

# **Guidebook to Patent Law**

**Volume I**

**Patent Education Series™**

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Guidebook to Patent Law  
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## **A few words about this book**

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The 4-Volume “Guidebook to Patent Law” set is a study aid for those preparing to take the patent bar examination. This exam covers topics found in the Manual of Patent Examination Procedure (MPEP) which is written by the Patent and Trademark Office. The 4-Volume “Guidebook to Patent Law” is a consolidated version of the MPEP. In addition to the “Guidebook to Patent Law”, we offer our line of educational materials, the Patent Education Series™, which is geared toward those wishing to enter into the field of patent law. Please feel free to contact us for more information.

This copy of the “Guidebook to Patent Law” is based on the MPEP 8<sup>th</sup> edition, Revision 4. Revision 3 became available from the U. S. Patent and Trademark Office as of August 2005. Revision 3 consists of changes from throughout the MPEP. Revision 4 became available from the Patent Office as of October 2005. Revision 4 only consists of changes from Chapter 2300.

### **Contact info for the Patent Education Series™:**

<b>Url:</b>	<b><a href="http://www.patenteducationseries.com">www.patenteducationseries.com</a></b>
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Hello,

Thank-you for purchasing the “Guidebook to Patent Law” 4-Volume set. I hope you will find it a useful tool.

I am committed to the success of individuals interested in patent law through the affordability and quality of my materials. Therefore, I am interested in any feedback or improvements you may have for the Patent Education Series™. Any suggestions for new study aids that would make your preparation for the patent bar exam easier and more productive are appreciated. And welcome to this exciting career field!

Sincerely,

Lisa A. Parmley - President

August 2007

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## Chapter 100: Secrecy, Access, National Security and Foreign Filing

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**Summary:** This chapter covers the confidentiality of patent applications and patent related documents. The focus is on who may or may not access particular application types.

Any patent application that contains a sensitive issue will be placed under a secrecy order by the PTO. Absolutely no member of the public may view these patents even after they have issued.

Foreign filing licenses must be issued if an applicant wants to apply for a patent on the same subject matter in a foreign country immediately after filing for a U.S. patent.

- \* Chapter 100 is a minor chapter in regards to the patent bar exam. At most, you may see a question or two touching the rules related to accessing patent applications. You should understand 37 C.F.R. 1.11 and 35 U.S.C. 122, which regard the files that are open to the public.

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## **Confidentiality of Patent Applications**

### **101 General**

*Patent applications must be kept confidential. Approved patents, however, are freely open to the public (unless they are under a secrecy order).*

- in order to maintain the confidential status of patent applications:
  - no information on the filing, status or subject matter of any patent application will be disclosed to the public
  - no access or copies of any application (or any patent application papers) will be given to the public
  
- confidentiality only applies to patent applications; actual existing patents are open to the public (unless they are under secrecy order)
  
- exceptions to the confidential status of applications include:
  - when a member of the public gains written authority from the applicant
  - when the application is abandoned and it has also been published
    - however, the application cannot be in a file jacket of a pending application (no one may be trying to patent that particular invention)
  - when it is deemed necessary by the Commissioner
  - when the material of the application is incorporated by reference in a U.S. patent

### **102 Information as to status of an application**

*There are 3 major types of patent status. These include pending applications, abandoned applications, and issued patents. This statute discusses the rules regarding the confidentiality of an application's status.*

#### **37 C.F.R. 1.14 Patent applications preserved in confidence**

**(a) Confidentiality of patent application information.** Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

**(1) Records associated with patent applications (see paragraph (g) for international applications) may be available in the following situations:**

**(i) Patented applications and statutory invention registrations.** The file of an application that has issued as a patent or published as a statutory invention registration is available to the public as set forth in §1.11(a). A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application may be provided upon request and payment of the appropriate fee set forth in § 1.19(b).

**(ii) Published abandoned applications.** The file of an abandoned application that has been published as a patent application publication is available to the public as set forth in § 1.11(a). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b).

