

Obtaining a Patent: Patent Prosecution

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Today

- Patent Prosecution Issues
 - The relationship between the specification and claims
 - Provisional Applications
 - Priority
 - Application Families
 - Foreign Rights
 - Ethical Obligations

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The Specification

- The specification must describe the invention – to show “possession of the invention”
- The specification must enable one skilled in the art to make and use the invention, w/o undue experimentation
- The specification must set out the “best mode” of practicing the invention

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Examples

- An invention that is described but not enabled:
 - Application describes and claims a perpetual motion machine
 - Application describes and claims a time travel machine
- An invention that is enabled but not described:
 - An application describes a genus of compounds and instructions for making species A, B, and C thereof; claims species D
 - An application describes a computer that uses a “memory” and describes RAM and ROM; claims a Flash memory

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Enablement & W.D. In Examination

- The specification is “frozen” after filing, with the exception of the claims, which can and do morph during examination.
- Enablement and written description requirements limit applicant’s ability to amend claims during examination
- *From a policy perspective, why is this a good thing?*

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Typical Application Examination

- Typical flow
 1. File application
 2. Examiner searches and finds prior art
 3. Examiner files an Office Action, rejecting claims
 4. Applicant distinguishes the prior art with:
 - Argument e.g., the prior art does not teach X
 - Claim amendments
 5. If successful, application issues, else go to 2.

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Bases for rejection

- You can get a rejection for many reasons:
 - Claims not novel
 - Claims are obvious
 - Claims are not enabled
 - Claims are not described
 - (We'll learn about more later...)
- Today we will focus mainly on novelty:
 - Is the claimed invention described by a single prior art reference?

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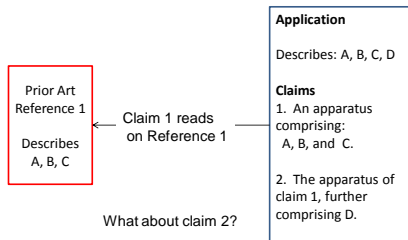
Word of the Day

- A new verb: "to read on"
- Claims may be said to "read on" prior art references, devices, processes, etc.
- If a claim reads on a prior art reference, the claim is invalid.
- If a claim reads on a device, the device infringes the claim.

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Reading claims

To determine whether to allow a claim, the Examiner "reads" the claims on the prior art...



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Termination of Examination

- When does examination end?
 - Issue: when the application issues...
 - Appeal: examiner's decision can be appealed after he has twice rejected your claims
 - Abandonment: an application goes abandoned when applicant does not reply to Office Action
- When an application issues into a patent, it obtains a presumption of validity, that can only be overcome with "clear and convincing" evidence

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Amending Claims During Examination

- Typical examination:
 - Application discloses A, B, C, and D
 - Claim to "A device comprising: A, B, and C."
 - Examiner rejects claim: Reference X shows a device comprising A, B, and C.
 - Applicant narrows claim:
 - YES: "A device comprising: A, B, C, and D."
 - NO: "A device comprising: A, B, C, and E."
 - NO: "A device comprising: A, B, and C, wherein C is yellow."

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Examination

- You can freely change claims during examination to, e.g., narrow claims to define the invention over the prior art
- But, claims can only be modified within the scope of the specification!
- Lesson: make sure all variations and refinements are well disclosed, even if they are not initially claimed!
- The specification is your "war chest" of ideas and you want it to be full as possible at the outset...

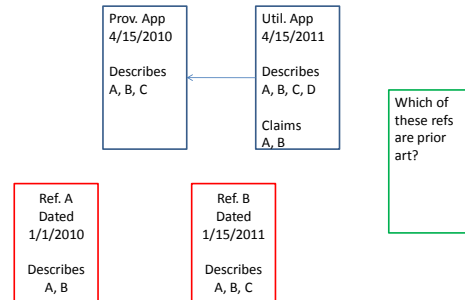
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The Provisional Application

- A provisional application is not really an application:
 - No claims required
 - It is just a placeholder that lasts for a year, no examination
 - Low cost (\$125/250)
 - Useful to get idea on file quickly
- Once an application is filed, you are “patent pending,” and free to disclose information that is covered by your filing
- You have one year to file a “regular” (non-provisional) application that claims priority to the provisional application

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Priority



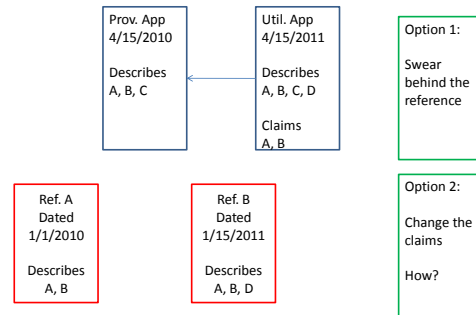
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Provisional Pitfalls

- The same rules for written description and enablement apply to provisional patent applications
 - We can and do file PowerPoint presentations, brochures, technical manuals, etc.
 - These materials sometimes do not enable the invention!
- The fact that a provisional applications do not require a claim does not mean they should not have one!

