Navigating the Patent Prosecution Highway and Other Accelerated Filing Options

Evaluating the Different Options, Weighing the Benefits and Risks, Obtaining Patent Protection

THURSDAY, AUGUST 31, 2017

1pm Eastern   |   12pm Central   |   11am Mountain   |   10am Pacific

Today’s faculty features:

Ralph G. Fischer, Shareholder, Buchanan Ingersoll & Rooney, Pittsburgh

Duane A. Stewart, III, Shareholder, Buchanan Ingersoll & Rooney, Pittsburgh

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Navigating the Patent Prosecution Highway and Other Accelerated Filing Options

Evaluating the Different Options, Weighing the Benefits and Risks, Obtaining Patent Protection

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Overview

Expedite Prosecution
- Prioritized Examination – “Track-1”
- Patent Prosecution Highway (PPH)
- Petition to Make Special
- “Patents 4 Patients”
- Accelerated Examination
- Full First Action Interview Pilot
- AFCP 2.0 – Amendments After Final
- Pre-Appeal Brief Review
- AFIDS – QPIDS – IDSs After Issue Fee
- Collaborative Search Pilot (CSP)
- Expedited Design Examination
- Ombudsman Program

Slow Prosecution
- Withholding fees from initial filing
- R.53(b) continuations
- Supplemental Amendments
- Shortened Statutory Period, Extensions and Patent Term Adjustment
Prioritized Examination (Track 1)

Purpose: Gain Special status with fewer requirements than accelerated examination (no pre-examination search). Goal is to provide final disposition within 12 months.

Requirements:
- Pay Fee at the time of filing ($4,000/$2,000/$1,000).
- File form PTO/SB/424
- No more than 4 independent claims, 30 total.
- Utility - must be filed using EFS-Web. Plant - must be filed in paper.
- The request for prioritized examination must be present on filing of the utility or plant application. Can pay for 1 prioritized RCE.

Pros/Cons: Quicker disposition, prosecution turnaround about 3 months, but expensive, unnecessary in areas with short backlogs, 10,000 annual limit.
Prioritized Examination (Track 1)

The prioritized examination program grants special status until one of the following occurs:

- i. Applicant files a petition for extension of time to extend the time period for filing a reply.
- ii. Applicant files an amendment to amend the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.
- iii. Applicant subsequently files a request for continued examination (RCE).
- iv. Applicant files a notice of appeal.
- v. Applicant files a request for suspension of action.
- vi. A notice of allowance is mailed.
- vii. A final Office action is mailed.
- viii. The application is abandoned.
- ix. Examination is completed as defined in 37 CFR 41.102.
Prioritized Examination (Track 1)

- Total Through July 2017: 5352
Prioritized Examination (RCE)

May be filed with an RCE or after the RCE is filed, as long as filing is prior to first action following RCE.

Fees are the same as Track One.

Allows applicants to continue to prioritize examination even after an RCE is filed, but only for the first RCE.
Prioritized Examination

Form SB0424
http://www.uspto.gov/forms/sb0424.pdf

For more information:
http://www.uspto.gov/patent/initiatives/usptos-prioritized-patent-examination-program
Patent Prosecution Highway (PPH)

Purpose: To avoid duplication of work from different Patent Offices, increase efficiency, reduce pendency and costs.

Requirements: Obtain favorable decision on application filed in an Office of Earlier Examination. Then file PPH request for accelerated examination in Office of Later Examination.

There are multiple eligible OEE’s and PPH program continues to expand.
PPH

Pros:
- Lowers Prosecution Costs
- Applicant can select preferred offices.
- Begins to Unify Coverage
- Reduces Search and Examination Burden on patent offices

Cons:
- Potentially limited claims in first U.S. patent application
PPH Programs Exist in many countries including:

- Australia
- Canada
- China
- Denmark
- EPO
- Japan
- Mexico
- Russia
- South Korea
- United States

Full list for US applicable PPH programs can be found at:
http://www.uspto.gov/patents/init_events/pph/index.jsp
PPH Process Overview

- Earliest Filing
- First Office Examination
- Allowance
- PPH Filing
- Allowed Claims
- Later Office Examination (OLE)
- Second Office Examination
PPH Request

