

UNITED STATES
PATENT AND TRADEMARK OFFICE



***Thank you for logging in for the Inventor Info Chat.
The program will start at 11:00 am.***

Understanding The Patent Examination Process

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UNITED STATES
PATENT AND TRADEMARK OFFICE



Office of Innovation Development

- In Person Assistance (by appointment) for Pro Se Applicants
- Assistance Hotline 1-866-767-3848
- Patent Email Support
innovationdevelopment@uspto.gov
- PTRC Partnership for Patent Education Courses
 - Virtual Assistance Pilot Program
- Inventor Outreach
 - Independent Inventor Conferences
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- <http://www.uspto.gov/inventors>

Overview

- Explanation of the role of the patent examiner in examination of an application
- Explanation of the examination process
- Explanation of the office action
- Explanation of applicant's rights and responsibilities when responding to an office action
- Explanation of the appeal process

Patent Examination

- ***Patent Examiner reviews contents of the application for compliance with all U.S. patent legal requirements***
- ***Burden is on the examiner: An applicant is entitled to a patent unless...***
 - Requirements of U.S. patent law are not met***

Simplified Patent Application Examination Process

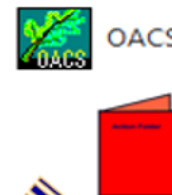
1. Examiner selects application from PALM docket in eDAN or DAV



2. Examiner reviews application, formulates search strategy, and performs prior art search



3. Examiner reviews prior art, applies art to application, and authors office action



4. Office action is forwarded for review and signature (if necessary) then routed to TSS for recording in PALM



6. Office action is indexed and scanned into IFW

5. Office action is forwarded to mailing contractor and mailed to applicant



Email questions to: inventorinfochat@uspto.gov

Terminology

Allowed: Patent application which has been indicated by an examiner as meeting all statutory (laws) and regulatory (rules) requirements – not patented yet; may or may not have been published

Patented: Allowed patent application which has been issued (published) on the patent (issue) date

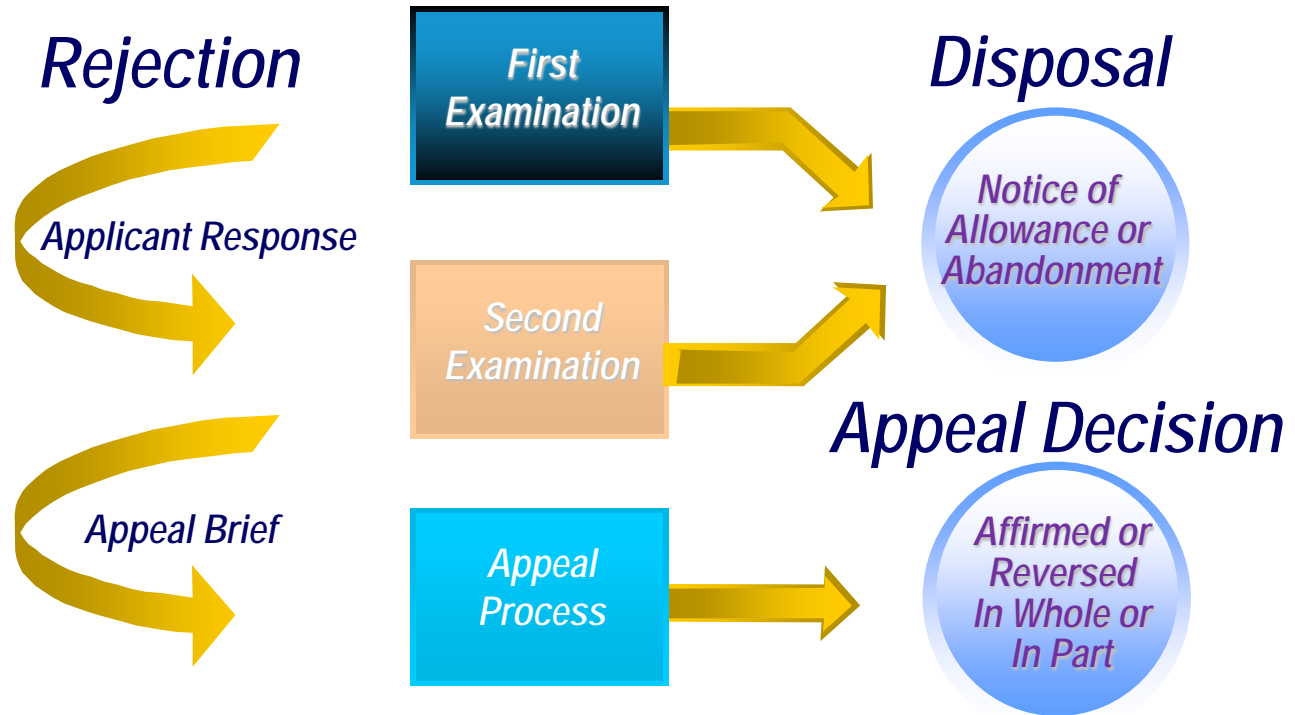
Abandoned: Application which is no longer pending and was not patented; abandonment may be expressly requested by applicant or be as a result of failing to respond within a set time period

