

GO SPEED RACER GO! Winning Strategies for Getting that Patent
Issued – SPEEDILY.
by Michael Frodsham

The length of the patent examination process (generally 2-4 years) tends to frustrate inventors and large companies alike. Occasionally, the reasons relate to difficulties of a particular technical field, while others are more practical, such as not enough Examiners handling certain types of inventions. The following outlines a few points that can help inventors speed up the patent process.

Speeding up the Examination Process

In general, the options to speed up examination involve some combination of 1) more focused effort; 2) more money; and/or 3) combinations thereof.

Aggressive Interview Practice (Moving Faster through the Line)

The most common, and lowest effort approach to Examination tends to be the simple written responses by the Applicants back and forth with the Examiner. Without ignoring the value of a written record, Applicants and their patent counsel can take affirmative steps to educate the Examiner about the technology and related art through Examiner interviews.

Examiner interviews are often as simple as calling the Examiner, or holding an online video conference (WebEx). Applicants tend to find it to be more effective in most cases, however, to interview the Examiner in-person, which can better afford use of physical specimens or other useful demonstrations.

Meeting directly with the Examiner before the first office action and after the first office action can focus the arguments very quickly, bringing expected time to issuance from 4 years to 3 or perhaps even 2 years from filing.

Recommendation: Monitor the application after filing to identify when the Examiner is assigned, and schedule an in-person interview before Examination, and after each subsequent office action, to the extent allowed. Aggressively interviewed patent applications tend to be issued within 2 years from filing.

Patent Prosecution Highway (Getting Earlier in Line)

The USPTO partners with a number of other foreign jurisdictions to create what is called a “Patent Prosecution Highway,” or PPH. The PPH enables Applicants to jump to the top of an Examiner’s examination list by showing that the claims are considered allowable by another member of the PPH.

The question is how to get those allowable claims, especially for Applicants who do not have (or plan to have) large numbers of foreign filings. One way to do this is to file the international placeholder application (the Patent Cooperation Treaty, or PCT, application) along with the US patent application. When filing a PCT application, the Applicant designates which participating international search authority the Applicant would like to examine the case preliminarily, which generally comes down to factors such as cost and likelihood of relevance given the expected future filings. US Applicants can designate any of the following search authorities: (i) USPTO; (ii) European Patent Office (EPO); (iii) IP Australia; (iv) Russian Patent Office (Rospatent); and (iv) Korean Intellectual Property Office (KIPO). Of the aforementioned, the Russian patent office is the least expensive, while the Korean patent office tends to be the fastest at providing a search and examination report.

Another route is to file a direct national filing in a participating Patent Prosecution Highway (PPH) country, and request expedited handling of the search and examination.

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The above countries all have reciprocal relationships with each other, meaning that allowable claims in any of the above countries can be used to fast-track a pending application in the other. The USPTO provides additional information [at this link](#). Notably, the USPTO does not charge a government fee for the PPH request.

Filing a direct application (*i.e.*, not as a national stage of the PCT as an intermediate or priority basis application) in a PPH member country tends to be less expensive than that of a PCT application filed with the US or EPO search authorities, and can often provide a mixture of allowed claims and a registration in that particular locale. [In contrast, the PCT application only provides a search report, but no patent grant – its purpose is to provide an extended option to go into other countries at a later point.] Some of the above noted countries (e.g., United Kingdom) even provide expedited examination options at low cost, which can lead to allowable claims and patent grant within 1 year of filing still without reaching the costs of a PCT application.

Recommendation: File a PCT or direct national application in a PPH member country at the same time as filing the US non-provisional application. Upon receipt of a favorable search report, amend the US claims to conform to the allowed claims, and petition the case for fast

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track status under the USPTO's PPH program. This can provide a similar timeline as aggressive interview practice (patent grant within about 2 years), but with a bit less effort.

USPTO's Special Status (Getting Earlier In - and Faster through - the Line, without Added Cost)

The USPTO allows Inventors qualifying on certain grounds to move through the line without extra fees. For example, Applicants 65 years of age and older, or those with severely deteriorating health to have their patent applications qualify as "Special," and examined at a much faster rate. The USPTO applies the same status to inventions that enhance the environment, contribute to energy conservation, or contribute to countering terrorism. Other types of cases that the USPTO lists as available for special status with a small fee includes those having to do with manufacture, infringement, recombinant DNA, superconductivity materials, HIV/AIDS and cancer, and biotechnology applications filed by small entities. The Applicant merely needs to file a petition with the USPTO that outlines the relevant factors. The USPTO provides additional detail regarding the factors and relevant statistics for granting special status [at this link](#).

