

## U.S. PATENT APPLICATION PROCEDURES

This brochure provides a brief summary of how a patent application is prepared and then prosecuted in the **U.S. Patent and Trademark Office**. It also considers the principal costs and foreign protection.

### WHEN IS AN INVENTION PATENTABLE?

Filing a patent application, whether the invention is simple or complex, does **not** guarantee that a patent will be granted. The Patent Law requires that to be patentable, an invention must be **useful**, **novel** and **unobvious**. (Each of these will be explained below.) The **Patent Examiner** at the USPTO, acting as a judge, compares the invention (as described in the patent application) with descriptions of previous inventions (the **prior art**), and then decides if the invention meets those requirements. The role of the patent attorney is to provide the Examiner with a clear and accurate description of the invention and to point out to the Examiner how the invention differs from the prior art inventions. However, the actual decision on granting of a patent is made **by the Examiner**, not the attorney.

### THE PATENTABILITY SEARCH

Often a patent application will be preceded by a **patentability search**. In this search those USPTO prior art collections in Washington D.C. which are considered most relevant to an invention are reviewed in order to identify similar prior inventions. It supplements the information provided to the attorney about the background and field of the invention. It is not a complete survey of all prior inventions, since there are over 6,000,000 U.S. patents alone. There are also other relevant sources (such as trade literature) which the search does not cover. However, these searches provide useful information and, taken with what is disclosed to the attorney, assist the attorney in arriving at an opinion on the likelihood of a Patent Examiner approving a patent for the invention. A fee for the patent search and analysis is in addition to the fee for preparing and filing the application.

### PATENTABILITY REQUIREMENTS; ONE YEAR STATUTORY BAR

There are two principal kinds of patents: **utility patents** and **design patents**. A utility patent covers functional aspects (structure, composition and/or operation) of an invention, while a design patent covers the nonfunctional "ornamental appearance" of products. An invention must have a practical **use**, but the use itself does not need to be new. The invention must also be **novel** (new), which means that the same invention cannot have been made or described previously. Finally, even if no one has previously made or described an identical invention, the invention must be sufficiently distinctive that a person

familiar with the field would not consider the invention to be merely an **obvious** variation on prior inventions. The attorney can discuss these issues as they apply to the invention.

The patent law prescribes a one year period for the filing of a patent application once there has been a sale, offer for sale, use, publication or other public disclosure of an invention. If no patent application is filed with the USPTO within this year a **statutory bar** is created **preventing any subsequent attempt to obtain a U.S. patent on that invention**. The one year statutory bar time limit cannot be waived or extended, nor can it be complied with by filing a Disclosure Document with the USPTO. (See the Gordon & Rees brochure on the U.S. Patent and Trademark Office Disclosure Document Program for further information). Only actual filing of a complete patent application (or of a provisional patent application) with the USPTO within the year will be sufficient. **Foreign patent application requirements generally impose more stringent time limits**; and often require that an application be on file before the invention is made public. This requirement is referred to as absolute novelty. See the Gordon & Rees brochure on Foreign Patent Considerations for information.

## **PREPARING THE PATENT APPLICATION**

If, after patentability of the invention has been discussed between the inventor and attorney and authorization is given to prepare and file a utility or provisional **patent application**, the attorney will obtain detailed information about the invention and will write a draft of the application. The application defines the invention in both technical and legal terms. A utility patent application includes a **specification**, often supplemented by **drawings**, which describe the invention and its background, disclosing its different embodiments in enough detail to **enable** a person knowledgeable in that field to understand and practice the invention without undertaking undue experimentation. It includes description of the **best mode**, which is what the inventor(s) considers to be the best current version of the invention. If the application is a complete application (not a provisional application) it will also include an **abstract** (a brief summary of the invention) and will conclude with one or more **claims**, which are the legal description of the invention. The claims are drafted to provide the broadest possible coverage of the invention.

The inventor must be sure to inform the attorney of **all** information known about and relevant to the invention, including any previous use, sale, offer to sell, or disclosure or description of the invention to third parties. The inventor must also identify any patents, articles, technical brochures or other written materials related to the invention (whether these activities or writings were done by him, people working with him or someone else). Not only is this necessary to enable the attorney to prepare the application, but it is also required that material information be provided to the USPTO.

Once a draft is written, the attorney will ask the inventor to **review** it carefully, to be sure that the invention (including possible variations) is accurately described. Any revisions, additions or deletions that are felt to be necessary or desirable must be brought to the

attorney=s attention at this point. The attorney will then prepare the final application for review and signature. Once completed and signed, the application is filed with the USPTO.

