

MEEKS

PatBar's
HOME STUDY KIT
Study Guide

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Volume 1

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Important Program Instructions

PLEASE read the “Open Me First” memo and follow the instructions to register with our company.

The program starts with a number of introductory items, as follows:

- “Open Me First” Memorandum
- Introduction Lecture on CD
- Program Instructions
- Introductory Reading Assignment
- Glossary

You should follow the following steps:

- **You should read the “Open Me First” memo and register with our company. This will assure that you receive any information about changes to the exam in the 6-month period following your registration.**
- You should listen to the Introduction Lecture. The lecture is the first track on the first CD in the plastic box of CD's. The following items are in the front of the Study Guide Volume 1.
- You should read the Program Instructions (which you are reading now).
- You should read the Introductory Reading Assignment that follows the instructions.
- You should review the Glossary that follows the Introductory Reading Assignment.
- After completing the above 5 items, you are ready to start the course.

The course has two main parts as follows:

- The body of the course consisting of 92 study sessions.
- The post-course curriculum part of the course that follows the study sessions.

There are also two packs of flash cards and a book called, “Patent File Wrapper Book” (the white book) that can be used at any time, and they become more useful the further along you get in the study sessions.

There is also a CD-ROM called the Exam Simulation Suite™ CD that contains practice exams. It also contains an electronic version of the Manual of Patent Examining Procedure (MPEP) and the USPTO notices that will be tested on the exam.. This CD is in a orange paper envelope.

IMPORTANT* USPTO Notices *IMPORTANT

On the date that you purchased this review course, the exam will be testing a specific edition of the MPEP and possibly some additional notices that have been posted by the OED. Our program is based on these materials.

You will also receive two separate sheets called “Open Me First” and “Important Notice.”

If you have **Registered** with our company (see the “Open Me “First” memo for information on registering), over the next six months we will notify you if the examination materials are changing. When these changes will be made and what they may be is always maintained in confidence in the OED. We do not have any advance notice of these changes.

If there are changes, you may try to take the exam before they go into effect. If that is not possible, you must enter our web site to access the additional material relating to the changes. If you have not located the address for these materials that may be found in a separate sheet called “Important Notice” in our program, please send us an email requesting the address (director@patbar.com).

Any notices that are or will be tested are only available in electronic form. This is also true of the supplement that we provide for each notice. The supplement(s) that we produce will be much easier to study from (but will not, obviously, be available when you take the exam).

“All electronic materials available through our company are only available to the original purchaser of our patent bar review program.”

What’s New at the OED

Notice of Non-Disclosure Agreement

Anyone taking the registration examination is expressly prohibited from disclosing, publishing, reproducing, or transmitting the content, or substantially similar content, of the examination, in whole or in part, in any form or by any means, verbal or written, electronic or mechanical, for any purpose. Beginning April 2, 2013, at each test site, every applicant will be required to enter into a non-disclosure agreement as a condition to sitting for the examination. Applicants should expect to encounter the following text on a computer screen at the examination.

NON-DISCLOSURE AGREEMENT AND GENERAL TERMS OF USE FOR EXAMS DEVELOPED FOR THE OFFICE OF ENROLLMENT AND DISCIPLINE OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

This exam is confidential and proprietary. It is made available to you, the examinee, solely for the purpose of assessing your proficiency level in the skill area referenced in the title of this exam. You are expressly prohibited from disclosing, publishing, reproducing, or transmitting the content, or substantially similar content, of this exam, in whole or in part, in any form or by any means, verbal or written, electronic or mechanical, for any purpose. By clicking “Yes” below, you agree not to disclose, publish, reproduce, or transmit the content, or substantially similar content, of this exam, in whole or in part, in any form or by any means, verbal or written, electronic or mechanical, for any purpose.

Yes, “I have read and agree to the terms stated above.”

No, “I Do Not Agree.”

If the candidate does not agree, this text is shown, followed by a repeat of the above:

You have indicated that you do not accept the terms of the NON-DISCLOSURE AGREEMENT. If you choose "NO, I DO NOT AGREE" to the terms of the NON-DISCLOSURE AGREEMENT again, you will NOT be able to continue with the exam.

Click Next to view the Agreement.

The Study Sessions

There are 92 study sessions. Each study session (with two exceptions) includes a reading assignment, a lecture, and a batch of prior exam questions. Most of our students will do 1, 2 or 3 study sessions per day depending on their schedule.

The reading assignments include information about prior exam questions that have been tested on the exam. This material is very important and is contained in shaded boxes. You should fully understand everything in shaded boxes.

There are lightning bolts on the left side of most of the rules in the reading assignments. A lightning bolt means that you should try and remember the topic covered in the rule and the corresponding rule number. This is because on exam day you may realize that a specific rule is relevant and that you should access the rule in MPEP Appendix R. Without an idea of the rule number, it will be more time consuming to find the rule. A good

percentage of exam questions come down to an understanding of a single rule.

The lectures are a summary of the reading assignment. You should listen to the audio lecture on your CD player, and if possible read along in your study guide. Doing both is more educational.

The last step is to review and master the prior exam questions at the end of the study session. Each prior exam question is important, especially the ones that have been reported to have been used on the exam. As you are doing the questions, you should begin marking your answers since you should also do this on the exam. Marking answers means that you have narrowed your choices, and you mark off what you consider incorrect answers. For example, you have encountered a question that you feel is too difficult to worry about, and you are going to mark the question and come back at the end. On scrap paper, you put the question number followed by A B C D E, for example 11. A B C D E. You cross out incorrect answers. When you come back later you can benefit from your earlier analysis if you have marked your answers.

During the study sessions you should begin using the electronic version of the MPEP and the notices on the Exam Simulation Suite™ CD.

The Post Course Curriculum

Once you have completed the study sessions, then you begin the post course curriculum. During this phase you will take all the complete exams on the Exam Simulation Suite™ CD. You should master all of the exam questions on the CD. As you are taking the exams, you will begin using the electronic MPEP and the notices on the CD until you are proficient at searching the MPEP and the notices. You will also begin identifying your weaknesses, and continue to review material in those areas. As you can see, there are three aspects of exam preparation during this phase. When you have completed this phase, you are ready to take the exam.

The Flashcards

The flashcards are a memory aid, pure and simple. The "USPTO Rules" flashcards allows you to see three topics at once and you attempt to identify the corresponding rule numbers. The "MPEP Sections" flashcards allows you to see three sections of the MPEP and you to attempt to identify the corresponding MPEP sections. Of course you can use these cards any way you like, but the more you know about the location of topics in the MPEP and the rules (37 CFR) the better.

The Electronic Version of the MPEP

The Exam Simulation Suite™ CD contains an electronic version of the MPEP (and the notices that are being tested), in fact the exact same one in the same format as the one you will have when you take the exam. You should begin using this copy ASAP. You should begin learning and improving your navigation skills right from the start. There is a short paper called the "Exam Search Guide" at the end of the introductory items. You should read over this paper at the time you begin searching the MPEP, and at any time you need to refer to it.

When you get to the post course curriculum, you should be ready to begin searching for real and in earnest. In many ways it is very difficult to pass the patent bar without adequate knowledge and skills in the area of computer searching.

Email Customer Support (Email Help!!!)

When you need help, we have customer support. Send your email to:

David Meeks <director@patbar.com>

Please number your questions 1, 2, 3, etc., for ease of reference.

There are only three rules:

- You must complete a study session and send in your questions. Any email that appears to be a compilation over time will be ignored.
- You must request clarification and indicate exactly what point or points require clarification. Any question like, "can you explain topic X to me since I find it confusing" will be ignored.
- You must include your name. Any email without the sender's name will be ignored.

Customer support is only available to the original first purchaser of the course.

Prometric Tutorial

Please be aware of a Prometric tutorial at the following link:

<http://www.prometric.com/demos/uspto/starthere.htm>

Dates (e.g., December 20, 2011)

You will see many dates during your studies. It would be advantageous to jot these down as you go along for the purpose of knowing where dates are applicable. At the end you will have a list of all the dates for ease of reference.

Patent File Wrapper Book

The program includes the above referenced book. The book contains three complete patent file wrappers. You can pick this book up at any time, but it would be more useful after you have finished about half of the study sessions. The book contains instructions at the beginning.

Outlining

It is probably very advantageous to generate (in your own words) a short 30-40 page "Short Outline" of the material covered in the Study Guides and including information about prior exam questions tested on the exam. If possible, you should have this completed before the beginning of the Post Course Curriculum. It should include key words and phrases (including lists) that will refresh your memory concerning specific material and provisions. You should read over the outline as many times as possible during the 2-3 week period just before the exam. If you come upon a key word or phrase that does not refresh your memory sufficiently, go back to the MPEP (or notices) and sort it out.

Introductory Reading Assignment

Studying for the patent bar involves different types of material. The material relates to the following general categories:

- Administrative matters developed by the USPTO relating to patents and patent applications.
- Representation of inventors by patent agents and patent attorneys in the USPTO.
- Assignment and licensing of patent rights.
- The filing of patent applications including the filing of international applications under the Patent Cooperation Treaty.
- The prosecution of the patent application before the examiner.
- Appeals relating to patent applications when the applicant believes that he or she has not been afforded the claims in which he or she is legally entitled. (and)
- Procedures and requirements in patents such as maintenance fees, reexamination, reissue and certificates of corrections.

There are many topics under each general category. One of your first priorities is learning which topics belong to which chapters in the Manual of Patent Examining Procedure (MPEP). This is extremely important because the MPEP is preloaded on the computer that you will use to take the exam. The strange part of this is that each chapter of the MPEP, including the appendices are preloaded as separate files. This means that you can access and search just one file at a time. Unless you know the topics in each file, you will have a hard time opening the correct file when you need to search for something during the exam. The MPEP is broken into the following files.

- 27 separate chapters, for example Chapter 1200 is on appeals.
- An appendix containing the patent laws (35 U.S.C.) called Appendix L.
- An appendix containing the patent rules in (37 CFR) called Appendix R.
- A number of appendices relating to the Patent Cooperation Treaty and the Paris Convention.
- A comprehensive index.

The preloaded materials also includes many new files. These are notices that have been published by the USPTO and are being tested on the exam. The notices are also preloaded on the Exam Simulation Suite™ CD along with the MPEP. An edited version of the notices have been placed in the supplemental materials.

To properly search for a point or topic on the exam, you must be capable of entering the correct chapter (or notice), or the patent laws or rules if applicable, to do a successful search. If this is not possible, you will be forced to use the index, which is usually not very helpful and in any case involves more time.

You should always have this idea in the back of your mind that if you need help with a topic that you are studying, where should I go in the MPEP (or a notice). Should I go right to a rule that covers all the requirements for what I am studying, or should I go to a specific section in a chapter or a notice that would be more helpful.

We have provided two different types of flash cards to help you memorize as much as possible about the MPEP topics and rules and where they are located. If you know what chapter a topic is located in, or which rule is applicable, you are ready to quickly find what you need. If you are just floundering around the MPEP, you will probably pass only because you have memorized enough material so that searching is not a factor.

The second important priority is learning as much as possible about prior exam questions. This is because:

- Some of these questions will be on the exam you take.
- If a question is not exactly the same, it may be very similar or it may be testing a point in the exact same way.
- If you are familiar with a question before you go in to take the exam you will probably get it right on the exam. (and)
- This in many cases may avoid a time consuming search of the MPEP.

We have given you a huge head start in this area by doing as much exam question research (EQR) as humanly possible. We have identified what we think is about half or more of the question pool, and this information is provided in the study sessions. When we become aware of other exam questions, we will email you if you have sent us a registration email as explained in the "Open Me First" memorandum. Also plan to spend a significant amount of time in the last study session called "Transitioning." This is another place where we have provided information about exam questions.

The third priority is practicing complete exams. We have provided proprietary software for this purpose (a CD-ROM called the Exam Simulation Suite™ CD). After completing the 93 study sessions, your focus turns to practicing exams using the software. The software simulates the total exam experience including timing, navigation, and MPEP/notice search. The exam should become second nature by using this CD. You should understand the questions, how to quickly do an MPEP (or notice) search if necessary, how to mark a question if necessary, and how to move on to the next question (all with ease and without hesitation).

The last priority involves discovering your weaknesses during the exam practice sessions. You should become intimately aware of what you are strong on and where you are weak. When you discover a weakness, you must go back and review that topic again. By going back again and again, you are eliminating what would otherwise be wasted time doing searching on the exam, and rising levels of anxiety and frustration when you hit a

topic that draws a blank.

So always keep in mind the four priorities:

- Know where to find things in the MPEP (or a notice).
- Understand the prior exam questions explained or used in this course.
- Do all the practice exams on the Exam Simulation Suite™ CD.
- When you discover a weakness, go back and review the topic over again.

A few other points are worth mentioning:

You have studied for many exams before. Although this exam is different than most, you already know your style of learning. From that you should apply your own strategies for passing this exam.

