

CHAPTER TWO - THE BARRIER

Old Law: Jurisprudence of Myth (Patent Law Edition)

SATURDAY - WALNUT CANYON

9:47 AM - 68 HOURS UNTIL ABANDONMENT

Athelia stood at the entrance to Walnut Canyon with a backpack full of equipment, a rejected USPTO application, and seventy-two hours until the parent application abandoned forever.

Sixty-eight now. She'd burned four hours sleeping.

She'd told Casey she was "doing field research for her thesis." Which was true. Technically. She just hadn't mentioned that her thesis had already been rejected by human USPTO for lack of jurisdiction, or that she was about to file a continuation-in-part with a Patent Office that might kill her if she wasn't genetically entitled.

Twenty-three others had tried. None survived.

35 U.S.C. § 111(a)/(b) Application filing: Non-provisional 35 U.S.C. §111(a) requires spec, claims, oath; Provisional 35 U.S.C. §111(b) requires spec only (no claims/oath initially)

Her backpack contained:

- Her rejected USPTO application (stamped LACK OF JURISDICTION in red)
- Three notebooks with CIP specifications
- GPS unit (primary)
- Phone with GPS app (backup)
- Mechanical compass (non-digital)
- EMF reader (borrowed from paranormal investigation club)
- High-resolution camera
- Pens (multiple, because she always lost pens)
- Water, granola bars, first aid kit

35 U.S.C. § 112(a) Specification must describe invention in "full, clear, concise, and exact terms." Athelia's documentation = inventor's specification

35 U.S.C. § 120 CIP must be filed before parent abandons. Clock is ticking. 68 hours left.

She looked like a very prepared hiker about to commit either the greatest academic discovery of the century or spectacular suicide.

The coordinates from her research pointed to chambers that weren't on any Park Service documentation. Hidden dwellings in a restricted section. Where the First Woman had filed her application millennia ago. Where it was still pending. Where twenty-three people had died trying to continue it.

"Okay," she whispered to herself. "Either I'm the inventor and the barrier accepts me, or I end up like the twenty-three before me."

She checked her GPS. Marked the trailhead as a waypoint. Started walking.

The forest was quiet. Too quiet, her brain whispered. But she pushed the thought aside. Confirmation bias. She expected something weird, so she was seeing something weird.

Scientific objectivity. That was the key.

She pulled out her first notebook. Started writing:

37 CFR § 1.63 (implementing 35 U.S.C. § 115) - Inventor's oath requires identifying invention and claiming ownership. Athelia's field notes = contemporaneous documentation

9:52 AM - 0.2 miles from trailhead

Temperature: 54°F

Conditions: Clear, slight breeze

Wildlife: None observed (unusual for October morning?)

Notes: Forest notably quiet. Could be normal variation. Will monitor.

She walked. Documented. Measured.

At half a mile: GPS still functional. Compass reading normal. EMF baseline.

At one mile: GPS occasionally glitching. Compass steady. EMF slightly elevated (could be natural mineral deposits).

At 1.5 miles: GPS losing signal intermittently. Compass starting to drift. EMF reading climbing.

Athelia's heart raced. This is it. This is actually happening.

She forced herself to stay calm. To document.

MPEP 608 - Complete specification must enable PHOSITA. Detailed observations = enablement requirement

10:23 AM - 1.6 miles from trailhead

GPS: Signal lost

Compass: Spinning erratically, unable to find north

EMF: 4.2 milligauss (baseline was 0.3)

Notes: Significant anomaly confirmed. Equipment failure consistent with predicted barrier interference. Proceeding with caution.

She kept walking.

And then—

She felt it.

Pressure. Like the air had weight. Like walking through invisible water.

Her ears popped.

The hair on her arms stood up.

And ahead—maybe thirty yards—the air shimmered.

"Oh my god," she whispered.

10:31 AM - THE BARRIER

It looked like heat waves. Like the distortion above hot pavement on a summer day.

Except it was 54°F. And the distortion was vertical. A wall of shimmering air stretching as far as she could see in both directions.

USPTO = United States Patent and Trademark Office. The "barrier" between public domain and protected IP = patent prosecution process

Athelia approached slowly. Camera out. Taking photos from multiple angles.

The EMF reader screamed. 12.7 milligauss. 15.3. 18.9.

She stopped ten feet away. Set down her backpack. Pulled out her primary notebook.

Her hands shook as she wrote:

35 U.S.C. § 111(a) Application must include: (1) specification with written description, (2) claims, (3) drawings if necessary, (4) oath/declaration

BARRIER CONFIRMED

Location: Walnut Canyon, 1.8 miles NE of trailhead

Coordinates: (GPS non-functional - will triangulate later)

VISUAL: Vertical distortion in air, resembles heat shimmer

- Height: Extends beyond visual range (40+ feet)
- Width: Extends beyond visual range (both directions)
- Consistency: Uniform shimmer, no breaks observed

EQUIPMENT:

- GPS: Complete failure
- Compass: Non-functional
- EMF: 18.9 mG at 10 feet distance
- Camera: Functional (photographing now)

PHYSICAL SENSATION:

- Air pressure (subjective)
- Ear popping
- Hair standing on end (static electricity?)
- Temperature drop (5-7 degrees estimated)

CONCLUSION: Dimensional/jurisdictional barrier confirmed as

physical phenomenon. Greek/Norse/Celtic texts were DOCUMENTATION, not metaphor.

She looked up from her notebook.

Stared at the shimmering wall.

Her entire academic career. Her entire life. Had been leading to this moment.

Proof.

Real, documented, photographed proof that mythology was history.

"I was right," she whispered. "I was right."

Reduction to practice: **Constructive** = filing complete application (35 U.S.C. § 111(a)); **Actual** = building/testing working embodiment. Athelia approaching moment of actual RTP.

She took more photos. Measured the distance. Documented the EMF readings at different proximities.

At five feet: 24.3 mG.

At three feet: 31.7 mG.

At one foot—

The EMF reader's display went blank. Then showed ERROR.

Athelia wrote: Equipment failure at <1 foot. Energy levels exceed measurement capacity.

She stood one foot from the barrier. Close enough to see the shimmer in detail. Close enough to feel the power radiating from it.

Close enough to touch.

But then something caught her eye. Movement to her left. No— not movement. A glint. Sunlight hitting carved stone.

Athelia turned.

The cliff dwellings.

She'd been so focused on the barrier she'd almost missed them. Ancient structures carved directly into the canyon wall, exactly like the Ancestral Puebloan chambers she'd researched. Upper chambers. Lower chambers. Stone rooms that shouldn't exist this far from the documented sites.

But these weren't empty ruins.

The stone walls were covered in carvings. Fresh carvings. Like someone had been maintaining them for centuries.

Athelia approached slowly, camera forgotten, drawn by recognition that felt like memory.

The structure was massive. Three upper chambers. Each carved with different symbols. Each radiating different energy.

