Working with the USPTO

Mark R. Powell
Director, Technology Center 2600

2010 MOBILE VOICE CONFERENCE
Reexamination Filings

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

![Graph showing reexamination filings from 1981 to 2009. The graph indicates a significant increase in filings from 2007 onwards.]

- **Owner requested ex parte**
- **Third Party ex parte**
- **Third Party ex + inter partes**
Ex parte Processing

Source:
Reexamination
Operational
Statistics
Inter partes Processing

Source:
Reexamination
Operational
Statistics
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
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

mark.powell@uspto.gov