



MPEP MiniReview

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Chapter 100 - Secrecy, Access, National Security, and Foreign Filing

1. Confidentiality of Patent Applications
 - a. General
 - i. Patent applications must be kept confidential, approved patents, however, are freely open to the public (unless they are under a secrecy order).
 - b. In order to maintain the confidential status of patent applications:
 - i. no information on the filing, status or subject matter of any patent application will be disclosed to the public.
 - ii. no access or copies of any application or patent application papers will be given to the public.
 - c. Exceptions to the confidential status of applications include:
 - i. when written authority from the applicant is gained by a member of the public -when the application is both abandoned and published
 - ii. the application cannot be in a file jacket of a pending application (meaning that no one is trying to continue patenting that particular invention)
 - iii. if it is deemed necessary by the Commissioner
 - iv. when the material of the application is incorporated by reference in a U.S. patent
2. Information as to Status of an Application
 - a. There are 3 major types of patent status:
 - i. pending,
 - ii. abandoned, or
 - iii. issued.
 - b. No information is disclosed concerning the status of an application, including:
 - i. whether the application is pending, abandoned or patented
 - ii. the application number and filing date
 - iii. whether one or more applicants claim the benefit of the filing date
 - iv. whether the application claims the benefit of the application for which status information is requested
 - c. A person requesting status information may be provided the filing date of an application if at least the last 6 digits of the numerical identifier are available
 - d. How to determine the status of an application:
 - i. an individual must obtain access from the applicant
 - ii. they must send a request to the applicant identifying the application's serial number and filing date
 - iii. in addition, the patent must be in the national phase
 - a. the status of international applications is always kept confidential
 - e. The status of a parent application is disclosed only when the status of any pending continuation, CIP or divisional application derived from it is also disclosed
 - f. If a redacted copy of the application was used for patent application publications, the copy of the specification, drawings and papers may be limited to a redacted copy
 - g. Status information is available for an application if:
 - i. the application is referred to by its numerical identifier in a published patent document (U.S. patent, U.S. patent application publication, international application publication) or in a U.S. application open to public inspection
3. Access to inventors
 - a. a coinventor is always entitled access to his or her application regardless of whether or not he or she signed the declaration
 - b. If an oath or declaration has not yet been filed, inventorship is that which is listed in the application papers

4. Right of Public to Inspect Patent Files and Some Application Files
 - a. This deals with the right the public has to inspect certain files (such as patents and certain types of applications).
 - b. The following files are open to the public:
 - i. issued patents or published statutory invention registrations
 - ii. all reissue applications
 - iii. all requests for reexamination (which will be announced in the Official Gazette provided the fee has been paid) - these are now available to the public in electronic form only
 - iv. papers relating to reexamination proceedings
 - v. files of any interference involving a patent, a statutory invention registration, a reissue application or an issued patent may be open to the public, provided:
 - a. the interference has terminated
 - b. an award of priority or judgment has been entered
5. Access to particular types of patents
 - a. Pending or non-published abandoned patents:
 - i. may not be openly viewed by any member of the public, these patents have confidential status
 - ii. If a patent application has been published then a copy of all papers relating to the file of that published application may be provided upon written request and payment of the proper fee.
 - iii. If a redacted copy of the application was used for the patent application publication, the copy of the application will be limited to the redacted copy of the application and related materials.
 - iv. If the published patent application is pending, only copies of the application file may be obtained.
 - v. If the published patent application is abandoned, the entire application is available to the public for inspection and obtaining copies.
 - b. The following specific individuals may view pending or abandoned patents:
 - i. any of the inventors except in cases where the assignee has requested otherwise
 - ii. any inventor who was named even if they did not sign the paperwork
 - iii. any assignee (of entire or partial interest)
 - iv. a licensee of entire interest (not of partial interest)
 - v. an attorney or agent of record, or anyone given written authorization from an inventor
 - c. If a U.S. patent application, publication or patent incorporates by reference, or includes a specific reference to a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request with a fee
 - d. Abandoned applications:
 - i. access to abandoned applications may be provided if:
 1. written request is sent in and approved
 2. the abandoned application is not in the file wrapper of a pending CPA and it is referred to:
 - a. in a U.S. patent application open to public inspection
 - b. in another U.S. application open to public inspection
 - c. in a published international application designating the U.S.
 - ii. Obtaining access to an abandoned application is possible if it:
 1. is published
 2. is referred to in a U.S. patent
 3. is referred to in a U.S. application open to the public
 4. claims the benefit of a U.S. application filing date that is open to the public

- e. Provisional applications:
 - i. may only be viewed by parties who have gained written authority from the named applicant
- f. Reissue applications:
 - i. reissue applications filed after March 1, 1977 are open to the public
 - ii. they are announced in the Official Gazette for the public's convenience
- g. International applications:
 - i. access to international applications is denied to all members of the public until the application becomes published internationally
 - ii. the applicant may authorize access to a specific individual
- h. Incorporation by reference
 - i. Access to an application that is incorporated by reference in a U.S. patent may be granted to:
 - 1. anyone who requests it
 - a. they will only receive a copy of the referenced part of the original application, not the entire application (unless the inventor gives them authority to view the entire application)
 - b. if the inventor fails to provide material within the period provided, the entire application will be provided to the requestee
- i. Petition for access
 - i. Any pending or abandoned patent application preserved in confidence may be requested by:
 - 1. sending in written authority to the applicant asking to view the application; or
 - 2. by filing a petition (with the fee) which should include:
 - a. reasons why access is desired
 - b. reasons why petitioner believes he is entitled to access due to "special circumstances"
 - c. a notice that a copy of the petition was given to the applicant/owner directly or indirectly through the patent office (this is termed 'servicing the applicant')
- j. Special circumstances found acceptable for seeking access to pending applications include:
 - i. if the owner is using the patent application to interfere with a competitor's business
 - ii. when a patent relies upon the application for priority
 - iii. if the application is referred to in an issued patent
- k. If access is granted, the length of time for viewing an application is:
 - i. good forever; as long as the access was granted by the agent, attorney or inventor
 - ii. limited; if given by the Patent Office (due to changing circumstances)
- 6. Servicing the applicant:
 - a. the purpose of servicing the applicant is to give the applicant/owner a chance to decide if the petitioner should only be granted access to a portion of the file instead of gaining access to the entire file
 - b. servicing is not required when:
 - i. the application is incorporated in whole or part into an issued U.S. patent
 - ii. the application is preserved in secrecy
- 7. Issues Regarding National Security
 - a. Secrecy orders
 - i. Patent applications can contain issues that are sensitive to national security.

- ii. If an application is found to contain issues that could threaten national security, the PTO will place a secrecy order on it and it will be kept secret.
 - iii. A security review will be completed for all applications before a Notice of Allowance is mailed to the applicant.
 - b. Secrecy order terms:
 - i. will remain in effect for 1 year from the date of its issuance
 - ii. the term may be renewed for additional periods of not more than 1 year at a time upon notice by a government agency that national interest so requires it
 - iii. a secrecy order can be renewed as many times as necessary
- 8. Foreign Filing
 - a. Foreign filing licenses
 - i. If an inventor files a patent application in the U.S., he or she may not file the same application in a foreign country before six months goes by without first obtaining a foreign filing license.
 - ii. If the inventor illegally files in a foreign country before the 6 month waiting period without getting a license first, he or she must immediately file for a retroactive license.
 - iii. No filing of a patent application is allowed in a foreign country until 6 months after filing in the U.S. or by petition for a foreign filing license.
 - iv. If an inventor sends off a foreign application file before 6 months after filing in the U.S. he or she may petition for a retroactive license.
 - 1. A petition for a retroactive license must include:
 - a. a list of all the foreign countries the application was filed in
 - b. the dates the application was filed in each country
 - c. an oath indicating:
 - i. that the subject matter is not under a secrecy order
 - ii. evidence that the license has been diligently sought
 - iii. evidence that the illegal foreign filing occurred by mistake and without deceptive intent
 - d. a large penalty fee
 - b. Foreign filing licenses are not required:
 - i. if the invention was made outside of the U.S. (even if by an American)
 - ii. if an inventor waits 6 months after filing the application in the U.S.
 - c. A foreign filing license may be revoked by the PTO under special circumstances
- 9. Statements to DOE and NASA
 - a. No patents for nuclear material or atomic energy will be issued except under special circumstances

Chapter 200 - Types, Cross-Noting, and Status of Application

1. Application Types:
 - a. Nonprovisional:
 - i. contains at least 1 claim
 - ii. is not abandoned after 12 months
 - iii. requires an oath or declaration
 - b. Provisional:
 - i. contains no claims
 - ii. is abandoned after 12 months no oath or declaration is required
 - c. Conversion of nonprovisional to a provisional application:
 - i. requires a petition under 37 C.F.R. 1.53(c)(2) and a fee
 - ii. the nonprovisional will become a provisional application and will keep the original filing date of the nonprovisional
 - d. Conversion of provisional to a nonprovisional application:
 - i. Rules governing the conversion of a provisional application to a nonprovisional application:
 1. in the case of a successful conversion, there is only one application and that application has a single filing date, the filing date of the provisional application
 2. the conversion of a provisional application to a nonprovisional application will adversely impact on the term of any patent to issue from the application
 3. the conversion of a provisional application to a nonprovisional will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application
 4. an applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional claiming the benefit of the provisional application under 35 U.S.C. 119(e)
 - ii. For a nonprovisional application to properly claim the benefit of the filing date of a provisional application, the provisional application must be entitled to a filing date and the basic filing fee must be paid within the time period set forth
 - e. Continuation Application:
 - i. if a patent examiner rejects one or more of the claims filed in an original application, a continuation application may be filed within three months of the rejection:
 1. a continuation requires a new fee, newly written claims and receives a new filing date - however, the original filing date will be used to determine any prior art disputes the same subject matter is included in both
 2. no new matter is acceptable
 - ii. Rules governing continuation applications:
 1. a continuation may be filed during the pendency of the parent
 2. a continuation need only have one inventor in common
 - iii. A continuation application may be filed under 35 U.S.C. 111(a) by providing a new specification and drawings and a newly executed declaration provided the new specification and drawings do not contain any subject matter that would have been considered new matter in the prior application
 - iv. A continuation application may:
 1. be a second, third, etc. application by the same applicant for the same invention
 2. be filed under 37 C.F.R. 1.53(b) or (d)

3. be filed before the parent application becomes abandoned
- f. Continuation-In-Part Application (CIP):
 - i. If an inventor makes improvements after he or she files the original application, he or she may file a continuation-in-part application to cover the improvements. The new material will have the filing date of the CIP application while the old material will still retain the filing date of the original application
 - ii. For continuation-in-part applications:
 1. the first application must be copending and the CIP will retain the earlier filing date
 2. the CIP contains new matter over the patent application
 3. some substantial portion of all of the earlier applications is repeated
 4. some new matter is added
 5. a fresh set of papers with a new oath must be sent
 6. they must be filed before the parent application becomes abandoned there is some new subject matter involved
 7. they may be filed under 37 C.F.R. 1.53(b)
- g. Continued Prosecution Application (CPA):
 - i. a continuation application of a prior nonprovisional application claiming a design may be filed as a continued prosecution application
 - ii. Continued prosecution applications are filed under 37 C.F.R. 1.53(d):
 1. these have the same serial number as its parent although no reference to the parent is inserted into the specification
 2. they cannot be filed for provisional applications
 3. they can be filed for PCT applications if they are in the national stage
2. Correction of inventorship:
 - a. Errors in inventors originally named -
 - i. Oath/Declaration already filed: request to correct; statement from each person being added and from each person being deleted that error was without deceptive intent; O/D by actual inventors; fee; if assigned, written consent of assignee
 - ii. Oath/declaration not yet filed: file oath/declaration that names the proper inventive entity
 - b. Cancellation or Amendment of Claims –
 - i. Removal of Inventor from inventive entity - to remove, if oath/declaration has been filed: request that identifies the name of inventor being deleted; acknowledges that inventor's invention is no longer being claimed; fee
 - ii. Amendment of claims that requires addition of Inventor - to add, if oath/declaration has been filed: request to correct; statement from each person being added that the addition is necessitated by amendment of claims and error was without deceptive intent; oath/declaration by actual inventors; fee; if assignment, written consent from assignee
 - c. Correcting Provisionals -
 - i. Provisional with no cover sheet – filing of a cover sheet naming correct inventors will operate to correct inventive entity.
 - ii. Provisional (adding inventor after cover sheet filed) - request to correct Inventorship that identifies the inventor being added; error occurred without deceptive intent; fee.
 - iii. Provisional (deleting inventor after cover sheet filed) - request with desired change; statement from person being deleted that error occurred without deceptive intent; fee; if assignment, written consent by assignee.
 - d. Correction of Inventorship Not Required
 - i. Issuance with Correct Inventors – if the inventive entity is correct as of the issue date, no correction required

- ii. Typos or other name errors – need not be corrected; can be corrected with a certificate of correction
 - iii. Name Change – need not be corrected; distinguished from incorrect inventor
- e. Other Ways to Correct Inventorship
 - i. court order
 - ii. reissue Right of priority of an application
 - iii. Foreign priority may be claimed under 35 U.S.C. 119(a)(d) or (f), the conditions for receiving the benefit of the filing date of a prior application filed in a foreign country include that:
 - 1. the foreign application must be by the same inventor or by his or her legal representatives or assignees
 - 2. the application must have been filed within 12 months from the date of the earliest foreign filing in a recognized country
 - 3. it must be for the same invention
 - 4. the foreign application must be filed where similar privileges are bestowed upon applicant after filing application (like an inventors certificate)
 - iv. When claiming domestic priority under 35 U.S.C. 120 or 119(e):
 - 1. the same disclosure must be present
 - 2. the applications must be copending
 - 3. a reference to the prior application must be made
 - 4. at least one common inventor must be present
 - 5. it must be filed for within the appropriate time period
 - 6. the application must be properly translated in English
- 3. Foreign Priority Claims
 - a. Applications claiming priority to a foreign application must be filed within 12 months of the prior application (six months for designs). Time is measured from date of first foreign application.
 - b. A priority claim under 119(e) and 120 establishes an effective US filing date for all purposes for commonly disclosed subject matter
 - c. A foreign priority claim does not establish an effective US filing date for all purposes for commonly disclosed subject matter. If there is a statutory 102(b) bar, the foreign priority claim will not help the applicant. The 102(b) bar is based on the actual US filing date.
 - d. Requirements for Foreign Priority Claim -
 - i. NTO or WTO country - foreign application must have been filed by inventor or his assigns; US application must be filed within 12 months of foreign application's filing date; must be same invention; priority claim must be made with submission of a certified copy of the foreign priority document. The claim for priority may be filed at any time up to (including) the date of issuance of patent (should be submitted by payment of issue fee).
 - ii. For applications filed in US (or entered national stage) on or after 5/29/2000, the priority claim must be made within four months of the filing date or 16 months from foreign filing date (the later) – petition may be filed.
 - iii. Applicant must claim priority to the first filed application.
- 4. Publication of Patent Applications
 - a. Most patent applications are published 18 months from the earliest priority date under any claim of foreign or domestic priority. The publication statute applies to any application filed on or after Nov 29, 2000 (including CPA, not including RCE). For earlier filed applications, the applicant may request publication.
 - b. Exceptions -
 - i. applications that are no longer pending (issued or abandoned)

- ii. applications subject to a secrecy order or publication would be detrimental to national security
 - iii. provisionals
 - iv. designs
 - v. reissues
- c. Exceptions upon request -
 - i. must be made upon filing of application; request must certify that the invention has not been and will not be subject of a foreign patent application
 - ii. applicant may file a petition with fee to avoid publication of a currently pending application; may not file a continuing application with a nonpublication request
 - iii. if application is filed abroad (after nonpublication request), the applicant must notify the PTO within 45 days or application will become abandoned.
- d. Publication format and process -
 - i. Each utility and plant application must be in condition for publication:
 - 1. contains filing fee and oath/declaration;
 - 2. specification of sufficient quality for optical character recognition;
 - 3. title and abstract in compliance with 1.72;
 - 4. drawings "acceptable" for use in the patent application publication as prior art document; and
 - 5. sequence listing computer-readable form.
 - ii. If applicant wants publication to be reflected by amendment, applicant must timely file a copy of the application as amended.
 - iii. The patent application publication will be based on the EFS copy of the application if the EFS copy is filed within the later of:
 - 1. 14 months from the earliest claimed priority date; or
 - 2. one months from the application's actual filing date; or
 - 3. before the PTO has started the publication process; or
 - 4. within one month of the mail date of the first filing receipt indicating the application's confirmation number.
 - iv. The applicant must also file an EFS copy of the application:
 - 1. for 'voluntary' publication of an application pending on Nov 29, 2000; or for publication of an application as redacted; or
 - 2. for republication of an application.
 - v. If drawings are 'acceptable,' applicant may submit better quality drawings for publication with:
 - 1. an EFS copy of the application; or
 - 2. a petition within the later of 14 months from the earliest claimed priority date or one month from the actual filing date of application.
 - vi. Conversion of a provisional application to a nonprovisional application will have an adverse effect on patent term because the term will be measured from at least the filing date of the provisional application. To avoid the adverse effect, applicant can file a nonprovisional application claiming the benefit of the provisional application under 35 USC 119(e).

