

Knobbe Practice Webinar Series: Overview of Statutory Requirements, Timelines and General Strategy Considerations for Patent Prosecution

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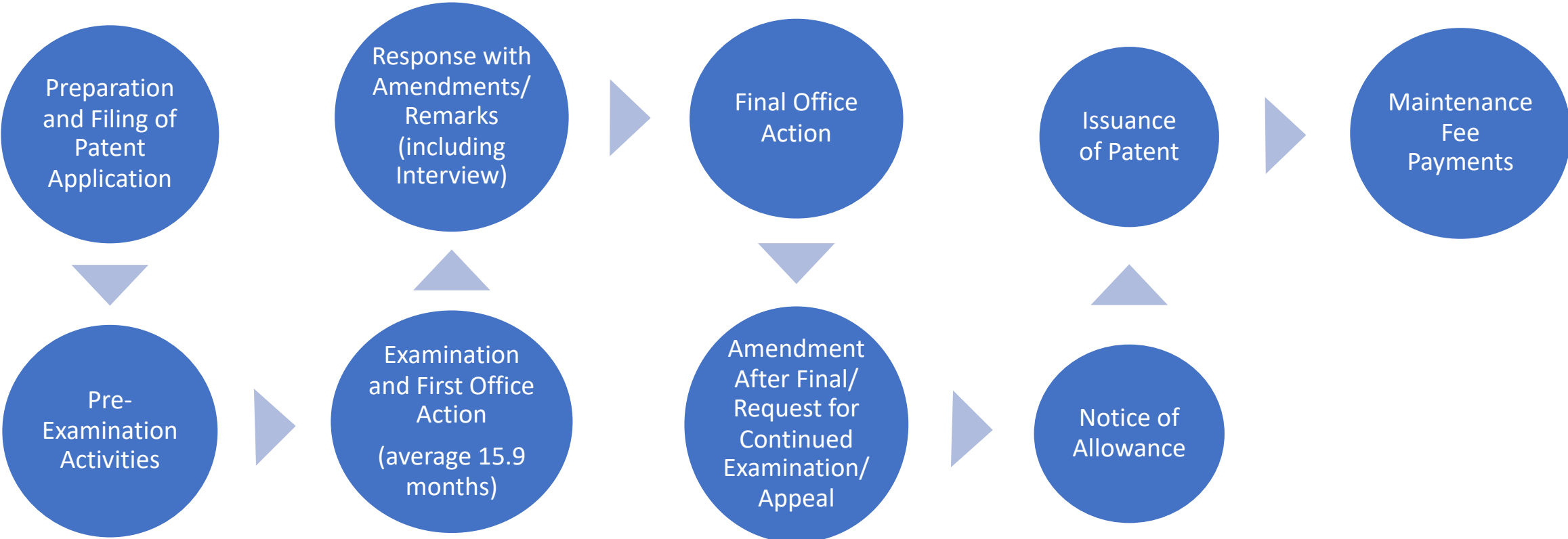
Mauricio Uribe

1 U.S. Patent Prosecution Timeline and Strategies


2 Statutory Requirements

3 General Strategy Considerations

Lifecycle of a U.S. Patent Application



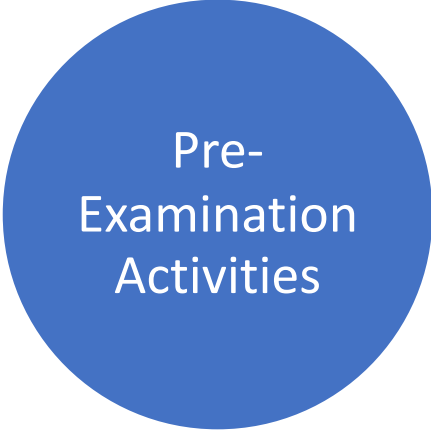
Lifecycle of a U.S. Patent Application



Preparation and Filing of Patent Application

- Specification, claims and drawings
 - Claim amendments (e.g., removing multiple dependent claims, more independent claims)
 - Provide high quality drawings
- Inventors
 - Full name
 - Residence
 - Mailing address
 - Declaration (need by issue fee payment)
- Applicant
 - Assignment (not required but recommended)
- Large or small or micro entity
- USPTO Fees effective 2 October 2020 (50% for small entity, 25% for micro entity)
 - Filing fee/basic national stage fee – \$320
 - Search fee – \$700; \$140 if U.S. was the ISA; \$540 if search report provided to USPTO
 - Examination fee – \$800; \$0 if U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)
 - Surcharge – \$160 (if missing any of the fees above or no inventor declaration)
 - Each independent claim over 3 – \$480
 - Each claim over 20 – \$100
- Request for special treatment – prioritized examination, First Action Interview (FAI), patent prosecution highway (PPH)

