KILPATRICK TOWNSEND

5 KEY TAKEAWAYS

Patent Prosecution & USPTO Update

Kilpatrick Townsend Partner Karam J. Saab recently presented, along with another legal leader, a "Patent Prosecution & USPTO Update" as part of the 19th Annual Rocky Mountain Intellectual Property & Technology Law Institute. This premier forum brought together intellectual property professionals from across the U.S. and beyond. Attendees were able to hear from a faculty of national and international IP and tech law experts from across the spectrum of the IP practice.

Mr. Saab shares 5 key takeaways from the presentation:

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A bit under-the-radar in 2020 was the creation of the USPTO's fast-track appeals pilot program. For $420, regardless of entity size, an appeal can be advanced out of turn. The stated goal of the program is for the PTAB to issue a decision within 6 months of the fast-track appeal petition being granted. However, due to the relatively low usage of the program so far, the average time has been 2.2 months from petition grant to issued PTAB decision. This timeline shaves 8-10 months off a typical appeal cycle and may justify the cost to a wide variety of Appellants looking to move cases quicker through appeal.

In 2020, patent application filings decreased by 2%. The average patent pendency from filing to issuance also decreased to 23.3 months – just under 2 years. This trend in quicker prosecution has continued since 2016. However, the average time across art units from filing until a first office action is issued ticked up slightly to 14.8 months. Track one filings remain a good option to expedite prosecution.

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The growth of artificial Intelligence related patent application filings continue to explode. In particular, applications related to intelligent control systems and AI-related data processing show the most growth, with machine learning related applications experiencing a significant uptick in the last couple years.

The Federal Circuit found patents both eligible (e.g., CadioNet, LLC v. InfoBionic, Inc., Uniloc USA, Inc v. LG Electronics USA, Inc.) and ineligible (e.g., Customedia Techs., LLC v. Dish Network Corp.) under 35 U.S.C. § 101. A common theme across the decisions was the Federal Circuit reviewing the specification to identify stated benefits of the claimed invention. Instances where the technological advantage was stated generically, such as in terms of increased speed and efficiency, were found ineligible under 35 U.S.C. § 101, while those that could point to more specific benefits fared well.

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Patent professionals should keep their eyes on American Axle & Manufacturing, Inc. v. Neapco Holdings LLC. In this case, the Federal Circuit was deeply divided on the standard that should be applied under 35 U.S.C. § 101 to determine if a claim is directed to patent ineligible concept. The claims at issue involve how vibrations of a shaft can be controlled. The majority of the panel found that some of the claims were, however, nakedly claiming the law of nature governing such vibrations. At the end of April, the Supreme Court invited the Acting Solicitor General to brief the case on behalf of the United States, so the Supreme Court seems to be seriously considering taking it up. This would be the most important 35 U.S.C. § 101 decision since Alice Corp. v. CLS Bank Intl. in 2014.

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