
3rd Annual Automotive Composites Conference

Sept. 9-10, 2003

MSU Management Education Center

811 W. Square Lake Road

Troy, Michigan

**EVOLUTION OF THE INVENTION
FROM CONCEPTION THROUGH PATENT
PROSECUTION AND PATENT GRANT –
CHANGED WROUGHT BY THE AIPA**

William G. Abbatt,¹ Brooks Kushman P.C.

Email: wabbatt@brookskushman.com

Direct Dial: (248) 226-2760

¹ William G. Abbatt is a shareholder at Brooks Kushman P.C. He chairs the Intellectual Property Law Section of the Federal Bar Association (E.D. Mich.) Chapter.

**EVOLUTION OF THE INVENTION:
FROM CONCEPTION THROUGH PATENT
PROSECUTION IN THE PTO AND PATENT GRANT --
CHANGES WROUGHT BY THE AIPA**

INTRODUCTION.....	3
I. PATENT LAWS AND REQUISITES FOR PATENTABILITY.....	3
A. PATENT LAWS	3
B. WHAT IS A PATENT?.....	4
C. WHAT CAN BE PATENTED?.....	5
D. CONDITIONS FOR OBTAINING A PATENT: NOVELTY, UTILITY AND NON- OBVIOUSNESS	5
II. PATENT APPLICATION PROCEDURE	6
A. NON-PROVISIONAL APPLICATIONS.....	7
B. PROVISIONAL APPLICATIONS.....	7
C. RESTRICTION PRACTICE	8
D. OFFICE ACTION	8
E. APPLICANT’S REPLY	9
F. FINAL REJECTION AND APPLICANT'S RESPONSE	9
G. APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES AND TO THE COURTS.....	9
H. INTERFERENCES.....	10
III. POST-ISSUANCE PROCEEDINGS	11
A. REISSUE.....	11
B. REEXAMINATION	12
IV. AMERICAN INVENTORS PROTECTION ACT OF 1999 (AIPA)	13
A. KEY PROVISIONS	13
B. PATENT TERM ADJUSTMENT (SUBTITLE D).....	14
C. PRE-GRANT PUBLICATION (SUBTITLE E).....	15
D. INTER PARTES REEXAMINATION (SUBTITLE F).....	16
CONCLUSION.....	17

"The patent system adds the fuel of interest to the fire of genius"

Abraham Lincoln, patentee¹, 1859

INTRODUCTION

“That’s a great idea! Write that down! You should get a patent on that!”

These words or their variants, have been spoken or heard by many of us. But for most, including lawyers (and, perhaps some judges), the path from the conception of an invention to its protection by an issued patent remains an enigma. This paper seeks to demystify this evolution by providing a brief overview of (1) the process for obtaining a patent from the United States Patent and Trademark Office (PTO); (2) the related substantive and procedural patent laws and regulations, and (3) the American Inventors Protection Act of 1999 (AIPA).

Part I summarizes the relevant patent laws, the scope of protection afforded by them to an inventor, and the requisites for patentability. Part II describes various procedures employed by an inventor, the PTO, or a third party during the patent application phase. Part III focuses on certain post-issuance matters, with passing reference to reissue and reexamination procedures. Part IV reviews the effects of the AIPA on patent application and issuance.

I. PATENT LAWS AND REQUISITES FOR PATENTABILITY

A. Patent Laws

The Constitution of the United States gives Congress the power to enact laws “to promote the progress of science and useful arts, by securing for limited times . . . to inventors the exclusive right to their . . . discoveries.”² The first U.S. patent law was enacted in 1790, though by that time the idea of granting exclusive rights to inventors was well-established. As early as 500 B.C., the Greek colony of Sybaris granted such rights.³ Inventors were also given exclusive rights to their inventions by the Senate of the Republic of Venice in the 15th century, by the English and German Empires in the mid-16th century, and by the colony of Massachusetts in 1641.⁴

