



Patent Filing: What to Expect During Patent Prosecution

After your patent application has been filed at one (or more) of the many Patent Offices around the world, it will be processed by that Patent Office. This is known as the patent “prosecution” process.

This Briefing provides an overview of what to expect. However there are many local differences to take into account. The law and practice that govern the details of the procedures followed by the Patent Office vary widely from country to country. The cost involved and the time taken to process applications also vary from country to country, and indeed from case to case.

Patent Formalities

The procedures followed in most countries involve a number of formal steps. Examples are the submission of various forms such as powers of attorney or assignment documents, the submission of a copy of your first patent application or the publishing of the application by the Patent Office.

In a large firm of patent attorneys, communications with a Patent Office relating to formal procedures are largely handled by a “formalities” function. The firm should notify the client of what is happening but, for most of the time, substantial technical input is unlikely to be required.

From time to time there may be papers which need signing, sometimes quite urgently. They may sometimes need signing in front of a witness or a notary public. Costs can be incurred, but these do not normally exceed a few hundred pounds, at least as long as the papers are signed and submitted promptly. Late submissions can substantially increase the costs.

Sometimes signatures are needed from the inventors. This can cause difficulties if you have lost contact with them, but the lack of a required signature can be very difficult and expensive to get around. It is therefore worth maintaining contact details for inventors who leave your company and keeping on good terms with them.

The Examination Process

Once the initial formalities have been completed, most Patent Offices in the world will pass the application to a technically qualified examiner, who will assess whether the invention as defined in your patent application satisfies the requirements for a patent to be granted.

In most cases this involves the examiner reading the application carefully and doing a prior art search to find out what has been done before in that area. The search can cover any type of prior art document, but most Patent Offices will search databases of previous patent applications and patents because these are well-indexed. Some Patent Offices will send you the results of the search as a simple list of documents known as a “Search Report”,

which is just for information. The examiners in some other Patent Offices, such as the US Patent Office and the European Patent Office, will also carefully assess whether the claims in your patent application are allowable in the light of the prior art, and send you a report setting out their views.

It is normal practice to draft claims initially to be quite broad. It is therefore quite normal for an examiner to object that the claims are too broad and do not sufficiently emphasise the differences between your invention and the prior art.

Some Patent Offices produce examination reports in relatively simple language. Other Patent Offices, such as the US Patent Office, use a lot of legal language which can make it difficult to distil the real technical point.

Your patent attorney will bring examination reports to your attention and seek your input on technical issues, including analysis of the prior art and what you regard as the significant differences between the prior art and your invention. The attorney will then amend the wording of the claims to reflect those differences and file a response to the examination report. Typically the response will argue against some aspects of the examiner’s objections and amend the claims to overcome other aspects of the objections.

Normally the Patent Office will set a deadline for response, typically of three or four months. The deadline can generally be extended, though in many countries this costs money. In the USA, for example, the fees for a three-month extension of time are well over one thousand dollars. Dealing with the matter promptly and sending your comments to the attorney in plenty of time can save a lot of unnecessary expense.

Clearly this examination process involves time and effort on your side in assessing what the examiner has found, considering whether you agree with him and deciding what to do about it. It also incurs costs because it involves your patent attorney’s time (and also involves a foreign attorney’s time if it is a foreign application). On the rare occasion that the objections raised by the examiner are relatively simple and can be dealt with swiftly, the costs might be only a few hundred pounds. More typically there is a lot of prior art to analyse and the claims require careful amendment to overcome the objections, with costs being in the region of a few thousand pounds.

There can be several rounds of correspondence with the examiner, each involving an examination report and response as above. The time between filing a response and hearing from the Patent Office is highly variable. It can range from a few months up to three years, depending on the workload in the Patent Office. It is usually possible to ask for the process to be accelerated if you want a quicker outcome.

There are still a few Patent Offices in the world that do not subject patent applications to a technical examination process. They will grant a patent without analysing it in detail. This is true, for example, in South Africa and France. As a consequence, obtaining patents in these countries tends to cost less, but the patents are regarded as more open to challenge because they have not been technically assessed.

Appeals

The overall aim is to reach an allowable form of the patent claims as a result of the response(s), but sometimes a stubborn objection is repeatedly maintained. In some Patent Offices, such as the European Patent Office, it may be necessary to attend an interview or formal hearing with the examiner to try to overcome such an objection. In other Patent Offices it may be more cost-effective to appeal to a higher level in the Patent Office. We can help you with advice on the options. Appeals are generally expensive, with costs running to thousands rather than hundreds of pounds.

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Grant of Your Patent

Once the examination process has been completed and the examiner is happy that the text of the patent application correctly defines the invention in comparison with the prior art, another formal set of processes starts which lead to grant of your patent. These may involve the issuing of a notice of allowance setting out the basis on which the patent is to be granted. Sometime further formal papers need to be submitted. For example, at the European Patent Office it is necessary to pay grant and printing fees and submit translations of the claims into French and German. At the US Patent Office it is necessary to pay the issue fee. In such Patent Offices, the costs incurred at this stage can again be several thousand pounds.

Completion of the Process

On completion of all of the processes required by the relevant Patent Office, your patent will be granted. You will receive a patent certificate and, normally, a copy of the granted patent.

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