

# Training Module for Chapter 17 of the MPEP

*(Revised August 16, 2018)*

## Summary

### Chapter 17: Miscellaneous

#### Section 1701 – Office Personnel Not to Express Opinion on Validity, Patentability, or Enforceability of Patents

- **Presumption of validity:** A patent will be presumed valid (until proven otherwise. (Just like we are innocent until proven guilty by a court of law.) Similarly, a patent may be invalidated by a court of law.
- A dependent claim remains valid even if the independent claim to which it refers is invalidated.
- The burden of establishing invalidity of a patent or any claim in it rests with the party asserting invalidity.
- The only times where it is appropriate for an employee of the USPTO to comment on the validity, patentability, or enforceability of an issued patent is when:
  - (1) the patent is being reissued
  - (2) the patent is being re-examined
  - (3) the patent is involved in an interference proceeding.

#### Section 1702 – Restrictions on Practice in Patent Matters

- NOTE: Restrictions on employees of the USPTO is frequently tested!
- Generally, the USPTO limits a former employee from:

- (1) acting as an agent at any time in any matter in which the employee substantially participated, and
  - (2) acting as an agent within two years from termination of employment with the Patent Office.
- Current employees of the USPTO may not prosecute or participate in any manner in the prosecution of any patent application.

Also, current employees cannot apply for or obtain interest in any patent while an employee and up to one year after their employment terminates (except by inheritance).

### Section 1705 III. COUNTING OF DISPOSALS

**[Doug's Comment:** While this section is not likely to be tested on the Bar Exam, it provides considerable insight into the performance evaluation of the patent examiners and the entire USPTO. Basically, the examiner and the USPTO receive a “count” (i.e. a positive evaluation point) for *either* a patent application allowance or an abandonment. Both actions are called “disposals” and are equally rewarded. However, at the USPTO level, no points are given for a disposal that involves an appeal to the Board of Patent Appeals and Interferences.

This evaluation system provides some insight into why an examiner's first office action may be a rejection of a patent application with what a patent agent or attorney may consider to be superficial reasoning. If neither the inventor nor the agent makes a response, abandonment becomes final and a “disposal count” is received with minimum effort by the examiner.

However, if a serious reply is made by the patent agent to the first office action, pressure goes up on the examiner to give the application and response further consideration - knowing that an appeal might follow that would negate any future “disposal count”.]

### **Selected Questions and Answers for Chapter 17 - NONE**

## **In-Depth Review of Chapter 17**

Chapter 17 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are highlighted in yellow.

[Chapter 17, MPEP](#)