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Inventors find ways to expedite patents

By Peter M. Klobuchar

Business executives and inventors often want to know how long it takes to acquire a patent in the United States.

Typically the process, culminating in either an issued patent or a final rejection, takes about three years (but often longer). While the U.S. Patent and Trademark Office (USPTO) guarantees action within a prescribed time period, the guarantee is provided in the form of an additional term added to an issued patent's life if the USPTO fails to act within that prescribed period.

For many clients, such as those who depend on the acquisition of intellectual property assets to raise capital, the three-year time period is unpalatable and the USPTO's guarantee does little to help. The inevitable follow-up question is: How can the process be expedited? The good news is that the USPTO provides several avenues for expediting the patent application examination process.

Avenue 1: The most common method is known as the petition to make special. This allows an applicant to petition the USPTO to expedite the processing of a patent application upon a showing which, in the opinion of the USPTO, will justify so expediting it. Typically, such petitions are based on the applicant's age or health. The USPTO also considers expediting inventions that will materially enhance the quality of the environment, contribute to the development or conservation of energy resources or contribute to countering terrorism.

A petition to make special can be based on other grounds when accompanied by a fee required by the USPTO. Examples of petitions that require a fee include actual (not prospective) infringement, prospective manufacture, inventions related to recombinant DNA and inventions related to HIV/AIDS and cancer.

Avenue 2: More recently, the America

Peter M. Klobuchar is a registered patent attorney and a partner in the intellectual property practice at Ungaretti & Harris LLP. He can be reached at (312) 977-4416.

Invents Act of 2011 introduced the concept of prioritized examination. This allows an applicant to ask the USPTO to expedite examination of a patent application. There is only a minor limitation on the length and content of the application. The request must be filed with a new application plus a \$4,800 fee over and above the normal filing fees. The additional fee is reduced to \$2,400 for small entities and to \$1,200 for micro entities.

When an applicant opts for prioritized examination, the application will be accorded special status during prosecution. The USPTO's goal is to provide a final disposition within 12 months, on average, of the prioritized status being granted. A maximum of 10,000 requests will be accepted during the fiscal year, although the USPTO may revise that cap in the future.

Prioritized examination should not be confused with the accelerated examination program introduced by the USPTO in 2006. Under the latter, an applicant was required to conduct a pre-examination publication search and prepare a rigorous and expensive support document. Prioritized examination under the new act does not require either a pre-examination publication search or the support document.

Avenue 3: The USPTO has also implemented a program to expedite examination of patent applications that were originally filed in a different country. This program is called the Patent Prosecution Highway (PPH). PPH can speed up the examination process for patent applications filed in the United States by allowing USPTO patent examiners to reuse the search and examination results produced by patent examiners of most major patent offices throughout the world. It allows an applicant who has received a favorable ruling from a first patent office to request that a second patent office fast track the examination of like subject matter in corresponding applications filed in the second patent office. The USPTO claims that examination of a patent application will begin within two to three months from the date the PPH request was granted.

The PPH program recently has been expanded on a test basis to permit PPH eligibility for national phase applications filed under the Patent Cooperation Treaty (PCT) on the basis of positive results in the PCT international phase. In the PCT-PPH program, an applicant receiving a favorable patentability determination from one of the participating patent offices acting as an international authority may request that a corresponding national phase entry or a national application filed at the USPTO receive fast-track examination under the PCT-PPH program. An application filed under the PCT-PPH program will be handled similarly to an application filed under the regular PPH program.

Avenue 4: Finally, in an attempt to rapidly advance green technology, the USPTO developed the Green Technology Pilot Program. Under this pilot program, an applicant may have his/her patent application advanced out of turn (accorded special status) for examination if the patent application pertains to green technologies including greenhouse gas reduction (this includes applications pertaining to environmental quality, energy conservation, development of renewable energy resources or greenhouse gas emission reduction). To apply for the program, the applicant need only complete a simple form and prepare a statement of special status for eligibility in the program. Also, there are certain minor limitations on the length and content of the patent application. The deadline for entering the program has been extended twice, but will expire on March 30 of this year or when 3,500 applications have been accorded special status under this program. As of Jan. 2, the USPTO has received 5,162 petitions, granted 3,110 of them, dismissed 1,454 and denied 253. Almost 800 patents have been issued under the program.

Hopefully, when an eager client asks what can be done to accelerate the patent process, one of these avenues provided by the USPTO will provide the means. In any event, you should consult with a registered patent attorney for full explanations of the available options.