Beat The Backlog:
New Fast Track for UK Patents

At the launch of the new government’s Strategy for Sustainable Growth on 20 July, Business Secretary Vince Cable promised that the UK engineering industry would be given the support it needs to reach its potential. He said:

“We need to rebalance away from an economy built on debt to a one that is greener and more technologically advanced. Our economy also needs to be prepared for the long term challenges ahead – the switch to lower carbon technologies in particular. This should also build on the UK’s historic strength in science and technology.”

As innovation is seen as a key driver for economic recovery, engineering businesses are increasingly aware of the importance of protecting and exploiting intellectual property (IP) rights such as patents in all areas of technology. Patent owners benefit from a monopoly lasting up to 20 years for their inventions. Thus IP is an indispensable asset that can allow your business to recoup the investment spent on R&D, e.g. through market dominance or IP sale or licensing deals. However a common complaint from users of the patent system is the worldwide backlogs that can prevent a patent from being granted quickly on your application.

It is recognised that patent backlogs hinder the deployment of innovation and have adverse effects on a technology-based economy. According to a study on behalf of the UK Intellectual Property Office (IPO), the cost to the global economy of the delay in processing patent applications is estimated to be as much as £7.65 billion per year. Back in March the UK and US governments agreed to develop an action plan for reducing patent processing backlogs in both countries' patent offices.

The UK IPO has been the first to act on its promise and on 28 May 2010 it announced that patent applicants can request accelerated examination in the UK national phase if their International patent application under the Patent Cooperation Treaty (PCT) has received a positive International Preliminary Report on Patentability. The introduction of this dedicated pathway for acceleration of UK national phase applications should be welcomed by all engineers looking to bypass examination backlogs and secure grant of a UK patent quickly via the International route.

The IPO pledged:

“Our current target is to issue a substantive examination report within two months of receipt of the request for accelerated examination, on at least 90% of cases.”

Further good news is that there is no official fee for requesting acceleration via the Fast Track procedure. Applicants are merely required to make a request for accelerated processing in writing when entering the UK phase of their application before the IPO. Requests can also be made for applications that have already entered the UK national phase and are awaiting examination. No reasons for requesting acceleration are required, unlike the acceleration procedure in some other patent offices.

To take advantage of the Fast Track procedure, a fully positive International Preliminary Report on Patentability must have been issued on the PCT application with all claims present in the application on entry to the UK national phase having been considered. This means that all of the claims must have been examined and the invention(s) defined therein found to meet the PCT requirements for novelty, inventive step and industrial applicability.
The new procedure provides a boost for any company or individual seeking to secure rapid grant of a UK patent. A patent must be granted before the rights under the patent can be enforced, for example to take action against infringers. Early grant can also be an attractive prospect for start-up companies and SMEs looking to secure investors or to license their technology. Having patent protection in place when entering a market can be particularly important in fast-moving fields and emerging technologies such as renewable energy and nanotechnology.

The government has commented that it wants to see UK industry working hard to secure a competitive advantage in innovative, high-growth sectors like advanced manufacturing, life sciences, and low-carbon technologies. Accelerated patent processing is already available via the "Green Channel" for UK patent applications where the invention relates to environmentally-friendly technology. This applies to both direct UK and PCT(UK) applications. Again, no official fee or reasons for requesting acceleration are required. The procedure was launched in May 2009 to encourage applicants coming from the green technology sector.

The hope is that the US will soon follow suit and introduce accelerated pathways to patent grant. The latest proposal from the US Patent and Trademark Office (PTO) is an Enhanced Examination Timing Control Initiative, also known as “Three-Track”. The “Three-Track” scheme would provide patent applicants greater control over when their applications are examined with three options for entering the patent examination process.

Under the proposed “Three-Track” initiative, applicants would be able to request prioritised examination under Track I. Where the US application claimed priority from a UK or other non-US application then copies of the search and examination results already obtained in other patent offices would be requested in order to avoid duplication of efforts. The goals for handling applications in the Track I queue would be to provide a first examination report within four months and a final disposition within 12 months of prioritised status being granted. UK and US patent applications running in parallel could both therefore be expedited in a more integrated and efficient examination procedure.

Under the US PTO’s proposal it would be necessary to pay a prioritisation fee in order to benefit from expedited examination. The US PTO is currently seeking input from the public on the technologies where prioritisation requests are most likely to arise, to assist them in setting an appropriate level for this fee. However this could be a relatively small price to pay for a business to jump the queue and secure another asset in a valuable worldwide patent portfolio.

Laura Ramsay, Associate
First published in Designs Products & Applications, September 2010