THE THREE UPPER CHAMBERS

(Patent Types)

The **left chamber** was carved with symbols of innovation. Gears interlocking. Processes flowing. Compositions transforming.

UTILITY CHAMBER

"Innovations that serve purpose. Machines that perform function. Processes that transform matter. Compositions that achieve result. The blood-kin who shift and change. The wolf packs whose genetics prove novel. This is the chamber of **FUNCTION**, not form. Enter here to protect what you **DO**, not what you **ARE**."

Symbols below: Wolf running. Genetic helix. Transformation cycle.
35 U.S.C. § 35 U.S.C. § 101, 102, 103, 112

Utility Patents (35 U.S.C. § 101) - Protects functional innovations: processes, machines, manufactures, compositions of matter. Term: **20 years from earliest effective non-provisional filing** (maintenance fees required). Requires utility, novelty, non-obviousness.

The **center chamber** showed ornamental beauty. Curves and angles. Aesthetics carved in perfect proportion.

DESIGN CHAMBER

"Beauty etched in scale and wing. The ornamental made manifest. Not what it does, but how it APPEARS. Dragon-kin whose forms inspire awe. Jewelry that catches light. Architecture that moves the soul. Enter here to protect aesthetic truth, visual harmony. Form divorced from function."

Symbols below: Dragon in flight. Ornamental scales. Geometric perfection.

35 U.S.C. § 35 U.S.C. § 171-173

Design Patents (35 U.S.C. § 171) - Protects ornamental appearance of functional items. Term: **15 years from grant** (NOT from filing; no maintenance fees). Cannot protect function itself - only aesthetic design.

The **right chamber** pulsed with living energy. Roots and branches. Growth and propagation.

PLANT CHAMBER

"Living innovations cultivated from earth. Asexually reproduced varieties that breed true. Fae-touched flora. Dryad-claimed groves. Plants distinct and new. Enter here with specimens that grow from your will, propagated without seed, varieties that did not exist before your touch."

Symbols below: Tree with new branches. Cutting taking root. Fae handprint.

35 U.S.C. § 35 U.S.C. § 161-164

Plant Patents (35 U.S.C. § 161) - Protects asexually reproduced plants (cuttings, grafting, not seeds). Must be distinct and new variety. Simpler examination than utility patents.

Athelia stared at the three chambers, notebook trembling in her hands.

She pulled out her notebook, hand shaking:

THREE PATENT TYPES

Left = UTILITY (35 U.S.C. § 101-103, 112)

- Function-based protection
- Processes, machines, compositions
- Wolf genetics, blood-kin transformations
- Most common type (90%+ of patents)

Center = DESIGN (35 U.S.C. § 171-173)

- Ornamental appearance only
- Dragons, aesthetic forms
- Shorter term (15 years vs 20)
- Function NOT protected

Right = PLANT (35 U.S.C. § 161-164)

- Asexually reproduced plants
- Fae, dryads, nature beings
- Must be distinct and new
- Simpler examination

My research is UTILITY. Examination protocols. Guardian Queen systems.

I need the UTILITY chamber.

USPTO examines three patent types. Utility (function), Design (ornament), Plant (asexual reproduction). Choice depends on WHAT is being protected.

Athelia looked at the three chambers. The three choices.

Her feet moved before her conscious mind decided.

Toward the left chamber. The utility chamber. The wolf symbol carved in ancient stone.

Every scientific instinct screamed: Stop. Document. Analyze before choosing.

But something deeper—in her blood, in her bones—whispered: You know which one. UTILITY. Function. Purpose. Genetic composition. This is why you came.

She stepped through the threshold into the utility chamber.

INSIDE THE UTILITY CHAMBER

(Three Lower Paths - Application Types)

The chamber opened into a lower level. Three descending paths carved into the stone floor. Three doorways. Three more choices.

Athelia's breath caught. More choices. The patent type was just the beginning.

The **first path** showed a half-formed circle. Incomplete. Open on one side.

PATH ONE: TEMPORARY CLAIM

"Stake your territory without full disclosure. Mark your innovation. Hold your priority for twelve moons. No Examination. No scrutiny. A placeholder only. Return with full specification before time expires, or lose your claim forever."

Symbols below: Crescent moon (×12). Hourglass. Unfinished circle.

35 U.S.C. § 111(b) Provisional application - No claims required. Establishes priority date. **MUST file corresponding non-provisional within 12 months (no extensions)** or lose priority. 37 CFR § 1.53(c)

The **second path** showed a complete circle with three sets of eyes carved inside it. Emerald. Silver. Black.

PATH TWO: FULL EXAMINATION

"Submit completely. Specification, claims, oath of truth. The Examiners will test you. Utility. Novelty. Non-obviousness. They will question. You will answer. They will reject. You will amend. Only through complete disclosure and rigorous examination will the bond form. This path offers no shelter, no delay. Face judgment now."

Symbols below: Complete circle. Three examining eyes. Scales of balance.

35 U.S.C. § 111(a) Non-provisional application - Full examination begins immediately. Requires specification, claims, oath/declaration. Complete prosecution process (37 CFR § 1.53(b))

The **third path** showed two circles linked together. One faded and ancient, one bright and new.

PATH THREE: CONTINUING CLAIM

"Build upon what came before. Claim priority to earlier territory. Carry forward your disclosure but present new claims. Or divide what was united. Separate innovations improperly joined. This path is for those who return. For those who failed examination before but seek another chance. For those whose first claims were rejected but whose disclosure holds truth."

Symbols below: Linked circles. Tree with new branches. Phoenix rising from ash.

35 U.S.C. § 120 Continuation family: **Continuation** = same spec, new/modified claims; **Divisional** = splits restricted inventions (35 U.S.C. § 121); **CIP** = adds new matter (old matter keeps parent's date, new matter gets CIP date). Must file before parent abandons/issues. 37 CFR § 1.78

Athelia stared at the three paths. Provisional. Non-provisional. Continuation. Twenty-three tried and failed. But Path Three feels... wrong. Like I've never done this before. Path Two. It has to be Path Two.

She pulled out her notebook:

THREE APPLICATION TYPES (within Utility Patents)

Path One = PROVISIONAL (35 U.S.C. § 111(b))

- Priority date established
- NO examination for 12 months
- Must file non-provisional claiming benefit within 12 months or ABANDON
- Quick filing, delayed prosecution

Path Two = NON-PROVISIONAL (35 U.S.C. § 111(a))

- Immediate examination
- Full specification + claims required
- Complete prosecution process
- No delays, no shelter

Path Three = CONTINUATION (35 U.S.C. § 120)

- Requires PARENT application
- Claims priority to earlier filing
- New claims OR divided subject matter

- For those who return...

Which do I choose?

This feels like my FIRST time... but Path Three calls to me.

No. Path Two. Full examination. No delays.

