

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Understanding the patent examination process

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Office of Patent Training

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UNITED STATES
PATENT AND TRADEMARK OFFICE



Learning outcomes

At the end of this session, you will be able to:

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



Role of patent examiner

- To serve as advocate/protector of the public interest with respect to intellectual property.
- To provide direct service and assistance to customers from inside and outside the USPTO.
- To serve as a judge on patentability with respect to invention(s) claimed in a patent application under the conditions for patentability set forth in Title 35 of the United States Code.



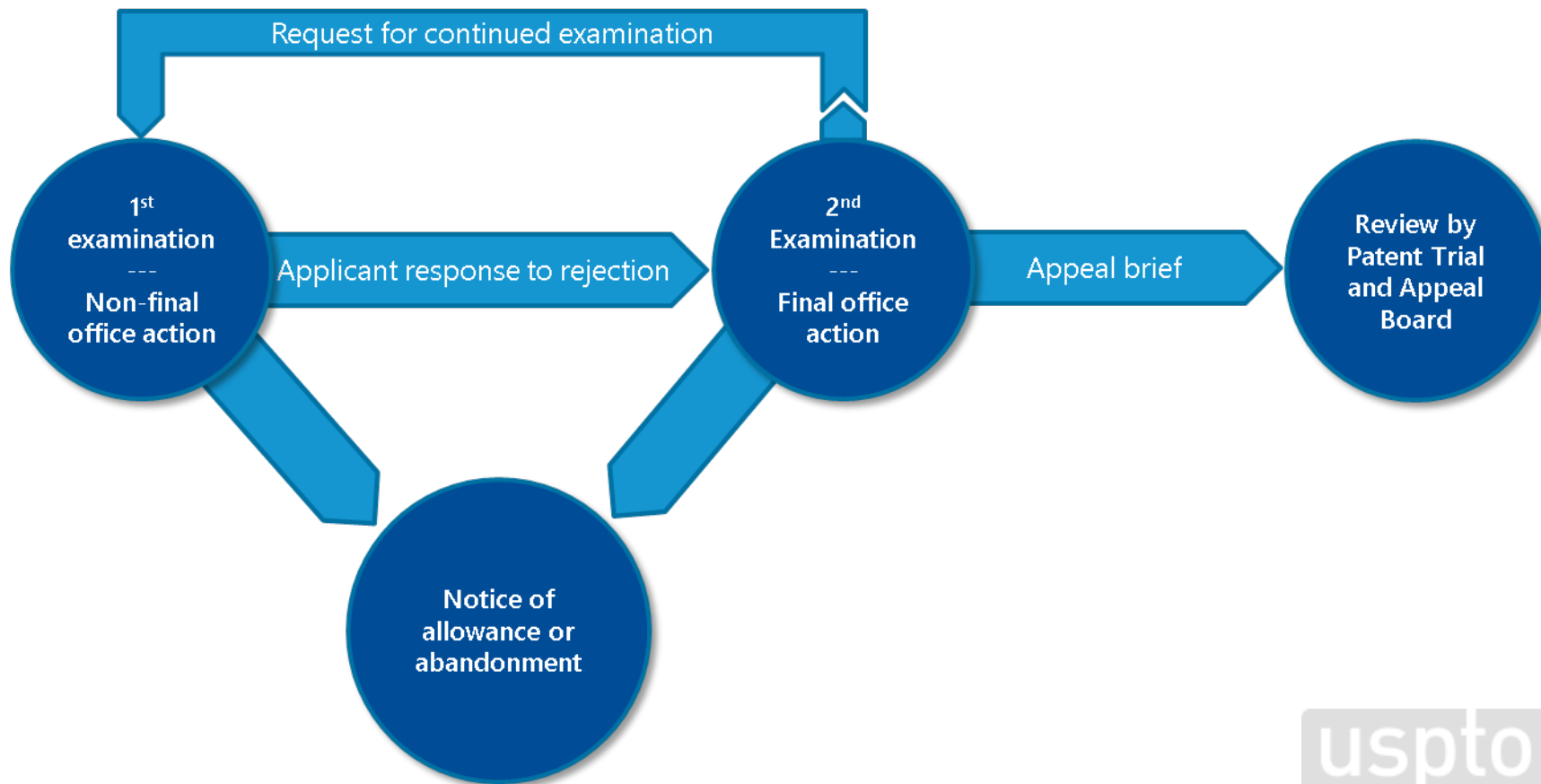
uspto



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.

