

INFORMATION SHEET

Filing and prosecuting a U.S. patent application

The following outlines the procedure for a typical U.S. patent application. Some applications require special handling and special circumstances that are outside of the scope of this outline. Please contact any of our offices to discuss the specific nature of your application.

Preparing and filing. Prior to undertaking the expense of a patent application, you may wish to search for relevant prior art (e.g., prior patents, publications, or products of your competitors), or you may engage us to conduct a search of the patent literature for relevant prior art. If, after any desired searches are completed, you wish to proceed, we prepare and forward a draft specification describing and claiming the invention. Once the language of the specification has been settled, filing forms are sent to you. After we receive the executed filing forms, we proceed with filing. As part of the application process, we will ask you to identify prior art that is relevant to the invention and is known to you. This step is necessary because an applicant for a U.S. patent has a duty to apprise the U.S. Patent and Trademark Office of all relevant prior art of which he or she is aware.

Receipt of filing certificate. The filing certificate follows approximately two to three months after filing.

Record of assignment. If an assignment was submitted on filing, a notice of recordation is received and recordal of the assignment is reported to you.

Publication. Unless, on filing, an applicant submits a statement that the application will not be filed outside of the United States, the U.S. application will be published. Publication occurs eighteen months from the earlier of the date of filing and the date of filing of an earlier application from which priority is claimed.

Divisional requirement or election of species requirement. After the filing certificate is generated, the application is passed to an Examiner. After reviewing the specification, it sometimes happens that the Examiner believes the application relates to more than one invention or more than one species (such that if you cannot maintain a broad claim covering all species, the Examiner will insist that you retain claims to only one species in the current application). If this is the Examiner's view, then the Examiner will, as a first step in the examination process, require you to pick one invention, or one species.

First Office Action on the merits. The Examiner conducts a search for relevant prior art and based on this, and a review of the specification, writes a report called an "Office Action," which raises any objections the Examiner may have to your application. When we receive this document, we must docket the same to ensure that a timely response is filed. Typically, the Examiner sets a three-month deadline to respond but several one-month extensions may be purchased, if necessary. We send the Action to you along with a letter providing a review of the Examiner's position and asking for instructions. Based on your instructions, we prepare and file a response, possibly after arranging a telephone interview with the Examiner.

Final Action. If the Examiner is not convinced by the arguments and any claim amendments presented in response to the first Office Action, the Examiner will normally issue a Final Action. If a Final Action is issued, the procedure is generally the same as with the first Office Action, namely, we docket, review and forward the Action and respond to the Action upon receipt of your instructions.

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Notice of Allowance. In rare cases, a Notice of Allowance is received as the next step after receiving the filing certificate.

More typically, however, we receive a Notice of Allowance after responding to one or more Office Actions. In response to the Notice of Allowance, it is necessary to submit issue and publication fees. Occasionally certain other formalizing steps are also necessary.

Maintenance fees. At three times during the life of the U.S. patent you must submit a maintenance fee. Such maintenance fees are due at three and one half years, seven and one half years and eleven and one half years after issue of the patent.