Do not lose sight of the fact that building strengths in the topics covered in this course builds confidence. Confidence leads to the ability to select and mark the correct answer and move on, or the confidence to do a quick, efficient search and then mark and move on.

Any time lost floundering around the MPEP (or a notice), trying to find or select a chapter, trying to find a rule, or trying to use the index, will lead to frustration, anxiety, fatigue and usually a failing score at the end. You must avoid "drawing a blank" on any topic except for those few questions where even the best preparation is not enough. Those are the ones that you realize are beyond the scope of your preparation, so make your best guess and move on. If time permits, come back at the end and work on the question some more.

So as you can see the most important skill is studying a topic, remembering how the topic fits into the MPEP/notice scheme of things, and where to find the topic if needed. Since you cannot memorize everything, there will be times when you must enter the MPEP or a notice, so get very good at doing that too.

The next step is to read over the terms found in the glossary that follows.

David Meeks/Program Director

Glossary

(You should review the following words, phrases and acronyms with the hope of understanding as many as possible.)

Abandonment- A patent application becomes abandoned for failure to file a complete and proper reply as the condition of the application may require within the time period provided under 37 CFR § 1.134 and § 1.136 unless an Office action indicates otherwise. Abandonment may be either of the invention or of an application. An abandoned application, in accordance with 37 CFR §§ 1.135 and 1.138, is one which is removed from the Office docket of pending applications.

Abstract of the Disclosure- A concise statement of the technical disclosure including that which is new in the art to which the invention pertains.

ADS- Application Data Sheet

Patent Agent- May be referred to as a practitioner or representative. One who is not an attorney but is authorized to act for or in place of the applicant(s) before the Office, that is, an individual who is registered to practice before the Office.

Applicant- One or joint inventors who are applying for a patent on their own invention, or the person mentioned in 37 CFR 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor.

Patent application- An application for patent filed under 35 U.S.C. 111(a) that includes all types of patent applications (i.e., utility, design, plant, and reissue) except provisional applications. The nonprovisional application establishes the filing date and initiates the examination process. A nonprovisional utility patent application must include a specification, including a claim or claims; drawings, when necessary; an oath or declaration; and the prescribed filing fee.

Patent Application Number- The unique number assigned to a patent application when it is filed. The application number includes a two digit series code and a six digit serial number.

Assignment- A transfer of ownership of a patent application or patent from one entity to another. Record all assignments with the USPTO Assignment Services Division to maintain clear title to pending patent applications and patents.

Patent Attorney- May be referred to as a practitioner or representative. An individual

who is a member in good standing of the bar of any United States court or the highest court of any State and who is registered to practice before the Office.

Benefit Claim- The claiming by an applicant in a nonprovisional application of a benefit of an invention disclosed in a prior-filed copending (under examination at the same time) provisional or nonprovisional application, or international application designating the U.S. for the purposes of securing an earlier-effective filing date for the nonprovisional application.

Certificate of Mailing- A certificate for each piece of correspondence mailed, prior to the expiration of the set period of time for response, stating the date of deposit with the U.S. Postal Service and including a signature.

CIP- Continuation-in-Part-An application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the earlier nonprovisional application.

Claims- Define the invention and are what aspects are legally enforceable. The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery. The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable (clearly understood) by reference to the description.

Coinventor- An inventor who is named with at least one other inventor in a patent application, wherein each inventor contributes to the conception (creation) of the invention set forth in at least one claim in a patent application.

Confirmation Number- A four-digit number that is assigned to each newly filed patent application. The confirmation number, in combination with the application number, is used to verify the accuracy of the application number placed on correspondence filed with the Office to avoid misidentification of an application due to a transposition error (misplaced digits) in the application number. The Office recommends that applicants include the application's confirmation number (in addition to the application number) on all correspondence submitted to the Office concerning the application.

Continuation- A second application for the same invention claimed in a prior nonprovisional application and filed before the first application becomes abandoned or patented.

CPA- Continued Prosecution Application. A continuation or divisional application filed in a design application under 37 CFR 1.53(d).

Customer Number- A number assigned by the Office that is used to simplify the submission of an address change, to appoint a practitioner, or to designate the fee address for a patent. Customer numbers are primarily used by attorneys and law firms, and must be requested using the "Request for Customer Number" form.

Deceased Inventor- A named inventor who has died prior to the filing of a patent application or during the prosecution of a patent application.

Declaration- A document in which an applicant for patent declares, under penalty of fine or imprisonment, or both (18 USC 1001), that (1) he or she is the original or sole inventor, (2) shall state of what country he or she is a citizen, (3) that he or she has reviewed and understands the contents of the specification and claims which the declaration refers to, and (4) acknowledges the duty to disclose information that is material to patentability as defined by 37 CFR § 1.56. An oath or declaration must be filed in each nonprovisional patent application.

Dependent Claim- A claim that refers back to (depends on) and further limits a preceding dependent or independent claim. A dependent claim shall include every limitation of the claim from which it depends.

Deposit Account- An account that is established in the U.S. Patent and Trademark Office (USPTO), upon payment of a fee for establishing such an account, for the convenience in paying any fees due, in ordering services offered by the USPTO, copies of records, etc.

Design Patent Application- An application for a patent to protect against the unauthorized use of new, original, and ornamental designs for articles of manufacture.

Disclaim- A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer (give up all or part of the owner's rights to enforce claims) of any complete claim, stating therein the extent of their interest in such patent. Such disclaimers are required to be in writing and recorded in the USPTO, and are considered as part of the original patent to the extent of the interest actually possessed by the disclaimant and by those claiming under him. Any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term (from a certain point in time through the projected end of the entire term), of the patent granted or to be granted. There are two types of disclaimers: a statutory disclaimer and a terminal disclaimer.

Disclosure- In return for a patent, the inventor gives as consideration a complete revelation (describes it) or disclosure of the invention for which protection is sought.

Divisional Application- A later application for an independent or distinct invention disclosing and claiming (only a portion of and) only subject matter disclosed in the earlier or parent application.

Drawing- Patent drawings must show every feature of the invention as specified in the claims. Omission of drawings may cause an application to be considered incomplete but are only required if drawings are necessary for the understanding of the subject matter sought to be patented.

Element- A discretely claimed component of a patent claim.

Embodiment- A manner in which an invention can be made, used, practiced or expressed.

Enforceability of a Patent- The right of the patent owner to bring an infringement suit against a party who, without permission, makes, uses or sells the claimed invention. The period of enforceability of a patent is the length of the term of the patent plus the six years under the statute of limitations for bringing an infringement action.

Express Abandonment- A patent application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment becomes effective when an appropriate official of the Office takes action thereon. Express abandonment of the application may not be recognized by the USPTO before the date of issue or publication unless it is actually received by appropriate officials in time to act. Abandonment may be either of the invention or of an application. An abandoned application, in accordance with 37 CFR 1.135 and 1.138, is one which is removed from the USPTO docket of pending applications.

Express Mail Mailing Label- Patent correspondence delivered to the USPTO via the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) which is considered filed in the Office on the date of deposit with the USPS, shown by the "date-in" on the "Express Mail" mailing label.

Fee- An amount of money charged for a particular service or product supplied by the USPTO.

Filing Date- The date of receipt in the Office of an application which includes (1) a specification containing a description and, if the application is a nonprovisional

application, at least one claim, and (2) any required drawings.

Filing Receipt- When an application is submitted electronically, the Office immediately issues a confirmation of filing via e-mail that includes the serial number and filing date, and a summary of all the data provided by applicant in the application. This serves as evidence of filing. Applicants who file paper applications receive printed filing receipts that list the application serial number and filing date, the mark, the applicant's name, the goods and/or services, the filing bases, if available; the international class(es), and the address to be used for correspondence.

Final Office Action- An Office action on the second or any subsequent examination or consideration by an examiner that is intended to close the prosecution of a non-provisional patent application.

IDS- See Information Disclosure Statement.

Independent Claim- A claim that does not refer back to or depend on another claim.

Information Disclosure Statement- A list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office in a non-provisional patent application filed under 35 U.S.C. § 111(a) to comply with applicant's duty to submit to the Office information which is material to patentability of the invention claimed in the non-provisional application. For patent applications filed under 35 U.S.C. § 111(a), applicants and other individuals who are substantively involved in preparing or prosecuting a patent application must submit to the Office information which is material to patentability (could render a claim unpatentable) as defined in 37 CFR § 1.56. The provisions of 37 CFR § 1.97 and 37 CFR § 1.98 provide a mechanism for compliance with the duty of disclosure provided in 37 CFR § 1.56. The IDS must include a list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office.

Interference- A proceeding, conducted before the Board of Patent Appeals and Interferences (Board), to determine priority of invention between a pending application and one or more pending applications and/or one or more unexpired patents.

International Application- An application filed under the Patent Cooperation Treaty.

Invention- Any art or process (way of doing or making things), machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States.

Inventor- One who contributes to the conception of an invention. The patent law of the United States of America requires that the applicant in a patent application must be the inventor.

Issue Date- The date that a patent application becomes a US patent. The issue date is the date that patent rights can be exercised. U.S. patents are always issued on Tuesdays.

Joint Application- An application in which the invention is presented as that of two or more persons.

Joint Inventor- An inventor who is named with at least one other inventor in a patent application, wherein each inventor contributes to the conception of the invention set forth in at least one claim in a patent application.

Maintenance Fees- Fees for maintaining in force a patent based on an application filed on or after December 12, 1980.

Markush Doctrine- When materials recited in a claim are so related as to constitute claiming the members of the claimed group in the alternative, such as "selected from the group consisting of A, B and C."

Multiple Dependent Claim- A dependent claim which further limits and refers back in the alternative to more than one preceding independent or dependent claim. Acceptable multiple dependent claims shall refer to preceding claims using the terms "or, any one of, one of, any of, either." A multiple dependent claim may not depend on another multiple dependent claim, either directly or indirectly.

Non-final Office Action- An Office action made by the examiner where the applicant is entitled to reply and request reconsideration or further examination, with or without making an amendment. On taking up an application for examination or a patent in a reexamination proceeding, the examiner is required to make a thorough study of the application and of the available prior art relating to the subject matter of the claimed invention. This examination must be complete with respect to:

- compliance of the application or patent under reexamination with the applicable statutes and rules,
- the patentability of the invention as claimed, and
- matters of form, unless otherwise indicated.

Nonprovisional Patent Application- An application for patent filed under 35 U.S.C. 111(a) that includes all patent applications (i.e., utility, design, plant, and reissue)

except provisional applications. The nonprovisional application establishes the filing date and initiates the examination process. A nonprovisional utility patent application must include a specification, including a claim or claims; drawings, when necessary; an oath or declaration; and the prescribed filing fee.

Non-responsive Amendment- An amendment filed by the applicant that does not fully respond to the examiner's office action in accordance with 37 CFR 1.111.

Notice of Abandonment- A written notification from the USPTO that an application has been declared abandoned or, in other words, is no longer pending. If the application was abandoned unintentionally or due to Office error, the applicant has a deadline of two months from the issue date of the notice of abandonment to file either (1) a petition to revive the application or (2) a request to reinstate the application.

Notice of Allowability- A notification to the patent applicant that the application has been placed in condition for allowance.

Notice of Allowance and Fees Due- A notification to the applicant that they are entitled to a patent under the law and requesting payment of a specified issue fee (and possibly a publication fee as well) within three months (non-extendable) from the mailing date of the notice of allowance.

Oath- A solemn declaration before another, complying with the laws of the state or country where made, that the document in which an applicant for patent declares that (1) he or she is the original or sole inventor, (2) shall state of what country he or she is a citizen, (3) that he or she has reviewed and understands the contents of the specification and claims which the declaration refers to, and (4) acknowledges the duty to disclose information that is material to patentability as defined by 37 CFR § 1.56. An oath or declaration must be filed in each nonprovisional patent application.

OED- Office of Enrollment and Discipline

Office- In the context of actions or activities involving the USPTO, this refers to the United States Patent and Trademark Office (USPTO) itself.

Office Action- A letter from a patent examiner setting forth the legal status of a patent application. The Office action may include requirements, objections and/or rejection of the claims. The applicant must respond to every requirement, objection or rejection in the Office action to avoid abandonment of the application.

OPAP- Office of Patent Application Processing

Original Application- "Original" is used in the patent statute and rules to refer to an application which is not a reissue application. An original application may be a first filing or a continuing application.

Parent Application- The term "parent" is applied to an earlier application of the inventor disclosing a given invention.

Patent- A property right granted by the Government of the United States of America to an inventor "to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States" for a limited time in exchange for public disclosure of the invention when the patent is granted.

Patent Number- Unique number assigned to a patent application when it issues as a patent.

Patent Pending- A phrase that often appears on manufactured items. It means that someone has applied for a patent on an invention that is contained in the manufactured item. It serves as a warning that a patent may issue that would cover the item and that copiers should be careful because they might infringe if the patent issues. Once the patent issues, the patent owner will stop using the phrase "patent pending" and start using a phrase such as "covered by U.S. Patent Number XXXXXXXX." Applying the patent pending phrase to an item when no patent application has been made can result in a fine.