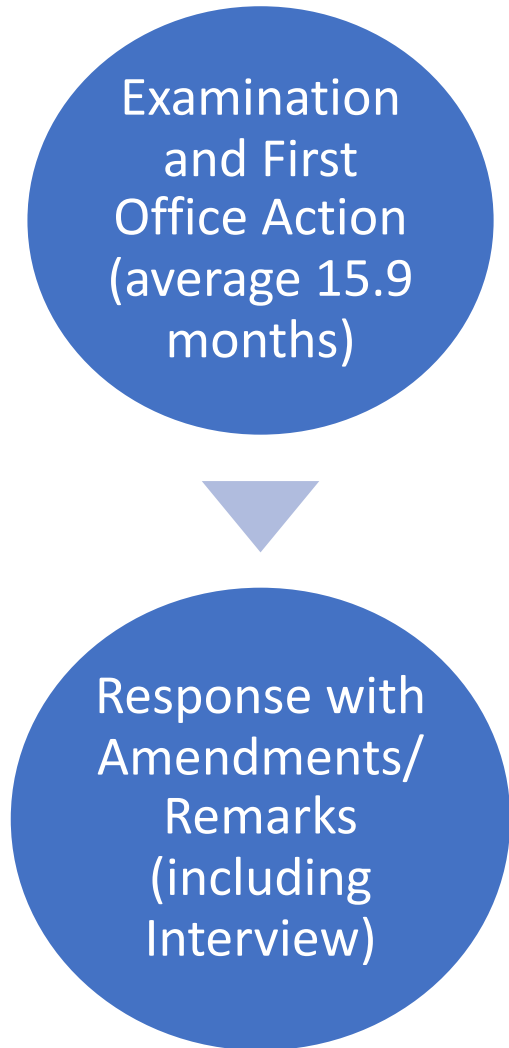
Lifecycle of a U.S. Patent Application



Pre-
Examination
Activities

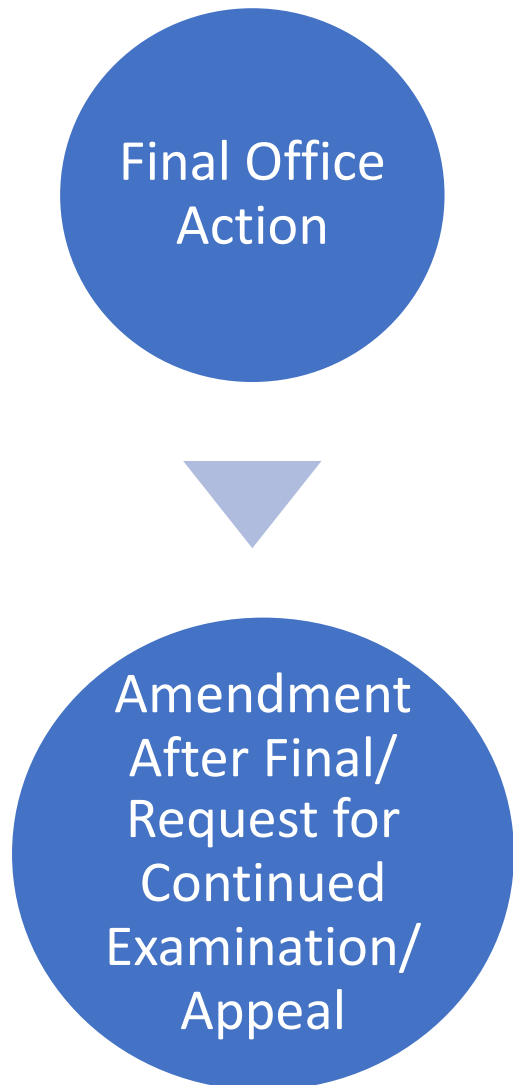
- References for Information Disclosure Statement
 - Submit with initial filing or ideally within 3 months
 - Continue to notify U.S. attorney of new references, particularly from other searches/examinations
- Evaluation of requests for special treatment
- Missing parts notice/notice of insufficiency
 - Missing fees
 - Informal drawings
 - 2 months to respond, extendible by up to 5 additional months (7 months total)
- Filing receipt
 - Check applicant
 - Check priority claim
- Publication
- No specific deadline for voluntary amendments

