

August 4, 2007

## THE PATENT PROCESS

By S. Daniel Daugherty II and Thomas R. (Terry) Williamson III, Esq.,

Obtaining a [patent](#) is often a long and complicated process which generally requires the aid of a patent attorney or patent agent. It is quite typical to take two years to obtain a patent, and for some types of inventions significantly longer (you are in '[Patent Pending](#)' status this whole time). During this process, much of what is necessary is essentially a negotiation process with the United States Patent & Trademark Office (USPTO) to allow as much as possible of your [invention](#). This article will attempt to give a brief overview of that process and the parties involved.

A patent grants the [inventor](#), an exclusive licensee or assignee of the patent, the exclusive right to prevent or exclude others from making, using, selling, offering to sell or importing the invention into the United States. A patent attorney is an attorney at law admitted to the bar in at least one state and who is authorized to practice before the United States Patent and Trademark Office (USPTO) after passing an extensive examination. A patent agent takes the same exam, but is not authorized to practice law outside of federal matters, as authorized by the USPTO, such as filing patent applications. Generally an inventor will contact a patent attorney or patent agent to conduct a patent search. Assuming there appear to be patentable features to the invention, a patent application will be drafted and filed with the USPTO. Subsequently, a series of communications will be conducted back-and-forth between an Examiner at the USPTO and the inventor's patent attorney or agent. Following arguments by each, a patent will either be granted or denied. Each of these steps will be discussed in greater detail below.

### **The Patent Search**

Before filing a patent, it is highly recommended that an inventor request a [patent search](#). Patent searches are primarily conducted by patent attorneys, patent agents or professional patent searchers, but should only be interpreted by patent attorneys who are familiar with the law. A patent search allows an inventor to determine if the invention is most likely patentable before committing the resources necessary to draft, file and prosecute a patent.

A patentability opinion is the application of law to facts disclosed in reference documents, such as patents and published patent applications, and more specifically the application of what is disclosed in these prior-art references as it pertains to the invention one wishes to patent. Prior art can briefly be described as any information which has been made publicly available before the conception of the idea which relates to the invention. More specifically, if the invention has been known or used by others in the United States, patented or described in a printed publication, including the Internet, anywhere in the world, then the invention is unlikely to be patentable. Thus, a substantial amount of fact gathering is required for a patent search.

## **The Patentability Opinion**

Once these facts are gathered and the patent search is complete, the next step is to interpret the facts and apply them to the invention. The same group of patent documents can often be seen in many ways or construed differently by different persons, but a competent opinion as to the patentability of an invention will be provided by a qualified patent attorney. The [patentability opinion](#) resulting from the patent search drafted by the patent attorney will tell an inventor what prior art exists and which aspects of the invention are most likely to be found patentable. Upon finding patentable aspects of an invention, an inventor can better decide whether or not to dedicate the resources necessary to drafting a patent and filing it with the USPTO.

In preparing a patentability opinion from the patent search, a patent attorney is looking particularly for certain things. First, if every element of the invention is disclosed (sometimes referred to as 'taught') by a patent or other publication, the new invention will not be considered to be novel, and thus, is not patentable. Second, the patent attorney looks to see if each of the elements of the new invention can be found by looking in several references. If a combination of two or more references discloses each and every element of the new invention, it may not be patentable. The references must be from the same field of art; that is, references related to automotive devices would not likely be combinable with references related to clothing. Further, there must be some reason within the references themselves to combine the references, although the law is shifting as to this aspect. Lastly, references that 'teach away' from the new invention, that is, that basically say that a portion of the new invention cannot be done or would not likely succeed, will not be combinable as to that portion.

## **The Patent Application**

A [patent application](#) is made up of the [specification](#) (written discussion), the [claims](#) and [drawings](#) of the different embodiments of the invention. The claims are actually what describe the invention, but the specification and drawings provide the explanation of the invention so that the claims will have meaning. The specification contains the background of the invention discussing what is previously known and what is lacking that makes the invention desirable or necessary, a summary of the new invention, and a detailed description of the new invention which sets forth through a description of the drawings, the embodiments of the inventions. Both preferred and alternate embodiments (variations) may be found to describe different ways of making or using the invention.

The claims generally set out the scope of the invention and the scope of protection which will be afforded the invention. The claims describe, in a very specific legal style, the essential and patentable features of the invention in a manner which clearly defines what would infringe on the patent. Thus, the claims are the central part of an application, while the summary of the invention and the detailed description in accompaniment with the drawings are often easier to read, and describe the invention in its broader aspects and uses, thereby providing support to what is in the claims. Once the specification and claims have been written and the drawings have been drafted, the completed patent is

sent to the inventor for review. After any necessary revisions or additions, and with the inventor's final approval and signature of the declaration that they are the actual inventor(s), the application can then be filed with the USPTO.

### **At the United States Patent & Trademark Office**

Once the patent application has been received by the USPTO with its accompanying forms, payment and information, confirmation is sent by the USPTO to the patent attorney or patent agent who represents the inventor. The application will be reviewed by the USPTO's Office of Initial Patent Examination (OIPE) to ensure that everything necessary is present and then the application will be scanned and entered into the USPTO's electronic database. Afterward, the application is assigned to a Group Art Unit at the USPTO (that is a group that deals with the type of invention submitted) where it will be further assigned to an Examiner, who works in the specific field or area of study.

