

Knobbe Martens Webinar Series:  
Strategic Considerations in  
Controlling the Speed of  
Prosecution at the USPTO

February 25, 2021

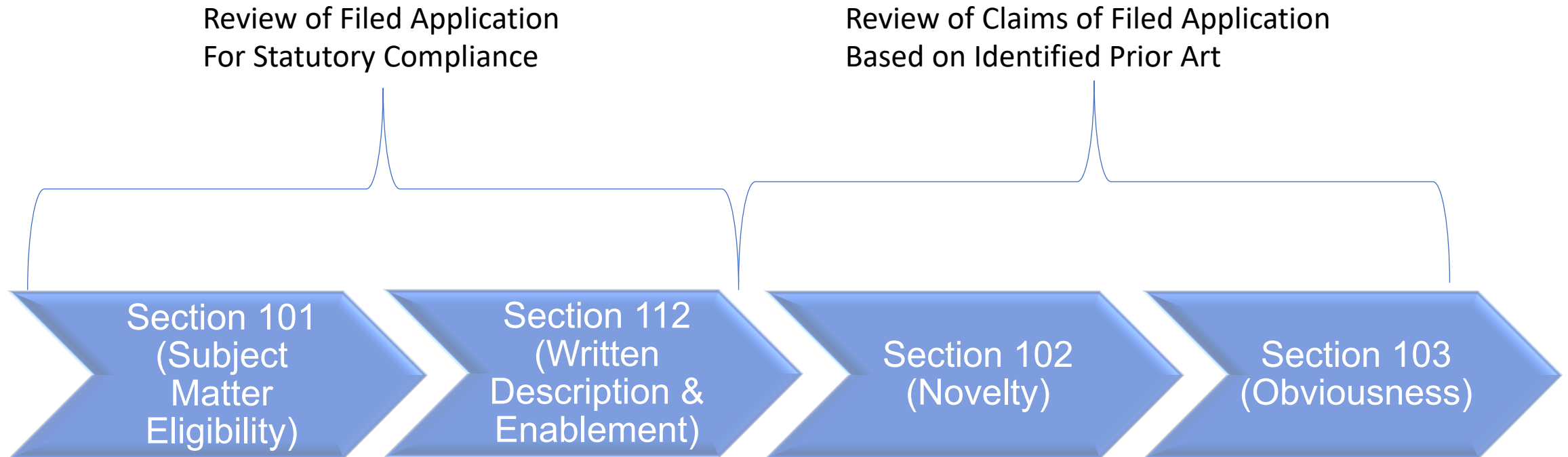
Heungsoo Choi

David Schmidt, Ph.D.

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# Statutory Requirements – Applicability of Controlling the Speed of Prosecution