Published Patent Application: An application published as part of PGPub (PreGrant Publication) in accordance with 35 U.S.C. §122(b)

Pendency: The time from a patent application's filing date until the date a patent is issued or the application is abandoned



The Examination Process



Please note that a negative opinion by the examiner may be correct. In those instances, a patent will not be granted. The Appeal Process can include appeals to the Patent Trial and Appeal Board, The US District Court for the Eastern District of Virginia, US Courts of Appeals for the Federal Circuit and The US Supreme Court.



The Office Action

Legal Record

- ***Sets forth the legal basis for any objections, rejections, and indications of allowable subject matter***
- ***Available to the public from www.uspto.gov (if published application)***
- ***Relied upon in any court proceedings for a resulting patent***
- ***Aids the public and the courts with the underlying rationale behind the prosecution history***
- ***Must be consistent with the policies of the Office, including:***
 - Manual of Patent Examining Procedures (MPEP)***
 - Published Guidelines (Interim or Final) used between MPEP updates***
 - Internal, unpublished positions***



Patent Examiner First Action on the Merits (FAOM)

- ***Reads and understands invention***
- ***Determines whether the application is adequate to define the metes and bounds of the claimed invention***
- ***Determines the scope of the claims***
- ***Searches existing technology for claimed invention***
- ***Determines patentability of claimed invention***
- ***Writes opinion – called an Office Action that notifies applicant of the examiner's patentability determination***

Opinion includes objections, rejections and/or indication of allowance of claimed invention presented based on Patent Laws

Sets forth a Shortened Statutory Period (SSP) for response

Email questions to:
inventorinfochat@uspto.gov



Laws/Rules – Application/Interpretation

Law = Title 35, United States Code

- Enacted by Congress, signed by the President
- USPTO does not have the authority to waive or interpret laws inconsistent with binding case law
- Basis for a ***rejection of claim(s)***
- If twice rejected, applicant may appeal to the Patent Trial and Appeal Board (PTAB)
- If PTAB affirms the examiner's rejection, judicial review may be sought at the CAFC or the U.S. District Court for the Eastern District of Virginia



Laws/Rules –

Application/Interpretation (*cont.*)

Rules = Title 37, Code of Federal Regulations (CFR)

- USPTO has authority to make changes in certain instances, subject to approval of the Office of Management and Budget (OMB)
- USPTO has the authority to waive its own rules so long as such waiver is not inconsistent with the law.
- The rules implement the patent law enacted by Congress so that the law can be administered. The rules set forth the procedures for complying with the law.



Laws/Rules – Applications are

Confidential

37 CFR 1.14: Patent applications preserved in confidence.

- Unless/until published/patented, patent applications are preserved in confidence
 - 37 CFR 1.14(a):
 - Patent applications that have not been published under 35 U.S.C. §122(b) are generally preserved in confidence pursuant to 35 U.S.C. §122(a)
 - Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in §1.11 or in this section



Laws/Rules – 35 U.S.C. §101

- 35 U.S.C. §101
 - 4 categories of patent-eligible (statutory) subject matter
 - Process, machine, article of manufacture, or composition of matter
 - includes improvement inventions in any of the 4 categories
 - Specific, substantial, and credible utility
 - 1 invention = 1 patent (restriction and double patenting)



Laws/Rules – Prior Art Rejections

- ***Rejections made under 35 U.S.C. §102 or §103 are commonly referred to as “prior art rejections”***
- 35 U.S.C. §102
 - Novelty (new)
 - Anticipation (every claimed feature present in a reference)
 - Defines what qualifies as “prior art”
- 35 U.S.C. §103
 - Non-obvious (legal determination)
 - Concept of “one of ordinary skill in the pertinent art”



