Part I

PATENT SYSTEM ORGANIZATION AND PROCESS

Chapter 1

History and Policy Justification

KeyCite*: Cases and other legal materials listed in KeyCite Scope can be researched through the KeyCite service on Westlaw®. Use KeyCite to check citations for form, parallel references, prior and later history, and comprehensive citator information, including citations to other decisions and secondary materials.

II. HISTORICAL ORIGINS OF THE MODERN PATENT GRANT

§ 1:14 Developments in the United States—Constitutional provision—Other issues—Sovereign immunity of the States

n. 1.

Add at end of footnote:
Chapter 2
The Patent System and the Patent and Trademark Office

II. CONGRESS’ EXERCISE OF ITS CONSTITUTIONAL POWER

§ 2:10 Judicial versus executive authority over the patent grant—Administrative post-grant proceedings

n. 5.
Replace footnote:
See generally § 16:1.

n. 6.
Replace footnote:
See generally § 16:1.
IV. JUDICIAL REVIEW OF USPTO DECISIONS

§ 2:38 Current mechanisms

n. 3. Add at end of footnote:


n. 7. Add at end of footnote:


Add the following before the last paragraph:

The nature of an action under section 145 was addressed by the Supreme Court in a 2012 decision, Kappos v. Hyatt.18 There, a patent applicant had received an adverse decision of the USPTO regarding his patent application. Thereafter, he elected to have it reviewed under section 145.16 In the section 145 action, and in response to the USPTO’s urging, the district court refused to allow the applicant to introduce new evidence into the record without a showing of why it could not have been presented during prosecution, and reviewed the USPTO’s decision under the deferential “substantial evidence” standard set out in the Administrative Procedure Act.17 On appeal to the Federal Circuit an en banc panel of that court reversed, holding that the introduction of evidence in a section 145 proceeding was subject only to the usual restrictions of the Federal Rules of Civil Procedure and of the Federal Rules of Evidence, and that review was to be de novo.18 Subsequently the USPTO petitioned for certiorari, which the Supreme Court granted.19

The Supreme Court reversed. Its decision is noteworthy and interesting for its review of various historical details of the judicial review of decisions by the Patent Office.20 For the purposes of this discussion, however, the main thrust of the Court’s opinion is premised on two points. First, the statutory text of section 145 did not compel the various limitations that the USPTO urged.21 Second, and more historically interesting, the Supreme Court asserted that actions under section 145 are still in the nature of a bill in equity to set aside the determination of the USPTO.22 A potentially contrary precedent, Morgan v. Daniels,23 was noted to be a decision reviewing an interference proceeding, and thus properly categorized as relevant to what is now section 146, not section 145.24
In light of this analysis, the Court concluded,
there are no limitations on a patent applicant's ability to
introduce new evidence in a § 145 proceeding beyond those al-
ready present in the Federal Rules of Evidence and the Federal
Rules of Civil Procedure. Moreover, if new evidence is pre-
sented on a disputed question of fact, the district court must
make de novo factual findings that take account of both the
new evidence and the administrative record before the PTO.25

A concurring opinion by Justice Sotomayor, joined by Justice
Breyer, noted that, as an action in Equity, suits under sec-
tion 145 would be subject to "ordinary equity practice and
procedure," which could include various other limitations on
the introduction of evidence beyond those addressed in the
main opinion.26

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26Kappos v. Hyatt, 132 S. Ct. 1690, 1695. 182 L. Ed. 2d 704, 102 U.S.P.Q.2d 1337 (2012) ("In 1995, respondent Gilbert Hyatt filed a patent application that, as amended, included 117 claims. The PTO's patent examiner denied each claim for lack of an adequate written description. [citation omitted] Hyatt appealed the examiner's decision to the Board, which eventually approved 38 claims, but denied the rest. Hyatt then filed a § 145 action in Federal District Court against the Director of the PTO [ ], petitioner here.").

