

An Overview of Patent Prosecution

by Fred Dingley

Whether it is talk about the new America Invents Act or patent wars between smartphone manufacturers, patents have been appearing in the news quite frequently lately. While most people understand the basic idea of a patent and what it does, the process of obtaining a patent remains shrouded in mystery to many, containing terms of art specific to the field, not to mention terms that take on a special meanings in patent law other than what may normally come to mind.

The process of obtaining a patent is called *prosecution*—not to be confused with criminal prosecutions. Patents come in different types: utility, design, and plant; but the most common is the *utility patent*, which covers items designed to produce a useful invention. This article presents a simplified summary of the prosecution process for a utility patent.

Overview of Patent Prosecution

Patent prosecution begins with filing an application with the U.S. Patent and Trademark Office (USPTO). Traditionally, the United States awards patent protection to the person deemed the first to invent. The recently-passed America Invents Act, however, changed that; as of March 16, 2013, the priority for an invention will go to the party deemed “first to file.”¹

At the USPTO, an examiner evaluates the application. The examiner’s job is to check the application and ensure it adequately discloses what the invention is, how it is made, and how it is used. The examiner will also weigh the claims in the application.² In patent law, *claim* takes on a very specific meaning—it defines exactly what the applicant is seeking patent protection for, the thing the applicant wants no one else to be able to make without the applicant’s permission. Claims must also belong to one of the acceptable categories of patentable subject matter. The subject of the patent must have a useful purpose, and it has to

be “novel” and “non-obvious.” *Novel* means it was never been invented before;³ *non-obvious* means it should not be something that any expert in the field could have thought of based on existing technology.⁴ This is where the term *prior art* comes into play—it refers to the state of technological development before an application is filed. To be considered “new,” the invention must be different from the prior art. After the examiner studies the application, the claims will either be accepted or rejected;⁵ rejected claims may be amended.⁶ Once all the claims are accepted, a patent can be granted.⁷

Free Patent Resources

So now you know the basics of the prosecution process, but what free resources are available to research patents? Fortunately, the USPTO’s website has an excellent patent research section at <http://www.uspto.gov/patents/index.jsp>. You can use this site to search for patents or patent owners, and get a useful description of the prosecution process. Note that normally patent applications are not made public, or *published*, until eighteen months after they are filed. An applicant can prevent their application from being published by swearing that they will not file the same patent in any other country, but this is very unusual.⁸ You can use the USPTO’s public PAIR (Patent Application Information Retrieval) system <http://www.uspto.gov/patents/process/status/index.jsp> to search for *file wrappers*, which are the collections of filings and communications connected with a patent’s prosecution process. PAIR’s public system contains information about patent applications and patents; the private version is used by patent attorneys and USPTO examiners, and has detailed information on prosecution histories. People who prefer searching Google-style can take advantage of Google’s Advanced Patent

Search http://www.google.com/advanced_patent_search—a useful tool if you’re trying to find completed patents.

The filed patents themselves are also a source of useful information. The front page of a patent alone will give you information on prior art, who owns the patent, and what classifications the patent was filed under, among other things. Queen’s University has a useful sheet that lists all the information available on the first page at http://library.queensu.ca/webeng/patents/Anatomy_of_a_US_patent.pdf.

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Endnotes:

- 1 SA DONALD S. CHISUM, CHISUM ON PATENTS § 3 (1978 & Supp. 2012); Leahy-Smith America Invents Act, Pub. L. 112-29, § 3, 125 Stat. 284, 285-293 (2011).
- 2 MUELLER, PATENT LAW, at 45; 35 U.S.C.S. §§ 101-103 (2012).
- 3 35 U.S.C.S. § 102 (2012).
- 4 35 U.S.C.S. § 103 (2012).
- 5 35 U.S.C.S. §§ 131,132 (2012).
- 6 37 C.F.R. § 1.116 (2012).
- 7 35 U.S.C.S. § 151 (2012).
- 8 JANICE M. MUELLER, PATENT LAW 53-4 (3d ed. 2009); 35 U.S.C.S. § 122 (2012).



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