

Training Module for Chapter 1 of the MPEP

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Summary

Chapter 1: Secrecy, Access, National Security, and Foreign Filing

[Doug's comment: For most of the history the United States Patent and Trademark Office (USPTO), patent applications made by inventors were held confidential to protect the best interests of the inventors before a patent was issued. Only after issue of a patent, could potential competitors assess the impact of a patent on their business.

However, the same procedures were not used throughout most of the other countries in the world. Patent applications were typically published well before the patents were issued. So, companies in the United States could gain insight into their competitor's future products and plans by reviewing any foreign patent applications that may have been relevant. In addition, pressure built up throughout the world to establish uniform patent rules and procedures for the international community.

In 1970, the United States joined many other members of the World Intellectual Property Organization to sign an international Patent Cooperation Treaty (PCT) that is now broadly accepted and used by more than 140 countries. One of the provisions of the PCT is to publish patent applications 18 months after their filing date. In order for the USPTO to be consistent in both their domestic and international activities, a provision was adopted to publish U.S. patent applications after 18 months as well – unless the inventor specifically promised not to file his/her application internationally at some later date.

With this background, it is hoped that the following provisions in Chapter 1 of the MPEP will seem less arbitrary than they might

otherwise appear.]

Section 101 - General

- Patent applications are initially held CONFIDENTIAL by the USPTO for a period of 18 months.
- Patent applications are to be published promptly after the 18 month period (starting from the earliest filing date for which a benefit is sought - usually the filing date). There can be an exception if the applicant promises not to make any foreign filing

Definitions:

- “Patent applicant” = inventor or joint inventors who are filing for a patent application on their invention.
- “Patent family” = multiple patent applications covering the same or closely related inventions that are filed at different times. (Sometimes also referred to as a “patent chain”.)
- “Effective filing date” = the earliest filing date in a chain to which the application properly claims priority. Properly is established by full disclosure in the earlier application.

[**Doug’s Comment:** After being filed, a patent application may continue forward in the USPTO without changes or it may be modified as a continuing application.]

- There are 3 types of Continuing Applications:
 - (1) a continuation adds extra claims to a filed patent application but does not change the earlier specification. No “new material” is permitted that would change the scope of the invention after the filing date of the application!
 - (2) a divisional is a portion of an earlier patent application that has been separated (carved out) as a distinct invention and is processed by the USPTO separate from another invention in a prior application.

Patent rules allow for only one invention to be claimed in any given application. Often, a divisional application is the result of a “restriction requirement” made by the patent examiner.

[Doug’s comment: Since both the patent examiners and the USPTO are compensated based on the number of applications they process, it would be inappropriate for an applicant to combine two or more inventions into a single application. In such cases, the patent examiner may impose a “restriction requirement” requiring the applicant to select just one invention for consideration (examination) by the USPTO. The applicant is also invited to file one or more divisional applications covering the other inventions in his original application that were not selected for examination. But, this is a discretionary choice left up to the applicant.]

(3) a continuation-in-part (or CIP) repeats a substantial portion of an earlier application but also adds new material not previously disclosed. (Note: A CIP may have more than one effective filing date due to the nature of the earlier and new claims. The filing date for any new claims covering material that was not previously disclosed would be the filing date for the CIP.)

Section 102 – Information as to Status of an Application

- USPTO generally holds all patent applications in confidence until it is published.
- Prior to publication, access is limited to:
 - (1) the inventor
 - (2) an attorney or agent of record in the application
 - (3) an assignee of record in the application, or
 - (4) a person with written authority from (1), (2), or (3), above, to obtain status information regarding a pending patent application.
- Status information includes:
 - (A) whether the application is pending, abandoned, or patented
 - (B) whether the patent has been published
 - (C) the application number, serial number, or filing date of the

application, and

(D) whether the application claims priority to another application.

EXCEPTION: Anyone may make a written request for status information for a patent application that is referenced in another application that is not subject to confidentiality (e.g. the other application has already been published). IN FACT, ONE MAY REQUEST NOT ONLY STATUS INFORMATION – BUT A COPY OF THE ENTIRE PATENT APPLICATION (INCLUDING THE FILE WRAPPER).