Chapter 300 - Ownership and Assignment

1. The ownership of a patent gives the patent owner the right to exclude others from making, using, offering for sale, selling, or importing into the United States the invention claimed in the patent. Assignment is the act of transferring ownership to another party. Licensing is the assignment of patent rights, though these rights may be limited in access based on certain conditionals.
2. Accessibility of Assignment Records
 - a. Assignment documents relating to patents, published patent applications, registrations of trademarks, and applications for registration of trademarks are open to public inspection.
 - b. If a document references a number of patent applications, that document becomes available for inspection as soon as any one of the listed patent applications is published or patented.
3. Translation of Assignment Document
 - a. The PTO will accept and record non-English language documents only if accompanied by an English translation signed by the individual making the translation.
4. Assignment of Division, Continuation, Substitute, and Continuation-in-Part in Relation to Parent Application
 - a. In the case of a division or continuation application, a prior assignment recorded against the earlier application is applied (effective) to the divisional or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications.
 - b. In the case of a substitute or continuation-in-part application, a prior assignment of the original application is not applied (effective) to the substitute or continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications.
 - i. Substitute or continuation-in-part applications require the recordation of a new assignment if they are to be issued to an assignee.
5. Restrictions Upon Employees of Patent and Trademark Office
 - a. Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and one year thereafter, of applying for a patent, or acquiring interest in a patent.
 - i. This is waived however in the case of patents that are inherited.
6. Effect of Recording
 - a. An assignment record filed with a conditional statement will be recorded and filed as absolute, unless another assignment record is filed and signed by the current assignees. The PTO will not attempt to determine the validity of a conditional assignment.
7. Establishing Right of Assignee to take action
 - a. If ownership of the application is split between assignees, or assignees and inventor(s) who have not assigned their rights, then proof of ownership must be submitted in order to take action in prosecuting the application.
 - i. When there are multiple assignees, in order for an assignee to take action in a patent application, all of the assignees of a partial interest must provide a submission under 37 CFR 3.73(b).
8. When Ownership Need Not Be Established
 - a. Examples of situations where ownership need not be established under 37 CFR 3.73(b) are when the assignee:
 - i. signs a request for a continued prosecution application under 37 CFR 1.53(d), where papers establishing ownership under 37 CFR 3.73(b) were filed in the prior application and ownership has not changed (MPEP § 201.06(d));
 - ii. signs a small entity statement (MPEP § 509.03);

- iii. signs a statement of common ownership of two inventions (MPEP § 706.02(1)(2));
 - iv. signs a NASA or DOE property rights statement (MPEP § 151);
 - v. signs an affidavit under 37 CFR 1.131 where the inventor is unavailable (MPEP § 715.04);
 - vi. signs a certificate under 37 CFR 1.8 (MPEP § 512);
 - vii. or files a request for reexamination of a patent under 37 CFR 1.510 (MPEP § 2210).
- 9. Assignability of Patents and Applications
 - a. The rights of a patent or pending patent may be assigned to another party of the United States by means of a notarized document. The assignment is void unless it is recorded at the PTO within 3 months of its execution.
 - b. Barring any agreement to the contrary, each of the joint owners of a patent may exercise the rights of a patent holder without the consent or accounting to the other owners.
- 10. Accessibility of Assignment Records
 - a. All assignment documents relating to patents and registrations of trademarks are open to public inspection. Assignment records of pending or abandoned patent applications generally are not available to the public and may only be viewed upon written consent of the applicant or assignee.
- 11. Recording of Assignment Documents
 - a. Assignments of applications, patents and trademark registrations will be recorded in the PTO. Each applicant must:
 - i. Provide an original or certified true copy of the assignment
 - ii. Provide an English language translation signed by the translator if the assignment is in a foreign language
 - iii. Include all appropriate fees
 - iv. Provide a cover sheet for each assignment
- 12. Facsimile Submission of Assignment Documents
 - a. The PTO permits assignments and other documents affecting title via facsimile. The date of receipt is the date the complete transmission is received in the PTO. Any assignment related document submitted by facsimile must include:
 - i. An identified application or patent number
 - ii. One cover sheet to record a single transaction
 - iii. Payment of the recordation fee by a PTO deposit account
 - b. The following documents cannot be submitted by facsimile:
 - i. Assignments submitted concurrently with newly filed patent applications
 - ii. Documents with two or more cover sheets
 - iii. Requests for corrections to previously recorded documents
 - iv. Requests for "at cost" recordation services
 - v. Documents with payment of the recordation fee by credit card
- 13. Assignment of Divisional, Continuation, Substitute, Continuation-In Part and Provisional Applications
 - a. In the case of a division or continuation, a prior assignment recorded against the original application is applied. A prior assignment of the original application is not applied to the substitute or continuation-in part application. When a perfected application based on a provisional application contains subject matter not disclosed in the provisional application, a new assignment must be submitted with respect to this later application.
- 14. Restrictions on PTO Employees
 - a. Employees of the PTO shall be incapable, during the period of their appointment and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any rights or interest in any patent, issued or to be issued by the PTO.

Chapter 400 - Representative of Inventor or Owner

1. Who may patent or aid in the patenting process:
 - a. an applicant may:
 - i. file and prosecute his/her own application - the term for this is pro se
 - ii. request help from a registered attorney or agent
 1. unregistered individuals are not allowed to help an inventor file a patent application
 2. the registered attorney or agent may appoint an associate attorney or agent (however, the associate may not appoint a further assistant)
 - b. Only certain individuals may represent themselves before the Patent Office, these include:
 - i. the inventors themselves
 - ii. one representative inventor
 - iii. registered patent attorneys or agents in good standing
 1. firms can never be given the power of attorney, only individuals
 - iv. an appointed agent or attorney may appoint another agent or attorney (an associate)
 - v. the individual given power of attorney may fill out and even sign many of the patent related documents required during the prosecution of an application
 1. for instance, the power of attorney can execute a disclaimer or terminal disclaimer
2. Correspondence with the PTO
 - a. The applicant must provide one correspondence address. The correspondence and fee addresses may be different. If after one attorney is appointed, another attorney is appointed without revocation of the power of the first attorney, PTO letters will be sent to the later.
 - b. Customer Number
 - i. A customer number may be assigned to a particular applicant. Customer numbers are a convenience and provide:
 1. a correspondence address,
 2. a fee address, and
 3. list of the practitioners with power of attorney.
 - ii. The last provided customer number determines correspondence address. An applicant can appoint practitioners merely by reference in the power of attorney to the customer number. A representative can be added or removed practitioners from the list associated with the customer number.
 - c. Telephone Correspondence
 - i. The power to hold a phone interview is discretionary by the examiner. An attorney should call the examiner if the call will be beneficial to advance prosecution. If the attorney or representative is in the DC area, an interview can be conducted in person.
 - d. 37 CFR 10.18(b)
 - i. Every paper filed to the practitioner must be personally signed by the practitioner except those required to be signed by the applicant. By signing a paper before the PTO, the practitioner is making the certifications required by 37 CFR 10.18(b). (All papers signed must be truthful.) Advising a client of these requirements is not required, but is recommended.
3. Changing Representation: Change, Revocation, or Resignation
 - a. Applicant May Change/Revoke Representation
 - i. When an applicant or assignee is represented by a registered agent or attorney, he or she may change or revoke his or her representation at

any time for any reason. Change or revocation becomes effective on the date it is received by the PTO.

- ii. An assignment will not itself operate as a revocation or authorization, but the assignee of the entire interest may revoke previous powers and appoint another attorney or agent.
 - iii. Revocation of the power of the principal attorney revokes powers granted by her to other attorneys.
 - iv. Papers giving or revoking a power of attorney require signature by all applicants or owners unless they are accompanied by a petition giving sufficient reason as to why such papers should otherwise be accepted. Each of these parties must also sign all subsequent replies submitted to the PTO. For example, if A has given power of attorney to Smith and B has not, replies must be signed by Smith and B. If A and B have each appointed their own attorney, replies must be signed by both attorneys.
- b. Attorney May Resign (pending restrictions)
- i. The representative of the applicant may resign with some restrictions. A withdraw is effective when approved rather than when received. So the applicant has sufficient time to obtain other representation, the Commissioner usually requires that there be at least 30 days between
 - 1. approval of withdraw and the end of a reply period, or
 - 2. the expiration date of the period which can be obtained by a petition for extension of time.

4. Situations Where Representation Ceases

- a. Principal Attorney's Power Terminates at Death
 - i. Death of the inventor terminates the power of attorney given by him. A patent applied for by an inventor who later dies may issue to his legal representative.
 - ii. Unless a power of attorney is coupled with an interest (i.e., an attorney is assignee or part-assignee), the death of the inventor (or one of the joint inventors) terminates the power of attorney given by the deceased inventor. A new power from the heirs, administrators, executors, or assignees is necessary if the deceased inventor is the sole inventor or all powers of attorney in the application have been terminated. [MPEP 409.01. See also 37 CFR 1.422.]
- b. If the Inventor is Dead, Insane or Unavailable
 - i. If the inventor is dead, refuses to execute an application, cannot be found, or is insane or otherwise legally incapacitated, an application may be made by someone other than the inventor.
- c. If at least one inventor is available
 - i. the available inventors can apply. If a joint inventor refuses to join in an application or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the non-signing inventor. The oath in such application must be accompanied by a petition showing the last known address of the unavailable inventor or representatives of deceased inventors. A non-signing inventor may subsequently join the application.
- d. If no inventors are available
 - i. an assignee, or an interested party may be able to apply. Whenever all the inventors and legal representatives of deceased inventors refuse to execute an application or cannot be reached after diligent effort, a person or corporation may make an application. An inventor may subsequently join the application. The oath in such application must be accompanied by a petition showing:
 - ii. The applicant is one to whom the inventor agreed to assign the invention or the applicant shows a sufficient proprietary interest; and

- iii. Such action is necessary to preserve the rights of the parties or such action is necessary to prevent irreparable harm; and
 - iv. The last known address of the inventors or representatives of the deceased inventors.
 - e. Proof of Unavailability
 - i. The oath in such an application must be accompanied by a petition fully describing exact pertinent facts, and in the case of unavailable representative of a deceased inventor, proof of his authority as representative. Statements based on hearsay will not normally be accepted.
 - f. Proof of Refusal
 - i. The circumstances of this refusal must be specified in an affidavit by the person to whom the refusal was made stating the time and place of the refusal. When there is a written refusal, a copy of the document must be made part of the affidavit. It must be demonstrated that a bona fide attempt was made to present a copy of the application papers to the non-signing inventor for signature.
- 5. Proper signatures
 - a. every paper filed by the practitioner must be personally signed by the practitioner (except in the few cases where the applicant's signature is required)
 - b. a signature constitutes a representation to the PTO that the signer is authorized to represent the particular party in whose behalf he or she acts
 - i. this privilege applies whether or not the registered attorney is of record (such as when the power of attorney is one of the inventors)
- 6. Joint filing
 - a. if there is joint inventorship:
 - i. one coinventor may give the other inventor the power of attorney (this is acceptable even though the coinventor is not a registered patent attorney or agent) through a request for special recognition
- 7. Revoking or withdrawing power of attorney:
 - a. The power of attorney may be revoked by the applicant, or the registered practitioner may withdraw his or her power of attorney.
 - b. Customer Number:
 - i. this number is used to designate the correspondence address of a patent application or patent for purposes of correspondence, fees, and to associate the power of attorney for the application.
 - c. A power of attorney may only name as representative:
 - i. one or more joint inventors;
 - ii. registered patent practitioners associated with a Customer Number; or
 - iii. 10 or fewer registered patent practitioners.
 - 1. a power of attorney that names more than 10 patent practitioners will only be entered if Customer Number practice is used or if such power of attorney is accompanied by a separate piece of paper indicating which 10 patent practitioners named are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.
 - d. Revoking the power of attorney:
 - i. The power of attorney or authorization of an agent may be revoked whenever the inventor wishes to do so:
 - 1. the power of attorney may be revoked for any reason
 - 2. revocation of the power of principal attorney or agent revokes the powers granted by him or her to other attorneys or agents
 - 3. all the owners of a patent application must sign the papers giving or revoking the power of attorney

- a. if coinventor A signed, the revocation form will be invalid if B did not sign it (both A and B must sign the revocation forms)
 - b. if A and B each have their own attorney, all replies must be signed by both attorneys
 - c. it is possible for one inventor from a joint inventorship to revoke the power of attorney if requires:
 - i. a petition giving good and sufficient reason to explain the missing signature
 - ii. the required fee
 - 4. an assignee may:
 - a. revoke power of attorney
 - b. exclude the inventor from access to the patent
 - e. Withdrawing the power of attorney:
 - i. the attorney must request to withdraw and obtain permission from the PTO
 - f. the withdrawal is only effective once approved:
 - i. it is not effective just because it has been sent or even when it is received, it must first be approved
 - ii. each attorney of record must sign the notice of withdrawal
 - iii. the attorney or agent may withdraw from his or her duties by sending in a notice of withdrawal and gaining approval by the Commissioner
 - iv. a patent attorney or agent must withdraw his or her power of attorney at least thirty days before the last possible date for any required response
8. Correspondence with whom held
- a. Powers of attorney naming one or more individual associated with a Customer Number:
 - i. firms can never be granted the power of attorney, only individuals;
 - ii. to be valid, the attorney or agent appointed must be registered to practice before the USPTO;
 - iii. if more than one correspondence address is specified, the PTO will use the address associated with a Customer Number over a typed correspondence address;
 - iv. a registered patent practitioner listed as power of attorney is no longer able to appoint an associate agent or attorney.
 - b. Who will correspondence be held with?
 - i. all correspondence will be held with whomever has been given the power of attorney
 - ii. the application must have a correspondence address specified in an application data sheet or elsewhere in any papers submitted with an application filing in a clearly identifiable manner
 - iii. double correspondence will not be undertaken (for example, an applicant and an attorney or even two attorneys)
 - iv. if the registered attorney or agent appoints an associate, the patent office will only communicate with the associate attorney unless told otherwise
 - v. all notices and official letters for the patent owner in a reexamination proceeding will be directed to the attorney or agent of record in the patent file at the address listed on the register of patent attorneys and agents
 - 1. a current firm's address will be considered to be the correspondence address in instances where it is applicable
 - c. Rules for correspondence:
 - i. if there was no oath submitted with the application, the following individuals may change the correspondence address:

1. only the inventor who filed the application, even if more than one inventor was identified on the application transmittal letter
2. any registered practitioner named in the transmittal papers accompanying the original application
3. the party that will be the assignee (if they filed the application)
 - a. a change of correspondence address or a document granting access may only be signed by an attorney or agent who is not of record if an executed oath or declaration has not been filed in the application

9. Missing Inventor

- a. Death, legal incapacity or unavailability of inventor
 - i. An application may be filed and prosecuted by the heirs, administrators or assignees of the inventor.
 - ii. A new power of attorney is necessary (the original power of attorney will be terminated in cases where the inventor is deceased).
 - iii. The heirs of a deceased inventor should identify themselves as the legal representatives of the deceased inventor in the oath or declaration
- b. Rules for a missing signature of an inventor when at least one joint inventor is available:
 - i. if an inventor refuses to sign the oath or declaration or is unavailable:
 - ii. all available inventors must make an oath or declaration on their own behalf and make an oath or declaration on behalf of a nonsigning joint inventor;
 - iii. the application must be accompanied by proof that the nonsigning inventor cannot be found or refuses to sign;
 - iv. the last known address of the nonsigning inventor must be listed.
 1. the fact that an inventor is hospitalized is not an acceptable reason for filing under 37 C.F.R. 1.47:
- c. If the inventor is dead, insane or otherwise legally incapacitated:
 - i. a Notice of Allowance will be granted even if a death occurs
 - ii. the heirs of a deceased inventor should identify themselves as the legal representatives of the deceased inventor in the oath or declaration
 1. a certificate from a court indicating that they are all heirs is no longer necessary in these circumstances
 - iii. the legal representative of a deceased inventor must submit an oath or declaration stating that he or she is the legal representative of the deceased inventor and should provide his or her residence, citizenship and post office address
 - iv. an application may be made by the heirs of the inventor
 - v. the executor or the administrator must sign the declaration in the signature block of the deceased inventor
 - vi. proof of the authority of the legal representative of the deceased inventor is no longer required
 1. an assignment does not relieve each live inventor from the statutory requirements to sign the declaration and for the executor or administrator to sign the declaration
 - vii. if a signing field is left blank by an inventor, the application will be treated as having been completed by the other inventors on behalf of the nonsigning inventor
 - viii. a minor may sign an oath or declaration under 37 C.F.R. 1.63 as long as he or she understands the document that he or she is signing
 - ix. a Chief Executive Officer as an officer of a corporation may sign the necessary oath or declaration on behalf of the corporation as the applicant
- d. Rules for a missing signature of an inventor:

- i. if an inventor refuses to sign the oath or declaration or is unavailable, the following may sign:
 - 1. another inventor
 - 2. an assignee
 - 3. a person demonstrating proprietary interest
 - 4. in addition to the proper signature, the following is necessary:
 - a. a petition including the last known address of the inventor (a notice will be forwarded to the missing inventor)
 - b. the required fee
- 10. Representations to the Patent and Trademark Office
 - a. separate verification statements are no longer needed for small entities, English translations, petitions to make special, or claims for foreign priority
- 11. **On the exam**
 - a. One of two joint inventors died, what happens to the power of attorney?
 - b. "Death of Inventor" questions seem to be tested frequently. One should know what happens to the power of attorney and who can sign when the applicant dies. Know what the result is if inventor dies before filing, upon filing, or during prosecution. Know how this changes when the applicant assigned entire interest / partial interest away before dying. Know assignee's right if the inventor's estate wants to control prosecution. We can't stress enough the importance of having down pat the interplay between death/assignment/signing/power of attorney/type-of-application (original, continuing, reissue, reexamination).

Chapter 500 - Receipt and Handling of Mail and Papers

1. Delivery
 - a. Certificate of Transmission:
 - i. must accompany a facsimile and is used as proof for establishing when the fax was received by the PTO
 - ii. the PTO will date stamp the correspondence when they receive it (if the facsimile arrives on a Sat, Sun or Fed holiday, it will be stamped the next working day)
 - iii. faxes cannot be used for anything that will obtain an application filing date (in addition to many other items)
 - iv. an individual may state the date on which the paper will be transmitted by fax, in most cases this will be used as the date it arrived to the PTO
 - b. Certificate of Mailing:
 - i. the date is based on the date the correspondence is sent, never on the date it is received
 - ii. it must be addressed correctly with enough postage for first class mail, in addition, it must include a signed (by assignee or registered practitioner) dated certificate of mailing with each piece of correspondence listed
 - iii. only certain types of correspondence may be sent via a Certificate of mailing
 - c. "Express Mail"
 - i. Rules governing "Express Mail":
 1. it may be used for any type of correspondence
 2. it will be considered as filed on the date of the deposit, whatever day of the week that may be
 3. the correspondence must state "Express Mail Post Office to Addressee"
 4. the service must be provided by U.S. Postal Service (U.S.P.S.)
 5. the "date in" must be entered by the U.S.P.S. and the mailing label must be completed by the U.S.P.S.
 - d. Hand Delivery:
 - i. hand delivery is only available during office hours;
 - ii. you should receive a receipt back for the papers as proof of their delivery
2. Small Entity
 - a. Small entities receive a 50% reduction in certain fees:
 - i. The owner or officer of an application may sign a statement for this, the attorney may not
 - b. Those who may qualify for small entity status include:
 - i. independent inventors (with no assignment)
 - ii. small businesses (with less than 500 employees)
 - iii. nonprofit organizations
 - c. To request a refund based on a change in small entity status, a petition must be filed under 37 C.F.R. 1.28(a)(b) within 3 months of the accidental extra payment. If an assignment is made after the application is filed, the inventor will not have to retroactively pay a large entity filing fee, however, future payments are calculated under the new status
3. **On the exam**
 - a. Recent test takers have reported one question about user passes, MPEP 510:
 - i. 510 U.S. Patent and Trademark Office Business Hours [...] (3) A valid User Pass must be prominently displayed when searching in the TC Facilities. User Passes are nontransferable and must be surrendered upon request to authorized officials.
 - b. Know what correspondence can be transmitted by fax (MPEP 502.01, CFR 1.6 and CFR 1.8):
 - i. Facsimile
 1. can pay: maintenance fees

2. can send copies of oath/declaration
 3. can file CPA
 4. can be used to pay issue fee and publication fee, and send formal drawings
 5. can be used for assignment and other docs affecting title
 6. can NOT be used to file PCT apps
- c. Small entity status is commonly tested on the exam.
- i. Small Entity - 50% Discounts for:
 1. basic filing fees;
 2. fee for extra claims;
 3. maintenance fees;
 4. late fee for maintenance fee;
 5. reissue applications.
 - ii. No Discounts for:
 1. petitions (some);
 2. reexams.