## **PROSECUTION OF THE APPLICATION; EXAMINATION**

Because the USPTO receives so many applications (over 200,000 per year) and has a huge backlog, the progress of an application will be slow. An official **serial number** and **filing date** will be given the application after its receipt, and the USPTO will provide notification of that information within two to three months of filing. However, it will be at least one year, and often more than two years, before an application will actually be reviewed by an Examiner. It is very common for the Examiner's first **Office Action** to be a **rejection** of all of the claims. Typically, the Examiner cites some prior art patents or literature which the Examiner believes may be relevant to the patentability of the invention, and gives technical and legal reasons for the rejection. The Action will state when response is due. The attorney will notify the inventor of each Action and will discuss the procedure and fee for an appropriate response to the Examiner's technical statements and legal rulings. The response may include both revisions (**amendments**) to the application (perhaps to redefine the invention) and explanations and argument (**remarks**) to the Examiner.

If a response is filed, the Examiner will (within a few months) again review the application. The Examiner may then accept the arguments of the response, reiterate and make **final** the previous ruling or issue a new ruling. Sometimes there may be two or more rounds of correspondence with an Examiner before the Examiner's final decision is reached. In our experience, more than 80% of the applications we file ultimately issue as a patent.

If the Examiner is ultimately persuaded that the invention is sufficiently different from prior inventions, the application will be **allowed**. Following allowance of the application, the USPTO requires payment of a substantial **issue fee** before printing and issuing a patent. The time from allowance to issuance of the patent is usually about four to eight months.

If the Examiner makes the rejection final, there are several actions that may be available if the inventor(s) wishes to continue to seek a patent for the invention, including **appeal** of the Examiner's ruling or filing of a **new or continued** application.

## **TIME SCHEDULES AND ABANDONMENT**

Under the law, if any communication from the USPTO is not responded to within a prescribed time, the application will be ruled by the USPTO to be **abandoned** and the Examiner will give it no further consideration. In most cases, this ends any possibility of patenting the invention. The inventor must be sure to understand the time deadlines set by the USPTO as reported by the attorney.

## **FEES**

The Gordon & Rees attorney will quote a fee for **preparing and filing** the application with the USPTO, based on the estimated amount of time needed to work with the inventor(s) and to write and revise the application. There will also be a **draftsman's charge** for preparation of any drawings, as well as a **filing fee** charged by the USPTO. A retainer is required when the application is authorized, and the balance of the total fee is required when the completed application is signed.

The prosecution of the application results in **additional fees** that are **not** included in the initial preparation and filing fees. As each prosecution event occurs, the attorney will quote the applicable fee for the necessary work to prepare an appropriate response. Agreement to each fee and charge will be needed before any work can be done and any response prepared.

Notification to discontinue prosecution and make no further efforts to obtain patent protection for the invention may be given at any time. However, the client will remain responsible for any fees previously authorized. Halting the prosecution process will result in **abandonment** of the application.

## **LEGAL EFFECTS OF APPLICATIONS AND PATENTS**

No legal rights against infringers become effective **until** a patent is **issued**. Having a patent application on file with the USPTO allows the applicant to label the invention Patent Pending or Patent Applied For to warn others that patent protection is being sought, but does **not** prevent others from making, using, selling or importing the invention before the patent is issued.

Utility patents have a term of twenty years from the initial filing date of the first application from which the patent claims priority. Design patents have a term of fourteen years from the issue date of the patent. A patent **cannot** be renewed.

An issued patent gives the legal right to **prevent** others from **making, using, selling, offering for sale or importing** the patented invention without permission. (Permission usually takes the form of a contract called a license between the parties). Note that a patent has only a preventative effect; the patent does **not** enable the patent holder to require others to use the invention or to stop someone with a different invention from competing.

**Enforcement** of patent rights against a suspected infringer usually involves **litigation** in court. Gordon & Rees has experienced patent litigators who can provide information on costs and procedures in matters where infringement is suspected.

## **FOREIGN PATENT RIGHTS**

There is **no** single international patent. A patent gives rights **only** in the country which issues it, so if an invention has potential foreign uses or markets, separate patent

applications must be prosecuted for each country or region of interest. Each country has its own requirements for patentability and patent applications. The attorney must be told at the beginning of the application process whether the client believes the invention has potential overseas, because there are some important limitations on filing foreign patent applications which must be considered early. The costs and procedures involved depend on the countries or regions selected. Additional necessary costs include fees of the local patent agent in each country and language translation charges. The attorney can provide you with information on foreign filing options and costs. Also, see the Gordon & Rees brochure on Foreign Patent Considerations.

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