Section 103 – Right of Public to Inspect Patent Files and Some Applications

- The specification, drawings, and file wrapper are open to public inspection for published applications, patents, and statutory invention registrations. (If the application is published in a redacted form, the file wrapper and redacted contents in the application will not be available.)
- Copies may be made available to anyone paying the required fee.

[**Doug's comment:** Since one objective of the USPTO is to operate without taxpayers' assistance, almost every item and every service provided has an associated fee.]

- The file of any interference is also open to public inspection and copies are available for a fee.

Definition

- “File wrapper” = The specification, drawings, and all papers relating to the file of a published application.
- LOSS OF CONFIDENTIALITY: Incorporation by reference of an unpublished application in a U.S. patent application publication, a U.S. patent, a published international patent or a

statutory invention registration RESULTS IN A LOSS OF CONFIDENTIALITY and anyone can petition for access to the application so referenced even if the application has been abandoned.

Section 104 Power to Inspect Application

- Inspection rights (including copying) of an unpublished patent application may be granted by an applicant, attorney or agent of record, or assignee of record (if an oath or declaration has been filed).
- In the absence of an oath or declaration, an attorney prosecuting an application without power of attorney may also grant power to inspection - but only if the attorney or agent was named in the application transmittal papers.
- Once an executed oath or declaration has been filed, any previously filed powers to inspect signed by a registered attorney or agent who does not have power of attorney will cease to have effect.

Section 105 – Suspended or Excluded Practitioner Cannot Inspect

- A suspended or excluded practitioner (attorney or agent) is excluded from oral and written communication with the USPTO.
- The only exception is if the excluded practitioner is also an applicant.
- If the suspended or excluded practitioner were also the attorney or agent of record, all USPTO correspondence will be mailed to the first named inventor of record.

Section 106 – Control of Inspection by Assignee

- The assignee of record of the entire interest in an application may intervene in the prosecution of the application (referred to as “taking over” prosecution) by appointing an attorney or agent of his or her own choice.
- Such intervention does not preclude the applicant from access to the application to see that it is being prosecuted properly – unless the assignee makes a specific request (directed to the Office of Petitions) denying the applicant access and that request is granted. (Possibly for cases when the applicant is no longer employed by the assignee.)

Section 110 – Confidential Nature of International Applications

- After publication of any application in the U.S., the USPTO will provide the public with copies of, and access to the complete application file wrapper.
- Similarly, after publication of an international application designating the U.S. under the Patent Cooperation Treaty (PCT) the USPTO will also make available copies and allow access to the international application files which are kept in the USPTO.
- However, the access to the written opinion of the International Search Authority (ISA) will not be made available until the expiration of 30 months from the priority date of the application. (However, if the U.S. acted as the International Preliminary Examining Authority, the International Preliminary Examination Report will be made available immediately upon request.)

Section 115 – Review of Application for National Security Property Rights Issues

- All patent applications sent to the USPTO are reviewed for subject matter that, if disclosed, might impact the national security.

If the Commissioner of Patents determines that disclosure of the application might, in his opinion, be detrimental to national security AND THE U.S. GOVERNMENT DOES NOT HAVE A PROPERTY INTEREST IN THE APPLICATION he will make it available to Atomic Energy Commission, Department of Defense, and any other agency involved in defense.

If any of these agencies concludes that disclosure would be detrimental, the Commissioner of Patents will issue a Secrecy Order and withhold publication of the application or grant of the patent for any such period as the national interest requires.

Section 120 – Secrecy Orders

- If the Commissioner of Patents determines that disclosure of the application might, in his opinion, be detrimental to national security AND THE U.S. GOVERNMENT DOES HAVE A PROPERTY INTEREST IN THE APPLICATION he shall contact the head of the interested government agency to determine if disclosure would be detrimental. If so, the Commissioner of patents will order the invention be kept secret and publication be withheld for no more that one year. However, at the end of the year, the order may be extended by another year, etc.

