

# Index

**ABANDONMENT**  
Generally, **8:266-8:272**  
Adequate utility, **7:44**  
Correction of inventorship, **10:67, 10:68**  
Examination of Original Application (this index)  
General abandonment, relation to, **8:271**  
History, **1:20, 1:21, 8:267-8:269**  
Joint inventorship, **10:52**  
Modern law, **8:279-8:272**  
Non-obviousness, **9:28, 9:29, 9:34, 9:39**  
Novelty bar, relation to, **8:268**  
Potential issues, **8:272**  
Priority (this index)  
Processes, **5:30**  
Section 102(c), generally, **8:266-8:272**  
Statutory history, **8:269**  
Technological scope, **13:89**

**ABBREVIATED APPROVAL APPLICATION**  
Adequate commerciality, **14:7**

**ABBREVIATED NEW-DRUG APPLICATION (ANDA)**  
Adequate commerciality, **14:62, 14:64, 14:79, 14:80**

**ABILITY OR SKILL**  
Skill (this index)

**ABSOLUTE NOVELTY**  
Priority (this index)

**ABSTRACT ACTS AND MATTERS**  
Adequate utility, **6:18, 7:6**  
Claims, **4:97**  
Computer-related inventions, **5:44**  
Inventorship, **10:9, 10:13, 10:17**  
Joint inventorship, **10:52**  
Non-statutory hybrid inventions, **5:78**

**ABSTRACT ACTS AND MATTERS**  
—Cont'd  
Processes, **5:19, 5:26, 5:39**  
Static physical configurations, **5:10**

**ABTOX, INC. v. EXITRON CORP.**  
Adequate commerciality, **14:71**

**A.C. AUKERMAN CO. v. R.I. CHAIDES CONST. CO.**  
Estoppel, **24:17**

**ACCIDENT**  
Reissue of patent, **16:25**

**ACCIDENTAL ANTICIPATION**  
Anticipation, Lack Of (this index)

**ACCIDENTAL DISCOVERY**  
Priority, **8:44**

**ACCOUNTABILITY**  
Correction of inventorship, **10:61**  
Joint inventorship, **10:50-10:53**

**ACCOUNTING**  
Processes, **5:28**

**ACCURAL**  
Six-year limitation, section 286 defense, **21:21, 21:22**

**ACCURACY**  
Definitional accuracy, **4:9**  
Technological scope, **13:54**

**ACCUSED ACTIVITY**  
Geographic Scope of Infringement (this index)

**ACTIVELY INDUCES INFRINGEMENT**  
Indirect infringement, **15:15**

**ADAMS v. EDWARDS**  
Priority, **8:44**

**ADDITIONS AND DELETIONS**  
Adequate commerciality, **14:31**

**ADDITIONS AND DELETIONS****—Cont'd**

Anticipation, lack of, **8:32**  
 Priority, **8:147**

**ADEQUATE COMMERCIALITY**

Abbreviated approval application, **14:7**

Abbreviated new-drug application (ANDA), **14:62, 14:64, 14:79, 14:80**

Abtox, Inc. v. Exitron Corp., **14:71**  
 Additional uses, capacity for, **14:31**  
 Allergan, Inc. v. Alcon Laboratories, Inc., **14:79**

Alternative purpose, use of claimed structure for, **14:37**

Amendments

Hatch-Waxman Act, below  
 Patent Act, **14:24, 14:44, 14:45**  
 TRIPs, **14:10**

Amusement, **14:12, 14:63**

Appeal and review

Hatch-Waxman Act, below  
 Paper Converting Machine Co. v. Magna-Graphics Corp., **14:26**

Application

abbreviated approval application, **14:7**

abbreviated new-drug application (ANDA), **14:62, 14:64, 14:79, 14:80**

declaratory judgment action, **14:80**  
 new-drug application (NDA), **14:62**

Approval

Approved Drug Products with Therapeutic Equivalence Evaluations, **14:76**

experimental use, **14:57**

FDA approval, **14:63**

Hatch-Waxman Act, below  
 technical infringement, **14:75, 14:78, 14:79**

Aro Mfg. Co. v. Convertible Top Replacement Co., **14:32**

Attorneys' fees, **14:78**

Bauer & Cie v. O'Donnell, **14:33, 14:39**

**ADEQUATE COMMERCIALITY****—Cont'd**

Capacity for use, questions of, **14:29-14:31**

Certification, **14:78**

Chemical arts, **14:61**

Circumstantial evidence, intent as, **14:16**

Common-law exception, **14:51**

Community Patent Convention, **14:46**

Competition, generally, **14:6**

Conner Peripherals, Inc. v. Western Digital Corp., **14:27**

Construction and interpretation, **14:65, 14:69, 14:70, 14:79**

Contracts and agreements  
 offers for sale, generally, **14:47**  
 TRIPs, **14:10**

Conveyance of title, **14:18**

Copyright, comparison to, **14:15**

Counterfeit goods, TRIPs, **14:10**

Court of claims, **14:51, 14:55**

Curiosity, satisfaction of, **14:12**

Damages, **14:19, 14:78**

Date of invention, **14:10**

Declaratory judgment action, availability of, **14:80**

Deepsouth Packing Co. v. Laitram Corp.

generally, **14:22-14:24**

holding, **14:23**

making, developments after 1982, **14:25-14:27**

subsequent enactment of section 271(f), **14:24**

Definitions

direct infringement, **14:1**

infringement, **14:10**

infringement, acts of, below

offers to sale, **14:47**

policy justifications, definition without reference to intent, **14:14-14:17**

selling, **14:39**

using, **14:33**

De Graffenreid v. U.S., **14:27**

Delay, **14:26**

## INDEX

### **ADEQUATE COMMERCIALITY**

#### **—Cont'd**

- Delivery, **14:40**
- De minimis activities. Experimental, noncommercial and de minimis activities, above
- Doctrine of Equivalents, **14:17, 14:29**
- Douglas v. U.S., **14:55**
- Drug Price Competition and Price Restoration Act of 1984. Hatch-Waxman Act, below
- E.I. DuPont De Nemours and Co. v. Monsanto Co., **14:36**
- Eli Lilly and Co. v. Medtronic, Inc., **14:65, 14:69-14:71**
- Embodiments, **14:42**
- Embrex, Inc. v. Service Engineering Corp., **14:59**
- Enercon GmbH v. International trade Com'n, **14:39, 14:40**
- Evidence, **14:6, 14:15, 14:16**
- Exceptions, exclusions, and exemptions, generally, **14:1**
- Exclusive rights, **14:42**
- Exclusivity, commercial, **14:12**
- Experimental, noncommercial and de minimis activities
  - generally, **14:12, 14:50-14:80**
  - court of claims, development in, **14:55**
  - experimental uses, generally, **14:50-14:59**
  - federal circuit courts, developments in, **14:56-14:59**
- Food, Drug, and Cosmetic Act (FDCA), **14:62, 14:63, 14:70, 14:76, 14:80**
- Food and Drug Administration (FDA), **14:63, 14:64, 14:79, 14:80**
  - genomic material, use of, **14:58**
  - Hatch-Waxman Act, below
  - history, **14:52**
  - policy justification, **14:53**
  - pre-federal circuit developments, **14:54**
  - recent developments, **14:59**

### **ADEQUATE COMMERCIALITY**

#### **—Cont'd**

- Experimental, noncommercial and de minimis activities—Cont'd
  - regulatory approval, experimental use for, **14:57**
- Expiration of patent, **14:61**
- Faroudja Laboratories, Inc. v. Dwin Electronics, Inc., **14:36**
- Federal Circuit, U.S. Court of Appeals for, generally, **14:6**
- Food and Drug Administration (FDA), generally, **14:6, 14:7**
- Foreign countries, **14:33**
- FTC, **14:58**
- General Agreement on Tariffs and Trade (GATT), **14:10, 14:33, 14:46**
- Generic drugs, **14:63, 14:64**
- Genome structure and inventions, **14:51, 14:58**
- Hatch-Waxman Act
  - generally, **14:6, 14:60-14:74**
  - amendments
    - Food, Drug, and Cosmetic Act of 1938, amendment to, **14:62**
      - 1988 amendments, **14:66**
      - safe harbor, **14:75**
      - 2003 amendments, **14:9, 14:66, 14:80**
    - appeal and review
      - generally, **14:6**
    - Eli Lilly and Co. v. Medtronic, Inc., **14:65, 14:70**
    - experimental uses, **14:51**
    - technical infringement, **14:79**
    - approval, pre-market regulatory approval, generally, **14:6**
    - early history, **14:62**
    - Eli Lilly and Co. v. Medtronic, Inc., **14:65, 14:70**
    - Food, Drug, and Cosmetic Act (FDCA), **14:62, 14:63, 14:70, 14:76, 14:80**
    - Food and Drug Administration (FDA), **14:63, 14:64, 14:79, 14:80**

**ADEQUATE COMMERCIALITY****—Cont'd**

Hatch-Waxman Act—Cont'd  
 historical development, generally, **14:6-14:9, 14:61-14:67**  
 initial act, **14:64**  
*Merck KGaA v. Integra Lifesciences I, Ltd.*, **14:67**  
*Roche Prod. Inc. v. Bolar Pharmaceutical Co., Inc.*, **14:63**  
 safe harbor, section 271(e)(1)  
 generally, **14:68-14:74**  
*Eli Lilly and Co. v. Medtronic, Inc.*, **14:70**  
 medical devices, application to, **14:69**  
 medical devices, class I and II, **14:71**  
*Merck KGaA v. Integra Lifesciences I, Ltd.*, **14:73**  
 reasonably related uses, **14:72-14:74**  
 subsequent developments, **14:74**  
 section 271(e)(1), generally. Safe harbor, section 271(e)(1), above this group  
 section 271(e)(2), generally.  
 Technical infringement, section 271(e)(2), below this group  
 technical infringement, section 271(e)(2)  
 generally, **14:75-14:80**  
 declaratory judgment action, availability of, **14:80**  
 induced infringement, relation to, **14:79**  
 limitations on remedies, **14:78**  
 special issues, **14:77-14:80**  
 statutory mechanics, **14:76**  
 veterinary biological products generally, **14:1, 14:50**  
 historical development, **14:8**  
 safe harbor, **14:69**  
 statutory amendments, **14:66**  
 technical infringement, **14:79**  
*High Tech Medical Instrumentation, Inc. v. New Image Industries, Inc.*, **14:30**

**ADEQUATE COMMERCIALITY****—Cont'd**

Historical development generally, **14:1-14:10**  
 amendments of 2003, **14:9**  
 early U. S. statutes, **14:3**  
 experimental, noncommercial and de minimis activities, **14:52**  
 General Agreement on Tariffs and Trade (GATT), **14:10**  
 Hatch-Waxman Act, above  
*Keplinger v. De Young*, **14:3**  
 offers to sale, **14:46**  
 Patent Act of 1836, **14:4, 14:5**  
 Patent Act of 1870, **14:4**  
 Patent Act of 1952, **14:5**  
 Statute of Monopolies of 1623, generally, **14:2**  
 Statute of Monopolies of 1790, **14:3**  
 Statute of Monopolies of 1793, **14:3**  
 Statute of Monopolies of 1800, **14:3**  
*Whittemore v. Cutter*, **14:3**  
*Hoffmann-La-Roche, Inc. v. Zenith Laboratories, Inc.*, **14:62**  
*Holding*, **14:23**  
*Hughes Aircraft Co. v. U.S.*, **14:27**  
 Identical subject matter, **14:12**  
 Immunity, **14:7, 14:68, 14:72**  
 Imports and exports, **14:23, 14:24**  
 Independent inventions, **14:11, 14:15**  
 Indirect infringement, contrast with, **14:17**  
*Inducement*, **14:79**  
 Infringement, acts of generally, **14:18-14:49**  
 additional uses, capacity for, **14:31**  
 alternative purpose, use of claimed structure for, **14:37**  
 contrasting making with using, **14:35**  
 date of offered sale, **14:48**  
*Deepsouth Packing Co. v. Laitram Corp.*, **14:22-14:24**  
 definitions  
 making, generally, **14:20-14:27**

## INDEX

### ADEQUATE COMMERCIALITY

#### —Cont'd

Infringement, acts of—Cont'd  
definitions—Cont'd  
    offers of sale, 14:47  
    selling, 14:39  
    using, 14:33  
delivery, 14:40  
historical development, 14:46  
holding, Deepsouth Packing Co. v.  
    Laitram Corp., 14:23  
making, contract with, 14:35  
making, generally, 14:19-14:31  
method inventions, inapplicability  
    to, 14:28, 14:43  
method inventions, use of, 14:34-  
    14:36  
methods, application to, 14:49  
modifications required before use,  
    14:30  
1982, development after, 14:25-  
    14:27  
offers to sale, generally, 14:44-  
    14:49  
offers to use, 14:35  
Paper Converting Machine Co. v.  
    Magna-Graphics Corp., 14:26  
questions of capacity for use,  
    14:29-14:31  
Radio Corporation of America v.  
    Andrea, 14:21  
relationship of offers for sale and  
    selling, 14:44  
sale versus license, 14:41  
section 271(i), generally, 14:48  
selling, generally, 14:35, 14:38-  
    14:44  
serial performance by different  
    persons, 14:36  
subsequent developments, 14:27  
subsequent enactment of section  
    271(f), effect of, 14:24  
transfer of embodiments versus  
    intellectual property rights,  
    14:42  
using, generally, 14:32-14:37,  
    14:49  
Injunctions, 14:78  
Intellectual property rights, 14:42

### ADEQUATE COMMERCIALITY

#### —Cont'd

Intent, 14:14-14:17, 14:29, 14:79  
International acts and matters  
    Community Patent Convention,  
        14:46  
    General Agreement on Tariffs and  
        Trade (GATT), 14:10, 14:33,  
        14:46  
    TRIPs, 14:10  
    Uruguay Round Agreement, 14:10  
    WTO Agreement, 14:46  
International Trade Commission  
    (ITC), 14:39, 14:40  
Investigational new drug (IND),  
    14:67, 14:73  
Joy Technologies, Inc. v. Flakt, Inc.,  
    14:27, 14:28, 14:43  
Judgments, 14:80  
Jurisdiction, 14:47  
Justification. Policy justifications,  
    below  
Keplinger v. De Young, 14:3  
License, sale versus, 14:41  
Limitations and restrictions  
    experimental, noncommercial and  
        de minimis activities, 14:68,  
        14:75, 14:78  
    making, 14:22, 14:26  
    offers for sale, 14:45, 14:48  
    policy justifications, 14:12  
    using, 14:33, 14:37  
Madey v. Duke University, 14:59  
Making, generally, 14:1  
Marketing regulation of FDA, 14:7  
Medical devices, 14:69, 14:71  
Medicare Prescription Drug,  
    Improvement, and Moderniza-  
        tion Act, 14:9, 14:66  
Merck KGaA v. Integra Lifesciences  
    I, Ltd., 14:67, 14:73, 14:74  
Method claims and inventions  
    making, 14:27, 14:28  
    offers to sale, 14:49  
    selling, 14:43  
    using, 14:32, 14:34-14:37  
Modifications, 14:30, 14:64  
Monetary relief, 14:78  
Multiple capabilities, 14:31

**ADEQUATE COMMERCIALITY****—Cont'd**

- Name-brand drugs, **14:63**
- New-drug application
  - generally, **14:62 et seq.**
  - abbreviated new-drug application (ANDA), **14:62, 14:64, 14:79, 14:80**
- 1982, development after, **14:25-14:27**
- Noncommercial activities. Experimental, noncommercial and de minimis activities, above
- Notice and knowledge, **14:14, 14:53, 14:61, 14:76**
- NTP, Inc. v. Research In Motion, Ltd., **14:28**
- Offering for sale, generally, **14:1**
- Offers to use, **14:35**
- Paper Converting Machine Co. v. Magna-Graphics Corp.
  - making, **14:19, 14:25-14:27, 14:30**
  - offers for sale, **14:48**
- Patent Act of 1793, **14:32**
- Patent Act of 1836, **14:4, 14:5**
- Patent Act of 1870, **14:4**
- Patent Act of 1952, **14:5, 14:42**
- Patent Act of 1977, **14:35, 14:49**
- Patent Law Amendments Act of 1984, **14:24**
- Pending actions, **14:80**
- Performance, **14:36**
- Personal jurisdiction, **14:47**
- Pfizer v. International Rectifier, **14:63**
- Pharmaceuticals
  - exception, generally, **14:1**
  - Hatch-Waxman Act, above
- Philosophical gratification, **14:63**
- Philosophical inquiry, strictly for, **14:12**
- Policy justifications
  - generally, **14:11-14:17**
  - circumstantial evidence, intent as, **14:16**
  - commercial exclusivity, **14:12**
  - copyright, comparison to, **14:15**
  - definition without reference to intent, **14:14-14:17**

**ADEQUATE COMMERCIALITY****—Cont'd**

- Policy justifications—Cont'd
  - experimental, noncommercial and de minimis activities, **14:53**
  - indirect infringement, contrast with, **14:17**
  - rule-based implementation, **14:13**
- Possession, **14:32, 14:41**
- Pre-federal circuit developments, **14:54**
- Preliminary injunction, **14:31**
- Pre-market regulatory approval.
  - Hatch-Waxman Act, above
- Price, **14:12, 14:47, 14:63**
- Profits, **14:12**
- Public knowledge, **14:53**
- Quality immunity, **14:7**
- Questions of capacity for use, **14:29-14:31**
- Radio Corp. of America v. Andrea, **14:21, 14:22, 14:26**
- Reasonable apprehension, **14:80**
- Reasonableness, **14:72**
- Reasonable relationship, **14:68, 14:73**
- Reasonably capable of use, **14:19**
- Reasonably related uses, **14:72-14:74**
- Regulatory approval, experimental use for, **14:57**
- Relevance of proof, **14:16**
- Research tools, **14:74**
- Restatement of Contracts, **14:47**
- Roche Prod. Inc. v. Bolar Pharmaceutical Co., Inc.
  - experimental, noncommercial and de minimis activities, **14:57, 14:58, 14:63, 14:64, 14:66**
  - historical development, **14:6, 14:7**
  - making, **14:26**
- Rotec Indus., Inc. v. Mitsubishi Corp., **14:40, 14:47**
- Rule-based implementation, **14:13**
- Safe harbor
  - generally, **14:7**
  - Hatch-Waxman Act, above
- Sales
  - exclusion from making, using, offering for sale or selling, generally, **14:1**

## INDEX

### ADEQUATE COMMERCIALITY

#### —Cont'd

- Sales—Cont'd
  - perform process, sale of materials to, **14:28**
- Section 154, **14:19**
- Section 154, generally, **14:1**
- Section 156. Hatch-Waxman Act, above
- Section 271(a), generally, **14:1**
- Section 271(e). Hatch-Waxman Act, above
- Section 271(e), pharmaceuticals exception, **14:1**
- Section 271(e)(1)
  - generally, **14:7**
  - Hatch-Waxman Act, above
- Section 271(e)(2)
  - generally, **14:7**
  - Hatch-Waxman Act, above
- Section 271(e)(3), **14:7**
- Section 271(e)(4), **14:7**
- Section 271(e)(5), **14:9**
- Section 271(f), **14:24**
- Section 271(i), **14:48**
- Serial performance by different persons, **14:36**
- Single-source control, **14:12**
- Special damages, **14:78**
- Standard Havens Products, Inc. v. Gencor Industries, Inc., **14:27**
- State of mind, **14:17**
- Statute of Monopolies. History, above
- Stearns-Roger Mfg. Co. v. Ruth, **14:29**
- Strict liability, **14:14**
- Subsequent developments, **14:27, 14:74**
- Subsequent enactment of section 271(f), effect of, **14:24**
- Summary judgment, **14:36, 14:79**
- Supreme Court cases, see lines throughout this index topic
- Tariff Act, **14:39**
- Technical infringement, section 271(e)(2). Hatch-Waxman Act, above
- Temporal scope, **11:6**