- After obtaining a favorable allowability finding in one corresponding application
  - Submit a Request prior to substantive examination of application:
    - Request Form
    - Amend claims in application to provide same scope as claims found allowable in corresponding application
    - Documents necessary to show allowability finding from corresponding application (e.g. office actions, amendments, and claim correspondence chart comparing claims found allowable and pending claims to show they have same scope or narrower scope)
    - In U.S, must submit an IDS including documents cited in work product indicating patentable subject matter exists (including English translations if necessary).
    - No fee for filing the request in the U.S.
PPH Options

- PPH – Bilateral Agreement Based
  - Uses national work product from a qualifying office
  - Search, opinion, allowance
  - Work product from foreign office of first filing (OFF) may be used in USPTO subsequent filing to expedite examination in the OSF

- Global PPH/IP5 PPH
  - Uses an “Office of Earlier Examination (OEE)” and “Office of Later Examination (OLE)” framework
  - Earlier Allowance Work product includes international stage work product (Search/written opinion,(e.g. IPER, IPRP) or foreign patent office work product)
  - Work product may be used in prior or later filed national application as well as the national stage applications
Claim Correspondence Requirements

- Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format,
  - Bilateral Agreement PPH Programs
    - Can require the claims in the USPTO to be of the same or similar scope as the claims in the foreign patent office
  - Global/IP5 PPH
    - the claims are of the same or similar scope or the claims in the OLE are narrower in scope than the claims in the OEE
Claim Correspondence Requirements

- Claim language may differ to account for differences due to translations and claim format requirements
  - U.S. examiners should allow a claim to be presented in the U.S. application that does not match word-for-word with the previously examined claim
    - Ex. Multiple dependent claims that were previously examined do not need to be in multiple dependent form in the U.S.
- Preliminary amendment with your request can provide basis for claim correspondence
Claim Correspondence Requirements

- During Prosecution – ensure claims are closest to exact language of previously examined and indicated as allowable claims
- Include a new claims correspondence table if file amendment to further amend claims during prosecution
- If claim correspondence cannot be maintained, a continuation must be filed and application is no longer in PPH
Selection of an ISA

- Speed of Examination
- Access to Prior Art Documents
- Types of Claims that are Examined
- **PPH Global/IP5**
  - Currently, 25 total countries including: Australia, Austria, Canada, China, Colombia, Denmark, EPO, Finland, Germany, Hungary, Iceland, Israel, Japan, Nordic Patent Institute, Norway, Poland, Portugal, Russia, S. Korea, Singapore, Spain, Sweden, and UK

- **Bilateral Agreements**
  - Argentina, Brazil, Czech Republic, Mexico, Philippines, Romania, Taiwan
Dedicated USPTO PPH web page (http://www.uspto.gov/patents/init_events/pph/index.jsp) including links to:

- PPH informational video
- FAQs, brochures, press releases, etc.
- Contact information and e-mail question box
- PPH information portal site with statistics and other information from all participating offices (http://www.jpo.go.jp/cgi/linke.cgi?url=/ppph-portal/index.htm)
PPH Prosecution Proficiency

- Allowance rates (cumulative)
  - PPH – 81.6%
  - Non PPH – currently 68.5%

- Prosecution Related Stats
  - PPH First Action Allowances – 21.8%
  - On average, wait 7 mos. For prosecution to start after PPH request is submitted
  - Avg. number of office actions – 2.98
Patent Prosecution Highway (PPH)

For more information:
http://www.uspto.gov/patents/init_events/pph/index.jsp
http://www.jpo.go.jp
Accelerated Examination

Purpose: Accelerate the prosecution of an application that is important to Applicant or government. Goal is to complete examination within 12 months of filing date.

Requirements:

- Must be filed via EFS-Web with a petition to make special with (a) required $130 petition fee or (b) a statement that it is directed to environmental quality, development or conservation of energy resources, or counter terrorism, File form PTO/SB/28.
- Limited to 3 independent claims, 20 total. Directed to single invention.
- Petition must include a statement agreeing to have an interview.
- Pre-examination Search and Accelerated Examination Support Document (AESD) and statement that search meets requirements.
- Application must be complete and ready for examination.
Accelerated Examination

Requirements for Pre-examination Search:

