

PATENT LAW AND PROSECUTION BEFORE THE USPTO

U.S. PATENT AND TRADEMARK OFFICE

Presented by

Hershkovitz & Associates, LLC

PATENT LAW AND PROSECUTION BEFORE THE USPTO

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Chapter 1

What is a Patent?

The Basic Law — What Precisely Is a Patent?

- U.S. Constitution (Article 1, Section 8): “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

The Basic Law — What Precisely Is a Patent?

1. **Qualifying Inventions.** In order to be eligible for a patent, an invention must be new, useful and not obvious. 35 U.S.C. §§ 101, 102, 103.
2. **Disclosure Required.** To obtain the patent, the inventor must disclose information sufficient to allow others to practice the invention. 35 U.S.C. § 112.
3. **Rights Conferred.** The patent then confers certain exclusive rights that preclude anyone from making, using, offering for sale, selling or importing the invention into the United States. 35 U.S.C. § 271.
 - a. Independent invention is NOT a defense to infringement.
 - b. Rights end after 20 years.

Chapter 2

Patentable Subject Matter

§101 Patentable Subject Matter

- 1972 *Benson* (US): “substantial practical application”
- 1978 *Parker v. Flook* (US): Affirmed *Benson*
- 1980 *Charkrabarty* (US): “anything under the sun made by man”
- 1981 *Diamond v. Diehr* (US): “transforming or reducing an article to a different state or thing”
- 1998 *State Street* (CAFC): “useful, concrete and tangible result”
- 2010 *Bilski* (US): (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Chakrabarty: Summary

- The case is widely known for its seemingly broad holding that “anything under the sun that is made by man” can be patentable subject matter.
- But the decision also reaffirms a somewhat amorphous (having no definite shape, form or structure) limitation on patentable subject matter – that “laws of nature, physical phenomena, and abstract ideas” are not patentable.

State Street: Business Methods

- Elusive origins of the business method “exception.”
- World view: Split between nations that follow U.S. and those that follow EU approach of no business/finance patents.
- Congressional response to *State Street*.
- Under *State Street*, would a business method unrelated to a computer program be patentable, for example, a step-by-step approach to sales that proves to increase buyers’ receptivity to offers?
- Does the congressional creation of a prior user defense violate the TRIPs Article 27 requirement that patent rights be available without discrimination to all fields of technology?

BILSKI

(1) it is tied to a particular machine or apparatus, or

(2) it transforms a particular article into a different state or thing.

Surgical Methods

- Medical techniques have a spotty patent history. *Morton v. New York Eye Infirmary*, 17 F. Cas. 879 (C.C. S.D.N.Y. 1862), is an early example of the courts' hesitation to enforce patents on medical procedures.
- *Ex parte Scherer*, 103 U.S.P.Q. (BNA) 107 Pat. Off. Bd. App. 1954), officially overturned the disfavor given medical procedures in the Patent Office, but the office had granted several medical procedure patents even before *Scherer*.
- *Pallin v. Singer* (D. Vt. 1995) – district court litigation on a patent technique for eye surgery. Though the patent is ultimately declared invalid, the litigation cause Congress to limit the enforceability of surgical patents.

Chapter 3

Utility

Statutory Bases of the Utility Doctrine

- Section 101 authorizes patents only for new and “useful” subject matter.
- Section 112 requires the disclosure of “the manner and process of making and using” the invention.

Three Strands of Utility Doctrine

- **Operability:** Does it work? (Should prophetic utilities be allowed?)
- **Beneficial Utility:** Does it produce some social benefit (or at least no social harm)?
- **Practical or Specific Utility:** Is the utility identified by the inventor a “substantial” utility? See *Brenner v. Manson*, & *In re Fisher* (How should the “substantiality” of a utility be decided?).

In re Brana

What is the utility in *Brana*? Is it curing mice of tumors? Or is it curing humans?

- The opinion seems to suggest that curing mice of artificial tumors is a “sufficiently specific use.” It is important, however, that this artificial disease was “originally derived from lymphocytic leukemias in mice.”
- By comparison, that the PTO had rejected the application for failing to disclose a “practical utility (i.e., antitumor activity in humans).”
- Also, the court states that the PTO did not meet its burden of challenging a “presumptively correct assertion of utility” because the PTO’s arguments would be “relevant only if applicants must prove the ultimate value in humans of their asserted utility.”

Chapter 4

Disclosure and Enablement

Enablement Hypothetical

- Imagine that a “space rock” falls to Earth. No one knows how to make such a rock, but pieces of the rock can be purchased on the open market. An inventor discovers a new and nonobvious process for using the rock. Can the inventor patent the process even though she cannot enable the creation of the space rock?
 - The Patent Office permits an inventor to enable starting materials by depositing them in a publicly available database. In fact, patent deposits were first used for starting materials and only later were permitted for elements actually claimed (recall the plant patent discussions from Chapter 2). What policy distinctions can you see between the deposit of starting materials versus deposit of that which is claimed?