### ADEQUATE COMMERCIALITY

#### —Cont'd

- Term of patent, **14:26**
- Territorial limitations, **14:22**
- Teva Pharmaceuticals USA, Inc. v. Pfizer, Inc., **14:80**
- Third parties, **14:32**
- 3D Systems, Inc. v. Aarotech Laboratories, Inc., **14:47**
- Time and date
  - expiration of patent, **14:61**
  - offers to sale, **14:48**
  - technical infringement, **14:76**
  - term of patent, **14:26**
  - TRIPs, **14:10**
- Title, conveyance of, **14:18**
- Toppan v. Tiffany Refrigerator Car Co., **14:42**
- Trade-Related Aspects of Intellectual Property Rights, Agreement on (TRIPs), **14:10, 14:27, 14:46**
- Trade shows, **14:33**
- Transfers, **14:42**
- TRIPs, **14:10, 14:27, 14:46**
- Union Oil Co. of California v. Atlantic Richfield Co., **14:37**
- Uruguay Round Agreement of GATT, **14:10**
- U.S. Court of Appeals for Federal Circuit, generally, **14:6**
- USCA, Title 21, Sections 151 to 158, **14:76**
- USCA, Title 28, Section 1498, **14:55**
- USCA 35 § 271(e)(2)(A), **14:79**
- Use, offers to, **14:49**
- Using, generally, **14:1**
- Van Kannell Revolving Door Co. v. Revolving Door & Fixture Co., **14:39, 14:40, 14:46**
- Veterinary biological products. Hatch-Waxman Act, above
- Warner-Lambert Co. v. Apotex Corp., **14:79**
- Waymark Corp. v. Porta Systems Corp., **14:27**
- Weed Chain Tire Grip Co v. Cleveland Chain & Mfg Co., **14:31**
- White v. Walbridge, **14:20**

**ADEQUATE COMMERCIALITY**  
—Cont'd  
Whittemore v. Cutter, **14:3, 14:52**  
Willfulness, **14:78**  
WTO Agreement, **14:46**

**ADEQUATE DIFFERENCES**  
Processes, **5:29**

**ADEQUATE DILIGENCE**  
Priority, **8:78**

**ADEQUATE DISCLOSURE**  
Disclosure (this index)

**ADEQUATE EVIDENCE**  
Priority, **8:260**

**ADEQUATE KNOWLEDGE**  
Adequate utility, **7:4**

**ADEQUATE PRICE**  
Policy justification, **1:38**

**ADEQUATE RANGE**  
Adequate disclosure, **7:23-7:26**

**ADEQUATE SUBJECTIVE INSIGHT**  
Non-obviousness, **9:41-9:43**

**ADEQUATE SUGGESTION**  
Non-obviousness, **9:66**

**ADEQUATE UTILITY**  
Utility Requirement (this index)

**AD HOC PROCESS**  
Patent and Trademark Office (PTO),  
**2:31**

**ADJUSTMENT**  
Change and Modification (this index)

**ADMINISTRATIVE LAW AND PROCEDURE**  
Adequate utility, **6:4, 7:5, 7:29**  
Claims, **4:2, 4:6**  
History, **1:17, 1:25**  
Non-obviousness, **9:14-9:16, 9:16**  
Non-statutory hybrid inventions,  
**5:59, 5:81, 5:83**  
Patent and Trademark Office (PTO)  
(this index)  
Priority, **8:192**

**ADMINISTRATIVE PATENT JUDGES**  
Generally, **2:22**

**ADMINISTRATIVE PROCEDURE ACT (APA)**  
Generally, **2:21, 2:26, 2:28, 2:41 et seq.**  
Application to legal rules of APA,  
**2:49**  
Application to review, **2:42, 2:43**  
Clear error, **2:43**  
Common law, **2:43**  
Dickenson v. Zurko, **2:43**  
Interpretative rules, **2:48, 2:51**  
Legal rules, **2:45 et seq.**  
Procedural versus nonprocedural rules,  
**2:46**  
Review of facts, **2:41 et seq.**  
Substantive/legislative rulemaking  
authority of USPTO, **2:50**  
Substantive/legislative rules, **2:47**

**ADMINISTRATIVE PROCEDURES ACT**  
Review of facts, Patent and  
Trademark Office (PTO), **2:41-2:43**

**ADMISSIBILITY**  
Non-obviousness, **9:59**

**ADMISSIONS**  
Non-obviousness, **9:42**

**ADVANCED HYDRAULICS, INC. v. OTIS ELEVATOR CO.**  
Estoppel, **24:13**

**ADVANCE-OVER-THE-ART**  
Non-obviousness, **9:31**

**ADVICE**  
Generally, **2:22**  
Non-obviousness, **9:66**

**ADVISORY COMMITTEE**  
Generally, **2:22**

**AESTHETIC THOUGHT**  
Processes, **5:26**

## INDEX

**A.F. STODDARD & CO. v. DANN**  
Correction of inventorship, **10:64**

**AFFECTED SUBJECT MATTER**  
Medical activity, section 287(c)  
defense, **20:17**

**AFFIDAVITS**  
Non-obviousness, **9:25, 9:36, 9:37, 9:73**  
Priority (this index)

**AGE**  
Inventorship, **10:7**

**AGENTS AND AGENCY**  
Inventorship, **10:13, 10:14, 10:17**  
Joint inventorship, **10:25**  
Patent and Trademark Office (PTO)  
(this index)

**AGGREGATION OF ELEMENTS**  
Non-statutory hybrid inventions, **5:51**

**AIDING AND ABETTING**  
Indirect infringement, **15:17**

**ALDEN v. DEWEY**  
Anticipation, lack of, **8:7**

**ALEXANDER MILBURN CO. v. DAVIS-BOURNONVILLE CO.**  
Non-obviousness, **9:33**  
Priority, **8:140**

**ALGORITHM**  
Non-statutory hybrid inventions, **5:80**

**ALL-CLAIMS RULE**  
Joint inventorship, **10:38-10:41**

**ALL-ELEMENT RULE**  
Anticipation, lack of, **8:11-8:14, 8:23, 8:32**  
Claims (this index)  
Priority, **8:57**  
Technological scope, **13:22, 13:113**

**ALLERGAN, INC. v. ALCON LABORATORIES, INC.**  
Adequate commerciality, **14:79**

**ALLOCATIONS AND TRADEMARK OFFICE EFFICIENCY ACT**  
Generally, **2:22**

**ALLOYS**  
Static physical configurations, **5:9**

**ALTERNATIVE ORGANIZATION**  
Claims (this index)

**AMBIGUITY**  
Generally, **2:40**  
Non-Obviousness (this index)

**AMENDMENTS**  
Generally, **2:18**  
Adequate Commerciality (this index)  
Adequate disclosure, **7:34, 7:41**  
Adequate utility, **7:38, 7:41**  
Anticipation, lack of, **8:8**  
Claims (this index)  
Correction of inventorship, **10:57, 10:58, 10:63**  
Eleventh Amendment, **1:14**  
Examination of Original Application  
(this index)  
Fourteenth Amendment, **1:14**  
Geographic scope, **12:29, 12:36-12:38**  
History, **1:14, 1:18, 1:20, 1:25**  
Hybrid claim presentations and  
nonlimiting recitations, **4:75-4:78**  
Joint Inventorship (this index)  
1984 amendments to section 116, **8:8**  
Non-Obviousness (this index)  
Prior inventor, prior-user rights,  
**22:10**  
Priority, **8:124**  
Processes, **5:39**  
Static physical configurations, **5:14**  
Statutory subject matter, **5:6**

**AMERICA INVENTS ACT**  
Adequate disclosure, **7:32**  
History, **1:26**  
Processes, **5:33**

**AMERICAN INVENTORS PROTECTION ACT OF 1999**  
Prior inventor, prior-user rights, **22:15**

**AMERICAN MEDICAL ASSOCIATION (AMA)**  
Processes, **5:39**

**AMERICAN STANDARD, INC. v. PFIZER INC.**  
Priority, **8:66**

**AMGEN, INC. v. CHUGAI PHARMACEUTICAL CO., LTD.**  
Priority, **8:45**

**AMUSEMENT**  
Adequate commerciality, **14:12, 14:63**

**AMUSEMENT DEVICES**  
Adequate utility, **6:15**

**ANALOGOUSNESS**  
Non-obviousness, **9:18, 9:19**

**ANDA**  
Abbreviated New-Drug Application (ANDA) (this index)

**ANDREWS v. HOVEY**  
Priority, **8:206, 8:251**

**ANIMALS**  
Adequate utility, **6:5, 6:18**  
Static physical configurations, **5:8, 5:17**  
Statutory subject matter, **5:16-5:18**

**ANNUAL REPORT TO CONGRESS**  
Generally, **2:20**

**ANOTHER**  
Joint Inventorship (this index)  
Non-obviousness, **9:46, 9:47**

**ANTICIPATION, LACK OF**  
Generally, **8:1 et seq.**  
Abandonment (this index)  
Accidental anticipations. Technical sufficiency of invalidating event, below

**ANTICIPATION, LACK OF**  
—Cont'd  
Accidental events, **8:23, 8:25**  
Additional elements, **8:32**  
Adequate disclosure, **8:16**  
Adequate utility, **6:7, 7:18, 7:29, 8:22**  
Alden v. Dewey, **8:7**  
All-element rule, **8:11-8:14, 8:23, 8:32**  
Amendments, **8:8**  
Analogies to paragraphs 102(g) and § 116, **8:5**  
Background information, **8:30**  
Background knowledge, **8:29, 8:32**  
Biotechnology, **8:22**  
Brenner v. Manson, **8:22**  
Business, **8:27**  
Change and modification, **8:22**  
Chemical compound, **8:22**  
Chemistry, **8:22**  
Circumstantial evidence, **8:27**  
Claimed invention, relation to, **8:11-8:14**  
Claims, **4:2, 4:71**  
Coinventor, **8:5**  
Combination, **8:12**  
Commercial exploitation, **8:20**  
Completeness, generally, **8:1**  
Complete vs. substantial prior conception, **8:7**  
Compositions, **8:28**  
Conception, **8:5-8:7, 8:9, 8:14**  
Configuration, **8:25**  
Conflicts, **8:29**  
Congress, **8:8**  
Constitutional law, **8:1**  
Construction and interpretation  
derivation vs. originality, Section 102(f), **8:5, 8:9**  
technical sufficiency of invalidating event, **8:10, 8:14, 8:18, 8:29**  
Contests, **8:6**  
Contribution, **8:5, 8:8, 8:23, 8:26**  
Copying, **8:9**  
Court of Customs and Patent Appeals (CCPA), **8:7, 8:22**

## INDEX

### ANTICIPATION, LACK OF

#### —Cont'd

Creative mental acts and processes, **8:5, 8:6**  
De facto single-source control, **8:20**  
Definition of invent, **8:4**  
Delay, Section 102(d), **8:1**  
Derivation vs. originality, Section 102(f)  
generally, **8:2-8:9**  
analogies to par. 102(g) and § 116, **8:5**  
complete vs. substantial prior conception, **8:7**  
conception only, invent as, **8:6**  
definition of invent, **8:4**  
evidence, **8:9**  
1984 amendments to Section 116, **8:8**  
policy justification, **8:3**  
Devices, **8:28**  
Disclosures, **8:22**  
Disparate onset. Foreign Countries (this index)  
Double patenting, **8:28**  
Effective filing date, **8:22**  
Embodiments, **8:13**  
Enablement. Technical sufficiency of invalidating event, below  
Evidence, **8:9, 8:27, 8:32**  
Exceptions and exclusions, **8:1, 8:14, 8:21**  
Federal Circuit, **8:10, 8:29, 8:31**  
Filing date of application, Section 102(b), generally, **8:1**  
First-in-time concepts, **8:1**  
First-to-invent, **8:1**  
Foreign Countries (this index)  
Genus and specie, **8:13**  
Germany, **8:22**  
Gillman v. Stern, **8:21**  
Great Britain, **8:1**  
History, **1:22**  
How-to-use, **8:22**  
Incorporation of outside sources, **8:30-8:32**  
Incorporation of paragraph 112, par. 1, **8:17**

### ANTICIPATION, LACK OF

#### —Cont'd

Inference, **8:16, 8:32**  
Infringement, **8:18, 8:29**  
Inherency. Technical sufficiency of invalidating event, below  
In re Hafner, **8:22**  
Inoperative disclosures, **8:22**  
Instructions to jury, **8:7**  
Interference, **8:1, 8:6**  
International trade, **8:1**  
Invalidating event. Technical sufficiency of invalidating event, below  
Joint inventorship, **8:8, 10:33, 10:42**  
Justification, **8:3, 8:26-8:28**  
Limitations and restrictions  
derivation vs. originality, Section 102(f), **8:8**  
technical sufficiency of invalidating event, **8:11, 8:25, 8:27, 8:31**  
Mental acts and matters  
derivation vs. originality, Section 102(f), **8:5, 8:6**  
technical sufficiency of invalidating event, **8:23**  
Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co., **8:21**  
Mitchell v. Tighlman, **8:27**  
1984 amendments to Section 116, **8:8**  
Non-informing public use, **8:20**  
Non-limiting recitations, effect of, **8:14**  
Non-Obviousness (this index)  
Non-statutory hybrid inventions, **5:53, 5:71, 5:74, 5:84**  
Notice and knowledge. Technical sufficiency of invalidating event, below  
Novelty, Section 102(b), generally, **8:1**  
On-sale activity, paragraph 102(b), **8:20**  
Ordinary course of prosecution, **8:22**  
Ordinary skill in the art  
technical sufficiency of invalidating event, **8:29, 8:31**

**ANTICIPATION, LACK OF****—Cont'd**

Originality, Section 102(f), generally, **8:1**  
 Outside sources, **8:30-8:32**  
 Patentability, generally, **8:1**  
 Patent Act of 1790, **8:1**  
 Patent Act of 1836, **8:1**  
 Patent and Trademark Office (PTO), **2:3, 8:14, 8:21**  
 Peerless Roll Leaf Co. v. H. Griffin & Sons, **8:21**  
 Pharmaceutical arts, **8:29**  
 Policy justification, **8:3, 8:18, 8:21, 8:26-8:28**  
 Possession, **8:10, 8:18-8:20, 8:30**  
 Potential conflicts, **8:29**  
 Practical utility, **8:22**  
 Preservation of public domain, **8:28**  
 Printed publications, paragraph 102(b), **8:19**  
 Prior art, **8:7, 8:24**  
 Prior conception, **8:7**  
 Prior events. Technical sufficiency of invalidating event, below  
 Prior filing, **8:21**  
 Priority, generally, **8:1**  
 Prior public possession, **8:18**  
 Prior public use, paragraph 102(b), **8:21**  
 Prior use, **8:18**  
 Processes, **5:24, 8:28**  
 Publication, **8:19, 8:31**  
 Public possession, **8:19, 8:30**  
 Public use, **8:21**  
 Qualification  
     derivation vs. originality, Section 102(f), **8:7**  
     technical sufficiency of invalidating event, **8:12, 8:18, 8:19, 8:22**  
 Recitations, **8:14**  
 Reduction-to-practice, **8:5, 8:6, 8:8**  
 Reference, **8:13, 8:22, 8:25**  
 Regular result, **8:25**  
 Research and development, **8:27**  
 Sales, **8:20**  
 Secret public use, **8:21**

**ANTICIPATION, LACK OF****—Cont'd**

Section 102, generally, **8:1**  
 Section 102(a), **8:18**  
 Section 102(b), **8:19-8:22**  
 Section 102(c). Abandonment (this index)  
 Section 102(d). Foreign Countries (this index)  
 Section 103, **8:23**  
 Section 103 vs. Section 112, par. 1, **8:31**  
 Section 116, **8:6**  
 Section 119, **8:22**  
 Seymour v. Osbourne, **8:18, 8:31**  
 Single-source control, **8:20**  
 Skilled in the art, **8:31**  
 Specification, **8:22**  
 Sporadic vs. regular result, **8:25**  
 Static physical configurations, **5:9, 5:16**  
 Statutory subject matter, **5:1**  
 Subcombination, **8:12**  
 Substantial prior conception, **8:7**  
 Sufficiency. Technical sufficiency of invalidating event, below  
 Supplements, **8:31**  
 Supreme Court, **8:18, 8:22, 8:27**  
 Teaching, **8:19, 8:31**  
 Technical completeness, generally, **8:1**  
 Technical sufficiency of invalidating event  
     generally, **8:10-8:32**  
     accidental anticipations and inherency  
     generally, **8:23-8:29**  
     circumstantial evidence, **8:27**  
     obviousness, anticipation vs., **8:24**  
     policy justifications, **8:26-8:28**  
     potential conflicts, **8:29**  
     preservation of public domain, **8:28**  
     sporadic vs. regular result, **8:25**  
     all-elements rule, **8:11-8:14**  
     background knowledge vs. additional elements, **8:32**

## INDEX

**ANTICIPATION, LACK OF**  
—Cont'd  
Technical sufficiency of invalidating event—Cont'd  
claimed invention, relation to, **8:11-8:14**  
combination, **8:12**  
enabling knowledge, required presence of generally, **8:15-8:22**  
incorporation of paragraph 112, par. 1, **8:17**  
inoperative disclosures, **8:22**  
on-sale activity, paragraph 102(b), **8:20**  
paragraph 102(a), **8:18**  
paragraph 102(b), **8:19-8:22**  
printed publications, paragraph 102(b), **8:19**  
prior public use, paragraph 102(b), **8:21**  
underlying rationale, relation to, **8:16**  
genus and specie, **8:13**  
incorporation of outside sources, **8:30-8:32**  
inherency. Accidental anticipations and inherency, above in this group  
knowledge. Enabling knowledge, required presence of, above in this group  
non-limiting recitations, effect of, **8:14**  
Section 103 vs. Section 112, par. 1, **8:31**  
subcombination, **8:12**  
Technological completeness, **8:32**  
Tests, **8:5**  
Tighlman v. Proctor, **8:27**  
Time and date, **8:1**  
Time-wise priority, **8:5**  
Timing of event. Priority (this index)  
Underlying rationale, relation to, **8:16**  
Use, **8:21**  
Validation. Technical sufficiency of invalidating event, above  
Value judgment, **8:1**

**ANTI-SLAVERY PROVISIONS**  
Static physical configurations, **5:17**  
**ANTITRUST**  
Claims, **4:80**  
History, **1:7**  
**ANY MENTAL ACTIVITY**  
Processes, **5:27**  
**ANY NEW AND USEFUL ART, MACHINE, MANUFACTURE, OR COMPOSITION OF MATTER**  
Statutory Subject Matter (this index)  
**ANY NEW AND USEFUL PROCESS, MACHINE, MANUFACTURE, OR COMPOSITION OF MATTER**  
Statutory Subject Matter (this index)  
**ANY USEFUL ART, MANUFACTURE, ENGINE, MACHINE, OR DEVICE, OR ANY IMPROVEMENT THEREIN**  
Statutory Subject Matter (this index)  
**APA**  
Administrative Procedure Act (APA) (this index)  
**APPARATUS**  
Adequate utility, **6:15, 7:24**  
Descriptions, **5:29**  
Geographic scope, **12:25, 12:33**  
Non-statutory hybrid inventions, **5:80**  
Processes (this index)  
Static physical configurations, **5:8**  
**APPEAL AND REVIEW**  
See also Judicial Review (this index)  
Adequate Commerciality (this index)  
Adequate disclosure, **7:52, 7:54, 7:57**  
Appellate Division of United States Court of Claims, **2:37**  
Board of Patent Appeals and Interferences (BPAI) (this index)  
Claims (this index)  
Computer-related inventions, **5:42**  
Correction of inventorship, **10:64**

**APPEAL AND REVIEW—Cont'd**

Court of Customs and Patent Appeals (CCPA) (this index)  
De novo review on appeal, 2:39  
District Court (this index)  
Examination of Original Application (this index)  
History, 1:19, 1:21, 1:24  
Indirect infringement, 15:8, 15:9, 15:12, 15:22  
Joint inventorship, 10:38, 10:51  
Non-Obviousness (this index)  
Non-Statutory Hybrid Inventions (this index)  
Patent and Trademark Office (PTO) decisions, generally, 2:9  
Priority, 8:46, 8:60  
Processes, 5:21, 5:26, 5:27, 5:30, 5:35  
Reexamination, 16:126  
Static physical configurations, 5:9, 5:12, 5:15, 5:17  
Temporal scope, 11:29  
Utility Requirement (this index)

