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# **When, Why, and How to Strategically Leverage Accelerated Examination**

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# Accelerated Examination Overview

## » Pendency

- Existing – approx. 3.5 years
- AE – average 296 days
- AE –fastest prosecution:  
18 days

## » AE First Action

- Average 157 days

## » Completed Prosecution

- Average 197 days

## » AE Issue

- Average 296 days

## » Allowance Rates

- Existing – approx. 41%
- AE – 80.3%

# AE Characteristics

## » Examined out of Order

- Accelerated Examination
- Patent Prosecution Highway

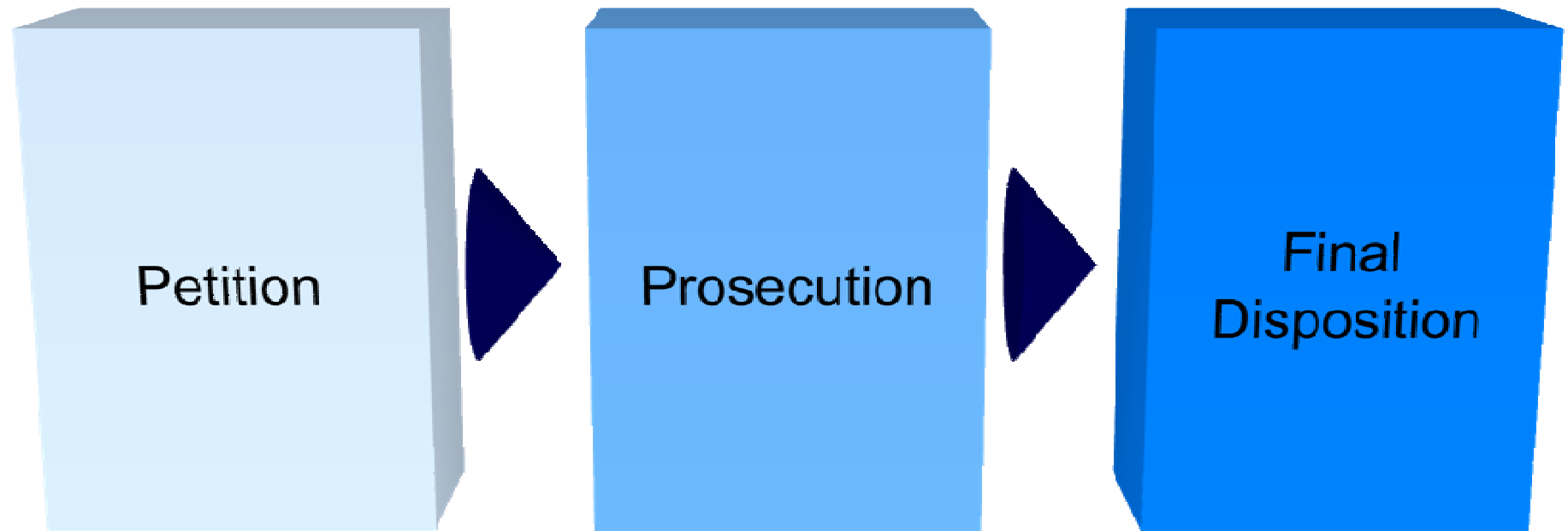
## » Formal Filing Requirements

- Petition/Fee
- File Electronically via EFS
- File complete application
- Limits on number of claims – 3/20
- Claims directed towards single invention
- File Under 35 U.S.C. §111(a)
- No International Applications under §371 (but national applications under §111(a) okay)
- Pre-Examination Search
- Support Document

