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Transforming Ideas into Opportunities

Patent Prosecution Strategies

Introducing Today's Presenters



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Patent Prosecution – Definitions

Filing A Patent Application

2 types of applications can be filed with USPTO:

- Provisional
- Non-provisional

PCT application (or international application) can be filed with WIPO

- Examined
- No resulting patent – national stage filing required

Individual countries patent application filings



Patent Prosecution – Definitions

Provisional Applications

Quick and inexpensive way to establish domestic priority date

Governed by 35 U.S.C. § 111(b) requiring:

- specification
- drawings if necessary to understand invention

Not required to include:

- oath
- claims



Patent Prosecution – Definitions

Provisional Applications

Advantages:

- “Patent Pending”
- Proof of date of conception
- Priority can be relied on for foreign filings
- Placeholder while developing product/raising funds
- No publication



Patent Prosecution – Definitions

Non-Provisional Applications

Can be stand alone or claim benefit of provisional application’s filing date if:

- filed within 10/12 month of provisional application filing date and
- adequately supported by disclosure of provisional application

Nonprovisional applications are “regular” or “full-service” applications

- examined
- must include claims and inventor oath(s) or declaration(s)
- expiration (when allowed) 20 years from filing date of nonprovisional application



Patent Prosecution – Definitions

Examination by the USPTO

Once all files of application submitted:

USPTO review for formatting/missing parts...

Elements of a utility patent application (MPEP 600)

- (1) Utility application transmittal form
- (2) Fee transmittal form
- (3) Application data sheet
- (4) Specification
- (5) Drawings
- (6) The inventor's oath or declaration



Patent Prosecution – Definitions

Examination by the USPTO

Parts of a utility patent application (MPEP 600)

- (1) Title of the invention
- (2) Cross-reference to related applications
- (3) Statement regarding federally sponsored research or development*
- (4) The names of the parties to a joint research agreement
- (5) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc
- (6) Statement regarding prior disclosures by the inventor or a joint inventor
- (7) Background of the invention
- (8) Brief summary of the invention
- (9) Brief description of the several views of the drawing
- (10) Detailed description of the invention
- (11) A claim or claims
- (12) Abstract of the disclosure
- (13) Sequence Listing (if on paper)



Patent Prosecution – Definitions

Examination by the USPTO

The Government Support Clause (GSC) must meet the requirements of the Bayh-Dole Act and Federal regulations. 37 CFR 401.14 (f)(4). The required language for the GSC is as follows:

“This invention was made with government support under [grant/contract number] awarded by the [government agency name]. The government has certain rights in the invention.”



Patent Prosecution – Definitions

Examination by the USPTO

After about 1-2 years from filing date:

Examiner assigned to examination:

form and contents (objections)

application requirements (definiteness)

invention requirements (novelty – nonobviousness)



Patent Prosecution – Definitions

Examination by the USPTO

Examiner issues office actions

- Non-final office actions
- Final office actions

Applicant submits responses

- Arguments
- Amendments

Examiner may allow some or all claims



Patent Prosecution – Definitions

End of Prosecution Options

Applicant may cancel non-allowed claims and proceed with patent

Applicant may appeal Examiner's decision

Applicant may request continued examination (RCE)

Applicant may file continuing application(s)

- Continuation (CON)
- Divisional (DIV)
- Continuation-in-part (CIP)