Written Description

Three statutes are important to understanding this area of the law: 112, 120, 132.

- § 112. Specification.
- [¶ 1] The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same ...
- § 120. Benefit of Earlier Filing Date in the United States
- An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . , shall have the same effect as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application
- § 132. Notice of rejection; reexamination
- ... [Right to make amendments.] No amendment shall introduce new matter into the disclosure of the invention.

Written Description: Textual Analysis of Section 112

- § 112. Specification.
- [¶ 1] The specification shall contain a written description of the invention..., in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same ...
- This parsing of the language suggests that the sufficiency of the written description requirement is tested by whether the person skilled in the art can make and use the invention (i.e., it is viewed as part of the enablement requirement).

Or

- [¶ 1] The specification shall contain

Written Description: Textual Analysis of Section 112 (cont'd)

- a written description of the invention,
 - and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same ...
- This version suggests that section 112 contains two distinct requirements: a written description and an enablement requirement.

Prohibition on New Matter

- **Statutory basis?**

- § 132 prohibits introducing “new matter” into applications.

- **Rationale?**

- An invention should be complete by the time of filing because the filing date serves as the latest possible priority date in determining rights to invention.

Best Mode

- Section 112, para. 1 requires that the inventor “shall set forth the best mode contemplated by the inventor of carrying out his invention.”

Claim Drafting

- Preamble
- Transitions
 1. comprising (including)
 2. consisting of
 3. consisting essentially of
 4. composed of and having
 5. Nonuse of “step of” in the transition

Claim Drafting

- Body of claims:
 1. introducing the elements
 2. structural and functional definitions
 3. “means for” and “step for” clauses
 4. cooperation : structural and functional
 5. method steps

Types of Claims

- Independent claims
- Dependent claims
- Multiple dependent claims
- Jepson claims
- Markush Groups
- Product-by-Process Claims

Chapter 5

Novelty

§ 102. CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT

A person shall be entitled to a patent unless —

- N (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- SB (c) he has abandoned the invention, or
- SB (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- N (e) the invention was described in [a patent application that is ultimately published or issued as a patent] or
- D (f) he did not himself invent the subject matter sought to be patented, or

§ 102. CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT (cont'd)

- N (g) (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or

(2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it.

In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 102. CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT (cont'd)

A person shall be entitled to a patent unless —

- N (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- ...
- N (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 or
 - (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 an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or.

§ 102. CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT (cont'd)

- D (f) he did not himself invent the subject matter sought to be patented, or
- N (g) (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or

(2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it.

In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

References under 102(a)

Statute says that applicant is not entitled to a patent if:

a) the invention was

- known or used by others in this country, [domestic]
- or patented or described in a printed publication in this or a foreign country, [global inquiry]

before the invention thereof by the applicant for patent, or

References under 102(b)

Statute says that applicant is not entitled to a patent if:

- the invention was patented or described in a printed publication in this
- or a foreign country
- or in public use
- or on sale in this country,
- more than one year prior to the date of the application for patent in the United States,

References under 102(e)

- Statute says that applicant is not entitled to a patent if:

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 or

(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 an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

“Defensive” Publications

- Even parties who do not want to patent their developments need to know the publication rules because they may want to prevent other parties from obtaining patents on those developments.
- Patent lawyers thus may sometimes advise their clients to make a “defensive” publication – a publication that will prevent others from seeking patent rights on a development that the client has made but does not want to patent.
- Some firms specialize in making such publications quickly and at low cost.

Prior Art Searching

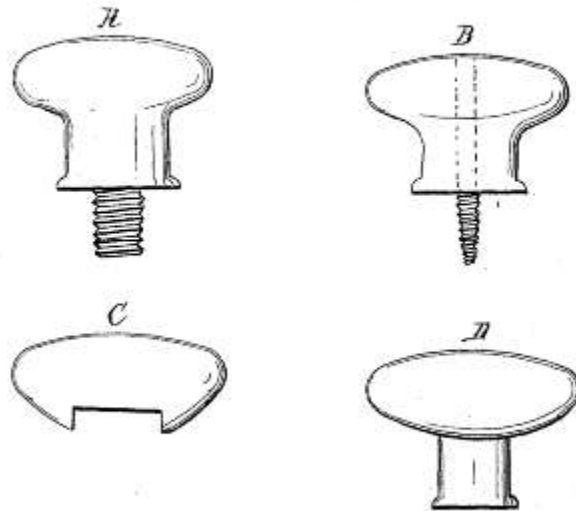
- Many other firms specialize in searching the prior art. These searches help attorneys:
 - To advise their clients whether a development is patentable in light of the prior art; and
 - To draft patent claims that are patentable in light of the prior art.
- A prior art search is not, however, a prerequisite for filing a patent application. Many inventors do not conduct a prior art search but instead simply rely on the PTO's search. That practice can be dangerous because, if the PTO does not find some relevant art, those references could invalidate claims in infringement litigation.

