

Patent Bar Dictionary

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Primarily based on materials from PLI's Patent Office Exam Course.

Terms marked with asterisk are important for patent bar, and associated rules are recommended to be known very well and/or memorized.

Access: confidentiality of applications; who can see before and after it's published and at various stages.

Allowance: patent application succeeds; requires Issue Fee and corrected drawings; may be withdrawn by applicant such as if they want to file a continuing application with narrower/broader claims

Amendment: change made in specification, claims, or drawings of application; "preliminary" if made before official office action is issued; different rules if amended after final rejection, after allowance, or on appeal

America Invents Act: became law on 9/16/11; biggest change is old to new 35 USC 102 (novelty; took effect 3/16/13)

Antecedent basis: required as specified in 112(b); you must refer to a thing with "a" or "an" before you refer to it with "said" or "the"

Anticipation (102) Pre- and Post-AIA: anticipation itself refers to the piece of prior art that is the same as the invention undergoing examination; existence of anticipation precludes issuance of patent; post-AIA simplifies dates to consider when evaluating prior art to just the filing date; also simplifies geographic limitation of evaluating prior art to worldwide

Appeal: process of appealing (by the appellant) second actions or Final Rejections to the PTAB (Patent Trial and Appeal Board); requires filing Notice of Appeal, maybe buying extensions of time, then Appeal Brief within 2 months; a notice of allowance can still be issued from unsuccessful appeal if any claims were allowed (only rejected claims are cancelled)

Application: owned by inventor(s) until the ownership is assigned in whole or part to another person or entity; assignment can take place beforehand (like at universities) in which owners apply as applicant; six types of applications.

(1) Standard: utility, design, or plant

(2) Continuation: same invention claimed in a prior, non-provisional application and filed in co-pendency with parent; typically filed in lieu of appeal to restart prosecution

(3) Continuation-in-Part: same invention claimed in a prior, non-provisional application and filed in co-pendency with parent; but this one adds (substantial, else double patenting rejection) new matter not disclosed in earlier applications

(4) Substitute: a repeat application by the same applicants but not co-pending with parent; does

not obtain benefit of earlier filing date.....

(5) Divisional: later application for distinct and independent invention carved out of a pending application and only containing the same subject matter as previously disclosed.....

(6) Provisional: filed to establish early filing date; does not require claims nor oath; valid for one year and does not get examined

Best mode: section 112, first paragraph, third requirement; requires inventor to set forth best mode known to him at time of filing of carrying out the invention; cannot be added after filing because that is new matter

Certificate of Mailing / Express mail: form provided with other papers filed in the PTO which allows filing date as the postmark; otherwise filing date is when papers are received by PTO; NOT valid for (1) new patent applications, (2) papers filed in interference directed to be filed by hand, (3) agreements settling an interference, (4) any PCT papers; express mail procedures can be used for filing any paper even the ones above

Claims: at least one is required on every patent application; may be directed to an apparatus, a method, or a composition; can be amended or canceled-and-replaced; take form as independent or dependent (which incorporates by reference all elements and claims of the associated indep claim); a claim that depends from more than one claim (proper [A or B]; improper [A and B]) is a multiple dependent claim but you can't daisy chain them ("improper"); to calculate fees, proper multiple dependent claims count as number of claims from which it depends, and improper dependent claim counts as one claim

Example for calculating fee based on number of claims:

- (1) independent claim
- (2) depends from claim 1
- (3) depends from claim 1 or 2
- (4) depends from claim 3
- (5) depends from claim 1 and 2
- (6) depends from claims 1 2 or 3

- (1) 1
 - (2) 0
 - (3) 2
 - (4) 2, counts as multiple dependent also
 - (5) 1, improper b/c "and"
 - (6) 1, improper b/c daisy
- total = 9

claims, con.: "means plus function" 112(f) allows claiming what it does rather than what it is but it has to have the word means and the means has to be supported in the specification; Jepson claim is a claim where the old details is listed in potentially long-ish preamble and separated by the new by a clause such as "the improvement comprising"; Markush group are custom user-defined groups; "consisting" is open-ended meaning at least these; "comprising" is close ended meaning only these

Co-pendency: two applications are co-pending when they were both alive at the patent office for at least one overlapping day

Correction of inventorship: inventorship can be added or removed for a person for pending or even after issued application; may occur because claim was added or removed or because of unintentional error; a person only needs to contribute to one claim to be an inventor; correction done by filing signed Application Data Sheet listing new inventors with oath for new inventors and fee

Correction of patents after issuance: possible triggers are:

- (1) Certificate of Correction: to fix clerical errors or typos by either side.....

(2) Reissue: re-acceptance of an already-accepted patent which was later deemed by owner to be wholly or partly inoperative or invalid; happens if (i) claims are too broad or too narrow, (ii) disclosure contains inaccuracies, (iii) applicant failed to make a proper claim for foreign priority, (iv) applicant failed to make proper reference to co-pending applications for domestic priority

(3) Reexamination: sought if new question of patentability arises from prior patent or publication; allows new but not broader claims

(4) Disclaimer: to disclaim a claim is to give up a claim and it is written in a disclaimer.....

(5) Inventorship: can be corrected if without deceptive intent

Design patents: protects technology of exterior appearance as opposed to covering the way something works (utility patent); can overlap copyright and trademark protection; patent number listed with “D” before number else is utility patent; disclosed by drawings and can have a single claim; can be expedited; can be filed internationally by Hague Agreement (PCT-like but not PCT)

Disclaimer: renunciation of one or more claims in already-issued patent; might happen due to invalid claims without deceptive intent, or failure to make claims suggested for interference, or failure to respond to rejection; a terminal disclaimer is a special type in which only the terminal (later-expiring) patent is agreed to expire at the same type as the earlier patent – this is to prevent “obvious type double patenting” (nice diagrams [here](#)); if patent is not yet issued the claims are said to be canceled not disclaimed

Double patenting: rejection based on common sense rule that inventor is only entitled to one US

patent on their invention; these rejections come in two types: (1) obviousness and (2) same invention aka anticipation; (1) different claim scope of obvious variant, can be overcome by filing terminal disclaimer, but not enforceable after previous patent expires; (2) has same scope of claim and this rejection cannot be overcome

