

The Examination

Patent Examiner reviews contents of the application for compliance with all U.S. patent legal requirements.

"An applicant is entitled to a patent unless..." * The requirements of U.S. patent law are not met. *(35 USC §102)*

The burden is on the examiner to show if a patent is not warranted.

 An illustration of a woman with dark hair tied back, wearing a purple long-sleeved shirt and a green office chair. She is sitting at a desk, looking at a computer monitor that displays a blue screen with some graphical elements. Her hands are on the keyboard.


What is the 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 U.S. Patent & Trademark Office
- To serve as a judge on 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



What May an Examiner Do?

- Advise on the advantages of, and appropriate classification fields for, a pre-examination search
- Assist the public in conducting a search, short of rendering patentability advice or opinion as to whether an application should be filed
- Advise on advantages of securing services of a competent patent attorney or agent
- Provide a listing of registered attorneys and agents
- Advise on Office fees and Office procedures in general



What Does a Patent Examiner Do?

- Reads and understands the invention set forth in the specification
- 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
- Determines patentability of the claimed invention



What Does a Patent Examiner Do? (cont.)

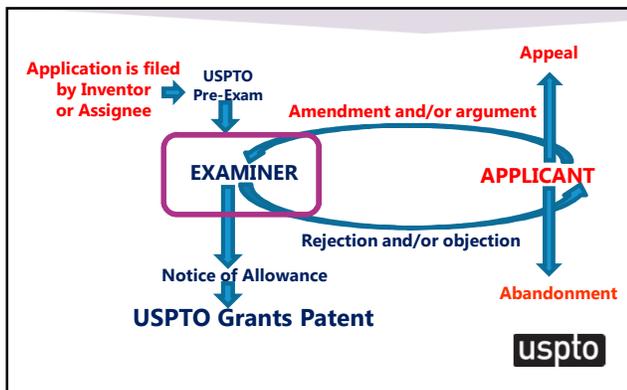
- Writes an Office Action which identifies and analyzes all issues in the application pertinent to patentability of the claimed invention
- Responds completely to Applicant's reply
- Issues Notice of Allowance, Notice of Abandonment, or an Examiner's Answer to Appeal
- Ensures that all pertinent procedural steps necessary for obtaining a patent are complied with during prosecution of an application



Examiner's Role

- Issue patents
 - Make appropriate objections
 - Make only reasonable rejections
 - Help the applicant identify allowable subject matter
- Act as an advocate for the public
 - Ensure development of a clear and complete file wrapper record







1. Quality

- This element evaluates the Examiner's abilities to formulate appropriate actions and/or recommendations with respect to the grant or denial of a patent application.
- Examiners are responsible for specific major activities in this element, which do increase with advancement in grade.
- This critical element basically evaluates all that the Examiner does in examining the patent application.



Quality Major Activities	Evaluation Level									
	GS 5	GS 7	GS 9	GS 11	GS 12	GS 13	GS 14/PA	GS 14/SA	GS 15	GS 16
(1) checking applications for (a) compliance with formal requirements of patent statutes and rules and (b) technological accuracy	1	1	1	1	1	1	1	1	1	1
(2) issuing rejections, objections and claims of novelty	1	1	1	1	1	1	1	1	1	1
(3) issuing decisions and claims for compliance with 35 USC 112	2	2	2	2	2	2	2	2	2	2
(4) issuing final actions	1	1	1	1	1	1	1	1	1	1
(6) making proper rejections under 35 USC 102 and 103 with supporting rationale or determining how claim is distinguish over the prior art	2	2	2	2	2	2	2	2	2	2
(7) determining whether amendment introduces new matter				2	2	2	2	2	2	2
(8) appropriately formulating restriction requirements, where application could be restricted				1	1	1	1	1	1	1
(9) determining whether claimed invention is in compliance with 35 USC 101				2	2	2	2	2	2	2
(10) evaluating prior art for obviousness										
(11) determining when appropriate line of patentable distinction is maintained between applications under review				1	1	1	1	1	1	1
(12) evaluating sufficiency of affidavit declarations				2	2	2	2	2	2	2
(13) evaluating sufficiency of claim amendments				2	2	2	2	2	2	2
(14) providing compact prosecution by including all reasonable grounds of rejection, objections, and formal requirements (M.P.P. 2017/14) etc.							1	1	1	1
(15) making the record, taken as a whole, reasonably clear and complete							1	1	1	1
(16) properly treats all matters of substance in applicant's response							1	1	1	1
(17) formulates and independently signs final determinations of patentability (final rejections, allowance, decisions concerning applicant's outcome)										
(18) properly closes prosecution; makes no premature final action								2	2	2
(19) properly rejects all rejectable claims in a final rejection; properly allows all claims in an allowance								3	3	3



Submitted for Review

GS Level	Submission Format	Review Process
5	Draft	Reviewed prior to mailing all actions
7		
9		
11	Final Form (except for advanced and legal functions)	Reviewed prior to mailing all actions
12	Final Form	Reviewed prior to mailing all actions
13		Non-Final Office actions reviewed following mailing and Final Office actions reviewed prior to mailing
13/14 Partial Signatory Authority		
14/15 Full Signatory Authority		Reviewed following 

Who Performs Reviews?

- **Junior Examiner (GS 5-13)**
 - The Supervisor
 - Office of Patent Quality Assurance (OPQA)
 - Primary Examiner (if applicable)
- **Primary Examiner (GS 14 & 15)**
 - The Supervisor
 - OPQA



2. Production

- **Production is simply the amount of work an examiner performs in a specified amount of examining time as compared to their Expectancy and Position Factor**
 - i.e. Each examiner has a specific amount of time to work through each application. The amount of time is calculated using the **Expectancy** of the particular application and the examiner's **Position Factor**
- **The Expectancy of an application is based on the complexity of the subject matter found in the application and has a considerable range**
- **An examiner's Position Factor is based on the examiner's experience level, also referred to as GS level or Grade.**



3. Docket Management

- Every application falls into one of five categories (Action Types)
- Each component within a category has its own "expected average days" for completion
- Each component receives a score based on when the examiner submits an action as compared to the expected average (e.g. submitting an action in 5 days when the expected average is 14 days yields a score above 100% while submitting the same action in 18 days yields a score below 100%)
- Each component score is then weight-averaged based on the sum of the number of actions in each of the five components to determine overall docket management performance



4. Stakeholder Interaction

The stakeholder interaction element is an objective measure of the ability to provide appropriate service to external customers in areas such as returning telephone calls, reviewing and responding to emails, utilizing voicemail systems to reflect work schedules and planned absences, and directing customers to the appropriate points of contact



Thank You

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