You may have heard your patent attorney use the term “patent prosecution” on many occasions. This phrase refers to the process that takes place between the patent applicant and the patent examiner from the date the patent application is filed with the United States Patent and Trademark Office (“USPTO”) until the application issues as a patent or is abandoned by the applicant.

Once a patent application is filed with the USPTO, the application is reviewed for compliance with formal filing requirements and is forwarded to a Group Art Unit within the USPTO. Within the Group Art Unit, the patent application is assigned to a particular patent examiner for examination on the merits. The patent examiner will classify the subject matter of the invention according to the patent classification system and conduct a search for relevant prior art references. Based on the results of the search, the patent examiner will issue an action on the merits of the application.

In the first action, the examiner either allows or, more often than not, rejects the claims of the application. If the examiner rejects the claims in the first action, the applicant has an opportunity to respond by arguing the merits of the application and, if appropriate, amending the patent claims. Thereafter, the examiner will then reconsider the application. Based on the applicant’s response, the examiner may issue a second non-final Office Action or a Final Office Action on the merits of the application. If a Final Office Action is issued, the prosecution options are generally limited to 1) filing an amendment after final (the examiner has discretion whether or not to consider the amendment), 2) filing a continuing application (continuation or continuation-in-part), 3) filing a Request for Continued Examination (RCE) of the application, 4) appealing the application to the Patent Trial and Appeal Board, or 5) abandoning the application. If claims of the application are allowed, then the USPTO will issue a communication instructing the applicant to pay the issue fee. Shortly after the issue fee is paid by the applicant, a Letters Patent will be issued.

As of March, 2013, the USPTO reported that there was a backlog of over 592,000 filed utility patent applications that were awaiting examination by the Office, and a backlog of nearly 112,000 RCEs. While the USPTO intends to reduce the time from filing to action on the merits of a patent application to 10 months from the filing date, according to current USPTO statistics, the average number of months from the filing date of the patent application to the issuance of a first Office Action on the merits of the application is 19.2 months. The USPTO currently reports that the total time of pendency of a patent application, which refers to the time period from the filing date of the patent application to the final disposition of the application (issuance of a patent or abandonment by the applicant), is 31.2 months. The filing of one RCE in a patent application extends the total pendency from the filing date of the application to the final disposition from 31 months to 63 months. The filing of an appeal to the Patent Trial and Appeal Board extends the total pendency from the filing date of the application to the final disposition from 31 months to 88 months.

First Action Interview Program
According to the First Action Interview Pilot Program, a patent applicant is entitled to a first action interview with the patent examiner, prior to the issuance of the first Office action on the merits. Upon request from the patent applicant, the examiner will conduct a prior art search and provide applicant with a condensed pre-interview communication citing relevant prior art and identifying proposed rejections or objections. Thereafter, the patent applicant shall schedule an interview with the patent examiner and submit proposed amendments and/or arguments in an attempt to overcome the proposed rejections. During the interview, the relevant prior art identified by the examiner in the prior art search, proposed rejections, amendments and arguments will be discussed between the parties. If agreement is not reached between the parties regarding the allowability of the claims, then the applicant will receive a first action interview Office Action that includes an interview summary that constitutes a first Office Action on the merits of the application. The applicant will then be able to respond to the first Office Action. This first action interview pilot program is available across all technologies.

After Final Consideration Pilot
The USPTO launched the After Final Consideration Pilot 2.0 on May 19, 2013. This pilot program is currently set to run through September 19, 2013. This pilot program is designed to increase collaboration between examiners and patent applicants to lead to a more-cost effective and efficient final disposition of patent applications. After the issuance of a final Office Action by the patent examiner, the applicant has the opportunity to submit further amendments and arguments to place the application in condition for allowance. This pilot program authorizes additional time for examiners to search and/or consider responses filed by patent applicants after issuance of the final rejection. According to this pilot program, the patent examiner may use this additional time to schedule and conduct an interview with the patent applicant to discuss the results of further prior art search and/or consideration. To be eligible for consideration under this pilot program, the applicant must file a response which includes a request on a USPTO standardized form for participation in the pilot and an amendment to at least one independent claim that does not broaden the scope of the independent claim in any aspect. The examiner is permitted to use their professional judgment to decide whether the applicant’s response can be fully considered under the pilot program.

