



# ACCELERATING PROSECUTION

Presented by Michael Ben-Shimon & Ryan McCormick

## DISCLAIMER

This presentation reflects the thoughts and opinions of the presenter, and does not necessarily reflect the opinions of M&B IP Analysts.

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Different patent applications may require different approaches, and general principles should not be treated as absolute rules for all patent applications.

## EXECUTIVE SUMMARY

- Current state of prosecution timing
- Petitions to make special
- Track One
- Patent prosecution highway (PPH)
- USPTO new pilot programs (COVID, PTAB)

## WHAT IS PATENT PROSECUTION?

- A process in which one or more people at the United States Patent and Trademark Office (USPTO) evaluate a patent application for various **patentability criteria**
- A patent examiner will typically issue one or more **office actions** including reasons as to why the patent is not allowable in its current state
- The applicant may have the opportunity to **amend** the application and/or explain why the application is allowable
- If prosecution reaches an impasse, **appeals** and other options for escalating are available

# PATENT PROSECUTION TIMELINE

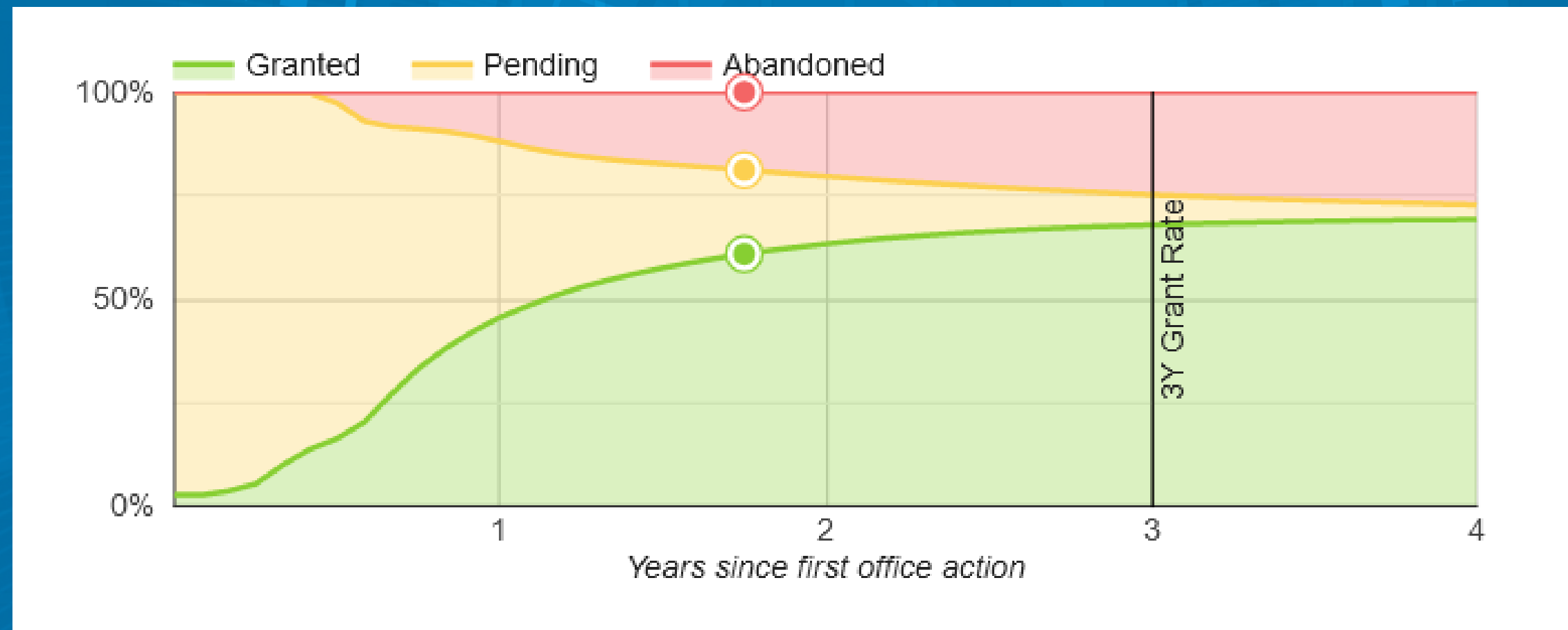
These are the main actions that can delay prosecution:

- A first non-final Office Action on the merits
  - *On average, issued by the Office **2 years** after the filing date*
- A final Office Action
  - *On average, issued by the Office **4 months** after a response on a non-final action is filed*
- An Appeal filed with the Patent Trials and Appeals Board (PTAB)
  - *On average, it takes **15 months** for the PTAB to decide on the case*

The amount of delay may be based on the Art Unit, Examiner, timeliness of response, and other, various, factors.

## GRANT RATE TIMELINE

- The grant rate timeline for USPTO, where the timeline is relative to the date of the first Office Action



SOURCE: PATENTBOTS.COM

# ACCELERATED PROSECUTION: BENEFITS

## Goal:

- Reduce the time until a patent is granted

## Benefits:

- Reduce costs on a specific application and a patent family
- Enable monetizing patents early
- Minimize damaging estoppel



## PETITIONS TO MAKE SPECIAL

- *37 CFR 1.102(C) Advancement of examination*
- A petition to make an application special may be filed **without a fee** if the basis for the petition is:
  - (1) The applicant's age or health; or
  - (2) That the invention will materially:
    - (i) Enhance the quality of the environment;
    - (ii) Contribute to the development or conservation of energy resources; or
    - (iii) Contribute to countering terrorism.
- Application will be advanced in the examination queue, but there is no guarantee of a specific timeline
- **Recommendation:** when you can make a case for a such a petition, favorably consider using this procedure.
  - *Examiners seem to honor petitions based on age*

# TRACK ONE PRIORITIZED EXAMINATION

- USPTO's Track One prioritized examination may allow for a final disposition within about twelve months.
- "Flexible" Requirements
  - Limit total number of claims to 30
  - Provide all required documents on filing
  - Timely respond to an office action
  - Can be requested with an RCE
  - No search is required
  - Pay fee – (\$4,200, large entity)
- Limited to 12,000 applications per year
- Our usual recommendation if you choose track-1, “examine” the application before filing. You typically will have one shot to get the application allowed.

## TAKE A FREE RIDE ON THE PATENT PROSECUTION HIGHWAY

### What is Patent Prosecution Highway?

- The PPH offers a mechanism by which positive examination results in a first office can be submitted to a second office in order to accelerate patent prosecution in the second office. There are two routes of PPH:
  1. PPH based on corresponding domestic patent application results
  2. PPH based on International Search Report and/or Preliminary Opinion in corresponding PCT application
- If a positive examination result has been obtained in one location, and the same scope of protection is desired in other geographic territories, PPH can make it much easier for a quick grant of corresponding pending patents in those territories

# THE PPH NETWORK



# PPH CORE REQUIREMENTS

- (1) The second application (at the second office) must have a "corresponding" first application(s) (at the first office)
- (2) At least one claim in each first application must have been indicated as being allowable by the first office (or search authority)
- (3) Each of the second application's claims must 'sufficiently correspond' to one of the claims indicated by the first office as being allowable in the first application(s)
- (4) Substantive examination by the second office has not begun
- (5) Continuation applications do not 'inherit' the PPH status of their parent
- (6) No fee for filing a PPH request with the USPTO

# PPH CONSIDERATIONS

- If correctly filed, a PPH requests provides a prioritized prosecution status
- PPH does **not** offer a guarantee of allowance
- PPH does **not** offer any 'filing' benefits (such as priority, different claiming strategies, etc.)
- PPH enables dramatically increasing the allowance rate and reducing the grant timeline

