CHAPTER FIVE - THE COUNCIL REACTS

Old Law: Jurisprudence of Myth (Patent Law Edition)

Prince Alexander woke at dawn with his client's application burning behind his eyes.

Not literally. But the knowledge was there—everything she'd claimed at the barrier yesterday. Process claims. Method claims. The entire continuation-in-part application for Guardian Queen examination authority, downloaded into his consciousness the moment her hand touched his fur and the bond snapped into place.

> 35 U.S.C. § 120 - Benefit of earlier filing date for continuation-in-part applications. CIP includes new matter not in parent application. Attorney must analyze both old and new subject matter.

He reached for the bond without thinking—that thread connecting him to her across jurisdictional boundaries. She was still asleep. Dreaming. Safe.

Client. She's a client. This is attorney-client relationship. Professional.

The mantra wasn't working as well as it had yesterday.

Breakfast was a trial.

The council had arranged themselves around the high table with the careful precision of people preparing an intervention. Chancellor Maris at the far end, Lady Vesper to his left, High Priestess Selene—still wearing her dismissed harem silks like a pointed accusation—beside her.

Near the window, Severen stood silent. Sapphire eyes watching. Not part of the Council, but present nonetheless—as he always was when Old Law matters required witness.

"Your Highness." Maris inclined his head as Alexander took his seat. "We were concerned when you didn't join us for evening meal last night."

"I was occupied." Alexander reached for the pitcher of water—not wine, never wine again—and poured himself a glass.

"With?" Lady Vesper's smile was sharp enough to cut.

"Royal business."

Selene leaned forward, voice honey-sweet with practiced concern. "Your Highness, we only wish to ensure you're well. The harem's dismissal was... sudden. If you're experiencing difficulty with the curse—"

"I'm fine." Alexander bit into bread that tasted like dust. The bond hummed at the back of his mind—she was waking now, confused, alone in her human world with no memory of what she'd filed. No memory of him.

> Attorney-client privilege creates asymmetry. Attorney knows client's identity and claims. Client has no knowledge of attorney assignment until formal notice. 37 CFR § 11.106

"You dismissed ten years of carefully curated companions in a single afternoon," Maris said quietly. "That is not 'fine,' Your Highness. That is impulsive. Dangerous."

Alexander set down his bread. Met the Chancellor's eyes. "The harem was a conflict of interest. I have a client now. Their presence would compromise my ability to provide competent representation."

Silence.

Then Vesper laughed—bright and brittle. "A client? Your Highness, you haven't practiced law in a decade. You're hardly in a position to—"

"Someone filed yesterday." Alexander stood. "Guardian Queen examination. My bloodline's jurisdiction. The assignment is valid and I will honor it. If you'll excuse me, I have work to do."

"The bond has been approved."

Everyone turned. Severen stepped away from the window, sapphire eyes glowing in the morning light.

"Approved by whom?" Maris demanded.

"By me. Pre-filing counseling confirmed the applicant's eligibility. Attorney assignment validated Saturday morning. The bond activated upon first contact—as it was meant to." Severen's gaze swept the Council. "This is Old Law patent prosecution. Not palace politics. The bond supersedes Council authority."

"You overreach, Severen," Lady Vesper said coldly.

"I perform my function. As Wolf King performs his." Severen looked at Alexander. "You have seventy-two hours from filing. Sixty-eight remain. I suggest you use them wisely."

Alexander nodded once. Left before the Council could regroup.

Behind him, Severen's voice rang clear: "The examination has begun. Interference will be noted as obstruction of patent prosecution. I trust the Council understands the consequences."

He left before they could object. Behind him, he heard Maris's sharp intake of breath, Selene's murmured concern, the scrape of chairs as the council rose to confer.

Let them worry. He had seventy-two hours. Maybe less.

The Royal Library occupied the entire western wing of the palace. Alexander had spent years here during his training—before the curse, before the fog, when he'd still believed he'd grow into his father's legacy as Royal Wolf attorney.

He moved past the public reading rooms, past the council's sanitized legal texts, past the sections he'd memorized as a boy.

His feet carried him deeper into the stacks, toward the back of the library where the oldest law lived.

The Forbidden Section.

He'd been told since childhood not to enter. Those texts are not for you, young prince. Dangerous knowledge. Old law that predates modern doctrine. You'll study them when you're ready.

Except he'd never been deemed ready. And eventually he'd stopped asking.

Today, Alexander didn't care.

He expected wards. Magical barriers. Some kind of resistance. But when he reached the archway marked with ancient runes, nothing stopped him. The air shimmered—acknowledged him—and let him pass.

> Royal Wolf bloodline carries inherent authority to access restricted legal materials. Wards recognize attorney activation. Forbidden becomes accessible upon client assignment.

In the center of the room sat a single desk.

And on that desk: a journal.

Alexander's breath caught. The leather was worn but well-maintained, embossed with his family crest. He opened it with trembling fingers.

The first page bore his father's handwriting:

> "To my son—
>
> If you're reading this, you have finally awakened. A Guardian Queen has filed. You have seventy-two hours from her filing to complete your examination review and appear before her.
>
> This deadline is absolute. Every Guardian Queen who has filed without proper attorney examination has died on the third day. The magic consumes what it cannot process.

Your review is not optional. Your official appearance is not ceremonial. You are the only one who can save her.

The council will try to stop you. They have spent decades suppressing Guardian Queen filings, preventing attorney activation, maintaining control through ignorance.

Do not let them.

Use this journal. Document everything. Your work product is privileged—they cannot access it without violating sacred law.

Save her, Alexander. Save them both.

—Your father"

Alexander's hands shook. His father had known. Known the council would try to keep him sedated. Known a Guardian Queen would eventually file. Left him this—evidence, instruction, warning.

He turned to the first blank page, picked up the pen resting beside the journal, and began to write.

SECTION 1: PATENTABLE SUBJECT MATTER ANALYSIS

CLIENT APPLICATION: Guardian Queen Examination Authority

Filing Date: [Yesterday - barrier crossing]

Application Type: Continuation-in-Part (35 U.S.C. § 120)

Applicant: [Name unknown - privilege protects identity until formal meeting]

> Attorney-client confidentiality - 37 CFR § 11.106. Work product doctrine (materials prepared in anticipation of prosecution) is separate federal common law protection. Both shield attorney's strategic analysis.

THRESHOLD QUESTION: 35 U.S.C. § 101 - Is this patentable subject matter?

The America Invents Act (AIA) enacted in 2011 brought about significant changes to U.S. patent law, particularly regarding first-to-file system. However, § 101 remains foundational:

"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..."

He underlined process three times.

CLIENT'S CLAIMED INVENTION: A process for examining patent applications through Guardian Queen authority. The method includes:

1. Applicant filing continuation application at jurisdictional barrier

2. Examiner (Guardian Queen) reviewing claims for novelty, non-obviousness, utility

3. Prior art search conducted via examination protocols predating human USPTO

4. Notice of Allowance or Rejection issued based on examination findings

Process patents under § 101 protect methods of doing or making things. Guardian Queen examination = process for determining patentability. Meta-patent: process for granting patents.

ANALYSIS - Does this fall within statutory categories?

Process? YES. Series of steps. Guardian Queen examination follows prescribed methodology. Meets process definition under § 101.

Machine? ARGUABLE. Guardian Queen functions as examination apparatus. But primarily process-based.

Manufacture? NO. Not producing article.

Composition of matter? NO. Not chemical compound.

Alexander paused, pen hovering. The next part was critical.

JUDICIAL EXCEPTIONS - Is this an abstract idea?

Patent law excluded three categories from protection:

- Laws of nature ($E=mc^2$)
- Natural phenomena (newly discovered plant)
- Abstract ideas (mathematical algorithms)

Examination itself could be considered abstract. But Guardian Queen examination included physical steps—barrier crossing, claim announcement, prior art manifestation. Tangible elements integrated into process.