Simplified patent examination process





Patent examiner responsibilities

Pre-search activities	Search	Patentability and office's position
<p>Reads and understands the invention set forth in the specification.</p> <p>Determines whether the application is adequate to define the metes and bounds of the claimed invention.</p> <p>Determines the scope of the claim(s).</p>	<p>Searches existing technology for claimed invention.</p>	<p>Writes office actions identifying and analyzing all issues pertinent to patentability of the claimed invention.</p> <p>Responds completely to applicant's reply.</p> <p>Issues notice of allowance or notice of abandonment.</p>

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



Statutes

Law=Title 35, United States Code (U.S.C.)

- Enacted by Congress, signed by the President.
- The 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.

Rules

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

- The USPTO has authority to make changes in certain instances, subject to approval of the Office of Management and Budget (OMB).
- The USPTO has the authority to waive or interpret the rules.
- CFR is basis for an **objection** to any part of an application, including the claims.
- Once a requirement is made final, applicant may **petition** the examiner's holding.
- Petition is decided by appropriate USPTO official - see the *Manual of Patent Examining Procedure (MPEP) Chapter 1000*.
- If both rejection and objection are present, related matters that are part of the rejection and the objection may be decided by the PTAB.

Basis for rejection

35 U.S.C. §101	Inventions patentable
35 U.S.C. §112	Specification
35 U.S.C. §102	Conditions for patentability: novelty
35 U.S.C. §103	Conditions for patentability: non-obvious subject matter

35 U.S.C. §101

1. Statutory double patenting (1 invention=1 patent)
2. Inventorship (proper inventor(s) named)
3. Eligibility
 - a) Falls within one of the four categories of patent-eligible (statutory) subject matter - process, machine, article of manufacture, or composition of matter (or improvements thereof)
 - b) Not directed to a judicial exception without additional limitations amounting to significantly more
4. **Specific, substantial, and credible utility**

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

35 U.S.C. §102 and §103

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 (no difference)
 - Defines “prior” art
- **35 U.S.C. §103**
 - Non-obvious (legal determination)
 - Concept of “one of ordinary skill in the pertinent art”

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; future classes will discuss in-depth how 35 U.S.C. §102 dictates the who, what, where, and when art is available as “prior art” for the particular application under examination.

Mechanisms through which art is made part of the application

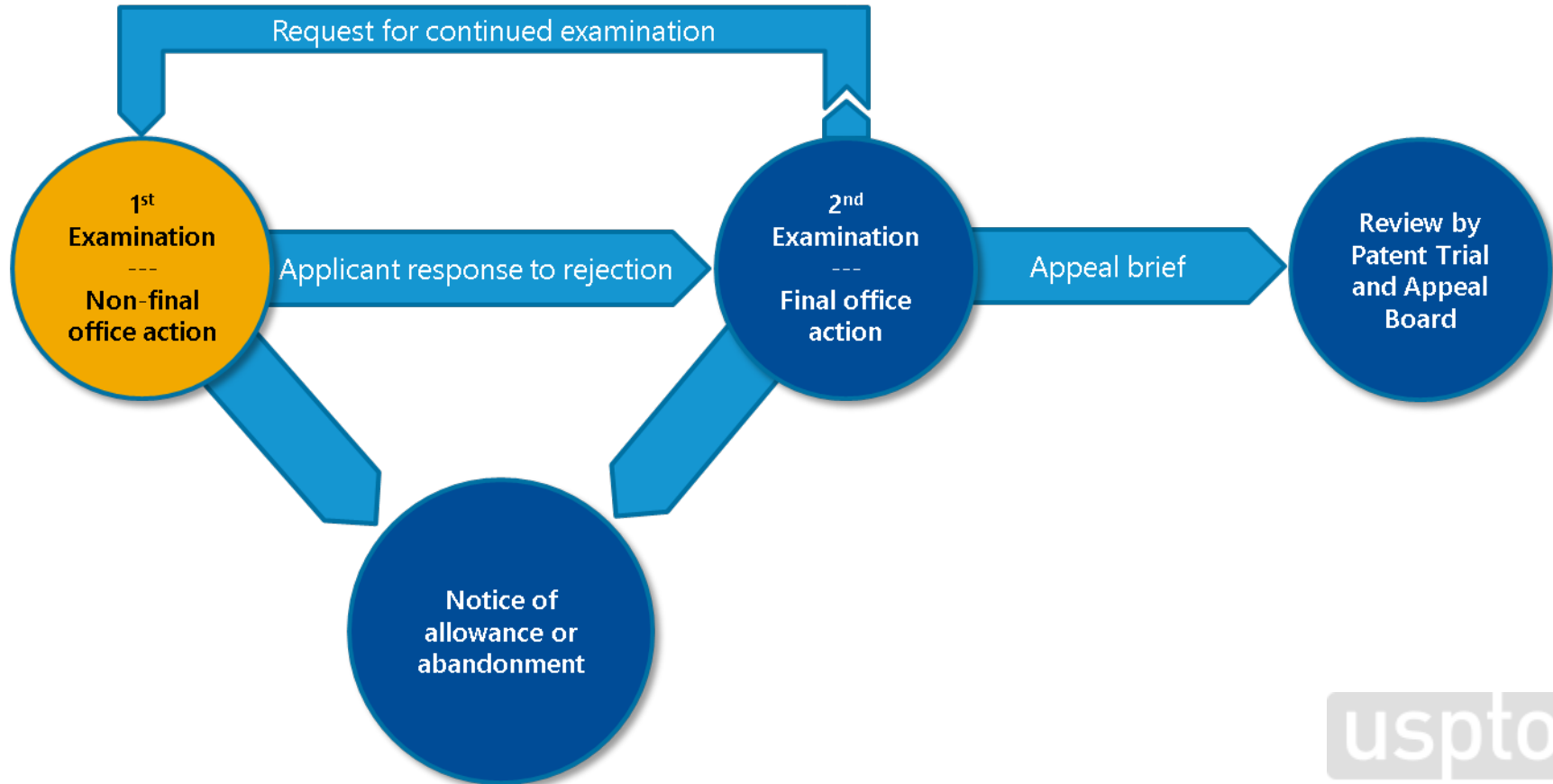
- 37 CFR 1.104 Nature of examination
 - "... On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. ..."
- 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




