

USPTO MOVE TO EGRANTS WILL AFFECT CONTINUATION DEADLINES

On April 18, 2023, the U.S. Patent and Trademark Office (USPTO) will shift to issuing electronic patent grants (eGrants) to patent recipients rather than paper patents. One reason for this move is to improve the environment. Other reasons include reducing the pendency and streamlining the process of issuing patents. One side effect of this change will be the increased speed with which patents are issued after the issue fee is paid. While getting patents issued faster is good for applicants, the change will also mean that the window for filing continuation and divisional applications will shorten.

Some applicants and practitioners file continuation and divisional applications in the six to eight weeks after the issue fee is paid and before the patent is issued. This can be helpful, by allowing applicants more time to determine whether they want to file a continuation or divisional application, and what subject matter to pursue in said application. The USPTO usually sends out an issue notification one to two weeks before the patent is issued giving applicants notice of the final deadline for filing.

Now with the move to eGrants, the time between paying the issue fee and the grant of the patent is expected to be drastically cut. The USPTO issued an alert stating that “eGrants may be issued shortly after paying the issue fee and sooner than applicants are accustomed to.” Accordingly, the buffer window for filing Continuation, Continuation-in-Part, and Divisional Applications will be in flux and shrink as the new eGrants system is rolled out over the next few months.

While we don’t yet know how fast the USPTO will issue patents given this new process, it would be advisable for applicants to file their continuation and divisional applications at or before the time they file their issue fee. This may require filing the issue fees near the end of the three-month deadline to allow the applicant to have more time to consider their continuation strategy. Furthermore, practitioners will need to notify applicants quickly about Notices of Allowance to give the applicants sufficient time to make strategic decisions.

Our Patent team will continue to monitor for developments and a formal updated timeline, and will share with clients and contacts accordingly. Should you have any questions, please contact your regular AT lawyer or the author

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