

# **The Application's Been Filed. What's Going On In The Patent Office?**

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## **I. Prosecuting<sup>1</sup> the Patent Application in the Patent Office**

### **a. The Application Filing Date**

Once the application is filed, the U.S. Patent and Trademark Office (PTO) will determine if the fundamental requirements for obtaining an application filing date are met. When the PTO receives a patent application meeting the basic requisites, it stamps the application as received and gives the application a filing date. On the face of each US patent and patent application publication there is noted the filing date of the application.

In patent law, the date of filing an application is critical. Under current United States law, the person who first files an application to obtain a patent for an invention gets the patent in the United States. The application filing date with the PTO is also critical for establishing patent rights, particularly in the rest of the world, for those seeking foreign patent protection based upon the United States patent application.

The filing date is also very important for other reasons. First, from the standpoint of U.S.C. § 102(b), the availability of possibly invalidating prior art will be calculated from that date. Second, the filing date will trigger other patent related rights and obligations. For example, once the application has been filed, the applicant can mark goods with a "patent pending" notation. Similarly, the filing date will trigger the running of deadlines for filing foreign applications that claim the benefit the application's filing date.

### **b. Examination of the Patent Application**

If the application is in order, the application will be assigned to a technology group and an examiner. The examiner will then place the application in line for examination. Because of the workload of patent examiners, this examination will likely not take place for at least 18 months for mechanical and electronic inventions, and several years for software-enabled or business method inventions. In examining the application, the examiner searches databases and evaluates whether the patent claims new and patentable subject matter. In performing this analysis, the examiner will review the language of each claim in the application against the prior art. If the examiner finds that what is claimed as an invention in a claim is either entirely

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<sup>1</sup> The procedure for pursuing a patent application in the patent office is called "prosecution."

disclosed in one reference or made obvious by a reference or combination of references, the examiner will issue a rejection of the claim. Conversely, if the examiner does not find such disclosure or determine the claimed invention is obvious, the examiner will allow the claim. The examiner will perform this analysis for each claim of the patent application. In the vast majority of all patent applications, the examiner issues rejections, rejecting all of the claims of the application. The result of the PTO examination is called an Office Action. The PTO usually issues a first Office Action 18-24 months after filing the patent application.

**c. Responding to the First Office Action**

Once the PTO issues a first Office Action the client and the patent attorney will work together to draft arguments or perhaps claim amendments to overcome the examiner's rejections. Once these arguments are prepared, the patent attorney will file them with the PTO.

**d. Publication of the Application**

All utility patent applications are now published 18 months from the earliest effective filing date of application. The only exception to this rule is for applications in which the applicant states that it will not pursue foreign patent rights to the invention.

**e. Final Office Action**

After the applicant's response to an office action, the examiner may stand on his or her rejections or allow some or all of the claims. If the examiner upholds the rejection of one or more claims, he or she will issue a "final rejection" of the application. If the examiner allows all of the claims, he or she will issue a notice of allowance. If the examiner stands on the rejections, he or she will issue a Final Office Action. If a Final Office Action is issued, this does not mean that an allowance will not be granted. However, it does mean that the applicant will likely have to amend the sought-after claims in order to get around prior art cited by the examiner. Alternatively, the applicant may choose to cancel the claims and try to pursue them in a continuation application.

**f. Options in the Event of Final Rejection**

The applicant has four choices in the event she receives a Final Rejection: (1) abandon the application altogether, (2) take any allowed claims and cancel the rejected claims, (3) file a continuation application, or (4) file an appeal with the Board of Patent Appeals and Interferences (the BPAI). In practice, if the patent attorney prosecuting the application feels there is a chance of the examiner allowing some of the claims, she will often request an interview with the

examiner and may continue a dialogue with the examiner for purposes of making acceptable amendments to the claims. There is, however, no absolute right to make amendments after receiving a Final Rejection.

**g. Issuance of Patent**

If the examiner issues a notice of allowance, the applicant will have to pay an issue fee in order for the PTO to issue the patent. Until the issue fee is paid and the patent is later issued, the application is considered "alive" for purposes of pursuing continuation applications.

## **II. Continuation Applications**

A continuation application is a subsequent application for the same invention claimed in a prior nonprovisional patent application and filed before the prior application becomes abandoned or patented. Sometimes, an applicant will file many continuation applications that link back to an original application. The continuation application receives the benefit of the filing date of the earlier filed application. A continuation application allows an applicant, in the case of a final rejection, to continue fighting for previously rejected claims in the patent office. It also allows an applicant who has already received a notice of allowance to continue prosecuting for different claims covering the invention and thus change the scope of patent coverage.

Sometimes, after a patent application for a particular invention is filed (but before it has been abandoned or a patent is issued), the inventor will discover improvements that can be made to the invention that are not discussed in the original application. In this case, an inventor may choose to file what is called a "continuation-in-part application." According to the PTO, a continuation-in-part application repeats a substantial portion or all of the earlier non-provisional application but adds matter not contained in the original application. The repeated matter is entitled to the original application's filing date. The new matter is entitled to the actual filing date of the continuation-in-part application. If a patent issues from a continuation-in-part application its term is measured from the filing date of the original application.

A divisional application is a special type of continuation application. A divisional application arises when the examiner in the original patent application issues what is known as a "restriction requirement." When an examiner issues a restriction requirement, he is ruling that there is more than one patentably distinct invention claimed in the application. Because the PTO

wants a filing fee for each patentably distinct invention applied-for, it will require the applicant to elect the claims to one invention to pursue in the present application and withdraw (divide out) the non-elected claims from consideration. The divided out claims may be pursued in a divisional application.

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