

EXPEDITING PATENT PROSECUTION BY SPECIAL TREATMENT OF APPLICATIONS

By Miku H. Mehta¹

I. INTRODUCTION

To obtain patent protection in the United States, an applicant must file a patent application in the United States Patent and Trademark Office (“PTO”).² Patent applications are normally examined in the order in which they are received.³ As a result of the large volume of patent applications, particularly in some technology areas (“art units”), the time required to reach the final disposition of a patent application can be significant, usually between two and four years. However, certain applications are taken out of order and examined ahead of the other applications in that art unit (“made special”).⁴

This article examines the circumstances under which a patent application may be made special by the PTO, other U.S. government agencies, or the applicant. In the case where an applicant wishes to make their application special, a petition must be filed (“Petition to Make Special”) and certain procedures that deviate from the normal patenting process may need to be followed.⁵ Instances where the PTO or other U.S. government agencies make an application special are discussed in greater detail in Section II. This article also provides an overview of the requirements, as well as the potential costs and benefits of filing a Petition to Make Special.

II. PTO DETERMINATION OF EXAMINATION ORDER

When a non-provisional utility application is filed, the PTO assigns the application to an art unit and an Examiner having expertise in a specific technology area examines the application.⁶ The Examiner normally examines the applications in the order of their effective filing dates.⁷ For Continuation-in-Part (CIP) applications,⁸ the Examiner may examine the application according to either the actual filing date of the CIP or the effective filing date of its parent application.⁹

An application may be made special and examined out of order for various reasons.¹⁰ Examiners must make special certain types of application having a specified status.¹¹ For example, if the head of a federal department believes that an invention is important to the U.S. Government, the patent application may be made special without requiring action by the applicant.¹² Additionally, reissue applications (especially those involved in stayed litigation),¹³

applications remanded by the Board of Appeals, applications that are the subject of interferences,¹⁴ applications in position for allowance pending formalities such as submission of final formal drawings, applications in condition for final rejection, applications with an effective pendency of more than five years,¹⁵ and reexamination proceedings qualify as special.¹⁶

For international applications filed under the Patent Cooperation Treaty (PCT) in which the applicant is entering the National Stage in the PTO,¹⁷ a different procedure is used. If the application satisfies the PCT requirements related to novelty, inventive step and industrial applicability,¹⁸ and the necessary fee has been paid,¹⁹ the National Stage application is eligible to be made special.²⁰

When a patent application has been made special as a result of independent PTO decision or granting of a Petition to Make Special, it is queued ahead of other cases that have not been made special.²¹ Within these types of special cases, there is an order of examination. Reissue and reexamination applications involved in litigation that has been stayed²² receive top priority, followed by special cases having a fixed 30-day due date (*e.g.*, Examiner's Answer to Appeal Brief).²³ The remaining special cases are examined based on their effective U.S. filing date.²⁴

III. APPLICANT'S FILING OF A PETITION TO MAKE SPECIAL

In addition to the above-noted ways for an application to reach special status, an applicant may file a Petition to Make Special.²⁵ Depending on the basis of the petition, the Petition may also require payment of a fee,²⁶ additional supporting documentation, or both.²⁷ A Petition to Make Special becomes part of the prosecution history, along with any correspondence related to that Petition, such as a grant or denial of the Petition.²⁸ The circumstances surrounding Petitions to Make Special are discussed in greater detail below.

A. Business/Strategic Basis

In certain cases, business or strategic considerations may be the basis for filing a Petition to Make Special. If an applicant can show that prospective manufacture will occur only if a patent is granted and a prospective manufacturer is obligated to perform the manufacturing immediately upon allowance, the Petition may be filed with the requisite fee²⁹ (and supporting evidence).³⁰ Additionally, the applicant must conduct a "careful and thorough" search of the prior art, and provide a copy of each reference found in such a search.³¹

A showing of actual infringement by a product or method in the marketplace may also be the basis for a Petition to Make Special.³² The Petition must be accompanied by the requisite

fee,³³ a rigid comparison between the claims of the application and the alleged infringing activity, and a statement that the relevant claims are “unquestionably infringed.”³⁴ Showing only prospective infringement is not sufficient as a basis for granting a Petition to Make Special.³⁵ As is the case for prospective manufacture, the applicant must conduct a prior art search, and provide a copy of each reference found in the search.³⁶

