

The page features three large, stylized red circles of varying sizes, each with a white center and a light red shadow effect. Two thin red lines intersect at the top center, forming a large 'V' shape that frames the circles. The circles are positioned in the upper right and lower right areas of the page.

Fast Tracking Examination

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Fast Tracking Examination

The process of patenting an invention may be a cumbersome process with respect to the procedures involved from the filing of a patent application to the grant/abandonment of the patent application. Once the patent application is filed, it moves through several stages before getting a grant. Thus, applicants/inventors wait for several years to see either a grant or abandonment of their patent application.

Further, the waiting period may also entail several rounds of information exchange, which may have undesired repercussions, between an applicant and the respective patent offices. Considering the constantly diminishing product life cycles, especially in fields like electronics and software, it is imperative that one is aware of the tools one can use to expedite examination to see an early grant. Also, with numerous patent applications being filed every day, there is a constant increase in the backlog of unexamined patent applications at different patent offices.

Various jurisdictions realizing the pressing need for shortening the gap between filing and grant of patent applications, have established patent prosecution highways (PPHs) between themselves. These PPHs allow examiners of one patent office to reuse the search and examination results of another patent office(s). Accordingly, applicants can expedite examination/grant of pending applications in a jurisdiction by utilizing search or examination reports/grant notices received in participant jurisdictions.

Currently, PPHs exist between various patent offices including between the United States Patent Trademark Office (USPTO) and the European Patent Office (EPO). Certain jurisdictions like India however, are not a part of the PPH program. However, the patent offices of those jurisdictions have some parallelism to PPHs. For instance, under the Indian Patent Act, an applicant is required to furnish filing/prosecution details of related foreign application(s), which can be used by the Indian Patent Office while examining the corresponding Indian application(s).

While PPHs are an alternative, their applicability is limited. There are a lot of other tools one may use for expediting examination of patent applications. This article attempts to highlight some of these alternatives for fast tracking examination in the United States (US) and European jurisdictions.



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Fast Tracking Examination at the USPTO

As far as the US jurisdiction is concerned, applicants can fast track examination of their patent applications via programs such as Accelerated Examination and Prioritized Examination.

Accelerated Examination: -

Accelerated Examination enables applicants to acquire a patent grant within a 12 month time frame. The applicants desirous of using this route have to submit an Examination Support Document (ESD) while filing their patent application in order to qualify for the accelerated examination. The ESD should contain information such as an Information Disclosure Statement (IDS) citing prior art references closely related to the subject matter of the claims, a detailed explanation as to how the claims are allowable over the cited prior art references, an interpretation of all possible limitation of the claims in the cited prior art references and information describing the utility of each of the independent claims. Owing to a bucket load of information to be disclosed in the ESD by applicants, applicants must exercise caution while submitting the ESD as there is higher risk of missing out on information in the ESD. This might later serve to invalidate the patent based on inequitable conduct. Thus, the flipside to obtaining a faster grant via the Accelerated Examination is the risk of the ESD being used in future litigation.

To initiate an Accelerated Examination, applicants need to pay a petition fee of around \$140 with the filing fees. For small entities, this fee is reduced to around \$70 and is around \$35 for micro entities.

Accelerated Examination has been deemed advantageous in terms of its cost benefits and the standing of a patent application during prosecution. It is likely that a patent application gets an allowance on the first office action, without further ado, thereby expediting the grant process of the application. Even if the applicant is provided with a subsequent office action(s), the time spent in prosecution is lesser due to the shortened office action response period set by the USPTO.

Petition to Make Special: -

An applicant can file a Petition to Make Special request for accelerated examination of a patent application if certain special conditions are met such as:



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- If the invention disclosed in the patent application is associated with recombinant DNA research, or
- If the invention is concerned with the diagnosis and treatment of HIV/AIDS or cancer, or
- If the invention is related to biotechnology applications, or
- If the patent application is immediately required for the manufacture of the invention or for infringement analysis.

In order to utilize the Petition to Make Special, the applicant is required to pay a fee unless:

- An inventor of the patent application is 65 years of age or more, or
- An inventor of the patent application has certain health related issues, or
- The invention disclosed in the patent application contributes to the quality of the environment or for the conservation of energy resources, or
- The invention disclosed in the patent application is related to superconductivity and terrorism.

Otherwise, the applicant is required to pay a fee of \$130.

Certain provisions of the Petition to Make Special program are driven in accordance with the Green Technology Pilot Program. This program enables an applicant to file the Petition to Make Special, without incurring additional fees, for a patent application related to a 'clean' technology. Thus patent applications directed towards a 'green' technology ^[6], which would be required for protecting the environment and preventing pollution, can be moved faster during the prosecution phase under the Petition to Make Special program.

Track One: -

Another form of accelerated examination is Prioritized Examination (PE), also referred to as the Track One. Track One expedites the examination process of newly filed utility and plant patent applications in a very fast and efficient manner. Track One enables patent applicants to obtain a final disposition for their patent applications within a 12 month period. This period includes the period for mailing of a Final Rejection as well as the period for mailing the Notice of Abandonment/Allowance as applicable.

