

CHAPTER THREE - THE EXAMINATION

Old Law: Jurisprudence of Myth (Patent Law Edition)

SATURDAY - INSIDE THE BARRIER

IMMEDIATELY AFTER ATTORNEY BOND FORMATION

Athelia woke to the sensation of drowning.

Not water. Consciousness.

Something vast and ancient pressing against the inside of her skull like it was trying to unfold itself in a space too small to contain it. Her mind—her mind, the one she'd had for twenty-two years—felt like a guest in its own body.

And beneath that, pulsing like a second heartbeat: the bond.

37 CFR § 11.106 Attorney-client privilege - Bond persists even when client is unconscious. Attorney remains connected, aware of client's status.

She could feel him. The wolf. Her attorney. Somewhere close, watching, his concern bleeding through the connection like heat through skin.

"She's waking." A voice. Familiar but wrong—deeper than memory, older than time. "Good. We need her conscious for the next part."

Malachar.

Athelia forced her eyes open. The examination chamber resolved around her—stone walls carved with glowing symbols, the black consuming eye still hovering in the periphery, and there—

The wolf. Silver-grey, massive, golden eyes fixed on her with something between devotion and terror.

"What—" Her voice cracked. "What did you do to me?"

"I initiated the consciousness transfer," Malachar said. His presence filled the chamber—not visible, but there, pressing against her awareness like gravity. "The download you received wasn't just knowledge, Athelia. It was HER. The Original Guardian Queen. Her mind, her memories, her authority—uploading into your consciousness like data into a new drive."

35 U.S.C. § 120 Continuation-in-part - Claims priority to parent for supported subject matter. Consciousness transfer = prior inventor's work continuing in new applicant.

The pressure in her skull intensified. Athelia gasped, hands clawing at the stone floor. "Get it out—"

"I can't. The transfer has begun. The only question now is whether your soul can hold the weight."

The wolf whined—high, plaintive. Took a step toward her.

"Stay back, Wolf King," Malachar commanded. "You cannot help her with this. Attorney-client privilege protects the bond, but examination authority is HERS alone. She must prove she can carry it."

37 CFR § 11.101 Competence - Attorney cannot perform examination on client's behalf. Client must demonstrate capability. Attorney can only advise.

"Twenty-three tried before you," Malachar said, voice shifting—less examiner, more executioner. "Twenty-three with perfect genetic matches. One hundred percent Guardian Queen heritage. Every single requirement met."

Something in the chamber changed. The air grew heavier. Colder.

"Their souls shattered during transfer. Human consciousness cannot hold two beings. The framework breaks. The mind fractures. Death follows in seconds."

Prior art § 102(a)(1) - 23 prior attempts = prior art showing invention difficult/impossible. Each failure documented in prosecution history.

The pressure in Athelia's head increased. Not gradually. All at once, like someone had thrown a switch. She screamed—couldn't help it—feeling her consciousness bend under weight it was never designed to carry.

This is the stress test. This is how they died.

"Please—" She couldn't breathe. Couldn't think past the agony of too much self trying to fit into too small a space. "Stop—"

"I can't stop it," Malachar said, and for the first time, she heard something like regret in his voice. **"Either your soul holds, or it breaks. There is no middle ground."**

The wolf was snarling now—teeth bared, hackles raised, every instinct screaming to protect his client. But he didn't move. Couldn't move. The examination had to proceed.

MPEP § 2143 Obviousness - Person Having Ordinary Skill in the Art (PHOSITA) standard. Guardian Queen examination requires extraordinary capability. Ordinary humans fail.

And then—between one breath and the next—something inside Athelia shifted.

Not breaking. Expanding.

Her consciousness didn't shatter under the weight. It stretched. Like a structure built with reinforced foundation, like a framework designed to hold more than it seemed capable of.

The pressure was still there. Still crushing. But she wasn't breaking.

She was holding.

