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The Patent Examination Process (Part 1 of a 2 Part Series)

To obtain a patent, an inventor must first file a non-provisional patent application with the U.S. Patent & Trademark Office (USPTO). A proper application must contain:

- (1) a description of the invention,
- (2) at least one claim, and
- (3) a drawing (if necessary to understand the invention).

After filing, the application is assigned for examination to the respective examining technology centers (TC) responsible for the areas of technology related to the invention.

The examination process consists of an initial review of the entire application for compliance with the formal legal requirements (e.g., filing fees, inventor declarations, priority claims, etc.). Next, the examination focuses on the claims of the patent because the claims ultimately define the property rights of the inventor. During this substantive part of the examination, a patent examiner will conduct a prior art search through issued U.S. patents, published patent applications, foreign patent documents, and any available literature, to see if the claimed invention is (1) *new*, (2) *useful* and (3) *non-obvious*.

Claim Example & Formal Requirements

The following is an example of a patent claim for a pencil with an eraser.

1. **A pencil, comprising:**
 - a *cylindrical lead*;
 - a *wooden body* surrounding said cylindrical lead, said wooden body having a first end and a second end; and
 - an *eraser* secured to said second end.

The claim includes a **preamble (bold)** that sets forth the environment of the invention and **elements (italicized)** that define the invention. As you can see, each element must be **interrelated or connected (underlined)** to satisfy the formal claim requirements.

Substantive Examination

The *usefulness* requirement is typically easily met, so examination primarily focuses on whether the invention is *new* and *non-obvious*. For this example, assume during examination the examiner identifies a first reference describing a pencil with a cylindrical lead surrounded by a wooden body and a second reference describing an eraser for erasing pencil markings.

Is the invention new in view of these references? Yes. Neither reference by itself teaches each and every element of the claim. Therefore, the examiner cannot reject the claim on the basis that it is not new (such rejections are referred to as ‘Anticipation Rejections’).

Is the invention non-obvious? The examiner will argue that it would be obvious for a person of ordinary skill in the art to combine the two references to “teach” each and every element of the claim. To overcome this rejection, the inventor can (1) argue against the propriety of the obviousness rejection, or (2) amend the claim to overcome the rejection. The next installment in this series will discuss such amendments and their ramification on infringers.

The UH Center for Clinical Research and Technology (CCRT) Office of Technology Management is available to assist with these and other matters related to patent applications.

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