

## The patent process: prosecuting your application at the PTO

**I**F YOU HAVE EVER ATTEMPTED to secure a patent for your invention, you know that dealing with the US Patent and Trademark office (PTO) can be quite involved. Previous columns in this series, including the one on pg 54 in this issue and others at [www.ednmag.com/](http://www.ednmag.com/)

[ednmag.com/extras/P17389.htm](http://ednmag.com/extras/P17389.htm), have discussed the key steps that lead up to the preparation and submission of a patent application.

Submitting your application begins the process commonly referred to as patent prosecution. The goal is to get approved as many of your requested claims as possible to have them included in your patent. The PTO issues patents for more than half of the applications submitted, so the odds are in your favor. A well-prepared application can substantially improve those odds. Here's an overview of what happens once the PTO receives your application.

Upon receipt, your patent application is assigned to the Applications Group where it receives a filing date and serial number and is placed in a folder called a file wrapper. The PTO then mails you an acknowledgment receipt. This receipt is the first of several written exchanges between you and the PTO. You should immediately check each document for accuracy, because each phase has a time limit for completion. Correcting inaccuracies can become more difficult as the process continues.

The Applications Group performs a procedural review for proper forms and content and then forwards the file wrapper to the Examination Group. An examiner reviews it for compliance with PTO procedural requirements, such as in the Patent Statute (Title 35, US Code)

and Patent Rules (Title 37, Code of Federal Regulations). If everything is in order, the examiner conducts a search of prior art that includes previous patents and trade literature. He then prepares an opinion reviewing your claims.

You usually receive the examiner's first report, called the First Office Action, within six to 12 months of application submission. The report details the claims that the PTO allows or rejects. It is not unusual to have most or all claims rejected initially. The examiner's objections may be based on spelling, wording, prior art, obviousness, novelty, or the other qualifiers mentioned in previous articles.

### RESPONDING TO PTO OFFICE ACTIONS

After receiving the First Office Action, you begin reconciling the

examiner's objections through the process of *Amendment and Response* within the time frame specified (usually three months) and using the format that the PTO requires. Response to the First Office Action can be as simple as rewording the specification or claims to overcome the objection. Often, a direct discussion with the examiner can clarify your claim and help you overcome the objection. You will often be asked to amend a claim to narrow its scope or application. For example, you may be required to modify a claim to limit a material description from "flexible material" to "flexible cloth" to satisfy the examiner. Other times, you must drop a claim because of prior art, obviousness, or similar reason. However, at no time during this process may you submit additional material.

The examiner may suggest ways to modify your specification or claim to overcome the objection. Your interaction with the PTO can quickly become complicated. Patent attorney Ed Pflieger, of patent-law firm Hayes Soloway, agrees.

"The procedural issues confronting a pending application are numerous," he cautions. Pflieger advises that you should consult with patent counsel before the application gets bogged down in the PTO. He warns that it is not a good idea

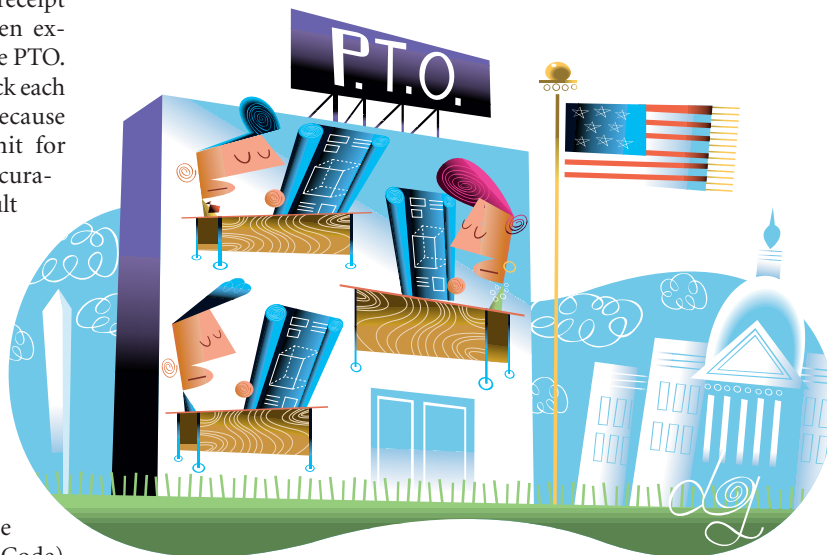


Illustration by Dan Guidera

to abandon an application while it is pending without the advice of counsel; the application filing date may be critical for several reasons, such as on-sale bar, publication bar, or overcoming prior art.