Chapter 6

Nonobviousness: Case Studies

Hotchkiss

*Hotchkiss, Davenport & Quincy,
Knob.
N^o 2,197. Patented July 29, 1841.*



*Witnesses:
Davenport & Quincy*

*Inventor:
Davenport & Quincy*

Hotchkiss

UNITED STATES PATENT OFFICE.

JOHN G. HOTCHKISS, OF NEW HAVEN, CONNECTICUT, AND JOHN A. DAVENPORT AND
JOHN W. QUINCY, OF NEW YORK, N. Y.

MAKING DOOR AND OTHER KNOBS OF ALL KINDS OF CLAY USED IN POTTERY AND OF
PORCELAIN.

Specification of Letters Patent No. 2,197, dated July 29, 1841.

To all whom it may concern:

Be it known that we, JOHN G. HOTCHKISS, of the city and county of New Haven and State of Connecticut, and JOHN A. DAVENPORT and JOHN W. QUINCY, both of the city, county, and State of New York, have invented an improved method of making knobs for locks, doors, cabinet-furniture, and for all other purposes for which wood and metal or other material knobs are used.

This improvement consists in making said knobs of potters' clay, such as is used in any species of pottery—also of porcelain.

The operation is the same as in pottery by molding, turning, burning and glazing. They may be plain, in surface and color, or ornamented to any degree in both. The modes of fitting them for their application to doors, locks, furniture and other uses, will be as various as the uses to which they may be applied, but chiefly predicated on one principle—that of having the cavity in which the screw or shank is inserted, by which they are fastened—largest at the

bottom of its depth, in form of a dovetail and a screw formed therein by pouring in metal in a fused state.

In the annexed drawing, A, represents a knob with a large screw inserted for drawers and similar purposes.

B represents a knob with a shank to pass through and receive a nut; C, the head of the knob calculated to receive a metallic neck; D, a knob, with a shank, calculated to receive a nut on the outside or front.

What we claim as our invention and desire to secure by Letters Patent is—

The manufacturing knobs as stated in the foregoing specification, of potters' clay or any kind of clay used in pottery, and shaped and finished by molding, turning, burning and glazing; and also of porcelain.

JOHN G. HOTCHKISS,
J. A. DAVENPORT,
JOHN W. QUINCY.

Witnesses:

ALPH. SHERMAN,
JAMES MONTGOMERY.

Hotchkiss

- At the time of the alleged invention, what items were in the prior art?
- A: Two relevant things were in the prior art:
 - Porcelain knobs.
 - The dovetailed structure for attaching a shank to knobs of metal or wood.
- What were the differences between the prior art and the invention as claimed in the patent?
- A: The combination of the two pieces of art above.

Hotchkiss

- If this were an obvious combination, why had it not yet been created?
- A: A full review of the record suggests that, while porcelain knobs were very old in the art, the dovetail structure had just been created (quite possibly from some innovator who lived in the neighboring town).

Hotchkiss

- What standard does the Hotchkiss articulate for determining whether an innovation is patentable?
- The Court holds that:
 - “[U]nless [there is proof of] more ingenuity and skill ... than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor.”
- Is this different from an “obviousness” standard?

Establishing a Prima Facie Case of Obviousness (Graham Analysis)

- (A) determine the scope and contents of the prior art;
- (B) ascertain the differences between the prior art and the claims in issue;
- (C) determine the level of ordinary skill in the pertinent art;
and
- (D) evaluate any evidence of secondary considerations.

Chapter 7

Infringement

Statutory Provision: 271

- The basic statute on infringement provides:

§ 271. Infringement of Patent.