aff'd, 576 F.3d 1246, 91 U.S.P.Q.2d 1865 (Fed. Cir. 2009), reh'g en banc
Cir. 2010) and judgment vacated, 625 F.3d 1320, 96 U.S.P.Q.2d 1841 (Fed.
Cir. 2010), judgment aff'd and remanded, 132 S. Ct. 1690, 182 L. Ed. 2d
18Hyatt v. Kappos, 625 F.3d 1320, 96 U.S.P.Q.2d 1841 (Fed. Cir. 2010),
judgment aff'd and remanded, 132 S. Ct. 1690, 182 L. Ed. 2d 704, 102
20See, e.g., Kappos v. Hyatt, 132 S. Ct. 1690, 1693-1695, 182 L. Ed. 2d
21See, e.g., Kappos v. Hyatt, 132 S. Ct. 1690, 1697, 182 L. Ed. 2d 704,
102 U.S.P.Q.2d 1337 (2012) ("Section 145 grants a disappointed patent
applicant a 'remedy by civil action against the Director.' The section fur-
ther explains that the district court 'may adjudge that such applicant is
titled to receive a patent for his invention, as specified in any of his
claims involved in the decision of the [PTO], as the facts in the case may
appear and such adjudication shall authorize the Director to issue such
patent on compliance with the requirements of law.' By its terms, § 145
neither imposes unique evidentiary limits in district court proceedings nor
establishes a heightened standard of review for factual findings by the
PTO.").
$2:38$ Moy’s Walker on Patents


24See, e.g., Kappos v. Hyatt, 132 S. Ct. 1690, 1699, 182 L. Ed. 2d 704, 102 U.S.P.Q.2d 1337 (2012) ("Morgan, on the other hand, concerned a different situation from the one presented in this case. First, Morgan addressed an interference proceeding. See 153 U.S., at 125, 14 S.Ct. 772 (emphasizing that ‘the question decided in the Patent Office is one between contesting parties as to priority of invention’). Although interference proceedings were previously governed by R.S. 4915, they are now governed by a separate section of the Patent Act, 35 U.S.C. § 146, and therefore do not implicate § 145. In addition, Morgan did not involve a proceeding in which new evidence was presented to the District Court. See 153 U.S., at 122, 14 S.Ct. 772 (stating that the case ‘was submitted, without any additional testimony, to the Circuit Court’).").


n. 25.

Add at end of first paragraph of footnote 25:

See e.g., In re Giuffrida, 527 Fed. Appx. 981 (Fed. Cir. 2013).

Add at end of section:

In addition decisions have noted that deference under Zurko and Gartside does not extend to the USPTO’s analysis of facts after a finding has been rendered.26


§ 2:50 Standards of review—Determinations of law—Application to legal rules of the USPTO—Substantive/legislative rulemaking authority of the USPTO

§ 2. Powers and duties.

n. 7.

Add at end of footnote:

See generally, e.g., In re Lovin, 652 F.3d 1349, 99 U.S.P.Q.2d 1373 (Fed. Cir. 2011).
§ 2:51 Standards of review—Determinations of law—Application to legal rules of the USPTO—Interpretive rules of the USPTO

n. 30.

Add at end of footnote:
II. EXAMINATION OF ORIGINAL APPLICATIONS

A. IN GENERAL

§ 3:4 Application papers—Regular applications

n. 1. Replace footnote:
Prior to December 12, 2012, the relevant portions of the section read as follows:

§ 111. Application

(a) In general.—
(1) Written application.— An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.
(2) Contents.— Such application shall include—
(A) a specification as prescribed by section 112;
(B) a drawing as prescribed by section 113; and (C) an oath or declaration as prescribed by section 115.
(3) Fee and oath or declaration.— The application must be accompanied by the fee required by law. The fee and oath or declaration may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.
(4) Failure to submit.— Upon failure to submit the fee and oath or declaration within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath or declaration

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was unavoidable or unintentional. The filing date of an application
shall be the date on which the specification and any required drawing
are received in the Patent and Trademark Office.