Patent Trial and Appeal Board- Replaces Office of Patent Appeals and Interferences.

Patentable- Suitable to be patented; entitled by law to be protected by the issuance of a patent.

PCT- Patent Cooperation Treaty

Plant Application- Applications to protect invented or discovered, asexually reproduced plant varieties.

Postcard Receipt- A self-addressed, stamped postcard with itemized list of parts of patent application and number of pages per MPEP 503; used as a receipt for what was submitted in an application.

Practitioner- One who stands for or acts on behalf of another. A patent attorney or patent agent may represent the inventors named in a patent application.

Primary Examiner- A patent examiner who is fully authorized to sign office actions

(signatory authority) regarding patentability.

Priority Claim- Claims under 35 USC 119(a)-(e) and 35 USC 120 for the benefit of the filing date of earlier filed applications.

Pro Se **Inventor-** Used to designate an independent inventor who has elected to file an application by themselves without the services of a licensed representative.

Provisional Patent Application- A provisional application for patent is a U. S. national application for patent filed in the USPTO under 35 U.S.C. § 111(b). It allows filing without a formal patent claim, oath or declaration, or any information disclosure (prior art) statement. It provides the means to establish an early effective filing date in a nonprovisional patent application filed under 35 U.S.C § 111(a) and automatically becomes abandoned after one year. It also allows the term "Patent Pending" to be applied.

RCE- Request for Continued Examination. A request filed in an application in which prosecution is closed (e.g., the application is under final rejection or a notice of allowance) that is filed to reopen prosecution and continue examination of the application; requires the filing of a submission and payment of a fee; see 37 CFR 1.114.

Reexamination Proceeding- At any time during the enforceability of a patent any person may file a request for the USPTO to conduct a second examination of any claim of the patent on the basis of prior art patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability (see 37 CFR 1.501). In order for the request for reexamination to be granted, a substantial new question of patentability must be present with regard to at least one patent claim. The request must be in writing and must be accompanied by payment of a reexamination request filing fee as set forth in 37 CFR 1.20(c).

Reissue Application- An application for a patent to take the place of an unexpired patent that is defective in one or more particulars (items or details) --see MPEP 201.05 and MPEP 1400.

Rejoinder- The rejoining (returning to active consideration) of claims previously withdrawn from consideration to due to an election requirement (see restriction).

Representative- One who stands for or acts on behalf of another. A patent attorney or patent agent may represent the inventors named in a patent application.

Restriction- if two or more independent and distinct inventions are claimed in a single

application, the examiner may require the applicant to elect (designate) a single invention to which the claims will be restricted (limited to). This requirement is known as a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action (final rejection).

Small Entity- For purposes of small entity determination per MPEP 509.02 - means an independent inventor, a small business concern, or a nonprofit organization eligible for reduced patent fees.

Specification- A written description of the invention and the manner and process of making and using the same.

Term of Art- An expression or phrase that has a defined meaning when used in a particular context or knowledge environment (such as the patenting process, pharmaceuticals, computers, etc.).

Track I Prioritized Examination- Prioritized examination of your utility and plant patent applications.

Trade Secret- Information that companies keep secret to give them an advantage over their competitors.

USPTO- United States Patent and Trademark Office

Utility Patent Application- Protect useful processes, machines, articles of manufacture, and compositions of matter.

Introduction Lecture on CD

Introduction to PATBAR's Home Study Kit

Welcome to the Introduction Lecture. We want to take this opportunity to thank you for choosing our program to prepare for the patent bar. We want to make sure that you get off to a good start, and for this reason we want to discuss a number of points relating to exam preparation that should help you in the days that follow.

The first idea is that you must keep plugging along. You should never stop. Preparing for the patent bar is like starting a new job. Your supervisors and others in the office go over things, and you learn as much as possible. You can't just stop. In many cases you must do something a few or many times before it really sinks in. This is true of the patent bar. You will learn everything that you need to know at some point in time as long as you keep plugging away. You don't have to learn it all today or tomorrow, but you need to keep studying each day if possible. Most of our students will study over a period of about 90 days.

Our study sessions are designed to take about 1 hour each. A few of them are longer. There are 93 study sessions in all. Most people should do at least two per day, and on this basis your study day will have six steps. Each study session involves a reading assignment, a short lecture that summarizes the reading, and a short batch of prior exam questions to challenge your mastery of the material. As you can see, you are very quickly going through the steps to complete your study day. You should never be doing any one thing for longer than about 20-30 minutes at a time.

Once you get used to the daily routine, it should become much easier. The point is to never get bogged down on any one point or topic. Everything is covered multiple times, and in the post course curriculum you will identify any weaknesses and address them at that time.

This type of approach is much different than an undergraduate course where it is very undesirable to move beyond material that you are having a problem with. This is because that material may support other material that you will study later in the course. However, this is not the case with the patent bar.

In the beginning the process is the point, not perfection. The process takes you to a place where you can begin practicing. Practicing involves learning how to take the exam and how to search the MPEP and notices. These activities allow you to identify your weaknesses and react accordingly. As you can see, each step builds on the last until you are fully prepared to take the exam. This should take about 90 days if you work every day,

which is a short period of time to master one of the most complex bureaucracies ever devised by man.

The above points are important, and we want to keep your morale up as much as possible. One way we do that is to respond to your email and phone calls on a daily basis, not including weekends or holidays. Education involves feedback, and when you need help we know how to go about it.

Another way is to remind you that a certain amount of frustration is normal. This curriculum is not easy and it takes its toll. Even hardened patent professionals grapple with practice before the USPTO, and experience the same frustration when changes come along as they do on a regular basis.

On a more practical note, efficient study requires some sacrifice. You should plan to eat right, sleep right, exercise right and generally plan your life around your study schedule. If you have a full time job, plan to take some time off just before you take the exam.

You should file your application in the OED around half to two thirds of the way through your studies if you are qualifying under Category A, and it usually takes about 2 weeks to get a qualification letter. Since more time is necessary under a Category B, you should file at least two weeks earlier. Get your documentation in order by requesting an official original transcript well before the time you plan to file your application. If you have speeding tickets and the like, begin documenting them starting at least a month or so before you plan to file your application.

You should realize that there is tight security at the testing centers where you take the exam. You should plan accordingly. The testing center can go over with you the many rules that apply and you should talk to them about any concerns that you have before you arrive there. (When you apply for the exam, make sure you use the exact identical name found on your driver's license.)

Your next step is to read the program instructions, introductory reading assignment, and glossary at the beginning of the Study Guide Volume 1. The program instructions explain how to go about using the materials that we have provided in your home study kit.

Finally, we want to thank you again for using our course.

Best wishes,

David Meeks

Exam Search Guide

This guide gives you some suggestions and tips for searching the MPEP during the exam. It will be most useful to you while using the Exam Simulation Suite™ CD at the end of the program.

Searching the MPEP during the computer-administered Patent Bar Exam is important to allow you to get the highest score possible. You should first go through the exam and answer all the questions that you can without using a search, and at the same time, flag those which you believe will be easy to answer using the MPEP. You may want to use your scrap paper to keep additional notes on these questions, such as which ones you think are the least difficult, or which are shortest, or which ones you know the approximate location of in the MPEP, so that you can go back and answer them as efficiently as possible.

When you've done this, use the function that allows you to see only the flagged questions, and answer them as quickly as possible using the MPEP. Leave yourself enough time to choose your best-guess on the remaining questions, or if you're almost out of time, at least pick random answers, since you're not penalized for an incorrect answer.

This tutorial uses examples to explain how to choose the best answers using the MPEP. For each question, you need to choose a search strategy based on how much you already know about the question, such as which MPEP Chapter and/or section it's in, or if it's in the Rules and where.

The best way to know what to search for is to look at the answer choices, and see if they all have the same word or phrase, for example "new matter" in the following question.

Example Question 1:

1. Assuming that a rejection has been properly made final, which of the following statements is not in accordance with the patent laws, rules and procedures as related in the MPEP?
 - (A) An objection and requirement to delete new matter from the specification is subject to supervisory review by petition under 37 CFR 1.181.
 - (B) A rejection of claims for lack of support by the specification (new matter) is reviewable by appeal to the Board of Patent Appeals and Interferences.
 - (C) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the primary examiner, the new matter issue should be decided by petition, and is not appealable.

- (D) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the examiner, the new matter issue is appealable, and should not be decided by petition.
- (E) None of the above.

In addition to the reference to "new matter" in each question, you should see that the question is asking about the circumstances under which it is allowed.

Looking up "New matter" in the MPEP Index gives three entries: 608.04, 706.03(o) and 2163.06. Look at all of these sections now to get an idea of what they're saying. Don't worry about being very fast at this point.

Tip: While taking the exam, you may wish to look back at the question while you're looking through the MPEP. If you click the button to go to the question, you'll lose your place in the MPEP. Some people have discovered, however, that you can drag the MPEP window so that the title bar (the blue bar at the top) is at the bottom of the screen, and therefore the question is visible. In other words, you're dragging the window down so that most of it is off the bottom of the screen. To practice this using our Exam Simulation Suite™ CD, click the Maximize/Restore button (the middle one) in the upper-right corner of the MPEP, and the window will become smaller. Drag the sides or corners so that it fills the whole screen. Then, drag it down by the blue bar (not the double-arrow that will resize the window) to the bottom of the screen. Drag it back up to the top to return to the MPEP.

Tip: Use the Table of Contents bar at the left side to quickly find these sections within a chapter, and to find the starting letter within the Index.

706.03(o) basically says that new matter is not allowed and doesn't go into detail about the circumstances under which it is allowed.

2163.06 has 3 subsections, I-III. I is about new matter not being allowed. II is about reviewing new matter. III says that if matter has already been introduced in a claim, it can be added to the specification. II is the important part here. Answer C contradicts this paragraph, since it says to use a petition and **not** an appeal, and the paragraph in the MPEP says the opposite, thus this is the right answer.

Tip: Make sure you're careful about positive and negative statements. The question here asks about which answer is NOT correct, and answer C (the right answer) is the opposite of what's stated in the MPEP. Keep an eye out for the word "not".

Example Question 2:

For purposes of determining whether a request for continued examination is in accordance with proper USPTO rules and procedure, in which of the following situations will prosecution be considered closed?

- (A) The last Office action is a final rejection.
- (B) The last Office action is an Office action under *Ex Parte* Quayle.
- (C) A notice of allowance has issued following a reply to a first Office action.
- (D) The application is under appeal.
- (E) All of the above.

Even though 3 of the 5 answers contain "office action," this is too generic to be helpful. The question asks about "request for continued examination."

Tip: Your search only works within the section of the MPEP that you have open, whether it's an MPEP Chapter, the Rules or Laws, or the MPEP Index.

Tip: Using the Find tool in the MPEP Index isn't always very useful, since a lot of the results it finds are subheadings under other terms, and not relevant to what you're looking for. It's best to use the Table of Contents window at the left to jump to the correct letter in the Index, and then look up your term manually.

Suppose that you know that this is in Chapter 700. Open this chapter, and click on the binoculars button, which will bring up a search box. Type in "request for continued examination" and click Find. The first match is in the Table of Contents in the chapter. It lists section 706.07(h). If you click "Find Next" four more times, you'll be right at the top of this section. You can also use the Table of Contents on the left side to go directly to this section.

Now change the text in the search box to "closed." The search will continue from where the previous one left off. Read a bit around each occurrence before going on to the next. The fourth occurrence of the word precedes a sentence that starts "Prosecution in an application is closed if..." and lists the four answers, so E, "All of the above," is correct.

Tip: You should know what all of the available buttons in Acrobat Reader do, since the exam uses a modified version of this program. Make sure you're using Version 5 of the reader, since the Find function on the real exam works the same way. If you're used to using a newer version, you'll have trouble with the older method of searching. Pay special attention to the two icons that let you set either the page width or page height to fill up the full window. If you pick page height, you'll see the whole page, and it will be easier to page through the document with the Page

Up and Page Down keys. If you pick the page width to fill the window, it will be larger and easier to read. Note that in either view, making sure that the "hand" tool is selected; you can click on the document and drag it around, to quickly look at different parts of a page.

Example Question 3:

Your client Sam, a U.S. resident, invented the Wigerator, a new device for the manufacture of toupee's. On May 10, 1995, Sam secretly went to Cleveland, Ohio and sold four of his Wigerators to Ted's Big Hair, Inc., a Canadian manufacturer of toupees. No restriction was placed on the use of the machines. On July 5, 1995, Ted started using the Wigerators in his Mexico factory to manufacture his revolutionary new Shag 1998 hairpiece. In order to boost the sales of his new line, Ted has widely publicized in Mexico, Canada, and the U.S. both the Shag 1998 and the Wigerator. On June 1, 1996, Sam came to your office seeking advice about patenting his machine. Which of the following is the most correct advice?

