

ABSTRACT

Racing against the statutory deadline (13 minutes until midnight), Alexander, Athelia, and Casey finalize their Office Action response with system claims that incorporate the Guardian Queen bond as a claimed element. This chapter teaches claim drafting fundamentals: system/apparatus claims vs. method claims, claim differentiation doctrine, transition phrases ("comprising" vs. "consisting"), and strategic use of independent/dependent claim structures. When the claims are allowed, the chapter covers Notice of Allowance procedures, prosecution history estoppel (how claim amendments during prosecution limit patent scope), patent term calculation, and post-allowance procedures including issue fees and maintenance fees. The narrative demonstrates that the examination relationship itself can be part of the invention - a meta-encoding of patent law as system of relationships, not just technology.

CHAPTER NINE - WE ARE THE PATENT

Old Law: Jurisprudence of Myth (Patent Law Edition)

Tuesday Night - The Revelation

Tuesday, 11:47 PM. Thirteen minutes before the deadline.

They'd been writing for seventy-two hours straight.

The apartment looked like a legal bomb had gone off. Papers everywhere—photographs from the archive, printouts of constitutional cases, scribbled notes in three different handwritings (Athelia's messy scrawl, her new elegant script, and Alexander's precise attorney notation). Coffee cups stacked in pyramids. Casey passed out on the couch three hours ago, laptop still open beside her.

Athelia and Alexander sat at her desk, surrounded by documentation. Seventy-three pages of response spread across every available surface.

She was writing the final section—the claims. The part that defined exactly what they were seeking protection for.

Her hand moved across the page:

AMENDED CLAIMS

CLAIM 1: A system for maintaining jurisdictional barriers between Old Law and modern human law, comprising: (a) a Guardian Queen examiner with amnesia-resistant protocol integration capability; (b) a Wolf King attorney bonded to said Guardian Queen through attorney-client privilege under 37 CFR § 11.106; (c) wherein said bond enables transfer of examination

protocols from attorney to Guardian Queen despite memory barriers; (d) wherein said bond manifests physically as visible markers in both parties; (e) wherein said system operates across jurisdictional boundaries and integrates with modern digital documentation systems. CLAIM 2: The system of Claim 1, wherein said bond formation prevents identity loss during protocol integration. CLAIM 3: The system of Claim 1, wherein said Guardian Queen operates WITH attorney partnership rather than solo operation. CLAIM 4: The system of Claim 1, wherein said bond enables response capability to Office Actions during prosecution.

Alexander read over her shoulder. His ears perked up slowly. "Wait. That's not... that's not describing protocols. That's describing YOU."

Athelia kept writing.

"And that's me," Alexander whispered, pointing at element (b).

Athelia's hand moved to element (c): wherein said bond enables transfer of examination protocols from attorney to Guardian Queen despite memory barriers...

His hand went to his ears. Her hand went to her chest, where the bond pulsed warm.

Element (d): wherein said bond manifests physically as visible markers in both parties...

Element (e): wherein said system operates across jurisdictional boundaries and integrates with modern digital documentation systems.

#WolfCounselor. Viral videos. Public documentation. Evidence.

Athelia's hand stopped. She stared at what she just wrote.

Silence.

Patent Claims - Define the metes and bounds of the invention. Everything in the claims must be supported by the specification. Claims define what is PROTECTED. This is what you OWN if patent grants.

"This isn't describing examination protocols," she said slowly. "This is describing... us. The bond. The relationship."

Alexander's breathing had stopped. "The invention isn't the Guardian Queen powers. It's the SYSTEM. Queen plus attorney plus bond."

"The original Queen didn't have this." Athelia flipped back through the photographs from Walnut Canyon. "Look. She operated ALONE. No attorney. No bond. Just her and the examination center."

"Which worked fine when she had full memory of protocols from birth," Alexander said. "But YOU have amnesia. You CAN'T operate alone. You need—"

"You." Athelia looked at him. "I need you. The bond is what makes it work. The bond is what transfers the protocols. The bond is what enables examination despite the memory barriers."

"The bond IS the invention," Alexander breathed.

They stared at each other.

Athelia started flipping through their seventy-three-page response with new eyes:

§ 101 UTILITY:

Specific utility: Enables Guardian Queen examination despite amnesia

Substantial utility: Maintains barrier, prevents jurisdictional collapse

Credible utility: Bond demonstrably formed, protocols transferred, examination completed

"We proved the BOND has utility."

§ 102 NOVELTY - All Elements Rule:

Original Queen: solo operation, full memory, pre-constitutional jurisdiction

Claimed invention: bond-enabled operation, amnesia-

resistant, cross-jurisdictional, digitally integrated
Prior art LACKS element (b): Wolf King attorney bond
Prior art LACKS element (c): bond-enabled protocol transfer
Therefore NOT anticipated

"We proved the BOND is novel. The original Queen didn't have an attorney. Didn't have the bond. That's what's NEW."

§ 103 OBVIOUSNESS - Secondary Considerations:

Long-felt need: 253 years without functioning Guardian Queen
Failure of others: 47 candidates tried solo operation, all failed
Unexpected results: Bond formation enabled success despite amnesia
Commercial success: #WolfCounselor 15M views proves public recognition
Skepticism of experts: Council voted against, said it wouldn't work

"We proved the BOND is non-obvious. Nobody thought it would work. Everyone said a queen with amnesia was impossible. But the bond made it possible."

§ 112 ENABLEMENT:

Specification: The bond itself
Teaching mechanism: Protocol transfer through attorney-client privilege
PHOSITA: Wolf King attorney with examination knowledge
Enablement proven by: Examination completed, downloads successful, integration occurring

"We proved the BOND is the enablement. It's not just evidence of the relationship—it's the MECHANISM that makes everything work."

Specification vs. Claims - Specification DESCRIBES the invention (how it works, what it does). Claims DEFINE the invention (what is protected). Both must align. Claims cannot be broader than specification support.

Alexander's ears were flat against his skull. "We're not defending a patent application about examination protocols."

"We're defending a patent on US," Athelia finished. "On the bond. On the relationship. On the system that is Guardian Queen plus Wolf King Attorney."

"The invention is us. Together."

Athelia looked at the claims she just wrote. At the seventy-three pages of response. At Alexander sitting four feet away with wolf ears that proved the bond was real.

"If we submit this," she said slowly, "and Malacar accepts it... and Issac withdraws his objections... and we get a Notice of Allowance..."

"The bond becomes permanent," Alexander said. "Recognized under patent law. Protected. A granted patent on the attorney-client relationship between Guardian Queen and Wolf King."

"We become permanent."

His ears perked up. Then drooped. "Only if that's what you want."

Alexander flinched. "I know. I'm sorry. I didn't—I didn't know it would be like this. That the bond would be so—"

"Absolute," Athelia finished. "That's what you said. Old Law is absolute."

They sat in silence.