Once you submit the Amendment and Response, the examiner completes his evaluation. The next report you receive advises you on what changes and claims the examiner is willing to allow. This response is usually the final office action, so you should exercise great care when completing your initial response.

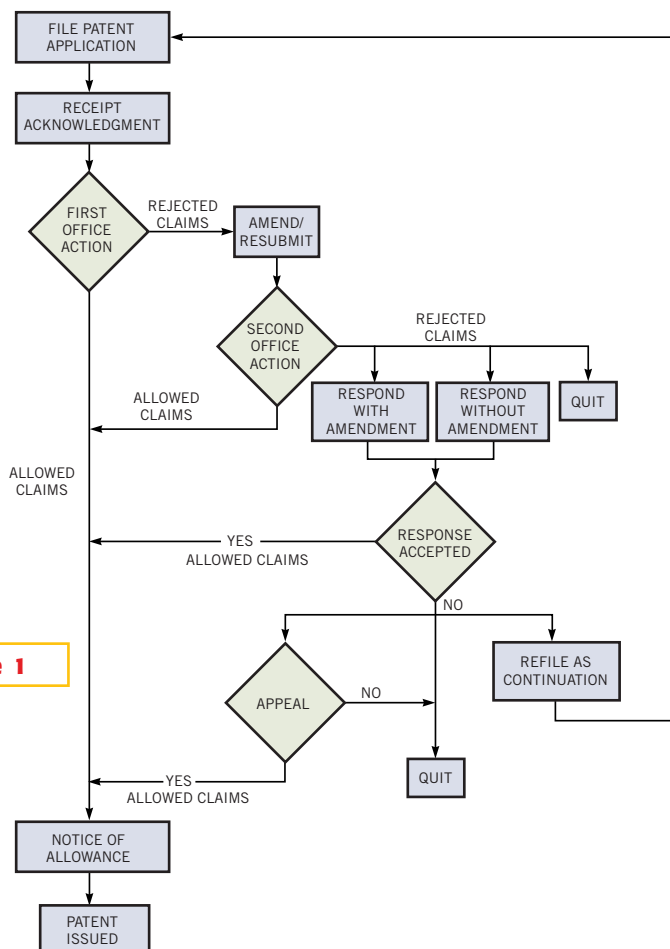
If the claims allowed result in an acceptable patent, all is well. However, if they do not, you still have several options. You may respond by filing an *Amendment and Response After Final Rejection* or simply a *Response After Final Rejection* depending on whether the application requires amendment to address objections. If that outcome is still unsatisfactory, you may either file a formal appeal to the patent commissioner or file a *Continuation Application*.

An appeal is fairly rare, and you should carefully research it before proceeding. You must file the *Continuation Application* within three months of rejection. This application typically involves restructuring your claims. Although the application receives a new filing date, the original filing date receives consideration if a conflict between two pending applications, or interference, exists. A *Continuation-In-Part Application* differs slightly, and you may use it, for example, when clarification of a claim requires new material that the original application does not contain. The continuation retains the same filing date as the original application.

You can more easily follow the steps involved in a typical patent prosecution by using the simplified flow chart in **Figure 1**.

### COMING DOWN THE HOME STRETCH

Once you resolve the issues and there is agreement on the specification and claims, your patent is essentially approved. The PTO then issues a *Notice of Allowance*, which indicates which claims will become



**This flow chart contains a simplified overview of patent prosecution.**

part of the issued patent. At this point, you should complete all final cleanups, such as drawing changes or language discrepancies, and enclose the patent issue fee with your response. An *Issue Notification Form* will follow within a few months of your response identifying the patent number and the date that the formal patent will be issued. Formal patents with the official PTO seal are always issued at noon on Tuesday. Receiving the official copy can be a very gratifying experience and will place you among the distinguished class of formally recognized inventors.

Ultimately, you must realize that a patent allows you to exclude others from using your invention in the United States for only 20 years. Protecting it in a foreign country may also be advisable, and, in most cases, you have one year from issuance to apply for a foreign patent. Also,

having a patent does not guarantee that you will be able to receive a financial benefit from it. You must devise a strategy for income generation through license, sale, or other commercialization of your invention. □

**AUTHOR'S BIOGRAPHY**  
*Randolph J Ford is responsible for intellectual-property coordination and new-product development at Apex Microtechnology (Tucson, AZ). He has a bachelor's degree in engineering from Kettering University (Flint, MI) and an MBA in technology management from the University of Phoenix. You can contact him at ipnews@yahoo.com.*

*Note: This information is provided to help you understand issues surrounding IP protection and management. It is not intended to substitute for legal counsel. Please consult with a competent IP attorney if you have legal questions.*