CONCLUSION: Application survives § 101 threshold. Patentable subject matter. Process with sufficient tangible steps to avoid abstract idea rejection.

Alexander leaned back, pen still in hand, and stared at what he'd written.

To him, the text was clear. Perfect. Legal analysis structured exactly as his father's precedent demanded—threshold questions, statutory categories, judicial exceptions, conclusion.

But the page itself...

The ink shimmered. Shifted. What he'd written appeared to rearrange itself into patterns that looked almost like—

"Binary code."

Alexander's head snapped up.

A man stood in the archway of the Forbidden Section. Ancient. That was the only word for him—not old, but ancient, like he'd been carved from stone that predated the palace itself. His eyes were dark as pitch, knowing, and fixed on Alexander's journal with an expression that might have been satisfaction.

"Lord Erikson." Alexander rose instinctively, though something in him bristled at the interruption. "I wasn't aware anyone else had access to this section."

"I've had access since before your grandfather was born." Erikson moved closer, slow and deliberate, like he had all the time in the world and knew Alexander didn't. He gestured to the journal. "May I?"

Alexander's hand tightened on the leather cover. "Attorney work product. Privileged."

"I'm not asking to read it." Erikson's smile was sharp. "Just to confirm what I already know."

He leaned over the desk, studied the pages Alexander had filled, and his smile widened into something that looked almost like pride.

"Ah. I see you have finally woken up."

> 37 CFR § 11.106(a) - Confidentiality of information. Communications and client information protected. Work product doctrine (federal common law) separately protects attorney's prepared materials. Both privileges shield strategic analysis.

Alexander's wolf stirred, hackles rising. "What do you mean?"

"The binary." Erikson straightened, meeting Alexander's eyes with the weight of centuries behind his gaze. "Your work product encodes itself. Protects itself. To anyone without proper authorization, what you've written will appear as machine code—unreadable, inaccessible. Attorney-client privilege made manifest."

Alexander looked down at the page. The text shimmered again, and for just a moment he could see what Erikson saw—strings of ones and zeros, digital encryption, impenetrable.

Then it resolved back into readable legal analysis.

"Your father's work." Erikson moved to one of the shelves, pulled free a volume so old the leather cracked when he opened it. "He

spent decades developing the encoding system. Knew the council would try to access Royal Wolf attorney work product. This ensures they can't."

"Why are you here?" Alexander asked.

Erikson closed the book with a soft thump. "To remind you of something your father's letter didn't make clear enough." His expression turned grave. "You have seventy-two hours from her filing to complete your examination review and appear before her officially. That deadline is not negotiable. It's not tradition. It's survival."

> USPTO examination timelines typically 6-18 months for first Office Action. But Guardian Queen examination operates under ancient protocols with absolute deadlines. Failure to meet deadline results in applicant death.

"She dies." Alexander's voice was flat. Not a question.

"Every Guardian Queen who has filed without proper attorney examination has died on the third day," Erikson confirmed. "The magic she's trying to patent—the examination authority itself—it's too powerful for a human body to contain without proper legal processing. Your review isn't optional, Your Highness. Your official appearance before her is critical to her survival."

The bond flared at the back of Alexander's mind—she was awake now, confused, going about her human life with no idea she had less than three days to live.

"She doesn't even know," Alexander said. "Doesn't remember filing. Doesn't know she has an attorney."

"No." Erikson's voice softened, just slightly. "The barrier wipes human memory as a protection mechanism. She won't remember until you appear before her officially and break the seal."

"And if I don't finish the review in time?"

"Then the magic consumes what it cannot process." Erikson met his eyes. "And you lose your mate before you ever get to meet her."

Alexander's hands clenched on the desk. "Client."

"Call it whatever helps you work faster." Erikson moved toward the archway, paused. "The council doesn't know about the seventy-two-hour deadline. They think they have time to manage you, reinstall their controls, prevent the examination from completing. Don't let them slow you down."

"Why are you helping me?"

Erikson glanced back, something ancient and tired in his expression. "Because I watched your father die trying to expose what the council had done to Guardian Queen filings. Because I've seen too many queens die waiting for attorneys the council kept sedated. And because..." He smiled, brief and sharp. "I've been waiting a very long time to see a Royal Wolf attorney actually practice law again."

He left without another word.

Alexander stared at the empty archway for a long moment. Then he looked down at his journal, at the legal analysis that would appear as binary code to anyone without authorization, and turned to the next section.

Seventy-two hours. He'd already used several. No time to waste.

> Time pressure in patent prosecution usually measured in months. Responses to Office Actions typically allow 3-6 months. But ancient examination protocols operate on compressed timelines where attorney must complete full review within 72 hours or applicant dies.

SECTION 2: JUDICIAL EXCEPTIONS - THRESHOLD ANALYSIS

Having established that the client's invention falls within statutory categories under § 101, Alexander moved to the next critical question: **Does this invention constitute a judicial exception?**

Supreme Court has carved out three categories of subject matter that cannot be patented even if they meet § 101 statutory language: Laws of Nature, Natural Phenomena, Abstract Ideas. Alice Corp. v. CLS Bank (2014), Mayo v. Prometheus (2012)

THE THREE JUDICIAL EXCEPTIONS:

1. **LAWS OF NATURE** - Naturally occurring principles or relationships. Cannot patent gravity, $E=mc^2$, or fundamental scientific truths. These exist independent of human invention.

2. **NATURAL PHENOMENA** - Products of nature. Newly discovered minerals, plants, animals in their natural state. Discovery ≠ Invention. Must show human intervention transforming natural product.

3. **ABSTRACT IDEAS** - Mental processes, mathematical algorithms, fundamental economic practices. Cannot patent basic human thought or calculation divorced from tangible application.

APPLICATION TO CLIENT'S CLAIMS:

Guardian Queen examination authority—is this abstract?

Abstract Idea Analysis: Examination of patent applications could be characterized as mental process—reviewing claims, comparing to prior art, making determination of patentability. Prima facie abstract.

BUT—Client's invention includes significant tangible elements:

- Physical barrier crossing (jurisdictional boundary manifestation)
- Barrier recognition protocols (authentication mechanism)
- Prior art manifestation (physical search results)
- Notice generation (formal written determination)

Alice/Mayo two-step test: (1) Does claim recite judicial exception? (2) If yes, does claim include additional elements that amount to "significantly more" than exception itself? Integration with tangible steps can save otherwise abstract invention.

SIGNIFICANTLY MORE ANALYSIS:

Client's process doesn't merely describe examination in abstract. Process integrates examination with physical barrier system, attorney activation protocols, and jurisdictional enforcement mechanisms that transform abstract concept into patent-eligible application.

Compare: Enfish LLC v. Microsoft Corp. (Fed. Cir. 2016) - Self-referential database held patent-eligible because improvements to computer functionality were not merely abstract data manipulation but tangible technical advancement.

Client's Guardian Queen system represents tangible advancement in examination methodology—not just "examination" in abstract, but specific technological/magical implementation with measurable improvements over prior art examination systems.

CONCLUSION: While examination contains abstract elements, integration with tangible barrier protocols and physical manifestation steps provides "significantly more" under Alice/Mayo framework. Survives judicial exception analysis.

SECTION 3: UTILITY REQUIREMENT - 35 U.S.C. § 101

Alexander paused, reached for water he'd brought from breakfast. The bond pulled at him—she was moving through her day, unaware. He pushed the sensation aside and continued.

PRACTICAL UTILITY STANDARD:

Patent law requires invention be "useful." But utility has specific meaning—not merely operational, but providing **specific, substantial, and credible utility.**

Utility requirement codified in § 101 "new and useful" language. Brenner v. Manson (1966) - Patent system encourages invention with real-world application, not just theoretical exercise. Must show specific benefit to public.