In order to avail the Track One option, applicants must submit a request for the prioritized examination at the time of filing of their patent applications. If an



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applicant desires to use Track One for an already filed patent application, the applicant can do so while submitting a Request for Continued Examination (RCE). Further, a petition fee of around \$4800 is incurred together with the filing fees for utilizing Track One. For small entities, this fee is reduced to around \$2400 and is around \$1000 for micro entities.

An advantage of the Track One program is that it does not require a pre-search examination report for initiating the examination process as opposed to the Accelerated Examination process that requires submission of the ESD at the time of filing. The number of applications that can use the Track One for expediting examination are however limited to only 10,000 in a year. These applications that can use the Track One program are determined on a first come first serve basis.

Fast Tracking Examination at the EPO

A special patent review program called PACE or Program for Accelerated Prosecution of European Patent Applications can be used for expediting examination of a patent application filed at the EPO. PACE enables applicants to rapidly obtain an Extended Search Report (ESR) and search opinions under the European Patent Convention (EPC), a First Examination Report (FER) and/or any kind of communication under Rule 71 ^[7] of the EPC. The accelerated prosecution involves two stages namely the 'Accelerated Search' and the 'Accelerated Examination' stage. Both the stages can be initiated via a written request.

Accelerated search stage: -

An accelerated search can be initiated only when a patent applicant submits all the application documents necessary for the ESR to be generated. This requires the applicant to provide the EPO with the claims, description, and translations where applicable, and the drawings/figures. This stage involves two different ways of filing the patent applications namely the first filing and the second filing. The first filing includes filing of a base patent application(s), claiming no priority from a previous patent application(s). For such a filing, the EPO ensures that the applicant obtains the search report and European Search Opinion (ESOP) within six months of the filing date without requiring a separate written request. The second filing includes filing of patent applications claiming priority from previous patent publications. In this case, the EPO makes efforts to issue the search report and the ESOP as soon

as possible. However, a written request must be filed for the obtaining the search report and the ESOP.

In either of the cases, the applicant must avoid submitting a plurality of independent claims related to the same category with overlapping scopes. If however, such a situation exists, the applicant may be asked to limit the scope of the search by electing a set of claims for search by the EPO. This additional exchange between the EPO and the applicant delays the procedure by about two months.

Accelerated examination stage: -

The accelerated examination of a patent application can be requested in writing at the EPO based on two cases. In the first case, the applicant can request for the accelerated examination before receiving the search report. Thus the applicant can waive off the wait period required for filing the petition for the accelerated examination. In the second case, if a Euro-PCT application enters the European Phase before the EPO as designated Office, the applicant can reply to the extended International Search Report (ISR) without waiting for a first communication. No official fees is required for accelerating the examination process via PACE.

Fast Tracking Examination in other Jurisdictions

Patent offices in various other jurisdictions such as Japan and Taiwan, have also implemented processes for fast tracking examination. The Japanese Patent Office (JPO) expedites the prosecution of the applications if the applications have already been filed in a foreign country or if the applicant or licensee of the application is practicing or selling the invention in Japan. In order to expedite the examination of applications filed at the JPO, the applicant needs to submit a copy of the examination reports issued by foreign patent offices along with a petition for expediting the examination. If there were no examination reports issued by the foreign patent offices, the applicant has to perform a prior art search pertaining to the invention disclosed in the application and submit the results of the search at the time of filing the petition. Thereafter, the applicant receives the first office action within approximately three months from the date of filing the petition.

Accelerated Examination at the Taiwan Patent Office (TPO) follows similar procedures as in other jurisdictions. Applications filed at the TPO become eligible for



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the accelerated examination if the corresponding foreign applications have been issued by the USPTO, JPO or EPO and the related search and examination results are submitted at the time of filing at the TPO. The TPO has also implemented an expedited examination process for green technology patent applications. A patent application will qualify for the accelerated examination program of the TPO provided the invention disclosed in the patent application relates to energy savings, carbon reduction etc.

India, however, does not have a full-fledged fast tracking examination process in place. Nevertheless, the Indian Patent Office (IPO) has a provision for receiving an express request for expediting examination of Indian national phase applications filed under Patent Co-operation Treaty (PCT). Further, under section 8 of the Indian Patent Act, an applicant is obligated to update the IPO with search and examination reports of related applications filed in other jurisdictions. Such search/examination reports are likely to facilitate the IPO to expedite examination of the corresponding Indian patent applications.

Battling the Huge Examination Backlogs

The backlog of unexamined patent applications has always been curbing the ability of patent offices to process patent applications in a fast and efficient manner. In some domains such as Biotechnology and Pharmacology, double patenting issues have further contributed to the backlog.

The pending patent backlog has tremendous competitive and legal implications. In terms of competitive implications, Standard Setting Organizations (SSOs) and cross-licensing firms remain in waiting for pending patent applications which are likely to influence the implementation of a standard or a licensing agreement(s). In terms of legal implications, litigation cases pertaining to invalidation or infringement are delayed due to the heavy backlog.

These delays have also had spiraling effects on patent owners in terms of manufacturing costs as well as in their attempts to prevent third parties from practicing their invention.

Accelerated examination processes have been playing a vital role in helping applicants reduce the delays at various patent offices. Fast tracking examination



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enables a maximal utilization of the twenty year patent term, thereby enhancing the patent's value in the long run.

While some programs have been implemented for fast tracking examination, there is still a need to have more reforms for reducing the huge examination backlogs.



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