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Efficient Patent Prosecution and Its Effect on Effective Term Length and Patent Quality

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I. Introduction

A number of programs can be used to improve the efficiency of prosecution in the United States Patent and Trademark Office (USPTO) including the use of accelerated examination options and Examiner Interviews. Various programs are available that can serve to accelerate examination including the Track I program, and various petitions to make the application special. Each of these programs decreases the time to receive a first Office Action, and in general, the time to reaching a final decision on the application. For example, the Track I program has a goal of reaching a final decision within one year of being granted priority status, and the current average time from the grant of the Track I petition to an allowance is only 5.1 months. Compared to the average of 18 months to receive a first Office Action in other applications and an average of 27 months total pendency, the Track I option can significantly decrease the time for obtaining a patent in the U.S.

Examiner Interviews can also improve prosecution efficiency by shortening the overall prosecution, which can reduce the overall prosecution timing and costs as well as limiting the introduction of unnecessary amendments. Examiner Interviews are available in all applications and can include the applicant, the US patent practitioner, and other parties (e.g., foreign counsel) when the US patent practitioner is present. In order to encourage more applicants to take part in Interviews, the USPTO has created several programs to formalize the interviewing process including the First Action Interview Pilot Program (FAIPP) and the After Final Consideration Pilot (AFCP) program. The success of interviews is clear. For example, the average first action allowance rate for applications as part of the FAIPP Program is around 30%, which is more than double the average first action allowance rate of 12% for applications that have not been interviewed.

The improvement in the efficiency of U.S. prosecution can also improve the efficiency in a global filing strategy. For example, a granted U.S. patent can be used to accelerate the examination of foreign applications in a number of jurisdictions. This can lead to an overall increase in the patent term by shortening the overall prosecution period. In addition, the selection of the priority claim along with the filing route can also affect the overall term. Specifically, provisional application filings and foreign priority claims (including foreign priority claims from PCT applications) can be used to effectively increase the patent term by a year. The

filing route may be used as a basis for increasing the examination speed in the US. For example, a petition under the Patent Prosecution Highway (PPH) can be based on a search in a foreign jurisdiction or in a PCT application. Any resulting US patent can then be similarly used to accelerate other foreign applications.

Efficient prosecution, both in the U.S. and abroad can also play a part in the order of prosecution in a global filing strategy. This may be useful for adjusting the order of prosecution in order to obtain patents that take the cited art across all of the applications into account. The end result should include a patent portfolio that has strong claims that have been examined in light of the best art, which can include art located in a number of examination searches in a variety of languages.

Each of these areas will be described in more detail in this paper.

II. Examiner Interviews

Examiner interviews are known to lead to higher allowance rates. For example, the First Action Interview Pilot Program was introduced to provide an opportunity to conduct an interview prior to a first Office Action. The statistics from this program demonstrate a first action allowance rate that is more than double that of the first action allowance rate of regular applications.¹ This is at least partially, if not entirely, due to the improved communications at the beginning of the interview as afforded by the Examiner interview prior to the first action.

Along with a higher allowance rate, Examiner interviews also tend to identify allowable subject matter earlier. Thus, the number of office actions needed to reach an allowance is typically reduced when interviews are carried out. The interview tends to cost less than preparing a full response. As a result, the costs of obtaining a patent can be reduced by avoiding one or more written responses. Even when the number of responses is the same, the responses after an interview are generally more focused on the amendments discussed during the interview. Thus, the cost of preparing the response can be reduced.

¹ <http://www.uspto.gov/dashboards/patents/main.dashxml> (last accessed: October 2, 2015) (listing a 29.7% first action allowance rate for FAIPP applications as compared to a 11.9% allowance rate for regular applications).

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