



Accelerated Examination

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AE: Discussion Points

1. Authority and Overview: resources / goal / exceptions
2. Filing Requirements: common errors and tips
3. Petition Requirement: search and support document: common errors and tips
4. Petition Review: denied and dismissed
5. TC-1600 Examination Processing: conference; prosecution; FY09 Overview
6. Benefits



AE: Authority

- **37 CFR 1.102 and MPEP 708.02 VIII**
- **Effective August 25, 2006**
- **Petitions prior to this date are not included**
- ***For more information, see “Changes to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination” (Federal Register: June 26, 2006 (Volume 71, Number 122): Pages 36323-36327) – available on USPTO web site at: <http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.htm>***
- **<http://www.uspto.gov/patents/process/file/accelerated/index.jsp>**



AE: Overview

- **“Special” status: advances an application out of turn for examination**
- **GOAL: achieve a final decision by the Examiner within 12 months from the filing date**
- **Apply to all petitions to make special, except for:**
 - **Age and Health**
 - **Patent Prosecution Highway**
 - **Green Technology Pilot**
 - **Backlog Reduction Stimulus Plan.**



AE: Filing Requirements

- 1. Electronically Filed**
- 2. Complete at filing**
- 3. $\leq 3/20$ claims directed to a single invention**
- 4. No multiple dependent claim(s)**
- 5. Fee: 37 CFR 1.17 (h)**
 - **or a statement that the claimed subject matter is related to environmental quality, energy or anti-terrorism**
- 6. Petition to make special**
 - **use PTO/SB/28**



AE: Common Filing Errors

- **Improper Filing**: e.g. contains a preliminary amendment
- **Not In Condition for Examination**: e.g., contains a a 37 CFR 1.47 petition for a non-signing inventor
- **Untimely Filing**: e.g. filed during mid-prosecution
- **Incomplete Filing**
 - unexecuted oath
 - missing or defective drawings
 - missing or non-compliant sequence listings



AE: Filing Tips

- **Satisfy the Filing Requirements**
 1. **For a Filing Date: Provide a specification, at least one claim and any required drawing - §1.81(a) and 1.184**
 2. **For a Complete Filing: include**
 - **the basic filing fee**
 - **an oath or declaration pursuant to §1.63**
 - **a correspondence address - § 1.33(a)**
- **Avoid:**
 - **37 CFR 1.16(f) surcharge**
 - **Notice To File Missing Parts to address the above deficiencies**
 - ✓ **See: MPEP 601.01(a); 37 CFR § 1.53**



AE: Filing Tips Cont.

- Can use application data sheet (ADS)
 - in lieu of oath for foreign or domestic priority claims
 - to effect cross-reference (37 CFR 1.78)
- For non-English specifications, timely provide English language translation under 37 CFR 1.52(d), an accuracy statement and the fee
- Include necessary Sequence Listing



AE: Petition Requirements

- **Petition must be accompanied by:**
 1. **Pre-Examination Search**
 2. **Accelerated Exam Support Document (ESD)**
- **Statements that applicant will:**
 1. **Make election w/o traverse in a telephonic interview**
 2. **Agree to have an interview when requested by the examiner**
 3. **Not separately argue any dependent claim on appeal**
- **See: PTO/SB/28 Petition to Make Special Under Accelerated Examination Program at http://www.uspto.gov/patents/process/file/efs/guidance/Form_fillable_pdfs_available.jsp**



AE: Pre-Exam Search

- **Must include a search of:**
 - **U.S. Patents**
 - **Patent application publications**
 - **Foreign patent documents**
 - **Non-patent literature**
- **Search directed to the claimed invention giving claims their broadest reasonable interpretation**
- **Include a classification search and text search**



AE: Deficient Pre-Exam Search

- **Petition dismissed if partially deficient**
 - **Will include specifics regarding deficiency with suggestions to remedy**
- e.g., Missing or Incomplete Search**
- **Missing: point out that search is required**
 - **Incomplete: guidance directed at improving the search will be given in the decision**



AE: Common Search Errors

- **Incomplete Search:**
 - **substantive: does not address key claim limitations**
 - **procedural: does not include foreign patent search**
does not document USPAT search terms



AE: Search Tips

- **Search the claimed invention**
 - **search must be commensurate in scope with the claims**
- **Search should include U.S. Patents and pubs, foreign patents & pubs and non-patent literature**
- **Provide the text search logic**
 - **a listing of terms will not suffice**



AE: Examination Support Document (ESD) Requirements

- **ESD must include:**
 1. **An information disclosure statement (IDS) citing each reference deemed most closely related to the claims**
 2. **An identification of where each limitation disclosed in each reference is found**
 - **Refer to specific paragraphs or drawing elements**
 3. **A detailed explanation of how each claim is patentable over each reference**
 - **Be specific – general statements are not sufficient**



AE: ESD Requirements Cont.

- ESD must also include:
 4. A concise statement of utility of the invention.
 5. A showing of support for each claim limitation in specification
 - Point to page and line numbers or drawing elements
 6. An identification of any cited references that may be disqualified as prior art under 35 U.S.C. 103(c)



AE: Common ESD Errors

- **PTO-1449 (PTO/SB/08) fails to include reference(s) discussed in the ESD**
- **Fails to apply reference(s) to claim limitations**
- **Fails to provide a detailed explanation of how each claim is patentable over each reference**



AE: ESD Tips

Clearly point out by specific claim language how each claim is patentable over each reference

- **Each reference discussed must be presented in an IDS**
- **Show support in the specification and/or drawings for each limitation of each claim. Be specific**
- **Clearly and specifically identify the limitations in each claim**
- **A chart is a clear, convenient format**



AE: Petition Review

- Denied if:
 - Fails to meet filing requirements
 - Application type ineligible (plant, reissue, reexam, 371)
- Preliminary dismissed if defective
 - Defects are specifically noted
 - One (1) chance to cure
- Ultimately Denied if:
 - Applicant is unable to timely cure defect(s)



AE: TC-1600 Examination Processing

The application will be taken up for action shortly after favorable petition decision granting “special” status

- The examiner will complete a prior art search
- If more than one invention, applicant must elect w/o traverse
- Telephone restriction practice (MPEP 812.01)
 - 1st claimed invention examined if:
 - ❖ Applicant refuses to elect without traverse; or
 - ❖ the examiner cannot reach applicant after a reasonable effort



AE: TC-1600 Examination Processing cont.

- **Prior to any first Office action on the merits (FAOM):**
 - **Conference held to confirm rejection or identify allowable subject matter**
 - **Telephone or personal interview is conducted prior to first office action**
- **Following a FAOM: an additional conference will be held prior to any final rejection or allowance**



AE: TC-1600 Conference

- **The TC-1600 conference is composed of:**
 - **The Examiner assigned to the application;**
 - **The Examiner's Supervisor (SPE); and**
 - **A Quality Assurance Specialist (QAS) or designated SPE**
- **Additional Examiners (e.g., training primary examiner) and/or Managers may be consulted, if needed**



AE: Applicant's Reply

- **Shorter Statutory Periods (SSP) for applicant reply:**
 - 1-month (or 30 days) for any action except final rejection or allowance
 - No time extensions under Section 1.136(a)- only 1.136(b)
 - Reply must be electronically filed
- **If response includes either amended or newly-added claims:**
 - An updated search will be required if claims are not encompassed by the pre-examination search
 - An updated ESD (examination support document) will be required if claims are not encompassed by original ESD



AE: Applicant's Non-Responsive Reply

An amendment (including after final and RCE submissions) is non-responsive (not entered) if it:

- **Exceeds the 3/20 claim limit;**
- **Presents claims to a non-elected invention;**
- **Presents claims not encompassed by the pre-examination search, or an updated search; or**
- **Presents claims requiring an updated AE support document but no AE support document has been submitted**



AE: Non-Responsive Reply

- **Must respond timely:**
 - **Examiner may provide one month (or 30 days) to supply the omission or a fully responsive reply for a bona-fide response to FAOM only**
 - **No extensions under 37 CFR 1.136(a)**
 - **Abandoned if not timely cured**



AE: Withdrawal From Special Status

- No AE provision for “withdrawal” from special status
- An RCE will not effect “withdrawal”
- Can abandon in favor of a “continuation” which is not special unless a new AE petition is filed and granted



AE: TC-1600 FY 2009 Overview

- **77 AE Petitions Filed:**
 - 68 Granted
 - 7 Denied
 - 2 Dismissed (deficiency not cured)

- **68 in AE Status:**
 - 36 Allowed / Issued (53 % allowed, so far)
 - 21 Non-final status
 - 11 Non-Allowance Final Disposition:
 - 6 Finally rejected
 - 1 Appealed
 - 4 Abandoned

- ❖ **36/40 = 90% of disposals are allowances**
- ❖ **All disposals achieved within 12 months from filing**



AE: Benefits

- Final patentability determination in 12 months
- ✓ Good for inventions with a short lifespan
- ✓ Patent may be granted at the peak of the technology's life
- ✓ Benefit inventions in very competitive markets
- ✓ Information provided more quickly to those seeking to avoid infringement
- ✓ Can be used to accelerate prolonged prosecution
- Claim drafting is more focused and clear
- Earlier and extended interaction between applicant and examiner



Questions

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