

## Chapter 2100 Patentability

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PATENTABILITY

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**-2102 [Reserved]****2103 Patent Examination Process [R-07.2015]****I. DETERMINE WHAT APPLICANT HAS INVENTED AND IS SEEKING TO PATENT**

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Prior to focusing on specific statutory requirements, USPTO personnel must begin examination by determining what, precisely, the applicant has invented and is seeking to patent, and how the claims relate to and define that invention. USPTO personnel will review the complete specification, including the detailed description of the invention, any specific embodiments that have been disclosed, the claims and any specific, substantial, and credible utilities that have been asserted for the invention.

After obtaining an understanding of what applicant invented, the examiner will conduct a search of the prior art and determine whether the invention as claimed complies with all statutory requirements.

**A. Identify and Understand Any Utility for the Invention**

The claimed invention as a whole must be useful. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter

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