How Many of Those Patent Office Actions Should I Budget For?

This Patent Stuff and My Semiconductor Business – Part 19

Welcome to this post about patents and chips. Not a lot has been written about this combination, but there is a lot to know, especially for the innovators and entrepreneurs themselves. In this three-weekly series, I talk about various aspects, from my dual points of view of a patent agent and a semiconductor entrepreneur. If you like the article and read it on LinkedIn, give it a thumbs up, and/or click on Follow. If you like to work with us for your next patent, "contact us" info is on www.icswpatent.com. You can also subscribe/unsubscribe for short email alerts when the next post is available.

"Those Patent Office Actions", what are they? When you file your patent application, your patent office—in the US that would be the USPTO, the US Patent and Trademark Office—will do a prior art search, and examine if your application meets the legal requirements to be allowed. Patent practitioners, like me, who write and file the application for you, usually claim as much as we think we can get. Maybe a little bit more. Patent examiners, who work in the patent office, review our claims and push back. If they find an independent claim (a root of a hierarchical claim tree) to be too broad, they reject (or object to) all the claims in that tree. Often, you file an application with around 20 claims, and often, too, the examiner rejects them all because the base claims were just a little bit too broad. As an example, you claim you've invented a cake with a candle (too broad, they are very common at birthday parties), whereas what you really invented is a cake with a green zigzag candle. Filing your independent claim for a cake with a green candle is not going to work (they already exist), but narrowing your claim to a cake with a zigzag candle might be good. You can claim that the candle is green in a dependent claim, so that your broadest claim covers all cakes with zigzag candles, even if they're vermillion.

When the examiner decides to reject your claim for a cake with a candle, he or she will write you a letter that says that your claim and all its dependent claims have been rejected, because a cake with a candle is not new. This letter is called an Office Action. Hopefully, one of the dependent claims is not rejected, but only objected to, as being dependent on a rejected claim. You (or your patent practitioner) will have to reply to the Office Action in time, otherwise your application will be thrown out as "abandoned". Your practitioner writes a letter back to the examiner (a response to the office action) and changes ("amends") the claim to be for a cake with a zigzag candle. This makes the examiner happy, and he or she will allow the claim and its dependent claims, and if everything else is OK, will send you a "Notice of Allowance". This is of course a happy event, which you may celebrate with the cake!

Of course there are more reasons why a claim, or your description or drawings, may be rejected or objected to. And defending or amending your application is usually a whole lot more complicated than moving the zigzag limitation from a dependent

claim to the independent claim at the root of its tree. And it can take your practitioner a lot of time to get everything right. For example, take the Apple Foods Inc. company that filed a 100-page patent a year before your application, and darn it, it shows or suggests a cake with a zigzag candle! Now you need to find something in your application that you can use to narrow your cake with a candle claim, and it can't have been mentioned or suggested in the Apple patent. You will find that that can be a real headache. Why would a big company with a lot of money file a 100-page patent? It's a lot like the guy with the big muscles telling other guys not to touch or come near his girlfriend. It might get even more complicated if Samsam Consumer Foods Co. Ltd. had already patented a green cake with a candle. Now USPTO can take the Apple and Samsam patents together and reject your claim because it was "obvious" that, Samsam having a green cake and Apple having a cake with a zigzag candle, you would think of a cake with a green zigzag candle. You might argue that a green cake doesn't suggest a green candle, but the examiner may think differently.

So you understand why a response to an office action might set you back several thousands of dollars. But you still wonder how many of those you should expect. And rightly so. Apart from the attorney fees, the US Patent and Trademark Office will set you back, too. It charges you for every step along the way. There are filing fees, fees when you want to continue fighting after a second office action, issue fees, maintenance fees, and more. Patent offices in other countries and jurisdictions work in much the same way as USPTO.

The lame answer to how many office actions you should expect is, of course, that it depends. Essentially, it is out of control.

But the good news is that it is possible to make a reasonable prediction, based on experience. Hardware patent applications receive fewer office actions than software patent applications. A technology that is very mature may have a lot of prior art, that might bite you from behind. And a hot new technology of which all the big guys want the biggest slice of the cake can be very crowded. Something very similar to what you have, or exactly the same, might have been described in a patent application just months before you submitted yours. You may have to fight 100-page prior art stuff. The examiner might not understand how your invention is any different than the dozens that are out there already that deal with the same problem. It can get the most difficult if the examiner determines that what you described is new, but obvious when you read two or three older publications or patents in the same field (think about the cakes). Or when your description is not very clear because it was never fully explained to or understood by the person who wrote the patent application. In those cases, you may deal with multiple office actions.

For the hardware patent applications I write, I usually tell my customers that they should budget for two office actions. It is a reasonable expectation. When I feel my bladder I may propose that we do a prior art search first to limit the risk. For software patent applications, I tell new customers that they need to count on at least three or four, unless the invention is really detailed and special. The range that I've seen is anywhere from zero to six (oaw!) office actions. You may get that many office actions if you go with an as-many-patents-as-possible strategy and fight in a crowded market. It may also happen when somebody tries to get an overly broad patent in a mature technology, with a description that is vague and that has holes in it.

A well experienced patent practitioner should be able to give you the reasonable prediction that you need. Obviously, "well experienced" means well experienced in the technology that you're trying to get a patent for. If you look me in the eyes and you see that I'm excited about patenting your invention, you can expect a reasonably low number of office actions. Then again, somebody else might get excited when he sees a high number of office actions 😉.

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21. Why Are Patent Claims So Weird, Anyway?
22. Why China Is Important for My Chip Patent
23. Do I Really Need to Spend So Much Time to Get the Patent?
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