Mechanisms through which art is made part of the application (cont.)

- 37 CFR 1.290 Third-party preissuance submissions
 - Members of the public may submit relevant references within six 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 six 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.

Office action



Office action

- Office action summary sheet 
 - Includes listing of attachments that are included with the office action.
- 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.

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 operation, cause the application to become ABANDONED (37 CFR 1.131).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any warranted patent term adjustment. See 37 CFR 1.705(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) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Drafting/Preparer's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Paper No(s)/Mail Date _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date # <u>11/2011</u>	6) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other _____

Office action (cont.)

DETAILED ACTION

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the transmitter of claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a)(1) the claimed invention was patented, described in a printed publication, or in public use, on sale or otherwise available to the public before the effective filing date of the claimed invention.

3. Claims 1–XX are rejected under 35 U.S.C. 102(a)(1) as being anticipated by Doe et al. (U.S. Patent No. X,XXX,XXX).
Regarding claim 1, Doe teaches ...

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102 of this title, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims XX and XX are rejected under 35 U.S.C. 103 as being unpatentable over Doe et al. (U.S. Patent No. X,XXX,XXX), in view of Jane. (US PG PUB 2020XXXXXX).
Regarding claim XX, Doe teaches ...
Doe fails to teach ...
However, Jane teaches ...
It would have been obvious to one of ordinary skill in the art before the effective filing of the claimed invention ...]

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference (U.S. Patent No. X,XXX,XXX) teaches ...