- (A) Sam is not barred from obtaining a U.S. patent on the Wigerator because the Wigerator was not publicly sold more than one year before today's date.
- (B) Sam is barred from obtaining a U.S. patent on the Wigerator because the Wigerators were sold more than one year before the present date.
- (C) Sam is not barred from obtaining a U.S. patent on his device because the Wigerator was not publicly used more than one year before today's date.
- (D) Sam is barred from applying for a patent on the Wigerator because Ted now owns the Wigerator.
- (E) None of the above.

This question is fairly complex and confusing. It includes a lot of extraneous and irrelevant information. Because of this, it's harder to find the answer "cold," you need to have remembered more information from your study. Using the flash cards will help you remember where to quickly find items in the MPEP.

You need to remember the concept that either selling or publicly using an invention precludes getting a patent after one year. The first thing to do is figure out what this question is talking about.

Tip: Make sure you read the whole question and all the answers before you decide what to look for. You need to fully understand the facts being presented, what's being asked, what the answers mean, and what information, if any, isn't relevant.

If you envision a timeline for this question, it would be something like this: Sam sells the invention. About two months later, it's used outside of the country. About a year and a

month after the original sale, Sam wants to get a patent. About two years after that, the invention is on sale in general.

The important facts here are: the sale of the invention, and the date when Sam wants to apply for a patent.

Since either sale or public use prevents getting a patent, the important one is the first one, which is sale. The public use long after this isn't relevant either.

If you look up "Sale, On" in the Index, it will tell you to see "On Sale". Notice that almost all of the subheadings point to Chapter 2100.

The first result is in the Table of Contents at the start of the chapter, and shows you that there are a lot of "on sale" references to 2133.03. You may have also remembered this from the Index and gone there directly using the Table of Contents at the left side of the screen.

Tip: You should be as specific as possible in crafting your searches. You need to pick a word or phrase that will find what you're looking for with as few irrelevant results as possible. For example, in this question, if you search for "on" or "sale" it will find many meaningless occurrences. If you use the key phrase "on sale" you'll have many fewer, but relevant, results.

You should now be wondering whether the fact that the sale was secret, and whether the fact that the buyer's company is in Canada, has any effect. If you search for "secret" (starting from 2133.03), the first occurrence says that a secret sale or offer to sale still bars a patent.

After trying several search terms, the term "in the United States" turns out to be good for finding out whether the location of the buyer's company is relevant. 2133.03(d) explains that the sale will result in a bar if it takes place in the US, even if other parts of the sale (i.e. delivery) happen in other countries.

After this research, answer B is the only one that makes sense, and is the correct answer.

“The better your memory, the less you will have to search in the MPEP or notices.”

Section 1

Chapter 100 Secrecy, Access, National Security, and Foreign Filing (1.28%*)

(*The percentage is the percentage of questions on the exam that come from this chapter. Each chapter has a percentage stated after the chapter heading. This will help you understand the emphasis of each chapter for the purposes of exam preparation. As you can see, Chapter 100 is very lightly tested.)

(We have provided a number of footnotes for your convenience. These will help you understand things that are studied in more detail in a later study session.)

(Numbers to the left or right of titles are MPEP section numbers.)

101 AVAILABILITY OF DOCUMENTS AND OTHER INFORMATION

A. Confidentiality



35 U.S.C 122

(a) Patent applications are maintained in confidence by the United States Patent and Trademark Office (USPTO). No information is available to the public or to a specific party without the authority of the applicant or owner

except where necessary to carry out provisions of an Act of Congress or under special circumstances as determined by the USPTO.

(b) Applications for patent are ordinarily **published**¹ 18 months after the filing date or earliest filing date for which **benefit is claimed**².



37 CFR 1.11

(a) Certain patent files are open to and available to the public including patent files, published patent application files, and the files of a **statutory invention registration**³.



37 CFR 1.14

(a) Patent applications that have not been published are generally preserved in confidence.

102 B. Status Information



37 CFR 1.14

(a) Patent applications that have not been published are

1. **Legal Definition:** n. 1) anything made public by print (as in a newspaper, magazine, pamphlet, letter, telegram, computer modem or program, poster, brochure or pamphlet), orally, or by broadcast (radio, television). With some exceptions (for example, design applications and applications where the applicant has filed a nonpublication request), patent applications are published by the USPTO promptly after 18 months from the filing date of the application. Patent application publications are available electronically on the USPTO web site (www.uspto.gov). This is sometimes referred to as pre-grant publication and this topic is reviewed in detail in Chapter 1100.
2. When a patent application is filed, it receives a filing date. This is an important date because certain aspects of patentability are based on the availability of prior art that predates the applicants filing date (in other cases more than 1 year before the filing date). In some cases the applicant has filed earlier applications for the same invention, and under certain conditions the applicant can reach back and claim an earlier filing date (possibly avoiding prior art in the process). This topic is reviewed in detail in Chapter 200.
3. Normally, when an applicant files a patent application he or she is interested in receiving a patent on the invention. The patent provides rights to the patentee or owner (i.e., to enforce the patent against infringers, importers, etc.). However, there is an exception because U.S. patent laws also allow an applicant to file a patent application and have the patent application published as a Statutory Invention Registration (SIR) instead. An SIR is a publication (and therefore prior art) of the invention in the form of a document that looks like a patent. When an applicant requests that the patent application be published as an SIR, he or she waives their right to a patent (and of course any patent rights that would accrue). This topic is reviewed in detail in Chapter 1100.

generally preserved in confidence. Status information about certain patent applications is available to the public in certain patent application files, as follows:

- (i) A file of an issued patent or a statutory invention registration.
- (ii) An **abandoned**⁴ published application.
- (iii) A published pending application.
- (iv) An unpublished abandoned application that is identified in a patent, statutory invention registration, patent application publication, or an international application that has been published.
- (v) An unpublished pending application whose **benefit is claimed**⁵ in a patent, statutory invention registration, patent application publication, or an **international application**⁶ that has been published.
- (vi) An unpublished pending application that is **incorporated by reference**⁷ in a patent, statutory invention registration, patent application publication, or an international application that has been published.

(2) Status information includes:

-
- 4. Sometimes the applicant abandons a patent application. This may be because the applicant (based on the examiners rationale and logic in rejecting the application claims) does not feel that it is beneficial to continue to pursue a patent. Once abandonment occurs, there is no more action on the application by the USPTO (i.e., prosecution is terminated).
 - 5. Sometimes a patent applicant files a (nonprovisional) patent application and later files one or more applications on the same invention or inventions (creating a chain of patent applications each with a different filing date). The later filed applications are called continuing applications. Under these circumstances the applicant (if all the requirements have been met) may claim the benefit of the earlier filing dates in the later filed applications. This allows the later applications to benefit from the earlier filing date and the examiner applies prior art based on the earlier date. This topic is reviewed in detail in Chapter 200.
 - 6. A U.S. patent application may be filed in the USPTO under the national laws of the U.S., or it may be filed under the provisions of a treaty called the Patent Cooperation Treaty (PCT). A patent application filed under the provisions of the PCT in the USPTO is called an international application. This topic is reviewed in detail in Chapter 1800.

(i) Whether the application is pending, abandoned or patented.

(ii) Whether the application has been published.

(iii) The eight digit application number, or the six digit serial number plus any one of the filing date of a national application, or the international filing date, or date of entry into the national stage.

(iv) Whether another application claims the benefit of the application and status information of the other application (as in items (i)-(iii) above).

Status information means (1) whether the application is pending, abandoned, or patented, (2) whether the application has been published, (3) the application number or serial number and filing date, and (4) whether any other applications claim the benefit of the application, and if so, status information of those applications as well.

The principals named in a patent application, including an inventor, an attorney or agent of record, an assignee of record, or a person with written authority from any of the above, may request status information at any time. This may be done by checking the Patent Application Retrieval System (PAIR) on the USPTO website, or by contacting the File Information Unit by mail, phone or fax.

Status information is available to the public if the application has been published, or if an application is identified in a patent, SIR, a U.S. patent application publication, or international patent application publication.

It has been reported that a prior exam question involves Company A that gave their agent B a competitor's unpublished patent application number, and asked if the agent B could get the information on the competitor's patent application, including whether it had been published and the publication date by telephoning the USPTO. Since such information may only be given to the applicant, or the assignee of record, or the attorney or agent of record, such information would not be available to agent B.

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7. Incorporation by reference is a legal term which means that a document includes something from somewhere outside of the document by incorporating it by reference. (This is common in insurance policies where the policy will incorporate a number of riders usually because the policy fairly well applies to several or many states, but specific riders are required to incorporate the state requirements or provisions.) Patent applications may also use this technique to include something in a patent application in this indirect fashion. For example, an applicant may include a statement in the application that he or she incorporates by reference his or her article on the invention published in a technical publication. This technique makes the article a part of the patent application.

103 C. Files Available to the Public



37 CFR 1.11

(a) Certain patent files are open to and available to the public including patent files, published patent application files, files of a statutory invention registration, and the files listed below. The files are open to inspection by the public, for both inspection and copying, and copies can be obtained upon the payment of a fee.

(b) All **reissue applications**⁸ are open to inspection by the public.

(c)-(d) All papers relating to a **reexamination**⁹ are open to inspection by the public.

(d) The file of an **interference**¹⁰ is open to public inspection.



37 CFR 1.14

(a)(1) Patent applications that have not been published are

8. Once a patent issues it may be the subject of one of many post-issuance provisions of U.S. patent law. One of these provisions is called a “reissue”, or “reissue application”. A reissue application is a provision that allows a patentee or patent owner to file a patent application to have the patent reissued. This may be done for one of many reasons, but every reissue must correct at least one error in the patent, which may be that the claims are too narrow or too broad, the disclosure contains inaccuracies, etc. This topic is reviewed in detail in Chapter 1400.

9. Another post-issuance provision of U.S. patent law is “reexamination”. The patentee or the patent owner, or any member of the public may file a request to have a patent reexamined. This is usually because someone having an interest in the validity of a patent wants the patent reexamined to determine if one or more of the claims are valid and enforceable. This may happen, for example where a possible infringer has found prior art that was not used by the examiner that would invalidate patent claims. This topic is reviewed in detail in Chapter 2200.

10. U.S. patent law is somewhat unique in that it is based on the idea that only the first to invent has the right to a patent. Later inventors are prohibited from obtaining a patent unless the earlier inventor abandoned, suppressed or concealed the invention. If two inventors file a patent application on the same invention, or an applicant files a patent application on an invention already patented in the U.S., under some circumstances the USPTO will declare an interference. The interference allows the parties to present evidence to prove inventive activity, including the dates of this activity, with the hopes of winning the interference and obtaining a patent on the invention. This topic is reviewed in detail in Chapters 2100 and 2300.

generally preserved in confidence. Records associated with patent applications are available in the following situations:

(i) A file of an issued patent or a statutory invention registration.

(ii) An abandoned published application.

(iii) A published pending application.

(iv) An unpublished abandoned application that is identified in a patent, statutory invention registration, patent application publication, or an international application that has been published.

(v) An unpublished pending application whose benefit is claimed in a patent, statutory invention registration, patent application publication, or an international application that has been published.

(vi) An unpublished pending application that is incorporated by reference in a patent, statutory invention registration, patent application publication, or an international application that has been published.

(vii) If an application is identified in the file contents of another application, but not the published patent application or patent itself, a **granted petition**¹¹ for access or a **power to inspect**¹² is necessary to obtain the application or a copy of the application.

11. Many provisions of the rules require a party to file a request in the form of a petition as a way of making a request (for example, a petition to access a patent application). The petition (which usually must be accompanied by a petition fee) is a formal way of asking the USPTO for something. Other petitions are filed because the applicant in a patent application disagrees with a patent examiner on a matter of a procedural nature. The patent rules allow an applicant to have a matter reviewed by a higher authority by filing a request for review by the Director, and this is usually filed under one of the many provisions for petitions under the patent rules.

12. Sometimes a patent applicant wants a certain party (possibly someone interested in licensing the invention) to have the right to review a patent application and/or other papers in the application file in the USPTO. To do this, the applicant gives the party a signed statement that the party may access the patent application file. A paper of this type is called a "power to inspect" the application.

D. Published U.S. Patent Applications

If a patent application has been published, then a copy of the specification, drawings, and all papers relating to the file is available through the PAIR system at the USPTO website. A copy may also be ordered from the USPTO by filing a request and paying the copy fee.

E. Unpublished Abandoned and Pending Applications That Are Identified

Patent applications are available in the following circumstances:

The files of an unpublished abandoned application are available (to the public) if it is identified or if benefit of the application is claimed in a U.S. patent, a SIR, a U.S. patent application publication, or a published international application upon written request and payment of the copy fee.