**APPLICANT**

Joint inventorship, joint applicants distinguished, 10:21

**APPLICATION**

Generally, 2:12, 2:32  
Adequate Commerciality (this index)  
Adequate disclosure, 7:56  
Claims (this index)  
Correction of inventorship, 10:56  
Examination of Original Applications (this index)  
Filing Application (this index)  
Filing Date of Application (this index)  
Foreign Countries (this index)  
Geographic scope, 12:40  
History, 1:18  
Inventorship, 10:8  
Joint Applications (this index)  
Joint Inventorship (this index)  
Noninfringement pleading, 17:9-17:13  
Non-Obviousness (this index)

**APPLICATION—Cont'd**

Policy justification, 1:38  
Priority (this index)  
Processes, 5:24, 5:26  
Static physical configurations, 5:8, 5:9  
Technological scope, 13:106  
Temporal Scope of Infringement (this index)  
Utility Requirement (this index)

**APPLIED TECHNOLOGY**

Non-statutory hybrid inventions, 5:61  
Statutory Subject Matter (this index)

**APPOINTMENT TO OFFICE**

Patent and Trademark Office (PTO), 2:22

**APPRECIATION**

Priority, 8:46, 8:58  
Subjectivity (this index)

**ARBITRARY, CAPRICIOUS OR ABUSE OF DISCRETION**

Judicial review, 2:41

**ARIAD PHARMACEUTICALS, INC. v. ELI LILLY AND CO.**

Adequate disclosure, 7:38

**ARISTOTLE**

History, 1:2

**ARO MFG. CO. v. CONVERTIBLE TOP REPLACEMENT CO.**

Adequate commerciality, 14:32  
Indirect infringement, 15:11, 15:12, 15:20, 15:24

**ARRHYTHMIA RESEARCH TECHNOLOGY, INC. v. CORAZONIX CORP.**

Computer-related inventions, 5:44

**ARTICLE I**

History, 1:10  
Patent and Trademark Office (PTO), 2:1

**ARTICLES OF CONFEDERATION**

Patent and Trademark Office (PTO), 2:4

## INDEX

### **AS A WHOLE**

Claims, hybrid claim presentations and nonlimiting recitations, **4:82**  
Non-obviousness, **9:1, 9:5, 9:6, 9:12**  
Non-statutory hybrid inventions, **5:48, 5:56**

### **ASEXUALLY REPRODUCED PLANTS**

Static physical configurations, **5:12**

### **ASSIGNING MEANINGS**

Claims (this index)

### **ASSIGNMENT**

Adequate disclosure, **7:54**  
Adequate utility, **7:51**  
Correction, **10:66-10:68**  
Defenses, estoppel, **17:42, 17:43**  
History, **1:16**  
Inventorship (this index)  
Non-obviousness, **9:46, 9:47**

### **ASSISTANTS**

Commissioners, **2:22**  
Judge of circuit court, **2:33**  
Secretary of commerce, **2:22**

### **ASSOCIATIONS**

History, **1:4**

### **ASSUMPTION**

Adequate disclosure, **7:29**

### **AS-YET-UNDISCOVERED**

Adequate utility, **7:14**

### **AT TIME INVENTION WAS MADE**

Non-obviousness, **9:21**

### **ATHENAEUS**

History, **1:2**

### **ATLANTIC THERMOPLASTICS CO. v. FAYTEX CORP.**

Claims, **4:74**

### **AT&T CORP. v. EXCEL COMMUNICATIONS, INC.**

Computer-related inventions, **5:44**

### **AT THE TIME INVENTION WAS MADE**

Non-obviousness, **9:32**

### **AT THE TIME THE INVENTION WAS MADE**

Non-obviousness, **9:21, 9:24**

### **ATTORNEY GENERAL**

Patent and Trademark Office (PTO), **2:15, 2:20**

### **ATTORNEYS**

Laches, lack of counsel, unreasonable delay, **2:22**  
Patent and Trademark Office (PTO), **2:22**

### **ATTORNEYS' FEES**

Adequate commerciality, **14:78**

### **AT&T v. EXCEL COMMUNICATIONS, INC.**

Processes, **5:23, 5:37**

### **AUKERMAN v. CHAIDES**

Laches, **23:16**

### **AUTHORS AND AUTHORSHIP**

History, **1:11**  
Inventorship, **10:6, 10:16**  
Static physical configurations, **5:11**

### **AVOIDANCE**

Defenses, **17:6**

### **BACK FIRING**

Claims, **4:85**

### **BACKGROUND**

Adequate utility, **7:10, 7:13, 7:16, 7:19**

Anticipation, lack of, **8:29, 8:30, 8:32**

Non-obviousness, **9:17, 9:19, 9:74**

### **BACTERIA**

Static physical configurations, **5:14, 5:17**

### **BAIN v. MORSE**

Central vs. peripheral claiming, **4:9**  
Priority, **8:101, 8:197**

### **BASS**

Non-obviousness, **9:37**

### **BATTIN v. TAGGERT**

Reissue of patent, **16:21**

**BAUER & CIE v. O'DONNELL**  
Adequate commerciality, 14:33, 14:39  
Express and implied licenses, 19:19  
Indirect infringement, 15:6, 15:7  
Misuse of patent, 18:13

**BAYER AG v. SCHEIN PHARMACEUTICALS, INC.**  
Adequate disclosure, 7:52, 7:53

**BEDFORD v. HUNT**  
Adequate utility, 6:4, 6:6, 6:7, 6:9

**BEMIS v. CHEVRON RESEARCH CO.**  
Correction of inventorship, 10:64

**BEST MODE**  
Adequate Disclosure (this index)  
Adequate utility, 7:1, 7:5, 7:9  
America Invents Act, diminution of defense, 1:26

**BEYOND REASONABLE DOUBT**  
Priority, 8:68, 8:69

**BIFURCATED TREATMENT**  
History, 1:5

**BIGHAM v. GODTFREDSEN**  
Priority, 8:66

**BILATERAL CONTRACT**  
Justification, 1:38

**BILSKI v. KAPPOS**  
Processes, 5:32

**BINARY CLASSIFICATION**  
Non-statutory hybrid inventions, 5:58

**BINARY-CODED DECIMALS (BCD)**  
Computer-related inventions, 5:44

**BIOENGINEERING**  
Static physical configurations, 5:13

**BIOLOGICAL COMPONENTS**  
Static physical configurations, 5:17

**BIOLOGICAL DEPOSITS**  
Adequate disclosure, 7:22  
Adequate utility, 7:9

**BIOLOGICAL MATERIALS**  
Adequate disclosure, 7:11  
Statutory subject matter, 5:6

**BIOLOGICAL PROCESSES**  
Claims, 4:6

**BIOMATERIAL DEPOSITORY**  
Adequate utility, 7:37

**BIOTECHNOLOGICAL PROCESS PATENT AMENDMENT ACT OF 1995**  
Non-obviousness, 9:1, 9:82, 9:83

**BIOTECHNOLOGY**  
Adequate utility, 6:6, 7:14  
Anticipation, lack of, 8:22  
Claims, 4:75, 4:77, 4:80  
Non-Obviousness (this index)  
Priority, 8:50  
Processes, 5:39  
Static physical configurations, 5:14  
Statutory subject matter, 5:1, 5:2, 5:16-5:18

**BLACKLEDGE v. WEIR & CRAIG MFG. CO.**  
Joint inventorship, 10:51

**BLACKSTONE'S COMMENTARIES**  
Inventorship, 10:4

**BLAKE v. SMITH**  
Indirect infringement, 15:4

**BLOCKING PATENT**  
Claims, 4:63

**BLONDER-TONGUE LABORATORIES, INC. v. UNIVERSITY OF ILLINOIS FOUNDATION**  
Invalidity, 17:28-17:31

**BLUE-PENCIL RULE**  
Non-Statutory Hybrid Inventions (this index)

**BOARD OF EXAMINERS**  
Patent and Trademark Office (PTO), 2:32, 2:33

## INDEX

**BOARD OF PATENT APPEALS AND INTERFERENCES (BPAI)**  
Generally, 2:22, 2:37  
Computer-related inventions, 5:42  
Joint inventorship, 10:46  
Judicial review of decisions, 2:38  
Non-statutory hybrid inventions, 5:83  
Priority, 8:46, 8:66

**BOARD OF USEFUL ARTS**  
Non-obviousness, 9:2

**BONITO BOATS V. THUNDER CRAFT BOATS**  
Historical origins of patent grant, 1:13.70

**BPAI**  
Board of Patent Appeals and Interferences (BPAI) (this index)

**BRAND NAMES**  
Adequate disclosure, 7:12

**BREACH**  
Invalidity, 17:40

**BREADTH AND NARROWNESS**  
Claims, 4:63

**BREADTH OF CLAIM**  
Adequate disclosure, 7:4, 7:23-7:26, 7:33

**BREATHE LIFE AND MEANING INTO STATEMENTS IN BODY**  
Claims, 4:99

**BREEDING**  
Static physical configurations, 5:15, 5:17

**BRENNER v. MANSON**  
Adequate disclosure, 7:14  
Adequate utility, 6:6, 6:7, 6:17-6:19  
Anticipation, lack of, 8:22  
Priority, 8:50, 8:53, 8:57

**BROWN v. DUCHESNE**  
Geographic scope, 12:4

**BUBBLE HIERARCHY**  
Non-statutory hybrid inventions, 5:78  
Processes, 5:23

**BUDDING**  
Static physical configurations, 5:14

**BURDEN OF PLEADING**  
Six-year limitation, 21:20

**BURDEN OF PROOF**  
Adequate utility, 6:16, 7:46  
Claims, 4:2, 4:74, 4:93  
Invalidity, 17:17  
Laches, 23:39  
Non-obviousness, 9:75  
Patent and Trademark Office (PTO), 2:13  
Six-year limitation, 21:19  
Technological scope, 13:84

**BURR v. DURYEE**  
Reissue of patent, 16:28

**BUSINESS ENTITIES AND METHODS**  
Anticipation, lack of, 8:27  
Inventorship (this index)  
Joint inventorship, 10:52  
Non-statutory hybrid inventions, 5:80  
Processes, 5:23, 5:32.50  
Static physical configurations, 5:10  
Statutory Subject Matter (this index)

**CALCULATIONS**  
Non-statutory hybrid inventions, 5:81, 5:83  
Reissue of patent, 16:117

**CAMPBELL v. CITY OF HAVERHILL**  
Laches, 23:8  
Six-year limitation, 21:6

**CANCELLATION**  
Claims, 4:1  
Technological scope, 13:104

**CAP**  
Claims, 4:97, 4:98

**CAPITAL EXPENDITURES**  
Inventorship, 10:17

**CAPITAL RESOURCES**  
Inventorship, 10:17

**CARBICE CORPORATION OF AMERICA v. AMERICAN PATENTS DEVELOPMENT CORPORATION**  
Indirect infringement, **15:8-15:10**  
Misuse of patent, **18:15**

**CARDINAL CHEMICAL CO. v. MORTON INTERNATIONAL, INC.**  
Invalidity, **17:24, 17:25**

**CARLTON v. VOKEE**  
Reissue of patent, **16:29**

**CARTER RULE**  
Joint inventorship, **10:53**

**CARTER v. BRAINTREE**  
Reissue of patent, **16:19**

**CASE LAW**  
See specific case headings throughout this index  
See also Supreme Court (this index)  
Adequate disclosure, **7:9, 7:25**  
Adequate utility, **6:14, 7:2, 7:14, 7:23, 7:46**  
Bonito Boats v. Thunder Craft Boats, **1:13:70**  
Compco Corp. v. Day Brite Lighting, Inc., **1:13:50**  
Description requirement, disclosure, **7:37, 7:38**  
Disclosure, **7:37, 7:38**  
Erie Railroad v. Tompkins, **1:13:30**  
Kewanee Oil Co. v. Bicron Corp., **1:13:60**  
Medical and diagnostic procedures, Pallin v. Singer, section 287(c) defense, **20:5**  
Metallizing Engineering v. Kenyon Bearing, **8:243**  
Misuse of patent, **18:19-18:21**  
Misuse of Patent (this index)  
Non-Obviousness (this index)  
Non-statutory hybrid inventions, **5:53, 5:72, 5:73-5:75, 5:83-5:85**  
Patent and Trademark Office (PTO), **2:20, 2:26, 2:28, 2:34, 2:43, 2:48**

**CASE LAW—Cont'd**  
Policy justification, **1:29**  
Prior inventor, prior-user rights, section 273 defense, **22:2-22:16**  
Priority, **8:50, 8:56, 8:63**  
Processes, **5:21, 5:22, 5:24-5:26**  
Reissue of patent, **16:44**  
Six-year limitation, section 286 defense, **21:2-21:15**  
Static physical configurations, **5:15, 5:17**  
Stiffel Co. v. Sears, Roebuck & Co., **1:13:40**  
Technological Scope of Infringement (this index)  
Utility requirement, **6:14**

**CATEGORIES OF ESTOPPEL**  
Early categories, **24:5**

**CAUSES OF ACTION**  
History, **1:14**  
Reissue of patent, **16:48, 16:49**

**CCPA**  
Court of Customs and Patent Appeals (CCPA) (this index)

**CENTRAL CLAIMING**  
Claims (this index)  
Technological scope, **13:5-13:7, 13:114**

**CERTIFICATES AND CERTIFICATION**  
Adequate commerciality, **14:78**  
Static physical configurations, **5:14, 5:15**

**CERTIORARI**  
Adequate utility, **6:6**  
Non-obviousness, **9:33**  
Patent and Trademark Office (PTO), **2:34, 2:43**  
Static physical configurations, **5:17**

**CHALLENGES**  
Patent and Trademark Office (PTO), **2:15**  
Processes, **5:39**

## INDEX

**CHANGE AND MODIFICATION**  
Adequate commerciality, **14:30, 14:64**  
Adequate utility, **6:18, 7:13, 7:22, 7:38**  
Anticipation, lack of, **8:22**  
Claims, **4:5, 4:6, 4:94, 4:101**  
Correction (this index)  
Examination of Original Application (this index)  
History, **1:16, 1:23, 1:25**  
Inventorship, **10:7, 10:14, 10:18, 10:45**  
Joint inventorship, **10:45, 10:50**  
Non-Obviousness (this index)  
Non-statutory hybrid inventions, **5:68, 5:81**  
Patent and Trademark Office (PTO), generally, **2:1**  
Processes, **5:19, 5:24, 5:28, 5:30**  
Static physical configurations, **5:14**  
Temporal scope, **11:12-11:15**

**CHARGE TO JURY**  
Adequate utility, **6:9**  
Priority, **8:44**

**CHECKPOINT SYSTEMS, INC. v. U.S. INTERN. TRADE COM'N**  
Correction of inventorship, **10:67**

**CHEMICAL ARTS**  
Adequate commerciality, **14:61**

**CHEMICALS AND CHEMISTRY**  
Generally, **5:5, 5:9**  
Adequate disclosure, **7:25, 7:26**  
Adequate utility  
    generally, **6:7, 6:19**  
    markers, construction of, **6:18**  
    process, **6:17**  
    products, **6:1, 6:6, 6:16**  
Anticipation, lack of, **8:22**  
Bonding, **5:9**  
Claims (this index)  
Compositions, **5:17**  
Field, **5:8**  
Hybrid claim presentations and nonlimiting recitations, **4:75-4:78**

**CHEMICALS AND CHEMISTRY**  
—Cont'd  
Non-Obviousness (this index)  
Priority, **8:46, 8:50**  
Processes, generally, **5:39**  
Static physical configurations, **5:8, 5:9, 5:17**  
Statutory Subject Matter (this index)

**CHEVRON U.S.A., INC. v. NATURAL RESOURCES DEFENSE COUNCIL**  
Generally, **2:48**

**CHIEF JUSTICE OF DISTRICT COURT OF DISTRICT OF COLUMBIA**  
Patent and Trademark Office (PTO), **2:33**

**CIRCUIT COURT FOR DISTRICT OF COLUMBIA CIRCUIT**  
Non-obviousness, **9:33**

**CIRCUIT COURTS**  
Generally, **2:33**  
Ninth Circuit Court of Appeals, **5:27**  
Regional federal circuit courts of appeal, **1:24**

**CIRCUITS (HARDWARE)**  
Computer-related inventions, **5:41**

**CIRCUMSTANTIAL EVIDENCE**  
Adequate commerciality, **14:16**  
Adequate utility, **6:20**  
Anticipation, lack of, **8:27**  
Claims, **4:31**  
Indirect infringement, **15:15, 15:16, 15:22, 15:24**  
Non-Obviousness (this index)  
Priority (this index)

**CIRCUMSTANTIAL INFERENCE**  
Indirect infringement, **15:15**

**CITY OF ELIZABETH v. NICHOLSON PAVEMENT CO.**  
Priority, **8:250**

**CIVIL ACTIONS**  
Invalidity, full and fair opportunity to litigate, **17:31**

**CIVIL ACTIONS—Cont'd**

Patent and Trademark Office (PTO),  
**2:7, 2:38**  
 Priority, **8:68**  
 Processes, **5:39**

**CLAIMED**

Defined, **13:98**

**CLAIMS**

Generally, **4:1 et seq.**  
 Abstract identifier, **4:97**  
 Accuracy, definitional, **4:9**  
 Adequate disclosure, **4:2, 7:7-7:9**  
 Administrative proceedings, **4:6**  
 Administrative publications, **4:2**  
 All-elements rule  
   hybrid claim presentations and  
   nonlimiting recitations, **4:71-**  
**4:74, 4:80-4:82**  
   policy justification and historical  
   development, **4:6**  
   tripartite form of individual claims,  
**4:97**  
 Alternative organization. Central vs.  
   peripheral claiming, below  
 Amendment of claim, **4:69**  
 Amendment of language, **4:94**  
 Amendment of statutes  
   Biotechnological Process Patent  
   Amendments Act of 1995,  
**4:75, 4:77**  
   multiple claims in single patent,  
**4:102**  
   policy justification and historical  
   development, **4:5, 4:6**  
   section 103(b), 1995, **4:75-4:78**  
 Anticipation, lack of, **4:2, 4:71, 8:11-**  
**8:14**  
 Antitrust, **4:80**  
 Appeal and review  
   central vs. peripheral claiming, **4:9**  
   construction and interpretation,  
**4:19**  
   hybrid claim presentations and  
   nonlimiting recitations, **4:76,**  
**4:80**  
   means expressions, **4:93**  
   policy justification and historical  
   development, **4:6**

**CLAIMS—Cont'd**

As a whole, consideration, **4:82**  
 Assigning meanings  
   peripheral claiming, below  
   policy justification and historical  
   development, **4:2**  
 Atlantic Thermoplastics Co. v. Faytex  
 Corp., **4:74**  
 Back firing, **4:85**  
 Bain v. Morse, **4:9**  
 Biological processes, **4:6**  
 Biotechnological Process Patent  
   Amendments Act of 1995, **4:75,**  
**4:77, 4:80**  
 Biotechnology, **4:77, 4:80**  
 Blocking patent, **4:63**  
 Body, **4:96, 4:97**  
 Breadth and narrowness, **4:63**  
 Breathe life and meaning into state-  
   ments in body, **4:99**  
 Burden of countering alternative  
   position, **4:2**  
 Burden of proof, **4:74, 4:93**  
 Cancellation of claims, **4:1**  
 Cap, **4:97, 4:98**  
 Central claiming  
   generally, **4:2-4:6**  
   adequate utility, **7:5, 7:46**  
   history, **1:21, 1:23**  
   means expressions, below  
   peripheral claiming compared.  
   Central vs. peripheral claim-  
   ing, below  
   processes, **5:21**  
 Central vs. peripheral claiming  
   generally, **4:8-4:62**  
   alternative organization. Construc-  
   tion and interpretation, below  
   in this group  
 construction and interpretation  
   generally, **4:10-4:60**  
   alternative organization  
   generally, **4:54-4:60**  
   application to claims, **4:58-**  
**4:60**  
   general example of semantic  
   and pragmatic meanings,  
**4:56**  
   illustrative diagram, **4:59**

