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How to think like a patent examiner

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Learning outcomes

At the end of this session, you will be able to:

- Understand the role of a patent examiner.
- Understand the responsibilities of an examiner in the examination of a patent application.
- Recognize what a patent examiner can and cannot do.
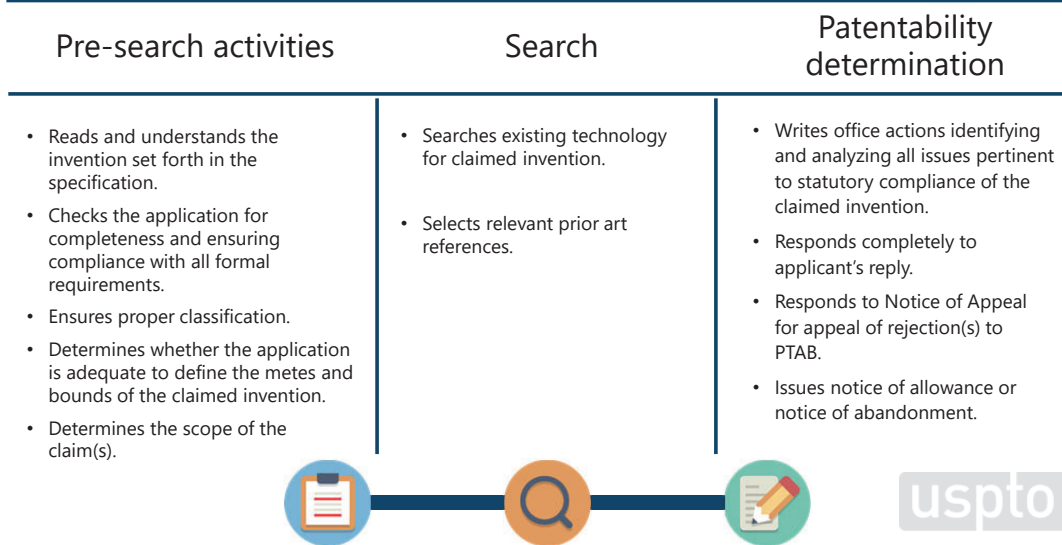
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Role of patent examiner

- To serve as advocate/protector of the public interest with respect to intellectual property.
- To provide direct service and assistance to customers from inside and outside the USPTO.
- To evaluate patentability with respect to invention(s) claimed in a patent application under the conditions for patentability set forth in Title 35 of the United States Code.
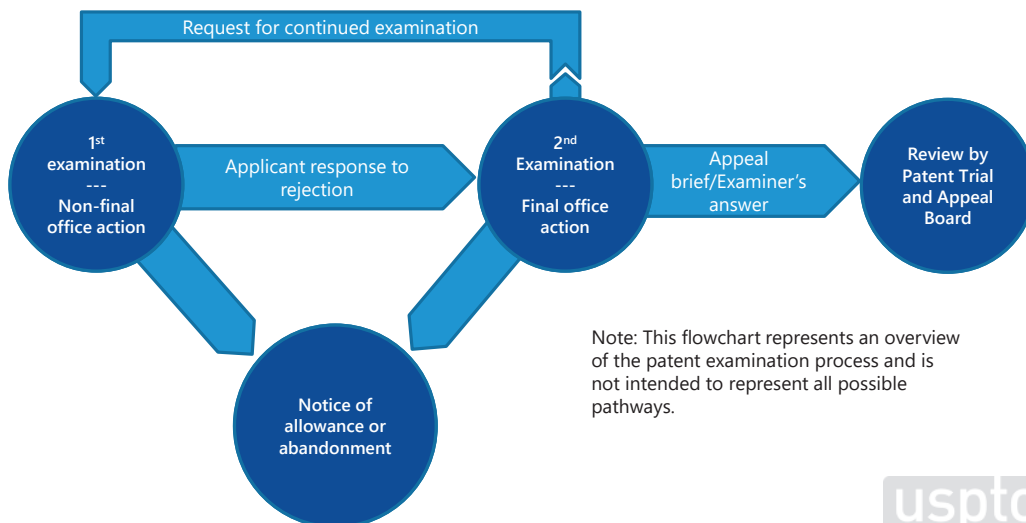
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Patent examiner responsibilities

Pre-search activities	Search	Patentability determination
• Reads and understands the invention set forth in the specification. • Checks the application for completeness and ensuring compliance with all formal requirements. • Ensures proper classification. • Determines whether the application is adequate to define the metes and bounds of the claimed invention. • Determines the scope of the claim(s).	• Searches existing technology for claimed invention. • Selects relevant prior art references.	• Writes office actions identifying and analyzing all issues pertinent to statutory compliance of the claimed invention. • Responds completely to applicant's reply. • Responds to Notice of Appeal for appeal of rejection(s) to PTAB. • Issues notice of allowance or notice of abandonment.

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Overview of patent examination process

Request for continued examination

1st examination --- Non-final office action

Applicant response to rejection

2nd Examination --- Final office action

Appeal brief/Examiner's answer

Review by Patent Trial and Appeal Board

Notice of allowance or abandonment

Note: This flowchart represents an overview of the patent examination process and is not intended to represent all possible pathways.

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Title search: How to Think Like a Patent Examiner

Also available as part of the eCourse
How to Think Like a Patent Examiner

First appeared as part of the conference materials for the
16th Annual Advanced Patent Law Institute session
"How to Think Like an Examiner"