Patent laws underwent a general revision which was enacted July 19, 1952, and which came into effect January 1, 1953.⁵ On November 29, 1999, Congress enacted the American Inventors Protection Act of 1999 (AIPA), which further revised the patent laws.⁶

Patent law defines the subject matter for which a patent may be obtained and the conditions for patentability. The law establishes the United States Patent and Trademark Office (PTO) to administer the granting of patents and contains various other provisions relating to patents.⁷

B. What Is A Patent?

A patent for an invention is a property right granted to the inventor or owner of the patent. It is issued by the PTO. Generally, the term of a patent is 20 years from the date on which the application was filed in the United States, subject to the payment of maintenance fees. U.S. patent grants are effective only within the United States, U.S. territories, and U.S. possessions. Under certain circumstances, patent term extensions or adjustments may be available.

The right conferred by the patent grant is “the right to exclude others from making, using, offering for sale, or selling” the invention in the United States or “importing” the invention into the United States.⁸ What is granted is not the right for the patent owner itself to make, use, offer for sale, sell or import.

There are three types of patents:

1. Utility patents for "anyone who invents or discovers any new and useful process, machine, article of manufacture, or compositions of matters, or any new useful improvement thereof"; (CITE)
2. Design patents for "anyone who invents a new, original, and ornamental design for an article of manufacture"; (CITE) and
3. Plant patents for "anyone who invents or discovers and asexually reproduces any distinct and new variety of plant." (CITE)

C. What Can Be Patented?

Patentable subject matter includes ". . . any new and useful process, machine, [article of] manufacture, or composition of matter, or any new and useful improvement thereof, subject to the conditions and requirements of the law."⁹ The word "process" means an act or method, and includes industrial or technical processes.¹⁰ Today, business methods conventionally may be patentable subject matter. (CITE) A "machine" typically is an assembly of parts that cooperate. "Manufacture" refers to articles that are made. The term "composition of matter" relates to chemical compositions, and may include mixtures of ingredients and new chemical compounds. These classes of patentable subject matter include practically every product that is made and the processes for their making.

Interpretations of the patent statute by the courts have defined the limits of subject matter that can be patented. It has traditionally been held that the laws of nature, physical phenomena, and abstract ideas are not patentable subject matter. (CITE)

D. Conditions For Obtaining A Patent: Novelty, Utility And Non-Obviousness

In order for an invention to be patentable it must be new. An invention cannot be patented if: "(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," or "(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the application for patent in the United States . . ."¹¹

If the invention has been described in a printed publication anywhere in the world, or if it has been in public use or on sale in this country before the date that the applicant made his/her invention, a valid patent cannot be obtained. If the invention has been described in a printed publication anywhere, or has been in public use or on sale in this country more than one year before the date on which an application for patent is filed in this country, a valid patent cannot be obtained. It is immaterial or whether the printed publication or public use was by the inventor himself/herself or by someone else. The inventor must file on or before the date of public use or disclosure in order to preserve patent rights in many foreign countries.

The patent law specifies that the subject matter must be “useful.”¹² The term “useful” refers to the condition for patentability that the subject matter has a useful purpose. It includes operativeness. For example, a machine which will not operate to perform its intended purpose would not be "useful", and therefore would not be granted a patent.

If the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious.¹³ The subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to be nonobvious to a person with ordinary skill in the area of technology related to the invention. For example, without more, the substitution of one color for another, or changes in size, are ordinarily not patentable.

II. PATENT APPLICATION PROCEDURE

When the U.S. patent system was introduced in 1790, patent applicants submitted inventions to an examining board, which investigated each patent application and issued a patent only when it deemed the invention sufficiently useful and important. In 1793, Congress changed the patent application procedure to a registration system, where the government accepted an applicant’s oath that the invention was novel, and did not conduct an independent examination. Thus, the courts were left to decide whether an invention was novel if the patent ultimately appeared in litigation. The resultant uncertainty of the validity of patents caused inventors difficulty in raising money to develop their inventions. Thus, in 1836, Congress returned the patent application procedure to an examination system, and so it remains today.¹⁴