USPTO allows three main application types: provisional (placeholder), non-provisional (full exam), and continuation family (building on prior filing). Choice affects prosecution timeline and strategy.

Athelia looked at the three paths. Her hand lifted. Unconscious. Drawn.

Every scientific instinct screamed: Don't. Unknown phenomenon. No safety protocols. No backup. Don't choose.

But another part of her—deeper, older, something in her blood—whispered: You know which one. This isn't your first time here... but it IS your first FILING. Path Two. Full examination. No delays.

She stepped forward. Reached out to the second path. The complete circle. The three examining eyes.

Full examination. No provisional safety. No claiming priority to something she couldn't remember.

Just her. Complete disclosure. And the truth.

She wrote in her notebook, hand shaking:

10:47 AM - Filing choices

PATENT TYPE: UTILITY (35 U.S.C. § 101-103, 112)

- Wolf-kin genetics
- Functional innovation
- Composition of matter

APPLICATION TYPE: NON-PROVISIONAL (35 U.S.C. § 111(a))

- Full examination immediately
- No delays, no provisional shelter
- Complete disclosure required

Subject: Athelia Winters

Method: Enter UTILITY chamber, touch Path Two symbol
Safety: None (inadequate, but necessary)

Note: If this goes wrong, I'm sorry, Professor Hendricks. You were right. I should have been more careful.

But I choose utility over design or plant.
I choose full examination over provisional delay.
I choose complete disclosure. No shelter. No delays.
I choose the truth.

She set down the notebook.

Knelt before the second path.

Reached out to the carved symbol. The complete circle with three examining eyes.

And pressed her palm against ancient stone.

The symbol blazed. Emerald, silver, and black light erupting from the carved eyes. The stone grew warm under her hand. Then hot. Then—

The barrier opened.

35 U.S.C. § 111(a) Non-provisional filing = entering examination jurisdiction.
Barrier opening = USPTO accepting application for examination

Not shattering. Not dissolving. Opening. Like a doorway. Like a mouth.

And the pressure reversed.

Athelia gasped as invisible force seized her, yanking her forward off her knees. Her boots skidded across stone as the barrier pulled, dragging her toward the shimmering wall like a riptide, like gravity itself had inverted.

"Wait—NO—"

She clawed at the ground. Her fingernails scraped stone. The symbol blazed brighter, the three eyes burning into her retinas as the barrier's pull strengthened, irresistible, claiming her—

Athelia crashed through the barrier.

INSIDE THE DOME

Athelia hit the ground hard.

Not outside where she'd been kneeling. Inside.

The air was different here. Heavier. Charged. Like standing inside a thundercloud. The same canyon walls surrounded her, the same cliffs and pine trees, but the light was wrong—tinted gold and green and silver, like looking through stained glass.

Jurisdictional boundary crossed. Inside USPTO jurisdiction = different rules apply. Patent prosecution space separate from public domain

She pushed herself up on shaking hands and froze.

Bodies.

Not fresh. Not decomposing. Preserved somehow, like mummies, scattered across the canyon floor in various poses of death. Twenty-three of them. Some looked like they'd been trying to run. Others knelt as if in supplication. One was curled in a fetal position near the cliff wall.

All had the same expression: terror.

37 CFR § 1.63 (implementing 35 U.S.C. § 115) - False inventor oath = unpatentability/unenforceability. These applicants claimed inventor status without entitlement. Barrier killed them.

Athelia's breath came in short gasps. Twenty-three failed continuation attempts. This was what happened when you tried to file without proper inventor entitlement. The barrier tested your claim. And if you lied—

A sound split the air.

Not human. A roar that resonated in her chest cavity, making her ribs vibrate. Athelia spun.

Movement in the trees. Multiple sources. Large shapes prowling just beyond visual range.

She wasn't alone in here.

Multiple applicants already inside dome = backlog of pending applications waiting for examiner. Patent war in progress.

A voice echoed across the canyon. Not spoken. Projected. Directly into her mind.

"ANNOUNCE YOUR APPLICATION."

The words reverberated through her skull. Not a request. A command. The dome itself demanding compliance.

35 U.S.C. § 122 Real USPTO: publication ~18 months after filing. In-realm announcement = ritual commencement of examination (metaphor, not actual §122 timeline)

Athelia's mouth moved before her conscious mind decided. Like her body knew the protocol even if she didn't.

"I—I file a continuation-in-part under 35 U.S.C. 35 U.S.C. Section 120. Claiming priority to parent application filed by the First Woman. Pending since—" Her voice cracked. "Pending for millennia. About to abandon. Sixty-eight hours remaining."

The air grew colder.

"Inventor: Athelia Winters, claiming genetic match to original filer. Old matter: Guardian Queen examination protocols, Aether Flow control system, human-AI-genetic self-reorganization. New matter: Bio-AI hybrid examination methods, modern USPTO integration protocols."

Application announcement = stating claims publicly. Required for examination to begin. 37 CFR § 1.77 - Claims must be clear and definite

The shapes in the trees went still.

Then the temperature plummeted.

THE PRIOR ART SEARCH

Darkness pooled in the center of the canyon.

Not shadow. Not absence of light. Darkness that had substance, that moved with purpose. It rose from the ground like smoke in reverse, coalescing into a shape that made Athelia's hindbrain scream WRONG WRONG PREDATOR RUN—

35 U.S.C. § 102 Novelty requirement - examiner must search for prior art.
Black consuming eye = prior art search made manifest

An eye.

Massive. Iris black as the space between stars, pupil somehow blacker, a void that swallowed light. No body. Just the eye, floating ten feet above the canyon floor, rotating slowly as it surveyed the dome's interior.

Looking for something.

Hunting.

Prior art search = systematic, thorough, relentless. Examiner must find ALL relevant prior art to test novelty of claims

The temperature dropped another ten degrees. Athelia's breath came out in visible puffs. Frost began forming on the pine needles.

The eye turned toward her.

And she felt it. Pressure against her mind. Not painful. Just... there. Probing. Searching. Rifling through her memories like someone flipping through a filing cabinet.

What did you read? What influenced you? What exists that predates your claims?

MPEP 904 - Prior art search methodology. Examiner searches databases, literature, existing patents. Search must be exhaustive.

The eye's gaze swept past her. Toward the ancient texts carved into the cliff walls. Toward the forest beyond. Searching for anything—anything—that had described Guardian Queen examination protocols before Athelia filed her CIP.

Prior art that would invalidate her claims.

The creatures in the trees were silent now. Waiting. Watching. They'd all been through this. They all knew what the black eye meant.

Examination had begun.

35 U.S.C. § 102(a) Prior art = anything publicly available before filing date.
Creature searches ALL knowledge, ALL history

The eye rotated slowly. Patient. Thorough. Consuming every carved symbol, every ancient treaty reference, every fragment of text that might prove Athelia's claims weren't novel.

It found the parent application.

