

ENGLISH FOR WORK / ENGLISH FOR PATENT PRACTICE

Patent Law English

Describe the invention. Define the legal question.



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Eight practical lessons. Eleven extended conversations.
Vocabulary, phrase banks, guided speaking, and explained answers.

Revised 2026 edition / Upper-intermediate to advanced

Your route through the book

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Suggested study range: B2-C1. This is an editorial study range, not a certified proficiency assessment.

Small wording changes can change the question.

Patent teams move between engineering detail, legal analysis, and commercial priorities. Effective English makes a component relationship, an unresolved claim issue, or a territorial limitation clear without overstating protection.

Ask how it works

A benefit such as faster cooling does not identify the structure or steps that produce it. Ask about the mechanism and alternatives.

"Which feature produces that result, and what changes if we remove it?"

Identify the document

An invention disclosure, application, publication, and granted patent have different functions. Identify the actual document and status.

"This is the published application, not a granted claim set."

Separate the analyses

Patentability, ownership, infringement, and freedom to operate are different questions. An encouraging result in one does not settle the others.

"That search addressed patentability, not clearance for commercial launch."

Keep scope visible

Territory, claim wording, product configuration, dates, and legal status can determine the relevance of an assessment.

"The review concerns this configuration in the named market."

Professional boundaries

All people, organizations, cases, figures, and documents in the exercises are fictional. Language practice, not patent or legal advice. Examples simplify documents and do not establish inventorship, patentability, validity, infringement, priority, filing deadlines, licensing rights, or freedom to operate. Real matters require qualified patent professionals, current law and office practice, and the actual documents. Protect confidential inventions and observe applicable filing, disclosure, security, and export requirements.

A Read the situation

LESSON 01 / INTERVIEWING INVENTORS WITHOUT LEADING THEIR ANSWERS

Elicit the mechanism, alternatives, and individual contributions behind an invention disclosure.

The improvement is a channel, not simply faster cooling

Engineer Amira describes a prototype battery enclosure with a curved coolant channel. Technician Leo built it from drawings and suggested a detachable connector. One internal test reports a shorter cooling time, but the test conditions have not been compared. Patent professional Daniel is gathering facts, not deciding inventorship or patentability.

People: Amira, Engineer; Daniel, Patent professional.

Read the record

Choose one answer per question using the facts above.

1. What change is described in the enclosure?

- A.** A curved coolant channel
- B.** A different battery chemistry
- C.** A larger enclosure with no channel change
- D.** A connector that replaces the channel

2. What is known about Leo?

- A.** His contribution has already been legally classified
- B.** He built the prototype and suggested a connector
- C.** He only supplied funding
- D.** He conceived every proposed claim

3. What limits the cooling-time comparison?

- A.** No prototype exists
- B.** The result is a commercial guarantee
- C.** The connector has been patented
- D.** The test conditions have not been compared

[Answers and explanations, page 107](#)

B Vocabulary in use

CORE TERMS

invention disclosure

Internal account of a proposed invention and its development.

submit an invention disclosure

technical effect

Technical result attributed to a feature or process.

substantiate a technical effect

reduction to practice

Implementation or legally relevant realization of an invention.

document reduction to practice

contribution record

Account of who contributed what and when.

preserve the contribution record

embodiment

Particular implementation described for an invention.

describe an embodiment

coolant channel

Passage through which cooling fluid moves.

trace the coolant channel

technical problem

Practical technical difficulty the proposed invention addresses.

define the technical problem

conception

Formation of the inventive idea under the applicable legal test.

investigate contribution to conception

inventorship

Legal identification of the inventor or inventors.

assess inventorship

prototype

Preliminary implementation used to explore or test a design.

evaluate the prototype

alternative configuration

Different arrangement of components or steps.

disclose an alternative configuration

detachable connector

Connection component designed to be separated.

specify a detachable connector

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

invention disclosure INVENTION DISCLOSURE

submit an invention disclosure

Keep the meaning precise: Internal account of a proposed invention and its development.

inventorship INVENTORSHIP

assess inventorship

Keep the meaning precise: Legal identification of the inventor or inventors.

B Precision and professional shorthand

EXTEND YOUR RANGE

causal mechanism

Process explaining how a feature produces a result.

explain the causal mechanism

baseline configuration

Reference arrangement used for comparison.

identify the baseline configuration

confidential disclosure

Communication within the relevant confidentiality arrangements.

control confidential disclosure

clarification request

Question that resolves an unclear meaning or instruction.

make a targeted clarification request

working assumption

Provisional premise used while information is incomplete.

challenge a working assumption

action owner

Named person responsible for a specified next step.

confirm the action owner

comparative test

Test comparing implementations under stated conditions.

conduct a comparative test

laboratory notebook

Contemporaneous record of experimental work.

preserve the laboratory notebook

public disclosure

Making information available outside the relevant confidential setting.

review public disclosure

source attribution

Identification of where information came from.

preserve source attribution

scope boundary

Limit of the work or authority being discussed.

state the scope boundary

check-back

Restatement used to verify that a message was understood.

complete a check-back

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

detachable connector DETACHABLE CONNECTOR

specify a detachable connector

Keep the meaning precise: Connection component designed to be separated.

confidential disclosure CONFIDENTIAL DISCLOSURE

control confidential disclosure

Keep the meaning precise: Communication within the relevant confidentiality arrangements.

Phrases that move the work forward

Elicit the mechanism

What does the curved channel change in the flow path?

Trace a contribution

Who first proposed that feature, and what records support the account?

Clarify implementation

Did Leo follow the drawings or propose a different arrangement?

Protect disclosure

Please use the approved confidential channel for the drawings.

Clarify the question

Are you asking about the finding or the next step?

Attribute information

That is what the current record says; it has not been independently confirmed.

Check scope

That decision sits outside my authority.

Repair misunderstanding

Let me restate the distinction more clearly.

Probe an alternative

Would the same effect occur with a straight channel?

Separate result from explanation

The test reports a shorter time; it does not yet establish why.

Preserve uncertainty

We have not compared the test conditions yet.

Summarize evidence

We have a prototype, a reported result, and contribution details to verify.

Invite correction

Please correct me if I have misunderstood that detail.

Separate possibility

That is a possibility, not an agreed outcome.

Pin down responsibility

Who is responsible for that specific next step?

Close an exchange

We agree on the action, the owner, and the point for review.

Precision in real exchanges

Purpose: Separate result from explanation

Useful wording: The test reports a shorter time; it does not yet establish why.

Purpose: Clarify implementation

Useful wording: Did Leo follow the drawings or propose a different arrangement?

D Choose the response that fits

Choose one response for each situation. Preserve the facts, the decision boundary, and the purpose of the exchange.

1. Which question is least leading?

- A.** The manager owns the idea, so is he the inventor?
- B.** Who proposed the connector, and when?
- C.** Leo merely followed instructions, correct?
- D.** Amira must be the only inventor, correct?

2. Which test summary is supported?

- A.** Comparable conditions have been confirmed
- B.** A shorter cooling time was reported in one test
- C.** Faster cooling is guaranteed in all conditions
- D.** The connector caused the improvement

3. A colleague needs the term for this meaning: Formation of the inventive idea under the applicable legal test. Which term fits?

- A.** baseline configuration
- B.** conception
- C.** embodiment
- D.** working assumption

D Choose the response that fits / continued

4. Rebuild the exchange from "The improvement is a channel, not simply faster cooling". Amira: "One internal test showed a shorter cooling time. I have not checked whether both tests used the same starting temperature." Daniel: [missing response] Amira: "Leo built the enclosure from my drawings, but he suggested making the connector detachable for easier assembly." Which response belongs in the gap?

- A.** Job title does not settle inventorship. We need the relevant facts and proposed claims before reaching that conclusion.
- B.** Then we need the baseline configuration and test conditions before describing the result as a controlled improvement.
- C.** Flag the proposed public disclosure for prompt legal review before anyone assumes the timing is harmless.
- D.** Describe the alternative configuration and explain whether you expect it to address the same flow problem.

[Answers and explanations, page 107](#)

One useful distinction

Describe each contribution before assessing its legal significance. Building a prototype and conceiving a claimed feature are not interchangeable descriptions.

Conversation

The improvement is a channel, not simply faster cooling

The improvement is a channel, not simply faster cooling

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

technical problem / inventorship / invention disclosure / alternative configuration /
public disclosure / causal mechanism / embodiment / contribution record /
baseline configuration / laboratory notebook

- 01 **Amira:** Our enclosure cools faster. I would like the application to focus on that benefit rather than the shape of the tubing.
- 02 **Daniel:** Let us identify the ¹ _____ first. What limits cooling in the reference design, and which feature changes that behavior?
- 03 **Amira:** Fluid bypasses part of the enclosure. The curved channel takes it around that area instead of directly to the outlet.
- 04 **Daniel:** That describes a ² _____. We should distinguish that explanation from the measurements supporting it.
- 05 **Amira:** One internal test showed a shorter cooling time. I have not checked whether both tests used the same starting temperature.
- 06 **Daniel:** Then we need the ³ _____ and test conditions before describing the result as a controlled improvement.
- 07 **Amira:** Leo built the enclosure from my drawings, but he suggested making the connector detachable for easier assembly.
- 08 **Daniel:** Record that in the ⁴ _____. Construction work and a new design suggestion should not be collapsed into one description.
- 09 **Amira:** Should I list only senior engineers as inventors? Leo is a technician and did not present the project to management.
- 10 **Daniel:** Job title does not settle ⁵ _____. We need the relevant facts and proposed claims before reaching that conclusion.

Conversation continues on the next page.

The improvement is a channel, not simply faster cooling

CONVERSATION / CONTINUED

- 11 **Amira:** I also sketched a straight channel with a baffle, although we have not built that version yet.
- 12 **Daniel:** Describe the ⁶ _____ and explain whether you expect it to address the same flow problem.
- 13 **Amira:** The curved version is the one we built. The straight version remains a drawing, with no performance measurements.
- 14 **Daniel:** Identify each ⁷ _____ separately and avoid implying that the untested version produced the reported data.
- 15 **Amira:** The notebook contains dated sketches and build notes. I can collect those without rewriting the original entries.
- 16 **Daniel:** Preserve the ⁸ _____ and provide copies through the approved confidential process.
- 17 **Amira:** Marketing wants to show the prototype at a public event next month. I have not approved that request.
- 18 **Daniel:** Flag the proposed ⁹ _____ for prompt legal review before anyone assumes the timing is harmless.
- 19 **Amira:** I will supply the drawings, contribution details, test conditions, and event request as separate items for your review.
- 20 **Daniel:** That gives the ¹⁰ _____ a factual foundation without promising protection or treating an initial result as a verified product claim.

CHECK THE GAPS

1. technical problem / 2. causal mechanism / 3. baseline configuration / 4. contribution record / 5. inventorship / 6. alternative configuration / 7. embodiment / 8. laboratory notebook / 9. public disclosure / 10. invention disclosure

[Why these answers fit, page 108](#)

F Check accuracy and scope

The improvement is a channel, not simply faster cooling

Return to the case

Engineer Amira describes a prototype battery enclosure with a curved coolant channel. Technician Leo built it from drawings and suggested a detachable connector. One internal test reports a shorter cooling time, but the test conditions have not been compared. Patent professional Daniel is gathering facts, not deciding inventorship or patentability.

Choose one answer per question. Use the case facts and keep any uncertainty or limits intact.

1. What should the interview capture about alternatives?

- A. How a straight channel would change the mechanism
- B. Only the preferred marketing benefit
- C. A guarantee that all alternatives are patentable
- D. An assumption that undisclosed alternatives are already supported

2. Which status is accurate?

- A. The presenter is necessarily the sole inventor
- B. Prototype construction alone settles the issue
- C. Inventorship remains for qualified assessment
- D. All contributors are automatically inventors

[Answers and explanations, page 110](#)

Listen for the distinction

Switch roles and deliver the final document list using only the supplied development facts.

Curiosity before characterization

Ask about contributions and evidence without assigning legal labels based on seniority, job title, or who presents the invention.

F Say it / transfer to a new case

A drawing was mistaken for a test result

A second enclosure appears only in a dated sketch. It has not been built or tested. The team wants to include it in the confidential disclosure.

Complete the four gaps. With a partner, read alternate roles, then switch. Studying alone, read both roles and pause before each response.

WORD AND PHRASE BANK

sketch / configuration / untested / hypothesis

- 01 **Engineer:** This is an alternative ¹ _____.
- 02 **Reviewer:** Its performance remains ² _____.
- 03 **Engineer:** I will preserve the dated ³ _____.
- 04 **Reviewer:** Describe the expected effect as a ⁴ _____.

CHECK THE GAPS

1. configuration / 2. untested / 3. sketch / 4. hypothesis

[Why these answers fit, page 110](#)

Rebuild the exchange

Choose the missing response. Read the completed three-turn exchange aloud, changing roles on the second reading.

1. Rebuild the exchange from "The improvement is a channel, not simply faster cooling".

Amira: "The curved version is the one we built. The straight version remains a drawing, with no performance measurements." **Daniel:** [missing response] **Amira:** "The notebook contains dated sketches and build notes. I can collect those without rewriting the original entries." **Which response belongs in the gap?**

- A.** Describe the alternative configuration and explain whether you expect it to address the same flow problem.
- B.** That describes a causal mechanism. We should distinguish that explanation from the measurements supporting it.
- C.** Identify each embodiment separately and avoid implying that the untested version produced the reported data.
- D.** Flag the proposed public disclosure for prompt legal review before anyone assumes the timing is harmless.

[Answers and explanations, page 111](#)

A Read the situation

LESSON 02 / DISCUSSING PRIOR ART WITHOUT OVERSTATING THE SEARCH

Explain a search result using feature mapping, dates, and the limits of the search scope.

One reference matches two features, not the entire claim

Analyst Noor finds Reference R describing a housing and curved channel. The draft claim also requires a detachable connector, which Noor has not located in R. Reference S mentions a detachable connector in a different device. Dates and legal relevance need review. Counsel Ethan must distinguish the references and search limitations.

People: Noor, Search analyst; Ethan, Patent counsel.

Read the record

Choose one answer per question using the facts above.

1. Which feature has not been located in R?

- A.** The housing
- B.** The curved channel
- C.** Every feature in the draft
- D.** The detachable connector

2. Where is a connector mentioned?

- A.** S, in a different device
- B.** Only in the client grant
- C.** In an identified passage of R
- D.** In no document at all

3. What remains to be reviewed?

- A.** Whether the draft requires a connector
- B.** Whether Noor performed a search
- C.** Dates and legal relevance
- D.** Whether R has been found

[Answers and explanations, page 112](#)

B Vocabulary in use

CORE TERMS

prior art

Earlier material relevant under the applicable patent law.

assess prior art

inventive step

Requirement addressing whether an invention exceeds the applicable obviousness threshold.

assess inventive step

reference document

Identified source considered in a patent analysis.

retrieve the reference document

disclosure passage

Specific text or figure describing relevant subject matter.

cite the disclosure passage

priority date

Claimed earlier date whose legal effect requires assessment.

check the priority date

classification code

Patent-search category identifying technical subject matter.

search by classification code

novelty

Requirement that claimed subject matter be new under the applicable test.

analyze novelty

nonobviousness

US patentability requirement concerning obviousness under applicable law.

evaluate nonobviousness

feature mapping

Comparison linking claimed features to disclosed material.

prepare feature mapping

publication date

Date a document was published.

verify the publication date

search scope

Boundaries of databases, terms, subject matter, and dates searched.

define the search scope

keyword variant

Alternative term used to locate related material.

include keyword variants

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

prior art **PRIOR ART**

assess prior art

Keep the meaning precise: Earlier material relevant under the applicable patent law.

feature mapping **FEATURE MAPPING**

prepare feature mapping

Keep the meaning precise: Comparison linking claimed features to disclosed material.

B Precision and professional shorthand

EXTEND YOUR RANGE

citation trail

Chain of references connected through citations.
follow the citation trail

non-patent literature

Relevant material outside patent documents.
search non-patent literature

combination rationale

Reasoning for combining teachings under the applicable legal test.
assess the combination rationale

clarification request

Question that resolves an unclear meaning or instruction.
make a targeted clarification request

working assumption

Provisional premise used while information is incomplete.
challenge a working assumption

action owner

Named person responsible for a specified next step.
confirm the action owner

patent family

Related filings linked through specified priority relationships.
review the patent family

single-reference analysis

Examination of what one identified reference discloses.
distinguish single-reference analysis

search limitation

Constraint affecting search completeness or interpretation.
disclose the search limitation

source attribution

Identification of where information came from.
preserve source attribution

scope boundary

Limit of the work or authority being discussed.
state the scope boundary

check-back

Restatement used to verify that a message was understood.
complete a check-back

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

keyword variant KEYWORD VARIANT

include keyword variants

Keep the meaning precise: Alternative term used to locate related material.

combination rationale COMBINATION RATIONALE

assess the combination rationale

Keep the meaning precise: Reasoning for combining teachings under the applicable legal test.

Phrases that move the work forward

Locate support

Which passage discloses the connector?

Separate references

R describes the channel; S discusses a connector in another device.

Define search limits

The search covered these databases and keyword variants.

Frame the legal issue

Any proposed combination needs the applicable legal analysis.

Noor / in the conversation

It shows a housing and curved channel, which are both in our current draft claim.

Noor / in the conversation

The housing is in paragraph twelve and the channel in figure three, but I have not located the detachable connector.

Noor / in the conversation

Reference S mentions a detachable connector, although its device is different and the function is not described in the same way.

Noor / in the conversation

Could the two documents still raise a problem if neither appears to describe the entire draft combination alone?

Qualify the finding

I have not located that feature in this reference.

Check dates

Publication and priority information still need verification.

Avoid a guarantee

No close result in this search is not a guarantee of patentability.

Report next steps

I will add pinpoint citations and document the remaining search gaps.

Ethan / in the conversation

Start with feature mapping so we can see exactly which passages support each comparison.

Ethan / in the conversation

Not located in your review is more precise than declaring that the reference cannot disclose it.

Ethan / in the conversation

We should not move a feature from S into the column describing R.

Ethan / in the conversation

That calls for the applicable nonobviousness or inventive-step analysis, including the facts and reasoning supporting any proposed combination.

Precision in real exchanges

Purpose: Check dates

Useful wording: Publication and priority information still need verification.

Purpose: Define search limits

Useful wording: The search covered these databases and keyword variants.

D Choose the response that fits

Choose one response for each situation. Preserve the facts, the decision boundary, and the purpose of the exchange.

1. Which report sentence is supported?

- A.** S proves the connector appears in R
- B.** No connector exists anywhere in prior art
- C.** R describes two features; its connector remains unlocated
- D.** R conclusively discloses the entire draft

2. What makes feature mapping traceable?

- A.** Removing uncertainty from the table
- B.** Pinpoint passages or figures for each feature
- C.** Titles without passages
- D.** One group label replacing both references

3. A colleague needs the term for this meaning: US patentability requirement concerning obviousness under applicable law. Which term fits?

- A.** non-patent literature
- B.** nonobviousness
- C.** working assumption
- D.** priority date

D Choose the response that fits / continued

4. Rebuild the exchange from "One reference matches two features, not the entire claim". Noor: "Reference S mentions a detachable connector, although its device is different and the function is not described in the same way." Ethan: [missing response] Noor: "Could the two documents still raise a problem if neither appears to describe the entire draft combination alone?" Which response belongs in the gap?

- A.** Preserve that search limitation. Not located in your review is more precise than declaring that the reference cannot disclose it.
- B.** Keep the reference document identities separate. We should not move a feature from S into the column describing R.
- C.** That calls for the applicable nonobviousness or inventive-step analysis, including the facts and reasoning supporting any proposed combination.
- D.** Identify a possible combination rationale for counsel to assess rather than treating shared subject matter as sufficient by itself.

[Answers and explanations, page 112](#)

One useful distinction

Not located is a search finding, not proof of absence. A reference describing some features does not automatically disclose the whole combination.

Conversation

One reference matches two features, not the entire claim

One reference matches two features, not the entire claim

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

patent family / feature mapping / reference document / publication date /
combination rationale / nonobviousness / search scope / novelty / search limitation /
disclosure passage

- 01 **Noor:** Reference R looks close. It shows a housing and curved channel, which are both in our current draft claim.
- 02 **Ethan:** Start with ¹ _____ so we can see exactly which passages support each comparison.
- 03 **Noor:** The housing is in paragraph twelve and the channel in figure three, but I have not located the detachable connector.
- 04 **Ethan:** Preserve that ² _____. Not located in your review is more precise than declaring that the reference cannot disclose it.
- 05 **Noor:** Reference S mentions a detachable connector, although its device is different and the function is not described in the same way.
- 06 **Ethan:** Keep the ³ _____ identities separate. We should not move a feature from S into the column describing R.
- 07 **Noor:** Could the two documents still raise a problem if neither appears to describe the entire draft combination alone?
- 08 **Ethan:** That calls for the applicable ⁴ _____ or inventive-step analysis, including the facts and reasoning supporting any proposed combination.
- 09 **Noor:** I will describe the potential combination without saying that it automatically defeats the claim under every legal system.
- 10 **Ethan:** Identify a possible ⁵ _____ for counsel to assess rather than treating shared subject matter as sufficient by itself.

Conversation continues on the next page.

One reference matches two features, not the entire claim

CONVERSATION / CONTINUED

- 11 **Noor:** The database gives several dates. I copied the earliest number without identifying what that date represents.
- 12 **Ethan:** Distinguish the ⁶ _____ from claimed priority information, and verify the relevant legal timing separately.
- 13 **Noor:** Some results are related filings with different claims. I grouped them together to keep the report shorter.
- 14 **Ethan:** A ⁷ _____ can organize results, but the actual document and claim version must remain identifiable.
- 15 **Noor:** We covered two databases, three classification groups, and synonyms for coolant routing, but not every technical publication.
- 16 **Ethan:** State that ⁸ _____, including limits on non-patent literature and any language coverage.
- 17 **Noor:** The team wants the conclusion changed to no blocking prior art found, which sounds broader than the report supports.
- 18 **Ethan:** Keep the ⁹ _____ discussion tied to the examined features; do not imply freedom to operate or a guarantee of grant.
- 19 **Noor:** I will revise the table, separate documents and dates, and flag the connector question for further review.
- 20 **Ethan:** Add the exact ¹⁰ _____ for every positive mapping. That gives us a report we can analyze, challenge, and update.

CHECK THE GAPS

1. feature mapping / 2. search limitation / 3. reference document / 4. nonobviousness / 5. combination rationale / 6. publication date / 7. patent family / 8. search scope / 9. novelty / 10. disclosure passage

[Why these answers fit, page 113](#)

F Check accuracy and scope

One reference matches two features, not the entire claim

Return to the case

Analyst Noor finds Reference R describing a housing and curved channel. The draft claim also requires a detachable connector, which Noor has not located in R. Reference S mentions a detachable connector in a different device. Dates and legal relevance need review. Counsel Ethan must distinguish the references and search limitations.

Choose one answer per question. Use the case facts and keep any uncertainty or limits intact.

1. What must an R-plus-S argument address?

- A. Only whether both documents are downloadable
- B. Whether the client prefers the title
- C. Automatic combination of all similar documents
- D. Applicable combination analysis and its factual basis

2. Which statement fairly describes an unsuccessful search?

- A. Commercial launch has been cleared
- B. No close result was located within the stated scope
- C. No relevant prior art exists
- D. Every claim is patentable worldwide

[Answers and explanations, page 115](#)

Listen for the distinction

Switch roles and distinguish R alone from a proposed R-plus-S argument using the printed facts.

