



# PATENT SPEAK — WHAT INVENTORS NEED TO KNOW TO UNDERSTAND PATENT LAWYERS AND DECODE PATENT DOCUMENTS

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Patent law has a steep learning curve. For patent lawyers, this means reading a lot of federal court decisions and attending seminars. For inventors, this learning curve can impede our ability to get patent protection. By creating an inventor's glossary, we hope to make patents and interacting with patent lawyers a bit less complex to the average inventor.

Note that this is a glossary that will grow over time, so please forgive the initial shortness of the list.

101: See Section 101.

102: See Section 102.

103: See Section 103.

112: See Section 112.

AIA: See America Invents Act.

**Alice:** This term refers to Alice Corporation Pty. Ltd. v. CLS Bank International et al., a June 19, 2014 United States Supreme Court case. It is impossible to accurately summarize what Alice says, because even top patent lawyers and Federal Circuit judges are still trying to figure it out. The general understanding is that an abstract idea, without some non-incidental technological addition, is not patent-eligible under Section 101. The USPTO has issued guidelines on subject matter eligibility after Alice, as well as a list of examples drawn from post-Alice court decisions.

**America Invents Act:** This 2011 statute, sometimes called the "AIA", made significant changes to U.S. patent law. The AIA switched the United States from a "first to invent" system to a "first to file" system. The AIA established a new "Inter partes review" procedure. The AIA switched made changes to the administrative appeal process, including changing the name of the appeals board from the BPAI ("Board of Patent Appeals and Interferences") to the PTAB ("Patent Trial and Appeal Board"). The AIA created a "covered business method" review process for certain financial-related patents.



**Best Mode:** The inventor is required to disclose what the inventors believes to be the best mode of practicing the invention. The AIA eliminated the Best Mode requirement as a basis for invalidating an issued patent in later court proceedings or post-grant review proceedings. The USPTO may reject a pending patent application for failure to identify the best mode.

**Claims:** The claims are the section of the issued patent that define what the inventor's monopoly covers. If Henry Ford had filed for a patent and described the entirety of a car, but the claims only described the suspension system, none of the other parts of the car would be patented. It is common practice in complex inventions to seek protection for elements not covered by the granted claims by filing a continuation application.

**Continuation:** Prior to issuance or abandonment, the inventor or assignee of the patent may file a continuation application. The continuation application cannot introduce new matter (this may be done as a continuation in part), but may seek claims that cover parts of the invention not previously claimed.

**FITF:** See First Inventor to File.

**First Inventor to File:** This is a system whereby the patent for an invention is issued to the first inventor who gets an application on file with the relevant patent office. This is the system in place throughout all or almost all patent offices in the world. The United States changed over to this system from a first to invent system effective March 16, 2013 as part of the changes implemented in the AIA.

**First to Invent:** This is the system that the United States followed until March 16, 2013, when the AIA first to invent provisions took effect. Under this system, inventors typically kept invention notebooks or other documents to prove their invention date. Subject to a lot of other limitations (such as not publishing the invention more than a year prior to the filing date), the first person to invent got the patent even if another inventor filed with the USPTO first.

**MPEP:** This is the Manual of Patent Examining Procedure, the book of rules that patent examiners and patent lawyers use to determine, among other things, how to conduct themselves and how to go about getting a patent issued.



**Myriad:** This refers to *Assn. for Molecular Pathology v. Myriad Genetics, Inc.*, a 2012 United States Supreme Court case. The case held that a naturally occurring DNA segment is a product of nature and not patent eligible merely because it has been isolated. However, cDNA, which is not naturally occurring, is patent eligible. Of interest, cDNA is the same as the naturally occurring DNA except that it omits portions within the DNA segment that do not code for proteins. This case expanded on the “law of nature” exception to patentability. The case invalidated patents related to the BRCA1 and BRCA2 genes, which are highly predictive of breast and ovarian cancer risk.

**Non-Final Rejection:** This is a rejection of some of the patent claims in a pending application, but in such a case the applicant has a right to get a second office action (usually either an allowance or a final rejection) in response to the inventor’s reply to the non-final rejection.

**Novelty:** A patent is not available under Section 102 if “the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention”, or described in another person’s previously-filed patent application. Note that novelty does not require that the invention be used for the same thing as the current inventor’s proposed use. For example, if an inventor develops an improved needle for closing surgical incisions, but unknown to the inventor, a sewing machine company across the country is selling an identical needle but for use in clothing, novelty bars a patent for the surgical use of that needle, even if it would not be obvious to one skilled in the art to use the sewing needle improvements in a surgical setting.

**Obviousness:** Even if an invention is novel, it is not patentable under Section 103 if “the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” Under this section, it is common for patent examiners to combine numerous references to construct a case for obviousness. If the inventor is able to overcome a Section 102 novelty rejection, the patent examiner will often fall back to a rejection based on Section 103 obviousness.

**PAIR:** See Public PAIR and Private PAIR.

**Private PAIR:** Private PAIR is a portal that patent lawyers and self-represented



inventors can use to monitor the status of the U.S. patent applications associated with their account, whether or not the applications are published.

**Public PAIR:** Public PAIR is a portal that members of the public can use to monitor the status of published U.S. patent applications.

**RCE:** See Request for Continued Examination.

**Request for Continued Examination (“RCE”):** When a patent has received a final rejection, the applicant typically has at least three options: (a) appeal; (b) abandon the application, potentially in conjunction with filing a continuation; or (c) file an RCE. An RCE filing returns the application to “Ready for Examination” status. If the inventor attempted to amend the claims after the final rejection and got an “advisory action” in response, the first office action on an RCE must be a non-final rejection. Otherwise, the examiner may choose to make the initial office action in an RCE a final rejection.

**Section 101:** This refers to section 101 of title 35 of the United States Code (35 U.S. Code § 101 – Inventions patentable). Section 101 can be thought of as a gateway every invention must pass in order to be patentable. While the text of the section is short and simple (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”), numerous judicial decisions have created additional exceptions to patentability. For example, after *Alice*, an invention that implements an abstract idea without substantially more is not patent eligible under Section 101.

**Section 102:** This refers to section 102 of title 35 of the United States Code (35 U.S. Code § 102 – Conditions for patentability; novelty). This section requires that an invention be novel in order to be patent-eligible. See *Novelty*.

**Section 103:** This refers to section 103 of title 35 of the United States Code (35 U.S. Code § 103 – Conditions for patentability; non-obvious subject matter). This section requires that an invention not be obvious in order to be patent-eligible. See *Obviousness*.

**Section 112:** This refers to section 112 of title 35 of the United States Code (35 U.S. Code § 112 – Specification). This section describes what must be present in a patent application. The inventor must provide a written description enabling a person skilled in the art to make the invention (see Written Description) and must disclose the best mode for carrying out the invention (see Best Mode).

**USPTO:** United States Patent and Trademark Office.

**Written Description:** This is a requirement created by Section 112(a). Under this requirement, the written description in the patent application (excluding the patent claims themselves) must describe the invention that the inventor seeks to protect in the patent claims. Each element of the claims must find support in the written description.

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