

## Using Available USPTO Tools to Advance IP Strategy While Staying Within Budget



**The USPTO offers a number of tools to help your company prosecute patent applications and obtain issued patents expeditiously. These tools and their associated requirements are summarized here.**

**By Joseph Agostino, Lennie A. Bersh and Philip J. Hoffman | [March 17, 2022](#) | [New Jersey Law Journal](#)**

You are counsel for a company that desires to apply for a patent at the U.S. Patent and Trademark Office (USPTO) covering its newest invention. You may have heard that the USPTO usually takes more than a year and a half to issue even the first official communication on a merits, such as an Office Action, due to a backlog of over several hundred thousand unexamined patent applications. So, what can be done when your company cannot wait that long due to, for example, an imminent product launch or a short useful life of the invention (e.g., 1-3 years)?

Do not fear, as the USPTO offers a number of tools to help your company prosecute patent applications and obtain issued patents expeditiously. These tools and their associated requirements are summarized below.

### **Track One Prioritized Patent Examination**

One of the most effective ways to have the USPTO quickly examine an application is to file a Track One request for prioritized examination. After the USPTO grants the request, as the name suggests, the USPTO gives the patent application priority over almost all of the other already pending patent applications. The

USPTO strives to reach a final decision in about 12 months, although the USPTO does not promise allowance of the application or a final rejection of all claims within one year. During prioritized examination, an applicant has an opportunity to participate in at least two rounds of communications with the USPTO examiner.

The request for prioritized examination may be filed at certain points during an application's pendency. The Track One request form sets the requirements for prioritized examination. For example, an applicant must pay, at the time the request is filed, the application's filing, search, and examination fees. The application cannot include more than four independent claims and 30 claims total. An applicant cannot request any extension of time during the prosecution of the application. But the fee is not insignificant—for instance, a large company having over 500 employees is required to pay an additional fee of \$4,200 for prioritized examination. However, the USPTO reports the average total pendency for Track One applications—from filing to final disposition—is less than 11 months, and the allowance rate is over 50%.

### **Patent Prosecution Highway (PPH)**

Another effective tool is the Patent Prosecution Highway (PPH) program. The PPH program allows an applicant to expedite examination via a cooperative program between the USPTO and more than two dozen foreign patent offices. When any of the other participating foreign patent offices allows at least one claim in a foreign application corresponding to a U.S. application, the PPH program allows the applicant in the U.S. to “fast track” the examination of the U.S. application. This may also result in early allowance, as the U.S. examiner would have the benefit of the foreign examination.

The principal requirement for participating in the PPH program is that a U.S. applicant must have an allowed claim in a corresponding foreign patent application. The U.S. applicant is required to file a form identifying the corresponding foreign application, and explaining how the claims in the U.S. application correspond to the allowed claims in the foreign application. Use of the PPH program is also cost friendly, as an applicant is not required to pay any USPTO fees to participate in the PPH program.

### **Interview With the Examiner**

An additional and effective tool to advance the prosecution of a patent application is to discuss the application with the examiner. This discussion between the applicant and the examiner is referred to as an “examiner interview.” The examiner interview acts as your “sales pitch” to convince the examiner the invention is entitled to a patent. An examiner interview is generally 30-60 minutes, and an applicant may conduct the interview by telephone, videoconference, or in person depending on COVID rules and other protocols. During the interview, the applicant may provide the background of the invention, demonstrate how the invention is made and works, and discuss the Office Action, the applied prior art references, and potential claim amendments. Inventors and other applicant representatives may attend, such as to answer technical questions about the invention. There is no USPTO fee required for an interview, although there are legal costs associated with preparing for and conducting the interview.

### **After Final Consideration Program (AFCP 2.0)**

During the typical course of patent prosecution, the examiner issues a first Office Action indicating why the claims are not yet in condition for allowance, after which the applicant files a response. If the examiner does not agree that the applicant's response puts the case in condition for allowance, a “final” Office Action is issued. At that point, a Request for Continued Examination (RCE) plus fee is often required before the examiner considers the case further. The After Final Consideration Program (AFCP 2.0) gives the examiner

additional time to study the response filed after the final Office Action. In many cases, an applicant can avoid the costs and delays associated with filing the RCE.

An applicant is not required to pay any USPTO fee to participate in the AFCP 2.0 program. To participate in the AFCP 2.0 program, an applicant is required to narrow at least one independent claim, and is prohibited from broadening the amended claim in any respect. The applicant also agrees to interview the case, as discussed above, if requested by the examiner.

