



Working with the Patent Office in Patent Prosecution

**Working with the USPTO: Selecting
the Right Legal Advocates**

October 10, 2012 – Eric L. Lane



Patent Prosecution Overview

- Prepare and file initial application (typically in home country)
 - First Office Action (can take 2-3 years!)
 - Restrict claims to single invention
 - Reject claims over prior art
 - Allow (some or all claims)
 - Response to first Office Action
 - Elect invention
 - Amend claims
 - Argue distinctions over prior art
 - Second Office Action / Final Rejection, Response, etc.
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Patentability Standards: Novelty

35 U.S.C. § 102

A person shall be entitled to a patent unless -

(b) the invention was ***patented or described in a printed publication*** in this or a foreign country or in public use or on sale in this country, ***more than one year prior to the date of the application for patent*** in the United States, or

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent...

If the claimed invention is not novel, it is "**anticipated.**"



Patentability Standards: Non-Obviousness

35 U.S.C. 103

Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that ***the subject matter*** as a whole ***would have been obvious*** at the time the invention was made ***to a person having ordinary skill in the art*** to which said subject matter pertains.



Patentability Standards: Written Description, Enablement, Definiteness

35 U.S.C. 112 Specification

- ¶1 The specification shall contain a **written description** of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as **to enable any person skilled in the art to which it pertains**, or with which it is most nearly connected, **to make and use the same**, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

 - ¶2 The specification shall conclude with one or more claims **particularly pointing out and distinctly claiming** the subject matter which the applicant regards as his invention.
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Complex Relationship with the Examiner

Adversarial



Arguments in writing

Collaborative



Cooperation on the Phone

Final Rejection: Plan B1 – Keep on Keepin' On

- File a Request for Continued Examination
- More arguments and amendments
- But it's expensive: \$465
- And it takes a long time b/c you're back in the ordinary queue

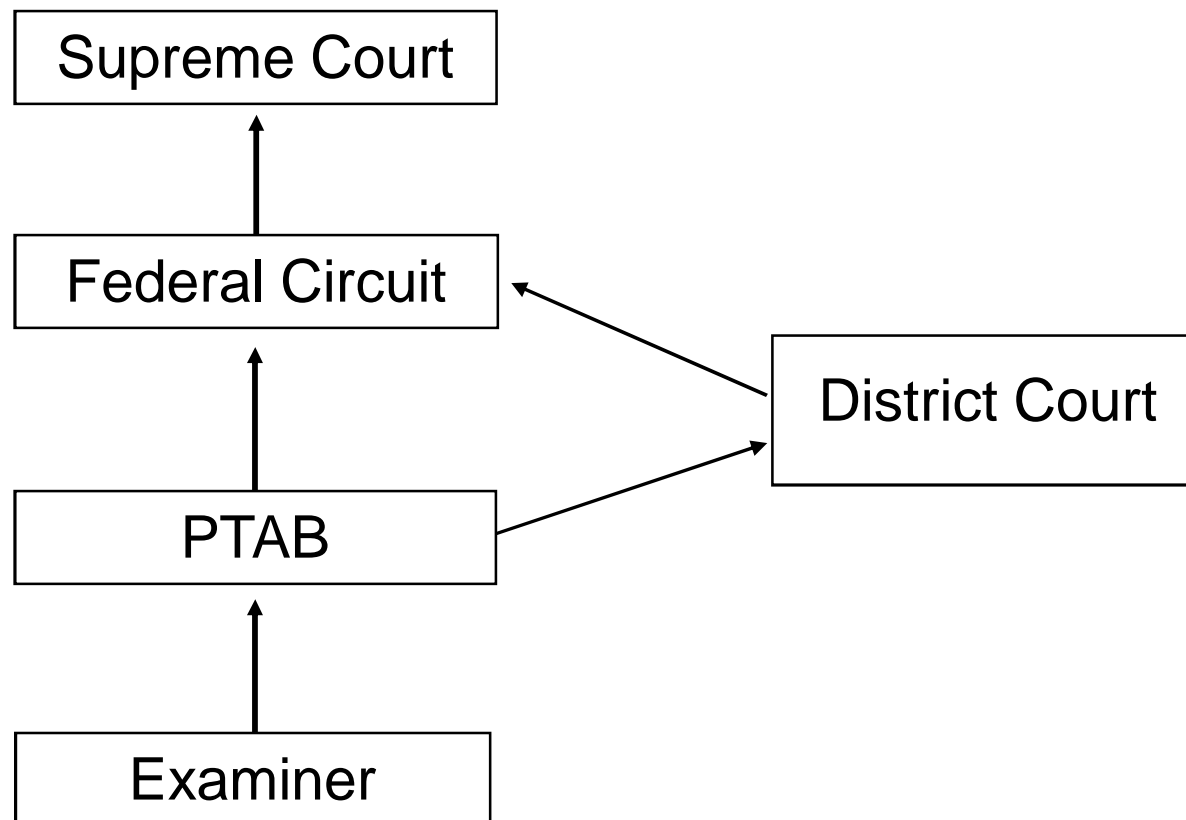


Final Rejection: Plan B2 – Continuation Practice

- Take narrowed claims and get a patent
- File continuation and argue for broader claims



Final Rejection: Plan B3 – The Appeal (Overview)





Final Rejection: Plan B3 – Notice of Appeal Options

Notice of Appeal Stages

- (1) File Notice of Appeal
 - (2) Exit before brief or request for pre-appeal review
 - (3) Exit after request for pre-appeal review
 - (4) File brief but exit before Examiner's reply brief
 - (5) File brief, Examiner replies, but exit before Board decision
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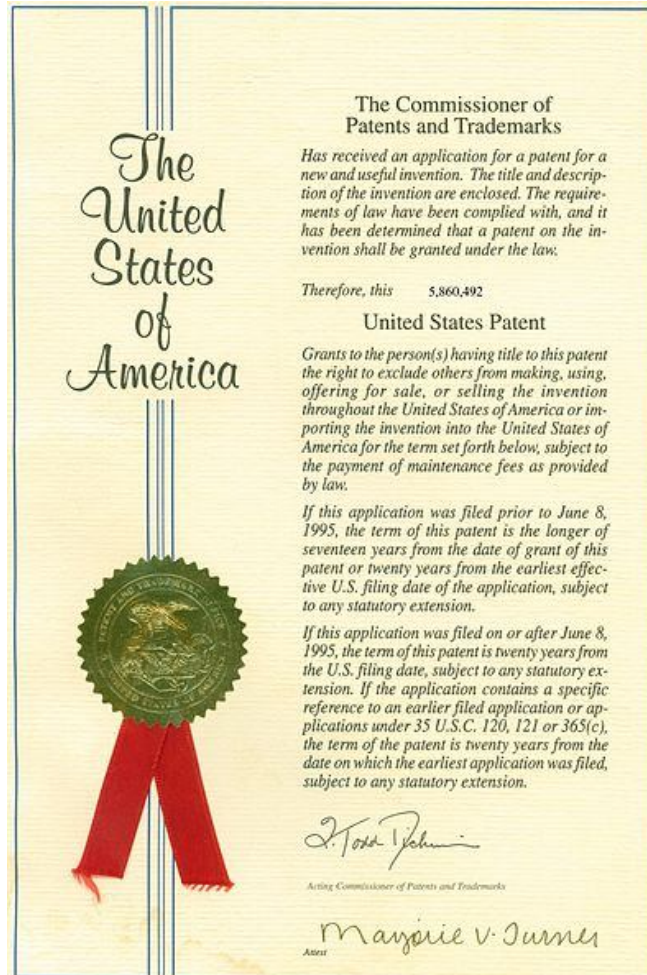


Final Rejection: Plan B3 – Notice of Appeal Options

“We find that patent applications fare surprisingly well in each of the stages preceding a [Board] decision. . . .This suggests that filing a notice of appeal, far from being a desperate prosecutorial act, may actually be a relatively effective strategy for garnering a positive outcome in patent prosecution...”

Andrew W. Torrance, *An Empirical Study of Patent Prosecution Success after the Filing of a Notice of Appeal*

Granted Patent





Presenter



Eric Lane is patent and trademark attorney at McKenna Long & Aldridge in San Diego. Lane is the founder and author of Green Patent Blog – www.greenpatentblog.com – an award-winning website dedicated to discussion and analysis of intellectual property issues in clean technology. His book, *Clean Tech Intellectual Property: Eco-Marks, Green Patents, and Green Innovation*, published by Oxford University Press, is available for purchase through Oxford's web site at www.oup.com, Amazon.com and select retailers.



Green Patent Blog

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