## INDEX

### CLAIMS—Cont'd

Central vs. peripheral claiming  
—Cont'd  
construction and interpretation  
—Cont'd  
alternative organization  
—Cont'd  
illustrative diagram of  
semantic and pragmatic  
meanings, **4:57**  
recommendation, **4:60**  
semantic and pragmatic  
meanings, **4:55-4:57**  
contract interpretation, **4:52**,  
**4:53**  
decision maker. Identity of decision  
maker, below this  
group  
extrinsic sources. Intrinsic vs.  
extrinsic sources, below in  
this subgroup  
fact, law versus. Law versus  
fact, below in this subgroup  
hierarchy of sources, generally,  
**4:32-4:60**  
historical development  
generally, **4:33-4:40**  
Johnson Worldwide v. Zebco,  
**4:36**  
Phillips v. AWH, **4:39**  
subsequent developments,  
**4:40**  
Texas Digital Instruments v.  
Telegenix, **4:38**  
Toro v. White Consol.  
Industries, **4:37**  
Vitronics Corp. v.  
Conceptronic, Inc., **4:34**  
identity of decision maker  
generally, **4:11-4:24**  
judge versus jury, below in  
this subgroup  
law versus fact, below this  
subgroup  
instructions to jury. Judge versus  
jury, below in this subgroup  
intrinsic vs. extrinsic sources  
generally, **4:41, 4:50-4:53**

### CLAIMS—Cont'd

Central vs. peripheral claiming  
—Cont'd  
construction and interpretation  
—Cont'd  
intrinsic vs. extrinsic sources  
—Cont'd  
contract interpretation analysis, **4:52, 4:53**  
statutory interpretation,  
contrast with, **4:51**  
judge versus jury  
generally, **4:21-4:24**  
application to interpretation,  
**4:23, 4:24**  
example decisions, **4:24**  
instructions to jury, generally,  
**4:22**  
verdicts, generally, **4:22**  
jury. Judge versus jury, above in  
this subgroup  
law versus fact  
generally, **4:12-4:20**  
appellate review, **4:19**  
corollary issues, **4:18-4:20**  
finality, **4:19**  
Lighting Ballast Control LLC  
v. Phillips Electronic  
North America Corp.,  
**4:17.50**  
Markman v. Westview Instruments,  
**4:16, 4:17.50, 4:17.75**  
mixed questions of law and  
fact, **4:14**  
preclusion of issue, **4:20**  
stare decisis, **4:20**  
Teva Pharmaceuticals USA,  
Inc. v. Sandoz, Inc.,  
**4:17.50**  
underlying questions of fact,  
**4:17-4:17.50**  
patentability versus validity,  
**4:62**  
questions of law and fact. Law  
versus fact, above in this  
subgroup  
required process, **4:61**

**CLAIMS—Cont'd**

Central vs. peripheral claiming  
—Cont'd  
construction and interpretation  
—Cont'd  
special sub-rules  
    generally, **4:42-4:49**  
    claims, **4:43**  
    contra proferentum, **4:48**  
    dictionaries, **4:46**  
    expert testimony, **4:47**  
    prosecution history, **4:45**  
    specification, **4:44**  
    validity, preservation of, **4:49**  
statutory interpretation  
    contrasted with intrinsic  
    and extrinsic sources, **4:51**  
target meaning  
    generally, **4:25-4:31**  
    application to patent  
        interpretations, **4:29-4:31**  
    author and recipient mean-  
    ings, generally, **4:26-4:28**  
    contract interpretation,  
        example, **4:28**  
    patentee's intended meaning  
        as circumstantial evi-  
        dence, **4:31**  
    patentee's meaning versus  
    recipient's meaning,  
        **4:30, 4:31**  
    statutory interpretation,  
        example, **4:27**  
    verdicts. Judge versus jury,  
        above in this subgroup  
definitional accuracy, **4:9**  
evidence, intrinsic vs. extrinsic  
sources. Construction and  
interpretation, above in this  
group  
extrinsic sources. Construction and  
interpretation, above in this  
group  
fact. Construction and interpreta-  
tion, above in this group  
Federal Circuit courts  
    historical development, deci-  
    sions after Vitronics, **4:35-4:38**

**CLAIMS—Cont'd**

Central vs. peripheral claiming  
—Cont'd  
Federal Circuit courts—Cont'd  
Johnson Worldwide v. Zebco,  
    **4:36**  
notice and definitional accuracy,  
    **4:9**  
Texas Digital Instruments v.  
    Telegenix, **4:38**  
Toro v. White Consol.  
    Industries, **4:37**  
historical development. Construc-  
    tion and interpretation, above  
    in this group  
instructions to jury. Construction  
    and interpretation, above in  
    this group  
intrinsic vs. extrinsic sources.  
    Construction and interpreta-  
    tion, above in this group  
law vs. fact. Construction and  
    interpretation, above in this  
    group  
notice, **4:9**  
questions of law and fact.  
    Construction and interpreta-  
    tion, above in this group  
special sub-rules. Construction and  
    interpretation, above in this  
    group  
target meaning. Construction and  
    interpretation, above in this  
    group  
verdicts. Construction and inter-  
    pretation, above in this group  
Change and modification  
    generally, **4:5, 4:6, 4:94, 4:101**  
    see also entries beginning:  
        "Amendment, " above  
Chemicals  
    dominance and subservience, **4:65,**  
        **4:66**  
    hybrid claim presentations and  
        nonlimiting recitations, **4:73-4:76, 4:80-4:82**  
    policy justification and historical  
        development, **4:4, 4:6**  
    starting and ending materials,  
        **4:75-4:78**

## INDEX

### CLAIMS—Cont'd

Circumstantial evidence, 4:31  
Clinton Administration, 4:77  
Closed formats, 4:98  
Code of Federal Regulations (CFR), 4:73  
Combinations  
    dominance and subservience, below  
    means expressions, below  
    subcombination, 4:64  
Commentary, means expressions, 4:90  
Common law, 4:5, 4:77, 4:78  
Competitors, 4:2  
Comprising, 4:98  
Compulsory license, 4:63  
Computer industry, 4:81  
Configurations, 4:87, 4:94  
Conflict between tribunals, 4:80  
Congress  
    definiteness and notice, 4:94  
    hybrid claim presentations and nonlimiting recitations, 4:75, 4:80  
    means expressions, 4:87, 4:88, 4:93  
    multiple claims in single patent, 4:103  
    policy justification and historical development, 4:5, 4:6  
Consisting essentially of, 4:98  
Consisting of, 4:98  
Construction and interpretation, generally, 4:1 *et seq.*  
Contract interpretation, 4:28, 4:52, 4:53  
Contra proferentum, 4:48  
Contributions, 4:9, 4:64, 4:83  
Corresponding structure, 4:5, 4:91, 4:93  
Costs and expenses, 4:63, 4:73, 4:83, 4:94  
Court of Appeals, 4:76  
Court of Appeals for Federal Circuit, 4:6, 4:80, 4:88, 4:93  
Court of Customs and Patent Appeals (CCPA), 4:76, 4:93  
Cross licenses, 4:63

### CLAIMS—Cont'd

Damages, 4:80  
Decision maker. Central vs. peripheral claiming, above  
Defective specification, 4:2  
Definiteness, 4:6, 4:94  
Definitional accuracy, 4:9  
Definition of patent rights, generally, 4:4  
Dependent, multiply, 4:5  
Dependent claims, 4:102, 4:103  
Dependent form, 4:5  
Determinations, 4:72, 4:73, 4:91  
Diagrams, 4:63, 4:97  
Dictionaries, 4:46  
Disclaimers, 4:2  
Disclosure, see lines throughout this index topic  
Discretion of applicants, 4:2  
District courts  
    definiteness and notice, 4:94  
    hybrid claim presentations and nonlimiting recitations, 4:73, 4:80, 4:81  
    means expressions, 4:93  
    policy justification and historical development, 4:6  
DNA sequences, 4:66  
Doctrine of Equivalents  
    central vs. peripheral claiming, 4:9  
    means expressions, 4:87, 4:88, 4:92  
    policy justification and historical development, 4:4, 4:6  
Doctrine of Overclaiming, 4:64  
Dominance and subservience  
    generally, 4:7, 4:63-4:66  
    genus and specie, 4:65  
    infringement, 4:66  
    limitations and restrictions, 4:63, 4:65  
    product method, 4:66  
    subcombination, 4:64  
    tripartite form of individual claims, 4:97  
Drawing, 4:2  
Electrical arts, 4:65  
Electronics industry, 4:81

**CLAIMS—Cont'd**

Embodiments  
 central vs. peripheral claiming, **4:8**  
 dominance and subservience, **4:63, 4:64**  
**4:87, 4:89, 4:91, 4:92**  
 means expressions, **4:84, 4:86, 4:87, 4:89, 4:91, 4:92**  
 policy justification and historical development, **4:2, 4:3**  
**En banc, 4:74, 4:78, 4:93**  
**English law, 4:2**  
**Entitlement, 4:2, 4:6**  
**Equivalents**  
 Doctrine of Equivalents, above  
 mechanical equivalents, **4:84, 4:86, 4:92**  
 structural equivalents, **4:92**  
**Europe, 4:80**  
**European Patent Convention, 4:73**  
**Evans v. Eaton, 4:2**  
**Evidence**  
 central vs. peripheral claiming, above  
 hybrid claim presentations and nonlimiting recitations, **4:73, 4:74, 4:80**  
 means expressions, **4:93**  
**Examination**  
 dominance and subservience, **4:69**  
 ex parte examination, **4:94**  
 policy justification and historical development, **4:3**  
**Exceptions and exclusions**  
 central vs. peripheral claiming, **4:8**  
 dominance and subservience, **4:64**  
 hybrid claim presentations and nonlimiting recitations, **4:75**  
 means expressions, **4:85**  
 policy justification and historical development, **4:4**  
 tripartite form of individual claims, **4:99**  
**Ex parte examination, 4:94**  
**Ex parte Markush, 4:100**  
**Ex parte prosecution, 4:87, 4:89**  
**Expert testimony, 4:47**  
**Expressions. Means expressions, below**

**CLAIMS—Cont'd**

Extrinsic sources. Central vs. peripheral claiming, above  
**Fact. Central vs. peripheral claiming, above**  
**Federal Circuit courts**  
 central vs. peripheral claiming, above  
 hybrid claiming, below  
 means expressions, **4:88, 4:91, 4:93**  
 policy justification and historical development, **4:6**  
**Federal trial courts, 4:80**  
**Finality, 4:19**  
**Foreign countries, 4:8, 4:9, 4:63**  
**Formal statement, 4:2**  
**Format required, generally, 4:95-4:103**  
**Genus and specie, 4:4, 4:63, 4:65**  
**Germany, 4:8**  
**Grammatical structure, 4:87**  
**Halliburton Oil Well Cementing Co. v. Walker, 4:86**  
**History**  
 generally, **4:1**  
 central vs. peripheral claiming, above  
 means expressions, below  
 policy justification and historical development, below  
**Hybrid claiming**  
 generally, **4:68-4:79**  
 amendments to section 103(b), 1995, **4:75-4:78**  
 chemical processes, starting and ending materials in, **4:75-4:78**  
 conflict with all-elements rules, **4:71**  
 dominance and subservience, above  
**Federal Circuit courts**  
 chemical process, starting and ending materials in, **4:75**  
 indefinite vs. nonlimiting, **4:69**  
**Patent and Trademark Office (PTO) guidelines, 4:78**  
 process, products defined by, **4:74**

## INDEX

### CLAIMS—Cont'd

Hybrid claiming—Cont'd  
    Federal Circuit courts—Cont'd  
        traditional practice, 4:76, 4:77  
    general practice, 4:70  
        hostility to traditional practice, 4:77  
        impetus to discard anomalies, hybrid claiming as, 4:82  
    indefinite vs. nonlimiting, 4:69  
    infringement, 4:71-4:74, 4:80  
    infringement determination, 4:73  
    multiple-category hybrids, generally, 4:67-4:82  
    non-obviousness, 9:77  
    nonstatutory elements, hybrid inventions incorporating, 4:79  
    other forms of hybrid claims, 4:81  
    patentability determinations, 4:72  
    Patent and Trademarks Office  
        (Patent and Trademark Office (PTO)), generally, 4:67-4:82  
    process, products defined by, 4:74  
    processes, 5:29, 5:36  
    single-category requirement, generally, 4:67-4:82  
    specific rules, 4:70  
    statutory subject matter, 5:38  
    traditional practice, 4:76  
I claim, 4:4  
Identical to technological configuration, invention as, 4:71  
Identity and identification  
    central vs. peripheral claiming, above  
        object and claimed invention, 4:97  
Illustrative diagrams, 4:57, 4:59  
Improvements, 4:2  
Incorporation by reference, 4:102  
Indefinite vs. nonlimiting, 4:69  
Independent claims, 4:102  
Independent form, 4:5  
Individual claims, 4:96-4:99  
Infringement  
    determination, 4:73  
    dominance and subservience, 4:66

### CLAIMS—Cont'd

Infringement—Cont'd  
    hybrid claim presentations and nonlimiting recitations, 4:71-4:74, 4:80  
    means expressions, 4:87, 4:92  
    multiple claims in single patent, 4:101, 4:102  
    policy justification and historical development, 4:2, 4:4, 4:6  
    required format, 4:95  
    tripartite form of individual claims, 4:97, 4:98  
In re Brouwer, 4:77, 4:78, 4:80  
In re Donaldson Co., 4:6, 4:80, 4:93  
In re Durden, 4:76-4:78, 4:80, 4:81  
In re Ochiai, 4:77, 4:78, 4:80  
In re Papesch, 4:82  
In re Pleudemann, 4:77, 4:78, 4:80  
Insert, 4:98  
Instructions to jury. Central vs. peripheral claiming, above  
Intent, 4:2, 4:3, 4:31, 4:87  
Interference, 4:9  
Interim supplemental guidelines, 4:89  
Interpretation, generally, 4:1 *et seq.*  
Intrinsic vs. extrinsic sources. Central vs. peripheral claiming, above  
Inventor's contribution, 4:2-4:4  
Issuance, 4:6  
Jepson-style claims, 4:99  
Johnson Worldwide v. Zebco, 4:36  
Judges  
    generally, 4:63  
    central vs. peripheral claiming, above  
Judgment, 4:2  
Judicial decisions, 4:87, 4:91, 4:92  
Judicial determinations, 4:73  
Judicial reaction under peripheral claiming practice, 4:86  
Judiciary Branch, 4:6  
Jurisdiction, 4:6  
Jury. Central vs. peripheral claiming, above  
Justification. Policy justification and historical development, below  
Late Claiming (this index)

**CLAIMS—Cont'd**

Law vs. fact. Central vs. peripheral claiming, above  
 Legislation, **4:77, 4:81, 4:87**  
 Legislature, **4:6**  
 Licenses, **4:63**  
 Lighting Ballast Control LLC v. Philips Electronic North America Corp., **4:17.50**  
 Limitations and restrictions dominance and subservience, above  
 multiple claims in single patent, **4:103**  
 policy justification and historical development, **4:2**  
 Lingual meaning, **4:1**  
 Literal infringement, **4:71**  
 Lower courts, **4:6, 4:80**  
 Manual of Patent Examining Procedure, **4:73, 4:78, 4:89, 4:93**  
 Markman v. Westview Instruments, **4:6, 4:16, 4:17.50, 4:17.75**  
 Markush groupings (Ex parte Markush), **4:100**  
 Mathematical formulae, **4:79**  
 Meaning, lingual, **4:1**  
 Means expressions generally, **4:7, 4:83-4:93**  
 boundary with non-means expressions, **4:89**  
 central vs. peripheral claiming, **4:8**  
 combinations, generally, **4:83-4:93**  
 commentary, **4:90**  
 corresponding structure, determination of, **4:91**  
 Federal Circuit courts, **4:88, 4:91, 4:93**  
 historical development generally, **4:84-4:88**  
 judicial reaction under peripheral claiming practice, **4:86**  
 recent developments, **4:88**  
 retention after 1870, **4:85**  
 statutory treatment in 1952 Patent Act, **4:87**  
 Patent and Trademark Office (PTO) practice, **4:93**

**CLAIMS—Cont'd**

Means expressions—Cont'd peripheral claiming, generally, **4:83-4:93**  
 policy justification and historical development, **4:2, 4:5**  
 section 112, generally, **4:83**  
 U.S.C.A. Title 35, generally, **4:83**  
 Mechanical arts, **4:65**  
 Mechanical equivalents, **4:84, 4:86, 4:92**  
 Method of use, **4:80**  
 Mixed questions of law and fact, **4:14**  
 Molecular physics, **4:65**  
 Multiple claims, **4:101-4:103**  
 Multiple dependent claims, **4:103**  
 Multiply dependent claims, **4:5**  
 National Institutes of Health, **4:66**  
 Natural laws, **4:79**  
 19th century, **4:2**  
 Non-Obviousness (this index)  
 Nonspecialist district court, **4:6**  
 Notice and knowledge generally, **4:7, 4:9, 4:94**  
 central vs. peripheral claiming, **4:9**  
 definiteness and notice, **4:94**  
 hybrid claim presentations and nonlimiting recitations, **4:71, 4:72, 4:74**  
 means expressions, **4:92**  
 policy justification and historical development, **4:2-4:4, 4:6**  
 Novelty, **4:72**  
 Objection, **4:2**  
 Objectionable, **4:66**  
 Objectionable per se, **4:5**  
 Open formats, **4:98**  
 O'Reilly v. Morse, **4:9**  
 Partially closed claim format, **4:98**  
 Patentability, **4:62, 4:67, 4:70, 4:72**  
 Patentable per se, **4:76**  
 Patent Act of 1836, **4:2, 4:94**  
 Patent Act of 1870, **4:94**  
 Patent Act of 1952, **4:5, 4:87, 4:93**  
 Patent and Trademark Office (PTO), generally, **4:3**  
 Patent Cooperation Treaty, **4:103**

## INDEX

### CLAIMS—Cont'd

Patent Department of the Department of State, **4:2**  
Patent law judges, **4:63**  
Pending claims, **4:1**  
Peripheral claiming  
    generally, **4:1, 7:5, 7:6**  
    adequate disclosure, **7:24, 7:26, 7:42**  
    central vs. peripheral claiming,  
        above  
    designs, **5:46**  
    dominance and subservience, **4:64**  
    historical development and policy justification, **1:21-1:25, 4:3, 4:4, 4:86**  
    hybrid claim presentations and nonlimiting recitations, **4:80**  
    indirect infringement, **15:5**  
    joint inventorship, **10:31**  
    means expressions, above  
    non-statutory hybrid inventions, **5:50, 5:52, 5:55**  
    policy justification and historical development, generally, **4:2-4:6**  
    processes, **5:21, 5:24**  
    statutory subject matter, **5:22**  
    Technological Scope of Infringement (this index)  
Per se rule, **4:78, 4:80**  
Phillips v. AWH, **4:39**  
Physics, **4:65**  
Policy justification and historical development  
    generally, **4:2-4:6**  
    peripheral claiming, 1870-1880, **4:3**  
    peripheral claiming, 1880-1952, **4:4**  
    statutes, 1952-1982, **4:5**  
    structural revision of judiciary, 1982-present, **4:6**  
Practical utility, **4:66**  
Practicing patent community, **4:89**  
Pragmatic meaning, **4:55-4:57**  
Preamble, **4:96, 4:99**  
Preclusion of issue, **4:20**  
Presumptions, **4:89**

