

## Beginning of exam/Test strategies

Write down numbers & symbols (**X** for certain, **XO** for answered but want to lookup, **O** for narrowed down to 2-3 answers [mark these], and **?** for not sure or longer lookup)

Write down brief summary of 102 rule

### 102 Summary to copy down

102(a) – Prior art is:

- 1) that publicly disclosed before **invention** filing date (publications, patents, public use/sale)
- 2) qualifying US patents and patent applications (including WIPO published applications that designate the US) naming another inventor that were effectively filed before **invention** filing date

102(b) – Not prior art if:

- 1) Disclosure was made WITHIN 1 year of effective filing date of the **invention** by inventor/another or disclosed publically by inventor/another prior to primary disclosure
- 2) Disclosure info was obtained from the inventor, was publically disclosed by inventor/another BEFORE effective filing date of **reference**, OR was commonly owned NO LATER THAN **invention** filing date
  - i) In these cases, another specifically refers to one who obtained the information directly or indirectly from an inventor

Note that prior art can fall under both 102(a) and 102(b) or just under one of them. For example, a US patent which was filed in March 2015 and published March 2016 would be prior art under 102(a) and 102(b) for an application filed April 2016, but only prior art under 102(b) for an application filed February 2016.

## MPEP 100 - Secrecy, Access, National Security, and Foreign Filing

- a foreign filing license is not needed six months after filing a corresponding US patent application (provided there is no secrecy order)
- if applicant wants to file in a foreign country earlier (as a first or subsequent patent), they must obtain a foreign filing licensee

## MPEP 200 - Types and Status of Application; Benefit and Priority Claims

- for continuation/divisionals/etc, AIA rules state priority of previous application (and relationship) must be indicated in ADS
- CPA can be a continuation or divisional application of a national design application
  - fewer requirements and faster turnaround than simple continuation or divisional
  - treated as amended applications vs "new" applications (like cont. or div.)
  - expressly abandons prior application (cont. and div. do not)
- an improper CPA is treated as an RCE, but an improper RCE (directed towards design app) is not automatically considered a CPA
- priority
- an incorporation by reference statement cannot be added after filing (would be considered new matter)
- must have same or common inventor (meaning of "same applicant" requirement) in order to claim priority

## MPEP 300 - Ownership and Assignment

- instructions for submitting assignment documents via facsimile (and exceptions) and online (EPAS)
- prior assignment is effective for continuing applications (div. & cont.) but not C-I-P or substitute (unless assignee is original applicant)
- assignees of entire patent or partial assignees and inventors/other assignees can conduct matters during regular prosecution and supplemental examination or reexamination
- if not the original applicant, assignee gains right to take action when:
  - inventor/applicant assigns all of their rights to New Assignee (NA)
  - NA is made of record in the application
  - applicant is changed under 37 CFR 1.46(c)(2) via the filing of an updated ADS
- when assignee (not original applicant) first takes action, they must both establish ownership (37 CFR 3.73, file evidence) and file a request to change the applicant (37 CFR 1.46(c))
- if other owners/inventors exist, they must also submit 37 CFR 1.46(c) statement establishing the extent of their own ownership
- **(IMPORTANT)** assignments can be made of record:
  - in the assignment records of the Office. Allows patent to issue to assignee. By itself, does NOT permit applicant to take action in prosecution

- in the file of the application or patent proceeding (necessary to permit assignee to "take action" in the patent prosecution)

## **MPEP 400 - Representative of Applicant or Owner**

- an assignee who is not an applicant cannot appoint or revoke a power of attorney (same if inventor is not the applicant)
- only someone who is registered to practice before the USPTO or is named as a joint inventor (registered or not) can be appointed as power of attorney
- power of attorney does NOT automatically carry over in continuing applications
- PoA must be given by ALL inventors/assignees, so the addition of a new inventor without a consistent PoA statement effectively revokes the previous PoA
- the most recently filed PoA controls
- a registered practitioner can act in a representative capacity without being appointed as PoA

## **MPEP 500 - Receipt and Handling of Mail and Papers**

- new applications can be transmitted via EFS web but **NOT** by facsimile and do **NOT** receive benefit of the Certificate of Transmission
- facsimile transmissions are given the date (eastern time) the complete transmission is received in the Office
  - unless it's a weekend/holiday, in which case the receipt date will be the next business day
- date of receipt for EFS Web is also local Eastern time
- Certificate of Transmission can overcome this if it's available for the filing of the item and the item was filed at the appropriate time locally
  - e.g. filed 9:30pm Pacific time on Friday (which would be 12:30am ET on a Saturday), but local time would count if Certificate of Transmission is used
  - Certificate of Transmission applies to papers filed from anywhere via facsimile or efs web (even foreign countries)
- Certificate of Mailing applies **ONLY** to papers filed in US
- Certificate of Mailing/Transmission is an official statement by an applicant of the date when the paper will be deposited with USPS or transmitted via fax/EFS Web
- such date is then considered the date the papers were filed by
- "Express Mail" or "Priority Mail Express" is a USPS mailing procedure/means to deposit mail
- items deposited via priority mail express are given the date of deposit with USPS as the filing date
- small entity status
  - once small entity status is established, fee payments can be made without regard to a change in status UNTIL the issue fee or maintenance fees are due
  - loss of status must be submitted in writing, one cannot just pay the larger fee
  - assertion of small entity status can be made in writing OR by paying the correct fee (liberal interpretation)
- micro entity status