Laws/Rules – Prior Art Rejections (*cont.*)

- 35 U.S.C. §101 sets forth patent-eligible subject matter. Notwithstanding the word “new” in the phrase “new and useful,” it is not a redundant test. Instead, it is a precursor to 35 U.S.C. §§ 102 and 103, which require the subject matter to be novel and unobvious, respectively, over the prior art.
- The public relies on the USPTO to ensure that whatever is patented was, as of the effective filing date, not only patent-eligible subject matter, but also new and unobvious



Laws/Rules – Prior Art Rejections

(cont.)

- The most common type of prior art is a reference document, such as:
 - Patents (foreign and domestic)
 - Patent application publications (international, foreign, and domestic)
 - Non-patent literature (NPL), e.g., books, journal articles, web-based publications, etc.
- Another type of prior art is applicant admitted prior art (AAPA)
- 37 CFR sets forth various rules that dictate how prior art gets made of record in a U.S. patent application



Laws/Rules – Mechanisms Through Which Art is Made Part of the Application

- 37 CFR 1.104 Nature of examination
 - *...On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention....*
- 37 CFR 1.56 Duty to disclose information material to patentability
 - *...Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section....*
 - 37 CFR 1.97 Filing of information disclosure statement
 - 37 CFR 1.98 Content of information disclosure statement



Laws/Rules – Mechanisms Through Which Art is Made Part of the Application

- 37 CFR 1.290 Third-party preissuance submissions
 - *Members of the public may submit relevant references within 6 months after the PGPub date unless a notice of allowance was already mailed by then; or up to the date of first rejection if the date of first rejection occurs more than 6 months from the PGPub date*
- 37 CFR 1.105 Requirements for information.
 - *Examiner may request information from individuals identified in §1.56(c) as may be reasonably necessary to properly examine or treat a matter*

Laws/Rules – 35 U.S.C. §112

- 35 U.S.C. §112
 - Specification requirements
 - Written Description
 - Enablement
 - Best Mode
 - Claim requirements
 - Content
 - Particularly point out (not vague); distinctly claim (not indefinite)
 - Format
 - Independent, dependent, multiple dependent



Office Action

| | | | |
|------------------------------|-------------------------------|----------------------------|------------|
| Office Action Summary | Application No. ██████████ | Applicant(s) ██████████ | |
| | Examiner ██████████ | Art Unit ██████████ | ██████████ |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03 March 2011.

2a) This action is **FINAL**. 2b) This action is non-final.

3) An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5) Claim(s) 1-5 is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6) Claim(s) _____ is/are allowed.

7) Claim(s) 1-5 is/are rejected.

8) Claim(s) _____ is/are objected to.

9) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10) The specification is objected to by the Examiner.

11) The drawing(s) filed on 03 March 2011 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/11/2011

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date, _____

5) Notice of Informal Patent Application

6) Other: _____

- **Office action Summary Sheet**
- **Detailed reasons and support for why applicant is not entitled to a patent at this time will accompany the Office action Summary Sheet**
- **Note in particular the type of Office action (non-final or final) and the shortened statutory period (SSP) for reply**
- **The Summary Sheet includes a listing of attachments that are included with the Office action**

Applicant Response

- ***Regarding Amendments:***
- ***Non-final Office Action***
 - ***Right of entry (37 CFR § 1.111)***
- ***Final Office Action (close of prosecution)***
 - ***No right of entry (37 CFR § 1.116)***

Applicant Response

- Requirements of Amendment
 - Answer all formal objections and rejections
 - Amendments must be filed timely in accordance with the SSP and 37 CFR § 1.136
 - Contain amendments and/or arguments (generally both)
 - 37 CFR § 1.121 governs manner of making amendments
 - Must be signed by the authorized individual (attorney or pro se applicant)
 - Sample amendment format available at <http://www.uspto.gov/sites/default/files/web/offices/pac/dapp/opla/preognotice/formatrevamdtprac.pdf>



Final Rejection

- ***May occur on second (or later) consideration if the application includes claims that are not allowable. The examiner's final Office Action would notify applicant of the examiner's final patentability determination***
 - ***The final Office action could include objections, rejections and/or indication of allowable subject matter***
 - ***Sets forth a Shortened Statutory Period (SSP) for response***
 - ***Prosecution is considered to be closed***
 - ***Further amendment (after final) is restricted (37 CFR § 1.113 & § 1.116)***



