



Working with the USPTO

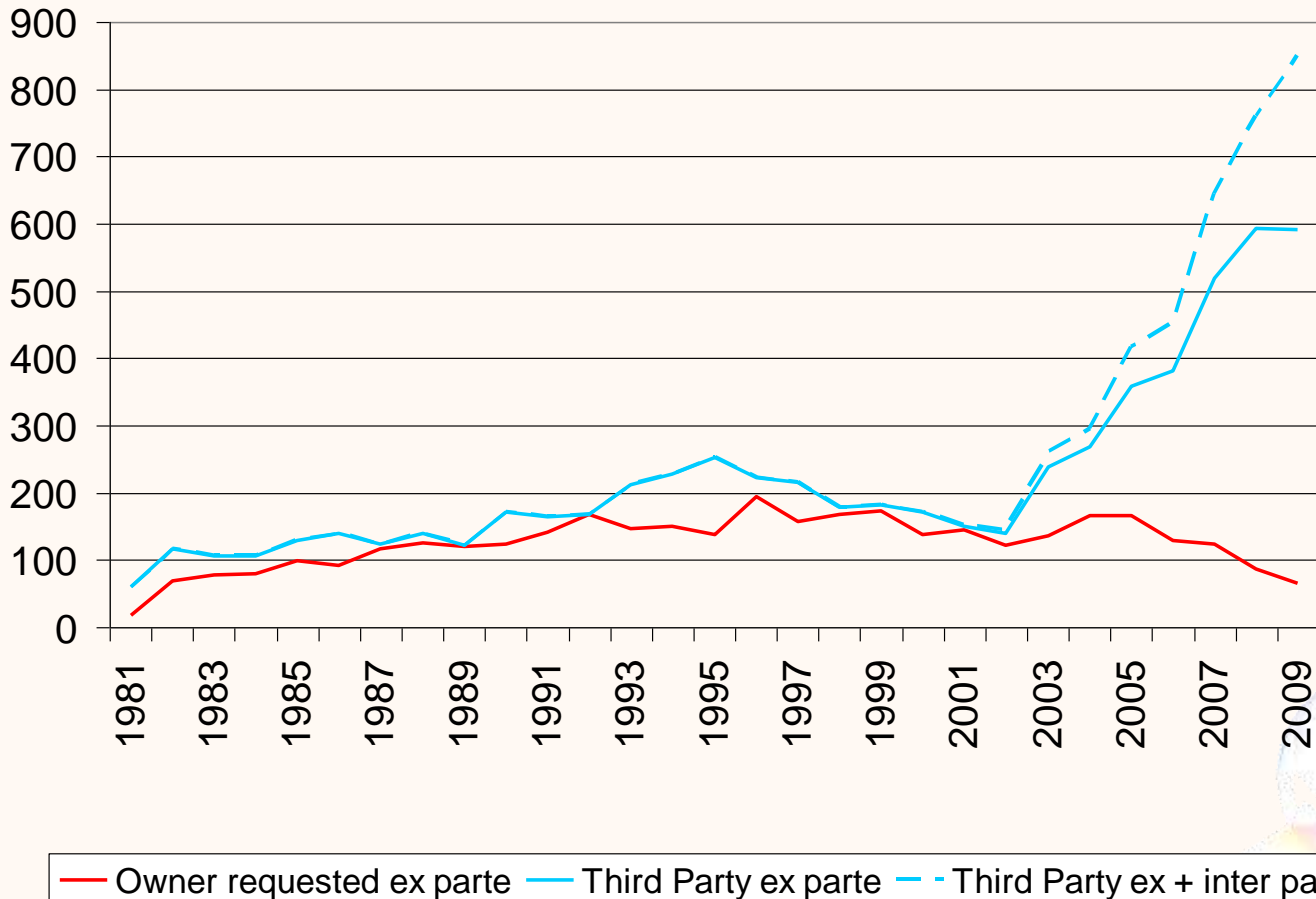
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