Duty of disclosure / Information Disclosure Statement (IDS): the duty to disclose to the Office all information known to the inventor (and attorney and owner and expert and everyone associated) to be material to patentability; listed in Rule 56 of CFR; includes material which can contribute alone or in part to a good rejection, or material inconsistent with argument by the Patent Office; material can take form of making, using, selling, offering to sell, importing; disclosed preferably in Information Disclosure Statements; may require fee and/or statement of no prior knowledge depending on when IDS is submitted

Ethics: (1) don't lie, cheat, or steal; (2) do your best for client within Patent office rules, and don't take on work you don't feel competent to handle; (3) avoid conflicts of interest; violation of rules may lead to disciplinary action by Patent Office; attorney must fully disclose who all is being paid by client; attorney must keep information confidential; conflicts of interest may involve new client who has some opposition relationship to a former client or taking proprietary interest (profits, rights, ownership shares, or advantages) in litigation or proceeding

Extensions of time*: due dates can be extended by either automatic extensions or extensions for cause; the second is only an option when automatic extension is unavailable; automatic extensions available for 1 2 3 4 5 months but not more; usually necessary to make an almost-abandoned application co-pending with its continuation or division to maintain effective filing date; extensions not valid for anything set

by statute including (i) six month limit to respond to (non-appeal) Official Actions, (ii) IDSs, (iii) date for paying issue fee

Filing date*: two flavors of actual filing date and effective filing date which may or may not be the same; differences come in for proper (co-pending) continuation, continuation-in-part, or divisional application which have effective filing date of parent application; different claims can have different effective filing dates in above scenario; important for assessing if other tech is prior art AND when this tech becomes prior art

Final rejections*: any second or later rejection by Examiner can be made final which limits applicant's response; applicant still required to respond unless abandoning the parent (for good, or as a continuation); responses include after-final response (usually disfavored unless minimal work; can still lead to allowance), request for continued examination (RCE; requires further work from significant claim amendments) appeal (generally valid if claims have been rejected twice), continuing application; there is no right to interview after final (examiner's discretion)

Foreign filing license*: permission from the US for applicant to patent the invention in foreign countries, mandatory for all inventions made in the US; every application includes an implicit request for a foreign filing license; implicit request is usually granted unless application is marked by security screeners; can be acquired by:

- (1) passage of six months after filing of application, including provisional application;
- (2) being granted on filing receipt;
- (3) granting of petition asking for one;
- (4) retroactive petition with facts showing that illegal filing was not intentionally made without foreign filing license

Foreign priority: if applicant has an application in a foreign country first, they can have the benefit of the first filing date if the second-set filings are within a year of the first (no daisy chains for extension); applies to countries that have signed the international treaties; first application should be enabling; second application must make the claim for priority; foreign priority moves back the date for prior art – essentially there's a bit less prior art with an earlier date even though the second filings were done later

The Hague Agreement on industrial designs: agreement to protect design style rights in various countries; a PCT-like equivalent for design filings but better than PCT (which is like a placeholder in line) since it actually becomes a design filing

"In this country": location important in defining prior art; for pre-AIA 102(g) prior art means in this country the USA; post-AIA considers acts and publications worldwide as prior art

Incomplete application: nonprovisional application too information to be given a filing date; complete for filing date means (1) specification containing a description, (2) at least one claim, (3) any required drawings; complete actually means also (4) filing fee, (5) English translation, (6) oath or declaration or substitute statement; can add new claims and drawings after submission of specification but the spec cannot get new matter; technically can only submit spec to get fixed filing date but not advised b/c claims/drawings will inevitably add new matter

Incorporation by reference: an application can incorporate "essential" material by reference to (1) issued US patent, (2) US patent application publication, (3) US patent that itself incorporates by reference the essential material from another patent; "nonessential" subject matter like background material may be incorporated from

publications or foreign patents; this must be specified explicitly like “incorporate by reference”

Interference: proceeding in the Patent Office between two applications or an application and a patent (but never between two patents) to determine which inventive entity is entitled to obtain claims covering an invention both seek to patent; winner is the one who has earliest date among set of: application filing date, foreign priority, dates of reduction to practice if any, dates of conception coupled with diligence; procedure is like a law suit with motions, discovery, briefs, hearing, appeal; discontinued after AIA for applications filed on/after Mar 16 2013 but still relevant to current practices; very complex rules so do not prioritize learning

Interview: personal appearance or telephone conversation of applicant, attorney, or agent with Examiner; still have to respond in writing to Official Actions; recording is responsibility of attorney; may involve demonstrate of non-dangerous models/exhibits; attorney must present proposals and arguments; only granted to those with written power of attorney in Patent Office file; must be held at Patent Office

Inventorship: only human beings can be inventors; ownership of invention / patent application always begins with inventors though rights may be assigned re terms of employment; inventorship determined on a claim by claim basis; even if someone makes a patentable contribution (conception, doesn't have to be reduction to practice) to just one claim they are a joint inventor of the whole patent; inventors need not work together or make equal contributions

Maintenance fees: required to be paid at 3.5, 7.5, and 11.5 years after issue for patents filed on or after December 12, 1980; no payment = patent expiration though this can be revived anytime if failure to pay was unintentional;

payment can be made six months ahead or on the day due; six month grace period but also comes with surcharge; only required for utility patents not design and plant patents

New matter: subject matter not supported by the original disclosure; this can include adding specific percentages or compounds after a broader original disclosure, or even the omission of a step where the disclosure as a whole indicates the step is an essential part of the invention; it is no longer possible to add new matter to an application by an amendment filed with a continuation-in-part application (so I guess you need all the info from starting CIP)

Oath/declaration*: oath is sworn to be true before a notary or its equivalent; declaration is statement with warning that willful false statements are punishable by law and may jeopardize the validity of any patent that may issue; either one must accompany every application w/no difference by Patent Office; contents should say that inventor(s) believe themselves to be the inventor(s), that application has been filed with their approval, that they have reviewed the contents of the application and acknowledged their duty to disclose all information known to be material to patentability; does not have to be in English; can be filed after filing date (with fee); may be filed by other persons of proprietary interest (owners, assignees) but inventors must still be identified on Application Data Sheet; substitute oath is one submitted where the original one is defective (like misspelled names)

Obviousness: rejections based on 35 USC 103; happens when Examiner asserts that a PHOSITA would find it obvious to modify what is taught by one reference (anything specified in 102) in light of what is taught by another reference; no limit to the number of references that can be combined; two basic arguments against this rejection:

(1) a PHOSITA would not make the combination suggested by the Examiner as obvious under a KSR rationale

(2) the resulting combination is not the claimed invention

a proper rejection can be overcome by amending the rejected claim(s) to include limitation, element, or step not taught by the prior art and that would not be obvious but remember it cannot be new matter and must be fully supported by the application as initially filed

Ownership contrasted with inventorship: invention owned by inventors initially even if they have assigned rights to employer by contract; inventorship is legal determination and cannot be changed by agreement

Patent*: the right to prevent others from making, using, selling or offering for sale, or importing, within the U.S., its territories, and possessions what is covered by one or more claims of the patent for a limited period or importing into the U.S. products made abroad using a method covered by the patent; rights are to exclude, not to *do* even by owner (e.g., security risk, limitations by previous patents); rights are not self-executing and are enforced by owner; infringement is not a crime but a tort (like libel or negligence); infringing act must encompass each and every one of the limitations of at least one claim; successful litigation grants litigant an injunction and damages; provisional rights grants owner a reasonable royalty from any infringer if the act was done before patent issuance, and the claims in application are substantially the same as claims granted, and notice was sent to infringer re published app

Patent Cooperation Treaty (PCT)*: a mechanism whereby an applicant can file an “international application” in a standardized format at one office and have that filing acknowledged as regular filing in as many member countries as

applicant elects; this does not replace regular filings but instead extends the time to file to 30 months (placeholder in line); expensive and complex so national filings remain the norm unless last minute decision

Patent Law Treaty Implementation Act (PLTIA): eased rules for reviving applications, paying issue and maintenance fees, responding (lengthened minimum period to 2 months); went into effect Dec 18 2013; also created possibility of “reference filing” allowing filing of a US application by merely referencing another application on file in US or foreign country; also restores priority to an already-filed foreign or provisional application if 14 months has not yet elapsed

Patent Trial and Appeal Board (PTAB): branch of the USPTO that conducts trials including *inter partes*, post-grant, and covered business method patent reviews and derivation proceedings; they also hear appeals from adverse examiner decisions in applications and reexamination proceedings and renders decisions in interferences; members are administrative law judges (ALJs)

Petitions to make special: allows applications to be taken up earlier than first-come-first-serve if applicant files petition and special status is assigned; sometimes need fee depending on the reason and time of filing (before or after August 25 2006); categories include: illness, benefit to environment, energy availability, age over 65, superconductivity, combating terrorism, prospective manufacture, stopping infringement, safer procedures involving DNA, for the asking, HIV/AIDS and cancer technologies, biotech from small entities; successors to know about: Accelerated Examination program, Prioritized Examination (“Track 1”), Patent Prosecution Highway

Plant patents: all plants are patentable except (1) bacteria and (2) those propagated by tubers,

like potatoes and Jerusalem artichokes; must be invented or discovered in a cultivated state (not growing wild) and asexually reproduced (not from seeds) before application is filed; application comprises one copy of specification, two copies of color photos or drawings (unless color is not part of the features), and one good reproducible black and white copy of drawings

Post-grant proceedings: involvement brought in by AIA of the PTO role in the US patent system to not just grant patents but also be the principal reviewer of patent validity post-grant; 3 types:

(1) Post-Grant Review (PGR): review from issue raised under 35 USC 101 102 103 112 which would otherwise invalidate a patent; applicable to AIA-examined patents; available within first nine months post issuance

(2) Inter Partes Review (IPR): review on basis of prior art “patents and printed publications” supporting issues of invalidity under 35 USC 102 and 103; available for any patent issued under old OR new statute; if the patent is eligible for PGR also, then IPR can be requested after the term for PGR (aka not earlier than 9 months after issuance or when a previous PGR has finished)

(3) Covered Business Method Patents (CBM): subset of PGR; available where a lawsuit has been filed due to infringement of the patent in question where the patent claims a computer-implemented method relating to a financial transaction; this will “sunset” aka end in 2020

Prima facie showing of obviousness: Latin for “on its face,” meaning that the Examiner must show all elements from all prior art that would make up the claimed invention; examiner can make this rejection on the basis of three criteria:

(1) there must be some suggestion or motivation or other rationale, either in reference or in knowledge of PHOSITA to modify the reference

or combine reference teachings.....

(2) there must be a reasonable expectation that the combination of modification will be successful.....

(3) the prior references must teach or suggest all the claim limitations (i.e., nothing claimed can be left out).....

this rejection may be rebutted by proving “secondary considerations”; subtleties introduced in Supreme Court decision in KSR

Pro se: Latin for “for oneself,” meaning that a party is appearing before the Patent Office without being represented by an attorney/agent

Protest: filed against issuance of any application by any member of the public based on any section of 102 or any other statutory requirement that is alleged not to be satisfied; must be (1) timely, before publication and final rejection/allowance, and (2) served upon the applicant; no fee; protestor cannot participate in prosecution and can only contribute additional prior art or new issues which couldn’t have been brought up earlier

Provisional application: application having at bare minimum specification satisfying 112(a) and any necessary drawings; allows attainment of effective filing date so utility (not design, not sure about plant?) application can be deferred up to a year; no claims or oath required; not examined; information disclosure statements (IDSs) not permitted; automatically abandoned at one year from filing and cannot be revived

Record: voluntary documents which can be recorded in Patent Office for assignments and other transfers of interest in patents and patent applications such as security interests; documents should be (1) in English, (2) identified with patent number and sometimes also date of execution, name of inventor, and title, (3)

accompanied by correct fee, electronic is free though, (4) legible, (5) original or true copy, (6) accompanied by a cover sheet

Reduction to practice: actual reduction to practice means making the claimed product or using the claimed method; constructive reduction to practice is the filing of a patent application; used to establish date of invention prior to filing date of application which has significance in any interference (to determine who prevails) and in prosecution (to swear behind the date of a reference); established by submitting proof of facts by affidavit and documents; can establish earlier date of invention than effective filing date by:

(1) reduction to practice prior to effective date of reference or another application in an interference; or

(2) conception of invention prior to effective date of the reference, coupled with due diligence from prior to the reference date, or

(3) conception of the invention prior to the effective date of the reference coupled with diligence from prior to the reference date to the filing date of the application that is the constructive reduction to practice