- assertion of micro entity status must be made via a certification, and loss of status must be submitted to the Office
- qualification for micro entity status must exist for EACH payment of a fee
- micro or small entity status must be met by ALL inventors and applicants/owners

## **MPEP 600 - Parts, Form, and Content of Application**

- content of nonprovisional and provisional applications
- ADS
- oath and declaration
- refunding fees
- disclosure (specification and content)
- claims
- drawings
- IDS
- Claim language
  - Consisting of/consisting essentially of [closed/closed to all but immaterial additions]
  - Comprising/containing/characterized by [open-ended]

## **MPEP 700 - Examination of Applications**

- [704] Examiners can make a requirement for information when further action will be taken (e.g. after a first office action but NOT with a final rejection)
- Rejection vs objection of claims (content/merit vs form, respectively)
- [706] final rejection
  - When allowed and when not allowed, also withdrawal of rejection
- [706.07(h)] RCE
  - Prosecution must be closed before an RCE can be filed
  - Filing includes payment of fee and some actual attempt to move prosecution along (such as an amendment)
- [708] Special circumstances for advancing examination
  - Petition to make special
    - Based on applicant's age or health, inventions relating to improved environment, new or improved energy resources, or counter terrorism
    - No fee required
    - Requirements listed under 'accelerated examination' section (doesn't apply to age/health special status or PPH program)
    - Goal to complete examination in 12 months
  - Request for prioritized examination
    - Also referred to as "track 1" prioritized examination
    - fewer requirements than accelerated examination and applicable to more types of applications

- patent prosecution highway program (see pdf)
- [710] period for reply to office action and extensions of time
  - Shortened statutory period (SSP) for reply have max time of 6 months and min of 30 days
  - Extensions of time are measured from original date time BEGAN not original due date (e.g. reply to Office action mailed Jan 31 with 3-month SSP is due April 30, and upon addition of 1-month extension of time is due May 31)
  - Replies with specific time limit (NOT SSP) are extendable up to 5 mos and if missed, usually don't result in abandonment (e.g. the 2-month period for filing appeal brief)
  - Extensions of time under 37 CFR 1.136(a) are automatic once requested and can be filed outside of initial reply period, but must be within the requested extended period for reply
  - Extensions of time under 37 CFR 1.136(b) allows extension for showing of sufficient cause and must be filed during initial reply period
- [711] Abandonment
  - If an application is deemed abandoned but is not in fact abandoned, applicant can petition for withdrawal of abandonment
  - Otherwise, if applicant agrees abandonment (accidental or otherwise) occurred, then revival can be petitioned for
    - Application can be revived after failure to reply to Office requirement, pay issue or maintenance fees, and to establish codependency between two applications
    - Revival requires either a reply, required fee, or any other outstanding item
- [713] Interviews
  - Can be in-person, email, telephone, or video chat
  - Can occur before first office action or after final rejection
  - Registered practitioners NOT of record may conduct an interview by filing an Applicant Initiated Interview Request form (simplest method), filing a power of attorney, or filing an authorization to act in a representative capacity
- [714] Amendments
  - Formatting rules for making amendments
    - Strikethrough and brackets to show deletions and underlining to show additions
  - Anytime changes are made to the claims, all claims ever presented must be provided with status identifiers (e.g. "original", "canceled", "currently amended", etc)
  - Rules for signing amendments
  - Preliminary amendments are any amendments sent in before mailing of the first Office action
- [715] 37 CFR 1.131(a) Affidavits or Declarations (pre-AIA)
  - Used to discredit a reference under pre-AIA 35 USC 102
  - Called "swearing back"
  - Prove invention of subject matter by inventor prior to prior art reference date
  - Applies only to prior art under pre-aia 102(a)/(g)/(e), publication or relevant date w/in one year of filing, but NOT pre-AIA 102(b)
- [716] 37 CFR 1.132 Affidavits or Declarations
  - All affidavits or declarations that don't fall under other rules are grouped here
    - This includes presentation of secondary evidence for rebutting obviousness rejections or rejections related to 35 USC 112

- Must include evidence to support arguments made
- Full discussion of the rules and means for arguing from secondary evidence, including:
  - unexpected results
  - commercial success
  - long-felt need
- Must be timely submitted in order to be considered
- [717] Prior Art Exceptions Under AIA 102(b)
  - 37 CFR 1.130 Affidavit/Declaration used to establish that disclosure is NOT prior art under all provisions of AIA 102(b)
  - 102(b)(1)
    - Disclosure made LESS THAN (or equal to) 1 year before the effective filing date of the invention are not prior art if disclosed by inventor or obtained from the inventor
  - 102(b)(2)(C)
    - A disclosure can be disqualified as prior art under 102(a)(2) if it was commonly owned/assigned or under joint research before or at the time of filing of the invention in question
    - Commonly owned means 100% ownership of both the subject matter (prior art) and the claimed invention
    - Applicants merely need to provide a clear statement, identifying the application in question, that establishes the existence of a joint research agreement or common ownership as of the application's filing date
      - No further evidence, unless specifically requested by examiner, is necessary
      - For a joint research agreement, an amendment must also be filed to add the names of the members of the agreement to the application
    - Cannot be used to disqualify art under a double patenting rejection
  - Can't use 1.130 if **(1)** a derivation is necessary (arguing that US patent or US patent application that is substantially the same derived invention from inventee) or **(2)** the disclosure was made more than one year before filing date
- [718] 37 CFR 1.131(c) Affidavit or Declaration (pre-AIA)
  - For disqualifying commonly owned patents

