

# Answers to Worksheet 2 (MPEP Chapter)

## 1. Section I includes the following chapters:

- Chapter 100 - Secrecy, Access, National Security and Foreign Filing
- Chapter 200 - Types, Cross-Noting and Status of Application
- Chapter 300 - Ownership and Assignment
- Chapter 400 - Representative of Inventor or Owner
- Chapter 500 - Receipt and Handling of Mail and Papers
- Chapter 600 - Parts, Form and Content of Application

## 2. Section II includes the following chapters:

- Chapter 700 - Examination of Applications
- Chapter 2100 - Patentability
- Appendix I - Prior Art Rejections
- Appendix II - 35 U.S.C. 102 Rejections
- Appendix III - 35 U.S.C. 103 Rejections
- Appendix IV - Disqualify Prior Art
- Appendix V - 35 U.S.C. 112 Specification Requirements

3. Section III includes the following chapters.

- Chapter 800 - Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting
- Chapter 900 - Prior Art, Classification, Search
- Chapter 1000 - Matters Decided by Various PTO Officials
- Chapter 1100 - Statutory Invention Registration (SIR) ; Pre-Grant Publication (PGPub) and Preissuance Submissions
- Chapter 1200 - Appeal
- Chapter 1300 - Allowance and Issue
- Chapter 1400 - Correction of Patents
- Chapter 1500 - Design Patents
- Chapter 1600 - Plant Patents
- Chapter 1700 - Miscellaneous
- Chapter 1800 - Patent Cooperation Treaty
- Chapter 1900 - Protest
- Chapter 2000 - Duty of Disclosure

4. Section IV includes the following chapters:

- Chapter 2200 - Citation of Prior Art and Ex Parte Reexamination of Patents
- Chapter 2300 - Interference Proceedings
- Chapter 2400 - Biotechnology
- Chapter 2500 - Maintenance Fees
- Chapter 2600 - Optional Inter Partes Reexamination
- Chapter 2700 - Patent Terms and Extensions
- Chapter 2800 - Supplemental Examination
- Updates - New Supplements.

## 5. Chapter 100 - Secrecy, Access, National Security and Foreign Filing

- Who may or may not access particular application types.
- Secrecy orders.
- Foreign filing licenses.

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

- National and international applications.
- Different types of applications that may be filed to the PTO including provisional, nonprovisional (regular), divisional, continuation-in-part, continuing, continued prosecution applications, substitute, statutory invention registration, and reissue applications.
- Claiming the priority of an earlier U.S. application or even applications filed in participating foreign countries.
- Application status.

## 7. Chapter 300 - Ownership and Assignment

- The inventor(s) may sell or transfer the rights to the invention via an assignment.
- Recording and establishment of the assignment by the PTO.

## 8. Chapter 400 - Representative of Inventor or Owner

- The power of attorney and the withdrawal or revocation of the power of attorney
- Who will receive correspondence during the prosecution of an application.

## 9. Chapter 500 - Receipt and Handling of Mail and Papers

- Proper methods for sending documents to the PTO in order to insure that the documents are received on time including facsimiles, hand delivery, “Express Mailing”, or the Certificate of Mailing procedure.
- Small entity status and micro entity status include where certain applications qualify for discounted fees due to particulars about the inventor(s).

## 10. Chapter 600 - Parts, Form and Content of Application

- Contents required for filing an application and gaining a filing date.
- Detailed descriptions and guidelines for the oath/declaration, the disclosure and the drawings
- Rules involved with writing claims and provides several examples of properly written claims.
- The time periods and regulations for submitting an Information Disclosure Statement (IDS).