A useful finding can still be incomplete

Describe what a reference discloses before calling it decisive. Make uncertainty usable instead of hiding it behind a yes-or-no label.

F Say it / transfer to a new case

The abstract hides a useful figure

A reviewer finds a potentially relevant figure after the abstract search. The feature and legal date still need verification against the full document.

Complete the four gaps. With a partner, read alternate roles, then switch. Studying alone, read both roles and pause before each response.

WORD AND PHRASE BANK

figure / verified / scope / disclosure

- 01 **Reviewer:** The abstract search did not identify this ¹ _____.
- 02 **Counsel:** Check the complete ² _____ before mapping the feature.
- 03 **Reviewer:** The relevant date remains to be ³ _____.
- 04 **Counsel:** Update the report and preserve its stated ⁴ _____.

CHECK THE GAPS

1. figure / 2. disclosure / 3. verified / 4. scope

[Why these answers fit, page 115](#)

Rebuild the exchange

Choose the missing response. Read the completed three-turn exchange aloud, changing roles on the second reading.

1. Rebuild the exchange from "One reference matches two features, not the entire claim". Noor: "Some results are related filings with different claims. I grouped them together to keep the report shorter." Ethan: [missing response] Noor: "We covered two databases, three classification groups, and synonyms for coolant routing, but not every technical publication." Which response belongs in the gap?

- A. Distinguish the publication date from claimed priority information, and verify the relevant legal timing separately.
- B. A patent family can organize results, but the actual document and claim version must remain identifiable.
- C. That calls for the applicable nonobviousness or inventive-step analysis, including the facts and reasoning supporting any proposed combination.
- D. Start with feature mapping so we can see exactly which passages support each comparison.

[Answers and explanations, page 116](#)

Review 1 / Meaning and context

Use language from the lessons you have completed. Choose one answer per question.

Case file

Revisit "Interviewing inventors without leading their answers" and "Discussing prior art without overstating the search". Choose precise terminology, then reconstruct the missing responses using both neighboring turns. The final two questions also revisit earlier conversations.

1. A colleague needs the term for this meaning: Technical result attributed to a feature or process. Which term fits?

- A. prototype
- B. source attribution
- C. technical effect
- D. comparative test

2. A colleague needs the term for this meaning: Date a document was published. Which term fits?

- A. prior art
- B. clarification request
- C. publication date
- D. citation trail

3. Rebuild the exchange from "The improvement is a channel, not simply faster cooling". Amira: "Should I list only senior engineers as inventors? Leo is a technician and did not present the project to management." Daniel: [missing response] Amira: "I also sketched a straight channel with a baffle, although we have not built that version yet." Which response belongs in the gap?

- A. Then we need the baseline configuration and test conditions before describing the result as a controlled improvement.
- B. Record that in the contribution record. Construction work and a new design suggestion should not be collapsed into one description.
- C. Job title does not settle inventorship. We need the relevant facts and proposed claims before reaching that conclusion.
- D. Let us identify the technical problem first. What limits cooling in the reference design, and which feature changes that behavior?

Review 1 / Meaning and context / continued

4. Rebuild the exchange from "One reference matches two features, not the entire claim". Noor: "The team wants the conclusion changed to no blocking prior art found, which sounds broader than the report supports." Ethan: [missing response] Noor: "I will revise the table, separate documents and dates, and flag the connector question for further review." Which response belongs in the gap?

- A.** Keep the reference document identities separate. We should not move a feature from S into the column describing R.
- B.** Keep the novelty discussion tied to the examined features; do not imply freedom to operate or a guarantee of grant.
- C.** Add the exact disclosure passage for every positive mapping. That gives us a report we can analyze, challenge, and update.
- D.** Preserve that search limitation. Not located in your review is more precise than declaring that the reference cannot disclose it.

[Answers and explanations, page 147](#)

A Read the situation

LESSON 03 / EXPLAINING CLAIM STRUCTURE TO A TECHNICAL COLLEAGUE

Translate claim relationships into plain English without changing their scope.

The dependent claim adds a feature

For this simplified drafting discussion, claim 1 requires a housing and channel. Claim 2 depends on claim 1 and adds a detachable connector. Engineer Priya thinks claim 2 covers a connector by itself. Patent professional Marcus explains the dependency and checks the draft term the valve, which has no clear earlier introduction. These are unfiled examples, not legal claim-construction conclusions.

People: Priya, Engineer; Marcus, Patent professional.

Read the record

Choose one answer per question using the facts above.

1. What does claim 2 add in this example?

- A. A valve replacing every earlier feature
- B. A detachable connector to the inherited requirements
- C. A connector instead of the housing and channel
- D. A new cooling-time guarantee

2. What is unclear about the valve wording?

- A. Whether claim 2 has a connector
- B. Whether claim 1 mentions a housing
- C. Whether the draft has been published
- D. Which earlier element the term identifies

3. What is the document status?

- A. An issued infringement judgment
- B. A signed license
- C. An unfiled drafting example
- D. A granted patent with settled scope

[Answers and explanations, page 117](#)

B Vocabulary in use

CORE TERMS

claim

Statement defining the subject matter for which protection is sought or granted.

review the claim

dependent claim

Claim incorporating a referenced claim and adding a further limitation.

review a dependent claim

claim limitation

Requirement expressed in a claim.

identify each claim limitation

antecedent basis

Earlier identification supporting a later reference to an element.

check antecedent basis

transitional phrase

Wording connecting claim introduction and body with legal significance.

select the transitional phrase

apparatus claim

Claim directed to a device or system.

distinguish an apparatus claim

independent claim

Claim that does not depend on another claim.

draft an independent claim

claim dependency

Relationship linking a dependent claim to another claim.

check claim dependency

claim scope

Extent of subject matter covered under the applicable interpretation.

assess claim scope

preamble

Introductory portion of a claim.

review the preamble

claim body

Portion stating substantive elements or steps.

analyze the claim body

method claim

Claim directed to steps of a process.

draft a method claim

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

claim CLAIM

review the claim

Keep the meaning precise: Statement defining the subject matter for which protection is sought or granted.

claim scope CLAIM SCOPE

assess claim scope

Keep the meaning precise: Extent of subject matter covered under the applicable interpretation.

B Precision and professional shorthand

EXTEND YOUR RANGE

functional language

Wording describing what an element does.

evaluate functional language

further limitation

Additional restriction in a dependent claim.

introduce a further limitation

claim tree

Diagram or list showing claim dependencies.

check the claim tree

clarification request

Question that resolves an unclear meaning or instruction.

make a targeted clarification request

working assumption

Provisional premise used while information is incomplete.

challenge a working assumption

action owner

Named person responsible for a specified next step.

confirm the action owner

structural limitation

Requirement describing physical structure or arrangement.

identify a structural limitation

claim construction

Legal interpretation of claim terms and scope.

address claim construction

fallback position

Narrower supported position available for appropriate consideration.

preserve a fallback position

source attribution

Identification of where information came from.

preserve source attribution

scope boundary

Limit of the work or authority being discussed.

state the scope boundary

check-back

Restatement used to verify that a message was understood.

complete a check-back

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

method claim **METHOD CLAIM**

draft a method claim

Keep the meaning precise: Claim directed to steps of a process.

claim tree **CLAIM TREE**

check the claim tree

Keep the meaning precise: Diagram or list showing claim dependencies.

Phrases that move the work forward

Explain inheritance

Claim 2 carries forward the requirements of claim 1.

Check the referent

Which valve does the later phrase refer to?

Separate claim types

This version describes an apparatus rather than a sequence of steps.

Discuss narrowing

Adding a requirement narrows this simplified combination.

Priya / in the conversation

Claim 2 says the enclosure of claim 1 has a detachable connector.

Marcus / in the conversation

In this draft, the dependent claim includes the requirements it inherits from claim 1.

Marcus / in the conversation

The claim dependency carries them forward, and the connector adds another requirement to that combination.

Marcus / in the conversation

Think in terms of each claim limitation.

Identify the addition

The connector is an added limitation, not a replacement.

Locate the first mention

We need to check where that element is introduced.

Limit the paraphrase

That is a working explanation, not a legal construction.

Keep alternatives distinct

A connector-only concept would need separate drafting and support review.

Priya / in the conversation

Does that mean we now have protection for any connector?

Priya / in the conversation

So the housing and channel remain part of the combination, even though their wording is not repeated on that line?

Priya / in the conversation

I had treated the numbered claims like a menu where the reader chooses one component and ignores the others.

Marcus / in the conversation

We must identify all the requirements in the particular claim under discussion.

Precision in real exchanges

Purpose: Locate the first mention

Useful wording: We need to check where that element is introduced.

Purpose: Separate claim types

Useful wording: This version describes an apparatus rather than a sequence of steps.

D Choose the response that fits

Choose one response for each situation. Preserve the facts, the decision boundary, and the purpose of the exchange.

1. Which paraphrase matches the supplied claim 2?

- A.** A housing and channel with the added connector
- B.** A connector with no housing requirement
- C.** Either a housing or a connector
- D.** A channel only if no connector is present

2. Which question addresses antecedent basis?

- A.** Where is the valve first identified?
- B.** Is the cover illustration attractive?
- C.** Which client prefers the title?
- D.** Has the product achieved commercial sales?

3. A colleague needs the term for this meaning: Relationship linking a dependent claim to another claim. Which term fits?

- A.** working assumption
- B.** transitional phrase
- C.** further limitation
- D.** claim dependency

D Choose the response that fits / continued

4. Rebuild the exchange from "The dependent claim adds a feature". Priya: "I had treated the numbered claims like a menu where the reader chooses one component and ignores the others." Marcus: [missing response] Priya: "Would a claim covering only the connector need to be drafted differently and checked against the original disclosure?" Which response belongs in the gap?

- A.** Yes. A separate independent claim would raise its own drafting and support questions; the current dependency does not accomplish that.
- B.** That is an antecedent basis issue to review. We need to establish which element the phrase is intended to identify.
- C.** Do not change that transitional phrase for style alone. The legal effect needs deliberate review under the applicable law.
- D.** Think in terms of each claim limitation. We must identify all the requirements in the particular claim under discussion.

[Answers and explanations, page 117](#)

One useful distinction

In the supplied example, claim 2 contains the housing, channel, and connector requirements. It is not a claim to the connector alone.

E Conversation

The dependent claim adds a feature

The dependent claim adds a feature

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

dependent claim / structural limitation / fallback position / independent claim /
claim dependency / claim tree / claim construction / antecedent basis / transitional phrase
/ claim limitation

- 01 **Priya:** Claim 2 says the enclosure of claim 1 has a detachable connector. Does that mean we now have protection for any connector?
- 02 **Marcus:** No. In this draft, the ¹ _____ includes the requirements it inherits from claim 1.
- 03 **Priya:** So the housing and channel remain part of the combination, even though their wording is not repeated on that line?
- 04 **Marcus:** Exactly. The ² _____ carries them forward, and the connector adds another requirement to that combination.
- 05 **Priya:** I had treated the numbered claims like a menu where the reader chooses one component and ignores the others.
- 06 **Marcus:** Think in terms of each ³ _____. We must identify all the requirements in the particular claim under discussion.
- 07 **Priya:** Would a claim covering only the connector need to be drafted differently and checked against the original disclosure?
- 08 **Marcus:** Yes. A separate ⁴ _____ would raise its own drafting and support questions; the current dependency does not accomplish that.
- 09 **Priya:** I also noticed the phrase the valve near the end, but I could not find a valve introduced earlier.
- 10 **Marcus:** That is an ⁵ _____ issue to review. We need to establish which element the phrase is intended to identify.

Conversation continues on the next page.

The dependent claim adds a feature

CONVERSATION / CONTINUED

- 11 **Priya:** The engineer meant a flow-control valve, not the detachable connector. I can point to the relevant drawing.
- 12 **Marcus:** Good. We should check the ⁶ _____ and its support rather than guessing that two different component names mean the same thing.
- 13 **Priya:** Could I simplify comprising to consisting of? The second phrase sounds more natural to me in ordinary English.
- 14 **Marcus:** Do not change that ⁷ _____ for style alone. The legal effect needs deliberate review under the applicable law.
- 15 **Priya:** I will leave the operative wording intact and add a separate plain-English explanation for the engineering meeting.
- 16 **Marcus:** That helps, provided you label it as a paraphrase rather than a definitive ⁸ _____ that settles every possible interpretation.
- 17 **Priya:** I can show claim 1 at the top and claim 2 below it, with the connector marked as an addition.
- 18 **Marcus:** A ⁹ _____ will make the relationship visible without dropping the inherited housing and channel requirements.
- 19 **Priya:** Then our summary is a housing and channel with a detachable connector, not a connector standing alone.
- 20 **Marcus:** Correct for this example. That narrower combination may be a ¹⁰ _____ to assess, but it is not a promise of grant or an infringement conclusion.

CHECK THE GAPS

1. dependent claim / 2. claim dependency / 3. claim limitation / 4. independent claim / 5. antecedent basis / 6. structural limitation / 7. transitional phrase / 8. claim construction / 9. claim tree / 10. fallback position

[Why these answers fit, page 118](#)

F Check accuracy and scope

The dependent claim adds a feature

Return to the case

For this simplified drafting discussion, claim 1 requires a housing and channel. Claim 2 depends on claim 1 and adds a detachable connector. Engineer Priya thinks claim 2 covers a connector by itself. Patent professional Marcus explains the dependency and checks the draft term the valve, which has no clear earlier introduction. These are unfiled examples, not legal claim-construction conclusions.

Choose one answer per question. Use the case facts and keep any uncertainty or limits intact.

1. What should a plain-language paraphrase avoid?

- A. Identifying that the document is a draft
- B. Silently dropping inherited limitations
- C. Naming the added feature
- D. Explaining the dependency

2. Which change requires substantive review rather than casual editing?

- A. Fixing an extra space in a cover label
- B. Replacing comprising with consisting of
- C. Correcting a page-number typo
- D. Aligning a heading without changing text

[Answers and explanations, page 120](#)

Listen for the distinction

Swap roles and explain the valve-reference problem without guessing which component the draft legally covers.

Explain the relationship before the terminology

Technical colleagues may read claim lists as separate product options. Explain what carries forward before introducing drafting labels.

F Say it / transfer to a new case

A different dependency changes the inherited features

Claim 3 depends on claim 2 and adds a pressure sensor. In this simplified example, claim 2 already includes the housing, channel, and connector.

Complete the four gaps. With a partner, read alternate roles, then switch. Studying alone, read both roles and pause before each response.

WORD AND PHRASE BANK

tree / connector / requirements / limitation

- 01 **Engineer:** Claim 3 inherits the earlier ¹ _____.
- 02 **Reviewer:** The sensor is an additional ² _____.
- 03 **Engineer:** It does not replace the ³ _____.
- 04 **Reviewer:** Show that relationship in the claim ⁴ _____.

CHECK THE GAPS

1. requirements / 2. limitation / 3. connector / 4. tree

[Why these answers fit, page 120](#)

Rebuild the exchange

Choose the missing response. Read the completed three-turn exchange aloud, changing roles on the second reading.

1. Rebuild the exchange from "The dependent claim adds a feature". Priya: "Could I simplify comprising to consisting of? The second phrase sounds more natural to me in ordinary English." Marcus: [missing response] Priya: "I will leave the operative wording intact and add a separate plain-English explanation for the engineering meeting." Which response belongs in the gap?

- A.** Think in terms of each claim limitation. We must identify all the requirements in the particular claim under discussion.
- B.** That is an antecedent basis issue to review. We need to establish which element the phrase is intended to identify.
- C.** Yes. A separate independent claim would raise its own drafting and support questions; the current dependency does not accomplish that.
- D.** Do not change that transitional phrase for style alone. The legal effect needs deliberate review under the applicable law.

[Answers and explanations, page 121](#)

A Read the situation

LESSON 04 / CHECKING DRAFTING SUPPORT BEFORE AMENDING

Distinguish filed disclosure from later engineering developments when discussing an amendment.

The new controller was developed after filing

The filed application describes a mechanical bypass. A later prototype uses an electronic controller. Engineer Sofia wants to insert the controller into the pending application as a clarification. Patent counsel Ravi has not located support for it in the filed text or drawings. The team must preserve both versions and obtain qualified advice on available filing options.

People: Sofia, Engineer; Ravi, Patent counsel.

Read the record

Choose one answer per question using the facts above.

1. Which feature appears in the filed disclosure as described?

- A. The later electronic controller
- B. A tested wireless interface
- C. Every future control system
- D. A mechanical bypass

2. What is Sofia proposing?

- A. Withdrawing every drawing
- B. Reporting an existing grant
- C. Adding the later controller as a clarification
- D. Deleting the whole application

3. What has Ravi established?

- A. The amendment is legally permissible
- B. The later prototype has an earlier filing date
- C. A new filing has already been approved
- D. He has not located support in the filed materials

[Answers and explanations, page 122](#)

B Vocabulary in use

CORE TERMS

specification

Written disclosure forming part of a patent application.

review the specification

written description

Disclosure supporting the claimed subject matter under the applicable requirement.

assess written description

new matter

Added subject matter not permitted by the applicable disclosure rules.

identify potential new matter

support citation

Pinpoint reference to material supporting proposed wording.

provide a support citation

later-developed feature

Feature developed after the earlier document or filing.

distinguish a later-developed feature

explicit support

Support stated directly in the relevant material.

identify explicit support

application as filed

Application content in its originally filed form.

compare the application as filed

enablement

Sufficiency of teaching under the applicable legal standard.

evaluate enablement

amendment

Proposed or entered change to application documents.

prepare an amendment

filed drawing

Drawing contained in the relevant filed application.

inspect the filed drawing

original disclosure

Content disclosed in the original application.

locate original disclosure

inherent disclosure

Feature necessarily present under the applicable analysis rather than merely possible.

assess inherent disclosure

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

specification SPECIFICATION

review the specification

Keep the meaning precise: Written disclosure forming part of a patent application.

amendment AMENDMENT

prepare an amendment

Keep the meaning precise: Proposed or entered change to application documents.

B Precision and professional shorthand

EXTEND YOUR RANGE

draft history

Record of successive drafting versions.

preserve the draft history

clean copy

Version showing text without visible change markings.

compare the clean copy

priority entitlement

Right to rely on an earlier date under applicable requirements.

assess priority entitlement

clarification request

Question that resolves an unclear meaning or instruction.

make a targeted clarification request

working assumption

Provisional premise used while information is incomplete.

challenge a working assumption

action owner

Named person responsible for a specified next step.

confirm the action owner

marked-up copy

Version visibly identifying proposed changes.

circulate a marked-up copy

support matrix

Table linking proposed wording to source disclosure.

maintain a support matrix

filing strategy

Plan for pursuing protection through appropriate filings.

review the filing strategy

source attribution

Identification of where information came from.

preserve source attribution

scope boundary

Limit of the work or authority being discussed.

state the scope boundary

check-back

Restatement used to verify that a message was understood.

complete a check-back

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

inherent disclosure INHERENT DISCLOSURE

assess inherent disclosure

Keep the meaning precise: Feature necessarily present under the applicable analysis rather than merely possible.

priority entitlement PRIORITY ENTITLEMENT

assess priority entitlement

Keep the meaning precise: Right to rely on an earlier date under applicable requirements.

Phrases that move the work forward

Locate the basis

Where does the filed application disclose that controller?

Challenge a label

Calling it a clarification does not answer the support question.

Avoid hindsight

We should not read later knowledge back into the earlier document.

Route the decision

We need advice on the available filing options.

Sofia / in the conversation

The latest prototype uses an electronic controller.

Ravi / in the conversation

First compare it with the application as filed.

Sofia / in the conversation

The controller performs a related purpose, but we developed its arrangement after the filing and drew a new circuit diagram.

Sofia / in the conversation

I found a broad sentence saying that flow may be controlled.

Separate versions

That feature appears in the later prototype, not the cited filed passage.

Request precision

Please provide the exact paragraph or drawing reference.

Preserve the record

Keep the filed version separate from the working draft.

Summarize the limit

The proposed addition remains under review; it is not approved for filing.

Sofia / in the conversation

Can we add it to the pending application as a clarification of the bypass?

Ravi / in the conversation

The version I have describes a mechanical bypass, not this later controller.

Ravi / in the conversation

Then identify it as a later-developed feature while we investigate whether the proposed wording has support in the earlier disclosure.

Sofia / in the conversation

Would that automatically support any electronic implementation?

Precision in real exchanges

Purpose: Request precision

Useful wording: Please provide the exact paragraph or drawing reference.

Purpose: Avoid hindsight

Useful wording: We should not read later knowledge back into the earlier document.

D Choose the response that fits

Choose one response for each situation. Preserve the facts, the decision boundary, and the purpose of the exchange.

1. What would most directly support the proposed wording?

- A.** A verified relevant passage or drawing in the filed disclosure
- B.** A later marketing slide alone
- C.** A new prototype photo with no earlier support
- D.** The engineer calling it obvious

2. Which summary avoids hindsight?

- A.** The new prototype changes the historical filing contents
- B.** The controller is later developed and support is unlocated
- C.** The original filing automatically includes later improvements
- D.** Every possible controller was necessarily disclosed

3. A colleague needs the term for this meaning: Sufficiency of teaching under the applicable legal standard. Which term fits?

- A.** enablement
- B.** working assumption
- C.** clean copy
- D.** later-developed feature

D Choose the response that fits / continued

4. Rebuild the exchange from "The new controller was developed after filing". Sofia: "I found a broad sentence saying that flow may be controlled. Would that automatically support any electronic implementation?" Ravi: [missing response] Sofia: "I can show the exact sentence and the drawing it references, instead of sending only the revised paragraph." Which response belongs in the gap?

- A.** Not automatically. We need a proper written description analysis rather than assuming a general result discloses every way of achieving it.
- B.** Then identify it as a later-developed feature while we investigate whether the proposed wording has support in the earlier disclosure.
- C.** First compare it with the application as filed. The version I have describes a mechanical bypass, not this later controller.
- D.** Yes. A support matrix makes both positive citations and unresolved gaps visible without concealing them in a clean draft.

[Answers and explanations, page 122](#)

One useful distinction

Calling a substantive addition a clarification does not supply support. Compare the proposed wording with the actual filed disclosure.

Conversation

The new controller was developed after filing

The new controller was developed after filing

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

support citation / marked-up copy / support matrix / written description / filing strategy /
new matter / later-developed feature / priority entitlement / filed drawing /
application as filed

- 01 **Sofia:** The latest prototype uses an electronic controller. Can we add it to the pending application as a clarification of the bypass?
- 02 **Ravi:** First compare it with the ¹ _____. The version I have describes a mechanical bypass, not this later controller.
- 03 **Sofia:** The controller performs a related purpose, but we developed its arrangement after the filing and drew a new circuit diagram.
- 04 **Ravi:** Then identify it as a ² _____ while we investigate whether the proposed wording has support in the earlier disclosure.
- 05 **Sofia:** I found a broad sentence saying that flow may be controlled. Would that automatically support any electronic implementation?
- 06 **Ravi:** Not automatically. We need a proper ³ _____ analysis rather than assuming a general result discloses every way of achieving it.
- 07 **Sofia:** I can show the exact sentence and the drawing it references, instead of sending only the revised paragraph.
- 08 **Ravi:** Please provide that ⁴ _____ so we can evaluate the proposed wording against the actual text and figures.
- 09 **Sofia:** The new diagram is clearer. I was going to replace the old drawing in our shared folder to avoid confusion.
- 10 **Ravi:** Preserve the ⁵ _____. Keep the new diagram separately labeled so that the historical record remains intact.

