

ABSTRACT

Alexander receives his first Office Action from Examiner Athelia containing multiple rejections under §§ 102 (anticipation), 103 (obviousness), and 112(a) (enablement). Racing against the statutory deadline, he must analyze each rejection, amend claims without introducing new matter, and craft arguments distinguishing prior art references. This chapter teaches the complete Office Action structure, response requirements, claim amendment strategies, and the critical distinction between narrowing amendments to overcome rejections versus prohibited broadening amendments. The story encodes the high-stakes nature of patent prosecution deadlines and the strategic balance between fighting rejections through argument versus amending claims to allowable scope.

CHAPTER SEVEN - OFFICE ACTION

Old Law: Jurisprudence of Myth (Patent Law Edition)

Sunday - The Prior Art Search

Six AM. Sunday morning.

Alexander's phone screamed.

Not buzzed. Not chimed. Screamed—an alarm that sounded like stone grinding against stone, ancient and terrible and absolutely wrong for a modern smartphone.

He grabbed it from the floor beside his makeshift bed. The screen glowed purple, text writing itself in real-time like an invisible hand was typing:

OFFICIAL NOTICE - OFFICE ACTION ISSUED Case: GQ-CIP-2025-00001 Applicant: Athelia Winters Attorney: Alexander [Wolf King] Examiner: I. Wavelander (Silver Eyes Division - § 103 Obviousness) Notice Date: November 9, 2025, 06:00:00 Response Deadline: November 12, 2025, 06:00:00 Time Remaining: 72 hours, 00 minutes, 00 seconds REJECTIONS UNDER 35 U.S.C.: § 101 - Utility § 102 - Anticipation § 103 - Obviousness § 112(a) - Enablement STATUS: AWAITING RESPONSE FAILURE TO RESPOND WITHIN DEADLINE = APPLICATION ABANDONED

Alexander's ears shot upright. Then flattened completely against his skull.

"No. No no no—"

On the bed four feet away, Athelia stirred. "Alexander? What's wrong? Your ears—"

She sat up, squinting in the dim light. Saw his expression. "What happened?"

He turned the phone toward her wordlessly.

Athelia read. Her face went pale. "Office Action. That's... that's bad, right?"

"It's the examiner's response to your application." Alexander's voice was tight. "Issac Wavelander just officially rejected your patent on four separate legal grounds. We have seventy-two hours to respond or the application is abandoned."

Standard USPTO Office Action response period = 3 months (extendable to 6 months). Old Law operates under **emergency prosecution protocols** - 72 hours for Guardian Queen examination applications. Old Law timing supersedes modern USPTO deadlines for jurisdictional matters.

"Abandoned means...?"

"The bond dissolves. I go back to my realm. You forget all of this. The barrier continues weakening until it collapses." His ears drooped. "We lose."

37 CFR § 1.135(a) - If applicant fails to reply to Office Action within set time period, application is considered abandoned. Cannot be revived without petition and showing of unintentional delay. Clock starts ticking immediately upon notice.

The door burst open. Casey stood there in pajamas, hair wild, holding her phone. "Why is MY phone screaming in LATIN?!"

"That's not Latin, it's—" Alexander stopped. "Wait. Malacar sent you a notification?"

"SOMETHING did! It woke me up with GREGORIAN CHANTING and then displayed a countdown timer!" She shoved her phone at them. The screen showed: **71:59:42... 71:59:41... 71:59:40...**

"The response deadline," Athelia said. "He's making sure we all know."

Alexander scrolled through his phone. "There's more. The detailed rejections. Four separate grounds."

He opened the first attachment:

REJECTION #1: 35 U.S.C. § 101 - UTILITY Claims 1-10 are rejected for lack of utility under 35 U.S.C. § 101. The statute requires that an invention have SPECIFIC, SUBSTANTIAL, and CREDIBLE utility. **SPECIFIC UTILITY:** Applicant claims "Guardian Queen examination protocols" but fails to specify WHAT will be examined, HOW examination will proceed, or WHAT distinguishes claimed protocols from general queenly duties. Recitation of "examination" without specific details is insufficient. Compare to: In re Fisher, 421 F.3d 1365 (Fed. Cir. 2005) - claimed ESTs lacked specific utility where specification failed to identify specific use beyond general research tool. Applicant must identify CONCRETE, SPECIFIC use that provides REAL-WORLD benefit. **SUBSTANTIAL UTILITY:** Even if specific utility exists, claimed utility must be SUBSTANTIAL - providing real benefit, not trivial or insignificant. "Maintaining a barrier" without explaining HOW this benefits the public or WHY this matters is not substantial utility. **CREDIBLE UTILITY:** Applicant has demonstrated no ability to perform claimed invention. How can examiner believe applicant capable of Guardian Queen examination when applicant has no training, no memory of protocols, and no prior examination experience? Burden is on applicant to establish credible utility with evidence or persuasive reasoning.

Athelia read it twice. Her hand started moving across her notebook without conscious thought:

SPECIFIC utility = concrete use (not vague)

"chemical compound" ✗ too general

"chemical compound treating lung cancer" ✓ specific

SUBSTANTIAL utility = real benefit (not trivial)

"makes baseballs fly 1 inch farther" ✗ insignificant

"treats disease" ✓ substantial

CREDIBLE utility = actually works (believable to PHOSITA)

perpetual motion ✗ violates physics

"person having ordinary skill would believe it" ✓ credible

"I'm writing definitions I don't remember learning," Athelia whispered.

Alexander looked at her notes. "The protocols are teaching you. You're absorbing the law through the bond."

She stared at what she'd written. "So Issac is saying I haven't proven my invention does something specific, substantial, and credible."

"Right. He's challenging whether Guardian Queen examination is even a patentable utility."

"Can we overcome that?"

"If we can show concrete examples of what you'll examine, how it benefits the public, and prove it actually works." Alexander scrolled to the next rejection. "But that's just § 101. Look at § 102."

REJECTION #2: 35 U.S.C. § 102 - ANTICIPATION Claims 1-10 are rejected as anticipated by prior art under 35 U.S.C. § 102. PRIOR ART REFERENCE: Original Guardian Queen patent, filed approximately 1725 CE (hereinafter "OGQ") Under the ALL ELEMENTS RULE, a claimed invention is anticipated if a SINGLE prior art reference discloses EVERY element of the claimed invention. Analysis of Claim 1: Element (a): Guardian Queen examiner - DISCLOSED in OGQ Element (b): Examination authority - DISCLOSED in OGQ Element (c): Barrier maintenance - DISCLOSED in OGQ Element (d): Application review capability - DISCLOSED in OGQ The OGQ reference discloses ALL elements of Claim 1. Therefore Claim 1 is ANTICIPATED. Not novel. The same analysis applies to Claims 2-10. All elements disclosed in single prior art reference. CONCLUSION: Applicant's claimed invention is not new. It was already invented by Original Guardian Queen in 1725. Application fails novelty requirement. Applicant must either: (1) Amend claims to recite elements NOT in prior art, OR (2) Show that prior art does NOT actually disclose all elements

"Wait." Athelia pointed at the screen. "What's the 'All Elements' rule?"

She read the § 102 notice again. Her hand moved—drawing automatically:

ALL ELEMENTS RULE (§ 102):

YOUR CLAIM: Elements A + B + C

PRIOR ART #1: Has A + B

PRIOR ART #2: Has C

Result: NOT ANTICIPATED ✓

(no SINGLE reference has all elements)

For anticipation: ONE reference must show EVERYTHING
A + B + C all from ONE source

Multiple references together = § 103 obviousness
(different test, different rules)

She stared at what she'd drawn. "I didn't learn this. The protocols just... gave it to me."

Alexander leaned over, reading her notes. His ears perked up. "That's exactly right. The All Elements rule—single reference must show everything."

"All Elements" Rule (§ 102) - Single reference must disclose EVERY claimed element for anticipation. Think of it like a checklist: ✓ A ✓ B ✓ C all from ONE source. If elements come from multiple sources, not § 102 (but might be § 103).

"So Issac is saying the Original Guardian Queen's patent shows ALL the elements of MY patent. Which means mine isn't new."

"Right. To overcome this, we need to find the Original Queen's actual patent and prove she DIDN'T have all your elements. That something in your claims is NEW—something she didn't have."

"Like what?"

Alexander's hand moved to his ears unconsciously. "Like the bond. Like having an attorney. Like—" He stopped. "We need to

see her original patent. Compare it to yours element by element."

Casey had been reading over their shoulders. "Where would a three-hundred-year-old magical patent BE?"

"The archives," Alexander said. "At Walnut Canyon. The examination center keeps records of all filed patents."

"The place that almost killed Athelia on Thursday."

"Yes."

"Of course it is." Casey looked at the countdown timer on her phone. 71:47:33. "When do we leave?"

"Now," Athelia said. "But show me the other rejections first. I need to understand what we're fighting."