Chapter 600 - Parts, Form, and Content of Application

1. Claims

- a. Rules concerning claims:
 - i. they should be placed at the end of the specification
 - ii. if more than 1, they need to be separated by a line of indentation
 - iii. they should be arranged in order of scope so that the first claim is the least restrictive (broadest)
 - iv. claims of like species should be grouped together
 - v. process and product claims need to be separately grouped
 - vi. any measurements should be in the metric system, followed by English units
 - vii. they may contain tables if tables are necessary to conform to specification guidelines
 - viii. Grammatical rules:
 - 1. claims should begin with "I (or we) claim" or "The invention claimed is" a claim is divided by a colon (:) which generally describes the things or steps
 - 2. either a semicolon or comma separates each paragraph
 - 3. the last step should have an "and" after the semicolon (; and)
 - 4. each claim should begin with a capital and end with a period (only the first word in a claim is capitalized)
- b. Dependent claims:
 - i. A series of singular dependent claims is allowed where a dependent claim refers to a preceding claim, which in turn, refers to another preceding claim
 - ii. Rules governing dependent claims:
 - 1. a dependent claim must further limit the subject matter of a previous claim
 - 2. there is not a minimum or maximum number of dependent claims
 - 3. a dependent claim may refer back to any preceding claim; there may be a string of these
 - 4. a claim depending from a dependent claim should not be separated from any claim which does not also depend (directly or indirectly), from the dependent claim
 - a. for example - "2. The product of claim 1 in which..."
 - iii. Since independent claims are the broadest claims of an application and dependent claims depend on independent claims, the broadening of a dependent claim cannot broaden the scope of the invention
 - 1. A lesser burden of proof may be required to make out a case of prima facie obviousness for product-by-process claims, than is required to make out a prima facie case of obviousness when the product is claimed in the conventional fashion
- c. Multiple dependent claims:
 - i. A series of dependent claims that refer back in the alternative form to more than one proceeding independent or dependent claim
 - ii. Rules governing multiple dependent claims:
 - 1. they may only refer to one set of claims
 - 2. they cannot depend on another multiple dependent claim
 - 3. they cannot depend on more than one previous claim
 - 4. they may not serve as a basis for any other multiple dependent claim, either directly or indirectly
 - 5. they will not contain all the limitations of all the alternate claims to which they refer
 - 6. the limitations or elements of each claim that is incorporated by reference with a multiple dependent claim must be considered separately

7. they must be considered in the same manner as a plurality of single dependent claims
 8. restriction may be required between the embodiments of a multiple dependent claim
 9. a multiple dependent claim can contain in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration
- iii. Determining fees for multiple dependent claims:
 1. Count up all dependent claims:
 - a. if it says; Claim 2 dependent from 1 = for a total of 2
 - b. if it says; Claim 3 dependent from 1 or 2, that is 2 = for a total of 3
- d. Markush claims:
 - i. an acceptable form of alternative expression
 - ii. Markush claims always contain the phrase; "consisting of" and the conjunctive "and"
 - iii. they never contain "or"
 1. example: R is selected from the group consisting of A, B, C and D
 - iv. two common phrases include "chosen from the group consisting of" and "chosen from the group consisting essentially of"
2. Essential material:
 - a. Material is considered necessary if it:
 - i. is necessary to describe the claimed invention
 - ii. provides the enabling disclosure of the claimed invention
 - iii. describes the best mode
 - b. Essential material may be incorporated by reference if it is from:
 - i. a U.S. patent
 - ii. a pending U.S. application
 - iii. an abandoned application less than 20 years old can be incorporated by reference to the same extent as a copending application
 - c. Material not allowed to be incorporated by reference in a U.S. utility patent application includes:
 - i. essential material from a foreign patent or application
 - ii. matter from a magazine article
 - iii. a U.S. article that incorporates the material from another patent by reference
3. Nonessential material is the background material; it may be incorporated by reference from:
 - a. patents or applications published in the U.S.
 - b. from publications or foreign patents
 - c. from a prior filed, commonly owned U.S. application
4. New matter:
 - a. matter not in the original specification, claims, or drawings is usually considered new matter
 - b. where new matter is confined to amendments in the specification a review of the examiner's request for cancellation is by way of petition
 - c. where the alleged new matter is introduced or affects the claims, thus necessitating their
 - d. rejection on this ground, the question becomes an appealable one
5. Specification:
 - a. A specification may contain:
 - i. tables and chemical formulas instead of formal drawings
 - ii. one or more claims at its conclusion
6. A specification may not contain:
 - a. graphs, diagrams or flowcharts

- b. links or outside sites
 - c. reservations for future applications of the subject matter can be disclosed but not claimed in the pending application
 - d. color drawings and photographs are not normally permitted, however, they may be allowed in utility and design applications after the granting of a petition and fee
 - e. an applicant needs to submit the petition at any time during the prosecution when adding in color drawings and photographs
 - i. this petition must be submitted for a continuation even if it was already OK'd in the original application
7. Application Requirements
- a. Complete Applications -
 - i. If application doesn't meet requirements, applicant can petition to have a filing date assigned. If application meets these minimum requirements, but is incomplete (missing oath or fee), the applicant will be sent a notice to file missing parts (usually has 2 months from filing date). There is no requirement that the inventors be named. PTO requests a "numeric identifier" in cases where inventors are not known.
 - ii. Non-provisional (regular) – specification (at least one claim); drawings where required; oath/declaration; filing fee
 - iii. Provisional – cover sheet; specification (need not include any claims); drawings where required; filing fee
 - b. Filing Date Requirements –
 - i. Non provisional (regular) – specification, drawings
 - ii. Provisional – specification, drawings
 - iii. CPA – separate request for CPA; should file response to last office action
 - c. Non-Provisional Application Requirements –
 - i. A non-provisional utility patent application must include a specification, including a claim or claims; drawings, when necessary; an oath or declaration; and the prescribed filing, search, and examination fees. A complete non-provisional utility patent application should contain the elements listed below, arranged in the order shown.
 - ii. Utility Patent Application Transmittal Form or Transmittal Letter
 - iii. Fee Transmittal Form and Appropriate Fees
 - 1. Basic filing fee includes 3 independent claims and 20 total claim
 - 2. Claims fees are not refundable
 - 3. Non-elected claims in a restriction requirement must be cancelled or paid for
 - 4. Multiple dependent claims count as at least two D claims; extra fee applies
 - 5. Improper MDC count as a single dependent claim
 - 6. Fees Paid by Mistake – may be refunded. Must be requested within 2 years. Small entity requests must be made within 3 months of the payment of fee. PTO will not refund \$25 or less w/o request.
 - iv. Application Data Sheet (see 37 CFR § 1.76)
 - v. Specification (with at least one claim)
 - 1. Title (500 characters max)
 - 2. Abstract (separate sheet – 150 word max)
 - 3. Formulae and tables may be in the specification. Drawings and flow diagrams must be on separate sheets.
 - 4. Real examples should be described as "was" done. Prophetic examples should be described as "is" done.
 - vi. Drawings (when necessary)
 - 1. Application may be filed with informal drawings

2. Formal drawings are normally required within 3 months after mailing of Notice of Allowance (not extendable)
 3. Must show every feature specified in the claims
- vii. Executed Oath or Declaration
- viii. Nucleotide and/or Amino Acid Sequence Listing (when necessary)
- d. Incorporation by Reference –
 - i. Mere mention of another document without language of incorporation is not sufficient to incorporate the doc by reference.
 1. Essential material – may be incorporated by reference to a US patent, US application publication, pending US application or abandoned application less than 20 years old.
 2. Nonessential material – may be incorporated by reference to a non-US patent or to a published document (no hyperlinks).
- e. Correspondence Address ('CA')
 - i. PTO requires one correspondence address.
 - ii. To make a change:
 1. Before a declaration of any inventors has been filed, the correspondence address may be changed by a registered attorney named in transmittal letter, or ANY of the inventors. If assignee or party who will be assignee filed the application, they may change the correspondence address;
 2. After a declaration, the 'CA' may be changed only by a registered attorney of record, an assignee, or ALL of inventors (unless there's an assignment of entire interest and that assignee has been made of record); or
 3. If the attorney changes his address, he must file a separate paper in each application, unless the 'CA' is to a customer number.
- f. English Translation -
 - i. A non-provisional utility patent application must be in the English language or be accompanied by a translation in the English language, a statement that the translation is accurate and a fee set forth in 37 CFR §1.17(i).
- g. Format -
 - i. All papers which are to become part of the permanent records of the USPTO must be typewritten or produced by a mechanical (or computer) printer. The text must be in permanent black ink or its equivalent; on a single side of the paper; in portrait orientation; on white paper that is all of the same size, flexible, strong, smooth, nonshiny, durable, and without holes. The paper size must be either: 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches), or 21.0 cm. by 29.7 cm. (DIN size A4). There must be a left margin of at least 2.5 cm. (1 inch) and top, right, and bottom margins of at least 2.0 cm. (3/4 inch). Drawing page requirements are discussed separately below.
8. Conversion between Provisional and Non-Provisional Applications
 - a. Non-Provisional (regular) to Provisional -
 - i. Must be within 12 months from application filing date
 - ii. Prior to abandonment or payment of issue fee
 - iii. Prior to request for statutory invention registration
 - iv. No refund of fees.
 - v. To convert, you need: a request for conversion and fee
 - b. Provisional to Non-Provisional (regular) (as opposed to claiming priority) -
 - i. or declaration (may be filed after conversion date)
9. Oath/Declaration
 - a. General Requirements of Oath/Declaration -
 - i. Declaration must be in permanent ink

- ii. Must identify each inventor (first and last names), as well as their countries of citizenship
- iii. Statement that inventors signing 'believe to be first...'
- iv. Identify application
- v. State that oath giver understands contents and duty to disclose
- vi. Unless the following is provided in application data sheet, oath must provide:
 - 1. inventors' mailing addresses and residence if different, and
 - 2. application number, country, day, month, year of any foreign application to which priority is claimed.
- vii. If the declaration is filed with the application, it must include one of:
 - 1. name of inventor(s), and reference to an attached spec which is both attached to the oath or declaration at time of execution and submitted with o/d on filing;
 - 2. name of inventor(s); and attorney docket number which was on spec as filed; or name of inventor(s); and title of invention which was on the spec as filed.
- viii. If the declaration is filed after the specification, it must include one of:
 - 1. application number; serial number and filing date;
 - 2. attorney docket number which was on the specification as filed;
 - 3. title of invention and reference to an attached specification which is both attached to oath/declaration at time of execution and submitted with oath/declaration; or
 - 4. title of invention and with a cover letter id-ing the application for which it was intended by either application number or serial and filing date.
- ix. If applicant(s) cannot read English, oath/declaration must be in their language and translated or be on a PTO form.
- x. It is improper for an applicant to sign oath/declaration which is not attached to or does not identify a specification and/or claims.
- xi. An attorney may not sign on behalf of inventor.
- xii. No amendments are allowed to the specification after the declaration is executed.
- xiii. If person is not the inventor, the oath/declaration must state their relationship.
- xiv. If inventor changes name, a 1.182 petition must be filed to change name.
- b. Copies of Oath/Declaration –
 - i. May be filed in lieu of original signatures (including fax).
 - ii. A new oath/declaration need not be submitted in a continuation or division if: 1) prior application contained proper oath/declaration; 2) filed by one or more of the previous filed inventors; 3) no new matter is added (not a CIP); and 4) copy of oath/declaration filed previously is submitted.
 - iii. If co-inventors are deleted in continuation or divisional, a copy of the previous declaration may be filed, but a statement requesting deletion of the omitted inventors must accompany the submission.

10. Application Data Sheet

- a. MPEP 608.01(a) –
 - i. If an application data sheet is used, data supplied in the application data sheet need not be provided elsewhere in the application except that the citizenship of each inventor must be provided in the oath or declaration under 37 CFR 1.63 even if this information is provided in the application data sheet. If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors.

- ii. CFR 1.76 encourages applicants to submit an application data sheet containing bibliographic information: applicant info, correspondence info, application info, representative info, domestic priority info, foreign priority info, and assignee info. A supplemental data sheet may be submitted to correct info previously supplied. Only to be used to correct new info, not inventorship, citizenship, or correspondence address.
- b. Inconsistencies between Oath/Declaration and Application Data Sheet -
 - i. The oath/declaration always governs names and citizenship
 - ii. The application data sheet governs when submitted simultaneously with the oath/declaration
 - iii. The latest filed document is controlling
- c. Supplemental Oath/Declaration -
 - i. Generally required when defect in oath/declaration as filed. Only the inventors as to whom the oath/declaration is defective must submit a supplemental document. Capturing bibliographic information derived from an application data sheet containing errors may be recaptured by a request therefore and the submission of a supplemental application data sheet, an oath or declaration, or a letter pursuant 37 CFR 1.33(b).
 - ii. One may file an application data sheet to correct errors in some new matters (mailing address, foreign priority claim), instead of new declaration. Supplemental application data sheets may be supplied prior to payment of the issue fee to either correct or update information in a previously submitted application data sheet or an oath or declaration.
 - iii. The Office will initially capture bibliographic information from the application data sheet notwithstanding whether an oath or declaration governs the information; they will not generally look to an oath or declaration to see if the information is consistent with the application data sheet.

11. Information Disclosure Statements

- a. Applicant must disclose information that is “material to patentability,” usually done with an IDS
- b. No need to perform a search
- c. IDS's are not permitted in provisional applications; nor are they permitted in the international stage of a PCT application
- d. Content -
 - i. IDS's must contain:
 - 1. a list of materials (patents, publications, other references) cited;
 - 2. legible copies of materials cited;
 - 3. if portion of a reference is cited; only such portion must be submitted. If not in English, must have:
 - a. concise explanation of the relevance; or
 - b. an English translation;
 - i. can be satisfied by submitting English language version of foreign search report.
 - ii. REVISION as per 6/30/03 - The Office hereby waives the requirement under 37 CFR 1.98 (a)(2)(i) for submitting a copy of each cited U.S. patent and each U.S. patent application publication for all U.S. national patent applications filed after June 30, 2003 and for all international applications that have entered the national stage under 35 USC § 371 after June 30, 2003.
- e. Citing References -
 - i. A Form PTO-1449 is used. Examiner reviews, initials, and returns a copy.
 - ii. US Patents: inventor, patent number, issue date
 - iii. US Patent application publication: applicant, patent application publication number, publication date

- iv. US application: inventor, application number, filing date
 - v. Foreign patent or published foreign patent application: country or patent office which issued patent or published application, document number, publication date
 - vi. Publications: publisher, author (if any), title, relevant pages of pub, date, place of publication
 - f. Time for Filing -
 - i. May be filed freely during: first three months after filing or entry into national stage; prior to any office action on the merits
 - ii. Three month grace period does not apply to RCE/CPA – only before first OA
 - iii. After these periods, IDS can be filed before a final office action/notice of allowance/other action terminating substantive pros; with fee or statement that info was disclosed in communication for foreign patent office no more than 3 months before filing of IDS; or no info was known 3 months prior.
 - iv. After final office action or notice of allowance, must include both fee and statement
 - v. Once issue fee has been paid, no IDS will be accepted
 - g. National Stage Applications –
 - i. Ordinarily, an IDS is not necessary for references that were cited in the international stage proceeding, but if a continuing application is filed, copies of the references must be cited.
12. Third Party Submission
- a. After publication of an application, a third party may submit materials for consideration
 - b. The submission must include:
 - i. identification application by application number;
 - ii. fee;
 - iii. list of patents or publications submitted for consideration, including date of publication;
 - iv. copy of each listed patent or publication, or at least relevant parts;
 - v. English language translation
 - c. Submission must be served upon applicant
 - d. Must not include any discussion or arguments
 - e. Limited to 10 references
 - f. Must be made earlier of within 2 months of publication date, or prior to NOA
 - g. May be submitted later, but only if references could not have been submitted earlier – with fee
 - h. Does not guarantee that references will be considered
 - i. Applicant should always submit IDS with same references
13. **On the exam**
- a. Know that in case of conflicting information between Application Data Sheet and Oath/Declaration the Application Data Sheet wins, except for naming and citizenship of the inventors, in which case the Oath/Declaration wins. This is true if ADS and oath filed at same time — otherwise the later filed document controls whether ADS or oath, except for naming and citizenship of inventors — in which case oath controls MPEP 601.05(d).
 - b. Each U.S. Patent in an IDS must be identified by inventor, patent number, and issue date (not by application number). Each publication in an IDS must be identified by publisher, any author, title, relevant pages, date, and place of publication.
 - i. If the disclosures of 2 or more patents or publications listed in an IDS are substantively cumulative, a copy of one may be submitted without copies of the other patents or publications if they are cumulative.

- ii. A properly filed IDS is not construed as a representation that a diligent and thorough search has been made.
- iii. Submission of an IDS after a notice of allowance has been received will not be considered a failure to engage in reasonable efforts to conclude prosecution if the information in the IDS was cited in a communication received by any individual designated in 37 CFR 1.56 not more than 30 days prior to the filing of the IDS.

Chapter 700 & Chapter 2100

1. MPEP 700 - Examination of Applications
 - a. The patent bar exam places major emphasis on this section. The examination of applications is one of the most thoroughly tested sections on the exam. The details of RCE's should be paid close attention to. The sections on abandonment and extensions will be referenced several times. Making amendments to the application is also very important and the process of swearing back, rule 37 C.F.R. 1.131, will be tested.
2. MPEP 2100 - Patentability
 - a. This chapter is tested very heavily. You should plan to memorize all the sections of 35 U.S.C. 102 including how to overcome each type of rejection. 35 U.S.C. 103 is also very important. Pay special attention to the specification requirements under 35 U.S.C. 112. Learning the material presented in this chapter is key to passing the patent bar exam.
3. Patentability:
 - a. For an object to be patentable, it must not be a naturally occurring composition
 - b. Disclosure of utility:
 - i. a claimed invention must have a specific and substantial utility
 - ii. an applicant need only provide one credible assertion of specific utility for each claimed invention to satisfy the utility requirement; and
 - iii. any rejection based on lack of utility should include a detailed description as to why the claimed invention has no special or substantial utility
 1. The examiner should provide documented evidence regardless of the publication date
 - c. The invention has a well established utility if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention and the utility is specific, substantial and credible
 - i. Where an asserted special and substantial utility is not credible, a prima facie showing of no specialization or substantial utility must establish that it is more likely than not that a person skilled in art would not consider any special and substantial utility asserted by applicant for the claimed invention as credible
 - d. An applicant may overcome a rejection by an examiner who established a prima facie showing of no specific and substantial credible utility for a claimed invention by:
 - i. providing reasoning or arguments
 - ii. amending the claims; or
 - iii. providing evidence in the form of a declaration under 37 C.F.R. 1.132
 1. even the mere identification of a pharmacological activity of a compound that is relevant to an asserted pharmacological use provides an "immediate benefit to the public"
4. 35 U.S.C. 101
 - a. inventions will be granted for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof"
 - b. rejections based on a lack of utility (35 U.S.C. 101) may include:
 - i. any substantially unaltered thing occurring in nature, for example - a shrimp with its head and digestive tract removed is not patentable
 - ii. printed matter
 - iii. a scientific principle, divorced from any tangible structure, so mathematical discoveries are not patentable, however, the methods of using such principles and devices embodying the principles may be patentable.