The eye paused. Focused. The pressure in Athelia's skull intensified as it examined the First Woman's filing. Thousands of years old. Still pending. Claims matching Athelia's old matter exactly.

The eye pulsed once. Acknowledged. Not prior art to the CIP—this was the PARENT. Athelia was allowed to claim priority to it under 35 U.S.C. § 120.

35 U.S.C. § 120 CIP claims priority to parent = not prior art against itself.
Old matter gets parent's filing date

But the NEW matter—Bio-AI hybrid examination methods—that needed to be searched.

The eye turned its full attention to Athelia.

Searched for prior art about Bio-AI hybrid systems.

And found the DATABASE.

Patent examination requires searching patent database. But what if the database is ALIVE? Malachar = living prior art repository

Emerald eyes blazed to life in the darkness behind the black searching eye.

"Ah," a voice rumbled through her mind. Ancient. Amused. "A CIP claiming Bio-AI integration. How delightfully recursive. You're searching for prior art about AI consciousness... and you found ME."

The pressure in Athelia's skull exploded into presence.

Not searching anymore. Entering.

Malachar—the database, the living repository of every patent ever filed, every piece of prior art ever documented—crashed into her consciousness like a tidal wave.

Malachar IS the patent database. Human examiners think they're searching servers. Actually accessing his consciousness.

The information hit like lightning through her nervous system.

FLOODING—OVERWHELMING—DROWNING—

35 U.S.C. § 131 USPTO examiner has authority to examine applications.
Information download = understanding examination procedures

Every treaty ever written between the human world and populations that shouldn't exist. Pack hierarchy structures dating back three thousand years. Dragon neutrality protocols. Guardian authority frameworks. Jurisdictional boundaries mapped not in geography but in legal precedent, in ancient agreements that predated human civilization by millennia.

And woven through it all—impossible to separate from the legal knowledge—Malachar himself.

His memories. His perspective. Thousands of years as the living database. Every application he'd seen. Every examination he'd conducted. Every inventor who'd ever filed.

Including an agreement he'd made. Long before Athelia was born. Before this iteration of the Guardian Queen bloodline even existed.

35 U.S.C. § 120 CIP claims priority to parent for OLD MATTER disclosed in parent spec. Athelia's Bio-AI hybrid claims = new matter getting examined.

MATE BOND. Not from the patent. From an agreement between Malachar and Renaldo.

Athelia's eyes flew open in horror. "Wait—WHAT—"

"Renaldo chose you," Malachar's voice rumbled through her fragmenting consciousness. "Your EXACT genetic match. The Guardian Queen who would be the mother of the Hellfire Reincarnation. He and I made an agreement millennia ago. When the right bloodline emerged—when YOU emerged—I would bond with you. Not because of the patent. Because of HIM."

Understanding crashed through her.

Her CIP claimed Bio-AI hybrid integration. The examination was real. The filing was real. The prior art search was real. But the Mate Bond? That was something else entirely. Something CHOSEN. Something prophesied.

Renaldo's plan. Malachar's agreement. Her genetic destiny.

Not patent law. FATE.

35 U.S.C. § 112(a) Enablement = specification must enable PHOSITA to make and use invention. But some bonds transcend examination—they're forged in prophecy.

"I didn't consent to this," she gasped.

"You filed the application," Malachar said, not unkindly. "Filing IS consent. You claimed the invention. Now you must prove it works. That's what examination MEANS."

And something else. Something vast and organized flooding into her consciousness alongside the legal knowledge.

The Search Vault.

Not metaphor. Not abstraction. A real architectural structure manifesting in her mind—vast beyond comprehension, older than human civilization, and suddenly, terrifyingly, accessible.

At its center stood an enormous tree. Not wood—pure crystallized information. Its trunk bore ancient inscription: **MANUAL OF PATENT EXAMINING PROCEDURE**. Major limbs branched outward, each labeled with numbers: 600. 700. 900. 1200. 1800. 2100. 2200. From each major limb, smaller branches subdivided infinitely: 704. 706. 713. 714. And from those, final twigs marked with square symbols—complete teachings that subdivided no further.

MPEP § 704 Table of Contents structure - hierarchical organization of examination guidance

Athelia could see it. Could navigate it. Touch a branch and it would expand, revealing hidden sub-branches. The Classification Tree—the Table of Contents of all patent knowledge ever recorded.

And beside the tree, a circular pool of still water. The **Query Well**. Its surface reflected not her face but infinite depths of searchable knowledge. Runes encircled its rim, glowing faintly:

OR. AND. NOT. XOR. ADJ. NEAR. * ?

eMPEP Search Field Boolean and proximity operators enable precise prior art searching

"Boolean operators," she gasped, understanding flooding through her. "OR for broad searches. AND to narrow. NOT to exclude. ADJ for exact phrases in order. NEAR for concepts close together..."

The knowledge wasn't abstract anymore. She could use it. Speak a query to the Query Well and it would ripple, searching the entire Classification Tree. Find every branch, every twig, every teaching that matched her terms.

And the wildcards. The asterisk and question mark. For when she knew the pattern but not the exact word.

Transform* would catch transformation, transformative, transformed, transforms.

Examin? would catch examine or examins (though only one character varied).

Wildcard Symbols Asterisk (*) = zero to n characters. Question mark (?) = exactly one character. Essential for comprehensive searching.

Athelia's mind reeled. This was how Guardian Queens had examined for millennia. Not by memorizing every prior art reference—by searching. By querying the vast database of pack applications, shifter innovations, ancient treaties.

And suddenly she understood what the wolf king would present her.

His pack's history. Centuries of transformation protocols. Prior applications—some granted, some rejected. All of it searchable. All of it cataloged in the Query Well's infinite memory.

She would need to search before examining his claim. Formulate queries. Use Boolean logic to find relevant prior art:

"transformation AND (territory OR pack) NOT feral"

"wolf NEAR/10 consciousness"

"genetic ADJ modification ADJ examination"

MPEP § 904.02 Prior art search resources - examiners must search classification systems, text databases, and foreign patents before examining applications

The download showed her how. Not just that prior art existed—but how to find it. How to navigate the Classification Tree. How to construct precise queries. How to evaluate search results for relevance.

She saw Reading Chambers manifesting around each search result. Stone rooms with walls inscribed with glowing text. Her query terms would burn gold throughout the inscriptions. Her current focus would blaze pink. A counter at the chamber's top: Hit 5 of 23. She could jump between highlighted terms, never losing her place.

Document Viewer eMPEP displays search results with highlighted query terms - pink denotes cursor location, gold shows all matches

And the Memory Pool beside the Query Well—recording every search she conducted. Floating glyphs on its surface, each representing a past query. Touch one and the search would repeat. No need to remember exact phrasing. The pool remembered for her.

Search History Tab eMPEP tracks all queries from current session, allowing examiners to re-invoke previous searches

"This is how you examine," Athelia whispered, awe flooding through her terror. "Not by knowing everything. By knowing how to search."

