EFFECTIVE PROSECUTION THROUGH THE USPTO

FICPI FORUM – 10 October 2002

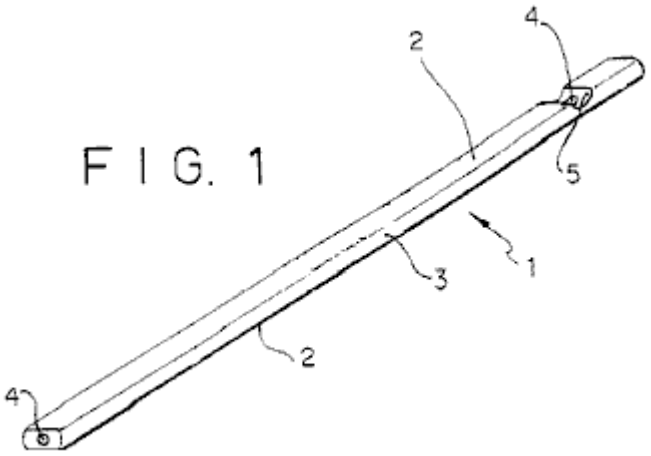
Noel Brett – Australia – Moderator

Charles E. Van Horn – USA

Ivan Ahlert – Brazil

Invention / First Patent Application

- Concept of invention: to simplify the manufacture of colored pencils, avoiding the need to paint the external surface with the same color of the lead.



Invention / First Patent Application

- Secondary concept: with plane faces having neutral background it is possible to provide set of pencils with a puzzle

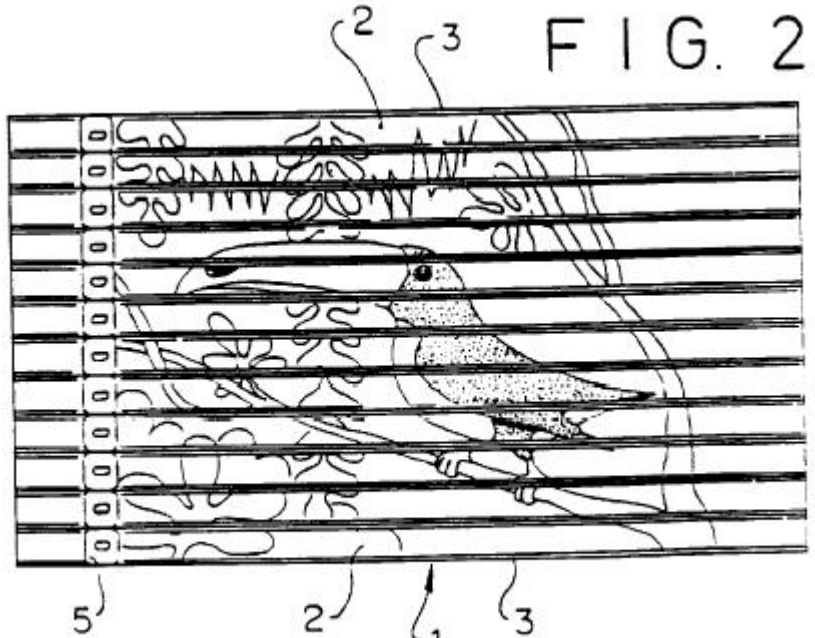


FIG. 2

Invention / First Patent Application

- Claim 1. A writing instrument comprising an elongated body and a means for writing provided within said elongated body along its longitudinal axis, wherein said elongated body includes at least one lateral cut-out exposing a portion of said means for writing.