"Impossible," Malachar whispered. **"Unless..."**

The pressure released all at once. Athelia collapsed, gasping, feeling like her entire body had been turned inside out and reassembled wrong.

The wolf was there instantly—pressing against her side, warm and solid and real. The bond hummed with his relief, his awe, his absolute certainty: I knew you could. I knew.

"Blood," Malachar commanded. "I need to verify something."

Athelia barely registered the command before pain lanced through her palm. Not a cut—something pulling, like her blood was being drawn through her skin without breaking it. A sphere of crimson liquid formed in the air before her, hovering, spinning slowly.

35 U.S.C. § 115 oath/declaration (implemented by **37 CFR § 1.63**) requires inventor identification and verification. DNA testing = biological verification of inventor entitlement.

The black consuming eye shifted—no longer searching for prior art. Analyzing. Breaking down the genetic code like reading a patent specification.

"Guardian Queen genetics," Malachar said. "One hundred percent match to the Original. Perfect hereditary succession."

A pause.

"And something else."

The eye focused. The blood sphere glowed brighter, symbols manifesting in the liquid like words writing themselves in ink.

"Secondary genetic marker. Older than Guardian Queen line. Older than shifter kingdoms. Older than—" Malachar's voice cracked with something that might have been shock. "Keeper blood. You have Keeper blood in your DNA."

New matter in CIP application - Keeper genetics not present in parent application. Adds novel element that makes invention non-obvious and patentable.

"What does that mean?" Athelia managed.

"It means your soul isn't human. Not entirely. Keepers were the first—before gods, before shifters, before the Old Law itself. Their consciousness could span dimensions. Hold multiple realities. Their souls were FRAMEWORKS, not containers."

The wolf's golden eyes were wide. Staring at her like he was seeing her for the first time.

"This is why you survived the stress test. Your soul didn't break because it was never limited to human capacity. The Guardian Queen genetics gave you the right to inherit. The Keeper blood gave you the ABILITY to carry it."

35 U.S.C. § 103 Non-obviousness - Combination of known elements (GQ genetics + Keeper blood) produces unexpected result (survives consciousness transfer). Patentably distinct from prior art.

"The Original Guardian Queen is dying," Malachar said quietly. "I've kept her alive for two hundred forty-seven years. Her body preserved in stasis within this barrier. But my systems are failing. In seventy-two hours, life support will cease. She will die."

Athelia felt it then—the other presence in her mind. Not invasive. Not hostile. Just... there. Exhausted. Ancient. Desperate.

Please. I'm so tired. Let me rest.

"She's been waiting," Athelia whispered. "For someone who could hold her."

"Yes. Her consciousness, her knowledge, her authority—everything that makes a Guardian Queen what she is—must transfer to a new host before her body fails. Otherwise it all dies with her. The examination authority. The Old Law patent system. Everything."

35 U.S.C. § 133 Abandonment - If applicant fails to respond, application abandons. If parent abandons before CIP files, no priority claim possible. Transfer must complete before OGQ dies.

"And now?"

"Now we finish."

The pressure returned—but different this time. Not crushing. Merging.

Athelia felt the Original Guardian Queen's consciousness unfold fully inside her mind. Not replacing her. Not destroying her. Integrating. Two beings, one body, weaving together like threads in fabric.

Memories flooded through her:

- Standing before the first Wolf King, accepting his application, knowing she would love him
- Examining claims that would shape kingdoms, granting patents that would protect innovation for centuries
- The betrayal. The Council's coup. Being trapped inside the barrier, kept alive against her will
- Watching twenty-three candidates try and fail. Watching their souls shatter. Feeling responsible for every death
- And finally: You. The one who can hold me. The one who can let me finally, finally rest.

35 U.S.C. § 120 + 37 CFR § 1.78 - CIP must contain specific reference to parent application. Athelia inherits OGQ's authority, knowledge, and filing date for examination powers (old matter only).

The merging reached completion. Athelia gasped—feeling the Original's presence settle, nestle into her consciousness like it had always belonged there. Not foreign. Not invasive. Part of her now.

