

## In This Issue

A Review of the Programs to Expedite Examination and Appeal with the USPTO  
.....Page 1-2

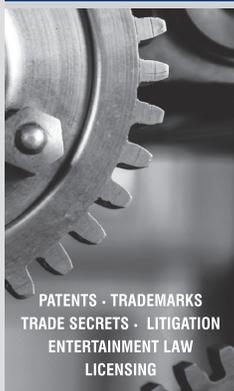
MVS – Your Worldwide IP Partner Since 1924™  
.....Page 3

Drake Intellectual Property (IP) Law Center Spring CLE  
.....Page 3-4

Newsletters...We're Going Green!.....Page 4

**YOUR  
MECHANICAL  
INVENTION  
IS OUR SPECIALTY**

YOUR WORLDWIDE IP  
PARTNER SINCE 1924™



PATENTS · TRADEMARKS  
TRADE SECRETS · LITIGATION  
ENTERTAINMENT LAW  
LICENSING

MVS

MCKEE,  
VOORHEES  
& SEASE, PLC

WWW.IPMVS.COM  
(515) 288-3667

## A REVIEW OF THE PROGRAMS TO EXPEDITE EXAMINATION AND APPEAL WITH THE USPTO

*by Paul S. Mazzola*

One of the biggest complaints with the patent process from individual inventors, small businesses, and large companies alike is the length of time from application to final disposition. And understandably so, as “patent pending” status is provisional in nature, the scope of any resulting rights remains uncertain until the patent claims issue. The uncertainty can result in delays in obtaining financing, licensing, etc., and thereby hamper full realization of the fruits of an inventive endeavor.

From filing to initial examination can often take greater than one year. To reduce these times and the overall backlog of applications and appeals, the United States Patent and Trademark Office (USPTO) has promulgated several programs. Many of the programs have been around for some time now, but applicants often do not know all of the options available to them. Proper use of one or more of these programs not only can greatly reduce pendency of an application, but also provide for an improved allowance rate. Each of these programs will be discussed in turn with associated advantages and disadvantages.

To obtain quicker examination of to-be-filed applications, an applicant may wish to enter Track One Prioritized Examination, Accelerated Examination, or Patent Prosecution Highway.

**Track One Prioritized Examination** is typically the fastest of the programs and generally provides a First Action within five months and a final disposition within twelve months. In exchange for that speed, entry into Track One requires a substantial associated fee - \$4,000 for large entities, \$2,000 for small entities, and \$1,000 for micro entities. The fee is the primary deterrent to applicants to seek entry into Track One. Other requirements include the application be a first filing, continuation application, or request for continued examination (RCE); and contain no more than four independent claims or thirty total claims, or any multiple dependent claims.

Once entered into the program, Track One status will be lost if any number of circumstances occur, including the mailing of a final Office Action. Often in prosecution, the second action on the merits is a final Office Action. See MPEP 706.07(A). In such instances, the application effectively remains in the program for one round of prosecution. Thus, despite the speed associated with Track One prioritized examination, applicants must be willing and able to place the application in a condition for allowance quickly, or risk having to file an RCE that will be examined with standard priority. During its entry in Track One, normal interview practice is afforded, permitting opportunity to streamline claims with examiner input prior to the mailing of a final Office Action and losing Track One status.

For micro entities (and perhaps small entities), the reduced Track One fee might be a worthwhile expense to secure an issued patent within one year, especially if business considerations are contingent on a patent (e.g., attracting investors to the underlying technology). Prior to filing the application, significant care should be taken to ensure the claims are not unduly broad so that amendments can be meaningfully made to quickly bring the claims into allowable form prior to the mailing of a final Office Action. Arguably, the relatively narrower claims as filed and aggressive amendment practice could offset at least a portion of the Track One fee by eliminating protracted prosecution such as RCE fees and attorney costs of responding to several Office Actions.

While not quite as fast as Track One prioritized examination, **Accelerated Examination** can also provide a First Action within five months at a fraction of the USPTO fees. In fact, the petition fee for Accelerated Examination is \$140 for large entities, \$70 for small entities, and \$35 for micro entities. Other requirements include the application be a first filing or continuation

*continued from page 1*

application; and contain no more than three independent claims or twenty total claims, or any multiple dependent claims. Upon entry into the program, applicant must agree to hold an examiner interview prior to the issuance of an Office Action.

In exchange for the accelerated examination at such a low cost relative to Track One, the USPTO requires, among other things, the applicant conduct a pre-examination search and provide an accelerated examination support document.

The requirements of the pre-examination search and accelerated examination support document are demanding, and essentially require the applicant to perform the initial search and examination for the USPTO, together with a response that the claimed subject matter remains patentable over the references. Such an endeavor should be performed by an experienced patent practitioner such that the application is granted entry into the Accelerated Examination program and reaps the benefits of the same. Consequently, the costs associated with the pre-examination search and accelerated examination support document are likely appreciable and could exceed, by comparison, the Track One fee, particularly for small entities and micro entities. The complexity of the application could make the difference whether to simply pay the Track One fee, or pay a patent practitioner to conduct the pre-examination search and prepare the accelerated examination support document. Similar to Track One, however, the initial form of the claims and aggressive amendment practice could offset at least a portion of the overall fees by eliminating protracted prosecution.

