



# The Role of the Patent Examiner

**Sue A. Purvis**

*Innovation and Outreach Coordinator*

*Greater New York Region*

U.S. Patent and Trademark Office

Department of Commerce



# Outline

- My Career Path
- Role of a Patent Examiner
- Job / Responsibility of a Patent Examiner
- Tools of a Patent Examiner

# Outreach in NYC



# United States Patents

- Grant of intellectual property right to exclude others from making, using, selling or importing
- Patent document describes how to make and use invention
  - Includes a “claim” setting forth the protected invention

# History Of the US Patent System

Patent No x-1 (July 31, 1790)



The United States.

To all to whom these Presents shall come. Greeting.

Whereas Samuel Hopkins of the City of Philadelphia and State of Pennsylvania hath discovered an Improvement, not known or used before such Discovery, in the making of Pot. ash and Pearl ash by a new Apparatus and Process, that is to say, in the making of Pearl ash 1<sup>st</sup> by burning the raw Ashes in a Furnace, 2<sup>d</sup> by dissolving and boiling them when so burnt in Water, 3<sup>d</sup> by drawing off and settling the ley, and 4<sup>th</sup> by boiling the ley into Salts which then are the true Pearl ash; and also in the making of Pot. ash by fluxing the Pearl ash so made as aforesaid; which Operation of burning the raw Ashes in a Furnace, preparatory to their Dissolution and boiling in Water, is new, leaves little Residuum; and produces a much greater Quantity of Salt: These are therefore in pursuance of the Act, entitled "An Act to promote the Progress of useful Arts", to grant to the said Samuel Hopkins, his Heirs, Administrators and Assigns, for the Term of fourteen Years, the sole and exclusive Right and Liberty of using, and vending to others the said Discovery, of burning the raw Ashes previous to their being dissolved and boiled in Water, according to the true Intent and Meaning of the Act aforesaid. In Testimony whereof I have caused these Letters to be made patent, and the Seal of the United States to be hereunto affixed Given under my Hand at the City of New York this thirty first Day of July in the Year of our Lord one thousand seven hundred & Ninety.

X000001  
July 31, 1790

George Washington

City of New York July 31<sup>st</sup> 1790. -

I do hereby certify that the foregoing Letters patent were delivered to me in pursuance of the Act, entitled "An Act to promote the Progress of useful Arts"; that I have examined the same, and find them conformable to the said Act.

Edm. Randolph Attorney General for the United States. -

Signed by  
George Washington

# History Of the US Patent System

- **Act of 1790:** examination administered by the Secretary of State with Secretary of War, Attorney General, & DoS Chief Clerk).
- **Act of 1793:** Changed to a registration system .
- **Act of 1836:** Reinstated examination, designated a Commissioner, used “novelty” as basis for patentability.
- **Act of 1952:** Currently in force; established and codified non-obviousness, made Patent Office part of the Commerce Department.

# Recent History

- **1984** Reexamination proceedings
- **1992** Fully fee funded
- **1995** Term changed from 17 years to 20 years; established Provisional applications.
- **1999 AIPA:** Pre Grant Publication, extension of term for Office delay
- **2011 AIA:** First-to-file/prior users; fast track; post grant review; fee setting; satellite offices



# What is the Role of Patent Examiner?

- Issue Valid Patents
  - Make appropriate objections
  - Make only reasonable rejections
  - Help applicant identify allowable subject matter
- Act as an advocate for the Public
  - Ensure development of a clear and complete file wrapper record
  - Patent prosecution before the Office should not be adversarial, instead it should be cooperative investigation between the Examiner and the Applicant, which ensures an Applicant receives a patent only for that which they are entitled to in accordance with Patent laws.