## 11. Chapter 700 - Examination of Applications

- Overview of examination process including replies to Office actions and final rejections.
- Petition to make special
- Petition to file for an extension of time or to revive application that was abandoned
- Requests for suspension of action
- Requests for continuing examination
- Interviews
- Amendments

## 12. Chapter 2100 - Patentability

- What is **patentable**.
- Overview of 35 USC 101, 102, and 103.
- Overview of the requirements for the specification

## 13. Appendix I - Prior Art Rejections (700 & 2100)

- Overview of **prior art rejections** including 35 USC 102 and 35 USC 103.
- America Invents Act (AIA)

## 14. Appendix II - 35 U.S.C. 102 Rejections (700 & 2100)

- AIA and pre-AIA versions of 35 USC 102 which is based on the **novelty** of the invention.

## 15. Appendix III - 35 U.S.C. 103 Rejections (700 & 2100)

- 35 USC 103 rejections which are based on the **obviousness** of the invention.

## 16. Appendix IV - Disqualify Prior Art (700 & 2100)

- Covers 37 CFR 1.130, **1.131**, and 1.132

## 17. Appendix V - 35 U.S.C. 112 Specification Requirements (2100)

- Covers 35 USC 112 which is based on the requirements of the specification.
- Written description, **enablement**, and best mode.

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

- Restrictions to only one invention.
- **Independence** and distinctness.

## 19. Chapter 900 - Prior Art, Classification, Search

- Prior art search for patent examiners
- Matter **cancelled** in an application, copending abandoned applications and foreign patents.

## 20. Chapter 1000 - Matters Decided by Various PTO Officials

- Petitionable **disputes**.

## 21. Chapter 1100 - Statutory Invention Registration (SIR) and Pre-Grant Publication

- Statutory invention registration (SIR)
- Publication, nonpublication, and **redacted** publication procedures.

## 22. Chapter 1200 - Appeal

- Extensive discussion on appeals.
- Notice of Appeal and **Appeal Briefs**.

## 23. Chapter 1300 - Allowance and Issue

- Notice of Allowance
- **Issue** Fee
- Withdrawing from issue and lengths of various patents.

## 24. Chapter 1400 - Correction of Patents

- Extensive discussion on **reissue** applications.

25. Chapter 1500 - Design Patents

- Extensive discussion of design patents.
- Unique properties of design patents.

26. Chapter 1600 - Plant Patents

- Overview of plant patents.
- Plants must reproduce asexually.

27. Chapter 1700 - Miscellaneous

- Restrictions placed on former examiners.
- Official Gazette.
- US Philippines search engine.

28. Chapter 1800 - Patent Cooperation Treaty

- Extensive discussion of the Patent Cooperation Treaty
- U.S. applicant may file one international application to the U.S. and have that international application acknowledged as a regularly nationally filed application in as many member PCT countries as he or she designates.

29. Chapter 1900 - Protest

- Protests are filed by individuals who believe a particular application should not gain patent status.

### 30. Chapter 2000 - Duty of Disclosure

- Each inventor and every other individual who is substantially involved in the preparation or prosecution of the application has a duty of disclosure.
- These duties consist of **candor**, good faith and the duty to disclose all relevant materials to the PTO.

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

- Covers the processing and filing of prior art citations and reexamination requests.
- Citations of prior art for reexaminations are limited to prior art patents and **printed publications**.

### 32. Chapter 2300 - Interference Proceedings

- Interferences determine who should receive the right to a patent when a pending application claims the same invention as another pending application or unexpired patent.
- Interferences have been phased out by **Derivation** Proceedings
- Applications filed before March 16, 2013 are still eligible for interferences.

### 33. Chapter 2400 - Biotechnology

- Covers the rules for biological **deposits** and sequences.

### 34. Chapter 2500 - Maintenance Fees

- Maintenance fees must be paid on all **utility** applications filed after December 12, 1980
- Maintenance fees are not required on design or plant patents.



35. Chapter 2600 - Optional Inter Partes Reexamination

- Discusses inter partes **reexamination** proceedings.

36. Chapter 2700 - Patent Terms and Extensions

- Discussion of patent lengths and **adjustments**.

37. Chapter 2800 - Supplemental Examination

- Supplemental examination provides a patent owner with a mechanism to request that the Office consider, reconsider, or **correct** information believed to be relevant to the patent.