

# The Fundamentals of Patent Prosecution (alternatively “The Basics of How to Obtain a Patent”)

CLE Outline

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1. Introduction
  - a. Background and why the course is important to attorneys and their clients
  - b. Patent practice basics
  - c. Issuing Patents to Inventors/Protecting Inventors
  
2. General Info About the USPTO - United States Patent and Trademark Office
  - a. Agency with U.S. Department of Commerce
  - b. Main Office – Alexandria, VA
  - c. Satellite Offices
  - d. Examiners
  - e. Controlling Law
    - i. **United States Code Title 35 - Patents**
    - ii. Title 37 - Code of Federal Regulations Patents, Trademarks, and Copyrights
    - iii. **Manual of Patent Examining Procedure (MPEP)**
  
3. What Types of Tech can be Patented? 35 USC 101
  - a. Inventions patentable. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
    - i. Mechanical/Electrical – Apparatus/System Patent
    - ii. Process – Method Patent
    - iii. Chemicals/Materials
    - iv. Plants – Plant Patent
  
4. What Types of Tech cannot be Patented?
  - a. Equations
  - b. Naturally-occurring Items
  - c. Abstract Ideas
  - d. “Some” Computer Inventions
    - i. ***Alice Corp. v. CLS Bank International***, 134 S. Ct. 2347 (2014)
      1. Patent Subject Matter and Patent

- a. Issue: whether certain claims about a computer-implemented, electronic escrow service for facilitating financial transactions covered abstract ideas ineligible for patent protection
- b. The patents were held to be invalid because the claims were drawn to an abstract idea, and implementing those claims on a computer was not enough to transform that idea into patentable subject matter.
- ii. Abstract ideas implemented on a computer
- iii. Machine or transformation test
- iv. “something more” than using a computer
- e. Publication would be “Detrimental to National Security”
  - i. 35 USC 181

**1. §181. Secrecy of certain inventions and withholding of patent**

2. Whenever publication or disclosure by the publication of an application or by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent therefor under the conditions set forth hereinafter.
3. Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner of Patents, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.
4. Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the

chief officer of another department or agency so designated, the publication or disclosure of the invention by the publication of an application or by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner of Patents and the Commissioner of Patents shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner of Patents shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

5. An invention shall not be ordered kept secret and the publication of the application or the grant of a patent withheld for a period of more than one year. The Commissioner of Patents shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner of Patents may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

ii. **MPEP 115 115 Review of Applications for National Security and Property Rights Issue**

1. Whenever publication or disclosure by the publication of an application or by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of an application or the grant of a patent therefor under the conditions set forth hereinafter.

## 5. Who Can File Patent Applications?

- a. Inventors
- b. Patent Agents vs. Patent Attorneys
  - i. Patent Bar
  - ii. Technical/Education requirements

## 6. Types of Applications

- a. Provisional
  - i. Spec and Drawings
  - ii. Filing Fee
  - iii. 12 Months
- b. NonProvisional
  - i. Spec, Drawings, and Claims
  - ii. Filing Fee
  - iii. Thorough Examination
- c. Design
  - i. Drawings
  - ii. Filing Fee
  - iii. Easy Examination

## 7. Other Miscellaneous Paperwork Usually Filed

- a. Declaration
- b. POA
- c. Assignments
- d. Information Disclosure Statement
  - i. MPEP 609

1. (a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with **§ 1.98** considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

2. (b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:
  - a. (1) Within three months of the filing date of a national application other than a continued prosecution application under **§ 1.53(d)**;
  - b. (2) Within three months of the date of entry of the national stage as set forth in **§ 1.491** in an international application;
  - c. (3) Before the mailing of a first Office action on the merits;
  - d. (4) Before the mailing of a first Office action after the filing of a request for continued examination under **§ 1.114**; or
  - e. (5) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application.
3. (c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under **§ 1.113**, a notice of allowance under **§ 1.311**, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:
  - a. (1) The statement specified in paragraph (e) of this section; or
  - b. (2) The fee set forth in **§ 1.17(p)**.

ii. 37 CFR 1.97 - **FILING OF INFORMATION DISCLOSURE STATEMENT**

1. a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with **§ 1.98** considered by the Office during the

pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

2. (b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

- a. (1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);
- b. (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;
- c. (3) Before the mailing of a first Office action on the merits;
- d. (4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114; or
- e. (5) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application.

