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INTELLECTUAL PROPERTY ATTORNEYS

# Patent Process FAQs

# *The Patent Process*

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The patent process can be challenging for those who are not familiar with it.

This booklet provides useful basic information and answers to frequently asked questions regarding the patent process and can serve as a good foundation for further discussions with an intellectual property attorney.

The following materials are adapted from the United States Patent and Trademark Office and provide a general guide to the patent process. This booklet is not intended to provide legal advice. Patent laws and regulations are complex and subject to change. Please consult an intellectual property attorney for counsel regarding your specific intellectual property matters.

# Frequently Asked Questions About The Patent Process

## 1 What is a patent?

A patent is a property right granted by the Government of the United States of America to an inventor “to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States” for a limited time in exchange for public disclosure of the invention when the patent is granted.

## 2 Who can apply for a patent?

A patent may be applied for in the name(s) of the actual inventor(s) or the assignee(s) of the invention

## 3 What cannot be patented?

- Laws of nature
- Physical phenomena
- Abstract ideas
- Literary, dramatic, musical, and artistic works (these can be Copyright protected)
- Inventions which are:
  - o Not useful (such as perpetual motion machines); or
  - o Offensive to public morality

## 4 What can be patented?

- Utility patents are provided for a new, nonobvious, and useful:
  - Process
  - Machine
  - Article of manufacture
  - Composition of matter
  - Improvement of any of the above
- Design patents may be granted for an ornamental design of an article of manufacture.
- Plant patents may be granted for asexually reproduced plant varieties.

### Invention must also be:

- Novel (35 U.S.C. §102)
  - A patent cannot be obtained if the invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public anywhere in the world before the date that the applicant filed the application for his/her invention
  - A patent cannot be obtained if the invention was described in a printed publication anywhere, or has been in public use or on sale in the US **more than 1 year** before the date on which an application for patent is filed in the US. It is immaterial whether the printed publication or public use was by the inventor himself/herself or by someone else.
- Nonobvious (35 U.S.C. §103)
  - Even if the subject matter sought to be patented is not exactly shown by the prior art and includes one or more differences over the most nearly similar subject matter already known, a patent may still be refused if the differences would be obvious. The subject matter sought to be patented must be sufficiently different from what has been used or described before such that it may be said to be nonobvious to a person having ordinary skill in the technological area of the invention. For example, the substitution of one color for another or changes in size are ordinarily not patentable.
- Adequately described or enabled (35 U.S.C. §112)
  - The specification must include a written description of the invention including the manner and process of making and using it. The specification must be written in such full, clear, concise, and exact terms as to enable any person skilled in the technological area to which the invention pertains, or with which it is most nearly connected, to make and use the same.
  - The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter, or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor for carrying out the invention must be set forth as well.
- Claimed in clear and definite terms
  - The specification must conclude with a claim or claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention. The portion of the application in which the applicant sets forth the claim or claims is an important part of the application, as it is the claims that define the scope of the protection afforded by the patent.

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## How do I know if my invention is patentable?

1. Look to see whether your invention qualifies as patentable subject matter based on the above description of what can be patented.
2. Learn the basics of the patenting process from the materials provided by the USPTO's Inventor Assistance Center at 800-PTO-9199.
3. A search of all previous public disclosures (prior art) including, but not limited to, previously patented inventions in the U.S. should be conducted to determine if your invention has been publicly disclosed and thus is not patentable. A search of foreign patents and printed publications should also be conducted. A prior art search is not required to file a patent application, but it is advisable to conduct one. A registered attorney or agent is often a useful resource for performance of a patentability search. After an application is filed, the USPTO will conduct a search as part of the official examination process. Conducting a thorough patent search is difficult, particularly for a beginner. Patent searching is a learned skill. The best advice is to contact the nearest Patent and Trademark Resource Center (PTRC) and seek out search experts to help in setting up a search strategy. If you are in the Washington, D.C. area, the USPTO provides public access to collections of patents, trademarks, and other documents at its Search Facilities located in Alexandria, Virginia. These facilities are open weekdays (except federal holidays) from 8:00 a.m. to 8:00 p.m.

**Disclaimer** You should not assume that your invention has not been patented even if you find no evidence of it being publicly disclosed. It's important to remember that a thorough examination at the USPTO may uncover U.S. and foreign patents as well as non-patent literature.

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## How long will it take to get a patent?

Due to the current backlog of patent applications at the Patent Office, you should not expect the Patent Office to quickly act on your patent application. In fact, you most likely will not hear anything from the Patent Office for at least one year following your patent application. As of November 2020, the Patent Office waited, on average, 14.9 months to issue a first Office Action after the application was filed. The average total pendency of an application that same quarter was 23 months.