# What is the Role of Patent Examiner? (cont.)

- To serve as advocate/protector of public interest with respect to intellectual property
- To provide direct service and assistance to customers from inside and outside the U.S. Patent & Trademark Office
- To serve as a judge on patentability with respect to inventions claimed in a patent application under conditions for patentability set forth in Title 35 of the United States Code

# Congress and the USPTO

- Congress passes the patent laws that govern all substantive and procedural functions of the USPTO
  - 35 USC §§ 101 – defines what is eligible to be patented
  - 35 USC §§ 102 – must be new
  - 35 USC §§ 103 – must be non-obvious
  - 35 USC §§ 112 – must be sufficiently described, enabled, with best mode disclosed

# What Does a Patent Examiner Do?

- **Reads and understands** the invention set forth in the specification
- 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 the claimed invention

# What Does a Patent Examiner Do? (cont.)

- Writes an Office Action which identifies and analyzes all issues in the application pertinent to patentability of the claimed invention
- Responds completely to Applicant's reply
- Issues Notice of Allowance or Notice of Abandonment
- Ensures that all pertinent procedural steps necessary for obtaining a patent are complied with during prosecution of an application

# What May an Examiner Do?

- Advise on advantages of, and appropriate classification fields for, pre-examination search
- Advise on advantages of securing services of a competent patent attorney or agent
- Advise on Office fees and Office procedures in general
- Assist public in conducting a search, short of rendering patentability advice or opinion as to whether an application should be filed

## An Examiner should be able to answer these questions about an application:

- What subject area is most related to Applicant's invention?
- What existing invention(s) did Applicant identify?
- What problem(s) did Applicant identify with existing inventions?
- How does Applicant propose to solve the problem(s)?
- How does Applicant implement the solution(s)?
- Do the claims incorporate Applicant's solution(s)?

# Parts of a Patent Application

- Title
- Abstract
- Background Of Invention
  - A Field of Invention in which Applicant identifies the most relevant subject area to which his invention belongs.
  - A Description of Related Art used by Applicant to:
    - Identify existing relevant inventions.
    - Discuss any problems with these existing inventions.
- Brief Summary Of Invention
- Brief Description Of Drawings
- Detailed Description Of Invention
- Claims



# How Much Detail is Needed?

- The Detailed Description must describe at least one specific embodiment or example of the invention.
- The claimed invention must encompass at least one disclosed embodiment.
- As you read the detailed description, be on the lookout for any parts relating to elements of the claimed invention that were not clear to you.
- Try to identify how Applicant implements solutions proposed for objectives/solutions.

# The Claims

- The Focus Must Begin And Remain On The Claims
- “The Invention Disclosed In Hiniker’s Written Description May Be Outstanding In Its Field, But **The Name Of The Game Is The Claim.**”
  - *In Re Hiniker Co.*, 150 F.3d 1362, 47 USPQ2d 1523 (Fed. Cir. 1998)

# The Claims (*cont.*)

- Patent Claims Are The Inventor's Attempt To Delineate, By Way Of A Single Sentence In The English Language, The Technology Which The Inventor Regards As His Or Her Invention.
- Claim language defines the metes and bounds of property protection desired (or the property boundaries).
- Patent Claims Provide Notice To The Public Regarding The Technology, Which Is Fenced Off Or Protected From Trespass.

# The Claimed Invention

- Analysis Begins With A Key Legal Question –
- What Is The Invention Claimed?
- “The First Inquiry Must Be Into Exactly What the Claims Define.” - *In Re Wilder*, 429 F.2d 447, 166 U.S.P.Q. 545 (C.C.P.A. 1970)
- Do the claims make sense
  - Grammatically?
  - Logically?
  - Technologically?
- Are there any terms you do not understand?
- Do you understand the concept of the claim?

# The Claimed Invention (*cont.*)

- How would you summarize the claim?
- What are the essential features of the claim?
- How are the claimed elements described in the specification?

# Sources of Law

- There are three sources of Federal Law that correlate to the three branches of government:
  - **Statutory law** consists of the acts passed by the legislature, i.e. the Legislative Branch
  - **Case law** consists of the case decisions issued by the courts, i.e. the Judicial Branch
  - **Regulatory law** consists of the regulations promulgated by agencies, i.e. the Executive Branch

# Manual of Patent Examining Procedure

**Statutes** – Patent Laws passed by Congress

**Regulations (Rules)** – Patent Rules the USPTO has established and must follow except in extraordinary situations

**Policy & Procedure** – Detailed guidance regarding operations of the USPTO

**Guidelines** – Comprehensive analyses of Office guidelines on individual topics

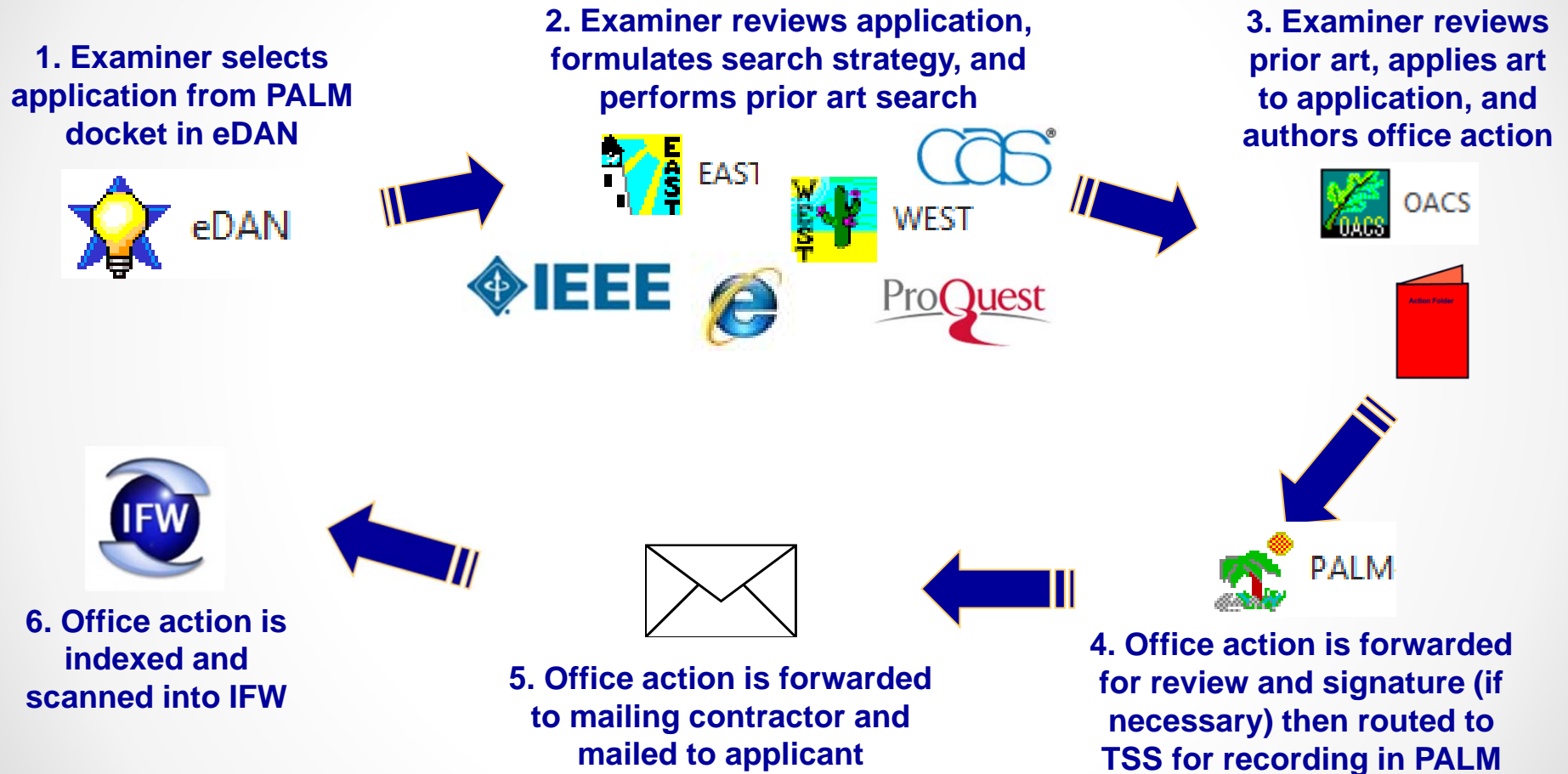
**Form Paragraphs** – Prewritten templates that Examiners use to convey information to applicants and attorneys



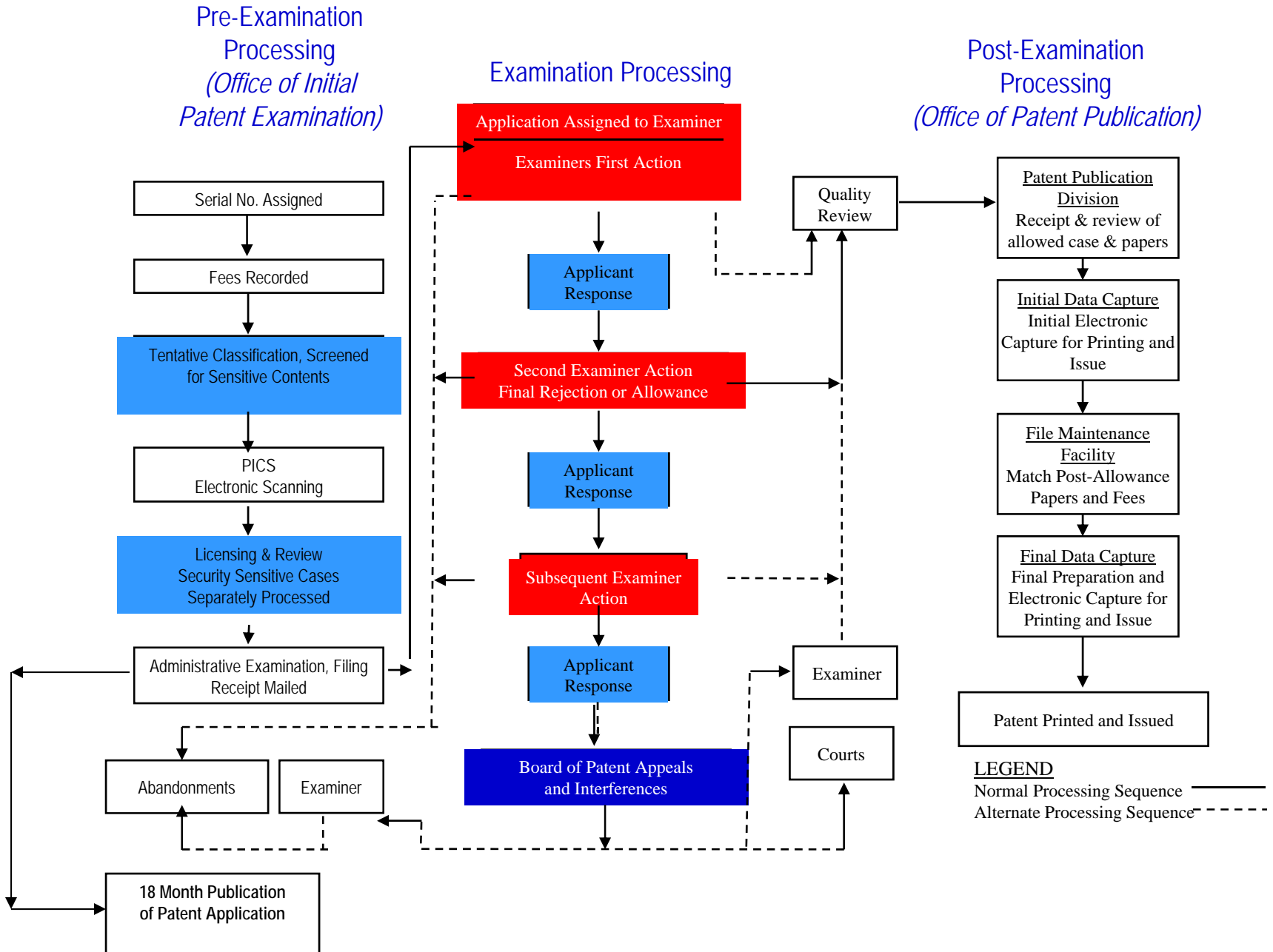
# MPEP - Roadmap



# Simplified Patent Examination Process



# The Patent Process



# Thank You!

[www.uspto.gov/cornell](http://www.uspto.gov/cornell)

[sue.purvis@uspto.gov](mailto:sue.purvis@uspto.gov)