On that date Congress amended the third and fourth paragraphs of
the provision. See Public Law 112-21, Title I, 112th Congress, 126 Stat.
1527 (Dec 18, 2012) (“An Act To implement the provisions of the Hague
Agreement and the Patent Law Treaty.”). See also Patent Law Treaty, 39
I.L.M. 1047 (June 1, 2000). The provision now reads:

§ 111. Application
(a) In general.—
(1) Written application.— An application for patent shall be made,
or authorized to be made, by the inventor, except as otherwise
provided in this title, in writing to the Director.
(2) Contents.— Such application shall include—
(A) a specification as prescribed by section 112;
(B) a drawing as prescribed by section 113; and (C) an oath or
declaration as prescribed by section 115.
(3) Fee, oath or declaration, and claims.— The application shall be
accompanied by the fee required by law. The fee, oath or declaration,
and 1 or more claims may be submitted after the filing date of the ap-
plication, within such period and under such conditions, including the
payment of a surcharge, as may be prescribed by the Director. Upon
failure to submit the fee, oath or declaration, and 1 or more claims
within such prescribed period, the application shall be regarded as
abandoned.
(4) Filing date.— The filing date of an application shall be the date
on which a specification, with or without claims, is received in the

The effective date of the statutory change was December 12, 2013.

§ 3:7 Application papers—Regular applications—
Oath or Declaration
n. 5.
Replace footnote:
Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 4(a), 125
See generally § 1:26.
As enacted the AIA version of the statute read:

§ 115. Inventor’s oath or declaration.
(a) Naming the Inventor; Inventor’s Oath or Declaration.— An ap-
plication for patent that is filed under section 111(a) or commences the
national stage under section 371 shall include, or be amended to include,
the name of the inventor for any invention claimed in the application.
Except as otherwise provided in this section, each individual who is the
inventor or a joint inventor of a claimed invention in an application for
patent shall execute an oath or declaration in connection with the
application.
(b) Required Statements— An oath or declaration under subsection (a) shall contain statements that—

(1) the application was made or was authorized to be made by the affiant or declarant; and

(2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

(c) Additional Requirements— The Director may specify additional information relating to the inventor and the invention that is required to be included in an oath or declaration under subsection (a).

(d) Substitute Statement—

(1) In General— In lieu of executing an oath or declaration under subsection (a), the applicant for patent may provide a substitute statement under the circumstances described in paragraph (2) and such additional circumstances that the Director may specify by regulation.

(2) Permitted Circumstances— A substitute statement under paragraph (1) is permitted with respect to any individual who—

(A) is unable to file the oath or declaration under subsection (a) because the individual—

(i) is deceased;

(ii) is under legal incapacity; or

(iii) cannot be found or reached after diligent effort; or

(B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).

(3) Contents— A substitute statement under this subsection shall—

(A) identify the individual with respect to whom the statement applies;

(B) set forth the circumstances representing the permitted basis for the filing of the substitute statement in lieu of the oath or declaration under subsection (a); and

(C) contain any additional information, including any showing, required by the Director.

(e) Making Required Statements in Assignment of Record— An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statements separately.

(f) Time For Filing— A notice of allowance under section 151 may be provided to an applicant for patent only if the applicant for patent has filed each required oath or declaration under subsection (a) or has filed a substitute statement under subsection (d) or recorded an assignment meeting the requirements of subsection (e).

(g) Earlier-Filed Application Containing Required Statements or Substitute Statement.—

(1) Exception— The requirements under this section shall not apply to an individual with respect to an application for patent in which
the individual is named as the inventor or a joint inventor and who claims the benefit under section 120, 121, or 365(c) of the filing of an earlier-filed application, if—

(A) an oath or declaration meeting the requirements of subsection (a) was executed by the individual and was filed in connection with the earlier-filed application;

(B) a substitute statement meeting the requirements of subsection (d) was filed in connection with the earlier filed application with respect to the individual; or

(C) an assignment meeting the requirements of subsection (e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application.

(2) Copies of Oaths, Declarations, Statements, or Assignments— Notwithstanding paragraph (1), the Director may require that a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application be included in the later-filed application.

(h) Supplemental and Corrected Statements; Filing Additional Statements.—

(1) In General— Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time. If a change is made in the naming of the inventor requiring the filing of 1 or more additional statements under this section, the Director shall establish regulations under which such additional statements may be filed.

(2) Supplemental Statements Not Required— If an individual has executed an oath or declaration meeting the requirements of subsection (a) or an assignment meeting the requirements of subsection (e) with respect to an application for patent, the Director may not thereafter require that individual to make any additional oath, declaration, or other statement equivalent to those required by this section in connection with the application for patent or any patent issuing thereon.