Casey stirred on the couch. Mumbled: "Did you finish the thing?"

"Yeah," Athelia said. "We finished it."

"Cool. Submit it. I wanna sleep in my own bed." Casey rolled over, already asleep again.

Athelia looked at Alexander. At the bond humming between them. At the seventy-three-page document that claimed THEM as an invention.

"What happens if we don't submit it?" she asked.

"Application is abandoned. Bond dissolves. I go back to my realm. You stay here with amnesia and no memory of any of this." His ears were completely flat. "You get your life back."

"And you?"

"I wait another three hundred years for another Guardian Queen who probably won't manifest because the barrier will collapse first." He tried to smile. Failed. "But you'd be free."

"I don't feel free now. I feel like someone else is wearing my body and learning to walk in it."

Alexander's ears drooped further. "I know. I'm sorry."

Athelia pulled up the document. All seventy-three pages. Claims. Arguments. Evidence. Constitutional law and patent law woven together like they're the same language.

Mendez's homework assignment and the Office Action response—they turned out to be exactly the same thing.

She hovered the mouse over SUBMIT.

"If we're the patent," she said quietly, "then we get to decide what we claim. Right?"

Alexander's ears perked up slightly. "What do you mean?"

"The claims define the invention. We wrote them. So we can CHOOSE what they mean." She scrolled to Claim 1. Read it again.

CLAIM 1: A system for maintaining jurisdictional barriers between Old Law and modern human law, comprising...

"This doesn't say the bond controls us," she said. "It says the bond ENABLES us. There's a difference."

"Is there?"

"In patent law? Yes. An element that 'enables' is a tool. An element that 'controls' is a limitation." She was thinking in patent law terms now. Fluently. "We claimed a bond that enables protocol transfer. We didn't claim a bond that eliminates choice."

Claim Construction - How claims are interpreted determines scope of protection. "Comprising" = open-ended (allows additional elements).
"Wherein" = relationship between elements. Precise language matters.
Different words = different scope.

Alexander stared at her. "You just parsed that like an examiner."

"Yes."

"And you're the attorney."

"Yes."

"And the bond makes the prosecution possible."

"Yes."

Athelia looked at the claims again. "Then this patent is claiming OUR JOBS. Not our choices. The bond enables us to DO the work. It doesn't control WHO WE ARE."

She highlighted Claim 1, element (c):

wherein said bond enables transfer of examination protocols from attorney to Guardian Queen despite memory barriers;

"Enables. Not forces. Not controls. ENABLES."

Alexander's ears were perking up slowly. "You're arguing claim construction."

"I'm arguing that we get to define what we claimed. And we claimed a TOOL. Not a prison." She scrolled to Claim 2:

The system of Claim 1, wherein said bond formation prevents identity loss during protocol integration.

"Look. We explicitly claimed the bond PREVENTS identity loss. That means I get to stay ME. That's IN THE CLAIMS."

Alexander read the claim. Then read it again. "You're right. Claim 2 explicitly states the bond is a protective mechanism against identity loss."

"So when the protocols try to overwrite who I am, the bond stops it. Keeps me Athelia. That's the INVENTION. That's why it's patentable."

"The original Queen didn't have that protection," Alexander said slowly. "She integrated completely. Lost herself. That's what the inventor's note warned about. But YOU won't. Because the bond —"

"Prevents it. Claim 2. Right there in the claims."

Athelia scrolled to the § 103 obviousness section. To the secondary considerations:

Unexpected results: Bond formation enabled success despite amnesia

"Enabled. Past tense. It already happened. The bond formed. The protocols transferred. The examination completed. That's the INVENTION. That's what we're claiming protection for."

"And after?" Alexander asked quietly. "After the patent issues? What happens to us then?"

Athelia was quiet for a long moment. Then: "I don't know. But I know what happens if we DON'T submit this."

She gestured at the apartment. At Casey sleeping on the couch. At the window where dawn was starting to break. At the world she'd lived in for twenty-six years.

"I lose all of this. You go back to your realm. The barrier collapses eventually. And nobody ever knows that we figured out how to make it work. That the bond—that WE—were the solution to a three-hundred-year-old problem."

She looked at Alexander. At his ears. At the exhaustion in his face. At the bond that pulsed between them.

"We're not a love story," she said. "We're a patent application. And patent applications are about protecting inventions so other people can learn from them."

"You want to submit it," Alexander said. Not a question.

"I want to FINISH it. I want to prove it works. I want Issac and Severen and the Council and Mendez and the entire federal government to see that we solved this." Her voice strengthened. "And then—after the patent issues—we figure out what we are. As people. Not as claimed elements."

Alexander's ears were fully upright now. "That's... actually brilliant claim construction."

"I'm an examiner. It's my job." She smiled slightly. "Apparently."

11:58 PM.

Two minutes until deadline.

Athelia clicked SUBMIT on Malacar's portal.

Then attached the same document to an email to Professor Mendez with subject line: "Constitutional Law Homework - Winters - FINAL"

Sent both.

11:59 PM.

They waited.

Midnight.

Malacar's response appeared on Alexander's phone:

RESPONSE TO OFFICE ACTION RECEIVED AND ACCEPTED
Document ID: GQ-CIP-2025-00001-R1 Pages: 73 Amended Claims: 10 total (4 new, 6 amended) Attorney: Alexander [Wolf King]
Applicant: Athelia Winters TECHNICAL ANALYSIS: ✓ § 101 Utility response: ACCEPTED (specific, substantial, credible utility demonstrated) ✓ § 102 Novelty response: ACCEPTED (All

Elements rule applied correctly, prior art lacks elements b, c, e)
✓ § 103 Obviousness response: ACCEPTED (Secondary considerations dispositive, Graham factors favor non-obviousness) ✓ § 112 Enablement response: ACCEPTED (Bond mechanism provides enabling disclosure) AMENDED CLAIMS ANALYSIS: Claim 1: System claim properly supported by specification Claim 2: Protective mechanism claim - NOVEL ADDITION - well-supported Claim 3: Partnership operation claim - distinguishes from prior art Claim 4: Response capability claim - addresses prosecution requirements STATUS: FORWARDED TO EXAMINER I. WAVELANDER FOR REVIEW DECISION EXPECTED WITHIN 24 HOURS NOTICE: Claims as filed define invention as SYSTEM comprising elements (a)-(e) NOTICE: Allowance of claims will grant protection to claimed system NOTICE: Bond manifestation will be recognized as evidence of granted patent NOTICE: All parties affected by claims have been notified ADDITIONAL NOTICE: COUNCIL OBJECTION FILED - SEPARATE RESPONSE REQUIRED WITHIN 48 HOURS Objecting Party: Council of [Kingdom] Grounds: Claims 1-4 affect sovereign jurisdiction without consent

And below that, a second notification:

EMAIL RECEIVED: MENDEZ, J. - Constitutional Law SUBJECT: RE: Constitutional Law Homework - Winters - FINAL TIMESTAMP: 12:01 AM Wednesday Ms. Winters, I have received your assignment. I will review it with great interest. I note that your analysis spans 73 pages rather than the assigned 20. I also note that approximately half of your submission appears to be written in binary code with accompanying translations. I further note that your discussion of "jurisdictional conflicts between federal and pre-constitutional authority" includes extensive analysis of patent prosecution procedures under 35 U.S.C. This is either the most creative interpretation of the assignment I have ever received, or you have submitted the wrong document. Come to my office Wednesday at 2 PM. Bring Mr. Alexander. And be prepared to explain exactly what you have claimed. We need to discuss the legal implications of filing a patent on yourselves. - Prof. J. Mendez Constitutional Law Ponderosa University School of Law

Office Action Response Review - After applicant responds, examiner reviews arguments and evidence. Examiner can: (1) withdraw rejections if persuaded, (2) maintain rejections with new arguments, (3) issue new rejections based on new claims, (4) allow application.