Patent Prosecution – Timeline

Timelines variations

Per application type

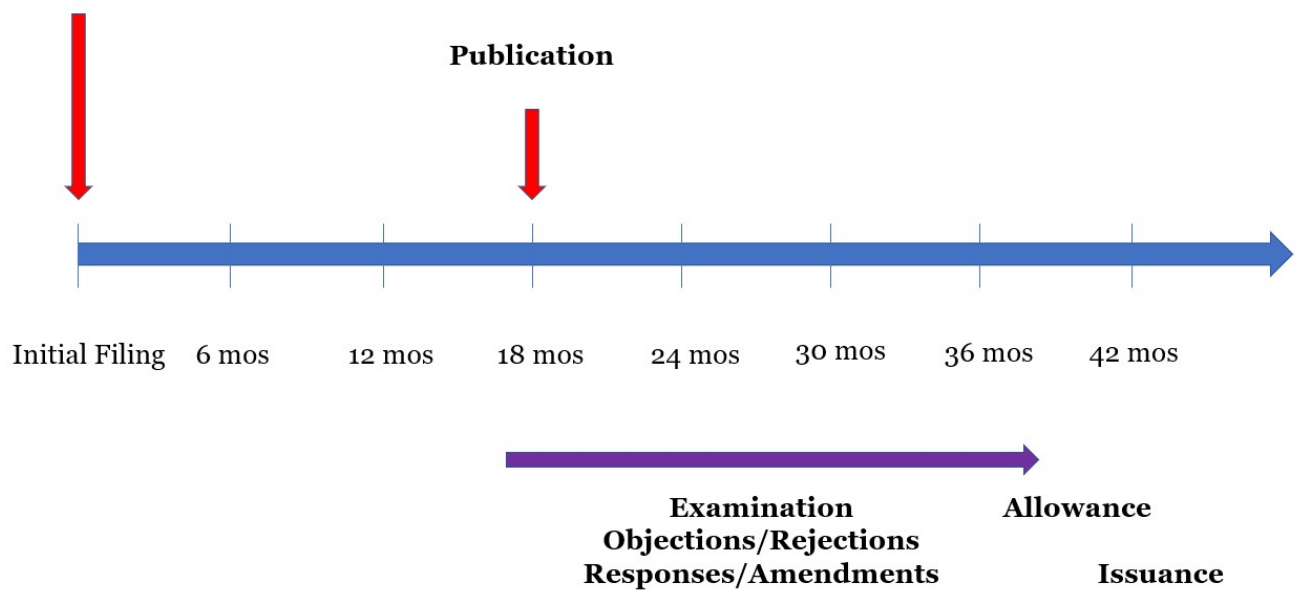
- Non-provisional