Conversation continues on the next page.

The new controller was developed after filing

CONVERSATION / CONTINUED

- 11 **Sofia:** I understand. Describing the addition as clarification does not establish that the original application taught this arrangement.
- 12 **Ravi:** Correct. We must assess potential ⁶ _____ and the other disclosure requirements before deciding what can be changed.
- 13 **Sofia:** Would a table listing each proposed phrase beside its original source help you identify the unsupported parts?
- 14 **Ravi:** Yes. A ⁷ _____ makes both positive citations and unresolved gaps visible without concealing them in a clean draft.
- 15 **Sofia:** I will also keep a version showing insertions and deletions, so the technical and legal reviewers see the same changes.
- 16 **Ravi:** Circulate the ⁸ _____ alongside the clean version, with neither described as approved for filing.
- 17 **Sofia:** Management asked whether the electronic version would automatically receive the earlier date because it improves the same product.
- 18 **Ravi:** We cannot promise ⁹ _____ on that basis. The relevant subject matter and actual disclosure need assessment.
- 19 **Sofia:** I will report that the later improvement is valuable, but the support and filing route remain unresolved.
- 20 **Ravi:** That is accurate. We can discuss ¹⁰ _____ once we have the records, without inventing a deadline or assuming that every route is available.

CHECK THE GAPS

1. application as filed / 2. later-developed feature / 3. written description / 4. support citation / 5. filed drawing / 6. new matter / 7. support matrix / 8. marked-up copy / 9. priority entitlement / 10. filing strategy

[Why these answers fit, page 123](#)

F Check accuracy and scope

The new controller was developed after filing

Return to the case

The filed application describes a mechanical bypass. A later prototype uses an electronic controller. Engineer Sofia wants to insert the controller into the pending application as a clarification. Patent counsel Ravi has not located support for it in the filed text or drawings. The team must preserve both versions and obtain qualified advice on available filing options.

Choose one answer per question. Use the case facts and keep any uncertainty or limits intact.

1. Why keep a marked-up copy?

- A. To establish patentability by formatting
- B. To replace the original filed record
- C. To give the new feature an earlier date
- D. To make proposed wording changes visible for review

2. Which action is appropriate now?

- A. Review support and available filing options with counsel
- B. File the addition because it is called clarification
- C. Promise the earlier date to every new feature
- D. Delete the filed version from the record

[Answers and explanations, page 125](#)

Listen for the distinction

Switch roles and state the three records to preserve: original documents, support matrix, and marked-up draft.

Accuracy can slow an attractive shortcut

A later improvement may be valuable without belonging in the earlier filing. Explain the document boundary without dismissing the engineering work.

F Say it / transfer to a new case

The new diagram is not the original diagram

A reviewer receives a clean drawing labeled revised. The original filed drawing and a change comparison have not been attached.

Complete the four gaps. With a partner, read alternate roles, then switch. Studying alone, read both roles and pause before each response.

WORD AND PHRASE BANK

support / comparison / review / filed

- 01 **Reviewer:** Please attach the original ¹ _____ drawing.
- 02 **Engineer:** I will also supply the change ² _____.
- 03 **Reviewer:** The clean version alone does not establish ³ _____.
- 04 **Engineer:** The proposed revision remains under ⁴ _____.

CHECK THE GAPS

1. filed / 2. comparison / 3. support / 4. review

[Why these answers fit, page 125](#)

Rebuild the exchange

Choose the missing response. Read the completed three-turn exchange aloud, changing roles on the second reading.

1. Rebuild the exchange from "The new controller was developed after filing". Sofia: "Would a table listing each proposed phrase beside its original source help you identify the unsupported parts?" Ravi: [missing response] Sofia: "I will also keep a version showing insertions and deletions, so the technical and legal reviewers see the same changes." Which response belongs in the gap?

- A.** Yes. A support matrix makes both positive citations and unresolved gaps visible without concealing them in a clean draft.
- B.** First compare it with the application as filed. The version I have describes a mechanical bypass, not this later controller.
- C.** Then identify it as a later-developed feature while we investigate whether the proposed wording has support in the earlier disclosure.
- D.** Please provide that support citation so we can evaluate the proposed wording against the actual text and figures.

[Answers and explanations, page 126](#)

Review 2 / Meaning and context

Use language from the lessons you have completed. Choose one answer per question.

Case file

Revisit "Explaining claim structure to a technical colleague" and "Checking drafting support before amending". Choose precise terminology, then reconstruct the missing responses using both neighboring turns. The final two questions also revisit earlier conversations.

1. A colleague needs the term for this meaning: Claim incorporating a referenced claim and adding a further limitation. Which term fits?

- A. structural limitation
- B. dependent claim
- C. preamble
- D. source attribution

2. A colleague needs the term for this meaning: Drawing contained in the relevant filed application. Which term fits?

- A. clarification request
- B. draft history
- C. specification
- D. filed drawing

3. Rebuild the exchange from "One reference matches two features, not the entire claim". Noor: "I will describe the potential combination without saying that it automatically defeats the claim under every legal system." Ethan: [missing response] Noor: "The database gives several dates. I copied the earliest number without identifying what that date represents." Which response belongs in the gap?

- A. Preserve that search limitation. Not located in your review is more precise than declaring that the reference cannot disclose it.
- B. Identify a possible combination rationale for counsel to assess rather than treating shared subject matter as sufficient by itself.
- C. Keep the reference document identities separate. We should not move a feature from S into the column describing R.
- D. That calls for the applicable nonobviousness or inventive-step analysis, including the facts and reasoning supporting any proposed combination.

Review 2 / Meaning and context / continued

4. Rebuild the exchange from "The new controller was developed after filing". Sofia: "Management asked whether the electronic version would automatically receive the earlier date because it improves the same product." Ravi: [missing response] Sofia: "I will report that the later improvement is valuable, but the support and filing route remain unresolved." Which response belongs in the gap?

- A.** Please provide that support citation so we can evaluate the proposed wording against the actual text and figures.
- B.** We cannot promise priority entitlement on that basis. The relevant subject matter and actual disclosure need assessment.
- C.** Correct. We must assess potential new matter and the other disclosure requirements before deciding what can be changed.
- D.** Preserve the filed drawing. Keep the new diagram separately labeled so that the historical record remains intact.

[Answers and explanations, page 149](#)

A Read the situation

LESSON 05 / EXPLAINING AN OFFICE ACTION AND AGREEING ON A RESPONSE

Separate the examiner position, proposed response, and procedural status in a client update.

The examiner raised two different issues

A fictional US non-final office action rejects claim 1 over Reference R and separately questions the clarity of the term substantially aligned. The client wants to say the examiner rejected the product. Counsel Elise proposes reviewing the cited mapping and the unclear term before selecting a response. The actual notice controls all dates; no deadline or guaranteed outcome is supplied.

People: Jon, Client engineering lead; Elise, Patent counsel.

Read the record

Choose one answer per question using the facts above.

1. What does the notice address?

- A. A prior-art rejection and a separate clarity issue
- B. Product safety approval
- C. A final infringement judgment
- D. A granted license

2. How should the examiner position be attributed?

- A. The company admitted every point
- B. The customer rejected the design
- C. The examiner states the cited mapping
- D. The patent office proved the product cannot work

3. Which source controls the response timing?

- A. A standard date invented for the exercise
- B. The actual notice and applicable procedure
- C. A guessed deadline from another case
- D. The engineering meeting calendar alone

[Answers and explanations, page 127](#)

B Vocabulary in use

CORE TERMS

office action

Official communication from a patent examiner or office.

review the office action

ground of rejection

Stated legal basis for rejecting a claim.

address each ground of rejection

response deadline

Time limit governing the required response.

verify the response deadline

claim amendment

Proposed or entered change to claim wording.

assess a claim amendment

examiner interview

Discussion with an examiner under the applicable procedure.

request an examiner interview

allowance

Office determination permitting claims to proceed toward grant subject to requirements.

distinguish allowance from issuance

non-final action

Procedural action not designated final in the relevant examination process.

respond to a non-final action

examiner position

View or reasoning expressed by the examiner.

summarize the examiner position

docket entry

Recorded matter and deadline information in a tracking system.

verify the docket entry

argument on the record

Reasoning formally submitted in the examination record.

develop an argument on the record

interview summary

Record of the substance and outcome of an examiner discussion.

review the interview summary

final rejection

Procedural designation affecting available response routes.

review a final rejection

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

office action OFFICE ACTION

review the office action

Keep the meaning precise: Official communication from a patent examiner or office.

docket entry DOCKET ENTRY

verify the docket entry

Keep the meaning precise: Recorded matter and deadline information in a tracking system.

B Precision and professional shorthand

EXTEND YOUR RANGE

appeal

Request for review under the applicable review procedure.

assess an appeal

clarity issue

Concern that wording does not identify its meaning sufficiently.

resolve a clarity issue

response strategy

Plan for addressing the actual issues raised.

agree on a response strategy

clarification request

Question that resolves an unclear meaning or instruction.

make a targeted clarification request

working assumption

Provisional premise used while information is incomplete.

challenge a working assumption

action owner

Named person responsible for a specified next step.

confirm the action owner

prosecution history

Record of proceedings during patent examination.

review the prosecution history

distinguishing feature

Feature relied on to differentiate claimed subject matter from cited material.

identify a distinguishing feature

client instruction

Authorized direction from the client on the matter.

obtain client instructions

source attribution

Identification of where information came from.

preserve source attribution

scope boundary

Limit of the work or authority being discussed.

state the scope boundary

check-back

Restatement used to verify that a message was understood.

complete a check-back

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

final rejection FINAL REJECTION

review a final rejection

Keep the meaning precise: Procedural designation affecting available response routes.

response strategy RESPONSE STRATEGY

agree on a response strategy

Keep the meaning precise: Plan for addressing the actual issues raised.

Phrases that move the work forward

Attribute the position

The examiner maps that passage to the channel limitation.

Disagree precisely

We do not read that passage as disclosing the stated relationship.

Avoid a promise

We can explain our position without guaranteeing allowance.

Preserve timing

We will verify the actual deadline and docket entry.

Jon / in the conversation

Management wants a quick assurance that your reply will reverse that decision.

Jon / in the conversation

The notice points to Reference R for claim 1 and also questions the phrase substantially aligned.

Jon / in the conversation

Our engineer thinks the channel in R runs beside the housing instead of through the relationship described in our draft.

Jon / in the conversation

We can provide a side-by-side diagram, but it should not introduce details that are missing from the filed application.

Separate issues

The clarity concern needs a response apart from the prior-art argument.

Discuss options

An amendment and an argument have different implications.

Confirm authority

Please confirm instructions after reviewing the proposed response.

Summarize status

The response is proposed; it has not yet been approved or filed.

Elise / in the conversation

The office action addresses the claims and their wording, not whether the product can be sold or will succeed commercially.

Elise / in the conversation

We need to address the ground of rejection and examine the clarity concern rather than assume one answer resolves both.

Elise / in the conversation

Please show the relevant passages and explain the technical relationship precisely.

Elise / in the conversation

Any proposed claim amendment needs support and scope review, while our argument must stay consistent with the actual disclosure.

Precision in real exchanges

Purpose: Discuss options

Useful wording: An amendment and an argument have different implications.

Purpose: Avoid a promise

Useful wording: We can explain our position without guaranteeing allowance.

D Choose the response that fits

Choose one response for each situation. Preserve the facts, the decision boundary, and the purpose of the exchange.

1. Which client update is accurate?

- A.** The patent has already been granted
- B.** An interview guarantees allowance
- C.** The office action raises prior-art and clarity issues for response
- D.** The product has been banned

2. Which disagreement is professionally precise?

- A.** Every citation is irrelevant because we disagree
- B.** The client wants protection, so the objection must disappear
- C.** The cited passage does not appear to disclose that relationship
- D.** The examiner is hostile and incompetent

3. A colleague needs the term for this meaning: View or reasoning expressed by the examiner. Which term fits?

- A.** examiner position
- B.** working assumption
- C.** examiner interview
- D.** clarity issue

D Choose the response that fits / continued

4. Rebuild the exchange from "The examiner raised two different issues". Jon: "Our engineer thinks the channel in R runs beside the housing instead of through the relationship described in our draft." Elise: [missing response] Jon: "We can provide a side-by-side diagram, but it should not introduce details that are missing from the filed application." Which response belongs in the gap?

- A.** Yes. The prosecution history matters, so we should review technical explanations and legal arguments carefully before submitting them.
- B.** No. Verify the response deadline and tracking record promptly; the label is not permission to disregard timing.
- C.** We can assess an examiner interview under the applicable procedure. A discussion may clarify the issue without guaranteeing agreement.
- D.** That may identify a distinguishing feature. Please show the relevant passages and explain the technical relationship precisely.

[Answers and explanations, page 127](#)

One useful distinction

The notice addresses claims and wording, not whether customers may buy the product. Examiner arguments, client disagreements, amendments, and allowance are separate statuses.

Conversation

The examiner raised two different issues

The examiner raised two different issues

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

office action / examiner interview / prosecution history / distinguishing feature /
claim amendment / ground of rejection / allowance / client instruction / response strategy
/ response deadline

- 01 **Jon:** The examiner rejected our product. Management wants a quick assurance that your reply will reverse that decision.
- 02 **Elise:** The ¹ _____ addresses the claims and their wording, not whether the product can be sold or will succeed commercially.
- 03 **Jon:** The notice points to Reference R for claim 1 and also questions the phrase substantially aligned.
- 04 **Elise:** Those are separate issues. We need to address the ² _____ and examine the clarity concern rather than assume one answer resolves both.
- 05 **Jon:** Our engineer thinks the channel in R runs beside the housing instead of through the relationship described in our draft.
- 06 **Elise:** That may identify a ³ _____. Please show the relevant passages and explain the technical relationship precisely.
- 07 **Jon:** We can provide a side-by-side diagram, but it should not introduce details that are missing from the filed application.
- 08 **Elise:** Correct. Any proposed ⁴ _____ needs support and scope review, while our argument must stay consistent with the actual disclosure.
- 09 **Jon:** Could we first ask the examiner how that passage is being read instead of guessing the intended mapping?
- 10 **Elise:** We can assess an ⁵ _____ under the applicable procedure. A discussion may clarify the issue without guaranteeing agreement.

Conversation continues on the next page.

The examiner raised two different issues

CONVERSATION / CONTINUED

- 11 **Jon:** If the conversation sounds encouraging, may I tell management that the application has been approved?
- 12 **Elise:** No. An encouraging discussion is not ⁶ _____. We need an accurate record of what was discussed and the actual subsequent procedural status.
- 13 **Jon:** I will describe the response as proposed until we have reviewed the alternatives and authorized the next step.
- 14 **Elise:** That preserves ⁷ _____. We should explain the consequences of an amendment and an argument before confirming the chosen response.
- 15 **Jon:** The notice is labeled non-final. Does that mean we can leave it until the next quarterly engineering meeting?
- 16 **Elise:** No. Verify the ⁸ _____ and tracking record promptly; the label is not permission to disregard timing.
- 17 **Jon:** I also want the team to understand that a formal response becomes part of the examination record.
- 18 **Elise:** Yes. The ⁹ _____ matters, so we should review technical explanations and legal arguments carefully before submitting them.
- 19 **Jon:** I will send the mapping and wording comments, then review your proposed alternatives with the authorized client contact.
- 20 **Elise:** We can then agree on the ¹⁰ _____, keeping the notice, instructions, deadline, and eventual filing confirmation separate in the status report.

CHECK THE GAPS

1. office action / 2. ground of rejection / 3. distinguishing feature / 4. claim amendment / 5. examiner interview / 6. allowance / 7. client instruction / 8. response deadline / 9. prosecution history / 10. response strategy

[Why these answers fit, page 128](#)

F Check accuracy and scope

The examiner raised two different issues

Return to the case

A fictional US non-final office action rejects claim 1 over Reference R and separately questions the clarity of the term substantially aligned. The client wants to say the examiner rejected the product. Counsel Elise proposes reviewing the cited mapping and the unclear term before selecting a response. The actual notice controls all dates; no deadline or guaranteed outcome is supplied.

Choose one answer per question. Use the case facts and keep any uncertainty or limits intact.

1. What must happen before calling the response filed?

- A.** The team must prefer one option
- B.** Counsel must open the notice
- C.** The actual filing must occur and be verified
- D.** The engineer must read a draft

2. Which summary keeps the issues separate?

- A.** Rename the notice to remove the rejection
- B.** Check the mapping and independently address the unclear term
- C.** Ignore clarity once a reference is disputed
- D.** Treat both issues as a product defect

[Answers and explanations, page 130](#)

Listen for the distinction

Switch roles and deliver the final action sequence without supplying a deadline or promising allowance.

Challenge reasoning, not the person

A firm response can identify a disputed mapping without portraying the examiner as hostile or promising that disagreement will secure allowance.

F Say it / transfer to a new case

A draft reply was marked filed

The response draft has been approved internally, but no submission or office receipt has been verified.

Complete the four gaps. With a partner, read alternate roles, then switch. Studying alone, read both roles and pause before each response.

WORD AND PHRASE BANK

approved / record / filed / visible

- 01 **Coordinator:** The draft is internally ¹ _____.
- 02 **Counsel:** That does not establish that it was ² _____.
- 03 **Coordinator:** I will check the actual submission ³ _____.
- 04 **Counsel:** Keep the deadline ⁴ _____ until its status is verified.

CHECK THE GAPS

1. approved / 2. filed / 3. record / 4. visible

[Why these answers fit, page 130](#)

Rebuild the exchange

Choose the missing response. Read the completed three-turn exchange aloud, changing roles on the second reading.

1. Rebuild the exchange from "The examiner raised two different issues". Jon: "I will describe the response as proposed until we have reviewed the alternatives and authorized the next step." Elise: [missing response] Jon: "The notice is labeled non-final. Does that mean we can leave it until the next quarterly engineering meeting?" Which response belongs in the gap?

- A.** That preserves client instruction. We should explain the consequences of an amendment and an argument before confirming the chosen response.
- B.** The office action addresses the claims and their wording, not whether the product can be sold or will succeed commercially.
- C.** We can assess an examiner interview under the applicable procedure. A discussion may clarify the issue without guaranteeing agreement.
- D.** Correct. Any proposed claim amendment needs support and scope review, while our argument must stay consistent with the actual disclosure.

[Answers and explanations, page 131](#)

A Read the situation

LESSON 06 / COORDINATING INTERNATIONAL PATENT FILING DECISIONS

Explain the PCT process and obtain specific instructions without promising universal protection.

An international report is not a worldwide grant

Coordinator Hana has received an international search report and written opinion for a PCT application. Manager Luis calls it a world patent. The company is evaluating markets A, B, and C but has authorized none for the national or regional stage. Local requirements, costs, translations, and actual deadlines remain for verification with the responsible professionals.

People: Luis, IP portfolio manager; Hana, Filing coordinator.

Read the record

Choose one answer per question using the facts above.

1. What documents have arrived?

- A. An international search report and written opinion
- B. A grant covering every country
- C. All national patents for A, B, and C
- D. A signed license for every market

2. Which markets are authorized for the next stage?

- A. Only A by implication
- B. Every PCT country
- C. None has yet been authorized
- D. All three automatically

3. Which matters need verification?

- A. Whether any market is being evaluated
- B. Requirements, costs, translations, and actual deadlines
- C. Whether the reports exist
- D. Whether the manager spoke

[Answers and explanations, page 132](#)

B Vocabulary in use

CORE TERMS

Patent Cooperation Treaty

Treaty providing an international patent application procedure.

use the Patent Cooperation Treaty route

receiving Office

Office receiving a PCT application under the applicable rules.

identify the receiving Office

international search report

Report identifying relevant search results in the PCT process.

review the international search report

international phase

International stage of the PCT application process.

complete international-phase tasks

regional phase

Stage before a regional office under the applicable framework.

coordinate regional-phase entry

national requirements

Requirements applicable before the relevant national office.

verify national requirements

international application

Application filed under the relevant international procedure.

identify the international application

International Searching Authority

Authority conducting the relevant PCT international search.

identify the International Searching Authority

written opinion

Written international-stage assessment under the relevant PCT procedure.

review the written opinion

national phase

Stage before national offices under the applicable PCT framework.

plan national-phase entry

designated Office

Office associated with a designation under the PCT procedure.

verify designated Office requirements

translation specification

Requirements for the language version needed in a filing.

confirm the translation specification

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

Patent Cooperation Treaty PATENT COOPERATION TREATY

use the Patent Cooperation Treaty route

Keep the meaning precise: Treaty providing an international patent application procedure.

written opinion WRITTEN OPINION

review the written opinion

Keep the meaning precise: Written international-stage assessment under the relevant PCT procedure.

B Precision and professional shorthand

EXTEND YOUR RANGE

filing instruction

Authorized direction identifying a requested filing action.

obtain filing instructions

local associate

Local patent professional assisting with a jurisdictional matter.

instruct the local associate

territorial protection

Rights limited to the relevant territory and legal scope.

explain territorial protection

clarification request

Question that resolves an unclear meaning or instruction.

make a targeted clarification request

working assumption

Provisional premise used while information is incomplete.

challenge a working assumption

action owner

Named person responsible for a specified next step.

confirm the action owner

jurisdiction budget

Planned expenditure for pursuing protection in a territory.

approve the jurisdiction budget

grant decision

Decision by the competent office on granting patent rights.

distinguish the grant decision

portfolio review

Assessment of filings and rights against organizational priorities.

conduct a portfolio review

source attribution

Identification of where information came from.

preserve source attribution

scope boundary

Limit of the work or authority being discussed.

state the scope boundary

check-back

Restatement used to verify that a message was understood.

complete a check-back

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

translation specification TRANSLATION SPECIFICATION

confirm the translation specification

Keep the meaning precise: Requirements for the language version needed in a filing.

territorial protection TERRITORIAL PROTECTION

explain territorial protection

Keep the meaning precise: Rights limited to the relevant territory and legal scope.

Phrases that move the work forward

Correct the label

We have a PCT application, not a worldwide grant.

Identify the decision

Which markets are authorized for the next stage?

Confirm responsibilities

Who verifies the local requirements and deadline?

Preserve territorial scope

Any resulting rights must be identified by territory and status.

Luis / in the conversation

Can I tell the board that our world patent now covers markets A, B, and C?

Hana / in the conversation

We do not have a worldwide grant from receiving those reports.

Hana / in the conversation

The written opinion gives an assessment under that procedure; neither document itself grants patents in the markets on our list.

Hana / in the conversation

They inform the portfolio review, alongside business priorities and qualified advice on the actual findings.

Explain the report

The written opinion is an assessment, not a patent certificate.

Separate interest from instruction

Evaluating a country is not an instruction to file there.

Clarify costs

Does this estimate include translation and local professional fees?

Close the loop

We need explicit instructions and confirmation of the action taken.

Hana / in the conversation

Please call it an international application under the PCT.

Luis / in the conversation

I see an international search report and a separate assessment discussing the claims.