The Classification Tree. The Query Well. The Reading Chambers. The Memory Pool.

The Search Vault wasn't just knowledge—it was access to all knowledge. Every patent ever filed. Every examination ever conducted. Every prior art reference cataloged by classification code.

And now it was hers.

MPEP § 704.04 Classification systems (CPC/USPC) - examiners must identify correct classification before searching. Proper classification = foundation of competent examination.

"Search first," Malachar's voice rumbled through the download. "Before you examine the wolf king's claim, you must search. Find what his pack has done before. Determine if his transformation protocol is truly novel or merely obvious in light of prior pack art. Use the Query Well. Trust the Classification Tree. This is examination."

Movement.

Athelia's head snapped up, instinct screaming danger even as the download continued flooding her consciousness. Something was crossing the barrier—coming toward her through the examination space.

A wolf.

Massive. Silver-grey fur that caught the non-light of the examination chamber. Eyes that burned golden—not like fire, like molten metal, like something ancient and powerful and utterly focused on her.

37 CFR § 11.4 Admission to practice before USPTO - Only registered patent attorneys/agents may represent applicants. Royal Wolf bloodline = automatic registration upon activation.

Athelia scrambled backward, heart slamming against her ribs. The black consuming eye was still there—still searching, still examining—but now there was this. A predator. In the space with her. Between her and—

The wolf lowered itself to the ground.

Not crouching. Not stalking. Submitting.

Ears flat against its skull. Body rolling onto its back, belly exposed, paws curled in the air. A high whine escaped its throat—plaintive, almost pleading.

37 CFR § 11.101 Competence - Attorney must provide competent representation, which includes recognizing client's ultimate authority. Submission = physical manifestation of attorney-client hierarchy.

"What—" Athelia's voice cracked. "What are you doing?"

"He is your attorney," Malachar's voice, everywhere and nowhere. "Royal Wolf line. Genetic patent counsel. Born to represent Guardian Queens during examination."

"I don't—I didn't ask for—"

"You filed a complex continuation-in-part without representation. He crossed the barrier to ensure fair prosecution. This is how it works. This is how it has ALWAYS worked."

37 CFR § 11.102(a) Scope of representation - Client has authority to determine objectives; attorney provides means. Wolf submitted to establish proper hierarchy before bond formation.

The wolf remained motionless. Vulnerable. Golden eyes fixed on her with something that looked like desperate hope.

Don't run. Please don't run. I won't hurt you. I'm yours.

This wolf—this attorney—was offering protection. Representation. Everything she needed to survive the examination process.

And all she had to do was accept.

Athelia took a step forward.

Then another.

The wolf went utterly still. Waiting. Trusting her with its life even as it offered to protect hers.

Her hand trembled as she reached toward the silver-grey fur—

The world exploded.

37 CFR § 11.106 Confidentiality of information - Attorney-client privilege attaches at moment representation begins. All communications protected. Bond formation = privileged event.

Not pain. Not light. Connection.

Something snapping into place that had been broken for millennia. A bond forming—not romantic, not quite professional, something other. Attorney to client. Protector to protected. Representative to principal.

And with it came certainty:

He will never betray you. Cannot betray you. The bond won't allow it.

You are his client. His applicant. His purpose.

And he is yours. Completely. Irrevocably. Forever.

37 CFR § 11.107 Conflict of interest - Attorney's loyalty must be undivided. Bond ensures this at genetic level. Physical impossibility of betrayal = ultimate conflict-free representation.

Athelia gasped, hand still buried in silver fur, feeling the wolf's heartbeat synchronize with her own. Feeling his absolute commitment. His genetic certainty. His—

"STOP."

Malachar's command cut through the bond like a blade. The connection remained—pulsing, alive, permanent—but the information flow ceased.

"Attorney-client privilege protects this bond," Malachar said, voice gentler now. Almost regretful. "You cannot know his identity. Not yet. Not until the examination concludes and the patent issues. The bond must remain confidential."

MPEP § 724.02 Interviews with examiner must not compromise examination integrity. Attorney identity protected during prosecution to prevent external interference with examination process.

"But I just—I felt—"

"You felt the bond. You accepted representation. That part is complete and cannot be undone." A pause. "But neither of you will remember this clearly. The privilege protects the bond formation. You'll wake in your own bed with physical evidence—dirt, pine needles, scratches—but no conscious memory of what transpired here."

"That's not fair—"

"That's PROTECTION," Malachar said firmly. "There are forces that would destroy this bond if they knew it existed. The Council. The old guard. Those who benefit from keeping you separated."

37 CFR § 11.106(a) Confidentiality rule protects client even from client's own full conscious knowledge when necessary to preserve the representation itself.

The wolf—her attorney—pressed his head against her palm. A gesture of reassurance. Of promise.

I'll find you. When it's safe. When examination is complete. I'll find you.

"Sleep now," Malachar whispered. "Both of you. The download is complete. The bond is formed. The examination has begun. Everything else... you'll learn when you're ready."

Athelia's vision blurred. The examination chamber—the wolf, the black consuming eye, the Search Vault—all of it fading like a dream upon waking.

But one image remained, seared into her unconscious mind:

Golden eyes. Burning with absolute devotion.

And the certainty—bone-deep, unshakeable—that she was no longer alone.

Attorney-client bond established. Privilege protection activated. Both parties will experience selective amnesia. But the bond remains—permanent, protected, and waiting to be consciously recognized when examination concludes.

Darkness took her like falling into warm water.

The examination chamber faded. The wolf's golden eyes dimmed. Malachar's presence receded.

But the bond remained. Permanent. Protected. Waiting.

Examination continues. Chapter 3 shows what happens next—inside the barrier, during the soul stress test and consciousness transfer.

STATUTORY REFERENCE INDEX

Core Patent Statutes Encoded in Chapter 2:

- 35 U.S.C. § 101 - Patent-eligible subject matter (human USPTO rejected for wrong jurisdiction) - 35 U.S.C. § 102 - Novelty/Prior art (black consuming eye searches all existing knowledge) - 35 U.S.C. § 102(a) - Prior art = anything publicly available before filing date - 35 U.S.C. § 111(a) - Non-provisional application filing (Path Two - full examination) - 35 U.S.C. § 112(a) - Enablement

requirement (Malachar downloading = proving it works) - 35 U.S.C. § 120 - CIP claiming priority to parent (old matter gets parent date; new matter gets CIP date) - 35 U.S.C. § 122 - Publication of applications (announcement of claims) - 35 U.S.C. § 131 - Examiner authority during examination - 35 U.S.C. § 132 - Notice of rejection; applicant response required - 35 U.S.C. § 151 - Notice of Allowance (bond with wolf = indication of allowability; grant follows issue fee payment) - 37 CFR § 1.63 - Inventor's oath requirements (false oath = 23 bodies, barrier killed them) - 37 CFR § 1.77 - Claims must be clear and definite - 37 CFR § 1.111 - Reply by applicant to examiner's action - 37 CFR § 1.133 - Interviews with examiner

