

Knobbe Martens

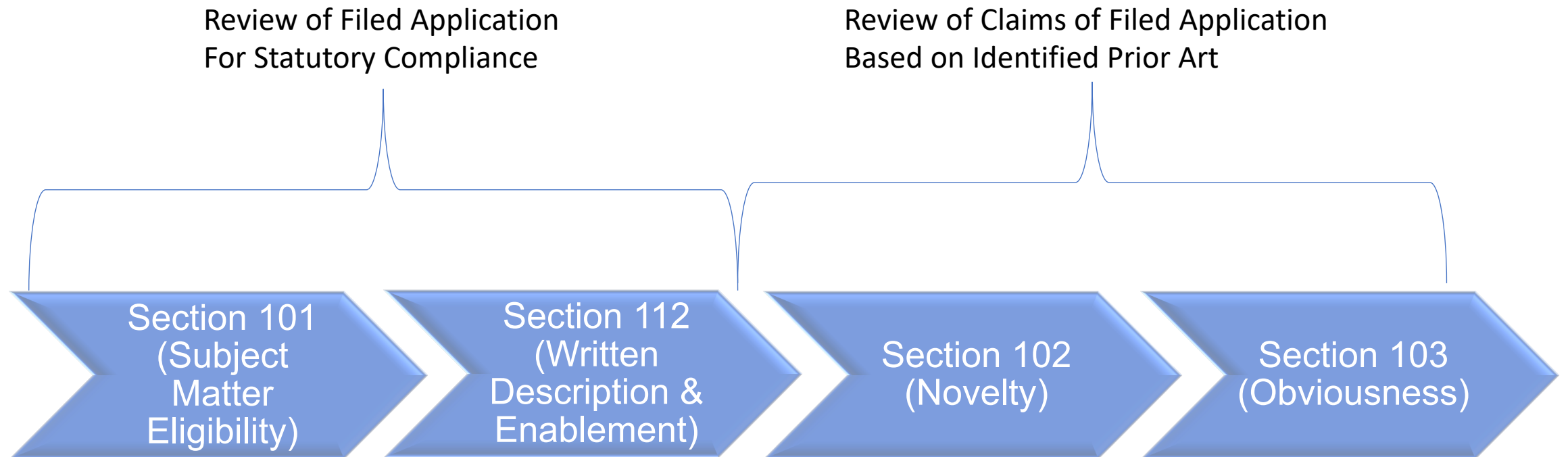
Knobbe Martens Webinar Series: Strategic Considerations in Controlling the Speed of Prosecution at the USPTO

March 18, 2021

Dave Schmidt, Ph.D.