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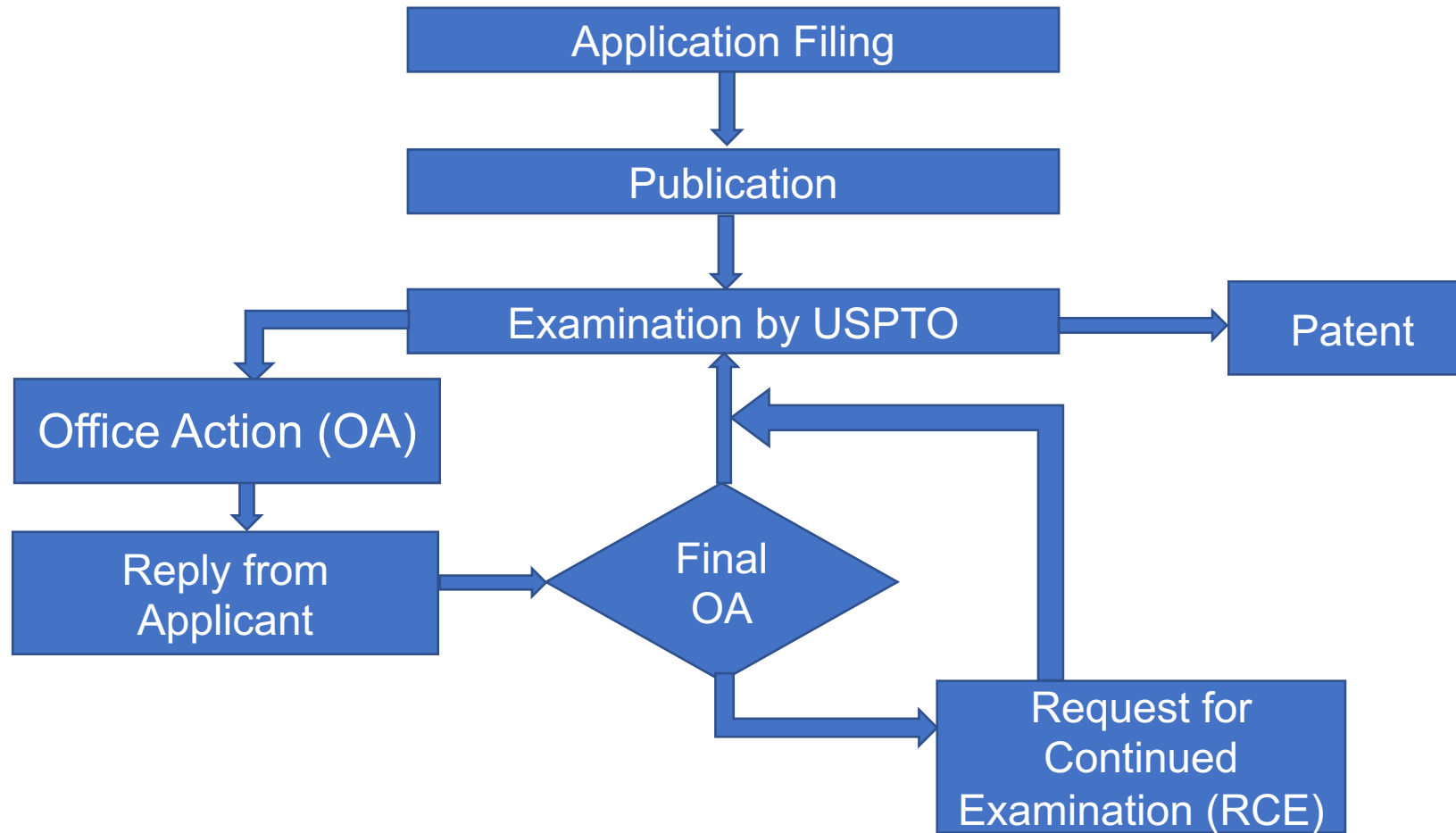
# Three Lanes of US Patent Prosecution

- **Regular Lane**
  - Procedure and timing
  - Current statistics
- **Fast Lane**
  - Track One Prioritized Examination (PE)
  - Patent Prosecution Highway (PPH)
  - Accelerated Examination
  - Petition to make special (age/disability)
- **Slow Lane**
  - Deferral of Examination
  - Limited suspension of action after a request for continued examination (RCE)
  - Petition with a showing of good and sufficient cause