Allowance

- **A Notice of Allowability form PTOL-37 is used whenever an application has been placed in condition for allowance.**
- **A notice of Allowance and Issue Fee Due (PTOL-85) will normally accompany a Notice of Allowability.**

| Notice of Allowability | Application No. | Applicant(s) | |
|--|-----------------|--------------|---|
| | Examiner | Art Unit | AIA (First Inventor to File) Status No |
| <p align="center">-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--</p> <p>All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.</p> | | | |
| <p>1. <input type="checkbox"/> This communication is responsive to _____ <input type="checkbox"/> A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on _____.</p> <p>2. <input type="checkbox"/> An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.</p> <p>3. <input type="checkbox"/> The allowed claim(s) is/are _____. As a result of the allowed claim(s), you may be eligible to benefit from the Patent Prosecution Highway program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.</p> <p>4. <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(c) or (f). Certified copies: a) <input type="checkbox"/> All b) <input type="checkbox"/> Some *c) <input type="checkbox"/> None of the: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)). * Certified copies not received: _____.</p> <p>Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.</p> <p>5. <input type="checkbox"/> CORRECTED DRAWINGS (as "replacement sheets") must be submitted. <input type="checkbox"/> including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____. Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).</p> <p>6. <input type="checkbox"/> DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.</p> <p>Attachment(s) 1. <input type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____ 3. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material 4. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____ 5. <input type="checkbox"/> Examiner's Amendment/Comment 6. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance 7. <input type="checkbox"/> Other _____</p> | | | |
| <p align="center">U.S. Patent and Trademark Office PTOL-37 (Rev. 08-13) Notice of Allowability Part of Paper No./Mail Date</p> | | | |



Applicant's Options After Final are Limited

- ***To avoid abandonment, Applicant's reply options are:***
 - ***Filing an After Final Reply (§1.116) that places the application in condition for allowance;***
 - ***Appealing any rejections (§41.31); or***
 - ***Filing an RCE (§1.114).***

- ***MPEP §§ 706.07 and 714.13 II***

After Final Rejection, Applicant Has No Right to Unrestricted Further Prosecution

- ***37 CFR §1.116 applies to replies filed After Final action.***
- ***Once a proper Final Rejection has been entered in an application, Applicant or Patent Owner no longer has any right to unrestricted further prosecution.
See: MPEP §714.12.***
- ***Ordinarily, amendments filed after the Final Action are not entered unless approved by the Examiner.***



Processing After Final Replies

After Final replies should be processed and considered promptly.

- ***Examiner's action in response to After-Final Reply under §1.116 should be mailed within 30 days of Office receipt of the After-Final reply.***

See: MPEP §714.13 III



Period for Reply to Final Office Action

- ***Shortened Statutory Period (SSP): 3 months***
 - ***SSP starts from the date the Final rejection is mailed.***
 - ***can be extended up to additional 3 months.***
- ***Replies After Final will not be considered by the Examiner unless they are filed within the SSP or are accompanied by a petition for an extension of time and the appropriate fee.***

Advisory Actions

If the Applicant's after-final reply does not place the application in condition for allowance, an Advisory Action (PTOL-303) should be sent to the Applicant stating the remaining period for reply. If no Notice of Appeal was filed:

- Normally, the reply period continues to run 3 months from the mailing date of the Final Rejection plus any extensions of time paid for.
- However, if the Advisory Action is mailed more than 3 months after the mailing date of the final rejection in response to an after-final reply filed within 2 months of the mailing date of the final rejection, the SSP ends on the mailing date of the Advisory Action.



Filing of a Notice of Appeal After a Final Rejection

Remember, after a Final rejection, Applicant's reply options are:

- Filing an After Final Reply that places the application in condition for allowance (§ 1.116);***
- Appeal of any rejections (§ 41.31); or***
- Filing an RCE (§ 1.114).***

Appeal

- *After claims either 1) twice rejected or 2) finally rejected, an application may be appealed to the Patent Trial Appeal Board*
- *Guidance for filing a Notice of Appeal, Appeal Brief and appropriate fees are found in MPEP sections 1204 and 1205.*

Request for Continued Examination (RCE)

After Final Rejection, Applicant's reply options are:

- ***Filing an After Final Amendment that places the application in condition for allowance (§ 1.116);***
- ***Appeal of any rejections (§ 41.31); or***
- ***Filing an RCE (§ 1.114)***

Request for Continued Examination (RCE)- What is it?