THREE-PART UTILITY TEST:

1. SPECIFIC UTILITY - Invention must provide particular, defined benefit. Cannot be vague or generalized. "Useful for something" insufficient. Must identify what it's useful for.

2. SUBSTANTIAL UTILITY - Benefit must be significant, not trivial. Real-world application that provides tangible advantage. Cannot patent invention whose only utility is research toward finding utility.

3. CREDIBLE UTILITY - Assertion of utility must be believable to person skilled in art. Cannot claim perpetual motion machine or other physically impossible results without extraordinary proof.

CLIENT'S CLAIMED UTILITY:

Guardian Queen examination process provides:

Specific: Examination of patent applications to determine whether claims meet novelty, non-obviousness, and utility requirements. Provides Notice of Allowance or Rejection based on prior art search and legal analysis. Highly specific function.

Substantial: Enables patent protection for inventions that would otherwise remain unexamined under modern USPTO protocols. Provides access to ancient examination standards predating human patent systems. Substantial benefit to applicants seeking protection under Old Law.

Credible: System has operated for thousands of years. Multiple documented examinations. Physical barrier exists and can be tested. Attorney activation and download are observable, reproducible phenomena. Credibility established through historical record and current manifestation.

OPERABILITY REQUIREMENT:

> Operability = invention functions as claimed. If invention cannot work as described, fails utility requirement. But demonstration of single successful instance sufficient to establish operability. Client's barrier crossing yesterday = proof system works.

CONCLUSION: Client's invention meets all three prongs of utility requirement. Specific, substantial, credible utility established. Operability demonstrated through successful filing. § 101 utility satisfied.

SECTION 4: OVERCOMING UTILITY REJECTIONS

This section felt almost prophetic. Alexander's hand moved across the page as if his father were guiding him—documenting not just what the law required, but how to defend it when challenged.

IF EXAMINER ISSUES UTILITY REJECTION:

USPTO may reject claims for lack of utility under § 101. Burden initially on examiner to establish prima facie case that utility lacking. But once examiner meets burden, applicant must respond with evidence.

> In re Brana (Fed. Cir. 1995) - Examiner must provide sound scientific reasoning to support utility rejection. Cannot rely on speculation. But once examiner establishes reasonable doubt, applicant must provide proof.

THREE METHODS TO OVERCOME UTILITY REJECTION:

1. **EXPERIMENTAL DATA** - Provide test results, measurements, documentation showing invention works as claimed. Scientific evidence demonstrating specific, substantial, credible utility. Most persuasive approach.

2. **DECLARATIONS/AFFIDAVITS** - 37 CFR § 1.132 allows applicant to submit sworn statements from experts establishing utility. Declaration from person skilled in art

explaining why invention provides claimed benefit. Must be specific, detailed, credible.

3. ARGUMENTS - Attorney can argue examiner's rejection lacks scientific basis, relies on incorrect assumptions, or mischaracterizes claimed invention. Show examiner failed to meet burden of establishing prima facie case. Point to evidence already in record demonstrating utility.

FOR CLIENT'S APPLICATION:

If utility challenged, response would include:

Experimental Data: Client's successful barrier crossing yesterday. Attorney activation and download. Physical manifestation of prior art. Observable, measurable, reproducible phenomena demonstrating system operability.

Declarations: Attorney's own sworn statement regarding download experience, knowledge transfer, and current examination proceedings. Declaration from Malachar (barrier guardian) confirming client's filing and authentication. Historical records from previous Guardian Queen examinations.

Arguments: Thousand years of documented examination history establishes credible utility. System currently operational—client is undergoing examination right now. Rejection would require examiner to ignore physical evidence and established precedent.

37 CFR § 1.132 - Affidavit or declaration to overcome rejection. Applicant may submit evidence not originally in application to establish patentability. Common tool when examiner questions utility, enablement, or written description.

CONCLUSION: Multiple avenues available to overcome utility rejection if raised. Strong evidentiary record supports claimed utility. Likelihood of successful utility challenge: low.

Alexander's hand cramped. He'd been writing for hours. The library had grown darker—afternoon fading toward evening. How much time had passed?

He reached for the bond. She was... tired. Confused. Something felt wrong to her but she couldn't identify what.

Because you're dying, his wolf supplied grimly. Keep working.

Three more sections. Then the barrier. Then her.

He turned the page.

SECTION 5: NOVELTY - 35 U.S.C. § 102

THE AMERICA INVENTS ACT (AIA) - PARADIGM SHIFT

In 2011, the United States overhauled its patent system with the America Invents Act. Most significant change: abandonment of "first-to-invent" system in favor of "first-inventor-to-file."

> Pre-AIA (before March 16, 2013): Patent granted to first person who invented, even if another filed first. Post-AIA: Patent granted to whoever files first, regardless of invention date. Massive strategic shift favoring prompt filing.

NOVELTY REQUIREMENT:

35 U.S.C. § 102 establishes that invention must be **new**. If claimed invention exists in prior art, cannot patent it. Simple concept, complex application.

WHAT QUALIFIES AS PRIOR ART UNDER AIA:

> § 102(a)(1) - Patent, printed publication, public use, on sale, or otherwise available to public **anywhere in the world** before effective filing date.
>
> § 102(a)(2) - Application filed by another and eventually published/patented, if that application's effective filing date was before applicant's filing date.

Key phrase: **"anywhere in the world."** Pre-AIA limited some prior art to United States. Post-AIA: global prior art applies. Publication in any country, in any language, defeats novelty.

> AIA § 102(a)(1) expanded geographic scope of prior art. Russian technical paper from 1987? Prior art. Japanese patent from 1995? Prior art. Indian conference presentation from 2003? Prior art. All relevant if public before filing date.

APPLICATION TO CLIENT'S CLAIMS:

Guardian Queen examination system—has this been disclosed in prior art?

Alexander's downloaded knowledge included centuries of Guardian Queen filings. But published prior art? That was different question.

PRIOR ART SEARCH RESULTS:

- No USPTO patents disclosing Guardian Queen examination process
- No printed publications in human patent literature describing system
- Mythological texts reference examination barriers but lack enabling disclosure
- Ancient texts known only to magical beings, not "available to public"
- Client's filing may be first public disclosure of complete system

CRITICAL DISTINCTION:

System has existed for thousands of years. But existence ≠ public disclosure. Prior art must be **accessible** to public. Secret processes, restricted texts, magical knowledge available only to initiated—these do not constitute prior art under § 102.

Compare: Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co. (2d Cir. 1946) - Secret commercial use does not

constitute prior art. Invention must be publicly accessible to defeat novelty.

> Public accessibility test: Could person interested in subject matter locate reference through reasonable diligence? If restricted to select group, not publicly accessible. Magic-only texts fail public accessibility test.

CONCLUSION: Despite ancient origins, Guardian Queen examination system lacks publicly accessible prior art disclosure. Client's application may constitute first enabling disclosure. Novelty requirement under § 102(a)(1) satisfied.

Two more sections.

The bond pulsed. She was feeling worse. Headache building. Body aching.

Forty-eight hours since filing, his wolf calculated. Twenty-four left. Work faster.

SECTION 6: ANTICIPATION AND THE IDENTITY RULE

ANTICIPATION - ULTIMATE NOVELTY CHALLENGE:

If single prior art reference discloses every element of claimed invention, claim is "anticipated" under § 102. Complete bar to patentability. One reference containing everything = death to patent application.

> Anticipation requires identity between claimed invention and prior art. Every element must be present. If even one claim element missing from reference, anticipation fails. Applicant can amend claims to distinguish from prior art.

ELEMENTS REQUIRED FOR ANTICIPATION:

1. **SINGLE REFERENCE** - Cannot combine multiple references to show anticipation. That's obviousness (§ 103), different analysis. Anticipation requires one reference containing everything.

