

## Accelerated Examination of Patent Applications: Too Good To Be True?

by *Michael T. Siekman*

The U.S. Patent and Trademark Office (PTO) recently established a new procedure to provide for accelerated examination of certain patent applications with the goal of reaching a final disposition within 12 months of application filing. In FY2005, the average pendency of a patent application ranged from 25 months to 45 months depending upon the technology. Not surprisingly, therefore, news of a potential 12-month pendency has attracted considerable attention from patent applicants, particularly applicants seeking early patents to protect technology with a short life-cycle or applicants from early-stage companies seeking to use a patent to raise capital.

Sound too good to be true? Unfortunately, in most cases it will be. The new accelerated examination program has significant procedural drawbacks and may compromise the scope of any resulting patent. Thus it will likely be used for very few applications. Nonetheless, the new accelerated examination program could offer applicants willing to accept the procedural drawbacks and increased risk much quicker issuance of a patent.

### **Only the special are eligible**

The new accelerated examination program is a further development of

two preexisting PTO programs allowing an applicant to “advance[] an application out of turn” by petitioning for special status. First, an application could be made special if there was a prospective or actual infringer, if the inventor was terminally ill or over 65, or if the invention related to certain technologies. Second, an application could be made special under the former accelerated examination program if it complied with several procedural requirements, including providing a detailed discussion of how the invention was patentable over the most closely related references identified in a preexamination search.

Both types of petitions for special status were rarely filed<sup>1</sup>, for two main reasons. First, special status did not result in a clear deadline for the PTO to act. Many practitioners believed that special status did not actually affect the pace of examination, and the PTO’s own analysis confirmed that belief. Second, performing the preexamination search and preparing the detailed discussion of patentability under the former accelerated examination program was an expensive endeavor, especially since such statements could provide fodder for later inequitable conduct or claim limitation arguments in any litigation involving a resulting patent.

Because the procedural requirements of the new accelerated examination program are even more onerous than those of the former accelerated examination program, it is unlikely many applicants will use it.

### **Accelerated examination comes at a cost**

The new accelerated examination program requires an applicant to prepare and file significant additional papers, subjecting the applicant to less favorable PTO procedures. The application must be filed electronically, must be complete with all required papers and fees, and must conform to significant limits on the number of claims (3 independent claims, 20 total claims, and no multiple dependent claims). Also, applications must be limited to a single invention.



*Michael T. Siekman is a member of the Biotechnology, Pharmaceutical, Interference, and Litigation Practice Groups at Wolf Greenfield.*

*He assists clients of all sizes in IP matters including patent prosecution and portfolio strategy, due diligence, licensing, invalidity and noninfringement options, enforcement options, and litigation.*

*Email: [msiekman@wolfgreenfield.com](mailto:msiekman@wolfgreenfield.com)*

*Phone: 617-646-8336*

An application must also be accompanied by a Preexamination Search Statement (PSS) indicating that a search has been conducted, and describing the search strategy. Moreover, it must be accompanied by an Examination Support Document (ESD) citing each reference and explaining how each claim is patentable over them. These requirements existed under the former accelerated examination program, but the new program goes much further. The ESD must also identify all claim limitations disclosed in each reference, specify where they are disclosed, provide a concise statement of utility, and show where (in the application and in any benefit application) each limitation finds written description support. These additional requirements will greatly increase the cost. They will also greatly increase the risk that the applicant will make statements that an accused infringer could use later to effectively narrow the scope of the claims or to bring a charge of “inequitable conduct” for making misrepresentations, even if essentially groundless.

Applicants normally have 3 months to respond to an Office Action, and extensions of an additional three months are available. In the new program, applicants will have one month to reply, with no extensions of time available. Also failure to timely respond will result in abandonment of the application. Finally, the Applicant must file all replies using the PTO’s electronic filing system and must update the ESD if the claims are amended outside the scope of the original ESD.

#### **12-month goal**

A “final disposition” for purposes of the 12-month goal is not an allowed patent. Rather, a Notice of Allowance is a “final disposition,” and it would take an additional several months from then before a patent actually issues. Of course, the PTO may still find the claims unpatentable, eventually resulting in a final Office Action, Notice of Appeal, or Request for Continued Examination, all of which would also qualify as a final disposition. Finally, the 12-month goal is just a goal, and there is no recourse

available to the Applicant if the PTO fails to reach it.

Given the significant costs, procedural drawbacks, and risks associated with the accelerated examination program, it appears very unlikely many applicants will request accelerated examination. For the great majority of applicants, other suggested proposals (increased hiring, training, and retention of patent examiners; improved collaboration with foreign patent offices) would better address the delays in obtaining a patent. But informed applicants willing to pay for significantly more work while accepting an increased risk may be able to utilize the new accelerated examination program to obtain a patent much quicker than the average applicant—including, perhaps, potential competitors.

#### **(Footnotes)**

<sup>1</sup> Applicants filed over 350,000 patent applications in FY2005, and the PTO ended FY2005 with a backlog of over 600,000 applications. But only 2,234 total petitions to make special were granted in FY2005, and only 926 of those were filed under the former accelerated examination program.

*continued on page 3*