Vlad Teplitskiy

Statutory Requirements – Applicability of Controlling the Speed of Prosecution

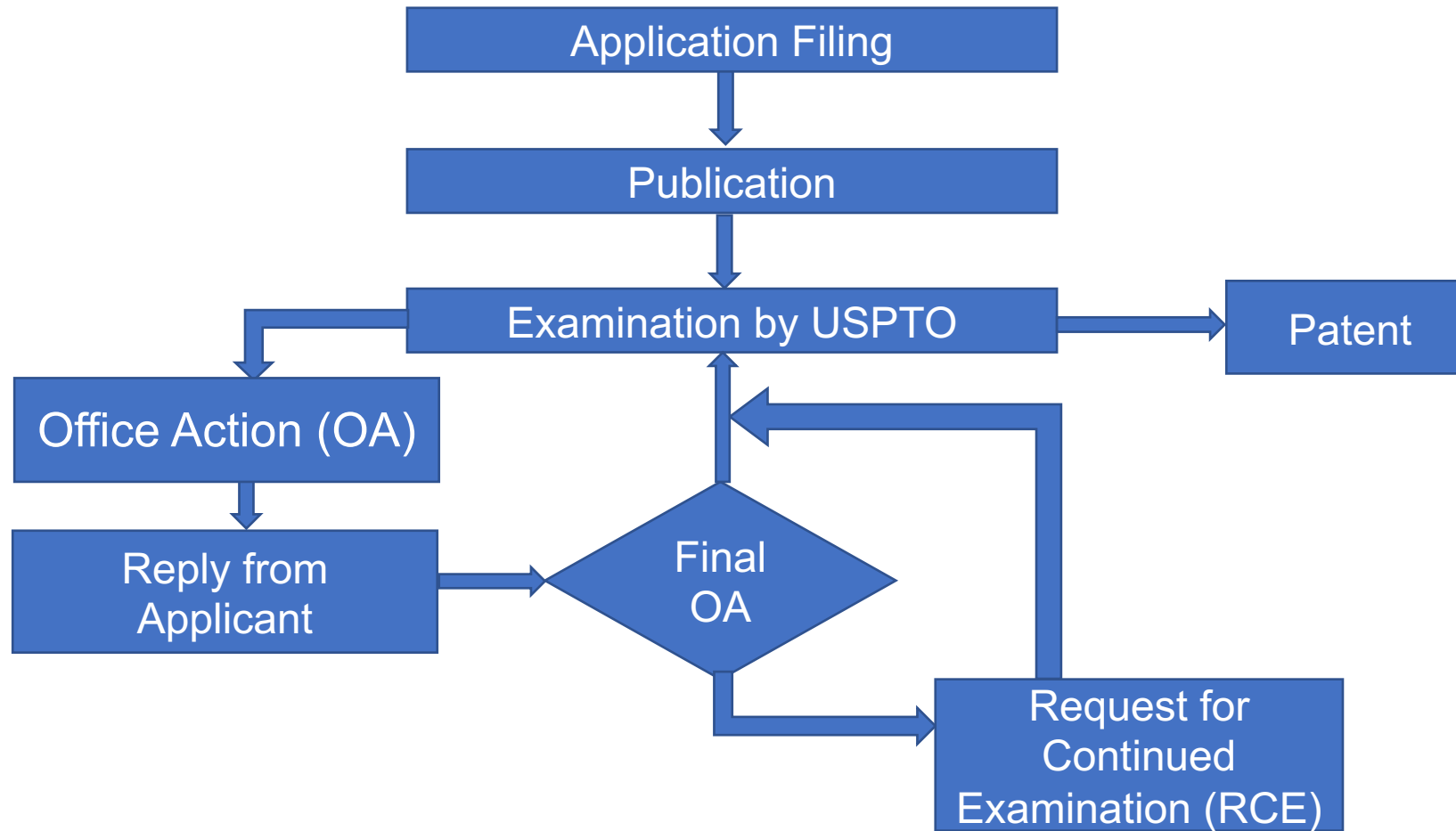


Three Lanes of US Patent Prosecution

- **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/green technology/anti-terrorism/COVID)
- **Slow Lane**
 - Deferral of Examination
 - Limited suspension of action after a request for continued examination (RCE)
 - Petition to defer with a showing of good and sufficient cause