# Typical U.S. Patent Application

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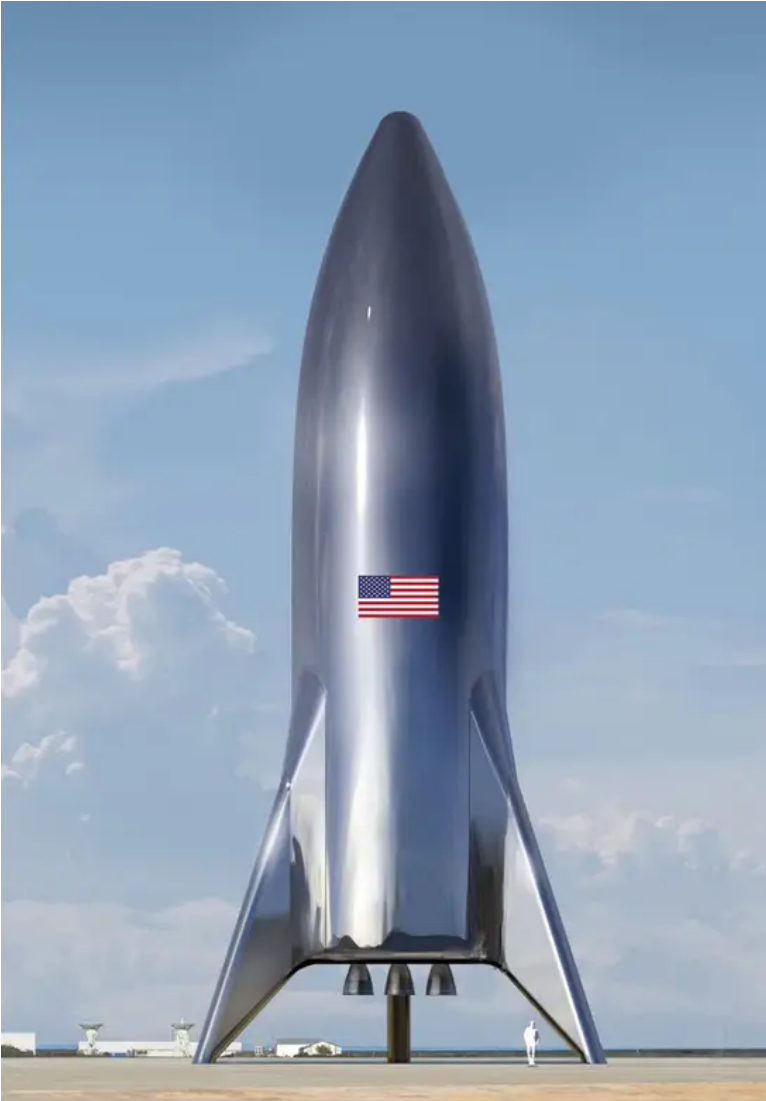


## Patent Prosecution Timeline Statistics

<b>First Office Action Pendency</b> – average time from the filing date to the date a first Office Action is produced	<b>~14-20</b> months
<b>Total Pendency not including RCEs</b> – average time from filing date to final disposition (i.e. issued or abandoned) including abandonment for RCE as disposal	<b>~23-30</b> months
<b>Total Pendency including RCEs</b> – average time from filing date to final disposition, irrespective of any intermediate abandonments due to the filing of a RCE	<b>~30-40</b> months

Data retrieved from <https://www.uspto.gov/dashboards/patents/main.dashxml>

# Fast Lane



- Application granted special status and pulled out of turn
  - Application moved to special docket category on Examiner's interface
  - May reduce prosecution time from years to months
    - 2020 – PE average from filing to first office action (2.8 months)
- Early patents improve competitive positioning and company valuation, particularly for startups
- Enforcement
- Early exposure to prior art
  - The prior art can help steer subsequent applications in US and elsewhere
  - IDS issues

# Fast Lane Example

(12) **United States Patent**  
**Park et al.**

(10) **Patent No.:** **US 10,813,565 B2**

(45) **Date of Patent:** **\*Oct. 27, 2020**

(54) **WEARABLE MONITOR**

(71) Applicant: **iRhythm Technologies, Inc.**, San Francisco, CA (US)

(72) Inventors: **Shena Hae Park**, San Francisco, CA (US); **Mark Day**, San Francisco, CA (US); **Frank Garcia**, Redwood City, CA (US); **Hung H. Ho**, San Francisco, CA (US); **Nicholas Hughes**, Orinda, CA (US); **Genaro S. Sepulveda**, San Francisco, CA (US); **Yuriko Tamura**, San Mateo, CA (US)

(73) Assignee: **iRhythm Technologies, Inc.**, San Francisco, CA (US)

(\*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

This patent is subject to a terminal disclaimer.