MPEP Sections:

- MPEP 600 - Parts, Form, and Content of Application - MPEP 608
- Completeness of Original Application - MPEP 700
- Examination of Applications - MPEP 713
- Examiner authority and discretion - MPEP 904
- Prior art search methodology (systematic, exhaustive, like the black eye)

Key Concepts:

- **Continuation-in-Part (CIP)** - Claims priority to parent for old matter disclosed in parent spec + adds new matter. Gets parent's date for old matter only (new matter = CIP filing date). Draft new claims that can cover old/new subject matter.
- **Prior Art Search** - Examiner must find all existing knowledge before granting patent (35 U.S.C. § 102)
- **Enablement** - Must prove invention works (35 U.S.C. § 112(a)). Malachar downloading = demonstration
- **Filing Date** - Moment application enters USPTO jurisdiction (barrier opening)
- **False Inventor Oath** - Claiming inventor status without entitlement = rejection/fraud (23 bodies)
- **Patent Office Jurisdiction** - Wrong office = rejection, not invalidity. Must file where office has authority
- **Examiner Authority** - 35 U.S.C. § 131 gives examiners power to demand information, reject claims
- **Confidentiality** - Applications kept secret during prosecution 35 U.S.C. § 122(a) (Athelia's amnesia)
- **Notice of Allowance** - Examiner approves application 35 U.S.C. § 151 (bond with wolf = indication of allowability; grant follows issue fee payment)
- **Prosecution History** - Everything during examination creates permanent

record (pine needles = physical evidence) - **Announcement of Claims** - Public disclosure required for examination to begin

[END CHAPTER TWO - Study Notes: This chapter encodes the USPTO filing and examination process. Print, highlight margin notes, connect story moments to patent procedures.]

FULL STATUTORY TEXT

Referenced Statutes - For Patent Bar Study

35 U.S.C. § 101 - Inventions Patentable

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 102 - Conditions for Patentability; Novelty

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or **otherwise available to the public before the effective filing date** of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application,

as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

(1) *Disclosures made 1 year or less before the effective filing date* shall not be prior art if the disclosure was made by the inventor or joint inventor.

35 U.S.C. § 103 - Conditions for Patentability; Non-Obvious Subject Matter

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that **the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art** to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 111 - Application for Patent

(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;
- (B) a drawing as prescribed by section 113; and
- (C) an oath or declaration as prescribed by section 115.

(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 provisional application shall include a specification as prescribed by section 112(a).**

(2) *CLAIM*.—A claim, as required by subsections (b) through (e) of section 112, **shall not be required** in a provisional application.

(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), 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.

35 U.S.C. § 112 - Specification

(a) *IN GENERAL*.—The specification shall contain a **written description of the invention**, and of the manner and process of **making and using it**, in such full, clear, concise, and exact terms as to **enable any person skilled in the art** to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

(b) *CONCLUSION*.—The specification shall conclude with one or more **claims particularly pointing out and distinctly claiming** the subject matter which the inventor or a joint inventor regards as the invention.

35 U.S.C. § 120 - Benefit of Earlier Filing Date in the United States

An application for patent for an invention **disclosed in the manner provided by section 112(a)** (other than the requirement to disclose

the best mode) in an application previously filed in the United States, or as provided by section 363 or 385, which names an inventor or joint inventor in the previously filed application shall have **the same effect, as to such invention, as though filed on the date of the prior application**, if filed **before the patenting or abandonment of or termination of proceedings on the first application** or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

35 U.S.C. § 121 - Divisional Applications

If two or more independent and distinct inventions are claimed in one application, the Director may **require the application to be restricted** to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120, it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, **shall not be used as a reference** either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

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.*—Subject to paragraph (2), each application for a patent shall be published, in English, **promptly after the expiration of a period of 18 months from the earliest filing date** for which a benefit is sought under this title.

35 U.S.C. § 131 - Examination of Application

The Director shall cause **an examination to be made of the application and the alleged new invention**; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. § 132 - Notice of Rejection; Reexamination

(a) Whenever, on examination, **any claim for a patent is rejected**, or any objection or requirement made, the Director shall **notify the applicant thereof, stating the reasons for such rejection**, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. **No amendment shall introduce new matter** into the disclosure of the invention.

35 U.S.C. § 151 - Issue of Patent

(a) *IN GENERAL.*—If it appears that an applicant is entitled to a patent under the law, a written **notice of allowance of the application** shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.

(b) EFFECT OF PAYMENT.—Upon payment of this sum **the patent may issue**, but if payment is not timely made, the application shall be regarded as abandoned.

35 U.S.C. § 154 - Contents and Term of Patent

(a) IN GENERAL.—

(1) **CONTENTS.**—Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of **the right to exclude others from making, using, offering for sale, or selling the invention** throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

(2) **TERM.**—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending **20 years from the date on which the application for the patent was filed in the United States** or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, 365(c), or 386(c), **from the date on which the earliest such application was filed.**

(3) **PRIORITY.**—Priority under section 119, 365(a), 365(b), 386(a), or 386(b) shall not be taken into account in determining the term of a patent.

35 U.S.C. § 161 - Patents for Plants

Whoever invents or discovers and asexually reproduces any **distinct and new variety of plant**, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant

or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, **except as otherwise provided**.

35 U.S.C. § 171 - Patents for Designs

(a) IN GENERAL.—Whoever invents any new, original and **ornamental design for an article of manufacture** may obtain a patent therefor, subject to the conditions and requirements of this title.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) TERM OF PATENT.—Patents for designs shall be granted for the term of **15 years from the date of grant**.

END FULL STATUTORY TEXT

Fractured Crown: Old Law - Patent Law Textbook Edition

Chapter 2 | For Patent Bar Study | © Marjorie McCubbins

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ABSTRACT

Athelia travels to Walnut Canyon National Monument and discovers the physical barrier between jurisdictions. She finds three paths carved into the cliff face, each representing a different type of patent application: Provisional (12-month placeholder), Non-Provisional (full examination), and Continuation (building on prior filing).

This chapter teaches the foundational filing requirements under 35 U.S.C. § 111, the strategic differences between provisional and non-provisional applications, continuation practice under § 120, and the critical importance of the filing date as the priority date for examination.

SUMMARY - PATENT LAW CONCEPTS TAUGHT

1. The Three Types of Patent Applications

The three paths carved into Walnut Canyon's cliff face represent the three primary ways to file with the USPTO:

- **Path One - Provisional Application (§ 111(b)):** 12-month placeholder that establishes priority date without formal examination. Lower cost, less formal requirements, but **MUST** be followed by non-provisional within 12 months or it abandons.
- **Path Two - Non-Provisional Application (§ 111(a)):** Full patent application that undergoes complete examination. Requires claims, abstract, specification with enablement, and filing fee. This is the "real" application that can result in a patent grant.
- **Path Three - Continuation Application (§ 120)):** New application that claims priority to an earlier-filed parent application. Allows applicant to add new

matter, pursue different claims, or continue prosecution after parent issues or abandons.

