



Intellectual Property Advisory: Tips for Accelerated Patent Examination

By Paul M. Rivard

It has now been 18 months since the U.S. Patent and Trademark Office (USPTO) implemented revised procedures for requesting accelerated examination. The USPTO indicated that the majority of petitions are now granted on the initial or second request, and that it has been successful in meeting its goal of concluding examination of approved applications within 12 months. Here are some tips that can help applicants navigate through the process.

Common Problems

- Search terms too general
- Search/petition does not address each and every claim
- Features lumped together (e.g., arguing a 20-word phrase is not taught by prior art)

Practice Tips

- Make a good search and document how it was performed (US, foreign, non-patent literature)
- Document search logic and make sure it is appropriate
- The petition should focus on most closely related art; consider submitting two Information Disclosure Statements (IDS's), one supporting (most relevant art) and the other non-supporting (remaining art)
- Non-supporting IDS: no need to discuss art but avoid citing an excessive number of references, which may raise concerns of appearing to bury relevant art
- Explain what is shown in prior art and why the claim is different
- For dependent claims, you can either argue patentable for same reasons as independent claim or explain why separately patentable
- Briefly explain why claims are non-obvious (e.g., references not combinable)
- Ensure filing formalities are complete, including good drawings (any notices from initial patent examination will trigger dismissal of petition)
- Identify § 112 ¶ 1 support for limitations in application and in any priority applications

- If filing a continuation, do not file a preliminary amendment (not allowed under accelerated exam rules) but rather include the claims you want examined in the body of the application
- In a continuation, it is helpful when paragraph numbers correspond to paragraph numbers in parent application(s)
- Claims are limited to three independent and 20 total; you must count claims that cross over statutory classes as independent claims (e.g., product-by-process)

Further information is available at <http://www.uspto.gov/web/patents/accelerated/> including a sample petition.

To subscribe or unsubscribe to this Intellectual Property Advisory, please send a message to April Kemp at akemp@bannerwitcoff.com



www.bannerwitcoff.com

© Copyright 2008 Banner & Witcoff, Ltd. All Rights Reserved. No distribution or reproduction of this issue or any portion thereof is allowed without written permission of the publisher except by recipient for internal use only within recipient's own organization. The opinions expressed in this publication are for the purpose of fostering productive discussions of legal issues and do not constitute the rendering of legal counseling or other professional services. No attorney-client relationship is created, nor is there any offer to provide legal services, by the publication and distribution of this advisory. This publication is designed to provide reasonably accurate and authoritative information in regard to the subject matter covered. It is provided with the understanding that the publisher is not engaged in rendering legal, counseling, accounting or other professional services. If legal advice or other professional assistance is required, the services of a competent professional person in the relevant area should be sought.