

The Limited Monopoly™

Building The Case For Patentability: Prosecution in the USPTO

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The Arcane World of Prosecution

Most engineers and scientists who have had some exposure to patents know that a substantial effort is required to file a patent application in the U.S. Patent and Trademark Office. A detailed written description and drawings of the subject invention must be prepared and submitted. At some point after the filing of the application, a patent may issue.

What is less well known is the series of proceedings between the Applicant (typically represented by a Patent Agent or Patent Attorney) and the USPTO, in which the application is considered by a Patent Examiner and a determination is made on whether or not to grant a patent on the invention. This series of proceedings is known as *prosecution*, as in the broader dictionary definition of the word, “the following up of something undertaken or begun, usually to its completion.” The following is a brief summary of the series of steps that can occur between patent application filing and patent issuance. Prosecution is often a complex and arduous process, at times seeming more like making sausage than champagne.

Initial Inspection

After a patent application is filed in the Patent Office, it undergoes a routine initial inspection. The application is checked to confirm that it meets minimal standards with respect to the written description and drawings, and that all required documents and fees have been filed and paid. It also undergoes a security review to determine if the patent application could be a risk to national security if it were to be published. If it passes the security review, an initial classification, i.e. the technology class and subclass to which the subject matter most closely pertains is then determined. The application is sent to a specific “Technology Center” in the Patent Office charged with examining applications within that classification, and is assigned to a specific Examiner having expertise in that field of technology.

The application then awaits its turn for examination, slowly working its way to the top of the Examiner’s docket as the examination of applications ahead of it are completed. As you may know, the backlog of pending applications in the Patent Office is

What happens to your patent application after it is filed?

severe, and it often takes more than two years for an application to receive a first action by an Examiner. (A relatively new option, Accelerated Examination¹, may shorten this time to less than one year.)



1st Question – How Many Inventions Are You Trying to Patent?

When the Examiner takes up an application, the first determination that is made after the initial study of its content is whether or not there is more than one invention being claimed. The simple principle being applied is “one invention per patent.” 37 CFR 1.142 states, “If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction.”

The Applicant may attempt to “traverse” (overcome) the restriction requirement with

arguments, but in any case an election of one of the sets of claims cited by the Examiner must be elected for examination. If the arguments to traverse are found “not persuasive,” the non-elected claims are then withdrawn from prosecution.

Examination on the Merits

With the claims to be examined having been determined, the Examiner proceeds to study the application to determine if a patent including these claims should be granted. Patent prosecution is an *ex parte* proceeding before the Patent Office, i.e. “a proceeding brought by one party in the absence of another.” (This is in contrast to an *inter partes* proceeding, such as litigation, in which two adversarial parties argue a matter before a judge in court).

Nonetheless, the process is not “non-adversarial” in nature. It is the Examiner’s responsibility to protect the public interest, preventing the granting of the limited monopoly that a patent confers when it is not warranted. Thus the Examiner is quite assertive in studying the patent application and rejecting it on one or more grounds defined by the following statutes:

- 35 USC 101: The invention must have *utility*², i.e. be useful for some purpose.
- 35 USC 112: A written description of the invention must be provided sufficient to enable one skilled in the art to practice the invention. The claims in the application must be definite, i.e. distinctly defining what is considered the invention.
- 35 USC 102: The invention must be novel, i.e. new, not previously known.
- 35 USC 103: The invention must be unobvious, i.e. a person “of ordinary skill in the art” would not easily be able to combine knowledge from multiple sources to create the invention.

Many rejections occur based upon the latter two statutes: the invention as claimed is found to lack novelty and/or to be obvious. In examining an application against the novelty and obviousness criteria, the Examiner first does a “prior art search” in the relevant classifications of patents and published patent applications in the U.S. and worldwide, as well as in relevant non-patent

literature (academic and trade journals, Internet sources, etc.) If the Examiner finds references that render the claims as lacking novelty or being obvious, they are rejected under “102” or “103.”

In contrast, if the Examiner finds that the application meets all of the standards prescribed by the statutes, and that the claims are patentable, he will issue a Notice of Allowance to the Applicant. (See below.) More likely, the Examiner finds some grounds for rejection of the application, and issues a first Office action to the Applicant, in which the grounds for rejection of the claims are set forth.

Upon receiving the Office action, the Applicant has a maximum of six months to respond to the Patent Office. How the Applicant responds depends upon the specific content of the rejection(s). In some cases, an Examiner’s rejection is in error, and can be overcome with arguments that are well-grounded in the statutes, such that the rejection is withdrawn by the Examiner. In other cases, the rejections are solid, and amendments of the wording of the claims, which narrow their scope, may be required to make them patentable over the references cited by the Examiner.

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The Examiner may also find some claims allowable, while rejecting others. If the Applicant considers that these allowable claims provide sufficient protection of the invention in the marketplace, the Applicant may cancel the rejected claims and accept the issuance of a patent with only the allowed claims. In the worst case, the Examiner will have found a “knock-out” reference in his search, i.e. one that completely discloses the same invention, such that no claims are patentable, regardless of any possible amendments. In that case, the application should be abandoned.

Presuming that the worst case is not present, the Applicant then prepares and files a Response to the Office action, including an amendment of the claims and/or arguments in support of the patentability of the original or newly amended claims. Within three to four months, the Response again reaches the top of the Examiner’s docket, and he reconsiders the application. Ideally, the

arguments set forth in the Response and/or the amendment of the claims is sufficient to convince the Examiner that the claims are patentable, and that a Notice of Allowance is in order.

Quite often, this is not the case. If the claims have been amended, the Examiner will almost always do a further search, and may find additional references that provide the basis for another rejection of the claims. In such an instance, the Examiner may issue a second Office action to the Applicant, making the rejection “Final,” and closing prosecution in the application. However, “Final Rejection” does not mean that the Applicant can never obtain a patent. Two options are available at this point, if the Applicant believes that a patent ought to be granted – and if the Applicant is willing to spend additional money to pursue one.

You Can Buy a Second Try

For a fee that is comparable to the original application filing fee, the Applicant can file a Request for Continued Examination (RCE), along with another Response to the second Office action. The Response may contain further arguments and/or further narrowing amendments of the claims beyond that which was filed in the first Response.

The filing of an RCE will reopen prosecution. The Examiner will again take up the case in a few months and consider the Response filed with the RCE. The Examiner may then issue a Notice of Allowance, or another Office action with a non-final rejection of the claims. In the latter case, the Applicant again has another maximum of six months to respond to the Office action. In some instances, when the Applicant is doggedly fighting, with as little narrowing of the claims as possible in amendments, the cycle of RCE and Response → Office action → Response → Final Office action may be repeated multiple times. There is no rule explicitly limiting the number of RCE’s that can be filed in prosecution.

Or Appeal to a Higher Power

As an alternative, when the claims in an application have been twice rejected, the Applicant may file an Appeal to the Board of Patent Appeals and Interferences (BPAI). The Appeal filing fees are expensive, and the rules for the form and content of an Appeal are complex and stringent. If an Appeal is filed and granted, it is considered by a three-member panel of administrative patent judges.

The BPAI panel may rule in favor of the Applicant, it may uphold the findings of the Examiner, or it may remand the application back to the Examiner for further action. If the Applicant loses the Appeal, it may then

be brought before the Court of Appeals for the Federal Circuit (CAFC). It is possible to ultimately appeal a patent case all the way up to the Supreme Court, although that is exceedingly rare.³

Success at Last – the Notice of Allowance, and Issue of the Patent

In most patent applications, the balance between the public interest and the rights of the Applicant are eventually achieved in prosecution. If arguments are found to be persuasive and/or claims have been narrowed, the Examiner will find the application to be allowable, and will issue a Notice of Allowance. The Applicant then has three months to pay the issue and publication fees in the application.

Following payment of these fees, the patent will typically issue in less than two months. Prior to issue of the patent, it is critical that the Applicant files any continuing applications to pursue any subject matter not covered in the allowed claims, such as subject matter in claims that were withdrawn as a result of a restriction requirement. Otherwise, after the patent issues, this unclaimed subject matter is “in the public domain.”

Closing Argument

Currently, the whole patent process from filing to issuance often takes nearly three years, so an Applicant must be in it “for the long haul.” Additionally, writing a good quality patent application is a difficult task. Prosecuting one is more difficult. We encourage you to consult an experienced patent practitioner who is well qualified to practice in your field of technology if you are considering patent protection of your intellectual property. □

1. See also “The Limited Monopoly,” March 2007.
2. See also “The Limited Monopoly,” January 2009.
3. See also “The Limited Monopoly,” June 2007.

(A pdf of this article with live hyperlinks to the above references is available at <http://www.patenteducation.com/patentarticles.html> under “Patent Prosecution.”)

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