

REPORT

U.S. PATENT OFFICE IMPOSES STRICTER REQUIREMENTS FOR PETITIONS TO MAKE SPECIAL AND FOR ACCELERATED EXAMINATION

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I. Introduction

Under standard U.S. Patent and Trademark Office (USPTO) procedures, new patent applications are examined in the order of their United States filing date. Certain exceptions are made by way of "petitions to make special," which, when granted, result in an application being examined out of turn ahead of most other pending applications. As discussed in our June 16, 2006, Special Report, the USPTO recently expanded the options for making applications special by implementing the Patent Prosecution Highway (PPH) pilot program. The USPTO has now, unfortunately, drastically restricted the other ways to obtain expedited examination.

Prior to August 25, 2006, an application could be made special for any of the following reasons: 1) prospective manufacture; 2) actual infringement; 3) the applicant's poor health; 4) the applicant's age (65 years of age or older); 5) the invention will materially enhance the quality of the environment; 6) the invention will materially contribute to the development or conservation of energy resources; 7) the invention relates to the safety of research in the recombinant DNA field; 8) the applicant requests accelerated examination and complies with procedural requirements including searching for, identifying and distinguishing the closest prior art; 9) the invention relates to superconductivity materials; 10) the invention relates to HIV/AIDS or cancer treatments; 11) the invention materially contributes to countering terrorism; 12) the applicant is a small entity and the invention involves biotechnology; or 13) the application is in the USPTO and Japanese Patent Office (JPO) PPH pilot program.

Due to a mounting backlog of applications and increasing pendency, the USPTO has experienced an increase in the number of petitions to make applications special. Seemingly in response to this increase, the USPTO has now implemented a program that restricts access to and creates significant disincentives for filing petitions to make special. Specifically, the USPTO has revised the requirements for filing most petitions to make special, including petitions requesting accelerated examination (reason (8) above).

The prior petition to make special practice still applies to applications wherein the applicant is in poor health, the applicant is 65 years of age or older, or the application is in the USPTO-JPO PPH pilot program (reasons (3), (4), and (13) above, respectively).

As of August 25, 2006, petitions to make special based on reasons (1), (2), and (5)-(12) above are still available, but must now meet the strict requirements set forth below. Such petitions, now generally termed "petitions for accelerated examination," are only available in United States non-reissue utility and design applications filed under 35 U.S.C. §111(a) that are simultaneously filed with the petition.

Such petitions are no longer available for already-pending utility and design applications, plant applications, international applications entering the U.S. national stage under 35 U.S.C. §371, and applications in which a Request for Continued Examination (RCE) has been filed (unless a petition for accelerated examination was previously granted in the application). Reissue applications and reexamination proceedings are already considered to have "special status."

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Applicants for design patents desiring accelerated examination may file a petition for accelerated examination under the new program or file a much more applicant-friendly request under the design application expedited examination program already in place (MPEP §1504.30).

Under the pre-existing petition to make special practice, examination was completed within twelve months of the grant of the petition. The stated goal of the USPTO's new program is to complete examination within twelve months of a special status application's United States filing date, i.e., the filing date of the petition. The twelve-month period ends on the date of a final disposition, i.e., mailing date of a notice of allowance, mailing date of a "final" Office Action, RCE filing date, or date of abandonment. However, the final disposition of an application may occur later than the twelve-month timeframe in certain situations as described below. The USPTO's failure to meet the twelve-month goal, which is *not* guaranteed, is neither petitionable nor appealable.

II. Requirements

A. Pre-Examination Search

Before a petition (and associated application) can be filed, a comprehensive pre-examination search must be performed.

The search must encompass U.S. patents and patent application publications, foreign patent documents and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those identified are likely to be found in the eliminated source. Such justification must be included in the pre-examination search statement, discussed below.

The search must be directed to the claimed invention and encompass all claimed features, individually and in combination, giving the claims the broadest reasonable interpretation. The search must also encompass narrow claim interpretations as well as those of intermediate breadth.

In addition, the search must encompass disclosed features that *may* be claimed.

A search by a foreign patent office will only satisfy the pre-examination search requirement if the search complies with these pre-examination search requirements.

