

How Long Does it Really Take to Get a Patent?

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Let's try to answer one of the most-asked questions.

Background

Many clients ask this question no matter how many patents they already hold. Even for inside counsel at large companies or serial inventors who have been through the patent process end-to-end multiple times, the production timelines of the U.S. Patent and Trademark Office (USPTO) are ever evolving.

The good news is the USPTO has for several years been publishing performance data that can be used by counsel to answer client questions. Clients can also see and parse the data for themselves if they wish. The USPTO publishes this data on a helpful dashboard:

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

Before diving into the data, here is a very short overview of the typical utility patent application process:

1. Client files new utility application without using prioritized examination
2. Client expects a first (non-final) Office Action typically rejecting one or more of the claims

NOTE: non-final Office Actions may have other content such as restriction requirements, etc. Only the non-final Office Actions that are the most typical and most impactful of time-to-allowance are considered here.

3. Client responds to the first (non-final) Office Action answering all of the rejections (and objections if applicable)
4. Client receives a) another non-final Office Action, b) a Notice of Allowance, or more typically c) a Final

Rejection

5. Client responds by:

- a) Responding again as in 3
- b) Preparing to pay the Issue Fee and deciding whether to file a continuation of divisional application
- c) Filing a Notice of Appeal, a Request for Continued Examination (RCE) (which includes a response as in 3), or (less often) deciding to abandon the application

Two Key Data Elements in Measuring the Pendency of a Patent Application

Given the background above, let's take a look at what the USPTO data tells us about how long it really takes to get a patent by considering two events that every patent applicant encounters.

First Office Action Pendency (15.6 months)

USPTO definition: "First Office Action pendency is the average number of months from the application filing date to the date a First Office Action is mailed by the USPTO. Our goal is to reduce the first action pendency to an average of 10 months by 2019. The term 'pendency' refers to the fact that the application is pending or awaiting a decision. The measure of First Office Action Pendency includes the time until a first office action by the USPTO as well as any time awaiting reply from an applicant to submit all parts of the application. The first office action pendency number displayed, measured in months, is the average for all applications that have a First Office Action mailed over a three-month (one quarter) period."

"Traditional" Total Pendency (i.e., how long it takes to get an application through to "final disposition" - 23.9 months)

USPTO definition: "This is the measure of total pendency, as traditionally measured. Historically, pendency has been measured as the average number of months from the patent application filing date to the date the application has reached final disposition (e.g., issued as a patent or abandoned) which is cited as a "disposal" [NOTE this is not a complete current definition of "final disposition". "Final disposition" also can include mailing of a Final Office Action (this is clear in the USPTO rules for Prioritized Examination)]. Our goal is to reduce Traditional Total Pendency to an average of 20 months by 2019. This pendency includes the time periods awaiting action by the USPTO as well as any time awaiting a reply from the applicant. The Tradition Total Pendency [sic] number displayed, measured in months is the average for all applications—excluding applications in which an RCE has been filed—which are "disposed" over a three-month period."

As can be inferred from the USPTO website quotes above, determining how long it will take to receive a response to a First Office Action is difficult, never mind how long it might take to receive a Notice of Allowance and eventual issuance.

The USPTO dashboard provides nuanced data reflecting factors that influence the broad numbers stated above (about 16 months to first Office Action and about 24 months to Final Disposition). These factors include the art unit to which the application is assigned. This can influence the application timeline as a

result of subject matter eligibility concerns, USPTO staffing of the art unit, etc.

It is also important to note that the prioritized examination procedure (Track I) has proven to significantly reduce the pendency time of applications, in no small part because part of the (essentially double) filing fee places the applicant in a different queue.

One of the valuable skills an experienced patent attorney brings is familiarity with the USPTO, its timeline trends, its art units, and its examiners. It is important for clients to educate themselves as much as possible using the many resources now available so that they can have a better idea of what questions to ask of the patent attorney.



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