

# How to Obtain Patents

This paper outlines in general terms the basic steps for obtaining patents in the U.S. and abroad. Please contact the author below if you have questions that are more specific in nature about obtaining patents.

## Step 1 - Meeting with an attorney

It is best to meet with patent attorneys at several different law firms to determine which best fits your particular needs. Do not disclose confidential information to an attorney until he or she has agreed to receive it. Each law firm will likely conduct a conflicts check to see if representing you would conflict with the representation of any of their existing clients. Once you have chosen a law firm to work with, an attorney-client engagement agreement will be put in place. Some firms will require that a retainer be placed in a trust account before work is commenced. This money will be used toward the total cost of the patent services that are provided.

## Step 2 - Patentability Search

There are various levels of patentability searches that can be conducted, from doing a quick internet or patent database search yourself, having your law firm conduct an in-depth search, and/or having your law firm commission an outside search firm to conduct a more exhaustive search. Your patent attorney can explain the search options and advise you as to which may make the most sense in your situation. In some cases, you may wish to proceed without conducting any searches. Keep in mind that a patentability search informs you as to the prospects of obtaining a patent on your invention, and is different from a more expensive freedom to operate search that helps determine if your invention is likely to infringe the patents of others. Freedom to operate searches typically are not conducted until later in the invention, patenting and product development cycles, but an earlier conducted patentability search will often provide useful information relative to your freedom to operate.

## Step 3 - Preparation and Filing of Patent Application

The utility patent is by far the most common type of patent obtained in the U.S. (as opposed to design patents or plant patents.) An applicant may start the patenting process by having a utility patent application directly prepared and filed, or may first file a provisional application and follow it up within one year with a utility application. The requirements and fees for filing a provisional application are considerably less than those for a utility application. By filing a provisional application first, an applicant can take additional time to develop the invention, assess the market, obtain further funding, and determine whether continuing with the patenting process is warranted. Within one year of filing the first provisional application (multiple provisionals may be filed over the course of the year), a more thorough utility application must be prepared and filed if the applicant wants to make use of the

provisional application. The utility application is entitled to the benefit of the filing date(s) of the earlier filed provisional(s), and may add additional information for technology developments that have occurred since the provisional filing(s). If an applicant wants to pursue patent protection outside the U.S. as well, a foreign or international application must be filed within one year of the first U.S. filing (regardless of whether that first filing is a provisional or a utility application.) The most common route for pursuing foreign protection is the filing of a Patent Cooperation Treaty (PCT) application one year after the first U.S. filing. This allows the applicant an additional 18 months before needing to file applications in foreign countries or regions (known as the “national phase”.) Each jurisdiction has its own patent laws, but in many countries examination of patent applications is somewhat similar to that of U.S. applications. Only U.S. examination is discussed below.

#### **Step 4 - Post-Filing Formalities**

The following documents may be filed with the patent application, but typically are filed a few months later after receiving a Notice to File Missing Parts from the Patent Office. Inventor declaration(s), assignment(s) from the inventor(s) to a business entity, formal drawings, and Information Disclosure Statements (IDS's) are among the documents that are typically filed. An IDS is a document listing all references cited in the patent application and any other “prior art” or circumstances known to the applicant that may potentially affect the novelty or obviousness of the invention. Patent applications are held in secret by the Patent Office until they are published 18 months after the first filing. If a provisional application is never followed up with a utility application, or if the utility application is actively abandoned before the 18 month period ends, the application is never made available to the public.

#### **Step 5 - Office Action and Response to Office Action (Amendment)**

About six months to two years after the filing date of a utility application (sometimes longer), your patent attorney will receive a communication from the assigned Patent Examiner known as an "Office Action." In this document, the Examiner describes the closest prior art relative to the claims of the application, and most often rejects all of the claims as being anticipated (lacking novelty) over one of the references, or obvious in light of a combination of two or more of the references. The Examiner may also object to one or more aspects of the written description. To overcome these objections and/or rejections, an "Office Action Response/Amendment" will be prepared. Even when the originally filed claims are patentable over the prior art, the Examiner often will initially reject them and require the applicant to explain on the record how the invention is patentable over the closest prior art found by the Examiner. The Office Action Response focuses on claim changes and/or arguments to convince the Examiner that the invention is patentable. Changes may be made to the claims and/or specification in the Amendment; however, once an application has been filed, substantive changes to the specification (i.e. the written description and drawings) are prohibited. Thus changes to the specification and drawings are typically made only to correct typographical errors. The time allowed for preparation and filing of a Response/Amendment is 3 months after the date of the Office Action. Extension of time fees may be paid retroactively to extend the response time up to an additional 3 months. In some cases, the

Examiner will issue a Second Office Action (about 2 to 6 months after the first response is filed) before the application is finally Allowed (see Step 6b) or Rejected (see Step 6a). In-person, telephone or video interviews with the Examiner will often streamline the process. Some findings by the Examiner in the Office Action(s) may prompt the applicant to file a "Divisional Application" or "Continuation Application" (See Extension Applications below).