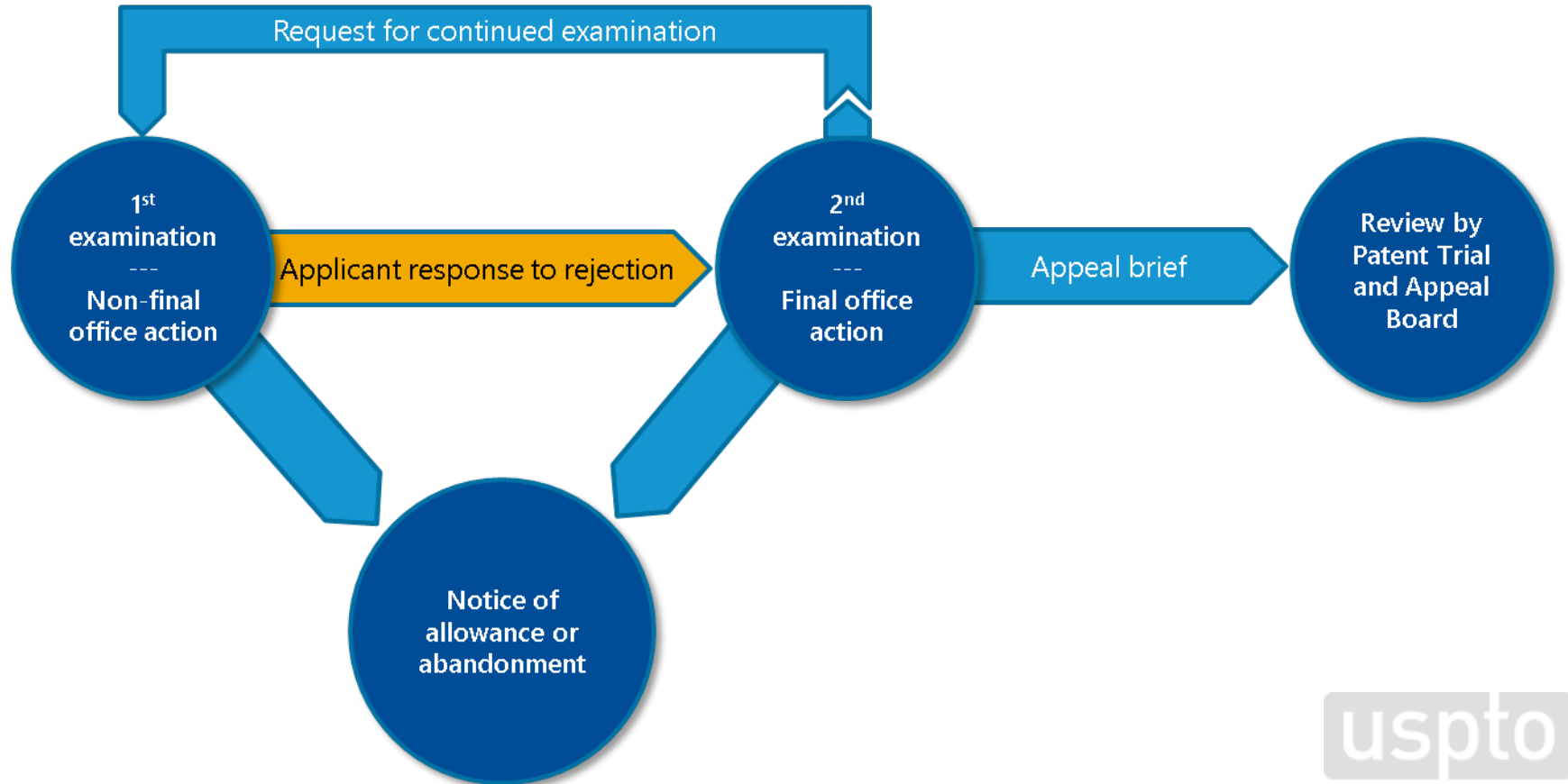
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EXAMINER whose telephone number is (571)XXX-XXX. The examiner can normally be reached on 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EXAMINERS SUPERVISOR can be reached on 571-XXX-XXX. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). (FP FINISH)