2. **EVERY CLAIM ELEMENT** - Prior art must disclose each and every limitation recited in claim. Even if 99% disclosed, missing 1% defeats anticipation.

3. **ARRANGED AS CLAIMED** - Elements must be related to each other in same way as claim recites. Cannot pick elements from different parts of reference and rearrange them.

4. **ENABLING DISCLOSURE** - Reference must enable person skilled in art to make/use invention without undue experimentation. Mere mention insufficient. Must provide enough detail for reproduction.

ANALYSIS OF CLIENT'S CLAIMS:

Does any single reference anticipate Guardian Queen examination process?

He found nothing.

Closest prior art: Ancient Greek text describing barrier examination for "Queens of Patent Authority." But critical differences:

• Greek system required applicant to remain at barrier for full examination (client's system allows return to human world)

• Greek system examination took years (client's operates on compressed timeline)

• Greek text lacks enabling disclosure—describes results, not methodology

Similar? Yes. Identical? No.

Anticipation requires identity. Close is not enough.

In re Bond (Fed. Cir. 1990) - Anticipation is finding of fact requiring strict identity between claim and prior art. Substantial similarity insufficient. Every element must be present exactly as claimed.

ADDITIONAL PRIOR ART REVIEWED:

- Norse texts - Describe examination by Valkyrie judges, but completely different procedural mechanism

- Celtic records - Reference "Queen's Law" but focus on trademark, not patent examination

- Puebloan petroglyphs - Show barrier symbols but lack written description enabling reproduction

- Egyptian papyrus - Mentions examination authority but describes religious, not legal process

None contain every element arranged as client claimed.

CONCLUSION: No single reference anticipates client's claimed invention. While similar systems exist in historical record, none disclose identical process with enabling detail. Client's combination of elements and specific methodology represent novel advancement over prior art. § 102 anticipation challenge: defeated.

Alexander set down his pen and stared at the completed analysis.

Six sections. Complete examination review. Every statutory requirement analyzed. Every potential rejection addressed. The work product that would save her life—if he could deliver it in time.

He checked the bond. She was lying down now. Too weak to continue her day. Her human mind couldn't understand why she felt like she was dying.

Because she was.

Alexander stood, journal clutched in his hand. Outside the Forbidden Section, evening had fallen. He'd worked through the entire day. How many hours left?

Not enough to hesitate.

He left the library at a run.

THE BARRIER - TIMELY RESPONSE

The palace corridors blurred past him. Alexander didn't stop to explain, didn't acknowledge the servants who pressed themselves against walls as their prince sprinted by. The journal burned in his hand—six sections of complete examination review, encoded in binary for anyone without authorization, readable only to him and the barrier system itself.

And her. When she woke. When he saved her.

If he saved her.

The bond was weak now. Flickering. She'd stopped moving. Lying in her bed in the human world, body shutting down as the magic consumed what it couldn't process.

> Timely response to Office Action critical. Miss deadline = application abandoned. In Guardian Queen examination, miss deadline = applicant dies. Time management not just strategic—it's life or death.

Alexander burst through the palace gates. The barrier shimmered at the edge of the royal grounds—jurisdictional boundary between magical and human worlds, between Old Law and modern patent systems.

Between him and his dying client.

The barrier recognized him before he reached it. Magic rippled across its surface, ancient runes glowing as Royal Wolf attorney approached with completed work product.

Malachar materialized from the barrier itself.

"Attorney." Malachar's voice resonated like stone grinding on stone. "You come with response to Office Action?"

"I come with complete examination review." Alexander held up the journal. "Six sections. Every statutory requirement analyzed. Patentable subject matter under § 101—established. Novelty

under § 102—established. She survives all challenges. The application is allowable."

> Attorney Response to Office Action must address every rejection, provide arguments and/or evidence, demonstrate claims meet all statutory requirements. 37 CFR § 1.111

Malachar's black eyes fixed on the journal. "May I examine?"

"It's privileged work product." Alexander's grip tightened. "But the barrier has authorization to verify completion."

He held out the journal.

Malachar touched it—one massive finger against leather—and the pages flipped open on their own. Binary code shimmered across every surface. To anyone without proper authorization, Alexander's analysis would appear as incomprehensible streams of ones and zeros.

But Malachar could read the encoding beneath. Ancient magic recognizing Royal Wolf attorney work product, verifying completion, confirming every statutory requirement had been addressed.

The barrier guardian's expression didn't change, but something in the air shifted. Approval. Acceptance.

"Response timely filed," Malachar intoned. "Examination review complete within seventy-two-hour deadline. Work product verified. Applicant status: CRITICAL. Attorney appearance required immediately."

> Timely response accepted by USPTO. Examination continues. If application meets all requirements, examiner issues Notice of Allowance. But first, any outstanding issues must be resolved.

"Where is she?" Alexander demanded.

"Examination chamber. Human world. Held in stasis pending attorney verification." Malachar gestured, and the barrier rippled. "You have authorization to cross. Retrieve your client. Complete the examination."

"She's dying."

"She is holding," Malachar corrected. "Barely. The chamber preserves what remains. But without attorney appearance to finalize examination..." He didn't need to finish the sentence.

Without Alexander crossing over and completing the process, the magic would consume her anyway.

"Let me through."

The barrier opened.

Alexander stepped through the shimmering wall between worlds and felt reality twist around him. Magic to mundane. Old Law to modern systems. The transition was jarring—his wolf recoiled from the sudden absence of magic, the flatness of human existence.

But the bond pulled him forward.

There.

> Attorney crossing jurisdictional boundaries to meet client. In-person appearance sometimes required for critical examination matters. 37 CFR § 11.106(a) - attorney must provide competent representation regardless of logistical challenges.

The examination chamber manifested as a space between spaces—not quite in her world, not quite in his, but suspended in the jurisdictional boundary where Old Law and modern patent systems overlapped.

She lay in the center.

Alexander's breath stopped.

She was small. That was his first thought. Human-sized, human-fragile, wrapped in magic that was slowly killing her. Her skin was too pale, lips tinged blue, breathing shallow. The Guardian Queen power she'd tried to patent was eating her alive from the inside.

But she was beautiful.

"I'm here." Alexander dropped to his knees beside her, journal still clutched in one hand. "I'm your attorney. The examination is complete. You're allowed."

Her eyes fluttered open—barely. Brown. Human. Confused.

"Who...?"

"Your attorney," he repeated. "You filed forty-eight hours ago. Guardian Queen examination. I've completed the review. The application is allowable. You just need to wake up."

> Notice of Allowance - USPTO determination that application meets all statutory requirements. Applicant must pay issue fee within 3 months for patent to grant. But first, applicant must be physically capable of accepting the notice.

He touched her hand—client contact, attorney-client privilege solidifying—and the bond roared to life.

She gasped. Color flooded back into her cheeks. The magic that had been consuming her suddenly had somewhere to go—into the bond, into him, processed through Royal Wolf attorney protocols that transformed lethal power into protected intellectual property.

Her application. Her patent. Her survival.

All contingent on him getting her home.

"Where do you live?" Alexander asked.

She stared at him with dawning awareness. "You're... real."

"Where do you live?" he repeated, more gently.

She gave him an address. Flagstaff. Twenty minutes from the barrier if he drove fast.

Alexander pulled her into his arms—careful, gentle, protective—and stood. She weighed almost nothing. Too light. Days without eating, magic consuming her resources, body shutting down system by system.

But she was alive. Breathing. Aware.

He carried her through the chamber, through the barrier, into the human world that felt wrong and flat and utterly mundane. Found her car in the parking lot where she'd left it Saturday morning before hiking to Walnut Canyon.

Drove faster than he should have through Flagstaff streets, following bond-memory of where she lived.

She drifted in and out of consciousness. Every time she woke, her eyes found him—confused, uncertain, but safe. Trusting.

"Attorney-client privilege," she mumbled at one point.