Lifecycle of a U.S. Patent Application



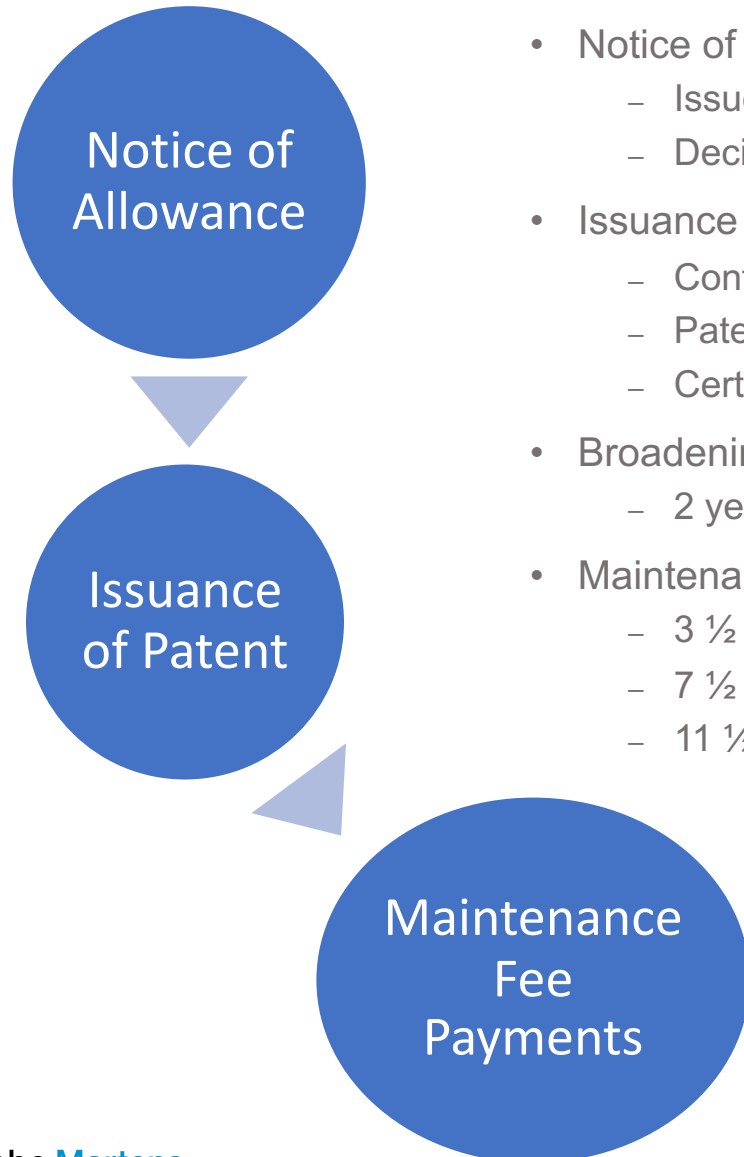
- Restriction Requirement
 - Multiple inventions recited in the claims
 - Identification of groupings of subject matter
 - 2 months to respond without fees
 - Extendible by up to 4 additional months (6 months total)
 - Divisional(s) can be filed any time before issuance of patent
- Non-Final Office Action
 - 3 months to respond without fees
 - Response includes amendments and/or remarks
 - Can interview before response
 - Extendible by up to 3 additional months (6 months total)

Lifecycle of a U.S. Patent Application



- Final Office Action
 - Interviews normally allowed
 - Applicant has 3 months to respond without fees
 - Application will be abandoned with expiration of 6 months of Final Office Action unless:
 - Examiner issues new Office Action or Notice of Allowance
 - Applicant files Request for Continued Examination (RCE) or Notice of Appeal
- Amendment After Final
 - Take allowable subject matter
 - After Final Consideration Pilot 2.0 (AFCP 2.0) gives examiner additional time to review after final
 - Examiner may issue an Advisory Action, which does not reset the 6 month deadline
- Request for Continued Examination (RCE)
 - Provides Examiner with additional time to review and likely results in new non-final Office Action, restarting the process
- Appeals (average pendency 14 months)
 - Notice of Appeal due by 6 months from Final Office Action date
 - Pre-appeal conference can be requested if 5 page brief is filed with Notice of Appeal
 - Regular appeal brief must be filed within 2 months of Notice of Appeal, or within 1 month of pre-appeal decision, extendible by up to 5 additional months
 - Claim amendments are not typically allowed unless made by the Examiner
 - Examiner response
 - 2 months to submit rebuttal brief
 - Oral hearing