## **MPEP 800 - Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting**

- Double patenting based on two applications (or application/patent) that are commonly owned (i.e. have some inventor, applicant, or assignee in common, or subject to joint research agreement)
- Statutory Double Patenting Rejections, "Same Invention" type - Under USC 101, same invention
  - CANNOT be overcome by terminal disclaimer
  - claims must be cancelled or amended or arguments against the double statutory assertion must be made

- Non-Statutory DPR - Under anticipation or obviousness; at least one claim in an application is patentably indistinct from a claim in another
  - same inventive concept, different scope
  - Can overcome with either a terminal disclaimer (provided the applications/patents in question are commonly owned) or by arguing the claims are patentably distinct
  - provisional double patenting rejection
    - made between copending applications, so long as confidentiality requirement is not violated
    - any changes to drawings (even minor) must be submitted as a replacement sheet

## **MPEP 900 - Prior Art, Classification, and Search**

- basic instructions for patent examiner on how to conduct a prior art search
- 901 most relevant for exam [prior art that does and does not qualify]

## **MPEP 1000 - Matters Decided by Various U.S. Patent and Trademark Office Officials**

- Conduct for petitions and appeals

## **MPEP 1100 - Statutory Invention Registration (SIR); Pre-Grant Publication (PGPub) and Preissuance Submissions**

- SIR have the defensive attributes of a patent (prior art) but not the enforceable attributes of a patent (ability to exclude)
  - no longer available as of March 16, 2013
- third party preissuance submissions
  - limited to US and foreign patents and non-patent publications
  - must be made before earliest of 1) notice of allowance, 2) first office action, 3) six months after US publication
- with few exceptions, nonProv. applications for plant and utility applications are published within 18 mos of their earliest effective filing date
- applicant can request nonpublication or faster publication
- design applications are typically not published
- publication must be allowed if filing a counterpart in a foreign country that requires publication, and a nonpublication request must be rescinded before or on the date of foreign filing
  - alternatively, applicant can submit a "notice of foreign filing" no more than 45 days after foreign filing, but one or the other must be done to avoid abandonment
- in order to be considered, nonpublication requests must be submitted upon filing application [this requirement CANNOT be waived]

## **MPEP 1200 - Appeal**

- notice of appeal (applicant) -> appeal brief (applicant arguments for appeal) -> examiner's answer (reopen prosecution to enter new ground of rejection, allow the application, or maintain appeal, hold appeal conference, and draft official examiner's answer) -> reply brief (applicant, answer to examiner, only required if a new ground of rejection is brought up) -> Board receives appeal for decision
- notice of appeal can be filed after any claims have been twice rejected (regardless of final rejection) including continuing over from previous applications

## **MPEP 1300 - Allowance and Issue**

- issue fee and publication fee (if not already published) are due 3 mos from notice of allowance mail date [NON extendable]
- both applicants and examiners can withdraw an application from issue for various reasons

## **MPEP 1400 - Correction of Patents**

- there must be some error in the patent in order to file a reissue (e.g. scope of claims too narrow/broad or priority claims incorrect/missing)
- broadening reissue must be filed w/in 2 years of patent grant (including 2 year anniversary day)
- all previously cited references are considered along with any additional materials submitted in reissue analysis
- NO recapture allowed (if material was "surrendered" in original application in order to make claims allowable, then that material cannot be reclaimed in a reissue app
  - this does not apply to material that was merely presented in the specification but not claimed
  - three step process of analysis:
    1. is there broadening of claims?
    2. is that broadening related to previously surrendered subject matter?  
[were amendments made in response to a rejection OR specific arguments made by applicant/attorney about already existing limitations in response to rejection?]
    3. are the claims additionally narrowed so that recapture is not occurring?  
[recapture occurs if surrendered subject matter/claim limitation is completely eliminated from a claim]  
[if limitation has not been entirely removed (e.g. made less restrictive or modified) and narrowed in other aspects, then recapture may be argued against]
- the oath or declaration for a broadening reissue must be signed by all inventors, unless the assignee of the whole interest filed the application for the original patent
- after announcement of reissue application in official gazette, examiner will typically wait at least 2 months for acting on the application to give third parties a chance to submit pertinent information



## MPEP 1500 – Design Patents

- design patents may only have a single claim
- last 15 years from date of patent grant (starting May 13, 2015)

## MPEP 1600 – Plant Patents

- only asexually reproducing plants are patentable
- only one claim allowed

## MPEP 1700 - Miscellaneous

- restrictions on current/former examiners aiding in patent prosecution
- Official Gazette publications

## MPEP 1800 – Patent Cooperation Treaty

- applicant can file a single international application and have it considered in as many member PCT countries as requested
- Section 1842 is Basic Flow Under the PCT with helpful chart for time requirements
- process:
  - **[international phase]** send in application (through local Receiving Office, e.g. USPTO or directly to the International Bureau (IB))
  - RO makes sure formal requirements for filing are met
  - initial international search report and written opinion by International Searching Authority (ISA)
    - report provides information on the most relevant prior art available
    - written opinion comments on the following qualities of the invention: novelty, whether an inventive step is involved (non-obvious), and industrial applicability (utility)
  - supplementary international searches can be requested and performed by other Offices authorized to do so
  - after sending out report, applicant has 2 months to file any amendments to the claims (and **ONLY** the claims) **[Article 19 amendments]**
  - publish the international application along with report and any amendments
  - applicant can send in Demand for international preliminary examination and said examination is conducted (if requested)
    - with demand, amendments can be made to the claims, as well as the description and drawings **[Article 34 amendments]**
    - any country to receive the results of this preliminary examination is designated as the Elected Office