Reissue: a reissue patent is a patent that had been deemed by the owner wholly or partially inoperative or invalid, through error, free of deceptive intention, which completes the process of reissuing; reissue application can be filed correcting the error(s) and examined like a new application; new grounds could be rejected, and just because parent passed doesn't mean the old grounds pass again; reissue application can be abandoned (unlike reexaminations); if reissue application broadens claims, it should be filed within two years of issue date of the original patent

Rejection / objection: rejection is the refusal to grant claims because the subject matter as claimed is considered unpatentable; objection made if form (not substance) of claim, specification, or drawing is improper; each and every one of these must be addressed else response to Patent Office is incomplete; only exception is drawings that do not conform to the rules governing drawings; to have rejection tested (fought, I guess), examiner must be asked to reconsider decision, then an appeal must be filed to Patent Trial and Appeal Board (note that text says Board of Patent Appeals and Interferences but apparently that was replaced by PTAB in September 2012); to have objection tested, examiner must first be asked for reconsideration, then a petition filed to the commissioner; note that restriction requirement (two inventions) cannot be appealed but is directly petitioned to Commissioner; most rejections based on 102 (anticipation), 103 (obviousness), 112(a) (written description, enablement, best mode), 112(b) (particularly pointing out and distinctly claiming), and 101 (patentable subject matter, utility)

Reply brief: comes after Notice of Appeal, Appeal Brief, examiner answer; the reply brief is an optional response to the examiner answer

Representation: inventor(s) can represent himself *pro se* before the Patent Office, or one inventor can represent the joint inventors, or they can be represented by a registered patent agent or attorney (who becomes the practitioner); individuals (not firms) can make that formal appointment executing a Power of Attorney; one can withdraw from representation by petition to the Commissioner and not normally granted unless at least one month to respond to an outstanding action; all papers filed must be personally signed by practitioner except those required to be signed by applicant; signature represents:

(1) the paper is not being presented for any improper purpose.....

(2) the claims and contentions are warranted

(3) the allegations and contentions have evidentiary support; and

(4) the denials have evidentiary support.....

Request for continued examination: procedural mechanism for an applicant to request further consideration of the application after the “close of prosecution,” which may be a final rejection, an *ex parte Quayle* action, or notice of allowance; this procedure can be used to submit further arguments, request for reconsideration, affidavit submission, anything that can be submitted during normal prosecution; this does not affect filing date, but prosecution just picks up where it left off

Restriction: two types; restriction of invention is when 2 or more independent or distinct inventions are claimed in the same application; when the examiner issues restriction requirement, applicant must elect one invention for prosecution; nonelected invention may be pursued in divisional application which cannot be rejected on the basis of double patenting over the parent application; restriction of species is where the application has a generic claim and other claims to each of more than one species; the examiner will require applicant to elect one species for search; but this means the claims are limited to the elected species so other species should be pursued in divisional application

Revival: bringing back to life an application that becomes abandoned because of failure to pay the issue fee or respond to a Patent Office deadline; also applies to patent which has lapsed from not paying maintenance fee; revival only is granted from unintentional means; no time limit; this is not a way to extend one’s limit because

you have to file a terminal disclaimer for the same amount of time the application was abandoned; decisions on revival are petitionable not appealable

Secondary considerations: objective indications that the invention is not obvious, indications that the real world puts a high value on the invention including unexpected results, commercial success, failure of others, copying by others, licensing, and skepticism of experts; proof of secondary considerations can be submitted to overcome a *prima facie* rejection under 103

Serial number / filing receipt: application number which consists of series code and serial number that identifies it until issuance at which time it is given a separate patent number; an initial filing receipt is given with bare minimum a written specification but more often also with claims and drawings; the final (aka latest new matter) filing receipt is issued when Office also receives fee and oath or declaration; filing receipt may or may not grant a Foreign Filing License

Service / served: a legal term of art that refers to the legally required method of delivery of a document to an opponent; in lawsuits this might mean physically handing over papers by someone not involved in the legal matter; in Patent Office the usually means just mailing the papers sometimes with return receipt requested

Small (and micro) entity / large entity: small guys get half off; micro entities can ¾ off; small:

(1) no single inventor(s) have assigned, granted, conveyed, licensed any rights to someone who is not a small entity (note that can still be considered small entity if licensed to the federal government or one of its agencies), or

(2) a nonprofit organization recognized by the IRS or an accredited university, or

(3) a small business concern that employs, together with its affiliates, no more than 500 people

to claim small entity status, a simple statement of the above must be filed at PTO else pay small entity filing fee; default status is large entity but refunds can be obtained up to 3 months after full fee is paid by filing a proper statement; micro entity is a subset of small entity which applies to independent inventors (who has not filed more than 4 applications and whose household income is less than 3x the median national household income) and university people (those with income predominantly from an institution of higher learning and who do not have a duty to assign or license the application to the university)

Standing: means that the party has suffered some injury by the action they are suing over or objecting to; one must have some standing to sue or to raise an objection

Statutory invention registration (SIR): strange hybrid between patent and publication; counts as prior art but does not confer any rights to exclude; can be used in interference to defeat an attempt by another to obtain a patent; discontinued post-AIA as of March 16 2013 but still exists as prior art

Substitute / continuing: substitute applications are those that have the same disclosure as an earlier application and are NOT co-pending with an earlier application whether intentional or not; continuing applications, including continuations, continuations-in-part, and divisional applications, are co-pending with parent; remember if abandonment was intentional the parent cannot be revived but a substitute application can be filed

Swearing back: means to establish an earlier date of invention; pre-AIA 102(a) and 102(e)

Collection of maybe useful things to know

prevent patentability if the date of invention comes on or after filing date; this is assumed by default so applicant has to “swear back”; this allows prior art patent to be removed as prior art if there is (conception plus diligence) or (reduction to practice) prior to the date of reference; swearing back also referred to as an affidavit or declaration under 37 CFR 1.131

Withdrawal*: five potential reasons

(1) Withdrawal of claims to nonelected species or invention: in response to restriction requirement; applicant withdraws the nonelected claims from consideration (can also cancel but then can't reinstitute as in divisional application); withdrawal may wholly or partially end if restriction requirement is reversed

(2) Withdrawal of a final rejection: finality of rejection may be improper because new ground of rejection was not necessitated by an action of the applicant; then applicant can petition examiner to have the final rejection withdrawn

(3) Withdrawal of holding of abandonment: an abandoned application due to mistake by applicant can be revived; an abandoned application due to mistake by Patent Office can be petitioned to withdraw the holding of ab.

