

DOHERTY  
& WALLACE  
PILLSBURY  
MURPHY P.C.

*Attorneys at Law*

1414 Main Street, One Monarch Place · Springfield, MA 01144-1002  
Telephone 413-733-3111 · Fax 413-734-3910 · E-Mail [dwpm@dwpm.com](mailto:dwpm@dwpm.com)

## Point of View

*A Quarterly Newsletter*

*Spring 2007*

### ACCELERATED PATENT EXAMINATION

by Karen K. Chadwell, Esq.

The United States Patent & Trademark Office (the "Office") recently promulgated an alternative process for examining utility and design patent applications. The goal of this new process, which the Office has coined "accelerated patent examination" ("APE"), is to expedite the examination process such that any one of a Notice of Allowance, an appeal, or an abandonment, occurs within 12 months from the filing date of the patent application. This is an improvement over the standard examination process where it may take several years for an Examiner at the Office to even begin reviewing the patent application.

However, there are limitations to a patent applicant's use of APE. For example, APE only applies to utility and design applications. It does not apply to reissue applications (i.e., applications revising inaccuracies contained in the originally issued patent), applications claiming priority to international applications, reexaminations (i.e., requests to review the accuracy of issuing a patent in light of relevant prior art not previously considered by the Examiner), and plant patents.

Although APE has the advantage of moving utility and design patent applications through the examination process at a ready speed, there are several more filing requirements under APE as compared to the filing requirements attendant with traditional filing procedures. For example, to invoke the traditional examination process, a patent applicant need only file the patent application, along with the appropriate filing, examination and search fees, an oath/declaration, and, where appropriate, an information disclosure statement. However, to implement APE, the patent application must, in addition to the

traditional filing requirements listed above, also file:

- a petition to make special;
- a petition fee, which, at the time of this writing, is set at \$130.00;
- a pre-examination search document specifically describing a prior art search conducted by the applicant or his/her representative; and
- a support document pointing out: (a) the section(s) of the prior art reference(s) relevant to the patentability of the claim(s); (b) how the claim(s) is distinguished over the prior art reference(s); (c) a statement as to the utility of the invention; and (d) how the claimed invention meets the "enablement" and "best mode" requirements under the Patent Act.

In addition to having additional filing requirements, APE is further distinguished from traditional patent examination as noted below:

- All documents and follow-up documents, e.g., responses to Office actions, must be filed electronically using the Office's electronic filing system.
- Prior to the issuance of an Office action, the Examiner will attempt to conduct a telephonic interview with the applicant unless to do so would unlikely resolve the issues. Accordingly, the applicant must be willing to conduct such an oral interview.

- After the issuance of a non-final Office action, the applicant will have only 1 month as compared to the 6-months granted under the traditional examination procedure, in which to respond to the Office action. Although there are no time-extensions allotted for under 37 CFR 1.136(a) to this time deadline, the applicant may seek an extension under 37 CFR 1.136(b) (extension for sufficient cause) (NOTE: this shortened statutory period of response does not apply to final Office actions).
- Any decision by the Office to deny the petition to make special, and hence, which denies the request to expedite the prosecution of the application, is non-appealable and non-petitionable. Accordingly, should the Office deny an applicant's petition to invoke APE, the application is placed at the bottom of the queue and is examined according to traditional examination procedures.
- Should the Office dismiss the petition to make special, e.g., should the Office find that the applicant has not filed all of the requisite documents necessary to qualify for APE, the applicant shall have 30 days to respond to the dismissal. However, the applicant is afforded only one opportunity to perfect the defective petition.
- Claims. The claims are a section of the patent application which provide the legal scope of protection to be afforded to any particular patent. Traditionally, so long as the applicant is willing to pay for them, a utility patent application can have any number of independent and dependent claims, where the dependent claims may be drafted to claim dependency on any of the preceding claims. However, under APE,
  - the number of independent claims cannot exceed 3, and the total number of claims cannot exceed 20;
  - multiple-dependent claims are not allowed; and
  - all of the claims must be directed towards a single invention.
  - Additionally, should amendments be made to the claims or should new claims be added to the application during the prosecution of the application, the applicant may need to submit additional search documents and support documents to support the patentability of the amended and/or newly added claims.
- Currently pending applications may be made special by the accelerated examination process by filing a continuation application.
- APE does not apply to petitions to make special based on the health and/or age of the applicant. However, to ensure that the application will be expedited under 12 months, the applicant is encouraged to use the accelerated examination process even if the applicant qualifies for expedited examination under the health/age exceptions as these applications are not always examined within 12 months filing.
- Design patent applications may use the previously implemented "rocket docket" procedure for expedited examination in lieu of APE. The "rocket docket" procedure allows a design patent applicant to move his/her application to the head of the examination line so long as the applicant submits the appropriate fee, formal drawings, a pre-examination search report, and an information disclosure statement.
- The Office makes no guarantee that the examination under APE will be complete within 12 months; hence, there are no repercussions, other than what currently exists, should examination extend past 12 months.

Therefore, although APE strives to improve the speed at which the Office examines and issues utility and design patents, it does require a greater contribution on the part of the applicant, both in terms of labor and in financial costs, as compared to the more traditional mode of filing and prosecuting utility and design patent applications. However, as a patent cannot be enforced until after it issues, depending on the technology and the market demand of the invention, it may well behoove the applicant to spend the extra time and money to facilitate a timely issuance of the patent. This is particularly true for business method patent applications and for inventions falling within "crowded" technological fields, where just the initial examination of these types of applications may take several years. For these patent applications, then, APE is likely to be a worthwhile course of action.

*Karen K. Chadwell is an associate specializing in intellectual property, with an emphasis on patent and trademark prosecution. For information relating to the present topic or other intellectual property-related issues, contact any of the following members of the firm's intellectual property group: Deborah A. Basile or Karen K. Chadwell.*

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