B. Electronic Filing

Applications in which special status is desired must be filed electronically with all the required documentation.

If the USPTO's electronic filing system (EFS) is not available to the public during the normal business hours for the system at the time of filing, the applicant may file the application, other papers, and fees by mail accompanied by a statement that the EFS was not available during normal business hours. However, the final disposition of the application may occur later than twelve months from the application filing date. If time permits, we recommend holding such an application for filing when the EFS is available, which seldom involves more than a one-day delay.

C. Petition and Fee

The filing must include a petition accompanied by the petition fee set forth in 37 C.F.R. §1.17(h) (currently \$130.00). This fee will be waived if the petition is accompanied by a statement that the claimed invention will materially enhance the quality of the environment, will materially contribute to the development or conservation of energy resources, or is directed to countering terrorism (reasons (5), (6), and (11), respectively, above).

D. Statements in the Petition

The applicant must agree in the petition to make an election, without traverse, in a telephonic interview if the Examiner determines that the claims cover multiple inventions. The election must be made without traverse even if the restriction requirement lacks merit.

The applicant must agree in the petition to have an interview when requested by the Examiner (possibly before the first Office Action). The purpose of the interview is to discuss the prior art and any potential rejection or objection with the intention of clarifying and possibly resolving all issues with respect to patentability at that time.

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The applicant must agree in the petition *not* to separately argue the patentability of any dependent claim during any appeal. In other words, the applicant must agree that, in an appeal brief, the dependent claims will be grouped together with, and not argued separately from, the independent claim(s) from which they depend. However, dependent claims may, and should, be separately argued during prosecution before the Examiner to identify the limits of any rejection.

The applicant must state, based on a good faith belief, that a pre-examination search was conducted in compliance with the above requirements.

E. Accelerated Examination Support Document

The petition must be accompanied by an Accelerated Examination Support Document ("support document"), containing the following information:

1. a statement identifying the field of search by U.S. class/subclass, the date of the search, and, for database searches, the search logic, chemical structure or sequence used as a query, the name(s) of the file(s) searched, the name(s) of the database service(s) used to conduct the search, and the date of the database search;
2. an Information Disclosure Statement (IDS) citing all references deemed to be most closely related to the subject matter of each claim;
3. an identification of all the claim limitations that are disclosed in each cited reference and an identification of where in each reference each such claim limitation is disclosed;
4. a detailed explanation of how each claim is patentable over each reference;
5. a concise statement of utility of the invention, unless the application is a design application;
6. a showing of where each claim limitation is supported in the specification under 35 U.S.C. §112, first paragraph (written description) (and in any parent application specification, when applicable), including a showing of support for any means-plus-function and step-

plus-function limitation, wherein every means- or step-plus-function claim limitation that invokes consideration under 35 U.S.C. §112, sixth paragraph, is identified, and the structures, materials or acts in the specification that correspond to each means- or step-plus-function claim limitation are identified; and

7. an identification of any cited reference that may be disqualified as prior art under 35 U.S.C. §103(c) relating to Joint Development Agreements.

F. Complete Application

The application with which the petition is filed must be a complete application that is in condition for examination *at the time of filing*, and thus includes the following, as applicable to the particular patent application:

1. all filing fees (basic filing fee, search fee, examination fee and application size fee);
2. executed oath or declaration;
3. specification and claims;
4. title and abstract;
5. drawings in compliance with 37 C.F.R. §1.84;
6. electronic submission of any sequence listing in compliance with 37 C.F.R. §1.821(c) or (e), large tables, or computer listing in compliance with 37 C.F.R. §1.96, submitted via the USPTO's electronic filing system in ASCII text as part of an associated file;
7. foreign priority claim under 35 U.S.C. §§119(a)-(d) identified in the executed oath or declaration or in an application data sheet;
8. domestic benefit claims under 35 U.S.C. §119(e), 120, 121 or 365(c) in compliance with 37 C.F.R. §1.78, identified by specific reference to the benefit application in the first sentence of the specification or in an application data sheet; and for any benefit claim to a non-English language provisional application, a statement that (1) an English language translation and (2) a statement that the translation is accurate have been filed in the provisional application; and

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9. for a non-English language specification, an English language translation thereof under 37 C.F.R. §1.52(d), a statement that the translation is accurate, and the processing fee under 37 C.F.R. §1.17(i) (currently \$130.00).