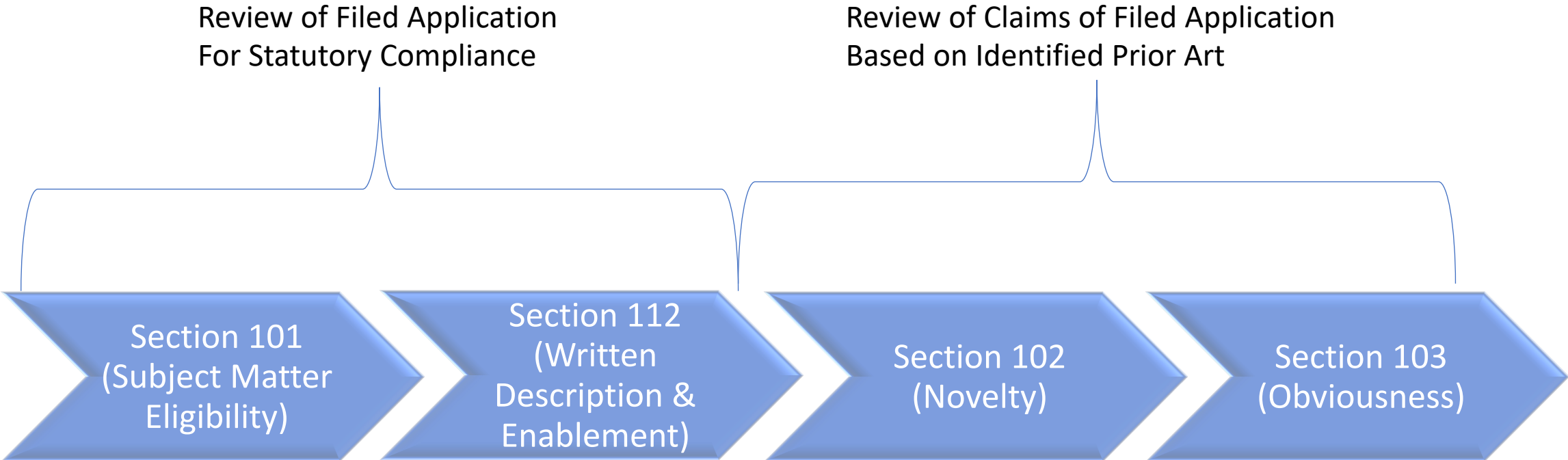
Lifecycle of a U.S. Patent Application



- Notice of Allowance
 - Issue fee due in 3 months
 - Decision whether to file continuation/divisional (due before issuance of patent)
- Issuance of Patent
 - Confirm patent term adjustment (PTA)
 - Patent proofreading
 - Certificate of Correction
- Broadening Reissue Deadline
 - 2 years after issuance
- Maintenance Fees
 - 3 ½ year – \$2,000 large entity (\$500 surcharge for late payment within 6 months)
 - 7 ½ year – \$3,760 large entity (\$500 surcharge for late payment within 6 months)
 - 11 ½ year – \$7,700 large entity (\$500 surcharge for late payment within 6 months)

Statutory Requirements

Statutory Requirements – Patentability of Inventions



Statutory Requirements – Patentability of Inventions



35 U.S. Code §101

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.

Statutory Requirements – Patentability of Inventions



35 U.S. Code §112

(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) 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.

Statutory Requirements – Patentability of Inventions



35 U.S. Code § 102

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise **available to the public** before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a **patent** issued under section 151, or in an **application for patent published** or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was **effectively filed before the effective filing date** of the claimed invention.

Statutory Requirements – Patentability of Inventions



35 U.S. Code § 102

(b) EXCEPTIONS.—(1) [CERTAIN] DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.

(2) [CERTAIN] DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.

Statutory Requirements – Patentability of Inventions



35 U.S. Code § 103

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, 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. Patentability shall not be negated by the manner in which the invention was made.

General Strategy Considerations

What Do Examiners Use?

- Statute (Title 35 of the United States Code, or 35 U.S.C.) – the Patent Laws
- Regulations (Title 37 of the United States Code of Federal Regulations, or 37 C.F.R.) – the Patent Rules
- Manual of Patent Examining Procedure – the MPEP
- Patent-Related Notices (e.g., announcing new programs)
- Examination Guidance and Training Materials (e.g., Section 101 examples)
- See <https://www.uspto.gov/patent/laws-regulations-policies-procedures-guidance-and-training>

Best Practices for U.S. Claims

- More than one independent claim of each claim type available
 - Pursue different claims types to match business goals
 - Methods, systems, and individual apparatus or replacement parts
- File continuations and/or divisionals
 - Inexpensive
 - No back annuity payments
- Basis for claim amendments generally not as strict as EPO
 - Can be based on the drawings alone
 - Standard is closer to what “a skilled person would derive directly and unambiguously, using common general knowledge” actually means
- Avoid divided infringement, especially for method claims

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