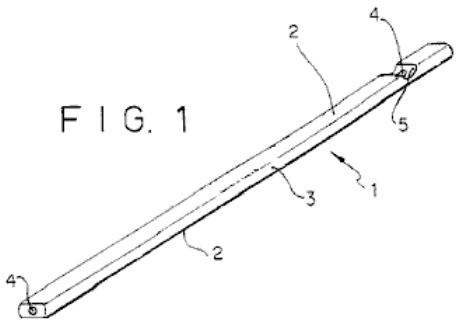
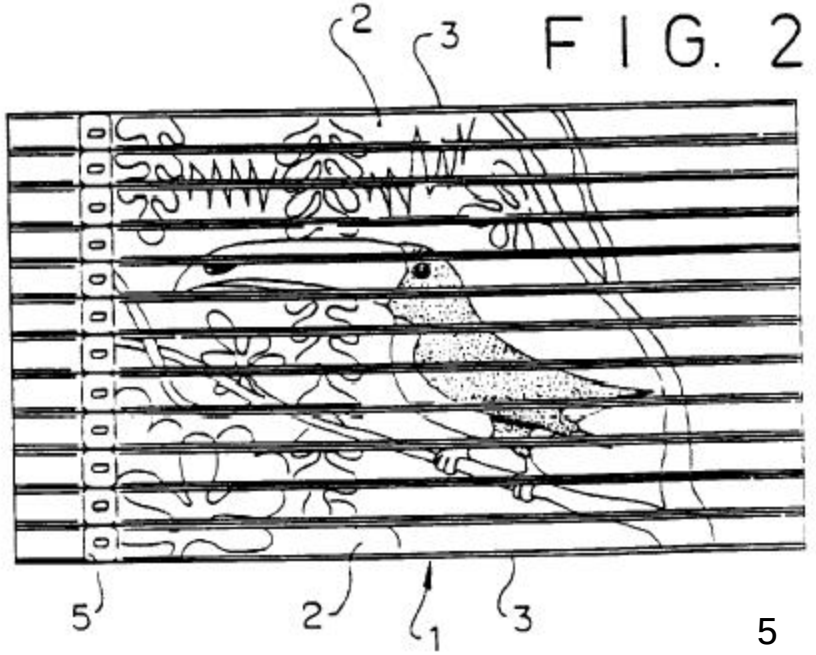


FIG. 1

Invention / First Patent Application

- Claim 8. A **set of pencils** embracing a plurality of pencils, each pencil comprising at least two substantially plane longitudinal faces opposed to each other, wherein each of said pencils comprises a partial pattern applied to at least one of said substantially plane longitudinal faces, such that said pencils arranged in a defined sequence outline an integral pattern.



Invention / First Patent Application

- First Application filed in Brazil 01 January 1998
- Presumably 1 year for filing abroad…

Benefits of US Provisional For Non-US Applicants

- Early US Filing date
  - Protection against § 102(b) prior art activities one year before US filing date
  - Prior art effect under § 102(e) – earliest US filing date
- Protection against § 135(b) forfeiture of patent rights
- Any language – no English-language translation in provisional
- $160/$80 Filing fee

35 U.S.C § 135(b)(2)

A claim which is the same as, or for substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published ONLY IF the claim is made before 1 year after the date on which the application is published.

Convention (Nonprovisional) Filing

1. National
2. PCT (US)
   - May have adverse effect under § 102(e) if PCT application is not published in English
   - US patent granted on PCT (US) application has no § 102(e) prior art effect

§ 102(e) – November 29, 2000

(e) The invention was described in—

(1) An application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

§ 102(e) – November 29, 2000

(2) A patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

Applications Filed

- Brazil 01 January 1998
- US Provisional 05 January 1998
- US Nonprovisional 01 January 1999
  - Claims benefit of Brazil/US Prov.
  - 16/4 month deadline for claiming benefit

Duty of Candor / Disclosure

- Inventors and those substantively involved in preparation or prosecution of application
- Information material to patentability
- Information Disclosure Statements (IDS)
  - Different requirements depending on state of prosecution – see attached chart
  - File early
- Submit IDS at time of filing

Restriction / Election of Species

1. § 121 – independent and distinct inventions
   - Separate inventions
   - Genus – species
   - Rejoinder
2. Unity of invention (PCT – covers entry into National Stage, but not continuing application)

Restriction / Election of Species

1. Writing instrument
2. Set of pencils –
    a. Matched cut-outs
    b. Random cut-outs

Election of invention and species must be made to avoid abandonment

First USPTO Action

- Claims are rejected as being anticipated by US Patent A that:
  - Issued 10 Dec. 2000
  - US National Phase 03 Sept. 1999
  - PCT Publication 03 July 1999
  - PCT Application 30 Dec. 1998
  - US Prov. 03 January 1998

What is earliest prior art effect date in US?

First USPTO Action

- US Patent A:
  - Issued 10 Dec. 2000
  - US National Phase 03 Sept. 1999
  - PCT Publication 03 July 1999
  - PCT Application 30 Dec. 1998
  - US Prov. 03 January 1998
- Our case:
  - US Nonprovisional 01 January 1999
  - US Provisional 05 January 1998
  - Brazil 01 January 1998

Reply to First Action

- Patent A is not prior art to invention having a date of 01 January 1998 (Brazil)
- Examiner interview?

