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Communicating with the U.S. Patent and Trademark Office During Patent Examination

by Ariel Rogson, Marger Johnson & McCollom



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In the [previous article](#) in this series, we discussed the process for preparing and submitting a patent application to the U.S. Patent and Trademark Office (USPTO). In this installment, we cover what happens next – the various communications you may have with the USPTO. Every application is handled individually, so your experience will be different almost every time. Because any additional information and responses the USPTO asks of you are required on a fairly short timeline, it is helpful to anticipate some of the steps you may encounter.

Examination

- The USPTO examiner to whom your application is assigned will review your application, search for applicable prior art, and make an assessment regarding the “allowability” of the claims in your application.
- The USPTO currently strives to respond to your application within about 14 months, but does not offer any guarantees.
- The first communication from the USPTO typically takes one of two forms. Your examiner can:
 1. “reject” your application, in what is termed an “office action,” or
 2. issue a “notice of allowance,” meaning that your invention is patentable.

We discuss office actions in this article and the notice of allowance in the next article.

Rejection

- In an office action rejecting an application, the examiner outlines why your application has been rejected and on what grounds. The most common reasons for rejection are:
 - The claims are considered “anticipated,” meaning that a single piece of prior art (e.g., patent, book, article, etc.) already teaches all elements of the claims.
 - The claims in your application are obvious because of one or more prior art references.
 - The claims cover multiple inventions. This type of office action is called a “restriction requirement” and requests that you limit your application to only one invention.

- The claims do not adequately define the invention, or are confusing or inaccurate.
- The claims are not supported by the specification.
- The examiner can mix any combination of these reasons in rejecting the claims, and can apply different reasons to different claims (although, generally, restriction requirements are sent before other reasons for rejection are considered).

Responding to rejection

- You are expected to respond to an office action within three months of its mailing date. You can extend this deadline by up to three more months, but there are associated fees.
- There are two general courses you can take. One is to change your claims in a way that you think will make the claims allowable. Another is to explain to the examiner why you think his/her interpretation of the prior art and/or the claims is incorrect. More specifically, you might take the following actions:
 - If you think the examiner's argument is incorrect or shows a misunderstanding, explain why.
 - If the claims appear to be anticipated or obvious, change the claims so that they are distinguishable over the references.
 - If the claims are considered to cover multiple inventions and a restriction requirement is issued, choose which invention you want to pursue and cancel the others. You can pursue the claims defining other inventions in separate applications called "divisional applications." We will talk more about divisional applications in the next article.
 - If the examiner rejects claims as obvious over a combination of multiple prior art references, you might be able to convince the examiner that the examiner's combination does not make sense.
- Both of these courses can be taken at the same time. That is, you can explain why you think the examiner's reasoning is incorrect, and also amend the claims to help clarify how they differ from the prior art. You can also add new claims to the application, provided they are supported by the original specification. But this may require payment of additional fees.
- To determine the best course of action and form your response, the prior art references need to be reviewed so you know what you are up against. Sometimes it is also helpful to talk with the examiner. Your attorney will know how to handle this.

"Final" rejection

If you receive a "final" rejection, it is the last communication you can have with the USPTO based on the original application fee paid. Responses to final office actions can be submitted, but are not always considered by the examiner. Starting with the second office action, the examiner can call an office action final based on certain conditions. If you want to continue the response and examination process, you can file a "request for continued examination" and pay additional fees.

Appeal

Sometimes, despite your best efforts, you cannot convince the examiner that your invention should be patentable. The examiner just refuses to concede the validity of

your arguments. You can abandon the application, or you can appeal to the Board of Patent Appeals and Interferences. The board takes an independent look at the claims and the rejection to decide if the examiner was right or not. If the board supports the examiner, you can appeal that decision to the federal courts. Appeals are complicated, involving careful writing of briefs and replies, and there are limits on the arguments that can be made in an appeal, so consult your attorney.

Assuming the examiner can be convinced of the patentability of the invention, the next step is moving the patent from allowance to issue. In the next article, we will discuss this process. We will also cover strategies to maximize your innovations by further mining your claims and disclosure for more patentable inventions.

About the author

Ariel Rogson is an attorney at Marger Johnson & McCollom, PC, a full-service intellectual property law firm headquartered in Portland. A former software developer, he continues to serve clients in software and high-tech industries. He can be reached at 503-222-3613 or ariel.rogson@techlaw.com.

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