(21) Appl. No.: **16/889,541**

(22) Filed: **Jun. 1, 2020**

(65) **Prior Publication Data**  
US 2020/0289014 A1 Sep. 17, 2020

**Related U.S. Application Data**  
(63) Continuation of application No. 16/422,224, filed on May 24, 2019, now Pat. No. 10,667,712, which is a (Continued)

(51) **Int. Cl.**  
**A61B 5/046** (2006.01)  
**A61B 5/00** (2006.01)  
(Continued)

(52) **U.S. Cl.**

CPC ..... **A61B 5/04087** (2013.01); **A61B 5/0006** (2013.01); **A61B 5/0022** (2013.01);  
(Continued)

(58) **Field of Classification Search**

None  
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

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(Continued)

OTHER PUBLICATIONS

US 8,750,980 B2, 06/2014, Katra et al. (withdrawn)  
(Continued)

*Primary Examiner* — Brian T Gedeon

(74) *Attorney, Agent, or Firm* — Knobbe, Martens, Olson & Bear, LLP

(57) **ABSTRACT**

The present disclosure relates to a wearable monitor device and methods and systems for using such a device. In certain embodiments, the wearable monitor records cardiac data from a mammal and extracts particular features of interest. These features are then transmitted and used to provide health-related information about the mammal.

**20 Claims, 25 Drawing Sheets**

# Fast Lane Example

(12) **United States Patent  
Shin**

(10) **Patent No.: US 10,778,856 B1**

(45) **Date of Patent: Sep. 15, 2020**

(54) **MULTI-PURPOSE/MULTI-FUNCTION  
PORTABLE ELECTRONIC DEVICE WHICH  
INCLUDES A DISPLAY MONITOR AND A  
SCANNER DISPOSED BELOW THE DISPLAY  
MONITOR AND EXTENDING TO CROSS  
THE DISPLAY MONITOR, AND A BASE  
CONFIGURED TO SUPPORT THE  
SCANNER, THE BASE INCLUDING A FIRST  
PORTION AND A SECOND PORTION,  
WHERE THE FIRST PORTION AT LEAST  
PARTIALLY VERTICALLY OVERLAPPING  
THE DISPLAY MONITOR AND THE  
SCANNER**

(71) Applicant: **Seeminex.com, Inc.**, San Diego, CA  
(US)

(72) Inventor: **Sukjoo Shin**, Incheon (KR)

(73) Assignee: **Seeminex.com, Inc.**, San Diego, CA  
(US)

(\*) Notice: Subject to any disclaimer, the term of this  
patent is extended or adjusted under 35  
U.S.C. 154(b) by 0 days.

(21) Appl. No.: **16/837,729**

(22) Filed: **Apr. 1, 2020**

(52) **U.S. CL.**  
CPC ..... **H04N 1/00411** (2013.01); **G06F 3/167**  
(2013.01); **H04N 1/00241** (2013.01); **H04N**  
**2201/0094** (2013.01)

(58) **Field of Classification Search**  
USPC ..... 248/688, 693, 548–550, 566–574,  
248/585–633, 637–678, 37.6, 511–541;  
(Continued)

(56) **References Cited**

U.S. PATENT DOCUMENTS

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*Primary Examiner* — Marcellus J Augustin