A consideration of utmost importance with Accelerated Examination involves an applicant characterizing its own claims to the USPTO. While generally interpreted in light of the written disclosure, claims are drafted in a manner to capture the idea in addition to the concrete embodiments required to practice the idea. Creating a written record with the USPTO could create detrimental estoppel should an applicant later need to argue the meaning of a claim term (whether in prosecution or litigation). This risk should not be underappreciated and must be weighed against the costs and the speed of the program.

For applications originating as foreign applications, the **Patent Prosecution Highway** can provide a mechanism to not only receive a First Action more quickly than a regular application, but also improve the likelihood of a First Action allowance. The key requirement of the Patent Prosecution Highway is that another foreign office that participates in the program must have found at least one of the claims allowable in the foreign application. Similar to the accelerated examination support document of the Accelerated Examination program, the USPTO essentially gains the benefit of an already-performed search and examination. There is no additional fee associated with the Patent Prosecution Highway.

Two primary considerations regarding the Patent Prosecution Highway are timing and claim scope. Given the key requirement of an allowed claim in a foreign application, an applicant must be willing to wait for the same prior to filing a United States application. Any number of considerations could be associated with such a decision. Further, an applicant must be cognizant that broader claim scope may be obtainable domestically than abroad, and the speed and ease gained by the Patent Prosecution Highway could come at the cost of unduly limited claims.

Additional tools available for pending applications include the **First-Action Interview Pilot Program and the After Final Consideration Pilot (AFCP) 2.0 Program**. Each of the pilot programs provide for additional opportunities for an examiner interview to discuss the claims and/or the cited references, and can provide quick and cost-effective means for advancing prosecution.

From the programs delineated above, it can be appreciated that several mechanisms exist to expedite an application. In nearly every instance, however, the USPTO is receiving a concession in order to do so – whether it be an applicant-generated patentability analysis or foreign office search and examination; the Track One fee itself is in lieu of any such concessions. Nevertheless, it is important that an applicant be knowledgeable of all available mechanisms to make the best possible decisions when pursuing an inventive endeavor.

## MVS - YOUR WORLDWIDE PARTNER SINCE 1924™

*by Jill N. Link, PharmD*

The attorneys of MVS provide work with clients in nearly all technical areas of intellectual property law, here in Iowa and the United States, as well as throughout the world. MVS' international patent and trademark practice is more expansive than you may imagine. MVS, through its foreign associates in each international jurisdiction, provides international intellectual property representation in over 130 countries. That is right - over 130 countries!

A robust international practice is critical to providing our clients full service intellectual property representation. As we identify our clients' needs for their business, as well as their goals for the business, international protections are often involved. For example, a United States patent application may serve as the foundation for a business' intellectual property position. However, global markets of interest are often identified based on where a product is to be manufactured (or portions thereof being manufactured) and where it will be sold and/or marketed to consumers. Other considerations MVS attorneys often discuss with clients to assist in the foreign filing decisions include for example, market size, presence (or absence) of key competitors, strength of legal protections in a particular country, availability of protection for the specific type of intellectual property (e.g. plant protection and/or methods of treating a human body), and the like.

Once foreign markets are identified, MVS is able to provide clients with detailed cost estimates for the filing, prosecution and maintenance of the patent in any foreign jurisdiction. For patents, the timing of such international protection is very important, as a foreign filing must take place no later than one year from your first filing (generally United States patent application). However, in some instances your filing may need to be accomplished earlier as most foreign jurisdictions require "absolute novelty" for an invention, meaning that the application must be filed before any public use and/or disclosure of the invention has taken place. Many clients take advantage of foreign patent protection through the Patent Cooperation Treaty (PCT) which allows a pending patent in a large number of countries with a single filing. At the end of a 30 month period (or 31 depending on the country), MVS assists its clients in choosing which of the PCT countries a patent will formally be pursued and filed. There are also other regional international options available to clients.

MVS then works with foreign co-counsel around the world to file and prosecute (at our direction) the necessary protections in each country. Beneficially, MVS remains your sole point of contact for the entire intellectual property portfolio, as the foreign counsel work directly through MVS. This provides a substantial benefit to your intellectual property examination throughout the world, as MVS ensures there is a coordinated, consistent and strategic examination of the intellectual property.

As previously highlighted in the MVS Spotlight, MVS is also a leading member of LEGUS, an international network of law firms. This membership further positions MVS to provide clients legal representation on non-intellectual property throughout foreign jurisdictions by referring clients to other LEGUS members. MVS' expansive foreign patent and trademark practices enables our clients to protect their intellectual property both here in the United States and throughout the world, demonstrating that we truly are "Your Worldwide IP Partner."