- Provisional
- PCT

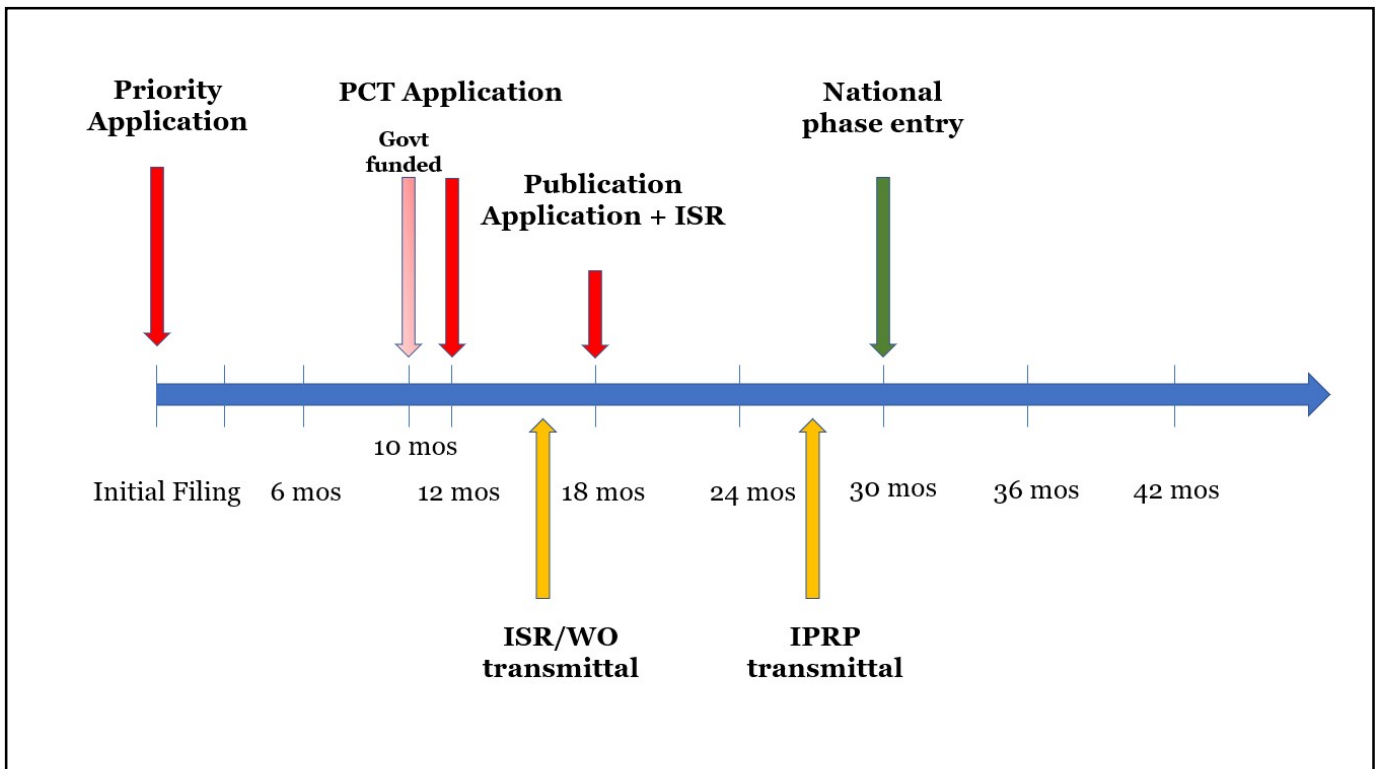
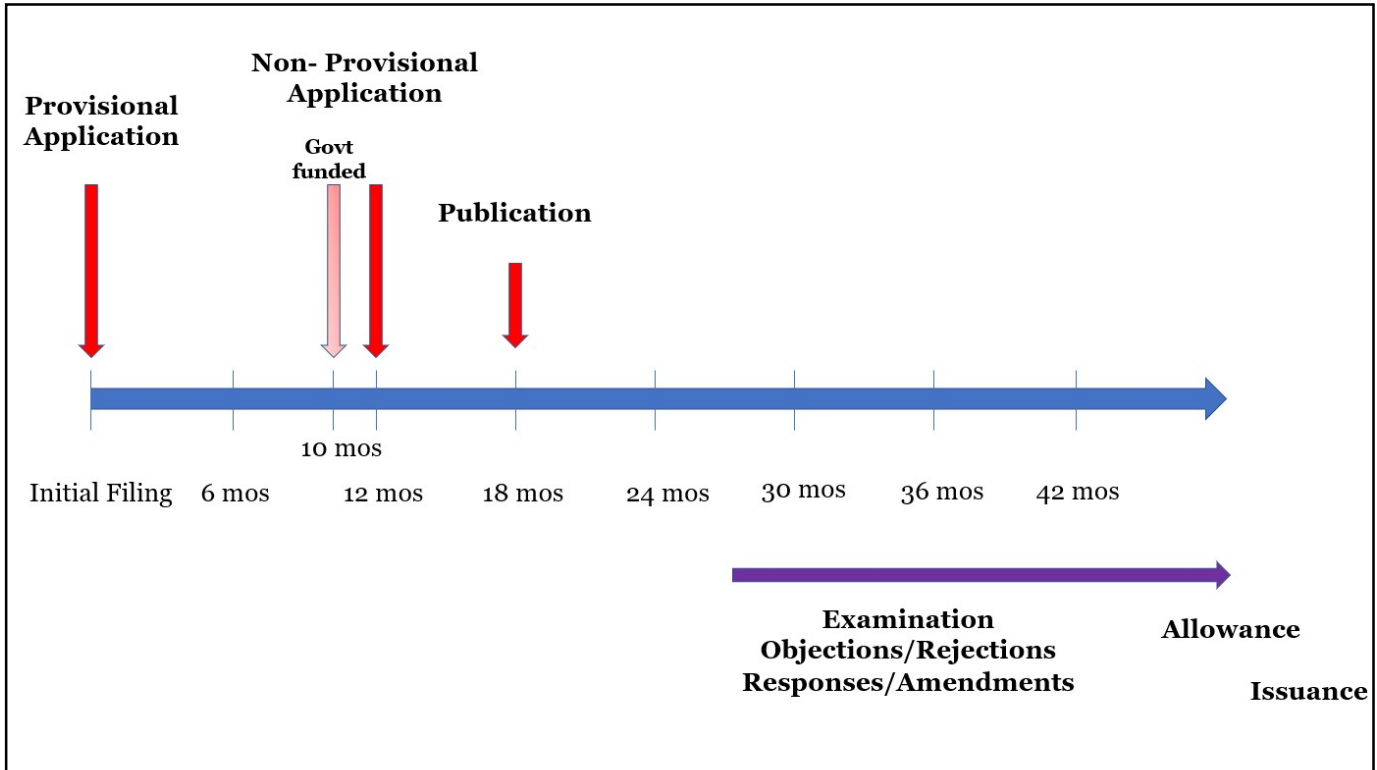
Options to make prosecution