Alexander almost smiled. "Yes. Privilege."

"Can't tell anyone..."

"Can't tell anyone," he confirmed. "Your work product is protected. Your identity is protected. Everything between us is privileged."

She relaxed.

> 37 CFR § 11.106(a) - Confidentiality of information relating to representation of client. Attorney shall not reveal information unless client gives informed consent. Privilege protects all communications, documents, strategy, identity itself if necessary.

Her apartment was small. Second floor. He carried her up the stairs, used her keys to unlock the door, found her bedroom by following the bond-sense of where she felt safest.

Her bed was unmade. Sheets tangled. She'd left Saturday morning for her hike and never came back to sleep in it.

Alexander laid her down carefully, pulled the blankets over her. She was already asleep—real sleep now, not magical stasis. Her body finally able to rest without fighting the examination magic.

He should leave. She was safe. The timely response had been filed. The examination was complete pending her formal acceptance of the Notice of Allowance.

But his wolf refused to move.

Client, he reminded himself. She's a client. This is professional duty.

Alexander sank into the chair beside her bed, journal still in his hand, and watched her breathe.

She lived.

For now, that was enough.

> Attorney duty extends beyond filing deadlines. Must ensure client survives prosecution process. In Guardian Queen examination, this duty is literal. Competent representation = kept client alive.

— END CHAPTER FIVE —

Next: Chapter Six - The Awakening

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.

---

35 U.S.C. § 120 - Benefit of Earlier Filing Date

An application for patent for an invention disclosed in an application previously filed in the United States shall have **the same effect as though filed on the date of the prior application**, if filed before the patenting or abandonment of the first application and if it contains a specific reference to the earlier filed application.

---

37 CFR § 11.106 - Confidentiality of Information

(a) GENERAL RULE.—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 paragraph (b) of this section permits such disclosure.

(b) PERMITTED DISCLOSURE.—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;

(4) To secure legal advice about the practitioner's compliance with USPTO Rules of Professional Conduct;

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

NOTE ON WORK PRODUCT DOCTRINE: While § 11.106 addresses **confidentiality** of client information, the **attorney work product doctrine** is a separate protection arising from federal common law (*Hickman v. Taylor,* 329 U.S. 495 (1947)). Work product protects materials prepared by counsel in anticipation of litigation or prosecution. The Federal Circuit recognizes **patent agent privilege** in appropriate circumstances (*In re Queen's University at Kingston*, 820 F. 3d 1287 (Fed. Cir. 2016)).

---

35 U.S.C. § 112(a) - Specification

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.

Three requirements in § 112(a):

1. **Written Description:** Must describe what you invented with enough detail that skilled artisan can recognize you possessed the invention at filing date. *Ariad Pharm. v. Eli Lilly* (Fed. Cir. 2010 en banc): Spec must demonstrate **possession** of claimed invention.

2. **Enablement:** Must teach how to make and use invention without undue experimentation. *Amgen Inc. v. Sanofi* (U.S. 2023): Must enable **full scope** of claims, especially for functional genus claims. See *In re Wands* (Fed. Cir. 1988) eight-factor test (detailed in Chapter 8).

3. **Best Mode:** Must disclose the best way of carrying out invention known to inventor at filing (not examined post-AIA).

---

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

(a) GENERAL.—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).

(b) ARGUMENTS.—Any arguments or authorities must be set forth under a separate heading. The arguments must be responsive to every ground of rejection and must state why the examiner erred.

(c) AMENDMENTS.—Any amendments to the specification, claims, or drawings must be made in accordance with § 1.121.

Note: Attorney in Chapter 5 completed comprehensive examination review addressing all statutory requirements—this is the timely response required by § 1.111.

---

37 CFR § 1.132 - Affidavit or Declaration to Overcome Rejection

When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate **affidavit or declaration** to traverse the grounds of rejection.

COMMON USES:

- **Utility rejections:** Declaration from inventor or expert establishing specific, substantial, credible utility
- **Enablement rejections:** Affidavit showing skilled artisan could make/use invention without undue experimentation

- **Unexpected results:** Declaration providing experimental data showing invention achieves surprising advantages over prior art
- **Operability:** Declaration demonstrating invention actually works as claimed

Declaration must be specific, factual, and credible. General conclusory statements insufficient. Must provide technical detail supporting patentability arguments.

KEY CASE LAW - JUDICIAL PRECEDENT

Supreme Court & Federal Circuit Decisions Interpreting Patent Statutes

---

Alice Corp. v. CLS Bank International, 573 U.S. 208 (2014)

ISSUE: Whether patent claims directed to computer-implemented method for mitigating settlement risk constitute patent-eligible subject matter under 35 U.S.C. § 101.

HOLDING: Claims directed to abstract idea of intermediated settlement are not patent-eligible merely because implemented on generic computer. Abstract ideas remain unpatentable even when applied using conventional technology.

TWO-STEP TEST (Alice/Mayo Framework):

Step 1: Does claim recite judicial exception (law of nature, natural phenomenon, or abstract idea)?

Step 2: If yes, does claim include additional elements that amount to "significantly more" than the exception itself?

"Significantly more" requires integration of abstract idea with inventive concept that transforms nature of claim. Mere recitation of generic computer implementation insufficient.

Application in Chapter 5: Alexander analyzes whether Guardian Queen examination constitutes abstract idea. Survives Alice because integrated with tangible barrier protocols, physical manifestation, and jurisdictional enforcement mechanisms—providing "significantly more" than mere examination concept.

Mayo Collaborative Services v. Prometheus Laboratories, 566 U.S. 66 (2012)

ISSUE: Whether patent claims directing physicians to measure metabolite levels and adjust drug dosage accordingly constitute patent-eligible process under § 101.

HOLDING: Claims directed to natural correlation between metabolite levels and optimal drug dosage constitute unpatentable law of nature. Adding conventional steps of "administering, determining, and adjusting" insufficient to transform law of nature into patent-eligible application.

KEY PRINCIPLE: Cannot patent natural phenomenon by simply adding instruction to "apply it." Must demonstrate inventive concept beyond recognition of naturally occurring relationship.

Claims must do more than recite law of nature and instruct skilled artisan to "use it." Integration with specific technological application required.

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327 (Fed. Cir. 2016)

ISSUE: Whether patent claims directed to self-referential database structure constitute patent-eligible subject matter or abstract idea.

HOLDING: Claims directed to specific improvement in computer functionality are not abstract. Self-referential table design providing faster search, smaller memory footprint, and more flexible data structure constitutes patent-eligible technological advancement.

DISTINCTION FROM ALICE: Claims focused on improving computer technology itself (not just using computer as tool to perform abstract process). Improvements to computer functionality can survive § 101 even when implemented in software.

This case provides path through Alice/Mayo framework: show claimed invention improves underlying technology rather than merely applying conventional technology to abstract idea.

Brenner v. Manson, 383 U.S. 519 (1966)

ISSUE: Whether chemical process patent meets utility requirement when applicant shows only that process produces compound, without demonstrating use for that compound.

HOLDING: Patent applicant must demonstrate **specific and substantial utility**—not merely that invention is capable of use, but that it provides concrete benefit sufficient to justify patent grant. Process producing compound with no known use lacks utility under § 101.

PRACTICAL UTILITY STANDARD: "Unless and until a process is refined and developed to this point—where specific benefit exists in currently available form—there is insufficient justification for permitting an applicant to engross what may prove to be broad sweep of patent protection."

Utility must be **specific** (identified particular use), **substantial** (real-world significant benefit), and **credible** (believable to skilled artisan).

In re Brana, 51 F.3d 1560 (Fed. Cir. 1995)

ISSUE: What level of evidence required to establish utility for pharmaceutical compounds when examiner challenges credibility of asserted utility.