(4) Withdrawal of Power of Attorney (representation): if the client has not revoked the Power of Attorney and the attorney wants to cease representing the client, he has to petition the Commissioner to withdraw; only granted when client has sufficient time to find a new attorney and/or respond on their own

(5) Withdrawal from issue: after Notice of Allowance, patent can be issued, abandoned or withdrawn by petition from issue

- **Invention** = conception + reduction to practice
- **Petition to Revive** an unintentionally abandoned application must be accompanied by a response to any action outstanding at the time of abandonment or a continuation
- An **intentionally abandoned** application cannot be revived
- **IDS** filed for provisional application: not allowed
- No **extensions** are granted for IDSs
- Each practitioner possessing unprivileged knowledge of a **violation** of a disciplinary rule must report that violation to the Patent Office
- Registered agents and attorneys may **advertise** but the advertising must include the name of the agent or attorney
- A separate **bank account** for funds belonging in whole or part to a client must be maintained; cannot commingle client funds with agent/attorney's personal funds
- Any second or Final Rejection can be appealed, but no **first action** can be appealed, except in a continuation application. In such a circumstance, if the rejection is the same as made in the parent, the first action can be made final and can then be repealed.
- An application can be **reissued** to properly claim foreign priority.
- A **translation** is not required to claim priority. It is required to remove an intervening reference as prior art if a rejection is made.
- Related to **interference**, whenever a claim from another patent or application is copied as a claim in your application, the patent or application from which that claim was copied must be identified by patent number or serial number and filing date.
- The substance of every interview, including telephone interviews, is required to be **recorded** by the Examiner and the attorney.
- While invention is conception and reduction to practice, only those who contribute towards **conception** is an inventor. No cigar for the person who demonstrated that invention would work aka carried out tests that reduced it to practice.
- Maintenance fee payments due at **3.5, 7.5, 11.5** years from issue date. If late, can pay in the following six month grace period with surcharge. If beyond the grace period AND unintentional, the maintenance fee can be paid and patent is considered not having expired. If the lapse was intentional, bye-bye patent.
- Maintenance fees for a reissue or a reexamination are based on the schedule for the **original** utility application.
- Whether a patent is expired or not has no effect on when and whether it is **prior art**.

- To swear back of reference (aka: get a patent even though the invention became public before the inventor filed an original patent application), an applicant need only show diligence from prior to the **reference date to the reduction to practice**, not from conception to reduction. Conception is important to define inventorship, but reduction to practice is important to define dates.
- If status (small / large entity) changes during prosecution or during the patent term, **no repayment** is required; rather, future payments are calculated under the new status.
- A provisional application must satisfy **112 requirements** of written description, enablement, and best mode for a nonprovisional to rely on it for an earlier filing date.
 - Don't confuse this with prior art **grace period**. To remove a reference as prior art under AIA 102(b), it does not have to fulfill these requirements.
- In the pre-AIA first to invent system, an application's **prior art date** can be different from its filing date. The prior art date would be when it's available to the public, e.g., date of publication. In the AIA first to file system, does this hold true? (?)

Ethics primer from PLI mini exam

As a practitioner, you must...

- Communicate adequately to the client. (**37 CFR 11.104**)
 - Explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding representation.
 - Example: Adequately inform the client about additional fees.
- Surrender papers and property to which the client is entitled upon termination of representation.
- NOT engage in conduct involving dishonesty, fraud, deceit or misrepresentation. (**37 CFR 11.804**)
 - Misrepresentation: failing to explain the exact nature of what had occurred
- Provide competent representation to a client. (**37 CFR 11.101**)
 - Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation.
 - However, this is a high bar. To demonstrate lack of competence, one would have to demonstrate *incompetence*, not merely that a mistake was made.
- NOT have your client sign the oath or declaration before the application is even complete. After all, the oath/decl requires that the signer review and understand the contents of the application including the claims.
- Act with reasonable diligence and promptness. (**37 CFR 11.103**)
- Report to the Office of Enrollment and Discipline for misdemeanors or convictions (all “public reprimands”). (**37 CFR 11.24(a)**)
 - Even if they’re not patent related like DUI, controlled substances, firearm without permit

A law firm CAN create a screen to segregate practitioners which would otherwise indicate conflict of interest.

- Despite this, if there is confidential information given which CANNOT be solved with an ethical screen or with a client waiver (i.e., what it would take is a selective memory wipe to have truly no conflict), then no representation allowed.

Go to **37 CFR 11.116** which lists reasons a practitioner *must* not represent a client (**a**) and reasons a practitioner *may* not represent a client (**b**). Interesting that stuff like criminal and fraudulent behavior are listed under subsection (b). Subsection (**d**) is also useful on some things a practitioner must do upon termination of representation.

Note: the Office no longer requires there to be at least 30 days between approval of the request to withdraw as a practitioner of record in a patent application and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

It is not a rule for the practitioner to quote all costs to the client, though it’s probably a good idea.

Preissuance submission vs. Protest

Protests are a bit harder in terms of who can submit and what can be the basis of submission. However, the timeline to submit is narrower.

COMPARISON: PREISSUANCE SUBMISSION & PROTESTS		
	PREISSUANCE SUBMISSION 37 C.F.R. § 1.290	PROTEST 37 C.F.R. § 1.291
INFORMATION AVAILABLE FOR SUBMISSION	Printed publications	Publications, information, arguments, and prior use
DESCRIPTION OF INFORMATION NEEDED	Description of relevance	Explanation of relevance
WHO CAN FILE	Any member of the public but cannot be the applicant or any individual who has a duty to disclose	Any member of the public
TIMING OF FILING	Prior to allowance and prior to the later of: 6 month post-publication OR first rejection	Prior to allowance and prior to publication; OR prior to allowance and post-publication with consent
APPLICABLE TO REISSUE APPLICATION?	N/A	Yes; up to allowance

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<https://www.finnegan.com/en/insights/blogs/prosecution-first/comparison-preissuance-submission-and-protests.html>

35 USC 102

<https://www.slideshare.net/SueSassmann/gone-withthewind>

<https://adamslaw.biz/2017/04/post-america-invents-act-inside-the-on-sale-bar-of-35-usc-%C2%A7102/>

