

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



USPTO Inventor Info Chat Series: Overview of Patent Examination

Office of Innovation Development

Daniel Kolker

Supervisory Patent Examiner

January 18, 2018

Email questions to:
inventorinfochat@uspto.gov

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Office of Innovation Development

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Overview

- When to expect a response from USPTO
- What does the examiner consider?
- How do I respond to an Office Action?
- How can I communicate with the examiner?

Send your questions to:

inventorinfochat@uspto.gov



Application is filed – what next?

- A patent is a right to exclude others from making, using, selling, importing the claimed invention in the U.S.
- Balance between rewarding invention and protecting the public domain.
- Patent applications are examined to ensure they comply with the patent laws.



In order for a patent to be granted, the claimed invention must be:

- Eligible for patenting and useful (35 USC §101)
 - Only a process, machine, manufacture, or composition of matter, or an improvement of one of these, can be patented.
 - Claimed invention must be useful.

In order for a patent to be granted, the claimed invention must be:

- New, as of the effective filing date (35 USC §102)
 - Exceptions for inventor-derived disclosures within a year of the effective filing date.
 - Other countries have different grace periods.
 - No patent granted on inventions that have been in use, described, or sold previously.



In order for a patent to be granted, the claimed invention must be:

- Non-obvious, as of the effective filing date (35 USC § 103)
 - Claimed invention compared to closest pre-existing technology known as prior art in patent law parlance.
 - Examiner determines differences between claimed invention and closest prior art.
 - Determines if the invention as a whole would have been obvious, given the differences between the claimed invention and the prior art.



In order for a patent to be granted, the claimed invention must be:

- Enabled and described (35 USC § 112(a))
 - The invention must be fully disclosed so that it can be practiced once it enters the public domain.
 - The disclosure must be in sufficient detail to allow one of ordinary skill in the relevant field to make and use the claimed invention.

In order for a patent to be granted, the claimed invention must be:

- Definite (35 USC § 112(b))
 - Public must be aware of what is, and is not, covered by the patent.
 - Claims support notice to the public by defining the rights of the patent grant.
 - This notice function of patent claims is supported by the statutory requirement that the claims be definite.

After Application is Filed

- Checked for formalities and fees by Office of Patent Application Processing
- Docketed to an examiner
 - Management matches the subject matter of the invention to the examiner's technical expertise.
 - Docketing based on technical expertise supports expedient quality examination.



Application Backlogs

- Technology-specific, but overall backlog is about 16 months from filing to first office action.
- Decreased from 17 months in October 2016 to 16.3 months in September 2017.
- First Office Action Estimate available on Private Patent Application Information Retrieval (PAIR) or <https://www.uspto.gov/learning-and-resources/statistics/first-office-action-estimator> (more general).