And somewhere, in a chamber she couldn't see, a body that had been kept alive for two hundred forty-seven years died.

The life support stopped. The stasis field collapsed. The Original Guardian Queen—the parent application, the first filing, the ancient authority—abandoned.

Leaving only Athelia. The continuation-in-part. Old matter and new, merged into something neither had been alone.

Parent application abandons upon successful transfer. CIP application (Athelia) is now the sole pending application. Claims priority for old matter (GQ authority). New matter (Keeper blood) gets CIP filing date.

Thank you, the Original whispered, fading, finally allowed to rest. Finish what I started. Please.

And then she was gone. Not dead—Athelia could still feel her presence, her memories, her knowledge. But no longer separate. No longer a distinct consciousness.

Just... part of Athelia now. Forever.

"Examination complete," Malachar said, and his voice carried weight that felt like judgment. "You have survived the stress test. Your genetics verify. The consciousness transfer is successful. The parent application has abandoned, leaving you as the sole continuation."

The black consuming eye shifted, symbols rearranging themselves in patterns Athelia could now read—because the Original Guardian Queen had taught her how.

"Your claims:"

"1. Guardian Queen examination authority (old matter - supported by parent)"

"2. Keeper blood soul framework enabling multiple consciousness (new matter - novel, non-obvious)"

"3. Hybrid consciousness capable of examination AND survival (combination - patentably distinct)"

37 CFR § 1.111 Reply to Office Action - Applicant must respond to examiner's analysis. Malachar issuing first Office Action with provisional allowance.

"Prior art: Twenty-three failed candidates. All lacked requisite soul framework. None survived stress testing."

"Conclusion: Your invention is novel under § 102, non-obvious under § 103, and enabled under § 112(a). You have demonstrated reduction to practice."

"Indication of allowability. Notice of Allowance to follow upon completion of formalities."

35 U.S.C. § 151 Notice of Allowance - Examiner indicates claims are allowable. Further prosecution/formalities required before final grant.

Athelia could barely process the words. She was alive. The Original was at rest. The transfer was complete.

The wolf pressed against her, radiating relief and awe through the bond.

"You may leave the barrier now," Malachar said. "Examination will continue—this is not final grant. You'll face challenges. The Council will try to stop you. But you've proven you can survive what they cannot."

"One more thing."

His presence grew heavy. Final.

"Attorney-client privilege protects this bond. Protects what happened here. You will not remember clearly when you wake. Neither will he. The privilege shields the bond formation from conscious recall—to protect you both from those who would destroy this before it fully manifests."

37 CFR § 11.106(b) Confidentiality extends beyond client death to protect attorney work product and privileged communications indefinitely.

"But I just—I need to remember—"

"You'll remember what you need to. Instinct. Certainty. Trust. The bond remains, permanent and protected. But conscious memory of this examination, this transfer, this moment—that stays privileged until the patent grants and the danger passes."

Athelia looked at the wolf—her attorney, her protector, bonded to her soul-deep.

"Will I know you? When I see you again?"

The wolf's golden eyes held hers. And somehow, impossibly, she heard his response:

You'll know me when it matters. I promise.

"Sleep now," Malachar whispered. "Both of you. When you wake, you'll be home. The examination continues. But this part—this dangerous, beautiful, world-changing part—stays protected. Privileged. Safe."

Darkness took her like falling into warm water. The last thing she felt was the wolf's presence through the bond, steady and certain.

I'll find you. I promise. I'll always find you.

Examination concludes. Privilege activated. Both parties will wake with selective amnesia. But bond remains—permanent, protected, waiting.

