

**THE ACCELERATED PATENT PROCESS –
DEBUNKING THE MYTHS**
By Catherine Rajwani¹

Beginning in August of 2006, patent applicants could petition the United States Patent Office (USPTO) to grant their applications accelerated examination or “special status.” This process allows *applicants to receive a patent in one year or less* – a substantially shorter period of time than the traditional process². Prior to 2006, applicants could only accelerate their applications in certain, special circumstances.³

Accelerated examination, in essence:

- (1) *transfers* some of the work that the examiner at the USPTO would normally perform to the applicant, such as:
 - initial search of prior art,
 - analysis of relevant prior art,
 - comparison of claims to relevant prior art, and
 - identification of support for claims in the written description of the specification;

- (2) *simplifies* the content of the patent application:
 - independent claims limited to three,
 - total claims limited to twenty, and
 - application limited to a single invention⁴; and

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² In FY2009, the average age of the applications that received a first action was **25.8 months** (from the date of the filing of the application) and the average age of application disposal (issuance or abandonment) was **34.6 months** (from the date of the application). See figures from U.S. Patent Pendency Model at http://www.uspto.gov/patents/stats/patent_pend_model.jsp#heading-1.

³ The applicant was 65 or older or in ill health; the applicant was ready to manufacture (or increase manufacturing) in the U.S. and would not unless certain a patent would be granted; there was ongoing infringement; the invention had a beneficial environmental, public health, energy or anti-terrorism impact, or was related to recombinant DNA, biotechnology for companies with less than 500 employees, superconductivity, or treatment/cures for HIV and cancer. See §708.02 of the 8th Edition of the MPEP (2001).

⁴ If the examiner determines that the application is directed to more than one invention, the applicant must agree to elect without traverse a single invention for accelerated examination.

(3) *expedites* the process of patent filing and examination:

- electronically submit application, related documents, and fees,
- agree to an interview with the examiner,
- no extensions of time for responses, and
- no appeal concerning the patentability of dependent claims.⁵

For many clients, obtaining a patent in less than a year provides substantial benefits to their business such as the ability to attract and retain investors, protect key product lines and/or product features, and obtain valuable cross-licenses. While these benefits do not come without an associated cost (approximately three times that of traditional applications), for many technology, start-up, and manufacturing businesses, the pros associated with accelerated examination greatly outweigh the cons.

Given the substantial upside for businesses, it was surprising to learn that many attorneys who focus their practice on patent prosecution were counseling clients against accelerated examination.⁶ Many of the rationales offered by these attorneys included an analysis of why a patentee would be disadvantaged in a subsequent infringement lawsuit if the patent asserted was obtained through the accelerated process. While it is prudent to explain to a client the differences in the prosecution history (or file wrapper) generated in an accelerated versus traditional patent application, in my opinion the downsides of accelerated applications have been largely overstated and often times misstated. The intent of this article is to respond to the “myths” promulgated by some patent prosecutors in an effort to largely debunk them.

⁵ For more information concerning the mechanics of filing applications under the accelerated process, go to <http://www.uspto.gov/patents/process/file/accelerated/index.jsp>.

⁶ See, e.g., “Why I Will Not Be Filing Under the Accelerated Examination Program of the USPTO” from the Anything Made Under the Sun Made by Man blog at http://www.krajec.com/index.php?/weblog/why_i_will_not_be_filing_under_the_accelerated_examination_program_of_the_u.

1. The Required Prior Art Search and Analysis Is Too Expensive And, If Not Comprehensive, Could Result In Claims of Inequitable Conduct In A Subsequent Litigation

As mentioned *supra*, accelerated applications cost approximately three times as much to prosecute than traditional applications.⁷ A large portion of these additional costs are attributable to the prior art search. In an effort to contain prior art search costs, it generally is prudent to have a third-party firm conduct the prior art searches. Their fees, on average, should be less than those of patent prosecutors. In addition, many search firms use technology specialists that are already familiar with certain bodies of prior art and the firms have access to a variety of data bases for their searches. It is important to use a firm that is familiar with the USPTO's requirements for accelerated application prior art searches and to have the search firm generate the required pre-examination search document.