(3) Savings Clause— A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under paragraph (1).

(i) Acknowledgement of penalties— Any declaration or statement filed pursuant to this section shall contain an acknowledgment that any willful false statement made in such declaration or statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

In January 2013 the text of the AIA-version of section 115 was amended by replacing paragraph (f) with the following, and making a technical correction to paragraph (g):

(f) Time for filing.— The applicant for patent shall provide each required oath or declaration under subsection (a), substitute statement under subsection (d), or recorded assignment meeting the requirements of subsection (e) no later than the date on which the issue fee for the patent is paid.
§ 3:8 Application papers—Regular applications—Fee

Replace first sentence of first paragraph with:
To be complete, an application must include submission of the requisite filing fee.\(^1\) Practice was altered in 2102 to allow the application to be filed initially without a fee, but this will invoke a surcharge and threatens the application with becoming abandoned if the requisite fee is not paid by the subsequent deadline.\(^2\)


Prior to December 12, 2012, the relevant portions of the section read as follows:

§ 111. Application

(a) In general.—

* * *

(3) Fee and oath or declaration.— The application must be accompanied by the fee required by law. The fee and oath or declaration may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) Failure to submit.— Upon failure to submit the fee and oath or declaration within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath or declaration was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

On that date Congress amended the third and fourth paragraphs of the provision. See Public Law 112-21, Title II, 112th Congress, 126 Stat. 1527 (Dec 18, 2012) (“An Act To implement the provisions of the Hague Agreement and the Patent Law Treaty.”). See also Patent Law Treaty, 39 I.L.M. 1047 (June 1, 2000). The provision now reads:

§ 111. Application

(a) In general.—

* * *

(3) Fee, oath or declaration, and claims.— The application shall be accompanied by the fee required by law. The fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon
failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.

(4) Filing date.— The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.

The effective date of the statutory change was December 12, 2013.

§ 3:11 Application papers—Regular applications—Missing parts

Replace section content with:

The second point deserving discussion is how the USPTO treats submissions of application materials in which one or more of the required parts has been omitted. Prior to 2012, the agency preferred that all parts be filed together, but generally exercised its discretion under the statute to permit the application to be filed initially without one or more parts, particularly the oath and fee. Obviously, where such a piecemeal submission occurs, it raises issues of whether the application should be rejected as incomplete and, if the application is accepted, what date of filing the application should be assigned. Practice in this area was referred to as the agency’s treatment of applications initially filed with “missing parts.” Prior to 2012 section 111(a)(3) of the statute expressly stated that the Commissioner is authorized to accept the applicant’s submission of the fee and oath at a time later than the applicant’s filing of the specification and drawing. In instances where the later filed parts were accepted, the USPTO’s rules assigned as the application’s filing date the date on which the specification and drawing were received. The PTO’s issued rules set out a relatively detailed procedure for completing applications that have been filed with missing parts, the details of which are not relevant enough to the subjects of the present work to warrant extended discussion here.

In 2012 the agency practice was formalized, to some degree, by Congress’s implementation of 2000 international agreement on the formalities of filing a patent application, the so-called Patent Law Treaty. This amended the relevant portions of the statute so that the agency is now compelled to accept as filed applications that lack the requisite fee, provided that the proper fee, plus a surcharge, is later filed within the designated time. The statutory change became effective December 12, 2013.
§ 1.54. Parts of application to be filed together; filing receipt.

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise, a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53(f) and (g) with regard to completion of an application.

(b) Applicant will be informed of the application number and filing date by a filing receipt, unless the application is an application filed under § 1.53(d).


4See, e.g. 37 C.F.R. § 1.53(b) (“The filing date of a [non-provisional] application for patent filed under this section, except for a continued prosecution application is the date on which a specification as prescribed by 35 U.S.C.A. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office.”).

5Cf. 35 U.S.C.A. § 111(a)(4) (2011) (filing date of application, revived after being abandoned for incomplete parts, is date of filing of specification and any required drawing).

6See generally, e.g., 37 C.F.R. § 1.53(e), (f); Manual of Patent Examining Procedure § 601.01 (8th ed., Rev. 9).