Final USPTO Action

- Examiner recites US Patent B:

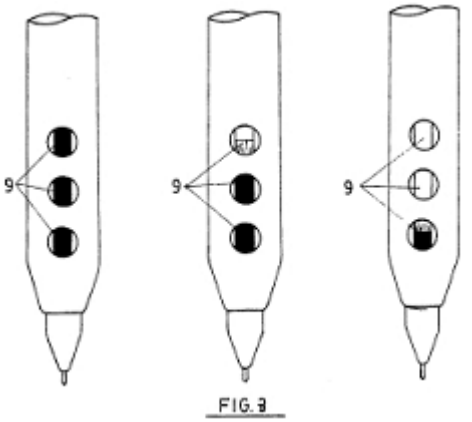


FIG. 3

- Our claim 1. A writing instrument comprising an elongated body and a means for writing provided within said elongated body along its longitudinal axis, wherein said elongated body includes at least one lateral cut-out exposing a portion of said means for writing.

Final USPTO Action

- Claims are rejected as being anticipated by US Patent B that:
  - Issued 10 Dec. 2000
  - Filed (US) 02 June 1998
  - US Prov. 03 June 1997

[Our appl.: Brazil 01 January 1998]

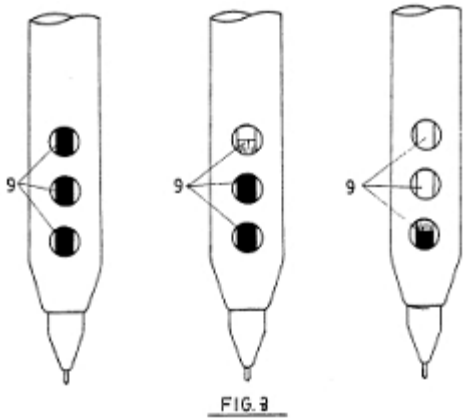
What is earliest prior art effect date in US?

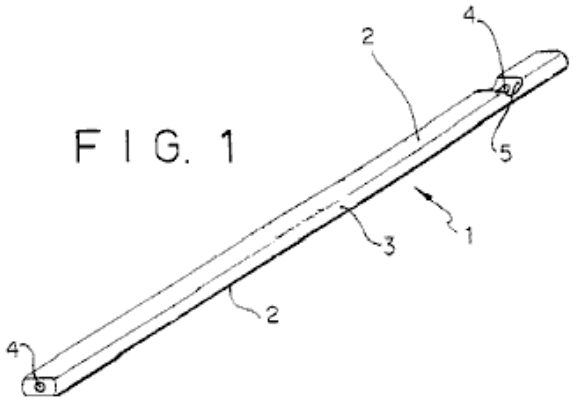
Reply to Final USPTO Action

1. Petition to have premature final action withdrawn?
2. Examiner interview?
3. Arguments?
4. Amendments?

Reply to Final USPTO Action

- Amend claim 1 as follows: A colored pencil comprising an elongated wooden body and a lead provided within said elongated body along its longitudinal axis, wherein said elongated wooden body includes at least one concave lateral cut-out exposing a portion of said lead.





USPTO Advisory Action

- Amendment not entered
- Raises new issues
- Raises an issue of new matter

Continuing Prosecution Options

- Appeal
- Continuation application
  - Rule 1.53(b)
  - Rule 1.53(d) – CPA (May 29, 2000)
- Request for Continued Examination – RCE
- Transition procedure – Rule 1.129(a)

Strategic Considerations – Cont./RCE

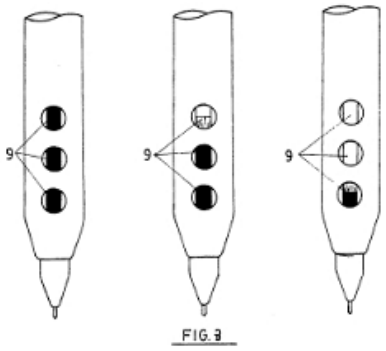
1. Invention to be examined
2. Stage of prosecution
3. Reply available
4. Patent term adjustments
5. Fees
6. Publication of application
7. § 103(c)/§ 102(e) [November 29, 1999]
8. § 102(e) prior art effect

File RCE

- Request entry of amendment
- Benefits
  - Fixed fee
  - Does not trigger publication
  - Request filed in existing file
    - Simple
    - No new IDS required
  - Preserves patent term adjustment except for benefit of 3-year pendency rule

Third (Final) USPTO Action

- Claims are rejected as being obvious over Patent B



  - Can we show an earlier date of invention?
  - Patent B and invention owned by the same party at the time the inventions were made?
  - Consider same after-final action options as above