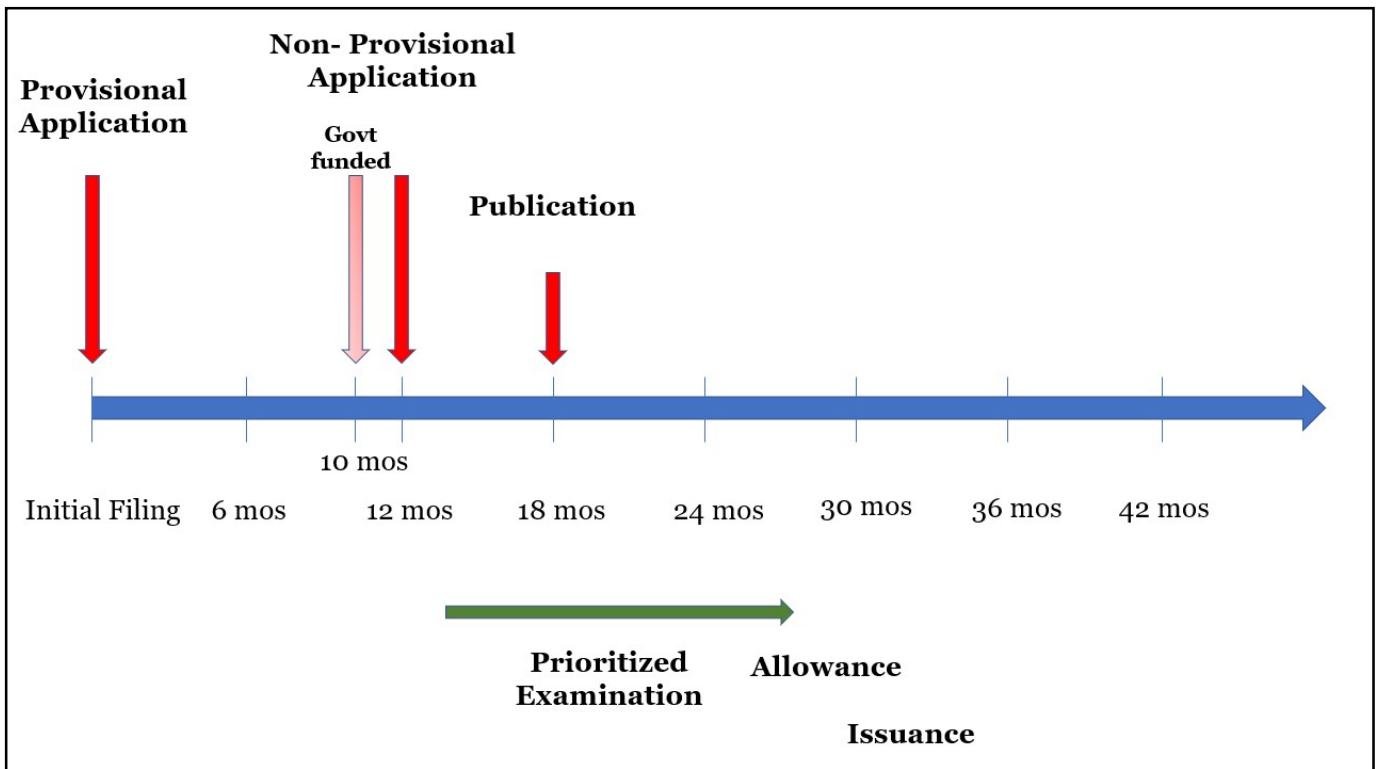