### **The Examination**

The Examiner will review the application and conduct a separate search of the relevant prior art to determine if she/he feels the invention is patentable, based primarily on whether it is novel and non-obvious. The Examiner may find prior art which was not available during the patent search or other information pertaining to the invention. Most of the time, the Examiner will find at least some aspects of the claims of the application which she/he does not feel is patentable and will send a Non-final Office Action to the inventor's representative patent attorney or patent agent.

### **Restriction**

Occasionally, the Examiner may consider the application to contain two or more different inventions. In such a case, the Examiner will require the inventor to restrict to a single invention and continue the prosecution at the USPTO on that invention only. However, the inventions that are not selected may be held in abeyance and subsequently prosecuted as their own separate applications to result in additional patents issued, so long as they are re-filed before the first patent issues. An Examiner may also require restriction to a single species that is part of a larger genus. In such a case, the Examiner is limiting the breadth of his/her search and examination to the single species and if it is found patentable, then the other non-selected species should also be patentable if they are linked through the genus. For instance, if an invention was for a car with wheels and subsequent separate dependent claims were to cars with three wheels and cars with four wheels, the Examiner might require that either three or four be selected as the species. It is also possible that an Examiner may require selection between species based on what is shown in the drawings. In such case, the inventor, through his/her attorney will need to restrict to a single or group of drawings and identify the claims that relate to that single or group of drawings.

When a requirement for Restriction is received, a response must be made within one month to avoid paying surcharges. Later responses may be made for five more months at

increasingly heavy surcharges. If no response is made within six months from the issuance of the Office Action, the patent application will go abandoned.

### Non-final Office Actions

After the Non-final Office Action is received by the patent attorney, it will be analyzed to determine whether it appears that the Examiner's view may be overcome through either amendment or argument or both, and a copy of the Office Action will be sent to inventor along with suggestions from the patent attorney or patent agent of how to proceed. The patent attorney or patent agent may agree with the Examiner's comments and suggest the claims be amended to comply with the Examiner's suggestions, or there will be disagreement with the Examiner's point of view. If there is disagreement by the patent attorney over the patentability of the patent application, then a response to the Office Action will be sent to the USPTO which sets forth, on behalf of the inventor, the arguments for patentability. Now the Examiner may either agree with the arguments of the patent attorney or patent agent and issue a Notice of Allowance granting the application, or she/he may still disagree and issue another Office Action. The second and any subsequent Office Actions may be Non-final or the Office Action can be Final. So long as the Examiner issues a Non-final Office Action and there is still a question to patentability, the patent attorney or patent agent and the Examiner may continue to discuss the reasons for or against patenting the invention. The goal of the patent attorney or patent agent is to get the broadest protection for the inventor at this stage as possible and hopefully any disagreements will be resolved in favor of the inventor. If so, then a Notice of Allowance will be issued and the patent will be granted.

As with the requirement for Restriction, a response must be made to the Non-final Office Action. The time frame for the Non-final Office Action allows a response within three months without having to pay a surcharge. A response must still be made within six months from issuance of the Office Action to avoid abandonment.

### Final Office Actions

Eventually, if the Examiner continues to refuse to allow any claims and the Examiner considers the claims and arguments to have already been addressed in a prior Office Action, a Final Office Action may be issued. As with the Non-final Office Action, a Final Office Action may be responded to within three months without surcharge or up to six months with surcharges. After six months, the application will go abandoned if no response is made. For the following reason, it is prudent to actually file a response within two months, rather than waiting three or more.

### Advisory Action

For Final Office Actions, there is a special case. If a response is made within two months, the Examiner will try to issue an Advisory Action commenting, or may allow the application based on the response. It is important to respond to Final Office Actions within the two month timeframe because if the Examiner is still disallowing some or all

claims in the Advisory Action, there is still time to take action without having to pay a surcharge if the action is taken before the end of the first three months. Principally, the patent attorney or patent agent can continue to argue patentability through filing a Request for Continued Examination or through the Appeal process. If the inventor no longer wishes to proceed, the application will go abandoned.

Note: In certain circumstances for a short period of time, patent applications (or patents) that have gone abandoned may be resurrected. A patent attorney should be consulted promptly if such has occurred to allow for a timely resurrection of the application or patent.

### Issuance

Once claims have been allowed, the patent application can proceed to Issuance. A Notice of Allowance will be issued along with a Notice of Allowability that may explain why the Examiner has allowed the claims. The issue fee must be paid within three months (NO EXTENSIONS) or the application will go abandoned. Once the issue fee is paid, the application will typically issue as a patent within about two to three months.

If you have any questions about this article, or are interested in trying to obtain a patent please feel free to contact [Williamson Intellectual Property Law, LLC](#) of Atlanta, Georgia. Alternatively, feel free to read other articles on similar subjects relating to both foreign and United States patent, trademark and copyright law. For more information on the patent process, please visit [Patent Information](#).

The content of this article is not intended to be, and does not constitute, legal advice and does not create attorney-client privilege. Consult the attorney of your choice before embarking on any legal matter or any document preparation/filing.

Dr. Thomas R. (Terry) Williamson III is a [Patent Attorney](#) practicing in Atlanta, Georgia.  
Williamson Intellectual Property Law, LLC  
1870 The Exchange, Suite 100  
Atlanta, GA 30339  
770-777-0977  
<http://www.trwiplaw.com>