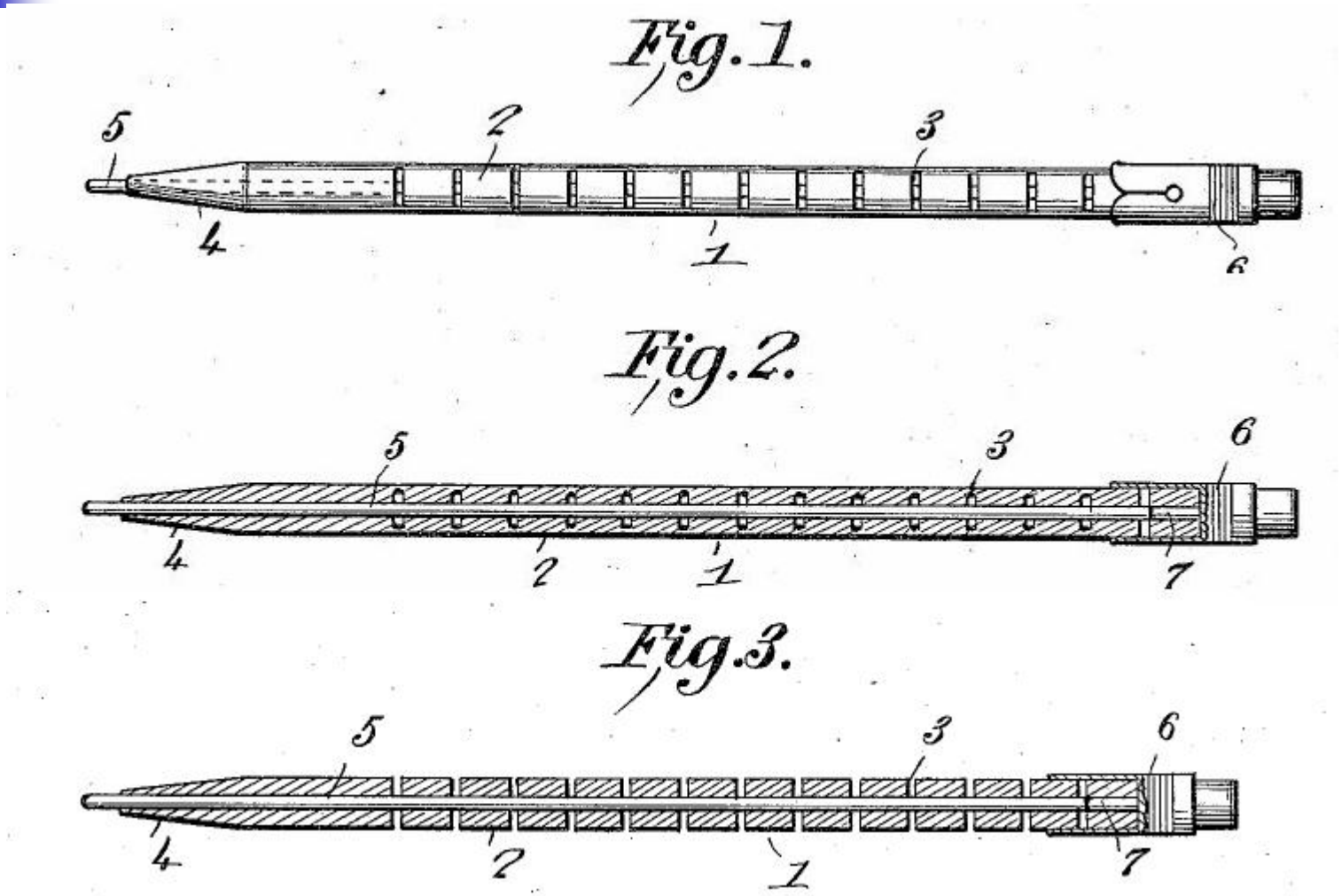
Appeal to Board of Patent Appeals

- Notice of Appeal
- Appeal Brief (Appeal Conference)
- Reply Brief and Request for Oral Hearing
- About 1 year for decision after Board receives fully briefed case

Board Decision

- Rejection reversed – all claims patentable
- Note attached statistics for Board decisions in FY 2002 – less than 30% affirmance

New Information Discovered



New Information Discovered After Notice of Allowance Mailed

- No action required – cumulative
- Continuation application
- RCE
- Rule 1.312 amendment of claims
- Rule 1.313 petition to withdraw application from issue if issue fee paid

New Information Discovered After Patent Issued

- No action required
- File § 301 statement in patent file
- Reissue – admission of error required
- Ex parte reexamination
- Inter partes reexamination
- Note attached reexamination statistics