Luis / in the conversation

The reports will still help us decide whether the commercial opportunity justifies further work in each market.

Luis / in the conversation

The market slide lists A, B, and C.

Precision in real exchanges

Purpose: Separate interest from instruction

Useful wording: Evaluating a country is not an instruction to file there.

Purpose: Confirm responsibilities

Useful wording: Who verifies the local requirements and deadline?

D Choose the response that fits

Choose one response for each situation. Preserve the facts, the decision boundary, and the purpose of the exchange.

1. Which description corrects world patent accurately?

- A.** One patent automatically enforceable everywhere
- B.** A license to sell in every country
- C.** A PCT application with international-stage reports
- D.** A guaranteed grant in all selected markets

2. What converts market interest into a filing instruction?

- A.** Explicit authorized direction for the specified action
- B.** A market appearing on a discussion slide
- C.** A translation estimate alone
- D.** A search report mentioning a country

3. A colleague needs the term for this meaning: Authority conducting the relevant PCT international search. Which term fits?

- A.** local associate
- B.** International Searching Authority
- C.** working assumption
- D.** regional phase

D Choose the response that fits / continued

4. Rebuild the exchange from "An international report is not a worldwide grant".
Luis: "The reports will still help us decide whether the commercial opportunity justifies further work in each market." **Hana:** [missing response] **Luis:** "The market slide lists A, B, and C. I assumed that putting them on the slide authorized your next steps." **Which response belongs in the gap?**

- A.** Yes. They inform the portfolio review, alongside business priorities and qualified advice on the actual findings.
- B.** Then the jurisdiction budget comparison needs clearer assumptions before anyone treats those totals as equivalent.
- C.** No. The relevant national requirements or regional requirements must be checked with the responsible professionals using current information.
- D.** Each local associate should receive the authorized scope, documents, and a request for confirmation of the action taken.

[Answers and explanations, page 132](#)

One useful distinction

A PCT application is not a world patent. International-stage reports inform further decisions; national or regional offices determine grant under their applicable systems.

Conversation

An international report is not a worldwide grant

An international report is not a worldwide grant

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

portfolio review / territorial protection / filing instruction / translation specification /
grant decision / local associate / national requirements / written opinion /
jurisdiction budget / international application

- 01 **Luis:** The search report has arrived. Can I tell the board that our world patent now covers markets A, B, and C?
- 02 **Hana:** Please call it an ¹ _____ under the PCT. We do not have a worldwide grant from receiving those reports.
- 03 **Luis:** I see an international search report and a separate assessment discussing the claims. Do they perform the same function?
- 04 **Hana:** The ² _____ gives an assessment under that procedure; neither document itself grants patents in the markets on our list.
- 05 **Luis:** The reports will still help us decide whether the commercial opportunity justifies further work in each market.
- 06 **Hana:** Yes. They inform the ³ _____, alongside business priorities and qualified advice on the actual findings.
- 07 **Luis:** The market slide lists A, B, and C. I assumed that putting them on the slide authorized your next steps.
- 08 **Hana:** We need a specific ⁴ _____. Evaluation and authorization are different statuses, especially where costs and timing are involved.
- 09 **Luis:** Should the board expect exactly the same requirements in each place once the international stage is complete?
- 10 **Hana:** No. The relevant ⁵ _____ or regional requirements must be checked with the responsible professionals using current information.

Conversation continues on the next page.

An international report is not a worldwide grant

CONVERSATION / CONTINUED

- 11 **Luis:** I have three estimates, but one includes translation and another mentions only the local professional fee.
- 12 **Hana:** Then the ⁶ _____ comparison needs clearer assumptions before anyone treats those totals as equivalent.
- 13 **Luis:** We also need to know who checks the language and format of each version, not just who places the order.
- 14 **Hana:** Confirm the ⁷ _____ and review responsibility. A completed translation is not proof that every filing requirement has been met.
- 15 **Luis:** The local firms can confirm the requirements and actual dates, but the central team must send consistent instructions.
- 16 **Hana:** Each ⁸ _____ should receive the authorized scope, documents, and a request for confirmation of the action taken.
- 17 **Luis:** Once the national-stage actions are completed, should the status report say protection is granted in each place?
- 18 **Hana:** No. Entry and the ⁹ _____ are separate. Report each application or right using its actual territory and procedural status.
- 19 **Luis:** I will revise the board slide to show reports received, market decisions pending, and local requirements under review.
- 20 **Hana:** Good. That explains ¹⁰ _____ without promising grants, inventing deadlines, or treating the application as permission to commercialize everywhere.

CHECK THE GAPS

1. international application / 2. written opinion / 3. portfolio review / 4. filing instruction / 5. national requirements / 6. jurisdiction budget / 7. translation specification / 8. local associate / 9. grant decision / 10. territorial protection

[Why these answers fit, page 133](#)

F Check accuracy and scope

An international report is not a worldwide grant

Return to the case

Coordinator Hana has received an international search report and written opinion for a PCT application. Manager Luis calls it a world patent. The company is evaluating markets A, B, and C but has authorized none for the national or regional stage. Local requirements, costs, translations, and actual deadlines remain for verification with the responsible professionals.

Choose one answer per question. Use the case facts and keep any uncertainty or limits intact.

1. What should a budget comparison identify?

- A.** An assumption that translations are always included
- B.** What each estimate includes and excludes
- C.** Only the smallest headline number
- D.** A guarantee that grants cost the same everywhere

2. Which status remains unresolved?

- A.** National or regional action for the evaluated markets
- B.** Receipt of the international reports
- C.** The existence of the PCT application
- D.** Management interest in A, B, and C

[Answers and explanations, page 135](#)

Listen for the distinction

Switch roles and state what the three estimates need before the board can compare them.

Translate the process into decision points

A manager needs to know what has happened, what still requires a decision, and who is responsible. Avoid turning a process diagram into a promise of grant.

F Say it / transfer to a new case

An estimate was mistaken for an instruction

A local associate sends an estimate for market B. The client has not authorized filing or approved the budget.

Complete the four gaps. With a partner, read alternate roles, then switch. Studying alone, read both roles and pause before each response.

WORD AND PHRASE BANK

estimate / instruction / deadline / pending

- 01 **Associate:** This document is an ¹ _____.
- 02 **Coordinator:** Client authorization is still ² _____.
- 03 **Associate:** Please send an explicit filing ³ _____.
- 04 **Coordinator:** We will also verify the applicable ⁴ _____.

CHECK THE GAPS

1. estimate / 2. pending / 3. instruction / 4. deadline

[Why these answers fit, page 135](#)

Rebuild the exchange

Choose the missing response. Read the completed three-turn exchange aloud, changing roles on the second reading.

1. Rebuild the exchange from "An international report is not a worldwide grant". Luis: "We also need to know who checks the language and format of each version, not just who places the order." Hana: [missing response] Luis: "The local firms can confirm the requirements and actual dates, but the central team must send consistent instructions." Which response belongs in the gap?

- A.** Please call it an international application under the PCT. We do not have a worldwide grant from receiving those reports.
- B.** No. Entry and the grant decision are separate. Report each application or right using its actual territory and procedural status.
- C.** The written opinion gives an assessment under that procedure; neither document itself grants patents in the markets on our list.
- D.** Confirm the translation specification and review responsibility. A completed translation is not proof that every filing requirement has been met.

[Answers and explanations, page 136](#)

Review 3 / Meaning and context

Use language from the lessons you have completed. Choose one answer per question.

Case file

Revisit "Explaining an office action and agreeing on a response" and "Coordinating international patent filing decisions". Choose precise terminology, then reconstruct the missing responses using both neighboring turns. The final two questions also revisit earlier conversations.

1. A colleague needs the term for this meaning: Stated legal basis for rejecting a claim. Which term fits?

- A. prosecution history
- B. argument on the record
- C. source attribution
- D. ground of rejection

2. A colleague needs the term for this meaning: Stage before national offices under the applicable PCT framework. Which term fits?

- A. clarification request
- B. filing instruction
- C. national phase
- D. Patent Cooperation Treaty

3. Rebuild the exchange from "The new controller was developed after filing". Sofia: "The new diagram is clearer. I was going to replace the old drawing in our shared folder to avoid confusion." Ravi: [missing response] Sofia: "I understand. Describing the addition as clarification does not establish that the original application taught this arrangement." Which response belongs in the gap?

- A. Please provide that support citation so we can evaluate the proposed wording against the actual text and figures.
- B. We cannot promise priority entitlement on that basis. The relevant subject matter and actual disclosure need assessment.
- C. Correct. We must assess potential new matter and the other disclosure requirements before deciding what can be changed.
- D. Preserve the filed drawing. Keep the new diagram separately labeled so that the historical record remains intact.

Review 3 / Meaning and context / continued

4. Rebuild the exchange from "An international report is not a worldwide grant".

Luis: "Once the national-stage actions are completed, should the status report say protection is granted in each place?" Hana: [missing response] Luis: "I will revise the board slide to show reports received, market decisions pending, and local requirements under review." Which response belongs in the gap?

- A.** The written opinion gives an assessment under that procedure; neither document itself grants patents in the markets on our list.
- B.** Confirm the translation specification and review responsibility. A completed translation is not proof that every filing requirement has been met.
- C.** Please call it an international application under the PCT. We do not have a worldwide grant from receiving those reports.
- D.** No. Entry and the grant decision are separate. Report each application or right using its actual territory and procedural status.

[Answers and explanations, page 151](#)

A Read the situation

LESSON 07 / EXPLAINING FREEDOM TO OPERATE AND DESIGN-AROUND QUESTIONS

Clarify the product, territory, claim status, and scope of a commercial-clearance review.

Our own patent does not answer the launch question

Product lead Mei says the company can launch its enclosure because it owns a patent. Counsel Arun explains that a separate freedom-to-operate review concerns third-party rights and the actual product configuration in market A. The engineers propose moving a connector but have not supplied revised drawings. No clearance opinion, infringement finding, or design-around conclusion has been issued.

People: Mei, Product lead; Arun, Patent counsel.

Read the record

Choose one answer per question using the facts above.

1. Why does ownership not settle the launch question?

- A. The company has no patent
- B. Third-party rights may require separate review
- C. Ownership always prohibits launch
- D. Every patent automatically expires at launch

2. What is missing for the proposed connector change?

- A. Revised drawings
- B. The name of the proposed market
- C. Any suggestion of a design change
- D. The product lead role

3. Which conclusion has been issued?

- A. A clearance opinion
- B. An infringement judgment
- C. A confirmed design-around assessment
- D. None of the stated legal conclusions

[Answers and explanations, page 137](#)

B Vocabulary in use

CORE TERMS

freedom to operate

Assessment of relevant rights affecting specified commercial activity in a territory.

commission a freedom-to-operate review

third-party patent

Patent belonging to another party.

review third-party patents

product configuration

Particular design and components being evaluated.

freeze the reviewed product configuration

legal status

Current procedural or rights status of a patent or application.

verify legal status

literal infringement

Infringement analysis based on the claim requirements under applicable interpretation.

assess literal infringement

design-around

Product change intended to avoid relevant patent scope, requiring assessment.

evaluate a design-around

right to exclude

Patent right to prevent specified acts within its legal scope.

explain the right to exclude

commercial clearance

Qualified assessment addressing specified launch or commercial risks.

define commercial-clearance scope

territory of interest

Geographic jurisdiction relevant to the proposed activity.

identify the territory of interest

claim chart

Structured comparison of claim requirements with relevant features.

prepare a claim chart

doctrine of equivalents

Jurisdiction-specific doctrine addressing certain equivalents beyond literal wording.

review the doctrine of equivalents

blocking patent

Patent whose relevant scope may constrain proposed commercial activity.

investigate a potential blocking patent

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

freedom to operate FREEDOM TO OPERATE

commission a freedom-to-operate review

Keep the meaning precise: Assessment of relevant rights affecting specified commercial activity in a territory.

territory of interest TERRITORY OF INTEREST

identify the territory of interest

Keep the meaning precise: Geographic jurisdiction relevant to the proposed activity.

B Precision and professional shorthand

EXTEND YOUR RANGE

expired patent

Patent whose term or rights have ended subject to actual legal status.

verify an expired patent

continuing application

Related further application under an applicable filing system.

review continuing applications

residual risk

Risk remaining after the stated review or action.

communicate residual risk

clarification request

Question that resolves an unclear meaning or instruction.

make a targeted clarification request

working assumption

Provisional premise used while information is incomplete.

challenge a working assumption

action owner

Named person responsible for a specified next step.

confirm the action owner

pending application

Application not yet resolved by the relevant final status.

monitor a pending application

clearance opinion

Professional opinion within a defined commercial-clearance scope.

obtain a clearance opinion

review trigger

Change or event requiring reassessment.

define a review trigger

source attribution

Identification of where information came from.

preserve source attribution

scope boundary

Limit of the work or authority being discussed.

state the scope boundary

check-back

Restatement used to verify that a message was understood.

complete a check-back

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

blocking patent **BLOCKING PATENT**

investigate a potential blocking patent

Keep the meaning precise: Patent whose relevant scope may constrain proposed commercial activity.

residual risk **RESIDUAL RISK**

communicate residual risk

Keep the meaning precise: Risk remaining after the stated review or action.

Phrases that move the work forward

Separate ownership from permission

Our own patent does not settle third-party rights.

Request the configuration

Please provide the revised drawings before we assess the change.

Check the record

We need the current claims and legal status.

Control changes

A material design change should trigger reassessment.

Mei / in the conversation

We own a patent on the enclosure, so I told the launch team that the product is clear to sell in market A.

Arun / in the conversation

It does not settle whether third-party rights affect our product.

Arun / in the conversation

A freedom to operate review needs a defined product, activity, territory, and current legal information.

Arun / in the conversation

Please identify the current product configuration rather than assuming that an earlier drawing still represents what will be sold.

Define the review

Which product version and market does the assessment cover?

Avoid a shortcut

A different appearance does not by itself establish a design-around.

Qualify the conclusion

Any opinion must state its scope, assumptions, and limits.

Report accurately

Clearance is under review, not already confirmed.

Arun / in the conversation

Ownership gives us a right to exclude within the patent scope.

Mei / in the conversation

Then the patentability search we commissioned earlier answered a different question from the one the launch team is asking now.

Mei / in the conversation

Our first market is A, and the production design has changed since the version used in the earlier review.

Mei / in the conversation

Engineering proposes moving the connector to the opposite side.

Precision in real exchanges

Purpose: Avoid a shortcut

Useful wording: A different appearance does not by itself establish a design-around.

Purpose: Check the record

Useful wording: We need the current claims and legal status.

D Choose the response that fits

Choose one response for each situation. Preserve the facts, the decision boundary, and the purpose of the exchange.

1. Which launch statement is supported?

- A.** Moving the connector eliminates every risk
- B.** The draft review is an infringement judgment
- C.** Third-party-rights review remains incomplete
- D.** Our patent guarantees launch clearance

2. What is necessary to assess the proposed change?

- A.** The actual revised configuration and relevant claims
- B.** Only a statement that it looks different
- C.** A sales target without drawings
- D.** The company patent cover page alone

3. A colleague needs the term for this meaning: Qualified assessment addressing specified launch or commercial risks. Which term fits?

- A.** working assumption
- B.** commercial clearance
- C.** literal infringement
- D.** continuing application

D Choose the response that fits / continued

4. Rebuild the exchange from "Our own patent does not answer the launch question". Mei: "Our first market is A, and the production design has changed since the version used in the earlier review." Arun: [missing response] Mei: "Engineering proposes moving the connector to the opposite side. The team thinks that should avoid the competitor patent." Which response belongs in the gap?

- A.** Please identify the current product configuration rather than assuming that an earlier drawing still represents what will be sold.
- B.** Ownership gives us a right to exclude within the patent scope. It does not settle whether third-party rights affect our product.
- C.** We need the revised drawings before assessing that design-around. A different appearance does not by itself answer the claim-scope question.
- D.** Good. We can use a claim chart to organize the relevant comparison, subject to proper claim interpretation and legal analysis.

[Answers and explanations, page 137](#)

One useful distinction

A patent confers exclusion rights within its scope; it is not a universal permission to commercialize. Patentability and freedom to operate ask different questions.

Conversation

Our own patent does not answer the launch question

Our own patent does not answer the launch question

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

legal status / territory of interest / design-around / claim chart / review trigger /
product configuration / residual risk / clearance opinion / right to exclude /
freedom to operate

- 01 **Mei:** We own a patent on the enclosure, so I told the launch team that the product is clear to sell in market A.
- 02 **Arun:** Ownership gives us a ¹ _____ within the patent scope. It does not settle whether third-party rights affect our product.
- 03 **Mei:** Then the patentability search we commissioned earlier answered a different question from the one the launch team is asking now.
- 04 **Arun:** Correct. A ² _____ review needs a defined product, activity, territory, and current legal information.
- 05 **Mei:** Our first market is A, and the production design has changed since the version used in the earlier review.
- 06 **Arun:** Please identify the current ³ _____ rather than assuming that an earlier drawing still represents what will be sold.
- 07 **Mei:** Engineering proposes moving the connector to the opposite side. The team thinks that should avoid the competitor patent.
- 08 **Arun:** We need the revised drawings before assessing that ⁴ _____. A different appearance does not by itself answer the claim-scope question.
- 09 **Mei:** I can obtain a controlled drawing and a list of changed components, with the old version retained for comparison.
- 10 **Arun:** Good. We can use a ⁵ _____ to organize the relevant comparison, subject to proper claim interpretation and legal analysis.

Conversation continues on the next page.

Our own patent does not answer the launch question

CONVERSATION / CONTINUED

- 11 **Mei:** The search result includes a granted patent and a related application. Can we treat both as the same right?
- 12 **Arun:** No. Verify the ⁶ _____ and actual claims for each relevant record. Related filings can differ in scope and procedural position.
- 13 **Mei:** We should also make clear that the report is about market A, not every country in the sales forecast.
- 14 **Arun:** Exactly. The ⁷ _____ matters, along with the specified activities and the applicable law.
- 15 **Mei:** Management would like a short answer before the launch meeting, even if several factual questions remain unresolved.
- 16 **Arun:** We can give a concise status, but not label it a completed ⁸ _____ while the configuration and relevant rights are still under review.
- 17 **Mei:** I will replace clear to sell with review ongoing and identify the missing drawing as the engineering team's next action.
- 18 **Arun:** That is accurate. The eventual assessment should also explain any ⁹ _____ within its stated scope rather than promising that no claim can ever arise.
- 19 **Mei:** Once the design is reviewed, I will flag any further connector or channel change before relying on the same conclusion.
- 20 **Arun:** Make that a ¹⁰ _____. A scoped assessment stays useful only when the team knows when its underlying facts have changed.

CHECK THE GAPS

1. right to exclude / 2. freedom to operate / 3. product configuration / 4. design-around / 5. claim chart / 6. legal status / 7. territory of interest / 8. clearance opinion / 9. residual risk / 10. review trigger

[Why these answers fit, page 138](#)

F Check accuracy and scope

Our own patent does not answer the launch question

Return to the case

Product lead Mei says the company can launch its enclosure because it owns a patent. Counsel Arun explains that a separate freedom-to-operate review concerns third-party rights and the actual product configuration in market A. The engineers propose moving a connector but have not supplied revised drawings. No clearance opinion, infringement finding, or design-around conclusion has been issued.

Choose one answer per question. Use the case facts and keep any uncertainty or limits intact.

1. Which scope statement is appropriately bounded?

- A. Any market named in a later slide
- B. This product configuration in market A
- C. Every future product worldwide
- D. All affiliates regardless of design

2. Which event should be flagged for reassessment?

- A. Reprinting the same approved cover page
- B. A material change to the reviewed product
- C. Correcting a non-substantive slide typo
- D. Reordering an internal meeting agenda

[Answers and explanations, page 140](#)

Listen for the distinction

Switch roles and restate the missing information without promising that the connector change avoids any claim.

Separate encouragement from clearance

Acknowledge the value of the company patent while explaining why it does not settle rights held by others. Avoid letting launch pressure broaden an uncompleted review.

F Say it / transfer to a new case

The sales team adds another market

A completed assessment concerns one specified product in market A. Sales now proposes market B, which is outside that assessment.

Complete the four gaps. With a partner, read alternate roles, then switch. Studying alone, read both roles and pause before each response.

WORD AND PHRASE BANK

worldwide / checked / market / scope

- 01 **Sales:** We want to add another ¹ _____.
- 02 **Counsel:** B is outside the existing review ² _____.
- 03 **Sales:** We need the relevant local rights ³ _____.
- 04 **Counsel:** Do not describe the earlier opinion as ⁴ _____ clearance.

CHECK THE GAPS

1. market / 2. scope / 3. checked / 4. worldwide

[Why these answers fit, page 140](#)

Rebuild the exchange

Choose the missing response. Read the completed three-turn exchange aloud, changing roles on the second reading.

1. Rebuild the exchange from "Our own patent does not answer the launch question".
Mei: "We should also make clear that the report is about market A, not every country in the sales forecast." **Arun:** [missing response] **Mei:** "Management would like a short answer before the launch meeting, even if several factual questions remain unresolved."
Which response belongs in the gap?

- A.** Please identify the current product configuration rather than assuming that an earlier drawing still represents what will be sold.
- B.** Exactly. The territory of interest matters, along with the specified activities and the applicable law.
- C.** We need the revised drawings before assessing that design-around. A different appearance does not by itself answer the claim-scope question.
- D.** Correct. A freedom to operate review needs a defined product, activity, territory, and current legal information.

[Answers and explanations, page 141](#)

A Read the situation

LESSON 08 / NEGOTIATING A PATENT-LICENSE TERM SHEET

Clarify grant scope, economic terms, and unresolved conditions during a licensing discussion.

Exclusive in one field is not exclusive everywhere

Licensor representative Nia and prospective licensee Ben review a draft term sheet. It proposes exclusivity for industrial cooling in territory A, with other fields excluded. A royalty percentage is discussed, but the net-sales definition and treatment of returns are unresolved. Sublicensing requires a separately negotiated provision. No agreement has been executed.

People: Ben, Prospective licensee; Nia, Licensor representative.

Read the record

Choose one answer per question using the facts above.

1. What exclusivity is proposed?

- A. Every use worldwide
- B. All fields in A and B
- C. Only an internal evaluation with no commercial rights
- D. Industrial cooling in territory A

2. Which economic issue remains unresolved?

- A. Net-sales definition and returns treatment
- B. Whether any percentage was discussed
- C. Whether Ben is interested
- D. Whether the draft names a territory

3. What is the agreement status?

- A. A court-imposed license
- B. Unexecuted draft terms
- C. A completed worldwide assignment
- D. An executed unrestricted license

[Answers and explanations, page 142](#)

B Vocabulary in use

CORE TERMS

licensor

Party granting rights under a license.

identify the licensor

license grant

Provision specifying licensed rights and limits.

negotiate the license grant

nonexclusive license

License without the specified exclusivity.

distinguish a nonexclusive license

licensed territory

Geographic scope of licensed rights.

define the licensed territory

royalty base

Amount or measure to which the royalty rate applies.

define the royalty base

upfront payment

Payment due at the initial contractual stage.

agree an upfront payment

licensee

Party receiving rights under a license.

identify the licensee

exclusive license

License granting exclusivity as defined by the actual agreement.

define the exclusive license

field of use

Defined application area within a license.

restrict the field of use

sublicense

Permission granted onward under rights allowed by the primary license.

negotiate sublicense rights

net sales

Contract-defined sales measure after specified adjustments.

negotiate net sales

milestone payment

Payment linked to a specified event or achievement.

define a milestone payment

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

licensor LICENSOR

identify the licensor

Keep the meaning precise: Party granting rights under a license.

field of use FIELD OF USE

restrict the field of use

Keep the meaning precise: Defined application area within a license.