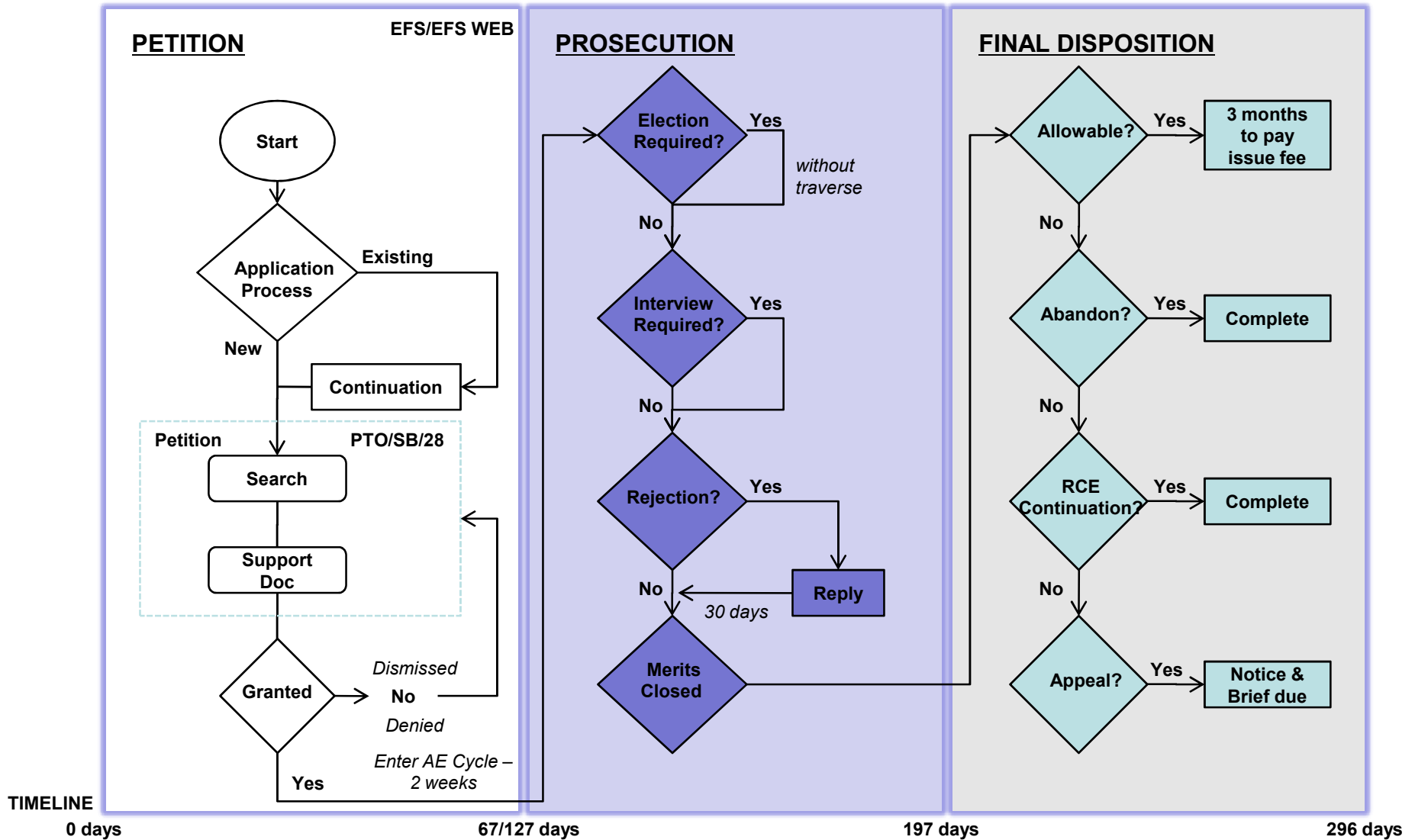
## » Initial Review

- Formalities
- Pre-Examination Search / Support Document

# Accelerated Examination Overview



# Accelerated Examination Overview



# AE Pre-Examination Search

## » Search Requirements

- Field of search (i.e. class/subclasses)
- US, International, NPL sources (e.g. file names, database providers)
- Search Logic including specific query
- Date of search

## » Dismissals (approx. 40%)

- Examiner requirements
  - » Field of search
  - » Search queries
  - » Search in fulltext
  - » Do not limit with classifications
  - » Must cover all claims
  - » Must use terms found in claims
- Overcoming
  - » Update Search and Resubmit with new art
  - » State if no new art was located

# AE Support Document

- » Support Document Requirements
  - Information Disclosure Statement
  - ID limitations disclosed by references found in search
  - Explanation of Patentability/Utility/§112 Support
- » Dismissals (approx. 40%)
  - Formal matters
    - » Spec support for claim limitations
    - » Failure to adequately explain reasons for patentability
    - » Failure to adequately characterize references
  - Overcoming
    - » Resubmit with changes
    - » Add any new art discussions
    - » State if no new art was located