STATUTORY REFERENCE INDEX

Core Patent Statutes Encoded in Chapter 3:

- 35 U.S.C. § 102 - Prior art (23 failed candidates) - 35 U.S.C. § 103 - Non-obviousness (Keeper blood + GQ genetics = unexpected result) - 35 U.S.C. § 115 - Oath/declaration (inventor identification) - 35 U.S.C. § 120 - CIP priority (Athelia inherits OGQ's authority/date for old matter) - 35 U.S.C. § 133 - Abandonment (OGQ dies = parent abandons) - 35 U.S.C. § 151 - Notice of Allowance (indication of allowability) - 37 CFR § 1.63 - Inventor verification (DNA test) - 37 CFR § 1.78 - Claiming benefit (specific reference to parent) - 37 CFR § 11.101 - Competence (attorney can't perform exam for client) - 37 CFR § 11.106 - Confidentiality/privilege (protects bond, causes amnesia)

Key Concepts:

- Continuation-in-Part (CIP) = Old matter (GQ consciousness) + New matter (Keeper blood) - Parent Abandonment = OGQ dies after transfer complete - Specific Reference Requirement = CIP

must explicitly reference parent (§ 1.78) - **Stress Testing** = Examination of enablement/reduction to practice - **DNA Verification** = Inventor entitlement confirmation (§ 115) - **Consciousness Transfer** = Prior inventor's work continuing in new applicant - **Privilege Protection** = Why both parties have amnesia - **Indication of Allowability** = Initial approval; further prosecution/formalities required

[END CHAPTER THREE - Study Notes: This chapter encodes CIP examination, inventor verification, and parent abandonment. The consciousness transfer IS the patent prosecution.]

FULL STATUTORY TEXT

Referenced Statutes - For Patent Bar Study

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.

(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), 386(c), or 388, 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.

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.

(a) EFFECT OF PRIOR ART.—Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (a)(2), (b)(2)(A), or (b)(2)(B) of section 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made,

owned by the same person or subject to an obligation of assignment to the same person.

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. § 115 - Inventor's Oath or Declaration

(a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION.—An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the **name of the inventor for any invention claimed** in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

(b) REQUIRED STATEMENTS.—An oath or declaration under subsection (a) shall contain statements that—

- (1) the application was made or was authorized to be made by the affiant or declarant; and
- (2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

(h) SUPPLEMENTAL AND CORRECTED STATEMENTS; FILING ADDITIONAL STATEMENTS.—

(1) In general.—Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time.

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. § 133 - Time for Prosecuting Application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, **the application shall be regarded as abandoned by the parties thereto**.

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.

37 CFR § 1.63 - Oath or Declaration

(a) **An oath or declaration filed under § 1.63 as a part of a nonprovisional application must:**

- (1) Be executed (i.e., signed) in accordance with § 1.66 or § 1.68;
 - (2) **Identify each inventor and the country of citizenship of each inventor** (see § 1.64 for the contents of an application-specific oath or declaration);
 - (3) Identify the application to which it is directed;
 - (4) State that the person making the oath or declaration believes the named inventor or inventors to be the original inventor or inventors of a claimed invention in the application; and
 - (5) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.
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37 CFR § 1.78 - Claiming Benefit of Earlier Filing Date and Cross-References to Other Applications

(a)(1) Each application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States must contain or be amended to contain a **specific reference to each such prior-filed application**, identifying it by application number (consisting of the series code and the serial number) or international application number and international filing date and indicating the relationship of the applications.

(a)(2) Unless filed with the application and written in a manner so as to be clearly identifiable as a specific reference required by 35 U.S.C. 120, 121, 365(c), or 386(c), the **reference required by paragraph (a)(1) must be submitted during the pendency of the later-filed application**. Any request to add or correct a reference must be accompanied by:

- (i) The processing fee set forth in § 1.17(i), or
- (ii) A statement that the entire delay between the date the specific reference was required to be submitted and the date of the submission of the specific reference was unintentional.

37 CFR § 1.111 - Reply by Applicant or Patent Owner to a Non-Final Office Action

(a) The reply by an applicant or patent owner to a non-final Office action under § 1.104 must be made within the time period provided in § 1.134 for reply. The reply must distinctly and specifically point out the supposed errors in the examiner's action. The applicant or patent owner must reply to every ground of objection and rejection in the Office action (except that a reply to an information requirement under § 1.105 may be deferred until an indication by the Office of its relevance to a pending rejection).