An example of the successful use of actual infringement as a basis for the Petition was its use in securing the “one click” patent for Amazon.com,³⁷ which subsequently obtained an injunction against Barnesandnoble.com for patent infringement³⁸ prior to the holiday season in December of 1999.³⁹ The injunction was subsequently vacated and remanded by the Federal Circuit, but not until well after the 1999 holiday season.⁴⁰

B. Applicant’s Condition

If the applicant is more than 65 years of age⁴¹ or in a state of health such that they might not be available to assist in prosecution of the application under the normal examination procedures,⁴² a Petition to Make Special may be filed without a fee.⁴³ A submission by a medical provider (e.g., doctor’s certificate) to show applicant’s state of health,⁴⁴ or proof of age (e.g., a birth certificate, passport with date of birth, statement from applicant, or both)⁴⁵ must also be submitted with the Petition.

C. Field of the Invention

Additionally, a Petition to Make Special may be based on the technology of the invention. For example, the Petition may be filed for a patent application directed to an invention that (a) materially enhances environmental quality by contributing to restoration or maintenance of basic life-sustaining natural elements,⁴⁶ (b) materially contributes to the discovery/ development and/or utilization and conservation of energy resources,⁴⁷ (c) involves superconductivity materials,⁴⁸ or (d) contributes to countering terrorism.⁴⁹ In these technology areas, the Petition must be accompanied by a statement of the invention’s contributions to those fields.⁵⁰ No petition fee is required.⁵¹

Also, the PTO has determined that patent applications related to the safety of research in recombinant DNA⁵² may be made special, if accompanied by the fee and a statement that demonstrates how the patent application is related to safety in recombinant DNA research.⁵³ Similarly, special status may be granted for Petitions to Make Special for patent applications for

inventions in the fields of HIV/AIDS, or cancer,⁵⁴ with the payment of the required petition fee and a statement explaining how the invention contributes to those fields.⁵⁵

For inventions in the area of biotechnology, a Petition to Make Special may be appropriate if the applicant has small entity status,⁵⁶ the patent application is a major asset of that small entity, and the development of the technology will be significantly impaired by delays in the patent application.⁵⁷ The small entity applicant must pay the petition fee and provide support for those conditions.⁵⁸

D. Special Examining Procedure

In addition to the foregoing bases, an applicant may make an application special by agreeing to an expedited examining procedure and if certain conditions have been met, discussed in greater detail below.⁵⁹ This type of petition must be accompanied by the requisite petition fee.⁶⁰

In order for an application to be eligible for special status under this type of Petition, the application must not yet have been examined by the PTO,⁶¹ and a pre-examination search must be conducted. The details of the search must be provided to the PTO⁶² along with a copy of each reference.⁶³ The search may be conducted by a foreign patent office, applicant, or the PTO.⁶⁴ For example, under 35 U.S.C. § 371, a search report prepared by the PTO as the International Search Authority (ISA) is acceptable.⁶⁵

The Petition must also include a detailed discussion of the references, including how the claimed subject matter is patentable over each of the references.⁶⁶ Further, the claims of the application must all be directed to a single invention, and the applicant must agree to make an election without traverse if the PTO decides that the claims are not directed to a single invention.⁶⁷ The PTO encourages established telephone restriction practice⁶⁸ in such cases. If the applicant refuses to make an election, the petition will be denied, and the application will not be made special.⁶⁹

If a parent application has been made special, divisional applications directed to non-elected inventions will not automatically be given special status and a separate petition would be required for such a divisional application.⁷⁰ However, for continuation applications, the special status carries over to a continuation application of the parent application.⁷¹

If the Petition is defective, the applicant will be given one opportunity to cure the defect.⁷² If the applicant is unable to successfully cure the defect, the petition will be denied.⁷³

Once the petition has been granted, the application is submitted to an accelerated examination procedure. The application is examined before all other categories of applications, except for those applications in condition for allowance or having set time limits, such as providing an Examiner's Answer to an Appeal Brief.⁷⁴ The Examiner will perform a search based only on the claimed subject matter, and issue a first Office Action that includes essential matters of merit.⁷⁵ The Office Action will have a 3-month shortened statutory period for reply.⁷⁶

The applicant's response to the Office Action must be restricted to the Examiner's objections and rejections, in addition to any other requirements set forth by the Examiner.⁷⁷ The applicant may not broaden the claims by amendment.⁷⁸

Throughout the process, the PTO encourages interview practice to expeditiously resolve issues. If an interview is to be conducted, the applicant should provide the Examiner with a draft or a proposal at least one day before the interview.⁷⁹ However, that draft or proposal does not become a part of the file history.⁸⁰

After the applicant has filed their response, the Examiner takes up the case within one month and issues either a final Office Action or a Notice of Allowance.⁸¹ Once allowed, the allowed application will be given top priority for printing,⁸² which may further reduce pendency of the application.⁸³

It is important to correctly include the fee, prior art search results and supporting statements as per the requirements of that category. Applicants should be vigilant in confirming that the PTO is handling their application in accordance with the established application handling procedures.