## **Step 6a - Final Rejection**

If the application receives a final rejection by the Examiner, the options for proceeding include (1) file an Amendment After Final Rejection (although these are discretionary - the Examiner is not required to enter them into the record); (2) appeal; (3) file a Request for Continued Examination (RCE); or (4) abandon the application.

### **Amendment After Final Rejection**

After a final rejection, an "Amendment After Final Rejection" may be submitted which narrows the claims or which includes other claims, provided no new issues are raised. If the Examiner agrees that the amendment narrows or changes the claims sufficiently to place the case in condition for allowance, he or she will authorize its entry and allow the case (See Step 6b below). Otherwise, the Examiner will issue an "Advisory Action" reiterating the reasons for rejection (leaving open the option to appeal). Even if the Examiner does not enter the amendment because it raises new issues, the Advisory Action will state whether the amendment will be entered for purposes of appeal.

### **Appeal**

If the examiner has not provided a strong case for rejecting the claims, an appeal brief can be filed with the Patent Trial and Appeal Board (PTAB). If the Board is persuaded by the applicant's arguments, the examiner will be reversed and the application will move to allowance (See Step 6b below). If the Board affirms the Examiner's rejection, a further appeal may be made to the Court of Appeals for the Federal Circuit (CAFC). If the CAFC upholds the USPTO's decision, the applicant can request that the U.S. Supreme Court hears the case (although the grant of this is rare).

### **Request for Continued Examination (RCE)**

After a final rejection, prosecution of the application may be continued by filing an RCE. For example, if it is desired to amend the claims to overcome the prior art and this is done in a manner that requires the Examiner to conduct a new search, filing an RCE is needed to restart the examination process.

## **Abandon Your Application**

If all claims of your application are rejected in the final Office Action and you no longer believe that commercially relevant claims can be obtained from the application, or if you simply do not wish to further pursue patent protection for your invention, you can allow the application to become abandoned (your application will go abandoned automatically if you do not file a timely reply by way of one of the options listed above to the Final Office Action). Keep in mind that once an application has gone abandoned, it generally will no longer be possible to obtain patent coverage on your invention. In some cases, however, if you allow the application to go abandoned it may be possible to resurrect the application.

## **Step 6b - Notice of Allowance**

If the Examiner is satisfied with the merits of the application and everything required by the Patent Office has been submitted, a Notice of Allowance and Issue Fee Due will be sent, indicating that all of the claims are allowed. The Patent Office will make a request at this time that an "issue fee" be paid. Several months after the issue fee is paid, the patent will issue and a formal "ribbon copy" will be mailed. The patent term starts on the day the patent is issued, and in general ends 20 years after the filing date of the first utility application (subject to many exceptions). Maintenance fees must be paid 4, 8 and 12 years after issuance to keep the patent in force.

## **EXTENSION APPLICATIONS**

Each of these applications must be filed before issuance or abandonment of the parent application.

### **Continuation**

If you want to continue the Examination of your application or a chance to try a new and different set of claims, a continuation application may be filed. A continuation is an additional application for the same invention claimed in your original patent application (typically containing the exact same specification as the original application but with new claims) and filed before your original application issues or becomes abandoned. A continuation application receives the filing date of your original patent application for purposes of overcoming prior art and for patent term determination, but receives its own serial number and filing date for USPTO administrative purposes.

### **Divisional**

You may be prompted by an Examiner in an Office Action to file a divisional patent application if it's found that there is more than one distinct invention claimed in your original patent application. This type of finding is referred to as a "restriction requirement" because you are restricted to claiming only one invention per patent application. If you receive a restriction requirement in which the Examiner indicates that there are claims directed toward two or more inventions, you must "elect" the claims you wish to pursue in this application and the remaining claims will be withdrawn from consideration. In the divisional application claims that were directed to the withdrawn subject matter are pursued. A

divisional application receives the filing date of your original application for purposes of overcoming prior art and for patent term determination, but receives its own serial number and filing date for USPTO administrative purposes.

### **Continuation-In-Part (CIP)**

If the basic invention of the original (parent) application has been improved in some material way while the original patent application is still pending and you want to obtain specific claims to the improvement, you may file a continuation-in-part (CIP) application. A CIP application receives the filing date of the original application for purposes of overcoming prior art related to material disclosed in your original application, but receives its own serial number and filing date for USPTO administrative purposes. The new material disclosed in the CIP application receives the filing date of the CIP application rather than being entitled to the priority of the filing date of the parent application.

### **Reissue**

If you've received an original patent, but you want to revise the claims of the patent or correct significant errors in the specification for some valid reason, a reissue application may be filed. A reissue patent takes the place of the original patent. There are specific rules that apply to these applications which should be discussed with your patent attorney before proceeding.

### **Further resources**

The author below may be contacted for additional information:

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The author provides further information on the patenting process at: [www.MedtechBriefs.com](http://www.MedtechBriefs.com). You may sign up there for periodic email updates of interest to the medical device community.

“Patent It Yourself” by David Pressman (Nolo Press) is another good educational resource, whether you are working with a patent attorney or doing some or all of the patenting work yourself.

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