

Training Module for Chapter 9 of the MPEP

Summary

Chapter 9: Prior Art, Classification, and Search

Section 901 – Prior Art

- Generally speaking, prior art constitutes all information that has been made available to the public in any form before a particular date that might be relevant to a patent's claims of novelty or non-obviousness.
- In contrast, information that has been kept secret (for instance a trade secret) is not usually prior art provided that employees and others with access to the information are under non-disclosure obligations.
- Prior art may consist of books, magazines, newspaper articles, technical journals, scholarly theses. And any other information reasonably accessible to the public, such as an abandoned patent application that was previously published.
- REMEMBER: Patent applications that have not been published are generally preserved in confidence and are, therefore, not available as prior art.
- Prior art references may be in any language!

Selected Questions and Answers for Chapter 9

Question 9-1 (Oct03am-44a)

A registered practitioner filed in the USPTO a client's utility patent application on December 30, 2002. The application was filed with a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application in another country, or under a multilateral international agreement, that requires eighteen month publication. Subsequently, the client files an application in Japan on the invention and some recent improvements to the invention. The improvements are not disclosed or supported in the utility application. Japan is a

country that requires eighteen month publication. Two months after filing the application in Japan, and before filing any other papers in the USPTO, the client remembers that a nonpublication request was filed and informs the practitioner about the application that was filed in Japan. Which of the following courses of action is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) The application is abandoned because the practitioner did not rescind the nonpublication request and provide notice of foreign filing within 45 days of having filed the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (B) The application is abandoned because the applicant did not rescind the nonpublication request before filing the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (C) The applicant should file an amendment to the specification of the U.S. application, adding the recent improvements to the disclosure in the specification.
- (D) The application is abandoned because the applicant did not rescind the nonpublication request by notifying the Office under 37 CFR 1.213(c) within the appropriate time. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (E) The applicant could today notify the USPTO of the foreign filing. It is not necessary to file a petition and fee to revive for the application to continue to be examined in the USPTO.

ANSWER: (A) is the most correct answer. See 35 U.S.C. 122(b)(2)(B)(iii); 37 CFR § 1.213; MPEP § 901.03 for information on nonpublication requests. See 37 CFR § 1.137(f); MPEP § 711.03(c), under the heading “3. Abandonment for Failure to Notify the Office of a Foreign Filing After Submission of a Non-Publication Request.” (B) is incorrect. The notice of foreign filing can be filed as late as 45 days after the foreign filing before the U.S. application becomes abandoned. (C) is incorrect. See MPEP § 608.04(a). The improvements would constitute new matter and new matter cannot be added to the disclosure of an application after the filing date of the application. (D) is not correct. The applicant is required to provide notice of foreign filing, not merely rescind the nonpublication request within the appropriate time. (E) is not correct. The applicant was required to provide notice of foreign filing within 45 days of filing in Japan, and two months have passed. As a result, a petition to revive under 37 CFR § 1.137(b) is required for examination to continue. Also see 37 CFR § 1.137(f).

Question 9-2 (Ap03pm-48a)

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements regarding a proper prior art reference is true?

- (A) Canceled matter in the application file of a U.S. patent is a prior art reference as of the filing date under 35 USC 102(e).
- (B) Where a patent refers to and relies on the disclosure of a copending subsequently abandoned application, such disclosure is not available as a reference.
- (C) Where the reference patent claims the benefit of an earlier filed, copending but subsequently abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure for the common subject matter and the claimed matter in the reference patent, the effective date of the reference patent as to the common subject matter is the filing date of the reference patent.
- (D) Matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date.
- (E) All foreign patents are available as prior art as of the date they are translated into English.

ANSWER: (D) is the most correct answer. See 35 U.S.C. § 102(a). As explained in MPEP § 901.01, the “matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP 2127 and 2136.02.” (A) is incorrect. 35 U.S.C. § 102(e). As stated in MPEP § 901.01, “Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e), see *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966).” (B) is incorrect. As stated in MPEP § 901.02, “*In re Heritage*, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a copending abandoned application, such disclosure is available as a reference. See also *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).” (C) is incorrect. As MPEP § 901.02 indicates, where the reference patent claims the benefit of a copending but abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure of the common subject matter and claimed matter in the reference patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *In re Switzer*, 77 USPQ 1, 612 O.G. 11 (CCPA 1948); *Ex parte Peterson*, 63 USPQ 99 (Bd. App. 1944); and *Ex parte Clifford*, 49 USPQ 152 (Bd. App. 1940).” (E) is incorrect. As stated in MPEP § 901.05, “In general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting or publication can be confirmed by an examiner’s review of a copy of the document.”

In-Depth Review of Chapter 9

Please click on the link, below, to bring up a special version of Chapter 9 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.

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