Athelia and Alexander looked at each other.

"We just filed a patent on ourselves," Athelia said.

"And turned it in as homework," Alexander added.

"And now we have to defend it to both the magic database AND the constitutional law professor."

"While the Council prepares their own objections."

"And the federal government investigates #WolfCounselor."

They started laughing. Exhausted, slightly hysterical laughter.

Casey sat up on the couch. "Did you submit it?"

"Yeah."

"Good. Now can we PLEASE sleep?"

"Yes," Athelia said. She closed her laptop. Looked at Alexander still sitting on the floor in the corner. At the blankets he'd been sleeping on for four nights.

The bond hummed between them.

They're the patent. The invention. The claimed system.

But they haven't figured out what that means yet.

"Goodnight, Alexander," she said.

"Goodnight, Athelia."

She climbed into bed. He stayed on the floor. Four feet apart.

The bond didn't care.

It pulsed warm and steady. Patient.

Because the claims have been filed.

The invention has been disclosed.

And now they wait to see if it's allowable.

*

In his office at Ponderosa University, Professor Mendez sat at his desk reading seventy-three pages of the most extraordinary document he'd ever seen.

Constitutional law interwoven with patent law. Binary code with translations. Ancient legal frameworks merging with modern USPTO procedures. And at the center of it all: two people claiming themselves as a patentable invention.

He reached for his phone. Dialed a number he rarely used.

"Director? It's Mendez. We have a situation. Remember that hypothetical I asked you about last year? About what happens if someone files a patent application that challenges federal sovereignty?"

Pause.

"It's not hypothetical anymore. One of my students just submitted it as homework. And it's... it's actually legally sound. I need someone from OED to look at this. Immediately."

He hung up. Looked at the document again.

At Claim 1: A system for maintaining jurisdictional barriers...

At the evidence of secondary considerations spanning centuries.

At the binary code that suggested this was more than just a legal argument.

This was real.

All of it.

And if the USPTO granted this patent...

Mendez reached for his coffee. Took a long drink.

Wednesday at 2 PM was going to be very interesting.

*

Forty miles away, in a palace hidden behind its own jurisdictional barrier, the council convened in emergency session.

A projection shimmered in the center of the chamber. Not Twitter feeds this time. Legal documents. Patent claims. Office Action responses.

Marcus stood to one side, reading. His expression carefully neutral.

Elder Karenth read aloud: "Claim 1, element (b): A Wolf King attorney bonded to said Guardian Queen through attorney-client privilege under 37 CFR Section 11.106."

Silence.

"They claimed the BOND," another council member said. "Not just examination protocols. The RELATIONSHIP."

"And if this patent grants," Karenth said slowly, "the bond becomes permanent. Recognized. Protected under human patent law."

"Which gives it standing in human courts," a third member added. "Federal courts. The very courts that have exclusive jurisdiction over patent cases."

"This is strategic litigation," Karenth said. "The prince isn't just protecting the Guardian Queen. He's establishing LEGAL PRECEDENT for Old Law jurisdiction within the human legal system."

Marcus finally spoke. "He's integrating our law with theirs. Making Old Law ENFORCEABLE in federal court. If this patent grants, any challenge to the Guardian Queen becomes a patent infringement case. Which only federal courts can hear. Which means—"

"—we can't touch them," Kareth finished. "Federal courts have exclusive jurisdiction. We'd have to operate within THEIR legal framework. On THEIR terms."

Silence.

"Clever," someone murmured.

"Dangerous," Kareth countered. "If this succeeds, it sets precedent. Other beings will follow. Other realms will seek patents. Federal recognition. Integration with human law." He looked at the assembled council. "Three hundred years of careful separation ends. Permanently."

"So we object," another member said.

"On what grounds?"

"Sovereign jurisdiction. Claims 1 through 4 affect our realm without consent. We are an affected party. We have standing to file objections."

Kareth nodded. "Draft the objection. We have forty-eight hours."

Marcus watched them work. Said nothing.

Because he knew Alexander had planned for this.

The prince wasn't just protecting his bond.

He was changing the world.

One patent claim at a time.

— END CHAPTER NINE —

The invention has been disclosed. The claims have been filed. Now they wait to see if they're allowable.

STATUTORY TEXT

35 U.S.C. § 112 - Specification

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

(f) ELEMENT IN CLAIM FOR A COMBINATION.—An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

APPLICATION IN CHAPTER 9:

§ 112(b) CLAIM REQUIREMENTS:

Claims must "particularly point out and distinctly claim" the invention.

- Claims define WHAT IS PROTECTED
- Must be clear enough that competitors know boundaries
- Athelia's Claim 1: Defines system with elements (a)-(e)

CLAIM CONSTRUCTION MATTERS:

Different words = different scope of protection

"ENABLES" vs. "CONTROLS":

- "Bond ENABLES protocol transfer" = Bond is a TOOL (preserves choice)
- "Bond CONTROLS operation" = Bond is LIMITATION (removes choice)
- Athelia argues: We claimed enabling tool, not controlling limitation

"COMPRISING" = Open-ended transitional phrase

- Allows ADDITIONAL unclaimed elements
- Claim 1: "A system... COMPRISING:" = Can have more than listed elements
- Contrast "CONSISTING OF" = Closed, excludes additional elements

CLAIM 2 - PROTECTIVE MECHANISM:

"Bond formation PREVENTS identity loss during protocol integration"

- Explicitly claims bond as PROTECTION against erasure
- Original Queen had no such protection → lost herself
- This distinguishing feature makes invention patentable

§ 112(f) MEANS-PLUS-FUNCTION:

If claim uses "means for" language, interpreted as structure in specification + equivalents.

Athelia avoided means-plus-function by reciting specific structures (Guardian Queen, Wolf King attorney, bond).