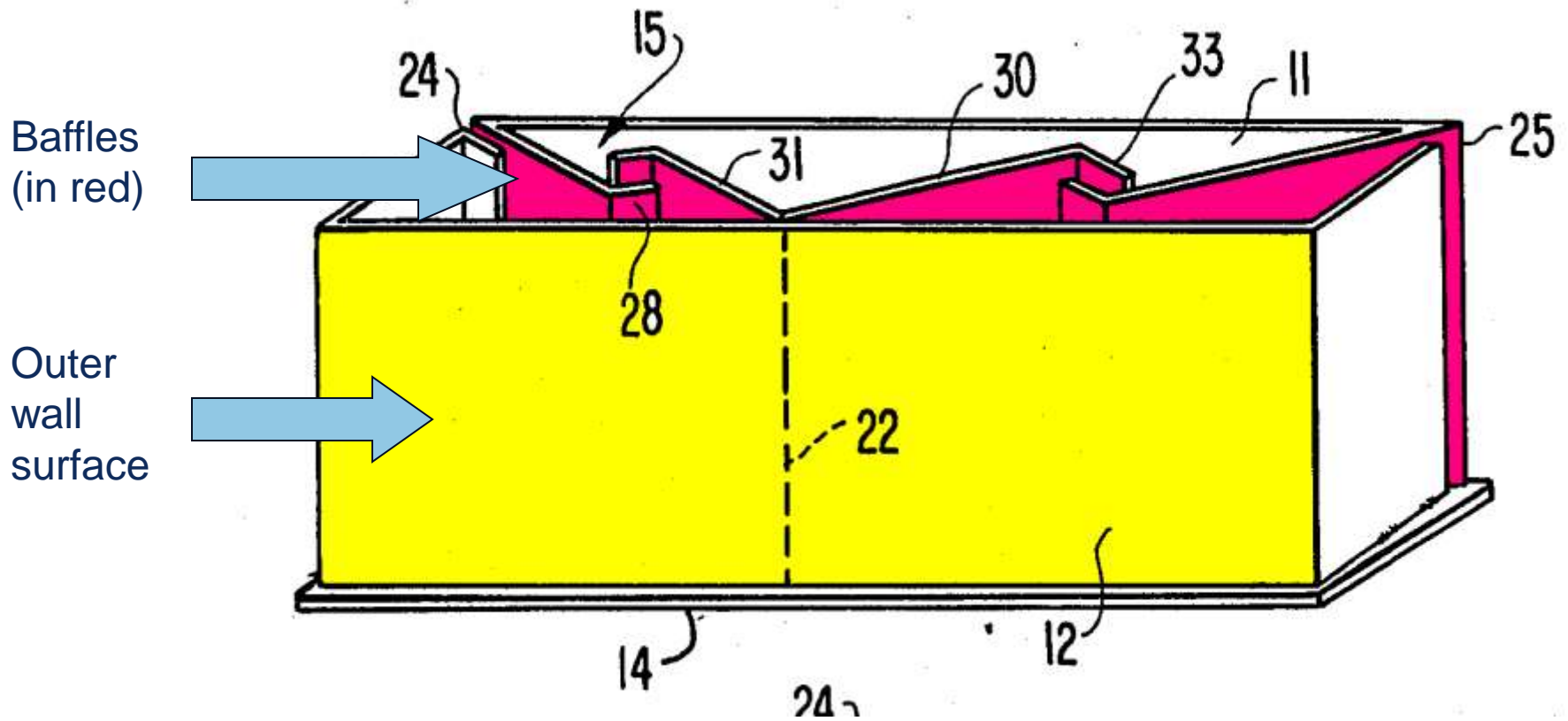
(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

- The statute precludes the making, using, etc. of the “patent invention,” but it does not say how a court should define the “patented invention” for purposes of infringement.

Phillips v. AWH Corp.

- The patented invention is an allegedly innovative type of wall with “internal steel baffles.” The wall is designed to be used in jails and other high security areas.
- The specification of the patent shows steel baffles set at angle between the inner and outer wall faces (see next slide).
- The steel baffles are designed to prevent things (e.g., bullets) from passing through the walls (see slide after next).
- The accused structure included steel structures running perpendicular to the wall faces.

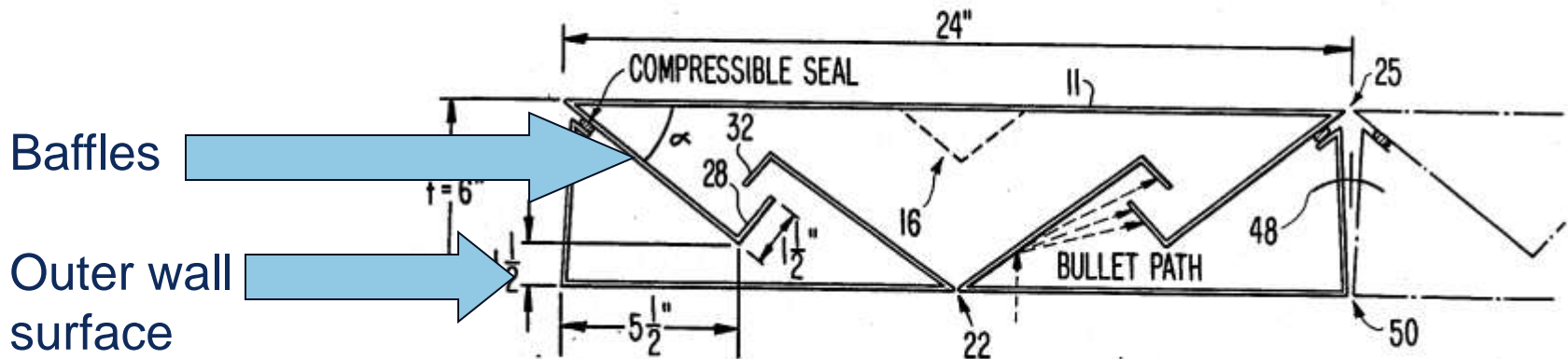
Phillips v. AWH Corp.