### CLAIMS—Cont'd

Prima facie case, **4:93**  
Printed matter, some forms of, **4:79**  
Prior art structure, **4:93**  
Priority  
    generally, **8:125**  
    central vs. peripheral claiming, **4:9**  
    claimed invention, **8:253**  
    claim language, **8:47-8:49, 8:57**  
Process, products defined by, **4:74**  
Product-and-method, **4:63**  
Product-by-process, **4:73, 4:74, 4:82, 4:102**  
Product method, **4:66**  
Profit from research, **4:63**  
Prosecution, **4:93**  
Prosecution history, **4:45**  
Publications, administrative, **4:2**  
Public Law No. 104-41, **4:77**  
Questions of fact. Central vs. peripheral claiming, above  
Questions of law  
    central vs. peripheral claiming,  
        above  
    means expressions, **4:91**  
Quid pro quo, **4:91**  
Reasonable notice, **4:2**  
Reasonable people, **4:3**  
Reasonably clear, **4:94**  
Rebuttal, **4:93**  
Recital, **4:5**  
Recitations  
    alternative, **4:100**  
    dominance and subservience,  
        above  
    means expressions, **4:91**  
Reexamination, **4:88**  
Reissuance, **4:4, 4:9, 16:26-16:29, 16:75-16:80**  
Rejection of application  
    generally, **4:1**  
    alternative recitations and markush groupings, **4:100**  
    definiteness and notice, **4:94**  
    dominance and subservience, **4:69**  
    hybrid claim presentations and nonlimiting recitations, **4:72, 4:77**

**CLAIMS—Cont'd**

Remand, **4:74**  
 Research and development, **4:63, 4:77**  
 Retention after 1870, **4:85**  
 Revisions in statutes, **4:2**  
 Scripps Clinic & Research Foundation v. Genentech, **4:74**  
 Sealing insert, **4:97**  
 Section 101, **4:66-4:68, 4:70, 4:73, 4:79**  
 Section 102, **4:102**  
 Section 103  
   amendment of statute, **4:75-4:78**  
   hybrid claim presentations and nonlimiting recitations, **4:75, 4:77**  
   multiple claims in single patent, **4:102**  
   policy justification and historical development, **4:6**  
 Section 112, generally, **4:1**  
 Section 271(a), **4:66**  
 Section 282, **4:101**  
 Semantic meaning, **4:55-4:57**  
 Single means claims, **4:87**  
 Skilled in the art, **4:2, 4:91, 4:92**  
 Special sub-rules. Central vs. peripheral claiming, above  
 Specification, **4:44**  
 Stare decisis, **4:20**  
 State Department, **4:2**  
 Static physical configurations, **5:8**  
 Statutes, generally, **4:1**  
 Statutory subject matter, generally, **4:2**  
 Structural equivalents, **4:92**  
 Subcombination, **4:63, 4:64**  
 Subject matter jurisdiction, **4:6**  
 Subsequent developments, **4:40**  
 Subservience. Dominance and subservience, above  
 Substantially as described, **4:2**  
 Supreme Court  
   generally, **4:3, 4:80**  
   Atlantic Thermoplastics Co. v. Faytex Corp., **4:74**  
   Bain v. Morse, **4:9**

**CLAIMS—Cont'd**

Supreme Court—Cont'd  
   Evans v. Eaton, **4:2**  
   Halliburton Oil Well Cementing Co. v. Walker, **4:86**  
   Markman v. Westview Instruments, Inc., **4:6**  
   means expressions, **4:86**  
   O'Reilly v. Morse, **4:9**  
   Scripps Clinic & Research Foundation v. Genentech, **4:74**  
   Tropix Inc. v. Lumigen Inc., **4:74**  
   Warner Jenkinson v. Hilton Davis, **4:6**  
 Target meaning. Central vs. peripheral claiming, above  
 Technical disclosure, **4:8**  
 Technological configuration, **4:65, 4:71, 4:94**  
 Technological Scope of Infringement (this index)  
 Temporal scope, **11:22-11:24**  
 Tests, **4:74, 4:92**  
 Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc., **4:17.50**  
 Texas Digital Instruments v. Telegenix, **4:38**  
 Theory, generally, **4:7-4:93**  
 35 USCS, generally. See lines throughout this index topic  
 Title and ownership, **4:2, 4:6, 4:73**  
 Toro v. White Consol. Industries, **4:37**  
 Transitional phrase, **4:96, 4:98, 4:99**  
 Trials  
   hybrid claim presentations and nonlimiting recitations, **4:80**  
   judgment, policy justification and historical development, **4:2**  
 Tripartite form of individual claims, **4:96-4:99**  
 Tropix Inc. v. Lumigen Inc., **4:74**  
 Tubular body, **4:97, 4:98**  
 Useful, **4:66**  
 Validity, **4:49, 4:62**  
 Venn diagram, **4:63**  
 Verdicts. Central vs. peripheral claiming, above

## INDEX

**CLAIMS—Cont'd**  
Vitronics Corp. v. Conceptronic, Inc.,  
**4:34**  
Warner Jenkinson v. Hilton Davis,  
**4:6**

**CLAIM THEORY**  
Technological Scope of Infringement  
(this index)

**CLASSICAL ESTOPPEL**  
Technological scope, **13:89**

**CLAUDE NEON LIGHTS v. E. MACHLETT & SON**  
Technological scope, **13:71**

**CLAYTON ANTITRUST ACT**  
Indirect infringement, **15:6**

**CLEAR AND CONVINCING EVIDENCE**  
Adequate utility, **6:14**

**CLEAR AND PARTICULAR**  
Non-obviousness, **9:66**

**CLERK OF DEPARTMENT OF STATE**  
Patent and Trademark Office (PTO),  
**2:20**

**CLINTON ADMINISTRATION**  
Claims, **4:77**

**CLONING**  
Adequate utility, **6:5**

**CLOSED FORMATS**  
Claims, **4:98**

**CLOSED LETTERS (LITTERAE CLAUSAE)**  
History, **1:1**

**CLOSED LIST**  
Non-obviousness, **9:55**

**CLOSELY RELATED INFORMATION**  
Adequate utility, **7:1**

**CLOSE REPLICAS**  
Adequate utility, **7:5**

**CLS v. ALICE**  
Processes, business methods, **5:32.50**

**CLUM v. BREWER**  
Joint inventorship, **10:49, 10:50**

**COCHRAN v. DEENER**  
Processes, **5:22**  
Statutory subject matter, **5:22**

**CODE OF FEDERAL REGULATIONS (CFR)**  
Claims, **4:73**

**CO-EMPLOYEES**  
Non-obviousness, **9:26**

**CO-INVENTION**  
Joint inventorship, **10:29**

**CO-INVENTORS**  
Anticipation, lack of, **8:5**  
Joint inventorship, **10:47**

**COLEMAN v. DINES**  
Priority, **8:45**

**COLLABORATION**  
Inventorship, **10:15, 10:18**  
Joint Inventorship (this index)  
Non-Obviousness (this index)

**COLLECTIONS**  
Non-statutory hybrid inventions, **5:50**

**COLONIAL PERIOD**  
Generally, **1:9**

**COLORFUL LANGUAGE**  
Non-obviousness, **9:4**

**COMBINATIONS**  
Adequate utility, **6:6, 7:24**  
Anticipation, lack of, **8:12**  
Claims (this index)  
Indirect infringement, **15:5**  
Non-obviousness, **9:3, 9:7, 9:86**  
Non-Statutory Hybrid Inventions  
(this index)  
Priority, **8:47**  
Static physical configurations, **5:8,**  
**5:9**  
Temporal scope, **11:49**

**COMMENTARY**

Correction of inventorship, **10:64**  
Means expressions, **4:90**  
Technological Scope of Infringement  
(this index)

**COMMERCE CLAUSE**

History, **1:15**

**COMMERCIAL EMBODIMENTS**

Adequate disclosure, **7:52, 7:53**

**COMMERCIAL EXPLOITATION**

Adequate utility, **7:5, 7:10**  
Anticipation, lack of, **8:20**  
Policy justification, **1:38**

**COMMERCIAL FIELD**

**LIMITATIONS**

Misuse of patent, **18:34**

**COMMERCIAL IMPORTANCE**

Static physical configurations, **5:13**

**COMMERCIAL INFORMATION**

Non-obviousness, **9:53**

**COMMERCIALITY**

Adequate Commerciality (this index)  
Temporal scope, **11:6**

**COMMERCIALIZATION**

Adequate utility, **6:4**  
Correction of inventorship, **10:67, 10:68**  
History, **1:3**  
Non-obviousness, **9:22**  
Policy justification, **1:39, 1:41**  
Priority, **8:67**  
Statutory subject matter, **5:4, 5:5**

**COMMERCIALLY SALABLE**

Adequate utility, **6:8, 6:11**

**COMMERCIAL MANUFACTURE**

Processes, **5:39**

**COMMERCIAL PROCESSES**

Processes, **5:37**

**COMMERCIAL SUCCESS**

Non-obviousness, **9:6, 9:51, 9:61-9:64, 9:76**

**COMMERCIAL USE**

Inventorship, **10:14**  
Prior inventor, prior-user rights,  
**22:21, 22:22**

**COMMISSIONED WORKS**

Inventorship, **10:16**

**COMMISSIONER IN UNITED  
STATES DISTRICT COURT  
FOR DISTRICT OF  
COLUMBIA**

Patent and Trademark Office (PTO),  
**2:38**

**COMMISSIONER OF PATENTS  
AND TRADEMARKS**

Generally, **2:7 et seq.**  
Adequate utility, **6:6, 7:9**  
Examination of Original Application  
(this index)  
History, **1:19, 1:21**  
Non-statutory hybrid inventions, **5:83**  
Report of Decisions of Commissioner  
of Patents, **2:20**

**COMMISSION FOR THE  
PROMOTION OF THE  
USEFUL ARTS**

Patent and Trademark Office (PTO),  
**2:15**

**COMMISSION ON THE USEFUL  
ARTS**

Generally, **2:20**  
Patent and Trademark Office (PTO),  
**2:31**

**COMMON ASSIGNMENT**

Correction, **10:66-10:68**  
Correction of inventorship, **10:59, 10:60, 10:66**

**COMMON ENTERPRISE**

Joint inventorship, **10:39**

**COMMON KNOWLEDGE**

Adequate utility, **7:15, 7:18**  
Non-obviousness, **9:43**

**COMMON LAW**

Adequate commerciality, **14:51**  
Claims, **4:5, 4:77, 4:78**

## INDEX

**COMMON LAW—Cont'd**  
Federal common law, historical origins, **1:13.20**  
History, **1:3, 1:5, 1:7, 1:17**  
Invalidity defense, **17:7**  
Inventorship, **10:14, 10:17, 10:47**  
Joint inventorship, **10:47**  
Noninfringement defense, **17:7**  
Non-obviousness, **9:4, 9:5**  
Non-statutory hybrid inventions, **5:59**  
Patent and Trademark Office (PTO),  
**2:6, 2:13, 2:43**  
Processes, **5:24**

**COMMON OWNERSHIP**  
Joint inventorship, **10:37**  
Non-Obviousness (this index)

**COMMON USAGE**  
History, **1:15**

**COMMUNICATION**  
Static physical configurations, **5:11**

**COMMUNITY PATENT CONVENTION**  
Adequate commerciality, **14:46**  
Indirect infringement, **15:14**

**COMPCO CORP. V. DAY BRITE LIGHTING, INC.**  
Historical origins of patent grant,  
**1:13.50**

**COMPENSATION**  
Priority, **8:36**

**COMPETENCE**  
Priority, **8:72**

**COMPETITION**  
Adequate Commerciality (this index)  
Adequate disclosure, **7:2, 7:5, 7:10, 7:11, 7:22**  
Adequate utility, **6:19**  
Claims, **4:2**  
Examination of Original Application (this index)  
History, **1:4, 1:7, 1:14**  
Non-obviousness, **9:11, 9:47, 9:60**  
Policy justification, **1:32, 1:38, 1:39, 1:43**

**COMPETITION—Cont'd**  
Preemption of state law, **1:13.10**  
Priority, **8:38, 8:103**  
Processes, **5:39**  
Statutory subject matter, **5:4, 5:5**

**COMPILATIONS**  
Non-statutory hybrid inventions, **5:55**  
Static physical configurations, **5:11**

**COMPLAINTS**  
Patent and Trademark Office (PTO),  
**2:22**  
Six-year limitation, date of filing,  
**21:1**

**COMPLETENESS**  
Anticipation, Lack Of (this index)  
Joint inventorship, **10:31**  
Priority, **8:47-8:49, 8:57, 8:253**  
Static physical configurations, **5:17**

**COMPOSITION OF MATTER**  
Statutory Subject Matter (this index)

**COMPOSITIONS**  
Adequate utility, **7:7**  
Anticipation, lack of, **8:28**  
Processes, **5:39**  
Static physical configurations, **5:7, 5:8, 5:17**  
Statutory subject matter, **5:9**

**COMPOUNDS**  
Adequate utility, **6:18**  
Static physical configurations, **5:9**

**COMPRISING**  
Claims, **4:98**

**COMPROMISE**  
Non-obviousness, **9:14-9:16**  
Processes, **5:39**

**COMPULSORY LICENSE**  
Claims, **4:63**

**COMPUTER-RELATED INVENTIONS**  
Generally, **5:40-4:45**  
Abstract ideas, **5:44**  
Adequate utility, **7:9**  
Apparatus, **5:2**

**COMPUTER-RELATED INVENTIONS—Cont'd**  
Appeal and review, **5:42**  
Arrhythmia Research Technology, Inc. v. Corazonix Corp., **5:44**  
Article of manufacture, software as, **5:42**  
AT&T Corp. v. Excel Communications, Inc., **5:44**  
Binary-coded decimals (BCD), **5:44**  
Board of Patent Appeals and Interferences (BPAI), **5:42**  
Circuits (hardware), **5:41**  
Claims, **4:81**  
Computer-implemented methods, generally, **5:40-4:45**  
Computer science, **5:2**  
Configuration, **5:42**  
Conversions, **5:44**  
Court of Customs and Patent Appeals (CCPA), **5:53**  
Data structure, computer-accessible, **5:42**  
Definition of software, **5:41**  
Economic factors, **5:41**  
Examiner, **5:53**  
Exceptions, **5:42**  
Exemptions, **5:45**  
Federal Circuit, **5:42-5:44**  
Gottschalk v. Benson, **5:44**  
Hardware, generally, **5:40-4:45**  
Human-readable languages, **5:41**  
Inherent to processes, **5:53**  
In re Abrams, **5:45**  
In re Bernhart, **5:53**  
In re Lowry, **5:42**  
Instructions, **5:41**  
Interference, **5:42**  
Literary expressions, **5:42**  
Manufacture, articles of, generally, **5:40-4:45**  
Mathematical algorithms, **5:41, 5:44**  
Mental steps, **5:45**  
Non-statutory hybrid inventions, **5:54, 5:78**  
Non-statutory subject matter, **5:41, 5:44, 5:45**  
Patentability, **5:53**

**COMPUTER-RELATED INVENTIONS—Cont'd**  
Patent and Trademark Office (PTO), **5:44**  
Physical transformation, **5:53**  
Policy discussion, **5:41**  
Printed matter and factual compilations, **5:41, 5:42**  
Prior art, **5:42**  
Process, software as, **5:43-5:45**  
Processes, **5:24, 5:26, 5:38**  
Programs, generally, **5:40-4:45**  
Rejection of application, **5:42, 5:44, 5:45**  
Research, **5:44**  
Reversal, **5:42**  
Software, generally, **5:1**  
Static physical configurations, **5:8, 5:10**  
Statutory subject matter, generally  
Storage media, generally, **5:40-4:45**  
Supreme Court, **5:44**

**CONCEALMENT**  
Adequate disclosure, **7:57**  
Adequate utility, **7:51**  
Anticipation, Lack Of (this index)  
Inventorship, **10:3**  
Non-obviousness, **9:28, 9:29, 9:34, 9:39**  
Priority (this index)

**CONCEPTION**  
Anticipation, Lack Of (this index)  
Inventorship (this index)  
Joint Inventorship (this index)  
Priority (this index)

**CONDITIONS**  
History, **1:4**

**CONDUCT**  
Estoppel, historical development, **24:6**

**CONFIDENTIALITY**  
Non-obviousness, **9:28**

**CONFIGURATION**  
Adequate disclosure, generally, **7:1**  
Anticipation, lack of, **8:25**

## INDEX

**CONFIGURATION—Cont'd**  
Claims, 4:87, 4:94  
Computer-related inventions, 5:42  
Inventorship, 10:12  
Joint inventorship, 10:47  
Non-Obviousness (this index)  
Patent and Trademark Office (PTO),  
    2:1  
Priority, 8:49, 8:57  
Statutory subject matter, 5:1

**CONGRESS**  
Generally, 2:1-2:18  
Adequate disclosure, 7:45  
Adequate utility, 6:9  
Administration of initial grant  
    generally, 2:12-2:18  
    examination under Act of 1836,  
        2:17  
    historical developments in U.S.,  
        2:14-2:17  
    Patent Act of 1790, 2:15  
    Patent Act of 1793, 2:16  
    Patent Act of 1836, 2:17  
    registration under Act of 1793,  
        2:16  
    subsequent developments, 2:18  
Anticipation, lack of, 8:8  
Claims  
    definiteness and notice, 4:94  
    hybrid claim presentations and  
    nonlimiting recitations, 4:75,  
        4:80  
    means expressions, 4:87, 4:88,  
        4:93  
    multiple claims in single patent,  
        4:103  
    policy justification and historical  
    development, 4:5, 4:6  
Correction of inventorship, 10:57,  
    10:58, 10:65  
Doubt, rule of, 2:9  
European patent systems, 2:11  
Examination of Original Application  
    (this index)  
Examination under Act of 1836, 2:17  
Executive authority. Judicial v. exec-  
utive authority, below  
General acts, 2:3, 2:5

**CONGRESS—Cont'd**  
History, generally, 1:12-1:25, 2:14-  
    2:17  
Inventorship, 10:2, 10:6, 10:7, 10:14  
Joint inventorship, 10:39-10:41,  
    10:45  
Judicial v. executive authority  
    generally, 2:6-2:11  
    doubt, rule of, 2:9  
European patent systems, 2:11  
general supremacy of judiciary, 2:8  
reexamination, 2:10  
relative law-making authority, 2:9  
separate delegations, 2:7  
Non-Obviousness (this index)  
Patent Act of 1790, 2:15  
Patent Act of 1793, 2:16  
Patent Act of 1836, 2:17  
Patent and Trademark Office (PTO),  
    generally, 2:1  
Policy justification, 1:31  
Processes, 5:30  
Registration under Act of 1793, 2:16  
Separate delegations, 2:7  
Specific acts, 2:3, 2:4  
Static physical configurations, 5:8,  
    5:14, 5:15, 5:17  
Statutes, 2:15-2:17  
Statutory Subject Matter (this index)

**CONNER PERIPHERALS, INC. v.  
WESTERN DIGITAL CORP.**  
Adequate commerciality, 14:27

**CONSENT**  
Correction, 10:61  
History, 1:14  
Inventorship, 10:14  
Joint Inventorship (this index)  
Patent and Trademark Office (PTO),  
    2:22

**CONSENT DECREES**  
Invalidity, 17:41

**CONSENT ORDERS**  
Processes, 5:39

**CONSIDERATION**  
Invalidity, 17:20

**CONSIDERED PER SE**  
Non-statutory hybrid inventions, **5:84**

**CONSISTING ESSENTIALLY OF**  
Claims, **4:98**

**CONSISTING OF**  
Claims, **4:98**

**CONSOLIDATED NOTICES**  
Patent and Trademark Office (PTO),  
**2:27**

**CONSOLIDATION**  
Patent and Trademark Office (PTO),  
**2:37**

**CONSTITUTIONAL LAW**  
Adequate utility, **6:2, 6:5, 6:9**  
Anticipation, lack of, **8:1**  
Congress (this index)  
History (this index)  
Inventorship, **10:2, 10:7**  
Non-obviousness, **9:9**  
Patent and Trademark Office (PTO),  
**2:1, 2:4, 2:21, 2:44**  
Reexamination (this index)  
Static physical configurations, **5:17**  
Statutory subject matter, **5:2**