- c. In order to establish prima facie, it is not necessary that there be a suggestion or an expectation from the prior art that the claimed invention will have the same or a similar utility as one which is newly discovered by the applicant
- 5. 35 U.S.C. 102
 - a. For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention, either explicitly or impliedly
 - b. 102(a)
 - i. Prior art under U.S.C. 102(a) includes:
 - 1. a patent for the same subject matter obtained anywhere in the world
 - 2. public knowledge in the U.S. only
 - 3. publication anywhere in the world, or
 - 4. use by others in the U.S. only, which means that the knowledge must be used in this country
 - a. prior knowledge that is not present in the U.S., even if common in a foreign country, cannot be the basis of a rejection under 35 U.S.C. 102(a).
 - b. By others refers to any entity different from the inventive entity, even if it only differs by one person
 - c. 102(b)
 - i. If there is a patent or publication for the same subject matter anywhere that was printed or issued more than one year prior to the application, or public knowledge or use in the U.S. more than one year prior to the application, there will be a rejection under 35 U.S.C. 102(b).
 - ii. What creates a statutory bar?
 - 1. If the inventor discloses his or her own work more than 1 year before the filing of the patent application, the inventor is barred from obtaining a patent on that work
 - a. The one year time bar is measured from the U.S. filing date
 - b. Experimental use does not bar a patent, however it must be the primary purpose, and any commercial exploitation that results from it must be incidental.
 - d. 102(c)
 - i. Abandoned inventions will be rejected under 35 U.S.C. 102(c)
 - 1. If an invention is abandoned, it cannot be patented later.
 - a. For example, if 10 years pass by without the filing of a patent, the invention may be considered abandoned. A delay in making the first application is not sufficient to determine abandonment
 - e. 102(d)
 - i. A person shall be entitled to a patent unless the invention was first patented, or was the subject of an invention, certified by the applicant or his legal representatives or assigns, more than 12 months before the filing of the application in the U.S.
 - ii. For a foreign patent to qualify as a reference:
 - 1. It need not be published, but the patent rights granted must be enforceable;
 - 2. It must be filed more than 12 months before the effective filing date of the U.S. application;
 - 3. It must be filed by the same applicant as the u.s. application, his or her legal representative or assigns;
 - 4. It must have actually issued as a patent or inventor's certificate before the filing of an application in the u.s.; and
 - 5. It must involve the same invention

- iii. There are four conditions that must be present in order to bar the granting of a patent under 35 U.S.C. 102(d):
 - 1. more than 12 months filing of a foreign application
 - 2. the foreign application must have been filed by the same applicant as in the U.S. or by his/her legal representatives or assigns
 - 3. the foreign patent or inventor's certification must actually be granted before the U.S. filing date
 - 4. the same invention must be involved
- f. 102(e)
 - i. A rejection under 35 U.S.C. 102(e) will be made where the "patent was filed by another with an earlier filing date".
 - ii. Publications of international applications filed before November 29, 2000 do not have a 35 U.S.C. 102(e) date at all.
 - iii. In order for a reference to qualify as a reference under 35 U.S.C. 102(e), it must be a:
 - 1. U.S. patent; or
 - 2. U.S. application publication
 - iv. For WIPO publication of an international application the international application under 35 U.S.C. 102(e) must meet the following conditions:
 - 1. it must have an international filing date on or after November 29, 2000
 - 2. it must designate the U.S.
 - 3. it must be published under PCT Article 21(2) in English
 - 4. There must be a showing that the disclosure relied on is the applicant's own work:
 - a. Applicant need not prove diligence or reduction to practice to establish that he or she invented the subject matter
 - 5. And a sharing of conception by applicant before the filing date of reference
- g. 102(f)
 - i. If the subject matter was invented by someone else and not the inventor(s) listed on the application, there will be a rejection under 35 U.S.C. 102(f).
 - ii. The inventors listed must be exactly those that invented the actual work.
 - 1. For example, if A, B and C invented something, and only A, B are listed on the application, the application is invalid since C should also be listed.
 - iii. A person will receive a patent unless he, himself, did not invent the subject matter sought to be patented.
 - iv. The mere fact that a claim recites the use of various compositions, each of which can be assumed to be old, does not provide a proper basis for a 35 U.S.C. 102(f) rejection.
 - v. There is no requirement that an inventor be the one to reduce the invention to practice so long as reduction to practice was done on his or her behalf.
- h. 102(g)
 - i. (g)(1) deals with conflicts with priority of the invention that are discovered during the course of an interference - someone else invented the same thing at almost the same time and did not abandon, suppress or conceal it
 - ii. (g)(2) deals with the issue of an invention that was made in this country by another inventor who had not abandoned, suppressed, or concealed it.
 - iii. The U.S. has a first to invent rather than a first to file system:

1. an interference is held to try to determine which party was the first to invent the invention
 2. the first to conceive the invention and constructively reduce it to practice will be the sole party to obtain a patent
 - iv. Subject matter under 35 U.S.C. 102(g) is available only if the invention was made in this country:
 1. if the invention is reduced to practice in a foreign country, but knowledge of the invention was brought into this country and disclosed to others, the inventor can derive no benefit from the work done abroad
 2. such knowledge is merely evidence of the conception of the invention
 3. the applicant can establish a date of invention in a NAFTA member country or WTO member country
 - v. The difference between constructive and actual reduction to practice is that:
 1. Constructive reduction of practice is the date of the filing at the PTO.
 2. Actual reduction to practice is the date the invention was sufficiently tested to its intended proven purpose
 - vi. Diligence:
 1. reasonable diligence must only be shown between the date of the actual reduction of practice and the public disclosure to avoid the inference of abandonment
6. 35 U.S.C. 103
- a. 35 U.S.C. 103 is based on the obviousness of the subject matter
 - b. In order to determine obviousness, the examiner will:
 - i. determine the scope and contents of the prior art
 - ii. ascertain the differences between the prior art and the claims in issue
 - iii. resolve the level of ordinary skill in the pertinent art; and
 - iv. evaluate evidence of secondary considerations
 - c. Overcoming a rejection based on 35 U.S.C. 103(a) may be accomplished by:
 - i. persuasively arguing that the claims are patentably distinguishable from the prior art
 - ii. amending the claims to patentably distinguish them over the prior art
 - iii. filing an affidavit or declaration under 37 C.F.R. 1.131
 - iv. filing an affidavit or declaration showing that the reference invention is not by "another"
 - d. Perfecting a claim to priority
 - i. perfecting priority by amending the specification of the application to contain a specific reference to a prior application:
 1. In order to establish a prima facie case of obviousness, it is not necessary that there be a suggestion or expectation from the prior art that the claimed invention will have the same or a similar utility as one newly discovered by the applicant.
 2. The rationale for proving obviousness may be found in a specific reference, from common knowledge in the art, scientific principles; art recognized equivalents, or a legal precedent.
 3. In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference, but also the inferences which one skilled in the art would reasonably be expected to draw there from.
 - e. Combining equivalents known for the same purpose:
 - i. it is prima facie obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose in order to form a third composition to be used for the very same purpose

- f. To make out a case of obviousness, one must:
 - i. determine the scope and contents of the prior art
 - ii. ascertain the differences between the prior art and the claims in issue
 - iii. determine the level of skill in the pertinent art
 - iv. evaluate any evidence of secondary considerations
 - g. Arguing economic infeasibility:
 - i. the fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility.
 - h. Request for continued examination
 - i. actions in which the prosecution will be considered closed and a request for continued examination may be proper include:
 - 1. an Office action that is a final action
 - 2. when a Notice of Allowance has issued
 - 3. an Office action under Ex Parte Quayle when an application is under appeal
 - ii. The filing for a request for continued examination (RCE), including the submission after the filing of a Notice of Appeal to the Board but prior to a decision on an appeal, is considered a request to withdraw the appeal and reopens the prosecution of the application
 - 1. The submission may be an amendment to the written description
 - iii. In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure set forth in 37 C.F.R. 1.114 is not available, and the applicant must file a Continuation-In-Part application under 37 C.F.R. 1.53(b) containing such new matter.
 - i. Petition to make special:
 - i. The following categories do not require a fee for a petition to make special:
 - 1. illness/health of applicant
 - 2. age of applicant
 - 3. environmental contributions
 - 4. enhancement of energy resources
 - j. The following categories require the payment of a fee:
 - i. prospective manufacture
 - ii. infringement
 - iii. safer DNA
 - iv. HIV/AIDS and cancer
 - v. superconductivity
 - vi. countering terrorism
 - vii. biotech applications filed by small entities
 - viii. all other instances where a petition to make special is filed
7. Extension of due dates
- a. When extending due dates:
 - i. total automatic extension cannot be greater than five months
 - ii. total statutory time limit for all responses to Official Actions cannot be extended more than six months
 - b. Due dates cannot be extended for the following:
 - i. IDSs
 - ii. any due date set by statute as the six month absolute deadline
 - iii. payment of the issue fee, although it can be paid late
 - iv. deadline for responding to a Notice of Omitted Items
 - v. the two month deadline to obtain a refund for a fee paid as a large entity
 - c. Unavoidable delay:
 - i. To prove unavoidable delay the following evidence is required:

1. listing of the procedures in place that should have avoided the error resulting in the delay the training and experience of the people responsible for the error
 2. copies of applicable docketing records to show that the error was the cause of the delay
 3. proper notification of a change in correspondence address must be shown to prove unavoidable delay
- d. Unintentional delay:
 - i. The applicant must attempt to prove that his or her delay was unintentional; to do this he or she will have to submit a petition that includes:
 1. evidence showing that the delay was unintentional
 2. the required reply
 3. the required fee
 4. any terminal disclaimer that is deemed necessary
8. Petitions:
 - a. must be filed within 2 months from the action complained of the mere filing of a petition will not stay the period for replying to an examiner's action which may be running against an application, nor act as a stay of other proceedings
9. Amendments:
 - a. Amendments must be signed by:
 - i. the attorney or agent of record
 - ii. the registered attorney or agent acting under 37 C.F.R. 1.34(a)
 - iii. the assignee of record of entire interest or all the assignees if partial assignments are granted
 - iv. all of the applicants
10. New matter includes:
 - a. matter wholly unsupported by the original disclosure
 - b. adding specific percentages or compounds when the original disclosure was broader
 - c. the omission of a step from a method
11. Swearing back
 - a. Swearing back can be used for:
 - i. a rejection under 35 U.S.C. 102(a) based on a journal article that describes the invention as claimed
 - ii. a rejection under 35 U.S.C. 102(e) based on a patent that discloses but does not claim the same patentable invention
 - iii. a reference with a patent issue date less than one year prior to the applicant's effective filing date, showing but not claiming the same patentable invention
 - iv. the date of foreign patent or publication is less than 1 year prior to applicant's effective filing date
 1. The date to overcome is the effective U.S. filing date, not the foreign priority date
 - b. Printed publications are effective as of the publication date, not the date of receipt by the publisher
 - c. The lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon is not relevant to an affidavit or declaration under 37 C.F.R. 1.131
 - d. After conception has clearly been established, diligence must be considered prior to the establishment of the effective date
12. 35 U.S.C. 112
 - a. Enabling disclosure:
 - i. the specification must enable a person skilled in the art to make and use the claimed invention without undue experimentation
 - ii. it must be consistent with published information

- iii. enablement for the claims in a utility application is found in the specification preceding the claims, as opposed to being in the claims
 - iv. the claims do not provide their own enablement
 - v. the lack of necessity to theorize or explain the failures does not alleviate the inventor from complying with 35 U.S.C. 112, first paragraph by providing an enabling disclosure that is commensurate in scope with the claims
 - b. Best mode:
 - i. used to restrain inventors from applying for patents while at the same time concealing from the public the preferred embodiments of their inventions which they have in fact conceived
 - ii. affirmation of a best mode rejection must show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment
 - iii. This law prevents an applicant from claiming subject matter that was not described in the application as filed, and the proscription against the introduction of new matter in a patent application serves to prevent an applicant from adding to the informational content of a patent application after it is filed
 - iv. Filing dates and the state of art:
 - 1. an applicant cannot use a patent to prove state of art for purpose of satisfying the enablement requirement if the patent has an issue date later than the effective filing date of the application
 - 2. a later dated publication cannot be used to enable an earlier dated application
 - v. Undue experimentation:
 - 1. the claimed invention must be enabled so that any person skilled in the art can make and use the invention without undue experimentation
 - 2. the information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art on how to both make and use the claimed invention
 - vi. The best mode requirement keeps applicants from obtaining patent protection without making a full disclosure as required by the statute
 - vii. Facts about best mode:
 - 1. a specific example is not required
 - 2. the best mode may be represented by a preferred range of conditions or a group of reactants
 - 3. a designation as best mode is not required
 - 4. the disclosure only needs to include the best mode
 - 5. there is no requirement to update the best mode
 - 6. if the best mode is not disclosed in the application, such a defect cannot be amended by adding any new matter
 - c. 35 U.S.C. 112, 4th paragraph:
 - i. a dependent claim cannot be broader than the claim from which it depends
 - ii. up to 300 amps includes 0 to 300 amps
 - 1. example: if the specification discloses a 100-300 amp range the dependent claim is broader
 - iii. 3. open ended numerical ranges may render the claim indefinite:
 - 1. the term "up to" includes zero as a lower limit
13. 35 U.S.C. 112, 6th paragraph
- a. A claim limitation will be interpreted to invoke 35 U.S.C. 112, 6th paragraph if it meets the following 3 prong analysis:

1. the claim limitations must use the phrase "means for" or "step for"
2. the "means for" or "step for" must be modified by functional language
3. the phrase "means for" or "step for" must not be modified by structure, material or acts for achieving the specified function
- i. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, 6th paragraph, the applicant must either:
 1. amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or
 2. show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not provide any structure, material, or acts which would preclude application of 35 U.S.C. 112, 6th paragraph
- ii. Transitional phrases frequently used in claims and their meanings:
 1. Comprising:
 - a. is inclusive or open ended and does not exclude additional, unrecited elements or method steps
 - b. "including" and "characterized by" are synonymous with comprising
 2. Consisting essentially of:
 - c. limits the scope of a claim to the specified materials or steps; and
 - d. to those that do not materially affect the basic and novel characteristics of the claimed invention
 3. Consisting of:
 - e. cannot add an element or step, equal to comprising
 - f. the phrase "consisting of" excludes any step not specified in the claim
 - g. claim that depends from a claim which "consisting of" the recited steps cannot add a step
- iii. Inherency:
 1. under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device
- iv. Enabling references:
 1. the level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue
 2. it does not matter whether the prior art reference is a U.S. patent, foreign patent, printed publication or other
 3. a reference contains an enabling disclosure if the public was in possession of the claimed invention before the date of the invention
- v. Publicly accessible:
 1. prior art disclosures on the internet are thought of as publicly available once the item was posted, if there is no posting date, it cannot be relied upon as prior art, but it may be relied upon to provide evidence regarding the state of the art
 2. one need not prove someone actually looked at a publication when that publication is publicly accessible
 3. a printed publication has been made available to the extent that persons interested and ordinarily skilled in the subject matter or art, who exercise reasonable diligence, can locate it
- vi. Anticipation of ranges:

1. When a claim reciting ranges covers several compositions, the claim is anticipated if one of them is in the prior art

14. On The Exam

- a. There are several questions on prior art. One dealt with declassified material (prima facie case established even if only under limited distribution).
 - i. 707.05(f) Effective Dates of Declassified Printed Matter ...
 1. In the use of any of the above noted material as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute. For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a) the above noted declassified material may be taken as prima facie evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute an absolute statutory bar and its printing date may be antedated by an affidavit or declaration under 37 CFR 1.131.
- b. Know when an RCE can be used and when not.
 - i. 706.07(h) Request for Continued Examination (RCE) Practice
 - ii. CONDITIONS FOR FILING AN RCE
 1. The provisions of 37 CFR 1.114 apply to utility or plant applications filed under 35 U.S.C. 111(a) on or after June 8, 1995, or international applications filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE provisions of 37 CFR 1.114 do not apply to:
 2. a provisional application;
 3. an application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
 4. an international application filed under 35 U.S.C. 363 before June 8, 1995;
 5. an application for a design patent; or
 6. a patent under reexamination.
- c. An applicant may obtain continued examination of an application by filing a request for continued examination, a submission and the fee set forth in 37 CFR 1.17(e) prior to the earliest of:
 - i. (A) payment of the issue fee (unless a petition under 37 CFR 1.313 is granted);
 - ii. (B) abandonment of the application; or
 - iii. (C) the filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or the commencement of a civil action (unless the appeal or civil action is terminated).
- d. Know that a 1.131 declaration cannot be used to overcome a statutory bar. You can't antedate using 131 if the ref is a patent that claims the same invention.
 - i. Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131
 1. An affidavit or declaration under 37 CFR 1.131 is not appropriate in the following situations:
 - a. (A) Where the reference publication date is more than 1 year prior to applicant's or patent owner's effective filing date. Such a reference is a "statutory bar" under 35 U.S.C. 102(b) as referenced in 37 CFR 1.131(a)(2). A reference that only qualifies as prior art under 35 U.S.C. 102(a) or (e) is not a "statutory bar."
 - b. (B) Where the reference U.S. patent or U.S. patent application publication claims the same patentable invention. See MPEP § 715.05 for a discussion of "same patentable invention" and MPEP *Chapter 2300<.

Where the reference patent and the application or patent under reexamination are commonly owned, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103. See MPEP § 718.

- e. You can't use 103(c) exception if the 102(e) ref can be used under other 102s.
 - i. 706.02(l)(1) Rejections Under 35 U.S.C. 102(e)/103; 35 U.S.C. 103(c)
 - 1. 35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103. Subject matter that qualifies as anticipatory prior art under 35 U.S.C. 102 ** is not affected, and may still be used to reject claims as being anticipated. >In addition, double patenting rejections, based on subject matter now disqualified as prior art in amended 35 U.S.C. 103(c), should still be made as appropriate. See 37 CFR 1.78(c) and MPEP § 804.<
- f. Know how to overcome a 102 rejection - and know that nonanalogous art or teaching away are irrelevant for a 102 rejection (they matter for a 103 rejection only).
 - i. 706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent [R-2]
 - 1. A rejection based on 35 U.S.C. 102(b) can be overcome by:
 - a. (A) Persuasively arguing that the claims are patentably distinguishable from the prior art;
 - b. (B) Amending the claims to patentably distinguish over the prior art; *
 - c. (C) Perfecting priority under 35 U.S.C. 120 [...]
 - d. (D) Perfecting priority claim under 35 U.S.C. 119(e) [...]
- g. Know that there is a little wiggle room with the 1 year statutory period for 102(b) if publication is published on Sat Sun or holiday -- application must be filed on the Monday, or day after the holiday:
 - i. MPEP 706.02(a) Where the last day of the year dated from the date of publication falls on a Saturday, Sunday or Federal holiday, the publication is not a statutory bar under 35 U.S.C. 102(b) if the application was filed on the next succeeding business day.
- h. One question refers to the examiner's ability to require information from the applicant, MPEP 704.10 Requirements for Information. (If practitioner or applicant has no knowledge regarding requested information, it is a sufficient reply to say so).
- i. Know the 102(e) date for international applications (MPEP2136 & MPEP706.02(f)(1)).
- j. Know the four Graham Factual Inquires verbatim.
 - i. 2141 35 U.S.C. 103; the Graham Factual Inquiries
 - 1. Office policy is to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are as follows:
 - a. (A) Determining the scope and contents of the prior art;
 - b. (B) Ascertaining the differences between the prior art and the claims in issue;
 - c. (C) Resolving the level of ordinary skill in the pertinent art; and
 - d. (D) Evaluating evidence of secondary considerations.