- [national phase] send application to all Designated Offices (Chapter I, no preliminary examination)
    - or Elected Offices (Chapter II, preliminary examination)
- copy of the international application and basic filing fee are due in uspto NO later than 30 months from application's priority date

## MPEP 1900 - Protest

- protest : type of preissuance opposition
- all protests (unless allowed by applicant) must be submitted prior to the earliest of publication date or mailing date of notice of allowance
- protester not involved in proceedings, i.e. not told the status of the application (or even if such application exists)

## MPEP 2000 - Duty of Disclosure

- once an applicant discloses a reference as prior art, this assertion cannot be taken back
- duty of disclosure continues throughout the life of the patent, doesn't end after issuance

## MPEP 2100 - Patentability

- specification can be used to define terms in the claims, but a limitation in the specification must NOT be read into the claims if the claim does not clearly impose such limitation
- [2104] 35 USC 101
  - Only a single patent may be obtained
  - Inventors must be named
  - Invention must be eligible for patenting (i.e. be a process, manufacture, composition of matter, or machine AND must be directed to patent-eligible subject matter)
  - Invention must be useful/have utility
- Some living matter is patentable (non-naturally occurring, non-human organisms, including animals)
- [2106] patent-eligible subject matter discussion
  - Judicial exceptions are subject matter outside the four recognized categories of invention and are comprised of **abstract ideas, laws of nature, and natural phenomena or products**
  - The *Mayo* test walks through how to determine if an invention, which includes a judicial exception, is still patent eligible
    - Flow chart for test included near beginning of this section
  - A product must have a physical or tangible form to fall within one of the statutory categories of invention, but it is not necessary to identify the specific category an invention falls into (as it may, in fact, be part of multiple categories)
    - Sound or electromagnetic waves, for example, are NOT patent eligible
  - ALL embodiments of a claim must fall into a statutory category in order to be patent eligible

- Note that often inventions, in some way, use judicial exceptions (such as a machine made with the Physics concept of  $F=m*a$ ), but it is the question of whether the claim is directed specifically to that judicial exception that will determine the ruling
- Primary groupings of abstract ideas (not exhaustive) [Part of Analysis Step 2A]
  - Mathematical concepts
  - Organizations of human activity (e.g. fundamental economic practices or managing interactions between people)
  - Mental processes
- If judicial exceptions are incorporated into a practical application, they can still count as patentable material [Analysis Step 2B]
  - Merely instructing to “apply” an exception, adding insignificant extra-solution activity, or generally linking the exception to a particular field of use does not qualify as sufficient integration
- Examiner must explain the reasoning behind a subject matter eligibility rejection by identifying the judicial exception and explaining why any additional elements don’t amount to more than the exception
  - Evidence is not required to prove an embodiment is a judicial exception
- [2107] rejections based on utility
  - Specific and substantial utility (specific to invention AND significant, presently available benefit to the public, respectively)
  - Invention must have either stated or obvious utility; an incredible, unproven utility (such as a cure for cancer) cannot be used to satisfy this requirement
  - Failure to provide utility is also a failure under 35 USC 112 to teach how to make and use the invention
- [2109] inventorship
  - An inventor is not required to have personally reduced an invention to practice
  - An inventor only needs to have contributed to at least one of the claims to be named
- [2111] claim interpretation
  - Claims will be given their broadest reasonable interpretation in light of the specification, giving terms in the claims their ordinary meaning used by those skilled in the art (unless special definition is provided)
    - Take care though, that limitations are not read into the claim from the specification
  - Transitional phrases: comprising, consisting of, consisting essentially of
    - Comprising – open-ended (also including/containing/characterized by)
    - Consisting of – closed, excludes anything not listed in the claim
    - Consisting essentially of – mostly closed, excludes anything not in the claim except immaterial additions
- [2112] inherency
  - Something old does NOT become patentable upon the discovery of a new property (one that is an inherent feature of the invention)
- [2113] product by process claims
  - Patentability is based on the product itself
- [2117] Markush Claims
  - Recites a list of alternatively usable members (referred to as a Markush grouping)

