

# Proper Prosecution of a U.S. Utility Patent Application<sup>1</sup>

by David E. Rogers

## I. Introduction.

“Prosecution” of a patent application is the process by which an application moves through the United States Patent and Trademark Office (“USPTO”) after being filed. Prosecution is often a more lengthy and costly endeavor than preparing and filing the application. It culminates when an application either matures into a patent or is abandoned.

## II. What to Expect.

During prosecution, an application is reviewed by a USPTO Examiner, who is a government employee with a technical background pertinent to the invention. The Examiner issues written communications, called Office Actions, to the applicant or the applicant’s attorney. An Office Action usually includes, among other things, citations of prior art patents and patent applications, and arguments as to why the claimed invention is not patentable. Most patent applications are rejected in their entirety in the first Office Action, and often on multiple grounds.

After receiving an Office Action the applicant or the applicant’s attorney typically file a “Response.” The average number of Office Actions and Responses during prosecution of a patent application is about four. But, do not be surprised if there are five or more, or an appeal or one or more continuation/divisional applications is required, to obtain the full inventive scope to which an application is entitled.

## III. What to Do.

Creating a valuable patent is the goal. Prosecution takes as much thought, diligence, and care as preparing the patent application. If not done properly, the broad scope you envisioned and incorporated into the patent application could be forfeited. Careless prosecution, or capitulation to an Examiner to merely obtain a patent, may spell disaster.

Sometimes obtaining broad scope is best done in steps, by taking allowable subject matter, obtaining a patent for it, and then filing one or more continuation applications and/or divisional applications to pursue additional subject matter.

## IV. What Not to Do.

Prosecution is not, as some patent practitioners believe, a “negotiation” with an Examiner. Nor is it an exercise in merely pushing a patent, regardless of value, through the USPTO. Do not unnecessarily narrow claims to placate an Examiner, and leave valuable subject matter behind to provide competitors design-around opportunities. Do not limit claims to only the exact embodiment you plan to sell or manufacture. Some estimate that over 90% of U.S. patents have zero value.<sup>2</sup> Short-sighted, down-and-dirty prosecution is one reason.

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<sup>1</sup> This article is for educational purposes and does not constitute legal advice. It represents current, general opinions of the author, and not of his law firm or colleagues.

<sup>2</sup> See Jackie Hutter, *Strategic Patenting Part 1: Why So Few Patents Create Real Value* (Jan. 24, 2014) (only about 5% of the patents obtained by the top patent filers have any value; when patents matter they matter a lot . . . the skill of the patent attorney must be better than average).

## V. Be Organized and Thorough.

All responses to an Office Action should be carefully prepared, well organized, simple to understand, and begin to place the application in condition for appeal, if appeal should become necessary. Some practice tips:

- Use headings and sub-headings to organize arguments and make Responses easy to read.
- Address each limitation not found in the cited prior art.
- Argue patentability on a claim-by-claim basis if one or more dependent claims include non-obvious limitations that are not in an independent claim.
- For obviousness rejections, do not automatically concede that the Examiner's proposed combination is proper. Explain why there is no motivation to combine disparate prior art references. Look for teaching-away positions in the prior art.
- Prosecution is a legal exercise. Cite current case law if the Examiner's legal position is incorrect.
- Be certain that the literal scope of the pending claims is commensurate with the arguments presented for patentability.
- If relevant, use annotated drawing figures to plainly distinguish the structures of an embodiment of the invention from the cited prior art.
- Enter any necessary evidence, such as declarations under 35 CFR § 1.132, in favor of patentability. The evidence should distinguish the invention as recited in the claims from the prior art cited by the Examiner. If the Examiner has established a prima facie case of obviousness, the burden falls on the applicant to explain why the claimed invention is not obvious. Attorney argument is not evidence.
- A conference (called an "interview") between an applicant (or the applicant's attorney) and Examiner can sometimes advance the prosecution of a patent application by improving the understanding of specific issues. It is desirable that the attorney or applicant state in advance of the interview what issues will be discussed by submitting a written, proposed amendment and/or proposed topics of discussion. The interview may be in person or telephonic.

## VI. Conclusion.

Patent prosecution can be a lengthy endeavor that should be undertaken with care, and with the goal of obtaining valuable patent scope. Short-sighted, down-and-dirty prosecution may lead to a worthless patent.



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