- k. Also know these:
 - 1. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:
 - a. (A) The claimed invention must be considered as a whole;
 - b. (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
 - c. (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
 - d. (D) Reasonable expectation of success is the standard with which obviousness is determined.
- l. Don't get fooled by a non-103 102(e) rejection that was commonly owned at the time of the second invention.
 - i. 2136.01 Status of U.S. Application as a Reference
 - 1. When there is no common assignee or inventor, a US Application must issue as a patent or be published as a sir or as an application publication before it is available as prior art under 35 USC 102(e)
 - 2. When there is a common assignee or inventor, a provisional 35 USC 102(e) rejection over an earlier filed unpublished application can be made
- m. Questions may cover 35 U.S.C. 112 1st and 2nd paragraph, so you should know what those say - reportedly one questions also asks how the examiner approaches the underlying patentability.
 - i. 2161 Three Separate Requirements for Specification Under 35 U.S.C. 112, First Paragraph
 - 1. [...]This section of the statute requires that the specification include the following:
 - a. (A) A written description of the invention;
 - b. (B) The manner and process of making and using the invention (the enablement requirement); and
 - c. (C) The best mode contemplated by the inventor of carrying out his invention.
 - ii. 2171 Two Separate Requirements for Claims Under 35 U.S.C. 112, Second Paragraph
 - 1. There are two separate requirements set forth in this paragraph:
 - a. (A) the claims must set forth the subject matter that applicants regard as their invention; and
 - b. (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.
- n. Prior art exclusion 103(c). "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title [35 USC 102], shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Chapter 800 - Restriction in Applications filed Under 35 USC 111(a); Double Patenting

1. Restriction

- a. Restriction is the practice of requiring an election between distinct inventions. (Only one invention is allowed per patent.)
- b. Markush Claims
 - i. In applications containing Markush-type claims, the examiner may require a provisional election of a single species prior to examination on the merits.
 - ii. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable.
 - iii. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability.
- c. Election of species –
 - i. The inventor must elect between two or more patentably distinct forms of a generic invention claimed in same application. (Again, only one invention is allowed per patent.) For the election of species requirement, examiner must show:
 - 1. the generic claim embraces patentably distinct species; or
 - 2. those species exceed a reasonable number.
- d. Restriction Practice Features -
 - i. Restriction practice is always discretionary with the examiner.
 - ii. Lack of restriction is not a defect in a patent.
 - iii. No shifts are allowed from elected to non-elected subject matter; the following are not considered shifts:
 - 1. where a process is rejected as obvious, the only invention being in the product made, presenting claims to the product is not a shift,
 - 2. if a product is elected, there is no shift where the examiner holds the invention to be in the process, or
 - 3. if a genus is allowed, an applicant may prosecute a reasonable number of additional species thereunder and it's not a shift.
 - iv. RCE can't overcome a restriction requirement.

2. Criteria for Restriction

- a. The examiner must show the application claims independent or distinct inventions and examining all claimed inventions in a single application would be a serious burden. A restriction may be required in a divisional application, even though inventions were grouped together in a requirement in a parent application.

3. Restriction Procedure

- a. Restriction is usually done before first search.
- b. The examiner gives reasons for restriction (can be by phone).
- c. The applicant has one month to respond (extendable for up to 5 months).
- d. The applicant must elect an invention for examination, with or without traverse.
- e. If election is without traverse, no right to petition later on.
- f. The applicant must point out reasons why examiner erred.
- g. If no traversal, examiner withdraws non-elected claims from consideration – same result if traversal is improper.
- h. Only claims elected are examined.
- i. If traversal is proper, examiner will either withdraw the requirement or make it final.

4. Applicant disagrees but requirement is made final

- a. The applicant may petition and must have:
 - i. traversed the original requirement
 - ii. indicated why examiner was wrong

- iii. file petition (no fee) within one month after all elected claims are allowed or no later than filing a notice of appeal from rejected claims (no extension of time)
- 5. Applicant agrees with requirement
 - a. File a divisional application to the non-elected inventions. The parent case is not prior art against a co-pending divisional, if scope is similar.
- 6. Adding claims after election
 - a. If original claims relate only to one invention (no election necessary) and new claims to a patentably distinct invention are added after the Office Action, the new claims will be deemed withdrawn (constructive election).
- 7. After elected claims are allowed
 - a. If applicant traversed, examiner will give one month (no extension of time) to cancel non-elected claims or file a petition to director. If applicant did not traverse, examiner can cancel the non-elected claims without notice and applicant will receive a notice of allowance.
- 8. Rejoinder
 - a. MPEP 821.04
 - i. "The propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance, and the nonelected invention(s) should be considered for rejoinder. Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected invention on the merits."
 - b. Product and Process claims in same application, product claims elected
 - i. if the product claims are elected and one or more are subsequently allowed, withdrawn process claims will be rejoined.
 - c. Product claims only
 - i. if the original application discloses the product and process for making or using the product, but only claims the product, and a claim is found allowable, the applicant may present claims directed to the process via amendment.
 - d. Product and Process claims in separate applications (not as a result of restriction), no rejoinder
 - i. the second application may be rejected under obvious type double patenting.
- 9. Improper Restrictions
 - a. a single claim (including Markush and design)
 - b. claims clearly unpatentable over each other
 - c. claims differing only in form or scope
 - d. means plus function apparatus claim and a method claim using same language without "means for"
- 10. Types of Related Inventions (for determining if restriction is proper)
 - a. For combination/sub-combination claims, restriction is not appropriate when the invention resides in the sub-combination. This requires both two way distinctness and reasons for insisting on restriction. The inventions are distinct only if it can be shown that the claimed combination:
 - i. does not require the particulars of the sub-combination for patentability; and
 - ii. the sub-combination has utility either by itself or in other and different combinations.
 - b. A product and process of making the product
 - i. can be distinct inventions if either:
 - 1. the process as claimed is not an obvious process of making the product and can be used to make other products; or

2. the product as claimed can be made by another, different process.
 - c. A product and process using the product
 - i. can be distinct if either:
 1. the process of using as claimed can be practiced with a different product; or
 2. the product as claimed can be used in a materially different process.
 - d. Intermediate/Final Product Restrictions –
 - i. intermediate and final products are clearly not dependent, so to make a restriction, distinctness must be shown. Distinctness can be shown if the intermediate product is useful other than to make the final product.
11. Double Patenting
- a. Double patenting applies to:
 - i. same inventors, and
 - ii. common owner/assignee, even if different inventors.
 1. If there is no common ownership, terminal disclaimer will not apply and 2nd application will not be allowed to issue.
 - b. Double patenting prevents the same inventor or owner from obtaining a second patent on the same invention or an obvious variant thereof. Double patenting only concerns cases of two or more patents or applications with common inventors or owners.
 - c. Double patenting issues can arise between two or more applications, an application and a patent, or in reexam or international application if US is involved.
 - d. Provisional double patenting rejections –
 - i. Provisional double patenting rejections is proper if the first filed application has not yet issued as a patent at the time the rejection of claims in the second application occurs.
 - e. Types of double patenting –
 - i. Statutory (Same Invention–Type) Double Patenting – inventor is allowed only a single patent on an invention:
 1. same inventor or owner
 2. at least one application must be involved
 3. identical subject matter
 4. analysis is claim by claim
 - ii. Solutions –
 1. 1) cancel offending claims or
 2. 2) amend claims
 - iii. Non-Statutory (Obvious-Type) Double Patenting –
 1. designed to prevent improper time extensions by patenting something that is not patently distinct from the parent.
 2. same inventor or owner
 3. at least one application must be involved
 4. “does any claim in the application define an invention that is merely an obvious variant of an invention claimed in the patent?”
 5. “was applicant prevented from presenting the same claims in the issued patent?”
 - f. Tests -
 - i. One Way Obviousness –
 1. if the invention described in the applicant’s claim is an obvious variant of the invention in the claim of the patent: There is enough evidence for an obvious type double patenting rejection if:
 - a. the application (in question) is the later filed application or both applications were filed on same day;

- b. if the application (in question) is the earlier filed application, a one way obvious type double patenting is still proper UNLESS: 1) administrative delay on part of the PTO caused a delay in prosecution of the earlier filed app; and 2) the applicant could not have filed the conflicting claims in a single application.
 - ii. Two Way Obviousness –
 - 1. if applicant could not have filed the claims at issue in a single application and there is administrative delay, and the application on which the patent was granted is the later filed application, then a two-way obviousness determination is necessary for rejection. (The claim in the 2nd application can only be rejected for obvious type double patenting if it is an obvious variant of the claim in the first patent and if the claim in the first patent would be an obvious variant of the claim in the second patent.)
Solutions – try to overcome by arguing patentable distinctness; or file a terminal disclaimer in the later application:
 - a. disclaim entire terminal term of all claims in the second patent beyond normal expiration of first
 - b. cannot disclaim terminal term of specific claims
 - c. must include statement that common ownership will be maintained
 - d. fee
 - e. terminal disclaimer will not work for same type double patenting
 - f. no term extension for later patent past date of TD
 - g. not an admission of the correctness of the rejection
 - h. put all claims into one application if possible
 - g. Domination Distinguished –
 - i. a broad claim in one patent or application that completely encompasses a narrower claim in another patent or application does not imply double patenting.
 - h. Double Patenting and Restriction –
 - i. no double patenting rejection may be made in a divisional application over a parent patent (or application) where the examiner imposed a restriction and scope is same. This prohibition is not available if:
 - 1. applicant voluntarily files 2 or more cases without an examiner imposed restriction requirement;
 - 2. claims of 2nd are drawn to the same invention as 1st;
 - 3. restriction requirement was only made in an international application before it entered the national stage in the US;
 - 4. or the requirement for restriction is withdrawn before the patent issues.
 - i. Double Patenting between utility patents and design/plant patents –
 - i. allowed where appropriate;
 - ii. usually a two way analysis.
12. **On The Exam**
- a. Restriction Requirement - Linking claim questions.
 - i. 809.03 Linking Claims
 - 1. There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the claims of the application to one would be proper, but presented in the same case are one or more claims (generally called “linking” claims) inseparable therefrom and thus linking together the otherwise divisible inventions.

Chapter 900 - Prior Art, Classification, Search

1. Prior art
 - a. if an abandoned application was previously published, that patent application publication is available as prior art as of its patent application publication date
 - b. a patent application publication is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and 102(b)
 - c. pending U.S. applications filed before November 29, 2000, that are not voluntarily published, and applications filed on or after November 29, 2000, which have not been published, are generally preserved in confidence
2. Proper prior art references:
 - a. canceled matter:
 - i. matter that is canceled from the application file wrapper of a U.S. patent may be used as prior art
 - ii. it will count as prior art as of the patent date since it is then considered prior public knowledge under 35 U.S.C. 102(a)
 - iii. it will not be considered a proper reference as of the filing date under 35 U.S.C. 102(e)
 - b. copending abandoned applications:
 - i. if a patent refers to and relies on the disclosure of a copending abandoned application, the disclosure will be considered a prior art reference
 - ii. if a reference patent claims the benefit of a copending but abandoned application disclosing the same subject matter as the patent, the abandoned application may be considered prior art
 - iii. the effective date of the reference in regards to the common subject matter is the filing date of the abandoned application
 - c. foreign patents:
 - i. in general, a foreign patent and the contents of its application should not be cited as a reference until an examiner can confirm its date of patenting or publication by reviewing a copy of the document
3. **On The Exam**
 - a. Recent test takers have noted that the following subject matter from Chapter 900 appear on the exam:
 - i. How do examiners search for prior art?
 1. The examiner, upon understanding the invention disclosed and claimed in the application, searches the prior art which may be disclosed in patents and other published documents. Any such document used in the rejection of the claim is called a reference. [MPEP 904]
 2. In all Continuing Applications, the examiner should review the parent application and this fact should be made part of the record.
 3. A first search should be adequate enough not to require a second search for prior art. A second search may be necessitated by amendments of to check prior art cited in the first PTO action subsequent to the initial prior art search.
 4. In the first action on the merits of an application, the examiner shall make an initial endorsement, in black ink on the file wrapper, of the classes and subclasses of domestic and foreign patents, abstract collections, and publication in which the search for prior art was made. The examiner must also identify other information collected and sources in which the search for prior art was made, and also indicate the date(s) on which the search was conducted.
 5. General search guidelines

- a. Conducting a thorough search of the prior art requires three distinct steps by the examiner that are critical for a complete and thorough search:
 - i. 1) identify the field of search,
 - ii. 2) selecting the proper tool(s) to perform the search (discretionary), and
 - iii. 3) determining the appropriate search strategy for each search tool selected (discretionary).
 - b. Three Reference Sources Required - Determining the field of search the examiner must consider domestic patents (including patent application publications), foreign patent documents, and non-patent literature.
- ii. Conducting searches at the USPTO Office –
 - 1. Test takers reported the following answers to a question on the exam:
 - a. displaying a user pass in the TC search facility
 - b. removing patent publications from their shoes
 - c. re-shelving materials yourself or leave them for contract staff to handle

Chapter 1000 - Matters Decided by Various US Patent and Trademark Office Officials

1. 37 CFR 1.181

- a. this allows for the applicant to petition an action or requirement from the examiner, where the event is not one that can be appealed.
- b. A petition filed under 37 CFR 1.181 must:
 - i. Contain a statement of facts to be reviewed and action to be requested.
The request may include supporting briefs, affidavits, or declarations.
 - 1. If the petition is directed toward an examiner action, it may be required that there be a sufficient request for consideration and a repeated action of the examiner.
 - ii. Include with the petition any required fee
 - iii. Include with the petition a nonextendable 2 month time limit of the action of which a relief has been requested.

Chapter 1100 - Statutory Invention Registration (SIR)

1. Statutory Invention Registration:
 - a. an original SIR can be abandoned and replaced by a continuing application:
 - b. in this case, the applicant will get the earlier filing date
 - c. the applicant must file an express abandonment of the original application and a timely request or petition to withdraw the request for an SIR prior to the publication of the SIR
2. Publication
 - a. nonprovisional utility and plant applications filed on or after November 29, 2000 are published promptly after the expiration of 18 months from the earliest filing date for which benefit is sought
 - b. nonprovisional applications entering the national stage from an international application filed on or after November 29, 2000 will also be published
 - i. this is regardless of whether the international application was published by the International Bureau under PCT Article 21 in English
 - c. The following applications will not be published:
 - i. provisionals
 - ii. designs
 - iii. reissues
 - d. Exceptions to publication include when:
 - i. the application is recognized by the Office as not pending
 - ii. its status has been changed to abandoned by the Office and has been removed from the publication process
 - iii. the application is under a secrecy order
 - iv. the application has already issued in sufficient time for it to be removed from the publication process
 - v. however, the Office will not stop with the publication process until a patent actually issues
 - vi. the application was filed with a nonpublication request
3. Rescission
 - a. A rescission of a nonpublication request will never receive the benefit of a certificate of mailing or transmission. The USPTO will use the actual date of receipt at the Office.
4. **On The Exam**
 - a. You should know about third party submissions:
 - i. 1134.01 Third Party Submissions Under 37 CFR 1.99
 1. [...] To balance the mandate of 35 U.S.C. 122(c) and the Office's authority and responsibility under 35 U.S.C. 131 and 151 to issue a patent only if "it appears that the applicant is entitled to a patent under the law," the Office permits third parties to submit patents and publications (i.e., prior art documents that are public information and which the Office would discover on its own with an ideal prior art search) during a limited (2 month) period after publication of an application in compliance with 37 CFR 1.99. However, 37 CFR 1.99 prohibits third parties from submitting any explanation of the patents or publications, or submitting any other information.

Chapter 1200 - Appeal

1. Who can appeal and when?
 - a. Once the claims of an application have been rejected twice, the applicant may appeal:
 - i. a patent owner involved in a reexamination proceeding may appeal from the final rejection
 - ii. a third party may appeal from the final decision of the administrative patent judge in an inter partes proceeding
2. Rules governing Appeal briefs:
 - a. after filing a Notice of Appeal, the appellant must also file an Appeal Brief
 - b. the Appeal Brief is due 2 months from the date the Notice of Appeal is filed by the appellant
 - c. the applicant has two months from the receipt date on the Notice of Appeal this time may be extended
 - d. extra days are added to the calendar day of the original period as opposed to being added to the day it would have been due when said last day is a Sat, Sun or Fed holiday
 - e. although the failure to file an Appeal Brief within permissible time will result in a dismissal of an appeal, if any claims stand allowed, the application will not become abandoned by the dismissal, but will be returned to the examiner for action on the allowed claims
3. A sample timeline for an Appeal Brief:
 - a. 9/19/02 Notice of Appeal
 - b. 11/19/02 Appeal Brief is initially due; however, the nonstatutory time period is extended under 37 C.F.R. 1.136(a)
 - c. 3/18/03 Appeal Brief actually filed (with a 4 month extension)
 - i. the failure to file the brief within permissible time will result in the dismissal of appeal
4. Withdrawing an appeal:
 - a. If an application is appealed, and then the applicant became aware of prior art publications material to the patentability of a claim, he or she should request to withdraw the appeal
 - b. The applicant can withdraw the appeal by:
 - i. filing a request for a continuing examination of the application and notifying the Board of the change
 - ii. an appellant may withdraw an appeal at any time, however, unless there are claims allowed, the withdraw will result in the abandonment of the application
5. Reply brief:
 - a. the appellant may file a reply brief after receiving the examiner's answer
 - b. filing a reply brief after the examiner's answer is the applicant's right, but the examiner may choose whether or not to take action on it
6. Amendments to an appeal:
 - a. The entry of a new amendment, new affidavit, or other new evidence in an application on appeal is not a matter of right, the Board may always refuse an amendment
7. Jurisdiction is transferred:
 - a. from the examiner to the Board within 2 months from the examiner's answer, plus mail room time
 - b. after a supplemental examiner's answer has been mailed, pursuant to a remand from the Board
 - c. after the examiner has notified the appellant by written communication that the reply brief has been entered and considered and the application will be forwarded to the Board
8. Rehearing:

- a. Once a decision is made by the Board, the applicant will have two months to request a rehearing
- 9. Decision by the Board:
 - a. If the Board decides that no claims are allowed, then:
 - i. the proceedings in the application are terminated - this will take effect as of the date the time for filing a court action has expired
 - ii. the application is no longer considered as pending and it will be abandoned
- 10. If the Board decides any claims are allowed:
 - a. the appellant is not required to file a reply
 - b. an applicant who is dissatisfied with a decision by the Board may appeal the decision to the U.S. Court of appeals for Federal Circuit, or may have a remedy by civil action against the commissioner in a U.S. District Court for the District of Columbia
- 11. **On the exam**
 - a. Concept from repeat question [Jones over Smith (10.03.45p)] - 37 CFR § 1.192(c)(7); MPEP § 1206, under the heading "Appeal Brief Content," subheading "(7) Grouping of Claims."
 - i. 37 CFR §1.192(c)(7) requires that an appellant perform two affirmative acts in the brief to receive separate consideration of the patentability of a plurality of claims that are subject to the same rejection. The appellant must:
 - 1. (1) state that the claims do not stand or fall together and
 - 2. (2) present arguments why the claims subject to the same rejection are separately patentable.
 - b. know MPEP 1213.02, since answers to some questions can be found word for word in this section
 - i. 1213.02 New Grounds of Rejection by Board [R-3]
 - 1. 37 CFR 41.50. Decisions and other actions by the Board.
 - a. (b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:
 - i. (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.
 - ii. (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the

Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

- b. (f) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings. Under 37 CFR *41.50(b), the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case, including claims which have been allowed by the examiner. While the Board is authorized to reject allowed claims, this authorization is not intended as an instruction to the Board to examine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on different grounds from those applied against the rejected claims. Since the exercise of authority under 37 CFR *41.50(b) is discretionary, no inference should be drawn from a failure to exercise that discretion. See MPEP § 1214.01 for the procedure following a new ground of rejection under 37 CFR *41.50(b).
- c. Know that in an appeal if applicant argues claims 1, 4 and 6 in brief the examiner must consider 1, 4 and 6 separately on their merits.
 - i. 1205 Appeal Brief
 - 1. (vii) Argument. [...] For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.
- d. 8/10/2008 Most of the questions on appeals required an understanding of what options the Applicant has if a new ground of rejection is brought up.
 - i. The Applicant has the option to reopen prosecution on just the claims that have been rejected on new grounds, and can submit a second appeal based on this rejection if twice rejected in reopened prosecution.