- Classified Class/subclass search where the claimed invention is most likely to be classified and other highly relevant classes.
- Text search of the US patents and published patent applications that covers the subject matter of the independent claims using terms recognized in the art given their broadest reasonable interpretation.
- Text search of foreign patents that includes sources required under the PCT min doc req. http://www.wipo.int/standards/en/part_04.html
- Search with any special tools (e.g., nucleic acid or protein sequence searching tools) as identified in the USPTO search templates.
Accelerated Examination

Requirements for Accelerated Examination Support Document (AESD):

- Information Disclosure Statement (IDS) citing references relevant to the claims. Use Form 1449.
- For each reference cited, must include all claim limitations disclosed by the reference specifying where the limitation is disclosed in the cited reference. Analogous to Examiner’s office Action.
- Explanation of how each claim is patentable over the references with the particularity required by 37 CFR 1.111(b) and (c). General statements will not be acceptable.
- Statement of invention’s utility as defined in each of the independent claims.
- Showing of support in the specification for each claim limitation under 35 U.S.C. 112, 1st paragraph, and each means-plus-function element that invokes 35 U.S.C. 112, Sec. 6; and (2) the corresponding structure.
- Identify any disqualified prior art under 35 U.S.C. 103(c).
Accelerated Examination

Pros:
- Less expensive than prioritized prosecution (but note attorney fees are substantively higher due to search and AESD documentation)
- Stronger, more focused claims (drafted in view of search)
- Prosecution turnaround about 1 month, no annual limit
- Retains Special Status, e.g. after RCE or reopening after appeal

Cons:
- A lot work! Provide search, rejection, and remarks against Rej. etc.
- Time it takes to prepare search and work in view of first to file rule
- If petition is denied, statements/search remain on the record
- Statements/search will likely be used by any opposing counsel
- No withdrawal of Special status, claims likely start more narrow
Accelerated Examination

Form SB/28
http://www.uspto.gov/web/forms/sb0028_fill.pdf

For more information:
http://www.uspto.gov/patent/initiatives/accelerated-examination
### Accelerated Examination

#### AE Petition Status

<table>
<thead>
<tr>
<th>Petition Status</th>
<th>Number of Applications</th>
<th>Percentage</th>
</tr>
</thead>
<tbody>
<tr>
<td>Granted</td>
<td>3175</td>
<td>61.2%</td>
</tr>
<tr>
<td>Denied (Not Meeting Formal Requirements, such as application not being complete upon filing)</td>
<td>876</td>
<td>16.9%</td>
</tr>
<tr>
<td>Denied (Based on Merits)</td>
<td>405</td>
<td>7.8%</td>
</tr>
<tr>
<td>Dismissed (No response from Applicant - Applicant could have cured, but chose not to attempt)</td>
<td>343</td>
<td>6.6%</td>
</tr>
<tr>
<td>Pending (Undecided)</td>
<td>328</td>
<td>6.3%</td>
</tr>
<tr>
<td>Express Abandonments</td>
<td>58</td>
<td>1.1%</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>5185</strong></td>
<td></td>
</tr>
</tbody>
</table>

#### First Office Actions

<table>
<thead>
<tr>
<th>First Office Actions</th>
<th>Number of Applications</th>
<th>Percentage</th>
</tr>
</thead>
<tbody>
<tr>
<td>Rejection</td>
<td>1753</td>
<td>55.2%</td>
</tr>
<tr>
<td>Ex parte Guayle</td>
<td>6</td>
<td>0.2%</td>
</tr>
<tr>
<td>Allowed</td>
<td>1352</td>
<td>42.6%</td>
</tr>
<tr>
<td>Abandoned before first action</td>
<td>6</td>
<td>0.2%</td>
</tr>
<tr>
<td>Pending</td>
<td>58</td>
<td>1.8%</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>3175</strong></td>
<td></td>
</tr>
</tbody>
</table>

#### AE Final Disposition (as defined in the Fed. Reg. Notice)

<table>
<thead>
<tr>
<th>AE Final Disposition</th>
<th>Number of Applications</th>
<th>Percentage</th>
</tr>
</thead>
<tbody>
<tr>
<td>Allowed</td>
<td>1948</td>
<td></td>
</tr>
<tr>
<td>Abandoned</td>
<td>115</td>
<td></td>
</tr>
<tr>
<td>Final Rejection</td>
<td>983</td>
<td></td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>3046</strong></td>
<td>95.9%</td>
</tr>
<tr>
<td>Pending Final Disposition</td>
<td>129</td>
<td>4.1%</td>
</tr>
</tbody>
</table>
Petition to Make Special Based on Age

Purpose: Advance Applications out of turn for older inventors.