§ 111. Application

(a) In general.—

* * *

(3) Fee.— The application shall be accompanied by the fee required by law. The fee may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned.

(4) Filing date.— The filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.
§ 3:12 Application papers—Provisional applications

Replace third sentence of first paragraph with:

As originally enacted, for example, section 111(b) of the statute stated that the provisional application is to include a specification and drawings, and that the filing date of the application is to be the date on which these parts are received.\(^2\)

\(^2\)35 U.S.C.A. § 111(b). The entire provision read:

§ 111. Application

... (b) Provisional application.—

(1) Authorization.— A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by section 112(a); and

(B) a drawing as prescribed by section 113.

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

(3) Fee.—

(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) Filing date.— The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) Abandonment.— Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3), if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) Other basis for provisional application.— Subject to all the
conditions in this subsection and section 119(e), and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) No right of priority or benefit of earliest filing date.— A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c).

(8) Applicable provisions.— The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 131, and 135.

Add at the end of the section:

In 2012 the statutory provisions in section 111 relating to provisions were amended to implement two treaties, relating to protection for industrial designs, and formal requirements for establishing a filing date. The changes became effective December 12, 2013.

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See Pub. L. No. 112-21, 126 Stat. 1527 (112th Congress) (Dec. 18, 2012) ("An Act To implement the provisions of the Hague Agreement and the Patent Law Treaty."). The changes to section 111 were as follows:

§ 111. Application

* * *

(b) Provisional application.—

(1) Authorization.— A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by section 112(a); and

(B) a drawing as prescribed by section 113.

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

(3) Fee.—

(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) Filing date.— The filing date of a provisional application shall
§ 3:12 Moy’s Walker on Patents

be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(3) Fee.— The application shall be accompanied by the fee required by law. The fee may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned.

(4) Filing date.— The filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.

(5) Abandonment.— Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3), if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) Other basis for provisional application.— Subject to all the conditions in this subsection and section 119(e), and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) No right of priority or benefit of earliest filing date.— A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) section 119, 365(a), or 386(a) or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) section 120, 121, 365(c), or 386(c).

(8) Applicable provisions.— The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 131 and 135.

(c) Prior filed application.— Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. Such application shall be treated as having never been filed, unless—

(1) the application is revived under section 27; and

(2) a copy of the specification and any drawings of the previously filed application are submitted to the Director.

10World Intellectual Property Organization, Hague Agreement

§ 3:13 Application papers—Provisional applications—Policy justification

Replace penultimate sentence of penultimate paragraph with:

The foreign inventor’s ability to claim priority under the international agreements lapses after 12 months;\textsuperscript{17} the provisional application becomes abandoned after the same period.\textsuperscript{18} Both practices previously ended absolutely at 12 months without the possibility of extension;\textsuperscript{19} under statutory amendments introduced in 2012 both are potentially extendable for two months.\textsuperscript{20}

\textsuperscript{17}Paris Convention, art. 4C; 35 U.S.C.A. § 119(a).
\textsuperscript{18}35 U.S.C.A. § 111(e)(1).
\textsuperscript{20}See, e.g., 35 U.S.C.A. §§ 119(a) (“The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application under section 111(a) or section 363 within the 12-month period was unintentional.”). See also Pub. L. No. 112-21, 126 Stat. 1527 (Title II, 112th Congress) (Dec. 18, 2012) (“An Act To implement the provisions of the Hague Agreement and the Patent Law Treaty.”). See also Patent Law Treaty, 39 I.L.M. 1047 (June 1, 2000). The change became effective December 12, 1013.

§ 3:14 Application papers—Provisional applications—Other aspects

n. 4.

Add at the end of footnote:

§ 3:27 Amendments—To the disclosure: prohibition against new matter—Incorporation by reference

n. 1.
Add at end of first paragraph of footnote:
Harari v. Lee, 656 F.3d 1331, 100 U.S.P.Q.2d 1052 (Fed. Cir. 2011)

§ 3:31 Amendments—To the claims: Doctrine against late claiming

n. 10.
Replace footnote:


The modern statutory provision relating to interferences, 35 U.S.C.A. § 135(b) (2011), read:

§ 135. Interferences

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

With regard to the 1952 codification, see Application of Tanke, 41 C.C.P.A. 919, 213 F.2d 551, 102 U.S.P.Q. 83 (1954).

