

# Prosecuting a Utility Patent Application<sup>1</sup>

by David E. Rogers

## I. Introduction.

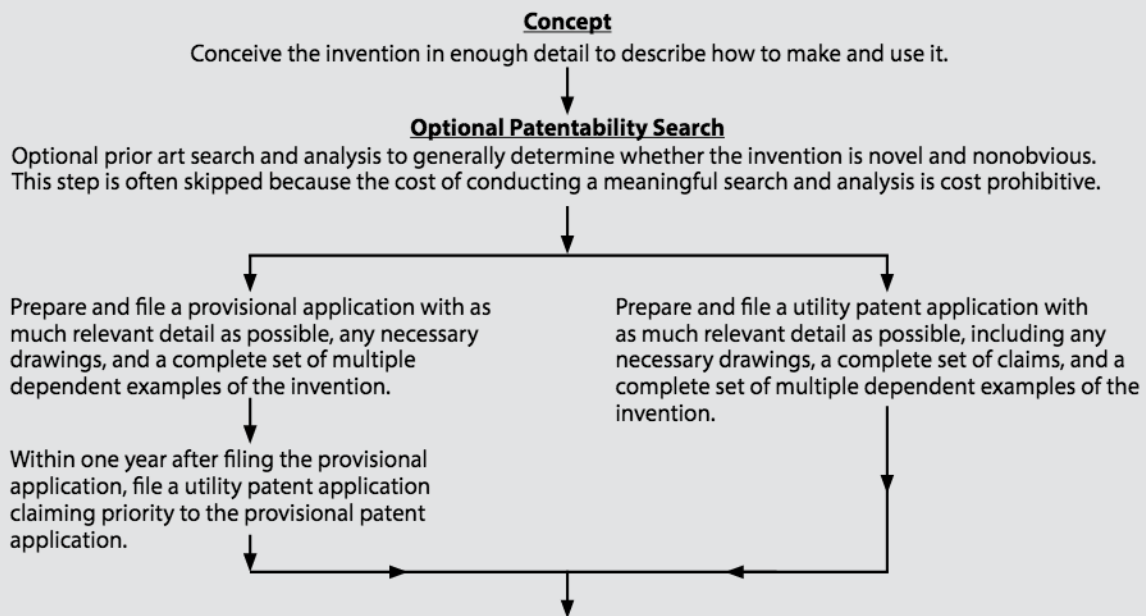
“Prosecution” of a utility patent application is the process by which an application advances through the United States Patent and Trademark Office (“USPTO”) after being filed. Prosecution is often a more lengthy and costly endeavor than preparing and filing the application. It culminates when an application either matures into a patent or is abandoned.

During prosecution an application is reviewed by a USPTO Examiner. The Examiner is a government employee with a technical background pertinent to the invention. The Examiner issues written communications, called Office Actions, to the applicant or the applicant’s attorney. An Office Action usually includes, among other things, citations of prior art patents and patent applications and arguments as to why the claimed invention is not patentable. Most patent applications are rejected in their entirety in the first Office Action, and often on multiple grounds.

After receiving an Office Action the applicant or the applicant’s attorney file a “Response.” The average number of Office Actions and Responses during prosecution of a patent application is about four. But, do not be surprised if there are five or more, or an appeal or one or more continuation/divisional applications is required, to obtain the full inventive scope to which an application is entitled.