Once the Petition is granted, the applicant should monitor the status of the Petition with the proper personnel at the art unit in the PTO and work with the Examiner to obtain allowance of the application. Additionally, due to the printing priority, the applicant should carefully review the application as early as possible to prevent errors in the published patent.

IV. Potential benefits and costs of Special Examination

Prior to deciding whether to pursue special prosecution of a patent application, the applicant should consider various costs and benefits associated with the process.

A benefit of filing the Petition to Make Special is the expedited consideration of the application, which may reduce its pendency at the PTO. Because the term of a patent is normally 20 years from its earliest effective filing date,⁸⁴ the benefits associated with having a

patent are extended as the pendency of the application is reduced. In other words, the sooner an applicant's patent is granted, the sooner the applicant may collect royalties or assert the patent against competitors in litigation. Because the Petition to Make Special may be granted in a matter of weeks⁸⁵ or months,⁸⁶ the prosecution of the application is significantly faster compared to normal prosecution.

While the Petition to Make Special can expedite the prosecution of a patent application, there may be disadvantages to making an application special. For example, it may not be quicker to file a Petition to Make Special in art units having a low pendency or short queue, because those art units would have a lower volume of patent applications. Additionally, the time and cost involved in the preparation and filing of the Petition to Make Special should also be weighed.⁸⁷

Additionally, a search and attachment of references is required for some of the categories of a Petition to Make Special. There are several important issues to consider in conducting, disclosing and discussing the prior art search for the Petition. For example, discussing the prior art search and the patentability of the claims over the prior art poses a potential problem if the patent becomes the subject of litigation. Since the petition and any further correspondences are part of the prosecution history,⁸⁸ they may be used by the courts to interpret and potentially limit the scope of the claims. Applicants and practitioners should also be aware of the inequitable conduct issues posed by Petitions to Make Special, as discussed with respect to the search, which may result in the invalidation of a patent.⁸⁹

It is noted that the aforementioned searches should be conducted by a private search firm or foreign/international patent office. However, a search is not considered to be sufficient if an applicant or their representatives merely search their own files or query various experts in the field as to whether they are aware of pertinent prior art. Courts have found such efforts to be inequitable conduct resulting in the invalidation of those patents and disciplinary action by the PTO for registered practitioners.

There are also various issues associated with making an application special under the accelerated examination procedure discussed in Section III.D above. For example, the applicant may not traverse an Election of Species requirement.⁹⁰ As a result, if the applicant is required to file a divisional application, they may want to do so with the immediate filing of a Petition to

Make Special since the term of the patent issued in the divisional application would run from the effective filing date of the parent application.

Additionally, under the accelerated examination procedure of MPEP 708.02(VIII), the applicant is restricted to the scope of the broadest claim submitted at the time of application.⁹¹ Therefore, it is incumbent upon the applicant and practitioner to carefully review the scope of the claims, and ensure that they sufficiently broad, and include sufficient detail in the dependent and narrower independent claims. Furthermore, the application and practitioner must act as quickly as possible to prepare and file a Petition because the Petition to Make Special under MPEP 708.02(VIII) can only be used for a new application not yet examined.⁹² If the Examiner examines the application in normal order, the Petition would not meet the conditions and would likely be denied. It may be advisable, however, to wait until the application has been assigned a serial number, so that the Petition can be matched with the application more quickly.⁹³

IV. CONCLUSION

United States Patent practice enables an application to be examined faster, if the application falls into at least one of the special categories. Certain categories are determined by the PTO, whereas other categories require the filing of a Petition to Make Special by the applicant.

In determining whether to file a Petition to Make Special, the applicant must consider the potential costs of special practice, such as the potential effects of prosecution history estoppel. Other risks and additional costs of the Petition should also be considered. However, those costs must be weighed against the clear benefits of obtaining expedited allowance of an application.

