

LAW WEEK

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Better, Faster, Cheaper Patents

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THE U.S. PATENT and Trademark Office, or USPTO, is often criticized for long delays between when a patent application is filed and when it is actually issued. Many believe these delays are harming innovation. As the rate of patent filings increases, the problem is only getting worse. Thankfully, there are now new options that can result in getting a patent in months, not years, and for far less cost.

Even with the recent expansion of the patent office to five locations including Denver, the backlog of patents at the USPTO is unacceptable. Patents are a catalyst for innovation and business growth. Delays in issuing a patent can mean the difference between getting funding or closing down a business or promising project. The average delay for issuing a patent is three years, but the hottest new areas of innovation can easily take five years or longer.

To its credit, the office now offers those needing quick patents several different options. The first option is called the Patent Prosecution Highway. It allows patent claims in one member country to move to the front of the examination line in other countries. This system recognizes that vetting in one country will make examination in another easier. Additionally, a patent filed under the Patent Cooperation Treaty, a so-called PCT application, can move examination to the front of the line under the prosecution highway where the examination is found to have no particularly relevant prior art.

Another technique offered by the office is Track 1 or fast track examination. For an additional fee at filing, the patent is examined immediately. The goal is to issue or deny the patent within one year from filing to allow those needing a quick decision the immediate



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feedback they desire. Traditional examination is now called Track 2, with a slow Track 3 in the works. The additional fee for Track 1 is \$2,000 or \$4,000 thousand dollars depending on company size.

Quick handling by the patent office is only half the equation. A patent can be “hand-carried” through examination by extensive use of in-person interviewing. Most practitioners would say that that there is no need to meet with the examiner in person. That might be true if slow and less persuasive advocacy is the goal. For fast track examination, however, it is wise to use every opportunity to orally advocate for a client’s patent rights.

The USPTO understands the efficiency of direct interaction with their examiners. A First Action Interview program allows a practitioner to discuss the case with the examiner before a formal rejection is formulated. At this early stage, one interview with a good oral

advocate can accomplish what would typically take several rounds of paper argument.

A fast track examination process that combines the patent prosecution highway, Track 1 and first action interview can achieve spectacular results that save clients significant legal fees. Instead of four rounds of paper argument, now it just takes one round of oral argument on average. Litigators know that fewer rounds of argument tend to equate to a better patent because there is less prosecution history estoppel. It is also important because the opportunity to achieve allowance in under a year can help clients align patent issuance with funding strategy for the first time.

Some might be concerned that this stepped-up advocacy is far too costly, but the opposite is true. It allows us to draft an application that is “better-than-most” with a budget that matches, to assure nothing is lacking in the original filing. We can concentrate on the fewest rounds of oral argument, which saves more than the average fees for applications with four rounds of paper argument. Quite frankly, these new, faster options might mean fewer fees for the firm, but they are definitely appealing for clients who need patents done better, faster and cheaper than the traditional manner.

If the goal is to save money, get a stronger patent and have that patent issued faster, it would be smart to work with counsel who are familiar with these new options. Only the strongest oral advocates with the deepest bench of prosecutors can deliver the horsepower to retool a patent program and get great patents issued in mere months with little or no prosecution history. •

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