Alexander scrolled to § 103:

REJECTION #3: 35 U.S.C. § 103 - OBVIOUSNESS Claims 1-10 are rejected as obvious over the Original Guardian Queen reference. Even if applicant successfully distinguishes claims from OGQ (addressing § 102 above), the claimed invention would be OBVIOUS variation of prior art under 35 U.S.C. § 103. GRAHAM FACTORS ANALYSIS (per Graham v. John Deere, 383 U.S. 1, 1966): **Factor 1 - Scope and Content of Prior Art:** OGQ performed Guardian Queen duties with full memory from birth. Solo operation. No attorney. Maintained barrier for 47 years (1725-1772). **Factor 2 - Differences Between Prior Art and Claimed Invention:** Applicant claims: modern human, amnesia present, attorney bond, digital integration. Differences acknowledged but see Factor 3. **Factor 3 - Level of Ordinary Skill in the Art:** PHOSITA = Person Having Ordinary Skill in the Art of being a Guardian Queen. Would possess: latent Queen bloodline, knowledge of Old Law, ability to access protocols. PHOSITA would recognize that substituting one queen for another is OBVIOUS. Modern human vs. historical queen = predictable substitution. Amnesia vs. full memory = variation, but obvious to try amnesia-resistant methods. **Factor 4 - Secondary Considerations:** Applicant provides NO EVIDENCE of: -

Commercial success - Long-felt need - Failure of others -
Unexpected results - Copying by competitors - Licensing activity
- Skepticism of experts Without objective evidence to rebut
prima facie obviousness, claimed invention is OBVIOUS.
Additionally, under KSR v. Teleflex, 550 U.S. 398 (2007): It is obvious
to try substituting elements with known alternatives when
results are predictable. Substituting modern queen for
historical queen = obvious to try. Results = predictable (queen
performs same functions). CONCLUSION: Obvious over prior art.

"Okay, stop." Athelia held up her hand. Her other hand was
already moving across the page:

GRAHAM v. JOHN DEERE (1966) - § 103 Test

Factor 1: PRIOR ART - what does prior art teach?
(baseline knowledge in the field)

Factor 2: DIFFERENCES - how is YOUR invention different?
(what's new? what changed?)

Factor 3: LEVEL OF SKILL - what would PHOSITA know?
PHOSITA = Person Having Ordinary Skill in the Art
(not genius, not novice - ordinary skill)
Would PHOSITA think invention is obvious?

Factor 4: SECONDARY CONSIDERATIONS - objective evidence of
NON-obviousness

- Long-felt need (took 300 years?)
- Failure of others (others tried and failed?)
- Skepticism of experts (said it wouldn't work?)
- Commercial success (solved real problem?)
- Unexpected results (surprised everyone?)

"I'm doing it again." Athelia stared at her handwriting. "The
protocols are writing the test through me."

Alexander read over her shoulder, ears perked. "Graham v. John
Deere. Four-factor test. That's exactly right."

Graham v. John Deere (1966) - Foundational § 103 case. Four factors: (1) prior art scope, (2) differences from prior art, (3) level of ordinary skill, (4) secondary considerations. Supreme Court established this framework. EVERY Patent Bar question on obviousness references Graham.

She read what she'd written. "So Issac is saying that even though my invention is different from the original Queen, those differences are OBVIOUS. Any normal queen would think of them."

"Right. And he's pointing out that we haven't provided any secondary considerations—no proof that it took a long time, or that others failed, or that it was unexpectedly successful."

"But we DON'T have that evidence. Do we?"

Alexander's ears flattened. "That's what we need to find at Walnut Canyon. If there are records of failed attempts to replace the original Queen—people who tried and couldn't make it work—that's 'failure of others.' If it's been 250 years since she disappeared, that's 'long-felt need.' If the Council said it wouldn't work and you proved them wrong, that's 'skepticism of experts.'"

"The archives would have that?"

"If anywhere does."

Athelia looked at the last rejection. "And § 112?"

REJECTION #4: 35 U.S.C. § 112(a) - ENABLEMENT Claims 1-10 are rejected for failure to enable under 35 U.S.C. § 112(a). The specification must enable a Person Having Ordinary Skill in the Art (PHOSITA) to make and use the claimed invention WITHOUT UNDUE EXPERIMENTATION. Here, the specification fails because: **Issue 1:** What ARE the Guardian Queen protocols? Specification states they will "download" but provides no description of WHAT downloads, HOW it occurs, or WHAT the protocols contain. **Issue 2:** How does examination work? No description of examination process, decision criteria, or operational steps. **Issue 3:** How does amnesia affect operation? Specification acknowledges amnesia but doesn't explain how applicant overcomes it to perform claimed functions. **Issue 4:**

What is the attorney bond? Claims reference "bond formation" but specification provides no enabling disclosure of bond mechanism, requirements, or function. A PHOSITA could not practice the claimed invention based on the specification as filed. Applicant must either: (1) Amend specification to provide enabling disclosure, OR (2) Argue that specification DOES enable based on knowledge in the art

Athelia read the § 112(a) rejection. Her hand moved again:

"Issac is saying my patent doesn't teach how to BE a Guardian Queen."

Athelia looked at the countdown timer. **71:38:12.**

Four rejections. Seventy-one hours. And they needed to find a three-hundred-year-old patent in magical cliff dwellings to prove any of it.

"We need to go," she said. "Now."

MONDAY MORNING - 8:30 AM

Alexander stood in Athelia's bedroom, exhausted. Not just from the sleepless night—from Sunday's research marathon that had yielded fragments, hints, but nothing complete. His ears tracked every sound. Neighbors arguing. Traffic. Birds outside the window.

Athelia emerged from the bathroom, dark circles under her eyes. "I found one reference to a 'Guardian examination center' in a 1782 colonial land dispute. ONE. In twelve hours of searching."

"Better than what I found." Alexander's ears drooped. "Which was nothing."

Casey knocked and entered. "You're coming to class, right? Because you live here now and I'm not explaining to professors why the viral wolf attorney ISN'T attending."

"I—" Alexander's ears flattened. "People are going to stare. Film me. We're already at 15 million views."

"So?"

"So I can't think when everyone is watching my ears move!"

Casey considered this. Then walked to her closet. Returned with an oversized black hoodie. "Here. Pull the hood up. Covers the ears. Problem solved."

Alexander's ears perked up with hope.

He pulled on the hoodie. Drew the hood up carefully over his ears. They were hidden—pressed flat against his skull under the fabric, but not visible.

Relief flooded through him. "Thank you. This is—"

His phone buzzed.

Then BLARED.

An alarm he'd never heard before. Loud. Insistent. Ancient-sounding.

MALACAR'S VOICE filled the small bedroom—not from the phone, but from everywhere at once:

VIOLATION DETECTED 37 CFR § 1.56 - DUTY OF CANDOR AND GOOD FAITH TO THE USPTO 37 CFR § 11.303 - CANDOR TOWARD THE TRIBUNAL ATTORNEY ALEXANDER [WOLF KING] IS CONCEALING PHYSICAL MANIFESTATION OF BOND. THIS CONSTITUTES LACK OF CANDOR IN PATENT PROSECUTION. PHYSICAL MANIFESTATION OF ATTORNEY-CLIENT BOND MUST REMAIN VISIBLE AS EVIDENCE OF ACTIVE PROSECUTION. CONCEALMENT CONSTITUTES DISHONESTY REGARDING MATERIAL FACT. REMOVE CONCEALMENT IMMEDIATELY OR FACE SANCTIONS FOR ETHICS VIOLATION.

Alexander froze.

"What?" Athelia stood in the doorway, toothbrush in hand. "What is he talking about?"

"The ears," Alexander said weakly. "I'm hiding the ears."

37 CFR § 11.106 - Confidentiality of information. 37 CFR § 11.303 - Candor toward tribunal (duty of honesty in prosecution). Under Old Law, physical manifestations of bond (ears, downloads) are EVIDENCE of attorney-client relationship. Concealing evidence = lack of candor = ethics violation under § 11.303.

"Are you KIDDING ME?!" Casey shrieked. "The magic database is regulating FASHION CHOICES?!"

"It's not fashion," Alexander said miserably, pulling the hood down. His ears sprang up, fully visible again. "It's evidence. The ears prove the bond exists. Prove the attorney-client relationship is real. Hiding them would be... lying to the Patent Office."

COMPLIANCE CONFIRMED ATTORNEY ALEXANDER [WOLF KING] EARS NOW VISIBLE. ETHICS VIOLATION WITHDRAWN. PROCEED WITH CANDOR.

The voice cut off.

Silence.

Casey looked at Alexander. At his ears, now perked forward in misery. "So. Plan B?"

"There is no Plan B," Alexander said. "I have to go to class with visible ears, get filmed again, trend on TikTok again, and hope the federal government doesn't arrest me before we finish responding to Issac's objections."

"Cool," Casey said flatly. "Cool cool cool. Just another Monday."

They walked across campus in silence. Early November cold bit through Athelia's jacket. Alexander's ears swiveled constantly—tracking students, cars, distant conversations. His shoulders were tense.

"You okay?" Athelia asked quietly.

"No." His ears flattened. "But we don't have a choice."

They reached the law building twenty minutes early. The classroom was empty except for a few students scattered in back rows, laptops open, cramming.

Athelia chose seats near the middle. Not front row—too exposed. Not back—too obvious they were hiding. Middle felt... safer.

Alexander sat. His ears immediately swiveled toward the door. Tracking every person who entered.

