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How To Fast-Track Your Patent App

Law360, New York (August 24, 2010) -- Benjamin Franklin, one of the country's first and most famous inventors, said that "time is money." This is certainly true for patenting, where the average pendency for a patent application is three to five years.


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For many businesses, this can mean the difference between a large windfall and small profits, between economic viability and company closure. Many companies with new and innovative products need patents quickly to deter competitors from copying their products.

Patents may also be needed as bargaining chips in an existing or future licensing negotiation or lawsuit.

Companies have considered turning to accelerated examination, a process introduced by the U.S. Patent and Trademark Office in 2006 to obtain patents more quickly. The goal of this process is to arrive at a final patentability decision within 12 months.

A final decision may be a final rejection, a notice of allowance or an abandonment. Even if prosecution continues after 12 months (e.g., due to further prosecution as a result of request for continued examination filings), an application undergoing accelerated examination continues on the fast track internally at the USPTO.

Furthermore, applicants must also be prompt in their responses to office actions as they have only one month to respond to them. Taken together, this results in the rapid processing of the application.

Numerous patents have been issued quickly under the AE process, even with significant prosecution. Some examples include U.S. Patent Numbers 7,720,933 (18 months to patent with three office actions); 7,567,920 (13 months to patent with one office action); and 7,260,212 (five months to patent with a first action allowance).

Eligibility for Accelerated Examination

Eligibility for accelerated examination is determined by a number of requirements. Some of the more important requirements are listed below.

1. The application must be complete on filing. For example, the application must include all filing fees, as well as an oath of declaration.

2. The application must be limited to a single invention and must not have more than 20 total and three independent claims.

3. A petition, a pre-examination search document and an accelerated examination support document must be filed with the application.

The pre-examination search document must show that a thorough prior art search including a search of foreign and domestic patents and printed publications has been conducted. The AESD must discuss the prior art in detail and must provide a showing of where the limitations in the claims can be found in the prior art. It must also explain why the claims are patentable over the prior art.

Success of Accelerated Examination Process

Many companies have been successful in taking advantage of the AE process. Statistics provided by the USPTO as of July indicate that about 3,900 accelerated examination applications have been filed, and about 62 percent of the petitions have been granted.

If an AE petition is not granted, the application is not abandoned, but is examined in order with other regular patent applications.

Although prosecution is compact, the allowance rate for patent applications undergoing accelerated examination is also relatively high. USPTO statistics indicate that of approximately 2,300 applications examined in the AE process, the allowance rate is about 61 percent, higher than the recent historical overall application allowance rate, which is typically less than 50 percent.

There are a number of reasons why the accelerated examination process results in more allowances. First, many applicants submitting accelerated examination applications tend to submit claims of narrower, but reasonable scope. This is done to improve the chance that a patent will issue quickly and to reduce the chance that application processing will be delayed by multiple prior art rejections.

When pursuing claims of narrower scope in the AE process, broader claims can be pursued in a continuation application filed under a normal examination process.

Second, because a thorough search has been performed by the applicant and the search results and extensive search history are of record, a patent examiner is more likely to feel comfortable allowing the application early in the examination process.

In a regular examination process, an examiner may feel less comfortable allowing an application early in the process, because he or she may not feel that sufficient prior art and/ or arguments are in the application file to justify an allowance.

When to Utilize the Accelerated Examination Process

There are of course a number of drawbacks to the AE process. These include the additional costs associated with the preparation of documents for the AE process. The additional costs can often range from $10,000 to $15,000.

Also, because the prior art and the claims must be discussed in detail before the USPTO ever issues an office action, applicants will be generating prosecution history estoppel.

There are a number of counter arguments to these perceived drawbacks. For instance, because the prosecution history of an application is likely to be shorter in an AE process, overall prosecution costs and likelihood of generating potential file history estoppel could actually be reduced, because applicants will be responding to fewer Office Actions.

Further, an argument can be made that a patent that has undergone accelerated examination is actually stronger than an application undergoing normal examination, because there is a much more extensive search record in the file for an AE application.

Accelerated examination is not suitable for all situations. However, when business needs of a company necessitate a short application process, accelerated examination should be one of the first filing options considered.

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