Phillips v. AWH Corp.

TOP VIEW OF PATENTED WALL

FIG. 6.



Baffles

Outer wall
surface

Phillips

- Otherwise the court merely reaffirms lots of its old case law about interpreting claims:
 - (1) Claims have primary importance in infringement analysis.
 - (2) Courts should also consider
 - the specification,
 - the prosecution history, and
 - extrinsic evidence (if any).
- The court then turns to applying these principles to the case.

Remedies: Damages and Injunctions

- Both damages and injunctions are available remedies for infringement.
 - Patent damages is a complex field. Parties typically hire expert economists to testify as to the precise measure of damages.
 - Injunctive relief is a matter for the trial judge to decide and is governed to a greater extent by legal considerations.

Remedies: Injunctions and eBay

- Historically, injunctive relief has been the rule, and denials of injunctions the exception.
 - Justification: Patents are supposed to be “property” rights and, generally speaking, property rights are usually enforced with injunctions.
 - Also, if injunctions are denied, courts must set a rate for future “damages” and that process is a form of government price regulation. (The granting of a compulsory license under a royalty rate fixed by the government is another example of price regulation.).
- In the eBay case, the Supreme Court reconsidered this historical practice. By and large, the decision leaves open the most fundamental questions, but does permit greater flexibility to deny injunctions.

Remedies: Injunctions and eBay

- Example of a quintessential case in which an injunction is most likely to be granted:
 - Patentee and infringer are direct competitors in the marketplace;
 - The validity of the patent and the infringement of the patent right are relatively clear.
- Example of a quintessential case in which an injunction is most likely to be granted:
 - Patentee merely licenses the right;
 - Patented component is a small part of a larger product that cannot be easily changed; and
 - The validity of the patent and the infringement of the patent right are uncertain.

Inequitable Conduct

- The doctrine, which is based largely on lower court law, permits courts to hold patent unenforceable (not invalid) where the patent applicant:
 - (i) failed to disclose material evidence to the PTO and
 - (ii) acted with an intent to deceive the PTO.
- Intent and materiality are “balanced.”
- There is no statutory basis for this doctrine; it has a weak basis in Supreme Court precedent; and it is not consistent with how courts treat similar issue in other areas of administrative law.

Chapter 8

Comparing Korean and U.S. Patent Laws

Court System: U.S.