Those pendency numbers are an improvement from the second quarter of the fiscal year 2009, during which the Patent Office waited, on average, 26.9 months to issue a first Office Action and the traditional total pendency of an application was 33.7 months.

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## How long does patent protection last?

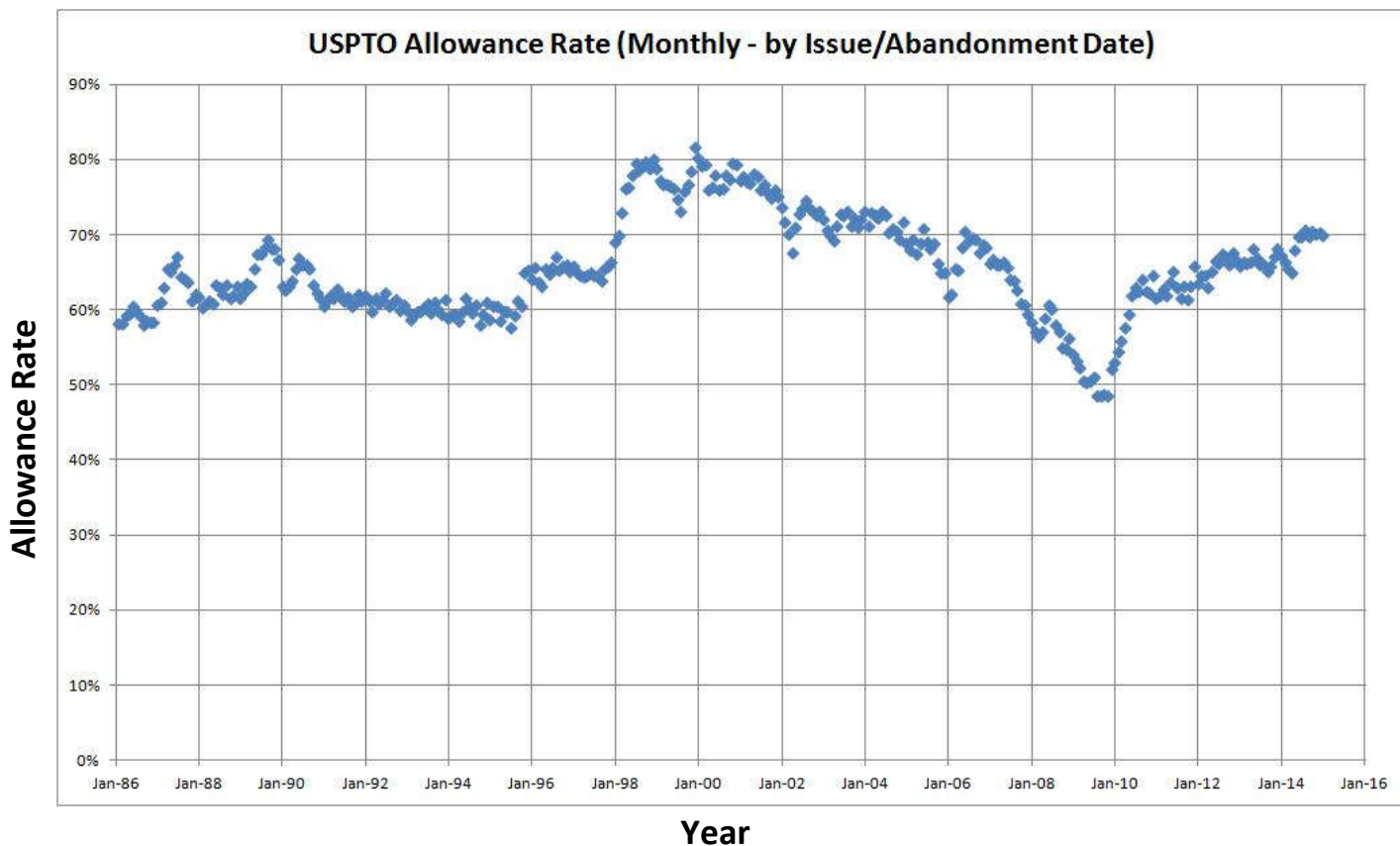
For applications filed on or after June 8, 1995, **utility** and **plant** patents are granted for a term which begins with the date of the **grant** and usually ends 20 years from the date you first applied for the patent, subject to the payment of appropriate maintenance fees. **Design** patents last 15 years from the date you are granted the patent. No maintenance fees are required for design or plant patents.