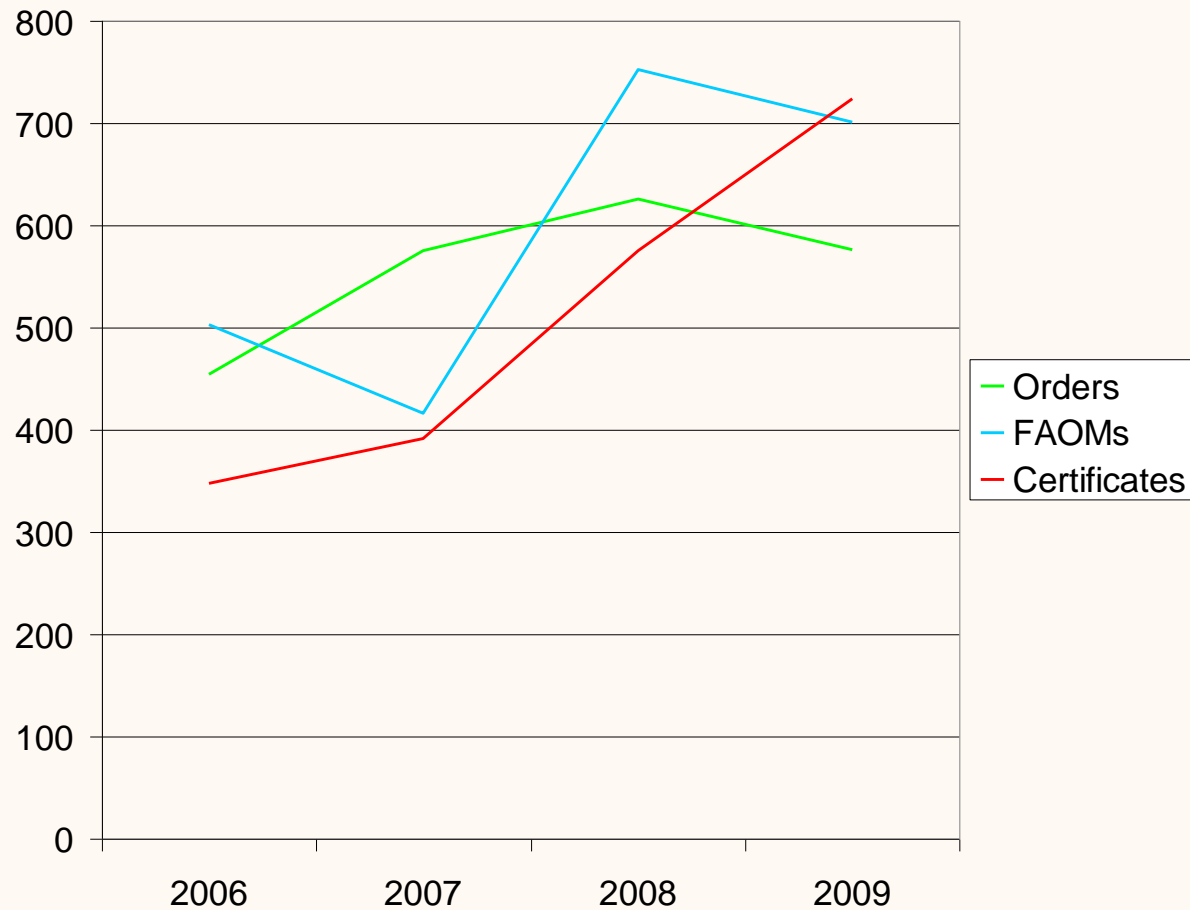
2010 MOBILE VOICE CONFERENCE