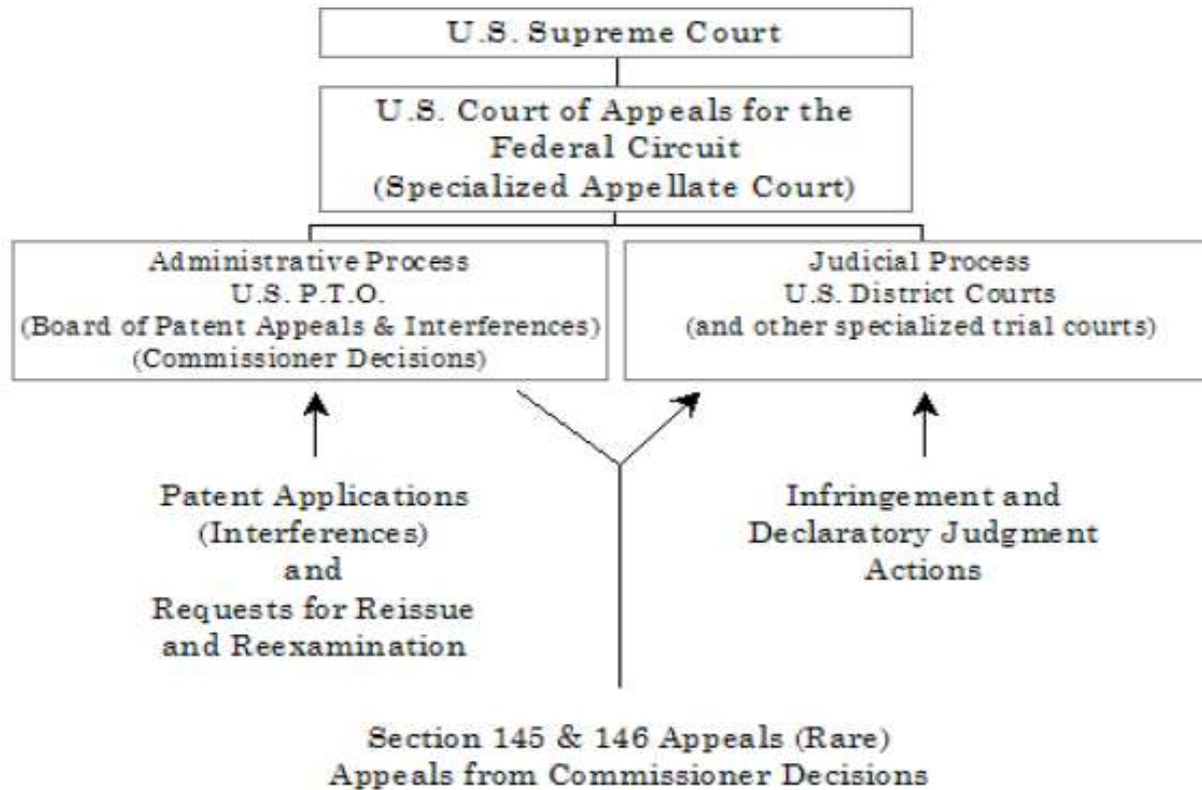
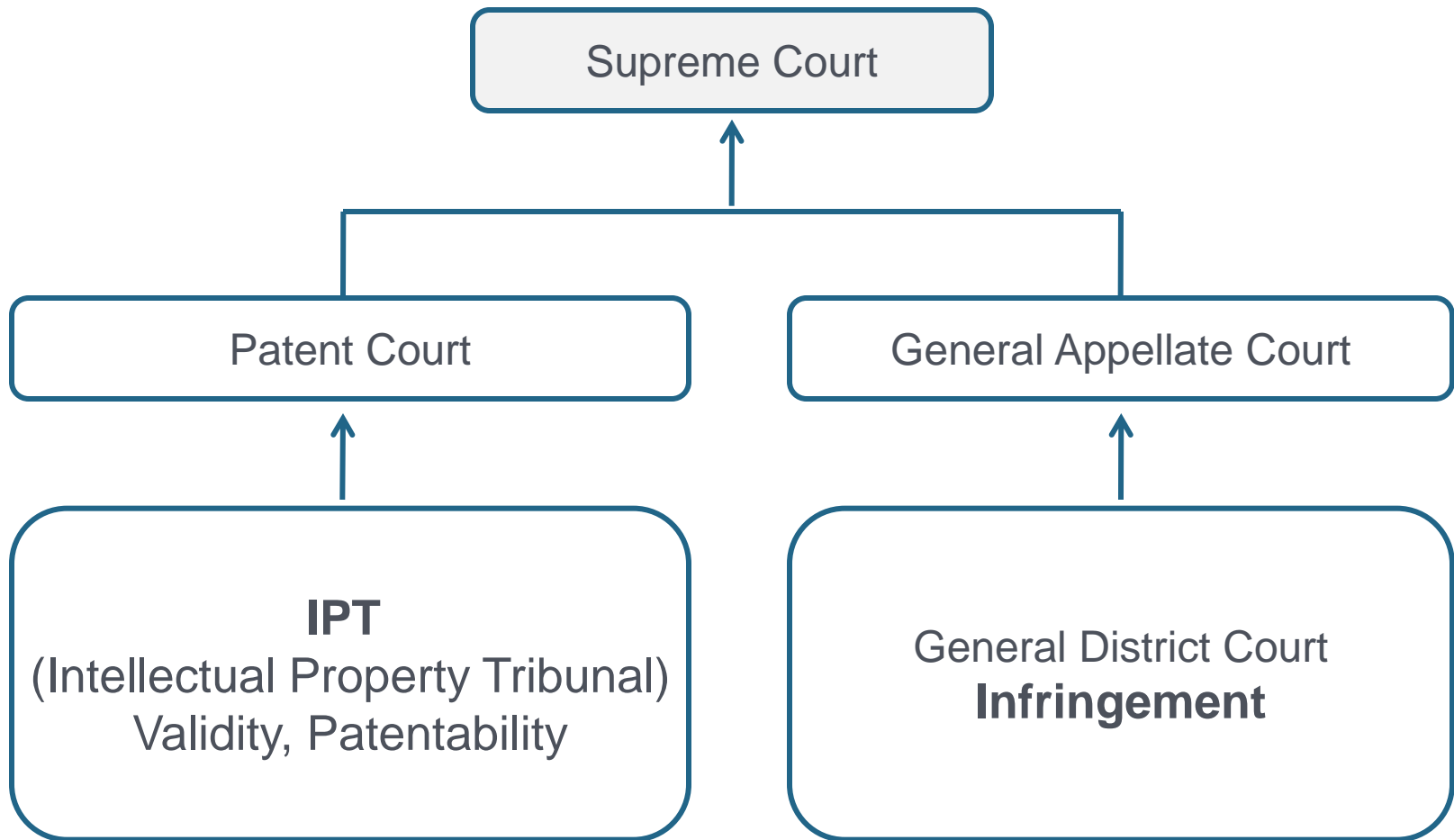