Requirements: Petition must set forth the age of an inventor is 65+

It is a simple, one page form petition – SB/130

Petition Based on Health Is Similar, but requires more proof
Petition to Make Special

Other grounds for petitioning to make special exist.

These other grounds (not age/health related and not PPH/track 1 related) fall under Form SB/28 and the accelerated examination process.

For more information:
http://www.uspto.gov/web/offices/pac/mpep/s708.html
First Action Interview

Overview:

- Obtain first action interview prior to the first Office action on the merits. Buys an extra bite at the apple during first round of prosecution. Goal is to reduce pendency and expedite prosecution.
- Examiner will conduct a search and provide applicant with a condensed pre-interview communication (mini Office Action) citing relevant prior art and proposed rejections.
- Within 30 days of receipt, applicant schedules an interview and submits arguments/amendments.
- At the interview, prior art, proposed rejections, amendments and arguments will be discussed. If agreement is not reached, the applicant will receive a first action interview Office action that includes an interview summary that constitutes a first Office action on the merits under 35 USC 132.
First Action Interview

Requirements:

- No additional Fee, but cases not taken out of turn.
- Must be a Utility application. No limit to technology type.
- Request must be submitted at least one day before a first Office action on the merits of the application appears in the Patent Application Information Retrieval (PAIR) system.
- Limited to 3 independent claims, 20 total.
- Must be filed via EFS-Web.
- Request must include statement agreeing to not file a request for refund of search fee or any excess claims fees paid after mailing or notification of Pre-Interview Communication.
- Applicant Initiated Interview Request Form (PTOL-413A)
# First Action Interview Pilot Program

## Pre-Interview Communication

<table>
<thead>
<tr>
<th>Application No.</th>
<th>Examiner</th>
<th>Art Unit</th>
<th>Page 1 of 2</th>
</tr>
</thead>
<tbody>
<tr>
<td>XXXXXXXX</td>
<td>XXXXXXXX</td>
<td>XXXXXXX</td>
<td></td>
</tr>
</tbody>
</table>

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### Disposition of Claims

3. [ ] Claims 1, 3-14 are pending in the application.

3a. Of the above claim(s) ______ is/are withdrawn from consideration.

4. [ ] Claims 1-14 are allowed.

5. [ ] Claims 1-14 are rejected.

6. [ ] Claim(s) are objected to.

7. [ ] Claim(s) are subject to restriction and/or election requirement.

### Application Papers

8. [ ] The specification is objected to by the Examiner.

9. [ ] The drawing(s) filed on ______ are accepted or objected to by the Examiner.

10. [ ] The oath or declaration is accepted by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119


   a. [ ] All [ ] Some [ ] None of.

   1. [ ] Certified copies of the priority documents have been received.

   2. [ ] Certified copies of the priority documents have been received in Application No. ______.

   [ ] Collateral copies of the priority documents have been received in this National Stage application from the International Bureau (PTO Rule 17.2(a)).

[ ] See the attached detailed Office action for a list of the certified copies not received.

### Contact Information

- Examiner's Telephone Number: (571) 272-XXXXX
- Examiner's Typical Work Schedule: Monday-Friday, 8 a.m. - 4:30 p.m.
- Supervisor's Name: Supervisor XXXXX
- Supervisor's Telephone Number: (571) 272-XXXXX

### Attachment(s)

1. [ ] Notice of Allowable Claims (PTO-150)

2. [ ] Notice of Draftsperson's Patent Drawing Review (PTO-948)

3. [ ] Information Disclosure Statement(s) (PTO-1449)

4. [ ] Terminal Drawing(s) (PTO-1449)