Thus, any application under a secrecy order will not be published 18 months after their effective filing date. Rather, publication occurs after the secrecy order is expired or is removed.

Section 121 – Handling of Applications of Other Papers Bearing Security Markings

All applications or papers in the USPTO bearing the words such as “Secret” or “Confidential” must be promptly referred to the appropriate Technology Center (TC) Working Group for clarification of security treatment.

- Under no circumstances may any such applications, drawings, exhibits, or other papers be placed in public records, such as patent files, until all security markings have been considered and declassified or otherwise explained.
- NOTE: Security markings on drawings should be outside of the illustration so that they may be removed when declassified.

Section 130 – Examination of Secrecy Order Cases

- Applications under a secrecy order are examined for patentability (as in other cases), but these applications may not be passed to issue, nor will an interference be declared.
- NOTE: In the case of a final rejection, an appeal must be completed by the applicant to avoid abandonment, such appeal will not be set for hearing by the Patent Trial and Appeal Board until after the secrecy order is removed.
- So, any application under a secrecy order will not be published, issued, or reviewed by the Board for purposes of an interference or appeal.

140 – Foreign Filing License

- A license from the USPTO is required before any foreign filing of an invention that was made in the U.S.
- A person filing a U.S. Patent may not file in a foreign country prior to 6 months after filing in the U.S. or earlier, if a license for foreign filing license is obtained from the Commissioner of Patents. (This provides time for the USPTO to review the application for possible secrecy treatment.)

The penalty for not following this procedure can be severe. First, any subsequently issued U.S. patent shall be invalid. Further, if a secrecy order were imposed after a foreign filing, the applicant could be imprisoned for up

to two years and a \$10,000 fine could be imposed if the foreign filing were willful.

Selected Questions and Answers for Chapter 1

Please make a serious effort to answer the following questions either by referring back to the **Summary**, above, or by searching for the answers in Chapter 1 of the MPEP. If you find the correct answer on your own, you will be likely to remember it. And even if you don't find the answer, you will have broadened your searching skills.

After you believe that you know the correct answer or you feel that you've invested a sufficient time searching for it, read on to the ANSWER.

In the event that you got the answer wrong, take a few minutes, with the benefit of hindsight, to try and find the correct answer in the MPEP. This will be time well spent to enhance your searching skills.

When finished, proceed to the next question.

Question 1-1

You search the Patent Office's publication database and locate an application of interest. The published application does not claim the benefit of another application but does properly incorporate by reference another non-published application that is not accessible through the database. May you obtain a copy of the non-published application from the Patent Office?

ANSWER: Yes, a copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee, if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication. Although the Patent Office will not generally provide access to the complete file wrapper of the pending application, a copy of the application as filed will be provided if a written request is made.

Question 1-2

Bill, through his patent attorney Peter, filed a divisional patent application on January 22, 2005. The application was published in due course. Jane, a close relative of Peter, desires to

obtain a copy of all Office Actions issued in the parent patent application from which the divisional claims priority. The parent application has since become abandoned and has not been published. Can Jane obtain a copy of the Office Actions entered in the parent application?

ANSWER: Yes, the complete file wrapper of an abandoned application may be made available to the public, upon a written request, if benefit of the abandoned application is claimed in a U.S. patent, U.S. patent application publication, or an international patent application that was published. Although the parent application was never published and has become abandoned, it is nonetheless accessible upon request because the divisional application has been published and claims priority to the abandoned parent application.

Question 1-3

Registered practitioner Peter filed a patent application claiming a novel system of encrypting information. Peter was a named co-inventor of the invention along with three other individuals, named Paul, John, and Mary. Peter's address was also the correspondence address of record in the application. Shortly after filing the application, Peter was suspended by the Patent Office for misconduct. Will the Patent Office mail an Office Action to Peter's address?