Track One – Prioritized Examination
According to prioritized examination under the Track One program, a patent applicant will achieve a final disposition of its utility patent application within about 12 months. An applicant can participate in this program by filing a request and paying the required fee at the time the patent application, or a RCE, is filed with the USPTO. By filing the request and paying the additional fee, the USPTO will accord “special” status to the patent application and expedite the search and examination process. According to USPTO statistics as of July 8, 2013, under the
Track One program, the time from the filing date of the application to the issuance of the first office action on the merits of the application is about 2 months. The time period from the grant of the request for participation in the program to final disposition of the application is about 6 months. While the fee for participation in the Track One program is somewhat costly, the extensive applicant pre-filing search and preparation of an examination support document required for the accelerated examination program is not required.

**Patent Prosecution Highway**

Another mechanism to expedite the prosecution of a patent application is through participation in the Patent Prosecution Highway ("PPH"). According to the PPH, an applicant that receives a ruling from the Office of First Filing (OFF) that at least one claim in an application filed in the OFF is patentable may request that the Office of Second Filing (OSF) fast track the examination of corresponding claims in corresponding applications filed in the OSF. Therefore, if a particular patent application was first filed outside of the USPTO, then the applicant in the USPTO can request participation in the PPH to obtain a corresponding patent in the United States faster and more cost effectively. The USPTO currently has reciprocal PPH agreements with Australia, Austria, Canada, China, Colombia, Czech Republic, Denmark, European Patent Office, Finland, Germany, Hungary, Iceland, Israel, Japan, South Korea, Mexico, Norway, Philippines, Portugal, Russian, Singapore, Spain, Sweden, Taiwan, and the United Kingdom.

**Quick Path IDS ("QPIDS")**

From one of my previous SVC columns, you are aware of the duty to disclose information that is material to the subject matter claimed in the patent application. Information that the applicant considers to be material to patentability is submitted to the patent examiner at the USPTO as part of an Information Disclosure Statement. Failure to submit known material information to the USPTO may lead to a subsequent finding of inequitable conduct (otherwise known in the patent community as “fraud on the Patent Office”), with the possibility that the resulting issued patent is unenforceable.

The USPTO has rules governing the submission of Information Disclosure Statements, which dictate the timing and requirements for filing the Information Disclosure Statements. According to the PTO rules, an Information Disclosure Statement are generally filed within three months of the filing date of a patent application and before the mailing of a first Office action on the merits. If the Information Disclosure Statement is not filed during this time, it can be filed before the mailing date of a final action, a notice of allowance, or another action that otherwise closes prosecution in the application, so long as the applicant pays a fees or can make a statement about the time the information became known to it. The Information Disclosure Statement can still be filed after the issuance of a notice of allowance or on or before payment of the issue fee.

Although the PTO rules provide for different mechanisms and time periods to file and Information Disclosure Statement, many times patent applicants become aware of items of prior art that are material to the patentability of the subject matter claimed in a patent application after payment of the issue fee. The current version of 37 C.F.R. 1.97 provides no mechanism by which the applicant can submit an Information Disclosure Statement to the United States Patent and Trademark Office and have the items of information considered by the Examiner. Consequently, the applicant is compelled to file a petition to withdraw the allowed application from issuance, and file a Request for Continued Examination for the sole purpose of submitting the Information Disclosure Statement. This results in increased costs for the applicant and delays the issuance of the application as a granted patent.

In an attempt to overcome the costs and delays with filing an Information Disclosure Statement after the mailing of a notice of allowance, the USPTO has launched the Quick Path Information Disclosure Statement (QPIDS) pilot program. The program was specifically designed to permit patent applicants to avoid having to file a RCE to have an Information Disclosure Statement considered by the Examiner after the issue fee is paid. Under the QPIDS pilot, the patent Examiner will consider the items submitted with the Information Disclosure Statement. Where the patent Examiner determines that no item of information submitted in the Information Disclosure Statement requires reopening of prosecution of the application, the application will be returned to issue and USPTO will issue a corrected notice of allowability for the application. In some cases, the prosecution of the application will be reopened where the patent examiner determines that further prosecution is necessary to address one or more items submitted in the Information Disclosure Statement. In the event that no items of information submitted in the Information Disclosure Statement require further consideration by the Examiner, and prosecution is not to be reopened, the costs and delays normally associated with the filing of Requests for Continued Examination of patent applications are eliminated.

Participation in one or more of the USPTO initiatives or pilot programs may significantly expedite the patent prosecution process, thereby reducing the pendency of the application, and result in an overall cost savings to the patent applicant.

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