A copy of an application-as-filed of an unpublished pending application may be provided (to the public) upon written request (including a copy of the page showing the reference) and payment of the copy fee (or available through PAIR) if the application is incorporated by reference or otherwise identified in a U.S. patent, a SIR, U.S. patent application publication, or international application publication. An application-as-filed means only the application papers filed by the applicant (specification, claims, drawings, etc.) but not any other papers or documents in the file.

In addition, if a U.S. patent application publication, a U.S. patent, or a published international application claims benefit to a U.S. patent application, a copy of that application-as-filed may be provided upon written request, or available through the public PAIR system if the application is maintained in the IFW system.

Lecture 1

Welcome to Lecture 1.

We are going to begin our lecture in Chapter 100. We realize that the material in Chapter 100 is very technical in nature and that there are many new vocabulary words (and terms of art) for you to become familiar with. Learning vocabulary is not fun or interesting, but you have to learn the terminology as soon as possible. This is not the kind of material that is interesting such as material that involves the everyday activities and strategies involved in getting a winning patent for your client. However, it is an excellent time to introduce a few concepts and a lot of vocabulary, and a good place to start because it is very lightly tested on the exam. The key is to learn as much as you can in the time allotted, and then move on. We have introduced tables where we think they are helpful.

The lecture always follows the reading of the material in the study guide. After listening to the lecture, you will proceed to the prior exam questions that follow the reading assignment in the study guide. The three parts will complete a study session.

The first study session begins in Chapter 100 with an introduction to the regulations in the USPTO regarding the confidentiality of patent applications. As a general rule, patent applications are confidential documents under 35 USC 122(a), which states that patent applications are maintained in confidence. There are three exceptions. The first is where a party has written permission from the applicant or owner to access the application, the second to carry out an Act of Congress, and the third under special circumstances as determined by the Director of the USPTO.

35 USC 122(b) introduces the requirement that patent applications are published after 18 months of their filing date, or 18 months after their earliest filing date claimed if the application claims the benefit of an earlier prior application. However, not all applications are published because an applicant has the option to file the application with a nonpublication request. If that is the case, then the application is not published. In the MPEP you will see constant reference to "publication under 35 USC 122(b)".

37 CFR 1.11 introduces a listing of the files that are always available to the public, including patent files, the files of Statutory Invention Registrations (called an SIR), and a patent application publication. These files are always available to the public, both on the internet or a copy can be purchased from the USPTO for a fee.

37 CFR 1.14(a) restates the statutory directive that patent applications that have

NOT been published must be maintained in confidence unless special circumstances exist as determined by the Director.

The second topic involves status information, which is limited to information about the application. The information includes whether the application is pending, abandoned or patented. It also includes whether the application has been published, the application number and filing date, and whether any later applications claim the benefit of the applications filing date, and their status as well.

Status information is always available to the parties named in the application, including the inventors, an attorney or agent of record, or an assignee of record. Status information is also available to any party that has written authority to obtain status information from one of the parties named in the application.

Status information is also available to any member of the public if the application has been published, or if the application is identified in a patent, an SIR, or a patent application publication.

The third topic reviews the files that are available to the public. 37 CFR 1.11 introduces a listing of files that are available to the public, including the files of a patent, a published application, and an SIR. These files are available for inspection and copying, or a copy can be ordered from the USPTO for a fee.

Additionally, after a patent application issues as a patent, any files relating to any matter in the patent are available to the public, including a reissue application, a reexamination, or an interference. Stated another way, once a patent issues any matter pertaining to that patent is available to the public.

37 CFR 1.14(a) introduces a number of circumstances that would allow the public access to a patent application. This would include, of course, where an application has been published. Additionally, if an unpublished application is identified in a patent, SIR, or a patent application publication, it would also be available to the public. The identification might be either that it claims the benefit of the earlier application or incorporates it by reference.

The fourth topic involves a patent application publication. As stated, a patent application publication is available to the public, including the specification, drawings, and all of the papers in the file. These may be accessed over the internet or copies may be purchased from the USPTO.

The last topic reviews in more detail when unpublished patent applications are available to the public.

The files of an unpublished abandoned application are available to the public if it is identified or its benefit is claimed in a patent, SIR, or a patent application publication.

If the unpublished patent application is still pending, any member of the public may order a copy of the application- as-filed if the application is incorporated by reference or otherwise identified in a U.S. patent, SIR or patent application publication. If the U.S. patent, SIR, or application publication claims the benefit of the unpublished pending application, a copy of any papers in the file may also be ordered from the USPTO. An application-as-filed means only the specification, claims and drawings filed by the applicant to receive a filing date, but not other papers in the file.

In summary:

Patent applications are generally preserved in confidence unless they have been published or have issued as a patent (or SIR).

The files of a patent (or SIR), or any post issuance matter relating to the patent (or SIR), are always available to the public.

Status information is always available to the principals named in the case, including the inventors, attorneys or agents of record, assignees of record, or to any party that has written permission to obtain status information from one of the principals.

Lastly, certain unpublished application files are available to the public. These include where the unpublished application is abandoned and has been identified in a patent, SIR, or a patent application publication. If the unpublished application is still pending and is incorporated by reference or otherwise identified in a patent, SIR or a U.S. patent application publication, a copy of the application-as-filed may be ordered from the USPTO upon request and payment of a fee. If the patent, SIR, or a patent application publication claims the benefit of the unpublished pending application, then any other paper in the file may be ordered as well.

Prior Exam Questions

Prior Exam Question That Has Been Reported to Have Been Tested on the Exam

Question 101

Application Number A was published as U.S. Patent Application Publication Number B. A member of the public reviewed the listing of the file contents of the application on the Patent Application Information Retrieval system and determined that the application was still pending, that a final Office action was mailed, and that the application file is in the Technology Center where it is being examined. The member of the public does not have a power to inspect, but would like a copy of the final Office action as well as the other papers in the patent application. In accordance with the patent laws, rules and procedures as related in the MPEP, can a copy of these papers be obtained by the member of the public, and if so, how can the copy be obtained?

- (A) No, a copy cannot be obtained because patent applications are maintained in confidence pursuant to 35 USC 122(a).
- (B) No, a copy cannot be obtained because the patent application is still pending.
- (C) Yes, a member of the public can go to the Technology Center and ask for the file for copying at a public photocopier.
- (D) Yes, the member of the public can complete a “Request for Access to an Application Under 37 CFR 1.14(e)” and, without payment of a fee, order the file from the File Information Unit. Upon the Unit’s receipt of the application, the member of the public can use a public photocopier to make a copy.
- (E) Yes, the member of the public can order a copy from the Office of Public Records, with a written request and payment of the appropriate fee.

ANSWER: (E) is the most correct answer. MPEP § 103, under the heading “Published U.S. Patent Applications” states that “If a patent application has been published pursuant to 35 U.S.C. 122(b), then a copy of the specification, drawings, and all papers relating to the file of that published application (whether abandoned or pending) may be provided to any person upon written request and payment of the fee.” (A), and (B) are not correct. Once an application has been published, a copy is available to the public upon written request and payment of a fee. (C) and (D) are not correct. As stated in MPEP § 103, under the heading “Published U.S. Patent Applications,” if the published patent application is pending and it is not maintained in the IFW system, the paper application file itself will not be available to the public for inspection.”

Other Prior Exam Questions

Question 102

Under which of the following circumstances may the contents of an unpublished application for U.S. patent be revealed to the public without written authority from the applicant or the assignee of record or the attorney or agent of record?

- (A) When the application becomes abandoned.
- (B) When the Secretary of Commerce deems the subject matter to be important to the national welfare.
- (C) Under special circumstances as determined by the Director.
- (D) By operation of law upon the death of the patent applicant.
- (E) By direction of the Attorney General of the United States.

SEE SECTIONS 101 and 103. Answer (c).

Question 103

Public access to pending unpublished U.S. patent applications:

- (A) can ordinarily be granted to review the application file to avoid infringing pending claims in the application.
- (B) can ordinarily be granted to submit pertinent prior art to aid the patent examiner in the examination of the application.
- (C) can ordinarily be granted to determine whether an interference is warranted.
- (D) cannot ordinarily be granted because the oath or declaration signed by the applicant prohibits public access.
- (E) cannot ordinarily be granted because pending patent application files are ordinarily kept in confidence by the USPTO.

SEE SECTION 101. Answer (e).

Question 104

While looking through the most recent *Official Gazette*, you noticed a patent directed to a device similar to that claimed in your client's pending application. You obtained a copy of the patent and discovered that the patent is a divisional application of a parent application. The patent only gave the application number and filing date of the parent applica-

tion. You want to know the status of the parent application. Can you obtain the status of the application from the USPTO?

- (A) No, unless the parent application has issued as a patent.
- (B) No, because all patent applications are preserved in confidence by the USPTO.
- (C) Yes, but only if a petition for access is filed.
- (D) Yes, by filing a "Waiver of Secrecy Order" form to get access to the parent application.
- (E) Yes, by submitting a written request for the status of the parent application which includes a copy of the patent.

SEE SECTION 102. Answer (e).

Section 2

103 AVAILABILITY OF DOCUMENTS AND OTHER INFORMATION (continued)

F. Petitions for Access



37 CFR 1.14

(a)(1)(vii) Applications that are (1) not published or patented, and (2) not subject of a benefit claim or identified in U.S. patent, a SIR, a U.S. patent application publication, or a published international application, are not available to the public.

If an application is identified in the file contents of another application, but not in the published application or patent itself, a granted petition for access or a power to inspect is necessary to obtain the application. A power to inspect is permission to access the application from the applicant, attorney or agent of record, the assignee of record, or a practitioner named in the papers on filing prior to the filing of an oath or declaration.

(h) The USPTO may provide access or copies if warranted under special circumstances by filing a petition for access. A petition must include the petition fee and a showing that special circumstances exist.

Any party may file a petition for access, including the fee and the required showing, to access an application. The petition should be filed with **proof of service**¹³ on the appli-

cant, attorney or agent of record, or assignee of record, or filed in duplicate. The applicant is given a limited time (usually three weeks) to object to granting the petition.

“Special Circumstances” were found where an applicant used the application as a means to interfere with a competitor’s business or customers.

G. Patent Claims Benefit of Pending Application



37 CFR 1.14

(a)(1)(v) The file contents of an unpublished pending application is available to the public if the benefit of the application is claimed in an U.S. patent, a SIR, a U.S. patent application publication, or a published international application upon request and payment of the copy fee.

Whenever a patent relies on the filing date of an earlier but still pending application, the USPTO permits an applicant to obtain a copy of the prior application, either as originally filed or of the pending file history, upon written request and payment of the appropriate fee.

104 H. Power to Inspect Application



37 CFR 1.14

(c) Access to an application may be provided to any person if the application contains written authority granting access to such person. The authority must be signed by the applicant, an **attorney or agent of record**¹⁴, an authorized official of the assignee of record, or a registered attorney or agent named in the application papers prior to the

13. **Legal Definition:** n. the delivery of copies of legal documents such as summons, complaint, subpoena, order to show cause (order to appear and argue against a proposed order), writs, notice to quit the premises and certain other documents, usually by personal delivery to the defendant or other person to whom the documents are directed. So-called “substituted service” can be accomplished by leaving the documents with an adult resident of a home, with an employee with management duties at a business office or with a designated “agent for acceptance of service” (often with name and address filed with the state’s Secretary of State), or, in some cases, by posting in a prominent place followed by mailing copies by certified mail to the opposing party. In certain cases of absent or unknown defendants, the court will allow service by publication in a newspaper. Once all parties have filed a complaint, answer or any pleading in a lawsuit, further documents usually can be served by mail or even FAX.

filing of an **oath or declaration**¹⁵ in the application.

Once an oath or declaration has been filed, the applicant (any one of joint applicants), an attorney or agent of record (if a power of attorney was filed), or an assignee whose assignment is of record, may provide written authority to any party to allow access to the application (which becomes part of the application file). Such a paper is called a power to inspect.

A person acting in a representative capacity (i.e., where a written power of attorney has not been filed) named in the application papers may execute a power to inspect but only if an oath or declaration has not been filed.

105 I. Suspended or Excluded Practitioner Cannot Inspect

USPTO employees are forbidden to hold either oral or written communication with an attorney or agent who has been suspended or excluded from practice by the USPTO regarding an application unless it is one in which said attorney or agent is the applicant. Power to inspect given to such an attorney or agent will not be accepted.

It has been reported that a question involves a suspended practitioner (it is the type of question which asks, “which one is incorrect”). Know that the USPTO will not appoint a new practitioner if the one named in the power of attorney is suspended.

106 K. Control of Inspection by Assignee

The assignee of record of the entire interest in an application may intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect.

14. The vast majority of all patent applicants are represented by one or more patent agents or patent attorneys. The applicant may give the practitioner his or her (verbal or written) authority to proceed with the application, or the applicant may file a power of attorney legally documenting the representation in the application file. Filing a signed document (signed by the applicant(s)) stating the name or names of the persons who will act as the representative or representatives in the case is giving the practitioners a power of attorney, and the paper is called a power of attorney.