(74) *Attorney, Agent, or Firm* — Knobbe Martens Olson  
& Bear LLP

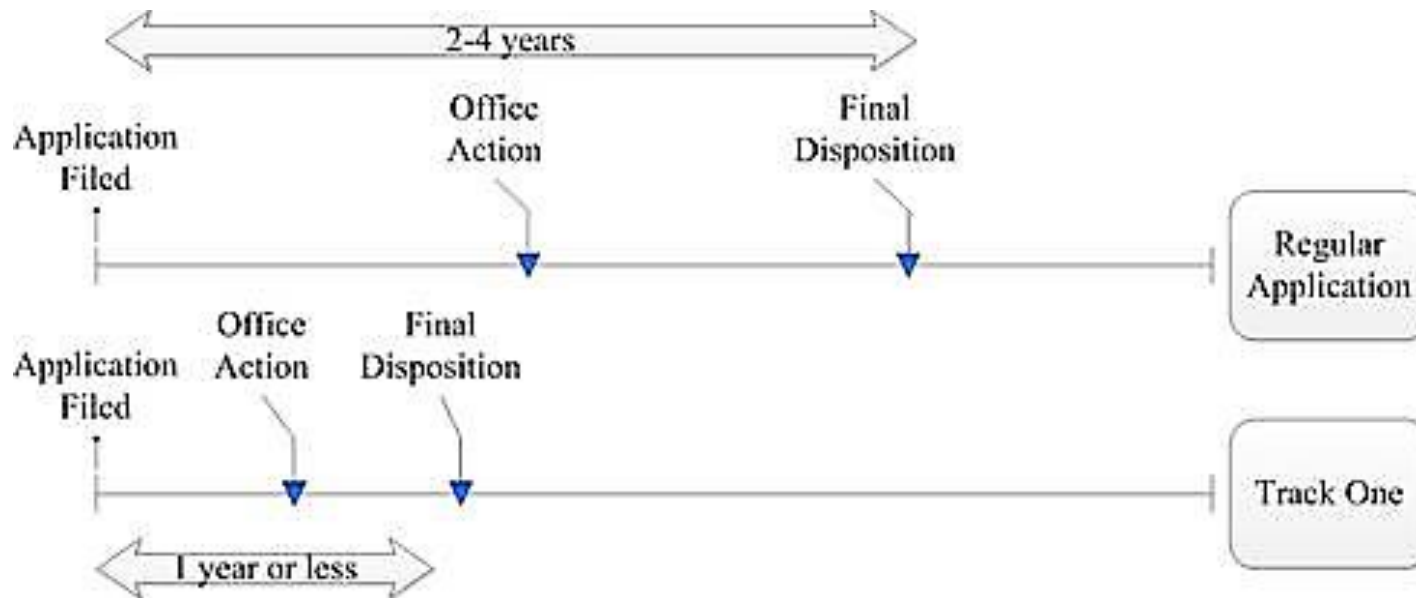
(57) **ABSTRACT**

A multi-function/multi-purpose portable electronic device is disclosed. In one aspect, the device may include a display monitor configured to display an image and a scanner disposed below the display monitor and extending to cross the display monitor, the scanner not directly contacting the display monitor. The device may also include a base configured to support the scanner, the base including a first



# Track One Prioritized Examination

- USPTO **guarantees** examination and final disposition within one year
- 30 total claims, 4 independent claims, no multi-depending claims
- Available to anyone who pays a US \$4200 fee, and completes the few requirements (US \$2100 for small businesses)