PRIOR ART
— What Happened to §102 and §103 —
Anticipation under 35 U.S.C. §102

<i>Before</i>	<i>After</i>
<ul style="list-style-type: none"> a) Publicly known or used in US or published anywhere before date of invention. b) Published anywhere or on sale in US more than 1 year before filing. c) Abandonment. d) Foreign filing more than one year prior. e) Secret prior art. f) Not the inventor. g) Made by another who didn't abandon, suppress or conceal (interferences). 	<ul style="list-style-type: none"> (a) (1) Patented, published, in public use, on sale or "otherwise available to the public" before effective filing date or (2) an earlier filed issued patent or published application to another inventor. (b) – (g) eliminated. <p>Subject to one year grace period exceptions.</p>

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AIA Statutory Framework

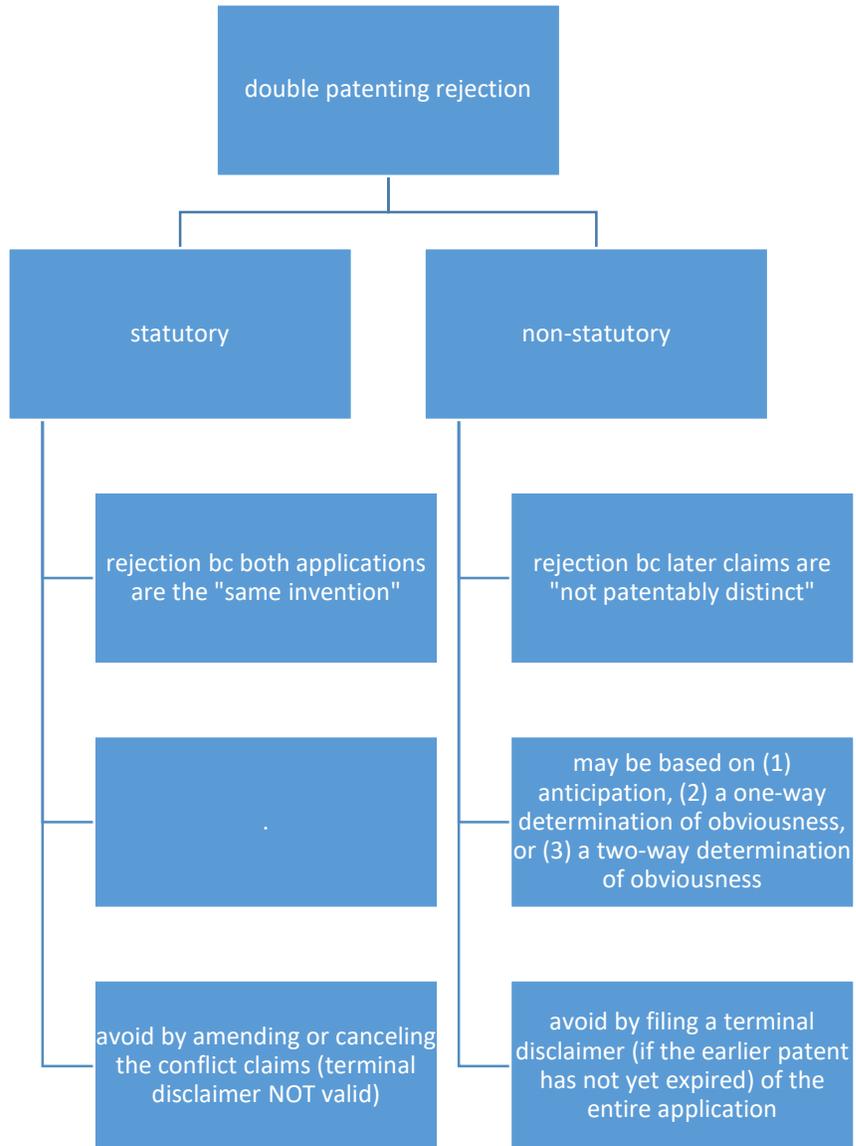
Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures

8

Types of double patenting rejections

Each of these can be provisional or nonprovisional rejections also. MPEP 804 has some flowcharts to determine if an application should get a provisional rejection.

Rejections can be made between two applications, or between an application and a patent.



Design vs. utility patents

Design patent	Utility patent
15 year term	20 year term from filing date
No maintenance fees	Maintenance fees at 3.5, 7.5, 11.5 years
Single formal claim	As many claims as necessary
Hague Agreement (no PCT)	Can be filed under PCT
Six months for foreign priority	One year for foreign priority
No provisional	Provisional allowed

Ownership vs. inventorship

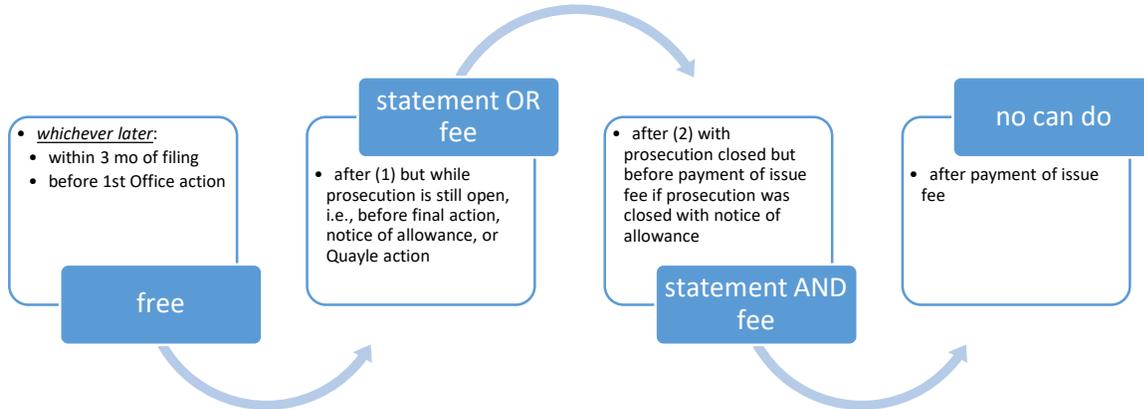
Ownership	Inventorship
Patent: owner can buy, sell, transfer like any other piece of property	Patent: inventors are the true applicants though patent may be applied in their name
Validity: no contribution	Validity: wrong inventorship makes patent invalid unless correctable and corrected diligently
Prosecution: can be controlled by owner without inventor	Prosecution: inventor can be excluded from participation if assigned and owner requests
Form: any legal entity such as partnership or corporation	Form: human being(s)