15. A patent application requires that the inventors file an oath or declaration. Both are legal documents (virtually the same, although an oath is executed before a Notary Public) that form the legal understanding or contract between the applicant and the U.S. government. An oath or declaration contains many statements relating to the requirements of U.S. patent law, and the inventors are agreeing that they have complied with these requirements by signing the legal document.

Of course, after the application has published pursuant to 35 U.S.C. 122(b), the application will be available to the public and any restriction on the inventor to access his or her application previously granted will no longer be in effect.

It has been reported that an exam question involves whether an applicant may be excluded from obtaining access to an application where there is an assignee.

L. Rights of Assignee of Part Interest (106.01)

While it is only the assignee of record of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, an assignee of a part interest or a licensee of exclusive right is entitled to inspect the application.

110 M. Confidentiality of International Applications



37 CFR 1.14(g)

International applications¹⁶ are published 18 months after their **priority date**¹⁷. Copies of or access to international files, or copies of a document in such files, which designate the U.S. and which have been published will be furnished upon written request and payment of the appropriate fee if the international application was filed with the USPTO, or the U.S. acted as the searching or examination authority. A copy of an English translation of a publication of an international application filed in the USPTO

16. Director's Comment-There is an entire chapter on international applications, Chapter 1800-Patent Cooperation Treaty. Everything about international applications is covered in Chapter 1800, including the topic above. It is almost always best (on the exam) to search Chapter 1800 for anything about international applications including the material in this section, which is reviewed again in more detail in the above referenced chapter. Although we will introduce material on international applications throughout this course, you should concentrate your efforts on the material covered in Chapter 1800.

17. International laws allow (under certain provisions) an applicant filing a U.S. (nonprovisional) patent application to claim the filing date of his or her earlier filed patent application on the same invention filed in a foreign country. For example, an applicant may file a patent application in England, and then (within 12 months) file an application on the same invention in the U.S. Under the law the U.S. application may claim the date of the foreign application, and this is called the priority date. A priority date is very advantageous in that the U.S. application is examined on the basis of the priority date in applying certain prior art, thereby avoiding prior art that may have been available during the interim. This topic is reviewed in detail in Chapter 200.

will be furnished upon request and the payment of the appropriate fee.

Table

Johnny is a new associate of a very large firm in New York. Johnny successfully passed the patent bar during law school, but her memory of access to patent applications and other patent documents (MPEP Chapter 100) is very dim. She asks her supervisor, Partner Barrister if this is an important topic and if other associates are having the same problem with this material. Barrister replies that is probably true, and comments that it is important what documents may be accessed in the USPTO, and how to go about doing that if the situation comes up. Barrister suggests that she make a table that comprehensively covers the topic, convert it into a pdf document and email it to all the associates in the firm. Find below the table that Johnny produced for the firm.

Table

Table 1: U.S. patent documents available to the Public.^a

	Document	Available	Access	How To Access
1	Patent	Patent and File Contents	All	Visit File Information Unit (FIU) or Internet^b or Written Request/ Fee^c
2	Statutory Invention Registration	SIR and File Contents		
3	Published Application	File Contents		
4	Unpublished Abandoned Application (including provisional applications)	File Contents	Identified in a U.S. Patent, Patent Application Publication, SIR, or Published International Application^d	Visit File Information Unit (FIU) or Written Request/Fee
			Claimed the benefit of in a U.S. Patent, Patent Application Publication, SIR, or Published International Application	Visit File Information Unit (FIU) or Written Request/Fee or Internet
5	Unpublished Pending Application (including provisional applications)	Application As Filed	Incorporation by Reference (or otherwise identified) in a U.S. Patent, Patent Application Publication, SIR, Published International Application	Written Request/Fee
		File Contents	Claimed the benefit in a U.S. Patent, Patent Application Publication, SIR, or Published International Application	Written Request/Fee or Internet
6	Provisional Application	Public Access is the Same as for Any Other Application	See 4 and 5 Above	

Table 1: U.S. patent documents available to the Public.^a

	Document	Available	Access	How To Access
7	Published International Applications which Designate the U.S.	Home Copy-File Contents	International Applications filed with the U.S. Receiving Office	Written Request/Fee
		Search Copy-File Contents (except for written opinion^e)	International Applications where the U.S. acted as the International Searching Authority	
		Examination Copy-File Contents	International Applications where the U.S. acted as the International Preliminary Examining Authority	
8	Reissue Application	File Contents	All	Visit File Information Unit (FIU) or Written Request/Fee or Internet
9	Reexamination	File Contents	All	Internet
10	Interference File	File Contents	All (except in a patent application that is not available to the public) after the Proceeding is Terminated	Written Request/Fee

- a. For additional information, review form PTO/SB/68 reproduced in MPEP Section 103, part III.
- b. All new applications are stored as an Image File Wrapper (IFW). When access to IFW applications is available to the public in the File Information Unit (FIU) and over the Internet, the public may access pending and abandoned published patent applications electronically; there is no paper file wrapper for IFW applications. Published applications maintained in the IFW system are available on the USPTO's Internet website in the public Patent Application Information Retrieval (PAIR) system.
- c. A member of the public may obtain a copy through the Office of Public Records upon payment of the appropriate fee under 37 CFR 1.19(b).
- d. International applications are published 18 months after their priority date.
- e. The written opinion is available after 30 months from the priority date.

120 SECURITY ORDERS

37 CFR 5.1-5.5

An application will not be published if publication or disclosure would be detrimental to national security.

When notified by a defense agency that publication would be detrimental, the USPTO will issue a secrecy order that the invention be kept secret.

A patent application under a secrecy order must be appealed or otherwise prosecuted to avoid abandonment. Appeals in such cases must be completed. An interference will not be declared in an application under a secrecy order.

If an application is in condition for allowance except for the secrecy order, the application will not issue until the secrecy order is removed.

The applicant or owner of the patent application may file a petition for the removal of the secrecy order, which must recite all of the facts that form the basis of the petition, and if the petition is denied, an appeal may be filed within 60 days to the Secretary of Commerce.

The applicant or owner may file a petition for a modification of the secrecy order.

Secrecy Orders apply to the subject matter of the invention, not just to the patent application itself. The Secrecy Order restricts disclosure or publication of the invention in any form.

If the Secrecy Order is applied to an international application, the application will not be forwarded to the International Bureau (the headquarters operation of the PCT) as long as the Secrecy Order remains in effect.

Applicants may petition for rescission or modification of the Secrecy Order. For example, if the applicant believes that certain existing facts or circumstances would render the Secrecy Order ineffectual, he or she may informally contact the sponsoring agency to discuss these facts or formally petition USPTO to rescind the Order.

If, prior to or after the issuance of the Secrecy Order, the subject matter relevant to the

application has been or is revealed to any U.S. citizen in the United States, the principals must promptly inform such person of the Secrecy Order and the penalties for improper disclosure. If such part of the subject matter was or is disclosed to any person in a foreign country or foreign national in the U.S., the principals must not inform such person of the Secrecy Order, but instead must promptly notify the USPTO.

A Secrecy Order remains in effect for a period of 1 year from its date of issuance. A Secrecy Order may be renewed for additional periods of not more than 1 year.

A secrecy order case will be examined up to the point of either abandonment, a notice of allowance, or the filing of an appeal. The application cannot issue as a patent or have the appeal heard until the order is removed.

140 FOREIGN FILING LICENSES

35 U.S.C. 184-186

An applicant must obtain a foreign filing license from the USPTO to file an application in a foreign country prior to 6 months after filing in the U.S. A foreign filing license is not available on an invention subject to a secrecy order. The license shall permit modifications in the foreign application if they do not change the general nature of the invention.

A person shall not receive a U.S. patent if that person filed a foreign application without the proscribed license.

Any person who discloses inventions under a secrecy order, or files an application on an invention in a foreign country without a foreign filing license at a time when a license is required, may be fined or imprisoned, or both.

37 CFR 5.11-5.25

A foreign filing license from the USPTO is required before filing any foreign application in a foreign country if the invention was made in the U.S. and (1) if an application has been filed in the U.S. less than six months prior to the date the foreign application was filed and no secrecy order has issued or (2) no application was filed in the U.S.

Filing a U.S. application for an invention made in the U.S. is considered to include a

petition for a foreign filing license. The **filing receipt**¹⁸ will indicate if the petition has been granted.

If there is no corresponding U.S. application, a petition of a license must be filed including the requisite fee and a legible copy of the material for which the license is desired.

If there is a corresponding U.S. application, the petition must identify the application.

A foreign filing license permits modification of the foreign application if the changes do not alter the general nature of the invention.

Where a foreign filing takes place at a time when a license was required, and no license was obtained a retroactive license may be available. A petition for a retroactive license requires (in the form of a **verified statement**¹⁹):

- (1) The listing of all the countries and filing dates where foreign filings took place.
- (2) A statement that the subject matter is not under a secrecy order.
- (3) A showing that the license was diligently sought.
- (4) An explanation of why the material was filed abroad through error and without deceptive intent.
- (5) The required fee.

No foreign filing license is required for inventions made outside of the U.S.

There are two ways in which permission to file a patent application abroad may be obtained: either a petition for a foreign filing license may be granted or the applicant

18. The first correspondence from the USPTO (not counting a returned postcard acknowledgement that was submitted with the application by the applicant on filing) after filing a patent application is called a "Filing Receipt". The filing receipt includes all the necessary information about the application (such as the filing date, application number, etc.) that is used to reference the patent application in future correspondence. The receipt should be checked for accuracy upon receipt, especially the filing date. The filing receipt may also include a statement that a foreign filing license has been granted.

19. A "verified" statement is one that is the form of an oath or declaration (sometimes called an affidavit) that includes all the necessary requirements. A document in the form of an oath must be signed in the presence of a Notary Public. A document in the form of a declaration must include a statement that false statements are punishable by fine, imprisonment, or both. This topic is reviewed in detail in Chapter 600.

may wait 6 months after filing a patent application in the USPTO (as long as no Secrecy Order has been imposed).

There are several ways a license may be issued:

(1) Every patent application is considered to include a request for a foreign filing license. If the license is granted, the filing receipt will indicate, "Foreign Filing License Granted."

(2) If there is no U.S. patent application, or if there is one but the filing receipt does not grant a license, or the applicant does not want to wait for the filing receipt, the applicant may file a petition for a foreign filing.

Retroactive License

If the applicant filed a foreign application at a time when a license was required (no corresponding U.S. application, prior to 6 months after filing his or her application, or no license in filing receipt), a retroactive license may be available. A petition for a retroactive license requires a listing of each of the foreign countries in which the unlicensed patent application material was filed, the dates on which the material was filed in each country, a verified statement (i.e., in the form of an oath or declaration) that the subject matter was not under a secrecy order, a showing that the license was diligently sought, an explanation of how the error without deceptive intent occurred, and a petition fee.

Table

Table 2: Options Relating to Foreign Filing Licenses

	Invention Made Where	Application Filed in the U.S.	Requirement For License	Obtaining a License
1	Made in a Foreign Country	Yes or No	No	Not Applicable (N/A)
2	Made in the U.S.	No	Yes	File Petition for License under 37 CFR 5.13
3		Yes and 6- Months has Elapsed W/O a Secrecy Order Being Issued	No	N/A
4		Yes and Filing Receipt Indicates “Foreign Filing License Granted”	Yes	License Granted
5		Yes but no Statement in Filing Receipt	Yes	Either wait 6-months or File Petition for License under 37 CFR 5.13

Lecture 2

Welcome to Lecture 2.

We are going to continue our discussion of Chapter 100, starting with the material on a Petition for Access. We begin with the material on a petition for access. If a patent application is not available to the public, any member of the public may file a petition for access. The petition must include the required fee and an explanation of the reasons for requesting access. The petition must be served on the applicant, attorney or agent of record, or an assignee of record. The petition must be filed in duplicate. For example, a business owner may file a petition for access where the applicant used the application to interfere with his or her business or customers.

The next section has been covered earlier, and it allows the public to access the file of an unpublished pending application whose benefit is claimed in a patent, SIR, or a patent application publication, upon written request and payment of the fee for this service.

The next section reviews a power to inspect an application. The applicant, an attorney or agent of record, an assignee of record, or an attorney or agent named in the papers before the filing of an oath or declaration, may provide written authority for any party to access a patent application. This may happen where the inventors want to allow a potential assignee to inspect the application that was filed in the USPTO, or documents relating to the prosecution.

The next section states that the USPTO will not communicate with a suspended or excluded practitioner in any application unless the practitioner is the applicant.

The next section involves an assignee who owns the application. An assignee of the entire interest may intervene in the prosecution to the exclusion of the inventor or inventors. Such intervention does not exclude the applicant from access to the application unless the assignee makes a specific request to that effect.

The next part reviews confidentiality of international applications. If an international application has been filed in the USPTO, and has been published and designates the U.S. as one of the countries where a patent is desired, the public may obtain copies of the application file upon written request and payment of a fee.