/EXAMINER/
Primary Examiner
Art Unit 9999
8/20/2020

Applicant's response

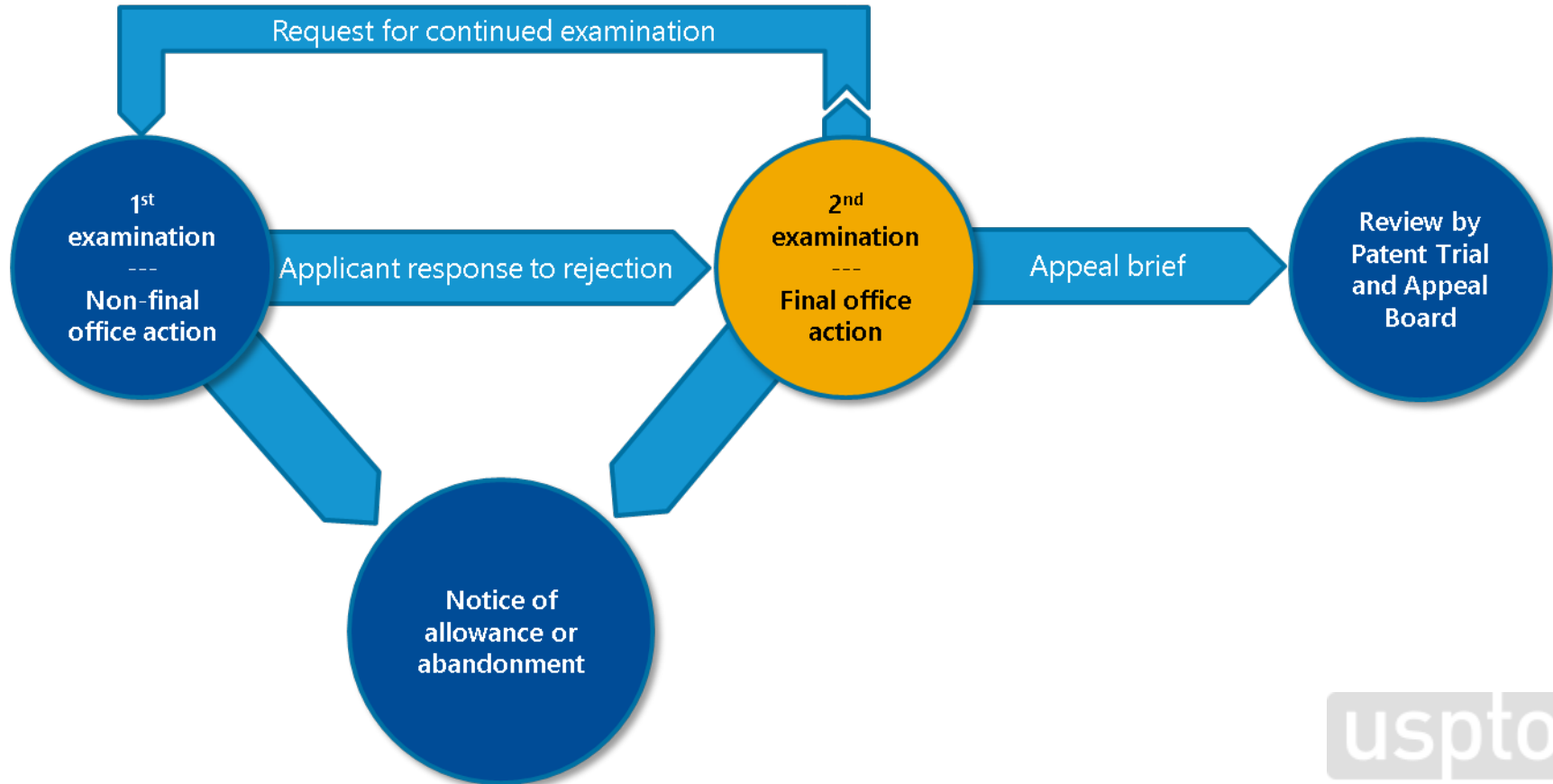




Applicant's response

- Must answer all formal objections and rejections
- Contain amendments and/or arguments (generally both)
 - Amendments must be filed timely in accordance with the SSP and 37 CFR § 1.136
 - 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 www.uspto.gov/sites/default/files/web/offices/pac/dapp/opla/preog_notice/formatrevamdtprac.pdf

