


Abel+Imray

# US patent law and practice for FD1

Simon Haslam  
Of Counsel




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## Background

- + Chemistry degree, chemistry/physics PhD
- + Entered profession 1998
- + Qualified UK 2001, EP 2004 (IIRC)
- + Lots of experience of US practice
- + CIPA FD1 tutor
- + CIPA FD1 mentor
- + Run in-house tutorials for FD1



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## Introduction

- + Three parts
  - Similarities between US, EP and GB practice;
  - US practice for FD1; and
  - Tips on US practice for the “day job”

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## “England and America are two countries separated by one language”

- + There are many similarities between US, EP and GB practice
- + Applications are examined to see if a patent should be granted
- + Claims have to be novel and non-obvious over the prior art
- + Clarity, sufficiency, unity and excluded subject matter all assessed
- + Now, first-to-file in US, EP and GB
- + Patents are exclusive rights in the US, EP and GB

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**“England and America are two countries separated by one language”**

- + But there are some key differences, some of which are regularly examined in FD1
  - Grace period
  - Continuations and CIPs
  - Provisional applications

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**“England and America are two countries separated by one language”**

- + Why do these come up?
  - Because they are easily examinable and because they come-up in real life

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## FD1 subject matter

### + Grace period

#### – Things to watch out for

- If the applicant files an application within the grace period after disclosing the invention, then the disclosure cannot be used to attack the patentability of the patent application
- In the US, the grace period is 12 months before the “effective filing date”

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## FD1 subject matter

### + Grace period

#### – Things to watch out for

- The “effective filing date” can be a priority date claimed from a foreign application (for applications having an effective filing date after 15 March 2013)
- If the effective filing date is on or before 15 March 2013, then the effective filing date is the filing date of the US application (unlikely to come up in the exam now)

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## FD1 subject matter

### + Grace period

- Who made the disclosure?
  - Disclosures are discounted if they were made by the inventor/applicant, or by someone who obtained the disclosed subject matter (either directly or indirectly) from the inventor/applicant
  - Third party disclosures that were not based on information obtained from the inventor/applicant are not discounted

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## FD1 subject matter

### + Grace period

- Rules are actually quite complex (see USPTO website), but complex cases not likely to come-up in FD1 exam

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## FD1 subject matter

- + Continuation
  - What is a continuation application?
  - Patent application filed while earlier application pending to pursue additional claims to an invention disclosed in an earlier application
  - No valid priority claim from a continuation because not the first application in accordance with the Paris Convention

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## FD1 subject matter

- Paris Convention Art. 4 (c) (2) and (4)
- These [priority] periods shall start from the date of filing of the first application; the day of filing shall not be included in the period
- A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

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## FD1 subject matter

### + CIP

- What is a CIP?
- Continuation in part
  - US application with a substantial portion of the parent application plus extra subject matter
  - Parent application must be pending to file CIP
  - Claims benefit of parent application for common subject matter – added subject matter has filing date of CIP

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## FD1 subject matter

### + CIP

- Problems in GB and EP arising from CIP...and it all comes down to the Paris Convention which you will come to know and love (well, maybe)

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## FD1 subject matter

### + CIP

- PC Art. 4(c)(4) designed to stop “rolling priority”
- Problem with a CIP?
  - Parent has to be pending when the CIP is filed
  - CIP will therefore not be the “first application” for the subject matter disclosed in the parent, so priority claim will not be valid for subject matter of parent

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## FD1 subject matter

### + CIP

- Priority claim may be good for subject matter added when CIP is filed
- Let’s look at an example and what you need to write in an exam answer

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## FD1 TYPE QUESTION

- + EP was filed in July 2010 and claims priority from USA3.
- + EP has four claims:
- + 1. A chest expander comprising two handles coupled to a spring mechanism configured to inhibit relative movement of the two handles.
- + 2. A chest expander according to claim 1 wherein the spring mechanism comprises a coil spring.
- + 3. A chest expander according to claim 1 wherein the spring mechanism comprises a leaf spring.
- + 4. A chest expander according to claim 1 wherein the spring mechanism comprises resilient elastomeric material.

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## FD1 TYPE QUESTION

- + USA3 is a CIP of USA2, which is a CIP of USA1. All applications were filed in the name of BuffedOne Inc
- + USA1 was filed in December 2008 and published in June 2010.
- + USA2 was filed in February 2009.
- + USA3 was filed in April 2010.
- + USA1 describes and claims a chest expander with a coil spring.
- + USA2 includes the description and claims of USA1, plus a generic description of a chest expander with a spring mechanism, and of a chest expander with a leaf spring. There are claims to the general chest expander and to the chest expander with a leaf spring and with a coil spring.
- + USA3 includes the description and claims of USA2, plus a description and a claim to a chest expander with a resilient elastomeric material.
- + Discuss the patentability of claims 1 to 4 of EP.