ANSWER: Yes. Several questions appear in the examination question bank regarding suspended practitioners. The general rule is that the Patent Office will not correspond with a suspended practitioner unless the practitioner has an interest in the application (*e.g.*, in also the inventor). If the suspended practitioner does not have an interest in the application, the Office Action will not be mailed to the suspended practitioner but is mailed to the address of the ***first named inventor***. This question, however, involves a suspended practitioner who is also a named co-inventor. In such a case, the Patent Office will continue to correspond with the suspended practitioner because the practitioner has an interest in the application.

Question 1-4

Peter, the agent of record, grants a written power to inspect a currently pending and unpublished patent application to Jill. Due to sickness, Peter withdraws his representation from the matter and transfers the case to Paul, a registered patent attorney. The applicant never executes a new power of attorney on behalf of Paul, but Paul does substantial work on the application, including responding to Office Actions and filing an Information Disclosure Statement (IDS). Paul grants Jessica a written power to inspect the still pending and unpublished application. Can Jill and Jessica make a copy of the application in accordance with the Rules?

ANSWER: Jill can make a copy of the application but Jessica cannot. Jill received a power

to inspect from Peter, who was, at the time of granting the power to inspect, an agent of record. Jessica, however, received a power to inspect from Paul, who never entered a power of attorney on his behalf in the application, and therefore, was not of record. Although Paul can continue to prosecute the application because he is acting in a representative capacity under 37 C.F.R. § 1.34, Paul cannot grant a power to inspect because he is not of record and was not named in the application transmittal papers.

Question 1-5

While working in a technology company, Jack and Jill were equally assigned a 50% stake in two patent applications. The inventors of the subject matter contained in the applications executed an assignment to Jack and Jill, which was duly recorded with the Patent Office. Jill submits a request to the Patent Office to take over the prosecution for one of the applications. Will the request be granted?

ANSWER: No. Jill is not an assignee of the entire interest. She is a partial assignee for both applications. Jill cannot therefore take over prosecution of either patent application. Both Jack and Jill, as co-owners, are entitled to inspect the application and must act together while prosecuting the applications.

Question 1-6

Bill filed an international application 19 months ago under the provisions of the PCT and designated the U.S., among other Contracting States. The application does not claim priority to an earlier application. In the filing, Bill indicated that the U.S. Patent Office was to act as the International Searching Authority ("ISA"). The international application was published one month ago, in accordance with PCT Article 21(2). Can Jack obtain the written opinion established by the U.S. Patent Office as the ISA?

ANSWER: No. The written opinion established by the ISA will not be available until the expiration of 30 months from the priority date. Jack could obtain a copy of the application and other papers associated with the application from the Patent Office because the application has been published in accordance with the PCT, but the opinion from the ISA will not be released at this time. The written opinion of the ISA is the notable exception to the general rule that once published, the complete file wrapper of an application is available to the public. If you got this question wrong, do not worry. It was designed to teach you the important exception to the rule.

Question 1-7

Bill, a registered patent agent and inventor, filed a patent application covering a novel way to avoid modern radar detection through the use of advanced acoustics. The subject matter contained in the application was invented by Bill and his friend Joel. After filing the application, the Patent Office notifies Bill and Joel that the Commissioner has issued a

secrecy order covering the application. The Department of Defense later contacted Bill and informed him that the military was eager to use the "breakthrough" technology disclosed in the application for its newest fleet of fighter jets because it solved a long-felt but unsolved need of the Department. The Patent Office later issued a first Office Action rejecting all claims of the applications as anticipated by several other publications under 35 U.S.C. § 102. Bill believes that the Office Action is improper because the secrecy order clearly indicates that the invention is valuable, and the Department of Defense even confirmed that the invention addressed a long-felt but unsolved need of the Department. Is Bill correct?

ANSWER: No. A Secrecy Order should not be construed in any way to mean that the Government has adopted or contemplates adoption of the alleged invention disclosed in an application; nor is it any indication of the value of such invention. Moreover, the belief of the Department of Defense is irrelevant to a rejection based on anticipation under 35 U.S.C. § 102. Secondary considerations, such as evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results are relevant only to a rejection based on obviousness under 35 U.S.C. § 103, not rejections based on anticipation. Rejections based on Sections 102 and 103 are discussed in detail later in this guide.