Final office action





Final office action

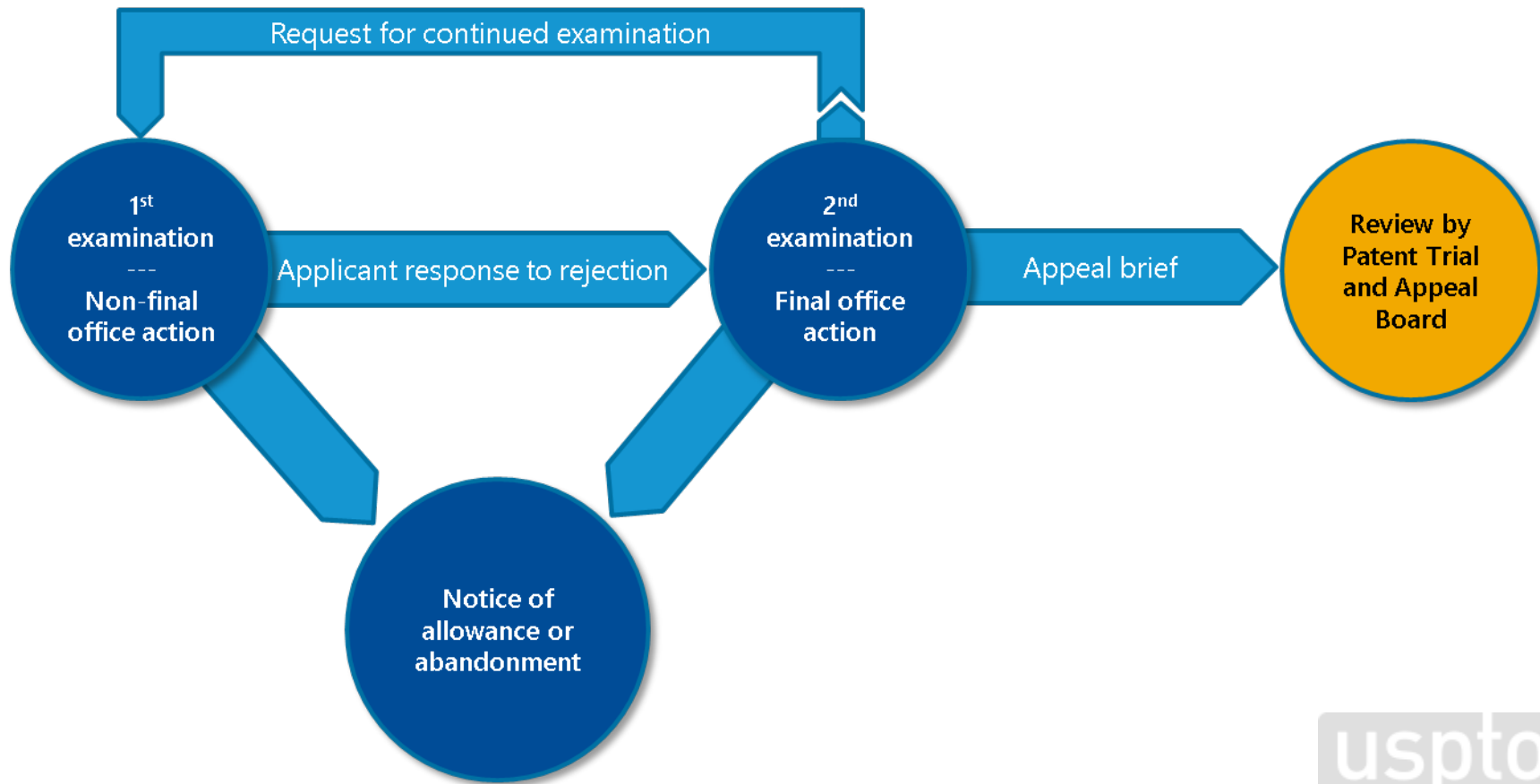
- May occur on second (or later) examination of the application if there are claims that are not allowable.
- The examiner's final office action would notify applicant of the examiner's final patentability determination.
 - The final office action could include objections, rejections, and/or indication 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).

After final rejection

- To avoid abandonment, an applicant has the following options:
 - Filing a reply after final action (§1.116)
 - Appealing any rejections (§41.31); or
 - Filing a request for continued examination (RCE) (§1.114).

See: MPEP 714.13(II)

