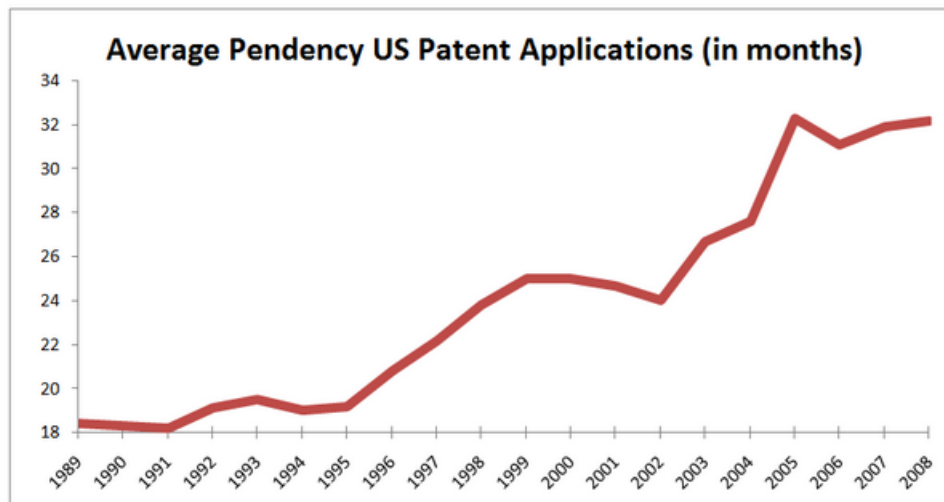


## Fast-Track Patents

By John M. Collins and Brandon Warner

One of the most perplexing problems faced by patent applicants today is the lengthy pendency of patent applications, or the time between the date of filing and the actual issuance of a patent. This issue has very real economic significance. The life of a U.S. patent is 20 years, measured from the first date of filing, regardless of when the patent actually issues. While undue delays in the Patent Office are supposedly offset by additional term, this occurs at the end of the patent term when the invention may be obsolete or no longer commercial. The statistics on Patent Office delays are daunting.

The following graph illustrates the average pendency of applications between the years 1989-2008.



Beginning in about 2002-2003, there was a sharp rise in pendencies, followed by an exponential rise thereafter. In 2008, the average pendency was more than 32 months. But it gets even worse. These are **average** pendencies. The actual pendencies can vary greatly based upon the subject matter of the invention. For example, many chemical or electrical inventions have average pendencies of 50-60 months. Moreover, for technical reasons relating to Patent Office procedures, the actual, "real-world" time for a patent to issue may be greater still.

However, under relatively recent procedures adopted by the Patent Office, it is sometimes possible to entirely avoid these interminable delays and obtain issued patents well within 1 year of filing. This program is referred to as Accelerated Examination, and our experience with the program confirms that the pendency times are indeed very short. In one recent instance, an application was filed in early November, and the patent issued the following April. Patent Office statistics for 2008 reveal that the average Accelerated Examination pendency was around 6 months, and that **every** such application was disposed of within 12 or less months from the filing date.

In order to seek Accelerated Examination, a comprehensive prior art search must be performed by the applicant, and the results of the search carefully analyzed vis-à-vis the invention being claimed. Further, the total number of claims in the application is limited, and the applicant must agree to very promptly deal with any issues raised by the Patent Office and otherwise take steps to move the application along promptly. Because of these requirements, it can be relatively expensive to secure Accelerated Examination of a patent application. Nonetheless, where an invention is important, or immediate patent protection is needed because of competitive pressures, the Accelerated Examination program may be worthwhile.

Another feature of the program is the manner in which the examination is conducted. Instead of the usual *pro forma* written rejections often encountered in ordinary prosecution, under the program, the examiner is instructed to telephone the applicant's attorney to arrange an interview if there are any outstanding issues within 2 weeks after receiving the application for examination. In fact, no written action is permitted unless it is an allowance or the interview was unavailing. Hence, in our experience, the pervasive "always reject first" attitude of the examiners is reversed in Accelerated Examination cases, so that the examiners affirmatively seek ways to put the applications in condition for patent grant. As such, many downstream costs commonly encountered with patent applications are entirely avoided.

The following are the salient advantages and disadvantages of Accelerated Examination.

**Advantages:**

- The patent issues early, with much longer effective patent term, and the ability to pursue infringers or licensing opportunities at the earliest possible date.
- Applicants avoid multiple rounds of rejection/amendment prosecution, with corresponding cost savings.
- Because of the prior art search requirement, the resultant application can be more focused on the areas of patentable novelty.
- If merited, a regular application can also be filed with, or subsequent to, an accelerated application, so that additional features may be claimed as commercialization proceeds.
- If a regular application is pending, a new case seeking accelerated examination can be filed without affecting the original filing; this allows an applicant to obtain early allowance of claims covering commercial embodiments, while allowing the applicant to seek broader protection in the regular application.

**Disadvantages:**

- Accelerated Examination has a higher upfront cost, as a professional searcher must be retained, and the search results subjected to a detailed analysis setting forth the features of each reference and the basis for patentability over the reference.

A number of our clients are now actively involved in accelerated examinations, particularly for highly meritorious inventions, which may have a relatively limited commercial life span. If you would like to learn more about this unique process, please contact us.

*John M. Collins is an of counsel attorney and Brandon Warner is an associate at Hovey Williams. You can contact Brandon at [bwerner@hoveywilliams.com](mailto:bwerner@hoveywilliams.com).*