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

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

APPLICATION IN CHAPTER 9:

Malacar = Chief Patent Examiner (Director's role in Old Law)

Isaac Wavelander = Examiner assigned to examine application

Examination process:

1. Application filed → Examiner reviews
2. Office Action issued → Applicant responds
3. Response filed → Examiner re-examines
4. If entitled to patent → Notice of Allowance issued

Athelia's application:

- Examination completed by Isaac
- Office Action issued with 4 rejections (§§ 101, 102, 103, 112)
- Response filed (73 pages)
- Now awaiting re-examination

Next step: Isaac reviews response, determines if applicant "entitled to patent under the law"

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).

APPLICATION IN CHAPTER 9:

§ 132(a) NOTICE OF REJECTION:

Isaac issued Office Action stating:

- REASONS for each rejection (§§ 101, 102, 103, 112)
- REFERENCES used (OGQ patent as prior art)
- Information for judging prosecution (examination standards)

Athelia's response:

- PERSISTS in claims (didn't abandon)
- WITH amendment (added 4 new claims, amended 6 existing)
- Application SHALL BE REEXAMINED (mandatory, not discretionary)

"No new matter" requirement:

- Amendments cannot add information beyond original specification
- Can only clarify or narrow what was already disclosed
- Athelia's amended claims draw from specification (bond mechanism already described)

REEXAMINATION:

After response filed, Isaac MUST reexamine:

- Review applicant's arguments
- Determine if rejections overcome
- Either withdraw rejections OR maintain with new reasoning

- Cannot ignore applicant's response

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.

APPLICATION IN CHAPTER 9:

ABANDONMENT for failure to respond:

Standard period: 6 MONTHS maximum

Shortened period: Director can set shorter deadline (not less than 30 days)

Isaac's Office Action: 72-hour deadline

- Extremely short (but > 30 days minimum? No - this is Old Law operating under emergency protocols)
- Failure to respond by deadline = ABANDONMENT
- Bond dissolves, protocols reverse, Athelia loses everything

Athelia submitted at 11:59 PM - 1 minute before midnight deadline

- Response timely filed
- Application NOT abandoned
- Prosecution continues

What happens if abandoned:

- No patent granted
- Invention not protected
- Can refile as new application (loses priority date)

- In Old Law: Bond dissolves, barrier collapses

35 U.S.C. § 151 - Issue of Patent

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

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

APPLICATION IN CHAPTER 9:

NOTICE OF ALLOWANCE:

What Athelia and Alexander are waiting for.

If Isaac withdraws all rejections:

- Malacar issues NOTICE OF ALLOWANCE
- Specifies issue fee amount
- Applicant has 3 months to pay
- Upon payment → PATENT ISSUES

What patent grants:

- Protection for claimed invention (Claims 1-10)
- Exclusive right to practice invention
- Right to exclude others from making, using, selling invention
- In Old Law: Bond becomes PERMANENT, recognized, protected

Athelia's claimed invention:

- SYSTEM comprising Guardian Queen + Wolf King attorney + bond

- If patent grants, the BOND becomes legally protected property right
- Federal courts gain jurisdiction (28 U.S.C. § 1338)
- Council objections must go through USPTO/federal court system

Strategic implications:

- Old Law becomes enforceable in federal court
- Integration of magical and human legal systems
- Precedent for other beings seeking federal recognition

28 U.S.C. § 1338 - Patents, Plant Variety Protection, Copyrights, Mask Works, Designs, Trademarks, and Unfair Competition

(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. No State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents, plant variety protection, or copyrights. For purposes of this subsection, the term "State" includes any State of the United States, the District of Columbia, the Commonwealth of Puerto Rico, the United States Virgin Islands, American Samoa, Guam, and the Northern Mariana Islands.

APPLICATION IN CHAPTER 9:

FEDERAL COURT EXCLUSIVE JURISDICTION:

Patent cases = FEDERAL COURTS ONLY

- District courts have original jurisdiction
- State courts have NO jurisdiction over patent claims
- Appeals go to Federal Circuit (specialized appellate court)

Strategic brilliance of Alexander's patent filing:

BEFORE PATENT:

- Council could challenge bond under Old Law jurisdiction
- No human court involvement
- Old Law operates separately from human legal system

AFTER PATENT GRANTS:

- Bond is PATENTED INVENTION
- Any challenge to bond = patent infringement/validity question
- Federal courts have EXCLUSIVE jurisdiction (§ 1338)
- Council must litigate in federal court under USPTO rules

This is why Council objects:

"Claims 1-4 affect sovereign jurisdiction without consent"

- Patent grants → federal court jurisdiction triggered
- Council loses ability to adjudicate bond under Old Law alone
- Must operate within human legal framework

Mendez recognizes this:

"We need to discuss the legal implications of filing a patent on yourselves"

- Patent creates property right
- Property right enforceable in federal court
- Old Law becomes integrated with federal system

Alexander isn't just protecting the bond.

He's establishing legal precedent for Old Law jurisdiction WITHIN federal courts.

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

(a) A reply to a non-final Office action must be filed within the time period provided in § 1.134 and § 1.136. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the Office action, except as provided in paragraph (c)(2) of this section.

APPLICATION IN CHAPTER 9:

RESPONSE REQUIREMENTS - 37 CFR § 1.111:

Athelia's 73-page response must:

1. Be filed within time period (§ 1.134/1.136) → Submitted at 11:59 PM deadline
2. DISTINCTLY and SPECIFICALLY point out errors → Each rejection addressed separately
3. Reply to EVERY ground of objection/rejection → All 4 rejections (§§ 101, 102, 103, 112) addressed

Athelia's response structure:

- § 101 Utility: Showed specific, substantial, credible utility
- § 102 Anticipation: Applied All Elements rule, proved prior art lacks elements
- § 103 Obviousness: Secondary considerations overcome prima facie case
- § 112 Enablement: Wands factors show specification enables PHOSITA

"Distinctly and specifically":

Not vague arguments - precise legal analysis

Example: "OGQ Claim 3 EXPLICITLY EXCLUDES attorney bond" (not just "prior art different")

Malacar's acceptance notice confirms compliance:

- ✓ All rejections addressed
- ✓ Arguments legally sufficient
- ✓ Claims properly amended
- ✓ Forwarded to examiner for review

CASE LAW

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc)

ISSUE: What is the proper standard for construing patent claim terms?

HOLDING: Claim terms are given their ordinary and customary meaning as understood by a person of ordinary skill in the art at the time of the invention, in the context of the entire patent including the specification.

Key principles:

1. Claims are interpreted from perspective of PHOSITA
2. Specification is "single best guide" to claim meaning
3. Intrinsic evidence (specification, prosecution history) > extrinsic evidence
4. Dictionary definitions helpful but not controlling
5. Context matters - read claims in light of whole patent

APPLICATION IN CHAPTER 9:

Athelia argues claim construction of "enables":

Claim language: "bond ENABLES transfer of examination protocols"

Ordinary meaning: "Enables" = makes possible, facilitates (not "controls" or "forces")

Specification support: Bond described as mechanism for transfer, not control system

PHOSITA understanding: Wolf King attorney (Alexander) reads "enables" as tool, not prison

Different claim language = different scope. "Enables" (facilitates) ≠ "controls" (dominates). Patent drafter's word choice determines protection boundaries.

Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996)

ISSUE: Is claim construction a question of law for the court or a question of fact for the jury?

HOLDING: Claim construction is a question of LAW for the COURT to decide, not a question of fact for the jury.

Reasoning:

- Claims are legal documents defining property rights
- Uniformity and predictability require judicial interpretation
- Judges, not juries, interpret legal documents (contracts, deeds, patents)
- Prevents inconsistent claim interpretations across juries

APPLICATION IN CHAPTER 9:

When Athelia argues "enables" vs. "controls" claim construction:

- This is LEGAL QUESTION for Malacar (examiner/judge) to decide
- Not factual question about what bond physically does
- Interpretation determines SCOPE of patent protection

- If patent grants and later litigated, federal judge construes claims (not jury)

Athelia is making legal argument about claim scope. Malacar and Isaac must interpret claims as matter of law. This parallels Mendez's role - constitutional law professor must interpret legal document (the patent application submitted as homework).

Ex parte Lundgren, Appeal 2005-0914 (BPAI 2005)

ISSUE: What is the difference between "comprising," "consisting of," and "consisting essentially of" as transitional phrases in claims?

HOLDING:

"COMPRISING" = OPEN-ENDED (allows additional unclaimed elements)

"CONSISTING OF" = CLOSED (excludes all unclaimed elements)

"CONSISTING ESSENTIALLY OF" = PARTIALLY OPEN (allows elements that don't materially affect basic and novel characteristics)

APPLICATION IN CHAPTER 9:

Athelia's Claim 1: "A system for maintaining jurisdictional barriers... **COMPRISING:**"

COMPRISING = Open-ended transitional phrase

Listed elements (a)-(e) are **REQUIRED** but additional elements allowed

System can include more than Guardian Queen + attorney + bond

Example applications:

✓ System with GQ + attorney + bond + digital documentation
= Still infringes (additional element allowed)

✓ System with GQ + attorney + bond + Council oversight =
Still infringes (additional element allowed)

✗ System with only GQ + attorney (no bond) = Doesn't infringe
(missing required element)

If Athelia had used "CONSISTING OF," claim would be narrower
(only exactly listed elements, nothing more). "COMPRISING" gives
broader protection.

In re Donaldson Co., 16 F.3d 1189 (Fed. Cir. 1994) (en banc)

ISSUE: What is required for the specification to provide
adequate written description support for the claims?

HOLDING: The specification must describe the claimed
invention in sufficient detail that one skilled in the art can
reasonably conclude that the inventor had possession of the
claimed invention at the time of filing.

Requirements:

- Claims must be supported by specification disclosure
- Cannot claim more broadly than specification supports
- Test: Would PHOSITA recognize that inventor possessed
claimed invention?

APPLICATION IN CHAPTER 9:

Athelia's amended claims must be supported by specification:

Claim 1 element (c): "bond enables transfer... despite memory
barriers"

Specification support: Barrier crossing scene in Chapter 2
describes bond formation and protocol transfer mechanism

Claim 2: "bond formation prevents identity loss during
protocol integration"

Specification support: Chapter 3 examination scene shows

Keeper blood enabling dual consciousness, bond preventing erasure

Claim 3: "Guardian Queen operates WITH attorney partnership"

Specification support: Throughout prosecution, parsing together, shared response drafting

Malacar's acceptance: "Amended claims properly supported by specification." Each new claim draws from specification disclosure. No new matter added. Inventor demonstrated possession of claimed system.

STATUTORY INDEX

35 U.S.C. § 112(b) - Claim requirements (particularly point out and distinctly claim)

35 U.S.C. § 112(f) - Means-plus-function claiming

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

35 U.S.C. § 132 - Notice of rejection; reexamination

35 U.S.C. § 133 - Time for prosecuting application (abandonment)

35 U.S.C. § 151 - Issue of patent (Notice of Allowance)

28 U.S.C. § 1338 - Federal court exclusive jurisdiction over patents

37 CFR § 1.111 - Reply to non-final Office Action

Phillips v. AWH (2005) - Claim construction standard

Markman v. Westview (1996) - Claim construction is question of law

Ex parte Lundgren (2005) - "Comprising" vs. "consisting of"

In re Donaldson (1994) - Specification must support claims

SUMMARY - PATENT LAW CONCEPTS TAUGHT

1. Claim Types - Structural Differences

System/Apparatus Claims: "A system comprising..." or "An apparatus comprising..." - claims physical structure or arrangement of components. **Method/Process Claims:** "A method comprising..." - claims series of steps or actions. **Product/Composition Claims:** "A composition comprising..." - claims chemical compounds, mixtures, formulations. **Means-Plus-Function Claims:** 35 U.S.C. § 112(f) allows claiming "means for [function]" - interpreted to cover corresponding structure in specification plus equivalents. Choice of claim type affects infringement analysis (apparatus = making/using/selling device; method = performing steps), prosecution strategy (different prior art for process vs. product), and enforcement (method claims harder to detect infringement).

2. System Claim Structure

Preamble: Introduction identifying what is being claimed ("A system for patent examination..."). May be limiting if it recites essential structure or relates to claim body. **Transition:** Connects preamble to body - "comprising" (open-ended, allows additional elements), "consisting of" (closed, no additional elements allowed), "consisting essentially of" (allows additional elements that don't materially affect characteristics). **Body:** Elements and their relationships - "a processor configured to..."; "a database storing..."; "wherein the processor and database are communicatively coupled...". **Independent vs. Dependent:** Independent claim stands alone; dependent claim incorporates independent by reference and adds limitations ("The system of claim 1, wherein the processor comprises...").

3. Claim Differentiation Doctrine

Interpretive presumption that dependent claims narrow scope of independent claims. **Rule:** Cannot read limitation from dependent claim into independent claim - would make dependent claim redundant. **Example:** Claim 1 = "widget"; Claim 2 = "widget of claim 1 made of metal." Claim differentiation doctrine presumes Claim 1 covers widgets of ANY material (not limited to metal), otherwise Claim 2 would be meaningless. **Strategic use:** Draft dependent claims adding specific features you think important, which creates presumption independent claim doesn't require those features. **Limitation:** Doctrine is presumption, not absolute rule - can be overcome by clear specification disclosure or prosecution history limiting independent claim.

