

EXPRESS SEARCH

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Accelerated Examination Research

Accelerated Examination Research Fees

- Cost: \$115 per hour
- Scope: up to 20 patents

Recommended hours:

- Initial Search: 24 hours
- Update prior to filing: 6 hours (*optional*)
- Update based on Examiner's response to petition: *Included*
- Update in response to amended claims: 6 hours

How is Accelerated Examination Research Used?

The goal of decreased pendency and increased efficiency at the USPTO has resulted in procedural changes based on burden-sharing, particularly with regard to research.

Accelerated Examination filing has been used for both legal and business decisions, growing in benefit as its procedures become more familiar to the USPTO and practitioners.

Alternative Uses:

Consequently, practitioner's have found numerous ways to utilize Accelerated Examination filing in addition to expediting special prosecution.

Some use Accelerated Examination filing as a testing ground for PCT filing. As PCT filings are expensive, one may file the US application as an Accelerated Examination filing. There is a one year spread between filing the US application and filing the subsequent PCT application. Initial discussions with a USPTO Examiner on an Accelerated Examination can indicate how likely allowance of a US patent will be, and thus determine the likelihood of gaining a PCT applica-

tion. PCT applications filed under 35 USC §111 (a) are eligible for Accelerated Examination filing, while a PCT application filed under 35 USC §371 is not eligible (but its subsequent Continuation *is* eligible).

It is also common to file Continuations with accompanying Accelerated Examination petitions. As it is not permissible to file an Accelerated Examination for an existing application, using the expedition petition on a subsequent Continuation has become useful. Certain qualifying patent applications currently in process may be well served by filing a Continuation with an Accelerated Examination petition, in the hopes of expediting the entire case.

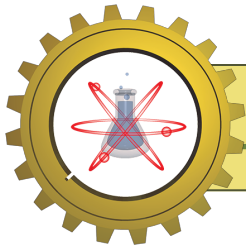
How is Accelerated Examination Research Conducted?

Initial Search:

The initial search consists of an extended novelty search including both patent and non-patent literature, where the search strategy is reported using a *Pre-Examination Search Document*. The Pre-Examination Search Document

Search Results Include:

- *Pre-Examination Search Document* (including field of search and search strategies)
- Opinion-free comments
- Keyword searchable patents
- Current PAIR assignments
- Current INPADOC patent family and legal status
- Electronic results
- Free shipping and free electronic patent copies
- Free research estimate and conferencing



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requires little modification by the client prior to submission.

The search is based on both a classification search as well as a keyword search of patent and non-patent literature. The art of conducting this research is based on selecting the keywords from the specification and claims. It is important to have consistent and well-crafted keyword search strategies across all keyword searching.

Search Update Prior to Filing:

Due to the close relationship between the keyword search strategy and the application as filed, we strongly recommend an update to the initial search based on any changes made to the disclosure and/or claims. Keywords or concepts added to the application after the initial search are routinely noted by the Examiner during review of the Petition.

Search Update Based On Examiner's Response:

We then review the concerns expressed by the Examiner and modify the search accordingly, supplying a modified search report and new *Pre-Examination Search Document*.

The dismissal of a Petition is as common as a first Office Action rejection. Express Search includes an update to the Petition at no additional charge.

Search Update Based On Amended Claims:

Finally the Examiner may require the *Pre-Examination Search Document* be updated prior to the patent's allowance, which Express Search will update at the direction of the client for an additional authorization.

Results Include:

Our search report includes the US and IPC classes and subclasses searched as well as the search strategy used for all text searching of both patent and non-patent literature. We include a listing of all external databases referenced in the course of the search. This format is suitable for inclusion in a *Pre-Examination Search Document* as outlined by the USPTO.

Our search results provide comments on the cited prior art designed to meet the IDS Requirements

of Identification under §1.98(a)(3)(iv)(A). We disclose, where appropriate, the column/line/paragraph/figure and claim causing citation.

We guarantee that this pre-examination search will be considered sufficient to support a Petition for Accelerated Examination. If there are any specific USPTO identified deficiencies that require further research by the applicant, Express Search will update the pre-examination search at no additional charge.

The additional IDS requirements for correlation under §1.98(a)(3)(iv)(B) and for non-cumulative description under §1.98(a)(3)(v) relate to specific claim language and are outside of the scope of our search results. The requirements for patentability justification under §1.98(a)(3)(vi) varies based on the period in which the IDS is filed and are also outside the scope of our search results.

Who Benefits from Accelerated Examination Research?

A growing number of companies are pushing for counsel to file Accelerated Examination Petitions in order to avoid the estimated six year examination backlog in some art units.

Clients who benefit most from this research typically have both legal and business motivations, wherein it is a part of a larger corporate portfolio strategy.

Critical applications may be filed normally and subsequently moved to the head of the queue by filing a Continuation through Accelerated Examination when business conditions require immediate protection.

Many practitioners file several smaller applications with Accelerated Examination Petitions in lieu of a larger single application with many claims, such as including method claims in one Continuation and apparatus claims in another Continuation. Under this strategy, a portion of the Accelerated Examination Petitions may be accepted ensuring some coverage for the technology within the first year of filing.