Casey pulled out her phone. "Fifteen point two million views. Trending number seven on TikTok. #WolfCounselor is now officially mainstream."

"Fantastic," Alexander muttered.

More students filtered in. One glanced at Alexander. Did a double-take. Pulled out their phone.

Then another. And another.

By the time Mendez walked in at 9:00 AM, half the class was filming.

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Mendez looked up from his desk. Saw Alexander. Saw the ears. His expression didn't change. "Ms. Winters. Mr. Alexander. I trust you've made progress on the assignment?"

"Working on it, Professor," Athelia said.

"Due Wednesday. No extensions." His gaze moved to Alexander's ears. Lingered there. "Interesting that you're still... manifesting."

Alexander's ears flattened.

"Take your seats."

As they sat, someone whispered: "Dude, I thought the ears were prosthetics..."

"They're MOVING. Look—they just swiveled toward us."

"#WolfCounselor round two, baby!"

Alexander wanted to die.

Mendez began lecturing about federal preemption and state sovereignty. Athelia opened her laptop to take notes.

She started typing normally:

Federal preemption occurs when federal law supersedes state law under the Supremacy Clause...

Then her fingers slipped. Binary appeared on screen:

01010101 01110100 01101001 01101100 01101001 01110100 01111001 00100000
01110010 01100101 01110001 01110101 01101001 01110010 01100101 01110011

Athelia stared at it. And then—without thinking, without knowing HOW—she read it.

Her hand wrote beneath the binary:

Utility requires: specific, substantial, credible

She blinked. She didn't KNOW that. Didn't study it. But her hand wrote it anyway.

And the binary... she could READ it now. Like it was plain English. Like it was always readable and she just needed to look properly.

She kept typing. Constitutional law. Then:

01000001 01101100 01101100 00100000 01100101 01101100 01100101 01101101
01100101 01101110 01110100 01110011 00100000 01110010 01110101 01101100
01100101

All elements rule: single prior art reference must disclose every claimed element for anticipation under 35 U.S.C. § 102

Her handwriting was changing. Some sentences in her normal script. Others in flowing, elegant handwriting she'd never used. Older. More formal.

Casey leaned over, saw the screen. Went pale. Whispered: "Uh. Athelia?"

Athelia didn't hear her. She was typing faster now. Binary and translation flowing together:

```
01000111 01110010 01100001 01101000 01100001 01101101 00100000 01100110  
01100001 01100011 01110100 01101111 01110010 01110011
```

Graham v. John Deere (1966) - Four factors for obviousness:

- (1) scope and content of prior art
- (2) differences between prior art and claimed invention
- (3) level of ordinary skill in the art
- (4) secondary considerations including commercial success, long-felt need, failure of others, unexpected results, copying by competitors, licensing, skepticism of experts

Guardian Queen Protocol Integration - Stage 3: Binary parsing.

Download protocols no longer appear as raw code—consciousness now translates automatically. Similar to patent examiner training: initial learning, integration, fluency. Athelia entering fluency phase.

Another line appears:

```
01010000 01001000 01001111 01010011 01001001 01010100 01000001
```

Person Having Ordinary Skill In The Art. Legal fiction. Benchmark for enablement, obviousness analysis. Not genius. Not novice. Ordinary skill in relevant technical field.

Her hand keeps moving. Page after page. Constitutional law mixed with patent law mixed with binary code. All flowing together like they're the same language.

A student behind her leans forward. Sees her screen. "Dude, is she writing in CODE?"

Another student pulls out their phone. Films over her shoulder.

Casey hisses: "Athelia. People are watching."

Athelia doesn't respond. Her eyes are unfocused. Fingers moving across keyboard like she's transcribing something only she can hear.

More binary:

```
01010011 01100101 01100011 01101111 01101110 01100100 01100001 01110010  
01111001 00100000 01100011 01101111 01101110 01110011 01101001 01100100  
01100101 01110010 01100001 01110100 01101001 01101111 01101110 01110011
```

Secondary considerations overcome prima facie obviousness. Objective indicia. Three hundred years = long-felt need. Multiple failed candidates = failure of others. Bond formation despite amnesia = unexpected results. Fifteen million views = commercial success analog. Council vote against = skepticism of experts.

She's writing the RESPONSE. The Office Action response. Using constitutional law framework to structure patent law arguments. The homework assignment and the prosecution response merging into a single document.

And she understands ALL of it now.

Alexander reaches across the aisle. Touches her hand.

The bond flares.

Athelia gasps. Blinks. The unfocused look clears. She stares at her screen.

Twelve pages. She's written twelve pages in twenty minutes. Half in English. Half in binary. All of it translated. All of it PERFECT.

"What—" Her voice shakes. "What did I just write?"

Alexander's ears flatten. "The response. You're writing Issac's response. And you're parsing the binary now. You can read it."

"I can READ it," she whispers. "It's not code anymore. It's just... words. Instructions. Legal frameworks. I can SEE it."

Casey grabs her laptop. Slams it shut. "We're leaving. Now."

"Ms. Morgan?" Mendez calls from the front. "Class isn't over."

"Emergency. Sorry Professor. We'll—" Casey doesn't finish. Just grabs Athelia's arm and hauls her up.

Alexander follows, ears tracking every phone filming their exit.

As they leave, someone whispers: "Did you see what she was typing? That looked like MATRIX shit..."

Another voice: "#WolfCounselor just got an upgrade. #BinaryGirl trending in 3... 2..."

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Hallway. Empty study room. Casey locks the door.

"Okay. WHAT THE FUCK WAS THAT?"

Athelia is shaking. "I could read it. The binary. It wasn't code. It was just... knowledge. Like someone uploaded an entire legal database directly into my brain and I can ACCESS it now."

"The Guardian Queen," Athelia finishes. Her voice breaks. "I'm becoming someone else. Something else. And I can't STOP it."

Alexander's ears droop. "The examination activated the protocols. They're teaching you. Preparing you. By the time we finish the response to Issac's objections, you'll probably have full access to all Guardian Queen knowledge."

"And then what? Do I stop being ME?"

Silence.

Because none of them know the answer.

Alexander's phone buzzes. Malacar:

NOTICE: APPLICATION STATUS UPDATE Parsing capability confirmed in applicant Integration proceeding faster than

historical baseline Estimated time to full protocol access: 48-72 hours Recommendation: Expedite Office Action response Council objections pending

Athelia reads over his shoulder. "Forty-eight to seventy-two hours. That's—that's the response deadline."

"Not a coincidence," Alexander says. "Issac timed it perfectly. By the time we respond, you'll have full access to the protocols. You'll KNOW everything you need to know to defend your application."

"But I won't be ME anymore."

"You'll be you," Alexander says firmly. "With added knowledge. Like... finishing law school. You don't stop being yourself when you learn new things."

"This isn't law school! This is MAGIC LOBOTOMY!"

His ears flatten completely. Because she's not wrong.

Casey is pacing. "Okay. New plan. We need to finish this response FAST. Before she fully integrates. Before she loses herself. What do we need?"

"The original Queen's documentation," Alexander says. "We need to go to Walnut Canyon. Find the archives. Compare her protocols to Athelia's. Prove what's new. What's different."

"When?"

"Now. This afternoon. We're out of time."

Athelia looks at her laptop. At the twelve pages of binary and patent law she wrote without thinking. At the handwriting that isn't quite hers anymore.

"Let's go," she says. "Before I forget who I am."

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Forty-five minutes later, they were in Casey's car heading south on Highway 89.

Athelia sat in passenger seat, laptop balanced on her knees. She'd opened a new document—started typing notes from Alexander's explanations:

§ 101 - Three types of utility required: specific, substantial, credible

§ 102 - All Elements rule: single reference must show ALL claimed elements

§ 103 - Graham factors: prior art + differences + ordinary skill + secondary considerations

§ 112 - Enablement: teach PHOSITA how to make/use invention

Her hands slipped. Binary appeared on screen:

```
01010000 01001000 01001111 01010011 01001001 01010100 01000001  
00100000 01100101 01101110 01100001 01100010 01101100 01100101 01101101  
01100101 01101110 01110100
```

Athelia stared at it. Then—without knowing how—she READ it.

Her hand wrote beneath:

PHOSITA enablement - must teach person having ordinary skill
how to make and use invention without undue experimentation

"I can read it," she whispered.

In the back seat, Alexander's ears perked up. "The binary?"

"It's not code anymore. It's just... words. Like English but in a different alphabet." She looked at her hand. "And I'm writing definitions I don't remember learning."

Casey glanced over, eyes still on the road. "Is that good or bad?"

"I don't know," Athelia said. "But it's happening faster."

Guardian Queen Integration - Stage 2: Binary parsing capability
activates. Downloaded protocols begin translating from machine code to

conscious understanding. Similar to language immersion—exposure leads to comprehension, then fluency.

Alexander leaned forward between the front seats. "Try something. Write 'All Elements rule' and see what happens."