Preliminary amendments and petitions under 37 C.F.R. §1.47 for acceptance of the application with a non-signing inventor are *not* permitted.

Design applications must additionally comply with the design application requirements set forth in 37 C.F.R. §§1.151-1.154.

G. Claims

Only twenty or fewer claims are permitted, of which no more than three may be independent. This requirement continues throughout prosecution of the application.

The claims must be directed to a single invention. If the Examiner determines that multiple inventions are present, then the applicant must make a telephonic election without traverse, as discussed above.

Multiple dependent claims are not permitted.

H. Suggested Classification

The new requirements state that the applicant *should* provide a suggested classification by U.S. class/subclass for the application in the transmittal letter, petition or application data sheet.

III. Procedures

A. Decision on Petition

The USPTO should make a decision on a petition for accelerated examination within three months of the application filing date. If the petition is granted, the application should be promptly examined, e.g., within two weeks of the decision on petition.

If the petition, search statement and/or support document do not meet all the requirements for grant of special status (for example, if the search is deemed to be insufficient), the applicant will be notified of the defect(s) and the application will remain in the status of a new application awaiting examination in its regular turn.

If the petition, search statement and/or support document are defective in one or more of the above requirements, the applicant may be given *one* opportunity to correct the defect(s) within an unextendable one month (or 30 days, whichever is longer) from the mailing date of the defect notification.

If the defect(s) is satisfactorily corrected in a timely manner, the petition will be granted, but the final disposition of the application may occur later than twelve months from the application filing date.

The opportunity to correct a defect does *not* apply to applications that are not in condition for examination upon filing. Thus, the petition will be dismissed if the application does not contain a required item (items 1-9 above), or if it includes a paper that causes the USPTO's Office of Initial Patent Examination to mail a notice during the formality review, e.g., notice of incomplete application, notice to file missing parts, notice to file corrected application papers, notice of omitted items, notice of non-compliance or notice of informal application. There is no opportunity to cure such defects.

B. First Office Action

If the Examiner determines that the claims encompass multiple inventions, the Examiner will call the applicant's representative for a telephonic election. If the applicant's representative refuses to make an election without traverse, or if the Examiner cannot reach the applicant's representative after reasonable effort, the Examiner will treat the first claimed invention, i.e., the invention of claim 1, as constructively elected without traverse for examination.

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Prior to mailing a first Office Action that contains claim rejections, a telephonic interview will be conducted, unless the Examiner determines that an interview is unlikely to overcome the rejections. Any interview initiated by the Examiner should be conducted within two weeks of the Examiner's request for an interview. If the applicant is unable to conduct an interview within this two-week time period, then the application may lose its special status.

In addition, a USPTO internal conference will be conducted prior to the mailing of a first Office Action to ensure the viability of the rejection(s). There will also be a USPTO internal conference before the mailing of a final Office Action.

C. Applicant's Response

The applicant will have one month (or thirty days, whichever is longer) to reply to an Office Action, other than a final Office Action or Notice of Allowance. *No extensions of time under §1.136(a) are permitted.* Failure to timely file a reply will result in *abandonment* of the application. The time period for responding to a final Office Action is the same as the current time period (three months, extendible to six months).

Replies to non-final Office Actions must be filed electronically (but see Part II.B. above), and they must be complete, fully responsive and limited to the rejection(s), objection(s) and requirement(s) in the Office Action.

Replies must be accompanied by an updated support document for any amended or new claim that is not encompassed by the previously-filed support document. This may involve a need for the applicant to conduct further searching.

Replies that include amendments that exceed the 3/20 claim limit, present claims to a non-elected invention, or present claims not encompassed by the pre-examination search and not accompanied by an updated support document will be considered non-responsive.

If a reply to a non-final Office Action is considered to be non-responsive, but appears to the Examiner to be a bona fide attempt to advance prosecution, the Examiner may give the applicant an unextendible one month or thirty

days, whichever is longer, to file a fully responsive reply. Failure to timely file a fully responsive reply within that time period will result in *abandonment* of the application.

