

STROOCK CLIENT MEMORANDUM

USPTO'S ACCELERATED EXAMINATION PROGRAM: SPEED AT A PRICE

MARCH 26, 2007

Background

Applicants for U.S. patents are not always aware that the U.S. Patent and Trademark Office (“USPTO”) generally takes two to four years – often even longer – before granting a patent. Although the USPTO has long had a rarely used program enabling an applicant to request examination of a case out of turn, that program changed markedly in August 2006, when the USPTO implemented a procedure called “Accelerated Examination.”

On March 13, 2007, the USPTO granted the first patent processed under the Accelerated Examination program – U.S. Patent No. 7,188,939, entitled “Ink Cartridge,” to Brother Kogyo Kabushiki Kaisha. This was less than six months after Brother’s September 29, 2006 application filing – considerably faster than the 25 months from filing to issuance typically required in the field of ink cartridge technology.

Although Brother’s experience might tempt many patent applicants to request Accelerated Examination, applicants should be aware that doing so comes at a price. The USPTO has imposed numerous substantive and procedural requirements for Accelerated Examination, some of which can be burdensome, expensive, and may have strategic con-

sequences. This **Stroock Client Memorandum** describes the most significant of those procedural requirements and some of the issues and risks an applicant should consider when deciding whether to seek Accelerated Examination.

Procedural Requirements for Accelerated Examination

To qualify for Accelerated Examination, an applicant must file a new patent application that is complete and ready for immediate examination (Accelerated Examination cannot be requested after an application has been filed). The patent application must be filed electronically together with the Petition and all other papers required when seeking Accelerated Examination.¹

Applicants must satisfy numerous requirements for Accelerated Examination, some of which are omitted as not relevant to this discussion.² The rationale for these requirements is clear – the applicant is assuming much of the investigative burden that otherwise would fall on the USPTO, thus enabling the USPTO to act more quickly once it receives the application. The potential downside for an applicant is that the cost of satisfying these requirements can be considerable and, after patent issuance, an adversary might rely on the

statements made in some of the required documents to challenge the validity or enforceability of the patent. The following requirements merit particular attention:

1. **Limitations on Claims.** The application must contain no more than three independent and twenty total claims, and cannot contain multiple dependent claims. An applicant whose invention is complex might have difficulty in obtaining adequate protection with this number of claims in a single application.
2. **Preexamination Search; Initial Listing of Prior Art.** The applicant must conduct a preexamination search for the technical field in which the applicant believes the invention belongs, must list all relevant prior art in an Information Disclosure Statement, and must identify the field of search according to the USPTO's scheme for classifying areas of technology. The USPTO's guidelines specify five components to such a search. Although a foreign search report from a counterpart application can be used, a foreign search report is not necessarily as inclusive as a United States search report, and might not address all five required search components. If not, the applicant would need to conduct an additional search to satisfy the USPTO's requirements.
3. **Accelerated Examination Support Document.** The applicant must provide an accelerated examination support document identifying, for each cited reference, all claim limitations disclosed by the prior art. The support document also must include an explanation, with the particularity required by 37 C.F.R. § 1.111(b), of how each of the claims are patentable over the cited prior art documents. The support document also must include a showing of where each claim limitation finds support in the written description of the specification, and any means- (or step-) plus-function features must be discussed in detail. Accelerated Examination therefore requires the applicant to characterize both the invention and the prior art. Such statements become a part of the application record and an adversary might later try to rely on those statements to challenge the patent.
4. **Establish Support for Benefit of Earlier Applications.** If the application claims the benefit of any earlier U.S. or foreign applications, applicant must explain where each claim limitation is supported in those applications.
5. **Limited Time to Respond to Rejection.** If the Examiner does not allow the case immediately and rejects the application in an Office Action, applicant has just one month to respond. Extensions of time are not available.
6. **Continuing Obligation to List Prior Art.** As in all patent applications, the applicant has a continuing obligation to bring to the USPTO's attention any material prior art they discover during prosecution. The failure to disclose such prior art may jeopardize any patent that is obtained. If, during Accelerated Examination, the applicant learns of material prior art, the applicant must identify that prior art to the Examiner (as is required for all applications) and must submit a new accelerated examination support document discussing that prior art.

Expedited Processing under “Special” Circumstances

The new Expedited Processing practice also alters the prior USPTO procedures under which requests for expedited examination were granted routinely where the applicant alleged that (a) the invention would be manufactured only if a patent were granted (“manufacture”), (b) a competitor was infringing, or (c) the invention involved any of the fields of environmental quality, energy, recombinant DNA, superconductivity, HIV/AIDS and cancer, counterterrorism or biotechnology (this last category was available only for “small entities,” that is, applicants that met size-related criteria). Now, such requests are subject to the more stringent requirements of Accelerated Examination.³

Conclusion

A patent applicant considering using the Accelerated Examination program should carefully decide whether their desire for prompt issuance of a patent warrants (1) the substantial effort required to prepare the necessary documents and (2) having in the application record applicant’s characterization of the invention and the prior art. Although faster issuance of a patent may justify these burdens for at least some applicants, applicants should weigh the costs and benefits carefully.

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1. Changes to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination, 71 Fed. Reg. 36,323 (June 26, 2006).
2. Additional requirements for Accelerated Examination, as well as related information are discussed at the USPTO website at <http://www.uspto.gov/web/patents/accelerated/>.
3. Manual of Patent Examining Procedure § 708.02 (8th Ed., Rev. 5, Aug. 2006)

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