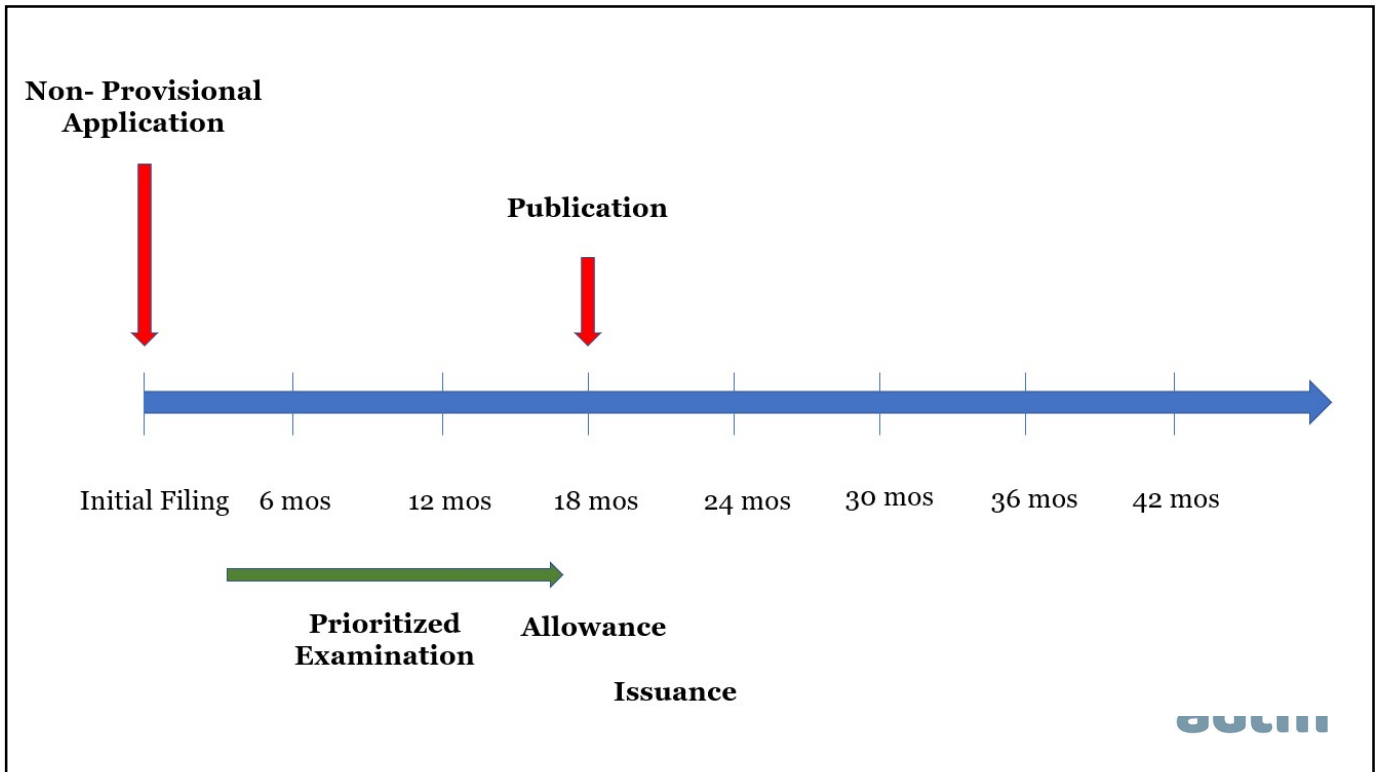
- longer
- shorter