As for concerns about inequitable conduct, I would argue that such claims are less likely in litigation concerning patents that are obtained through an accelerated process. First, it bears mentioning, that fewer than 1 in 50 U.S. patents ever go through the litigation process. And, while my strong preference is that all patents are drafted as if they will be litigated, statistics show that the vast majority will not. Therefore, short term business benefits should trump, in most cases, any unlikely long term litigation concerns.

Second, inequitable conduct claims are very difficult for defendants to prevail upon. Defendants must show, by clear and convincing evidence, a material misrepresentation or omission by the patentee concerning the patent examination *and* the patentee's intent to deceive the USPTO. With respect to nondisclosure of prior art (material omission), inequitable conduct claims occasionally arise when the patentee had knowledge of prior art that was not disclosed to the USPTO. Having a thorough search of the prior art done as part of the patent application process, lessens rather than increases the risk that certain prior art may not be disclosed to the USPTO.

⁷ This is a *very* rough approximation based upon additional up-front costs. This estimate will vary substantially given a number of different factors. For example, accelerated application costs would increase dramatically for technologies with a large body of prior art and decrease when compared with traditional applications that have broad initial claims that generate substantial correspondence (*i.e.* rejections) from the USPTO.

Third, having an objective third party conduct the search further decreases the likelihood that a defendant could claim that the *patentee* failed to disclose prior art with an intent to deceive. Moreover, the scope of the search (*i.e.* comprehensiveness) is dictated by USPTO guidelines which the firm follows. A third party search firm, in most instances, would be more skilled at searching for prior art and would not be viewed as an advocate for or representative of the patentee in subsequent litigation. Of course, the patentee should disclose any prior art of which it is aware, but that obligation is the same in both the traditional and accelerated examination process.

2. A Subsequent More Thorough Search of Prior Art (During Patent License, Sale or Litigation) Could Easily Invalidate the Patent Obtained Through an Accelerated Examination

A patent obtained through an accelerated process would be less likely, not more, to be subsequently invalidated (or claimed to be invalid). A patent which is granted through the accelerated process is subject to two separate searches of prior art – one by the applicant (or applicant’s search firm) and one by the examiner. The USPTO does not forgo its normal search but rather performs it as a double check of the applicant’s. And, it stands to reason, that the applicant’s prior art search would be more thorough than a search performed by the USPTO. A typical search firm will devote days to searching prior art while an examiner may only have a few hours and more limited access to search tools.

Patents obtained through an accelerated process are not subject to a different standard concerning validity. An issued patent is presumed to be valid. It is extremely difficult to argue that a patent is invalid in view of references that were before the USPTO during examination. Courts and juries give great deference to examiners at the USPTO because the examiners, not the lay judges and jurors, are considered to be the experts at determining the novelty and nonobviousness of an invention. Thus, a larger body of prior art considered during examination equates to a smaller chance of subsequent patent invalidation.

3. The Patent Will Not Be Granted Because the Invention Will Not Be Considered Novel or Nonobvious Over The Prior Art Found

If prior art exists which presents a substantial obstacle to an invention's ability to be patented, it is better to learn of such art earlier rather than later in the patenting process. It can be catastrophic to a client's business, after investing significant time in obtaining a patent, building a business model around its patented technology, and incurring substantial costs in enforcing the patent in litigation, to learn that its patent is worthless. A thorough assessment of prior art before applying for a patent and investing in a product or technology is a worthwhile business endeavor. Early in the patenting process, a client has varied options should prior art be uncovered which is very similar to its "invention." For example, a client can invest in additional research and development efforts to further build upon the body of existing prior art (*i.e.* differentiate its technology or design-around existing art) or it can choose to pursue more focused claims in the prosecution process which would not encompass existing art. Such options are delayed or lost if relevant prior art is not discovered until after the patent issues.