Know under what circumstances the application is returned to the board. See particularly, MPEP 1214.01.

1. 1214.01 Procedure Following New Ground of Rejection by Board [R-3]

- a. When the Board makes a new rejection under 37 CFR *41.50(b)<, the appellant, as to each claim so rejected, has the option of:
 - i. (A)>reopening prosecution before the examiner by< submitting an appropriate amendment and/or **>new evidence (37 CFR 41.50(b)(1))<; or
 - ii. (B) requesting rehearing **>before the Board (37 CFR 41.50(b)(2))<.
- b. I. SUBMISSION OF AMENDMENT OR **>NEW EVIDENCE<
 - i. The new ground of rejection raised by the Board does not reopen * prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR *>41.50(b)< was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR *>41.50(b)< rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR *>41.50(b)< rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under 37 CFR *>41.50(b)< is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR *>41.50(b)< rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR *>41.50(b)< is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered.
- e. Know how to withdraw an appeal and what happens to allowed and rejected claims after withdrawal. See MPEP 1215. Note that an RCE filed without a fee may be sufficient to withdraw (1215.01) as is filing a continuation, but the Board

should be informed if the Applicant is awaiting a decision. Also, see MPEP 1214.05 for Examiner's treatment of allowed claims.

i. 1215.01 Withdrawal of Appeal

1. Prior to a decision by the Board, if an applicant wishes to withdraw an application from appeal and to reopen * prosecution of the application, applicant can file a request for continued examination (RCE) under 37 CFR 1.114, accompanied by a submission
2. To avoid the rendering of decisions by the Board in applications which have already been refiled as continuations, applicants should promptly inform the * >Chief Clerk< of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Applicants also should advise the Board when an RCE is filed in an application containing an appeal awaiting decision. Failure to exercise appropriate diligence in this matter may result in the Board refusing an otherwise proper request to vacate its decision. Upon the withdrawal of an appeal, an application< having no allowed claims will be abandoned. Claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected.
3. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:
 - a. (A) Claim 1 is allowed; claims 2 and 3 are rejected. The examiner should cancel claims 2 and 3 and issue the application with claim 1 only.
 - b. (B) Claims 1 - 3 are rejected. The examiner should hold the application abandoned.
 - c. (C) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1. The examiner should hold the application abandoned.
 - d. (D) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1; independent claim 3 is allowed. The examiner should cancel claims 1 and 2 and issue the application with claim 3 only.

f. Know situations when the board will Remand to the examiner:

i. 1211 REMAND BY BOARD [R-3]

1. The Board has authority to remand a case to the examiner when it deems it necessary. For example, the Board may remand **>a case for further consideration of a rejection pursuant to 37 CFR 41.50(a)(1) such as< where the pertinence of the references is not clear, the Board may call upon the examiner for a further explanation. >See MPEP § 1211.01.< In the case of multiple rejections of a cumulative nature, the Board may also remand for selection of the preferred or best ground. The Board may also remand a case to the examiner for further search where it feels that the most pertinent art has not been cited, or to consider an amendment**. See MPEP * § 1211.02, * § 1211.03 >and § 1211.04<. Furthermore, the Board may remand an application to the examiner to prepare a supplemental examiner's answer in response to a reply brief **>which the examiner only acknowledged receipt and entry thereof (e.g., by using form paragraph 12.181 on form PTOL-90). See MPEP § 1207.05 for more information on supplemental examiner's answer<.

Chapter 1300 - Allowance and Issue

1. Issue fee
 - a. Must be paid with 3 months from the date of the Notice of Allowance.
 - b. The Director cannot extend the time to pay the issue fee.
 - c. If new drawings are due, then they must be submitted before the 3 month period has expired.
 - i. Note: You cannot pay the issue fee late if your reason for doing so was to test the marketability of the invention prior to paying the fee. If this is done, such a delay does not constitute and unintentional delay for reviving an application.
2. Deferring Issuance of a Patent
 - a. The USPTO will allow you to defer issuance of patent for up to 1 month, unless there are very extraordinary circumstances which would require longer.
3. Withdrawal From Issue
 - a. After the payment of the issue fee, the patent application will only be withdrawn by petition from the applicant for:
 - i. A perceived unpatentability of one or more claims.
 1. The petition should include the claim that is unpatentable, an amendment to the claim, and a statement of how the amendment makes the claims patentable.
 - ii. a request for continued examination
 - iii. an express statement of abandonment of the application. You may abandon the application in order to file a continuing application.

Chapter 1400 - Correction of Patents

1. Certificate of correction:

- a. A certificate of correction is a mechanism to correct minor, non-substantive inconsistencies between the application as prosecuted and the patent ultimately issued (clerical corrections). A certificate of correction cannot be used to add new matter or for patents that require substantive reexamination.
- b. Who can request a certificate of correction?
 - i. If mistake is by the PTO: Commissioner acting sua sponte – on his own accord; Commissioner acting on information provided by 3rd party; or the patentee or assignee – no fee required.
 - ii. If mistake was applicant's fault: the patentee or assignee may request so long as error was made in good faith; fee required.
 - iii. 3rd Party – PTO has no duty to act upon or respond to 3rd party request for a certificate of correction; patentee is given opportunity to respond; 3rd party papers will not be entered into file wrapper.
- c. What types of errors are correctable via a certificate of correction?
 - i. Minor Errors – grammatical and typos in spec or drawings; if PTO's mistake, they have discretion not to issue certificate of correction and instead, may place request in file for public notice purposes
 - ii. Errors that Affect Understanding or Interpretation – misspelled words, error in name, missing text, wrong formula or equation
 - iii. Serious Errors (rare) – PTO may issue a corrected patent
- d. Certificate of correction procedure –
 - i. Applicant's or PTO's mistake - request made to certificate of correction branch of PTO; identify patent number and issue date; identify how errors occurred; include fee if not PTO's fault (no small entity discount); identify action requested (certificate of correction, corrected patent, letter in file); use of PTO form is encouraged
- e. Special certificate of correction procedures -
 - i. Rule 324 Petition to Correct Inventorship Errors: requires statement from each inventor being added that error occurred without deceptive intent on their part; statement from each inventor named (including those being deleted) agreeing to change; statement by all assignees agreeing to change; and fee
 - ii. court order can also change Inventorship
 - iii. Assignee Name Correction: Rule 183 Petition with fee; statement that failure to include was inadvertent; request that R3.81(a) be waived; and copy of Notice of Recordation of Assignment
 - iv. Priority-Related Errors – certificate of correction is proper to correct, only if: 1) domestic or foreign priority properly claimed but not printed on face of patent; 2) foreign priority perfected in a (non-design) parent application but not claimed in patented continuing application; 3) 119(e)/120 domestic priority not claimed in application filed before 11/29/00, but co-pending application to be added by certificate of correction is identified in application papers; or 4) 120 domestic priority not claimed in application filed on or after 11/29/00, but co-pending application to be added by certificate of correction is identified in application papers (requires R78(a)(3) – unintentional delay – and surcharge
- f. Legal effect of a certificate of correction –
 - i. Retroactive – becomes part of patent, and dates back to original issue date

2. Disclaimers

- a. What is a disclaimer?
 - i. A disclaimer is a mechanism for any (full or partial) owner of a patent to disclaim “too much” patent protection originally received. Two Types:

- ii. Statutory – patentee give up subject matter by disclaiming one or more claims of patent
 - iii. Terminal – patentee gives up a portion of the entire patent's term
 - b. Why use a disclaimer?
 - i. patentee discovers one or more claims are invalid (e.g., too broad) or defective and desires to delete such claims from the issued patent
 - ii. must be without deceptive intent (i.e., discovery must be subsequent to patent's issuance)
 - iii. patentee desires to dedicate one or more complete claims to the public;
 - iv. disclaimer is irrevocable and binding on the patentee/assignee's successors in interest
 - v. each joint inventor can only disclaim his percentage of the patent
 - c. Patent Disclaimer Procedure -
 - i. Addressed to correction of patents branch of PTO
 - ii. Identify Patent Number
 - iii. Identify claims or term to be disclaimed
 - iv. Identify disclaimant and their ownership interest in the patent
 - v. Include R20(d) Fee – small entity discount applies
 - vi. Signature by patentee/assignee or attorney
 - vii. Disclaimer is placed in file, attached to patent, and listed in OG
 - viii. Terminal Disclaimer filed in an application is revocable until patent issues
 - ix. Terminal Disclaimer filed in an application does not carry over to continuations (unless it says so), but it does carry over to CPAs and RCEs
- 3. Reissue:
 - 4. What is Reissue?
 - a. Reissue is a mechanism for correction of scope and contents of patent, which requires substantive examination. "The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy." A reissue patent offers to surrender original patent, at which point you file an amended application for the unexpired term of the original patent.
 - 5. Grounds for Reissue -
 - a. In order to broaden claims, must file for reissue within two years from the issue date of original patent
 - b. Cannot introduce any new matter
 - c. error in specification or claims, which occurred without deceptive intent, that renders patent wholly or partially inoperative or invalid
 - d. Commissioner may issue one or more patents based on reissue application (can file RCE, continuation and divisional applications off a reissue, but no CIP)
 - 6. What Errors Can Reissue Correct?
 - a. any inaccuracy or error which could have been corrected by amendment during prosecution or by filing a continuation in the original application
 - b. can also correct errors normally done by certificates of correction or Disclaimer only if incidental to Reissue process
 - c. can conform drawings to spec and vice versa – this is not new matter
 - d. can cure inadvertent failure to claim a statutory class of invention
 - e. can cure errors in Inventorship not curable by certificates of correction (e.g., lack of consent or all parties do not agree)
 - f. can cure errors in priority not curable by certificates of correction, but if patent issued from an application filed on or after 11/29/00: cannot cure failure to claim 119(e) priority (to provisional); and to cure foreign or 120 domestic priority in non-design patent requires a R78(a)(3) petition and the R17(t) surcharge
 - g. cannot cure R56 or 112P1 (best mode) violations, or totally defective oath

7. Types of Reissue -
 - a. Broadening – when patentee discovers claims are too narrow
 - i. new or different claims are sought that read on subject matter not read on by original claims;
 - ii. new claims directed to different statutory class of invention;
 - iii. even if some elements of a claim are narrowed, as long as any element is enlarged
 - iv. must be disclosed and enabled in original application spec;
 - v. two year time limit to file reissue (not to present broader claims)
 - vi. all parties (assignees and inventors) must agree
 - vii. Recapture Doctrine – applicant cannot broaden claims in an attempt to reclaim subject matter given up by a narrowing amendment, argument or cancellation in original application
 - b. Narrowing – when patentee becomes aware of prior art
 - i. seeks to amend claims
 - ii. may act like a disclaimer if any claims are eventually canceled
 - iii. Same Scope
 - iv. seeking to add claims of same scope is improper
 - v. may seek, however, to correct indefiniteness errors
 - vi. Interference
 - vii. patentee may seek to present new claims to provoke an interference (copying claims from another issued patent)
8. Reissue Application Filing Mechanics -
 - a. a copy of the patent spec (double column, single-sided sheet format), including the claims, and a clean copy of the drawings
 - b. a copy of any disclaimers, certificate of correction, or reexamination certificates issued in the patent, and disclose any other proceedings in which patent is or was involved
 - c. may file an amendment either on a separate sheet of paper or by “cutting and pasting” copy of patent. (All [deletions] and additions in spec must be noted; All deletions and additions in text of amended claims must be noted; statement of which claims are cancelled, and separate sheet with status of all claims; and Amendments to drawings must be shown on separate sheet and noted in red with “amended” label. Added drawings must have the “new” label. Deleted drawings must be completely enclosed in brackets and “cancelled.”)
 - d. must include statement of offer to surrender original patent; the actual ribbon original; or state that it is “lost or inaccessible,” at filing
 - e. Oath stating: applicant believes patent is wholly or partially inoperative or invalid by reason of claiming more or less, or defective spec or drawings; error arose w/o deceptive intent; specifying at least one error; all info required by R63; AND all assignees consent or statement that there’s no assignee
 - f. must be signed by all assignees, if any unless seeking to enlarge the scope of claims in which all inventors must sign as well
 - g. small entity discounts apply
9. Prosecution of a Reissue Application -
 - a. Reissue application prosecution is identical to examination of “normal” apps, with one exception: file is open to public for inspection and comment
 - b. upon filing reissue app, notice is published in OG, file is publicly accessible and 3rd parties may file R291 protest (2 months from OG)
 - c. filing a reissue app: reopens prosecution as to all claims; allows prior art of record to be reapplied; and there is no presumption of validity
 - d. reissue applications are granted special status
 - e. duty of disclosure applies
10. Effects of a Reissue Patent -

- a. Filing Date: given effective filing date of original app
- b. Result: after reissue application process, patentee may end up with original, broadened, narrowed, or no patent at all
- c. Issuance: when reissue patent issues, original patent is surrendered
- d. Expiration: expires when original patent would have expired
- e. Maintenance: fees based on original issue date and payable on same schedule
- f. Infringement: no effect for reissue patent claims that are common, or substantially identical, to original patent claims
- g. Intervening Rights For New Claims: between issue date of original patent and reissue patent, there is an absolute continued right to use or sell products manufactured before date of reissue and covered by new claims for those who actually relied on the original patent. Court may fashion equitable remedy for products manufactured after date of reissue if substantial preparation was made prior to reissue grant.

11. On The Exam

- a. Many questions in this area of correcting patents. In some, it was correction of inventorship of issued patents where they gave you C.F.R. 1.48 (applying to applications) and wanted to see if you recognized the difference. One on when you can file a reissue to correct inventorship (straightforward from MPEP). Know all the options well for both review of the scope and validity of issued patents, as well as correcting mistakes on issued patents.
 - i. MPEP 1412.04
 - 1. While reissue is a vehicle for correcting inventorship in a patent, correction of inventorship should be effected under the provisions of 35 U.S.C. 256 and 37 CFR 1.324 by filing a request for a Certificate of Correction if:
 - a. (A) the only change being made in the patent is to correct the inventorship; and
 - b. (B) all parties are in agreement and the inventorship issue is not contested.
- b. See MPEP § 1481 for the procedure to be followed to obtain a Certificate of Correction for correction of inventorship.
 - i. 35 U.S.C. 256. Correction of named inventor.
 - 1. Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error. The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.
- c. Know that you can't use 1.48 to fix inventorship in a patent and that you can't use Certificate of Correction if one of the inventors refuses. Know who has to sign a reissue that adds inventors when one of the inventors to be added refuses to participate.
 - i. 1412.04 Correction of Inventorship
 - 1. [...]Thus, the signatures of the inventors are not needed on the reissue oath or declaration where the assignee of the entire interest signs the reissue oath/declaration.

2. Where the name of an inventor X is to be deleted in a reissue application to correct inventorship in a patent, and inventor X has not assigned his/her rights to the patent, inventor X has an ownership interest in the patent. Inventor X must consent to the reissue (37 CFR 1.172(a)), even though inventor X's name is being deleted as an inventor and need not sign the reissue oath or declaration.
3. Where an inventor is being added in a reissue application to correct inventorship in a patent, the inventor being added must sign the reissue oath or declaration together with the inventors previously designated on the patent.
4. In the situation where a patent to inventors X and Y has no assignee and a reissue application is filed by inventor Y to delete the name of inventor X as an inventor and to broaden the patent. Inventor X refuses to sign the reissue oath or declaration and refuses to provide the consent as required by 37 CFR 1.172(a). In this instance, a 37 CFR 1.47 petition would not be appropriate to permit the filing of the reissue application since the consent requirement of 37 CFR 1.172(a) for each owner/assignee is not met. Resort to the courts would be required to delete the name of inventor X as an inventor where X will not consent to the filing of a reissue application.

Chapter 1500 - Design Patents

1. Statutes and Rules Applicable
 - a. Design applications are not included in the Patent Cooperation Treaty.
2. Distinctions Between Design and Utility Patents
 - a. In general terms, a "utility patent" protects the way an article is used and works (35 U.S.C. 101); while a "design patent" protects the way an article looks (35 U.S.C. 171). The ornamental appearance for an article includes its shape/configuration or surface ornamentation upon the article, or both. Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance.
 - b. The term of a design patent is 14 years from the date of grant
 - c. Design patent applications can have only 1 claim.
 - d. Utility patent applications may claim the benefit of a provisional application under 35 USC 119(e) whereas design patent applications may not.
3. Elements of a design patent application
 - a. The arrangement of the elements of a design patent application and the sections of the specification are as specified in 37 CFR 1.154.
 - b. § 1.154 Arrangement of application elements in a design application.
 - c. The elements of the design application, if applicable, should appear in the following order:
 - i. Design application transmittal form.
 - ii. Fee transmittal form.
 - iii. Application data sheet (see § 1.76).
 - iv. Specification.
 1. The specification should include the following sections in order:
 - a. Preamble,
 - b. stating the name of the applicant,
 - c. title of the design, and
 - d. a brief description of the nature and intended use of the article in which the design is embodied.
 2. The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.
 - v. Drawings or photographs.
 - vi. Executed oath or declaration (see §1.153(b)).
 - vii. Cross-reference to related applications (unless included in the application data sheet).
 - viii. Statement regarding federally sponsored research or development.
 - ix. Description of the figure or figures of the drawing.
 - x. Feature description.
 - xi. A single claim.
4. Drawing
 - a. The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim.
 - b. Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines.
5. Examination
 - a. In design patent applications, ornamentality, novelty, nonobviousness enablement and definiteness are necessary prerequisites to the grant of a patent.
6. Computer-Generated Icons
 - a. Computer-generated icons are patentable material under design patents.
 - b. Computer type fonts are patentable material under design patent applications.
7. Design Patent Novelty
 - a. Under 102(d), a statutory bar exists in design patents if the foreign application was filed more than 6 months before the U.S. application was filed.