### **Appeal and Pre-Appeal Brief Request for Review**

Another effective tool is a Pre-Appeal Brief Request for Review. By way of background, in the USPTO, usually a single examiner is responsible for examining a patent application, from beginning to end, no matter the length of time the patent application remains pending. Further, other than by appealing the examiner's decision to the Patent Trial and Appeal Board (PTAB or Board), there is no way an applicant can require someone else at the USPTO to review the examiner's decision. The first step in an appeal is the filing of an Appeal Brief, after which the examiner is required to meet with a panel, and the panel determines whether the examiner either prepares an answer to the Appeal Brief, thus continuing the appeal, or reopens prosecution by issuing another Office Action and withdrawing the application from appeal.

In many cases, the panel requires that the examiner reopen prosecution. However, by this time, the applicant has already incurred the time to prepare and file the Appeal Brief.

Conversely, a Pre-Appeal Brief Request for Review allows an applicant to submit a limited set of arguments to the examiner and the panel, rather than the entire appeal brief, and then receive the panel's decision as to whether appeal should continue, or whether the examiner should reopen prosecution. The requirements for the Pre-Appeal Brief Request for Review are fairly simple: payment of the Notice of Appeal fee and the filing of up to a five-page brief directed to why the invention is patentable. However, the USPTO does not refund the Notice of Appeal fee, even if the examiner reopens prosecution, but the USPTO will credit the fee in the event that an applicant appeals the examiner's decision at any time during prosecution of the patent application.

### **Fast-Track Appeals Pilot Program to Appeal to the PTAB**

As discussed above, an applicant may appeal the examiner's decision to the Board. At the Board, a three-judge panel reviews the examiner's rejections, and issues a decision affirming or reversing the rejections. Typically, the PTAB takes more than a year to issue a final decision. Under the Fast-Track Appeals Pilot Program, an applicant can have its appeal placed in the front of the line. To participate in this program, an applicant need only file a form and pay an additional fee of \$420. Although the Board has set a target of issuing a decision within six months from the date it grants the request to participate in the program, the PTAB is currently issuing decisions in less than three months on average.

### **Petition to Make an Application Special**

A petition to make an application special is a low-cost way to advance prosecution, by having the USPTO examine the special application before most other applications. No additional USPTO fees are required to make an application special, and only nominal legal fees are required to prepare and file the petition form.

There are several different bases for a petition to make special. For example, a petition may be based on the inventor's health, with evidence that the inventor may be unable to aid in the application's prosecution if prosecution were to occur at the usual pace. The petition also may be based on the inventor's age, if at least one inventor is 65 or older. Alternatively, an applicant may request that an application be taken out of turn because the claimed invention materially enhances the environment, or materially contributes either to energy resource development or conservation, COVID-19 diagnosis or treatment, or to counter-terrorism measures. In general, these applications are examined before other "regular" pending applications.

### **Quick Path Information Disclosure Statement (QPIDS) Program**

During prosecution, the USPTO requires certain individuals associated with an application to submit known, relevant prior art references, for the examiner's consideration. Often, an individual becomes aware of prior art after the examiner allows the application. When that occurs, the general practice is to file an RCE, which delays the application's issuance. The QPIDS program requires the examiner, under certain circumstances, to consider references without the delay associated with filing the RCE.

To take advantage of the QPIDS program, an applicant already must have paid the issue fee for an allowed application. The applicant must file an information disclosure statement (IDS) and any required references, a web-based petition to withdraw the application from issuance, and the RCE. The applicant must also provide authorization to charge the applicant's deposit account for any IDS fee, the fee to withdraw the application from allowance, and the RCE fee. The applicant also must certify they became aware of the references within the last three months. If the examiner determines the claims are still allowable over the new references, the case will remain allowed, and the USPTO will not charge the deposit account for the RCE fee. Conversely, if the examiner determines that any reference anticipates or renders obvious at least one of the allowed claims, the USPTO will withdraw the application from issuance, process the RCE, and reopen prosecution of the application.

*Reprinted with permission from the March 17, 2022 edition of The New Jersey Law Journal © 2022 ALM Media Properties, LLC. All rights reserved. Further duplication without permission is prohibited, contact 1.877.257.3382 or [reprints@alm.com](mailto:reprints@alm.com).*

#### **About the Authors:**

**Joseph Agostino** and **Lennie A. Bersh** are Shareholders with Greenberg Traurig in Florham Park, concentrating their practices on intellectual property law. **Philip J. Hoffmann**, a former Administrative Patent Judge at the USPTO, is Of Counsel with the firm. This article is presented for informational purposes only and it is not intended to be construed or used as general legal advice nor as a solicitation of any type.