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## Obtaining a Patent Patent Prosecution

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## Today

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- Wrap up the Conditions for Patentability Module – Obviousness
  - Patent Prosecution Issues
    - The specification
    - Provisional Applications
    - Priority
    - Application Families
    - Foreign Rights
    - Ethical Obligations
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## The Specification

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- 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

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- 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

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- 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

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- 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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## Termination of Examination

- When does examination end?
  - 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

## Amending Claims During Examination

- Typical examination:
  1. Application discloses A, B, C, and D
  2. Claim to "A device comprising: A, B, and C."
  3. Examiner rejects claim: Reference X shows a device comprising A, B, and C.
  4. 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."

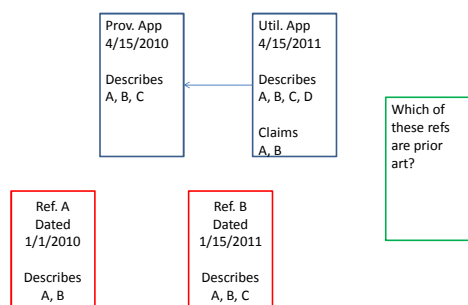
## Examination

- 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...

## The Provisional Application

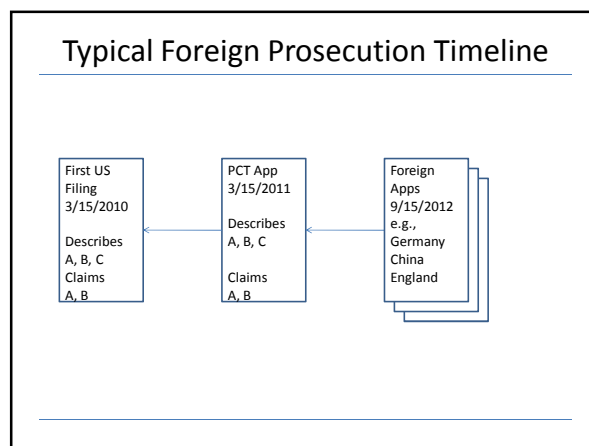
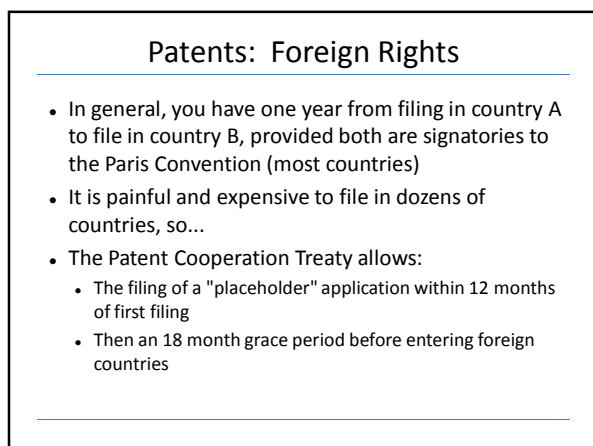
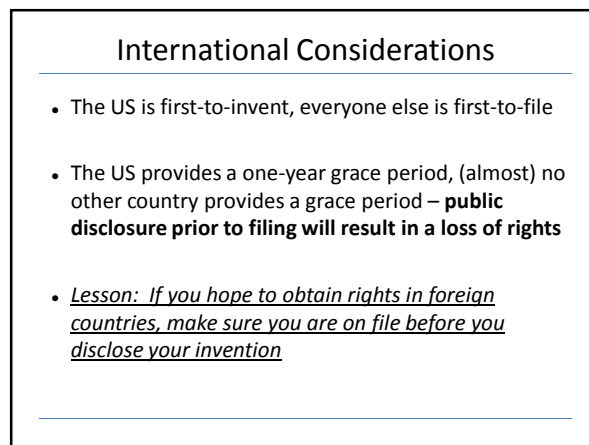
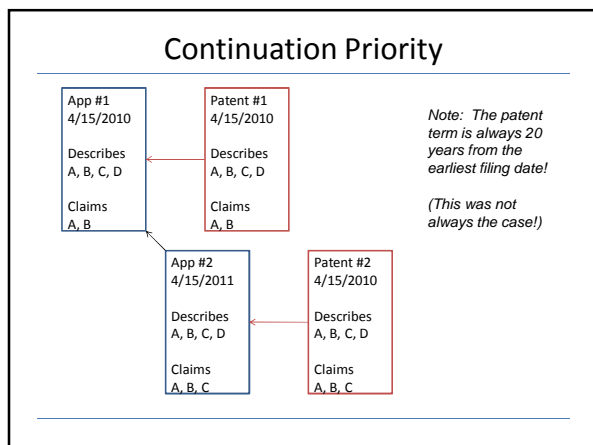
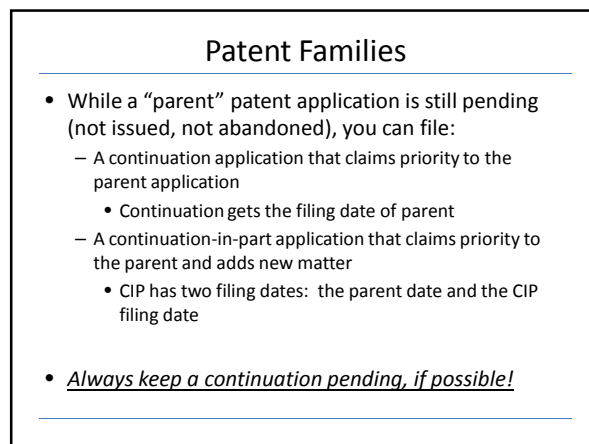
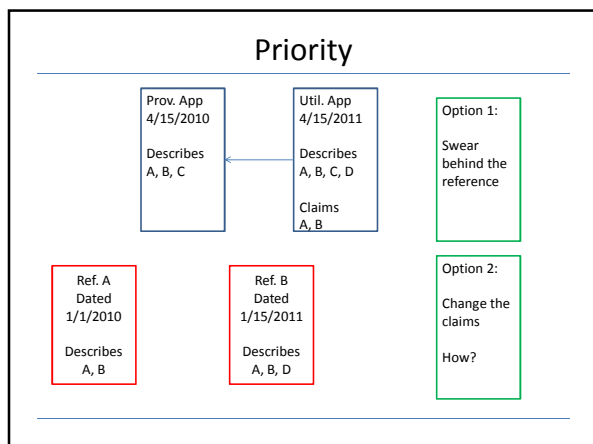
- A provisional application is not really an application:
  - No claims required
  - It is just a placeholder that lasts for a year, no examination
  - Low cost (\$110/220)
  - Useful to get idea on file quickly
- Once an application is filed, you are "patent pending," and free to disclose information that is covered by your filing
- You have one year to file a "regular" (non-provisional) application that claims priority to the provisional application

## Priority



## 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!



## New Developments

- Accelerated Examination
  - Applicant does search and analyzes claims in light of prior art
  - The PTO promises to reach a resolution within 12 months
  - Cost: can double the cost of a regular application, because of extra legal fees
- Three Track Examination (starting soon):
  - Track 1: pay \$4000 extra in filing fees, get an answer in 12 months
  - Track 2: same as today
  - Track 3: deferred examination (up to 30 months)

## 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)

## 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

## 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*

## Searching

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

## 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