B Precision and professional shorthand

EXTEND YOUR RANGE

minimum royalty

Contractual minimum payment under the stated terms.

negotiate a minimum royalty

improvement rights

Contractual treatment of later improvements.

clarify improvement rights

term sheet

Document recording proposed or preliminary commercial terms.

revise the term sheet

clarification request

Question that resolves an unclear meaning or instruction.

make a targeted clarification request

working assumption

Provisional premise used while information is incomplete.

challenge a working assumption

action owner

Named person responsible for a specified next step.

confirm the action owner

audit right

Contractual ability to verify relevant records.

agree audit rights

termination trigger

Event allowing or requiring termination under the agreement.

define a termination trigger

execution

Formal signing or completion under the applicable agreement process.

confirm execution

source attribution

Identification of where information came from.

preserve source attribution

scope boundary

Limit of the work or authority being discussed.

state the scope boundary

check-back

Restatement used to verify that a message was understood.

complete a check-back

Say it in context

Stress the highlighted expression. Keep the surrounding words connected; pause at the end of the phrase.

milestone payment MILESTONE PAYMENT

define a milestone payment

Keep the meaning precise: Payment linked to a specified event or achievement.

term sheet TERM SHEET

revise the term sheet

Keep the meaning precise: Document recording proposed or preliminary commercial terms.

Phrases that move the work forward

Clarify exclusivity

Exclusive for which field and territory?

Separate rate and base

We have discussed the percentage, not settled the amount it applies to.

Trade a specific term

We can discuss that minimum alongside the defined commercial commitment.

Preserve open items

The royalty base and returns treatment remain unresolved.

Ben / in the conversation

Our sales team reads that as permission to use the technology in any product we develop.

Nia / in the conversation

The heading must be read with that limitation and the rest of the grant.

Ben / in the conversation

I assumed the same exclusivity would follow the product wherever it travels.

Ben / in the conversation

We have discussed the percentage, but our finance team cannot calculate the expected payment from the current wording.

Define the economics

Which deductions are included in the net-sales definition?

Check onward rights

Sublicensing needs its own agreed provision.

Keep versions aligned

Please mark the revised grant language in the next draft.

Confirm status

These are proposed terms, not an executed license.

Nia / in the conversation

The proposed field of use is industrial cooling.

Ben / in the conversation

We also plan to sell in market B.

Nia / in the conversation

Any request to include B needs explicit negotiation rather than an assumption from the word exclusive.

Nia / in the conversation

We still need to settle the royalty base, including which sales and adjustments the definition actually covers.

Precision in real exchanges

Purpose: Check onward rights

Useful wording: Sublicensing needs its own agreed provision.

Purpose: Trade a specific term

Useful wording: We can discuss that minimum alongside the defined commercial commitment.

D Choose the response that fits

Choose one response for each situation. Preserve the facts, the decision boundary, and the purpose of the exchange.

1. Which description matches the proposed exclusivity?

- A.** All improvements automatically owned by Ben
- B.** Unlimited sublicensing in every field
- C.** Industrial cooling in A, subject to final terms
- D.** Every commercial use in every territory

2. Why is the percentage alone insufficient?

- A.** A draft percentage establishes every payment date
- B.** The royalty base and return treatment are unresolved
- C.** Percentages cannot be used in licenses
- D.** Territory always determines net sales automatically

3. A colleague needs the term for this meaning: License granting exclusivity as defined by the actual agreement. Which term fits?

- A.** improvement rights
- B.** exclusive license
- C.** royalty base
- D.** working assumption

D Choose the response that fits / continued

4. Rebuild the exchange from "Exclusive in one field is not exclusive everywhere".
Ben: "Understood. We have discussed the percentage, but our finance team cannot calculate the expected payment from the current wording." **Nia:** [missing response]
Ben: "Returns matter for our business. We need the calculation to distinguish invoiced sales from products later returned by customers." **Which response belongs in the gap?**

- A.** Distribution and a sublicense are not interchangeable. Any onward manufacturing rights need the appropriate negotiated provision.
- B.** We still need to settle the royalty base, including which sales and adjustments the definition actually covers.
- C.** The proposed audit right should address the relevant records and conditions, with appropriate confidentiality and practical arrangements.
- D.** We can discuss a milestone payment, but the event, evidence, and payment obligation would need precise agreement.

[Answers and explanations, page 142](#)

One useful distinction

Exclusive must be read with its field, territory, rights, and conditions. A percentage has limited meaning without the agreed royalty base.

E Conversation

Exclusive in one field is not exclusive everywhere

Exclusive in one field is not exclusive everywhere

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

execution / audit right / sublicense / term sheet / field of use / royalty base /
licensed territory / improvement rights / milestone payment / net sales

- 01 **Ben:** The heading says exclusive license. Our sales team reads that as permission to use the technology in any product we develop.
- 02 **Nia:** The proposed ¹ _____ is industrial cooling. The heading must be read with that limitation and the rest of the grant.
- 03 **Ben:** We also plan to sell in market B. I assumed the same exclusivity would follow the product wherever it travels.
- 04 **Nia:** The draft ² _____ is A. Any request to include B needs explicit negotiation rather than an assumption from the word exclusive.
- 05 **Ben:** Understood. We have discussed the percentage, but our finance team cannot calculate the expected payment from the current wording.
- 06 **Nia:** We still need to settle the ³ _____, including which sales and adjustments the definition actually covers.
- 07 **Ben:** Returns matter for our business. We need the calculation to distinguish invoiced sales from products later returned by customers.
- 08 **Nia:** That belongs in the ⁴ _____ definition. We should agree the treatment and timing rather than rely on an undefined accounting shorthand.
- 09 **Ben:** A regional partner would distribute the product and may want rights to manufacture a version for local customers.
- 10 **Nia:** Distribution and a ⁵ _____ are not interchangeable. Any onward manufacturing rights need the appropriate negotiated provision.

Conversation continues on the next page.

Exclusive in one field is not exclusive everywhere

CONVERSATION / CONTINUED

- 11 **Ben:** Could we discuss a lower initial payment if we accept a payment when the first approved product enters commercial production?
- 12 **Nia:** We can discuss a ⁶ _____, but the event, evidence, and payment obligation would need precise agreement.
- 13 **Ben:** Our finance team also wants to know what records we would need to maintain for royalty verification.
- 14 **Nia:** The proposed ⁷ _____ should address the relevant records and conditions, with appropriate confidentiality and practical arrangements.
- 15 **Ben:** We expect to develop improved connectors. I do not want either side to assume ownership or access without discussing it.
- 16 **Nia:** Then include ⁸ _____ as a separate open item, alongside the licensed patents and any other defined subject matter.
- 17 **Ben:** I will send a marked-up version showing our requests on territory, returns, sublicensing, and later improvements.
- 18 **Nia:** Please keep the ⁹ _____ status clear. A discussion of those points does not mean the license has been completed.
- 19 **Ben:** Our closing summary should say that the commercial proposal is progressing, with several specified provisions still unresolved.
- 20 **Nia:** Agreed. Do not describe ¹⁰ _____ as complete. We need the final terms, proper review, and authorized completion before reporting an executed license.

CHECK THE GAPS

1. field of use / 2. licensed territory / 3. royalty base / 4. net sales / 5. sublicense / 6. milestone payment / 7. audit right / 8. improvement rights / 9. term sheet / 10. execution

[Why these answers fit, page 143](#)

F Check accuracy and scope

Exclusive in one field is not exclusive everywhere

Return to the case

Licensor representative Nia and prospective licensee Ben review a draft term sheet. It proposes exclusivity for industrial cooling in territory A, with other fields excluded. A royalty percentage is discussed, but the net-sales definition and treatment of returns are unresolved. Sublicensing requires a separately negotiated provision. No agreement has been executed.

Choose one answer per question. Use the case facts and keep any uncertainty or limits intact.

1. Which request requires separate negotiation here?

- A. Permission to sublicense
- B. Confirmation that a draft exists
- C. Repeating the named field
- D. Recording that returns remain open

2. Which closing summary is accurate?

- A. Proposed grant discussed; economics and sublicensing remain open
- B. All rights granted and payment terms settled
- C. Exclusivity automatically extends outside the field
- D. The term sheet has no possible legal relevance

[Answers and explanations, page 145](#)

Listen for the distinction

Switch roles and list the four requested revisions without treating proposed terms as completed rights.

Narrow the disagreement

Negotiations move forward when each side identifies the specific right or economic assumption it needs. Avoid treating a headline percentage as a complete commercial agreement.

F Say it / transfer to a new case

The rate is unchanged but the base differs

Two draft royalty provisions use the same percentage. Draft A permits specified returns deductions; draft B does not. Neither is approved.

Complete the four gaps. With a partner, read alternate roles, then switch. Studying alone, read both roles and pause before each response.

WORD AND PHRASE BANK

deductions / base / rate / proposed

- 01 **Analyst:** The two drafts use the same ¹ _____.
- 02 **Counsel:** Their royalty ² _____ differs.
- 03 **Analyst:** We must compare the permitted ³ _____.
- 04 **Counsel:** Both provisions remain ⁴ _____.

CHECK THE GAPS

1. rate / 2. base / 3. deductions / 4. proposed

[Why these answers fit, page 145](#)

Rebuild the exchange

Choose the missing response. Read the completed three-turn exchange aloud, changing roles on the second reading.

1. Rebuild the exchange from "Exclusive in one field is not exclusive everywhere". Ben: "Our finance team also wants to know what records we would need to maintain for royalty verification." Nia: [missing response] Ben: "We expect to develop improved connectors. I do not want either side to assume ownership or access without discussing it." Which response belongs in the gap?

- A.** The proposed audit right should address the relevant records and conditions, with appropriate confidentiality and practical arrangements.
- B.** We still need to settle the royalty base, including which sales and adjustments the definition actually covers.
- C.** We can discuss a milestone payment, but the event, evidence, and payment obligation would need precise agreement.
- D.** Distribution and a sublicense are not interchangeable. Any onward manufacturing rights need the appropriate negotiated provision.

[Answers and explanations, page 146](#)

Review 4 / Meaning and context

Use language from the lessons you have completed. Choose one answer per question.

Case file

Revisit "Explaining freedom to operate and design-around questions" and "Negotiating a patent-license term sheet". Choose precise terminology, then reconstruct the missing responses using both neighboring turns. The final two questions also revisit earlier conversations.

1. A colleague needs the term for this meaning: Patent belonging to another party. Which term fits?

- A. pending application
- B. source attribution
- C. claim chart
- D. third-party patent

2. A colleague needs the term for this meaning: Permission granted onward under rights allowed by the primary license. Which term fits?

- A. clarification request
- B. sublicense
- C. minimum royalty
- D. licensor

3. Rebuild the exchange from "An international report is not a worldwide grant". Luis: "Should the board expect exactly the same requirements in each place once the international stage is complete?" Hana: [missing response] Luis: "I have three estimates, but one includes translation and another mentions only the local professional fee." Which response belongs in the gap?

- A. Each local associate should receive the authorized scope, documents, and a request for confirmation of the action taken.
- B. No. The relevant national requirements or regional requirements must be checked with the responsible professionals using current information.
- C. Good. That explains territorial protection without promising grants, inventing deadlines, or treating the application as permission to commercialize everywhere.
- D. We need a specific filing instruction. Evaluation and authorization are different statuses, especially where costs and timing are involved.

Review 4 / Meaning and context / continued

4. Rebuild the exchange from "Exclusive in one field is not exclusive everywhere". Ben: "I will send a marked-up version showing our requests on territory, returns, sublicensing, and later improvements." Nia: [missing response] Ben: "Our closing summary should say that the commercial proposal is progressing, with several specified provisions still unresolved." Which response belongs in the gap?

- A.** The proposed field of use is industrial cooling. The heading must be read with that limitation and the rest of the grant.
- B.** Then include improvement rights as a separate open item, alongside the licensed patents and any other defined subject matter.
- C.** The draft licensed territory is A. Any request to include B needs explicit negotiation rather than an assumption from the word exclusive.
- D.** Please keep the term sheet status clear. A discussion of those points does not mean the license has been completed.

[Answers and explanations, page 153](#)

Language for the next case

Separating inventorship from the ownership record

Inventorship

Inventorship identifies the relevant inventors under the applicable legal test and is not settled merely by who funded the work.

Joel: Correct. Inventorship is not a synonym for funding, employment, or present ownership.

assignment

An assignment is the instrument or transaction transferring the relevant interest, whose actual scope and legal effect require review.

Joel: Yes. Review the actual assignment rather than treating a short database entry as the entire transaction.

entity identification

Entity identification establishes which legal person each document concerns and prevents a name change from being mistaken for an unexplained transfer.

Joel: Preserve the records and obtain the relevant entity identification information rather than assuming that similar names identify the same party.

Recordation

Recordation is the recording step and does not itself establish the validity or ownership effect of the underlying assignment instrument.

Joel: No. Recordation does not supply that substantive conclusion merely because an entry appears in the database.

chain of title

The chain of title traces relevant ownership transfers and requires examination of the actual links rather than a single isolated entry.

Joel: That supports the chain of title review, while keeping the distinction between documents located and ownership conclusions reached.

title assessment

The title assessment is the qualified evaluation of ownership and its supporting documents, not an automatic result of a database search.

Joel: Exactly. The title assessment must follow the evidence and applicable law.

Read the phrases aloud. Then complete the conversation on the following pages using the word bank.

Conversation

Separating inventorship from the ownership record

IP coordinator Mina and counsel Joel review a fictional US patent file. The inventor list names two people. A database shows a recorded assignment, but the underlying instrument and its scope have not been reviewed. Mina initially treats the database entry as proof that every ownership issue is resolved. No conclusion on title or document validity is supplied.

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

Inventorship / chain of title / assignment / entity identification / title assessment /
Recordation

- 01 **Mina:** The patent lists two inventors, while the assignment database names a company. I thought one of those records must be wrong.
- 02 **Joel:** They address different questions. Inventor identity and ownership can differ, and the actual documents need to be examined.
- 03 **Mina:** The company paid for development, but I should not use that fact alone to decide who invented the claimed subject matter.
- 04 **Joel:** Correct. ¹ _____ is not a synonym for funding, employment, or present ownership.
- 05 **Mina:** The database also shows a recorded transfer. Does that mean the office has determined the underlying document is legally valid?
- 06 **Joel:** No. ² _____ does not supply that substantive conclusion merely because an entry appears in the database.

Conversation / continued

- 07 **Mina:** We need the instrument itself, including the parties, subject matter, signatures, and any relevant conditions.
- 08 **Joel:** Yes. Review the actual ³ _____ rather than treating a short database entry as the entire transaction.
- 09 **Mina:** The file contains one scanned document, but I do not know whether it covers both inventors or every relevant application.
- 10 **Joel:** Then those are specific open questions. We should not silently extend the document beyond the parties and rights it actually addresses.

Conversation continues on the next page.

Separating inventorship from the ownership record

CONVERSATION / CONTINUED

- 11 **Mina:** I can assemble the related documents in sequence and mark any missing link instead of declaring the file complete.
- 12 **Joel:** That supports the ⁴ _____ review, while keeping the distinction between documents located and ownership conclusions reached.
- 13 **Mina:** One company name also changed after a reorganization. The folder uses both names without explaining the relationship.
- 14 **Joel:** Preserve the records and obtain the relevant ⁵ _____ information rather than assuming that similar names identify the same party.
- 15 **Mina:** The business team wants a short status for diligence. I can say the entry was found but the instrument is still being reviewed.
- 16 **Joel:** That is accurate and tells them what remains unresolved without implying a defect that has not been established either.
- 17 **Mina:** We should avoid both extremes: guaranteed clean title and an unsupported assertion that the company owns nothing.
- 18 **Joel:** Exactly. The ⁶ _____ must follow the evidence and applicable law.
- 19 **Mina:** I will supply the inventor record, database entry, underlying instrument, and entity documents as separate labeled items.
- 20 **Joel:** Then the review can address the actual questions without confusing invention, transfer, recording, and present ownership in one headline.

CHECK THE GAPS

1. Inventorship / **2.** Recordation / **3.** assignment / **4.** chain of title / **5.** entity identification / **6.** title assessment

[Why these answers fit, page 155](#)

Recorded became legally validated

A status note says a database entry proves an assignment is valid. The instrument has not been reviewed.

Complete the exchange using each phrase once. Read both roles, then switch roles and repeat with the bank covered.

WORD AND PHRASE BANK

recordation / instrument / validity / qualified

- 01 **Coordinator:** The database shows ¹ _____.
- 02 **Counsel:** The underlying ² _____ still needs review.
- 03 **Coordinator:** The note overstated legal ³ _____.
- 04 **Counsel:** Keep the ownership conclusion ⁴ _____.

CHECK THE GAPS

1. recordation / 2. instrument / 3. validity / 4. qualified

[Why these answers fit, page 155](#)

Keep the distinction audible

Explain a document gap without confusing inventor identity, assignment, recordation, and ownership.

Language for the next case

Verifying a patent-renewal payment request

solicitation

A solicitation can use public patent details without being an official fee notice, so appearance alone does not establish authority.

Suri: Those details may be public. An official-looking solicitation is not proof that the sender is the patent office or our authorized provider.

trusted contact

A trusted contact is verified independently of the suspicious request, reducing reliance on contact details supplied by the same unverified sender.

Suri: Use an independently verified trusted contact to confirm the matter under our normal controls.

verification record

The verification record preserves the source, finding, and authorized next action rather than leaving only a vague assurance that someone checked.

Suri: Maintain that verification record so accounts and the patent team rely on the same confirmed information.

maintenance status

Maintenance status concerns the real patent record and obligations, which remain a separate question from whether the received letter is authentic.

Suri: Exactly. Verify the actual maintenance status through known official channels and the responsible patent professional.

payment authorization

Payment authorization must follow the actual approved process and cannot be inferred from urgency or an official-looking design.

Suri: Good. The payment authorization needs to come through the established process after the obligation and payee are checked.

payment confirmation

Payment confirmation is evidence of the actual completed payment, not the original request or an internal intention to pay.

Suri: Yes, and the payment confirmation should remain distinct from the request, authorization, and filing or maintenance status.

Read the phrases aloud. Then complete the conversation on the following pages using the word bank.

Conversation

Verifying a patent-renewal payment request

Accounts officer Alex receives a letter headed urgent patent cancellation notice. It names the correct patent but comes from an unfamiliar private sender and requests payment through a link. Patent administrator Suri has not verified the sender or the real maintenance status. They route the request through known official and professional channels without assuming that the patent has no genuine deadline.

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

maintenance status / verification record / payment authorization / trusted contact /
payment confirmation / solicitation

- 01 **Alex:** This letter names our patent and says urgent cancellation notice. Should I pay through the link before we lose the rights?
- 02 **Suri:** Do not treat the heading or correct patent number as authentication. We need to verify the sender and the actual obligation.
- 03 **Alex:** The sender is a private organization I do not recognize, but the letter uses formal language and details from the patent record.
- 04 **Suri:** Those details may be public. An official-looking ¹ _____ is not proof that the sender is the patent office or our authorized provider.
- 05 **Alex:** I will not use the supplied payment link while the request remains unverified. What information should I send you?
- 06 **Suri:** Preserve the letter and sender details through our approved reporting process, without sharing credentials or making an unverified payment.

Conversation / continued

- 07 **Alex:** We should separately check whether a genuine maintenance obligation exists, even if this particular request is questionable.
- 08 **Suri:** Exactly. Verify the actual ² _____ through known official channels and the responsible patent professional.
- 09 **Alex:** The accounts system has a contact from our previous legitimate instruction, rather than the phone number printed in this letter.
- 10 **Suri:** Use an independently verified ³ _____ to confirm the matter under our normal controls.

Conversation continues on the next page.

Verifying a patent-renewal payment request

CONVERSATION / CONTINUED

- 11 **Alex:** I can flag the request as unverified rather than mark it paid or dismiss every possible deadline.
- 12 **Suri:** Good. The ⁴ _____ needs to come through the established process after the obligation and payee are checked.
- 13 **Alex:** The letter's urgency made me assume that asking questions would itself cause a loss of rights.
- 14 **Suri:** Prompt verification matters, but urgency should not bypass controls or turn an unverified demand into a confirmed obligation.
- 15 **Alex:** Once you have checked, we should record the source used and any real action the responsible professional instructs.
- 16 **Suri:** Maintain that ⁵ _____ so accounts and the patent team rely on the same confirmed information.
- 17 **Alex:** If a payment is genuinely required, the team will use the approved route and retain the actual receipt.
- 18 **Suri:** Yes, and the ⁶ _____ should remain distinct from the request, authorization, and filing or maintenance status.
- 19 **Alex:** I will route the letter now, keep the real timing question visible, and avoid using the unverified link.
- 20 **Suri:** That addresses both risks: an improper payment and a genuine obligation being overlooked while the suspicious request is investigated.

CHECK THE GAPS

1. solicitation / 2. maintenance status / 3. trusted contact / 4. payment authorization / 5. verification record / 6. payment confirmation

[Why these answers fit, page 157](#)

Correct details do not authenticate a sender

An unfamiliar letter includes the correct patent number but has not been verified. The actual maintenance status also needs checking.

Complete the exchange using each phrase once. Read both roles, then switch roles and repeat with the bank covered.

WORD AND PHRASE BANK

channel / check / unverified / controls

- 01 **Accounts:** The patent number is correct, but the sender is ¹ _____.
- 02 **Administrator:** Use an independently verified ² _____.
- 03 **Accounts:** The real maintenance obligation needs a separate ³ _____.
- 04 **Administrator:** Do not bypass payment ⁴ _____ because of urgency.

CHECK THE GAPS

1. unverified / 2. channel / 3. check / 4. controls

[Why these answers fit, page 157](#)

Keep the distinction audible

Challenge an official-looking request while keeping genuine maintenance obligations visible.

Language for the next case

Resolving a material patent-translation query

quantifier discrepancy

The quantifier discrepancy changes the stated numerical range, so it needs substantive review rather than a silent stylistic correction.

Rosa: That quantifier discrepancy needs an explicit query before we settle the reviewed text.

translation query

A translation query identifies a specific discrepancy for authorized resolution without granting the translator authority to choose the legal scope.

Rosa: That is a useful translation query. It lets the technical and patent reviewers answer the actual question.

controlled revision

A controlled revision makes the authorized change traceable and preserves the relationship between the approved instruction and revised text.

Rosa: Use a controlled revision that preserves what changed, who approved it, and which passages were checked.

source wording

The source wording is the actual expression being translated and must remain available while the intended meaning and legal implications are reviewed.

Rosa: Correct. Preserve the source wording and do not quietly rewrite either version to match your preferred interpretation.

version label

The version label should reflect the actual review status rather than imply final approval while material questions remain unresolved.

Rosa: Correct the version label so nobody mistakes a working translation for approved filing text.

terminology check

The terminology check verifies consistent use within its stated scope and complements, rather than replaces, the substantive quantifier review.