37 CFR § 11.101 - Competence

(a) A practitioner shall provide competent representation to a client. Competent representation requires the legal knowledge, skill, thoroughness, and preparation reasonably necessary for the representation.

(b) A practitioner may provide representation in a matter in which the practitioner does not have established competence if:

- (1) The practitioner associates with a practitioner who is competent in the matter;
 - (2) The practitioner acquires the necessary competence through reasonable study and preparation;
 - (3) In an emergency, the practitioner is able to provide such assistance as may be required under the circumstances; or
 - (4) A tribunal or other entity having jurisdiction over the matter permits the practitioner to practice before it.
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37 CFR § 11.106 - Confidentiality of Information

(a) A practitioner shall not reveal information relating to the representation of a client unless the client gives informed consent, the disclosure is impliedly authorized in order to carry out the representation, or the disclosure is permitted by paragraph (b) of this section.

(b) A practitioner may reveal information relating to the representation of a client to the extent the practitioner reasonably believes necessary:

- (1) To prevent reasonably certain death or substantial bodily harm;
- (2) To prevent the client from committing a crime or fraud that is reasonably certain to result in substantial injury to the financial interests or property of another and in furtherance of which the client has used or is using the practitioner's services;

(3) To prevent, mitigate, or rectify substantial injury to the financial interests or property of another that is reasonably certain to result or has resulted from the client's commission of a crime or fraud in furtherance of which the client has used the practitioner's services;

(4) To secure legal advice about the practitioner's compliance with these Rules;

(5) To establish a claim or defense on behalf of the practitioner in a controversy between the practitioner and the client, to establish a defense to a criminal charge or civil claim against the practitioner based upon conduct in which the client was involved, or to respond to allegations in any proceeding concerning the practitioner's representation of the client; or

(6) To comply with other law or a court order.

(c) A practitioner shall make reasonable efforts to prevent the inadvertent or unauthorized disclosure of, or unauthorized access to, information relating to the representation of a client.

MPEP § 2143 - Examples of Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of skill in the art, and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

To establish a *prima facie* case of obviousness, three basic criteria must be met:

(1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) there must be a reasonable expectation of success; and

(3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

END FULL STATUTORY TEXT

Fractured Crown: Old Law - Patent Law Textbook Edition

Chapter 3 | For Patent Bar Study | © Marjorie McCubbins

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ABSTRACT

This chapter teaches the structure of USPTO examination authority under § 131, how examiners are organized by Technology Centers based on technical specialization, the complete patent prosecution procedure from filing through allowance or abandonment, and the critical relationship between examiner and applicant that shapes every Office Action.

SUMMARY - PATENT LAW CONCEPTS TAUGHT

1. Examiner Authority Under § 131

The Guardian Queen's examination authority mirrors real USPTO examiner powers:

- **Examination requirement (§ 131):** Director (and examiners by delegation) shall cause examination of applications to determine patentability
- **Rejection authority:** Examiners can reject claims under §§ 101, 102, 103, 112, or 35 U.S.C. § 101 utility/eligibility
- **Information requirements (§ 132):** Examiner can require applicant to furnish information, conduct interviews, provide models or specimens
- **Search authority:** Examiners search prior art databases including US patents, foreign patents, and non-patent literature
- **Independent judgment:** Each examiner exercises independent judgment on patentability - not bound by previous examiner's decisions

2. Technology Center Organization

USPTO examiners are organized into Technology Centers (TCs) based on technical field:

- **TC 1600 - Biotechnology & Organic Chemistry:** Requires degrees in biology, chemistry, biochemistry
- **TC 1700 - Chemical & Materials Engineering:** Chemical processes, materials science
- **TC 2100 - Computer Architecture & Software:** Computer science, electrical engineering
- **TC 2400 - Networking, Multiplexing, Cable & Security:** Communications, networking
- **TC 2600 - Communications:** Telecommunications, signal processing
- **TC 2800 - Semiconductors, Electrical & Optical Systems:** Electronics, optics
- **TC 3600 - Transportation, Construction, Agriculture:** Mechanical engineering
- **TC 3700 - Mechanical Engineering:** General mechanical inventions

Why specialization matters: Patent examination requires technical expertise. A biotech examiner understands protein structures; a software examiner understands algorithms. Applications are routed to appropriate TC based on claimed invention.