- The members must share a structural similarity or some common use
- [2120] Rejections on Prior Art
  - For a rejection under 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly, and any feature not taught must be inherent
    - Almost always based on a single piece of prior art, unless additional pieces are used to back up or help define something in the primary piece
  - For a rejection under 103, a reference must be modified in some way to meet the claims
- [2121] Prior art, general level of operability required [Enabling Prior Art]
  - Prior art provides an enabling disclosure if the invention is described in sufficient detail to enable a person of ordinary skill to carry it out, proof of efficacy is NOT required for proving anticipation (102)
    - Enabling means no undue experimentation would have been necessary to utilize the invention, so mere naming of things (such as compounds) does not count as prior art (but evidence that there was failure to make the compound/invention at the time must be shown)
- [2122] No utility need be disclosed for reference to count as prior art
- [2123] Nonpreferred and alternative embodiments of an invention also count as prior art, even if they aren't the main focus of a disclosure
  - A disclosure criticizing or discrediting certain embodiments may, however, count as "teaching away" and revoke a reference's application as prior art in a 103 rejection
- [2125] Drawings can be used as prior art so long as they sufficiently disclose the invention
- [2126] Patent documents available for rejection under **102(a)**
  - A document must be at least minimally available to the public and accord certain rights to be considered a prior art "patent" for 102(a)
    - Secret patents, for example, are not available as prior art under 102(a) until they are formally published/made available to public
    - A foreign patent is considered prior art as of the issue date (or equivalent of)
  - The information contained in a patent's specification may be used to support a 102(a) rejection, whereas only the claims can be used for a patent application publication
- [2127] Domestic and Foreign patent applications as prior art
  - An abandoned patent application (including provisional) is not available as prior art until it has been formally disclosed (such as being referenced in another patent)
  - Canceled matter in an application cannot be used to support a 102(a)(2) rejection; however, it can be used to support a 102(a)(1) rejection once the canceled matter becomes publically available (for the US, issuance of an application means the prosecution history becomes available for public inspection)
  - Foreign patent application not available as prior art until date of publication/open to public
- [2128] Printed Publications as prior art
  - Online publications are prior art so long as they are sufficiently publically available and a date of publication or retrieval can be shown
  - An oral presentation is considered prior art if written copies are distributed
  - Internal documents clearly intended to remain confidential are not publically available
  - A publically displayed document can constitute prior art depending on the length of time it was displayed, its availability, and ease or allowance for copying the material

- A publication sent by mail becomes prior art as of the date the first person receives it, NOT when it was sent out
- [2129] Admissions as prior art
  - A clear admission of material as prior art by the applicant (excluding IDS listings and applicant's own work) will automatically make that material prior art regardless of whether it qualifies under 102
- [2131] Anticipation – Application of 35 USC 102
  - To reject a claim as “anticipated” by the prior art, the prior art must teach EVERY element of the claim, expressly or inherently
  - Typically, only one reference is used, but additional references may be included as a support for the primary one, defining terms or proving some element is inherent
  - A species will anticipate a claimed genus, but a genus does not necessarily anticipate a claim to a species within the genus (depending on how many species are contained within the genus and the ease of “picking out” said species from the genus)
  - Ranges can be anticipated or not, depending on the specificity and importance of the range, but generally overlapping ranges are likely to be anticipated and ranges that do not overlap with prior art are not anticipated (but can fall under 103's “obviousness”)
  - Secondary considerations (such as commercial success or unexpected results) are NOT sufficient for overcoming 102 rejections, neither are arguments that the literature disparages an invention or “teaches away” from using it
- [2132 – 2139] Pre-AIA 102 rules
- [2141] Examination guidelines for determining obviousness under 35 USC 103
  - An invention that would have obvious to one of ordinary skill at the time of the invention is not patentable
  - The Supreme Court has emphasized factual inquiries underlying an obviousness analysis (called the Graham factual inquiries):
    - Determine the scope and content of the prior art
      - The prior art available is determined by 102(a) rules
      - Prior art must be analogous art to the claimed invention (from the same field as claimed invention or, if from a different field, reasonably related to claimed invention)
    - Determine the difference between the prior art and claimed invention
      - “the mere existence of differences between prior art and an invention does NOT establish an invention's nonobviousness”
      - The question is not whether the differences would have been obvious, but rather would the claimed invention as a WHOLE have been obvious
      - Prior art teaching away or discrediting a claimed invention may be relevant in combating a rejection of obviousness
    - Determine the level of ordinary skill in the relevant art
      - Not definable by way of credentials (has a doctorate, masters, etc)
- [2142 – 2143] Prima Facie Obviousness and Many Case Examples
  - The concept of prima facie obviousness establishes the framework for the obviousness determination and who has the burden of providing evidence

- Patent examiner must first set forth the prima facie case, considering all facts (prior art AND claimed invention) and supplying evidence for findings
  - All limitations in the claim must be considered (excluding optional or dependent limitations)
  - If a claim includes selection of an element from a list of alternatives, only a single option need be proven obvious to render the element as a whole obvious
- Burden then shifts to the applicant to argue against findings of obviousness, with evidence if necessary
- Obviousness requires that there be a “reasonable expectation of success” when viewing motivation to modify the prior art or combine previous art references
  - In the same vein, the question of obvious results or outcome is also considered (predictable results)
- Objective evidence or secondary considerations **ARE** relevant in this analysis
  - This includes long-felt but unsolved needs, commercial success, unexpected results, and failure of others
- Obviousness cannot be predicated on what is NOT known at the time, even if the inherency of some feature is later established
- Any rebuttal to a rejection of obviousness must provide evidence or arguments and clearly address each issue raised by the examiner
  - Cannot merely state “examiner failed to provide a legitimate argument” or anything general along those lines
- [2144] Supporting 103 Obviousness Rejection
  - Rationale for combining or modifying prior art does not have to be explicitly stated in a work, but should carry some reasonable expectation of success or advantage
  - Common knowledge (unsupported by specific evidence) can be used to support a 103 rejection (but cannot be the sole basis for a rejection), and care should be taken and full reasoning/explanation should still be given
  - Legal precedence can be used to support a 103 rejection so long as the facts of the case are sufficiently similar to the claimed invention
  - Similar/close or overlapping claimed ranges (such as temperature or concentration) can be used to establish obviousness
    - Factors such as the prior range being incredibly broad or the claimed range being a critical optimization can be used to rebut an obviousness rejection
  - Substituting one known element for another or combining two known elements for the same purpose serves as evidence for obviousness, an express suggestion to combine is not needed
  - When prior art teaches a genus and the claim is to a species, many factors need to be taken into account to determine if obviousness is present: the size of the genus, other prior art species, predictability of variations, etc
- [2145] Rebuttal to 103 Obviousness Rejection
  - secondary considerations (failure of others, long felt needs, commercial success)
  - a showing of unexpected results (supported by data/evidence) in at least one aspect of the claimed invention
  - failure of prior art to satisfy the enablement requirement
    - prior art must put the public in possession of the invention