- ***A procedure set forth in 37 CFR 1.114 under which an Applicant may obtain continued examination of an application in which prosecution is closed (i.e., the application is under final rejection or appeal, a notice of allowance, or an action that otherwise closes prosecution in the application such as Ex parte Quayle).***
- ***An RCE is not the filing of a new application.***
- ***See: MPEP §706.07(h)***

Request for Continued Examination (RCE)- What is it? (cont.)

- ***An RCE is not the filing of a new application.***
- ***If Applicant timely files a submission and fee, the Office will withdraw the finality of any Office action and the submission will be entered and considered.***

Options for Continuing Applications:

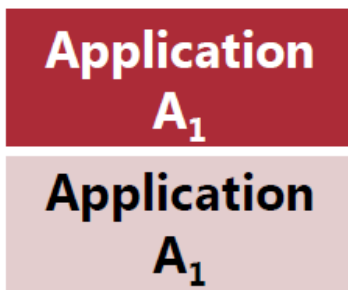
- ***Continuation***
- ***Continuation-in-Part***
- ***Divisional***

Continuation/Continuation-in-Part (CIP)

Continuation:

(MPEP 201.07)

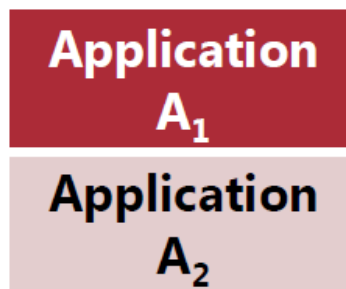
Has same disclosure as
"parent"



Continuation-in-Part:

(MPEP 201.08)

Disclosure includes *additional*
subject matter not disclosed
in parent



Divisional Application (DIV)

Has same disclosure as “parent,” but claims an invention independent or distinct from the invention claimed in the parent

(MPEP 201.06)

Application

A₁

Application

B₁



Helpful Hint: Have an Interview

Interview

- ***Pro Se***

In person, over the phone, or via WebEx

- ***Attorney/Agent***

In person, over the phone, or via WebEx

Inventor cannot have an interview without their attorney or agent present

Use USPTO Automated Interview Request (AIR) form found on

<https://www.uspto.gov/patent/uspto-automated-interview-request-air-form>



Tips for Requesting and Preparing for an Interview

Once the need for an interview is recognized, applicant should

- ***Submit a request for an interview as early as possible***
- ***Provide a detailed agenda, reference support for any - proposed claim or spec. amendments***
- ***Be prepared to explain the “inventive concept” of the invention***
- ***Summarize the interview in the next response***



Recordation of Interviews

- ***Agendas, proposed amendments and remarks, submitted (email, fax, etc.) to the Office, will be retained as part of the application record***
- ***Interview summary, completed after interview, captures the thrust of the issues and arguments presented***
- ***Comments & Questions – ExaminerInterviewPractice@uspto.gov***



Allowance and Issue

- ***Fees***

- ***No extension of time permitted***
- ***Check the current fee schedule at:***