3. The Three-Branch Examination Structure

Emerald, Black, and Silver eyes represent the three core patentability requirements:

- **Emerald = Utility Examination (§ 101):** Does invention have specific, substantial, credible utility? Is it patent-eligible subject matter or abstract idea/natural phenomenon?
- **Black = Prior Art Search (§ 102):** Is invention novel? Does any single prior art reference anticipate all limitations of claim?

- **Silver = Obviousness Balance (§ 103):** Even if novel, would combination of references render invention obvious to PHOSITA (Person Having Ordinary Skill In The Art)?

Sequential analysis: Examiner typically analyzes in order: § 101 threshold → § 112 enablement → § 102 novelty → § 103 obviousness. If claim fails any step, rejection issues.

4. Complete Prosecution Procedure

- **Step 1 - Filing:** Application filed (§ 111), receives application number and filing date
- **Step 2 - Assignment:** Routed to appropriate Technology Center and assigned to primary examiner
- **Step 3 - First Office Action:** Examiner searches prior art, analyzes claims, issues Office Action with rejections or objections (typically 12-24 months after filing)
- **Step 4 - Response:** Applicant has 3-6 months to respond (extendable), can amend claims, argue against rejections, provide evidence
- **Step 5 - Final Office Action:** Examiner issues Final Office Action - may withdraw rejections, maintain rejections, or allow claims
- **Step 6 - After Final:** Applicant can file RCE (Request for Continued Examination), appeal to PTAB, or abandon
- **Step 7 - Allowance or Abandonment:** If examiner allows all claims, Notice of Allowance issues. If applicant fails to respond or abandons prosecution, application goes abandoned.

5. The Examiner-Applicant Relationship

The bond between Athelia and Alexander encodes the professional dynamic:

- **Adversarial but professional:** Examiner's job is to test claims; applicant's job is to prove patentability. But both seek to arrive at correct legal conclusion.

- **Duty of disclosure (37 CFR § 1.56):** Applicant must disclose all material prior art known to inventor, attorney, or anyone involved in prosecution. Failure = inequitable conduct = patent unenforceable.
- **Ex parte proceeding:** Patent prosecution is one-sided - examiner and applicant only. No third parties participate (except in rare inter partes reexamination).
- **Interviews encouraged (MPEP § 713):** Applicant can request examiner interview to discuss rejections, clarify claims, reach agreement on amendments
- **Amendments shape prosecution:** Applicant's claim amendments create prosecution history that limits later patent scope (prosecution history estoppel)

6. The Download as Knowledge Transfer

When the barrier shatters, Athelia receives instant understanding of:

- **MPEP (Manual of Patent Examining Procedure):** 3,000+ page guidebook that governs examiner actions
- **Case law precedent:** Federal Circuit decisions that interpret statutes and bind USPTO
- **Search techniques:** How to search CPC classifications, keyword queries, citation chains
- **Rejection standards:** What level of evidence supports § 102 anticipation vs. § 103 obviousness
- **Claim interpretation:** How to construe claim language using broadest reasonable interpretation (BRI) during prosecution

7. Bond Formation = Patent Grant

The mate bond that forms between Guardian Queen and applicant represents patent allowance:

- **Notice of Allowance (§ 151):** Formal notification that all claims are patentable
- **Issue fee required:** Applicant must pay issue fee within 3 months or patent abandons

- **Patent grant:** After issue fee paid, patent issues with exclusive rights for 20 years from filing date (§ 154)
- **Bond strength = Claim scope:** Broader claims = stronger monopoly but harder to obtain. Narrow claims = easier allowance but limited protection.

