

# The Limited Monopoly

## Faster Than A Speeding Bullet

### The Need for Speed

Joe is the founder and CEO of Catatonics, a high tech startup that has a new add-on module for CT scanners. Catatonics' new module increases CT scanner image resolution by 10X, and includes image enhancement software and a digital image library to assist a radiologist in making a diagnosis from a scan. Several breakthroughs have just occurred in development, and interest in the new product from a major CT scanner manufacturer is high. Although Joe is a pretty laid-back guy, he knows it is urgent that Catatonics pursue patent protection of its new product. He has just learned that due to the huge backlog of pending patent applications in the Patent Office, the time from application filing to patent issuance could be several years. What? Several years?!! Catatonics needs to get an issued patent sooner for a variety of reasons. Joe confers with his patent agent and learns that he has some options to accelerate the patent process.

### Well, Isn't That Special?

Joe's patent agent is well versed in techniques to get a client to an issued patent fast. (The term fast being a relative term when compared to, say, a presidential election cycle). The patent agent knew of the importance of issued patents for high tech companies, and had a toolbox full of ways to get to one faster. He first explored the standalone Petition to Make Special categories. In 2006, the United States Patent and Trademark Office added a level of complexity and cost to the "Free" categories of Petitions to Make Special. The only categories that are still free for newly filed applications in the U.S. are Age and Illness. If one of the inventors is over the age of 65, or is suffering from an illness where he or she may not be available to assist in the prosecution of an application if it were to run its normal course, the patent application, upon submission and approval of a Petition to Make Special, will be accorded "special" status, and will be advanced out of turn for examination. Unfortunately for Joe (from a patent standpoint, that is), his company is full of young and healthy inventors, and the free Petition to Make Special categories were out.

### Accelerated Examination

On August 25, 2006 the United States Patent and Trademark Office established new procedures for the remaining Petition to Make Special categories. They are no longer free, but the patent office now guarantees a final disposition within 12 months of filing the application. If the invention relates to

*"With the New Accelerated Examination Procedures, the Patent Office guarantees a final disposition within 12 months of filing the (Patent) application."*

environmental quality, energy, recombinant DNA, superconductivity, HIV/AIDS or cancer, biotechnology, or countering terrorism, or if U.S. manufacturing is predicated on an issued patent, or if there is alleged infringement of a patent that might issue, a Petition to Make Special under the new accelerated examination procedures is possible.

There are a number of submissions required for the accelerated examination option, the petition fee being one of them. The fee is modest, currently at \$130. The majority of the costs for an accelerated examination submittal are in the preparation of the support documents required for the submission. First, a petition must be prepared for one of the eligible Petition to Make Special categories.

claims, describes the utility of the invention as defined in the claims, shows support of the claims in the specification, as well as other required statements.

Accelerated examination is a new procedure that has a high level of complexity associated with it, adding to the cost of your patent application. The upside is that final disposition of your patent application is reached in 12 months. If that final disposition is a Notice of Allowance, the value of an issued patent to your business may quickly offset the additional costs. Of course, you will need to budget some extra time for your patent agent to prepare the accelerated examination submission package over and above the time needed to prepare and file the patent application itself.



### The Intangibles

There are also many intangible ways to help move your patent application along. An experienced patent agent is well versed in these techniques. To begin, full compliance with the United States Patent Office's Electronic Filing System and full integration with the USPTO's Private PAIR system allows for immediate filing, serial number issuance, and status updates. Quick and efficient responses to office actions and other notices also keeps prosecution moving. Also, good and proper formal communication with the examiner, including examiner interviews to help resolve sticky prosecution related items, often helps to clear hurdles. Electronic retrieval of documents before they arrive by mail also speeds up the communication process. And lastly, perfection and quality in what is submitted to the USPTO avoids unnecessary and time consuming rework, all of which cause delay and add to the cost of a patent application filing. □

The Request for Accelerated Examination must also be prepared. Also, all of the filing papers and follow on submissions must be filed electronically – NO PAPER filings are accepted. The patent application must be complete, and contain three or fewer independent claims and no more than 20 claims total. The patent application must be for a single invention, and the applicants must agree to elect without traverse a single invention for examination if there is a restriction requirement. Also, the applicants or their agent must agree to an interview with the examiner to discuss any outstanding issues arising in the examination process. In addition to all of this, a pre-examination patentability search must be conducted, and an Accelerated Examination Support Document (AESD) must be filed. The AESD is a complicated document that explains the search in light of the applicant's invention, makes a comparison and explanation of

Authors Robert D. Gunderman P.E. (Patent Technologies, LLC [www.patenttechnologies.com](http://www.patenttechnologies.com)) and John M. Hammond P.E. (Patent Innovations, LLC [www.patent-innovations.com](http://www.patent-innovations.com)) are both registered patent agents and licensed professional engineers. They offer several courses that qualify for PDH credits. More information can be found at [www.patenteducation.com](http://www.patenteducation.com). Copyright 2007 Robert Gunderman, Jr. and John Hammond.

Note: This short article is intended only to provide cursory background information, and is not intended to be legal advice. No client relationship with the authors is in any way established by this article.

The Authors would like to thank Nick Counts for providing this photograph of the Shinkansen 500 series "bullet train" taken at Kyoto Station. The photograph is licensed under The Creative Commons Attribution 2.5 (<http://creativecommons.org/licenses/by/2.5>) License.