Figure 1-5 The Legal Process of the U.S. Patent System

Court System: Korea



Types of Patents

U.S.	KOREA
Utility Patent	Utility Patent Utility Model (Petty Patent)
Plant Patent	Plant Patent
Design Patent (Boat Hull Act (2005); Fashion Design Act (3 years) proposed to amend CR Act – not passed)	Design Patent

First-to-File v. First-to-Invent

- Priority Rule – 35 U.S.C. 102(g)
 - The first to reduce the invention to practice
 - Filing a valid application constitutes a constructive reduction to practice and a provisional application counts as a constructive reduction to practice.

First-to-File v. First-to-Invent

- Priority Rule – 35 U.S.C. 102(g)
 - The first to conceive may prevail over the first to reduce to practice if the first to conceive was diligent from a time prior to the other inventor's conception through to his/her own reduction to practice (either actual or constructive).
 - Thus, it is implied that the first to conceive and first to reduce to practice always wins without regard to diligence.

First-to-File v. First-to-Invent

- Priority Rule – 35 U.S.C. 102(g)
 - Any reduction to practice that has been “abandoned, suppressed, or concealed” is disregarded.
 - Interference proceeding: Board of Appeals and Interferences in the USPTO

First-to-File v. First-to-Invent

What if two parties file on the same day and neither are able to prove a date of conception?

- U.S.: Neither party gets the patent.
- Korea: KIPO orders them to reach an agreement. If not agreed, no party is awarded the patent.

First-to-File v. First-to-Invent

International Harmonization of Patent Law

- Territorial Limitations
- Trade is Global
- Paris Convention (1883): one-year-rule of priority
- PCT (Patent Cooperation Treaty, 1978): established an international application process
 - International phase and national phase

First-to-File v. First-to-Invent

International Harmonization of Patent Law

- EPC (European Patent Convention): EPO
- TRIPs (Trade Related Aspects of Intellectual Property): restructuring of dispute settlement rules to make decisions binding on all states and to authorize the use of retaliatory sanctions....
- SPLT (Substantive Patent Law Treaty)
- Mutual reciprocity for patents (U.S., EU, Japan)

First-to-File v. First-to-Invent

Fairness and Efficiency Consideration

- Is the first-to-file system is less fair because a true inventor may lose his entitlement on the patent?
- Purpose of patent law – progress of useful art, incentives for inventors?

First-to-File v. First-to-Invent

Fairness and Efficiency Consideration

- What if an inventor who first reduced an invention into practice and uses it without filing the application, should the inventor stop using the invention if someone files a patent application on the same invention?
- Compulsory nonexclusive license by prior use (Korean Patent Act)

First-to-File v. First-to-Invent

Fairness and Efficiency Consideration

- Does it disfavor small and individual inventors against larger corporations and business groups?
- Screening time to consider the marketability of the patent?
- In Korea, the Patent Act allows to amend applications, but does not allow to add a new matter just like the U.S. patent law.
- In Korea, Request of examination of a patent application within five years from application.
- First-to-Invent: there is an advantage to filing early to get the benefit of the presumption of prior invention.

First-to-File v. First-to-Invent

Fairness and Efficiency Consideration

- Administrative efficiency?
(Interference vs. Grace period (date of pre-filing activity, date of publication, experimental use, by the inventor) and Enablement-provisional application))
- Premature and incomplete technical disclosure in hastily-file application?

Information Disclosure Statement (IDS)

Before 1992, the standard was that disclosure was required “where there is substantial likelihood that a reasonable examiner would consider it in deciding whether to allow the application” – “Materiality” Standard

In 1992, disclosure is required if (a) the material establishes or contributes to a *prima facie* case of unpatentability, or (b) the information is inconsistent with a position or argument brought before the USPTO regarding patentability: Similar to “but for” test

Information Disclosure Statement (IDS)

Prima facie is interpreted in the following context: “giving each claim term its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability”

The CAFC continues to apply the old standard of materiality, so this should be the threshold for general practice – in general, erring on the side of disclosure is preferable to the consequences of a Rule 56 violation; this principle is endorsed by the USPTO (MPEP §2004(10)), and submission does not constitute an admission of materiality (37 CFR §1.97(h))

Provisional Patent Applications

Provisional patent applications allow inventors to initiate the patent process with a minimum of expense and effort.

