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Expediting Examination of U.S. Patent Applications

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U.S. patent rights to an invention can only be enforced after the patent issues. However, due to a backlog in the U.S. Patent and Trademark Office's (USPTO) of approximately 700,000 patent applications, the average length of time before a patent application is even examined is over two years. In some areas of technology, the wait can be significantly longer. This prolonged examination of a patent application may be disadvantageous to an applicant for a number of reasons. For example, this may delay one's ability to enforce his or her rights to the invention, allowing infringing competitors to unduly gain market share. A postponement may also make it more difficult to raise capital or to license the patent rights. Fortunately, there are procedures that may be used to expedite examination of patent applications.

Prior to August 25, 2006, there was a long list of potential factors that could be used to support a "petition to make special" for expedited examination. Except for the factors of an applicant's age (over 65) or health, accelerated examinations have been replaced with the Accelerated Examination (AE) program. Under the AE program, a petition to make special can be filed for any application, but further requirements must also be met. The AE program requires that the applicant must conduct a pre-examination search. Applicant must also include an identification of all the limitations in the claims that are disclosed by the references, specify where each limitation is disclosed in each reference, and provide a detailed explanation as to how each of the claims in the patent application is patentable over the references found in the search. Although there are additional requirements under the AE program, these requirements alone add significant cost and can also result in a weaker patent due to estoppel resulting from the statements made to distinguish the claims over the references found in the search. This can result in a narrow, literal scope of protection due to the explanations given by the applicant of claim terms, without allowing claim terms to cover a range of equivalents under the doctrine of equivalents.

Fortunately, the USPTO more recently introduced another approach to obtain expedited prosecution for inventions related to "green technologies" which does not require a search, claim analysis, or patentability arguments as with the AE requirements. In addition, the Project Exchange program permits an application filed before October 1, 2009 to be accelerated, without the AE requirements if another co-owned application filed before October 1, 2009 is expressly abandoned in exchange.

Another recent option without AE requirements is the Patent Prosecution Highway (PPH) pilot program. Accelerated examination under the PPH is available for applicants who are pursuing patents in more than one country. Under the PPH program, applicants can take advantage of favorable findings by the first patent office in which the application is filed to expedite patent examination in another patent office. The PPH program currently exists between the USPTO and Australia, Austria, Canada, Denmark, the European Patent Office, Finland, Germany, Hungary, Japan, Korea, Mexico, Russia, Spain, Singapore and the United Kingdom. A U.S. patent application may be eligible to enter the PPH program if patentable claims are found in the first country where the original patent application was filed. However, the PPH program cannot be based on a favorable report on patentability issued in a PCT application.

A U.S. national phase application receives expedited examination if the claims were found to be patentable during the international phase based on a search by the U.S. searching authority. However, if the search was conducted by a foreign searching authority, expedited examination is not automatically available. The PCT-PPH program, still a trial program, now permits a favorable report on patentability issued in a PCT application to be used to expedite examination, even if the international searching authority was the Japanese, European or Korean patent office. While the favorable report is not given full faith and credit, to date, **patent applications in the USPTO's PCT-PPH program have been allowed at the rate of 98 percent**, more than double the overall USPTO allowance rate of 46 percent. Additionally, PCT-PPH applications have a shorter examination process, with an average of

1.17 Office Actions issued by the USPTO before disposal for PCT-PPH applications, significantly less than the overall average of 2.42 actions before disposal.

To be eligible for the PCT-PPH program, substantive examination must not have begun in the U.S. patent application and all claims must have the same, similar, or narrower scope as the claims found patentable in the PCT application. While a request to enter the PCT-PPH program requires no governmental fees, a verified English translation of all claims determined to be patentable must be provided to the USPTO along with a chart indicating how claims in the U.S. application sufficiently correspond to the patentable claims in the corresponding PCT application. An Information Disclosure Statement (IDS) that includes all documents cited in the PCT office is also required.

While the PCT-PPH program has many benefits, PCT-PPH applications are subject to the restriction that further claim limitations can not be added during prosecution unless the limitations were already present in at least one of the claims when the PCT-PPH request was granted. In the unlikely event that all claims in a PCT-PPH application are found to be unpatentable and limitations not previously examined must be introduced into the claims, a continuation application must be filed to introduce the new claim limitations.

There are now several options available to expedite the prosecution of a U.S. patent application. Due to the simplicity and the benefits of the PCT-PPH program, this option should not be overlooked for U.S. national phase applications when considering patent prosecution options.