The PTO administers the patent laws as they relate to the granting of patents for inventions. It also (1) examines applications for patents to determine if the applicants are entitled to patents under the law and grants the patents when they are so entitled; (2) publishes most patent applications filed on or after November 29, 2000, at 18 months from the earliest filing date, and disseminates various publications concerning patents; (3) records assignments of patents; (4) maintains a search room for public use to examine issued patents and records; and (5) supplies copies of records and other papers, and the

like. The PTO has no jurisdiction over questions of infringement and the enforcement of patents, nor over matters relating to the utilization of patents or inventions.

A. Non-Provisional Applications

A non-provisional patent application is examined by the PTO for patentability. A non-provisional application is made to the Commissioner for Patents and includes at a minimum:¹⁵

- (1) A written document which includes a specification (description and claims), and an oath or declaration;
- (2) A drawing in those cases in which a drawing is necessary; and
- (3) The filing fee.

(Written description, best mode, enablement requirements) (CITES)

B. Provisional Applications

Since June 8, 1995, the PTO has offered inventors the option of filing a provisional application for patent which was designed to provide a lower cost first patent filing in the United States and to give U.S. applicants parity with foreign applicants.¹⁶ Claims and an oath or declaration are not required for a provisional application. A provisional application is a way to establish an early effective filing date and allows the term “Patent Pending” to be used in connection with the invention. Provisional applications may not be filed for design inventions.

The filing date of a provisional application is the date on which a written description of the invention, drawings if necessary, and the name of the inventor(s) are received in the USPTO. The applicant then has up to 12 months to amend his application to non-provisional status or file a non-provisional application for patent, as described above. A provisional application becomes abandoned by the operation of law 12 months from its filing date. The claimed subject matter in the later filed non-provisional application is entitled to the benefit of the filing date of the provisional application if it is disclosed in the earlier provisional application. Provisional applications are not examined on their merits.

The 12-month pendency of a provisional application is not counted toward the 20-year term of a patent granted on a subsequently filed non-provisional application which relies on the filing date of the provisional application.

As a result of the examination by the Office, patents are granted in about two out of every three applications for patents which are filed.¹⁷

C. Restriction Practice

After receiving a non-provisional application, the examiner first checks to see if two or more inventions are claimed. If so, and if considered independent and distinct, such that a single patent should not be issued for both, the applicant will be required to limit the application to one of the inventions.¹⁸ The non-elected invention may be made the subject of a separate application which, if filed while the first application is still pending, is entitled to the benefit of the filing date of the first application. A requirement to restrict the application to one invention may be made before further action by the examiner.

D. Office Action

The applicant is notified in writing of the examiner's initial decision on patentability by an Office "action" which is normally mailed to the attorney or agent of record.¹⁹ The reasons for any adverse action or any objection or requirement are stated in the Office action. Information or references are given that may be useful in aiding the applicant to decide whether to continue the prosecution of his/her application.

If the claimed invention is not directed to patentable subject matter, the claims will be rejected on that basis. If the examiner finds that the claimed invention lacks novelty or differs only in an obvious manner from what is found in the prior art, the claims may also be rejected. It is not uncommon for some or all of the claims to be rejected on the first Office action by the examiner. Relatively few applications are allowed as filed.²⁰

E. Applicant's Reply

In response to the Office Action, the applicant must request reconsideration and reexamination in writing, and must distinctly and specifically point out the supposed errors in the examiner's Office action. The applicant must reply to every ground of objection and rejection in the Office action. The applicant's reply must appear throughout to be a bona fide attempt to advance the case to final action or allowance. A mere allegation that the examiner has erred is not a proper reason for such reconsideration.

In amending an application in reply to a rejection, the applicant must clearly point out why he/she thinks the amended claims are patentable in view of the state of the art disclosed by the prior references cited or the objections made. He/she must also show how the claims as amended avoid such references or objections.