Non- Provisional Application







Patent Prosecution – Timeline

Longer prosecution times

- Prosecution-related expenses delayed
- Changes in law
- Valuable “patent pending”
- Developing invention time



Patent Prosecution – Timeline

Shorter prosecution times

Prioritization – USPTO Track One program

- 15,000 annual requests
- fee (\$2,100 small entities)

Petition to make special

- Age (inventor 65 and older)
- Illness
- Type of invention
 - enhances quality of environment
 - contributes to development of conservation of energy resources
 - contributes to countering terrorism



Patent Prosecution – Timeline

Shorter prosecution times

Patent Prosecution Highway (PPH)

PCT application – National stage in 2+ countries

- 1st country: patent granted

- 2nd country: PPH program to expedite prosecution - claims allowed in 1st country

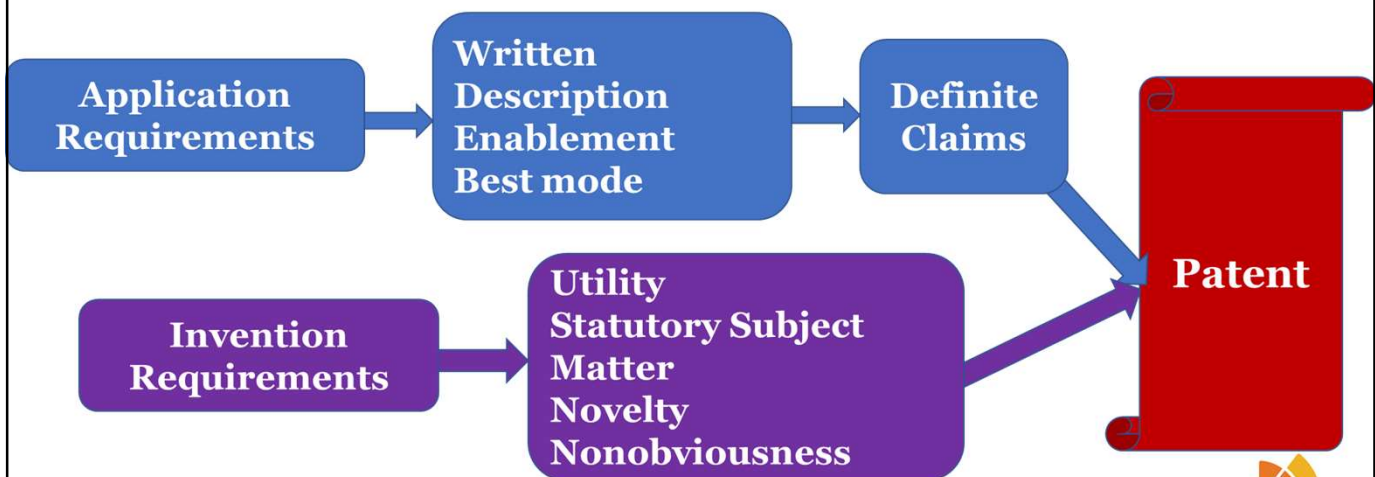
PCT-PPH

PCT application – Favorable ISR/WO

Request for expedited prosecution in US – No fee



Patent Prosecution – Patent Requirements Overview



Patent Prosecution – From Invention to Examination

Invention – Beyond the Invention Disclosure Form towards the Inventive Concept

Questions to inventor:

- Describe full invention as completely as possible
- How was it originated?
- What problem(s) are solved/How are they solved?
- Are these old/new problems?
- Are there any current solutions?
- If so what is different in the invention?
- Restate to the inventor understanding of invention and problem-solution



Patent Prosecution – From Invention to Examination

Invention – Beyond the Invention Disclosure Form towards the Inventive Concept

Questions to inventor:

- Are there any possible alternatives to the invention or any of its elements?
- Can the solution to the problem accomplished by the invention be more generally applied to other fields?
- Does the invention create any problems and how can they be solved?
- How would a commercial product incorporate invention?
- Are there any companies practicing similar or related technology?



Patent Prosecution – From Invention to Examination

Invention – Beyond the Invention Disclosure Form towards the Inventive Concept

Underlying aspects behind questions to ask:

- Written Description (separate what from how)
- Enablement (separate how from what)
- Best Mode (prototypes, etc...)
- Prior art differences
- Fallback positions
- Foreseeable designing around
- Commercial merit and prospects



Strategic Filing

Decision on filing for protection

Based on inventor feedback, there are several routes for filing and questions for you to consider:

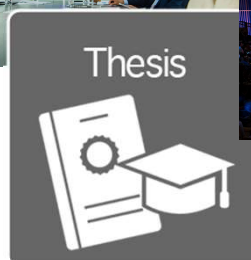
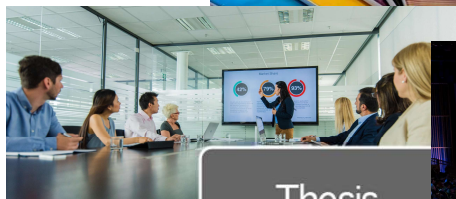
- Has any/some of the underlying aspects been publicly disclosed?
- Does this innovation have foreign applications?
- Does the invention have a narrow scope or field of use, lots of prior art?
- Does the invention have many potential applications, little prior art?



Public Disclosure

Types of Disclosure

- Journal articles
 - Prepublication or Publication
 - Online journals
- Presentation
 - Funding opportunity
 - Thesis defense
 - Conference



Was the disclosure enabling?



Grace Periods for Public Disclosure

- Non-exhaustive list of countries with grace periods for filing
 - US, Singapore, Australia, South Korea, Canada, Japan, Brazil, Phillipines, and others
 - Referred to as “**relative novelty**” countries
- Countries without a grace period
 - Europe, including Germany, UK, France, Italy, and Spain
 - Referred to as “**absolute novelty**” countries



Foreign Filings

- Foreign filings can be far more difficult to navigate, not to mention expensive
- Articulated reasoning for the filing, would the invention be used or made in that country?

