

New Option To Complete U.S. Patent Examination In One Year

Tuesday, October 31, 2006 --- The United States Patent and Trademark Office has just introduced a new procedure that promises to complete examination of a new U.S. patent application within one year after the application is filed. The Patent Examiner must also phone the applicant and seek to resolve any concerns prior to issuing a rejection.

On the other hand, qualifying for the new procedure will increase costs, require statements to be made that could have an adverse impact during litigation, and restrict the number of patent claims that may be requested and the amendments that may be made to them.

The applicant must conduct a prior art search for U.S. patents and patent application publications, foreign patent documents, and non-patent literature. The search must be directed to every claimed feature of the invention. All or portions of the search may be omitted if the applicant can demonstrate “with reasonable certainty” that no reference more pertinent than those already identified is likely to be found.

The applicant must identify which features of the invention are disclosed in each reference that is “most closely related” to the subject matter of the invention. The applicant must then explain why the application is meritorious in view of the prior art that has been uncovered.

The application must be limited to 20 claims, only three of which may be “independent” (i.e., need not be a subset of another claim). No claim may be amended to add a limitation that was not the subject of the original prior art search.

The added costs of these procedures are apparent. Still, the expedited process may save other costs, such as the costs of responding to rejections that are improvidently issued.

An error in a required representation about the scope of the search or a teaching in the prior art could give rise to an allegation of inequitable conduct during litigation. Although an honest mistake would not be sufficient, the line between a mistake and an effort to deceive often does not shimmer with clarity.

The scope that the patent is afforded in litigation may also be affected. The required identification of the elements of the invention that are and are not disclosed by the prior may affect the interpretation that a court gives to the words of the claim. It may also result in the loss of the right to establish

infringement under the “doctrine of equivalents,” a doctrine that otherwise might allow the patent to be stretched beyond its literal scope.

The limit on the number of independent claims could similarly result in a narrower scope of overall protection. The inability to narrow a claim to overcome an unexpected prior art problem by adding an element that was not searched could also result in a loss of some protection. The limit on the number of dependent claims (i.e., those that are subsets of another claim) could cause the loss of important fall-back positions during litigation.

Still, the average U.S. patent application pended for 2.5 years in 2005, and this year seems even slower. The opportunity to instead complete examination in less than one year with the Examiner being required to make efforts to resolve concerns, not merely to express them, is luring. This may be particularly true in those situations in which a quick patent is more important than The Perfect Patent. The restrictions on the number of claims and the amendments that may be made to them could also be overcome by pursuing those claims in a continuation application.

A petition may now be filed with any application to have it processed under the new procedure. An existing application may also be accelerated by refiling it as a continuation application along with a petition. The petition must report on the results of the prior art search and several other matters. The required form, as well as more information about the procedure, may be found at <http://www.uspto.gov/web/patents/accelerated/>.

--By Marc E. Brown

Mr. Brown is a partner of McDermott Will & Emery LLP and head of its patent procurement practice in its Los Angeles office. McDermott has about 1000 lawyers with other offices in Boston, Brussels, Chicago, Düsseldorf, London, Miami, Munich, New York, Orange County, Rome, San Diego, Silicon Valley and Washington, D.C.

Mr. Brown emphasizes computer hardware and software, the Internet and other electronic systems and devices. He is a member of the Computer Law Association and held an Advanced Class Amateur Radio Operator's License (WB6WRI). He has designed digital systems, analog circuitry, servo systems, and R.F. equipment and has written database and other software applications.