**CONSTRUCTION AND  
INTERPRETATION**  
Adequate commerciality, **14:65, 14:69, 14:70, 14:79**  
Adequate utility, **6:3, 6:14, 6:16**  
Anticipation, Lack Of (this index)  
Claims (this index)  
Correction of inventorship, **10:59**  
Disclosure (this index)  
History, generally, **1:7**  
Indirect infringement, **15:2, 15:4**  
Inventorship, **10:12**  
Joint inventorship, **10:37, 10:41**  
Non-Obviousness (this index)  
Non-statutory hybrid inventions,  
**5:59, 5:80**  
Patent and Trademark Office (PTO),  
generally, **2:3, 2:4**  
Priority, **8:63, 8:151, 8:259**  
Processes, **5:21, 5:23, 5:27**

**CONSTRUCTION AND  
INTERPRETATION—Cont'd**  
Static physical configurations, **5:8, 5:14, 5:15, 5:18**  
Statutory subject matter, **5:1 et seq.**  
Utility requirement, **6:18, 6:19**

**CONSTRUCTION OF WORK**  
Joint inventorship, **10:23, 10:31**

**CONSTRUCTIVE PUBLICATION**  
Non-obviousness, **9:33**  
Priority, **8:141**

**CONSTRUCTIVE REDUCTION TO  
PRACTICE**  
Anticipation, Lack Of (this index)  
Priority (this index)

**CONSUMER PRODUCTS SAFETY  
COMMISSION**  
Adequate utility, **6:5**

**CONSUMERS**  
Adequate utility, **6:5, 6:15**  
Policy justification, **1:33**  
Processes, **5:39**

**CONTEST**  
Anticipation, lack of, **8:6**  
Correction of inventorship, **10:61**  
Inventorship, **10:7, 10:25, 10:52**  
Joint inventorship, **10:25, 10:52**  
Priority, **8:38, 8:39, 8:46, 8:129**  
Statutory subject matter, **5:1**

**CONTEXT MISTAKES**  
Technological scope, **13:57, 13:58**

**CONTINENTAL COATINGS  
CORPORATION v. METRO,  
INC.**  
Estoppel, **24:12**

**CONTINENTAL CONGRESS**  
Patent and Trademark Office (PTO),  
**2:4**

**CONTINUATION APPLICATION**  
Adequate disclosure, **7:56**  
Disclosure. Examination of original  
application, below  
Joint inventorship, **10:45, 10:46**

## INDEX

**CONTINUATION APPLICATION**  
—Cont'd  
Priority (this index)  
Reissue of patent, **16:83**  
Validity. Examination of original application, above

**CONTINUATION-IN-PART APPLICATION**  
Adequate disclosure, **7:56**  
Examination of Original Application (this index)  
Joint inventorship, **10:46**  
Priority, **8:147**

**CONTINUITY, STANDARD OF**  
Priority, **8:66**

**CONTINUOUS EFFORT**  
Inventorship, **10:18**

**CONTRACTS AND AGREEMENTS**  
Adequate Commerciality (this index)  
Adequate disclosure, **7:54**  
Claims, **4:28, 4:52, 4:53**  
Dominance and subservience, **4:63**  
History, **1:16, 1:25**  
Indirect infringement, **15:14**  
Inventorship (this index)  
Justification, **1:38, 1:39**  
Licenses and Permits (this index)  
Non-obviousness, **9:47**  
Patent and Trademark Office (PTO), **2:13**  
Policy justification, **1:38, 1:39**  
Priority (this index)  
Processes, **5:29**  
Six-year limitation, contractual agreements, **21:24**

**CONTRA PROFERENTUM**  
Claims, **4:48**

**CONTRIBUTION**  
Adequate disclosure, **7:43**  
Anticipation, lack of, **8:5, 8:23, 8:26**  
Claims, **4:9, 4:64, 4:83**  
Geographic Scope of Infringement (this index)  
History, **1:23**  
Inventorship, **10:11, 10:17**

**CONTRIBUTION—Cont'd**  
Joint Inventorship (this index)  
Non-statutory hybrid inventions, **5:61**  
Processes, **5:21**

**CONTRIBUTORY INFRINGEMENT**  
Indirect Infringement (this index)

**CONTROLLED SPACES**  
Geographic scope, **12:12**

**CONVERSION**  
Computer-related inventions, **5:44**  
Correction (this index)  
Joint inventorship, **10:49**  
Processes, **5:30**

**CONVEYANCE OF TITLE**  
Adequate commerciality, **14:18**  
Inventorship, **10:7, 10:14**

**COOPERATIVE ENTERPRISE**  
Correction of inventorship, **10:60**

**COOPERATIVE INVENTORS**  
Joint Inventorship (this index)

**COOPERATIVE RESEARCH**  
Inventorship, **10:18**  
Non-obviousness, **9:46**

**COOPERATIVE RESEARCH AND TECHNOLOGY ENHANCEMENT ACT OF 2004**  
Nonobviousness, secret prior art, **9:48.1**

**COOPERATIVE WORK**  
Joint inventorship, **10:26**

**CO-OWNERSHIP**  
Joint Inventorship (this index)

**COPENDING APPLICATIONS**  
Priority, **8:69**

**COPIES AND DUPLICATES**  
Adequate disclosure, **7:41**  
Anticipation, lack of, **8:9**  
Examination of Original Application (this index)  
Non-obviousness, **9:51, 9:60**  
Static physical configurations, **5:14**

**COPYRIGHT**

Adequate commerciality, 14:15  
History, 1:10, 1:11, 1:15  
Inventorship, 10:6, 10:16-10:18,  
10:53  
Joint inventorship, 10:53  
Non-obviousness, 9:47  
Patent and Trademark Office (PTO),  
2:29  
Policy justification, 1:29  
Processes, 5:38  
Static physical configurations, 5:11  
Statutory subject matter, 5:4  
Useful arts, 1:11

**CORNETTA v. U.S.**

Laches, 23:15

**CORNING v. BURDEN**

Processes, 5:21  
Static physical configurations, 5:8

**COROLLARIES**

Adequate disclosure, 7:56  
Inventorship, 10:6, 10:7, 10:13  
Non-obviousness, 9:55

**CORPORATIONS**

History, 1:4  
Indirect infringement, 15:19  
Joint inventorship, 10:39

**CORPOREAL PROPERTY**

Priority, 8:39

**CORRECTION**

Abandonment, 10:67, 10:68  
Accountability, 10:61  
Adequate disclosure, 7:31  
A.F. Stoddard & Co. v. Dann, 10:64  
Appeal and review, 10:64  
Application, 10:56  
Application, amendment of, 10:57,  
10:58  
Assignment, 10:59-10:61, 10:66-  
10:68  
Bemis v. Chevron Research Co.,  
10:64  
Bona fide original inventive entity,  
10:60

Checkpoint Systems, Inc. v. U.S.  
Intern. Trade Com'n., 10:67  
Clarity, 10:56, 10:60  
Commentary, 10:64  
Commercialization, 10:67, 10:68  
Common assignment, 10:59, 10:60,  
10:66-10:68  
Congress, 10:57, 10:58, 10:65  
Consent, 10:61  
Construction and interpretation,  
10:59  
Contest, 10:61  
Conversions  
generally, 10:64  
inventorship, correction of, below  
Cooperative enterprise, 10:60  
Court of Appeals for District of  
Columbia, 10:64  
Deceptive intent, 10:57, 10:60  
Defenses, 10:58  
Delay, 10:59  
Diligence, 10:62  
Director of Patent and Trademark  
Office (PTO), 10:61  
Disclosure, 10:68  
District of Columbia, 10:64  
Donation to public, 10:67  
Employment, 10:59, 10:67  
Error without deceptive intent, 10:60  
Evidence, 10:58, 10:60  
Examination  
generally, 10:58  
Exceptions, 10:61  
Federal Circuit, 10:67, 10:68  
First inventor, 10:67  
First-to-file, 22:4  
Foreclosure of rights, 10:67  
Fraud, 10:57  
Historical development, 10:55-10:58  
Improvements, 10:68  
Inadvertent error, 10:67  
Inadvertent mistake, 10:57  
Infringement, 10:58  
Intent, 10:57, 10:60, 10:65  
Inventive entity, 10:55  
Inventorship, correction of  
generally, 10:54-10:68

## INDEX

### CORRECTION—Cont'd

Inventorship, correction of—Cont'd  
amendments of 1982, **10:58**  
consent, **10:61**  
conversions. Sole-to-sole conversions, below in this group  
diligence, **10:62**  
error without deceptive intent, **10:60**  
historical development, **10:55-10:58**  
Patent Act of 1952, **10:57**  
policy justification, **10:59**  
pre-1952 law, **10:56**  
section 116, generally, **10:57-10:67**  
section 256, generally, **10:59-10:67**  
sole-to-sole conversions  
generally, **10:63-10:68**  
amendments of 1982, **10:65**  
common vs. non-common assignment, **10:66-10:68**  
first inventorship, **10:67**  
limits, conflicts with, **10:66-10:68**  
novelty, lack of, **10:68**  
Patent Act of 1952, **10:64**  
Inventorship, correction of inventorship of  
consent, **10:54**  
diligence, **10:54**  
issued patents, generally, **10:54**  
name, generally, **10:54**  
omissions, generally, **10:54**  
pending applications, generally, **10:54**  
sole-to-sole transfers, **10:54**  
validity, generally, **10:54**  
Joinder, **10:57**  
Joint inventors, **10:20, 10:25, 10:40, 10:65**  
Justification, **10:59**  
Laches, **10:61**  
Licenses and permits, **10:61**  
Limitations and restrictions  
error without deceptive intent, **10:60**

### CORRECTION—Cont'd

Limitations and restrictions—Cont'd  
history, **10:59**  
sole-to-sole conversions, **10:64, 10:66-10:68**  
Misjoinder, **10:57**  
Misnaming, **10:65**  
Motivation, **10:66**  
Name. Inventorship, correction of, above  
Non-joinder, **10:57**  
Non-obviousness, **9:77**  
Notice and knowledge, **10:68**  
Novelty, **10:59, 10:68**  
Original inventive entity, **10:60**  
Originally named inventor, **10:60**  
Participants, **10:60**  
Patent Act Amendment of 1982, **10:59, 10:63**  
Patent Act of 1952, **10:57, 10:64**  
Patent and Trademark Office (PTO), **10:58-10:61, 10:64**  
Pending applications. Inventorship, correction of, above  
Policy justification, **10:59**  
Prior art, **10:67**  
Prior inventor, prior-user rights, **22:4**  
Priority, **8:82**  
Prosecution of application, **10:56**  
Public, **10:61, 10:67**  
Public domain, **10:68**  
Public in due course, **10:67**  
Public use and on sale, **10:68**  
Reference, **10:65, 10:66, 10:68**  
Relevant participants, **10:60**  
Relevant parties, **10:61**  
Research and development, **10:64**  
Richardson v. Suzuki Motor Company, Ltd., **10:68**  
Section 102(a), **10:67**  
Section 102(b), **10:63, 10:68**  
Section 102(e), **10:67**  
Section 102(f), **10:60**  
Section 102(g), **10:67**  
Section 116, generally, **10:57-10:67**  
Section 256, generally, **10:57-10:67**  
Single inventive act, **10:66**

**CORRECTION—Cont'd**

Sole-to-sole conversions. Inventorship, correction of, above  
State of mind, **10:60**  
Statutes, amendment of, **10:58**, **10:63**, **10:65**  
Timeliness, **10:62**  
Trade secrets, **10:68**  
Transfers, **10:61**, **10:64**, **10:68**  
True inventors, **10:60**, **10:66**  
Unnamed inventor, **10:62**  
Validity. Inventorship, correction of, above  
Void rights, **10:56**  
Writing of application, **10:56**

**CORRECTNESS**

Adequate utility, **6:13**

**CORROBORATION**

Priority (this index)

**COSTS AND EXPENSES**

Adequate disclosure, **7:24**  
Adequate utility, **6:4**, **6:10**  
Claims, **4:63**, **4:73**, **4:83**, **4:94**  
Examination of Original Application (this index)  
History, **1:3**, **1:7**  
Inventorship, **10:17**  
Non-obviousness, **9:10**, **9:77**, **9:82**  
Patent and Trademark Office (PTO), **2:13**, **2:22**  
Policy justification, **1:30**, **1:31**, **1:42**  
Processes, **5:39**  
Social Cost (this index)  
Static physical configurations, **5:14**  
Statutory subject matter, **5:5**

**CO-TENANCY**

Joint inventorship, **10:47**, **10:51**

**COTTON**

Static physical configurations, **5:14**

**COUNTERFEIT GOODS**

TRIPs, **14:10**

**COUPONS**

Processes, **5:29**

**COURT OF APPEALS**

Claims, **4:76**

**COURT OF APPEALS FOR DISTRICT OF COLUMBIA**

Correction of inventorship, **10:64**

**COURT OF APPEALS FOR FEDERAL CIRCUIT (CAFC)**

Claims, **4:6**, **4:80**, **4:88**, **4:93**

History, **1:25**

Patent and Trademark Office (PTO), **2:37**, **2:38**, **2:43**

**COURT OF CLAIMS**

Adequate commerciality, **14:51**, **14:55**

**COURT OF CUSTOMS AND PATENT APPEALS (CCPA)**

Adequate disclosure, **7:9**, **7:18**, **7:30**, **7:57**

Adequate utility. Utility Requirement (this index)

Anticipation, lack of, **8:7**, **8:22**

Claims, **4:76**, **4:93**

Computer-related inventions, **5:53**

History, **1:24**

Joint inventorship, **10:38**

Non-Obviousness (this index)

Non-statutory hybrid inventions, **5:74**, **5:76**

Patent and Trademark Office (PTO), **2:21**, **2:36**

Priority, **8:46**, **8:62**

Processes, **5:26**, **5:27**, **5:30**

Static physical configurations, **5:9**, **5:12**, **5:17**

Utility Requirement (this index)

**COVENANT NOT TO DEAL IN COMPETING GOODS**

Misuse of patent, **18:36**

**CPR**

Processes, **5:39**

**CREATIVE MENTAL ACTS AND PROCESSES**

Anticipation, lack of, **8:5**, **8:6**

Non-obviousness, **9:43**

Processes, **5:26**

## INDEX

**CREDIBILITY**  
Priority, **8:73**

**CRITICAL DATE**  
Priority, **8:219**

**CROPS**  
Static physical configurations, **5:14**

**CROSS-BORDER TRANSACTIONS**  
Geographic Scope of Infringement  
(this index)

**CROSS-EXAMINATION**  
Priority, **8:75**

**CROSS LICENSES**  
Claims, **4:63**  
Non-obviousness, **9:11**

**CULTIVATED SPORES**  
Static physical configurations, **5:14**

**CURIOSITY, SATISFACTION OF**  
Adequate commerciality, **14:12**

**CUSTOMERS**  
Misuse of patent, **18:34**  
Non-obviousness, **9:62**  
Processes, **5:28**

**DAMAGES**  
Adequate commerciality, **14:19**,  
**14:78**  
Claims, **4:80**  
Indirect infringement, **15:15**, **15:16**,  
**15:22**  
Inventorship, **10:8**  
Processes, **5:39**

**DANGEROUS**  
Adequate utility, **6:12**

**DANN AMENDMENTS**  
Reissue of patent, **16:64**

**DARCY v. ALLEN**  
History, **1:4**, **1:5**

**DATABASE**  
Static physical configurations, **5:11**

**DATA PER SE**  
Non-statutory hybrid inventions, **5:69**

**DAUGHTERS OF CONFEDERACY**  
Patent and Trademark Office (PTO),  
**2:4**

**DAWSON CHEMICAL CO. v.  
ROHM AND HAAS CO.**  
Indirect infringement, **15:12**, **15:13**  
Misuse of patent, **18:21**

**DEATH**  
Inventorship, **10:8**

**DECEIT**  
Adequate disclosure, **7:1**  
Adequate utility, **6:15**  
Correction of inventorship, **10:57**,  
**10:60**  
Joint inventorship, **10:40**  
Reissue of patent, **16:98**

**DECLARATION**  
Adequate discovery, **7:28**

**DECLARATORY JUDGMENT**  
Adequate commerciality, **14:80**

**DECLARATORY JUDGMENTS  
ACT OF 1934**  
Patent and Trademark Office (PTO),  
**2:18**

**DECLARATORY RELIEF**  
Patent and Trademark Office (PTO),  
**2:18**

**DEEPSOUTH PACKING CO. v.  
LAITRAM CORP.**  
Adequate Commerciality (this index)  
Geographic scope, **12:7**, **12:28**

**DE FACTO CONTROL**  
Adequate discovery, **7:44**  
Anticipation, lack of, **8:20**

**DEFECTS**  
Claims, **4:2**  
Reissue of Patent (this index)

**DEFEND TRADE SECRETS ACT  
OF 2016**  
History and policy justification,  
**1:13.90**

## DEFENSES

Adequate discovery, **7:45**  
Application to patent statute, **17:9-17:13**  
Common law pleading, **17:7**  
Correction of inventorship, **10:58**  
Current statute, **17:2-17:13**  
Estoppel (this index)  
Examination of Original Application (this index)  
Federal code pleading, **17:8**  
General pleading theory and current statute, **17:2-17:13**  
Invalidity (this index)  
Joint inventorship, **10:25**  
Laches (this index)  
Licenses and Permits (this index)  
Modern pleading, **17:8**  
Negation vs. avoidance, **17:6**  
Noninfringement (this index)  
Patent and Trademark Office (PTO), **2:7, 2:17**  
Pleading, generally, **17:4-17:8, 23:39**  
Prior art notice, **17:14**  
Priority, **8:43**  
Prior statutes, **17:3, 17:10**  
Processes, **5:23**  
Section 273. Prior Inventor, Prior-User Rights (this index)  
Section 282, **17:11**  
Section 286. Six-Year Limitation (this index)  
Section 287(c). Medical and Diagnostic Procedures (this index)  
Statutory subject matter, **5:5**  
Technological Scope of Infringement (this index)

## DEFENSIVE ACTS AND MATTERS

Adequate utility, **6:7**  
Priority, **8:53, 8:108, 8:118**

## DEFINITENESS

Joint inventorship, **10:31**  
Non-obviousness, **9:3**  
Priority, **8:171**  
Processes, **5:26**

## DEFINITENESS—Cont'd

Reissue of patent, eligibility, changes to improve definiteness, **16:80**

## DEFINITIONAL ACCURACY

Central vs. peripheral claiming, **4:9**  
Technological scope, **13:54**

## DEFINITIONS

Generally, **1:1**  
Adequate Commerciality (this index)  
Another, **9:46, 9:47, 10:37**  
Broadening, **16:78**  
Claimed, **13:98**  
Combination of elements, **5:76**  
Commercial use, **22:21, 22:22**  
Derivation, **10:28**  
Disclosed, **13:99**  
Effective filing date, **22:23**  
Estoppel, **24:4**  
In this country, **8:194**  
Initial occupant, **10:4**  
Invent, **8:4**  
Inventive entities, **10:19**  
Inventor (this index)  
Joint Inventorship (this index)  
Limitation to business methods, **22:20**  
Non-profit entity, commercial use by, **22:22**  
Non-statutory hybrid inventions, **5:55**  
Patented, **8:278**  
Possession, **7:3**  
Printed, **8:177**  
Process, products defined by, **4:74**  
Product, **12:37**  
Products made by process, **12:38**  
Publication, **8:177**  
Reissue of Patent (this index)  
Section 273 defense. Prior Inventor, Prior-User Rights (this index)  
Section 287(c) defense. Medical and Diagnostic Procedures (this index)  
Software, **5:41**  
Static physical configurations, **5:8**

## DE GRAFFENRIED v. U.S.

Adequate commerciality, **14:27**

## INDEX

### **DELAY**

- Adequate commerciality, 14:26
- Adequate disclosure, 7:5
- Correction of inventorship, 10:59
- Estoppel, communication from patent owner, 24:26
- Examination of Original Application (this index)
- Non-obviousness, 9:39
- Patent and Trademark Office (PTO), 2:13
- Priority, 8:64

