

PATENT FILE

Innovation liberation

Linda Thayer looks at harnessing global patent prosecution to protect innovation in a pandemic



Linda Thayer

Despite Covid-19, patent filings during the first three months of the pandemic actually increased in the US.¹ But if your company hit the pause button on patenting, how do you catch up?

Provisional patent applications

Passing the America Invents Act (AIA) in 2013, the US joined the rest of the world in the race to patent. Even during a pandemic, the applicant that files first will receive priority over all others. No special pandemic rules change this. If you or your company cannot afford full application drafting and filing costs now, filing a provisional application for \$280 (\$140 for small entities), often with existing internal documents drafted by your own engineers, allows you to stake out your place in line and provides you with a one-year grace period to continue innovating, analysing the market, and developing a worldwide patenting strategy before committing larger sums of money. Well-written provisional applications may attract investors and funding while protecting your ownership in your ideas. Consulting a patent attorney or agent at some point before filing is recommended.

Act quickly

Globally, the patent application process is fraught with deadlines that, if missed, may cause loss of rights. Most countries offer extensions of time before rights are permanently lost.

If you filed provisional or foreign applications, but could not complete the US utility filing within the one-year grace period (or six months for design applications claiming foreign priority), all is not lost! After this period expires, the US patent laws permit an applicant two more months to petition for restoration of the right to claim priority to or benefit of a prior-filed foreign or provisional application.

The Coronavirus Aid, Relief, and Economic Security Act (CARES Act) extended the deadline for small businesses and individuals to file free petitions for restoration as well as pay certain other patent-related fees to 30 September 2020.² For a full list of USPTO notices regarding the COVID-19 outbreak, see www.uspto.gov/coronavirus. Even if special Covid-19 rules have expired, many jurisdictions, like Europe, have procedures for “further processing” emergency measures you can take after deadlines have passed.³

Many require applicants to state that despite due care taken, the deadline was missed due to extraordinary circumstances, like Covid-19 disruptions.

Expedited process

If you are a company with small entity or micro-entity status⁴ and are developing a product or process related to Covid-19, you may qualify for reduced or waiver of fees and expedited processing of your application.⁵ In this programme, announced 14 May 2020, the US Patent and Trademark Office (USPTO) promises to provide up to 500 qualifying patent applications prioritised examination without payment of prioritised examination fees and to reach final disposition within six months. Applicants should not be discouraged by the requirement that to qualify, the claimed product or process must be “subject to an applicable Food and Drug Administration approval for Covid-19 use” as there is much debate as to the scope of that requirement.

Prioritised examination

Applicants may also request prioritised examination under 37 CFR 1.102(e). Since 2011, the so-called “Track One” process has been available to any applicants willing to pay the fee of \$4,000 for large entities, \$2,000 for small entities, or \$1,000 for micro entities.

Under Track One, the USPTO guarantees examination and issuance of a patent (if the invention is worthy) within one year. USPTO statistics show that, on average, patents are granted under this programme on average in eight months,⁶ although the author’s firm has had patents granted in as little as four months.

The USPTO raised the limit on Track One requests per fiscal year to 12,000 starting 1 October 2019, but appears on track to hit the limit before 30 September 2020 this year.⁷ The first action interview pilot programme (FAIPP) and robust use of examiner interviews, can further expedite prosecution and reduce costs.

Footnotes

- <https://www.uspto.gov/corda/dashboards/patents/main.dashxml?CTNAVID=1005>
- <https://www.uspto.gov/about-us/news-updates/uspto-extends-certain-cares-act-relief-small-and-micro-entities>
- <https://www.finnegan.com/en/insights/blogs/european-ip-blog/the-dos-and-donts-of-further-processing.html>
- To qualify as a small entity for purposes of paying patent fees, you must either be an individual, small business having no more than 500 employees (or affiliates), a university, or a 501(c)(3) nonprofit organisation. 37 CFR 1.27. Individuals, small entities, or universities with no more than four previous patent applications and gross income less than three times median household income (currently about \$190,000) may qualify for micro entity status. 37 CFR 1.27.
- <https://bit.ly/3hlUKNJ>
- <https://www.uspto.gov/corda/dashboards/patents/main.dashxml?CTNAVID=1007> Average time from filing to petition grant (1.1 months) plus average time from petition grant to final disposition (6.4 months), plus time from Notice of Allowance to issuance (one month, if issue fees paid promptly).
- <https://bit.ly/3eTUvgD>

Linda Thayer is a partner with Finnegan, Henderson, Farabow, Garrett & Dunner. She focuses her practice on guiding high-tech clients in developing strong intellectual property portfolios and defending their patent assets before the PTAB and in federal courts.