- so a non-enabling disclosure cannot, on its own, hold up a 103 rejection, but it can be used to support it
  - argue reference explicitly teaches away/discredits claimed invention, combination, or element
- [2151] AIA vs Pre-AIA 102 and 103
  - 102(a)(2) – collective US patent documents are prior art as of their **filing date** (so long as they have been published)
    - WIPO publications of international PCT applications designating the US are included under US patent documents (regardless of whether they’ve entered the national stage and what language they’re published in)
  - Note that prior art can qualify under 102(a)(2) AND 102(a)(1), and certain exceptions [102(b)] may not disqualify the prior art under both categories
- [2152] Detailed View of AIA 102(a) and 102(b)
  - The documents which a 102(a)(1) rejection may be based on are an issued patent (domestic or foreign), a published patent application, and a non-patent published application
  - the activities a rejection can be based on includes public access (sale, use, or other availability)
    - secret sale, or a sale that occurs with an obligation of confidentiality does NOT count under AIA (but did under pre-AIA)
  - The documents which a 102(a)(2) rejection may be based on are ONLY US patent documents (this includes international applications that designate the US)
  - A disclosure that qualifies as anticipatory prior art will (1) disclose all elements of the invention arranged/combined in the same way as the claim and (2) enable one of ordinary skill in the art to make/use it
    - However, proof of efficacy, details on how to use, or reduction to practice is not necessary
  - Gives general overview on overcoming a rejection
- [2153] Prior art exceptions under 102(b)(1) to 102(a)(1)
  - Grace-period inventor disclosures
    - Disclosure made by inventor one year or less before effective filing date of invention
  - Disclosure by “another” can be overcome by showing that inventor publically disclosed the invention prior to such disclosure (but still within the grace period)
    - Such disclosures need not be in the same format or use the exact same language
- [2154] Provisions Pertaining to prior art under 102(a)(2)
  - Three types of patent documents are available as prior art as of their filing date (referred to collectively as US patent documents):
    - US patents
    - US patent application publications
    - Certain WIPO published applications of a PCT international application
      - Specifically, applications that designate the US, regardless of what language they are published in and or whether they enter the national stage
  - To qualify as prior art, the US patent documents must name another inventor, as well as have an effective filing date before that of the claimed invention
    - ANY difference in inventive entity satisfies the “names another inventor” requirement

- If the issue arises between two copending US patent applications, a provisional rejection can be made so long as the applications have at least one inventor in common or a common assignee
  - If there is no common assignee or inventor, confidentiality must be maintained and no provisional rejection can be made
- Prior art 102(b)(2) exceptions
  - Disclosure info obtained from inventor
  - Invention and prior art subject matter commonly owned or developed under a joint research agreement in place at time of filing of claimed invention is also excepted (under pre-AIA this only excepted prior art under a 103 rejection)
    - A double patenting rejection may still be appropriate
    - Need to supply a clear statement about the existence of such assignment or joint research agreement and, for a research agreement, must amend the application to include the name of the parties under the agreement
    - No further evidence of assignment/agreement is necessary unless specifically requested by examiner
- [2155] 37 CFR 1.130 Affidavits or Declarations [AIA]
  - 1.130(a)
    - Covers disclosures made by inventor and disclosures made by one who obtained info directly from inventor
  - 1.130(b)
    - Covers public disclosures made by inventor or one who obtained info directly from inventor in order to disqualify a secondary disclosure by another
  - Discusses evidence required to support such an affidavit or declaration
    - Primarily, that the disclosure was in fact made by inventor or via information obtained from inventor or, prior to disclosure by another, publically disclosed by inventor or by another who obtained information from inventor
    - Said disclosure need not have been enabling
- [2156] Joint research agreement
- [2158] AIA 35 USC 103 vs Pre-AIA 103
- [2159] determining whether application is subject to pre-AIA or AIA rules
- [2161] Three Requirements of 35 USC 112(a)
  - The three requirements of 112(a) are separate and distinct from each other
  - 1) written description
    - Show that inventor was in possession of the invention at time of filing
  - 2) enablement
    - Give the manner and process of making/using the invention, so that no undue experimentation is necessary
    - “undue experimentation” is measured against factors such as the level of predictability in the art, the average skill of one in the art, and the nature of the invention
  - 3) best mode
    - Give what the inventor considers to be the best means for carrying out invention
- [2163] Written Description Requirement