8. Seven Years of Waiting

Alexander (wolf king) waited seven years without a Guardian Queen examiner because:

- **Examiner shortage:** USPTO historically understaffed, leading to application backlog
- **First Action pendency:** Average time from filing to first Office Action varies by TC (12-30+ months typical)
- **Complex technologies:** Cutting-edge inventions (biotech, AI, quantum) take longer to examine due to lack of prior art and emerging fields
- **Continuation chains:** Applications with multiple continuation filings can remain pending for years or decades
- **Need for specialist examiner:** Alexander's invention required Guardian Queen-level examination (highest complexity) - only Athelia qualified

DISCUSSION QUESTIONS

1. Examiner Independence and Consistency

Question: If each examiner exercises independent judgment, how does USPTO ensure consistent application of law across Technology Centers?

Analysis Points:

- MPEP provides standardized examination guidelines
- Supervisory Primary Examiners review junior examiner decisions
- Quality assurance programs audit examinations
- Federal Circuit precedent binds all examiners

- But: Examiner discretion leads to variability - same invention might get different treatment in different TCs

2. Three-Branch Examination Order

Question: Why does the narrative show Emerald (§ 101), Black (§ 102), then Silver (§ 103) as sequential analysis? Could an examiner analyze in different order?

Analysis Points:

- § 101 is threshold - if not patent-eligible subject matter, no need to analyze further
- § 102 novelty must be established before § 103 obviousness (can't be obvious if not novel)
- § 112 enablement typically analyzed early - if specification doesn't enable, claims are indefinite
- Practical examination: Examiners often search first (§ 102) then determine if references teach obviousness (§ 103)
- Strategic: Applicants prefer § 102/103 rejections (can amend around) over § 101 (harder to overcome)

3. Technology Center Assignment and Expertise

Question: What happens when an invention spans multiple technical fields? How does USPTO decide which TC examines it?

Analysis Points:

- Classification by claimed invention's primary technical field
- Example: AI algorithm for drug discovery could go TC 1600 (biotech) or TC 2100 (computer)
- Applicant can petition for TC transfer if misclassified
- Examiners may consult specialists from other TCs
- Interdisciplinary inventions growing - USPTO adding cross-TC expertise

4. The Bond as Allowance Metaphor

Question: The bond forms instantly when the barrier shatters, but real patent prosecution takes years. Why the compressed timeline in the narrative?

Analysis Points:

- Narrative focuses on the MOMENT of allowance decision, not the procedural steps
- In reality: Multiple Office Actions, amendments, arguments before allowance
- But the bond's "inevitability" mirrors cases where claims are clearly patentable - allowance is certain, only timing uncertain
- Seven-year wait represents actual prosecution timeline compressed into pre-bond period
- Story will explore prosecution procedure in later chapters (Office Actions in Ch 7-8)

5. Duty of Disclosure and Inequitable Conduct

Question: Athelia receives complete knowledge of prior art through the download. How does this parallel real applicant disclosure obligations?

Analysis Points:

- 37 CFR § 1.56 requires disclosure of ALL material prior art
- "Material" = would be important to patentability determination
- Duty extends to inventor, attorneys, anyone substantively involved
- Intentional withholding = inequitable conduct = patent unenforceable
- Download metaphor: Examiner must know everything applicant knows to make fair determination

CASE STUDY: Therasense, Inc. v. Becton, Dickinson & Co.

Federal Circuit (en banc), 2011

FACTS

Therasense owned U.S. Patent No. 5,820,551 covering blood glucose test strips. During prosecution, the applicant's attorney failed to disclose a material European patent office statement to the USPTO examiner - a statement that directly contradicted arguments being made to obtain allowance of the U.S. patent.