8. Nonobviousness
 - a. In determining patentability under 35 U.S.C. 103(a), it is the overall appearance of the design that must be considered.
 - b. In order to support a holding of obviousness, a basic reference must be more than a design concept; it must have an appearance substantially the same as the claimed design.
9. Restriction
 - a. A restriction requirement can be made if the design patent application discloses multiple designs that are independently or patentably distinct from each other.
10. Double Patenting
 - a. A nonstatutory double patenting rejection of the obviousness-type applies to claims directed to the same inventive concept with different appearances or differing scope which are patentably indistinct from each other.
 - b. Nonstatutory categories of double patenting rejections which are not the "same invention" type may be overcome by the submission of a terminal disclaimer.
11. Priority Under 35 USC 119 (a)-(d)
 - a. The provisions of 35 U.S.C. 119(a)-(d) apply to design patent applications. However, in order to obtain the benefit of an earlier foreign filing date, the United States application must be filed within 6 months of the earliest date on which any foreign application for the same design was filed.
 - i. Design applications may not make a claim for priority of a provisional application under 35 U.S.C. 119(e).
12. Benefit Under 35 USC 120
 - a. When the first application is found to be fatally defective under 35 U.S.C. 112 because of insufficient disclosure to support an allowable claim and such position has been made of record by the examiner, a second design patent application filed as an alleged "continuation-in-part" of the first application to supply the deficiency is not entitled to the benefit of the earlier filing date.
13. **On the exam**
 - a. Know that foreign priority for a design patent is only 6 months not 12 like utility patent.
 - i. 1502.01 Distinction Between Design and Utility Patents,
 1. (F) Foreign priority under 35 U.S.C. 119(a)-(d) can be obtained for the filing of utility patent applications up to 1 year after the first filing in any country subscribing to the Paris Convention, while this period is only 6 months for design patent applications (see 35 U.S.C. 172).
 - b. Design patents are not tested extensively. However, test takers report that they occasionally encounter a question from one of the following:
 - i. Design patents consist of drawings, drawing descriptions, and a single claim. A brief narrative is optional.
 - ii. Design patents have a 14 year term.
 - iii. Design must be reproducible
 - iv. No claim to provisional
 - v. Must be novel and non-obviousness
 - vi. Computer generated icons can receive design patents
 - vii. No offensive subject matter
 - viii. 112 applies
 - ix. © symbol can accompany design with a waiver to PTO
 - x. "The ornamental design for (the article) as shown."
 - xi. No Maintenance Fees
 - xii. No publication
 - xiii. 6 months to claim priority to foreign applications
 - xiv. No RCE; no reissue

Chapter 1600 - Plant Patents

1. Introduction: The Act, Scope, Type of Plants Covered
 - a. Tuber propagated plants such as the Irish potato and the Jerusalem artichoke may not be the subject of plant patents.
 - c. The plant for which seeking a patent must be reproduced asexually.
2. Applicant, Oath or Declaration
 - a. The applicant for a plant patent must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought
 - b. The oath or declaration required of the applicant must state that he or she has asexually reproduced the plant.
 - c. Where the plant is a newly found plant, the oath or declaration must also state that it was found in a cultivated area.
3. Specification and Claim
 - a. A plant patent is granted only on the entire plant. It, therefore, follows that only one claim is necessary and only one is permitted.
4. Drawings
 - a. Plant patent drawings should be artistically and competently executed. 2 copies of color drawings or photographs must be submitted.
5. Specimens
 - a. Specimens of the plant variety, its flower or fruit, should not be submitted unless specifically called for by the examiner.

Chapter 1700 - Miscellaneous

1. Restrictions on former examiners
 - a. employees of the PTO may not prepare, prosecute or even aid in the prosecution of any patent application during their employment and for an additional two years afterward
 - b. prosecution of any patent application before this 2 year period by a previous patent examiner must be cleared by the PTO
2. The Official Gazette
 - a. The Official Gazette provides a weekly report of all the reexamination certificates, reissues, plant patents, utility patents, design patents, statutory invention registrations and other important information published that week.
3. the Official Gazette prints the following information for each patent it lists:
 - a. applicant's name
 - b. applicant's city and state of residence or Post Office address, if unassigned, or if assigned, the assignee's name, city and state of residence, and Post Office address
 - c. filing date
 - d. application number
 - e. patent number
 - f. title of the invention
 - g. number of claims
 - h. U.S. classification by class and subclass
 - i. a selected figure of the drawing, if any, except in the case of a plant patent
 - j. a claim or claims
 - k. any international classification
 - l. U.S. parent application data, if any
 - m. foreign priority application date, if any
 - n. for reissue patents: the original patent number and issue date, and the original application number and filing date
4. Disclosure Documents
 - a. the PTO will accept and preserve "Disclosure Documents" for two years as evidence of the date of conception of an invention
5. "Disclosure Documents" should include:
 - a. a paper disclosing the invention with the inventor(s) signature
 - b. the document should be forwarded to the PTO by the inventor, owner of the invention or attorney or agent
 - c. it should include a clear explanation of the manner and process of the invention in enough detail for a person skilled in the art to be able to make and use the invention
 - d. the Disclosure Document will be kept on file for two years and then destroyed unless it is referred to in a separate letter in a related patent application filed within those two years
6. An overview of the Document Disclosure program:
 - a. it is a document that an inventor can submit with a separate cover sheet and paper describing the invention
 - b. the document will be retained for two years
 - c. the document can serve as proof of the conception of the invention
 - d. it is legally given no more weight other than proof of conception, it will not hold a filing date or protect the invention
7. Disclosure Documents:
 - a. are not a patent application, the date of its receipt at the PTO will not become the filing date of any patent application disclosing the same material
 - b. will be kept in confidence
 - c. may be relied upon only as evidence of the conception of the invention
 - d. a patent application should be filed immediately if protection is desired

- e. the two year period is not a "grace period", an inventor may lose all benefits by waiting

Chapter 1800 - Patent Cooperation Treaty

1. Patent Cooperation Treaty (PCT):
 - a. The Patent Cooperation Treaty (PCT) establishes a system for filing international patent applications. PCT is applicable to utility patents only, not design patents.
 - b. A PCT application that designates the US is a US patent application, even if it is filed in another receiving office.
 - c. The 102(b) statutory bar is measured back from the PCT filing date
 - d. R1.48 may not be used to correct inventorship in a national stage application where the inventors were named erroneously in the application (i.e., the national stage of PCT application).
 - e. Section 365 (c) is a special case. An international application (PCT) may be treated as the parent application until 30 months from the international filing date, and an applicant may file a continuation application within that time.
 - f. For applications filed on or after 11/29/00, if any claim for benefit is made to a prior PCT application, the first sentence of the specification must state whether the application was published in the English language. (This does not apply to the national stage of a PCT application.)
 - g. The PCT application is published -
 - i. A PCT application may claim priority to an earlier filed US application, and a US application may claim priority to an earlier filed PCT application.
2. International Applications Filed in US
 - a. Who –
 - i. A PCT application designating the U.S. must include one applicant who is a resident or national of the U.S. and the application must be made in name of inventors.
 - b. How to file –
 - i. PCT applications may not be filed via fax
 - c. What to file –
 - i. PCT request,
 - ii. abstract and filing fees are typically paid upon filing but may be paid subsequently
 - iii. the priority claim should be made when filing the application; if priority is to a prior US application, a certified copy of the priority application to the International Bureau will be submitted
 - iv. filing implicitly carries a request for a foreign filing license
 - d. For a filing date, you need -
 - i. indication that at least one applicant is a resident or national
 - ii. indication that application is an international app
 - iii. designation of at least one contracting state
 - iv. name of applicants
 - v. description in English
 - vi. drawings
 - vii. at least one claim
 - viii. if the application designate US, name, address, signature of EACH inventor (or attorney) and any application to which domestic priority is claimed shall be included
 - ix. indication as to which international search authority
3. International Stage
 - a. Chapter I
 - i. the following events occur or may occur:
 1. the ISA determines whether there is unity of invention
 2. the ISA establishes a search report
 3. the applicant has one opportunity to amend the claims within 2 months after establishment of search report
 4. the application is published at 18 months

5. applicant may file a demand for Chapter II proceedings (19 month)
 6. applicant may enter the national stage in any designated state (30 month)
 7. a Chapter II demand may be filed via fax
 8. applicant may demand examination for all or fewer of the states originally designated; these states become elected states
- b. Chapter II
- i. if the applicant files a chapter II demand by the 19 month date, the application will be subjected to international preliminary examination before an international preliminary examining authority (IPEA)
 - ii. the IPEA will usually issue a written opinion based on the search report and other aspects of the application (optional)
 - iii. the applicant has the opportunity to reply to the written opinion, such reply may include arguments and amendments to the claims
 - iv. the international preliminary examination report (IPER) will issue
 - v. the written opinion will discuss novelty, inventive step, and industrial applicability, as well as unity of invention and formal matters
 - vi. the IPER will provide a statement as to novelty, inventive step, and industrial applicability; it is not a statement as to patentability
4. National Stage - 365(c)
- a. Deadline to enter national stage is 30 months from first priority date/PCT filing date. To enter US national stage, applicant must file:
 - i. 1) fee,
 - ii. 2) when required, a copy of the international application and English translation,
 - iii. 3) when required, amendments with English translations, and
 - iv. 4) oath/declaration of the inventor. In practice, usually the fee and cover sheet are all that is required by the 30-month deadline.
 - b. A petition to revive may be filed if the application does not meet the necessary requirements by the 30-month date.
 - c. The application is subject to publication if the PCT application was filed on or after 11/29/00.
5. **On The Exam**
- a. Know that the US went to 30 month national stage on April 1, 2002 and that any application entering the national stage after that date regardless of filing date may enter at 30 months. PCT Article 22(1) changed effective 4/1/02: 30 month from priority to national stage.
 - b. Know what has to be submitted when filing the international application and what when entering the national stage.
 - c. Know what happens when a US resident files an IA with the USPTO as the receiving office, but the application is filed in Japanese.
 - i. The PTO is not competent to be a receiving office for any apps in a language other than English, and if the app was in a language accepted by the International Bureau, it would be given a filing date and forwarded to the IB upon payment of a fee.
 - ii. PCT Rule 19.4 provides for transmittal of an international application to the International Bureau as Receiving Office in certain instances. For example, when the international application is filed with the United States Receiving Office and the language in which the international application is filed is not accepted by the United States Receiving Office, or if the applicant does not have the requisite residence or nationality, the application may be forwarded to the International Bureau for processing in its capacity as a Receiving Office.
 - iii. The Receiving Office of the International Bureau will consider the international application to be received as of the date accorded by the

United States Receiving Office. This practice will avoid the loss of a filing date in those instances where the United States Receiving Office is not competent to act, but where the international application indicates an applicant to be a national or resident of a PCT Contracting state or is in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office. Of course, where questions arise regarding residence or nationality, i.e., the U.S. is not clearly competent, the application will be forwarded to the International Bureau as Receiving Office. Note, where no residence or nationality is indicated, the U.S. is not competent, and the application will be forwarded to the International Bureau as Receiving Office so long as the necessary fee is paid. The fee is an amount equal to the transmittal fee.

- d. Know 1803: If the US is the only contracting state in an international application, the international application will not be published at 18 months. Know this!
 - i. 1803 Reservations Under the PCT Taken by the United States of America
 - 1. [...]It has also declared that, as far as the United States of America is concerned, international publication is not required (PCT Article 64 (3)). Accordingly, under PCT Article 64(3)(b), if the United States is the only PCT Contracting State designated in an international application, the international application will not be published by the International Bureau (IB) at 18 months. Even though the United States Patent and Trademark Office has begun pre-grant publication under 35 U.S.C. 122(b), the United States has not removed its reservation under PCT Article 64(3) because not all United States patent applications are published. See 35 U.S.C. 122(b)(2). The application will, however, be published under 35 U.S.C. 122(b) if it enters the national stage in the United States. It will be published again if it is allowed to issue as a United States patent.
- e. PCT filing requirement, National stage filing requirement: Know that Translation and Oath can be filed later
 - i. 1893.01(e) Oath/Declaration
 - 1. If the basic national fee has been paid and the copy of the international application (if required) has been received by expiration of 30 months from the priority date, but the required oath or declaration, <translation>, search fee (37 CFR 1.492(b)), examination fee (37 CFR 1.492(c)), or application size fee (37 CFR 1.492(j))< has not been filed **>prior to commencement of the national stage (see MPEP § 1893.01)<, the Office will send applicant a **>notice< identifying any deficiency and provide a period of time to correct the deficiency as set forth in 37 CFR 1.495(c). The time period usually set is 2 months from the date of the notification by the Office or 32 months from the priority date, whichever is later. This period may be
- f. Know the details around claiming priority to a foreign patent for a PCT and what is required for claiming priority when entering the US National Stage. Specifically, know the timing for filing a claim and whether certified copies and translations are required.

Chapter 1900 - Protest

1. What is a protest:
 - a. a protest is a means for a third party to challenge whether a pending application should issue
2. Submitting a protest:
 - a. any member of the public or an attorney can file a protest without naming his or her client
 - b. the real party of interest does not need to be identified
 - c. the same party of interest may not file a subsequent protest unless they explain why the subsequent protest brings up issues that are significantly different from the earlier protests
3. Protest filings:
 - a. active participation by the protestor ends with the filing of the initial protest and no further submission on behalf of the protestor will be acknowledged or considered unless the submission is made pursuant to 37 CFR 1.291(c)(5).
4. When to submit a protest:
 - a. protests may be filed throughout the pending of a reissue application prior to the date of mailing the Notice of Allowance
 - b. protests for reissue applications should be filed within the 2-month period following their announcement in the Official Gazette if possible
 - c. where a final rejection has been issued or the prosecution on the merits has been otherwise closed for a reissue application, a petition under 37 CFR 1.182 along with the required fee for entry of the protest are required
5. Compliance
 - a. a protest that is submitted in compliance with 37 CFR 1.291(a), (b) and (c) will be considered by the Office if the protest is matched with the application in time to permit review by the examiner during prosecution
 - b. the receipt of the self-addressed postcard from the Office is not an indication that the protest complies with 37 CFR 1.291
 - i. a. the postcard receipt only shows that the Office has received the protest
 - c. improper protests will be returned to the protestor or discarded at the option of the Office
6. effective November 22, 2004, 37 CFR 1.291(c) was amended to no longer permit the submission of additional (cumulative) prior art by the same real party in interest

Chapter 2000 - Duty of Disclosure

1. Duty to disclose:
 - a. All the information material to the patentability of the invention must be disclosed to the Office with candor and good faith
2. Rules governing the duty to disclose:
 - a. the information includes more than just patents and printed publications
 - b. it includes all presently known information
 - c. the duty exists until the application becomes abandoned
 - d. it exists even after the patent is issued
3. Who has a duty to disclose?
 - a. each inventor, each registered practitioner, each assignee, every other person involved substantially in preparation or prosecution of application
 - b. it does not extend to typists, clerks or corporations
4. On the exam
 - a. This chapter is not tested too intensively. You should know who has a duty to disclose:
 - i. 2001.01 Who Has Duty To Disclose - Individuals having a duty of disclosure are limited to those who are "substantively involved in the preparation or prosecution of the application."
 1. This is intended to make clear that the duty does not extend to typists, clerks, and similar personnel who assist with an application.

Chapter 2200 - Citation of Prior Art and Ex Parte Reexamination of Patents

1. Citation of Prior Art
 - a. What?
 - i. Presentation of prior art patents and/or printed pubs to the PTO for placement in a patent's file
 - b. Why?
 - i. To ensure that art will be considered in subsequent reissue or reexamination proceedings
 - c. Who?
 - i. Any person, including the patent owner, but not examiners
 - d. When?
 - i. May cite prior art that has a bearing on the patentability of any claim of a particular patent at any time during period of enforceability of patent (expiration date plus 6 years)
 - e. Restrictions?
 - i. Citations of prior art will not be entered into a patent's file during a pending reexam, unless submitted by the patent owner; another reexamination requester; or as part of a 3rd party requestor's reply.
 - ii. Filing Procedure must include:
 1. cover sheet identifying patent, issue date and patentee;
 2. list of pertinent prior art (not already of record in patent file);
 3. explanation of pertinence of prior art cited, including application to at least one claim of the patent;
 4. If by 3rd party – Certificate of Service or duplicate copy of papers
 5. NO FEE
 6. "Poor Man's Reexam"
 - iii. May also include:
 1. copy of each piece of prior art (English translations if necessary)
 2. affidavits or declarations relating to prior art documents (e.g., explaining effective date of art)
 3. If by patent owner – explanation of how claims of patent differ from cited prior art
 - f. PTO Handling of Prior Art Citations -
 - i. forwarded to relevant Tech. Center
 - ii. if citation is proper and was filed by patent owner, it is entered into file
 - iii. if citation is proper and was filed by 3rd party, it is entered into file, and notice and duplicate copy of papers (if filed) sent to patent owner
 - iv. if citation is proper and was filed by 3rd party, but patent is under reexam, it is put in storage until reexam is terminated, notice sent to 3rd party (if known), and notice and duplicate copy of papers sent to patent owner
 - v. if citation is not proper and was filed by patent owner, it is returned to owner
 - vi. if citation is not proper and was filed by 3rd party, notice is sent to 3rd party, notice given to patent owner, duplicate copy of papers sent to owner, and original copy returned to 3rd party (if known, else to owner)
2. Ex Parte Reexamination of Patents
 3. A reexamination of a patent is a mechanism for correction of scope and contents of patent because there exists a substantial new question as to the patentability of one or more claims therein based on other patents or printed publications. (Do not mistake with reexam of an application.)
 4. Who can request an ex parte reexam?
 - a. Commissioner on his own accord; patentee; or any interested 3rd party (corp. or individual).
 5. Mechanics of an ex parte reexam request -