Example:

The invention is a jet engine, what potential licensee is interested in it?
Brazil has very few engine fabricators in country, so probably wouldn't make sense to file in Brazil

Example:

The invention is a crop that is widely produced in countries outside of the US, it might be useful to seek protection in a country that primarily grows the crop



Strategy for US filings

Approach:

- As broad as possible, with specific fallback positions
- Utilize answers from the inventor and research
- Keep in mind a potential licensee when crafting fallback positions
 - What would a company who wants to commercialize this product need protected, the method of making it? The composition? Both?

Specification

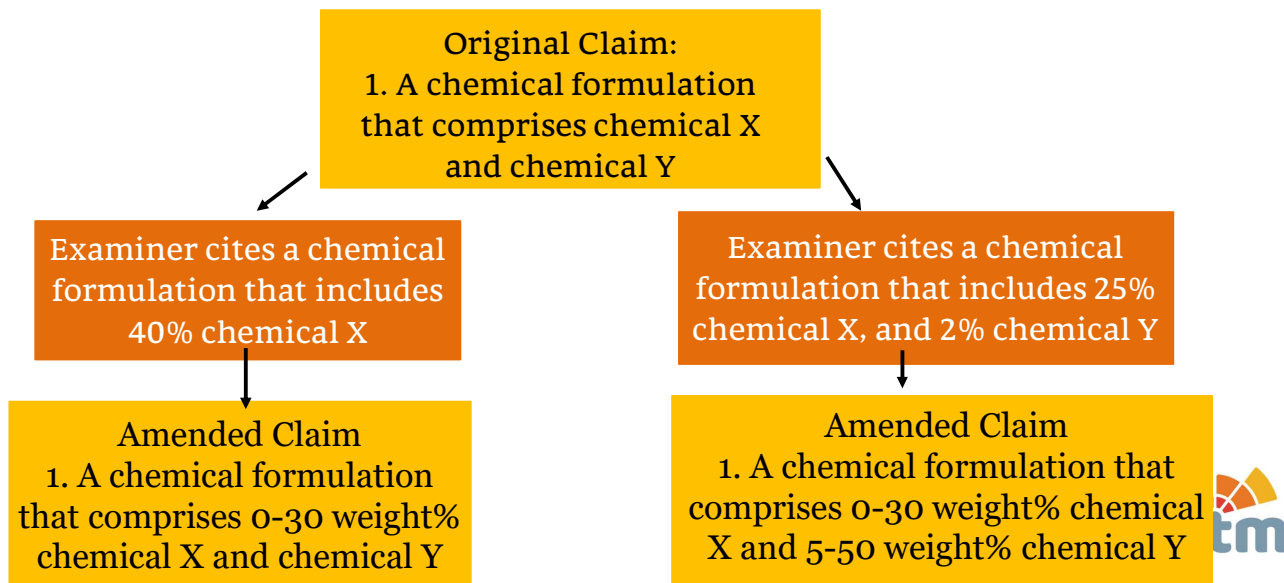
Initial
independent
claims

Dependent
claims



Fallback Positions and Support

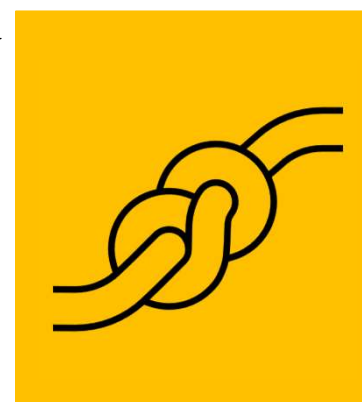
Fallback positions and verbatim support



But What about Restriction Requirements?

That is OK!

- Restriction requirements are not uncommon, and electing a group with traverse can allow for rejoinder later
- Rejoinder: A consideration of claims directed to non-elected species or inventions that may be eligible if the claim depends from or otherwise requires all limitations of an allowable claim
- An example: Original application was subject to a restriction requirement, and there is a product and a process of making and/or using the product. The product was elected, is now allowable, and under MPEP §821.04(b), the process/method of making and/or process/method of using claims can be allowable if they require all of the limitations of the product claims



Planning Ahead

- Upfront discussions with your inventors can guide filing decisions and areas
- A broader specification gives you more options in prosecution efforts
- Fallback positions clearly laid out will also guide prosecution efforts
- Rejoinder may be a more cost-effective protection than divisional applications



“A man who does not plan long ahead will find trouble at his door”

—
-Confucius