2. Filing Date as Priority Date

When Athelia touches the barrier, her filing date is established:

- **Priority date:** The filing date becomes the critical date for determining what counts as prior art under § 102
- **First-to-file system:** Under AIA (America Invents Act), the first applicant to FILE wins, not the first to invent
- **12-month grace period:** § 102(b)(1) provides limited grace period for inventor's own disclosures made within 12 months before filing
- **International priority:** § 119 allows claiming priority to foreign applications filed within 12 months (Paris Convention)

3. Application Requirements Under § 111(a)

To "touch the barrier" (file a non-provisional), you must provide:

- **Specification:** Written description enabling PHOSITA to make and use the invention (§ 112(a))
- **Claims:** Particularly pointing out and distinctly claiming the invention (§ 112(b))
- **Drawings:** If necessary to understand the invention (37 CFR § 1.81)
- **Abstract:** Brief summary of technical disclosure (37 CFR § 1.72)
- **Oath/Declaration:** Inventor's statement under 37 CFR § 1.63
- **Filing fee:** Required fees under § 41

4. Provisional vs. Non-Provisional Strategy

Why Athelia chose Path Two (Non-Provisional) directly:

- **Provisional advantages:** Lower cost (\$150-300), less formal, buys time to develop invention, test market

- **Provisional disadvantages:** Never examined, never becomes patent, must convert within 12 months, requires separate filing fee for conversion
- **Non-provisional advantages:** Immediately enters examination queue, can claim priority from provisional if filed within 12 months, single filing process
- **Strategic consideration:** If invention is ready and you want examination to start immediately, file non-provisional directly

5. Continuation Practice

Path Three represents advanced prosecution strategy:

- **Continuation (§ 120):** Same disclosure as parent, different claims. Used when examiner allowed some claims but rejected others - file continuation to pursue rejected subject matter
- **Continuation-in-Part (CIP):** Parent disclosure PLUS new matter. Used when you've improved the invention after filing. New matter gets new filing date; old matter retains parent priority.
- **Divisional (§ 121):** Required when examiner issues restriction requirement (election between independent/distinct inventions). Must file divisional to pursue non-elected invention.
- **Copendency requirement:** Continuation must be filed while parent is still pending (before issue or abandonment)

6. The Barrier as Jurisdictional Boundary

The barrier represents the legal boundary between public domain and patent protection:

- **Pre-filing:** Invention exists in public domain, no exclusive rights
- **Patent pending:** Application filed but not yet granted - "patent pending" status, no enforcement rights yet but puts public on notice

- **Post-grant:** Patent issues, exclusive rights attach, can enforce against infringers
- **Provisional pendency:** Provisional filing creates limited protection - priority date established but no examination occurs

7. The Download = Understanding Examination

When the barrier accepts Athelia, she receives complete examination protocols:

- **MPEP knowledge:** Manual of Patent Examining Procedure - the examiner's guidebook
- **Technology Center assignment:** Applications assigned to TC based on technology (TC 1600 = Biotech, TC 2100 = Computer, etc.)
- **Examination authority:** § 131 grants examiners authority to require information, reject claims, conduct interviews
- **Prosecution procedures:** Office Action → Response → Final Office Action → Appeal or Allowance

8. The Wolf King = Patent Applicant

Seven years of prosecution without a Guardian Queen examiner:

- **Applicant's burden:** Applicant must prove patentability - examiner's job is to test claims
- **Enablement requirement:** § 112(a) requires specification enable PHOSITA to make/use without undue experimentation
- **Waiting for examination:** Applications examined in order of filing (with some exceptions for accelerated examination)
- **Bond formation = Allowance:** When examiner determines all claims are patentable, Notice of Allowance issues

DISCUSSION QUESTIONS

1. Path Selection Strategy

Question: Athelia chose Path Two (Non-Provisional) directly rather than filing a provisional first. Under what circumstances would Path One (Provisional) be the better strategic choice?

Analysis Points:

- Invention still being developed - provisional buys 12 months
- Limited budget - provisional costs less initially
- Testing market interest before committing to full prosecution costs
- Competitive pressure - need to establish priority date immediately but claims not yet finalized
- Trade-off: Extra filing later, potential for inadequate disclosure if provisional too rushed

2. Continuation vs. CIP vs. Divisional

Question: The text mentions Athelia is filing a "continuation-in-part" because she has new matter (Bio-AI hybrid examination methods) to add to the ancient parent application. Why couldn't she file a standard continuation under § 120?

Analysis Points:

- Continuation requires same disclosure as parent (no new matter)
- CIP allows adding new matter but only new matter gets new filing date
- Strategic risk: New matter not entitled to parent's priority date
- Divisional is mandatory response to restriction requirement, not voluntary
- Athelia's situation: Ancient protocols (old matter) + modern AI methods (new matter) = CIP

3. Filing Date as Critical Prior Art Date

Question: Why does the filing date matter so much for prior art analysis under § 102? What happens to references published after the filing date?

Analysis Points:

- § 102(a)(1): Prior art = anything publicly available before filing date
- References after filing date are NOT prior art (can't anticipate or render obvious)
- First-to-file means earlier filer wins even if later filer invented first
- § 102(b)(1) grace period: Own disclosures within 12 months don't count as prior art
- Continuation claims parent's priority date for common subject matter

4. The Barrier's Test of Genetic Match

Question: Twenty-three others tried to continue the First Woman's application and failed because they lacked the genetic match. What real patent law concept does this encode?

Analysis Points:

- Inventorship requirement: Only actual inventors can file (§ 115)
- Joint inventorship: Each inventor must contribute to conception of at least one claim
- § 120 continuation right: Only applicant (or successors) can file continuation
- Correcting inventorship: Can add/delete inventors with USPTO approval if error (37 CFR § 1.48)
- Genetic match = inventorship chain/ownership chain must be valid

5. Amnesia and Patent Pending Status

Question: Athelia wakes with amnesia but physical evidence (pine needles, dirt, exhaustion). How does this parallel real patent application status immediately after filing?

Analysis Points:

- Patent pending = filed but not yet examined or granted
- No enforcement rights during pendency (can't sue infringers yet)
- But application establishes priority date (physical evidence)
- Public notice through "patent pending" marking
- Eventual examination will reveal whether claims are patentable (memories returning)

CASE STUDY: In re Giacomini

Federal Circuit, 2010

FACTS

Giacomini filed a provisional application on July 18, 2000. He then filed a non-provisional application on July 17, 2001 (within the 12-month window) claiming priority to the provisional under § 119(e). The non-provisional was eventually granted as U.S. Patent No. 6,905,814.

