

USPTO Programs for Expediting Patent Prosecution: Accelerated Exam, Patent Prosecution Highway, Green Technology

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Accelerated Examination

- Available in non-Reissue non-provisional applications filed August 25, 2006 or after
- Final disposition of case within 12 months of filing
 - Final disposition can include allowance, abandonment, filing of RCE or appeal
- Must agree to interview, if requested
- Must agree to respond to telephone restriction, if requested
- Must agree not to argue for separate patentability of claims if the claim rejections are appealed
- Must certify that a search was done of U.S. patent and patent publication databases, including fields of search and search logic; search of foreign patent databases and non-patent literature
- Applicant must file an Accelerated Examination Support Document (unless acceleration is based on inventor's health or age, or based on PPH)



Accelerated Examination Requirements of Examination Support Document

- Information Disclosure Statement
- For every claim, show where the features of the claim are shown in the prior art search documents, and an explanation of how claim is different from prior art
 - Includes features disclosed but which are not presently claimed, but may be claimed at a future date
- Demonstrate Section 112 support in specification for each claim recitation
 - For means-plus-function (MPF) elements, identify the element as MPF and identify the corresponding structure, acts that correspond to the MPF element
- Identify references which may be disqualified as prior art under common obligation of assignment provision of Section 103(c)
- Statement of Utility (unless application is a design patent)



Accelerated Examination

- ❑ Does not apply to National stage entry applications, reissues, reexaminations or plant patents
- ❑ Petition to make special fee applies
 - Unless application relates to counter-terrorism, environmental quality or energy
- ❑ Application must be limited to 3 independent claims, 20 claims total and include no multiple dependent claims
- ❑ Examination on merits has 30 day reply dates, with no extensions granted as a matter of course, and replies must also include supplemented Examination Support Document for any new claims added