Athelia typed: All Elements rule

Her hands slipped again. Binary flowed:

```
01000001 01101100 01101100 00100000 01100101 01101100 01100101 01101101
01100101 01101110 01101000 01110011 00100000 01110010 01110101 01101100
01100101 00111010 00100000 01100001 01101110 01110100 01101001 01100011
01101001 01110000 01100001 01110100 01101001 01101111 01101110 00100000
01110010 01100101 01110001 01110101 01101001 01110010 01100101 01110011
00100000 01110011 01101001 01101110 01100111 01101100 01100101 00100000
01110000 01110010 01101001 01101111 01110010 00100000 01100001 01110010
01110100 00100000 01110010 01100101 01100110 01100101 01110010 01100101
01101110 01100011 01100101 00100000 01100100 01101001 01110011 01100011
01101100 01101111 01110011 01101001 01101110 01100111 00100000 01100101
01110110 01100101 01110010 01111001 00100000 01100011 01101100 01100001
01101001 01101101 01100101 01100100 00100000 01100101 01101100 01100101
01101101 01100101 01101110 01110100
```

And she translated automatically:

All elements rule: anticipation requires single prior art reference disclosing every claimed element. If even ONE element missing from reference, NOT anticipated under § 102. Can use multiple references for § 103 obviousness, but NOT for § 102.

Athelia stared at what she'd written. "I didn't study that. I didn't KNOW that detail about multiple references."

"But you know it now," Alexander said quietly. "The protocols are teaching you. Faster than I expected."

Walnut Canyon appeared ahead. The brown sign for the national monument. Sunday morning—few cars in the parking lot.

Casey parked. Looked at the countdown on her phone. **70:52:08**. "How long will you be?"

"Time moves differently across the barrier," Alexander said. "Could be an hour our time, twenty minutes here. Or vice versa."

"So I just... wait?"

"If we're not back by noon, call everyone. FBI. Homeland Security. Campus security. I don't care if Malacar blocks it."

"Comforting." Casey handed Athelia her phone. "Take this. If you CAN call, do it."

They climbed out. November air cold and sharp. Clear blue sky. Tourists were just starting to arrive—families, hikers, a group of geology students with clipboards.

Alexander's ears swiveled, tracking everything. The bond pulled him forward. Toward the canyon. Toward the barrier.

"Last time I was here," Athelia said, staring down the paved trail, "I almost died."

"Last time you were alone. This time I'm with you." Alexander started walking. "Stay close. Don't fight the barrier when we cross. Let it take you."

They walked down into the canyon. Past the visitor center. Down stone steps worn smooth by a million feet. The cliff dwellings appeared—ancient alcoves carved into limestone walls eight hundred years ago by people who understood this place had power.

Tourists wandered. Took photos. Read interpretive signs about the Sinagua people.

None of them saw the shimmer.

But Athelia saw it now. Between one alcove and the next—a ripple in the air like heat rising from pavement. The barrier between jurisdictions.

"There." She pointed.

Alexander nodded. "When we cross, reality will invert. Like drowning. Your wolf will panic—"

"I don't have a wolf."

"The bond gives you access to mine. You'll feel it." His ears flattened. "Don't fight. Just let it happen."

They approached the shimmer. Alexander reached out—touched it with one hand.

The barrier recognized him. Pulsed warm under his palm. Parted like water around a stone.

He looked back. "Ready?"

Athelia took his hand. "No. But let's go anyway."

They stepped through.

The world inverted.

Everything Athelia remembered from Thursday came flooding back—the sensation of drowning, being crushed and stretched simultaneously, dimensions folding into impossible shapes her mind couldn't process. Her lungs screamed for air that didn't exist. Her vision went white then black then colors that had no names.

And something inside her SURGED. Not her. Something else. Wolf instinct borrowed from Alexander through the bond—pure animal panic at the WRONGNESS of this space.

Don't fight it, Alexander's voice in her head. Not spoken. Bond-sent. Let the barrier carry you.

Athelia stopped fighting.

The pressure built. Built. BUILT—

—and released.

Her feet hit solid ground. Air rushed into her lungs. Different air—heavier, magic-saturated, tasting of stone and time and ancient purpose.

She opened her eyes.

Some cliff dwellings. Some limestone alcoves. But the walls GLOWED.

Text carved into limestone. Runes. Diagrams. Legal frameworks in languages that shouldn't exist but Athelia could now READ:

CLAIM 1: A method for maintaining jurisdictional separation, comprising: (a) establishing boundary marker at geographic threshold; (b) requiring formal application for passage across said boundary; (c) examining said application according to established protocols; (d) granting or denying passage based on examination results. Filed: Year of Three Moons (approximately 1691 CE) Inventor: [Script in language Athelia didn't recognize] Status: GRANTED - Patent active for duration of barrier maintenance

"These are patent claims," Athelia breathed. "Carved into the WALLS. The entire examination center is a PATENT."

Alexander's ears swiveled, reading different sections. "The barrier itself. The original Guardian Queen didn't just maintain the system—she INVENTED it. Filed the foundational patent."

He pointed deeper into the alcove. "The archives are this way. Follow me."

They walked past more carved claims. Past chambers that had clearly been examination rooms—stone benches, carved sigils, spaces designed for applicants to stand while being evaluated. Everything covered in legal text describing procedures, requirements, jurisdictional boundaries.

It was like walking through a three-dimensional patent specification.

Finally, the passage opened into a circular chamber. Stone shelves carved into walls floor to ceiling. And on those shelves:

BOOKS. Scrolls. Tablets. Centuries of documentation preserved by the same barrier magic that kept this place hidden.

In the center of the chamber: a stone pedestal. And resting on it: a single large tome, leather-bound, ancient, with a golden sigil on the cover that pulsed faintly.

Athelia approached it slowly. "Is that...?"

"The original patent," Alexander said. "The Guardian Queen's application."

She reached out. Touched the cover.

The book opened by itself.

Pages flipped rapidly—decades blurring past in seconds. Then stopped. Settled on a specific section as if the book itself knew what they needed:

PATENT APPLICATION GUARDIAN QUEEN EXAMINATION PROTOCOLS Inventor: [Name in flowing script] Title: Guardian Queen, First of Her Line, Keeper of the Threshold Filed: Third Moon, Year of Broken Promises (approximately 1725 CE) Examination Center: Walnut Canyon, Territory of New Spain
BACKGROUND OF THE INVENTION: For millennia, passage between Old Law jurisdiction and human jurisdiction has been ungoverned. Beings cross at will, causing jurisdictional chaos, legal confusion, and barrier instability. There is a need in the art for a systematic examination process to regulate passage, maintain barrier integrity, and ensure only qualified applicants cross jurisdictions. **SUMMARY OF THE INVENTION:** A Guardian Queen examination system is provided. The Guardian Queen possesses inherent protocol knowledge from birth, passed through maternal bloodline. No training required. No external assistance needed. The Guardian Queen operates independently, examining all applications for passage, maintaining barrier integrity, and making final determinations without appeal or review. **DETAILED DESCRIPTION:** The Guardian Queen is born with complete knowledge of examination protocols. These protocols are instinctive, genetic, present from first breath. No learning period. No amnesia barriers. Knowledge is **INHERENT**. The examination process operates as follows: **STEP 1:** Applicant approaches barrier at designated threshold (Walnut Canyon

examination center) STEP 2: Guardian Queen senses application through direct barrier connection (no intermediary required) STEP 3: Guardian Queen evaluates: - Applicant lineage - Jurisdictional standing - Intent and purpose - Compatibility with Old Law - Risk to barrier integrity STEP 4: Guardian Queen makes determination - GRANTED or DENIED STEP 5: Decision is FINAL. No appeal. No review. No Office Actions. No responses required. The system requires NO ATTORNEY. NO BONDED PARTNER. NO EXTERNAL VERIFICATION. Solo operation only. Guardian Queen authority is absolute.

Prior Art Analysis: When responding to § 102 rejection, must compare claimed invention to prior art element by element. Look for differences. Even one missing element defeats anticipation under All Elements rule.

Athelia pulled out her phone. Started photographing pages. "Solo operation. No attorney. No bond. Immediate decisions. No appeals."

Alexander leaned over her shoulder, ears forward, reading intently. "That's completely different from your application. Your application **REQUIRES** the bond. Requires me."

"Keep reading. There's more."

She flipped to the claims section:

WHAT IS CLAIMED: 1. A Guardian Queen examination system, comprising: (a) a Guardian Queen with inherent protocol knowledge from birth; (b) direct barrier connection requiring no intermediary; (c) solo examination authority with no external verification; (d) instant decision-making capability based on instinctive protocols. 2. The system of Claim 1, wherein said Guardian Queen operates without amnesia barriers. 3. The system of Claim 1, wherein said Guardian Queen requires no attorney or bonded partner. 4. The system of Claim 1, wherein examination decisions are final and not subject to appeal or response. 5. The system of Claim 1, wherein protocols are inherited through maternal bloodline. 6-10. [Additional claims regarding barrier maintenance procedures]

Athelia stared at Claim 3. Read it aloud: "The system of Claim 1, wherein said Guardian Queen requires no attorney or bonded partner."

She looked at Alexander. "She explicitly claimed NO attorney. NO bond."

His ears shot upright. "That's the difference. That's what makes your application novel."

"Explain. Use small words. I'm still learning."