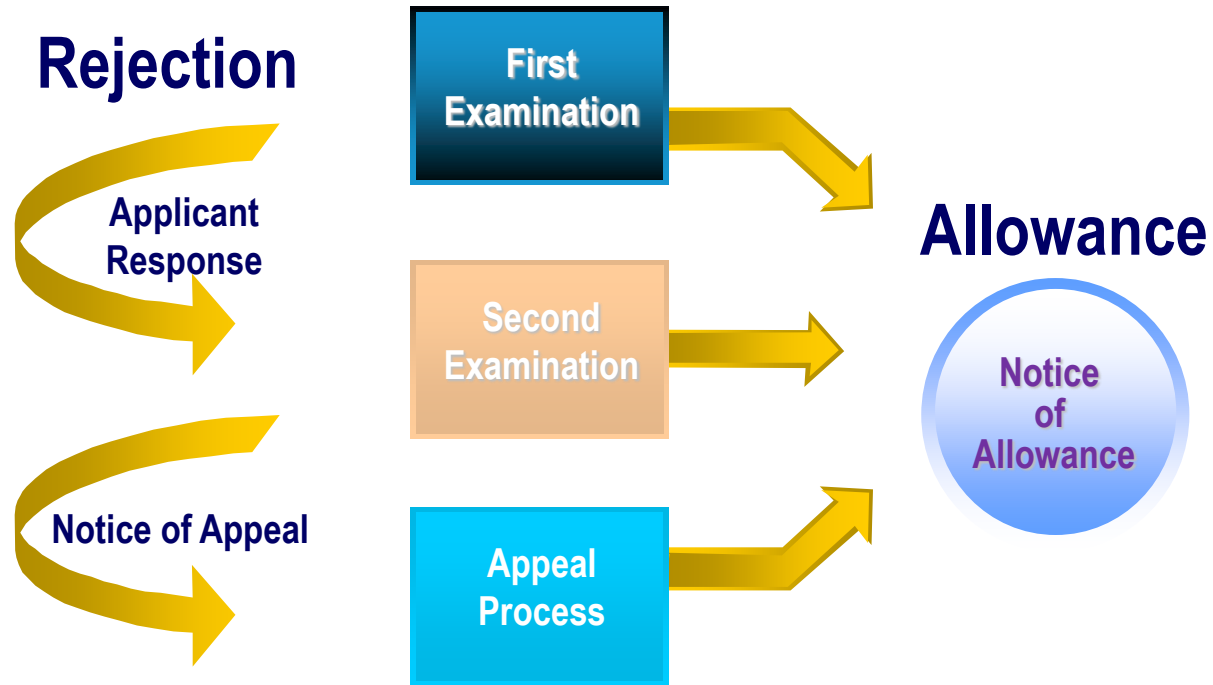


Patent Examination Process

- Restriction, if examiner determines multiple inventions are present
- First Office Action on the Merits
- Final Office Action
- Appeal
- Notice of Allowance may come at any point in the process



Patent Examination Process



Restriction

- If the claims encompass multiple inventions which are independent and distinct, examiner may require prosecution be limited to one invention.
- Other inventions can be prosecuted in divisional applications.

Restriction

- If restriction is required, applicant must elect an invention for prosecution.
- Required to elect even if you disagree with the examiner's determination.

First Office Action or Non-Final Rejection

- Examiner reads and understands the claimed invention.
- Examiner searches the relevant art, including:
 - Public disclosures, scientific meetings, journal articles, dissertations, sales brochures, internet resources.



First Office Action or Non-Final Rejection

- Based on the search and review of the application, examiner evaluates whether the claimed invention complies with the patent laws.
- Claimed invention must be:
 - Eligible for patenting and useful (35 USC §101)
 - New and non-obvious, as of effective filing date (35 USC §102, 103)
 - Described, enabled, and definite (35 USC §112)



First Office Action or Non-Final Rejection

- Examiner writes report, called Office Action, conveying findings on patentability.
 - May indicate some subject matter allowable
 - A rejection indicates the claim in question is not patentable

After First Office Action

- Consider an interview, or discussion with examiner, prior to filing response.
- Opportunity to explain invention and hear examiner's understanding.
- Remember: focus is on the claims.
- Phone, WebEx® video conference, In-Person: all are effective.



After First Office Action

- Applicant's turn to respond. All rejections and objections must be addressed.
- Multiple options:
 - Present amendments to the claims (Amendments are limited to the content of the specification as originally filed, cannot add anything to the claims that was not in original disclosure).
 - Present arguments to persuade the examiner as to the patentability of the claimed invention (Usually based upon the facts of the case or relevant principles of law).
 - Abandon application by not responding.