# Sample Support Document

1. A method of delivering a secure promotion to a user comprising:
  - collecting a plurality of offers;
  - assigning a unique identifier to each of the offers from the plurality of offers;
  - encoding each of the unique identifiers utilizing an XYZA algorithm and forming a plurality of coupons by combining each offer with the assigned, encoded identifier;
  - providing a retailer with the plurality of coupons;
  - identifying the user;
  - providing the user with a portion of the plurality of coupons for selection;
  - determining which of the provided coupons the user has selected;
  - informing the retailer about the selected coupons by the user;
  - decoding the identifiers on the selected coupons and validating the selected coupons using the decoded identifiers;
  - redeeming the validated coupons; and
  - providing a clearinghouse with the redemption information.

# Sample Support Document

1. A method of delivering a secure promotion to a user comprising:
  - collecting a plurality of offers;
  - assigning a unique identifier to each of the offers from the plurality of offers;
  - encoding each of the unique identifiers utilizing an XYZA algorithm and
  - forming a plurality of coupons by combining each offer with the assigned, encoded identifier;
  - providing a retailer with the plurality of coupons;
  - identifying the user;
  - providing the user with a portion of the plurality of coupons for selection;
  - determining which of the provided coupons the user has selected;
  - informing the retailer about the selected coupons by the user;
  - decoding the identifiers on the selected coupons and validating the selected coupons using the decoded identifiers;
  - redeeming the validated coupons; and
  - providing a clearinghouse with the redemption information.

# Sample Support Document

1. A method of delivering a secure promotion to a user comprising:  
collecting a plurality of offers; [\[col. 10 lines 11-19\]](#)  
assigning a unique identifier to each of the offers from the plurality of offers; [\[col. 4 lines 19-22\]](#)  
encoding each of the unique identifiers and forming a plurality of coupons by combining each offer with the assigned, encoded identifier; [\[col. 4 lines 19-22\]](#)  
providing a retailer with the plurality of coupons; [\[col. 4 lines 19-26\]](#)  
identifying the user; [\[col. 4 lines 19-26\]](#)  
providing the user with a portion of the plurality of coupons for selection; [\[col. 10 lines 11-19\]](#)  
determining which of the provided coupons the user has selected; [\[Fig1\]](#)  
informing the retailer about the selected coupons by the user; [\[col. 10\]](#)  
decoding the identifiers on the selected coupons and validating the selected coupons using the decoded identifiers; [\[col. 7 lines 63-65\]](#)  
redeeming the validated coupons; [\[col. 1- lines 43-47\]](#) and  
providing a clearinghouse with the redemption information. [\[col.4 line 5\]](#)

# Decision to Use AE

- » AE Petition and AESD Requirements
  - Dismissed
  - Denied
- » Drawbacks?
  - Cost
  - Inequitable Conduct
  - Narrow Claim Scope
- » AE Benefits

# AE Benefits and Strategy

Technology Center	AE Average 1 <sup>st</sup> Action Pendency (months) FY09	Average 1 <sup>st</sup> Action Pendency (months) 2nd Quarter FY09	AE Average Total Pendency (months) FY09	Average Total Pendency (months) 2nd Quarter FY09
1600 - Biotechnology and Organic Chemistry	<b>5.2</b>	22.5	<b>9.9</b>	35.1
1700 - Chemical and Materials Engineering		25.9		37.4
2100 - Computer Architecture Software		29.4		40.7
2400 - Networking, Multiplexing, Cable, and Security		28.6		47.7
2600 – Communications		33.0		42.7
2800 - Semiconductor, Electrical, Optical Systems		20.8		29.7
3600 - Transportation, Construction, Electronic Commerce		24.4		35.1
3700 - Mechanical Engineering, Manufacturing and Products		26.5		35.5

# AE Benefits and Strategy (cont'd)

## » AE Strategies

- New Technologies
- Capture Incremental Improvements
- Startups
- Portfolio Builders

## » Implementing Effective AE Strategies

- Identify Invention Disclosures for AE as part of Triage
- Industry/Technology
- Portfolio Analysis and Competitive Assessment

# Summary

- » AE offers substantial benefits
- » AE not appropriate for every applicant or every invention but provides value in many instances
- » Decisions about AE made based on holistic perspective of process

Thank You

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