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'Quick' issuance of patents

Wednesday, April 21, 2010
By Paul C. Remus

It is well known that the issuance of patents is anything but "quick." It now takes on average at least three years between the filing of a full patent application and the issuance of a patent, and that is a significant problem for inventors. It is particularly troublesome to a start-up company whose inventions can be copied by larger competitors with more "muscle" in the marketplace.

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Nevertheless, many companies follow a patent-filing strategy that is designed to minimize and defer the costs for filing patent applications, and the easiest way to accomplish this, unfortunately, delays examination of the applications and issuance of any resulting patents.

For example, many companies routinely file a provisional application prior to a regular application to defer costs by deferring the more expensive regular application for a year. Also, using the Patent Cooperation Treaty process for foreign filings allows companies to defer costly foreign filing decisions for up to 30 months.

Shifting to early filing of the regular application is a key tool. As soon as possible after the provisional filing, a regular application should be filed because the regular application is examined according to its filing date, not the provisional filing date.

The regular application should be drafted with an eye toward "helping" the patent examiner, who is much more likely to pick up a case having 10 claims rather than a case having hundreds of claims. Moreover, claims with widely varying scope are more likely to result in a restriction requirement, further delaying examination.

Also, in drafting the specification, it is important to explain the terminology used in the particular technical field, and it never hurts to explain, more than once, the needs addressed by the invention, taking every opportunity to convince the examiner of the non-obviousness of the invention.

Other steps can be taken in the prosecution of a regular application at the U.S. Patent and Trademark Office, including filing formal drawings, a signed inventor declaration and paying all requisite fees at the time of filing the application — all will expedite its examination and avoid the delays that follow receipt of a Notice to File Missing Parts.

Pilot program

After a regular application is filed, a number of formal procedures can expedite examination by the PTO. The first involves a "petition to make special."

If granted, such a petition expedites examination, but the grounds for obtaining one are limited. They include the inventor's health, age or that the invention will materially enhance the quality of the environment, contribute to the development or conservation of energy resources or contribute to countering terrorism.

The second such procedure is the recently announced pilot program for green technologies.

Under the program, examination of an already filed application that meets certain procedural and eligibility requirements will be expedited.

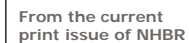
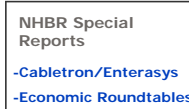
First, the invention must materially contribute to the discovery or development of renewable energy resources, the more efficient utilization and conservation of energy resources or the reduction of greenhouse gas emissions.

Second, the invention must fall into one of certain specified classes, which are fairly arbitrary and are based on the PTO's efforts to even out the increased workload generated for examiners by the pilot program.

A third procedure for expediting examination is the accelerated examination process, which allows applicants to obtain a final office action on a regular



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application within 12 months of the filing date, as opposed to the two to three years that is now typical.

The process requires compliance with a laundry list of procedural requirements, the most troublesome of which is an "accelerated examination support document," or SD.

The SD requires an applicant to perform, and report the result of, a thorough search of the prior art. The search must identify the references that are most closely related to the subject matter of the claims in the application, identify all limitations in the claims that are disclosed by the reference and discuss the patentability of the invention, including its non-obviousness.

The SD presents many problems. The first is that statements may result in a narrower interpretation of the patent than an examiner would have come to on his own. Another is that, if the patent is ever litigated, lawyers attacking it will undoubtedly accuse the patentee and his lawyers of misleading the PTO through one or more statements in the SD, making it possible for the court to render the patent unenforceable.

Companies interested in filing patent applications in other countries may possibly expedite examination of the regular U.S. application by filing a concurrent PCT application designating the United States as the international search authority.

The international search report for the PCT application must be prepared within nine months — a much shorter time frame than for the first office action on a regular U.S. application, which is more typically at least 24 months.

The company can contact the examiner to let him know that there is a corresponding regular U.S. application and ask the examiner to consider issuing the first office action on the regular U.S. application based on the international search report. The examiner may take advantage of an opportunity to apply a single search to two patent applications.

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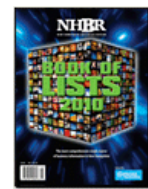
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