**(iii) Published pending applications.** A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending application that has been published as a patent application publication may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b). If a redacted copy of the application was used for the patent application publication, the copy of the specification,

drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (h) of this section.

(iv) Unpublished abandoned applications (including provisional applications) that are identified or relied upon. The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication of an international application that was published in accordance with PCT Article 21(2). An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)).

(v) Unpublished pending applications (including provisional applications) whose benefit is claimed. A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, or a specific document in the file of the pending application may also be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (h) of this section.

(vi) Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified. A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (h) of this section.

(vii) When a petition for access or a power to inspect is required. Applications that were not published or patented, that are not the subject of a benefit claim under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2), are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (h)) or a power to inspect (see paragraph (c)) is necessary to obtain the application, or a copy of the application.

(2) Information concerning a patent application may be communicated to the public if the patent application is identified in paragraphs (a)(1)(i) through (a)(1)(vi) of this section. The information that may be communicated to the public (i.e., status information) includes:

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

(ii) Whether the application has been published under 35 U.S.C. 122(b);

(iii) The application “numerical identifier” which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage; and

(iv) Whether another application claims the benefit of the application (i.e., whether there are any applications that claim the benefit of the filing date under 35 U.S.C. 119(e), 120, 121 or 365 of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (e.g., continuation), whether the application is pending, abandoned or patented, and whether the application has been published under 35 U.S.C. 122(b).

(b) Electronic access to an application. Where a copy of the application papers or access to the application may be made available pursuant to paragraphs (a)(1)(i) through (a)(1)(vi) of this section, the Office may at its discretion provide access to only an electronic copy of the specification, drawings, and file contents of the application.

(c) Power to inspect a pending or abandoned application. Access to an application may be provided to any person if the application file is available, and the application contains written authority (e.g., a power to inspect) granting access to such person. The written authority must be signed by:

- (1) An applicant;
- (2) An attorney or agent of record;
- (3) An authorized official of an assignee of record (made of record pursuant to § 3.71 of this chapter); or
- (4) A registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.495, if an executed oath or declaration pursuant to § 1.63 or § 1.497 has not been filed.

(d) Applications reported to Department of Energy. Applications for patents which appear to disclose, purport to disclose or do disclose inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to the applications. Such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or is an invention or discovery, or that such application in fact discloses subject matter in categories specified by 42 U.S.C. 2181(c) and (d).

(e) Decisions by the Director or the Board of Patent Appeals and Interferences. Any decision by the Director or the Board of Patent Appeals and Interferences which would not otherwise be open to public inspection may be published or made available for public inspection if:

- (1) The Director believes the decision involves an interpretation of patent laws or regulations that would be of precedential value; and
- (2) The applicant, or a party involved in an interference for which a decision was rendered, is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection.

(f) Publication pursuant to § 1.47. Information as to the filing of an application will be published in the Official Gazette in accordance with § 1.47(c).

(g) International applications.

- (1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the

publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see § 1.19(b)), if:

- (i) With respect to the Home Copy (the copy of the international application kept by the Office in its capacity as the Receiving Office, see PCT Article 12(1)), the international application was filed with the U.S. Receiving Office;
- (ii) With respect to the Search Copy (the copy of an international application kept by the Office in its capacity as the International Searching Authority, see PCT Article 12(1)), the U.S. acted as the International Searching Authority, except for the written opinion of the International Searching Authority which shall not be available until the expiration of thirty months from the priority date; or
- (iii) With respect to the Examination Copy (the copy of an international application kept by the Office in its capacity as the International Preliminary Examining Authority), the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of a publication of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(4)).