HOLDING: Examiner bears initial burden of establishing reasonable doubt about utility assertion. Once examiner provides sound scientific reasoning questioning credibility, applicant must respond with evidence (test data, expert declarations, scientific publications) demonstrating utility.

BURDEN SHIFTING:

1. Applicant asserts utility in specification
2. Examiner must provide **sound scientific reasoning** to question utility
3. If examiner meets burden, applicant must provide **factual evidence** establishing utility

Examiner cannot rely on speculation or general skepticism. Must show specific technical reasons why asserted utility lacks credibility.

In re Bond, 910 F.2d 831 (Fed. Cir. 1990)

ISSUE: What standard applies for anticipation rejection under 35 U.S.C. § 102—must prior art reference identically disclose every claim element?

HOLDING: Anticipation is **question of fact** requiring **strict identity** between claim and prior art reference. Every element must be present in single reference, arranged as claimed. Substantial similarity insufficient—anticipation requires identity.

ANTICIPATION REQUIREMENTS:

- **Single reference:** Cannot combine multiple references (that's obviousness, not anticipation)

- **Every element:** All claim limitations must be disclosed
- **Arranged as claimed:** Elements related to each other as claim specifies
- **Enabling disclosure:** Reference must enable skilled artisan to make/use invention

If even one claim element missing or arranged differently, anticipation fails. Applicant can amend claims to distinguish from prior art.

Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516 (2d Cir. 1946)

ISSUE: Whether secret commercial use of invention by the inventor constitutes "public use" that bars patentability under § 102.

HOLDING: (Judge Learned Hand) Secret commercial exploitation BY THE INVENTOR more than one year before filing DOES bar patentability as a forfeiture, even if the use was not publicly accessible. An inventor cannot commercially exploit an invention in secret and then seek patent protection. This is distinct from secret use by third parties, which generally doesn't constitute prior art. **Post-AIA note:** Courts continue to treat non-public commercial exploitation problematically (see *Helsinn v. Teva*, 2019 - "on sale" includes non-public sales).

PUBLIC ACCESSIBILITY TEST: Prior art must be **accessible** to public. Could person interested in subject matter locate reference through reasonable diligence? If restricted to select group or kept secret, not publicly accessible.

POLICY: Patent system encourages disclosure. Secret uses don't provide public benefit that justifies denying patent. But once invention becomes publicly accessible (publication, public demonstration, unrestricted sale), statutory bar may apply.

Application in Chapter 5: Guardian Queen system existed for millennia but remained secret—accessible only to magical beings. Secret existence doesn't constitute publicly accessible prior art. Alexander's

analysis correctly distinguishes between existence and public disclosure.

STATUTORY INDEX

35 U.S.C. § 101 - Patentable subject matter, utility

35 U.S.C. § 102 - Novelty, anticipation, All Elements rule

35 U.S.C. § 112(a) - Written description, enablement, best mode

37 CFR § 1.111 - Reply to Office Action requirements

37 CFR § 1.132 - Affidavits/declarations to overcome rejections

37 CFR § 11.106 - Confidentiality of information

Alice Corp. v. CLS Bank (2014) - Abstract idea test (two-step)

Mayo v. Prometheus (2012) - Laws of nature, natural phenomena

Enfish v. Microsoft (2016) - Computer improvements pass Alice

Brenner v. Manson (1966) - Specific/substantial/credible utility

In re Brana (1995) - Burden shifting for utility rejections

In re Bond (1990) - All Elements rule for anticipation

Metallizing Engineering (1946) - Secret commercial use by inventor bars patent

Ariad Pharm. v. Eli Lilly (2010) - Written description possession test

Amgen Inc. v. Sanofi (2023) - Enablement of full claim scope

In re Wands (1988) - Eight-factor enablement test

Hickman v. Taylor (1947) - Work product doctrine (federal common law)

In re Queen's University (2016) - Patent agent privilege

END CHAPTER 5 - SURGICAL FIXES APPLIED

ABSTRACT

Malacar, the ancient dragon who serves as Director of the Patent Office, oversees the entire examination system. This chapter explores the broad authority granted to the USPTO Director under 35 U.S.C. § 3, the structure of post-grant proceedings including inter partes review (IPR) and post-grant review (PGR), and the role of the Patent Trial and Appeal Board (PTAB) in reviewing examiner decisions and adjudicating challenges to issued patents.

The chapter examines the constitutional questions raised by administrative patent adjudication, including the Appointments Clause issues addressed in *United States v. Arthrex* and the Article III concerns from *Oil States Energy Services v. Greene's Energy*. Malacar's absolute authority over the examination system parallels the Director's sweeping statutory powers, while also highlighting the constitutional limits on administrative patent review.

This chapter teaches the Director's rulemaking authority, the PTAB structure and procedures, the differences between ex parte appeals and inter partes proceedings, and the standards for instituting IPR/PGR challenges to issued patents.

SUMMARY - PATENT LAW CONCEPTS TAUGHT

1. Director's Authority Under § 3

The USPTO Director wields broad power over patent system:

- **§ 3(a)(1) - Superintendence:** Director has general superintendence over the Patent and Trademark Office and shall establish regulations for conduct of proceedings

- **§ 3(a)(2)(A) - Examination:** May establish regulations governing recognition and conduct of patent agents and attorneys
- **§ 3(a)(2)(B) - Fees:** May adjust patent fees (subject to statutory limits in § 41)
- **§ 3(a)(3) - Delegation:** May delegate duties to subordinate officers (Technology Center Directors, examiners, PTAB judges)
- **Rulemaking power:** Director can issue procedural rules for USPTO operation through Federal Register notice-and-comment
- **Substantive limits:** Cannot create new substantive patent law - bound by statutes. Can only interpret ambiguous statutory provisions (Chevron deference applies)

2. Patent Trial and Appeal Board (PTAB)

PTAB serves as administrative tribunal within USPTO:

- **Structure:** Composed of Director, Deputy Director, Commissioner for Patents, and Administrative Patent Judges (APJs)
- **Appointment:** APJs appointed by Secretary of Commerce (after *Arthrex* fix). Serve as inferior officers under Appointments Clause.
- **Two functions:** (1) Ex parte appeals from examiner rejections, (2) Inter partes proceedings challenging issued patents
- **Panels:** Decisions made by panels of at least 3 APJs. Director can designate which judges hear which cases.
- **Precedential decisions:** Director can designate decisions as precedential (binding on future panels)
- **Review authority:** Director retains authority to review and modify PTAB decisions (post-*Arthrex*)

3. Ex Parte Appeals

Applicants can appeal examiner rejections to PTAB:

- **§ 134 appeal right:** After Final Office Action, applicant may appeal to PTAB any rejection that is being maintained
- **Notice of Appeal (§ 41.31):** Must file within time for response to Final (with extensions, up to 6 months from Final)
- **Appeal Brief (§ 41.37):** Must articulate specific arguments why examiner erred on each rejected claim
- **Standard of review:** PTAB reviews examiner's factual findings under "substantial evidence" standard; legal conclusions de novo
- **Outcomes:** Affirm rejection, reverse rejection (claim allowed), affirm-in-part, or enter new ground of rejection
- **Further review:** If PTAB affirms rejection, applicant can appeal to Federal Circuit (§ 141) OR file civil action in district court (§ 145)

4. Inter Partes Review (IPR)

Third parties can challenge issued patents through IPR:

- **§ 311 - Who can file:** Any person who is not the patent owner may file IPR petition (except barred by estoppel)
- **§ 311(b) - Timing:** Cannot file until 9 months after patent grant OR after PGR termination
- **§ 312 - Grounds:** IPR limited to challenges under §§ 102 (novelty) and 103 (obviousness) based on ONLY patents and printed publications (no § 101, no § 112, no public use/on-sale)
- **§ 314(a) - Institution standard:** Director institutes IPR only if petition shows "reasonable likelihood" that petitioner would prevail on at least one challenged claim