- Satisfied by a clear showing that applicant invented the subject matter claimed, i.e. had possession of the invention at the time of filing
  - This is demonstrated by showing some form of reduction to practice of the invention, adequate depiction (drawings or structural details or chemical formulas), or distinguishing, identifying characteristics
- Elements of the invention described in the claims must be sufficiently supported by the specification (sufficiently described)
- Claims that add new matter not supported by the specification violate the written description requirement (NOT, in technical terms, a new matter violation) [rejection under 112(a)]
  - New matter violation issues arise when the material is added to the abstract, specification (any part BUT claims), or drawings [objection under other rules]
  - Note the difference between a rejection and objection
- Situations where new matter violations typically arise
  - Amendment of a claim
    - Broadening or narrowing
  - Claiming priority under 35 USC 120 (earlier US application) or 35 USC 119 (foreign application and provisional application)
- [2164] Enablement Requirement
  - One skilled in the relevant art must be enabled to make and use the invention claimed without undue experimentation (not including such experimentation typically associated with the art)
    - As long as the way forward is clear (e.g. clear instructions for implementation given) then the time an experiment would take and the cost of it are irrelevant
  - Only a single method for making and using need be disclosed
  - When determining enablement, factors such as the level of skill in the art, the predictability in the art, and the state of the prior art must be taken into consideration
  - If a claimed invention fails to meet the utility requirement of 101 (nonuseful or inoperative) then it also fails to satisfy the how-to-use aspect of the enablement requirement
    - However, an invention can satisfy utility under 101 and fail to meet the enablement requirement by not providing clear instructions for how to put that effect/utility into practice
  - If the specification contains a feature taught as critical to invention but is not recited in the claims, then a rejection under enablement should be made (a rejection under lack of written description can also be made)
    - Conversely, if the claims contain a critical feature not mentioned in the specification, a rejection under lack of written description should be made
- [2165] Best Mode Requirement
  - Inventor must disclose what they consider to be the best mode of making and using the invention
    - The best mode does NOT need to be specifically pointed out in the specification
  - Under AIA, violation of best mode requirement may NOT be used to hold invalid or cancel a claim in a patent validity or infringement proceeding
  - When claiming priority to older applications, the best mode need not have been contained in the previous disclosure
  - Failure to provide best mode in original filing cannot be fixed by amendment

- [2171] Claim requirements under 35 USC 112(b)
  - Two separate requirements. Claims must:
    - Set forth the subject matter inventor regards as invention
      - Subjective, dependent on what exactly inventor considers the invention
    - Clearly point out and define the bounds of the subject matter to be protected
      - Objective, analysis of definiteness or indefiniteness of a claim
- [2172] Subject matter inventor regards as invention
  - Can only reject under this if there is evidence elsewhere that the invention claimed is actually not that which the inventor considers to be the invention
    - This evidence comes from outside the primary application materials themselves (e.g. in admission or affidavits filed under 1.132)
    - Inconsistent specification and claims is NOT evidence of this, but an issue of 112(a)
  - A claim missing matter disclosed in the specification as essential can be rejected under 112(b), either part (though most likely an indefiniteness issue), instead of a rejection under 112(a)
- [2173] Claims must particularly point out and distinctly claim invention
  - Claim language must be definite
    - A claim is indefinite when the boundaries or scope of the subject matter is not clear
  - During examination, claims are given their broadest reasonable interpretation, giving terms their typical meaning in the art unless the specification gives a special definition
  - If a claim falls under 112(f) (i.e. is a means-plus-function claim) then the claim limitation includes the corresponding structure, material, or acts described in the specification AND their equivalents
  - Includes a detailed discussion of indefiniteness and claim language with numerous examples
    - Product-by-process claims are appropriate, but product AND process claims are not
- [2174] Relationship between 35 USC 112(a) and (b) requirements
- [2181] 35 USC 112(f)
  - Covers means/step-plus-function claims
    - Typically, only covers claims that explicitly use the term “mean” or “step” with functional language (e.g. “means for” or “configured to”) and does NOT explicitly include the structure, material, or acts necessary to perform the function
    - i.e. the claim recites the function without sufficient description of the structure performing that function
      - e.g. “module configured to deliver ink”; the function is ink delivery but the term ‘module’ is generic here
  - such a claim is interpreted to include/cover the corresponding structure described in the specification AND any equivalents
    - so somewhere in the specification there needs to be an adequate disclosure showing what structure the language covers, otherwise a rejection under 112(b) is appropriate
      - this structure must be clearly linked to the function claimed
- [2183-2186] Doctrine of Equivalents and Other 112 issues

## **MPEP 2200 - Citation of Prior Art and Ex Parte Reexamination of Patents**

- reexamination occurs if prior art filed raises a Substantial New Question of patentability (SNQ)
- includes double patenting considerations
- all reexamination and patent files are open to the public
- only patents and printed publications are allowed as evidence submissions in an ex parte reexamination of a patent
  - affidavits or declarations made on record (i.e. admission by patent owner) may be used in conjunction with the appropriate prior art, i.e. may help explain pertinence of prior art, but themselves cannot alone be used to raise an SNQ or support a rejection
- only reviewed wrspt USC 102 and 103 (no rejections under 112, unless regarding newly added amendments/additions, allowed)
- anyone allowed to file (unless prohibited by law), even patent owner
- request directed towards specific claims, but other claims can reexamined at examiner's discretion
- amendments and new claims allowed
- no broadening claims
- patent owner must be served reexamination submission and, vice versa, patent owner must serve any response on third party requester
- normal two month shortened statutory period for reply to office action
- two month extensions of time for patent owner reply automatically granted upon request
  - two month or less request for extension of time can be filed AFTER original expiration of time,
  - more than two months, request must be made before expiration date to reply (and sufficient reason for extension given) and must be approved
- certificate of mailing/transmission and priority mail express procedures may be used to file any response
- ends with issue of reexamination certificate