¹ Mr. Miku H. Mehta is a patent attorney and has been an Associate in the Washington, D.C. office of SUGHRUE MION, PLLC since July 2000.

² 35 U.S.C. § 1.111(a) (2000).

³ *Manual of Patent Examining Procedure* § 708 (original 8th ed. 2001) [hereinafter *MPEP*].

⁴ 37 C.F.R. § 1.102 (2002).

⁵ 37 C.F.R. § 1.102(c)-(d) (2002).

⁶ *MPEP* § 708.

⁷ *MPEP* § 708; 82 J. PAT. & TRADEMARK OFF. SOC'Y 467 (July 2000).

⁸ 37 C.F.R. § 1.53(b) (2002); *MPEP* § 201.08.

⁹ *MPEP* § 708.

¹⁰ 37 C.F.R. § 1.102 (2002).

¹¹ 37 C.F.R. § 1.102(b) (2002).

- ¹² *MPEP* § 708.01(A).
- ¹³ 37 C.F.R. § 1.176 (2002).
- ¹⁴ *MPEP* § 2300.
- ¹⁵ *MPEP* § 707.02.
- ¹⁶ *MPEP* § 708.01.
- ¹⁷ 35 U.S.C. § 371(f) (2000); 37 C.F.R. § 1.9(a) (2002); *MPEP* § 1893.
- ¹⁸ PCT Art. 33(1)-(4).
- ¹⁹ 37 C.F.R. § 1.492(a)(4) (2002).
- ²⁰ 37 C.F.R. § 1.496(a)-(b) (2002); *MPEP* § 1893.03.
- ²¹ 37 C.F.R. § 1.102(a) (2002); *MPEP* § 708.
- ²² *MPEP* §§ 1442.03, 2261.
- ²³ *MPEP* § 708.
- ²⁴ *MPEP* § 708.
- ²⁵ 37 C.F.R. § 1.102(c)-(d) (2002).
- ²⁶ 37 C.F.R. §§ 1.102(d), 1.17(h) (2002).
- ²⁷ 37 C.F.R. § 1.102(c)-(d) (2002); *MPEP* § 708.02.
- ²⁸ *MPEP* § 708.02.
- ²⁹ 37 C.F.R. § 1.17(h) (2002). The fee is currently \$130.00. *Id.*
- ³⁰ *MPEP* § 708.02(I).
- ³¹ *MPEP* § 708.02(I).
- ³² *MPEP* § 708.02(II).
- ³³ 37 C.F.R. §§ 1.102(d), 1.17(h) (2002).
- ³⁴ *MPEP* § 708.02(II).
- ³⁵ D.C. Toedt III, “Accelerating the Examination of a U.S. Patent Application at www.lawnotes.com/patent/accel/html (January 6, 2000).
- ³⁶ *MPEP* § 708.02(II).
- ³⁷ U.S. Patent No. 5,960,411 (issued Sept. 28, 1999).
- ³⁸ *Amazon.com v. Barnesandnoble.com*, 73 F. Supp. 2d 1228,1249 (W.D. Wash. 1999).
- ³⁹ Robert R. Sachs, “Tips, Tricks and Strategies for Getting Your Patent Rights Right Away,” *Intellectual Property Bulletin*, Summer 2000, at http://www.fenwick.com/pub/ip_pubs/IP_Bulletin_Summer_2000/ip_bulletin_summer_2000.htm#tips.
- ⁴⁰ *Amazon.com v. Barnesandnoble.com*, 239 F.3d 1343, 1347 (Fed. Cir. 2001).
- ⁴¹ *MPEP* § 708.02(IV).
- ⁴² *MPEP* § 708.02(III).
- ⁴³ 37 C.F.R. § 1.102(c) (2002).
- ⁴⁴ *MPEP* § 708.02(III).
- ⁴⁵ *MPEP* § 708.02(IV).
- ⁴⁶ 37 C.F.R. § 1.102(c) (2002); *MPEP* § 708.02 (V).
- ⁴⁷ 37 C.F.R. § 1.102(c) (2002); *MPEP* § 708.02 (VI).
- ⁴⁸ *MPEP* § 708.02 (IX)