The next section reviews "secrecy orders." Some patent applications are reviewed by one of a number of government agencies, who may determine that the material involves national security. If that is the case, the USPTO issues a secrecy order. The order applies to all the principals involved in the patent appli-

cation. Once a secrecy order is issued, the application is prosecuted up to the point where the applicant appeals the case by filing a notice of appeal or the USPTO issues a notice that the application is in a condition for allowance, although a patent will not issue until the secrecy order is removed.

If the applicant believes that the secrecy order would be ineffectual, such as where the information is in the public domain already, the applicant may file a petition to remove or modify the secrecy order. If for some reason the subject matter is revealed to a U.S. citizen, the principals must notify the person or persons of the secrecy order and the penalties for improper disclosure. If the subject matter was disclosed to a foreigner, the principals must promptly notify the USPTO.

A secrecy order remains in effect for one year, and it can be renewed indefinitely in one year increments.

The next section involves "foreign filing licenses." In some cases an applicant must have a foreign filing license to file a patent application in a foreign country. When an applicant files a patent application on an invention, the USPTO issues a filing receipt in about 6-8 weeks. The filing receipt may indicate that "foreign filing license granted." At this point, the applicant may file in any foreign country.

One exception to the requirement for a foreign filing license is for inventions made outside of the U.S. If this is the case, or if the filing receipt includes the statement "foreign filing license granted," then the applicant may proceed with any desired foreign filings.

Additionally, if the applicant filed a U.S. application and no secrecy order has issued within 6 months, on or after 6 months from the filing date, no foreign filing license is required. At that point the applicant may proceed to file applications in any foreign countries.

If none of the above exceptions apply, such as where the inventor has not filed a U.S. application on an invention made in the U.S., the inventor may file a petition for a foreign filing license. The petition must include the petition, a petition fee, and a description of the invention that the applicant wants to patent abroad. The applicant would also have to file a petition if the applicant received a filing receipt without the "foreign filing license granted," and it is before 6 months from the filing date.

If a foreign filing takes place at a time when a license is required, the applicant may file a petition for a retroactive license. A petition requires a petition fee and a verified statement listing the countries and filing dates where foreign filings took place, a statement that no secrecy order has issued, a showing that the license was diligently sought, and an explanation of why the foreign filing was through error and without deceptive intent.

Prior Exam Questions

Question 201

The existence of a particular U.S. patent application becomes apparent due to the publication of its foreign counterpart. The application could greatly affect a domestic industry that is at a critical juncture. Public concern, as well as private concern among potential domestic licensees runs high, with the following individuals wanting to know how the prosecution of the application is proceeding. The individuals obtain the following powers and access:

U obtains a power to inspect from the applicant having no time limit.

V gets a power to inspect from the Attorney of Record having no time limit.

W acquires a power to inspect from the Assignee of Record having no time limit.

X an attorney with the Security and Exchange Commission, acquires a power to inspect from the Assignee of Record having no time limit.

Y has a petition for access granted by the Director having no time limit.

U, V, W, X, & Y inspect the file. Eighteen months later, no patent has issued. In the interim, U, V, W, X, & Y come back to the PTO to inspect the file for a second time. Which party will not be permitted to inspect the application?

- (A) U
- (B) V
- (C) W
- (D) X
- (E) Y

SEE SECTION 104. Answer (e).

Question 202

Which of the following statements, if any, regarding Secrecy Orders are false?

- (A) A Secrecy Order remains in effect for a period of one year from its date of issuance.
- (B) If the Secrecy Order is applied to an international application, the application will not be forwarded to the International Bureau as long as the Secrecy Order remains in effect.

- (C) If, prior to or after the issuance of the Secrecy Order, any significant part of the subject matter or material information relevant to the application has been or is revealed to any person in a foreign country, the principals must promptly inform such person of the Secrecy Order and the penalties for improper disclosure.
- (D) Use of facsimile transmissions to file correspondence in a Secrecy Order case is permitted so long as it is transmitted to the Office in a manner that would preclude disclosure to unauthorized individuals and is properly addressed.
- (E) (C) and (D).

SEE SECTIONS 120 and 130. Answer (e).

Question 203

Jack loved to tinker with electrical gadgets in his youth, but adulthood and the responsibilities of a job and a family forced him to spend his time with other pursuits. Retirement, however, opened the door to renew his passion for tinkering, and soon he began to spend so much time at his pastime that he developed a reputation as an eccentric among his friends and neighbors. One day, while Jack was tinkering in his homemade shop and his wife, Jill, was entertaining relatives, Bruce, a visiting relative and a registered patent attorney, wandered into Jack's shop, and soon became entranced with one of the gadgets that Jack had invented. Bruce informed Jack that his invention appeared to be patentable and that he, Bruce, would be delighted to obtain patent protection for Jack for no more than the expenses involved, and that he, Bruce, could probably arrange to market the invention for little more than the effort involved in making a few phone calls. After very little persuasion, Jack retained Bruce to patent the invention, insisting, however, that he be permitted to review the final draft of the application, that he be consulted at every step of the prosecution, and that no prosecution decision be made without his concurrence. Bruce agreed, and thereupon prepared and filed a patent application naming Jack as sole inventor. Subsequently, Bruce succeeded in negotiating the sale of Jack's entire interest in the invention to the Star Financial Group, which in turn conveyed an exclusive license in the invention to the Omega Electrical Corporation. Both the assignment to Star and the license to Omega were properly executed and recorded in the PTO. According to proper PTO practice and procedure, which of the following statements is true?

- (A) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce without Jack's consent.
- (B) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file.
- (C) Star may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file.

- (D) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file, but Jack may be permitted to inspect the file on sufficient showing why the inspection is necessary to conserve his rights.
- (E) Star may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Omega be excluded from access to his patent application file.

SEE SECTIONS 106 and 106.01. Answer (c).

Question 204

In late June of 1993, Deutsche Flugzeug Werke (DFW) retains you to file a patent application in the USPTO corresponding to an application which DFW filed in the German Patent Office on November 30, 1992. The claims in the German application are directed to what is termed the "Waffe" invention which was invented by Hans von Heidelberg, a German citizen, at DFW's research facilities in Frankfurt, Germany. DFW requests that you file the U.S. application within the time frame required to obtain the priority benefits of 35 U.S.C. 119. Accordingly, you prepare an application which corresponds to the German application and file it in the PTO on July 5, 1993. On March 11, 1994, while attending a meeting of the research staff of ABC, Inc. (a fully owned subsidiary of DFW located in Trenton, New Jersey), you are introduced to Heidelberg who tells you that on March 9, 1994, he made a significant improvement to the "Waffe" invention in the ABC lab in Trenton. On March 30, 1994, DFW's patent agent in Frankfurt asks you to prepare a continuation-in-part (CIP) application to cover Heidelberg's improvement of the "Waffe" invention. You prepared the CIP application and sent it to Heidelberg for his review and execution of the application declaration. Today, April 13, 1994, you received the executed application with a note from Heidelberg requesting that you forward a copy of the CIP application to the DFW's patent agent in Frankfurt for preparing and filing a corresponding German application. Which of the following would be the most proper procedure for filing the CIP application in the USPTO and a corresponding application in the German Patent Office which would not violate the export control laws and regulations, and which would not require filing a request for a retroactive license?

- (A) File the CIP application in the USPTO on April 14, 1994, and file the corresponding German application in the German Patent Office on Tuesday, September 13, 1994.
- (B) File a proper petition and fee in the USPTO for a license for filing in a foreign country and before the petition is granted, file the corresponding application in the German Patent Office.
- (C) File the CIP application in the USPTO on April 14, 1994 and, if a filing receipt from the USPTO is received on Friday, June 10, 1994, indicating that a license

has been granted, forward a copy of the application to DFW's patent agent authorizing the agent to file the corresponding application in the German Patent Office.

- (D) File both the German application in the German Patent Office and the CIP application in the USPTO on Friday, May 13, 1994.
- (E) Because Heidelberg is a German citizen, forward a copy of the CIP application to DFW's patent agent with instructions authorizing the agent to file a corresponding application in the German Patent Office, and then file the CIP application in the USPTO six months later.

SEE SECTION 140. Answer (c).

Section 3

Chapter 200 Types, Cross-Noting, and Status of Application (2.88%)

201 TYPES OF APPLICATIONS

A. Provisional vs. Nonprovisional Applications

The statute provides for provisional (35 U.S.C. 111(b)) and nonprovisional (35 U.S.C. 111(a)) patent applications. A provisional application is used for establishing a **domestic priority date**²⁰, and is limited to a disclosure of the invention and a fee. A provisional application can never issue as a patent, and the applicant must follow with a nonprovisional application within 12 months. Both types of applications are reviewed in detail in Chapter 600.



37 CFR 1.9 Definitions

A national application is a patent application filed under 35 U.S.C. 111(a) or (b), or which entered the national stage

²⁰.An applicant may file a provisional application on an invention in the USPTO. A provisional application in many cases is more convenient and always less expensive than a nonprovisional application. A nonprovisional application must follow within 12 months. If all the requirements have been met, the nonprovisional application is examined for all purposes of applying prior art on the basis of the provisional applications filing date because the provisional application has established a U.S. priority date (i.e., a domestic priority date).

from an international application under 35 U.S.C. 371.

A provisional application is a U.S. national application filed under 35 U.S.C. 111(b).

A nonprovisional application is a U.S. national application which was either filed under 35 U.S.C. 111(a), or which entered the national stage from an international application under 35 U.S.C. 371.

An international application is an application filed under the Patent Cooperation Treaty (PCT) prior to entering the national processing (i.e., the **national stage**²¹) in one or more countries chosen by the applicant. It is sometimes called a PCT application.

B. National Application (35 U.S.C. 111(a)) vs. National Stage Application (35 U.S.C. 371)

Nonprovisional and provisional applications are national applications. Treatment of a national application and a national stage application (a national application which entered the national stage from an international application) are similar but not identical.

37 CFR 1.9(a)(1) defines a national application as a U.S. application which was either filed in the USPTO under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371. Domestic national patent applications fall under three broad types:

- (1) Applications for patent under 35 U.S.C. 101 relating to a new and useful process, machine, manufacture, or composition of matter, etc.
- (2) Applications for plant patents under 35 U.S.C. 161.
- (3) Applications for design patents under 35 U.S.C. 171.

21.If an applicant files an international (PCT) application (in the U.S. or some other member country), this allows the applicant to have his or her application examined in any or all of the countries that are a members of the treaty. Since the international application does not involve any member country except for administrative purposes, the application at some point (usually after 30 months) must undergo examination of the application in the countries where a patent is desired. For this to happen, the applicant must meet the requirements of entering the national stage in each country, and the processing and prosecution of the application in the individual countries is called the “national stage”.

Sole Application (201.01)

A patent application filed by a single inventor.

Joint Application (201.02)

An application filed by two or more inventors.

CORRECTION OF INVENTORSHIP (201.03)

A. General

Sometimes a patent application is filed naming the wrong inventors (i.e., the wrong inventive entity). One aspect of U.S. patent law is that patent applications must name the correct inventors. Correction is possible in a number of ways. One way is to file a continuing application naming the correct inventorship. Filing a continuing application is appropriate if at least one of the correct inventors was named in the prior application (called inventorship overlap). A continuing application is another application filed by the inventors disclosing and claiming the same invention.

Where the name of an inventor(s) is to be deleted, applicant can file a continuation or divisional application (using a copy of the executed oath or declaration from the parent application) with a request for deletion of the name of the inventor(s). If a continuing application is filed with a new executed oath or declaration properly naming the correct inventors, a request for deletion of the name(s) of the person(s) who are not inventors in the continuing application is not necessary.

Where the name of at least one inventor is to be added, correction of inventorship can be accomplished by filing a continuing application with a newly executed oath or declaration.

Where the name of an inventor(s) is to be deleted, applicant can file a continuation application (using a copy of the executed oath or declaration from the **parent application**²²)

22.Sometimes an applicant files a nonprovisional patent application and for one of many reasons, decides to file another application (called a continuing application) on the same or one of the same inventions in the first application. If all the requirements have been met, the later application can benefit from the prior applications filing date. Sometimes the earlier application is referred to as the “parent” application. This topic is reviewed in detail in Chapter 200. The terminology “original” distinguishes a patent application from a reissue application and should not be used in the sense of the terminology “parent” above.

with a request for deletion of the name of the inventor(s).

For provisional applications, it is not necessary to correct inventorship unless there would be no overlap of inventors upon the filing of a nonprovisional application.

Another way of correcting inventorship is under the provisions of 37 CFR 1.48 (covered below). Requests under the rule are usually decided by the primary examiner except when the application is involved in an interference, when the application is a national stage application and the application has not satisfied the requirements to enter the national stage, or when the request is accompanied with a petition requesting the waiver of any of the requirements under the rule.