Reexamination Filings

Source: USPTO Annual Reports. Excludes Director-ordered reexaminations. 2009 data is preliminary.



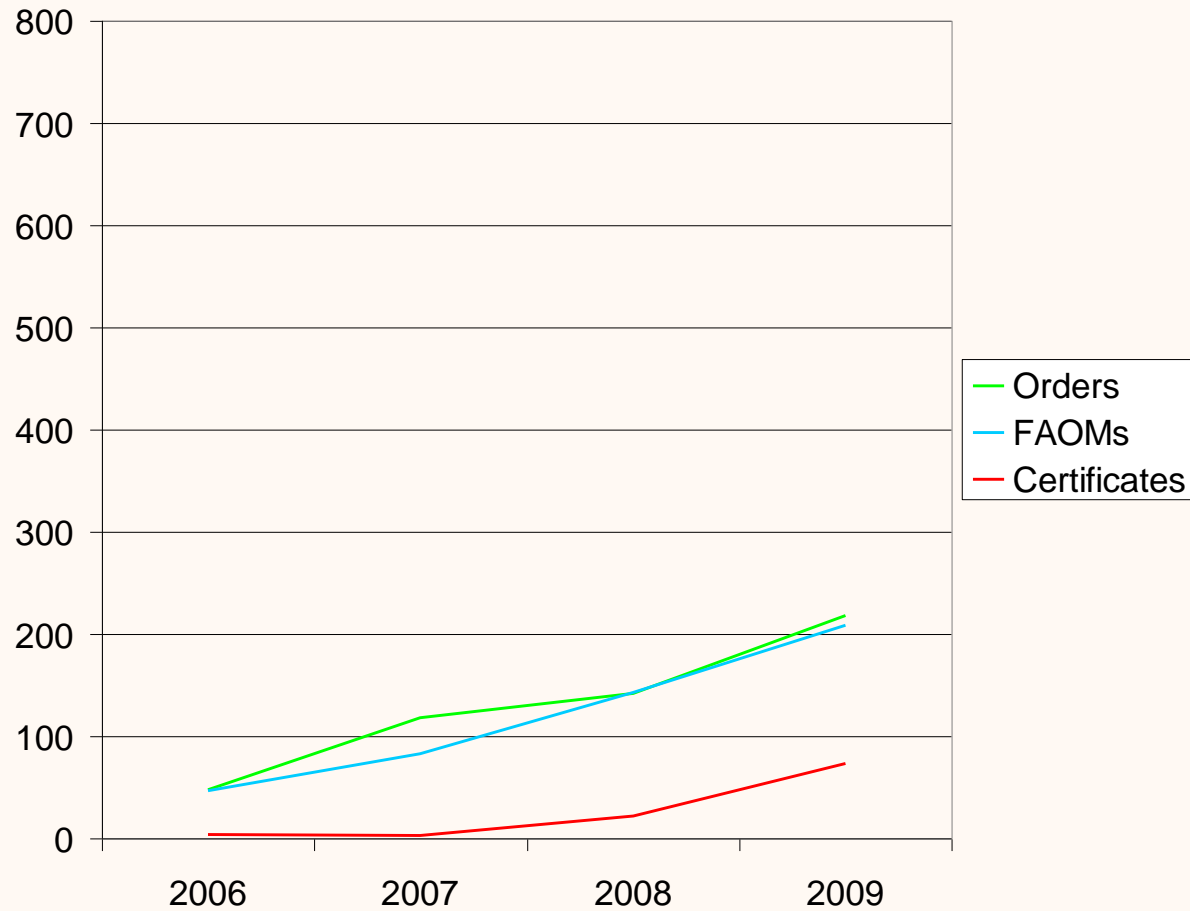
Ex parte Processing



Source:
Reexamination
Operational
Statistics



Inter partes Processing



Source:
Reexamination
Operational
Statistics



Statistical Reports

- *Ex parte* and *inter partes* historical statistics and reexamination operational statistics are available at www.uspto.gov/patents/stats
- Summary of Stats:
 - ◆ Complex cases (those involving multiple patents) take much longer.
 - ◆ Average time to closure is about 37 months.
 - ◆ USPTO required to complete proceedings regardless of settlement of litigating parties.



Reexamination Procedure

- All prior art considered fully on the basis of the request.
- Mere argument that prior art is “cumulative” is not an acceptable rebuttal to an examiner’s rejection.
- Art previously of record can be reconsidered in new light.
- Note, however, effective filing dates; “obviousness” for example is considered as of that point.



Other Re-exam Factors

- USPTO Fees:
 - ◆ *Ex parte*: \$2520
 - ◆ *Inter partes*: \$8800
 - ◆ Likely to increase in the future
- Attorney effort
 - ◆ Re-exams are unusual and legally complex
 - ◆ Costs are commensurate



Examination in General

- Best practices include clear and concise disclosures
- “Background of Invention” section of great value
- Key is to have the best possible prior art before examiner
- Examiner interviews very often lead to speedier process
- Accelerated examination programs
 - ◆ AE program: 12 months to final disposition
 - ◆ First action interview pilot



Peer to Patent Program

- December 2005: Members of academia and the IP community meet with USPTO management to discuss, among other quality initiatives, a Peer Review concept
- USPTO and the New York Law School Institute for Information Law and Policy entered into a cooperative understanding for a framework to allow public input to patent applications on a voluntary basis
- Website implementing Pilot program launched on June 15th, 2007, designating the first 5 applications subject to Peer Review



Peer to Patent Program

- Current Rules Third-party submissions of prior art
- Leverage private sector knowledge base to provide prior art to the Office before patents are granted
- Public Criticism of Patents, Software (e.g., open source)
- Leverage existing technology for collaborative filtering to provide best prior art to the Office
- Provide peer review of applications
- Improve patent quality



Peer to Patent Program

- 2 year pilot accepted its last volunteered application on June 15th, 2009
- Results of pilot will be evaluated by student interns from Worcester Polytechnic Institute began in September
- Evaluation criteria will be developed by USPTO and New York Law School
- Final report due May of 2010



Peer to Patent Program-Next Steps

- Completion of first pilot evaluation
- Expansion expected:
 - ◆ Wireless telecom, including Speech Processing
 - ◆ Life Sciences
 - ◆ BioInformatics
- Enhancements to Program
- Programs in other offices: Japan, Australia, UK
- Exchange of information and procedural aspects



Patent Prosecution Highway

- An international worksharing program you should use
- Claims allowed in an office of first filing will be accelerated in an office of second filing
- Results to date have been significant:
 - ◆ Grant rate in US is twice that of the normal route.
 - ◆ Speedier, less office actions and applicant responses—meaning much less cost
- Program now includes PCT Route cases
- Now—no fees!





Thank You

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