For authorities dealing with the pre-AIA version of section 135(b), see generally, also, In re Sasse, 629 F.2d 675, 207 U.S.P.Q. 107 (C.C.P.A. 1980); In re McGrew, 120 F.3d 1236, 43 U.S.P.Q.2d 1632 (Fed. Cir. 1997); In re Berger, 279 F.3d 975, 61 U.S.P.Q.2d 1523 (Fed. Cir. 2002); Regents of University of California v. University of Iowa Research Foundation, 455 F.3d 1371, 79 U.S.P.Q.2d 1687 (Fed. Cir. 2006).

With the passage of the America Invents Act, Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (16 Sept. 2011), and its change to priority based on the date of filing, section 135(b) was amended to address only derivation. See, e.g., Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3(i), 125 Stat. 284 (16 Sept. 2011). The provision as enacted by the AIA still contains a one-year limit on the copying of claims, but calculated from the date on which the claim is first published. The relevant portion read:

§ 135. Derivation proceedings

(a) INSTITUTION OF PROCEEDING— An applicant for patent may
file a petition to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner’s application and, without authorization, the earlier application claiming such invention was filed. Any such petition may be filed only within the 1-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application’s claim to the invention, shall be made under oath, and shall be supported by substantial evidence. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding. The determination by the Director whether to institute a derivation proceeding shall be final and nonappealable.

Paragraph 135(a) was amended again, in 2013, by a technical corrections act, but the amended provision still sets out a one-year period in which to copy the claims from an issued patent or a published application:

§ 135. Derivation proceedings

(a) Institution of proceeding.—

(1) In general.— An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an individual named in an earlier application as the inventor or a joint inventor derived such invention from an individual named in the petitioner’s application as the inventor or a joint inventor and, without authorization, the earlier application claiming such invention was filed. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.

(2) Time for filing.— A petition under this section with respect to an invention that is the same or substantially the same invention as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 122(b), may not be filed unless such petition is filed during the 1-year period following the date on which the patent containing such claim was granted or the earlier application containing such claim was published, whichever is earlier.

(3) Earlier application.— For purposes of this section, an application shall not be deemed to be an earlier application with respect to an invention, relative to another application, unless a claim to the invention was or could have been made in such application having an effective filing date that is earlier than the effective filing date of any claim to the invention that was or could have been made in such other application.

(4) No appeal.— A determination by the Director whether to institute a derivation proceeding under paragraph (1) shall be final and not appealable.

§ 3:35 Amendments—To the claims: Doctrine against late claiming—Subsequent developments

n. 9.
Insert at end of footnote:
; Adair v. Carter, 668 F.3d 1334, 101 U.S.P.Q.2d 1625 (Fed. Cir. 2012);
Pioneer Hi-Bred Intern., Inc. v. Monsanto Technology LLC, 671 F.3d 1324, 101 U.S.P.Q.2d 1849 (Fed. Cir. 2012);

n. 11.
Insert the following before “In re Berger”:
Adair v. Carter, 668 F.3d 1334, 101 U.S.P.Q.2d 1625 (Fed. Cir. 2012);

C. MECHANISMS TO ENCOURAGE DILIGENT PROSECUTION

§ 3:39 Generally

n. 1.
Replace footnote:
The provision reads:

§ 133. Time for prosecution 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 Commissioner in such action, the application shall be regarded as abandoned by the parties thereto.

§ 3:42 Response deadlines

n. 1.
Replace footnote:
The provision reads:

§ 133. Time for prosecution 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 Commissioner in such action, the application shall be regarded as abandoned by the parties thereto.

See also 37 C.F.R. § 1.134.

n. 30.
Replace footnote:
Act To implement the provisions of the Hague Agreement and the Patent Law Treaty.”) (enacting section 27).

See also 35 U.S.C.A. § 133 (2011) (allowing exception where Commissioner determines delay to have been unavoidable); 37 C.F.R. §§ 1.137, 1.183.


See also, e.g., Exela Pharma Sciences, LLC v. Lee, 781 F.3d 1349 (Fed. Cir. 2015) (challenge under APA).

