Patent Prosecution and Malpractice

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1. Potential New Problems.

a. Patenting Alternatives and Speeding Prosecution.

This section is based in part from a forthcoming article, David Hricik Will Patenting Make as Much Sense in the New Regime of Weakened Patent Rights and Shorter Product Life Cycles?, __ Vanderbilt Ent. L. J. __ (2017).

a. Trade Secrets as an Alternative to Patenting**.**

To obtain a patent, an applicant must disclose the information necessary to make and use the invention. Understandably, the unwillingness to do so when the information is a business' trade secret is one reason businesses forego patenting.[1] Given the weakened protection afforded to patents, depending on the industry and the particular invention, the cost-benefit analysis may in more instances favor trade secrets.

In that regard and as noted above, by enacting the Federal Defend Trade Secrets Act,[2] Congress for the first time provided federal trade secret protection.[3] Practitioners should consider this option in light of likely near-term changes in the particular industry and in light of the invention.

b. Quicker and More Effective Patent Prosecution Tactics, and Related Issues.

When patenting is the best choice for a particular invention, there are steps that practitioners can take to get more benefit from a patent. They can speed up prosecution, allow for damages before issuance, and draft claims in a way to address 3D printing. In a particular case, none of these steps may be best for a client, or some combination may be appropriate. Some of these steps are outlined below.[4]

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[1] Ted Sichelman & Stuart J.H. Graham, *Patenting by Entreprenuers: An Empirical Study,* 17 Mich. Telecomm. & Tech. L. Rev. 111, 173 (2010).

[2] 18 U.S.C. § 1836.

[3] *See generally,* Richard F. Dole, Jr., Identifying the Trade Secrets at Issue in Litigation Under the Uniform Trade Secrets Act and the Federal Defend Trade Secrets Act, 33 Santa Clara High Tech. L.J. 470 (2017)

[4] Practitioners for clients in certain fields have already faced shorter product life cycles, and have adopted practices such as using requests for continued examination, rather than traditional continuation practice, to speed up prosecution. *See generally,* Warren K. Mabey, Jr., *Deconstructing the Patent Application Backlog… a Story of Prolonged Pendency, PCT Pandemonium & Patent Pending Pirates,* 92 J. Pat. & Trademark Off. Soc'y 208 (2010) (discussing backlog generally); Mark A. Lemley & Bhaven Sampat, *Examining Patent Examination,* 2010 Stan. Tech. L. Rev. 2, 28 (2010) (computer and software practitioners much more likely to use RCE rather than continuations).

1. *Use Track One or Other Existing Procedures to Reduce the 25-month Delay*

The USPTO has adopted procedures that, while more expensive than traditional prosecution, rapidly speed up the time to issuance from the typical twenty-five months.[5] There are four potential means to reduce the time to issuance: (1) Track One Prioritized Examination; (2) the Patent Prosecution Highway; (3) the First Action Interview Pilot Program; and (4) Accelerated Examination. [6] Each of these procedures has its own requirements,[7] but they each potentially reduce the twenty-five month delay significantly.

Foremost, the average time for the USPTO to grant a petition to allow a patent application to enter Track One is about six weeks. The time from that point to allowance is just over five months, and so the average pendency is about six and a half months.[8] While it is more expensive, and limited in other ways, Track One is a mechanism that may be needed to obtain meaningful patent protection more frequently in the near future.

2. *Use Existing Procedures to Allow for Recovery of Damages Upon Publication of the Patent Application, Not Only After Issuance of the Patent.*

While ordinarily damages for patent infringement are available only after issuance, Section 154(d) of the Patent Act permits damages for "infringement" occurring before issuance, but only in narrow circumstances. The statute provides:

> [A] patent shall include the right to obtain a reasonable royalty from any person who, during the period beginning on the date of publication of the application . . . and ending on the date the patent is issued–(A)(i) makes, uses, offers for sale, or sells in the United States the invention as claimed in the published patent application or imports such an invention into the United States . . . and (B) had actual notice of the published patent application.[9]

Thus, the three essential requirements for a successful damages claim are that the defendant (1) on or after the date the application is published; (2) infringes "the invention as claimed" in the published application; and (3) had actual notice of the published application. In some

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[5] To be clear, during regular prosecution there are ways to speed up examination, such as by appropriately asking for an examiner interview. [Citation] The focus here is on ways outside of regular prosecution to reduce delay.

[6] Rory P. Pheiffer & Lauren Ingegneri, *Paths to Get a Patent Approved More Quickly,* 27 No. 3 Intell. Prop. & Tech. L.J. 16 (March 2015).

[7] *See id.*

[8] https://www.uspto.gov/corda/dashboards/patents/main.dashxml?CTNAVID=1007 (visited July 13, 2017).

[9] 35 U.S.C. 154(d).

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