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INTELLECTUAL PROPERTY ALERT

AN INSIGHT INTO THE PATENT PROCESS

The process to obtain a utility patent begins with the filing of a patent application, a legal document that describes the invention for which patent protection is being sought. When the application is filed, government fees must be paid. It is worth noting that there are no guarantees of success in securing a patent from the United States Patent and Trademark Office ('USPTO'), regardless of the invention. This is because certain legal requirements must be satisfied before an application is allowed, and satisfying those legal requirements is often difficult.

From the date the application is filed, a first response from the USPTO generally can be expected to take between one and two years. The main reason for the delay is that the USPTO processes a large volume of applications every year. There are situations where the first response can result in a Notice of Allowance ('NOA'), a response from the USPTO in which a Patent Examiner has determined that the legal requirements for a patent have been satisfied. In this instance, payment of a government issue fee by the Applicant to the USPTO will result in the patent application issuing into an enforceable patent roughly one month later.

However, it is very common that the first response from the USPTO will be to reject the application. This type of a response is called a non-final Office Action. In the Office Action, the assigned Examiner explains why, for at least one legal reason, the application is not in condition for allowance. Once this non-final Office Action has been received, the process, and associated costs throughout prosecution, that cause the application to mature into an issued patent can vary significantly. For example, if the Examiner has only a minor technical challenge to the application, the Applicant can file a response, called an Amendment, to correct a portion of the application in order to address the challenge raised by the Examiner. If the Examiner determines that the challenge was properly addressed, a NOA could be promptly issued. As such, the time from receipt of the Office Action to the mailing of the NOA would be the sum of the time it took the Applicant to file the Amendment plus the time it took the Examiner to read the Amendment and issue the NOA. On average, Examiners take anywhere from a few days to a few months to respond to Amendments.

If, however, the Examiner raises more than a mere technical challenge, the time and associated costs for the application to mature into an issued patent will likely both increase. For example, one common challenge raised by Examiners pertains to the breadth of protection being sought. This type of challenge involves an assertion that the invention, as claimed in the application, is not new, or if it is new, it would have been obvious to have invented it based on the prior art (i.e., existing technology). The time and costs associated with prosecuting the application in this scenario to the point at which an Examiner issues a NOA can vary tremendously based on the content of the prior art and the position taken by both the Examiner and the Applicant.

If the prior art is strong such that the invention disclosed in the application is not significantly new, securing patent protection becomes more difficult. That is, even strong arguments and/or modifications to the scope of coverage being sought may not be enough to overcome a rejection based on the strong prior art cited by the Examiner. Examiners will frequently take the position that even though the invention, as claimed, is not entirely taught by any one prior art reference, when multiple prior art

references are viewed together, the invention as a whole would have been obvious to another skilled in the art of the invention, and therefore it does not satisfy the requirements of the law.

As mentioned above, the exchange of documents between the Examiner and Applicant generally involves at least the issuing of the non-final Office Action by the USPTO followed by the filing of an Amendment by the Applicant. If the Examiner determines that a NOA is still not proper, the Examiner will typically issue a final Office Action. In the final Office Action, the rejections may be maintained, or new rejections may be asserted. At this stage, certain government procedures, such as the After Final Consideration Pilot Program 2.0, the Pre-Appeal Brief Conference Program, and the new Post-Prosecution Pilot Program 3.0, are available to the Applicant to streamline the back and forth exchange of documents. Also at this stage, because the Examiner has rejected the claims in the application twice, the Applicant has the option to remove the case from prosecution before the Examiner and place it before the Patent Trial and Appeal Board ('PTAB'), an appellate board comprised of patent attorneys. Filing an appeal requires that government fees be paid by the Applicant, as well as an Appeal Brief filed by the Applicant and an Examiner Answer to the Brief. Additionally, a typical wait time involved for a decision to be reached by the PTAB is around two and a half years from the time the briefs are forwarded to the PTAB.

Finally, once a utility patent has issued, the government requires that maintenance fees be paid at periodic intervals throughout the duration of the enforceability period of the patent. Failure to pay these fees can result in the patent falling into the public domain. In other words, the patent could become unenforceable. However, assuming that maintenance fees are paid, the issued utility patent, for roughly a period of 20 years from the filing date, provides its owner with the power to exclude others from making, using, or selling the invention as claimed in the patent.

This Eckert Seamans Intellectual Property Alert was authored by John Powers The alert is intended to keep readers current on matters affecting intellectual property and is not intended to be legal advice. If you have any questions about its content, please contact John Powers at jpowers@eckertseamans.com or (412) 566-6174.