### **DELIBERATE ACTS AND MATTERS**

- Non-obviousness, 9:67, 9:68
- Priority, 8:87

### **DELIVERY**

- Adequate commerciality, 14:40
- Static physical configurations, 5:18

### **DEMAND**

- Adequate discovery, 7:14
- Adequate utility, 6:4, 6:10
- History, 1:3
- Patent and Trademark Office (PTO), 2:22
- Policy justification, 1:33
- Processes, 5:39

### **DE MINIMIS ACTIVITIES**

- Adequate Commerciality (this index)

### **DE NOVO REVIEW**

- Patent and Trademark Office (PTO), 2:39

### **DEPARTMENT OF AGRICULTURE**

- Patent and Trademark Office (PTO), 2:20
- Static physical configurations, 5:14

### **DEPARTMENT OF INTERIOR**

- Patent and Trademark Office (PTO), 2:20

### **DEPARTMENT OF STATE**

- Patent and Trademark Office (PTO), 2:16, 2:20, 2:31

### **DEPENDENT CLAIMS**

- Generally, 4:5, 4:102

### **DEPENDENT CLAIMS—Cont'd**

- Form, 4:5
- Multiple claims in single patent, 4:102, 4:103

### **DEPENDENT PATENTS**

- Adequate utility, 7:24

### **DEPOSITS AND DEPOSITORYES**

- Adequate disclosure, 7:9, 7:11, 7:22, 7:37

### **DEPUTY COMMISSIONER**

- Patent and Trademark Office (PTO), 2:22

### **DEPUTY DIRECTOR**

- Patent and Trademark Office (PTO), 2:22

### **DERIVATION**

- Anticipation, Lack Of (this index)
- Joint inventorship, 10:28
- Non-obviousness, 9:41

### **DESCRIPTION**

- Claims (this index)
- Disclosure (this index)
- Non-Obviousness (this index)
- Priority (this index)
- Processes, 5:29
- Technological scope, 13:11
- Utility Requirement (this index)

### **DESIGNS**

- Disclosure, 5:46
- Double patenting, 5:46
- Embodiments, 5:46
- Filing date of application, 5:46
- Foreign countries, 5:46
- Infringement, 5:46
- International priority, 5:46
- Manufacture, articles of, 5:46
- Ordinary purchaser, 5:46
- Ornamental exterior appearance of article of manufacture, 5:46
- Patent and Trademark Office (PTO), 5:46
- Peripheral claiming, 5:46
- Registration, 5:46
- Section 171 et seq., 5:46
- Statutory subject matter, 5:46

**DESIGNS—Cont'd**

Trademark law, **5:46**

Utility patents, **5:46**

**DEVICES**

Anticipation, lack of, **8:28**

Static physical configurations, **5:8**

Statutory Subject Matter (this index)

**DIAGNOSTIC PROCEDURES**

Processes, **5:39**

**DIAGRAMS AND DIAGRAMMING**

Claims, **4:63**

Convention of tripartite form of individual claims, **4:97**

Non-statutory hybrid inventions, **5:55**

**DIAMOND v. CHAKRABARTY**

Static physical configurations, **5:17**

**DIAMOND v. DIEHR**

Non-statutory hybrid inventions, **5:73-5:75, 5:84, 5:85**

**DICKENSON v. ZURKO**

Generally, **2:43**

**DICKINSON v. ZURKO**

Patent and Trademark Office (PTO), **2:43**

**DICTA, ASSERTED IN**

Processes, **5:21**

**DICTIONARIES**

Claims, **4:46**

**DILIGENCE**

Anticipation, Lack Of (this index)

Examination of Original Applications (this index)

Inventorship, correction of, **10:62**

Priority, **8:44, 8:70, 8:78, 8:79, 8:89**

**DIRECTED SUMMARY**

**JUDGMENT**

Processes, **5:30**

**DIRECT INFRINGEMENT**

Adequate Commerciality (this index)

Indirect infringement, **15:16, 15:17, 15:22, 15:24**

**DIRECTING OR PERMITTING CONDUCT OF ANOTHER**

Indirect infringement, **15:14**

**DIRECTOR OF PATENT AND TRADEMARK OFFICE (PTO)**

Generally, **2:7, 2:22**

Adequate utility, **7:11**

Correction of inventorship, **10:61**

Non-statutory hybrid inventions, **5:83**

**DIRECT TECHNOLOGICAL SCOPE**

Technological Scope of Infringement (this index)

**DISCLAIMER**

Claims, **4:2**

History, **1:24**

**DISCLOSED**

Defined, **13:99**

**DISCLOSURE**

Generally, **7:1 et seq.**

Abstract acts and matters, **7:6**

Adequate disclosure, generally, **7:1 et seq.**

Adequate range of embodiments, **7:23-7:26**

Administrative law and procedure, **7:5**

Amended claims, **7:41**

America Invents Act, **7:32**

Anticipation, lack of, **7:18, 7:29, 8:16, 8:22**

Apparatus, **7:24**

Appeal and review, **7:52, 7:54, 7:57**

Assignee, duty of, **7:54**

Assumption as of filing date, **7:29**

Background knowledge. Single-embodiment, below

Bad faith, **7:57**

Bayer AG v. Schein Pharmaceuticals, Inc., **7:52, 7:53**

Best mode

generally, **7:44-7:57**

America Invents Act, **7:32**

continuing applications, **7:56**

enablement distinguished, **7:48**

## INDEX

### DISCLOSURE—Cont'd

Best mode—Cont'd  
historical development and policy justification, 7:45, 7:46  
intent, 7:57  
policy objectives, 7:46  
time frame, 7:56  
trade secrets and reverse engineering, 7:50  
two-prong test for occurrence of violation, 7:49  
unsettled issues  
generally, 7:51-7:55  
assignee, duty of, 7:54  
commercial embodiments, 7:52, 7:53  
discuss objectives opposing disclosure, failure to, generally, 7:51-7:55  
employer, duty of, 7:54  
production details, 7:52, 7:53  
related information, 7:52, 7:53  
well-settled issues, 7:47-7:50  
Biological deposits, 7:22  
Biological starting materials, 7:11  
Biotechnological arts, 7:14  
Brand names, 7:12  
Breadth of claims, 7:4, 7:23-7:26, 7:33  
Brenner v. Manson, 7:14  
Case law, 7:9, 7:25  
Change and modification, 7:13, 7:22, 7:38  
Claim breadth, 7:33  
Claimed configuration, 7:7-7:9  
Claims (this index)  
Combinations, 7:24  
Commercial embodiments, 7:52, 7:53  
Commissioner of Patents, 7:9  
Compounds, 7:10  
Concealment, 7:57  
Congress, 7:45  
Construction and interpretation, generally, 7:1 *et seq.*  
Continuation Application (this index)  
Continuation-in-part application, 7:56

### DISCLOSURE—Cont'd

Contracts and agreements, 7:54  
Corollaries, 7:56  
Correction of inventorship, 10:68  
Costs and expenses, 7:24  
Court of Customs and Patent Appeals (CCPA), 7:57  
Decisions, 7:9  
Demand, 7:14  
Deposits, 7:22  
Description requirement  
generally, 7:27-7:43  
ambiguity, 7:35-7:39  
amended claims, 7:41  
America Invents Act, 7:32  
Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., 7:38  
case law, 7:37, 7:38  
confusion and dissent, 7:35, 7:36  
enablement, 7:34-7:39, 7:36  
enablement and description distinguished, 7:34-7:39  
envisioned inventions, 7:34  
examples, 7:37  
filing date of application, below first to file under America Invents Act, 7:32  
frame of reference, 7:43  
in haec verba, 7:42  
introducing new inventions, 7:34  
inventive configuration, description vs., 7:39  
justification. Policy justification, below in this group  
last theorem of Pierre de Fermat, 7:34  
nomenclature, 7:37, 7:38  
policy justification  
generally, 7:28-7:32  
America Invents Act, 7:32  
assumption as of filing date, 7:29  
example, 7:30  
first to file, 7:32  
inventions already made, 7:32  
limitation on claim breadth, 7:33  
new-matter prohibition, relation to, 7:31

**DISCLOSURE—Cont'd**

Description requirement—Cont'd  
 policy justification—Cont'd  
 timewise priority criterion, 7:32  
 subjective appreciation, 7:34, 7:39  
 timewise priority criterion, 7:32

Designs, 5:46

District court, 7:52

Dominant-subservient relationships, 7:24, 7:46

Duplication, 7:20, 7:22

Effective filing date, 7:52

Effectively placed on file, 7:56

Electrical arts, 7:25

Embodiments, generally, 7:1

Employer, duty of, 7:54

Enablement, generally, 7:2-7:26

Evidence  
 generally, 7:1  
 adequate disclosure, generally, 7:1  
 best mode, 7:57  
 description requirements, 7:29, 7:31, 7:43  
 enablement, 7:5, 7:18

Examination of Original Applications (this index)

Examples, 7:37

Exceptions and exclusions, 7:3, 7:22, 7:25

Existing case law, 7:25

Experimentation, 7:20

Federal Circuit courts  
 best mode, 7:52, 7:56, 7:57  
 description requirements, 7:37  
 enablement, 7:9, 7:20, 7:25

File, effectively placed on, 7:56

Filing date of application  
 generally, 7:1, 7:56  
 best mode, 7:56  
 description requirements  
 generally, 7:27  
 enablement distinguished, 7:37  
 In haec verba, 7:42  
 policy justification, 7:29, 7:31  
 enablement, 7:21, 7:22  
 first to file under America Invents Act, 7:32

Foreign countries, 7:5

**DISCLOSURE—Cont'd**

Foreseeability, 7:26, 7:53

Frame of reference, 7:43

Future Acts and Matters (this index)

Genetics, 7:14

Germany, 7:24

Glaxo Inc. v. Novopharm Ltd., 7:54

History  
 generally, 7:4, 7:5  
 best mode, 7:45, 7:46, 7:57  
 description, 7:31  
 first to invent changed to first to file, 7:32  
 initial statutes and developments up to 1836, 1:18

Incorporation by reference, 7:19

Indirect infringement, 15:4

In haec verba, 7:42

In re Sherwood, 7:57

Intent  
 generally, 7:1  
 description requirement, 7:31  
 enablement, 7:14

Inventive configuration, description vs., 7:39

Investigation, 7:20

Joint inventorship, 10:44, 10:46

Judgments, 7:52

Justification  
 generally, 1:38  
 best mode, 7:45, 7:46  
 description requirement, above  
 enablement, 7:4, 7:21  
 historical development and, 7:5

Limitations and restrictions  
 generally, 7:3  
 best mode, 7:46, 7:51, 7:54, 7:57  
 description, 7:33  
 description requirements, 7:38  
 enablement, 7:3, 7:18, 7:23, 7:26

Lower courts, 7:45

Mechanical arts, 7:9, 7:24, 7:25

Method of making, 7:10-7:12

Mode. Best mode, above

New-matter prohibition, relation to, 7:31

Nomenclature, 7:37, 7:38

## INDEX

**DISCLOSURE—Cont'd**

- Non-obviousness
  - generally, **7:18**
  - Graham v. John Deere, **9:19**
  - secondary considerations, **9:51, 9:54**
  - timeliness, Section 102, **9:22**
- Non-statutory hybrid inventions, **5:80**
- Notice and knowledge
  - generally, **7:54, 7:56**
  - single-embodiment, below
- Ordinary skill in the art, **7:52**
- Original application, **7:56**
- Over-breadth, **7:24**
- Patent and Trademark Office (PTO)
  - (this index)
- Policy justification
  - description requirement, above
  - public disclosure, **1:37, 1:38**
- Possession, generally, **7:2**
- Priority (this index)
- Private knowledge, **7:17**
- Processes, **5:19, 5:21**
- Production details, **7:52, 7:53**
- Qualifications, **7:14, 7:18**
- Real party in interest, **7:54**
- Reasonable vs. undue experimentation, **7:20**
- Reference
  - best mode, **7:52**
  - description requirements, **7:37, 7:43**
  - enablement, **7:12, 7:18**
- Reissue of patent, **16:81**
- Rejection of application, **7:1, 7:9, 7:14, 7:25**
- Related information, **7:52, 7:53**
- Research and development, **7:5**
- Reversal, **7:14**
- Reverse engineering, **7:50**
- Routine details, **7:52**
- Secrecy, **7:55**
- Section 103, **7:18, 7:25**
- Section 119, **7:56**
- Section 120, **7:56**
- Single-embodiment
  - generally, **7:6-7:22**
  - adequate utility, relation to, **7:14**

**DISCLOSURE—Cont'd**

- Single-embodiment—Cont'd
  - background knowledge
    - generally, **7:15-7:19**
  - incorporation by reference, **7:19**
  - private knowledge, **7:17**
  - Section 103, relation to, **7:18**
  - target audience, **7:16**
- biological deposits, **7:22**
- biological starting materials, **7:11**
- brand names, **7:12**
- case decisions, claimed configuration, **7:9**
- claimed configuration, **7:7-7:9**
- knowledge. Background knowledge, above in this group
  - method of making, **7:10-7:12**
- reasonable vs. undue experimentation, **7:20**
- statutory basis, claimed configuration, **7:8**
- time frame, **7:21, 7:22**
- trademarks, **7:12**
- use, **7:13, 7:14**
- Skill in the art
  - generally, **7:1**
  - best mode, **7:49**
  - description requirements, **7:37, 7:43**
  - enablement, **7:10, 7:15, 7:18, 7:25**
- Static physical configurations, **5:12, 5:14**
- Statutory basis, claimed configuration, **7:8**
- Statutory subject matter, **5:1**
- Subjective appreciation, **7:34, 7:39**
- Summary judgment, **7:52**
- Supreme Court, **7:14**
- Target audience, **7:16**
- Teaching (this index)
- Technological Scope of Infringement (this index)
- Teleflex, Inc. v. Ficosa North America Corp., **7:52, 7:53**
- Tests and experiments
  - generally, **7:4**
  - adequate range of embodiment, **7:25**

**DISCLOSURE—Cont'd**

Tests and experiments—Cont'd  
best mode, 7:49  
description requirements, 7:37  
enablement, generally, 7:2, 7:4  
single-embodiment, 7:9, 7:11, 7:20  
Time and date, 7:29, 7:52, 7:56  
Time frame, 7:21, 7:22, 7:56  
Trademarks, 7:12  
Trade Secrets (this index)  
Transco Products Inc. v. Performance  
Contracting, Inc., 7:56  
Two-prong test for occurrence of  
violation, 7:49  
Undue experimentation, 7:20  
Unsettled issues. Best mode, above  
Use, 7:13, 7:14  
Utility Requirement (this index)  
Well-settled issues, 7:47-7:50

**DISCONTINUED SUBJECT  
MATTER**

Priority, 8:146

**DISCOVERY**

Adequate utility, 6:18  
Non-obviousness, 9:9, 9:39, 9:77  
Non-statutory hybrid inventions, 5:61  
Priority, 8:44, 8:109  
Processes, 5:24  
Technological scope, 13:56

**DISCRETION**

Claims, 4:2  
Non-statutory hybrid inventions,  
5:49, 5:64  
Policy Justification (this index)  
Processes, 5:27

**DISCRIMINATION**

Misuse of patent, 18:31

**DISDAINFUL AMUSEMENT  
DEVICES**

Adequate utility, 6:15

**DISTRIBUTION OF OWNERSHIP**

Joint inventorship, 10:29, 10:32

**DISTRICT COURT**

Adequate disclosure, 7:52

**DISTRICT COURT—Cont'd**

Appeal and review of PTO decisions  
consolidation in federal circuit,  
2:37  
Court of Customs and Patent  
Appeals (CCPA), 2:36  
Patent Act of 1839, 2:33  
Claims (this index)  
History, 1:25  
Non-obviousness, 9:3, 9:33  
Priority, 8:66, 8:75  
Processes, 5:30

**DISTRICT COURT FOR DISTRICT  
OF COLUMBIA**

Non-obviousness, 9:33  
Patent and Trademark Office (PTO),  
2:33

**DISTRICT COURT OF DISTRICT  
OF COLUMBIA**

Chief justice, 2:33

**DISTRICT OF COLUMBIA**

Circuit Court for District of Colum-  
bia Circuit, 9:33  
Court of Appeals for District of  
Columbia, 10:64  
District Court for District of Colum-  
bia, 9:33  
District Court of District of Colum-  
bia, 2:33  
Reforms of 1870, 2:34

**DNA SEQUENCES**

Claims, 4:66

**DOCTRINE OF EQUIVALENTS**

Adequate commerciality, 14:17,  
14:29  
Claims (this index)  
History, 1:20, 1:22  
Technological Scope of Infringement  
(this index)

**DOCTRINE OF INHERENT  
ANTICIPATION**

Non-obviousness, 9:77

**DOCTRINE OF LOST COUNTS**

Non-obviousness, 9:35, 9:37

## INDEX

**DOCTRINE OF OVERCLAIMING**  
Dominance and subservience, **4:64**

**DOCTRINE OF SHOP RIGHT**  
Inventorship, **10:14, 10:17**

**DOCUMENTARY EVIDENCE**  
Non-statutory hybrid inventions, **5:72**  
Priority, **8:73**

**DOING BUSINESS**  
Non-statutory hybrid inventions, **5:78**  
Statutory subject matter, **5:2, 5:6**

**DOLBEAR v. AMERICAN BELL TELEPHONE CO.**  
Processes, **5:24**

**DOMESTIC APPLICATION**  
Geographic scope, **12:40**

**DOMESTIC INFRINGEMENT**  
Geographic scope, **12:43**

**DOMESTIC PRIORITY**  
Temporal scope, **11:23**

**DOMESTIC SALE**  
Geographic scope, **12:21**

**DOMINANCE**  
Adequate disclosure, **7:24, 7:46**  
Adequate utility, **6:6**  
Claims (this index)  
Non-obviousness, **9:73**

**DONATION TO PUBLIC**  
Correction of inventorship, **10:67**

**DOUBLE PATENTING**  
Anticipation, lack of, **8:28**  
Designs, **5:46**  
History, **1:24**  
Non-obviousness, **9:36, 9:83**