- **§ 316 - Proceedings:** Discovery limited. Oral hearing. Decision within 1 year (extendable to 18 months for good cause)
- **§ 318(a) - Final decision:** PTAB issues written decision. Can cancel claims, uphold claims, or issue new patentability determination
- **§ 319 - Appeal:** Either party can appeal PTAB final decision to Federal Circuit

5. Post-Grant Review (PGR)

Broader challenge mechanism available only for AIA patents:

- **§ 321 eligibility:** Only available for patents with effective filing date on or after March 16, 2013 (AIA effective date)
- **§ 321(c) timing:** Must be filed within 9 months of patent grant (SHORT window)
- **§ 321(b) grounds:** Can challenge on ANY ground - §§ 101, 102, 103, 112, written description, enablement, etc. Much broader than IPR.
- **§ 324(a) institution:** Director institutes PGR if petition shows "more likely than not" that at least one challenged claim is unpatentable OR raises novel/ unsettled legal question
- **Use case:** Catch patents early (within 9 months) on broader grounds. After 9-month window closes, only IPR available (narrower grounds)

6. Differences Between IPR/PGR and District Court Litigation

Why petitioners choose PTAB vs. court:

- **Claim construction:** PTAB uses "broadest reasonable interpretation" (BRI) during IPR/PGR (same as examination). District courts use Phillips construction (ordinary meaning to PHOSITA). BRI often makes invalidation easier.
- **Burden of proof:** PTAB uses preponderance of evidence. District court uses clear and convincing

evidence (higher burden to invalidate). PTAB easier standard for petitioner.

- **Cost:** IPR/PGR typically costs $300K-500K. District court litigation costs $2M-5M+. Massive savings.
- **Speed:** PTAB final decision within 12-18 months. District court can take 3-5 years to trial. Much faster resolution.
- **Limited grounds:** IPR only §§ 102/103 on patents/publications. Can't raise § 101, § 112(a) enablement, public use, on-sale bar. District court allows all grounds.
- **Strategic use:** Accused infringers often file IPR to invalidate patent while simultaneously defending district court suit. If PTAB cancels claims, infringement suit dismissed.

7. Estoppel and Time-Bar Rules

IPR/PGR filing creates strategic consequences:

- **§ 315(a)(1) - 1-year time bar:** Cannot file IPR more than 1 year after being served with infringement complaint. Forces quick decision on whether to petition.
- **§ 315(b) - Real party in interest:** All real parties in interest must be identified. Cannot use shell companies to evade time bar.
- **§ 315(e)(2) - Estoppel:** If PTAB issues final written decision, petitioner estopped from raising in subsequent proceeding any ground that was raised OR reasonably could have been raised. Broad estoppel encourages presenting best case initially.
- **§ 325(a)(1) - PGR 1-year bar:** Cannot file PGR if petitioner or real party in interest already filed civil action challenging patent validity

8. Constitutional Challenges to PTAB

PTAB authority has faced constitutional scrutiny:

- **Appointments Clause (*Arthrex*):** APJs originally appointed by Director (principal officer). Supreme Court held this violated Appointments Clause - APJs exercise significant authority but weren't removable by President. Fix: APJ decisions now reviewable by Director (who IS removable), making APJs inferior officers.
- **Article III (*Oil States*):** Argument that patent rights are private property requiring Article III court adjudication. Supreme Court rejected - patents are "public rights" that government can reconsider through administrative process. IPR constitutional.
- **Seventh Amendment:** Argument that patent validity determination requires jury trial. Rejected - IPR is not traditional common law action requiring jury.
- **Due Process:** Concerns about "stacking" multiple IPRs on same patent. Director has discretion under § 314(a) to deny institution if prior IPR adequately addressed issues.

DISCUSSION QUESTIONS

1. Director's Rulemaking Authority vs. Congressional Intent

Question: The Director has broad authority to establish regulations under § 3. What limits exist on this rulemaking power? Could the Director, for example, create a rule that no patents shall issue on software inventions?

Analysis Points:

- Director can issue procedural rules but cannot contradict statutory text

- Software is patent-eligible under § 101 (if not abstract idea). Director cannot override statute.
- Chevron deference: Courts defer to agency interpretation of ambiguous statutes, but only if reasonable
- Major questions doctrine: Issues of vast economic/political significance require clear Congressional authorization
- Example of valid rule: Director sets examination procedures, fee structures, PTAB panel assignments
- Example of invalid rule: Director declares entire technology class ineligible (substantive law change)

2. IPR vs. District Court Litigation - Strategic Choice

Question: You represent a defendant in patent infringement suit. Patent has broad claims that likely read on your product, but you've found potentially invalidating prior art (patents and publications). Should you file IPR or defend in district court? What factors matter?

Analysis Points:

- IPR advantages: Lower cost, faster (12-18 months), lower burden (preponderance), broader claim construction (BRI)
- IPR disadvantages: Limited to §§ 102/103 on patents/publications, estoppel prevents raising same grounds later in court
- District court advantages: Can raise all defenses (§ 101, § 112 enablement, inequitable conduct), jury trial if favorable facts
- District court disadvantages: Expensive ($2M+), slow (3-5 years), higher burden to invalidate (clear and convincing)
- Common strategy: File both - IPR to cancel claims quickly/cheaply, while district court stayed pending PTAB decision
- Time bar risk: Must file IPR within 1 year of service of complaint (§ 315(a)). Clock is ticking.

3. Post-Grant Review 9-Month Window

Question: Why did Congress create such a short 9-month window for PGR (§ 321(c)) compared to the longer availability of IPR? What policy objectives does this serve?

Analysis Points:

- PGR allows ANY ground (§ 101, § 112, etc.) - much more powerful than IPR's limited grounds
- 9-month window encourages early challenges before patent owner invests heavily in enforcement
- Patent owners need certainty - can't have unlimited time for broad challenges on any ground
- After 9 months, only IPR available (narrower grounds) - balances challenger rights with patent owner investment
- Trade-off: Early vigilance rewarded, late challenges limited to prior art (§§ 102/103)
- Only applies to AIA patents (post-March 16, 2013) - pre-AIA patents can't be challenged via PGR at all

4. PTAB Appointments Clause Fix (Arthrex)

Question: Before *Arthrex*, APJs could issue final decisions canceling patent claims without any review by a principal officer. Why did this violate the Appointments Clause? How did making APJ decisions reviewable by the Director fix the problem?

Analysis Points:

- Appointments Clause requires inferior officers be appointed by President, courts, or department heads
- APJs appointed by Secretary of Commerce (department head) - OK so far
- But APJs exercised "significant authority" without supervision by principal officer (Director)
- Supreme Court: This made APJs function like principal officers, requiring Presidential appointment + Senate confirmation

- Fix: Director (who IS removable by President) can now review and modify PTAB decisions
- Effect: APJs now inferior officers (supervised by Director), so Secretary appointment is constitutional
- Practical impact: Director rarely exercises review power, but POTENTIAL for review satisfies Appointments Clause

5. Malacar's Absolute Authority as Director Metaphor

Question: In the narrative, Malacar (Director) has seemingly absolute authority over the examination system. Does the real USPTO Director have similarly broad power? What checks exist?

Analysis Points:

- Statutory limits: Director bound by 35 U.S.C. provisions - cannot override statutes
- Judicial review: Director's decisions appealable to Federal Circuit, can be overturned if arbitrary/capricious
- Congressional oversight: Congress can amend patent statutes, hold hearings, cut USPTO funding
- Presidential removal: Director serves at pleasure of President (removable), limiting independence
- APA requirements: Rulemaking must follow Administrative Procedure Act (notice-and-comment)
- Malacar's "absolute" authority represents the BROAD discretion within statutory bounds, not unlimited power

CASE STUDY: United States v. Arthrex, Inc.