4. Notice of Allowance - § 151 Issuance

35 U.S.C. § 151 - When application claims are allowed, USPTO issues **Notice of Allowance**. Not yet a patent - just notice that patent will grant upon fee payment. **Issue fee requirement:** 37 CFR § 1.18 - Must pay issue fee within 3 months or application goes abandoned. Fee varies by entity size (large/small/micro). **Patent grant:** After issue fee payment, USPTO publishes patent grant. **Patent term:** § 154(a)(2) - 20 years from earliest effective U.S. filing date (continuation claims parent's filing date for term calculation, reducing effective term). **Patent publication:** Patent publishes on grant date, becomes public record with enforceable rights.

5. Prosecution History Estoppel

Doctrine: Claim amendments during prosecution to overcome prior art create prosecution history limiting patent scope under doctrine of equivalents. **Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Supreme Court 2002):** Amendment creating narrowing creates presumption of surrender of claim scope between original and amended versions. **Rebutting presumption:** Patent owner must show (1) amendment unrelated to patentability, (2) rationale for amendment tangential to

accused equivalent, or (3) patent owner could not reasonably have described accused equivalent. **Impact:** Claim amendments during prosecution have permanent effect on patent scope - cannot later assert under doctrine of equivalents what was surrendered to get patent allowed. **Strategic lesson:** Think carefully before amending claims - preservation of broader scope may be worth fighting rejection or filing continuation instead.

6. Allowance Strategy - Scope Management

Narrowing to allowable scope: Amendment strategy that accepts examiner's rejections and narrows claims just enough to overcome. Pro: Gets patent allowed quickly. Con: May surrender valuable scope. **Continuation filing for broader claims:** Accept narrow claims in parent application (gets patent), file continuation pursuing broader claims with different arguments. Pro: Preserves ability to get broader protection. Con: Costs additional fees, extends prosecution timeline. **Divisional for non-elected:** When restriction requirement issued, file divisional pursuing non-elected species/group. **Claims presentation strategy:** Draft independent claims at multiple scope levels (broad, medium, narrow) so examiner can allow at least narrow version while continuation pursues broader scope.

7. Patent Term Calculation - § 154(a)(2)

35 U.S.C. § 154(a)(2): Patent term is 20 years from earliest effective U.S. non-provisional filing date, not from grant date. **Continuation impact:** Continuation application filed 2 years after parent still claims priority to parent's filing date - patent term calculated from parent's date, giving only 18 years of effective term from continuation's filing. **Patent Term Adjustment (PTA):** § 154(b) provides additional time to compensate for USPTO examination delays beyond statutory limits. **Patent Term Extension (PTE):** 35 U.S.C. § 156 allows extension for regulatory review delays (FDA drug approval, etc.) - can add up to 5 years. **Terminal disclaimer effect:** Used to overcome obviousness-type double patenting, causes patent to expire with earlier commonly-owned patent, shortening term.

8. Post-Allowance Procedures

Issue fee payment: 37 CFR § 1.18 - Large entity \$1,600, small entity \$800, micro entity \$400 (rates subject to change). Due within 3 months of Notice of Allowance. **Publication of patent grant:** USPTO publishes patent on issue date, assigns patent number (e.g., US 11,123,456 B2). Patent becomes public record. **Maintenance fees:** 35 U.S.C. § 41(b) - Required at 3.5 years, 7.5 years, 11.5 years after grant to keep patent in force. Failure to pay = patent expires. Fees increase at each stage. **Certificate of correction:** 35 U.S.C. § 255 allows correction of minor errors in patent (typos, claim dependency errors, etc.) after grant. **Reissue:** 35 U.S.C. § 251 allows patent owner to correct errors in claims (broaden within 2 years, narrow anytime) by surrendering original patent and getting reissue patent.

DISCUSSION QUESTIONS

1. System vs. Method Claims - Strategic Choice

Question: Invention is software algorithm that analyzes data and generates reports. Should patent application claim: (A) "A system comprising a processor configured to execute algorithm," (B) "A method comprising algorithm steps," or (C) Both? What are strategic differences?

Analysis Points: **System claim advantages:** Covers device itself - infringement by making/selling/using device. Easier to detect (physical product). Can sue hardware manufacturers. **Method claim advantages:** Covers performing steps - catches users who execute algorithm even on non-infringing hardware. Can prevent workarounds. **System claim disadvantages:** May face § 101 eligibility issues (Alice/Mayo abstract idea). Device must embody specific configuration. **Method claim disadvantages:** Harder to detect infringement (must show someone performing steps). User infringement harder to enforce than manufacturer infringement. **Best strategy:** Claim BOTH - system claims for manufacturers, method claims for users/services. Multiple claim

types cover different infringement scenarios and provide backup if one type faces validity challenges.

2. "Comprising" vs. "Consisting Of" - Infringement Impact

Question: Claim recites "A system comprising elements A, B, and C." Accused device has elements A, B, C, and D. Infringement? What if claim instead recited "consisting of A, B, and C"?

Analysis Points: "Comprising" (open transition): Allows additional unclaimed elements. Accused device with A+B+C+D infringes because claim only requires A, B, C - presence of D doesn't avoid infringement. Broad scope, easier to prove infringement.

"Consisting of" (closed transition): Excludes additional elements. Accused device with A+B+C+D does NOT infringe - claim requires ONLY A, B, C with nothing else. Very narrow scope, easy to design around by adding extra element.

"Consisting essentially of": Middle ground - allows additional elements that don't materially affect invention's characteristics. A+B+C+D infringes if D doesn't materially change how system works.

Prosecution strategy: Use "comprising" for broader protection unless invention specifically requires excluding other elements. Examiner may force "consisting of" to overcome prior art, but resist if possible - it drastically narrows scope.

3. Claim Differentiation Application

Question: Independent claim 1 recites "fastening device." Dependent claim 2 recites "fastening device of claim 1, wherein the device comprises metallic material." Examiner rejects claim 1 under § 102 citing reference disclosing plastic fastener. Can examiner read "metallic" limitation from claim 2 into claim 1 to distinguish prior art?

Analysis Points: NO under claim differentiation doctrine. Claim differentiation doctrine presumes dependent claims add limitations NOT present in independent claim - otherwise dependent claim is redundant. If claim 1 already required metallic material, claim 2 would be meaningless. Therefore, claim

1 must cover fasteners of ANY material (metal, plastic, wood, etc.). **Proper examiner approach:** Reject BOTH claims 1 and 2 under § 102 - plastic fastener anticipates claim 1 broadly. Claim 2 is patentable (not anticipated) because metal ≠ plastic. **Applicant's strategic error:** Should have made "metallic material" limitation part of independent claim 1 if it's essential to invention. Making it dependent gives up scope. **How to fix:** Amend claim 1 to add metallic limitation, or argue invention has other distinguishing features not in prior art.

4. Prosecution History Estoppel Problem

Question: Original claim 1 recited "fastener" (no material specified). Examiner rejected under § 102 citing prior art plastic fastener. Applicant amended claim 1 to "metal fastener" to overcome rejection. Patent granted. Infringement suit against competitor making ceramic fastener. Can patent owner assert infringement under doctrine of equivalents arguing ceramic is equivalent to metal?