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Priority



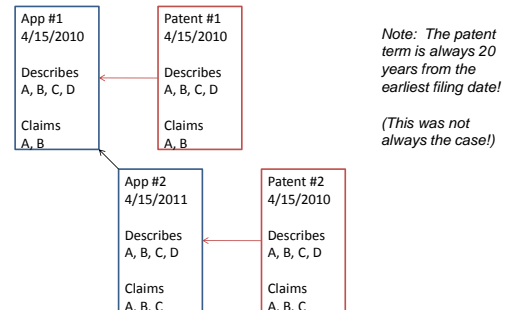
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Patent Families

- While a “parent” patent application is still pending (not issued, not abandoned), you can file:
 - A continuation application that claims priority to the parent application
 - Continuation gets the filing date of parent
 - A continuation-in-part application that claims priority to the parent and adds new matter
 - CIP has two filing dates: the parent date and the CIP filing date
- Always keep a continuation pending, if possible!

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Continuation Priority



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International Considerations

- The US provides a one-year grace period
- (Almost) no other country provides a grace period – **any public disclosure prior to filing will result in a loss of rights**
- Lesson: If you hope to obtain rights in foreign countries, make sure you are on file before you disclose your invention

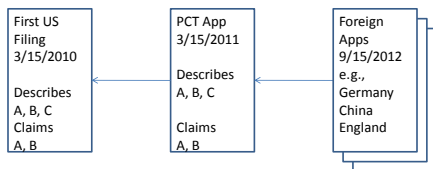
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Patents: Foreign Rights

- In general, you have one year from filing in country A to file in country B, provided both are signatories to the Paris Convention (most countries)
- It is painful and expensive to file in dozens of countries, so...
- The Patent Cooperation Treaty allows:
 - The filing of a "placeholder" application within 12 months of first filing
 - Then an 18 month grace period before entering foreign countries

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Typical Foreign Prosecution Timeline



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New Developments

- Three Track Examination:
 - Track 1: Prioritized examination
 - Pay \$4000 / \$2000 (small) / \$1000 (micro) extra in filing fees
 - Get a "final" answer in 12 months
 - Track 2: Regular examination
 - Track 3: Deferred examination
 - Delay examination up to 30 months
 - *Not implemented yet*

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Inventorship

- An inventor is one who conceived of the invention as defined by at least one claim
- Conception = *formation in the mind of a definite and permanent idea of the complete and operative invention*
- Invention is NOT reduction to practice
- Inventorship can and does change during patent prosecution (because the claims change)

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Patents: Ethical Obligations

- Any individual associated with filing and prosecuting application have a duty to disclose all information that is known to that individual and that is material to the patentability of any claim
- No obligation to search for information!
- Who: Patent attorney, inventor, admin personnel
- What: Publications, public uses or sales prior to critical date
- Failure to disclose can render a patent unenforceable

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Searching Before Filing

- Often, doing at least some prior art searching prior to filing is advisable
- A quick search can be done using just your favorite search engine and the USPTO web site
- You may save yourself lots of time and money
- You are almost guaranteed to find something “in the ballpark”
- A good patent attorney should be able to draft claims around the art
- *Lesson: Use the phone when discussing prior art*

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Searching

- USPTO – Full text search:
 - <http://patft.uspto.gov/>
- Google
 - <http://www.google.com/patents>
- Free Patents Online
 - <http://www.freepatentsonline.com/>

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More About Patent Prosecution

- For published applications and issued patents, the “file history” is available to the public:
 - <http://portal.uspto.gov/external/portal/pair>
- You can look up cases by patent number, application number, etc.
- You can find the file history by clicking the “Image File Wrapper” tab

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Takeaways

- Keep good records of your invention
- File early and often
- Provisional filings can be your friend, if used correctly
 - Preserve foreign rights
 - Protect you where an NDA cannot
- Make sure your application sufficiently covers variations, refinements, extensions

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