Advisory
PATENT PRACTICE GROUP | AUGUST 2006

WIGGIN AND DANA
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Expedited United States Patent Application Processing

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Wiggin and Dana patent attorneys and our clients have endured long delays between the filing of an application for a United States Patent and grant of that patent. Indeed, it is not uncommon for several years to lapse before an application receives an initial examination. Beyond frustration with the delay, the enforceable period of a granted patent, typically 20 years from the date of filing, is impacted by examination delays. On June 26, 2006, the United States Patent and Trademark Office (USPTO) published a Notice in the Federal Register of an alternative procedure for patent examination that will result in a patentability determination, either allowance or final rejection, within 12 months from the date the application is filed. This expedited examination procedure will be available for most, but not all, patent applications filed with the USPTO on or after **August 25, 2006**.

In return for expedited examination, the applicant for a US patent must make representations to the USPTO and surrender certain rights. Expedited examination will be beneficial in certain instances, at other times; standard examination will remain the procedure of choice. A summary of the expedited examination procedure and some of the benefits and disadvantages follows. Please contact a Wiggin and Dana patent attorney if you have an interest in the expedited examination procedure and would like further information.

1. Expedited Examination Procedure

- The application is filed electronically with the USPTO.
- A petition to expedite, all fees and a Declaration signed by all inventors must accompany the application filing.
- A prior art search encompassing US patent publications, foreign patent publications and non-patent documents must accompany the application filing. The scope of the search and the relevancy of the identified documents to the claims of the patent application must be provided to the USPTO.
- The application is limited to 20 claims, three of which may be independent.

2. Benefits of Expedited Examination Procedure

- If the invention is deemed patentable, a patent is granted more quickly.
- The term of most US patents is 20 years from the filing date. A more rapid grant results in a longer enforceable term. If the patent is licensed, the longer enforceable term may result in an enhanced revenue stream.
- Most rights to enforce a patent inure with granting of the patent. A more rapid grant enables earlier enforcement. Earlier enforcement may remove competitors more quickly and, if a competitor has not yet made a significant investment in the manufacture of a product, result in the competitor respecting the patent with less fight, potentially reducing your enforcement expenses. *continued next page*

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3. Disadvantages with Expedited Examination Procedure

- The prior art search and analysis are more detailed than typically performed. This will likely increase application filing expenses.
- The relevancy of the prior art references must be identified to the USPTO. This may limit our ability to distinguish a prior art reference later in application prosecution. Further, a challenger to the validity of a patent will likely assert that the relevancy, or lack thereof, was mischaracterized to the patent office. Under some circumstances, if a Court agrees the relevancy was mischaracterized, the validity of the patent may be in jeopardy.
- When a patent application is subject to final rejection, there is an appeal process available. While we may assert the patentability of each claim when appealing a final rejection of an application that underwent standard examination, only the patentability of the independent claims may be argued on appeal if the alternate expedited examination was employed. Thus, the appeal becomes more of an all or nothing approach, without the fall-back positions of dependent claims having increasingly narrow scope. ■

This Advisory presents a general overview to inform clients and other about a new process proposed by the USPTO. Nothing in this advisory constitutes legal advice, which can only be obtained as a result of personal consultation with an attorney. To discuss specific situations please contact Greg Rosenblatt or one of the other Patent Group attorneys listed.