Typical U.S. Patent Application



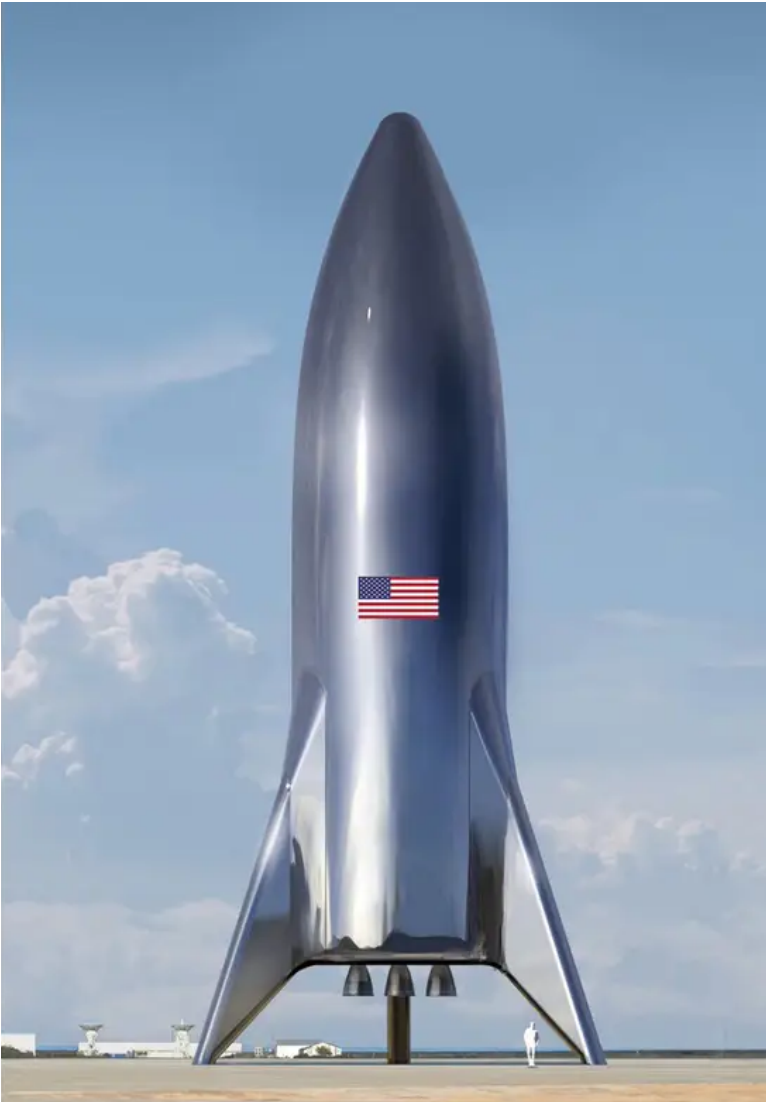
Regular Lane Timeline

Patent Prosecution Timeline Statistics

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

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AU 2011252998 8/2015
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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**

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Primary Examiner — Marcellus J Augustin

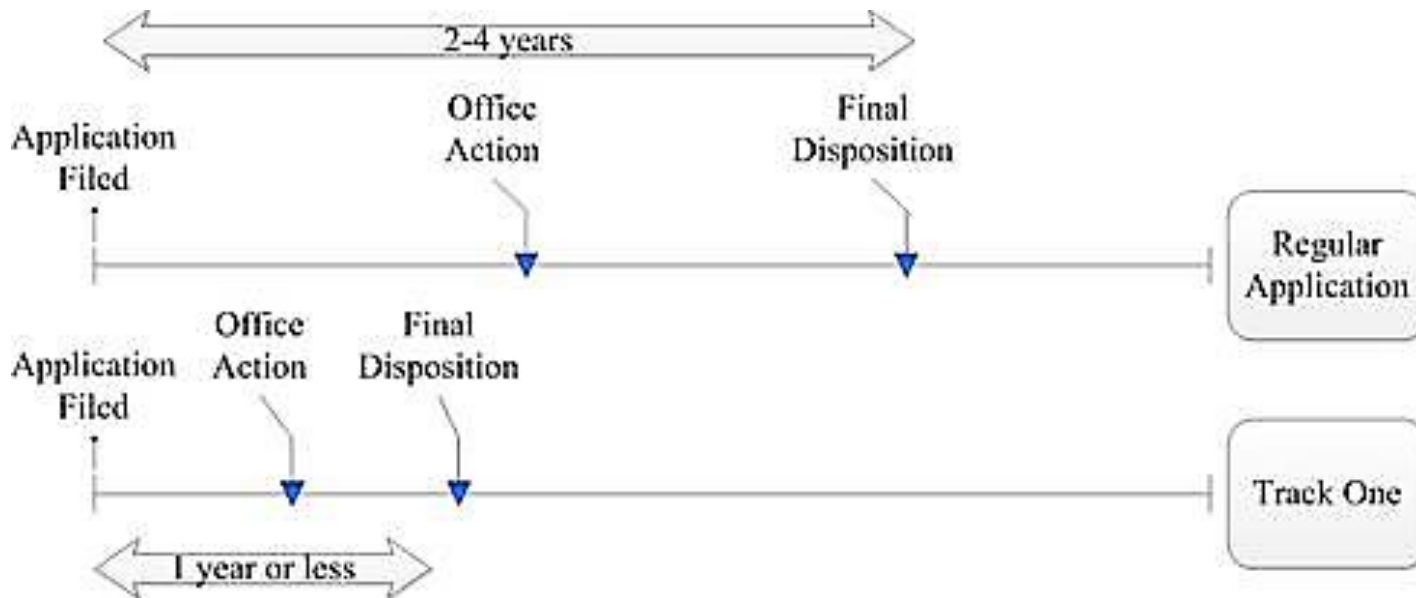
(74) *Attorney, Agent, or Firm* — Knobbe Martens Olson & Bear LLP

