

# REPORT

## NEW PATENT OFFICE PROCEDURE TO ALLOW SMALL ENTITY APPLICANTS TO EXPEDITE EXAMINATION OF APPLICATIONS

December 7, 2009

The United States Patent and Trademark Office (USPTO) has recently announced a Patent Application Backlog Reduction Stimulus Plan ("Plan"), currently only available until February 28, 2010, intended to expedite examination of some applications for small entity applicants. As discussed in detail below, the Plan allows a small entity applicant to have an application accorded special status for examination if the applicant expressly abandons another copending application.

The Plan may be helpful to small entity applicants with more than one pending application. 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, small entity applicants may be able to significantly reduce such delay. 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 also in the patent issuance process.

### I. Deadline

The Plan is a pilot program that is effective as of November 27, 2009, and is only currently available until February 28, 2010. The USPTO may extend the Plan after February 28, 2010. However, because the USPTO may not extend the Plan, applicants desiring to participate are encouraged to take action no later than February 28, 2010.

### II. Requirements to Participate in the Plan

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

(1) The applicant must have a pending non-provisional application, for which special status is sought, that has an actual filing date earlier than October 1, 2009. Further, the applicant must have established small entity status in that non-provisional application at least by the time of requesting special status 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).

(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.

(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 telephone Restriction Requirements) or a first Office Action on the merits has issued in the copending application. In addition, a statement must be made, either in the letter of express abandonment or in a separate statement filed with the letter of express abandonment, that the applicant has not filed and will not file a U.S. application that claims the benefit of the expressly abandoned application. Further, the applicant must agree not to 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 identify the basis for receiving special status (i.e., express

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abandonment of another copending application) and must include a copy of the above-described letter of express abandonment from the expressly abandoned application. There is no government fee for this petition.

(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.

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, that 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 the 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.

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

At present, there are substantial delays in the issuance of first Office Actions due to the backlog at the USPTO. The procedures under the Plan may be useful in situations where a small entity applicant desires to obtain patent protection more quickly and is willing to expressly abandon another copending application. To take advantage of the

Plan, we recommend acting before February 28, 2010, as the Plan may not be available thereafter. 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;

(b) Consider the potential commercial value of the application that might be abandoned through the Plan;

(c) 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 an application is expressly abandoned before it is taken up for examination;

(d) Consider the advantages and disadvantages of expediting examination of an application;

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

(f) 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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