



Summer 2011 Newsletter

In this year's Summer Newsletter, an update on each of the U.S. Patent and Trademark Office (USPTO) programs available for **expediting patent application examination** is provided. Further, we are devoting a section this newsletter (beginning on page 2) to a review of two books that teach **patent searching techniques**. Our clients often wish to carry out at least preliminary patent searches, and having some resources in that area may be useful. In addition to the two books that are reviewed, there are many other **patent searching resources** available to assist one in patent searching, some of which are provided (with links) on page 3 of this newsletter.

UPDATE ON EXPEDITED EXAMINATION IN THE U.S. PATENT AND TRADEMARK OFFICE (USPTO).

New patent applications are ordinarily examined in the order of their U.S. filing dates. However, sometimes it is possible to speed up the examination process, and such expedited prosecution may be particularly desirable when a granted U.S. patent may be beneficial in view of potential business opportunities. Some of these programs were discussed in our 2010 Summer Newsletter and here we provide an update on each of the available programs, noting expansion of some programs to include additional technology areas as well as new dates by which petitions to participate in the programs must be submitted.

(1) Accelerated Examination: The "Accelerated Examination" (AE) procedure allows accelerated examination, but is often disfavored due to the burdensome disclosure requirements for participation. Under the current AE procedure, applicants must obtain a Pre-Examination Search and file an Examination Support Document (ESD). The ESD must cite each reference deemed most closely related to the subject matter of each claim, identify all of the limitations in the claims that are disclosed by the reference and specify where the limitation is disclosed in the reference cited, include a detailed explanation of how each of the claims are patentable over the references cited, and provide a statement of utility and

support in the application for each of the claims. If the AE petition is accepted, examination should begin within 12 months of the filing date of the application.

(2) Patent Prosecution Highway: Under the program entitled "Patent Prosecution Highway," or PPH, the U.S. has formed agreements with a number of other countries that allow an applicant that receives a ruling from the patent office where the application was first filed that at least one claim is patentable to request that an office of second filing fast track the examination of corresponding claims. The patent offices with which the U.S. has agreements under the PPH program include, among others, Europe, Canada, Japan, Israel, Mexico, Korea, Russia, Singapore and Taiwan. There is no petition fee for this program but the petition must be submitted before substantive prosecution has begun in the U.S.

(3) Petition to Make Special Due to Age or Health of an Applicant: A "Petition to Make Special" may be filed without any fee if the basis for the petition is the applicant's age (at least 65 yrs old) or health. The petition must be accompanied by evidence, such as a statement of age by the applicant or a doctor's certificate showing that the state of health of the applicant is such that he or she may not be available to assist in prosecution of the application if it were to be examined in the normal course.

(4) First Action Interview Program: Upon request, prior to the first Office Action, applicants may conduct an examiner interview after reviewing a "Pre-Interview Communication" provided by the examiner. This program was originally only available in certain technology areas but this year the program was expanded to include all technology areas and will now continue until at least May 16, 2012. To participate in the program an application must be a non-provisional, non-reissue utility application with three or fewer independent claims and twenty or fewer total claims. A request to participate in the program must be filed before the issuance of an Office Action on the merits. No fee is required to participate.

(5) Project Exchange: Under a program called “Project Exchange,” a patent application can receive special, accelerated status if the applicant abandons another related unexamined application. The related applications must be owned by the same party and/or have at least one inventor in common. To be included in this program, both of the applications must have been filed before October 1, 2009. No fee is required to participate in this program.

(6) Green Technology: Applications pertaining to green technologies including greenhouse gas reduction, environmental quality, energy conservation, development of renewable energy resources or greenhouse gas emissions may be advanced out of turn for examination. This is pilot program that began in late 2009 (see our 2010 Summer Newsletter) and late last year was extended until December 31, 2011. It is limited to the first 3,000 petitions. In the petition to participate in this program, an applicant must provide a basis for eligibility under this program. No fee is required.

PATENT SEARCHING TOOLS. Let us begin with words of caution: Thorough patent searching is complicated and tedious. Different types of searches (e.g., a “knock-out” search versus a “freedom to operate” search) differ dramatically from one another. Searches conducted in the past may well require updating in the future. Skillful searching can be as much an “art” as it is a “science” and the development of a professional skill set can take years of practice. Finally, even a thorough professional search can miss an important reference. Yet, a plethora of material has become available (with little instruction) on the Internet. Hence, the reviews and links below are provided as a general introduction to this complicated topic.

Patent Searching Made Easy, 5th ed., D. Hitchcock, Nolo, 2009. List price: US\$39.99. This particular book is targeted at novices to patent searching. The author walks inventors step-by-step through the process of using the Internet to search for patents related to an invention. The book describes each step and “click” needed to accomplish a reasonable search and provides numerous screen shots of the user interface, making it possible for even the beginner to perform a preliminary or “knock-out” patent search.