If a reply does not appear to the Examiner to be a bona fide attempt to advance prosecution, or if the reply is to a final Office Action, no additional time will be given. The time period set forth in the previous Office Action will continue to run. Thus, if the one-month or thirty-day time period is over, the application is *abandoned*. If not, the applicant may file a responsive reply within the remainder of the time period.

If the reply is not filed electronically, or if the reply is considered to be non-responsive, the final disposition of the application may occur later than twelve months from the application filing date.

D. Post-Allowance

In response to a Notice of Allowance, the applicant must pay the issue fee within three months of the mailing date of the Notice of Allowance to avoid abandonment of the application -- the same as with other applications. Also, as with other applications, to expedite issuance as a patent, the applicant must, within one month after the mailing date of the Notice of Allowance, pay the issue fee and any outstanding fees, and not file any post-allowance papers that are not required by the USPTO.

E. Appeals

If any claim rejection is appealed to the Board of Patent Appeals and Interferences, the applicant must "promptly" file the Notice of Appeal, Appeal Brief and appeal fees, and *not* request a pre-appeal brief conference (the USPTO will have already held an internal conference prior to mailing the final Office Action).

During the appeal process, the application will be treated in accordance with the normal appeal procedures. The USPTO will resume treatment of the application as special under the accelerated examination program after the Board decision.

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F. Request for Continued Examination

If the applicant files a Request for Continued Examination (RCE) in a "special status" application with an RCE submission and fee, the submission must meet the reply requirements above. Although the filing of the RCE is a final disposition for purposes of the twelve-month goal, the application will retain its special status and remain in the accelerated examination program with the goal that there will be a final disposition of the application within twelve months from the RCE filing date.

G. Proceedings Outside the Normal Examination Process

If an application becomes involved in proceedings outside the normal examination process, e.g., secrecy order, national security review, interference, or petition under 37 C.F.R. §§1.181-1.183, the USPTO will treat the application as special under the accelerated examination program before and after such proceedings. During these proceedings, however, examination will not be accelerated. Thus, final disposition may occur later than twelve months from the application filing date.

H. Withdrawal From Accelerated Examination

There is *no provision* for an applicant to withdraw an application from the accelerated examination program. Instead, the applicant may abandon an application that has been granted special status in favor of a Rule 53(b) continuation application. The continuation application will not be given special status under the accelerated examination program unless the continuation application is filed with its own petition and required documentation. Thus, RCEs and continuation applications are treated differently under the accelerated examination program.

IV. Recommendations

Although there are substantial delays in examination in certain technologies, we do not recommend filing a petition for accelerated examination absent very unusual circumstances. If expedited examination is desired and if the facts permit, we recommend filing the standard petition to make special based on the applicant's health, the applicant's age, or the application's qualification for the PPH pilot program or design acceleration program.

We advise against filing a petition for accelerated examination in most cases because of: (1) the numerous admissions that must be made in the petition and support document, including in the pre-examination search statement, and the estoppels that would result from those admissions; and (2) the onerous requirements involved prior to filing and during prosecution of an application under "special status" in the accelerated examination program.

For example, the applicant is required to make admissions on the record as to what claim limitations are disclosed in each reference submitted with the petition. The applicant is also required to identify on the record its patentability arguments as to each reference, before any rejection is made. Prior to filing, the applicant must conduct a burdensome pre-examination search of the subject matter initially claimed *and* potentially claimed after filing, such as in an amendment. As noted above, this search is not limited to patents and published applications, but includes non-patent literature. During prosecution, the applicant is burdened by the *unextendible* one-month time period in which to file a complete response to an Office Action, including possibly updating the pre-examination search and making further admissions as to the content of any newly cited reference.

Moreover, after filing the petition and accompanying documents, including all the admissions, the petition may be denied. If the petition is denied, the application is examined in its regular turn, but has a file history containing the applicant's interpretation of the claims and the prior art, which could be used to estop the applicant from asserting a broader or even different interpretation during infringement or validity litigation. Even if the petition is granted, the application may not issue as a patent or may issue later than twelve months from the application filing date, and the file history will still contain the same admissions and estoppels.

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Please let us know if you need additional information regarding USPTO procedures for expediting 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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