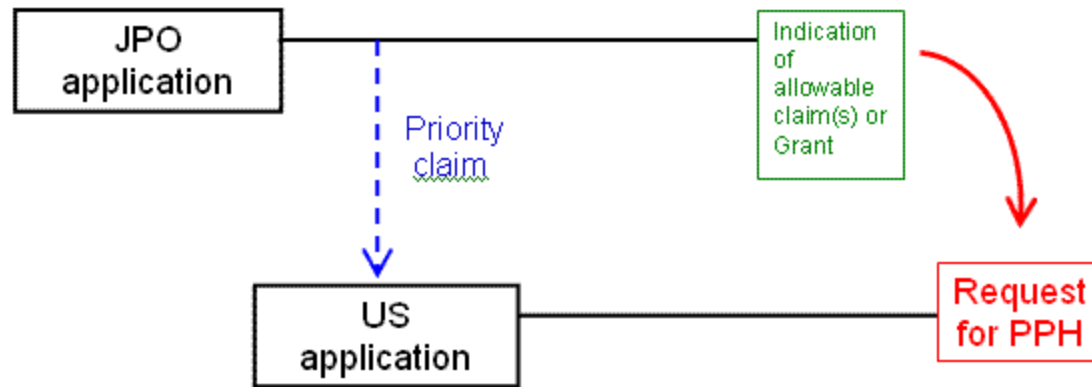


Patent Prosecution Highway

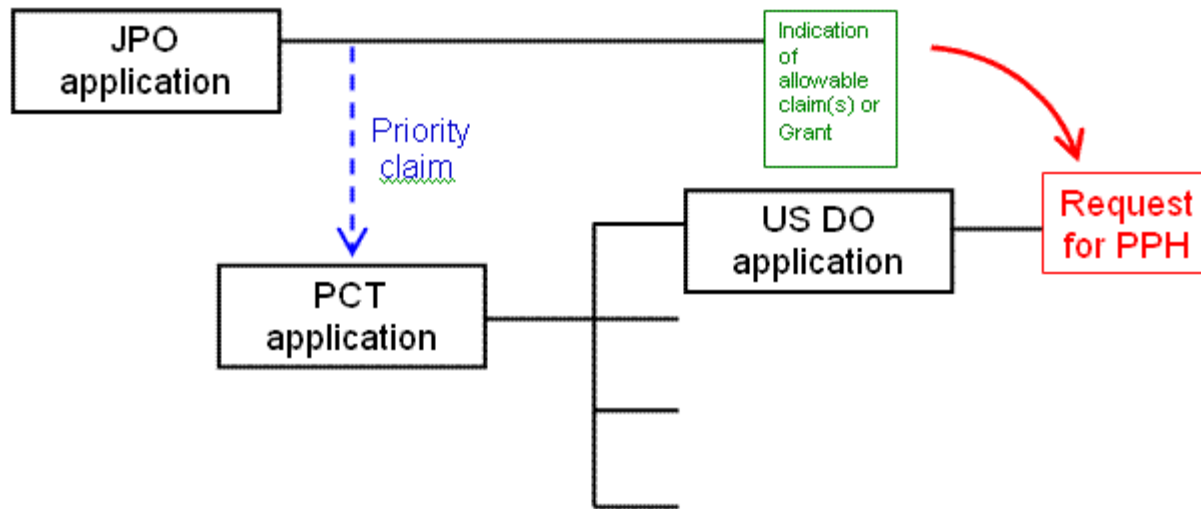
- U.S. application is a Paris Convention application with foreign priority claim to Office of First Filing (OFF), or is a national stage entry of a PCT application, or is a bypass continuation claiming benefit to a PCT application
- Claims stand allowed in the OFF



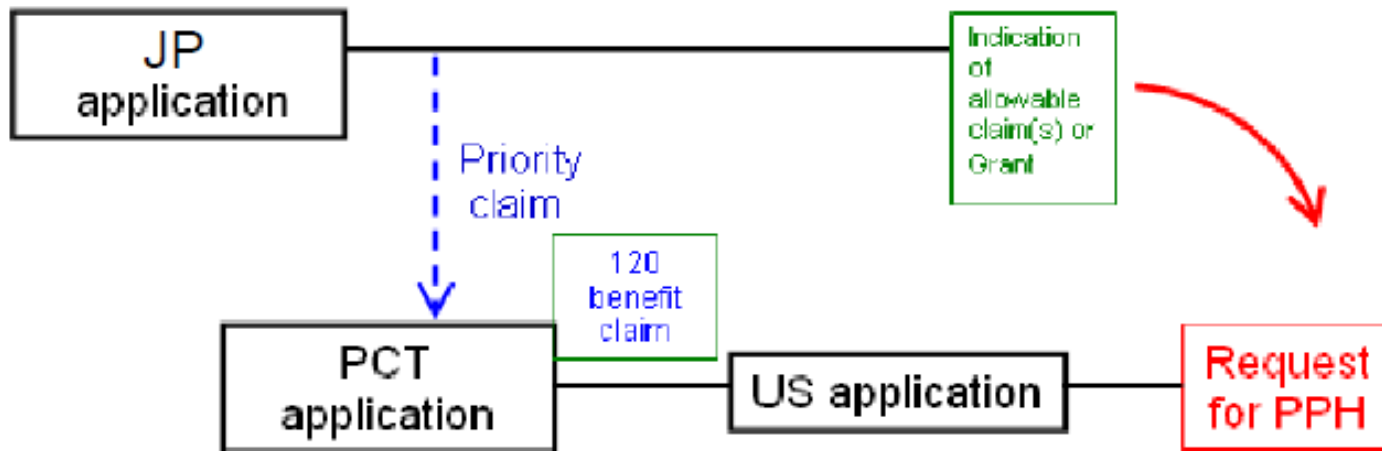
Patent Prosecution Highway Example 1



Patent Prosecution Highway Example 2



Patent Prosecution Highway Example 3



Patent Prosecution Highway (continued)

- Office of First Filing application (JP) has at least one claim that is determined to be allowable
 - Applicant must submit a copy of the allowable/patentable claims from the JPO application along with an English translation thereof and a statement that the English translation is accurate
- All claims of Office of Second Filing (U.S.) application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claims in the OFF application, and such correspondence must be shown with PPH request



Patent Prosecution Highway (continued)