3. (c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

- a. (1) The statement specified in paragraph (e) of this section; or
- b. (2) The fee set forth in § 1.17(p).

4. (d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:
  - a. (1) The statement specified in paragraph (e) of this section; and
  - b. (2) The fee set forth in § 1.17(p).
5. (e) A statement under this section must state either:
  - a. (1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or
  - b. (2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.
6. (f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. If a bona fide attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

7. (g) An information disclosure statement filed in accordance with this section shall not be construed as a representation that a search has been made.
8. (h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).
  - a. (i) If an information disclosure statement does not comply with either this section or § 1.98, it will be placed in the file but will not be considered by the Office.

## 8. Patent Searching

- a. Knock out searches
- b. Technical landscape
- c. Freedom to Operate
- d. USPTO Search

## 9. The Prosecution Process

- a. Application Formalities
  - i. Drawings
    1. Color
    2. Line weights
  - ii. Abstract
  - iii. # of Claims and type
  - iv. Misc. Paperwork
- b. Restriction/Election of Species
- c. First Office Action
  - i. Patentable Subject Matter
    1. 35 USC 101
      - a. Inventions patentable. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
  - ii. Clarity of Claim Language



1. “particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery”
  2. MPEP 608.01(i)
    - a. The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.
  3. 37 CFR 1.75
- iii. Support for Claim Language in Spec
1. Written description that is enabling
  2. 35 USC 112
    - a. (a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.
    - b. (b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.
    - c. (c) FORM.—A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.
    - d. (d) REFERENCE IN DEPENDENT FORMS.—Subject to subsection (e), a claim in dependent form shall contain a reference to a claim previously set forth and

then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

- e. (e) REFERENCE IN MULTIPLE DEPENDENT FORM.—A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.
- f. (f) ELEMENT IN CLAIM FOR A COMBINATION.—An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

iv. Novelty

1. 35 USC 102
2. This section also describes the types of prior art
  - a. Prior publications (either applicant or others)

- b. Prior applications (either applicant or others)
    - c. Prior Use / Offer for Sale / Disclosure
  - v. Obviousness
    - 1. 35 USC 103
      - a. A patent may not be obtained... if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains
    - 2. Put yourself in the shoes of a PHOSITA, surrounded by all prior art in your workshop
    - 3. TSM test
    - 4. ***KSR Int'l Co. v. Teleflex, Inc.***, 550 U.S. 398 (2007)
      - a. No explicit suggestion or motivation for the invention is necessary, “common sense” could find motivation implicit in the prior art
    - 5. USPTO KSR Rationales – MPEP 2141-2143
      - a. TSM still valid, but not controlling
    - 6. Argue against KSR Rationales
      - a. No reasonable expectation of success
      - b. Teaching away
    - 7. Non Analogous Art
      - a. MPEP 2141.01(a)
    - 8. Secondary Considerations
      - a. MPEP 2141
      - b. commercial success, long-felt but unsolved needs, failure of others, and unexpected results
  - d. Applicant’s Response Brief
    - i. Claim Amendments
    - ii. Specification/Drawing Amendments
    - iii. Legal Argument
      - 1. Must address every objection and rejection
  - e. Second (Final) Office Action
  - f. Allowance (if you are lucky)
  - g. Request for Continued Examination
  - h. Pre-Appeal Brief Conference
  - i. Appeal to the Patent Trial and Appeal Board
  - j. Appeal to the Federal Circuit
  - k. Appeal to the US Supreme Court

10. After Allowance

- a. Notice of Issuance
  - b. Continuation/Divisional Applications
  - c. Patent Issuance
    - i. Issue fee
  - d. Maintenance Fees
    - i. 3.5, 7.5, 11.5 years after grant
    - ii. None for design and plant patents
11. International Patenting
- a. Patent Cooperation Treaty
  - b. Individual Country Patents
12. Patent Enforcement
- a. Cease and Desist Letters
  - b. Settlements (Licenses)
  - c. Litigation
    - i. Validity
    - ii. Infringement

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