D. CONTINUATION PRACTICE

§ 3:44 Generally

n. 1.
Replace footnote:

See, e.g., 35 U.S.C.A. § 120.

The provision reads:

§ 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

§ 3:45 Historical origins and policy justification

n. 16.
Replace footnote:

E.g., 35 U.S.C.A. § 154(a)(2) (“Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, 365(c), or 386(c), from the date on which the earliest such application was filed.”).
§ 3:46 Modern law

n. 1.

Replace footnote:

See, e.g., 35 U.S.C.A. § 120.

The provision reads:

§ 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

n. 24.

Insert the following before “Go Medical Industries”:

Cummins-Allison Corp. v. SBM Co., Ltd., 2012 WL 1890153 (Fed. Cir. 2012); Cordance Corp. v. Amazon.com, Inc., 658 F.3d 1330, 100 U.S.P.Q.2d 1230 (Fed. Cir. 2011);

Add at end of footnote:

See generally also In re NTP, Inc., 654 F.3d 1268, 99 U.S.P.Q.2d 1500 (Fed. Cir. 2011) (102(e) priority).

§ 3:47 Modern law—Time limits on filing

n. 4.

Replace footnote:

See, e.g., 35 U.S.C.A. § 120.

The provision reads:

§ 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings
on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

§ 3:48 Modern law—Time limits on filing—Laches, abandonment, and the doctrine against late claiming

Replace last sentence of section with:
The majority rule now, at least in the lower courts, is that the doctrine survives only in section 135(a), which limits the time during which the applicant may copy claims from an issued patent or a published application, and to an unknown extent in a potential defense of prosecution laches.


§ 3:51 Modern law—Cross reference

n. 1.

Replace footnote:
See, e.g., 35 U.S.C.A. § 120.

The provision reads:

§ 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Direc-
tor may consider the failure to submit such an amendment within that
time period as a waiver of any benefit under this section. The Director
may establish procedures, including the requirement for payment of the
fee specified in section 41(a)(7), to accept an unintentionally delayed
submission of an amendment under this section.

n. 3.
Add before citation to “Encyclopaedia Britannica” in footnote 3:
Medtronic CoreValve, LLC v. Edwards Lifesciences Corp., 741 F.3d 1359,
109 U.S.P.Q.2d 1422 (Fed. Cir. 2014);

Add at end of section:
Federal Circuit decisions establish that, in cases where
the applicant has filed a series of continuing applications,
each application in the sequence must contain a valid set of
cross references to earlier applications.10

10See, e.g., Zenon Environmental, Inc. v. U.S. Filter Corp., 506 F.3d
1370, 85 U.S.P.Q.2d 1118 (Fed. Cir. 2007); Broadcast Innovation, LLC v.
Cir. 2005); Santarus, Inc. v. Par Pharmaceutical, Inc., 694 F.3d 1344, 104
U.S.P.Q.2d 1641 (Fed. Cir. 2012); Medtronic CoreValve, LLC v. Edwards

§ 3:52 Modern law—Same subject matter

n. 3.
Replace footnote:
See, e.g., 35 U.S.C.A. § 120.
The provision reads:

§ 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner
provided by section 112(a) (other than the requirement to disclose the
best mode) in an application previously filed in the United States, or as
provided by section 363, which names an inventor or joint inventor in
the previously filed application shall have the same effect, as to such
invention, as though filed on the date of the prior application, if filed
before the patenting or abandonment of or termination of proceedings
on the first application or on an application similarly entitled to the
benefit of the filing date of the first application and if it contains or is
amended to contain a specific reference to the earlier filed application.
No application shall be entitled to the benefit of an earlier filed application
under this section unless an amendment containing the specific reference
to the earlier filed application is submitted at such time during
the pendency of the application as required by the Director. The Director
may consider the failure to submit such an amendment within that
time period as a waiver of any benefit under this section. The Director
may establish procedures, including the requirement for payment of the
fee specified in section 41(a)(7), to accept an unintentionally delayed
submission of an amendment under this section.
§ 3:55 Modern law—Same subject matter—Rule of adequate disclosure—Reference to disclosure

n. 4.
Replace footnote:
See, e.g., 35 U.S.C.A. § 120.
The provision reads:

§ 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

n. 9.
Insert the following after “See, e.g.,”:
Cordance Corp. v. Amazon.com, Inc., 658 F.3d 1330, 100 U.S.P.Q.2d 1230 (Fed. Cir. 2011); In re NTP, Inc., 654 F.3d 1268, 99 U.S.P.Q.2d 1500 (Fed. Cir. 2011) (description);

§ 3:56 Modern law—Same subject matter—Rule of adequate disclosure—Best mode issues

n. 13.
Replace quoted text of 35 U.S.C.A. § 120 with:

§ 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.
§ 3:56 Moy’s Walker on Patents

No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

§ 3:59 Modern law—Same subject matter—Additions and deletions—Additions: Continuations in part

n. 10.
Add after “See, e.g.,” in the footnote 10:
Trading Technologies Intern., Inc. v. Open E Cry, LLC, 728 F.3d 1309, 107 U.S.P.Q.2d 2085 (Fed. Cir. 2013);

n. 17.
Add at end of footnote:
See also Santarus, Inc. v. Par Pharmaceutical, Inc., 694 F.3d 1344, 104 U.S.P.Q.2d 1641 (Fed. Cir. 2012).

n. 18.
Add at end of footnote:
See also Santarus, Inc. v. Par Pharmaceutical, Inc., 694 F.3d 1344, 104 U.S.P.Q.2d 1641 (Fed. Cir. 2012).

n. 21.
Add after E.g.,:
Santarus, Inc. v. Par Pharmaceutical, Inc., 694 F.3d 1344, 104 U.S.P.Q.2d 1641 (Fed. Cir. 2012);

§ 3:60 Modern law—Same subject matter—Multiple continuations in sequence; Continuity of disclosure

n. 4.
Replace footnote:
See, e.g., 35 U.S.C.A. § 120.
The provision reads:

§ 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363, which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is
amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

n. 12.
Add after See, e.g.:

n. 13.
Add after See, e.g.:
Hollmer v. Harari, 681 F.3d 1351, 102 U.S.P.Q.2d 1958 (Fed. Cir. 2012), cert. denied, 133 S. Ct.989, 184 L. Ed. 2d 763 (2013) (intervening applications not amended to recite serial number of incorporated application);

E. OTHER PROCEDURAL MATTERS

§ 3:63 Issuance

n. 1.
Replace footnote:
Section 151 in particular states:

§ 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.


The immediately prior version of section 151 read:

§ 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.
Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

§ 3:65 Interferences and derivation proceedings

Insert at end of first sentence of eighth paragraph:

, at least for patents that are subject to the new provisions’ effective date

Add after footnote 29:

Interferences between issued patents under section 291 will presumably remain until the subject pre-AIA patents expire.

n. 31.

Add at end of footnote:

Paragraph (a) of section 135 was amended again, in 2013, by a technical corrections act:

§ 135. Derivation proceedings

(a) Institution of proceeding.—

(1) In general.— An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an individual named in an earlier application as the inventor or a joint inventor derived such invention from an individual named in the petitioner’s application as the inventor or a joint inventor and, without authorization, the earlier application claiming such invention was filed. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.

(2) Time for filing.— A petition under this section with respect to an invention that is the same or substantially the same invention as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 122(b), may not be filed unless such petition is filed during the 1-year period following the date on which the patent containing such claim was granted or the earlier application containing such claim was published, whichever is earlier.

(3) Earlier application.— For purposes of this section, an application shall not be deemed to be an earlier application with respect to an invention, relative to another application, unless a claim to the invention was or could have been made in such application having an
effective filing date that is earlier than the effective filing date of any claim to the invention that was or could have been made in such other application.

(4) No appeal.—A determination by the Director whether to institute a derivation proceeding under paragraph (1) shall be final and not appealable.


See also Leahy-Smith Correction Act, Pub. L. No. 112-274, § 1, 126 Stat. 2456 (Jan. 14, 2013) (technical correction to section 135(e)).

n. 32.
Replace first paragraph with:

§ 3:66 Post-issuance proceedings

n. 12.
Replace footnote:

n. 14.
Replace footnote:

§ 3:67 Certificates of correction

n. 2.
Add after "See generally, e.g.," in footnote 2: