USPTO Inventor Info Chat Series: Overview of Patent Examination

Office of Innovation Development
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Email questions to:
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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?

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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.

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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.

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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.

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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.

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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.

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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.

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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

- **Rejection**
  - Applicant Response
  - Notice of Appeal

- **First Examination**

- **Second Examination**

- **Appeal Process**

- **Allowance**
  - Notice of Allowance

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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.

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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.

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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)

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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

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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.

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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.

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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.

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Patent Examination Process

1. **Rejection**
   - Applicant Response
   - Notice of Appeal

2. **First Examination**

3. **Second Examination**

4. **Notice of Allowance**

5. **Allowance**

6. **Appeal Process**

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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.

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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!

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To inquire about OID services please contact us at: InnovationDevelopment@uspto.gov

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