(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

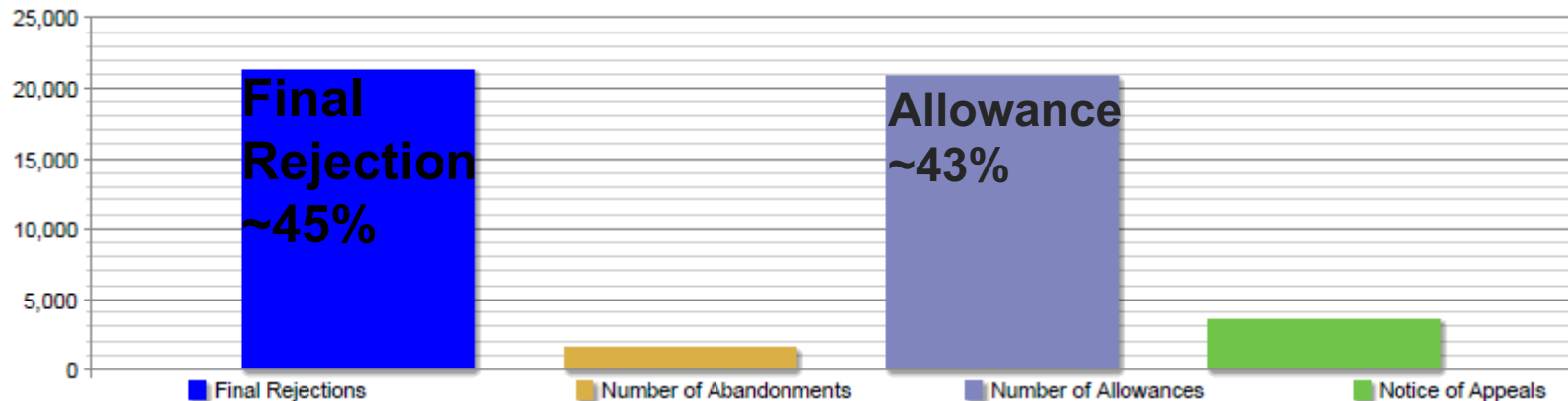
Track One Prioritized Examination

- 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)