B. Applications Filed Under 37 CFR 1.53(f) With No Oath or Declaration

The filing receipt identifies the inventors named in a patent application filed without an oath or declaration. If an oath or declaration is filed that names a different inventive entity, the actual inventorship is taken from the oath or declaration. A request under 37 CFR 1.48 is not necessary.

C. Correction Under 37 CFR 1.48(a) (Nonprovisional Application)



37 CFR 1.48

(a) A nonprovisional application filed with an oath or declaration that names an incorrect inventive entity may be corrected if the error arose without any deceptive intention on the part of the person named as an inventor in error, or on the part of the person through error was not named as an inventor.

If this is the case, the application may be amended to name only the actual inventor or inventors. The amendment requires (1) a request to correct the inventorship and the desired change, (2) a statement from each person being added or deleted that the error occurred without deceptive intention, (3) an oath or declaration by the actual inventors, (4) a processing fee, and (5) the consent of the assignee, if any.

The statement required from each inventor being added or deleted may simply state that the inventorship error occurred without deceptive intention.

An oath or declaration by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity.

If the processing fee has not been submitted or authorized the request will be dismissed.

The written consent of every existing assignee of the original named inventors must be submitted. Where no assignee exists requester should affirmatively state that fact.

D. Correction Under 37 CFR 1.48(b) (Nonprovisional Application)



37 CFR 1.48

(b) If the correct inventors are named in a nonprovisional application, and during prosecution claims are cancelled or amended so that some of the currently named inventors should no longer be named as inventors in the application, an amendment must be filed requesting deletion of the names of persons who are not inventors. The amendment requires (1) a request (signed by a party in 1.33(b), i.e., a practitioner of record, a practitioner acting in a representative capacity, an assignee, or all of the applicants) to correct the inventorship that identifies the inventors being deleted and acknowledging that the inventor's invention is no longer being claimed, and (2) a processing fee.

A request under 37 CFR 1.48(b) to delete an inventor would be appropriate where it is decided not to pursue particular aspects of an invention attributable to some of the original named inventors.

The statement may be signed by applicant's registered attorney or agent who then takes full responsibility for ensuring that the inventor is not being improperly deleted from the application. Written consent of any assignee is not required for requests filed under 37 CFR 1.48(b).

The question states: An amendment in an unassigned nonprovisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

(A) A registered practitioner not of record who acts in a representative capacity under 37 CFR 1.34.

(B) All of the applicants (37 CFR 1.41(b)) for patent.

(C) A registered practitioner of record appointed pursuant to 37 CFR 1.32(b).

(D) (B) and (C).

(E) (A), (B), and (C).

Answer (E) is the correct answer. Sections 1.48(b) and (d) indicate that a request to correct the inventorship must be signed by a party as set forth in 37 CFR 1.33(b). (A), (B), and (C) are provided for in 37 C.F.R. 1.33(b). Thus (E), the most inclusive answer, is correct.

E. Correction Under 37 CFR 1.48(c) (Nonprovisional Application)



37 CFR 1.48

(c) If a nonprovisional application discloses unclaimed subject matter, the application may be amended to add claims to the subject matter and amend the application to name the correct inventors for the application. The amendment requires (1) a request to correct the inventorship, (2) a statement from each inventor being added that the change was necessitated by amendment of the claims and that the error occurred without deceptive intention on their part, (3) an oath or declaration by the actual inventors, (4) a processing fee, and (5) the consent of the assignee, if any.

37 CFR 1.48(c) provides for the situation where a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application when an executed declaration under 37 CFR 1.63 was first filed.

F. Correction Under 37 CFR 1.48(d) (Provisional Application)



37 CFR 1.48

(d) If the names of inventors were omitted in a provisional application through error without any deceptive intention on the part of the omitted inventors, the provisional application may be amended to add the names of the omitted inventors. The amendment requires (1) a request signed by a party in 1.33(b) (a practitioner of record, a practitioner acting in a representative capacity, an assignee, or all of the applicants) to correct the inventorship that identifies

the inventors being added and that the error occurred without deceptive intention on the part of the omitted inventors and (2) a processing fee.

37 CFR 1.48(d) provides a procedure for adding the name of an inventor in a provisional application, where the name was originally omitted without deceptive intent.

G. Correction Under 37 CFR 1.48(e) (Provisional Application)



37 CFR 1.48

(e) If the names of inventors were named in a provisional application through error without any deceptive intent on the part of such inventors, the provisional application may be amended deleting the names of the erroneously named inventors. The amendment requires (1) a request to correct the inventorship that sets forth the desired change, (2) a statement by the inventors whose names are being deleted that the error occurred without deceptive intention on their part, (3) a processing fee, and (4) the consent of the assignee, if any.

37 CFR 1.48(e) provides a procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application.

An error in not naming or in naming a person as an inventor in a provisional application would not require correction in the provisional application so long as the nonprovisional application naming the correct inventorship would contain an overlap of at least one inventor with the provisional application.

In the situation where an inventor was not named in a provisional application and an inventor was also erroneously named in the same provisional application and correction is desired, a request under 37 CFR 1.48(d) and a request under 37 CFR 1.48(e) would be required.

Where an inventorship error in a provisional application is desired to be corrected after expiration of twelve months from the filing date of the provisional application, a request under 37 CFR 1.48(d) and/or 37 CFR 1.48(e) may still be filed to correct the inventorship in provisional applications.

Examples

If applicant chooses to correct the inventive entity of a provisional application, for exam-

ple, to permit the provisional application to serve as the basis of a priority claim in a foreign country, 37 CFR 1.48(d) and (e) set forth the procedures for adding one or more actual inventors and for deleting one or more erroneously named inventors respectively.

In the situation where an inventor was not named in a provisional application and an inventor was also erroneously named in the same provisional application and correction is desired, a request under 37 CFR 1.48(d) and a request under 37 CFR 1.48(e) would be required.

Lecture 3

Welcome to Lecture 3.

We are starting in Chapter 200 with some important vocabulary and definitions. The first part introduces provisional and nonprovisional patent applications. Provisional applications are authorized under 35 USC 111(b), and are sometimes referred to as applications filed under 111(b). Nonprovisional applications are authorized under 35 USC 111(a), and are sometimes referred to as applications filed under 111(a).

A national application is an application filed under 111(a) or (b), or which entered the national stage from an international application filed under 35 USC 371. All three are domestic national patent applications. An international application is an application filed under the Patent Cooperation Treaty, or PCT prior to entering the national stage in one or more countries where a patent is desired by the applicant.

Domestic national patent applications may be for a new and useful process, machine, manufacture, or composition of matter under 35 USC 101. It may also be a plant patent under 35 USC 161 or a design patent under 35 USC 171.

A sole application is an application filed by a single inventor, and a joint application is one filed by two or more inventors.

The next section involves correction of inventorship. U.S. patent law requires that a patent applications name the correct inventors. If the inventorship is wrong, it must be corrected. There are two ways to correct inventorship. The first one is to file a continuing application naming the correct inventors, which is a second patent application for the same invention. Filing a continuation application is appropriate so long as there is at least one of the correct inventors was named in the prior parent application. If the continuing application is deleting an inventor, a copy of the oath or declaration filed in the prior application may be used with a request to delete the name of the incorrect inventor. If an inventor is to be added, a newly executed oath or declaration must be filed. For provisional applications it is not necessary to correct inventorship unless there would be no overlap of inventors upon filing a nonprovisional application.

The second way of correcting inventorship is under one or more of the provisions under 37 CFR 1.48(a)-(e). Each of the five paragraphs (a)-(e) of the rule introduce a different situation, and (a)-(c) are for nonprovisional applications and (d)-(e) are for provisional applications.

37 CFR 1.48(f) also introduces a way of changing the inventorship in a patent

application without resort to filing a continuing application or under the provisions of 1.48(a)-(e). Under 1.48(f), if a nonprovisional patent application is filed without an oath or declaration improperly naming the inventors, or a provisional application is filed without a cover sheet improperly naming the inventors, the inventorship may be corrected by filing an oath or declaration naming the correct inventors in a nonprovisional application, or by filing a cover sheet naming the proper inventors in a provisional application. If 1.48(f) is applicable, that would always be the proper way to correct inventorship.

The next parts introduce the requirements under 1.48(a)-(e). 1.48(a), (b) and (c) apply to nonprovisional applications only. Under 1.48(a), an inventor (or inventors) must be added or deleted, but note that this provision is only available if the error occurred without deceptive intention. If there was deceptive intention, then a continuing application must be filed to correct inventorship assuming inventorship overlap is present. 1.48(a) requires a request to amend the inventorship, a statement from each person being added or deleted that the error occurred without deceptive intention, an oath or declaration by the actual inventors, a processing fee, and the consent of the assignee, if any.

1.48(b) is available where a claim or claims have been cancelled in an application that results in an inventor or inventors no longer being an inventor of any claimed invention in the application. For example, the application is filed claiming inventions A, B, and C. Inventor X invented only invention A. The claim to invention A is cancelled. To correct the inventorship, the applicant must file a request to correct inventorship under 1.48(b) that identifies the inventors being deleted and a processing fee.

1.48(c) is the reverse of 1.48(b). Under 1.48(c), an application contains subject that was not claimed in the application-as-filed, and during prosecution an amendment is filed claiming the unclaimed subject matter. This may require the naming of an inventor of the unclaimed subject matter if that inventor was not named in the oath or declaration. Under 1.48(c), the applicant must file a request to correct inventorship including a statement from each inventor being added that the change is necessitated by amendment of the claims and the error occurred without deceptive intent, an oath or declaration by the actual inventors, and a processing fee.

1.48(d) and (e) apply to provisional applications only. 1.48(d) applies where inventors were omitted, and 1.48(e) applies where inventors were improperly named. In both cases the mistake must have occurred through error and without deceptive intent. Under 1.48(d), the applicant must file an amendment to correct the inventorship identifying the inventors being added including a statement that the error occurred without deceptive intent and a processing fee. Under 1.48(e), the applicant must file an amendment deleting the names of the erroneously named inventors including a statement by the inventors being deleted that the

error occurred without deceptive intent, a processing fee, and the consent of the assignee, if any.

Prior Exam Questions

Question 301

A patent application was filed in the PTO on January 4, 1998. The entire interest in the application was assigned to an assignee who properly recorded the assignment in the PTO. However, one of the actual inventors was inadvertently and unintentionally omitted from the executed application declaration. Which of the following is not required to correct the inventorship?

- (A) A declaration by the assignee stating there is no deceptive intent on the part of the assignee.
- (B) A fee.
- (C) A statement by the omitted inventor which includes a statement of facts that the error was without any deceptive intent.
- (D) An oath or declaration by each actual inventor.
- (E) The written consent of the assignee.

SEE SECTION 201.03. Answer (a).

Question 302

J, a patent practitioner, submitted a patent to the PTO listing two inventors, A and D. The original application contained 10 claims. The first Office action rejected all ten claims under 35 U.S.C. § 103. J then submitted an amendment canceling claims 5 and 6 and adding claims 11 and 12. Before the amendment was acted on by the examiner, J discovered that in the original application, A was a co-inventor only in claims 5 and 6. D was the sole inventor of the remaining claims. For the two claims submitted with the amendment, D was the sole inventor of claims 11 and 12. What should J do to rectify any inventorship questions?

- (A) Nothing, because the inventorship question does not affect the validity of the patent and is mainly concerned with ownership rights which implicates state law, not Title 35. Therefore, the USPTO does not allow applicants to correct errors in naming inventors.
- (B) File an amendment with the processing fee requesting deletion of A as an inventor.
- (C) Abandon the application and file a continuation application listing only A as the inventor.

- (D) Send the PTO a petition with the appropriate fee, after receiving a notice of allowance, explaining the problem and asking the PTO to correct the clerical error in the application.
- (E) Abandon the application and file a continuation application listing only D as the inventor.

SEE SECTION 201.03. Answer (b).

Question 303

Requests under 37 CFR § 1.48 are generally decided by the primary examiner except:

- (A) When the application is involved in an interference.
- (B) When the application is a national stage application filed under 35 U.S.C. § 371.
- (C) When accompanied by a petition under 37 CFR § 1.183 requesting waiver of a requirement under 37 CFR § 1.48(a) or (c), e.g., waiver of the statement of lack of deceptive intent by an inventor to be added or deleted, or waiver of the reexecution of the declaration by all of the inventors.
- (D) When a second conversion under 37 CFR § 1.48(a) is attempted.
- (E) A, B and C.

SEE SECTION 201.03. Answer (e).

Question 304

An amendment is filed in an unassigned nonprovisional application that seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

- (A) A registered practitioner not of record who acts in a representative capacity under 37 CFR § 1.34(a).
- (B) All of the applicants (37 CFR § 1.41(b)) for patent.
- (C) A registered practitioner of record appointed pursuant to 37 CFR § 1.34(b).
- (D) (B) and (C).
- (E) (A), (B), and (C).

SEE SECTION 201.03 and 37 CFR 1.48(b). Answer (e).