Notably, the USPTO will grant special status to Applicants qualifying under the age or health guidelines as a matter of course. The statistics vary much more with Applicants petitioning to qualify on the other factors. Historically, the USPTO grants special status to the other factors (*i.e.*, other than age/health) a little more often than it denies it, or around 50%.

Recommendation: Determine whether one or more inventors qualify for special status, or whether the invention is directed to a technology deemed special by the USPTO, and petition for special status. If granted special status, Applicants should expect the office action from the USPTO within about 4-5 months, and typically receive a patent grant within 1 year of filing. This is a reduction of 2-3 years from the expected timeline.

USPTO's Track One Status (Paying to Get Earlier In - and Faster through - the Line)

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Not surprisingly, the USPTO is willing to accept more money to move inventions to the front of the line. There is not much complication to this other than simply paying the expedited fee at filing. The USPTO provides details for Track One Prioritized Examination [at this link](#). As of 2019, the fees are as follows: large entities (more than 500 employees) pay \$4K USD, small entities pay \$2K USD, and “micro entities” pay \$1K USD. Adding in the other filing fees makes the total government costs alone approximately \$6K USD, \$3K USD, and \$1.5K USD for large, small, and micro entities, respectively. Of course, this is separate from any professional/attorney fees.

In contrast with special status applications, the USPTO’s primary requirement is that the Applicant request expedited examination upon filing. Secondly, Applicants can only request examination of up to 30 claims (including 4 or fewer independent claims). Any claims more than this, failing to pay the fees at filing, or requesting expedited examination even a day after filing, and the USPTO will simply deny the request, refund the expedited examination fees, and process the application under ordinary examination guidelines. There is no way for the Applicant to fix the error or amend the number of claims other than to file a new application, such as by filing a continuation application, or by filing a Request for Continued Examination (RCE) where applicable.

The USPTO grants Track One status to all properly filed and paid applications, and Applicants can expect a patent grant within 1 year of filing.

While Applicants may balk at the higher up-front costs, Applicants should consider that the quicker application process can result in fewer UPSTO rejections and the attendant costs.

Those factors, plus the ability to leverage the issued patent within 1 year of filing can provide significant cost reductions, and/or added value.

Recommendation: Determine whether the invention and budget merit enhanced filing fees and pay them upon filing. Applicants can expect an office action within 2-3 months, and issuance of focused claims in under a year. As with special status, this is a reduction of 2-3 years from the expected timeline.

Expedited Design Patent Filing (Similar to Track One)

Notably, the PPH and Track One programs are available only for utility patents. For designs patents, the USPTO provides (37 CFR § 1.155) that inventors can expedite design filing by paying the expedited examination fee (about \$500), and conducting a pre-examination search. The inventor supplies the pre-examination search results in an information disclosure statement, along with a pre-examination search statement, which is essentially a confirmation that the search was completed, and an indication of the search methodology, including search classes. Like Track One, the fees and materials need to be included with the filing of the application, and of course a complete application that includes design drawings.

Recommendation: Like Track One for utility patents, determine whether the design and budget merit enhanced filing and search fees. Perform the search, and either save the search strategy terms, or have the search professional prepare the pre-examination search statement along with the results. Provide the search results, statement, and extra fees upon filing. Applicants can expect an office action within 2-3 months, and issuance within a year. As with special status, this is a reduction of 2-3 years from the expected timeline.

Conclusion

Inventors have multiple options at their disposal to get patents issued quickly, in some cases as quickly as just a few months from filing. This is true for both utility and design patent applications. These include aggressive interview practices, using favorable patent examinations from other jurisdictions, qualifying under special status, and simply paying more fees (e.g., Track One). Applicants willing to invest a bit more money and time on the front end can expect to see an overall reduction in expected patent budget, and quicker options to enforcing their valuable patent rights. Specifically, a quicker path to issuance means less money spent in patent prosecution, and potentially more money reaping its value in the marketplace