EIP

Should I get my Patent Application to Grant as Fast as Possible?

Why do patents take so long to grant?

Progressing a patent family through to grant can take a notoriously long amount of time, particularly when an applicant is looking to protect their invention in a number of countries across the world. There are many steps and many people involved in granting a patent, which inevitably can cause delays.

Patent office's typically have relatively long processing times due to a backlog of applications caused by the rapid increase in the number of patent applications being filed over the last couple of decades. In recent years patent offices around the world have invested heavily in streamlining in-office procedures to reduce turn-around time. However, it can still typically take 3-5 years for a patent application to be allowed.

For many applicants this long patenting process is not particularly problematic. However, the patent-pending period can be challenging for others, particularly as there is no certainty that a patent right will ultimately be obtained.

Can I get my patent to grant quicker?

There are a number of simple ways that a patent applicant and their patent attorney can

speed up prosecution of an application. The below actions are cost-effective ways to reduce the total time taken for an application to reach grant (or refusal):

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- Ensure that the application complies with all formal requirements at the time of filing.
- Make a formal request for search (and examination, if funds allow) as early as possible.
- Reply promptly to communications from the patent office.
- Address significant problems in an application, for example that have been identified for a corresponding application filed elsewhere, before examination begins.

An applicant can also make use of programmes designed to fast-track patent applications. Options in the UK include:

- Making use of one or more of the numerous Patent Prosecution Highway (PPH) agreements between the UK IPO and selected patent offices. A PPH allows an applicant to accelerate their application in one country on the basis of a positive decision on a corresponding application in another country, thus avoiding duplication of search and examination work at the patent offices.
- Requesting combined search and examination, which can be done by any applicant. The search and examination reports are usually issued within six months of making the request.
- Requesting accelerated search and/or examination, which must be accompanied by a demonstration that it is important to do so. The UK IPO aims to issue a substantive response within two months in 90% of cases. Acceptable reasons for making the request include: the need to enforce the right against an infringer, to obtain investment, if the request is for an international application being pursued in the UK national phase that received a positive International Preliminary Report on Patentability (IPRP) for the claims on file in the UK national phase.
- Requesting accelerated publication, which will usually result in publication around six weeks after making the request. This helps achieve a fast grant as a patent cannot be granted until three months after the application has been published.
- Requesting accelerated search, examination or publication via the Green Channel if your invention relates to an environmentally beneficial technology. As long as an applicant can explain why the invention provides an environmental benefit, they application is likely to be accepted onto the Green Channel irrespective of technology area.

Why would I want to accelerate my patent application?

An applicant should consider which, if any, of the above options would best suit their needs.

The variable costs associated with drafting, filing and prosecuting a patent portfolio being difficult to manage, particularly for start-ups and SME's. Once a patent is granted, the renewal fees are set and therefore easier to manage. An applicant may therefore wish to get to grant as quick as possible.

It can be highly advantageous to obtain a search report within 12-months of filing an application. This is because further patent applications can be filed in other countries up to one year after the original, or 'priority', application is filed. If a search report identifies highly relevant prior art an applicant may decide not to file any further applications because there is a low chance of reaching a grant decision. Alternatively, the results of the search report may prompt the applicant to add new information to the further applications to differentiate from the relevant prior art, the 12-month date being the last date by which new information can be added.

A positive search or examination report might be sufficient for an investor to part with their money, which could help an applicant commercialise their invention and/or pay for further patent applications.

Conversely, an early negative search or examination report may prompt an applicant to withdraw their application before it is published, thus allowing them to keep the invention to themselves and perhaps still commercialise it (subject to them not infringing the rights of others).

As mentioned above, accelerated patent prosecution can be helpful if an applicant intends to subsequently make use of the PPH at another office based on the GB patent. The GB granted patent can then be used to accelerate applications to grant in other countries.

In some technology areas the rapid nature of development can mean the technology disclosed in a patent application is defunct or out-dated by the time the patent is granted. Whilst the patent could cover underlying technology and can therefore generate revenue, there is also the risk that the rights conveyed by the patent have no commercial value.

A patent right cannot be enforced against an infringer until granted - although some rights are conferred upon publication of a patent application. If an applicant is aware that a competitor has launched an infringing product, they may wish to obtain a quick grant so that they can enforce their rights before the competitor obtains too much advantage.

In the UK, a business cannot benefit from the tax-relief afforded by the Patent Box scheme until they have a granted patent. Since the tax-relief could significantly outweigh the up-front costs for prosecuting the patent application, a quick grant can provide immediate financial benefits when a patented invention is providing revenue. For more information on Patent Box, which gives businesses a tax break on profits derived from a patent-protected invention, see the Patentise website.

The Green Channel is an attractive acceleration option for qualifying inventions since a written request can be filed at any time during prosecution of an application and no commercial reasons need be given. Further, the applicant can choose which actions to accelerate, which gives them control over the speed at which the application progresses. Since its launch in 2009 over 2,500 patent applications have made use of the Green Channel. The average time to grant for a Green Channel patent application is just 11 months, significantly shorter than the standard patenting timeline. In some instances, a request for examination under the Green Channel has been filed by an applicant with an examination report being issued just a week later.

Why wouldn't I accelerate my patent application?

Having a pending patent application can cause uncertainty for competitors, which may deter them from launching a product for fear of infringing your rights. It can therefore be beneficial to allow an application to proceed along the standard timeline if there are not other factors necessitating acceleration.

In some instances, particularly if a competitor has launched a competing product, an applicant can file a divisional application based on a pending application. The claims of the divisional application can be tailored to cover the competitor's product so that they may be forced to take a licence of the patent, pay damages, or alter their product so that it does not infringe the patent (once granted). Importantly, divisional applications cannot be filed after the 'parent' application has been granted.

Accelerating a patent application can bring forward costs. This may be disadvantageous

for individual applicants or smaller businesses with limited amounts of capital. Avoiding acceleration may therefore give more opportunity to generate income or obtain investment before needing to pay patent-related fees.

An applicant should also consider whether they are happy to bring forward publication of their patent application. A patent application is typically published 18-months after its filing date, giving the applicant time to work their invention before it comes to the attention of their competitors. Early publication can limit the time during which you have a competitive advantage, which you might use to develop, refine and commercialise the invention.

Another disadvantage of a quick patent grant is the uncertainty of whether the patent is actually valid, due to the afore-mentioned delay between filing and publication. If the patent grants within 18 months of filing there could be knock-out prior art documents of which you are not aware, meaning that the patent could be invalid and later revoked.

Conclusion

Patent offices across the world are working hard to help applicants prosecute their patents quicker when they need to. There are a number of different options for acceleration, with differing requirements and advantages they provide. Every applicant will have different needs and should assess their situation, including their finances, competitor patent filings and technology field, carefully when deciding whether to accelerate their application.

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