Question 1-8

Peter, a registered patent agent, was preparing a patent application covering a system developed by government researchers at the Lawrence Livermore National Laboratory. All inventors of the subject matter in the application had "Top Secret" security clearance and the system was designated "Top Secret" by the Department of Defense. Peter prepared the application and clearly marked "Top Secret" on the transmittal form, detailed description, and claims. Peter, however, did not mark the drawings with a "Top Secret" indication. Did Peter violate any Rules by not including a security indication on the drawings?

ANSWER: No. 37 C.F.R. § 1.84(v) provides that authorized security markings *may* be placed on the drawings provided they are outside the sight, preferably centered in the top margin. Because the transmittal form and other application documents contained security markings, the entire application will be forwarded to the Technology Center (TC) Working Group that reviews applications for security treatment. The Working Group will then decide whether the entire application, including the drawings, should receive security treatment.

Question 1-9

Peter, a registered patent agent, is currently prosecuting an application under a secrecy order for the United States Navy. Peter, while reviewing recent patent application publications, discovers that another application assigned to General Dynamics Corporation claims virtually identical subject matter to that of the application he is prosecuting. Because the applications were filed with the Patent Office within days of each other, Peter, following the procedures set forth in 37 C.F.R. § 41.202, decides to suggest an interference with the General Dynamics application to determine which application should obtain priority. Can Peter suggest an interference in this situation in compliance with the Rules?

ANSWER: Yes. Peter may *suggest* an interference, but the Patent Office will not grant the interference request because his application is currently under a secrecy order. Because the question merely asks if Peter could suggest an interference, the answer is affirmative. The Patent Office, however, will not conduct an interference until the secrecy order is lifted.

Question 1-10

Jack and Jill, the inventors of a new type of wheel barrow, seek the assistance of patent agent Peter to file a patent application covering their invention. After filing an application with the Patent Office, Jill (without conferring with Jack) asks Peter about filing another patent application in Holland, where wheel barrows sales have significantly increased in the past year. Peter informs Jill that they must wait for the foreign filing license before filing in Holland. Peter, through error and without deceptive intent, files an application in Holland even though he has yet to receive a foreign filing license. A week after filing in Holland, Peter receives a foreign filing license from the Patent Office. Was the foreign filing proper?

ANSWER: No. Peter filed the application in Holland before receiving a foreign filing license. The fact that Peter later received a foreign filing license is irrelevant. Peter may, however, seek a retroactive license because the unlicensed foreign filing occurred through error and without deceptive intent. 37 C.F.R. § 5.25 sets forth the procedure for obtaining a retroactive license, including a showing of facts (rather than a mere allegation) that the unlicensed filing was through error and without deceptive intent.

In-Depth Review of Chapter 1

Please click on the link, below, to bring up a special version of Chapter 1 in the MPEP that has been prepared exclusively by **PassPatentBar** to complete your review of this chapter. It is recommended that you quickly scan through most of this chapter while reading only those sections, about 10% of the total, that are highlighted in yellow. When you are finished with this review, please return here by using the return arrow at the top-left on your screen.

When reading the highlighted sections, you will see numerous references to various patent Laws and Rules. Unless you have a specific interest in a particular Law or Rule, it is recommended that you just read past the references, since the text that you will be reading has been prepared to explain those Laws and Rules.

[Doug's comment: Life is too short to spend your time reading the MPEP from cover-to-cover. One of the main objectives of **PassPatentBar** is to help you avoid doing this. However, it is important for you to gain an early appreciation for the composition

and style of this rather complex document. Some may develop a lack of fondness for the MPEP, yet everyone will come to embrace it because it contains all the answers that you will need to become a registered patent practitioner.

Chapter 1 is a particularly difficult chapter because many new terms are thrown at you in a less than logical manner and the subject material is not particularly interesting. You can look forward to Chapter 2 being somewhat easier to assimilate. As you work through the **Training Modules** covering the MPEP Chapters, you will find that many of the disjointed pieces will come together.]

[Chapter 1 MPEP](#)