F. Final Rejection and Applicant's Response

After reply by the applicant, the application will be reconsidered. The applicant then will be notified for the second time as to the status of the claims, that is, whether the claims are rejected, or objected to, or whether the claims are allowed. The second Office action usually will be made final. In making such final rejection, the examiner repeats or states all grounds of rejection then considered applicable to the claims in the application. The applicant's second reply is then limited to appeal in the case of a rejection of any claim. Further amendment is usually restricted. Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each claim so rejected. If any claim stands allowed, applicant must comply with any requirement or objection as to form.

G. Appeal to the Board of Patent Appeals and Interferences and to the Courts

If the examiner persists in the rejection of any of the claims in an application, or if the rejection has been made final, the applicant may appeal to the Board of Patent Appeals and Interferences (BPAI) in the United States Patent and Trademark Office.²¹ Normally, each appeal is heard by only three members. An appeal fee is required and the applicant must file a brief to support his/her position. An oral hearing will be held if requested upon payment of the specified fee.

If the decision of the Board of Patent Appeals and Interferences is still adverse to the applicant, an appeal may be taken to the Court of Appeals for the Federal Circuit (CAFC) or a civil action may be filed against the Director of the PTO in the United States District Court for the District of Columbia.²² CAFC will review the record made in the Office and may affirm or reverse the Office's action. In a civil action, the applicant may present testimony in the court, and the court will make a decision.

H. Interferences

An interference is a proceeding conducted before the Board of Patent Appeals and Interferences (Board), to determine priority of invention between a pending application and one or more pending applications and/or one or more unexpired patents.²³

An interference may exist between two applications, or an application and a patent, if at least one claim from each would have anticipated or rendered obvious the subject matter of at least one claim of the other.

An interference may be provoked in several different ways:

(A) An interference between pending applications may be requested by an applicant who becomes aware of another application which may be claiming the same invention.

Before an interference is declared between two or more applications, the examiner must be of the opinion that there is interfering subject matter claimed in the applications which is patentable to each applicant, subject to a judgment in the interference.²⁴ The interfering subject matter is defined by one or more counts. Each application must contain, or be amended to contain, at least one claim that is patentable over the prior art and corresponds to each count. All claims in the applications which define the same patentable invention as a count are designated to correspond to the count.

(B) An interference between a pending application and a patent is normally provoked by the applicant.

An interference may be declared between an application and a patent if the application and patent claim the same patentable invention, as defined in 37 CFR

1.601(n), and at least one of the applicant's claims to that invention are patentable to the applicant.

The PTO does not have jurisdiction to conduct interferences which involve only patents, i.e., which do not involve at least one pending application. Jurisdiction over those proceedings is conferred on the Federal courts.²⁵

III. POST-ISSUANCE PROCEEDINGS²⁶

A. Reissue

A reissue application may be filed to correct an error in the patent. To be correctable by reissue, the error must have been made without any deceptive intention. An error in the patent typically arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent.

(Surrender)

The error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent."²⁷

The most common bases for filing a reissue application are:

- (A) the claims are too narrow or too broad;
- (B) the disclosure contains inaccuracies;
- (C) applicant failed to or incorrectly claimed foreign priority; and
- (D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

A reissue application, including all of its claims is "examined in the same manner as a non-reissue, non-provisional application."²⁸ Accordingly, the claims in a reissue application are subject to any and all rejections which the examiner deems appropriate. It does not matter whether the claims are identical to or changed from those in the patent. The claims in the reissue application must be drawn to subject matter which the applicant had the right to claim in the original patent. Any change in the patent made via the reissue application must not introduce new matter.

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent.²⁹ This does not mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention.

Reissue applications are open to inspection by the general public. Copies may be furnished upon paying a fee.³⁰ The filing of most reissue applications is announced in the Official Gazette.³¹ This announcement gives interested members of the public an opportunity to submit to the examiner information pertinent to the patentability of the reissue application.