- ⁴⁹ 37 C.F.R. § 1.102(c) (2004); *MPEP* § 708.08 (XI).
- ⁵⁰ 37 C.F.R. § 1.102(c) (2002); *MPEP* § 708.08 (V), (VI), (IX).
- ⁵¹ 37 C.F.R. § 1.102(c) (2002); *MPEP* § 708.08 (V), (VI), (IX).
- ⁵² *MPEP* § 708.02(VII).
- ⁵³ 37 C.F.R. §§ 1.102(d), 1.17(h) (2002); *MPEP* § 708.02(VII).
- ⁵⁴ *MPEP* § 708.02(X).
- ⁵⁵ 37 C.F.R. §§ 1.102(d), 1.17(h) (2002); *MPEP* § 708.02(X)-(XI).
- ⁵⁶ 37 C.F.R. § 1.27(a) (2002); *MPEP* § 509.02-03.
- ⁵⁷ *MPEP* § 708.02(XII).
- ⁵⁸ 37 C.F.R. §§ 1.102(d), 1.17(h) (2002); *MPEP* § 708.02(XII).
- ⁵⁹ *MPEP* § 708.02 (VIII).
- ⁶⁰ 37 C.F.R. §§ 1.102(d); 1.17(h) (2002); *MPEP* § 708.02 (VIII).
- ⁶¹ *MPEP* § 708.02 (VIII).
- ⁶² Including a listing of classes and subclasses searched, Examiners contacted, etc.
- ⁶³ *MPEP* § 708.02 (VIII).
- ⁶⁴ 82 J. PAT. & TRADEMARK OFF. SOC'Y 467 (July 2000).
- ⁶⁵ 82 J. PAT. & TRADEMARK OFF. SOC'Y 467 (July 2000).
- ⁶⁶ *MPEP* § 708.02 (VIII).
- ⁶⁷ *MPEP* § 708.02 (VIII).
- ⁶⁸ *MPEP* § 812.01.
- ⁶⁹ *MPEP* § 708.02 (VIII).
- ⁷⁰ *MPEP* § 708.02 (VIII).
- ⁷¹ *MPEP* § 708.02 (VIII); 82 J. PAT. & TRADEMARK OFF. SOC'Y 467 (July 2000).
- ⁷² *MPEP* § 708.02 (VIII).
- ⁷³ *MPEP* § 708.02 (VIII).
- ⁷⁴ *MPEP* § 708.02 (VIII).
- ⁷⁵ *MPEP* § 708.02 (VIII).
- ⁷⁶ 37 C.F.R. § 1.136; *MPEP* §§ 710.02, 708.02 (VIII).
- ⁷⁷ *MPEP* § 708.02 (VIII).
- ⁷⁸ *MPEP* § 708.02 (VIII).
- ⁷⁹ *MPEP* § 708.02 (VIII).
- ⁸⁰ *MPEP* § 708.02 (VIII).
- ⁸¹ *MPEP* § 708.02 (VIII).
- ⁸² *MPEP* §§ 708.02 (VIII), 1309.
- ⁸³ D.C. Toedt III, "Accelerating the Examination of a U.S. Patent Application at www.lawnotes.com/patent/accel/html (January 6, 2000).
- ⁸⁴ 35 U.S.C. §§ 154-156 (2000).
- ⁸⁵ Robert W. Harris, "Patent Office Fast Tracks Seniors' Applications," *Albuquerque Journal*, August 19, 2002 at www.abqjournal.com/health/mature/755078fun08-19-02.htm.
- ⁸⁶ Results of survey of various practitioners at SUGHRUE MION, PLLC, February 2003.

⁸⁷ D.C. Toedt III, “Accelerating the Examination of a U.S. Patent Application at www.lawnotes.com/patent/accel/html (January 6, 2000).

⁸⁸ *MPEP* § 708.02 (VIII).

⁸⁹ *General Electro Music Corp v. Samick Music Corp.*, 19 F.3d 1405, 1408-12 (Fed. Cir. 1994); *GFI, Inc. v. Franklin Corp.*, 88 F. Supp. 2d 619 (N.D. Miss. 2000).

⁹⁰ *MPEP* § 708.02 (VIII).

⁹¹ *MPEP* § 708.02 (VIII).

⁹² *MPEP* § 708.02 (VIII).

⁹³ Robert R. Sachs, “Tips, Tricks and Strategies for Getting Your Patent Rights Right Away,” *Intellectual Property Bulletin*, Summer 2000, at http://www.fenwick.com/pub/ip_pubs/IP_Bulletin_Summer_2000/ip_bulletin_summer_2000.htm#tips.