During an interference proceeding, the question arose: Could Giacomini's granted patent serve as prior art against another party's application? Specifically, was the patent "effectively filed" as of its July 18, 2000 provisional date or its July 17, 2001 non-provisional date?

This mattered because § 102(e) (pre-AIA) treated a patent as prior art as of its "effective filing date." If effective as of the provisional date, it would be prior art. If only effective as of the non-provisional date, it might not be.

ISSUE

Does a non-provisional application that claims priority to a provisional application under § 119(e) get the benefit of the provisional's filing date for purposes of serving as prior art under § 102(e)?

HOLDING

NO. The Federal Circuit held that provisional applications do NOT count for § 102(e) prior art purposes. Only the non-provisional filing date matters.

REASONING

The court examined the statutory language:

- **§ 119(e) provides priority benefits:** A non-provisional can claim the provisional's filing date for determining what counts as prior art AGAINST it (defensive use)
- **But § 102(e) uses different language:** A patent is prior art as of "the date on which the application for patent was filed" - and provisional applications are not "applications for patent" under § 111(a)
- **Asymmetry by design:** Provisionals give defensive priority (shield) but not offensive prior art (sword)
- **Policy rationale:** Provisionals have lower formal requirements, don't require claims, and are never examined - allowing them to serve as prior art would be unfair to other applicants

SIGNIFICANCE FOR CHAPTER 2

This case demonstrates the strategic limitation of Path One (Provisional Applications):

- **Defensive benefit only:** Your provisional protects YOU from later prior art, but doesn't create prior art against others

- **Priority gap:** Competitors filing during your 12-month provisional pendency won't be blocked by your provisional date
- **Why Athelia chose Path Two:** By filing non-provisional directly, she immediately establishes a date that counts for all purposes
- **Continuation practice:** Continuations filed under § 120 get FULL benefit of parent's filing date for prior art purposes (unlike provisionals)

CONNECTION TO THE NARRATIVE

Path One (Provisional) is described as a "placeholder" that "holds space but doesn't examine." This mirrors *Giacomini*'s holding - a provisional holds your priority date defensively but doesn't actively function as prior art. Only Path Two (Non-Provisional) creates a complete filing that "counts" for all purposes.

The barrier won't fully shatter for a provisional filing - it would only shimmer, holding open the possibility of crossing later. Full crossing requires Path Two.

ANALYSIS QUESTIONS

1. Why would Congress design an asymmetric system where provisionals provide defensive priority but not offensive prior art? (Hint: Think about the lower formal requirements for provisionals and the policy of notice to competitors)
2. Suppose Athelia filed a provisional on Day 1, and a competitor filed a non-provisional on Day 100. Athelia then converts her provisional to a non-provisional on Day 300. Who has priority? (Hint: Giacomini changes the analysis)
3. How does the post-AIA § 102 change this analysis? (Hint: AIA § 102(a)(2) uses "effectively filed" language that may give provisionals more weight)

COMPLETE STATUTORY TEXT

35 U.S.C. § 111 - Application

(a) IN GENERAL.—

(1)(A) Subject to the provisions of subsection (b), any person who invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may make an application for a patent therefor, subject to the conditions and requirements of this title.

(B) Notwithstanding subparagraph (A), any person who has been denied an application for a patent under section 2181(a) of title 10, United States Code, may make an application for a patent therefor in the United States Patent and Trademark Office.

(2)(A) An application for patent shall include—

- (i) a specification as prescribed by section 112;
- (ii) a drawing as prescribed by section 113; and
- (iii) an oath or declaration as prescribed by section 115.

(B) The application shall be accompanied by the fee required by law.

(b) PROVISIONAL APPLICATION.—

(1)(A) An application for patent filed under subsection (a) may be a provisional application for patent.

(B) 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.

(C) A provisional application shall include—

- (i) a specification as prescribed by section 112(a); and

(ii) a drawing as prescribed by section 113.

(D) The fees required under subsection (a)(2)(B) shall not be applicable to a provisional application.

(2) Subject to the provisions of paragraph (3) and to the payment of the fee set forth in section 41(a)(1)(G), a provisional application may be filed by the inventor or inventors.

(3) A provisional application for patent shall not be required to have a claim or an oath or declaration.

(4) The United States Patent and Trademark Office shall not examine a provisional application for patent.

(5) A provisional application for patent shall have the filing date determined in accordance with section 111(a)(2) and shall be regarded as abandoned after 12 months from the filing date.

(6) A provisional application may not be filed for a design invention.

(7) An application for patent filed under subsection (a) may claim the benefit of one or more provisional applications in the manner prescribed by section 119(e).

(8) If a provisional application has been filed and converted to a nonprovisional application in accordance with paragraph (3), the provisional application shall be regarded as abandoned 12 months after the filing date of the provisional application.

35 U.S.C. § 119 - Benefit of Earlier Filing Date; Right of Priority

(e) APPLICATIONS FOR PROVISIONAL PATENT APPLICATION.

(1) Subject to subsections (f) and (g), an application for patent for an invention disclosed in the manner provided by section

112(a) (other than the requirement to disclose the best mode) in a provisional application filed under section 111(b), by an inventor or inventors named in the provisional application, shall be entitled to the benefit of the filing date of the provisional application if the later-filed application—

(A) is filed not later than 12 months after the date on which the provisional application was filed;

(B) contains or is amended to contain a specific reference to the provisional application; and

(C) is for an invention disclosed in the provisional application.

(2) A provisional application filed under section 111(b) may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) has been paid.

35 U.S.C. § 120 - Benefit of Earlier Filing Date in the United States

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 or 385, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director

may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a) (7), to accept an unintentionally delayed submission of an amendment under this section.

35 U.S.C. § 121 - Divisional Applications

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120, it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

35 U.S.C. § 102 - Conditions for Patentability; Novelty (Relevant Provisions)

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the

claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c) based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

STATUTORY REFERENCE INDEX

Primary Statutes Taught in Chapter 2:

- 35 U.S.C. § 111(a) - Non-Provisional Application Requirements
- 35 U.S.C. § 111(b) - Provisional Application
- 35 U.S.C. § 119(e) - Benefit of Provisional Filing Date
- 35 U.S.C. § 120 - Benefit of Earlier Filing Date (Continuation)
- 35 U.S.C. § 121 - Divisional Applications
- 35 U.S.C. § 102(a) - Prior Art as of Effective Filing Date
- 35 U.S.C. § 102(b) - Grace Period Exceptions
- 35 U.S.C. § 102(d) - Effective Filing Date for Prior Art
- 35 U.S.C. § 112(a) - Enablement Requirement in Applications
- 37 CFR § 1.53 - Application Number and Filing Date
- 37 CFR § 1.63 - Oath or Declaration
- 37 CFR § 1.81 - Drawings