

Preparing A Patent Application

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Is The Invention Patentable?

- Must meet the legal criteria of
 - Statutory Class
 - Utility
 - Novelty
 - Nonobviousness

Statutory Class – 35 USC § 101

- Any new and useful
- Process
- Machine
- Manufacture or
- Composition of matter.

Utility

- The invention must be USEFUL, must have a utilitarian function, cannot be just ornamental
- Utility is often self-evident from drawings or from a description
- Utility is not self-evident for chemical and biotechnology inventions; you must show data

Novelty – 35 USC § 102

- The invention must be NEW
- Novelty is determined through a search of the Prior Art (usually a patent search)
- A determination of novelty is a requirement to be met before preparing a patent application

Nonobvious – 35 USC § 103

- Even though novel, the invention could not have been obvious to a person having ordinary skill in the art, at the time it was made.
- What does this mean?

Nonobviousness – slide 2

- Obviousness relates to degree of novelty
- Obviousness allows PTO to deny a patent for an invention wherein the novelty is due to such a small change so as to be obvious
- Obviousness, unlike novelty, is usually not a threshold requirement for filing an application
- Always argue the invention is nonobvious

Draft the Patent Claims First

- The Claims must define an invention which is novel over the prior art
- Independent Claims stand on their own
- Dependent Claims refer to another claim and add further features
- See Example Patent Provided

Specification – 35 USC § 112

- Written description must fully support the claims
- Written description must be enable a skilled person to make and use the invention
- Prepare drawings to illustrate all features recited in the claims
- Prepare background of the invention
- Prepare abstract

File the Application

- Electronic filing – instant filing date
- US Express Mail – instant filing date
- First Class US Mail – delayed filing date
- Courier delivery – delayed filing date

Filing Requirements

- At minimum a written specification, one claim, and a drawing if required
- Inventor's declaration
- Power of Attorney
- Filing fee
- Non-publication request must be included
- Self-addressed stamped postcard (optional)

Patent Prosecution

- All activity following the filing of the patent application, through issuance of the patent.

Filing Receipt

- Unofficial receipt: your self-addressed, stamped postcard returns in 2-4 weeks.
- Official receipt: about 2 months after filing

Required to Obtain Filing Date

- Written specification containing an enabling description
- At least one claim
- A drawing if required for understanding the invention

Application Is Missing Parts

- One or more filing requirement(s) were not included in the application.
- Notice To File Missing Parts
- Applicant must usually respond within one to three months.

What Could Be Missing?

- Inventor's oath or declaration
- Application fee
- Power of Attorney

Information Disclosure Statement

- Duty of Candor before the PTO
- Must disclose information that may be material to patentability
- IDS filed before examination
- Include copy of each reference discovered in search

Assignment of Rights

- In U.S. only inventor may apply
- Inventor may not be rightful owner
- Employee assigns rights to employer
- Assignment can be filed at any time

Restriction Requirement

- First substantive review by Examiner
- Claims define more than one invention
- Applicant must elect one invention for prosecution in the application
- Non-elected claims may be prosecuted in additional application(s) filed later
- Applicant given 1 month to reply

First Office Action

- At about 14 to 18 months from filing
- Substantive review on the merits
- Typically rejects the claims
- Applicant must respond within 3 months
- Up to 3 months additional extension of time, for a fee

Publication of Application

- At 18 months from priority filing date
- U.S. only application must request non-publication at time of filing
- Non-pub request may be rescinded
- Published applications are prior art

Typical Claim Rejections

- Non-Statutory Matter (§ 101)
- Anticipation or Lack of Novelty (§ 102)
- Obviousness (§ 103)
- Indefiniteness, Lack of Clarity, Lack of Support in Specification (§ 112)

Second Office Action

- Typically a Final Office Action
- Within about 3 months of response
- Allowance: issue fee; correct drawings
- Partial allowance: cancel rejected claims, and take what you can get
- Full rejection: abandon, or pay fee to continue to prosecute

Issuance of Patent

- Congratulations!
- Always on Tuesdays
- Original Letters Patent with ribbon/seal
- About 2 to 3 years from filing

FINALLY

WHAT DOES IT ALL
MEAN?

The Meaning of Life – one view

“ . . . everything can be taken from a man but one thing: the last of the human freedoms – to choose one’s attitude in any given set of circumstances, to choose one’s own way.”

**Viktor E. Frankl, MD
Concentration Camp Survivor**