(3) Access to international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be permitted in accordance with PCT Articles 30 and 38 and PCT Rules 44<sup>ter</sup>.1, 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (a) of this section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (a)(1)(i) through (a)(1)(vi) and (g)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

(h) Access or copies in other circumstances. The Office, either sua sponte or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

- (1) The fee set forth in § 1.17(h); and
- (2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

-no information will be disclosed related to the status of an application, including the following:

- whether the application is pending, abandoned or patented
- the application number and filing date
- whether one or more applicants claim the benefit of the filing date
- whether the application claims the benefit of an application

-a person requesting status information may be provided with the filing date of an application if they know at least the last 6 digits of the numerical identifier of the application

**-How to determine the status of an application:**

- in order to learn any information regarding the status of an application, an individual must obtain access from the applicant:
  - they must send a request to the applicant identifying the application's serial number and filing date
  - in addition, the patent must be in the national phase
- the status of a parent application is only disclosed when the status of any pending continuation, CIP or divisional application derived from it is also disclosed
- if a redacted copy of the application was used for patent application publications, the copy of the specification, drawings and papers may be limited to a redacted copy
- the status information of an application is available if:
  - the application is referred to by its numerical identifier in a published patent document (U.S. patent, U.S. patent application publication, international application publication) or in a U.S. application open to public inspection

**-Access to inventors:**

- a coinventor is always entitled access to his or her application regardless of whether or not he or she signed the declaration
- if an oath or declaration has not yet been filed, inventorship is that which is listed in the application papers

***At a glance-*****Common documents accessible to the public.**

<b>Accessible to the public</b>	<b>Not accessible to the public</b>
• Published SIR's	• Pending, non-published patent applications
• Issued patents not under secrecy order	• Non-published international applications
• Reissue applications	• Non-published abandoned patents
• Requests for reexamination (and all related papers)	• Provisional applications
• Files of an interference proceeding once the proceeding has ended	

### 103 Right of public to inspect patent files and some application files

*This statute discusses the rights the public has to inspect files (such as patents and certain types of applications).*

#### *§ 1.11 Files open to the public.*

(a) The specification, drawings, and all papers relating to the file of an abandoned published application, except if a redacted copy of the application was used for the patent application publication, a patent, or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). See § 2.27 for trademark files.

(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under § 1.53(d) of reissue applications, will be announced in the Official Gazette. The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

(c) All requests for reexamination for which the fee under § 1.20(c) has been paid, will be announced in the Official Gazette. Any reexaminations at the initiative of the Director pursuant to § 1.520 will also be announced in the Official Gazette. The announcement shall include at least the date of the request, if any, the reexamination request control number or the Director initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

(d) All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

(e) The file of any interference involving a patent, a statutory invention registration, a reissue application, or an application on which a patent has been issued or which has been published as a statutory invention registration, is open to inspection by the public, and copies may be obtained upon paying the fee therefor, if:

- (1) The interference has terminated or
- (2) An award of priority or judgment has been entered as to all parties and all counts.

#### •Summary of 37 CFR 1.11:

-the following files are open to the public:

- issued patents or published statutory invention registrations
- all reissue applications
- all requests for reexamination (which will be announced in the Official Gazette provided the fee has been paid)
  - these are now available to the public in electronic form only
- papers relating to reexamination proceedings
- files of any interference involving a patent, a statutory invention registration, a reissue application or an issued patent may be open to the public, provided:
  - the interference has terminated
  - an award of priority or judgment has been entered

**•Access to particular types of patents****-Pending or non-published abandoned patents:**

-pending or non-published abandoned patents may not be openly viewed by any member of the Public (these patents maintain confidential status)

-the following individuals may view pending or abandoned patents:

- any of the inventors except in cases where the assignee has requested otherwise
- any inventor who was named even if they did not sign the paperwork
- any assignee (of entire or partial interest)
- a licensee of entire interest (not of partial interest)
- an attorney or agent of record, or anyone given written authorization from an inventor

-if a U.S. patent application, publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request with a fee

**-Abandoned applications:**

-access to abandoned applications may be provided if:

- written request is sent in and approved
- the abandoned application is not in the file wrapper of a pending CPA and it is referred to:
  - in a U.S. patent application open to public inspection
  - in another U.S. application open to public inspection
  - in a published international application designating the U.S.