Alexander pulled out his own phone, opened a notes app, started typing:

ORIGINAL QUEEN'S CLAIM 1 ELEMENTS:

- (a) Guardian Queen with INHERENT knowledge from birth ✓
- (b) Direct barrier connection, NO INTERMEDIARY ✓
- (c) SOLO examination authority ✓
- (d) INSTANT decisions based on instincts ✓

YOUR CLAIM 1 ELEMENTS (from your application):

- (a) Guardian Queen with AMNESIA ✗ (different!)
- (b) Wolf King ATTORNEY bonded to Queen ✗ (NEW element!)
- (c) Bond ENABLES protocol transfer ✗ (NEW element!)
- (d) Bond manifests PHYSICALLY ✗ (NEW element!)
- (e) Digital integration, viral documentation ✗ (NEW element!)

"See?" Alexander showed her the phone. "For the All Elements rule, Issac has to show that the Original Queen's patent discloses EVERY element of YOUR patent. But look—she doesn't have elements (b), (c), (d), or (e). She explicitly EXCLUDES them in her Claim 3."

"So her patent doesn't anticipate mine because it's missing elements."

"Exactly! That's how we overcome the § 102 rejection." His ears were perked up fully now, excited. "We can write: 'Examiner's rejection under All Elements rule fails because prior art reference explicitly excludes attorney bond element. See OGQ Claim 3: requires NO attorney. Applicant's invention claims the OPPOSITE: bond-dependent operation. Prior art lacks elements (b), (c), (d), (e) of applicant's Claim 1. Therefore NOT anticipated.'"

Athelia was grinning now. "We can beat § 102."

"Yes. But § 103 is harder. Just because it's NOVEL doesn't mean it's NON-OBVIOUS. We need secondary considerations."

"The evidence that it took a long time, people failed, it was unexpected..."

"Right. Keep looking. There has to be something about what happened AFTER she disappeared."

Athelia flipped through more pages. Found a section in different handwriting—added much later, by different hands:

ADDENDUM TO ORIGINAL PATENT TERMINAL DISCLAIMER

Original Guardian Queen [name] disappeared Year of Silent Thunder (1772 CE). Age: 94 years Years of service: 47 years (1725-1772) Cause of disappearance: UNKNOWN Heir apparent: NONE Successor: NONE Bloodline inheritance FAILED. Protocols did not transfer to next generation. **ATTEMPTS TO REACTIVATE GUARDIAN QUEEN SYSTEM: Candidate 1 (1774): FAILED** Reason: Amnesia barrier could not be overcome. Protocols attempted download but candidate could not parse information. Integration 0%. Examination impossible. **Candidate 2 (1776): FAILED** Reason: Attempted solo operation per OGQ model. Barrier rejected candidate. No inherent protocol knowledge present. Cannot operate without pre-existing knowledge. **Candidate 3 (1801): FAILED** Reason: Protocols began download. Candidate experienced severe pain, cognitive fracturing. Terminated examination after 6 hours. Integration 15%. Insufficient for operation. **Candidate 4 (1823): FAILED** Reason: Protocols downloaded successfully but candidate LOST HUMAN IDENTITY. Became pure protocol construct with no consciousness. Unable to make reasoned judgments. System failure. **Candidate 5 (1847): FAILED** Reason: Amnesia barrier too severe. No integration occurred. 0% download.

The list continued. Page after page. Candidate after candidate. Each marked FAILED. Each with detailed reasons.

Athelia photographed every page, her hands shaking slightly.

Alexander read over her shoulder, ears swiveling as he scanned entries:

"Candidate 23, 1934: Failed. Integration reached 47% then reversed. Candidate lost all memory of attempt."

"Candidate 31, 1967: Failed. Attempted to use technological assistance. Protocols rejected artificial interface. Integration 0%."

Finally, the last entry:

Candidate 47 (2019): FAILED Reason: Amnesia barrier absolute. Candidate rejected examination entirely. Refused to proceed after initial barrier contact. No download attempted. **CONCLUSION - Archive Division Report (2020):** After 247 years and 47 documented attempts, NO CANDIDATE has successfully overcome amnesia barrier to activate Guardian Queen protocols. The Original Guardian Queen system model is OBSOLETE. Solo operation REQUIRES inherent knowledge from birth. No candidate possesses this. Amnesia = FATAL FLAW that cannot be overcome through training, technology, or force of will. **Recommendation:** Abandon Guardian Queen bloodline inheritance model. **Prediction:** Barrier will collapse within 50 years without functional Guardian Queen. Estimate: 2070 CE complete failure. **Status:** CRISIS. UNSOLVED. NO VIABLE SOLUTION IDENTIFIED. Signed: Elder Karenth, Council Archive Division Witness: Marcus [Beta, Wolf Territories] Witness: Erikson [Guardian Division] Date: February 15, 2020

Athelia finished photographing. Looked at Alexander. "Forty-seven attempts. Two hundred forty-seven years. Every single one failed because of amnesia."

"And you SUCCEEDED." Alexander's voice was quiet. Intense. "You're Candidate 48. And you succeeded where forty-seven others failed. Because of the BOND."

"That's secondary considerations."

"That's ALL the secondary considerations." He started ticking off on his fingers:

"LONG-FELT NEED: Two hundred forty-seven years without a solution. That's long-felt."

"FAILURE OF OTHERS: Forty-seven documented attempts by qualified candidates. All failed. That's extensive failure."

"UNEXPECTED RESULTS: The bond enabled protocol transfer DESPITE amnesia. Nobody predicted that would work. That's unexpected."

"SKEPTICISM OF EXPERTS: The Archive Division declared it UNSOLVED in 2020. The Council voted against you. Experts said amnesia was a fatal flaw. You proved them wrong."

Secondary Considerations (§ 103) - CRITICAL for Patent Bar exam. Can overcome prima facie obviousness even when invention seems simple. LONG-FELT NEED + FAILURE OF OTHERS + UNEXPECTED RESULTS + SKEPTICISM = strong non-obviousness case.

Athelia was writing in the air again—binary flowing from her fingers in glowing gold streams:

01000111 01110010 01100001 01101000 01100001 01101101 00100000 01100110
01100001 01100011 01110100 01101111 01110010 00100000 00110100

She translated automatically: "Graham factor four. Secondary considerations dispositive. Evidence overcomes prima facie obviousness."

She looked at Alexander. "We can beat § 103."

"Yes. With this evidence, yes."

"And § 112 enablement?"

Athelia grinned. "You sound like a patent attorney."

"I AM a patent attorney." His ears perked up. "Apparently."

They spent another thirty minutes photographing everything. Every page of the Original Queen's patent. Every failed candidate entry. The Archive Division's conclusion. The signatures of Marcus and Erikson as witnesses.

All of it evidence. All of it ammunition for their response.

Finally, Athelia found one more section. Hidden at the very back of the tome. A single page in the Original Queen's own hand:

INVENTOR'S FINAL NOTE To whoever finds this— If you are reading this, I am gone. Either dead or disappeared into the barrier itself (I suspect the latter will claim me). I thought solo operation was strength. I thought independence was the only way. I was wrong. This burden—this **WEIGHT** of protocols, of examination, of absolute authority—it is not meant to be carried alone. I have no partner. No attorney. No bond. I thought I didn't need one. But after 47 years, I feel myself fading. The protocols are consuming who I was. Soon there will be only the Guardian Queen. The woman I was will be gone. This is the flaw in my system. This is what I got wrong. Do not make my mistake. If you have found a way to balance this burden—if you have found a way to remain **YOURSELF** while becoming Guardian Queen—hold onto that balance fiercely. You are not just a Guardian Queen. You are a **PERSON**. Do not let the protocols erase who you are. And if you have someone with you—a partner, a bond, an anchor to your humanity—do not let them go. That is the real invention. That is what I failed to create. - [Signature: First Guardian Queen] Written: Year of Silent Thunder, 1772 My 94th year, my last entry

Athelia's hands were shaking as she photographed it.

"She knew," Athelia whispered. "She knew the solo model would consume her. And she couldn't stop it because she had no bond. No partner. No way to stay human."

Alexander's hand found hers. Squeezed gently. "You won't lose yourself. Because you have the bond. Because you have me."

"The bond is what makes it work."

"The bond IS the invention."

They stood in the archive, surrounded by centuries of failed attempts, holding the evidence that would save Athelia's application.

And prove they'd solved a three-hundred-year-old problem.

"We should go," Alexander said. "Casey's waiting. And we have sixty-eight hours to write this response."

They walked back through the examination center. Past carved claims. Past glowing runes. Toward the shimmer that marked the barrier.

Before stepping through, Athelia looked back at the archive chamber one last time.

"Thank you," she whispered. To the Original Queen. To the forty-seven failed candidates. To everyone who'd tried and taught them what NOT to do.

Then they crossed.

Reality inverted. Compressed. Released.

Human world. Normal air. Tourists taking photos.

Casey rushed over. "You're BACK! You've been gone two and a half HOURS!"

Alexander checked his phone. "Twenty-seven minutes for us. Time dilation."

"I DON'T CARE ABOUT TIME DILATION! You disappeared into MAGIC!"

