Working with the Patent Office in Patent Prosecution

Working with the USPTO: Selecting the Right Legal Advocates

October 10, 2012 – Eric L. Lane
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Patent Prosecution Overview

- Prepare and file initial application (typically in home country)
- First Office Action (can take 2-3 years!)
  - Restrict claims to single invention
  - Reject claims over prior art
  - Allow (some or all claims)
- Response to first Office Action
  - Elect invention
  - Amend claims
  - Argue distinctions over prior art
- Second Office Action / Final Rejection, Response, etc.
Patentability Standards: Novelty

35 U.S.C. § 102

A person shall be entitled to a patent unless -

(b) the invention was *patented or described in a printed publication* in this or a foreign country or in public use or on sale in this country, *more than one year prior to the date of the application for patent* in the United States, or

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent…

If the claimed invention is not novel, it is “anticipated.”
35 U.S.C. 103

Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability Standards: Written Description, Enablement, Definiteness

35 U.S.C. 112
Specification

¶1 The specification shall contain a *written description* of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as *to enable any person skilled in the art to which it pertains*, or with which it is most nearly connected, *to make and use the same*, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

¶2 The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention.
Complex Relationship with the Examiner

Adversarial

Arguments in writing

Collaborative

Cooperation on the Phone
Final Rejection: Plan B1 – Keep on Keepin’ On

• File a Request for Continued Examination
• More arguments and amendments
• But it’s expensive: $465
• And it takes a long time b/c you’re back in the ordinary queue
Final Rejection: Plan B2 – Continuation Practice

- Take narrowed claims and get a patent
- File continuation and argue for broader claims
Final Rejection: Plan B3 – The Appeal (Overview)
Final Rejection: Plan B3 – Notice of Appeal Options

Notice of Appeal Stages

(1) File Notice of Appeal
(2) Exit before brief or request for pre-appeal review
(3) Exit after request for pre-appeal review
(4) File brief but exit before Examiner’s reply brief
(5) File brief, Examiner replies, but exit before Board decision
“We find that patent applications fare surprisingly well in each of the stages preceding a [Board] decision. . . . This suggests that filing a notice of appeal, far from being a desperate prosecutorial act, may actually be a relatively effective strategy for garnering a positive outcome in patent prosecution…”

Andrew W. Torrance, *An Empirical Study of Patent Prosecution Success after the Filing of a Notice of Appeal*
The Commissioner of Patents and Trademarks

Has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.

Therefore, this

United States Patent

Grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America, import the invention into the United States of America for the term set forth below, subject to the payment of maintenance fees as provided by law.

If this application was filed prior to June 9, 1995, the term of this patent is the longer of seventeen years from the date of grant of this patent or twenty years from the earliest effective U.S. filing date of the application, subject to any statutory extension.

If this application was filed on or after June 9, 1995, the term of this patent is twenty years from the U.S. filing date, subject to any statutory extension. If the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121 or 365(c), the term of the patent is twenty years from the date on which the earliest application was filed, subject to any statutory extension.

Acting Commissioner of Patents and Trademarks

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