5. [ ] Notice of Pre-Academic Filing Date

### Explanations of Rejection(s) and/or Objection(s)

<table>
<thead>
<tr>
<th>#</th>
<th>Claim(s)</th>
<th>Reference(s) (If applicable)</th>
<th>Rejection Statutory Basis</th>
<th>Brief Explanation or Rejection</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>1</td>
<td>U,V</td>
<td>103(a)</td>
<td>Reference U discloses claim 1 (see p. 3 lines 35-45 for the grid network, see p. 1 lines 11-21 for the grid manager) except for “to respond to determining that there are no available (see continuation below).”</td>
</tr>
<tr>
<td>2</td>
<td>2, 4-7, 8-13</td>
<td>U,V</td>
<td>103(a)</td>
<td>Building on the rejection of claim 1, U discloses claim 2 (see p. 3 line 35-15), claim 3 (see p. 4, section 3.2), claim 4 (see p. 3 line 35-15), claim 5 (see p. 3, section 3.2) claims 6, 7, and 10-15 (see p. 3, section 5.3), and claim 20 (see p. 4, section 5.3).</td>
</tr>
<tr>
<td>3</td>
<td>3</td>
<td>U,V,W</td>
<td>103(a)</td>
<td>U and V do not disclose the plurality of computing devices to a single management system. V discloses this at p. 2. It would have been obvious to a person skilled in the art to use V’s basic grid system with the combined system of U and V in order to adapt easily, see continuation.</td>
</tr>
<tr>
<td>4</td>
<td>8</td>
<td>U,V</td>
<td>103(a)</td>
<td>U does not disclose the network to the grid. V discloses this at p. 2. It would have been obvious to a person skilled in the art to use V’s basic grid system with the combined system of U and V in order to adapt easily, see continuation.</td>
</tr>
<tr>
<td>5</td>
<td>14</td>
<td>U,V,W</td>
<td>103(a)</td>
<td>Reference U and V disclose the limitations of claims 14 and 22 (see p. 3 lines 35-45 for the grid network, see p. 4 lines 1-15) for the grid manager and the limitations of using JAVA see continuation.</td>
</tr>
</tbody>
</table>

### Expanded Discussion/Commentary

1. [ ] Computing devices having the specific operating system. Reference V discloses this limitation at p. 3 lines 25-30. It would have been obvious to use reference V’s algorithm with reference U’s customer base to make a suitable collection of resources that meet a user’s needs (reference V, p. 3 lines 33-37).

2. [ ] - note that 6.4 teaches that a RAM or any extra known memory may be used, thus covering claims 10-13.

3. [ ] operate efficiently, and manage complexity (see reference W, p. 2).

4. [ ] W discloses this limitation at p. 3 lines 32-33. One would want to utilize the platform-independent characteristics of JAVA programming language in the network of U as it allows for system compatibility across a wide range of systems, giving greater flexibility to the network designer.

Note: claim 11 is objected to under Rule 71(b) for failing to have proper antecedence for “said computing system.”

**DATE:**

**Examiner Signature:**

**Primary Examiner Signature:**
First Action Interview

Pros:

- Effectively buys an extra bite at the apple during first round of prosecution with No Additional Fee.
- Reduce pendency and expedite prosecution by addressing potential issues early and in a collaborative manner between the Applicant and Examiner.
- First Action Allowance rate is currently about 29.4%

Cons:

- Unintended consequences: Examiners disfavor the program, unusual for the Examiner to perform, incentives for the Examiner are not aligned, Examiner must produce a substantially full Office Action and conduct interview without receiving a full count.
- Any agreement or indication of allowability during the interview can be rescinded upon further consideration by the Office.
- Not taken out of turn.
First Action Interview

Forms:
- Request For First Action Interview (Pilot Program)
- Applicant Initiated Interview Request Form (PTOL-413A)
- First Action Interview Pre-Interview Communication
- First Action Interview Office Action Summary

For more information:
AFCP 2.0

After Final Consideration Pilot 2.0

Purpose: Provides additional time for Examiner to search and/or consider responses after final rejection;

Examiner to conduct an interview to discuss the results of search and/or consideration if Amendment does not place application in condition for allowance.
AFCP 2.0

Requirements:
- Filed by September 30, 2017;
- Uses Form sb0434.pdf;
- Submitted with non-broadening amendment to at least one indep. claim;
- Filed via EFS-Web;
- All normal fees paid.
AFCP 2.0

Pros/Cons:

- Gives the Examiner up to 3 hours non-production time;
- Examiner must initiate interview if answer is “no”;
- At discretion of Examiner to consider submission (considering 3 hour window).
AFCP 2.0