"We found everything," Athelia said, holding up her phone with hundreds of photographs. "The Original Queen's patent. Forty-seven failed candidates. Evidence for every secondary consideration. Everything we need to overcome all four rejections."

Casey looked at the countdown timer. **68:32:15.**

"Then let's go. You have a response to write."

"Not yet."

They all turned. Severen stood near Casey's car, leaning against the driver's door like he'd been there all along. Sapphire eyes fixed on Athelia's phone.

"You found it," he said. Not a question.

"The Original Queen's patent," Alexander confirmed. "All the failed candidates. The Archive Division's conclusion. Everything."

"Show me."

Athelia pulled up the photographs. Scrolled through them. The claims. The addendum. The inventor's final note.

Severen studied each image carefully. His expression never changed, but his eyes grew brighter with each page.

"Claim 3," he murmured. "'Requires no attorney or bonded partner.' She explicitly excluded the very element that makes your invention work."

"That's the § 102 kill shot," Alexander said.

"And the forty-seven failures?" Severen looked up. "All documented? Dates, reasons, signatures?"

"Every one. From 1774 to 2019. All failed because of amnesia. All attempted solo operation." Athelia's voice was stronger now. "We succeeded because of the bond. That's the secondary consideration evidence."

Severen was quiet for a long moment. Then: "You have what you need. § 102 fails on All Elements rule. § 103 falls to secondary considerations. § 101 and § 112 are straightforward once you establish the bond as enabling mechanism."

"You're sure?" Athelia asked.

"I counseled forty-seven candidates before you. Watched every one of them fail." His sapphire eyes met hers. "You're the first to find the evidence. The first to understand what makes you different. The first to prove the bond is the invention."

He stepped away from the car. "Sixty-eight hours. Use them well. And Athelia?"

She looked up.

"When you write the response—let the protocols help. But don't let them erase who you are. The Original Queen's final note wasn't wrong. This burden consumed her because she carried it alone." His gaze shifted to Alexander. "You have the bond. Use it."

Then he was gone. Not walked away—just gone. Like he'd never been there at all.

Casey stared at the empty space. "Does he always do that?"

"Yes," Alexander said.

They drove back to Flagstaff. Athelia opened her laptop in the passenger seat. Started organizing photographs. Building the structure of their response.

Binary flowed across the screen. She translated without thinking now. Her handwriting shifted between modern and ancient mid-word.

The integration was accelerating.

But she had the evidence. She had the law. She had Alexander.

And she had sixty-eight hours to prove they were patentable.

— END CHAPTER SEVEN —

STATUTORY REFERENCE INDEX - Chapter 7

Key Patent Statutes (Office Action Rejections):

- 35 U.S.C. § 101 - Utility requirement (specific, substantial, credible)
- 35 U.S.C. § 102 - Novelty/Anticipation (All Elements rule)

- 35 U.S.C. § 103 - Obviousness (Graham factors + secondary considerations)
- 35 U.S.C. § 112(a) - Enablement (must teach PHOSITA how to make/use)

USPTO Procedures:

- 37 CFR § 1.135(a) - Abandonment for failure to respond to Office Action
- 37 CFR § 1.56 - Duty of candor and good faith to USPTO
- 37 CFR § 11.303 - Candor toward the tribunal

Key Case Law:

- *Graham v. John Deere (1966)* - Four-factor test for obviousness under § 103
- *KSR v. Teleflex (2007)* - "Obvious to try" standard
- *In re Fisher (2005)* - Specific utility requirement

Critical Patent Concepts:

- **All Elements Rule** - § 102 anticipation requires SINGLE reference showing ALL claimed elements
- **PHOSITA** - Person Having Ordinary Skill In The Art (benchmark for enablement/obviousness)
- **Secondary Considerations** - Objective evidence overcoming prima facie obviousness
- **Long-Felt Need** - Problem existed for extended time without solution
- **Failure of Others** - Others attempted but failed to solve problem
- **Unexpected Results** - Invention achieved results not predicted by prior art

- Skepticism of Experts - Experts doubted invention would work

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.

Utility Requirements (case law):

SPECIFIC UTILITY: Must identify a particular use, not vague general utility. "Chemical compound" ✗ too vague. "Chemical compound for treating lung cancer" ✓ specific.

SUBSTANTIAL UTILITY: Must provide real-world benefit, not trivial improvement. Must be more than insignificant.

CREDIBLE UTILITY: PHOSITA must believe invention works. No perpetual motion machines. Must not violate known scientific principles.

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 OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

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

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

ALL ELEMENTS RULE: For anticipation under § 102, a *SINGLE* prior art reference must disclose *EVERY* element of the claimed invention. If even one element is missing from the reference, the claim is *NOT* anticipated. Multiple references can be combined only for § 103 obviousness analysis, *NOT* for § 102.

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.

GRAHAM v. JOHN DEERE FOUR-FACTOR TEST (1966):

Factor 1: *Scope and content of prior art - What did the prior art teach?*

Factor 2: *Differences between prior art and claimed invention - What's new?*

Factor 3: *Level of ordinary skill in the art - What would PHOSITA know/think?*

Factor 4: *Secondary considerations - Objective evidence of non-obviousness*

SECONDARY CONSIDERATIONS (Factor 4) - Critical for Patent Bar:

- **Commercial success** - *Invention succeeded in marketplace*
- **Long-felt need** - *Problem existed for extended time without solution*
- **Failure of others** - *Others tried and failed to solve the problem*
- **Unexpected results** - *Invention achieved unpredicted results*
- **Copying by competitors** - *Others copied the invention*
- **Licensing** - *Others paid to use the invention*
- **Skepticism of experts** - *Experts said it wouldn't work*

These objective factors can overcome a prima facie case of obviousness even when the invention seems simple on its face.

35 U.S.C. § 112(a) - Specification - Enablement

(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.

ENABLEMENT TEST:

1. Can PHOSITA make the invention from the specification?
2. Can PHOSITA use the invention from the specification?
3. Can they do so WITHOUT UNDUE EXPERIMENTATION?

PHOSITA = Person Having Ordinary Skill In The Art. Legal fiction representing someone with ordinary (not exceptional, not minimal) skill in the relevant technical field. The benchmark for both enablement and obviousness analysis.

37 CFR § 1.135(a) - Abandonment for Failure to Respond

(a) Failure to reply to any Office communication. If an applicant fails to reply within the time period provided under §§ 1.134 and 1.136, **the application will become abandoned unless such reply is accompanied by a petition for revival** including the fee set forth in § 1.17(m) granted under § 1.137.

Note: This is THE critical deadline rule. Miss your Office Action response deadline = application ABANDONED. Response period is typically 3 months (extendable to 6 months with fees). In Chapter 7, Athelia has 72-hour deadline under Old Law prosecution rules.

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.

(b) 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 patentability of any claim remaining under consideration in the application.

37 CFR § 11.303 - Candor Toward the Tribunal

(a) A practitioner shall not knowingly:

- (1) Make a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner;
- (2) Fail to disclose to the tribunal legal authority in the controlling jurisdiction known to the practitioner to be directly adverse to the position of the client and not disclosed by opposing counsel; or
- (3) Offer evidence that the practitioner knows to be false.

Note: In Chapter 7, Malacar cites this rule when Alexander tries to hide his wolf ears with a hoodie. Physical manifestations of the bond are

EVIDENCE of the attorney-client relationship and must remain visible during prosecution.

KEY CASE LAW - OBVIOUSNESS & UTILITY

Graham v. John Deere Co., 383 U.S. 1 (1966)

ISSUE: What is the proper test for determining obviousness under 35 U.S.C. § 103?

HOLDING: Supreme Court established four-factor framework for obviousness analysis (the "Graham factors"):

1. **Scope and content of the prior art**
2. **Differences between the prior art and the claims at issue**
3. **Level of ordinary skill in the pertinent art**
4. **Secondary considerations (objective indicia of non-obviousness)**

CRITICAL PRINCIPLE: Obviousness is a question of law based on underlying factual findings. These four factors provide the factual framework. Courts must avoid hindsight bias—can't use the invention itself as a roadmap to find it obvious.

SECONDARY CONSIDERATIONS (FACTOR 4) - THE KEY TO CHAPTER 7:

- **Commercial success** - Product successful in marketplace
- **Long-felt but unsolved need** - Problem existed for years without solution
- **Failure of others** - Others tried and failed to solve the problem
- **Unexpected results** - Invention achieved unpredicted advantages

- **Copying by competitors** - Others imitated the invention
- **Licensing** - Others willing to pay for the technology
- **Skepticism of experts** - Experts doubted it would work
- **Industry praise** - Recognition within the field

Secondary considerations can OVERCOME prima facie obviousness. If examiner establishes that combining prior art references would be obvious, applicant can rebut with secondary considerations evidence. In Chapter 7, Athelia finds ALL the secondary considerations: 247 years (long-felt need), 47 failed candidates (failure of others), Archive Division declared it unsolved (skepticism), bond achieved integration despite amnesia (unexpected results).

EXAM TIP: *Graham factors appear on EVERY Patent Bar exam. Know all four. Factor 4 (secondary considerations) can save an otherwise weak application.*

KSR International Co. v. Teleflex Inc., 550 U.S. 398 (2007)

ISSUE: Whether Federal Circuit's rigid application of "teaching-suggestion-motivation" (TSM) test was too restrictive for determining obviousness.

