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Strategies for Getting Patents Issued Quickly

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The competitive value of many Internet, business method, or software patents lies in functional features that are exposed when the invention is made commercially available. However, patent protection of these functions is available only after the patent issues, which often takes more than three years. In the world of “Internet time,” such a delay may be devastating to a company whose inventions are quickly copied by a competitor. Quick issuance of patents may be a key component of an aggressive strategy, particularly where there is intent to license or litigate. This article provides various practice tips and strategies for expediting patent issuance.

Early issuance of patents occurs only with early filing of applications. Company procedures to identify inventions early on in product development are essential. However, patent programs that essentially rely on inventors to volunteer disclosures often catch inventions at the tail end of development, if at all. Tight product develop schedules give inventors very little time to identify their inventions, let alone provide the details for a patent application, even after a product release. Accordingly, a patent program should start with a review of the technology strategy of the company, the product or market segments in which it competes, and which technologies support these segments. A patent attorney can then actively investigate what inventions are being made in each of these areas, and task inventors to provide documentation.

Once inventions have been identified, early filing is the next step, and provisional applications are key tool. While the provisional filing date is useful to close off later prior art from being cited against the application, by itself it does not speed up issuance of the patent. This is because the utility application, which claims the provisional filing date, is examined according to its own actual filing date, not the provisional filing date. Accordingly, it’s best to start the conversion process immediately after the provisional application is filed.

Early issuance mainly depends on early examination. The most common procedure for accelerated examination is the Petition to Make Special, as provided in 37 C.F.R. §1.102. There are several different grounds for making an application special, but two of the most commonly used are i) actual infringement of the prospective claims of the patent, and ii) completion and analysis of a prior art search. The actual infringement approach was used by Amazon.com for its One Click patent, and helped get the patent issued in time to obtain an injunction against BarnesandNoble.com for infringement right before the 1999 holiday season.

The Manual of Patent Examining Procedure describes the requirements for this petition, but omits some of the finer points. First, timing of the petition is crucial. Experience suggests that filing the petition with the application filing is not desirable. Because the application is not assigned a serial number yet, the petition cannot be easily matched to the application file, and this delays handling of the petition and routing it to the appropriate examiner. Thus, file the petition after the serial number has been assigned.

Second, the Special Program Examiner in the technology group that handles the invention technology decides these petitions. Call the Special Program Examiner ahead of time informing him of the petition, and offering to be available to answer any questions. Then, file the petition by facsimile to ensure immediate consideration. Petitions should normally be decided within 45 days, and so follow-up with a phone call 30 days after filing to keep the process on track. This avoids the unfortunate circumstance of the petition languishing for months and vitiating the benefit of the procedure. Once the petition is granted, an official action is typically issued within three months. Call the examiner to confirm this expectation and provide further discussion of the invention and the references if possible.

The Petition to Make Special may also be combined with international patent procedures. Many companies wait the

full year allowed by the Patent Cooperation Treaty (“PCT”) and U.S. law in which to file the PCT application. However, a PCT application can be filed at the same time as the US application. If so filed, then the International Search Report must be prepared within nine months (PCT Rule 42.1), well ahead of the typical time the first action issues, which is typically 18 to 24 months.

The key here is to designate the PTO as the International Search Authority, so that a U.S. examiner prepares the International Search Report. After the Search Report is received, call the examiner and inform him that there is corresponding U.S. patent application, and politely suggest that he consider issuing the first action in that application. This helps the examiner reduce his caseload, effectively applying the single search to two patent applications. If the examiner declines, then the Search Report can be used as the basis of the search-based Petition to Make Special. Carefully crafted remarks that distinguish the claims (not some vague “present invention”) from the references should lead to grant of the petition and an early first action.

Getting an early first action is good, but getting a first action allowance is better. Many attorneys typically file with one to three independent claims and many dependent claims, both to reduce filing fees and later to choose which dependent claims to make independent to obtain allowance. This works, but not for early issuance. To succeed here, file the application with many independent claims of varying scope, detail, and form (e.g., system, method, web site, computer program product, means for apparatus, etc.). This gives the examiner a broad array of different possible claims to immediately allow. The attorney can then cancel rejected claims and proceed to issuance.

Getting claims allowed quickly is great, but getting the patent issued is the goal. There are two primary roadblocks: matching the issue fee payment with the file, and getting formal drawings approved. Many practitioners file formal drawings with the issue fee payment, in order to delay the expense. However, this can seriously delay issuance, sometimes for over six months. Accordingly, file formal drawings early, preferably before the first action. If you do have to file late, call the examiner and arrange to have the drawings personally delivered (or FEDEXed) to him, and ask him to hand carry them to the draftsman for immediate review. To avoid the delay of matching the issue fee payment, pre-pay this amount, or authorize the PTO to charge the deposit account upon mailing of the notice of allowance. These steps can result in the patent issuing in as

little as three weeks following the notice of allowance (if the issue fee is prepaid).

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