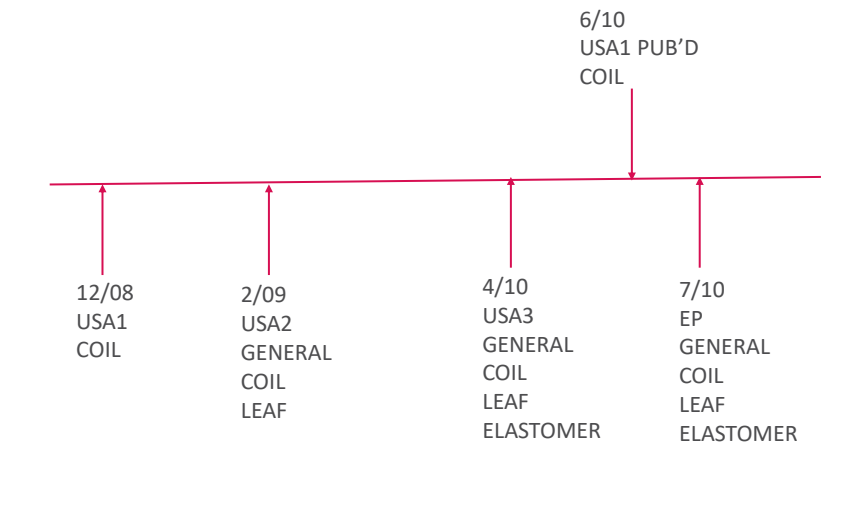
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## FD1 TYPE QUESTION



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## MAIN POINTS IN ANSWER

- + USA2 and USA3 are CIPS
- + CIPS can only be filed if preceding application is still pending
- + USA3 not first application for the point of view of a priority claim for subject matter of claims 1-3
- + Priority claim for claims 1-3 invalid
- + Subject matter of claim 4 first disclosed in USA3, so priority claim valid
- + Effective date of claims 1-3 is July 2010
- + Effective date of claim 4 is April 2010

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## MAIN POINTS IN ANSWER

- + USA1 is prior art for novelty and inventive step against claims 1 to 3
- + USA2 is unpublished before effective date and is therefore not citable
- + USA1 is not an EP application and therefore is not citable under A54(3) EPC
- + Claim 1 of EP lacks novelty over USA1 (specific destroys novelty of generic)
- + Claim 2 of EP lacks novelty over USA1 (specific embodiments the same in USA1 and EP)

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## MAIN POINTS IN ANSWER

- + Claim 3 is novel but is the use of a leaf spring obvious over the use of coil spring?
  - + Claim 4 novel and inventive – no disclosure of the use of any spring before the priority date of claim 4
- + 14 MARKS!!

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## TAKEAWAYS

- + This CIPs issue does not come up often, but when it does it's big marks
- + Use a timeline
- + Work logically through the question, writing down all of your deductions/thoughts – write down the obvious
- + Use all of the information

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## FD1 subject matter

- + The provisional application
  - Things to watch out for
    - Cannot itself lead to a granted US patent (need to file utility application claiming the benefit of the provisional)
    - Often very scanty and light on information (valid priority claim?)
    - Often filed in the inventor's name (valid priority claim?)
      - Assignment? Edwards v Cook

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“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5

- + It’s a “pay and play” system
  - You can have as many rounds of examination as you want, so long as you keep filing the Requests for Continued Examination
  - You could go round and round and round in writing for years...

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“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5

- + It’s a “pay and play” system
  - Useful for the US attorney to have an interview with the examiner
    - Often get to the bottom an examiner’s objections – especially useful if the written objections look odd

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“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5

- + It’s a “pay and play” system
  - Use continuations if you want something granted quickly
    - Get something narrow granted quickly, and then file a continuation
    - Independent claims of different scope can be a useful way to achieve this (US practice allows multiple independent claims)

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“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5

- + It’s a “pay and play” system
  - USPTO examination process is unpredictable; never say never with the USPTO
  - US attorneys may be able to provide some information re examiner behaviour

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**“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5**

- + Added subject matter
  - You can be far more creative in the US when it comes to amendment
- + “Broadest reasonable interpretation”
  - Reasonable? Hmm...
- + Inventor Declarations
  - Can be far stronger than attorney arguments

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**“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5**

- + Non-obviousness
  - Teaching-suggestion-motivation often used, but not the only test
  - “Mosaicing” of lots of documents far more common than in EP or GB
  - Can lead to different outcomes compared to EPO Inventive Step or UKIPO Pozzoli

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“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5

+ Extensions

- Can be useful, but expensive and will be deducted from any PTA

+ Patent Term Adjustment

- Extra patent term due to the USPTO being slow – can be substantial
- Tardiness of the applicant will be penalised

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“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5

+ Small entity status

- SMEs, non-profits and unis can get reduced official fees by claiming small entity status
- BUT if you intentionally misclaim small entity status, your patent could be unenforceable
- Groups of companies

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**“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5**

- + Small entity status
  - If you mistakenly but honestly claim small entity status, don’t worry. You can pay the extra fees

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**“Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5**

- + Information Disclosure Statements
  - Obligation to disclose prior art cited against other (non-US) applications
  - Obligation up to issue date
  - Obligation on all people connected to patent – ensure that clients know
  - File IDS docs ASAP
  - What happens if do not conform

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## “Tumble outta bed and I stumble to the kitchen” – back to the 9-to-5

- + USPTO examiners like structure, not function
- + Use multiple independent claims in same application to secure protection in the US

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## Abel+Imray

**London**  
20 St. Andrew Street  
EC4A 3AG, UK  
T 020 7242 9984  
F 020 7242 9989

**Cardiff**  
3 Assembly Square  
Britannia Quay  
CF10 4PL, UK  
T 029 2089 4200  
F 029 2089 4201

**Bath**  
Westpoint Building  
James Street West  
BA1 2DA, UK  
T 01225 469 914  
F 01225 338 098

**Delft**  
Crommelinplein 1  
2627BM Delft  
The Netherlands  
T +31 (0) 15 8080 194  
F +31 (0) 15 8080 195

**Ribadeo, Spain**  
Avda. Rafael Fernandez Cardoso  
20-22  
Bajo 1  
Local 7 27700 Ribadeo  
Lugo  
Spain  
[www.abelimray.com](http://www.abelimray.com)

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