Quick Success With Accelerated Patent Examination

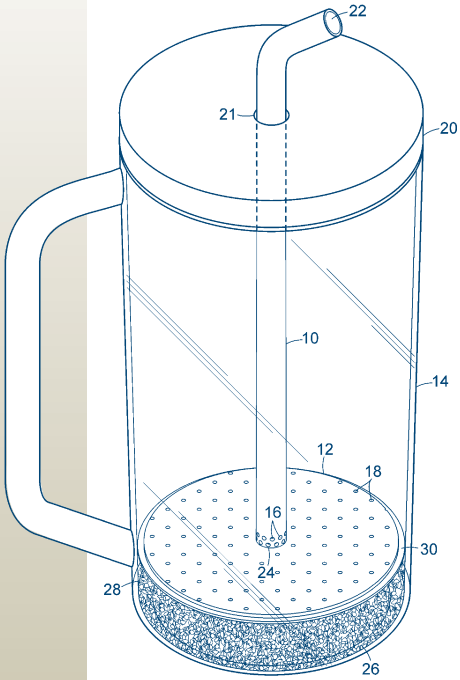
Robert M. Asher
rasher@bromsun.com

Robert Asher is a patent partner at Bromberg & Sunstein.

Entrepreneurs Laura Catena and Elissa Hambrecht are veterans of the wine business. From their experience over the years, they naturally developed a keen understanding of beverage consumers of all types. One day, the inventive spirit caught them and they devised a new beverage concept. It combined the convenience of brewing one's own drink with sipping the beverage through a straw. Whether used for tea, coffee or chocolate or a South American favorite, like mate, the combination brewing/sipping cup holds the potential for a new market of drinkers.

> THE EXCITEMENT OF A QUICK PATENT IS HARD TO BEAT.

They had the foresight to consider what might happen when the new product reached the shelves, and decided to review their concept with us. If it were successful, others would try to copy it. The inventive design of the cup would be immediately apparent to anyone wishing to imitate it. The inventors were rightfully concerned that any success might be overwhelmed by a well-capitalized company seeking to take unfair advantage of the new market.



Patent No. 7,337,705
The invention allows enthusiasts of yerba mate and other brewed drinks to make and consume their beverage in a single cup.

There are a variety of strategies for protecting new products including the use of patent and trademark protection. Trademark protection typically requires proposing a mark and conducting a search to evaluate the risks of adopting the mark. Catena and Hambrecht were able to settle upon the trademark SIPPA PRESS. An intent to use trademark application was filed to secure the inventors exclusive rights in the name for the new product. It took about seven months to receive a notice of allowance for the desired trademark.

With regard to patents, the United States Patent and Trademark Office ("USPTO") is in the unfortunate position of being bogged down with an unprecedented backlog of work adding years to the pendency of most patent applications. Without a patent, the inventors would be hard pressed to stop a knockoff of their product sold under a different name. We introduced the inventors to a new program initiated by the USPTO in 2006 for accelerating the examination of patents. The inventors decided to try taking advantage of this new accelerated examination process. A patent application was filed June 8, 2007. Just five months later, prosecution of the patent application was completed and the application allowed. Instead of waiting two, three, four or more years for a first office action, Catena and Hambrecht are now owners of U.S. Patent No. 7,337,705.

The patent strategy did not throw all their eggs in this one basket. A continuation patent application was filed to pursue additional broad protection to pursue claims that could not fit in the accelerated application. With patent in hand, the inventors can allow the continuation to proceed at the ordinary pace of the USPTO. The combination of an accelerated application and continuation application gives the inventors the best of both worlds – speed and breadth.

The accelerated examination process is not without its detractions. The process is expensive, particularly in the early filing stage. Remember several years of patent prosecution are crammed into just a few months' time. Moreover, the USPTO imposes significant additional burdens on the patent applicant including conducting an extensive prior

CONTINUED ON PAGE 5

Accelerated Patent Examination CONTINUED FROM PAGE 4

art search and drafting a detailed accelerated examination support document ("AESD"). The prior art search must be directed to the claims of the application. Therefore, the claims, limited to twenty, must be written before the final search is completed. A further search is often required at the request of the USPTO upon reviewing your petition to make special. The AESD must provide a detailed identification of every limitation in the claims that is disclosed by each of the most closely related prior art references. Further, applicant must explain what makes each of the claims patentable over the references. In addition, for each limitation in the claims, applicant must show where the support for that limitation can be found in the patent specification. Great care must be taken with regard to all these statements being put on the record of the patent application. Thus, preparation of an AESD is time consuming and costly.

Prosecution of the application is brisk. The first hurdle is getting the petition to make special granted. This involves satisfying the petitions examiner with a supplemental search and any further supplementation of the AESD that the examiner requires. Generally, within a couple months of the granting of the petition, the examiner on the merits will either arrange an interview or send out an office action. For Catena and Hambrecht, we received an office action and shortly thereafter arranged to speak with the examiner. We were able to work out an amendment to the claims that was acceptable to the examiner. This produced the Notice of Allowance.

While the process of seeking accelerated examination is quite onerous, the prospect of a quick decision on a patent application may in some circumstances make it worthwhile. Certainly, the effort is more manageable for simpler mechanical inventions where prior art is more easily evaluated. When a patent is required quickly, there may be no alternative. An inventor may not assert patent infringement and successfully stop infringers without an issued patent. Also, inventors seeking financing while often benefiting from having patent applications pending, may be able to differentiate their venture over other ventures competing for capital by showing a patent in hand.

The excitement of a quick patent is hard to beat. For Catena and Hambrecht the focus can now shift to bringing a protected product to market. We wish them Godspeed.

Robert M. Asher – rasher@bromsun.com
Robert Asher is a partner at Bromberg & Sunstein.