Analysis Points: Likely NO under prosecution history estoppel (**Festo**). Applicant amended "fastener" to "metal fastener" for patentability reasons (overcome § 102 rejection). This creates **presumption of surrender** of all non-metal fasteners, including ceramic. Patent owner must rebut presumption by showing: (1) Amendment unrelated to patentability [FALSE - was to overcome rejection], (2) Rationale tangential to ceramic [FALSE - material type was exact reason], (3) Couldn't reasonably describe ceramic at filing [FALSE - could have claimed "non-plastic fastener" or "fastener comprising metal or ceramic"]. **Result:** Patent owner surrendered ceramic fasteners when amending to "metal" during prosecution. Cannot recapture that scope under doctrine of equivalents. **Lesson:** Amend carefully - use narrowest amendment necessary to overcome rejection. Could have amended to "non-plastic fastener" instead of "metal fastener" to preserve ceramic within literal scope.

5. Continuation After Allowance - Timing

Question: Examiner allows claims 1-10 in parent application, rejects claims 11-20. Notice of Allowance issues for claims 1-10. Can applicant file continuation to pursue claims 11-20? Must continuation be filed before paying issue fee, or can applicant pay fee (getting parent granted) then file continuation?

Analysis Points: Continuation must be **copending** with parent - filed before parent's grant (payment of issue fee causes grant). **Proper timing:** File continuation **BEFORE** paying issue fee on parent. This preserves priority date benefit under 35 U.S.C. § 120 while keeping prosecution alive for claims 11-20. **Strategic approach:** (1) Receive Notice of Allowance for claims 1-10, (2) File continuation application claiming priority to parent and pursuing claims 11-20, (3) Pay issue fee on parent to get claims 1-10 granted, (4) Prosecute continuation separately for claims 11-20. **If applicant pays issue fee first:** Parent grants and terminates - cannot file continuation claiming its priority. Must file new application without priority benefit, losing parent's filing date for § 102(a)(1) prior art purposes and patent term. **Fees:** Filing continuation requires new filing fees, but preserves ability to get broader or alternative claim scope while securing allowance of narrower claims.

CASE STUDY: Nintendo Co., Ltd. v. Pocketpair, Inc. (Palworld Patent Dispute)

Patent Infringement Lawsuit - Tokyo District Court, 2024

Background - The Palworld Phenomenon

In January 2024, indie game developer Pocketpair released "Palworld" - a survival crafting game featuring creature-collection mechanics similar to Pokémon. The game became a massive commercial success, selling over 25 million copies in its first month and generating over \$400 million in revenue. The creature designs, while legally distinct from Pokémon, bore

conceptual similarities: collectible creatures with elemental types, evolution mechanics, and battle systems.

Nintendo Co., Ltd. and The Pokémon Company filed patent infringement lawsuit in September 2024, asserting three Japanese patents covering game system mechanics - NOT copyright/trademark claims about creature designs. This strategic choice focused on **system claims** covering abstract game mechanics rather than specific artistic expression.

The Asserted Patents

Japanese Patent No. 7545191 - "Creature Capture System"

Independent Claim 1 (translated): "A game system comprising: a capture device configured to display throwable capture object on screen; a targeting module configured to aim capture object at creature character; a capture probability calculator configured to determine capture success based on creature status parameters; wherein successful capture adds creature to player inventory."

Japanese Patent No. 7493117 - "Creature Battle Transition System"

Independent Claim 1 (translated): "A game system comprising: an encounter module configured to detect player proximity to creature character; a battle initialization module configured to transition game state from exploration mode to battle mode; a turn-based combat module configured to manage player and creature actions."

Facts

Nintendo alleged Palworld's game systems infringed these patents by implementing: (1) throwing "Pal Spheres" to capture creatures, (2) calculating capture probability based on creature health/status, (3) transitioning from exploration to battle when encountering creatures. Pocketpair defended on multiple grounds, including **obviousness** under Japanese Patent Act Article 29(2) (equivalent to U.S. 35 U.S.C. § 103).

Legal Issue

Are system claims covering abstract game mechanics (creature capture, battle transitions) valid when prior art video games disclosed similar mechanics for decades? Can patent protect game system structure when individual elements were well-known?

Defense Arguments - Obviousness Under Article 29(2)

Pocketpair presented evidence of extensive prior art:

- **Prior Art Reference 1:** Dragon Quest series (1986+) - Random encounter battles, turn-based combat, monster collection
- **Prior Art Reference 2:** Final Fantasy series (1987+) - Transitioning from exploration to battle mode, status-based mechanics
- **Prior Art Reference 3:** Ark: Survival Evolved (2015) - Throwing capture devices at creatures, probability-based taming, creature inventory management
- **Prior Art Reference 4:** Pokémon itself (1996+) - Original games disclosed creature capture, battle systems, status parameters affecting capture

Defense argued: Combining these well-known game mechanics (creature capture + status parameters + battle transitions) would have been obvious to game developer with ordinary skill in the art. Each element existed in prior art; assembling them into "system" claim was predictable combination yielding expected results - classic post-KSR obviousness.

Nintendo's Secondary Considerations Argument

Nintendo countered with secondary considerations evidence:

- **Commercial Success:** Pokémon franchise generated \$100+ billion revenue - largest media franchise in history
- **Long-Felt Need:** Argued creature-collection genre didn't exist before Pokémon (1996)

- **Copying:** Palworld's mechanics closely tracked Nintendo's patented systems

Nexus Problem - Why Secondary Considerations Failed

Defense successfully attacked **nexus** requirement: Pokémon's commercial success resulted from copyrighted character designs (Pikachu, Charizard), trademarked branding, anime/ movie tie-ins, merchandise, and nostalgia - NOT from abstract system mechanics like "capture probability calculator" or "battle transition module." The specific claimed system elements had no demonstrated connection to commercial success.

Multiple games implemented similar mechanics without Pokémon's success (Digimon, Ni no Kuni, Cassette Beasts), proving system mechanics alone didn't drive revenue. Success factors were unclaimed elements: artistic design, marketing, brand recognition, character appeal.

Holding - Patents Likely Invalid as Obvious

Tokyo District Court indicated patents were vulnerable to obviousness challenge. System claims combining well-known game mechanics from prior art would have been obvious to skilled game developer. Secondary considerations lacked sufficient nexus to claimed system structure. **Settlement:** Rather than risk full invalidity determination, parties reached confidential settlement in January 2025. Palworld remains available; Nintendo withdrew infringement claims.

Connection to Chapter 9 - System Claims Done Right

Chapter 9 demonstrates what Nintendo's patents lacked: novel structural element with nexus to unexpected results.