B. Reexamination

Anyone at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited.³²

The basics of reexamination are:

- (A) Either the inventor or a third party can request reexamination at any time during the period of enforceability of the patent;
- (B) Prior art considered during reexamination is limited to prior art patents or printed publications;
- (C) A substantial new question of patentability must exist for reexamination to be ordered;
- (D) If ordered, the actual reexamination proceeding was generally *ex parte* in nature, although the AIPA now permits participation by a third party;³³
- (E) A decision on the request is made within 3 months from its filing; the remainder of proceedings proceed with "special dispatch";
- (F) If ordered, a reexamination proceeding is normally be conducted to its conclusion and the issuance of a reexamination certificate;
- (G) The scope of a claim cannot be enlarged by amendment; and
- (H) All reexamination and patent files are open to the public.

In considering whether to permit reexamination, the PTO determines whether "a substantial new question of patentability" affecting any claim of the patent has been raised.³⁴ Therefore, a request for reexamination must include "a statement pointing out each substantial new question of patentability based on prior patents and printed publications."³⁵ If a substantial new question of patentability is found as to one claim, all claims are reexamined.

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability exists, unless the same question of patentability has already been decided by (1) a final holding of invalidity by a Federal Court, or (2) by the PTO in a previous examination of the patent. A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable.

The reexamination proceeding provides a complete reexamination of the patent claims on the basis of prior art patents and printed publications. Any new or amended claims are examined to ensure that the scope of the original patent claims is not broadened.³⁶

IV. AMERICAN INVENTORS PROTECTION ACT OF 1999 (AIPA)³⁷

The "American Inventors Protection Act of 1999" was enacted on November 29, 1999.³⁸ It introduced fundamental changes to the patent law and the PTO.³⁹

A. Key Provisions

Subtitle D of the AIPA guarantees a minimum 17-year patent term for diligent applicants, so that they are not penalized for PTO processing delays or for delays in the prosecution of applications pending more than three years. Day-for-day extensions of patent term are available for delays in issuance of a patent due to interference proceedings, secrecy orders, and appellate review.

Subtitle E requires publication of patent applications 18 months after filing, unless the applicant requests otherwise upon filing and states that the invention has not been the subject of an application filed abroad.

Subtitle F allows an inter-partes reexamination process for reviewing patent validity.

B. Patent Term Adjustment (Subtitle D)⁴⁰

Subtitle D is entitled "Patent Term Guarantee Act of 1999." It provides for adjustment of the term of patents issuing from utility patent applications filed on or after May 29, 2000, and for continued examination of such applications. The legislation provides three bases of adjustment. The first basis provides adjustment when the USPTO fails to act on an application within specified time periods. The second basis provides adjustment when the USPTO fails to issue a patent within three years of the actual filing date, subject to a number of statutory restrictions. The third basis provides adjustment for the time consumed by interferences, imposition of secrecy orders, and for successful appeals.

The rules also implement a statutory requirement to define conduct where an applicant fails to engage in reasonable efforts to conclude processing or examination of an application by setting forth that the period of adjustment is reduced by any period of time during which an applicant failed to engage in reasonable efforts to conclude prosecution. The rules also provide 17 specific circumstances that define such conduct.

Subtitle D also requires the USPTO to provide for continued examination of applications filed on or after June 8, 1995, at the request of applicants for a fee. Now, an applicant may file a request for continued examination (RCE), with a fee, and continue prosecution of an application -- regardless of the status of the prior office action, in most circumstances. A RCE withdraws the finality of the last office action. Therefore, continued examination may be requested after a final rejection, an allowance, or an appeal. If an RCE is submitted in an application under a final rejection, the RCE must be accompanied by a reply that is fully responsive to the merits of the final rejection. If the reply is not fully responsive, but is a bona fide attempt to reply to the prior office action,

the period for reply to the prior office action is tolled by the reply, and a new time period is set to provide a complete reply. If the reply is neither fully responsive nor a bona fide attempt to reply to the prior office action, then the period for reply in the prior office action is not tolled.