- This mechanism has been available to foreign applications for a while, and was extended to U.S. applicants in 1994 for competitive equality under the General Agreement on Tariff and Trade (GATT)
- The filing fees are considerably smaller than for full nonprovisional applications, because provisionals are only examined for adequate filing requirements
- Provisional patent applications are only effective for utility patents, not plant or design patents
- Provisionals are kept secret unless a converted nonprovisional patent based on the provisional issues, in which case, the provisional becomes part of the file wrapper for the issued patent

Provisional Patent Applications

Requirements:

- a specification sufficient to satisfy 35 USC §112
- drawings where necessary to understand the invention, the filing fee
- the application *may optionally* include claims
- the application must cite inventors,
- the format of the specification is not required to follow the structure of a nonprovisional,
- information disclosure statements won't even be accepted

Provisional Patent Applications

Claims: A provisional does not require claims – however, filing at least one claim is advised, because it is uncertain whether foreign patent offices will recognize a priority claim back to a provisional application with no claims – the claim should be very narrowly drafted: if the broad provisional claim that is narrowed in the nonprovisional, this may trigger *Festo* and narrow the scope of the patent claims

Provisional Application

- Not be examined for patentability
- Abandoned 12 months after its filing date
- Non-provisional application claims the benefit of priority (but design patent cannot make a claim for priority)
- Request to convert a provisional to a non-provisional app.
- Kept in confidence
- Recommend against the use of prov. app. Except in circumstances where the applicant has insufficient financial resources and has allowed insufficient time to prepare a non-provisional app.

Continuation Application (CA)

- Not available in Korea
- Under 37 C.F.R. 1.53(b)
- An application whose specification is the same as that of the parent application, but whose claims are different from those of the parent application
- Entitled to the parent's filing date

Continuation Application (CA)

- Some claims were finally rejected in the parent, then those claims might be cancelled from the parent, allowing other claims to be issued. The cancelled claims may be then pursued, with or without change, in the CA.
- Apparatus claim, method claim
- Example: General rifle, Semi-automatic rifle, automatic rifle

Divisional Application

- A later application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or "division."
- A divisional application is often filed as a result of a restriction requirement made by the examiner.
- The divisional application must claim the benefit of the prior nonprovisional application under **35 U.S.C. 121** or **365(c)**.

Continuation-In-Part Application (CIP)

- An application that has some subject matter in common with the parent but also has new subject matter.
- If the applicant wished to add limitations to the parent claims to distinguish a reference, but the added limitations are not supported by the written description of the parent, and the examiner will not allow supporting material to be added to the written description because it introduces new matter.
- A CIP might also be filed if the applicant has improved the invention described in the parent.
- Example: Rifle

Continuing Prosecution Application (CPA)

- Under C.F.R. 1.53(d)
- While the parent is indeed abandoned, the application has the same number as its parent and no reference to the parent is inserted into the specification.
- CPA cannot be filed unless the parent is to be abandoned.
- All papers filed in the parent, except election in a divisional application, carry over into the new application.

Continuing Prosecution Application (CPA)

CA	CPA
New File is Created	Not Created
New Application No. is assigned	Not assigned
Cannot filed by Fax	Can be filed by Fax
Not automatically abandon parent	Automatically abandon
Must include a reference to the parent for domestic priority and must make a claim for foreign priority	Does not
Applicable	Not Applicable after July 14, 2003 - Utility and Plant (if filed, convert CPA to RCE) Applicable to design patent

Request for Continued Examination (RCE)

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee prior to the earliest of:

- (1) Payment of the issue fee;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal

(b) Prosecution in an application is closed:

- appeal
- a final action (§ 1.113),
- a notice of allowance (§ 1.311)

Request for Continued Examination (RCE)

(c) A submission as used in this section includes,

- (1) an information disclosure statement,
- (2) an amendment to the written description, claims, or drawings,
- (3) new arguments,
- (4) new evidence in support of patentability.

(d) If an applicant timely files a submission and fee, the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner.

Request for Continued Examination (RCE)

(e) The provisions of this section do not apply to:

- (1) A provisional application;
- (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
- (3) An international application filed under 35 U.S.C. 363 before June 8, 1995;
- (4) An application for a design patent; or
- (5) A patent under reexamination.



U.S. PATENT AND TRADEMARK OFFICE

The End

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