Rosa: Then the terminology check can be reviewed separately from the decision about the numerical wording.

Read the phrases aloud. Then complete the conversation on the following pages using the word bank.

Conversation

Resolving a material patent-translation query

Translator Aiko compares a source draft saying at least two channels with a translation saying exactly two channels. The text is being prepared for professional review; no filing has occurred. Patent professional Rosa needs the discrepancy raised explicitly. Aiko can explain the linguistic difference but cannot independently decide the final claim scope or legal filing strategy.

Complete the numbered gaps. Use each bank entry once; some entries contain several words.

WORD AND PHRASE BANK

controlled revision / source wording / version label / quantifier discrepancy /
translation query / terminology check

- 01 **Aiko:** I found a scope difference in the draft. The source says at least two channels, but the translation says exactly two.
- 02 **Rosa:** Please identify the exact sentence and version. Those expressions are not stylistic alternatives with the same numerical meaning.
- 03 **Aiko:** At least two permits two or more in ordinary numerical language, while exactly two restricts the count to two.
- 04 **Rosa:** That ¹ _____ needs an explicit query before we settle the reviewed text.
- 05 **Aiko:** I can explain the language issue without deciding whether the final patent claim should use the broader or narrower expression.
- 06 **Rosa:** Correct. Preserve the ² _____ and do not quietly rewrite either version to match your preferred interpretation.

Conversation / continued

- 07 **Aiko:** The engineering drawing shows two channels, but that alone does not tell me which quantifier the drafter intended.
- 08 **Rosa:** Good distinction. A pictured example and the intended wording need to be checked against the relevant disclosure and drafting instructions.
- 09 **Aiko:** I will attach the short source passage, translated passage, and explanation of the difference in ordinary English.
- 10 **Rosa:** That is a useful ³ _____. It lets the technical and patent reviewers answer the actual question.

Conversation continues on the next page.

Resolving a material patent-translation query

CONVERSATION / CONTINUED

- 11 **Aiko:** The file name currently says final, although this issue and several terminology questions are still open.
- 12 **Rosa:** Correct the ⁴ _____ so nobody mistakes a working translation for approved filing text.
- 13 **Aiko:** Once the reviewers confirm the intended expression, I can apply the authorized wording and check related occurrences.
- 14 **Rosa:** Use a ⁵ _____ that preserves what changed, who approved it, and which passages were checked.
- 15 **Aiko:** We should also check whether the same quantifier appears in the summary or dependent claims, rather than correcting only one line.
- 16 **Rosa:** Yes, but report the actual review coverage instead of claiming that every possible language issue has been eliminated.
- 17 **Aiko:** After the check, I will return both a marked version and a clean version with the same date and identifier.
- 18 **Rosa:** Then the ⁶ _____ can be reviewed separately from the decision about the numerical wording.
- 19 **Aiko:** The delivery note will say the identified query was resolved under instruction, not that I independently certified patent scope.
- 20 **Rosa:** Exactly. Accurate translation supports the legal process while keeping linguistic explanation, technical intent, and legal authority distinct.

CHECK THE GAPS

1. quantifier discrepancy / 2. source wording / 3. translation query / 4. version label / 5. controlled revision / 6. terminology check

[Why these answers fit, page 159](#)

At least became at most

A source draft says at least three sensors. Its translation says at most three sensors. No instruction authorizes changing the numerical relationship.

Complete the exchange using each phrase once. Read both roles, then switch roles and repeat with the bank covered.

WORD AND PHRASE BANK

limit / traceable / bound / query

- 01 **Translator:** At least sets a lower ¹ _____.
- 02 **Reviewer:** At most sets an upper ² _____.
- 03 **Translator:** The difference needs an explicit ³ _____.
- 04 **Reviewer:** Keep both original versions ⁴ _____.

CHECK THE GAPS

1. bound / 2. limit / 3. query / 4. traceable

[Why these answers fit, page 159](#)

Keep the distinction audible

Explain a quantifier discrepancy and preserve version control without silently changing technical scope.

01 / Answers and explanations

A / Read the situation

A1. What change is described in the enclosure?

A. A curved coolant channel

The supplied mechanism concerns a curved coolant channel in the prototype enclosure.

[Return to the exercise, page 4](#)

A2. What is known about Leo?

B. He built the prototype and suggested a connector

The brief identifies construction and a connector suggestion without deciding inventorship.

[Return to the exercise, page 4](#)

A3. What limits the cooling-time comparison?

D. The test conditions have not been compared

A single internal result cannot establish a controlled comparison without checking conditions.

[Return to the exercise, page 4](#)

D / Response choices

D1. Which question is least leading?

B. Who proposed the connector, and when?

The neutral question elicits contribution facts without suggesting the desired legal conclusion.

[Return to the exercise, page 8](#)

D2. Which test summary is supported?

B. A shorter cooling time was reported in one test

The brief supplies a reported result but no verified causal or controlled comparison.

[Return to the exercise, page 8](#)

01 / Answers and explanations / continued

D3. A colleague needs the term for this meaning: Formation of the inventive idea under the applicable legal test. Which term fits?

B. conception

A Not here. baseline configuration: Reference arrangement used for comparison. The usual combination is "identify the baseline configuration".

B Correct. conception: Formation of the inventive idea under the applicable legal test. The usual combination is "investigate contribution to conception".

C Not here. embodiment: Particular implementation described for an invention. The usual combination is "describe an embodiment".

D Not here. working assumption: Provisional premise used while information is incomplete. The usual combination is "challenge a working assumption".

[Return to the exercise, page 8](#)

D4. Rebuild the exchange from "The improvement is a channel, not simply faster cooling". Amira: "One internal test showed a shorter cooling time. I have not checked whether both tests used the same starting temperature." Daniel: [missing response] Amira: "Leo built the enclosure from my drawings, but he suggested making the connector detachable for easier assembly." Which response belongs in the gap?

B. Then we need the baseline configuration and test conditions before describing the result as a controlled improvement.

A Not here. This line belongs to turn 10, after Amira says: "Should I list only senior engineers as inventors? Leo is a technician and did not present the project to management." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Daniel's response in turn 6. It connects Amira's preceding point with Amira's follow-up. The baseline configuration is the reference arrangement needed to interpret the comparison rather than assuming comparable conditions.

C Not here. This line belongs to turn 18, after Amira says: "Marketing wants to show the prototype at a public event next month. I have not approved that request." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 12, after Amira says: "I also sketched a straight channel with a baffle, although we have not built that version yet." It addresses that point, not the missing turn in the supplied exchange.

[Return to the exercise, page 8](#)

E / Conversation

1. technical problem

Turn 2. The technical problem identifies the difficulty addressed rather than substituting a marketing benefit for the mechanism.

01 / Answers and explanations / continued

2. causal mechanism

Turn 4. The causal mechanism connects the arrangement to the proposed effect while leaving performance evidence open to review.

3. baseline configuration

Turn 6. The baseline configuration is the reference arrangement needed to interpret the comparison rather than assuming comparable conditions.

4. contribution record

Turn 8. The contribution record preserves who proposed each feature without prematurely deciding the legal inventorship question.

5. inventorship

Turn 10. Inventorship requires the applicable legal assessment of contributions, not a ranking by seniority or presentation role.

6. alternative configuration

Turn 12. An alternative configuration is another arrangement that should be identified accurately, including whether it was constructed or tested.

7. embodiment

Turn 14. An embodiment is a particular implementation, so the tested version must remain distinct from an untested proposed arrangement.

8. laboratory notebook

Turn 16. The laboratory notebook contains contemporaneous development evidence and should be preserved rather than rewritten to fit a preferred account.

9. public disclosure

Turn 18. Public disclosure can have patent consequences under actual law and facts, so the plan requires prompt qualified review.

10. invention disclosure

Turn 20. The invention disclosure organizes the technical facts and development history without itself establishing patentability or inventorship.

[Return to the conversation, page 10](#)

01 / Answers and explanations / continued

F / Accuracy and scope

F1. What should the interview capture about alternatives?

A. How a straight channel would change the mechanism

Explaining alternatives identifies technical relationships without inventing evidence or legal conclusions.

[Return to the exercise, page 12](#)

F2. Which status is accurate?

C. Inventorship remains for qualified assessment

The interview gathers facts without establishing the applicable legal inventorship outcome.

[Return to the exercise, page 12](#)

F / Guided speaking

1. configuration

Engineer: This is an alternative configuration.

Turn 1. The sketch depicts another arrangement, not an established test outcome.

2. untested

Reviewer: Its performance remains untested.

Turn 2. The brief states that no construction or testing has occurred.

3. sketch

Engineer: I will preserve the dated sketch.

Turn 3. The dated drawing is the supplied development record for this version.

4. hypothesis

Reviewer: Describe the expected effect as a hypothesis.

Turn 4. An expected untested effect is a proposition to investigate, not a measured result.

[Return to the conversation, page 13](#)

01 / Answers and explanations / continued

F / Rebuild the exchange

1. Rebuild the exchange from "The improvement is a channel, not simply faster cooling". Amira: "The curved version is the one we built. The straight version remains a drawing, with no performance measurements." Daniel: [missing response] Amira: "The notebook contains dated sketches and build notes. I can collect those without rewriting the original entries." Which response belongs in the gap?

C. Identify each embodiment separately and avoid implying that the untested version produced the reported data.

A Not here. This line belongs to turn 12, after Amira says: "I also sketched a straight channel with a baffle, although we have not built that version yet." It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 4, after Amira says: "Fluid bypasses part of the enclosure. The curved channel takes it around that area instead of directly to the outlet." It addresses that point, not the missing turn in the supplied exchange.

C Correct. This is Daniel's response in turn 14. It connects Amira's preceding point with Amira's follow-up. An embodiment is a particular implementation, so the tested version must remain distinct from an untested proposed arrangement.

D Not here. This line belongs to turn 18, after Amira says: "Marketing wants to show the prototype at a public event next month. I have not approved that request." It addresses that point, not the missing turn in the supplied exchange.

[Return to the exercise, page 13](#)

02 / Answers and explanations

A / Read the situation

A1. Which feature has not been located in R?

D. The detachable connector

Noor found the housing and channel but has not located the connector in R.

[Return to the exercise, page 14](#)

A2. Where is a connector mentioned?

A. S, in a different device

The facts place the connector in S without establishing its presence in R.

[Return to the exercise, page 14](#)

A3. What remains to be reviewed?

C. Dates and legal relevance

The case expressly leaves dates and legal significance unresolved for review.

[Return to the exercise, page 14](#)

D / Response choices

D1. Which report sentence is supported?

C. R describes two features; its connector remains unlocated

The findings support a limited account of R, not a universal legal conclusion.

[Return to the exercise, page 18](#)

D2. What makes feature mapping traceable?

B. Pinpoint passages or figures for each feature

Pinpoint support lets reviewers check each proposed mapping against the actual source.

[Return to the exercise, page 18](#)

02 / Answers and explanations / continued

D3. A colleague needs the term for this meaning: US patentability requirement concerning obviousness under applicable law. Which term fits?

B. nonobviousness

A Not here. non-patent literature: Relevant material outside patent documents. The usual combination is "search non-patent literature".

B Correct. nonobviousness: US patentability requirement concerning obviousness under applicable law. The usual combination is "evaluate nonobviousness".

C Not here. working assumption: Provisional premise used while information is incomplete. The usual combination is "challenge a working assumption".

D Not here. priority date: Claimed earlier date whose legal effect requires assessment. The usual combination is "check the priority date".

[Return to the exercise, page 18](#)

D4. Rebuild the exchange from "One reference matches two features, not the entire claim". Noor: "Reference S mentions a detachable connector, although its device is different and the function is not described in the same way." Ethan: [missing response] Noor: "Could the two documents still raise a problem if neither appears to describe the entire draft combination alone?" Which response belongs in the gap?

B. Keep the reference document identities separate. We should not move a feature from S into the column describing R.

A Not here. This line belongs to turn 4, after Noor says: "The housing is in paragraph twelve and the channel in figure three, but I have not located the detachable connector." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Ethan's response in turn 6. It connects Noor's preceding point with Noor's follow-up. Each reference document must remain separately identified so that a feature from S is not silently attributed to R.

C Not here. This line belongs to turn 8, after Noor says: "Could the two documents still raise a problem if neither appears to describe the entire draft combination alone?" It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 10, after Noor says: "I will describe the potential combination without saying that it automatically defeats the claim under every legal system." It addresses that point, not the missing turn in the supplied exchange.

[Return to the exercise, page 18](#)

E / Conversation

1. feature mapping

Turn 2. Feature mapping links each claimed element to identified source material instead of equating overall similarity with complete disclosure.

02 / Answers and explanations / continued

2. search limitation

Turn 4. The search limitation states what has not been established and prevents an incomplete finding from becoming proof of absence.

3. reference document

Turn 6. Each reference document must remain separately identified so that a feature from S is not silently attributed to R.

4. nonobviousness

Turn 8. Nonobviousness concerns a distinct patentability analysis under US law, not automatic treatment of multiple documents as one disclosure.

5. combination rationale

Turn 10. A combination rationale supplies reasoning for considering teachings together and must be assessed under the relevant legal test.

6. publication date

Turn 12. The publication date identifies publication and must not be confused with other dates whose legal effect may differ.

7. patent family

Turn 14. A patent family groups related filings but does not establish identical claims or legal status for every member.

8. search scope

Turn 16. Search scope identifies actual coverage and makes the limits visible to readers interpreting the findings.

9. novelty

Turn 18. Novelty is a specific patentability question, so the search summary must not become a broad commercial-clearance conclusion.

10. disclosure passage

Turn 20. The disclosure passage allows direct verification of each proposed feature mapping rather than reliance on an unsupported summary.

[Return to the conversation, page 20](#)

02 / Answers and explanations / continued

F / Accuracy and scope

F1. What must an R-plus-S argument address?

D. Applicable combination analysis and its factual basis

A combination argument requires appropriate legal reasoning rather than automatic aggregation.

[Return to the exercise, page 22](#)

F2. Which statement fairly describes an unsuccessful search?

B. No close result was located within the stated scope

A search result is bounded by coverage and does not establish universal patentability or clearance.

[Return to the exercise, page 22](#)

F / Guided speaking

1. figure

Reviewer: The abstract search did not identify this figure.

Turn 1. The new finding is a figure, not a completed legal conclusion.

2. disclosure

Counsel: Check the complete disclosure before mapping the feature.

Turn 2. The mapping needs actual disclosed material rather than an abstract-only impression.

3. verified

Reviewer: The relevant date remains to be verified.

Turn 3. The brief expressly leaves the relevant legal timing unresolved.

4. scope

Counsel: Update the report and preserve its stated scope.

Turn 4. The new finding improves the report without creating an unlimited search guarantee.

[Return to the conversation, page 23](#)

02 / Answers and explanations / continued

F / Rebuild the exchange

1. Rebuild the exchange from "One reference matches two features, not the entire claim". Noor: "Some results are related filings with different claims. I grouped them together to keep the report shorter." Ethan: [missing response] Noor: "We covered two databases, three classification groups, and synonyms for coolant routing, but not every technical publication." Which response belongs in the gap?

B. A patent family can organize results, but the actual document and claim version must remain identifiable.

A Not here. This line belongs to turn 12, after Noor says: "The database gives several dates. I copied the earliest number without identifying what that date represents." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Ethan's response in turn 14. It connects Noor's preceding point with Noor's follow-up. A patent family groups related filings but does not establish identical claims or legal status for every member.

C Not here. This line belongs to turn 8, after Noor says: "Could the two documents still raise a problem if neither appears to describe the entire draft combination alone?" It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 2, after Noor says: "Reference R looks close. It shows a housing and curved channel, which are both in our current draft claim." It addresses that point, not the missing turn in the supplied exchange.

[Return to the exercise, page 23](#)

03 / Answers and explanations

A / Read the situation

A1. What does claim 2 add in this example?

B. A detachable connector to the inherited requirements

The simplified dependency expressly carries forward claim 1 and adds the connector.

[Return to the exercise, page 26](#)

A2. What is unclear about the valve wording?

D. Which earlier element the term identifies

The definite phrase has no clear earlier introduction identifying the intended element.

[Return to the exercise, page 26](#)

A3. What is the document status?

C. An unfiled drafting example

The case explicitly describes unfiled examples rather than granted or adjudicated claims.

[Return to the exercise, page 26](#)

D / Response choices

D1. Which paraphrase matches the supplied claim 2?

A. A housing and channel with the added connector

The stated dependency retains claim 1 requirements and adds the connector.

[Return to the exercise, page 30](#)

D2. Which question addresses antecedent basis?

A. Where is the valve first identified?

Antecedent basis concerns the earlier identification of the later referenced element.

[Return to the exercise, page 30](#)

03 / Answers and explanations / continued

D3. A colleague needs the term for this meaning: Relationship linking a dependent claim to another claim. Which term fits?

D. claim dependency

A Not here. working assumption: Provisional premise used while information is incomplete. The usual combination is "challenge a working assumption".

B Not here. transitional phrase: Wording connecting claim introduction and body with legal significance. The usual combination is "select the transitional phrase".

C Not here. further limitation: Additional restriction in a dependent claim. The usual combination is "introduce a further limitation".

D Correct. claim dependency: Relationship linking a dependent claim to another claim. The usual combination is "check claim dependency".

[Return to the exercise, page 30](#)

D4. Rebuild the exchange from "The dependent claim adds a feature". Priya: "I had treated the numbered claims like a menu where the reader chooses one component and ignores the others." Marcus: [missing response] Priya: "Would a claim covering only the connector need to be drafted differently and checked against the original disclosure?" Which response belongs in the gap?

D. Think in terms of each claim limitation. We must identify all the requirements in the particular claim under discussion.

A Not here. This line belongs to turn 8, after Priya says: "Would a claim covering only the connector need to be drafted differently and checked against the original disclosure?" It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 10, after Priya says: "I also noticed the phrase the valve near the end, but I could not find a valve introduced earlier." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 14, after Priya says: "Could I simplify comprising to consisting of? The second phrase sounds more natural to me in ordinary English." It addresses that point, not the missing turn in the supplied exchange.

D Correct. This is Marcus's response in turn 6. It connects Priya's preceding point with Priya's follow-up. A claim limitation is a requirement of the claimed combination, not a menu item that can be omitted at will.

[Return to the exercise, page 30](#)

E / Conversation

1. dependent claim

Turn 2. A dependent claim retains the referenced requirements and adds a limitation rather than protecting the added element in isolation.

03 / Answers and explanations / continued

2. claim dependency

Turn 4. Claim dependency identifies the relationship that carries the earlier requirements into the dependent claim.

3. claim limitation

Turn 6. A claim limitation is a requirement of the claimed combination, not a menu item that can be omitted at will.

4. independent claim

Turn 8. An independent claim does not depend on another claim, but its drafting and legal support still require assessment.

5. antecedent basis

Turn 10. Antecedent basis concerns the earlier identification needed to make the later reference to the valve clear.

6. structural limitation

Turn 12. A structural limitation describes the physical element or arrangement, which must match the intended supported feature.

7. transitional phrase

Turn 14. A transitional phrase can affect legal scope, so these expressions must not be exchanged as stylistic synonyms.

8. claim construction

Turn 16. Claim construction is the legal interpretation of scope, not an informal engineering paraphrase.

9. claim tree

Turn 18. A claim tree displays dependencies and helps readers see which requirements are inherited by later claims.

10. fallback position

Turn 20. A fallback position is a narrower supported position for consideration, not a guarantee of patentability or protection.

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03 / Answers and explanations / continued

F / Accuracy and scope

F1. What should a plain-language paraphrase avoid?

B. Silently dropping inherited limitations

Dropping inherited limitations would change the supplied combination and mislead the technical reader.

[Return to the exercise, page 34](#)

F2. Which change requires substantive review rather than casual editing?

B. Replacing comprising with consisting of

Transitional phrases can affect legal scope and are not interchangeable stylistic choices.

[Return to the exercise, page 34](#)

F / Guided speaking

1. requirements

Engineer: Claim 3 inherits the earlier requirements.

Turn 1. The stated dependency retains the requirements already included in claim 2.

2. limitation

Reviewer: The sensor is an additional limitation.

Turn 2. The new sensor adds a requirement to the inherited combination.

3. connector

Engineer: It does not replace the connector.

Turn 3. The connector remains part of claim 2 and is inherited by claim 3.

4. tree

Reviewer: Show that relationship in the claim tree.

Turn 4. A claim tree represents the dependency relationship described in the example.

[Return to the conversation, page 35](#)

03 / Answers and explanations / continued

F / Rebuild the exchange

1. Rebuild the exchange from "The dependent claim adds a feature". Priya: "Could I simplify comprising to consisting of? The second phrase sounds more natural to me in ordinary English." Marcus: [missing response] Priya: "I will leave the operative wording intact and add a separate plain-English explanation for the engineering meeting." Which response belongs in the gap?

D. Do not change that transitional phrase for style alone. The legal effect needs deliberate review under the applicable law.

A Not here. This line belongs to turn 6, after Priya says: "I had treated the numbered claims like a menu where the reader chooses one component and ignores the others." It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 10, after Priya says: "I also noticed the phrase the valve near the end, but I could not find a valve introduced earlier." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 8, after Priya says: "Would a claim covering only the connector need to be drafted differently and checked against the original disclosure?" It addresses that point, not the missing turn in the supplied exchange.

D Correct. This is Marcus's response in turn 14. It connects Priya's preceding point with Priya's follow-up. A transitional phrase can affect legal scope, so these expressions must not be exchanged as stylistic synonyms.

[Return to the exercise, page 35](#)

04 / Answers and explanations

A / Read the situation

A1. Which feature appears in the filed disclosure as described?

D. A mechanical bypass

The brief identifies a mechanical bypass as the feature described at filing.

[Return to the exercise, page 36](#)

A2. What is Sofia proposing?

C. Adding the later controller as a clarification

She wants to insert the later controller while describing the change as clarification.

[Return to the exercise, page 36](#)

A3. What has Ravi established?

D. He has not located support in the filed materials

The supplied finding is lack of located support, not a final legal or filing decision.

[Return to the exercise, page 36](#)

D / Response choices

D1. What would most directly support the proposed wording?

A. A verified relevant passage or drawing in the filed disclosure

Support must be assessed against the relevant original disclosure, not supplied by a label.

[Return to the exercise, page 40](#)

D2. Which summary avoids hindsight?

B. The controller is later developed and support is unlocated

The supplied facts distinguish later development from the unresolved original-support question.

[Return to the exercise, page 40](#)

04 / Answers and explanations / continued

D3. A colleague needs the term for this meaning: Sufficiency of teaching under the applicable legal standard. Which term fits?

A. enablement

A Correct. enablement: Sufficiency of teaching under the applicable legal standard. The usual combination is "evaluate enablement".

B Not here. working assumption: Provisional premise used while information is incomplete. The usual combination is "challenge a working assumption".

C Not here. clean copy: Version showing text without visible change markings. The usual combination is "compare the clean copy".

D Not here. later-developed feature: Feature developed after the earlier document or filing. The usual combination is "distinguish a later-developed feature".

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D4. Rebuild the exchange from "The new controller was developed after filing". Sofia: "I found a broad sentence saying that flow may be controlled. Would that automatically support any electronic implementation?" Ravi: [missing response] Sofia: "I can show the exact sentence and the drawing it references, instead of sending only the revised paragraph." Which response belongs in the gap?