## DRAKE INTELLECTUAL PROPERTY (IP) LAW CENTER SPRING CLE

*by Heidi S. Nebel*

MVS has a long history of supporting Drake University Law School. Several MVS attorneys serve as adjunct professors teaching IP classes, MVS mentors and sponsors Drake Students in the National Intellectual Property moot court competition, and MVS also funds an IP law scholarship that is awarded each year to a law student who wants to practice in Intellectual Property. This tradition continued in 2015 when Ed Sease agreed to serve as the Interim Director of the Drake IP Law Center. The Center was established in the fall 2007, to promote global, interdisciplinary understanding of intellectual property law and policy. The Center was launched with the support of a \$1.5 million gift from Wayne and Donna Kern, which endowed the Kern Family Chair in Intellectual Property Law, and a \$750,000 leadership commitment from DuPont Pioneer. For seven years in a row, peer surveys conducted by *U.S. News and World Report* have ranked the Center among the top 25

intellectual property law programs in the United States.

As part of its mission the Center provides an annual roundtable discussion/seminar to explore theoretical, practical and current issues in Intellectual Property. This year's event is also a CLE, featuring presentations from Industry, Academia and the United States Patent and Trademark Office.

Day one includes presentations from the USPTO and two former judges from the Board of Patent Appeals and Interferences, including the Former Chief Judge Honorable James Smith. Day one also includes a presentation on AIA Post Grant Relief from an attorney who has had involvement with over 40 of these new proceedings.

*continued on page 4*

*continued from page 3*

Day two of the seminar is focused exclusively on Agricultural IP, with confirmed speakers from DuPont/Pioneer and Monsanto. Law Professors Mark Janis and Jay Kesan, who authored the book "Agricultural Biotechnology and Intellectual Property: Seeds of Change" will each be presenting and MVS's own Heidi Nebel will be speaking on IP protection of plants. The Key note Speaker is Tom Vilsack, Secretary of Agriculture (Invited) and there will be time for socializing and informal discussion as well. Mark your calendars for March 24th and 25th. The event will be held at the Neal Smith Law Center at 24th and University in Des Moines, starting at 8:00. It is sure to be a fun and intellectually stimulating event.

## NEWSLETTERS...WE'RE GOING GREEN!



In an effort to "Go Green" we have decided our March 2016 Newsletter will be our last issue in full print format. You can opt in to receive it via USPS or sign up for electronic distribution.

We will continue to produce a newsletter that will be delivered via email. It is very important that we have your correct address on file, whether it's your email address or a physical address, including attention to instructions. If you are not certain that we have your correct address, or if you have not been receiving our e-newsletters and you would like to, please send an email to [briefs@ipmvs.com](mailto:briefs@ipmvs.com), or fill out the form which can be found at the bottom of each page of our website [www.ipmvs.com](http://www.ipmvs.com).

## MVS FILEWRAPPER® BLOG

McKee, Voorhees & Sease maintains the Filewrapper® blog at [www.filewrapper.com](http://www.filewrapper.com). The blog is regularly updated to report on topics such as recent intellectual property case law, legislation, proposed legislation, administrative policies, and other intellectual property developments. We consciously refrain from expressing opinions on this blog and instead, offer it as a form of information and education.

We have always been proud of the fact that the content is original content authored by MVS attorneys. Although there are many contributors, Daniel Lorentzen, Ph.D coordinates efforts and is also the firm's most prolific contributor.

We encourage clients interested in intellectual property developments to visit or subscribe to the blog.

## WE'RE THERE

### January 26, 2016

Jill Link attended the Small Business Association/SCORE meeting in Montgomery, AL.

### February 14-17, 2016

Heidi Nebel and Laura Hupp attended the AUTM Annual Meeting in San Diego, CA.

### February 15, 2016

Brandon Clark attended the Grammy Awards in Los Angeles, CA.

### February 22, 2016

Kirk Hartung will be speaking on Motivational Leadership at Blaine Labs in Santa Fe Springs, CA.

### March 13-17, 2016

Jonathan Kennedy and Daniel Lorentzen will attend the American Chemical Society National Meeting and Exposition in San Diego, CA.

### March 16-20, 2016

Brandon Clark will attend the South by Southwest SXSW conference and festival in Austin, TX.

### March 24-25, 2016

Ed Sease (organizer of the symposium), Heidi Nebel and Jill Link will attend the Drake IP Law Center Patent CLE/Roundtable in Des Moines, IA.

### March 30, 2016

Laura Hupp and Daniel Lorentzen will attend the IA Biotech Innovation Showcase in Ankeny, IA.

### April 26-28, 2016

Jill Link will attend the Licensing Executive Society meetings in Houston, TX.

**If you would like to receive the BRIEFS newsletter electronically, please subscribe to [briefs@ipmvs.com](mailto:briefs@ipmvs.com)**

*BRIEFS is published periodically and is intended as an information source for the clients of McKee, Voorhees & Sease, PLC. Its contents should not be considered legal advice and no reader should act upon any of the information contained in this publication without professional counsel.*