

OGAWA
PROFESSIONAL CORPORATION

“Tortoise and Hare”

NCCAUS
Plasma Applications Group Meeting

Presented by
Lu Yin, Esq.
Attorney at OGAWA p.c.

Timing to Issuing a U.S. Patent

- ▶ The patent office is slow.
 - Average time of 32.7 months pendency
 - Average time of 22.3 months to a first office action
 - Backlog of 623,168 unexamined patent applications

August 2012 Data

Why Expedite?

- ▶ Issued patents are more valuable than “patent pending”
- ▶ Enforceable
- ▶ Calculation of damages
- ▶ Certainty of ownership
- ▶ Defined patent coverage
- ▶ Funding for start up company
- ▶ Patent award and plaque
- ▶ Resume

Why Delay?

- ▶ Save cost in short Term
- ▶ Technical risk or uncertainty
- ▶ Change in law-Bilski
- ▶ Prevent public disclosure-know how
- ▶ No product

Ways to Expedite

- ▶ Accelerated Examination Program
- ▶ Green Technology Pilot Program (Closed)
- ▶ Applicant's Age or Health
- ▶ Patent Prosecution Highway (PPH)
- ▶ Track I under the Three Track Proposal

Accelerated Examination Program

▶ Requirements

- Petition Fee \$130
- Search report
- Accelerated examination support documents requirement (it's faster because you are doing the work for the Examiner)
- 3/20 claims

▶ Pro

- To complete examination within 12 months from the date of filing
- Accelerated track through prosecution

▶ Con

- Expensive: the acceleration costs can often exceed the cost of preparing the patent application
- Potential prosecution history problem

Green Technology Pilot Program (Closed)

▶ Requirements

- Claims directed to an invention that materially enhance the environment
- 3/20 claims

▶ Pro

- Fast, no fees
- Examination support document not required

▶ Con

- Closed
- Limited subject matter

Applicant's Age or Health

▶ Requirements

- Evidence (doctor's certificate) that “the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course”; or
- The applicant's age is 65 or older

▶ Pro

- Fast, no fees
- Examination support document not required

▶ Con

- Limited availability

Patent Prosecution Highway (PPH)

▶ Requirements

- Use favorable ruling (at least 1 patentable claim) from the Office of First Filing (OFF) to request fast track at Office of Second Filing (OSF)
- Request that identify correspondence of claims

▶ Pro

- Free
- Fast
- No Support documents

▶ Con

- Limited application
- Foreign filing might be expensive
- Depending on the OFF, amount of acceleration varies

Track I (Prioritized Examination)

▶ Requirements

- Request submitted via EFS on the date of filing
 - For application already filed, request can be filed with RCE
- Cost recovery fee (\$4800 or \$2400 depending on entity status)
- Claims limited to 4/30
- Limited to first 10,000 granted request (since 9/26/2011)

▶ Pro

- Fast
- Examination support document not required
- Higher likelihood of grant

▶ Con

- Expensive

Track I Requirements

- ▶ Additional Fee & Request is \$4,800 (\$2,400 for small entity) must be paid at time of filing
- ▶ Claim Limit: 4 independent and 30 total
 - no multiple dependent claims
- ▶ Any extension of time Exits the Program
- ▶ Utility & Plant Patents only (no Design Patents)

Track I Benefit

- ▶ 150% higher allowance rate than normal prosecution
 - Compact prosecution creates an urgency that the USPTO cannot deal well with except to allow the case
- ▶ Allowances usually within 1 year of filing (and as soon as 4 months)
 - The first patent on a Track I application issued on January 10, 2012 (U.S. Pat. No. 8,094,942), which was filed on September 30, 2011.
- ▶ Prosecution history is limited with use interviews and first action allowances

How to Delay Examination

▶ Requirements

- File a request for delay up to 30 months
- The application does not claim priority from prior-filed foreign or US non-provisional application

Thank-you

OGAWA
PROFESSIONAL CORPORATION

lu@rtogawa.com