Reissue vs. Reexamination

Reissue	Reexamination
Limited to patent owner	Anyone can file
Any prior art can be considered	Limited to patents and printed publications
Broadening claims allowed in first two years	No broadening claims
Automatic extensions	No automatic extensions
Original patent must be surrendered	Original patent not surrendered
Can be abandoned	Certificate will always issue

When and how much to file Information Disclosure Statements

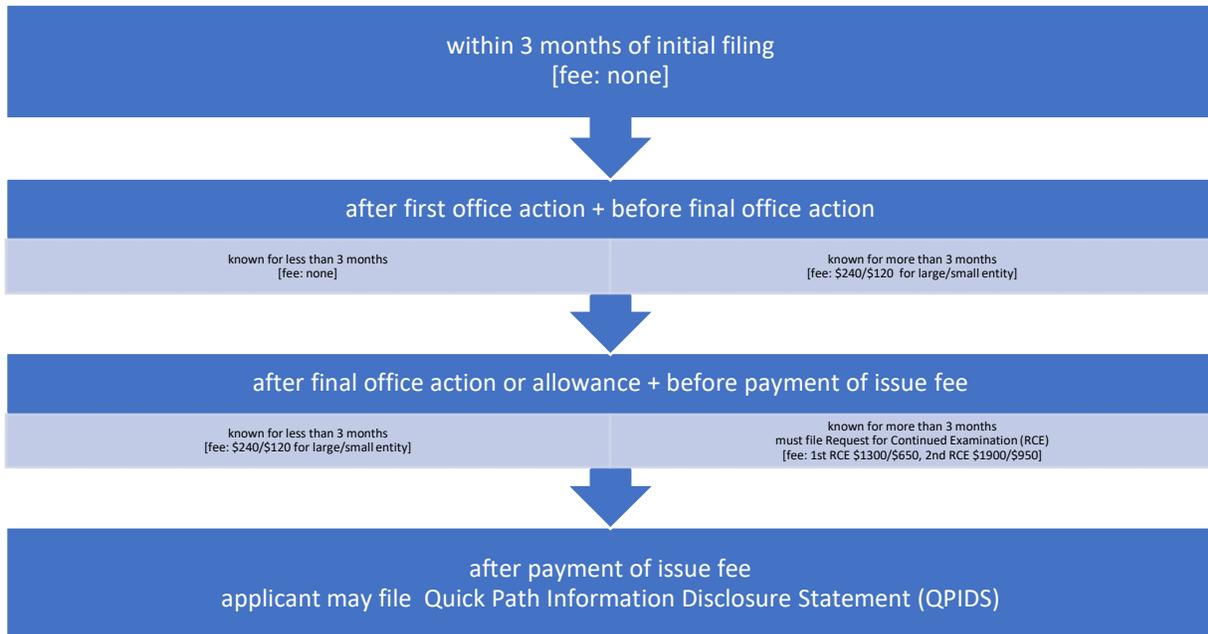
MPEP 609.01 for table, 609.04(b) for more details



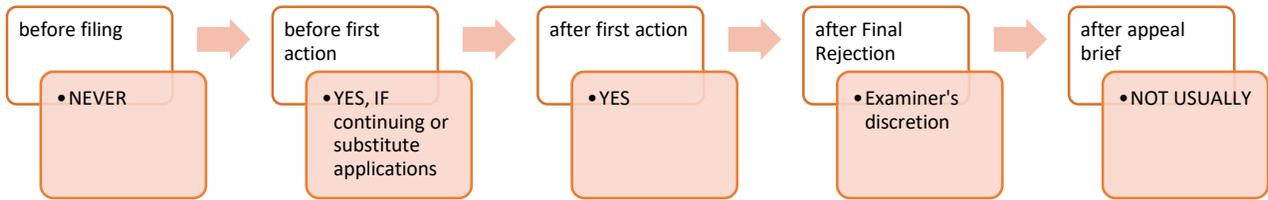
Statement 37 CFR 1.97(e) – The info was NOT known for more than 3 months.

Fee 37 CFR 1.17(p) – Lists amounts based on micro / small / normal entity.

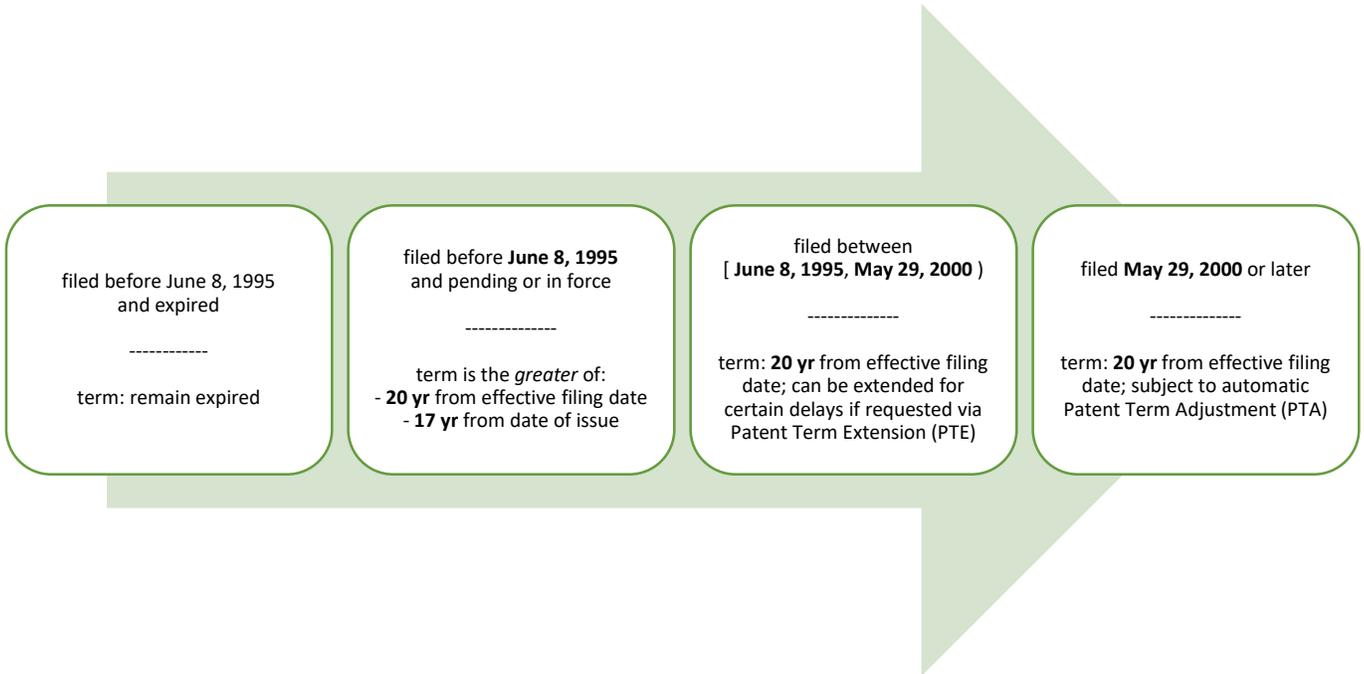
<http://www.patenttrademarkblog.com/ids-due-fees/>