Appeal



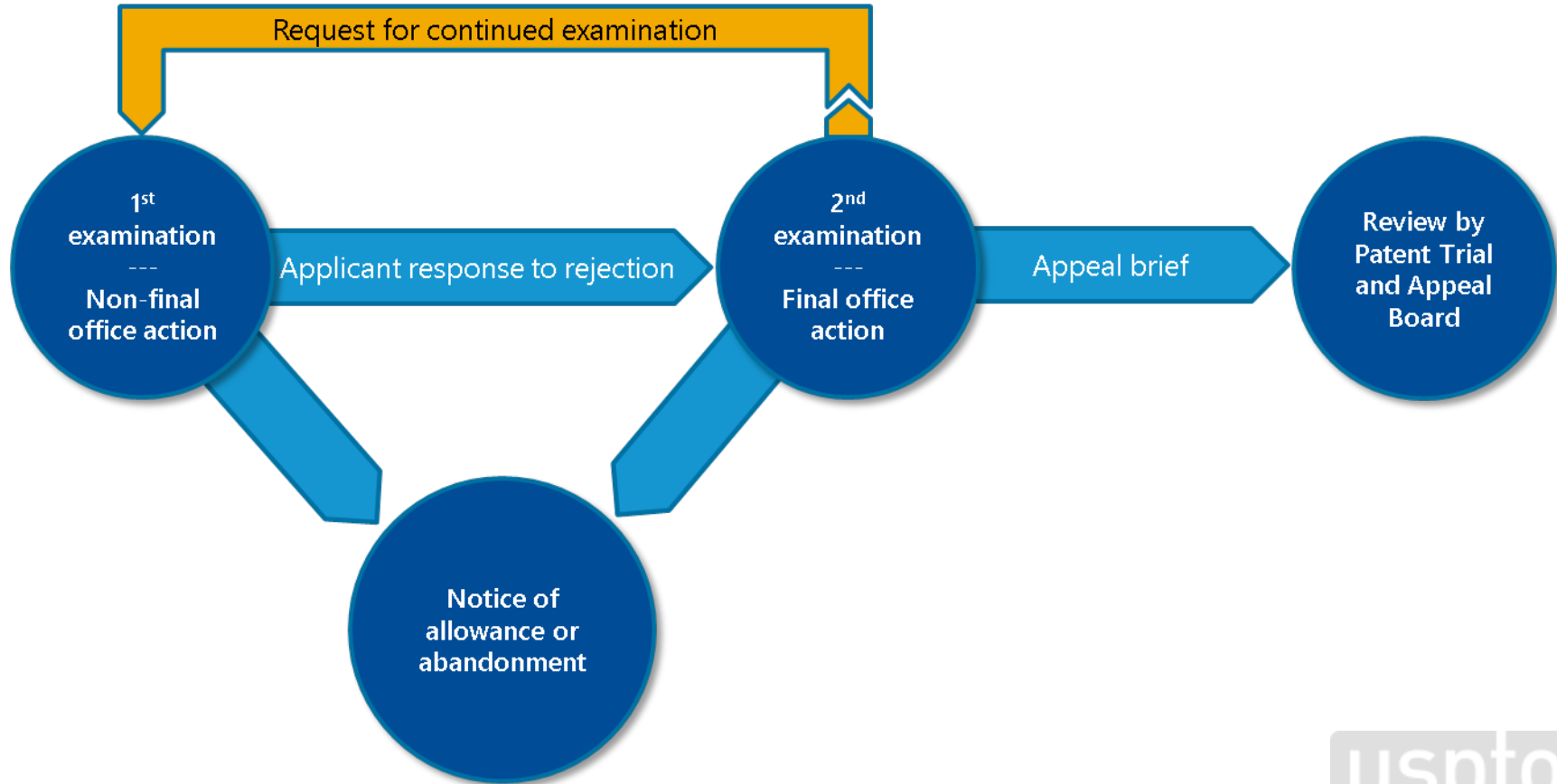


Appeal

- A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected.
- The limitation of "twice rejected" does not have to be related to a particular application.
- Guidance for filing a Notice of Appeal, Appeal Brief and appropriate fees are found in MPEP sections 1204 and 1205.

See MPEP 1204(II)