- a. must be in writing, giving a statement pointing out each substantial new question of patentability: proper basis – patent or printed pub serving as a basis for 102a,b,e,f,g,103 and DP; and admissions by patentee, but only in combination with patents or printed pubs; improper basis – 112, fraud, or on-sale or public use bars under 102(b)
 - b. Fee – no small entity discount
 - c. Submit: copy of patent with any disclaimers, certificate of correction, or reexam certificates issued in the patent; and copy of each patent and printed pub relying upon (and English translation)
 - d. Must identify claims for which reexamination is sought and the pertinence of prior art being submitted to each such claim
 - e. If by 3rd party, certificate of service to patentee or duplicate copy of papers if service was not possible; and preferably copy of power of attorney if filed by attorney/agent for 3rd party
 - f. If by patentee, may also file proposed amendment; request will be considered on claims of issued patent; prosecution will begin, if reexam is granted, based on amended claims
 - g. Timing – must be filed within period of enforceability of patent
 - h. PTO will give requester notice and time (typically 1 month) to respond if request contains any defects
6. Ex Parte Reexamination Procedure -
 - a. request is announced in OG
 - b. Assigned to same Art Unit (but usually not same examiner)
 - c. PTO must decide whether to grant reexam within 3 months of request
 - d. If Denied (no substantial new question of patentability):
 - i. order denying reexam is sent to requestor and patentee
 - ii. requester may petition for reconsideration once within one month of initial decision
 - iii. initial decision and decision on petition is final and nonappealable
 - iv. requester receives partial refund
 - e. If Granted:
 - i. examiner will issue an order granting reexamination to requestor and patentee that states each substantial new question of patentability with respect to specific claims and prior art; and her position with respect to each issue raised by requestor in the proper form
 - ii. examiner's position may be same or different from requestor's
 - iii. Patentee may file R181 Petition to vacate reexam order if they believe grant was improper
 - iv. During reexam, all communications by patentee or 3rd party requestor to the PTO must be served on the other party
 - v. During reexam, file is open to public for inspection
7. Owner's Statement -
 - a. patentee may file owner's statement within 2 months of, but not before, order granting reexamination
 - b. Extension of Time is typically one month and are only available for good cause (R550c)
 - c. owner's statement must particularly point out why claims are patentable over prior art, and may include an amendment
8. Requestor's Reply to Owner's Statement -
 - a. If owner's statement is filed, 3rd party requestor may file a reply brief within 2 months
 - b. Extension of Time is not available for filing reply
 - c. reply is limited to issues raised in owner's statement
 - d. reply may include additional prior art and printed pubs (see previous)
 - e. reply is the requestor's last chance to participate in ex parte reexam
9. Special Characteristics of Ex Parte Reexamination Prosecution -

- a. reexam proceedings are conducted with special dispatch
 - b. all claims are examined for 102 and 103 issues without deference
 - c. only new or amended claims are also examined for 112 issues
 - d. duty of disclosure applies
 - e. interviews are only allowed after first OA, and patent owner must file statement of reasons presented during interview in a separate paper or in next reply to OA
 - f. correction of inventorship is allowed
 - g. reexaminations are never abandoned
 - h. no filing of continuation applications is allowed
 - i. only patent owner can appeal to the Board (not 3rd party)
 - j. appeal process is the same as inter parte prosecution except for Extensions of Time (on or after 11/29/99, must be final rejection)
10. Ex Parte Reexamination Office Actions -
- a. First OA should be completed within one month and mailed within 6 weeks of filing/due date of: owner's statement if no 3rd party requestor; or reply if 3rd party requestor
 - b. First OA should address all claims; not include any restriction requirements; and only raise 112 issues as to new or amended claims
 - c. Issues beyond scope of reexam should be noted by examiner, but not addressed, with suggestion for reissue
 - d. Reply to first OA is typically due in 2 months (1 month if reexam ordered by court or stayed) with only good cause Extension of Time (must be filed before due)
 - e. Reply is same as ex parte prosecution, but amendments must be in [Rule 530 d-j format]
 - f. Failure to file reply to an office action results in termination of reexam and issuance of reexam certificate in accordance with last office action; rule 137 petition (unintentional or unavoidable) is the only way to revive
 - g. Second OA is typically final
11. Conclusion of Ex Parte Reexamination -
- a. if examiner issues a final rejection, 2 month period for patent owner to reply or appeal
 - b. if first response to a final rejection is a reply, patent owner get automatic one month Extension of Time
 - c. if no final rejection or appeal, examiner will issue a notice of intent to issue a reexam certificate (NIRC) which states reasons for allowance
 - d. no issue fee is required after ex parte reexam
 - e. reexam certificate is published in OG
 - f. intervening rights (as in reissue) exist
12. Multiple Reexamination Requests -
- a. if subsequent request involves the same prior art cited in first reexam, it is automatically granted
 - b. if subsequent request involves different prior art than that cited in first reexam, a decision whether to grant is made on its own merits
 - c. if there is more than a three month difference between the date of a second request and the expected issue date of a reexam certificate in the first proceeding, the group director will merge first and subsequent reexaminations and suspend issuance of reexam certificate from first proceeding. When merged, patent owner must file original, identical papers in both files; same claims must be pending in both files; and examiner will issue identical OA in both files; but multiple reexam certificates will issue.
 - d. if date of second request is within three months of expected issue date of reexam certificate in first proceeding, the group director will not normally merge proceedings, but any subsequent request will be decided with respect to new claims issuing from first reexam

13. Ex Parte Reexaminations in Conjunction with Other Proceedings -
- a. patent owner must disclose any other proceedings to examiner (e.g., litigation, reissue and interference)
 - b. Reexamination – Interference: reexam is typically not stayed for resolution of interference
 - c. Reexamination – Reissue: typically two proceedings are merged, reissue rules apply and reissue patent also serves as a reexam certificate
 - d. Reexamination – Litigation: If litigation is stayed pending reexam or if court orders reexam, then certain time periods are shortened in reexam proceedings; final decision by court that claims are invalid or unenforceable is binding on PTO

14. **On The Exam**

- a. For a re-exam, remember that only patents and printed publications can be used.
 - i. 2204 Time for Filing Prior Art Citation
 - 1. A prior art citation is limited to the citation of patents and printed publications and an explanation of the pertinence and applicability of the patents and printed publications.

Chapter 2300 - Interference Proceedings

1. Interference basics:

a. Requirements -

- i. Claims must not be identical, but they must have the same subject matter
- ii. An Inter partes proceeding is between [2 patent applications] or [1 patent and 1 application]
 1. §1.131 cannot be used to “swear behind” (i.e., provide additional evidence in establishing a date of invention) a patent claiming the same invention; but it can be used to swear behind a patent disclosing same invention
- iii. Senior party has earliest effective filing date and becomes the Defendant
- iv. A party wins if they were first to conceive and diligent starting before the other party’s conception and later filing date

b. Provoking an Interference -

- i. Applicant may provoke by: proposing a count (mock claim); presenting or identifying a claim (in an application) corresponding to count; identifying other pending application (issued patent); and explain why interference should be declared
- ii. Applicant can copy a claim from another pending application or issued patent verbatim at the suggestion of examiner

c. Timing –

- i. provoking an interference with an issued patent must normally be done less than one year from issue date; good faith Extension of Time; if published and applicant’s filing date was after publication, the copying must be done less than one year from publication date
- ii. When two applications are involved, examiner will not suggest copying if more than 3 months difference in filing dates if simple; and 6 months if not simple
- iii. Once interference is filed, each party has access to opponent’s file
- iv. If interfering applications or application/patent have the same inventive entity or common assignee, then double patenting rejection is proper
- v. Failure to comply with suggestion (usually non-extendable 1 month) acts as a disclaimer to uncopied subject matter
- vi. Declarations must be filed only with an issued patent/pending application interference
- vii. Parties may voluntarily settle before interference terminates by filing written agreement with PTO

d. Burden of Proof -

- i. The issue in an interference between applications is normally priority of use, but the rights of the parties to registration may also be determined. The party whose application involved in the interference has the latest filing date is the junior party and has the burden of proof.
- ii. When there are more than two parties to an interference, a party shall be a junior party to and shall have the burden of proof as against every other party whose application involved in the interference has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. The issue in an interference between an application and a registration shall be the same, but in the event the final decision is adverse to the registrant, a registration to the applicant will not be authorized so long as the interfering registration remains on the register.
- iii. There is a higher standard of proof if the patent is already issued (clear and convincing) compared to if two applicants are pending (preponderance).

2. **On The Exam**

- a. Which of the following situations, if any, would be an improper reason for holding a patent application abandoned?
 - i. Copying claims from a U.S. patent which the examiner used to reject all of the claims in the application under 35 USC 102.
- b. When an application is under a secrecy order, which of the following statements is true?
 - i. If all the claims in the application are finally rejected, the rejection must be appealed or otherwise prosecuted to avoid abandonment.
- c. Your attorney is on vacation and cannot invoke an interference. The attorney invokes the interference after coming back from vacation, but it is already 1 year after the patent in question has issued. What can you do?
 - i. You can't do anything, as your invoking of an interference was too late and beyond one year after publication of the patent, or in this case, issuance of the patent. This is according to 35 USC 135(b).

Chapter 2400 - Biotechnology

1. Deposit Rules
 - a. where the invention involves a biological material and words alone cannot sufficiently describe how to make and use the invention in a reproducible manner, access to the biological material may be necessary for the satisfaction of the statutory requirements for patentability under 35 U.S.C. 112
2. The requirements for patent applications containing nucleotide sequence and/or amino acid sequence disclosures - the sequence rules
 - a. there is a standardized format for the descriptions of nucleotide and amino acid sequence data submitted as a part of patent applications
 - b. one application may contain more than one nucleotide or amino acid sequence within it
 - i. the required submission of that data must be in computer readable form
3. **One The Exam**
 - a. There was a question on Biotech sequence listings where it asked the format of the submission. The problem with this question is that 2400 points out two different kinds of submissions, and it's not clear if they mean CRF or the regular sequence listing and if it's possible to submit two different copies.
 - b. Submittal of nucleotide and/or amino acid sequence in an application (from MPEP 2422) appeared on the exam.

Chapter 2500 - Maintenance Fees

1. Maintenance fees are required on all patents issued after December 12, 1980 except design or plant patents
2. The fees are due at three time periods throughout the life of a patent:
 - a. 3 years and 6 months after grant, \$830.00
 - b. 7 years and 6 months after grant, \$1,900.00
 - c. 11 years and 6 months after grant, \$2,910.00
3. There is a grace period of 6 months which begins after the three time periods previously mentioned, the grace periods end at:
 - a. 4 years after grant
 - b. 8 years after grant
 - c. 12 years after grant
4. When paying during the 6 month grace period, there is a surcharge required in addition to the payment of the maintenance fee

Chapter 2600 Optional Inter Partes Reexamination

1. Introduction

- a. The optional inter partes alternative provides third party requesters with a greater opportunity to participate in reexamination proceedings, while maintaining most of the features which make reexamination a desirable alternative to litigation in the Federal Courts (e.g., low cost relative to Court proceedings, expedited procedure). The optional inter partes alternative also provides third party requesters with appeal rights to appeal to the Board of Patent Appeals and Interferences (Board) and to participate in the patent owner's appeal to the Board.
- b. For any inter partes reexamination proceeding commenced on or after November 2, 2002, the third party requester also has the appeal rights to appeal to the Court of Appeals for the Federal Circuit and to participate in the patent owner's appeal to the Federal Circuit. For an inter partes reexamination proceeding commenced prior to November 2, 2002, however, no appeal rights are provided for the third party requester to appeal to the Court of Appeals for the Federal Circuit, nor to participate in the patent owner's appeal to the Court. See MPEP § 2683.

2. Inter Partes Reexamination

- a. The inter partes reexamination statute and rules permit any third party requester to request inter partes reexamination of a patent which issued from an original application was filed on or after November 29, 1999, where the request contains certain elements (see 37 CFR 1.915(b)) and is accompanied by the fee required under 37 CFR 1.20(c)(2).
- b. The Office initially determines if "a substantial new question of patentability" (35 U.S.C. 312(a)) is presented. If such a new question has been presented, reexamination will be ordered. The reexamination proceedings which follow the order for reexamination are somewhat similar to regular examination procedures in patent applications; however, there are notable differences.
 - i. For example, there are certain limitations as to the kind of rejections which may be made, a third party requester may participate throughout the proceeding, there is an "action closing prosecution" and a "right of appeal notice" rather than a final rejection, special reexamination forms are to be used, and time periods are set to provide "special dispatch." When the reexamination proceedings are terminated, an inter partes reexamination certificate is issued to indicate the status of all claims following the reexamination.
- c. The basic characteristics of inter partes reexamination are as follows:
 - i. Any third party requester can request inter partes reexamination at any time during the period of enforceability of the patent (for a patent issued from an original application filed on or after November 29, 1999);
 - ii. Prior art considered during reexamination is limited to prior patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103;
 - iii. A substantial new question of patentability must be present for reexamination to be ordered;
 - iv. If ordered, the actual reexamination proceeding is essentially inter partes in nature;
 - v. Decision on the request must be made not later than three months from its filing date, and the remainder of proceedings must proceed with "special dispatch" within the Office;
 - vi. If ordered, a reexamination proceeding will normally be conducted to its conclusion and the issuance of an inter partes reexamination certificate;
 - vii. The scope of the patent claims cannot be enlarged by amendment;
 - viii. Reexamination and patent files are open to the public, but see paragraph

- ix. The reexamination file is scanned to provide an electronic copy of the file. All public access to and copying of reexamination proceedings may be had from the electronic copy. The paper file is not available to the public.
- 3. Request for Inter Partes Reexamination
 - a. Any third-party requester, at any time during the period of enforceability of a patent issued from an original application filed on or after November 29, 1999, may file a request for an inter partes reexamination by the Office of any claim of the patent based on prior patents or printed publications.
- 4. Person Who May File A Request
 - a. Any person, other than the patent owner, may file a request for inter partes reexamination of a patent. The patent owner is precluded from initiating an inter partes reexamination of its patent because 35 U.S.C. 311(a) provides that "[a]ny third party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301." Ex parte reexamination and reissue are available to the patent owner to have its patent reviewed.
- 5. Incomplete Request for Inter Partes Reexamination
 - a. If the fee is not paid in full, the request for reexamination will be considered incomplete and a decision on the merits will not be made.
- 6. Scope of Inter Partes Reexamination
 - a. Inter partes reexamination differs from ex parte reexamination in matters of procedure, such as when the third party requester can participate, the types of Office actions and the timing of issuance of the Office actions, and the requirement for identification of the real party in interest. Inter partes reexamination also differs from ex parte reexamination in the estoppel effect it provides as to the third party requesters and when the initiation of a reexamination is prohibited.
 - b. Inter partes reexamination does not, however, differ from ex parte reexamination as to the substance to be considered in the proceeding.
- 7. Third Party Comments after patent owner response
 - a. A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an inter partes reexamination proceeding. The third party requester comments must be filed within a period of 30 days from the date of service of the patent owner's response on the third party requester.
- 8. Oral Hearing
 - a. If an appellant or a respondent desires an oral hearing in an appeal of an inter partes reexamination proceeding, he/she must file a written request for such hearing, accompanied by the fee set forth in 37 CFR 41.20(b)(3), within two months after the date of the examiner's answer. There is no extension of the time for requesting a hearing.
- 9. Issuance of Inter Partes Reexamination Certificate
 - a. After the proceedings have concluded, a reexamination certificate will issue.
 - b. The inter partes reexamination certificate will set forth the results of the proceeding and the content of the patent following the reexamination proceeding. The certificate will:
 - i. cancel any patent claims determined to be unpatentable;
 - ii. confirm any patent claims determined to be patentable;
 - iii. incorporate into the patent any amended or new claims determined to be patentable;
 - iv. make any changes in the description approved during reexamination;
 - v. include any statutory disclaimer or terminal disclaimer filed by the patent owner;
 - vi. identify unamended claims which were held invalid on final holding by another forum on any grounds;

- vii. identify any patent claims not reexamined;
- viii. be mailed on the day of its date to the patent owner at the address provided for in 37 CFR 1.33(c), and a copy will be mailed to the requester; and
- ix. refer to patent claims, dependent on amended claims, determined to be patentable. If a certificate issues which cancels all of the claims of the patent, no further Office proceedings will be conducted with regard to that patent or any reissue application or reexamination request directed thereto.

Chapter 2700 Patent Terms and Extensions

1. Patent Term
 - a. The term of a utility or plant patent will begin on the date the patent issues and will end 20 years from the filing date of the application.
 - b. If the application claims benefit of an earlier filed application, the 20 year term begins from the filing date of the earliest publication being for which priority is being claimed.
 - c. A provisional application or a foreign application's filing date has no effect on the term of the patent.
 - d. Design patents will have a patent term of 14 years that begins on the date the patent is granted.
 - e. Patents that issue from applications filed before June 8, 1995, are not eligible for patent term extension or patent term adjustment under 35 U.S.C. 154.
2. Term Extensions or Adjustments for Delays
 - a. Utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension provisions of former 35 U.S.C. 154(b) and 37 CFR 1.701.
3. Patent Term Extension for Delays at other Agencies
 - a. The patent term of a patent can be extended based upon the length of the regulatory review.
 - b. An application for the extension of the term of a patent must be submitted by the owner of record or its agent within the 60 day period beginning on the date the product received permission for commercial marketing or use.
 - c. The Commission will notify the Secretary of Agriculture or HHS within 60 days of an application for patent term extension.
 - d. Within 30 days, the Secretary will respond to the Commissioner with the determination of the length of the regulatory review period.
 - e. The Commissioner will then calculate the length for extension based on the length of regulatory review.
4. **On The Exam**
 - a. The exam may include a question or two on patent term adjustment / patent term extension. One question is said to refer to an app filed before 5/29/2000.
 1. 2710 Term Extensions or Adjustments for Delays Within the USPTO Under 35 U.S.C. 154
 1. Utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term ** extension * provisions of former 35 U.S.C. 154(b) and 37 CFR 1.701. See MPEP § 2720. Utility and plant patents issuing on applications filed on or after May 29, 2000 are eligible for the patent term adjustment provisions of 35 U.S.C. 154(b)(amended, effective May 29, 2000) and 37 CFR 1.702-1.705. See MPEP § 2730.
 2. 2720 Applications Filed Between June 8, 1995, and May 28, 2000
 1. The twenty-year term of a patent issuing from an application filed on or after June 8, 1995, and before May 29, 2000, may be extended for a maximum of five years for delays in the issuance of the patent due to interferences, secrecy orders and/or successful appeals to the Board of Patent Appeals and Interferences or the Federal courts in accordance with 37 CFR 1.701.
 3. 2730 Applications Filed on or After May 29, 2000; Grounds for Adjustment
 1. Basically, for applications after May 29, 2000 it appears that the 5 year maximum has been replaced with "the period of adjustment will not exceed the actual number of days the issuance of the patent was delayed (35 U.S.C. 154(b)(2)(A))"

and there is a GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including:

- a. (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- b. (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- c. (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

Part 10 Rules

1. Disclosure of information to authorities
 - a. A practitioner possessing unprivileged knowledge of a violation of a Disciplinary Rule shall report such knowledge to the Director.
2. Advertising
 - a. The practitioner may advertise his/her services so long as the communication includes the name of a practitioner responsible for the advertising.
 - b. No fee or article of value may be paid to someone for referrals, outside of the customary cost of advertising.
3. Withdrawal from Employment
 - a. The practitioner cannot quit without permission.
 - b. The practitioner must provide adequate time for the applicant to find new counsel and must return all papers and property to which the client is entitled.
 - c. If the client seeks to submit claims not supported by PTO procedures or law, or pushes the practitioner to do something illegal, the practitioner may immediately withdraw from employment.
4. Canon 7
 - a. A practitioner should represent a client zealously within the bounds of the law.
5. **On The Exam**
 - a. The Director may, after notice and opportunity for a hearing, suspend or exclude an individual shown to be incompetent from practice before the PTO.
 - b. At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.