-obtaining access to an abandoned application is possible if one of the following has occurred:

- it is published, or
- it is referred to in a U.S. patent, or
- it is referred to in a U.S. application open to the public, or
- it claims the benefit of a U.S. application filing date that is open to the public

**-Provisional applications:**

-provisional applications may only be viewed by parties who have gained written authority from the applicant

**-Reissue applications:**

- reissue applications filed after March 1, 1977 are open to the public
- they are announced in the Official Gazette for the public's convenience

**-International applications:**

-access to international applications is denied to all members of the public until the application becomes internationally published

-however, the applicant may authorize access to a specific individual

-if an international application designates the U.S. and has been published in accordance with PCT Article 21(2) and incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request.

-the written request must include:

-a showing that the publication of the application is in accordance with PCT Article 21(2), and

-that the U.S. was designated, and

-payment of a fee

**-Incorporation by reference:**

-access to an application that is incorporated by reference in a U.S. patent may be granted to anyone who requests it, however:

-they will only receive a copy of the referenced part of the original application, not

the entire application (unless the inventor gives them authority to view the entire application)

-if the inventor fails to provide material within the period provided, the entire application will be provided to the requestee

**•Petition for access:**

-any pending or abandoned patent application preserved in confidence may be requested by an individual if:

-they send in written authority to the applicant asking to view the application

-or-

-by filing a petition (with the fee) which should include:

-reasons why access is desired

-reasons why he or she believes they are entitled access (“special circumstances” must be present)

-a notice that a copy of the petition was given to the applicant/owner either directly or indirectly through the patent office (this is termed ‘servicing the applicant’)

-special circumstances found acceptable for seeking access to pending applications include:

-if the owner is using the patent application to interfere with a competitor’s business

-when a patent relies upon the application for priority

-if the application is referred to in an issued patent

- if access is granted, the length of time for viewing an application is:
  - good forever; as long as the access was granted by the agent, attorney or inventor
  - limited; if given by the Patent Office (due to changing circumstances)

•**Servicing the applicant:**

- the purpose of servicing the applicant is to give the applicant/owner a chance to decide if the petitioner should only be granted access to a portion of the file instead of gaining access to the entire file

- servicing is not required when:

- the application is incorporated in whole or part into an issued U.S. patent
- the application is preserved in secrecy

•**35 U.S.C. 122:**

*The previous statute (37 C.F.R. 1.14) covered the confidentiality of patent applications in regards to instances when application status may be revealed to private parties within the public. 35 U.S.C. 122 states the specific times when patent related documents will be published by the PTO.*

**35 U.S.C. 122 Confidential status of applications; publication of patent applications.**

(a) **CONFIDENTIALITY.**— Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

(b) **PUBLICATION.**—

(1) **IN GENERAL.**—

(A) Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

(B) No information concerning published patent applications shall be made available to the public except as the Director determines.

(C) Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

(2) **EXCEPTIONS.**—

(A) An application shall not be published if that application is—

- (i) no longer pending;
- (ii) subject to a secrecy order under section 181 of this title;
- (iii) a provisional application filed under section 111(b) of this title; or
- (iv) an application for a design patent filed under chapter 16 of this title.

(B)

(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application

filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

(c) **PROTEST AND PRE-ISSUANCE OPPOSITION.**— The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

(d) **NATIONAL SECURITY.**— No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17 of this title.

-neither the publication of a foreign counterpart application or the disclosure of a U.S. patent application waives confidence under 35 U.S.C. 122

## **Issues Regarding National Security**

### **120 Secrecy orders**

*It is possible for patent applications to contain issues sensitive to national security.*

*If an application is found to contain issues that could threaten national security, the PTO will place a secrecy order on it. Therefore, a security review will be completed for all applications before a Notice of Allowance is mailed to the applicant.*

-secrecy order terms:

- will remain in effect for 1 year from the date of its issuance
- the term may be renewed for additional periods of not more than 1 year at a time
- however, a secrecy order can be renewed as many times as necessary