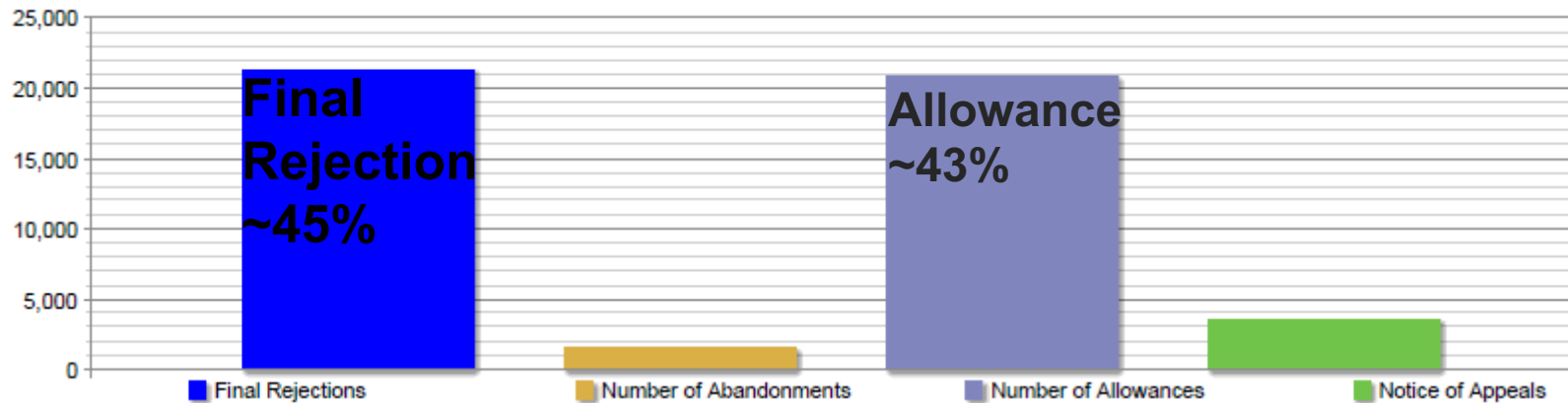
Cumulative for fiscal year 2018



Cumulative for fiscal year 2018

# Prioritized Examination Statistics: Allowance Rates

- First Action Allowance: 29.2% compared to 13.4% for first action allowance in new non-continuing applications
- ~43% allowance rate at final disposition (below) compared to ~ 32% overall RCE rate of new applications



The Track One final disposition numbers displayed are broken out by final rejections, abandonments, allowances and notice of appeals. The totals are cumulative since inception of the program.

Cumulative Through  
January 2018

# Overall Advantages and Disadvantages of Track One Prioritized Examination

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- Advantages

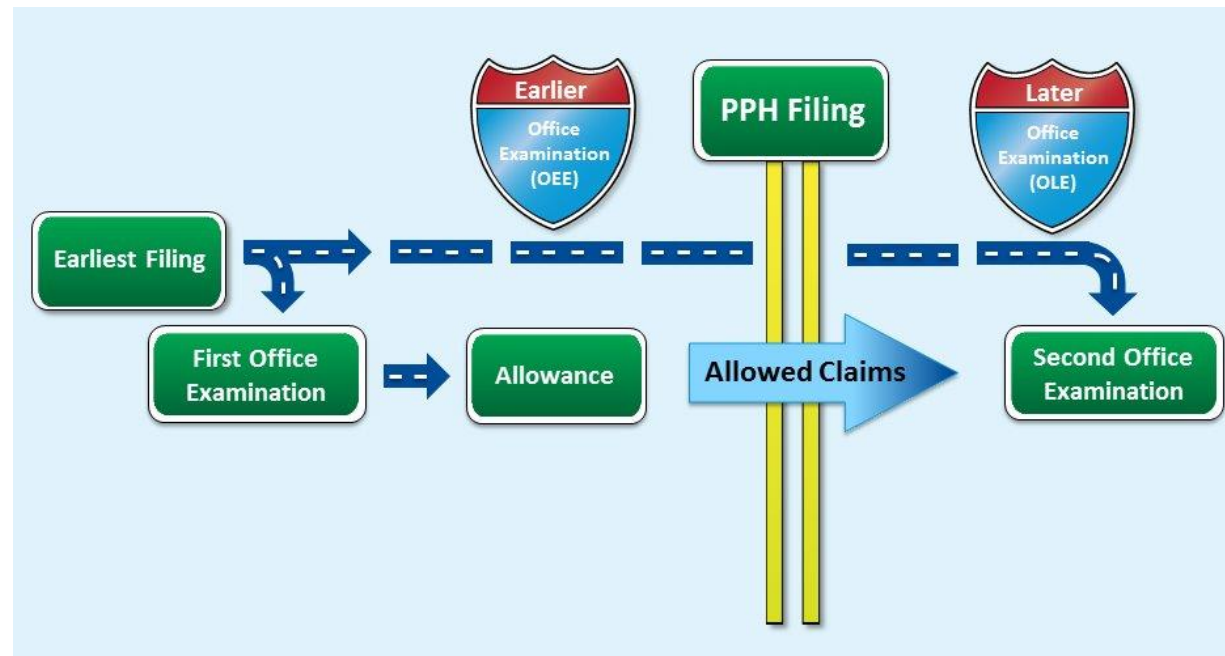
- Much faster prosecution, easier to build issued patent portfolio in short timeframe
- Typically results in less Office Actions
- Examiners are more experienced
- Examiners are more motivated to negotiate
- May result in broader claim scope