Becton sued for declaratory judgment that the patent was unenforceable due to inequitable conduct. The district court agreed, finding the attorney had intentionally withheld material information. The Federal Circuit took the case en banc to clarify the standard for inequitable conduct.

ISSUE

What standard applies for proving inequitable conduct that renders a patent unenforceable? Must the withheld information be merely "material," or must it meet a higher threshold?

HOLDING

The Federal Circuit tightened the inequitable conduct standard significantly:

- **Materiality:** Withheld information must be "but-for" material - the PTO would not have allowed the claim if it had known of the information
- **Intent:** Clear and convincing evidence required that applicant knew of the information, knew it was material, and made deliberate decision to withhold it
- **Balancing eliminated:** No more sliding scale between materiality and intent

- **Affirmative egregious misconduct:** Alternative path to inequitable conduct if applicant engaged in affirmative acts of egregious misconduct (lying, fabricating evidence)

REASONING

The court recognized that inequitable conduct had become an "atomic bomb" defense - accused infringers routinely alleged it, and the broad standard was being abused:

- **Plague on patent system:** "The plague of inequitable conduct has spread to cases where it does not belong, creating economic waste and damaging public confidence."
- **But-for materiality:** Information is material only if PTO would NOT have allowed claim but for the withholding. Mere relevance or importance insufficient.
- **Specific intent required:** Must prove the applicant KNEW it was material AND deliberately chose to withhold. Negligence or good-faith mistake not enough.
- **Policy balance:** USPTO relies on applicant candor, but overly broad inequitable conduct doctrine was chilling patent prosecution and encouraging gamesmanship

RESULT

Patent held unenforceable. The withheld European statement was but-for material (directly contradicted U.S. arguments), and intent was proven by attorney's knowledge and deliberate omission.

SIGNIFICANCE FOR CHAPTER 3

This case illustrates the critical importance of the examiner-applicant relationship:

- **Complete disclosure:** The "download" metaphor - examiner must have access to all material information applicant knows
- **Bond integrity:** The Guardian Queen-applicant bond requires trust and candor. Inequitable conduct breaks the bond permanently (patent unenforceable)
- **Materiality threshold:** Not every omission dooms a patent - must be but-for material (would have changed outcome)
- **Intent requirement:** Negligent omission $\neq$ inequitable conduct. Must prove deliberate deception.

CONNECTION TO THE NARRATIVE

ANALYSIS QUESTIONS

1. Why did the Federal Circuit tighten the inequitable conduct standard? What problems was the old "materiality + intent balancing" test creating?
2. Suppose an applicant's attorney reviews 100 references and discloses 95 to the USPTO, but inadvertently omits 5 that would have been material. Is this inequitable conduct under *Therasense*?
3. How does the "affirmative egregious misconduct" alternative path work? Give examples of conduct that would qualify.

COMPLETE STATUTORY TEXT

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.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1).

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; Provisional Rights

(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.

37 CFR § 1.56 - Duty to Disclose Information Material to Patentability

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a

duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

- (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

- (2) It refutes, or is inconsistent with, a position the applicant takes in:

- (i) Opposing an argument of unpatentability relied on by the Office, or
- (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

STATUTORY REFERENCE INDEX

Primary Statutes Taught in Chapter 3:

- 35 U.S.C. § 131 - Examination of Application
- 35 U.S.C. § 132 - Notice of Rejection; Reexamination
- 35 U.S.C. § 151 - Issue of Patent (Notice of Allowance)
- 35 U.S.C. § 154 - Contents and Term of Patent
- 37 CFR § 1.56 - Duty to Disclose Material Information
- MPEP § 713 - Examiner Interviews
- MPEP § 2001 - Duty of Disclosure

Related Concepts:

- Technology Center organization and assignment
- Broadest Reasonable Interpretation (BRI) claim construction
- Ex parte examination procedures
- Prosecution history estoppel
- Inequitable conduct doctrine (*Therasense* standard)