A. Not automatically. We need a proper written description analysis rather than assuming a general result discloses every way of achieving it.

A Correct. This is Ravi's response in turn 6. It connects Sofia's preceding point with Sofia's follow-up. Written description asks whether the relevant disclosure supports the claimed subject matter under the applicable legal standard.

B Not here. This line belongs to turn 4, after Sofia says: "The controller performs a related purpose, but we developed its arrangement after the filing and drew a new circuit diagram." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 2, after Sofia says: "The latest prototype uses an electronic controller. Can we add it to the pending application as a clarification of the bypass?" It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 14, after Sofia says: "Would a table listing each proposed phrase beside its original source help you identify the unsupported parts?" It addresses that point, not the missing turn in the supplied exchange.

[Return to the exercise, page 40](#)

E / Conversation

1. application as filed

Turn 2. The application as filed is the historical disclosure against which the proposed addition must be assessed.

04 / Answers and explanations / continued

2. later-developed feature

Turn 4. A later-developed feature must remain distinguishable from what was actually disclosed in the earlier filing.

3. written description

Turn 6. Written description asks whether the relevant disclosure supports the claimed subject matter under the applicable legal standard.

4. support citation

Turn 8. A support citation points to the specific original material on which the proposed wording relies.

5. filed drawing

Turn 10. The filed drawing is part of the historical application record and must not be overwritten by a later engineering version.

6. new matter

Turn 12. New matter concerns impermissible added subject matter under applicable rules and cannot be avoided merely by calling an addition clarification.

7. support matrix

Turn 14. A support matrix links each proposed phrase to its claimed original basis and exposes missing or disputed support.

8. marked-up copy

Turn 16. A marked-up copy visibly identifies proposed changes so reviewers can assess their substance against the existing text.

9. priority entitlement

Turn 18. Priority entitlement depends on the applicable requirements and supported subject matter, not merely on improving the same product.

10. filing strategy

Turn 20. Filing strategy evaluates appropriate available routes after considering the actual disclosure, dates, jurisdictions, and legal requirements.

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04 / Answers and explanations / continued

F / Accuracy and scope

F1. Why keep a marked-up copy?

D. To make proposed wording changes visible for review

Visible changes help reviewers assess additions without altering the historical filed document.

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F2. Which action is appropriate now?

A. Review support and available filing options with counsel

Qualified review must resolve support and options before the team assumes a permissible filing step.

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F / Guided speaking

1. filed

Reviewer: Please attach the original filed drawing.

Turn 1. The historical filed drawing is needed to compare the proposed changes.

2. comparison

Engineer: I will also supply the change comparison.

Turn 2. A change comparison makes the differences visible for review.

3. support

Reviewer: The clean version alone does not establish support.

Turn 3. A revised drawing does not itself prove support in the original disclosure.

4. review

Engineer: The proposed revision remains under review.

Turn 4. No approval or completed support assessment is supplied in the scenario.

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04 / Answers and explanations / continued

F / Rebuild the exchange

1. Rebuild the exchange from "The new controller was developed after filing". Sofia: "Would a table listing each proposed phrase beside its original source help you identify the unsupported parts?" Ravi: [missing response] Sofia: "I will also keep a version showing insertions and deletions, so the technical and legal reviewers see the same changes." Which response belongs in the gap?

A. Yes. A support matrix makes both positive citations and unresolved gaps visible without concealing them in a clean draft.

A Correct. This is Ravi's response in turn 14. It connects Sofia's preceding point with Sofia's follow-up. A support matrix links each proposed phrase to its claimed original basis and exposes missing or disputed support.

B Not here. This line belongs to turn 2, after Sofia says: "The latest prototype uses an electronic controller. Can we add it to the pending application as a clarification of the bypass?" It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 4, after Sofia says: "The controller performs a related purpose, but we developed its arrangement after the filing and drew a new circuit diagram." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 8, after Sofia says: "I can show the exact sentence and the drawing it references, instead of sending only the revised paragraph." It addresses that point, not the missing turn in the supplied exchange.

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05 / Answers and explanations

A / Read the situation

A1. What does the notice address?

A. A prior-art rejection and a separate clarity issue

The case identifies a claim rejection and a separate concern about a term.

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A2. How should the examiner position be attributed?

C. The examiner states the cited mapping

The position comes from the office action and should not be turned into a different conclusion.

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A3. Which source controls the response timing?

B. The actual notice and applicable procedure

The brief supplies no date and directs timing to the actual notice and procedure.

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D / Response choices

D1. Which client update is accurate?

C. The office action raises prior-art and clarity issues for response

The notice concerns examination issues, not product prohibition, grant, or a promised result.

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D2. Which disagreement is professionally precise?

C. The cited passage does not appear to disclose that relationship

This statement challenges the reasoning with an identifiable issue rather than attacking the examiner.

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05 / Answers and explanations / continued

D3. A colleague needs the term for this meaning: View or reasoning expressed by the examiner. Which term fits?

A. examiner position

A Correct. examiner position: View or reasoning expressed by the examiner. The usual combination is "summarize the examiner position".

B Not here. working assumption: Provisional premise used while information is incomplete. The usual combination is "challenge a working assumption".

C Not here. examiner interview: Discussion with an examiner under the applicable procedure. The usual combination is "request an examiner interview".

D Not here. clarity issue: Concern that wording does not identify its meaning sufficiently. The usual combination is "resolve a clarity issue".

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D4. Rebuild the exchange from "The examiner raised two different issues". Jon: "Our engineer thinks the channel in R runs beside the housing instead of through the relationship described in our draft." Elise: [missing response] Jon: "We can provide a side-by-side diagram, but it should not introduce details that are missing from the filed application." Which response belongs in the gap?

D. That may identify a distinguishing feature. Please show the relevant passages and explain the technical relationship precisely.

A Not here. This line belongs to turn 18, after Jon says: "I also want the team to understand that a formal response becomes part of the examination record." It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 16, after Jon says: "The notice is labeled non-final. Does that mean we can leave it until the next quarterly engineering meeting?" It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 10, after Jon says: "Could we first ask the examiner how that passage is being read instead of guessing the intended mapping?" It addresses that point, not the missing turn in the supplied exchange.

D Correct. This is Elise's response in turn 6. It connects Jon's preceding point with Jon's follow-up. A distinguishing feature identifies the particular claimed difference to analyze, not a generalized assertion that the whole reference is irrelevant.

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E / Conversation

1. office action

Turn 2. The office action concerns patent examination issues and should not be misreported as a general rejection or prohibition of the product.

05 / Answers and explanations / continued

2. ground of rejection

Turn 4. The ground of rejection is the stated basis for rejecting the claim, distinct from a separate wording concern.

3. distinguishing feature

Turn 6. A distinguishing feature identifies the particular claimed difference to analyze, not a generalized assertion that the whole reference is irrelevant.

4. claim amendment

Turn 8. A claim amendment changes operative claim wording and requires support and scope review rather than being treated as an informal explanatory note.

5. examiner interview

Turn 10. An examiner interview can clarify issues under the applicable procedure but does not itself guarantee agreement or allowance.

6. allowance

Turn 12. Allowance is a formal examination status and must not be inferred from an encouraging informal discussion.

7. client instruction

Turn 14. Client instruction identifies the authorized direction needed for the matter and must not be assumed from informal interest in an option.

8. response deadline

Turn 16. The response deadline comes from the actual notice and procedure and cannot be postponed based on the word non-final.

9. prosecution history

Turn 18. The prosecution history preserves examination proceedings and submissions, so formal arguments require careful, consistent review.

10. response strategy

Turn 20. Response strategy coordinates the distinct issues, supported options, authority, and actual procedure without promising a favorable outcome.

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05 / Answers and explanations / continued

F / Accuracy and scope

F1. What must happen before calling the response filed?

C. The actual filing must occur and be verified

Draft review and preference do not establish that a response has actually been filed.

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F2. Which summary keeps the issues separate?

B. Check the mapping and independently address the unclear term

Each stated issue needs appropriate attention rather than being erased by disagreement on another point.

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F / Guided speaking

1. approved

Coordinator: The draft is internally approved.

Turn 1. Internal approval is the completed step supplied in the scenario.

2. filed

Counsel: That does not establish that it was filed.

Turn 2. Approval alone does not prove submission to the patent office.

3. record

Coordinator: I will check the actual submission record.

Turn 3. The actual filing record is needed to verify the event.

4. visible

Counsel: Keep the deadline visible until its status is verified.

Turn 4. Unverified filing requires continued attention to the real timing obligation.

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05 / Answers and explanations / continued

F / Rebuild the exchange

1. Rebuild the exchange from "The examiner raised two different issues". Jon: "I will describe the response as proposed until we have reviewed the alternatives and authorized the next step." Elise: [missing response] Jon: "The notice is labeled non-final. Does that mean we can leave it until the next quarterly engineering meeting?" Which response belongs in the gap?

A. That preserves client instruction. We should explain the consequences of an amendment and an argument before confirming the chosen response.

A Correct. This is Elise's response in turn 14. It connects Jon's preceding point with Jon's follow-up. Client instruction identifies the authorized direction needed for the matter and must not be assumed from informal interest in an option.

B Not here. This line belongs to turn 2, after Jon says: "The examiner rejected our product. Management wants a quick assurance that your reply will reverse that decision." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 10, after Jon says: "Could we first ask the examiner how that passage is being read instead of guessing the intended mapping?" It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 8, after Jon says: "We can provide a side-by-side diagram, but it should not introduce details that are missing from the filed application." It addresses that point, not the missing turn in the supplied exchange.

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06 / Answers and explanations

A / Read the situation

A1. What documents have arrived?

A. An international search report and written opinion

The case supplies international-stage reports, not national or worldwide grants.

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A2. Which markets are authorized for the next stage?

C. None has yet been authorized

The brief expressly says no market has been authorized for national or regional action.

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A3. Which matters need verification?

B. Requirements, costs, translations, and actual deadlines

These implementation and timing matters remain unresolved in the supplied case.

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D / Response choices

D1. Which description corrects world patent accurately?

C. A PCT application with international-stage reports

The supplied process is an application route, not universal grant or commercial permission.

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D2. What converts market interest into a filing instruction?

A. Explicit authorized direction for the specified action

A specific authorized instruction is distinct from exploratory discussion and cost information.

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06 / Answers and explanations / continued

D3. A colleague needs the term for this meaning: Authority conducting the relevant PCT international search. Which term fits?

B. International Searching Authority

A Not here. local associate: Local patent professional assisting with a jurisdictional matter. The usual combination is "instruct the local associate".

B Correct. International Searching Authority: Authority conducting the relevant PCT international search. The usual combination is "identify the International Searching Authority".

C Not here. working assumption: Provisional premise used while information is incomplete. The usual combination is "challenge a working assumption".

D Not here. regional phase: Stage before a regional office under the applicable framework. The usual combination is "coordinate regional-phase entry".

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D4. Rebuild the exchange from "An international report is not a worldwide grant". Luis: "The reports will still help us decide whether the commercial opportunity justifies further work in each market." Hana: [missing response] Luis: "The market slide lists A, B, and C. I assumed that putting them on the slide authorized your next steps." Which response belongs in the gap?

A. Yes. They inform the portfolio review, alongside business priorities and qualified advice on the actual findings.

A Correct. This is Hana's response in turn 6. It connects Luis's preceding point with Luis's follow-up. Portfolio review compares the filings and available information with business priorities without treating an assessment as a grant.

B Not here. This line belongs to turn 12, after Luis says: "I have three estimates, but one includes translation and another mentions only the local professional fee." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 10, after Luis says: "Should the board expect exactly the same requirements in each place once the international stage is complete?" It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 16, after Luis says: "The local firms can confirm the requirements and actual dates, but the central team must send consistent instructions." It addresses that point, not the missing turn in the supplied exchange.

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E / Conversation

1. international application

Turn 2. An international application under the PCT is a filing procedure, not a worldwide granted patent.

06 / Answers and explanations / continued

2. written opinion

Turn 4. The written opinion provides an international-stage assessment and must not be presented as a certificate granting patent rights.

3. portfolio review

Turn 6. Portfolio review compares the filings and available information with business priorities without treating an assessment as a grant.

4. filing instruction

Turn 8. A filing instruction is an authorized direction for a specified action and cannot be inferred from a list of markets under evaluation.

5. national requirements

Turn 10. National requirements are office-specific and need verification rather than being assumed identical across markets.

6. jurisdiction budget

Turn 12. A jurisdiction budget must identify included and excluded costs so that figures for different territories can be compared meaningfully.

7. translation specification

Turn 14. The translation specification identifies the actual language and filing requirements that the prepared version must satisfy.

8. local associate

Turn 16. The local associate provides the relevant local professional coordination, while the central team must preserve clear instructions and accountability.

9. grant decision

Turn 18. The grant decision belongs to the competent office and remains distinct from completing national or regional entry actions.

10. territorial protection

Turn 20. Territorial protection requires identifying where rights exist and their actual scope and status, rather than implying universal coverage.

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06 / Answers and explanations / continued

F / Accuracy and scope

F1. What should a budget comparison identify?

B. What each estimate includes and excludes

Comparable budgets require clear coverage of local fees, translation, and other stated items.

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F2. Which status remains unresolved?

A. National or regional action for the evaluated markets

No market authorization or completed next-stage action is supplied in the brief.

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F / Guided speaking

1. estimate

Associate: This document is an estimate.

Turn 1. The document describes expected cost rather than an authorized filing action.

2. pending

Coordinator: Client authorization is still pending.

Turn 2. The brief says no client filing or budget approval has been given.

3. instruction

Associate: Please send an explicit filing instruction.

Turn 3. The associate needs an authorized direction for the actual requested action.

4. deadline

Coordinator: We will also verify the applicable deadline.

Turn 4. The scenario supplies no date, so the real deadline requires verification.

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06 / Answers and explanations / continued

F / Rebuild the exchange

1. Rebuild the exchange from "An international report is not a worldwide grant".

Luis: "We also need to know who checks the language and format of each version, not just who places the order." **Hana:** [missing response] **Luis:** "The local firms can confirm the requirements and actual dates, but the central team must send consistent instructions." **Which response belongs in the gap?**

D. Confirm the translation specification and review responsibility. A completed translation is not proof that every filing requirement has been met.

A Not here. This line belongs to turn 2, after Luis says: "The search report has arrived. Can I tell the board that our world patent now covers markets A, B, and C?" It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 18, after Luis says: "Once the national-stage actions are completed, should the status report say protection is granted in each place?" It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 4, after Luis says: "I see an international search report and a separate assessment discussing the claims. Do they perform the same function?" It addresses that point, not the missing turn in the supplied exchange.

D Correct. This is Hana's response in turn 14. It connects Luis's preceding point with Luis's follow-up. The translation specification identifies the actual language and filing requirements that the prepared version must satisfy.

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07 / Answers and explanations

A / Read the situation

A1. Why does ownership not settle the launch question?

B. Third-party rights may require separate review

The brief distinguishes the company patent from possible third-party rights affecting the actual product.

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A2. What is missing for the proposed connector change?

A. Revised drawings

The engineers propose a change but have not provided the revised configuration.

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A3. Which conclusion has been issued?

D. None of the stated legal conclusions

The brief expressly says that no such opinion, finding, or conclusion has been issued.

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D / Response choices

D1. Which launch statement is supported?

C. Third-party-rights review remains incomplete

The case provides no completed clearance or design-around assessment.

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D2. What is necessary to assess the proposed change?

A. The actual revised configuration and relevant claims

Assessment requires the changed design and relevant legal material rather than appearance or ownership alone.

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07 / Answers and explanations / continued

D3. A colleague needs the term for this meaning: Qualified assessment addressing specified launch or commercial risks. Which term fits?

B. commercial clearance

A Not here. working assumption: Provisional premise used while information is incomplete. The usual combination is "challenge a working assumption".

B Correct. commercial clearance: Qualified assessment addressing specified launch or commercial risks. The usual combination is "define commercial-clearance scope".

C Not here. literal infringement: Infringement analysis based on the claim requirements under applicable interpretation. The usual combination is "assess literal infringement".

D Not here. continuing application: Related further application under an applicable filing system. The usual combination is "review continuing applications".

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D4. Rebuild the exchange from "Our own patent does not answer the launch question". Mei: "Our first market is A, and the production design has changed since the version used in the earlier review." Arun: [missing response] Mei: "Engineering proposes moving the connector to the opposite side. The team thinks that should avoid the competitor patent." Which response belongs in the gap?

A. Please identify the current product configuration rather than assuming that an earlier drawing still represents what will be sold.

A Correct. This is Arun's response in turn 6. It connects Mei's preceding point with Mei's follow-up. The product configuration is the actual design being assessed, so an earlier version cannot silently stand in for the changed production design.

B Not here. This line belongs to turn 2, after Mei says: "We own a patent on the enclosure, so I told the launch team that the product is clear to sell in market A." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 8, after Mei says: "Engineering proposes moving the connector to the opposite side. The team thinks that should avoid the competitor patent." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 10, after Mei says: "I can obtain a controlled drawing and a list of changed components, with the old version retained for comparison." It addresses that point, not the missing turn in the supplied exchange.

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E / Conversation

1. right to exclude

Turn 2. The right to exclude concerns specified acts within patent scope and does not itself authorize commercialization free of other rights.

07 / Answers and explanations / continued

2. freedom to operate

Turn 4. Freedom to operate concerns relevant rights affecting specified commercial activity, distinct from whether the company invention may be patentable.

3. product configuration

Turn 6. The product configuration is the actual design being assessed, so an earlier version cannot silently stand in for the changed production design.

4. design-around

Turn 8. A design-around is an intended avoidance change whose legal effectiveness requires assessment rather than being established by intent or visual difference.

5. claim chart

Turn 10. A claim chart compares relevant claim requirements with the product features and helps expose where the actual scope questions arise.

6. legal status

Turn 12. Legal status distinguishes granted rights, pending applications, and other relevant conditions rather than equating related documents.

7. territory of interest

Turn 14. The territory of interest bounds the jurisdictional review and cannot be expanded merely because another country appears in a sales forecast.

8. clearance opinion

Turn 16. A clearance opinion is a professional assessment within a defined scope, not a substitute label for an unfinished status update.

9. residual risk

Turn 18. Residual risk identifies what remains after the stated review and should not be hidden behind an absolute assurance.

10. review trigger

Turn 20. A review trigger is a change requiring reassessment because it may alter the factual basis of the previous conclusion.

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07 / Answers and explanations / continued

F / Accuracy and scope

F1. Which scope statement is appropriately bounded?

B. This product configuration in market A

The brief identifies a specific configuration and market, not universal future clearance.

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F2. Which event should be flagged for reassessment?

B. A material change to the reviewed product

A material product change can affect the basis of the actual review.

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F / Guided speaking

1. market

Sales: We want to add another market.

Turn 1. The proposed change is expansion to a different geographic market.

2. scope

Counsel: B is outside the existing review scope.

Turn 2. The supplied assessment concerns market A only, not market B.

3. checked

Sales: We need the relevant local rights checked.

Turn 3. The new territory requires the appropriate rights assessment rather than automatic reuse.

4. worldwide

Counsel: Do not describe the earlier opinion as worldwide clearance.

Turn 4. The prior assessment is expressly limited and cannot support universal coverage.

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07 / Answers and explanations / continued

F / Rebuild the exchange

1. Rebuild the exchange from "Our own patent does not answer the launch question". Mei: "We should also make clear that the report is about market A, not every country in the sales forecast." Arun: [missing response] Mei: "Management would like a short answer before the launch meeting, even if several factual questions remain unresolved." Which response belongs in the gap?

B. Exactly. The territory of interest matters, along with the specified activities and the applicable law.

A Not here. This line belongs to turn 6, after Mei says: "Our first market is A, and the production design has changed since the version used in the earlier review." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Arun's response in turn 14. It connects Mei's preceding point with Mei's follow-up. The territory of interest bounds the jurisdictional review and cannot be expanded merely because another country appears in a sales forecast.

C Not here. This line belongs to turn 8, after Mei says: "Engineering proposes moving the connector to the opposite side. The team thinks that should avoid the competitor patent." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 4, after Mei says: "Then the patentability search we commissioned earlier answered a different question from the one the launch team is asking now." It addresses that point, not the missing turn in the supplied exchange.

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08 / Answers and explanations

A / Read the situation

A1. What exclusivity is proposed?

D. Industrial cooling in territory A

The draft limits proposed exclusivity to the named field and territory.

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A2. Which economic issue remains unresolved?

A. Net-sales definition and returns treatment

The royalty base and return treatment are open even though a percentage has been discussed.

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A3. What is the agreement status?

B. Unexecuted draft terms

The brief states that no agreement has been executed and important terms remain open.

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D / Response choices

D1. Which description matches the proposed exclusivity?

C. Industrial cooling in A, subject to final terms

The supplied proposal is limited by field and territory and remains unexecuted.

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D2. Why is the percentage alone insufficient?

B. The royalty base and return treatment are unresolved

The amount payable depends on the agreed base and adjustments, not only the rate.

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08 / Answers and explanations / continued

D3. A colleague needs the term for this meaning: License granting exclusivity as defined by the actual agreement. Which term fits?

B. exclusive license

A Not here. improvement rights: Contractual treatment of later improvements. The usual combination is "clarify improvement rights".

B Correct. exclusive license: License granting exclusivity as defined by the actual agreement. The usual combination is "define the exclusive license".

C Not here. royalty base: Amount or measure to which the royalty rate applies. The usual combination is "define the royalty base".

D Not here. working assumption: Provisional premise used while information is incomplete. The usual combination is "challenge a working assumption".

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D4. Rebuild the exchange from "Exclusive in one field is not exclusive everywhere". Ben: "Understood. We have discussed the percentage, but our finance team cannot calculate the expected payment from the current wording." Nia: [missing response] Ben: "Returns matter for our business. We need the calculation to distinguish invoiced sales from products later returned by customers." Which response belongs in the gap?

B. We still need to settle the royalty base, including which sales and adjustments the definition actually covers.

A Not here. This line belongs to turn 10, after Ben says: "A regional partner would distribute the product and may want rights to manufacture a version for local customers." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Nia's response in turn 6. It connects Ben's preceding point with Ben's follow-up. The royalty base is the amount or measure to which the percentage applies, so an agreed rate alone does not determine payment.

C Not here. This line belongs to turn 14, after Ben says: "Our finance team also wants to know what records we would need to maintain for royalty verification." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 12, after Ben says: "Could we discuss a lower initial payment if we accept a payment when the first approved product enters commercial production?" It addresses that point, not the missing turn in the supplied exchange.

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E / Conversation

1. field of use

Turn 2. The field of use defines the permitted application area and prevents exclusive from being mistaken for unrestricted use.

08 / Answers and explanations / continued

2. licensed territory

Turn 4. The licensed territory defines geographic scope, which does not automatically expand with the licensee sales plans.

3. royalty base

Turn 6. The royalty base is the amount or measure to which the percentage applies, so an agreed rate alone does not determine payment.

4. net sales

Turn 8. Net sales is a contract-defined measure whose deductions and adjustments need explicit agreement rather than assumed standard treatment.

5. sublicense

Turn 10. A sublicense grants onward rights only as permitted by the primary agreement and must not be inferred from distribution arrangements alone.

6. milestone payment

Turn 12. A milestone payment depends on a specifically defined event, which needs precise terms rather than an informal expectation of progress.