## **Foreign Filing**

### **140 Foreign filing licenses**

*If an inventor files a patent application in the U.S., he or she may not file the same application in a foreign country prior to the passing of six months without first obtaining a foreign filing license. If the inventor illegally files in a foreign country before the 6 month waiting period has passed without getting a license first, he or she must immediately file for a retroactive license.*

-no filing of a patent application is allowed in a foreign country until 6 months after filing in the U.S. or by petition of a foreign filing license

-if an inventor sends off a foreign application (before 6 months has passed) after filing in the U.S. he or she must petition for a retroactive license

-a petition for a retroactive license must include:

-a list of all the foreign countries the application was filed in

-the dates the application was filed in each country

-an oath indicating:

-that the subject matter is not under a secrecy order

-evidence that the license has been diligently sought

-evidence that the illegal foreign filing occurred by mistake and without deceptive intent

-a large penalty fee

-foreign filing licenses are not required when:

-the invention was made outside the U.S. (even if by an American)

-an inventor has waited 6 months after filing the application in the U.S.

-a foreign filing license may be revoked by the PTO under special circumstances

### **150 Statements to DOE and NASA**

-no patents for nuclear material or atomic energy will be issued except under special circumstances

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

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**Summary:** Chapter 200 discusses many important topics. These include the differences between national and international applications, the correction of inventorship in patent applications, and a general overview of the different types of applications that may be filed to the PTO.

There are several different application types in all including; provisional, nonprovisional (regular), divisional, continuation-in-part, continuing, continued prosecution applications, substitute, statutory invention registration, and reissue applications.

Under specific conditions, an applicant may want to claim the earlier filing date of a previously filed application. It is possible to claim the priority of an earlier U.S. application or even applications filed in participating foreign countries.

Application status is also covered. The status of the application includes whether the application is pending, rejected or has been abandoned.

**\*\*\*\*** This chapter will provide you with a foundation for many of the other sections in the MPEP. Pay special attention to the section covering different application types. This will provide you with a solid understanding of patent applications. The subtle differences between continuing applications, C-I-P's and CPA's will most certainly be tested on the exam in numerous questions.

The exam will probably contain a specific question or two directed at correcting the inventorship of an application. Priority claims will also be covered in a couple of questions. The conditions for meeting the right of priority are usually incorporated in the test in at least one question.

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## National versus International Applications

### 201 Types of applications

#### *35 U.S.C. 111 Application.*

##### (a) IN GENERAL.—

(1) **WRITTEN APPLICATION.**—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) **CONTENTS.**—Such application shall include—

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title; and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) **FEE AND OATH.**—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) **FAILURE TO SUBMIT.**—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

##### (b) PROVISIONAL APPLICATION.—

(1) **AUTHORIZATION.**—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) **CLAIM.**—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

(3) **FEE.**—

(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) **FILING DATE.**—The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) **ABANDONMENT.**—Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) **OTHER BASIS FOR PROVISIONAL APPLICATION.**—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) **NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.**—A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

(8) **APPLICABLE PROVISIONS.**—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

**-International vs. National:**

-international applications:

-an international application is one that is filed under the Patent Cooperation Treaty (PCT) and has not yet entered national processing at the Designated Office Stage (this means the individual filed an application, but it has not yet been reviewed by the U.S.)

-national applications:

-there are two ways for an application to receive classification as a national application:

1- It may be filed as a U.S. application under 35 U.S.C. 111

2- It may be filed as an international application and then enter the national stage

-the national stage occurs when an internationally filed application enters the U.S. (this may include PCT applications initially filed in a foreign country)

-the date of national stage is treated as the filing date of the application

***At a glance-***

**Basic differences between national and national stage applications.**

<b>National applications</b>	<b>National stage applications</b>
• Filed under 35 U.S.C. 111	• Entered the national stage from an international application
• Restriction practice applies ( <i>Chapter 800</i> )	• Unity of invention applies ( <i>Chapter 1800</i> )
• The filing date may be awarded without the fee or an oath or declaration	• The filing date will not be awarded until the fee is paid and the oath or declaration is submitted

