

## Getting on the Patent Fast Track While Keeping Competitors in the Rearview Mirror

**Q** Long delays at the U.S. Patent and Trademark Office (USPTO) can be frustrating and detrimental to a company. What options exist to speed up patent prosecution?

**Rory P. Pheiffer:** There are five programs that can accelerate the process: 1) Track One Prioritized Examination; 2) Accelerated Examination; 3) Petitions to Make Special; 4) the Patent Prosecution Highway; and 5) the First Action Interview pilot program.

**Q** What are the differentiators in these programs?

**RPP:** The **Track One (PE)** program results in allowance or two rounds of rejections and responses in 12 months; cost is the most significant hurdle. However, the investment often provides a faster result at a reduced total cost.

The **Accelerated Examination (AE)** program is designed to advance at a similar pace as the Track One PE program and the administrative cost is minimal. However, a major investment must be made to prepare an AE Examination Support document, which explains why the pending claims distinguish over the most pertinent prior art. This is expensive to prepare and requires an applicant to characterize prior art, which is often not advisable.

**Petitions to Make Special** allow certain classes of applicants to have their applications treated expeditiously, but without a specific timeframe. Classes of applicants that can file petitions include those with health issues, of a certain age, or whose inventions fall in particular fields of interest. No fee is required to file a petition.

The **Patent Prosecution Highway (PPH)** program can expedite the allowance of claims in other jurisdictions once allowed subject matter has been identified in a first jurisdiction. The examiner relies on the search and examination results from another participating jurisdiction in which similar claims were deemed allowable, or from a favorable international search report. Once allowable subject matter is identified, applicants can expedite the prosecution of their applications in participating jurisdictions, including the U.S.

The **First Action Interview (FAI)** pilot program expedites prosecution only after the application has been picked up by the examiner. There is no special treatment given to the application between the filing date and the time of the first substantive Office Action. However, once the FAI program begins, prosecution is more compact. The examiner issues an FAI Office Action, which is a shortened version of a regular Office Action that provides a high level overview of the basis for rejection. The applicant then has 30 days to reply by initiating an examiner interview. There is no cost to participate in the FAI program, and the result can be quicker because it can eliminate Office Actions and written responses.

**Q** What are the chief considerations when applying to these programs?

**RPP:** While the best suited program depends on many circumstances, applicants may find the PE program and Petitions to Make Special the speediest options in the U.S., and then may look to couple one of those programs with the PPH Program for international filings. The FAI pilot program is a useful option for applicants who are interested in expediting prosecution at a time subsequent to their initial application filing.

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Rory P. Pheiffer is a partner in the Intellectual Property Department, and a member of both the Emerging Companies and Life Sciences practice groups. His practice covers a broad spectrum of intellectual property issues, including domestic and international patent prosecution, patent litigation, patent opinion and clearance matters, domestic and international trademark prosecution and enforcement, and technology licensing matters.

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