7. audit right

Turn 14. An audit right defines contractual verification access and conditions, which should be agreed rather than assumed from the royalty obligation alone.

8. improvement rights

Turn 16. Improvement rights address contractual treatment of later developments and must not be inferred from the original license heading.

9. term sheet

Turn 18. The term sheet records the proposed terms and open issues; its actual legal effect depends on its wording and applicable law.

10. execution

Turn 20. Execution refers to formal completion or signing under the actual agreement process, which has not occurred in the supplied case.

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08 / Answers and explanations / continued

F / Accuracy and scope

F1. Which request requires separate negotiation here?

A. Permission to sublicense

The brief states that sublicensing requires a separately negotiated provision.

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F2. Which closing summary is accurate?

A. Proposed grant discussed; economics and sublicensing remain open

This summary preserves the specific unresolved terms without assuming execution or legal effect.

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F / Guided speaking

1. rate

Analyst: The two drafts use the same rate.

Turn 1. The supplied percentage is identical in both draft provisions.

2. base

Counsel: Their royalty base differs.

Turn 2. The return deduction changes the amount to which the rate applies.

3. deductions

Analyst: We must compare the permitted deductions.

Turn 3. The stated difference concerns whether returns may reduce the calculation.

4. proposed

Counsel: Both provisions remain proposed.

Turn 4. Neither draft has been approved, so neither is a completed agreed term.

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08 / Answers and explanations / continued

F / Rebuild the exchange

1. Rebuild the exchange from "Exclusive in one field is not exclusive everywhere".

Ben: "Our finance team also wants to know what records we would need to maintain for royalty verification." **Nia:** [missing response] **Ben:** "We expect to develop improved connectors. I do not want either side to assume ownership or access without discussing it." Which response belongs in the gap?

A. The proposed audit right should address the relevant records and conditions, with appropriate confidentiality and practical arrangements.

A Correct. This is Nia's response in turn 14. It connects Ben's preceding point with Ben's follow-up. An audit right defines contractual verification access and conditions, which should be agreed rather than assumed from the royalty obligation alone.

B Not here. This line belongs to turn 6, after Ben says: "Understood. We have discussed the percentage, but our finance team cannot calculate the expected payment from the current wording." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 12, after Ben says: "Could we discuss a lower initial payment if we accept a payment when the first approved product enters commercial production?" It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 10, after Ben says: "A regional partner would distribute the product and may want rights to manufacture a version for local customers." It addresses that point, not the missing turn in the supplied exchange.

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Review 1 / Explanations

Cumulative review

1. A colleague needs the term for this meaning: Technical result attributed to a feature or process. Which term fits?

C. technical effect

A Not here. prototype: Preliminary implementation used to explore or test a design. The usual combination is "evaluate the prototype".

B Not here. source attribution: Identification of where information came from. The usual combination is "preserve source attribution".

C Correct. technical effect: Technical result attributed to a feature or process. The usual combination is "substantiate a technical effect".

D Not here. comparative test: Test comparing implementations under stated conditions. The usual combination is "conduct a comparative test".

[Return to the exercise, page 24](#)

2. A colleague needs the term for this meaning: Date a document was published. Which term fits?

C. publication date

A Not here. prior art: Earlier material relevant under the applicable patent law. The usual combination is "assess prior art".

B Not here. clarification request: Question that resolves an unclear meaning or instruction. The usual combination is "make a targeted clarification request".

C Correct. publication date: Date a document was published. The usual combination is "verify the publication date".

D Not here. citation trail: Chain of references connected through citations. The usual combination is "follow the citation trail".

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Review 1 / Explanations / continued

3. Rebuild the exchange from "The improvement is a channel, not simply faster cooling". Amira: "Should I list only senior engineers as inventors? Leo is a technician and did not present the project to management." Daniel: [missing response] Amira: "I also sketched a straight channel with a baffle, although we have not built that version yet." Which response belongs in the gap?

C. Job title does not settle inventorship. We need the relevant facts and proposed claims before reaching that conclusion.

A Not here. This line belongs to turn 6, after Amira says: "One internal test showed a shorter cooling time. I have not checked whether both tests used the same starting temperature." It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 8, after Amira says: "Leo built the enclosure from my drawings, but he suggested making the connector detachable for easier assembly." It addresses that point, not the missing turn in the supplied exchange.

C Correct. This is Daniel's response in turn 10. It connects Amira's preceding point with Amira's follow-up. Inventorship requires the applicable legal assessment of contributions, not a ranking by seniority or presentation role.

D Not here. This line belongs to turn 2, after Amira says: "Our enclosure cools faster. I would like the application to focus on that benefit rather than the shape of the tubing." It addresses that point, not the missing turn in the supplied exchange.

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4. Rebuild the exchange from "One reference matches two features, not the entire claim". Noor: "The team wants the conclusion changed to no blocking prior art found, which sounds broader than the report supports." Ethan: [missing response] Noor: "I will revise the table, separate documents and dates, and flag the connector question for further review." Which response belongs in the gap?

B. Keep the novelty discussion tied to the examined features; do not imply freedom to operate or a guarantee of grant.

A Not here. This line belongs to turn 6, after Noor says: "Reference S mentions a detachable connector, although its device is different and the function is not described in the same way." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Ethan's response in turn 18. It connects Noor's preceding point with Noor's follow-up. Novelty is a specific patentability question, so the search summary must not become a broad commercial-clearance conclusion.

C Not here. This line belongs to turn 20, after Noor says: "I will revise the table, separate documents and dates, and flag the connector question for further review." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 4, after Noor says: "The housing is in paragraph twelve and the channel in figure three, but I have not located the detachable connector." It addresses that point, not the missing turn in the supplied exchange.

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Review 2 / Explanations

Cumulative review

1. A colleague needs the term for this meaning: Claim incorporating a referenced claim and adding a further limitation. Which term fits?

B. dependent claim

A Not here. structural limitation: Requirement describing physical structure or arrangement. The usual combination is "identify a structural limitation".

B Correct. dependent claim: Claim incorporating a referenced claim and adding a further limitation. The usual combination is "review a dependent claim".

C Not here. preamble: Introductory portion of a claim. The usual combination is "review the preamble".

D Not here. source attribution: Identification of where information came from. The usual combination is "preserve source attribution".

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2. A colleague needs the term for this meaning: Drawing contained in the relevant filed application. Which term fits?

D. filed drawing

A Not here. clarification request: Question that resolves an unclear meaning or instruction. The usual combination is "make a targeted clarification request".

B Not here. draft history: Record of successive drafting versions. The usual combination is "preserve the draft history".

C Not here. specification: Written disclosure forming part of a patent application. The usual combination is "review the specification".

D Correct. filed drawing: Drawing contained in the relevant filed application. The usual combination is "inspect the filed drawing".

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Review 2 / Explanations / continued

3. Rebuild the exchange from "One reference matches two features, not the entire claim". Noor: "I will describe the potential combination without saying that it automatically defeats the claim under every legal system." Ethan: [missing response] Noor: "The database gives several dates. I copied the earliest number without identifying what that date represents." Which response belongs in the gap?

B. Identify a possible combination rationale for counsel to assess rather than treating shared subject matter as sufficient by itself.

A Not here. This line belongs to turn 4, after Noor says: "The housing is in paragraph twelve and the channel in figure three, but I have not located the detachable connector." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Ethan's response in turn 10. It connects Noor's preceding point with Noor's follow-up. A combination rationale supplies reasoning for considering teachings together and must be assessed under the relevant legal test.

C Not here. This line belongs to turn 6, after Noor says: "Reference S mentions a detachable connector, although its device is different and the function is not described in the same way." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 8, after Noor says: "Could the two documents still raise a problem if neither appears to describe the entire draft combination alone?" It addresses that point, not the missing turn in the supplied exchange.

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4. Rebuild the exchange from "The new controller was developed after filing". Sofia: "Management asked whether the electronic version would automatically receive the earlier date because it improves the same product." Ravi: [missing response] Sofia: "I will report that the later improvement is valuable, but the support and filing route remain unresolved." Which response belongs in the gap?

B. We cannot promise priority entitlement on that basis. The relevant subject matter and actual disclosure need assessment.

A Not here. This line belongs to turn 8, after Sofia says: "I can show the exact sentence and the drawing it references, instead of sending only the revised paragraph." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Ravi's response in turn 18. It connects Sofia's preceding point with Sofia's follow-up. Priority entitlement depends on the applicable requirements and supported subject matter, not merely on improving the same product.

C Not here. This line belongs to turn 12, after Sofia says: "I understand. Describing the addition as clarification does not establish that the original application taught this arrangement." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 10, after Sofia says: "The new diagram is clearer. I was going to replace the old drawing in our shared folder to avoid confusion." It addresses that point, not the missing turn in the supplied exchange.

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Review 3 / Explanations

Cumulative review

1. A colleague needs the term for this meaning: Stated legal basis for rejecting a claim. Which term fits?

D. ground of rejection

A Not here. prosecution history: Record of proceedings during patent examination. The usual combination is "review the prosecution history".

B Not here. argument on the record: Reasoning formally submitted in the examination record. The usual combination is "develop an argument on the record".

C Not here. source attribution: Identification of where information came from. The usual combination is "preserve source attribution".

D Correct. ground of rejection: Stated legal basis for rejecting a claim. The usual combination is "address each ground of rejection".

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2. A colleague needs the term for this meaning: Stage before national offices under the applicable PCT framework. Which term fits?

C. national phase

A Not here. clarification request: Question that resolves an unclear meaning or instruction. The usual combination is "make a targeted clarification request".

B Not here. filing instruction: Authorized direction identifying a requested filing action. The usual combination is "obtain filing instructions".

C Correct. national phase: Stage before national offices under the applicable PCT framework. The usual combination is "plan national-phase entry".

D Not here. Patent Cooperation Treaty: Treaty providing an international patent application procedure. The usual combination is "use the Patent Cooperation Treaty route".

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Review 3 / Explanations / continued

3. Rebuild the exchange from "The new controller was developed after filing". Sofia: "The new diagram is clearer. I was going to replace the old drawing in our shared folder to avoid confusion." Ravi: [missing response] Sofia: "I understand. Describing the addition as clarification does not establish that the original application taught this arrangement." Which response belongs in the gap?

D. Preserve the filed drawing. Keep the new diagram separately labeled so that the historical record remains intact.

A Not here. This line belongs to turn 8, after Sofia says: "I can show the exact sentence and the drawing it references, instead of sending only the revised paragraph." It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 18, after Sofia says: "Management asked whether the electronic version would automatically receive the earlier date because it improves the same product." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 12, after Sofia says: "I understand. Describing the addition as clarification does not establish that the original application taught this arrangement." It addresses that point, not the missing turn in the supplied exchange.

D Correct. This is Ravi's response in turn 10. It connects Sofia's preceding point with Sofia's follow-up. The filed drawing is part of the historical application record and must not be overwritten by a later engineering version.

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4. Rebuild the exchange from "An international report is not a worldwide grant". Luis: "Once the national-stage actions are completed, should the status report say protection is granted in each place?" Hana: [missing response] Luis: "I will revise the board slide to show reports received, market decisions pending, and local requirements under review." Which response belongs in the gap?

D. No. Entry and the grant decision are separate. Report each application or right using its actual territory and procedural status.

A Not here. This line belongs to turn 4, after Luis says: "I see an international search report and a separate assessment discussing the claims. Do they perform the same function?" It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 14, after Luis says: "We also need to know who checks the language and format of each version, not just who places the order." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 2, after Luis says: "The search report has arrived. Can I tell the board that our world patent now covers markets A, B, and C?" It addresses that point, not the missing turn in the supplied exchange.

D Correct. This is Hana's response in turn 18. It connects Luis's preceding point with Luis's follow-up. The grant decision belongs to the competent office and remains distinct from completing national or regional entry actions.

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Review 4 / Explanations

Cumulative review

1. A colleague needs the term for this meaning: Patent belonging to another party. Which term fits?

D. third-party patent

A Not here. pending application: Application not yet resolved by the relevant final status. The usual combination is "monitor a pending application".

B Not here. source attribution: Identification of where information came from. The usual combination is "preserve source attribution".

C Not here. claim chart: Structured comparison of claim requirements with relevant features. The usual combination is "prepare a claim chart".

D Correct. third-party patent: Patent belonging to another party. The usual combination is "review third-party patents".

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2. A colleague needs the term for this meaning: Permission granted onward under rights allowed by the primary license. Which term fits?

B. sublicense

A Not here. clarification request: Question that resolves an unclear meaning or instruction. The usual combination is "make a targeted clarification request".

B Correct. sublicense: Permission granted onward under rights allowed by the primary license. The usual combination is "negotiate sublicense rights".

C Not here. minimum royalty: Contractual minimum payment under the stated terms. The usual combination is "negotiate a minimum royalty".

D Not here. licensor: Party granting rights under a license. The usual combination is "identify the licensor".

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Review 4 / Explanations / continued

3. Rebuild the exchange from "An international report is not a worldwide grant".

Luis: "Should the board expect exactly the same requirements in each place once the international stage is complete?" **Hana:** [missing response] **Luis:** "I have three estimates, but one includes translation and another mentions only the local professional fee." Which response belongs in the gap?

B. No. The relevant national requirements or regional requirements must be checked with the responsible professionals using current information.

A Not here. This line belongs to turn 16, after Luis says: "The local firms can confirm the requirements and actual dates, but the central team must send consistent instructions." It addresses that point, not the missing turn in the supplied exchange.

B Correct. This is Hana's response in turn 10. It connects Luis's preceding point with Luis's follow-up. National requirements are office-specific and need verification rather than being assumed identical across markets.

C Not here. This line belongs to turn 20, after Luis says: "I will revise the board slide to show reports received, market decisions pending, and local requirements under review." It addresses that point, not the missing turn in the supplied exchange.

D Not here. This line belongs to turn 8, after Luis says: "The market slide lists A, B, and C. I assumed that putting them on the slide authorized your next steps." It addresses that point, not the missing turn in the supplied exchange.

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4. Rebuild the exchange from "Exclusive in one field is not exclusive everywhere".

Ben: "I will send a marked-up version showing our requests on territory, returns, sublicensing, and later improvements." **Nia:** [missing response] **Ben:** "Our closing summary should say that the commercial proposal is progressing, with several specified provisions still unresolved." Which response belongs in the gap?

D. Please keep the term sheet status clear. A discussion of those points does not mean the license has been completed.

A Not here. This line belongs to turn 2, after Ben says: "The heading says exclusive license. Our sales team reads that as permission to use the technology in any product we develop." It addresses that point, not the missing turn in the supplied exchange.

B Not here. This line belongs to turn 16, after Ben says: "We expect to develop improved connectors. I do not want either side to assume ownership or access without discussing it." It addresses that point, not the missing turn in the supplied exchange.

C Not here. This line belongs to turn 4, after Ben says: "We also plan to sell in market B. I assumed the same exclusivity would follow the product wherever it travels." It addresses that point, not the missing turn in the supplied exchange.

D Correct. This is Nia's response in turn 18. It connects Ben's preceding point with Ben's follow-up. The term sheet records the proposed terms and open issues; its actual legal effect depends on its wording and applicable law.

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Additional case 1 / Explanations

Extended conversation

1. Inventorship

Turn 4. Inventorship identifies the relevant inventors under the applicable legal test and is not settled merely by who funded the work.

2. Recordation

Turn 6. Recordation is the recording step and does not itself establish the validity or ownership effect of the underlying assignment instrument.

3. assignment

Turn 8. An assignment is the instrument or transaction transferring the relevant interest, whose actual scope and legal effect require review.

4. chain of title

Turn 12. The chain of title traces relevant ownership transfers and requires examination of the actual links rather than a single isolated entry.

5. entity identification

Turn 14. Entity identification establishes which legal person each document concerns and prevents a name change from being mistaken for an unexplained transfer.

6. title assessment

Turn 18. The title assessment is the qualified evaluation of ownership and its supporting documents, not an automatic result of a database search.

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Transfer exchange

1. recordation

Coordinator: The database shows recordation.

Turn 1. The database establishes the recorded entry, not every substantive legal conclusion.

Additional case 1 / Explanations / continued

2. instrument

Counsel: The underlying instrument still needs review.

Turn 2. The actual transfer document must be examined for its relevant effect.

3. validity

Coordinator: The note overstated legal validity.

Turn 3. Recording alone does not establish the assignment document's substantive validity.

4. qualified

Counsel: Keep the ownership conclusion qualified.

Turn 4. The unresolved document review prevents an unqualified ownership assurance.

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Additional case 2 / Explanations

Extended conversation

1. solicitation

Turn 4. A solicitation can use public patent details without being an official fee notice, so appearance alone does not establish authority.

2. maintenance status

Turn 8. Maintenance status concerns the real patent record and obligations, which remain a separate question from whether the received letter is authentic.

3. trusted contact

Turn 10. A trusted contact is verified independently of the suspicious request, reducing reliance on contact details supplied by the same unverified sender.

4. payment authorization

Turn 12. Payment authorization must follow the actual approved process and cannot be inferred from urgency or an official-looking design.

5. verification record

Turn 16. The verification record preserves the source, finding, and authorized next action rather than leaving only a vague assurance that someone checked.

6. payment confirmation

Turn 18. Payment confirmation is evidence of the actual completed payment, not the original request or an internal intention to pay.

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Transfer exchange

1. unverified

Accounts: The patent number is correct, but the sender is unverified.

Turn 1. Correct public details do not establish that the sender is authentic.

Additional case 2 / Explanations / continued

2. channel

Administrator: Use an independently verified channel.

Turn 2. Verification should not depend on contact details in the unverified request.

3. check

Accounts: The real maintenance obligation needs a separate check.

Turn 3. Sender authenticity and actual patent maintenance status are different questions.

4. controls

Administrator: Do not bypass payment controls because of urgency.

Turn 4. Urgent wording does not replace the established authorization and verification process.

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Additional case 3 / Explanations

Extended conversation

1. quantifier discrepancy

Turn 4. The quantifier discrepancy changes the stated numerical range, so it needs substantive review rather than a silent stylistic correction.

2. source wording

Turn 6. The source wording is the actual expression being translated and must remain available while the intended meaning and legal implications are reviewed.

3. translation query

Turn 10. A translation query identifies a specific discrepancy for authorized resolution without granting the translator authority to choose the legal scope.

4. version label

Turn 12. The version label should reflect the actual review status rather than imply final approval while material questions remain unresolved.

5. controlled revision

Turn 14. A controlled revision makes the authorized change traceable and preserves the relationship between the approved instruction and revised text.

6. terminology check

Turn 18. The terminology check verifies consistent use within its stated scope and complements, rather than replaces, the substantive quantifier review.

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Transfer exchange

1. bound

Translator: At least sets a lower bound.

Turn 1. At least three includes three and larger counts in the supplied numerical comparison.

Additional case 3 / Explanations / continued

2. limit

Reviewer: At most sets an upper limit.

Turn 2. At most three includes three and smaller counts, changing the relationship.

3. query

Translator: The difference needs an explicit query.

Turn 3. The translator should raise the discrepancy for authorized review rather than choose scope.

4. traceable

Reviewer: Keep both original versions traceable.

Turn 4. Preserving the versions lets reviewers identify the discrepancy and the authorized resolution.

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Find a phrase by purpose

Interviewing inventors without leading their answers

Elicit the mechanism: What does the curved channel change in the flow path?

Probe an alternative: Would the same effect occur with a straight channel?

Trace a contribution: Who first proposed that feature, and what records support the account?

[Full phrase bank, page 7](#)

Discussing prior art without overstating the search

Locate support: Which passage discloses the connector?

Qualify the finding: I have not located that feature in this reference.

Separate references: R describes the channel; S discusses a connector in another device.

[Full phrase bank, page 17](#)

Explaining claim structure to a technical colleague

Explain inheritance: Claim 2 carries forward the requirements of claim 1.

Identify the addition: The connector is an added limitation, not a replacement.

Check the referent: Which valve does the later phrase refer to?

[Full phrase bank, page 29](#)

Checking drafting support before amending

Locate the basis: Where does the filed application disclose that controller?

Separate versions: That feature appears in the later prototype, not the cited filed passage.

Challenge a label: Calling it a clarification does not answer the support question.

[Full phrase bank, page 39](#)

Find a phrase by purpose / continued

Explaining an office action and agreeing on a response

Attribute the position: The examiner maps that passage to the channel limitation.

Separate issues: The clarity concern needs a response apart from the prior-art argument.

Disagree precisely: We do not read that passage as disclosing the stated relationship.

[Full phrase bank, page 51](#)

Coordinating international patent filing decisions

Correct the label: We have a PCT application, not a worldwide grant.

Explain the report: The written opinion is an assessment, not a patent certificate.

Identify the decision: Which markets are authorized for the next stage?

[Full phrase bank, page 61](#)

Explaining freedom to operate and design-around questions

Separate ownership from permission: Our own patent does not settle third-party rights.

Define the review: Which product version and market does the assessment cover?

Request the configuration: Please provide the revised drawings before we assess the change.

[Full phrase bank, page 73](#)

Negotiating a patent-license term sheet

Clarify exclusivity: Exclusive for which field and territory?

Define the economics: Which deductions are included in the net-sales definition?

Separate rate and base: We have discussed the percentage, not settled the amount it applies to.

[Full phrase bank, page 83](#)

Vocabulary index

action owner

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claim body

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Vocabulary index / continued

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References and publication notes

All cases, organizations, figures, and conversations are fictional teaching material, not transcripts. Communication practice does not replace qualified advice or current workplace procedures.

[1] USPTO. MPEP 2109: Inventorship.

US terminology concerning contribution to conception of claimed subject matter; not a universal inventorship test. Source checked 11 October 2026.

<https://www.uspto.gov/web/offices/pac/mpep/s2109.html>

[2] USPTO. MPEP 301: Ownership and assignability.

Distinguishes patent ownership and exclusion rights from permission to commercialize. Source checked 11 October 2026.

<https://www.uspto.gov/web/offices/pac/mpep/s301.html>

[3] WIPO. Introduction to the Patent Cooperation Treaty.

International filing, search, and national or regional examination terminology. Source checked 11 October 2026.

<https://www.wipo.int/en/web/pct-system/introduction>

[4] USPTO. Manual of Patent Examining Procedure.

Primary US examination terminology; sections 608, 706, 714, and 2163 inform the claim, response, and disclosure distinctions. Actual matters require current rules and qualified review. Source checked 11 October 2026.

<https://www.uspto.gov/web/offices/pac/mpep/index.html>

Companion course

The website offers the eight-lesson course and related practice. This book can be used independently. No audio access or external account is needed for its exercises.

<https://englishladder.com/efsp-patent-law.html>

Describe the invention. Define the legal question.

Eight matters move from an invention disclosure to a licensing discussion, separating technical facts from legal conclusions that require qualified review.

Interviewing inventors without leading their answers

Describe each contribution before assessing its legal significance. Building a prototype and conceiving a claimed feature are not interchangeable descriptions.

Discussing prior art without overstating the search

Not located is a search finding, not proof of absence. A reference describing some features does not automatically disclose the whole combination.

Explaining claim structure to a technical colleague

In the supplied example, claim 2 contains the housing, channel, and connector requirements. It is not a claim to the connector alone.

Checking drafting support before amending

Calling a substantive addition a clarification does not supply support. Compare the proposed wording with the actual filed disclosure.

Phil Stilwell

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