Supreme Court, 2021

FACTS

Arthrex, Inc. owned a patent on surgical knotless suture anchors. Smith & Nephew, Inc. filed an inter partes review (IPR)

petition challenging the patent. A panel of three Administrative Patent Judges (APJs) at the PTAB held claims unpatentable. Arthrex appealed to the Federal Circuit, arguing that the APJ appointment structure violated the Appointments Clause of the Constitution.

APJs were appointed by the Secretary of Commerce (not the President with Senate confirmation). Under the pre-*Arthrex* statutory scheme, APJ decisions were final and unreviewable by the Director - APJs exercised significant authority without supervision by a principal officer.

ISSUE

Does the PTAB's structure - where APJs are appointed by the Secretary of Commerce but issue final decisions without any review by the Director - violate the Appointments Clause?

HOLDING

YES. The Supreme Court held 5-4 that unreviewable authority wielded by APJs was incompatible with their appointment by a department head under the Appointments Clause.

Remedy: Rather than invalidate the entire IPR system, the Court severed the statutory provisions that made APJ decisions unreviewable, allowing the Director to review PTAB decisions.

REASONING

Chief Justice Roberts wrote for the majority:

Appointments Clause framework:

- Article II, § 2, cl. 2: President appoints principal officers with Senate consent
- "Inferior officers" may be appointed by President alone, courts, or department heads
- Test: Officers who are not subject to direction and supervision by principal officer are themselves principal officers

APJs wield significant authority:

- Issue final decisions on behalf of United States
- Cancel patent claims with precedential effect
- Decisions reviewable only by Federal Circuit (not by Director)
- Exercise "more than ordinary" administrative authority

Lack of supervision problem:

- Director (principal officer) could not review APJ decisions
- APJs acted with "finality and independence" inconsistent with inferior officer status
- This made APJs function as principal officers
- But APJs appointed only by Secretary (not President + Senate) - VIOLATION

Remedy - severing unreviewability:

- Court severed 35 U.S.C. § 6(c) provision making APJ decisions final and unreviewable
- Effect: Director now has authority to review and modify PTAB decisions
- This makes APJs inferior officers (subject to Director supervision)
- Secretary appointment now constitutional

RESULT

Case remanded to Director for consideration whether to review the PTAB's decision in this case. IPR system preserved but Director given review authority.

SIGNIFICANCE FOR CHAPTER 5

This case fundamentally reshaped PTAB structure:

- **Director review power:** Director can now rehear any PTAB decision (rarely used but exists)

- **Validation of IPR:** Court preserved IPR system rather than striking it down - endorsed post-grant review as constitutional
- **Appointments Clause compliance:** Clarified that administrative patent judges must have supervision by principal officer
- **Practical impact:** Most PTAB decisions still final from panel, but shadow of Director review affects PTAB reasoning

CONNECTION TO THE NARRATIVE

Malacar's (Director's) oversight of all Guardian Queen examiners and PTAB-equivalent tribunal mirrors the constitutional requirement that a principal officer (removable by President) must supervise administrative adjudication. The "absolute authority" Malacar wields isn't unlimited - it exists within statutory and constitutional bounds, just as the Director's power is cabined by separation of powers.

Before *Arthrex*, examiners (APJs) could make final unreviewable decisions. This was like Guardian Queens operating independently without Director oversight. *Arthrex* required Director supervision - Malacar must be able to review and override Guardian Queen decisions to maintain constitutional structure.

ANALYSIS QUESTIONS

1. **Why didn't the Supreme Court just require Presidential appointment of APJs with Senate confirmation?** (Hint: Consider disruption to existing IPR proceedings and policy preference for preserving IPR system)
2. **How does Director review authority make APJs "inferior officers"?** (Hint: Focus on supervision vs. independence - inferior officers are supervised)
3. **What practical effect does *Arthrex* have on IPR proceedings?** (Hint: Director rarely exercises review, but parties can request it - creates strategic option)

COMPLETE STATUTORY TEXT

35 U.S.C. § 3 - Officers and Employees

(a) UNDER SECRETARY AND DIRECTOR.—

(1) IN GENERAL.—The powers and duties of the United States Patent and Trademark Office shall be vested in an Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (in this title referred to as the "Director"), who shall be a citizen of the United States and who shall be appointed by the President, by and with the advice and consent of the Senate. The Director shall be a person who has a professional background and experience in patent or trademark law.

(2) DUTIES.—

(A) The Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. The Director shall perform these duties in a fair, impartial, and equitable manner.

(B) The Director may establish regulations, not inconsistent with law, which—

(i) shall govern the conduct of proceedings in the Office;

(ii) shall be made in accordance with section 553 of title 5;

(iii) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section 122 relating to the confidential status of applications;

(iv) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;

(3) CONSULTATION.—The Director shall consult with the Public Advisory Committees established in section 5 on a regular basis on matters relating to the policies, goals, performance, budget, and user fees of the Office.

(4) PUBLIC INFORMATION.—The Director shall publish in the Federal Register the policies established by the Director in the exercise of the authority under paragraph (2)(B).

35 U.S.C. § 6 - Patent Trial and Appeal Board

(a) IN GENERAL.—There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Secretary, in consultation with the Director.

(b) DUTIES.—The Patent Trial and Appeal Board shall—

(1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a);

(2) review appeals of reexaminations pursuant to section 134(b);

(3) conduct derivation proceedings pursuant to section 135; and

(4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.

(c) 3-MEMBER PANELS.—Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director. Only the Patent Trial and Appeal Board, or a duly designated panel thereof, may grant rehearings.

35 U.S.C. § 311 - Inter Partes Review

(a) IN GENERAL.—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.

(b) SCOPE.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

(c) FILING DEADLINE.—A petition for inter partes review shall be filed after the later of either—

(1) the date that is 9 months after the grant of a patent; or

(2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

35 U.S.C. § 314 - Institution of Inter Partes Review

(a) THRESHOLD.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

(b) TIMING.—The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—

(1) receiving a preliminary response to the petition under section 313; or

(2) if no such preliminary response is filed, the last date on which such response may be filed.

(d) NO APPEAL.—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

35 U.S.C. § 315 - Relation to Other Proceedings or Actions

(a) INFRINGER'S CIVIL ACTION.—

(1) INTER PARTES REVIEW BARRED BY CIVIL ACTION.—An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

(2) STAY OF CIVIL ACTION.—If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either—

(A) the patent owner moves the court to lift the stay;

(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or

(C) the petitioner or real party in interest moves the court to dismiss the civil action.

(b) PATENT OWNER'S ACTION.—An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

(e) ESTOPPEL.—

(1) PROCEEDINGS BEFORE THE OFFICE.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. § 321 - Post-Grant Review

(a) IN GENERAL.—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the post-grant review.

(b) SCOPE.—A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).

(c) FILING DEADLINE.—A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).

STATUTORY REFERENCE INDEX

Primary Statutes Taught in Chapter 5:

- 35 U.S.C. § 3 - Director's Authority and Powers
- 35 U.S.C. § 6 - Patent Trial and Appeal Board Structure
- 35 U.S.C. § 134 - Ex Parte Appeals to PTAB
- 35 U.S.C. § 311 - Inter Partes Review (IPR) Filing
- 35 U.S.C. § 314 - Institution of IPR
- 35 U.S.C. § 315 - IPR Time Bars and Estoppel
- 35 U.S.C. § 318 - IPR Final Decision
- 35 U.S.C. § 321 - Post-Grant Review (PGR) Filing
- 35 U.S.C. § 324 - Institution of PGR
- 37 CFR § 41 - Practice Before Patent Trial and Appeal Board

Related Concepts:

- Administrative Patent Judges (APJs) appointment and authority
- Appointments Clause (Article II, § 2, cl. 2)
- Article III adjudication vs. administrative proceedings
- Broadest Reasonable Interpretation (BRI) claim construction
- Chevron deference to agency interpretations
- Major questions doctrine