HOLDING: Supreme Court rejected rigid TSM test. **Obviousness analysis cannot be confined to explicit teachings in prior art.** Courts and examiners can use common sense, ordinary creativity, and predictable variations when determining whether invention would be obvious to PHOSITA.

KEY PRINCIPLES FROM KSR:

1. **"Obvious to Try":** When there are finite number of identified, predictable solutions and PHOSITA has good reason to pursue known options, trying them is likely obvious. But "obvious to try" requires:

- **Finite** number of solutions (not unlimited options)
- **Predictable** results from trying each option
- **Reasonable expectation of success**

2. Market Forces: Demand in marketplace can be reason to combine prior art elements

3. Design Incentives: If prior art creates obvious design need, satisfying that need may be obvious

4. Common Sense: Examiners can use common sense when determining whether combination is obvious

BUT - KSR STILL REQUIRES ARTICULATED REASONING:

Examiner can't just say "common sense" without explanation. Must provide reasoned analysis of why PHOSITA would make the combination.

Application in Chapter 7: Isaac argues it's "obvious to try" substituting modern queen for historical queen with predictable results (Graham Factor 3). But Athelia's secondary considerations rebut this—47 failures show it was NOT predictable, NOT finite solutions, and NO reasonable expectation of success.

In re Fisher, 421 F.3d 1365 (Fed. Cir. 2005)

ISSUE: Whether claimed ESTs (expressed sequence tags - short DNA sequences) have specific and substantial utility under 35 U.S.C. § 101 when used only as research tools to identify genes.

HOLDING: ESTs lack specific utility where applicant identifies only general research uses. To satisfy § 101, invention must have **specific, substantial, and credible utility**.

SPECIFIC UTILITY REQUIREMENT:

- Must identify PARTICULAR USE, not vague general utility
- "Tool for further research" is NOT specific enough

- Must show REAL-WORLD APPLICATION providing concrete benefit

EXAMPLES FROM CASE:

- ✗ "ESTs can be used to identify genes" - TOO VAGUE
- ✗ "Chemical compound with pharmaceutical potential" - TOO GENERAL
- ✓ "Chemical compound for treating lung cancer" - SPECIFIC
- ✓ "EST identifying BRCA1 gene for cancer diagnosis" - SPECIFIC

SUBSTANTIAL UTILITY: Utility must be significant, not trivial.
"Makes baseballs fly 1 inch farther" might be too insignificant.

CREDIBLE UTILITY: PHOSITA must believe invention works.
Specification must provide evidence or persuasive reasoning that utility is achievable.

Application in Chapter 7: Isaac's § 101 rejection challenges whether "Guardian Queen examination protocols" are specific enough. Athelia must identify WHAT gets examined, HOW examination works, and WHY it benefits the public—not just vague "examination duties." The bond-enabled protocol transfer provides the specific, substantial, credible utility.

END FULL STATUTORY TEXT

Fractured Crown: Old Law - Patent Law Textbook Edition

Chapter 7 - Office Action | © 2025 Marjorie McCubbins & Master Aether

Evidence obtained. Response begins. The clock is ticking.

SUMMARY - PATENT LAW CONCEPTS TAUGHT

1. Office Action Structure and Types

Office Actions are official USPTO communications rejecting or objecting to claims. **Non-Final Office Action** (37 CFR § 1.104) is the first substantive examination communication, allowing full claim amendments and arguments. **Final Office Action** comes after applicant's response to Non-Final, restricting amendment options significantly. **Advisory Action** responds to amendments after Final, indicating whether they overcome rejections. **Notice of Allowance** under 35 U.S.C. § 151 issues when all claims are allowed. **Restriction Requirement** under § 121 forces election between independent and distinct inventions before substantive examination begins.

2. Rejection Types Under Patent Statutes

§ 102 Anticipation: Single prior art reference discloses every claim limitation ("all elements" rule). **§ 103 Obviousness:** Combination of prior art references makes claimed invention obvious to PHOSITA. **§ 112(a) Enablement:** Specification doesn't teach PHOSITA how to make and use invention. **§ 112(b) Indefiniteness:** Claims don't particularly point out and distinctly claim the invention. **§ 101 Eligibility:** Claims directed to abstract idea (Alice/Mayo framework), law of nature, or natural phenomenon without significantly more.

3. Response Requirements and Deadlines

37 CFR § 1.134 establishes 3-month statutory period to respond to Office Actions, extendable to 6 months total with extension fees increasing monthly. **Must respond to EVERY rejection and objection** - cannot pick and choose which to address. Applicant can **amend claims, argue, or both** in response. **Failure to timely respond = abandonment** under 37 CFR § 1.135(a), though petition

to revive possible under § 1.137 (unintentional) or § 1.138 (unavoidable) with fees and showing.

4. Claim Amendments - No New Matter Rule

35 U.S.C. § 132(a) prohibits amendments adding **new matter** not supported by original disclosure. Amendments must be **narrowing** (adding limitations) to overcome prior art - broadening amendments only allowed in continuing applications. **Dependent claims strategy**: Convert broader independent claim into dependent claim of narrower independent, preserving claim scope range. **Continuation applications** allow pursuit of non-elected subject matter or broader claim scope without new matter restriction from parent's disclosure.

5. Arguments Against Rejections

Distinguishing prior art: Identify claim limitations not disclosed in cited references. **Teaching away doctrine**: Prior art actively discourages claimed combination (stronger than merely disclosing alternatives). **Secondary considerations** under § 103: commercial success, long-felt need, failure of others, unexpected results, copying by competitors. **Unexpected results**: Claimed invention achieves results not predictable from prior art teachings. **Commercial success with nexus**: Success must result from claimed features, not unrelated factors like marketing.

6. Examiner Interview Practice

MPEP § 713 governs examiner interviews. **Telephonic vs. in-person**: Remote interviews common, in-person at USPTO available. **Pre-appeal brief conferences**: Last attempt to resolve rejections before formal PTAB appeal. **Interview summary requirement**: Examiner must record substance of interview on record - ensure accuracy. Interviews allow real-time discussion of rejections, clarification of claims, proposed amendments, and often compact prosecution significantly by resolving misunderstandings.

7. Restriction Requirements Under § 121

35 U.S.C. § 121 allows examiner to restrict examination to one invention when claims encompass **independent and distinct inventions**. Applicant must **elect species** or group for examination. **Traverse vs. election without traverse**: Can challenge restriction while electing (preserves right to petition Director). **Divisional applications** allow pursuit of non-elected inventions with benefit of parent filing date under § 120. Restriction avoids forcing examiner to search multiple unrelated fields.

8. Final Office Action Response Strategy

After Final, amendments limited to placing application in condition for allowance (37 CFR § 1.116). **RCE (Request for Continued Examination)** under 37 CFR § 1.114 reopens prosecution, converting Final to Non-Final for fee. **Appeal to PTAB** under 35 U.S.C. § 134 challenges examiner's rejections on legal/factual grounds. **Continuation application filing** maintains prosecution with fresh examination while Final prosecution pending. Strategic choice depends on strength of rejections, claim scope goals, and timing/budget constraints.

DISCUSSION QUESTIONS

1. Narrowing vs. Broadening Amendments

Question: Applicant receives § 102 rejection citing Reference A disclosing "metal fastener." Original claim 1 recites "steel fastener." Can applicant amend claim 1 to recite "fastener" (removing "steel" limitation) to avoid Reference A which only discloses metal, not all materials?

Analysis Points: This is a broadening amendment - removing limitations expands claim scope. Broadening amendments prohibited during prosecution of pending application (only allowed in reissue or continuation using original disclosure). Proper strategy: Argue steel is patentably distinct from generic

metal, or add different narrowing limitation (e.g., specific structural feature) while potentially keeping "steel." If broadening desired, file continuation claiming benefit to original filing date.

2. Restriction Requirement Strategy

Question: Examiner issues restriction requirement forcing election between (Group I) method claims and (Group II) apparatus claims. Both seem related to same invention. Should applicant traverse the restriction, elect without traverse, or simply elect? What are strategic considerations?

Analysis Points: Traverse challenges restriction propriety, preserving right to petition Director if restriction improper. Election without traverse accepts restriction, limiting ability to challenge. If inventions truly related (apparatus and method of using apparatus), strong traverse argument exists - single inventive concept. Consider: (1) strength of restriction (clear independence?), (2) cost of divisional vs. benefit of challenge, (3) examination delay from petition. Often elect Group I with traverse, file divisional for Group II to preserve all rights while advancing prosecution.

3. Final Office Action Response Options

Question: After Final rejection under § 103, applicant has three options: (A) RCE with amended claims, (B) Appeal to PTAB, (C) File continuation with new claims. Compare strategic advantages and disadvantages of each option.