4. The Accelerated Examination Support Document Creates an Unfavorable Prosecution History (i.e. "Admissions Against Interest") Which Will Be Detrimental To Later Enforcement of the Resulting Patent in Court

Of the "myths" listed, this one could arguably present some issues in litigation. But, when compared with the traditional application process, the accelerated examination (AE) support document would not necessarily be any more detrimental than a patentee's response to an office action. Yes, the support document causes an applicant to make affirmative statements comparing the patent claims to the prior art. And, in an ideal litigation world, the patentee does not make any statements about its claims or the prior art which could later affect the patentee's ability to argue for the most beneficial claim constructions in litigation. However, patent litigation rarely occurs with patents that are first action allowances. Instead, positions taken by an applicant during prosecution need to be considered when advocating claim construction. A patentee can be estopped from advocating that claims encompass subject matter clearly given up during prosecution.

The “admissions” made in an AE support document, comparing the elements of the proposed claims to the prior art, should, in large part, be noncontroversial. The important aspects of the support document are the elements in the claims that are missing from the prior art – that which makes the invention novel or nonobvious. In the AE support document, the applicant is not making any affirmative “admissions” about the missing elements other than to say they are not present in the prior art. To the extent that the examiner disagrees, the statements or admissions made to advocate novelty or nonobviousness are the same in both traditional and accelerated applications.

There is also a substantial benefit to providing the examiner with the AE support document as part of the initial application submission. The patentee is able to present the prior art in a manner that is most beneficial to the positions that it is advocating (*i.e.* patentability of invention). The examiner’s first analysis of the relevant prior art will likely be in conjunction with his or her evaluation of the patentee’s AE support submission. Thus, the patentee is able to influence the examiner’s first impressions of the art.

5. By Forgoing a Thorough and Comprehensive Search and Evaluation by the USPTO, Your Resulting Patent is Inferior

This concern of prosecutors is largely addressed in connection with responses to myths #1 and 2 *supra*. In accelerated examination, the examiner still conducts a search and evaluation of prior art. Much of the initial identification and analysis is already done by the applicant, so it saves the examiner time and effort. The examiner instead can focus on the claim elements which the applicant claims are missing (rather than the elements admitted to be present) when determining whether the claims should be allowed.

The resulting patent is presumed valid. Patents granted through an accelerated process are not subject to a different validity standard. There is no two tier system with super patents and inferior patents. The only difference, I would argue, is that a patent obtained through an accelerated process would likely have more prior art considered by the examiner and therefore would be more difficult to invalidate in subsequent litigation. *See* response to myth #2 *supra*.

Valid Downsides: Cost and Flexibility

Having responded to many of the rationales proffered against accelerated examination, I do think that there are some valid downsides to consider. The first, of course, is cost. Many large technology companies file hundreds of patent applications each year without knowledge, at the time of filing, as to which may possess the most, or indeed any, value to their business model. Instead, they take a broad brush approach to protecting any and all innovations. The patent budgets for these companies would not be able to absorb the additional costs associated with large scale accelerated filings. Even for these clients, however, it is important to consider accelerated filings on key technologies that can be identified early in the R&D process.

Another potential downside is that competitors may bring to market competing technologies during the pendency of a traditional application that arguably could fall within the scope of properly drafted claims. Having an application pending through the traditional process for years, could provide a competitive advantage in that continuing applications with newly drafted claims could be filed for many years while the marketplace of competitive products evolves. For some clients in fiercely competitive marketplaces, this may be a major concern. However, clients in competitive markets often need their patents as soon as possible. In order to “have their cake and eat it too,” I often suggest filing an accelerated application focused on the heart of the technology/invention and filing a second patent application, through the traditional (long) process, that is directed to a separate, but related, invention. In these instances, a client can file a terminal disclaimer if faced with a double patenting rejection. While this is an expensive option, it affords clients the greatest level of marketplace protection.

In conclusion, obtaining a patent through the USPTO’s accelerated filing process can present substantial benefits to clients. Such filings should be carefully considered when determining how best to grow and protect a client’s intellectual property portfolio.

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