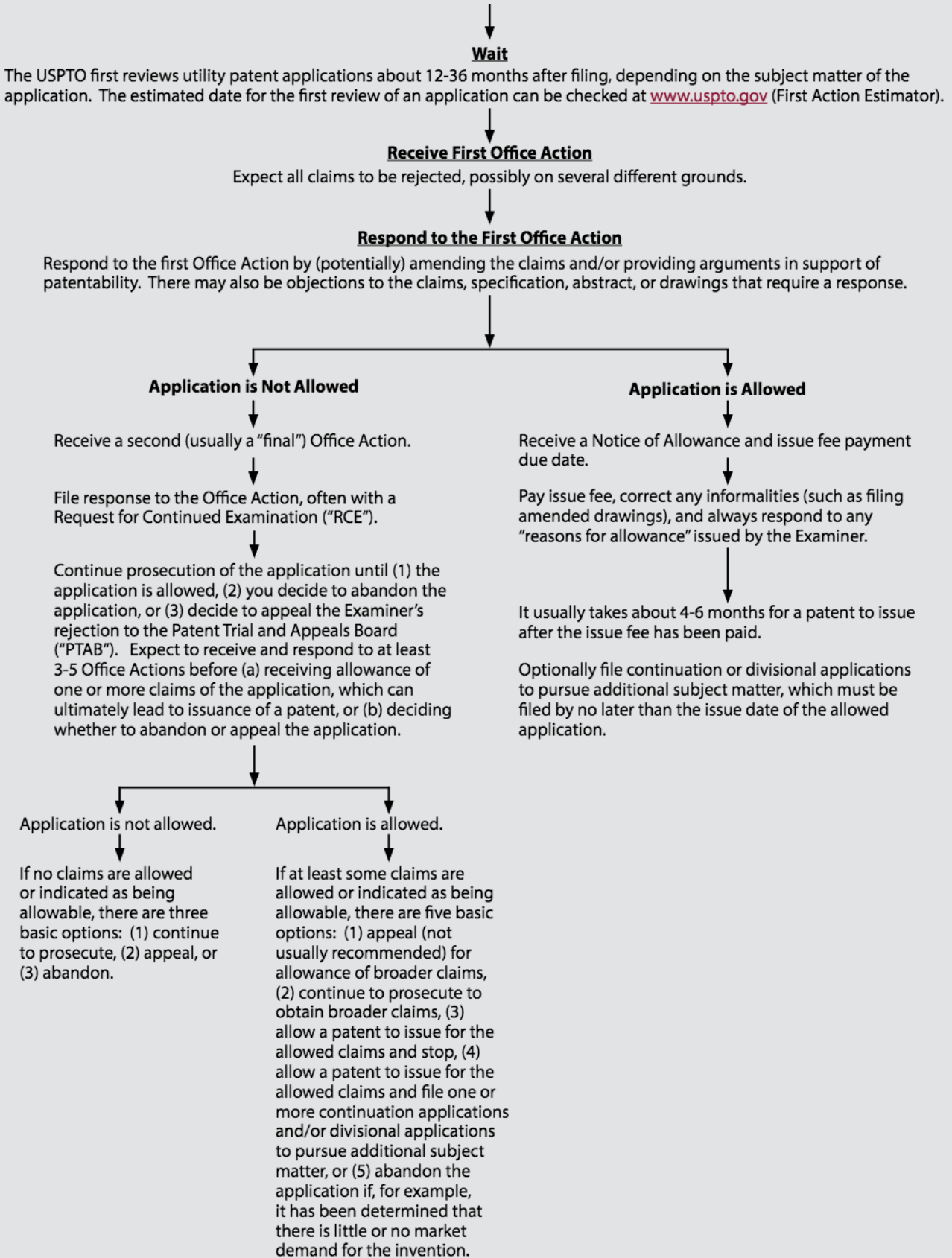
## II. The Basic United States Utility Patent Application Process.

Following is a summary of the process for a typical utility patent in the United States<sup>2</sup> :



1 This article is for educational purposes and does not constitute legal advice. It represents current, general opinions of the author, and not of his law firm or colleagues.

2 Not shown here are the processes for filing a U.S. utility application claiming priority to a PCT application or foreign application.



### III. Basic Prosecution Strategy.

#### A Creating Broad Patent Scope Is Key.

Prosecution takes as much thought, diligence, and care as preparing the patent application. If not done properly, the broad scope you envisioned and incorporated into the patent application could be forfeited. Careless prosecution, or capitulation to an Examiner to merely obtain a patent, may spell disaster. During prosecution, do not limit claim scope to only the exact embodiment you plan to manufacture because a competitor may be able to tweak the design and circumvent the claims.

Sometimes obtaining broad scope is best done in steps, by taking allowable subject matter, obtaining a patent for it, and then filing one or more continuation applications and/or divisional applications to pursue additional subject matter.

#### B Prosecution Is Not a “Negotiation.”

Prosecution is not, as some patent practitioners believe, a “negotiation” with an Examiner. Be professional, but fight to obtain all of the permissible, valuable claim scope to which your application is entitled. Do not unnecessarily narrow claims and leave valuable subject matter behind for competitors to practice.

#### C Be Organized and Thorough.

All responses to an Office Action should be carefully prepared, well organized with headings and sub-headings, simple to understand, and begin to place the application in condition for appeal, if appeal should become necessary. Some practice tips:

- Address each limitation not found in the cited prior art.
- Do not characterize prior art more than is required to distinguish it from the pending claims.
- Argue patentability on a claim-by-claim basis if one or more dependent claims include non-obvious limitations that are not in an independent claim.
- For obviousness rejections, do not automatically concede that the Examiner’s proposed combination is proper. Explain why there is no motivation to combine disparate prior art references. Look for teaching-away positions in the prior art.
- Be certain that the literal scope of the pending claims is commensurate with the arguments presented for patentability.
- If relevant, use annotated drawing figures to plainly distinguish the structures of an embodiment of the invention from the cited prior art.
- Enter any necessary declarations under 35 CFR § 1.132 to submit evidence in favor of patentability. The evidence in a declaration should distinguish the invention as recited in the claims from the prior art cited by the Examiner. If the Examiner has established a prima facie case of obviousness, the burden falls on the applicant to explain why the claimed invention is not obvious. Attorney argument is not evidence.

#### D Examiner Interviews

A conference between an applicant (or the applicant’s attorney) and Examiner can sometimes advance the prosecution of a patent application by improving the understanding of specific issues. It is desirable that the attorney or applicant state in advance of the interview what issues will be discussed by submitting a written, proposed amendment and/or proposed topics of discussion. The interview may be in person or telephonic.

#### IV. Conclusion.

Patent prosecution can be a lengthy and costly endeavor that should be undertaken with the goal of obtaining broad patent scope.



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Dave Rogers is a registered patent attorney with over 20 years of experience. He practices patent, trademark, trade secret and unfair competition law, including: litigation and arbitration; trademark oppositions, cancellations and domain name disputes; preparing manufacturing and technology contracts; and patent and trademark preparation and prosecution.