## **MPEP 2300 - Interference and Derivation Proceedings**

- interference only proper between two applications or an application and a patent, NOT two patents
- interferences no longer an option for AIA applications

## **MPEP 2400 - Biotechnology**

- biotechnology and rules and means for making deposits
- deposit required to satisfy USC 112

## **MPEP 2500 - Maintenance Fees**

- maintenance fees for utility patents due 3.5, 7.5, and 11.5 years after grant
- can be paid, without surcharge, six months in advance (anytime from 3-3.5 years, 7-7.5 years, etc)

- six month grace period afterwards to pay fee with surcharge
- small and micro entity status fee reductions available
- as of 1/16/2018, maintenance fees must be paid separately for each reissue patent based on a single original patent (and original IF there is a reissue patent currently pending)

## **MPEP 2600 – Optional Inter Partes Reexamination**

- inter partes reexamination replaced by inter partes review as of 9/16/2012
- similar to ex parte reexamination in many ways
- final office action is an ACP (action closing prosecution), similar to final rejection or allowance in other applications, but is not considered "final" and thus cannot be appealed
- after ACP, a RAN (right to appeal notice) is sent out
- reexamination ends with the mailing of a NIRC (notice to issue inter partes reexamination certificate)
- SNQ is standard for initiating review (as with ex parte)
  - for inter partes REVIEW, the standard is reasonable likelihood that request will prevail wrspst at least one of the claims challenged
  - a transition period was implemented from 9/16/2011 - 9/15/2012 where IPReX could still be requested, BUT the reasonable likelihood standard replaced the SNQ standard

## **MPEP 2700 - Patent Terms, Adjustments, and Extensions**

- patent term is 20 years from filing date (US filing date, US filing date for priority application, or international application filing date)
- priority to a provisional app. or foreign (not international) app, for example, doesn't count towards the patent term
- patent term adjustments only available for plant and utility patents

## **MPEP 2800 - Supplemental Examination**

- not an examination procedure itself, but an assessment of the need for one
- allows any and all information to be submitted as evidence
- ends with supplemental examination certificate ordering reexamination or not
- moves into an ex parte reexamination procedure if a SNQ is found
- available starting with new AIA procedures (9/16/2012)

## **MPEP 2900 - International Design Applications**

- US became a contracting member of Hague agreement as of 5/13/2015

## **New Trials pdf**

- effective as of September 16, 2012
- first 15 pages of pdf go over trials, many of remaining pages are response to public comments about the change and analysis of the trials and results after the new implementation
- full listing of rules and regs starts near end, page 49, important (includes index)
- includes inter partes review, post grant review, and transitional review for covered business method patents
- inter partes review
  - may be filed 9 months AFTER patent grant or issuance of reissue OR termination of post-grant review
  - same prior art limitations as IPreexamination, but with "reasonable likelihood" the standard for instituting review
  - conducted in front of three members of the Board rather than an examiner
  - single amendment is allowed, further amendments must be approved
  - oral hearing available
  - Board issues final certificate with decision if no appeal is made
- post grant review
  - may be filed no later than 9 months after patent grant or issuance of reissue
  - only third party may institute
  - standard is that it is "more likely than not" that at least one claim is unpatenable or an unsettled novel or legal question is in consideration
  - also conducted by the Board
  - single amendment is allowed, further amendments must be approved
  - essentially any grounds, except best mode requirement, can be used as a basis for PG review
  - Board issues final certificate with decision if no appeal is made
- covered business method patent transitional review
  - for the most part, works as a post-grant review
  - only valid from September 16, 2012 through September 15, 2020
  - only person that can file is one who has been sued for infringement of the patent
  - a covered business method patent claims a method or apparatus for performing data processing or like operations used in the implementation of a financial product or service (does not include patents for technological inventions)

## **Derivation Trial pdf**

- effective 3/16/2013
- first five pages give overview, much of remainder is response to public comments
- important section is last few pages, which lists official rules and regulations and includes table of contents for section
- appeal is to district court or federal circuit

## **Patent Prosecution Highway (PPH) Program pdf**

- when a claim is found allowed in one participating office, applicant can request a fast track examination of corresponding claim(s) in a corresponding application in another participating office
- allows offices to reuse search results from earlier examinations
- OEE (office of earlier examination)
- OLE (office of later examination)
- two forms: Global PPH and IP5 PPH
  - different participating offices, requirements equivalent

## **Representation of Others pdf**

- overview of behavior and rules guiding agents and attorneys in dealing with clients and the Office
- first ten pages are overview, much of remainder is response to public comments, and the rules and regulations begin on page 18 with ToC

## **New Trials (amendments) pdf**

- effective 5/2/2016
- various procedural changes (e.g. increased page limit for owner's amendment request and petitioner's reply brief)
- allows use of court-style (Phillips) claim interpretation standard for patents in a trial proceeding before the board that are set to expire before a final decision can be made

## **Claim Construction pdf**

- effective 11/13/2018
- standard for interpreting all claims in trial proceedings (IPR, PGR, transitional CBM) is now updated
- effective for any petitions for the aforementioned trials filed on or after effective date
- broadest reasonable interpretation is replaced for all patents involved in trials with standard used to interpret claims in federal district court