

Stakeholder Training on Examination Practice and Procedure

From the USPTO

GORDEN IP LAW

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What is STEPP?

- ▶ Provides insight into how USPTO examiners are taught to examine your cases
- ▶ The program is based on the actual training provided to new examiners
- ▶ Taught by actual USPTO trainers and subject matter experts from the office
- ▶ Free of charge (complimentary). Except for happy hour

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The Role of a Patent Examiner

- ▶ What does an examiner do? USPTO perspective
- ▶ Review by senior examiners: who, what?
- ▶ Production: how much time does an examiner get?
- ▶ Docket Management: which case do they take up first?
- ▶ Stakeholder interaction: you might be surprised...

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Claim Interpretation

- ▶ Broadest Reasonable Interpretation. Not BPI
- ▶ Plain Meaning
- ▶ Functional Language
- ▶ Product by Process Claims

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35 USC 101, 112(a), and 112(b)

- ▶ Utility: 101 Utility Analysis - must make a “credible” claim
- ▶ Patent eligible subject matter under 101 (2019 PEG)
- ▶ 112(a) - Fully Supported and Enabled
- ▶ 112(b) - Definiteness

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Reading and Understanding and Application

- ▶ Informalities: title, abstract, specification, drawings, claims
- ▶ Reviewing the disclosure: it’s not their job to be a proofreader. Might go straight to the claims, but if they notice something they are supposed to bring it to our attention
- ▶ Claim analysis tools: tree, mapping (report)

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Planning a Search

- ▶ Good office actions use the best available art
- ▶ Tools: EAST, WEST, Non-Patent Literature
- ▶ Classification searching
- ▶ Generating a text search strategy

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Double Patenting and Restriction

- ▶ Statutory
- ▶ Non-statutory
- ▶ Restriction
- ▶ Serious burden
- ▶ Election

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35 USC 102 and 103

- ▶ AIA statutory framework and exceptions
- ▶ Unless the record is clear that an exception applies the examiner must make a rejection
- ▶ If the applicant says there is an exception, the examiner will generally accept it
- ▶ Analogous prior art (same field of endeavor reasonably, pertinent to the problem)

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Correction of Patents and the Central Reexam Unit (CRU)

- ▶ Certificates of Correction
- ▶ Reissue
- ▶ Ex parte reexamination
- ▶ Supplemental examination
- ▶ Inter Partes Reexamination

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Professional Responsibility and Practice before the USPTO

- ▶ Trademarks: local counsel rule
- ▶ Proposed annual active patent practitioner fee. CLE?
- ▶ OED Diversion
- ▶ Pro bono
- ▶ Discipline: 40 warning letters, 35 formal, 15-20 reciprocal

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The Patent Trial and Appeal Board (PTAB)

- ▶ Around 250 since 2015
- ▶ Alexandria and Four Regional Offices
- ▶ Appeals
- ▶ AIA Proceedings: IPR, PGR, CBM, Derivations (mostly IPR)
- ▶ Interferences

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Writing an Office Action and Responding to Applicant

- ▶ Will a room full of attorneys and agents all issue a first action allowance?
- ▶ Read the specification and claims
- ▶ Identify and apply the best prior art
- ▶ Write an Office Action

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Thank you!

- ▶ Sources:
- ▶ Materials from STEPP training in Miami Beach, January 2020
- ▶ USPTO website: <https://www.uspto.gov>



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