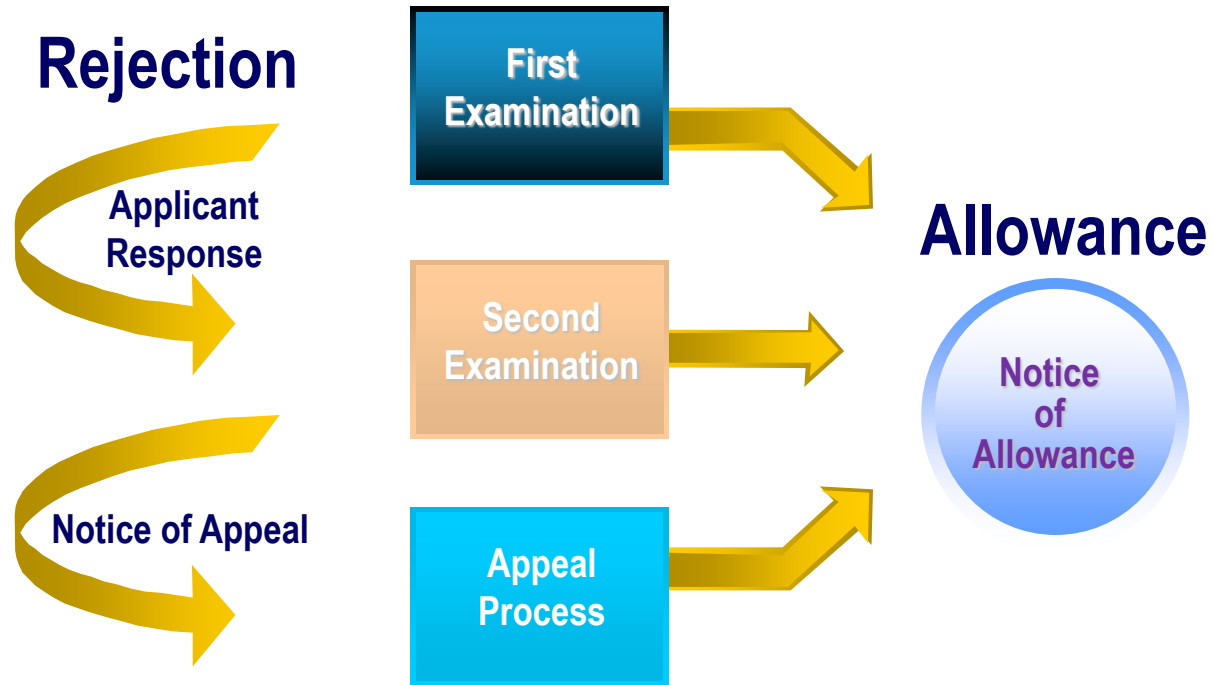


After First Office Action

- **Timeframe for response: 6 months total.**
 - First three months are free.
 - Respond within months 4-6 for a fee.
 - Not extendable past six months, except until next business day if 6 month date is a weekend or federal holiday.
 - Abandoned after six months.
- **To minimize fees, respond within first three months.**



Patent Examination Process



Second Examination – Final Rejection

- Response may overcome some issues, may raise new issues.
- An examiner's second Office Action may be designated final. After-final practice is more limited in terms of an applicant's options to respond.

After Final Rejection

- Options are more limited than after first office action
 - Amend to allowable subject matter
 - Notice of Appeal
 - Request for Continued Examination (RCE), requires fee and submission

After Notice of Allowance

- Notice of Allowance indicates patentable claims. Not a patent!
- Time to pay issue fee: 3 months, not extendable.

After patent grant

- Maintenance fees required to keep patent in force for its full life.
- Defers expenses until later; allows patentee to choose to let less valuable patents lapse.
- Current fees for micro entity:
 - \$400 at 3.5 years, \$900 at 7.5 years, \$1850 at 11.5 years.

Upcoming OID Events

- February 15 – Inventor Info Chat: Claim Drafting – Online
- August 2018 – Invention Con – Alexandria VA

For more information or to register for any of the above events contact us at oidevents@uspto.gov

<https://www.uspto.gov/patents-application-process/inventor-info-chat>





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Thank You!

Send your questions to:

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To inquire about OID services please contact us at:

InnovationDevelopment@uspto.gov

1.866.767.3848

Presented By:

Daniel Kolker

Daniel.Kolker@uspto.gov

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