

## Overview of US Patent Prosecution

This briefing note explains a few important aspects of the US patent system and some of the steps involved in prosecuting a US patent application through to grant.

### Filing a US patent application

A US patent application may be filed either as a regular US patent application or by entering the US national phase of an International or “PCT” patent application within 30 months from the earliest priority date of the International patent application.

### Patentability

The US patent system is perhaps more generous than most other patent systems in that an invention is not required to have a technical character in order to be patentable. Therefore, some inventions which would not normally be patentable in other countries (such as a pure method of doing business) are potentially patentable in the US.

### Grace period

The US patent system has a 12 month “grace period” provision which enables an inventor to disclose an invention to the public and then to delay filing a US patent application by up to 12 months. In most other countries the act of publicly disclosing an invention prior to filing a patent application will invalidate any subsequently filed patent application in that country.

Therefore, if an inventor has disclosed an invention to the public (either deliberately or inadvertently) prior to filing a patent application, then normally it will still be possible to secure potentially valid patent protection in the US so long as the inventor files a US patent application within 12 months of the public disclosure.

### Requirement to inform the US Patent Office of relevant prior art documents

An applicant for a US patent is required to inform the US Patent Office of any potentially relevant prior art (i.e. prior published patent documents or journal articles) which the applicant is aware of whilst the US patent application is pending. Failure to meet this requirement could result in the patent being unenforceable.

### Examination of a pending US patent application

A first examination report or “Office Action” can normally be expected to be received within one to three years. An applicant normally then has three months to respond to the Office Action. Extensions of time of up to three months are available upon payment of a fee.

If an application includes claims to two or more different inventions then the examiner will normally require an applicant to make an election of just one of the inventions. Further inventions which are not elected can be filed in one or more divisional applications.

The first Office Action is normally indicated by the US Patent Office examiner as being “Non-Final” which means that an applicant is able to make fairly substantial amendments to the claims in response to any objections raised by the examiner in the Office Action. Once an applicant has filed a response to the Office Action, then the examiner may then either: (i) issue a notice of allowance; (ii) raise some new objections and issue a second Non-Final Office Action; or (iii) maintain at least some of the objections which were raised in the first Office Action in which case the Office Action is likely to be indicated as being a “Final” Office Action. An applicant is relatively restricted in the scope of amendment which they can make when filing a response to a Final Office Action.



If the examiner indicates in a Final Office Action that some claims are allowable but that other claims are rejected, then an applicant can respond by deleting those claims which are rejected. This will result in the issuance of a notice of allowance in respect of those claims which were deemed allowable by the examiner. An applicant can continue to argue for the allowance of those claims which have initially been rejected by re-filing those claims in one or more continuation applications.

If the examiner issues a Final Office Action and an applicant makes fairly substantial amendments in response thereto, then the examiner may refuse to consider the amendments on the grounds that the amendments raise new issues. In such circumstances an applicant may proceed further with the application by either: (i) filing a Request for Continued Examination (“RCE”); or (ii) filing a notice of appeal.

A RCE is a procedural mechanism which enables an applicant to have at least two further opportunities to amend the claims and/or to present arguments for the examiner’s consideration. Currently there is no limit to the number of times that an applicant can file a RCE although this may change in the future.

In some cases it may be worth considering arranging a personal interview with the examiner at the US Patent Office. An applicant can discuss a number of different potential claim amendments with the examiner with a view to agreeing a potentially allowable set of claims.

### Filing an Appeal

If an examiner continues to reject an application and an applicant feels that they have nothing further to add, then an applicant may consider filing a notice of appeal. At the same time as filing a notice of appeal, an applicant can also file a request for the case to be reviewed by a panel of examiners. Approximately half of cases which are reviewed by a panel of examiners result in a favourable decision e.g. either the examiner’s objections are overturned and the examination process is resumed or better still the application is allowed.

If the panel of examiners decides that the application should remain under appeal (or if the applicant did not request a review by a panel of examiners) then the next stage is to file a grounds of appeal which sets out the reasons why the applicant believes that the examiner is wrong to reject the application. The examiner is required to give a detailed response to the arguments set out in the grounds of appeal and this process can cause the examiner to change their mind and to allow the case after all. Otherwise, the appeal passes to the Board of Patent Appeals which has a track record of deciding in favour of the applicant approximately half of the time.

### Further advice

If you would like any further advice please contact us at Dehns using the details below.

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