

Patent Prosecution

Patent prosecution refers to the process of applying for a US patent and having the patent examined by the US Patent Office. There are many complex substantive and procedural legal requirements that must be fulfilled in order to obtain not only an issued patent, but a valuable patent that includes broad claims and is immune from defects or serious limitations. It is important to note in advance that no one can guarantee that any patent claims will be allowed or a patent will issue. The patent prosecution phase can typically take 2 - 3 years from the filing date of the utility application, although it may be longer or shorter depending upon the circumstances.

After the utility patent application is drafted and filed with the necessary signature documents in the U.S. Patent Office, it is assigned to one of over 4000 Examiners at the patent office. This is the person who will review the patent application, do a search for prior art, and "examine" the application for compliance with the patent statutes and patent office rules. The applicant's participation in the patent prosecution includes the filing of information disclosure statements, assignments, and responses to correspondence received from the patent office.

The first substantive communication from the patent office is generally an "office action," in which the examiner is likely to make one or more statutory rejections of some or all claims based on earlier references, with an explanation of the legal basis for the rejection. The patent attorney normally reviews the office action, consults with the client-applicant about the reasons for the rejection, and prepares an "office action response" which may contain amendments to the claims and arguments in support of the application.

The cycle of office action and response may continue for another one or several iterations during the patent prosecution until either the patent is allowed (allowance) or receives a final rejection. If it results in a final rejection, the applicant has several options including filing an appeal with the Board of Patent Appeals and Interferences. Ultimately, if the patent application is not allowed and the rejection is not appealed or continued, the application will be abandoned and the patent prosecution comes to an end.

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If the patent prosecution of the application is successful, and the patent application is allowed, a notice of allowance is issued and the applicant is invited to pay the issue fee. Upon payment of the issue fee, the patent will issue. After proof reading, any necessary corrections can be filed with the patent office and become part of the record as well.

For a more extensive explanation of the patent process or details concerning patent prosecution, consult any of our registered patent attorneys. For more information about patents, consult our Document Library.