When interviews are granted with an Examiner



Patent terms

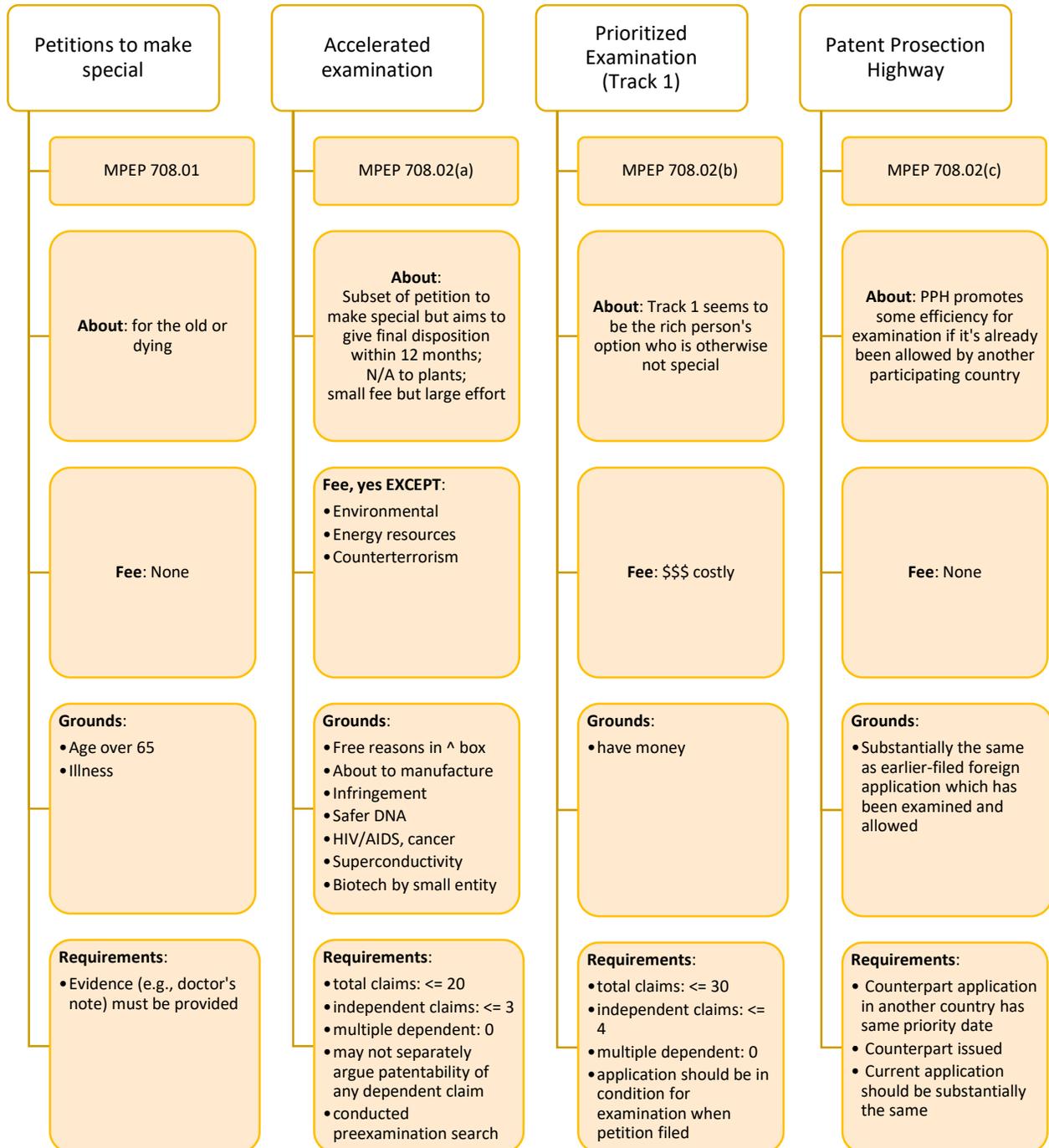


Methods to expedite patent prosecution

MPEP 708 – “Order of Examination”

<https://norrismclaughlin.com/tap/2018/01/25/need-patent-quickly-uspto-programs-expediting-prosecution/>

<https://www.henrypatentfirm.com/blog/speed-up-patent-prosecution>



Who is a small or micro entity? (MPEP 509.02)

A small entity is one of the gray list items. A micro entity is a subset of small entity and is one of the blue list items.



Independent inventor

- Not under obligation to assign, grant, convey, or license rights to a not-small entity



Nonprofit

- Not under obligation to assign, grant, convey, or license rights to a not-small entity
- Includes nonprofit or public accredited university in U.S. or abroad



Small business

- Not under obligation to assign, grant, convey, or license rights to a not-small entity
- Fewer than 500 total employees including part-time and temporary workers



"Poor and non-accomplished"

- Each applicant / inventor / joint inventor has **no more than 4** previously filed nonprovisional applications (application(s) from former employment waived), **AND**
- Each applicant / inventor / joint inventor has a gross income less than **3x median household income** for preceding calendar year



Professor-types

- Majority of applicant's income is from an institution of higher education, **OR**
- Applicant has assigned rights to such an institution of higher education
- Institution of higher education = public or nonprofit accredited institution that admits post-secondary students for programs of not less than two years.