- Disadvantages

- Large upfront cost (\$4200 for large entity)
- Prompt attention to deadlines
  - Lose prioritized status if extend date
- Prompt attention to IDS issues
- May be necessary to file continuation/divisional in a short timeframe

# Patent Prosecution Highway (PPH) Program

- At least one claim is allowed in a first patent office → Can request fast track examination of corresponding patent application pending in a second patent office



# PPH: Advantages and Downsides

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- Advantages

- Higher allowance rate: 90% compared to 60% for regular applications
- Can be combined with PCT applications when there are positive PCT Written Opinions
- No additional fee

- Downsides

- Stuck with claims allowed in a first country
  - Cannot substantively change claims in a second country
- Potential inequitable conduct regarding claim correspondence description

## Accelerated Examination – We do not recommend

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- Requires pre-filing search
- Examination support document explaining why claims are allowable in light of the search results
  - Unnecessary file history estoppel created
  - Possible inequitable conduct allegations if any references not accurately characterized
  - Substantial attorney fees required to do properly
- No substantial benefits compared to Fast Track

# Petition to Make Special based on Age or Health

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- At least one inventor is 65 or older; or
  - Requires proof of age or statement from practitioner
- At least one inventor unavailable to assist a patent process due to health condition
  - Requires proof (e.g., doctor's certificate)
- No fee required

## Slow Lane - Deferred Prosecution (prior to 1<sup>st</sup> OA)

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- Deferred examination request
  - Written request to officially ask the UPSTO to hold off examination for a certain time period
  - Can be filed at any time before first action on the merits
  - Maximum length of suspension is three years from earliest priority date
  - Official fee is only \$140 (large entity) / \$70 (small entity)
  - PTA reduced by period of deferral





## Slow Lane – Deferred Prosecution (after 1<sup>st</sup> OA)

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- Limited suspension of action after RCE
  - Applicant can request for suspension of action **up to three months** when a request for continued examination (RCE) is filed
  - Often takes Examiner three months to issue first office action after RCE even without this request
- Suspension for cause
  - Applicant can request for suspension of action **up to six months** with showing of good and sufficient cause and when there is no outstanding Office Action
- PTA reduced by period of suspension

# Slow Lane – Reasons for deferred prosecution

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- Delay legal expenses
  - Defer until investments occur
  - Defer until business priorities determined
- Monitor and cover competitor product
  - Wait to see what product a competitor will make and then drafting patent claims to cover that product
- Buy time for data for patentability
  - Gather data or experimental results to be submitted to the USPTO to support patentability (prior art and enablement)



# Slow Lane – Additional Prosecution Strategies

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- Prosecution strategies – extending prosecution
  - File without meeting formalities
  - Include claim set likely to cause restriction
  - Respond to first Office Action with bare minimum that likely causes another Office Action
  - File continuation instead of filing OA response
  - File Notice of Appeal in response to final Office Action
  - File continuation instead of appeal brief to start entire cycle again

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