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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.



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).

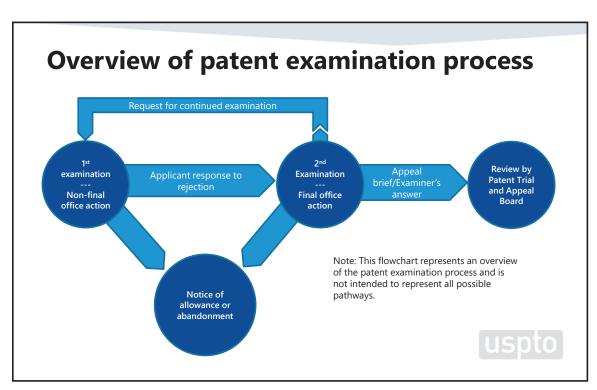
- Searches existing technology for claimed invention.
- Selects relevant prior art references.
- Writes office actions identifying and analyzing all issues pertinent to statutory compliance of the claimed invention.
- Responds completely to applicant's reply.
- Responds to Notice of Appeal for appeal of rejection(s) to PTAR
- Issues notice of allowance or notice of abandonment.







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Title search: How to Think Like a Patent Examiner

Also available as part of the eCourse 2021 Advanced Patent Law (USPTO) eConference

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