-there are three broad types of inventions that qualify for status as a national patent application:

-utility patents (usually mechanical-type inventions)

-plant patents

-design patents

**-Provisional vs. nonprovisional:**

*Please note that these classifications will be discussed in greater detail further on, this is just a basic overview of nonprovisional and provisional applications.*

-an original patent filed with the PTO must be further classified as either a:

-nonprovisional application:

-a U.S. national application filed under 35 U.S.C. 111(a) or one entering the national stage from an international application

-or-

-provisional application:

- a U.S. national application filed under 35 U.S.C. 111(b)

## Correcting Inventorship

*There are many instances where an application will be filed, but the inventors listed on the application are incorrect. This may be due to an innocent error or to changes made during the prosecution of the application. For example, some of the claims may have been canceled during the examination process. Therefore, a previously named inventor will no longer have any role in the subject matter that was claimed.*

*No matter what the circumstances are, the PTO has provided a means for an application's inventorship to be corrected. Rule 37 C.F.R. 1.48 addresses these issues. This specific rule and the topic of correcting inventorship will almost certainly be covered on the exam in a question or two.*

### **201.03 Correction of Inventorship in an Application**

- inventors are listed in the oath or declaration for non-provisional applications, and in the cover sheet for provisional applications
  - a new oath or declaration is not required to correct the inventorship of a provisional application because provisional applications do not require oaths or declarations
  - no new oath or declaration is required in rules 37 C.F.R. 1.48(b), 1.48(d), 1.48(e)
  
- an assignee's written consent is not required if an inventor is being deleted due to a cancellation of claims in order to reflect changes made to the application during its prosecution
  
- a petition under 37 C.F.R. 1.48 is **not** required where:
  - the claims and the inventorship ultimately match in the end  
*(if a team of scientists forgot Joe's name, but the claim he helped with was eventually deleted from the application)*
  - there is a spelling error in the name of the inventor
  - the inventor's name has changed
  - a court issued an order for the correction of the inventors involved in a patent
  - there was no change of the individual, but the incorrect name was given
  - a nonprovisional application, 35 U.S.C. 111(a) filed on or after 12/1/97 that does not include the names of the correct inventors, but also does not yet have an executed oath or declaration
    - the correct inventors may be listed when the oath or declaration is finally submitted
  - a provisional application, 35 U.S.C. 111(b), filed on or after 12/1/97 that does not include the names of the correct inventors, but also does not yet have a cover sheet
    - the correct inventors may be listed when the cover sheet is finally submitted
  - an error in the inventorship of a provisional application so long as a nonprovisional application naming the correct inventorship contains an overlap of at least one inventor with the provisional application.

•**Outline describing the proper use of 37 C.F.R. 1.48:**

**-When to use 1.48(a)?**

*-If the mistake in inventorship occurred in the executed oath or declaration of a nonprovisional application.*

-1.48(a) may be used when an innocent error occurred and inventorship was wrong from the beginning

**§ 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116.**

**(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:**

- (1) A request to correct the inventorship that sets forth the desired inventorship change;**
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;**
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;**
- (4) The processing fee set forth in § 1.17(i); and**
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).**

-a 1.48(a) filing must be accompanied by:

- a request to correct the inventorship of the application
- a statement from each person being added and each person being deleted acknowledging that the error occurred without deceptive intention on his or her part
- an oath or declaration executed by actual inventors
- the required fee
- the written consent of an assignee (if applicable)

**-When to use 1.48(b)?**

*-If a correction in the inventorship became necessary during the prosecution (usually due to the cancellation or amending of the claims) of a nonprovisional application and one or more inventors must now be deleted.*

-in this case, the executed oath or declaration of the nonprovisional application must be amended

-usually, a canceled claim or amendment will result in fewer inventors (i.e., inventor A came up with claim 3 and since claim 3 was canceled, inventor A needs to be taken off the application)