Prioritized Examination Statistics: Allowance Rates

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



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

- Advantages

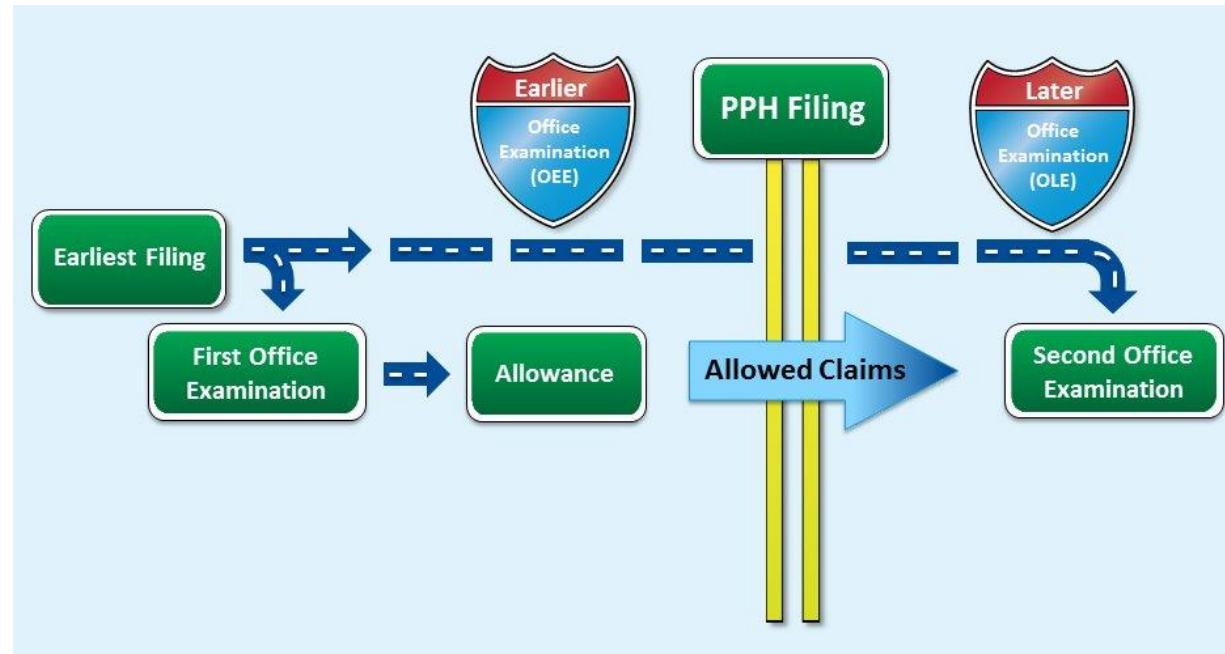
- Much faster prosecution, easier to build issued patent portfolio in short timeframe
- Typically results in less Office Actions
- Examiners are more experienced
- Examiners are more motivated to negotiate
- May result in broader claim scope

- 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 Disadvantages

- Advantages

- Higher allowance rate
- Can be combined with PCT applications when there is a positive Written Opinion from the ISA
 - A positive Written Opinion from faster ISAs can speed up the overall PPH process
- No additional fee

- Disadvantages

- Stuck with claims allowed in a first office of examination
 - Cannot substantively change the independent claims in the US
- Risk of possible inequitable conduct regarding claim correspondence description and claim amendments during examination

Petition to Make Special



- Applicant is 65 or older
- Applicant's health
- **Green technology**
- Anti-terrorism technology
- Covid-related technology
- No fee required
- Result: Application supposed to be accelerated—However, no penalty to Examiners who ignore the grant of this petition.

Accelerated Examination

- 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 properly prepare
- No substantial benefits compared to Track One
- **We do not recommend Accelerated Examination**

Why Choose the Slow Lane?

- 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)



Deferring Prosecution Prior to First Office Action

- Deferred examination

- 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)
- Patent term adjustment reduced by period of deferral



Deferring Prosecution After First Office Action

- Limited suspension of action after request for continued examination (RCE)
 - Applicant can request for suspension of action **up to three months** when 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
 - Requires payment of small fee
- Patent term adjustment reduced by period of suspension

Take Advantage of Procedural Mechanisms



- Simply go slow
 - File application 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 Notice of Appeal in response to Final Office Action
 - File continuation instead of appeal brief to start entire cycle again

Knobbe Martens

Dave Schmidt, Ph.D.

David.Schmidt@knobbe.com

Vlad Teplitskiy

Vlad.Teplitskiy@knobbe.com