- Applicant must file a request for participation in the PPH program, including a Petition to Make Special
 - No Petition Fees Required as of May 25, 2010
- PPH must be filed prior to start of substantive examination in USPTO
- Submit OFF Office Actions with English translations
 - Office Actions and translations are not necessary if the OFF document is a first action allowance
- IDS with all references cited in OFF Office Actions



Patent Prosecution Highway (continued)

- PPH does not impose time limits on USPTO to reach final disposition
- PPH generally reaches final disposition, on average, within 1.7 Office Actions while applications in the regular examination pool typically reach final disposition in 2.7 Office Actions



Green Technology Pilot Program

- Pilot program recently extended to December 31, 2011, or when 3000 applications are accepted into program (currently, 790 petitions have been granted)
- Invention contributes to
 - Environmental quality
 - Discovery or development of renewable energy resources
 - More efficient utilization and conservation of energy resources
 - Reduction of Greenhouse gas emissions
- Applicant must request early publication of application
- Applicant must agree to respond to telephone restriction, if necessary



Green Technology Pilot Program

- Request to participate in Green Technology Pilot must be received prior to first Office Action on merits
 - Written Restriction/Election qualifies as a first Office Action on merits
- National stage applications qualify for pilot
- Claims cannot exceed 3 independent claims and 20 claims total, no multiple dependent claims permitted



Green Technology Pilot Program

- ❑ Pilot program projected to shorten pendency cycle of application by 12 months
- ❑ First Office Action on the merits usually provided within 49 days of acceptance of Petition to Make Special under Pilot program
- ❑ Many applications issue within 1 year
- ❑ 94 applications of 790 granted Green petitions have already been passed to issue



Distribution of Green Tech Cases by Technology Area

Technology Center	Name of Technology Center	Number of Petitions
1600	Biotechnology and Organic Chemistry	77
1700	Chemical and Materials Engineering	530
2100	Computer Architecture, Software, and Information Security	81
2400	Computer Networks, Multiplex Communication, Video Distribution, and Security	8
2600	Communications	16
2800	Semiconductors, Electrical and Optical Systems and Components	394
3600	Transportation, Construction, Electronic Commerce, Agriculture, National Security, and License & Review	136
3700	Mechanical Engineering, Manufacturing Products	327
Not Assigned		26



*http://www.uspto.gov/patents/init_events/green_report_summary20101102.pdf

Comparison of Expedited Examination Programs

	Accelerated Examination	Patent Prosecution Highway	Green Tech Pilot
Time-savings	USPTO must reach final disposition within one year.* Severe constraints on time to respond to Office Actions	No USPTO mandated time for disposition. Avg. final disposition in 1.7 actions, as compared to 2.7 actions	No USPTO mandated time for disposition. Expected pendency reduction of 12 months
Service Costs	Must conduct comprehensive search and provide detailed examination search document.* Moderate to High	Submit charts showing similarity between allowed OFF and OSF claims. Translations required. Low-Moderate	Statement of impact on environment or energy conservation. Low-Moderate
Estoppel Risks	Must compare claims to prior art and map claims to specification. Moderate to High	Not significant	Not significant

*Does not apply when acceleration is due to inventor health or age

Comparison of Expedited Examination Programs

	Accelerated Examination	Patent Prosecution Highway	Green Tech Pilot
Subject matter requirements	Greater degree of freedom on subject matter	Must have allowed claim in Office of First Filing	Must comply with narrow technology areas
Claim limits	3 independent/20 claims total, no multiple dependencies	Must substantially conform with claims allowed in Office of First Filing	3 independent/20 claims total, no multiple dependencies
Statutory Fees	Yes, unless for environment, energy or counter-terrorism	No	No
PCT eligible	No	OFF can be based on PCT	Yes



Comparison of Expedited Examination Programs

	Accelerated Examination	Patent Prosecution Highway	Green Tech Pilot
Electronic Filing	Required	Required	Required
Timing of Request	At time of filing of complete application including filing fees and Declaration	Effectively, before first Office Action Rejecting Claims	Before First Office Action on the merits, including a Restriction. Must be before closing date of 12/31/11 or be first 3000 applications accepted
Uses	High commercial value inventions with short market cycle	Efficient prosecution in multiple jurisdictions	Support early market entry, funding



Questions?

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Thank you.