# PPH STATS

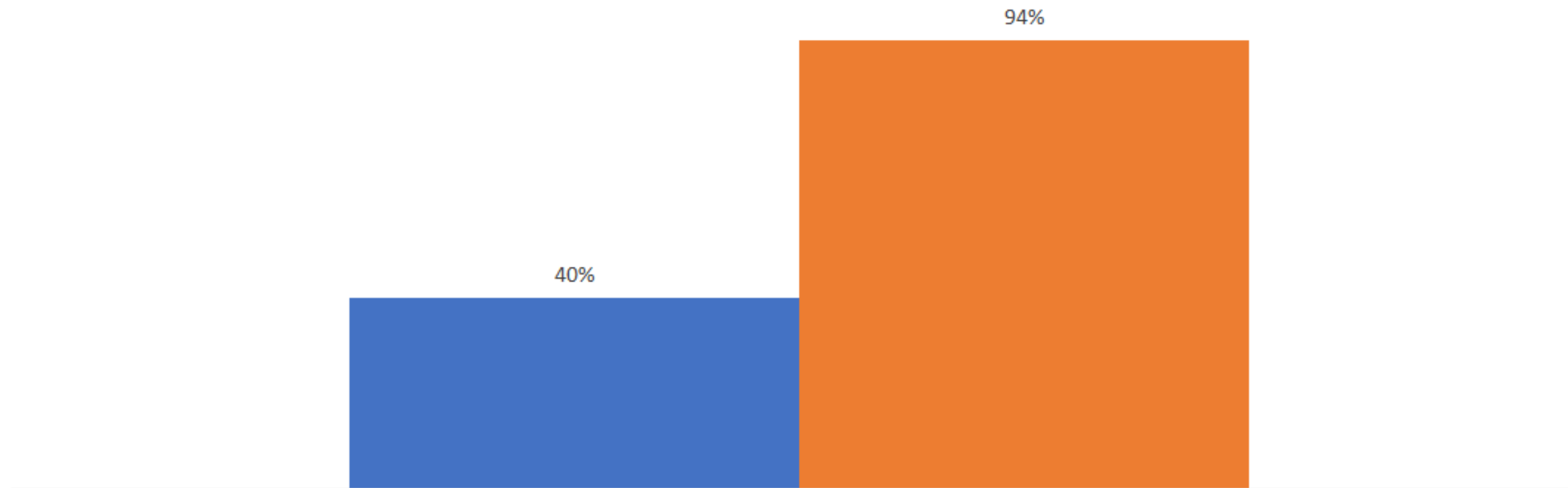
## Allowance Rate

■ No PPH ■ With PPH

40%

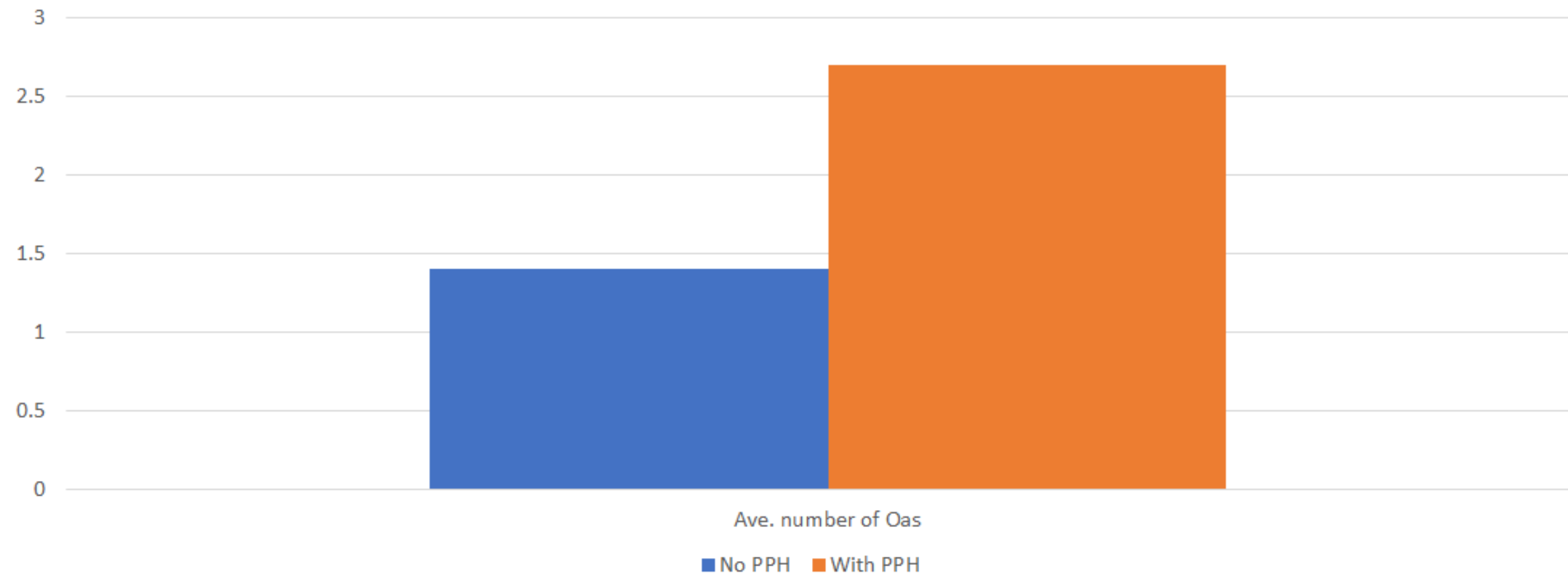
94%

Allowance Rate



# PPH STATS

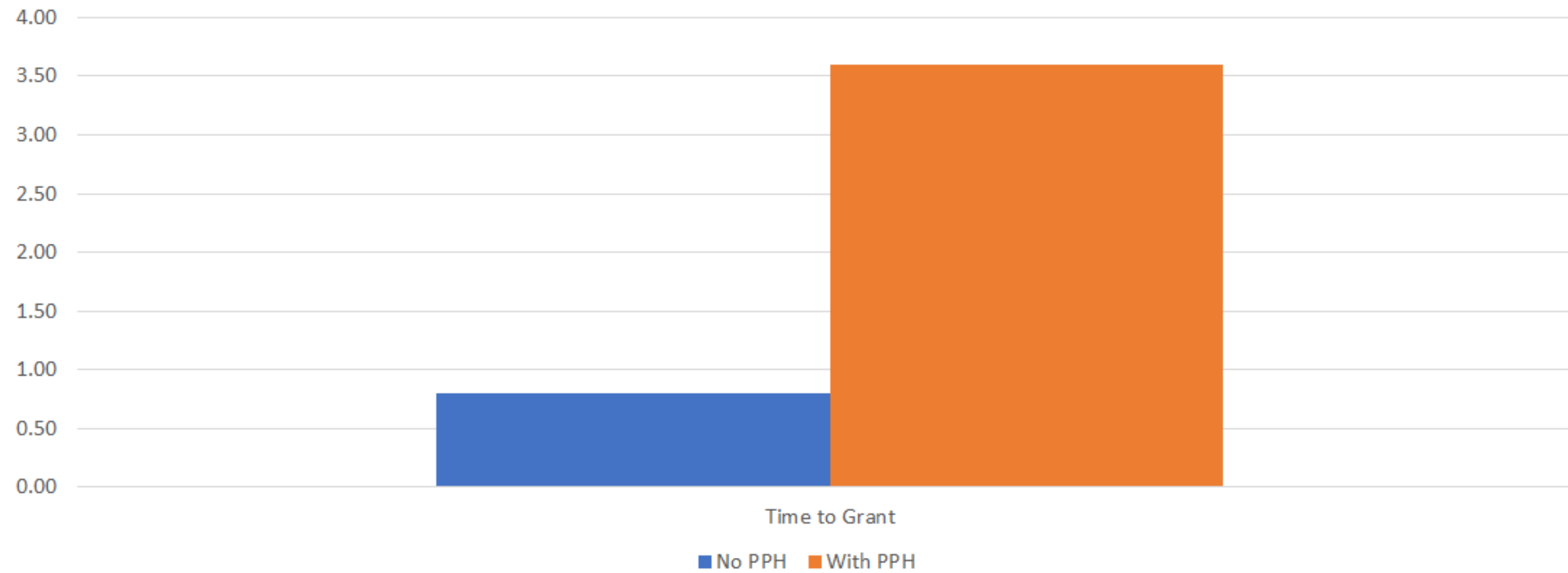
Average Number of OAs Rate



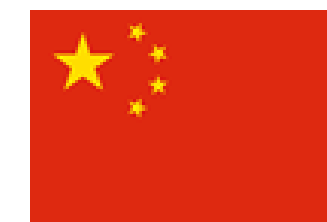
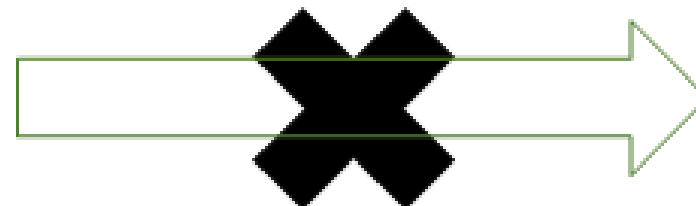
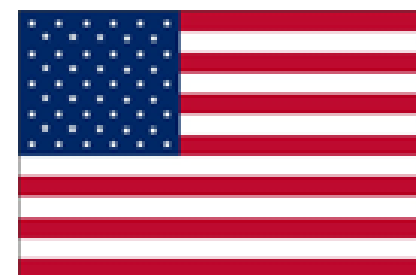
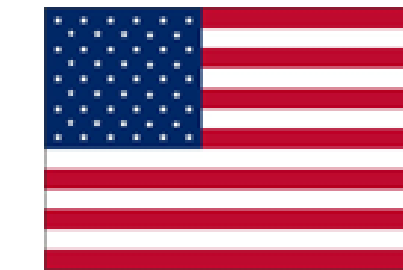
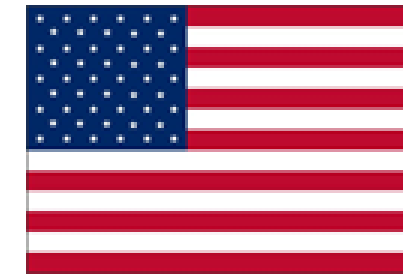


# PPH STATS

Grant Timeline



# BEST PERFORMING PPH ROUTES



# PTAB FAST-TRACK PILOT PROGRAM

- Fast-Track Appeals Pilot Program launched July 2, 2020 on *ex parte* appeals.
- On average, an appeal awaits a decision for **15 months**
- The USPTO expects that the average *ex parte* appeal reviewed under the Pilot Program will be decided within **6 months** from the date a petition is granted
- Requires the filing of a petition and addition fee (\$400)
- Does not accelerate the briefing process with the Examiner
- The Pilot is not available for applications or proceedings that are already treated as special during appeal (e.g., as reissue applications, reexamination proceedings, appeals made special due to the age or health of an applicant, etc)
- Status of appeal: The appeal must be pending before the PTAB.

## COVID-19 PRIORITIZED EXAMINATION PILOT PROGRAM

- USPTO grants requests for prioritized examination to patent applicants that qualify for **small** or **micro** entity status
- No fee
- The claims of an application must cover a product or process that is subject to U.S. Food and Drug Administration (FDA) approval for use in the prevention and/or treatment of COVID-19

# CONCLUSIONS

- Filing a PPH request can save time and money when electing a route of PCT into the US
- Filing a PPH request based on a US application in China and Europe does not improve allowance
- Tailor your filing strategy to fully utilize the benefits of the PPH program
- When applicable, use "free" acceleration programs suggested by the USPTO

QUESTIONS?