The book begins with a basic explanation of patents and prior art, then describes the USPTO website and how to use its search function. Basic search strategies are explained, including text searching using Boolean logic and searching by classification. The book then briefly covers other websites, including the European Patent Office, SurfIP, Google Patent Search, government websites, and others. Finally, it provides descriptions of resources such as the PTO search tools EAST and WEST and the Manual of Classification.

This book is an excellent resource for inventors who want at least a preliminary indication of whether their idea has been patented. It also is useful for corporate personnel that are interested in learning how to do simple patent searching. The book lacks sufficient details of advanced searching techniques or the thorough search strategies needed for patentability or freedom-to-operate analyses, but is more than adequate to get the beginner “up and running.”

Patent Searching: Tools & Techniques, (D. Hunt, L. Nyugen, M. Rodgers, eds.), John Wiley & Sons, Inc., 2007. List price: US\$95. In contrast to “Patent Searching Made Easy,” reviewed above, “Patent Searching: Tools and Techniques” is written by professional patent searchers. It is targeted to experienced patent searchers and those who wish to become patent searchers. The editors are officers of Landon IP, Inc., a large patent search firm, and this book arose in part out of materials developed by Landon IP for a course on patent searching.

The first chapter provides an explanation of patents and the patent process, briefly discussing patent prosecution and the job performed by patent examiners. Chapter 2 describes different reasons why patent searches are performed and how these searches differ from one another. The types of searches covered include patentability searches, validity searches, clearance searches, state-of-the-art searches, and patent landscape searches.

The mechanics of searching are addressed in Chapter 3 including how to develop a search strategy and how to conduct a search. Different search techniques are discussed, such as classification searching, full-text searching, citation searching and foreign patent searching. This chapter also identifies searching issues that are specific to each of the major

technical areas (biotechnology, chemical, business methods, computer, software and electronics, and mechanical engineering).

Chapter 4 covers the topic of patent analysis and how it is distinguished from patent searching. A useful discussion on approaches to reporting search results is provided in Chapter 5. The final chapter addresses search tools, describing different databases for patents and non-patent literature.

This book is most useful for the person who is planning to do significant patent searching and needs to learn how to carry out thorough and extensive searches. It provides a reasonable explanation of search strategies without getting bogged down in minute details. It also is a useful resource for someone with a little searching experience that wishes to improve his or her searching skills.

Additional resources for patent searching

On-line training materials:

- USPTO Seven step strategy: <http://www.uspto.gov/products/library/ptdl/service/s/step7.jsp> (recommended starting point by USPTO's Office of Patent Classification);
- USPTO Tutorial: <http://www.uspto.gov/products/library/ptdl/tutorials.jsp>;
- Patent Search Types and Methods: <http://www.freepatentsonline.com/help/item/Patent-Search-Types-and-Methodologies.html>;

Free databases:

- Basic USPTO search: <http://patft.uspto.gov/> (including both patents and published applications);
- USPTO Classification search: <http://www.uspto.gov/web/patents/classification/>;
- Google Patents: <http://www.google.com/patents> (now also includes published applications);
- Freepatentsonline: www.freepatentsonline.com;
- WIPO: <http://www.wipo.int/pctdb/en/> and <http://www.wipo.int/patentscope/search/en/search.jsf>;
- EPO: <http://www.epo.org/searching/free/espacenet.html> and <http://worldwide.espacenet.com/>

- JPO: http://www.ipdl.inpit.go.jp/homepg_e.ipdl (including free Japanese-to-English machine translations, discussed further at: http://www.patenttranslations.com/resources_MT.htm)
- KIPO: <http://kpa.kipris.or.kr/kpa2010/loin1000a.do?searchType=S> (including English language abstracts of Korean applications)

Proprietary databases:

- CAS/STN/SCIFINDER: <http://www.cas.org/index.html>
- DIALOG DERWENT: <http://library.dialog.com/bluesheets/html/bl0351.html>
- DELPHION: <http://www.delphion.com/>

Search services:

- Danish PTO: <http://searchservices.dkpto.org/>
 - Swedish PTO: <http://www.prv.se/In-English/Consultancy-services/Our-services/Patent-consultancy-services/>
 - Science IP: <http://www.scienceip.org/>
 - Landon IP: <http://www.landon-ip.com/>
 - Legal Advantage: <http://legaladvantage.net/Home.aspx>
 - Ms. Jean Porter, Patents by Porter, Raleigh NC (see biography on "Linkedin")
- (Note: there are many search services. The above are examples only. No endorsement is expressed or to be implied)

Article sources:

- Free Online Text Articles: <http://highwire.stanford.edu/lists/freeart.dtl>
- Comprehensive Science Research Tool: <http://www.scirus.com/srsapp/>
- Wisconsin Tech Service for Article Delivery: <http://wts.wisc.edu/> (reasonable cost and prompt delivery)

Professional organizations:

- Patent Information Users Group: <http://www.piug.org/>

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