

PATENT PROSECUTION: WHAT TO EXPECT

The Patent Application

A patent application includes the following main parts:

Background: The background provides a general description of the current state of the art in the field to which the invention pertains.

Summary: The summary provides a brief description of the features and advantages of the invention.

Detailed description: The detailed description provides a full and complete disclosure of the invention. The patent law requires that this description of the invention be detailed enough to enable one of ordinary skill in the art to which the invention pertains to make and use the invention. Moreover, this description of the invention must disclose what the inventors subjectively believe to be the best mode of practicing the invention at the time the patent application is filed. Typically, the patent application includes one or more drawings that illustrate the invention.

One or more claims: Each claim is a precisely worded sentence that verbally defines the extent of the rights granted by the patent. In other words, it is the claims of the patent (not the detailed description or the drawings) that ultimately determine whether an accused device or method infringes any patent issuing from the patent application or whether a prior patent, publication, or activity (referred to as “prior art”) renders the claims invalid. There are two general types of claims: dependent claims (which refer to and incorporate all the features recited in one or more other claims) and independent claims (which do not refer to or incorporate features recited in other claims).

The U.S. Patent Application Process

The first step in the patent application process is the preparation of a patent application. Depending on the nature of the invention, preparation of a patent application typically takes around 3-6 months and typically costs from \$8,000 – \$12,000. The process can be expedited when necessary.

After the patent application is completed, we file it with the United States Patent and Trademark Office (USPTO). The applicant must pay a basic filing fee to the USPTO. The basic filing fee is currently \$760 for a large entity (roughly speaking, a company with more than 500 employees) and \$380 for a small entity (a company with 500 or less employees). In addition, the applicant must pay an additional \$78 fee (\$39 for small entities) for each independent claim in excess of three and a fee of \$18 (\$9 for small entities) for each claim (including both independent and dependent claims) in excess of twenty.

In addition to the application and filing fee, each inventor must sign a declaration stating that each inventor:

- believes that he or she is the original, first, and sole (if there is only one inventor) or joint inventor (if there is more than one inventor) of the claimed invention;
- has reviewed and understands the patent application; and
- acknowledges his or her duty to disclose to the USPTO information that is material to the patentability of one or more claims of the patent application.

If the patent examiner determines that the patent application contains claims that are directed to more than one invention and that the different claimed inventions should not be examined together in a single patent application, the patent examiner may require the applicant to elect one of the claimed inventions for prosecution in the current patent application. The applicant can file separate patent applications (referred to as “divisional” applications) to prosecute the other non-elected inventions; divisional applications are entitled to the benefit of the filing date of the original patent application, as long as certain requirements are met. The cost of preparing and filing a response to an election requirement is typically around \$500-\$1000, and a separate filing fee must be paid for each divisional application that is filed.

Around six months to a year after the patent application has been filed, the patent examiner will review the merits of the patent application and send out an “office action.” Almost always, the patent examiner rejects one or more of the claims for various reasons. We can respond to the office action by preparing and filing a response arguing against the positions taken by the examiner and/or amending the claims to avoid any cited prior art. There can be additional rounds of this kind of give and take between the examiner and the applicant. The cost of preparing and filing a response to an office action typically is in the range of \$2000-\$4000 but varies widely depending on the position taken by the examiner in the office action.

If and when the examiner determines that the patent application is allowable (i.e., that the pending claims are patentable), the applicant must prepare and file formal drawings (which typically cost \$250-\$500) and pay an issue fee (which is \$1210 for large entities and \$605 for small entities). A few months after submitting formal drawings and paying the issue fee, the USPTO will issue a patent. After the patent issues, the patent owner has the right to exclude others from making, selling, offering to sell, and importing in the United States the invention as set forth in the claims of the patent. These exclusive rights exist for 20 years from the filing date of the patent application. However, in order to keep the patent in force, the patent owner must pay maintenance fees of that are due 3.5 years, 7.5 years, and 11.5 years, respectively, after the patent issues. USPTO fees change from time-to-time.