Form PTO/SB/434

http://www.uspto.gov/forms/sb0434.pdf

For more information:

http://www.uspto.gov/patents/init_events/afcp.jsp
Quick Path Information Disclosure Statement (QPIDS) pilot program - Extended to 9/30/2017

Purpose: Eliminate need for RCE to gain consideration of an IDS filed after payment of the issue fee – if art does require reopening prosecution, a corrected notice of allowability is to issue.
QPIDS

Requirements:
(1) Request filed through 9/30/2017 with no accompanying amendments;
(2) After Issue Fee paid;
(3) Certification under 1.97(e)(1) or (2);
(4) Petition to Withdraw from Issuance and “conditional” RCE (with fees authorization to charge fees), which will be denied/not entered if art does not require reopening; and
(5) filed via EFS-Web.

Pros/Cons: Conditionally avoids RCE/No downside seen.
QPIDS

Form SB/09

http://www.uspto.gov/forms/sb0009.pdf

For more information:

http://www.uspto.gov/patent/initiatives/quick-path-information-disclosure-statement-qpids
Patents 4 Patients (Cancer Immunotherapy Pilot)

- File by December 31, 2018
- No Official Fee
- 3/20 Claims
- At least one claim directed to a method of treating cancer using immunotherapy
- Agreement to restrict without traverse
- May be filed after filing.
Collaborative Search Pilot (CSP)

- U.S., Japan, and Korea
- Technically expired, but USPTO promises a return.
- Allows parallel examination and sharing of results between U.S. and other Patent Offices
- Applicant has benefit of multiple search reports.
- Prior program limited in number of applications, but underutilized
Expedited Design Processing

- Priority throughout prosecution and appeal
- Preexamination Search
- Formal Drawings
- IDS
- Fee ($900/$450/$160)
- Pendency is reduced from 15 months to 5 months (average)
USPTO Ombudsman Program

- www.uspto.gov/patents/ombudsman.jsp
- Phone: 571-272-5555 or 1-855-559-8589
- PatentsOmbudsmanprogram@uspto.gov
- Contact from Ombudsman within one day
- “The Patents Ombudsman Program should only be contacted when an applicant, attorney or agent feels that examination has stalled and that their efforts to move their application forward through the normal channels (e.g., contacting the examiner or supervisory patent examiner or TC Director) have not been effective.”
Slow Down Prosecution

- Petitions for Suspension of Action
- 37 C.F.R. 1.103(a)
  - Up to 6 Month Suspension for “Good and Sufficient Cause”
    - Not if Office action is outstanding
    - Petition must specify a period of suspension not exceeding six months; showing of good and sufficient cause for suspension of action; and the fee set forth in § 1.17(g), unless such cause is the fault of the Office.
  - Can be Renewed.
Slow Down Prosecution

- Petition for Suspension of Action – Cont’d
- 37 C.F.R. 1.103:
  - (b) Three Month Limited suspension of action in a CPA (moot).
  - (c) Up to 3 Month Limited suspension of action after RCE
    - File with RCE; Specify period of suspension and the processing fee set forth in § 1.17(i).
Slow Down Prosecution

- Petition for Suspension of Action - Cont’d
- 37 C.F.R. 1.103(d)
  - Up to 3 Year Deferral of Examination from earliest priority date.
    - Request of the applicant must include (1) the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i); (2) directed to an original utility or plant application; (3) No outstanding non-publication requests; (4) Appl. is ready to be published; (5) No action taken
- Form PTO/SB/37
Slow Down Prosecution

- Petition for Suspension of Action - Cont’d
- 37 C.F.R. 1.103:
  - (e) Notice of suspension on initiative of the Office.
  - (f) Suspension of action for public safety or defense of U.S. owned applications at request of appropriate department or agency
Slow-down Prosecution

- Petition for Suspension of Action - Cont’d
- 37 C.F.R. 1.103:
  - (g) Statutory invention registration.
    - The Office will suspend action by the Office for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except for purposes relating to patent interference proceedings under part 41, subpart D, of this title.
Slow Down Prosecution

- Withholding fees from initial filing
- R.53(b) continuations
- Supplemental Amendments
- Shortened Statutory Period, Extensions and Patent Term Adjustment
- File Wrapper Laches
Conclusion

- Statistics:
  http://www.uspto.gov/dashboards/patents/main.dashxml

- Closing thoughts?