*Note:* Patents in force on June 8, 1995 and patents issued thereafter on applications filed prior to June 8, 1995 automatically have a term that is the greater of the twenty year term discussed above or seventeen years from the patent grant.

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## Am I guaranteed an issued patent if I file an application?

The filing of a patent application does not guarantee an issued patent. Between 2011 and 2015, the USPTO Allowance rate was approximately 65-70%.



## ***Examination Of Applications In The USPTO***

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Applications, other than provisional applications, filed in the USPTO and accepted as complete applications are assigned for examination to the respective examining technology centers (TC) having charge of the technological areas related to the invention. In the examining TC, applications are taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed or in accordance with examining procedures established by the Director.

Applications will not be advanced out of turn for examination or for further action except as provided by the rules, upon order of the Director to expedite the business of the Office, or upon a showing which, in the opinion of the Director, will justify advancing them.

The examination of the application consists of a study of the application for compliance with the legal requirements and a search through U.S. patents, publications of patent applications, foreign patent documents, and available literature, to see if the claimed invention is new, useful, and nonobvious and if the application meets the requirements of the patent statute and rules of practice. If the examiner's decision on patentability is favorable, a patent is granted.

### **1 What is an Office Action?**

After an examiner reviews a patent application, the applicant is notified in writing of the examiner's decision by an Office "action" which is normally mailed to the attorney or agent of record. The reasons for any adverse action or any objection or requirement are stated in the Office Action and such information or references are given as may be useful in aiding the applicant to judge the propriety of continuing the prosecution of his/her application.

If the claimed invention is not directed to patentable subject matter, the claims will be rejected. If the examiner finds that the claimed invention lacks novelty or differs only in an obvious manner from what is found in the prior art, the claims may also be rejected. It is not uncommon for some or all of the claims to be rejected on the first Office Action by the examiner; relatively few applications are allowed as filed.



## 2 What is an Applicant's Reply?

The applicant must request reconsideration in writing and must distinctly and specifically point out the supposed errors in the examiner's Office Action. The applicant must reply to every ground of objection and rejection in the prior Office Action. The applicant's reply must appear throughout to be a bona fide attempt to advance the case to final action or allowance. The mere allegation that the examiner has erred will not be received as a proper reason for such reconsideration.

In amending an application in reply to a rejection, the applicant must clearly point out why he/she thinks the amended claims are patentable in view of the state of the art disclosed by the prior references cited or the objections made. He/she must also show how the claims as amended avoid such references or objections. After reply by the applicant, the application will be reconsidered, and the applicant will be notified as to the status of the claims: whether the claims are rejected, objected to, or allowed, in the same manner as after the first examination. The second Office Action usually will be made final.

## 3 What is a Restriction?

If two or more independent and distinct inventions are claimed in a single application, the examiner may require the applicant to elect one of the inventions for examination. This is called a restriction. The other invention is withdrawn from consideration.

A) If the restriction was between claims drawn to a product and a process claims (process of making/process of use) and you elected to have the product claims examined then you may be entitled to have the process claims rejoined with the product claims when the product claims are allowable. The process claims must include all the limitations of the patentable product and those claims must be in the application prior to a final rejection or allowance, whichever is earlier.

B) Another option is to file a divisional application (second application) claiming benefit to the first application while your first application is still pending. This application would be an exact copy of the first application including the specification, oath, etc.

## **4** What is an Appeal?

If the examiner persists in the rejection of any of the claims in an application, or if the rejection has been made final, the applicant may appeal to the Patent Trial and Appeal Board (PTAB), an administrative agency that is part of the USPTO. An appeal fee is required and the applicant must file a brief to support his/her position. An oral hearing will be held if requested upon payment of the specified fee.

If the decision of the PTAB is still adverse to the applicant, an appeal may be taken to the Court of Appeals for the Federal Circuit or a civil action may be filed against the Director in the United States District Court for the District of Columbia. The Court of Appeals for the Federal Circuit will review the record made in the Office and may affirm or reverse the Office's action. In a civil action, the applicant may present testimony in the court, and the court will make a decision.

## **5** What is an RCE?

As an alternative to appeal, in situations where an applicant desires consideration of different claims or further evidence, a request for continued examination (RCE) is often filed without requiring the applicant to file a continuing application. An RCE is used to obtain continued examination of an application by filing a submission and paying a specified fee, even if the application is under a final rejection, appeal, or a notice of allowance. An RCE is not available in an application for a design patent, but a continuation of a design application may be filed as a Continued Prosecution Application (CPA).