<http://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>

- ***Amendments after allowance***

- ***Minor corrections, drawings, formal matters***

- ***Corrections***

- ***Inventorship, misspelled words***

- ***Time to publish the patent***

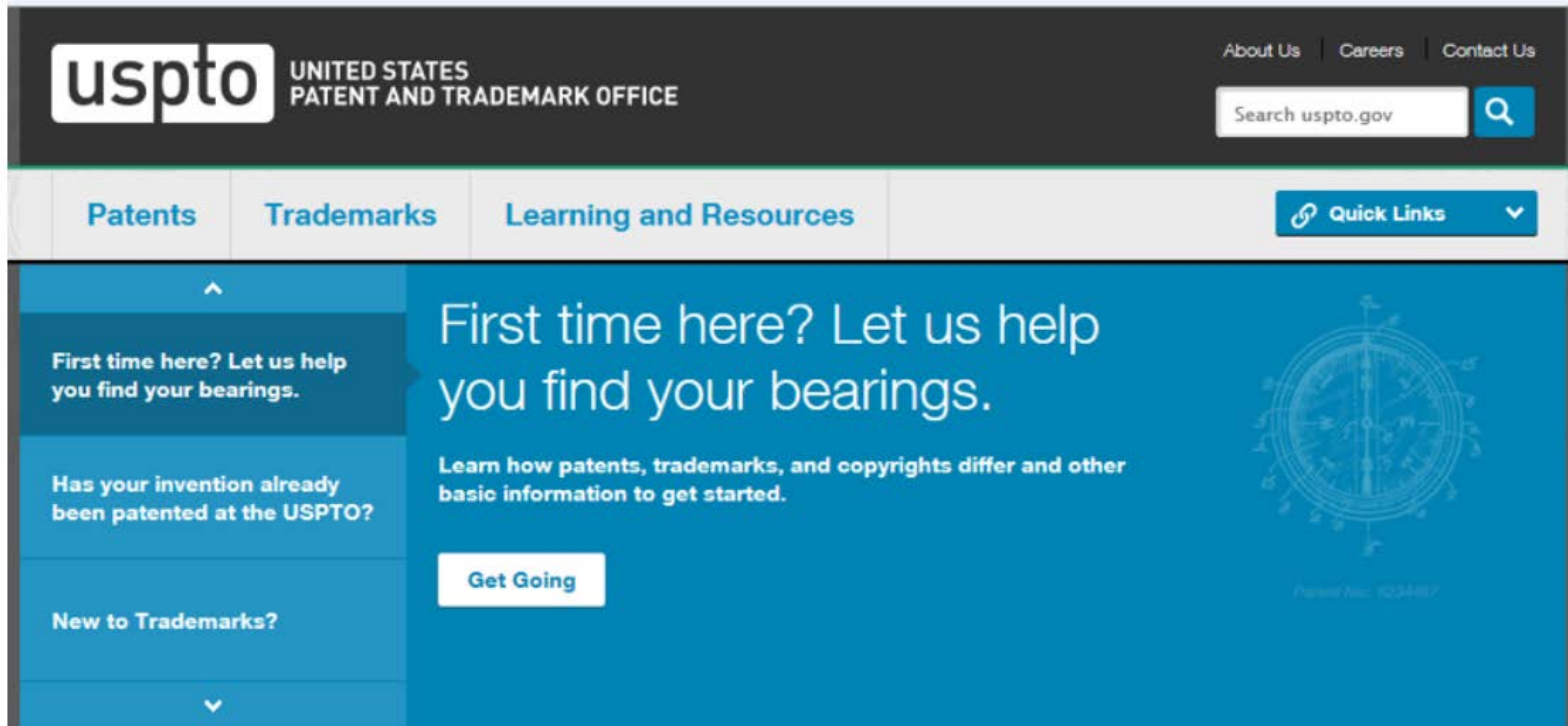


After Patent Grant

- ***Maintenance fees for utility patents***
 - ***Due 3.5, 7.5, and 11.5 years after patent issue date***
- ***Correction***
 - ***Certificate of Correction***
 - ***Reissue***

Resource – USPTO on the web

www.uspto.gov



The screenshot shows the USPTO website homepage. At the top left is the 'uspto' logo and the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. To the right are links for 'About Us', 'Careers', and 'Contact Us'. A search bar with the placeholder 'Search uspto.gov' and a magnifying glass icon is located in the top right. Below the header is a navigation bar with 'Patents', 'Trademarks', and 'Learning and Resources' tabs, and a 'Quick Links' dropdown menu. The main content area features a blue banner with the text 'First time here? Let us help you find your bearings.' and 'Learn how patents, trademarks, and copyrights differ and other basic information to get started.' A 'Get Going' button is positioned below this text. On the left side of the banner, there are three vertical links: 'First time here? Let us help you find your bearings.', 'Has your invention already been patented at the USPTO?', and 'New to Trademarks?'. A compass graphic is visible on the right side of the banner.

Email questions to:
inventorinfochat@uspto.gov

Questions?

Email questions to:
inventorinfochat@uspto.gov



Upcoming OI Events

- 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>



UNITED STATES
PATENT AND TRADEMARK OFFICE

Thank You!

Send your questions to: inventorinfochat@uspto.gov

To inquire about OLD services please contact us at:

InnovationDevelopment@uspto.gov

1.866.767.3848



Email questions to:
inventorinfochat@uspto.gov