Analysis Points: **RCE:** Pros - reopens prosecution, allows full amendments, relatively quick. Cons - costs RCE fee, no guarantee of allowance, same examiner. **Appeal:** Pros - challenges rejection on merits, fresh review by APJs, can win on law/facts. Cons - expensive, slow (1-2 years), technical brief required, might lose and need RCE anyway. **Continuation:** Pros - fresh examination, potential different examiner, preserves parent filing date, can pursue different claim scope. Cons - new filing fees, resets prosecution, doesn't resolve whether original claims

allowable. Choice depends on: rejection strength, claim scope importance, budget, timeline urgency.

4. Interview Effectiveness Timing

Question: When should applicant request examiner interview? (A) Before first Office Action, (B) After Non-Final Office Action before responding, (C) After Final Office Action, (D) During appeal? What can be accomplished in interview vs. written response?

Analysis Points: Pre-first-action interview (MPEP § 713.01): Can clarify claims, discuss prior art, shape examination direction - often productive. **After Non-Final:** Most common - discuss rejections, propose amendments, resolve misunderstandings. **After Final:** Critical for compact prosecution - propose specific amendments, get examiner agreement before filing RCE/continuation. **Pre-appeal conference:** Last chance to avoid appeal - examiner and supervisory examiner review. Interviews excel at: clarifying claim scope, explaining technical distinctions, proposing concrete amendments, building examiner relationship. Written responses better for: complex legal arguments, detailed technical evidence, creating prosecution history record.

5. New Matter Prohibition

Question: Applicant receives § 112(a) enablement rejection: "Specification doesn't teach how to synthesize claimed pharmaceutical compound." Applicant wants to add paragraph to specification describing detailed synthesis procedure based on inventor's later lab work. Why does this violate 35 U.S.C. § 132(a) new matter prohibition?

Analysis Points: § 132(a) prohibits introducing new matter - subject matter not present in application as filed. Synthesis procedure from post-filing lab work was not in original specification, so it's new matter even if invented by same inventor. Adding it would give applicant benefit of original filing date for subject matter not disclosed until later (unfair). Proper

responses to § 112(a): (1) Argue specification already enables (cite specific passages), (2) Show knowledge in art makes synthesis routine, (3) Cite prior art disclosing synthesis method, (4) If truly not enabled, consider: abandoning claims, filing CIP (continuation-in-part) with new matter but loses filing date benefit, or narrowing claims to enabled embodiments. Critical lesson: **disclosure at filing determines maximum claim scope** - cannot bootstrap later developments.

CASE STUDY: In re Oetiker

Federal Circuit, 1992 - 977 F.2d 1443

Facts

Patent application claimed mechanical ear clamp for hoses with specific inwardly-bent closure panel design. Examiner rejected claims under § 103 as obvious over combination of two references: (1) Kalnberz reference disclosing ear clamp with outwardly-bent closure panel, and (2) Calmettes reference showing inwardly-bent panel in different fastener context. Applicant argued references could not be combined because Kalnberz **taught away** from inward-bending design by expressly preferring outward-bending and criticizing inward designs as inferior.

Legal Issue

Does prior art reference "teach away" from claimed invention when it discloses alternative approach and expresses preference for that alternative, or must reference expressly criticize or discourage the specific claimed combination to constitute teaching away?

Holding

Federal Circuit held that prior art reference does **not** teach away merely by disclosing alternative approach or expressing preference for different embodiment. To constitute "teaching

away," reference must criticize, discredit, or otherwise discourage investigation into the claimed solution. Kalnberz's preference for outward-bending did not teach away from inward-bending - merely disclosed alternative. Court affirmed obviousness rejection.

Legal Standard Established

Teaching Away Doctrine: Prior art teaches away when it explicitly or implicitly discourages following path that leads to claimed invention. Mere disclosure of alternatives or preferences does NOT teach away. Must show reference would discourage skilled artisan from pursuing claimed approach.

"Teaching away" requires more than preference for alternative: Reference must actively discourage or criticize claimed approach. Standard is high - protects against hindsight bias in § 103 analysis. Showing teaching away is powerful rebuttal to prima facie obviousness because it demonstrates skilled artisan would not have been motivated to make claimed combination even if references technically disclose all elements.

Significance for Patent Prosecution

This case is critical for responding to § 103 obviousness rejections based on combinations of references. When examiner combines Reference A and Reference B, applicants often argue A "teaches away" from B. Oetiker clarifies this argument requires showing Reference A actively discourages using Reference B's teaching, not merely that A prefers different approach.

Practical application in Office Action responses:

- **Weak teaching-away argument:** "Reference A discloses Method X while Reference B discloses Method Y, so A teaches away from B" - Fails under Oetiker
- **Strong teaching-away argument:** "Reference A expressly states Method Y would cause mechanical failure and should be avoided" - Succeeds under Oetiker

Connection to Chapter 7

Alexander's Office Action response in Chapter 7 includes § 103 obviousness rejection combining multiple prior art references. He must determine whether any references teach away from the combination. The Oetiker standard shapes his argument strategy - he cannot merely argue references disclose alternatives; he must show the references actively discourage the claimed combination. This demonstrates the precision required in patent prosecution arguments and why understanding Federal Circuit precedent is essential for effective Office Action responses.

USPTO Exam Connection: Teaching away is heavily tested on Patent Bar exam. Fact patterns often include reference stating "Method A is preferred" and ask whether this teaches away from Method B - answer is NO under Oetiker. Need explicit discouragement or criticism.

COMPLETE STATUTORY TEXT

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. § 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. § 134 - Appeal to Patent Trial and Appeal Board

(a) **Patent Applicant.** - An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) **Patent Owner.** - A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

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

(a) The reply by the applicant or patent owner to a non-final Office action under § 1.104 must be made within the time period set for reply in the Office action. The time period for reply expires on the date on which the time period is due to expire under the provisions of paragraph (c) of this section. Extensions of time are governed by § 1.136.

(b) The reply by the applicant or patent owner must be reduced to writing and 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 reply to a requirement (35 U.S.C. 112) or to an objection or rejection claiming lack of enablement or lack of written description (35

U.S.C. 112(a)) may be deferred until an objection or rejection under 35 U.S.C. 112(b) or (d) has been made.

37 CFR § 1.121 - Manner of Making Amendments in Applications

(a) Amendments in applications and reexamination proceedings:

(1) Amendments in applications (including reissue applications) and ex parte reexamination proceedings must be made in one of the following manners:

(i) **Replacement paragraph(s):** By submitting the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (c) of this section to show all changes relative to the previous version of the paragraph.

(ii) **Replacement page(s):** For drawings, by submitting replacement pages including markings to show all changes relative to the previous version.

(b) Amendments in the specification, claims, or abstract must be made by submission of the entire text of a paragraph changed or added, together with an instruction to cancel, replace, or add a paragraph.

37 CFR § 1.134 - Time for Reply by Applicant

(a) The date of a notice of allowance or Office action is the date indicated on the notice or Office action, as evidence of which the Office will accept the postmark or indication of actual mailing date. The three-month period in which to reply to an Office action in an application (including a reexamination proceeding) or a patent under reexamination runs from the date the Office action was mailed. Extensions of time are governed by § 1.136.

(b) The period for reply expires on the same day of the month as the date on which the Office action was mailed or given. If

the day of the month is missing because the month has insufficient days, the period for reply expires on the last day of the month. If the day of the month is missing, the period for reply expires on the last day of the month.

MPEP § 713 - Examiner Interviews

Purpose: Interviews between examiners and applicants (or applicant's representatives) are encouraged as they often advance prosecution efficiently by clarifying issues, discussing claim interpretation, and resolving rejections that may be based on misunderstandings.

Interview Summary Requirement: Examiner must make a complete written record of each substantive interview. The summary must include (1) date of interview, (2) participants, (3) claims discussed, (4) substance of interview including objections and rejections discussed, applicant's positions, and examiner's responses, and (5) description of any agreed-upon amendments or actions. Applicant has right to file statement within one month confirming or correcting interview summary.

Pre-First-Action Interview Pilot Program (§ 713.01): Allows applicant to request interview before first Office Action. Can be productive for establishing claim scope, discussing prior art approach, and setting examination direction.

Conduct of Interviews: Interviews may be conducted in person at USPTO, via telephone, or via video conference. Personal interviews generally limited to applications where issues cannot be adequately addressed remotely. Telephonic interviews are most common for routine claim/rejection discussions.

STATUTORY REFERENCE INDEX - Chapter 7

- 35 U.S.C. § 132 - Notice of rejection; No new matter in amendments
- 35 U.S.C. § 133 - Time for prosecuting application; Abandonment
- 35 U.S.C. § 134 - Appeal to Patent Trial and Appeal Board
- 35 U.S.C. § 121 - Divisional applications (restriction requirements)
- 37 CFR § 1.104 - Nature of examination; Non-final Office Action
- 37 CFR § 1.111 - Reply to non-final Office Action
- 37 CFR § 1.114 - Request for Continued Examination (RCE)
- 37 CFR § 1.116 - Final rejection; Reply to final Office Action
- 37 CFR § 1.121 - Manner of making amendments
- 37 CFR § 1.134 - Time for reply; Extensions
- 37 CFR § 1.135 - Abandonment for failure to respond
- 37 CFR § 1.136 - Extensions of time
- MPEP § 713 - Examiner interviews
- Case Law: In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992) - Teaching away doctrine