

“After my patent application is filed, then what?”

After an inventor files a patent application, several key events occur. Additionally, there will be additional costs / fees along the way. The following summarizes the post-filing process.

EFS Receipt

Assuming that your application was filed using the Patent Office’s Electronic Filing System, an electronic receipt including a serial number and filing date will be immediately provided . Ask your patent attorney for this information, and make sure you maintain it in confidence.

“Patent Pending”

As soon as you file a patent application (including a provisional application), you may (and should) mark any product that would be covered by the patent were it to issue with the term “Pat. Pending” .

Official Filing Receipt

Shortly after filing, the application will undergo a preliminary review. The Patent Office will look over the application for formal matters. It is important to carefully review the Official Filing Receipt to ensure that the inventorship information is correct. Bring any errors to the attention of your patent attorney for corrective action.

Notice to File Missing Parts

Any errors found by the Patent Office during the formalities review will be noted on a Notice to File Missing Parts. These must be corrected within

two months (which can be extended for a fee). The most common problem is with drawings that are not in an acceptable format.

Patent Application Publication

This will occur 18 months after the earliest filing date. So, if the application claims the benefit of a provisional application, publication will be 18 months from the provisional filing date. Otherwise, it will occur 18 months from the non-provisional filing date. (The only exception to publication is if your application was filed with an approved Non-Publication Request with the appropriate fee.)

In most cases, the following events will occur after about two years or more from the filing date. However, once the examination process starts, the Patent Office will expect timely responses from the applicant.

Restriction / Election of Species Requirement

In many cases, the examiner will issue an initial Office action in which it is asserted that the application claims more than one invention which is patentably distinct from another (restriction) or the application would cover more than one variation (species). The applicant is then asked to elect a group of claims to initially have examined. The withdrawn claims can later be filed in one or more Divisional applications at any point to the final disposition of the parent application. Even if applicant disagrees with the examiner, the applicant must elect a group of claims to prosecute. The restriction / election of species requirement can be challenged by filing a response or petition arguing that it is improper.

Non-Final Office Action(s)

In most cases, the first Office action on the merits will reject all pending claims. It is important to understand that you must respond to the Examiner's rejection in full within the statutory time period (six months) or the application will go abandoned. After three months, extension of time fees will be required. To prepare a response, your patent attorney will charge a fee, which depending on complexity, is usually between \$1000 and \$1500. This amount could be less if the Office action is relatively easy to respond to and the subject matter is non-complex, but it could be higher if the Office action is very detailed (long) and the subject matter is difficult. Usually, it will be easier for the patent attorney to draft a response if he or she drafted the application.

Responses to the Office Action can be done by amending the claims, arguing without amending, or a combination of amending the claims and arguments. In certain cases, "evidence" can be submitted in the form of an Affidavit from an expert in the field (such as experimental data showing an unexpected result).

Examiner Interview

It is often a good idea to have your patent attorney conduct an examiner interview. Most of the time, this occurs via a telephone conference with the examiner (and sometimes the examiner's supervisor). Proposed claim amendments can be submitted for examiner review. The substance of the interview is then entered into the record. In some cases, an agreement can be reached to allow the case, though most examiners will no longer do this. Note that your patent attorney will usually charge a fee for conducting

the examiner interview. However, this can well be worth the expense, if it helps expedite examination.

Final Rejection

If the Examiner is not persuaded by the response, the next Office action could be a Final Rejection. (In some cases, however, the examiner will not make the action final – giving applicant the opportunity to respond again without limitation.)

Response to a Final Rejection is tricky. Examiners do not have to enter an after-final claim amendment, and most will not do so. The applicant may wish to respond to the final rejection only with arguments by filing a Request for Reconsideration.

Additionally, the Examiner may have indicated allowance of certain claims. (Sometimes, the Examiner will indicated that some claims are allowable in a non-Final Rejection). At that point, you would have to decide whether amend the claims such that the allowable subject matter is incorporated into the independent claims so that the case would be in condition for allowance.

It is not at all unusual for the Examiner to issue 3 or 4 (or more) Office actions prior to final disposition of the case. Thus, it is critical for the applicant to properly budget. Often the most valuable patents will require the most effort. On the other hand, be sure to carefully review the prior art found by the Examiner to ensure that your invention is truly patentable. If it is clear that the prior art cited by the Examiner is very close or actually on point and you cannot amend around it, you will have to abandon the application.

Request for Continued Examination (RCE)

Luckily, there is a way to continue the examination process after receiving a Final Rejection. This is by filing a Request for Continued Examination (RCE). However, there is a fee to do so (\$465). When an RCE is filed, the applicant can include amendments and arguments. There is no limit on the number of times an applicant can file an RCE, so, in theory, the prosecution process can continue indefinitely.

Appeal to Board of Patent Appeals and Interferences (BPAI)

At any point after receiving a final rejection or being twice rejected, the applicant can appeal the case to the BPAI. However, there is considerable expense to doing this. The filing-associated fees include a Notice of Appeal (\$310) and a Appeal Brief filing fee (\$310). Since preparing an appeal brief is a lengthy process, most patent attorneys charge several thousand dollars for this. Appealing the case is often a good idea when it appears that the examiner will not change his or her mind and when the patent involves subject matter that is valuable.

Notice of Allowance

If the examiner determines that your application should be issued (or the BPAI made this determination), the Patent Office will issue a Notice of Allowance. You must pay the issue fee (\$870) and publican fee (\$300) within two months. This cannot be extended.

Issuance

After payment of the issue fee and publican fee is paid, you will receive a date on which the patent will issue. Patents issue each Tuesday of the week. There is no fee for the patent to be issued. You will receive an original copy of the patent (with a ribbon).

Maintenance Fees

All utility patents are subject to maintenance fees, which must be paid to maintain the patent in force. These fees are due 3 1/2, 7 1/2 and 11 1/2 years from the issue date, as follows:

3 ½ years: \$565

7 ½ years: \$1,425

11 ½ years: \$2,365

Other Costs and Considerations

In addition to the above, there can be other prosecution-related fees and costs. The most common additional expense involves “late fees”, fees to prepare and file petitions, and costs for correcting drawings. The current Patent Fee Schedule can be accessed here:

<http://www.uspto.gov/web/offices/ac/qs/ope/fee092611.htm>

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