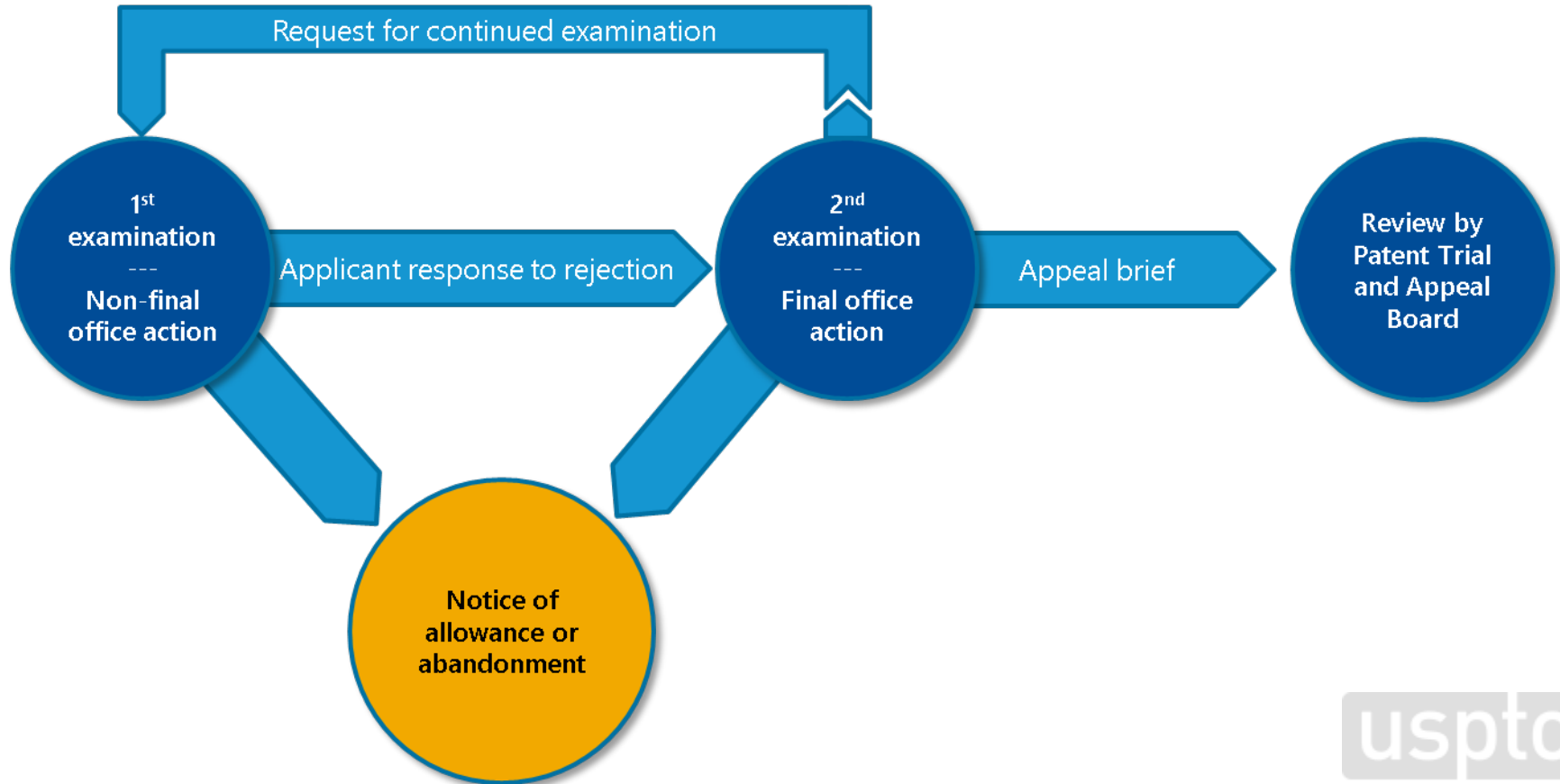
Request for continued examination (RCE)



Request for continued examination (RCE)

- 37 CFR 1.114: If applicant timely files a submission and fee in an application in which prosecution is closed, the office will withdraw the finality of any office action and the submission will be entered and considered.
 - Prosecution is closed when, for example, 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.

Allowance



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	AIX (First Inventor to File Status)	No
<p align="center">-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address-- 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/iph/index.jsp or send an inquiry to PPH-fee@uspto.gov.</p>				
<p>4. <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) 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)</p>				
<p>1. <input type="checkbox"/> Notice of References Cited (PTO-892)</p>		<p>5. <input type="checkbox"/> Examiner's Amendment/Comment</p>		
<p>2. <input type="checkbox"/> Information Disclosure Statements (PTO/IS/08), Paper No./Mail Date _____</p>		<p>6. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance</p>		
<p>3. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material</p>		<p>7. <input type="checkbox"/> Other _____</p>		
<p>4. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____</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>				

Allowance, issue, and after patent grant

Allowance	Issue	After patent grant
<ul style="list-style-type: none">• “Allowance” refers to the decision-making aspect of the process.	<ul style="list-style-type: none">• “Issue” refers to the administrative and procedural aspects of the process.• An application is ISSUED after a decision to ALLOW the application has been made by the examiner	<ul style="list-style-type: none">• Maintenance fees for utility patents due 3.5, 7.5, and 11.5 years after patent issue date.• Correction by way of Certificate of Correction or Reissue.

Interview practice

- The USPTO encourages examiners to take a proactive approach to examination by reaching out and engaging our stakeholders in an effort to resolve issues and shorten prosecution.
 - The USPTO [Interview Practice site](#) is a great resource
- An interview can take place over the phone or via WebEx with a pro se applicant or the applicant's attorney/agent of record.
 - Telephonic/video conference interviews will not be recorded; however, the substance of the interview will be documented by the examiner in an interview summary according to standard practice.
- In addition to calling the examiner, the [Automated Interview Request \(AIR\) form](#) can be also used to schedule an interview with an examiner for a pending patent application.

Resources

- Patent process overview:
www.uspto.gov/patents-getting-started/patent-process-overview

Questions?



Thank you!

www.uspto.gov