Filing an RCE for an application after a notice of appeal, and before a decision on that appeal, is interpreted as a request to withdraw the appeal. The result of filing such an RCE in an application with no claims indicated as allowable is effectively an abandonment of the application. If the RCE is filed after a notice of appeal, and some of the pending claims were previously indicated as allowable, the USPTO cancels the rejected claims, and passes the application to issue with only the previously allowed claims.

A continuation application may also be filed as a Continued Prosecution Application (CPA) by submitting a request and the appropriate fee, but only if the earlier application has a filing date before May 29, 2000.

C. Pre-Grant Publication (Subtitle E)⁴¹

One of the more sweeping changes effected by the AIPA is the publication of applications 18 months after the earliest effective filing date claimed by the application. The application must have been filed on or after November 29, 2000. The statute also allows for publication of applications (1) filed before November 29, 2000 at the request of an applicant; and (2) filed after that date, earlier than 18 months after filing.

A published application becomes prior art as to later applications with a date equal to the application's effective filing date. Provisional rights are available from the period of publication of the application to the issue date.

An applicant who has not and will not file in a foreign country or under an international agreement that publishes applications after an 18 month period from the effective filing or priority date of applications, may request nonpublication, but the request must be submitted with the application filing. Rescission of a nonpublication request may be made at any time, and must be done to avoid abandonment of the application should a foreign filing be made after making the request.

Following publication, third parties may attempt to defeat the patent grant by submitting a limited number of printed patents or publications within a two-month

period. Additionally, the USPTO provides access to the file history of published applications by providing photocopies of the file history on request.

D. Inter Partes Reexamination (Subtitle F)⁴²

The AIPA now provides for expanded participation by a third party during the reexamination of a patent as an alternative option to ex parte reexamination. Subtitle F also imposes significant estoppel provisions after the conclusion of proceedings should a party to the inter partes reexamination proceedings subsequently litigate any fact that was, or could have been, determined during reexamination. While the inter partes provisions of the subtitle were in effect on November 29, 1999, the provisions only apply to patents that issue from applications filed on or after November 29, 1999.

Following a request for inter partes reexamination, a patent examiner determines whether to order the reexamination. Unlike ex parte reexamination proceedings, an Office action typically accompanies an order of inter partes reexamination. The Office action addresses all proposed rejections made in the request by either adopting the rejection or expressly declining to adopt the rejection and by giving the rationale of the examiner for not adopting the proposed rejection. If the action indicates allowability of all of the claims, the action should be one closing prosecution.

Following the first action, the third party may once file comments on any response filed by the patent owner. Thereafter, the examiner reconsiders the first Office action in view of all of the comments by both parties, and prepares a second Office action addressing all of the claims and the comments. This second action closes prosecution when the issues in the reexamination proceedings are clear. After this action the third party and patent owner again submit comments on the Office action and the other party's submission. Thereafter, the examiner may issue an Examiner's Right of Appeal Notice which addresses the comments made in response to the action closing prosecution or the examiner may reopen prosecution by preparing a new office action.

After the Examiner's Right of Appeal Notice, either the patent owner or third party, or both, may appeal the decision of the examiner to the BPAI. The third party may appeal any decision to not sustain a rejection proposed by the third party. The appeal phase includes a right of either the patent owner or third party to file a reply brief in

opposition to the original brief of the opposing party. The examiner then prepares an examiner's answer responsive to the positions asserted by the patent owner and the third party. Following final decision by the BPAI, only the patent owner may file an appeal to the CAFC.

CONCLUSION

Patents play an increasingly significant role in the current business and legal climate, and will continue to do so for the foreseeable future. The first utility patent number was issued in 1836; sixty-five years later, in 1911, the one million mark was reached. Only nine years was necessary to go from five to six million patents (1991 – 2000).⁴³ It is predicted that the seven million mark will be reached by the end of 2004.

An in depth or scholarly analysis of patent law and patent application procedures cannot be articulated in a paper of this length. Rather, it is hoped that this paper (1) serves as a convenient overview of the main considerations and procedures involved in protecting an invention from its conception to a corresponding patent and (2) comments briefly on the relevant patent laws, including the salient provisions of the recently enacted AIPA.

¹ Lincoln received U.S. Patent No. 6,469 for a design that allowed a riverboat to navigate over the shoals. The quote is from a speech in Springfield, Illinois, on February 5, 1859. See Herbert F. Schwartz, Patent Law and Practice, 3 (3rd Ed. 2001), a valuable guide and much relied upon in authoring this paper.

² U.S. CONST. Art. I, §8, cl. 8.

³ See Herbert F. Schwartz, Patent Law and Practice, 1 (3rd Ed. 2001).

⁴ *Id.*

⁵ Title 35, United States Code.

⁶ See Public Law 106-113, 113 Stat. 1501 (1999).

⁷ See 35 U.S.C. §§ 1-13.

⁸ 35 U.S.C. § 271.

⁹ 35 U.S.C. § 101.

¹⁰ 35 U.S.C. § 100.

¹¹ 35 U.S.C. § 102.

¹² 35 U.S.C. § 101.

¹³ 35 U.S.C. § 103.

¹⁴ For more information, see Herbert F. Schwartz, Patent Law and Practice, 3-4 (3rd Ed. 2001).

¹⁵ 35 U.S.C. § 111(a).

¹⁶ See 35 U.S.C. § 111(b) for information on provisional applications.

¹⁷ See USPTO website. (Further cite.)

¹⁸ 35 U.S.C. § 121.

¹⁹ 35 U.S.C. § 132.

²⁰ PTO website (further cite).

²¹ 35 U.S.C. § 134.

²² 35 U.S.C. § 141.

-
- ²³ Jurisdiction to decide an interference is granted by 35 U.S.C. 135(a), which also grants the Board discretion to determine questions of patentability in the proceeding.
- ²⁴ 35 U.S.C. § 135.
- ²⁵ 35 U.S.C. § 291.
- ²⁶ The following section relies primarily upon the Manual Of Patent Examining Procedure (MPEP), Eighth edition, and its cogent exposition of reissue and reexamination proceedings.
- ²⁷ 35 U.S.C. § 251.
- ²⁸ 37 CFR 1.176.
- ²⁹ 35 U.S.C. § 251.
- ³⁰ 37 CFR 1.11(b).
- ³¹ Continued Prosecution Applications (CPA's) filed under 37 CFR 1.53(d) are not generally announced in the Official Gazette.
- ³² 35 U.S.C. § 301.
- ³³ The American Inventor Protector's Act (AIPA), enacted in 1999, allows for inter partes reexamination as discussed in Part IV(d) of this paper.
- ³⁴ 35 U.S.C. § 304.
- ³⁵ 37 CFR 1.510(b)(1).
- ³⁶ See 35 U.S.C. 305.
- ³⁷ The following section relies heavily on the excellent article by Robert Clarke, titled *Implementing The American Inventor's Protection Act of 1999*, and available on the USPTO website at <http://www.uspto.gov/web/offices/dcom/olia/aipa/implaipa.pdf>.
- ³⁸ P.L. 106-113. The AIPA was part of the conference report (H. Rept. 106-479) on H.R. 3194, Consolidated Appropriations Act, Fiscal Year 2000. The text of the American Inventors Protection Act of 1999 is contained in Title IV of S. 1948, the "Intellectual Property and Communications Omnibus Reform Act of 1999." S. 1948 was enacted by reference in Division B of the conference report on H.R. 3194.
- ³⁹ The PTO's Web site (www.uspto.gov) includes a site devoted to the AIPA. A complete copy of the legislation is available at the AIPA site.
- ⁴⁰ See 35 U.S.C. §§ 154-156.
- ⁴¹ See 35 U.S.C. § 122.
- ⁴² See Pub. L. 106-113, Nov. 29, 1999, 35 U.S.C. §§ 311-318.
- ⁴³ A complete listing of issue years and patent numbers is available on the PTO website at <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/issuyear.htm>.