

# REPORT

## EXPANSION OF PROGRAM TO EXPEDITE EXAMINATION OF PATENT APPLICATIONS

June 25, 2010

The United States Patent and Trademark Office (USPTO) has expanded its Patent Application Backlog Reduction Stimulus Plan ("Plan"), effective June 24, 2010.<sup>1</sup> As discussed in detail below, the Plan now allows all applicants to have certain applications accorded special status for examination if the applicant expressly abandons certain other unexamined copending application without requesting a refund of fees, and meets other requirements.

Currently, the delay in issuance of a first Office Action can be up to three years or more in some art units. Under the Plan, applicants may be able to significantly reduce such delay for selected applications. Being accorded special status under the Plan not only may result in the application receiving a first Office Action more quickly, but also will accord the application special status in any appeal to the Board of Patent Appeals and Interferences (BPAI), and in the patent issuance process.

### I. Deadline

The Plan is a temporary program that is effective as of June 24, 2010, and is currently available until the earlier of December 31, 2010, or the date that 10,000 applications have been accorded special status under the Plan. The Plan is limited to a maximum of 15 expedited applications per owner through December 31, 2010. The USPTO may extend the Plan after December 31, 2010.

### II. Requirements to Participate in the Plan

In order to expedite examination of an application under the Plan, applicants must meet the following requirements:

(1) The applicant must have a pending non-provisional application, having an actual filing date earlier than October 1, 2009, for which special status is sought. PCT National Phase applications are included among the non-provisional applications eligible to be expedited under the Plan.

(2) The applicant must have another copending non-provisional application that has an actual filing date earlier than October 1, 2009, and that is complete (i.e., the application contains an executed oath or declaration and all the filing fees have been paid). PCT National Phase applications, which are not subject to a refund of previously paid fees, are eligible to be abandoned to expedite examination of another application under the Plan.

(3) The application for which special status is sought and the other copending application must be either (a) owned by the same party as of October 1, 2009 or (b) name at least one inventor in common.

<sup>1</sup> See our December 7, 2009 Special Report regarding the Patent Application Backlog Reduction Stimulus Plan for Small Entity Applicants.

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(4) The applicant must file a letter of express abandonment in the copending application before the copending application has been taken up for examination. The USPTO has confirmed to us that "before the copending application has been taken up for examination" means before either a Restriction Requirement (including a telephone Restriction Requirement) or a first Office Action on the merits has issued in the copending application. The letter of express abandonment, or a separate statement filed with the letter of express abandonment, must include a statement that the applicant: (a) has not filed and will not file a new U.S. application that claims the benefit of the expressly abandoned application, or that claims the same invention claimed in the expressly abandoned application;<sup>2</sup> and (b) will not request a refund of any fees previously paid in the expressly abandoned application.

(5) The applicant must file a petition in the application for which special status is sought. The petition must (a) identify the basis for receiving special status (i.e., express abandonment of another copending application); (b) include a copy of the above-described letter of express abandonment; (c) include a specific identification of the relationship between the applications that qualifies the application for special status (e.g., identifying, by name, a common inventor, assignee or owner); (d) identify, by application number, if available, the application that is being expressly abandoned; (e) provide a statement certifying that the applicant has not filed petitions in more than fourteen other applications requesting special status under the Plan;<sup>3</sup> and (f) provide a statement that the applicant agrees to make an election without traverse in a telephonic interview if the USPTO determines that the claims of the application to be made special are directed to two or more independent and distinct inventions. There is no government fee for this petition.

<sup>2</sup> "Claims the same invention" for this purpose means having a claim of identical scope to a claim in the abandoned application.

<sup>3</sup> The number of petitions for this purpose is based on ownership. That is, any petition filed under the Plan in an application that is assigned to, subject to an obligation to assign to, or otherwise owned by the same entity, is considered to be a petition filed by the applicant.

(6) The express abandonment of one copending application can only form the basis for a petition to expedite examination of one other application.

### III. The Effect of Being Accorded Special Status

Once the application is accorded special status, the application is placed on the Examiner's special docket. At least once every four weeks, the Examiner must act on the application on his or her special docket that has the oldest effective filing date. Therefore, how quickly an Examiner takes up the application for examination as a result of the Plan depends upon (1) when the application was filed and (2) the number of applications on the Examiner's special docket. The average number of applications on an Examiner's special docket varies, but is generally small. The general policy of the USPTO is that once an application is granted special status, the application should be taken up for examination within a few weeks of receiving special status, according to the U.S. Manual of Patent Examining Procedure (MPEP) §708.02(a)III. However, this general policy may not result, in practice, in applications under the Plan being taken up for examination as quickly as anticipated by the USPTO. In a similar program, the USPTO has estimated that examination delays can be shortened by about one year by obtaining special status.

Under the Plan, an application is only placed on the Examiner's special docket before the first Office Action, in any appeal to the BPAI, and in the patent publication process. After the first Office Action, the application is placed on the Examiner's amended docket instead of the Examiner's special docket. As such, the effect of the Plan is primarily to expedite issuance of a first Office Action. Once a response has been filed, the next Office Action should issue within about two to four months after the response is filed.

Under the Plan, the applicant must agree not to traverse a telephonic Restriction/Election of Species Requirement if the USPTO determines that the claims of the application to be made special are directed to two or more independent and distinct inventions. Moreover, if the examiner is unable to reach the applicant, or if the applicant refuses to make an election in a telephonic interview, the examiner will constructively elect the first claimed invention without traverse for examination. As

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a result of agreeing to elect without traverse, applicant will be unable to contest the propriety of any telephonic Restriction or Election of Species Requirement made by the examiner in the expedited application, regardless of the propriety or impropriety of such requirement.

The USPTO will not revive the expressly abandoned application once the letter of express abandonment is recognized by the USPTO. Thus, applicants should carefully consider this result in making a decision to participate in the Plan.

#### IV. Recommendations

To take advantage of the Plan, we recommend acting as soon as possible, as the Plan is limited both in duration and the total number of applications that will be accorded special status. When considering whether to participate in the Plan, please consider the following steps:

(a) Review the patent portfolio for obsolete applications that can be abandoned, or at least consider the Plan when a decision is made to abandon an unexamined patent application;

(b) Consider the cost/benefit of expediting examination of a surviving application as opposed to receiving a refund of the search fee and extra claims fee that otherwise may be available when a non-PCT National Phase application is expressly abandoned before it is taken up for examination;

(c) Consider the advantages of expediting examination of an application in exchange for abandoning a PCT National Phase application, given that previously paid fees are already not refundable upon abandonment of PCT National Phase applications;

(d) Consider the advantages and disadvantages of expediting examination of an application in view of the loss of the right to traverse any telephonic Restriction or Election of Species Requirement asserted by the Patent Office in the expedited application;

(e) Consider the advantages and disadvantages of expediting versus postponing examination of an application;

(f) Consider the fact that the USPTO will not revive an application once the letter of express abandonment is recognized by the USPTO; and

(g) Keep in mind that the Plan does not guarantee success in the expedited application.

Please let us know if you desire any additional information regarding the procedures under the Patent Application Backlog Reduction Stimulus Plan, or if you have any questions about other ways to expedite examination.

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*Oloff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.*

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