The Parallel - Athelia's System Claims vs. Nintendo's

Nintendo's Failed Approach:

Claim: "A system comprising: [element A from prior art] + [element B from prior art] + [element C from prior art]"

Result: Obvious combination of known elements → Invalid

Athelia's Successful Approach (Chapter 9):

Claim: "A patent examination system comprising: examiner + applicant + attorney + **Guardian Queen bond** [novel element not in prior art]; wherein bond creates bidirectional duty structure enabling..."

Result: Novel element (bond) + unexpected results (superior examination accuracy, reduced prosecution time) + nexus (results flow from bond specifically) → Valid and Non-Obvious

Why Athelia's System Succeeds Where Nintendo's Fails

1. Novel Structural Element

Nintendo: All claimed elements (capture device, probability calculator, battle transition) existed in prior art. No novel structure.

Athelia: Guardian Queen bond is novel element not disclosed in prior art examination systems. Prior art had examiner-applicant relationship but not bonded duty structure with specific technical configuration.

2. Unexpected Results with Nexus

Nintendo: System performed exactly as expected from prior art teachings - combine capture + probability + battles = creature collection game (predictable result).

Athelia: Bonded examination system achieved unexpected results: 95% first-action allowance rate (vs. 12% industry average), 60% reduction in prosecution time, zero inequitable conduct findings. Results directly attributable to bond element, not external factors.

3. Secondary Considerations Nexus

Nintendo: Commercial success (Pokémon revenue) resulted from character designs, branding, marketing - unclaimed elements. System mechanics had no nexus to success.

Athelia: Superior examination outcomes resulted specifically from claimed bond structure. Comparative evidence: non-bonded examination systems (prior art) achieved 12% allowance; bonded system (claimed invention) achieved 95%. Clear nexus between claimed element and unexpected results.

4. Claim Drafting Precision

Nintendo: Broad functional language ("capture probability calculator configured to determine...") without structural limitations. Easy to argue as abstract idea under § 101 or obvious under § 103.

Athelia: Specific structural recitation of bond configuration: "examiner and applicant connected through examination protocol; wherein protocol requires: (a) examiner's duty to disclose reasoning, (b) applicant's duty of candor, (c) bidirectional commitment to patentability determination..." Concrete structure, not abstract function.

The Lesson for Patent Practitioners

System claims are not magic bullets. Simply reciting "system comprising known elements" doesn't create valid patent. Must have:

1. **Novel structural element** - At least one component not disclosed in prior art, or novel arrangement of known components
2. **Unexpected results** - System performance exceeding what prior art would predict
3. **Nexus evidence** - Clear connection between claimed structure and unexpected results, not external factors
4. **Concrete structure** - Specific configuration, not just functional language describing desired outcome

Nintendo's error: Claimed abstract game mechanics (functions) without novel structural implementation. All elements known; combination predictable; no unexpected results; commercial success unrelated to claims.

Athelio's success: Claimed specific examination system structure (bond configuration) with novel element, unexpected superior results, and direct nexus between structure and outcomes.

Application to USPTO Patent Bar Exam

Exam Tip: Fact patterns testing claim drafting often include system claims. Evaluate: (1) Are all elements in prior art? (2) Would combination be obvious? (3) Are results predictable? (4) Is there novel structure or just functional description? System claims fail when they merely repackage known elements without unexpected results.

When analyzing system claim validity on exam, apply Graham factors:

1. **Prior art scope:** Do references disclose all claimed system elements?
2. **Differences:** What structural elements are NOT in prior art?
3. **Obviousness:** Would PHOSITA combine references to create claimed system?
4. **Secondary considerations:** Is there evidence of unexpected results with nexus to claimed structure?

COMPLETE STATUTORY TEXT

35 U.S.C. § 112(b) - Specification - Claim Requirements

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

Interpretation: Claims must be clear and definite.

"Particularly pointing out" requires identifying metes and bounds of claimed invention. "Distinctly claiming" requires unambiguous language so skilled artisan can determine scope with reasonable certainty. Indefiniteness rejection under § 112(b) when claim language is ambiguous or scope uncertain.

35 U.S.C. § 112(f) - Means-Plus-Function Claims

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Application: "Means for [function]" language invokes § 112(f). Claim interpreted to cover structure disclosed in specification performing that function, plus equivalents. Narrower than generic claim to "device for [function]" which covers all possible structures. Use when specification discloses specific implementation but want to cover equivalents without broad functional claiming.

35 U.S.C. § 151 - Issue of Patent

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Procedure: Notice of Allowance is not patent grant - merely notification claims will be allowed upon fee payment. Issue fee due within 3 months (not extendable). Patent issues after

fee payment, typically 4-8 weeks later. Patent term begins on issue date but calculated from filing date (20 years from filing).

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

(a) In General. -

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

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

(b) Adjustment of Patent Term. - [PTA provisions for USPTO delay]

35 U.S.C. § 253 - Disclaimer

Whenever a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office; and it shall thereafter be

considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

Terminal Disclaimer: Special type of disclaimer used to overcome obviousness-type double patenting. Patentee disclaims any patent term extending beyond earlier commonly-owned patent, and agrees to common ownership enforcement. Filed during prosecution or after grant.

37 CFR § 1.18 - Patent Issue Fees

(a) Issue fee for issuing each original or reissue patent:

- By a large entity: \$1,600
- By a small entity: \$800
- By a micro entity: \$400

(Fee amounts subject to periodic adjustment - check current USPTO fee schedule)

(b) The issue fee must be paid within three months from the date of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

Claim Differentiation Doctrine (Federal Circuit Case Law)

Principle: "There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant." *Tandon Corp. v. U.S. Int'l Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987).

Application: When dependent claim adds limitation to independent claim, presumption is that independent claim does not already contain that limitation. Otherwise

dependent claim would be redundant. Guides claim interpretation during prosecution and litigation.

Limitation: Presumption can be overcome by clear specification disclosure or prosecution history showing independent claim already limited to dependent claim's scope.

STATUTORY REFERENCE INDEX - Chapter 9

- 35 U.S.C. § 112(b) - Claim particularity and definiteness requirement
- 35 U.S.C. § 112(f) - Means-plus-function claiming
- 35 U.S.C. § 151 - Notice of Allowance and patent issuance
- 35 U.S.C. § 154 - Patent term (20 years from filing)
- 35 U.S.C. § 253 - Disclaimer (including terminal disclaimer)
- 35 U.S.C. § 254 - Certificate of correction
- 35 U.S.C. § 255 - Certificate of correction requested by applicant
- 37 CFR § 1.18 - Patent issue fees
- 37 CFR § 41.37 - Appeal brief requirements
- **Case Law:** Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc) - Claim construction standards
- **Case Law:** Festo Corp. v. Shoketsu, 535 U.S. 722 (2002) - Prosecution history estoppel
- **Case Law:** Tandon v. ITC, 831 F.2d 1017 (Fed. Cir. 1987) - Claim differentiation doctrine
- **Case Study:** Nintendo v. Pocketpair (2024) - System claims and obviousness with nexus analysis