**DOUBT, RULE OF**  
Congress, **2:9**

**DOUGLAS v. U.S.**  
Adequate commerciality, **14:55**

**DRAWINGS**  
Adequate utility, **7:5, 7:9**  
Claims, **4:2**

**DRAWINGS—Cont'd**  
Examination of Original Application (this index)  
Non-obviousness, **9:42**  
Priority, **8:74**

**DRUG PRICE COMPETITION AND PRICE RESTORATION ACT OF 1984**  
Adequate Commerciality (this index)

**DRUG PRODUCTS**  
Temporal scope, **11:46-11:49**

**DRUGS**  
Processes, **5:39**

**DUAL USE**  
Indirect infringement, **15:18**

**DUE COURSE**  
Non-obviousness, **9:28, 9:29**

**DUE PROCESS**  
Priority, **8:73**  
Reexamination, **16:127**

**DUPLICATE APPLICATIONS**  
Joint inventorship, **10:45**

**DUPLICATE RESEARCH**  
Policy justification, **1:42**

**DUPLICATES**  
Copies and Duplicates (this index)

**DUPLICATING**  
Adequate utility, **7:20, 7:22**

**DUPLICATION**  
Adequate utility, **6:3**

**DWIGHT & LLOYD SINTERING CO. v. GREENWALT**  
Estoppel, defense to patent infringement, **24:11**

**DYNACORE HOLDINGS CORP. v. U.S. PHILIPS CORP.**  
Indirect infringement, **15:16**

**EARLY CATEGORIES OF ESTOPPELS**  
Generally, **24:5**

<b>ECOLOGY</b>	Static physical configurations, <b>5:18</b>
<b>ECONOMIC COSTS</b>	Adequate utility, <b>6:4, 6:10</b>
<b>ECONOMIC JUSTIFICATIONS</b>	Temporal scope, <b>11:18</b>
<b>ECONOMICS</b>	Computer-related inventions, <b>5:41</b> History, <b>1:2, 1:18</b> Inventorship, <b>10:3, 10:14</b> Joint inventorship, <b>10:52</b> Non-obviousness, <b>9:10, 9:38, 9:39, 9:43</b> Non-statutory hybrid inventions, <b>5:83, 5:84</b> Policy Justification (this index) Priority, <b>8:36</b> Processes, <b>5:38</b> Static physical configurations, <b>5:14, 5:15, 5:18</b> Utility requirement, <b>6:2, 6:10</b>
<b>EDUCATION LEVEL</b>	Non-obviousness, <b>9:50</b>
<b>EFFECTIVE ABANDONMENT</b>	Joint inventorship, <b>10:52</b>
<b>EFFECTIVE CONTROL</b>	Adequate utility, <b>7:3</b>
<b>EFFECTIVE FILING DATE</b>	Adequate disclosure, <b>7:52</b> Anticipation, lack of, <b>8:22</b> Non-obviousness, <b>9:83</b> Prior inventor, prior-user rights, <b>22:23</b> Priority, <b>8:176</b> Temporal scope, <b>11:30, 11:35</b>
<b>EFFECTIVELY PLACED ON FILE</b>	Adequate disclosure, <b>7:56</b>
<b>EFFECTIVENESS</b>	Adequate utility, <b>6:12</b>
<b>E.I. DUPONT DE NEMOURS AND CO. v. MONSANTO CO.</b>	Adequate commerciality, <b>14:36</b>
<b>18-MONTH PUBLICATION</b>	Temporal Scope of Infringement (this index)
<b>1883 TEXT OF PARIS CONVENTION</b>	Prior inventor, prior-user rights, <b>22:9</b>
<b>ELECTION</b>	Non-obviousness, <b>9:78</b> Patent and Trademark Office (PTO), <b>2:35</b>
<b>ELECTRICAL ARTS</b>	Adequate utility, <b>6:19, 7:25</b> Claims, <b>4:65</b> Non-obviousness, <b>9:70, 9:76</b> Priority, <b>8:48</b> Processes, <b>5:21</b> Static physical configurations, <b>5:8</b>
<b>ELECTRIC STORAGE BATTERY CO. v. SHIMADZU</b>	Priority, <b>8:102</b>
<b>ELECTRONICS INDUSTRY</b>	Claims, <b>4:81</b> Static physical configurations, <b>5:8</b>
<b>ELEMENT-BY-ELEMENT INQUIRY</b>	Technological scope, <b>13:73</b>
<b>ELEMENTS OF EQUITABLE ESTOPPEL</b>	Generally, <b>24:7</b>
<b>ELEMENTS PER SE</b>	Non-statutory hybrid inventions, <b>5:74</b>
<b>ELEVENTH AMENDMENT</b>	History, <b>1:14</b>
<b>ELI LILLY AND CO. v. MEDTRONIC, INC.</b>	Adequate commerciality, <b>14:65, 14:69-14:71</b>
<b>EMBODIMENTS</b>	Adequate commerciality, <b>14:42</b> Adequate disclosure. Disclosure (this index) Adequate utility, <b>6:14</b> Anticipation, lack of, <b>8:13</b>

## INDEX

### **EMBODIMENTS—Cont'd**

Claims (this index)  
Designs, **5:46**  
Disclosure (this index)  
Geographic scope, **12:24, 12:44**  
Inventorship, **10:12**  
Joint inventorship, **10:40**  
Priority, **8:44, 8:55**  
Processes, **5:21, 5:22**  
Reissue of patent, **16:119**

### **EMBREX, INC. v. SERVICE ENGINEERING CORP.**

Adequate commerciality, **14:59**

### **EMOTIONAL THOUGHT**

Processes, **5:26**

### **EMPLOYMENT**

Adequate disclosure, **7:54**  
Adequate utility, **7:51**  
Contracts and agreements, **1:16**  
Correction of inventorship, **10:59, 10:67**  
History, **1:16, 1:19**  
Inventorship (this index)  
Joint inventorship, **10:25, 10:39**  
Non-Obviousness (this index)  
Patent and Trademark Office (PTO), **2:22**  
Policy justification, **1:34**  
Priority, **8:67, 8:71**

### **ENABLEMENT**

Anticipation, Lack Of (this index)  
Description requirement, **7:34-7:39**  
Disclosure (this index)

### **EN BANC**

Claims, **4:74, 4:93**  
Non-obviousness, **9:74, 9:85**  
Non-statutory hybrid inventions, **5:76**  
Patent and Trademark Office (PTO), **2:36, 2:43**  
Technological scope, **13:31-13:33**

### **ENCOMPASSED TERRITORY**

Geographic scope, **12:11-12:14**

### **ENERCON GMBH v. INTERNATIONAL TRADE COM'N**

Adequate commerciality, **14:39, 14:40**

### **ENFORCEMENT**

Adequate utility, **6:19**  
History, **1:14, 1:18, 1:24**  
Inventorship, **10:17**  
Joint inventorship, **10:29**  
Patent and Trademark Office (PTO), **2:7, 2:13, 2:21**  
Policy justification, **1:31**  
Processes, **5:39**

### **ENGINEERING PROCESSES**

Static physical configurations, **5:14**

### **ENGINES**

Statutory Subject Matter (this index)

### **ENGLISH LAW AND DOCTRINES**

Adequate disclosure, **7:46**  
Claims, **4:2**  
History (this index)  
Inventorship, **10:2**  
Joint inventorship, **10:53**  
Patent and Trademark Office (PTO), **2:1, 2:4, 2:7, 2:16**  
Processes, **5:21**  
Static physical configurations, **5:9**

### **ENTREPRENEURS**

Inventorship, **10:14**

### **ENVISIONED INVENTIONS**

Adequate disclosure, **7:34**

### **ENZO BIOCHEM, INC. v. GEN-PROBE INC.**

Adequate utility, **7:9, 7:37, 7:39**

### **EQUIPMENT**

Policy justification, **1:34, 1:39**

### **EQUITABLE ESTOPPEL**

Elements, **24:7**  
Historical development, **24:6**

### **EQUITABLE LIMITATIONS**

History, **1:22**

**EQUITY**

Technological scope, **13:20, 13:61**

**EQUIVALENTS, DOCTRINE OF**

Doctrine of Equivalents (this index)

**ERIE RAILROAD V. TOMPKINS**

Historical origins of patent grant,  
**1:13.30**

**ERROR**

Mistake and Error (this index)

**ESCROW**

Invalidity, **17:40**

**ESTERS**

Temporal scope, **11:47**

**ESTOPPEL**

Generally, **24:1-24:32**

A.C. Aukerman Co. v. R.I. Chaides  
Const. Co., **24:17**

Advanced Hydraulics, Inc. v. Otis  
Elevator Co., **24:13**

Basic definition, **24:4**

Basic rule, **24:23**

Case law

A.C. Aukerman Co. v. R.I. Chaides  
Const. Co., **24:17**

Advanced Hydraulics, Inc. v. Otis  
Elevator co., defense to patent  
infringement, **24:13**

Continental Coatings Corporation  
v. Metco, Inc., defense to  
patent infringement, **24:12**

Dwight & Lloyd Sintering Co. v.  
Greenwalt, defense to patent  
infringement, **24:11**

examples of court decisions in  
1982, **24:10-24:14**

Wyeth v. Stone, early law, **24:9**

Categories of estoppels, **24:5**

Communication from patent owner  
generally, **24:25**

delay, **24:26**

litigation, **24:27**

silence, **24:26**

threat, **24:26**

Conduct, historical development,  
**24:6**

**ESTOPPEL—Cont'd**

Continental Coatings Corporation v.

Metco, Inc., **24:12**

Court decisions in 1982, examples,  
**24:10-24:14**

Defense to patent infringement  
generally, **24:8**

Advanced Hydraulics, Inc. v. Otis  
Elevator co., **24:13**

Continental Coatings Corporation  
v. Metco, Inc., **24:12**  
court decisions in 1982, examples,  
**24:10-24:14**

Dwight & Lloyd Sintering Co. v.  
Greenwalt, **24:11**

early law, **24:9**

Federal Circuit developments,  
**24:15-24:18**

historical development, **24:8-24:18**  
Wyeth v. Stone, **24:9**

Definition, **24:4**

Delay, communication from patent  
owner, **24:26**

Dwight & Lloyd Sintering Co. v.  
Greenwalt, defense to patent  
infringement, **24:11**

Early categories of estoppels, **24:5**

Elements of equitable estoppel, **24:7**

Equitable estoppel

elements, **24:7**

historical development, **24:6**

Estoppels in pais, **24:5**

Federal Circuit developments

A.C. Aukerman Co. v. R.I. Chaides  
Const. Co., **24:17**

defense to patent infringement,  
**24:15-24:18**

early decisions, **24:16**

subsequent developments, **24:18**

Fraud distinguished, **24:22**

Historical development

conduct, **24:6**

defense to patent infringement,  
**24:8-24:18**

early categories of estoppels, **24:5**  
equitable estoppel, **24:6**

Federal Circuit developments,  
**24:15-24:18**

In pais estoppels, **24:5**

## INDEX

### **ESTOPPEL—Cont'd**

- Invalidity (this index)
- Laches distinguished, **24:21**
- Litigation, communication from patent owner, **24:27**
- Material prejudice, **24:29**
- Patent infringement, defense, **24:8-24:18**
- Policy justification
  - generally, **24:20**
  - fraud distinguished, **24:22**
  - laches distinguished, **24:21**
- Priority, **8:86**
- Reexamination, **16:127, 16:135**
- Reliance, **24:28**
- Remedies, impact of estoppel, **24:32**
- Silence, communication from patent owner, **24:26**
- Specific issues
  - communication from patent owner, **24:25-24:27**
  - impact on remedies, **24:32**
  - material prejudice, **24:29**
  - proof issues, **24:30**
  - reliance, **24:28**
  - unclean hands, **24:31**
- Technological Scope of Infringement (this index)
- Threat, communication from patent owner, **24:26**
- Unclean hands, **24:31**
- Wyeth v. Stone, defense to patent infringement, **24:9**

### **ESTOPPELS IN PAIS**

- Early categories of estoppels, **24:5**

### **ETHICAL ISSUES**

- Static physical configurations, **5:18**

### **EUROPE**

- Claims, **4:80**
- History, **1:2**
- Non-obviousness, **9:5**
- Policy justification, **1:43**

### **EUROPEAN PATENT CONVENTION (EPC)**

- Adequate utility, **6:3**
- Claims, **4:73**

### **EUROPEAN PATENT**

#### **CONVENTION (EPC)—Cont'd**

- Inventorship, **10:17**
- Non-obviousness, **9:38**
- Patent and Trademark Office (PTO), **2:11, 2:13**
- Processes, **5:39**
- Statutory subject matter, **5:4**

### **EUROPEAN PATENT OFFICE**

- Patent and Trademark Office (PTO), **2:11**

### **EUROPEAN PATENT SYSTEMS**

- Congress, **2:11**

### **EUROPEAN UNION**

- Static physical configurations, **5:18**

### **EVANS v. EATON**

- Claims, **4:2**

### **EVIDENCE**

- Adequate commerciality, **14:6, 14:15, 14:16**
- Adequate disclosure. Disclosure (this index)
- Anticipation, Lack Of (this index)
- Claims (this index)
- Correction of inventorship, **10:58, 10:60**
- Examination of Original Application (this index)
- Indirect Infringement (this index)
- Inventorship, **10:14**
- Non-Obviousness (this index)
- Patent and Trademark Office (PTO), **2:28, 2:39, 2:43**
- Presumptions (this index)
- Priority (this index)
- Static physical configurations, **5:17**
- Utility Requirement (this index)

### **EXACT CLAIM LANGUAGE**

- Priority, **8:259**

### **EXAMINATION**

- Application
  - Examination of Application (this index)
  - Examination of Original Application (this index)

**EXAMINATION—Cont'd**

Claims (this index)  
Correction (this index)  
Ex Parte Examination (this index)  
Original application. Examination of  
    Original Application (this index)  
Patent Act of 1836, **2:17**  
Patent and Trademark Office (PTO),  
    generally, **2:2**  
Reexamination (this index)

**EXAMINATION OF APPLICATION**

Claims, **4:3**  
Correction of inventorship, **10:58**  
Initial examination, **2:10**  
Non-statutory hybrid inventions,  
    **5:69, 5:85**  
Patent and Trademark Office (PTO),  
    generally, **2:27**

**EXAMINATION OF ORIGINAL  
APPLICATION**

Amendment of application  
    response and reexamination, below  
Claims  
    response and reexamination, below  
Continuation Application (this index)  
Continuation-In-Part-Application  
    (this index)  
Disclosure  
    Continuation Application (this  
        index)  
    response and reexamination, below  
Fees  
    filing fee, below  
Issuance of Patent (this index)  
Late-Claiming (this index)  
Merits of application, examination of.  
    Examination of original applica-  
        tions, above  
Modification. Change and modifica-  
    tion, above  
New matter  
    response and reexamination, below  
Parent application  
    Continuation Practice (this index)  
Pending applications  
    adequate utility, **7:28**  
    Continuance Practice (this index)

**EXAMINATION OF ORIGINAL  
APPLICATION—Cont'd**

Reexamination. Response and  
    reexamination, below  
Reference  
    Continuation Practice (this index)  
Rejection of Application (this index)  
Response and reexamination  
    amendments  
        disclosure, below in this group  
        late claiming, below in this  
            group  
        new matter. Disclosure, below in  
            this group  
    Late-Claiming (this index)  
Same subject matter. Continuation  
    Practice (this index)  
Specification  
    response and reexamination, above  
Validity  
    Continuance Practice (this index)  
    response and reexamination, above

**EXAMINATION OF PATENT**

Adequate utility, **6:13**  
Manual of Patent Examining Proce-  
    dure, generally, **2:26**

**EXAMINATION PROCESS**

Processes, **5:30**

**EXAMINER**

Adequate disclosure, **7:9**  
Computer-related inventions, **5:53**  
Examination of Original Application  
    (this index) (this index)  
Joint inventorship, **10:46**  
Non-statutory hybrid inventions,  
    **5:48, 5:64, 5:68**  
Patent and Trademark Office (PTO),  
    **2:22, 2:26**

**EXAMINERS-IN-CHIEF**

Patent and Trademark Office (PTO),  
    **2:22**

**EXAMINING CLERK**

Generally, **2:20**

**EXAMINING CORPS**

Generally, **2:22**

## INDEX

**EXAMINING CORPS—Cont'd**  
Non-obviousness, **9:78**  
Non-statutory hybrid inventions, **5:56, 5:72, 5:83**  
Processes, **5:38**

**EXCEPTIONS, EXCLUSIONS, AND EXEMPTIONS**  
Adequate Commerciality (this index)  
Adequate disclosure, **7:3, 7:22, 7:25**  
Adequate utility, **6:5**  
Anticipation, lack of, **8:1, 8:14, 8:21**  
Claims (this index)  
Computer-related inventions, **5:42, 5:45**  
Correction of inventorship, **10:61**  
History, **1:2, 1:7**  
Inventorship, **10:8**  
Joint inventorship, **10:31, 10:33**  
Medical and diagnostic procedures, section 287(c) defense, **20:21**  
Non-Obviousness (this index)  
Patent and Trademark Office (PTO), **2:12**  
Priority, **8:34, 8:38, 8:39, 8:54**  
Processes (this index)  
Static Physical Configurations (this index)  
Statutory subject matter, **5:1, 5:4-5:6, 5:12, 5:27**  
Statutory Subject Matter (this index)

**EXCESSIVE ROYALTIES**  
Misuse of patent, **18:30**

**EXCESS OVER STATE OF THE ART**  
Joint inventorship, **10:33**

**EXCLUSIVE CONTROL**  
Adequate utility, **7:20**  
Priority, **8:242-8:244**

**EXCLUSIVE POWER**  
Patent and Trademark Office (PTO), **2:7**  
Processes, **5:21**

**EXCLUSIVE RIGHTS**  
Adequate commerciality, **14:42**  
Adequate disclosure, **7:22**

**EXCLUSIVE RIGHTS—Cont'd**  
History, **1:2**  
Indirect infringement, **15:7, 15:18**  
Inventorship, **10:2**  
Non-obviousness, **9:60**  
Patent and Trademark Office (PTO), **2:1**  
Static physical configurations, **5:15**

**EXCLUSIVITY**  
Adequate commerciality, **14:12**  
Policy justification, **1:38**

**EXCUSE**  
Justification (this index)

**EXECUTIVE AUTHORITY**  
Congress (this index)

**EXECUTIVE BRANCH**  
History, **1:18, 1:25**  
Non-obviousness, **9:82**  
Patent and Trademark Office (PTO) (this index)  
Priority, **8:34**

**EXHAUSTION**  
Implied-in-law license compared, **19:33**  
Prior inventor, prior-user rights, extension by exhaustion, **22:26**

**EXPANDED POST-GRANT REVIEW**  
Processes, **5:35**

**EX PARTE ALLEN**  
Static physical configurations, **5:17**

**EX PARTE CONTEXT**  
Adequate utility, **7:20**

**EX PARTE DESORMEAUX**  
Joint inventorship, **10:46**

**EX PARTE DETERMINATION**  
Patent and Trademark Office (PTO), **2:29, 2:34**

**EX PARTE EXAMINATION**  
Generally, **2:12, 2:18, 2:38**  
Adequate disclosure, **7:21, 7:31**  
Claims, **4:94**  
Static physical configurations, **5:17**

**EX PARTE GILDERDALE**

Joint inventorship, **10:46**

**EX PARTE MARKUSH**

Claims, **4:100**

**EX PARTE McNABB**

Processes, **5:27**

**EX PARTE NATURE**

Patent and Trademark Office (PTO),  
**2:6**

**EX PARTE PROCEEDINGS**

Examination of Original Application  
(this index)  
Patent and Trademark Office (PTO),  
**2:13, 2:17, 2:18**  
Priority, **8:69**  
Reexamination, **16:123**

**EX PARTE PROSECUTION**

Adequate disclosure, **7:41**  
Claims, **4:87, 4:89**  
Priority, **8:73**

**EX PARTE READ**

Processes, **5:27**

**EX PARTE REJECTION**

Non-obviousness, **9:37**

**EX PARTE ROBBINS**

Non-obviousness, **9:36, 9:37**

**EXPECTATIONS**

Adequate utility, **6:19**  
Non-statutory hybrid inventions, **5:61**  
Policy justification, **1:37, 1:39**  
Statutory subject matter, **5:4**

**EXPERIENCE**

Non-obviousness, **9:50**

**EXPERIMENTS**

Adequate Commerciality (this index)  
Tests and Experiments (this index)

**EXPERTS**

Claims, **4:47**  
Patent and Trademark Office (PTO),  
**2:37, 2:39**  
Priority, **8:58, 8:69**

**EXPIRATION**

Adequate commerciality, **14:61**  
Adequate disclosure, **7:5**  
Reissue of patent, **16:114**

**EXPRESS CONTRACT**

Inventorship, **10:17**

**EXPRESS INSTRUCTIONS OR  
ADVICE**

Non-obviousness, **9:66**

**EXPRESSIONS**

Claims (this index)

**EXPRESS LICENSE**

Licenses and Permits (this index)

**EXPRESS WAIVER**

History, **1:14**

**EXTENSION**

Examination of Original Application  
(this index)  
Priority, **8:242-8:244**  
Temporal Scope of Infringement (this  
index)

**EXTENSION BY EXHAUSTION**

Prior inventor, prior-user rights,  
**22:26**

**EXTREME POVERTY**

Priority, **8:67**

**EXTRINSIC SOURCES**

Claims (this index)

**FACSIMILE MACHINES**

Processes, **5:24**

**FACT-FINDING**

Patent and Trademark Office (PTO),  
**2:39**

**FACT-INTENSIVE INQUIRY**

Adequate utility, **7:11**

**FACTS**

Claims (this index)  
Technological scope, **13:29**

**FACTUAL COMPILATIONS**

Static physical configurations, **5:11**  
Statutory subject matter, **5:42**

## INDEX

### **FACTUAL DATA**

Non-statutory hybrid inventions, **5:55**  
Static physical configurations, **5:11**

### **FACTUAL DETERMINATION**

Patent and Trademark Office (PTO),  
**2:19**

### **FACTUAL EQUIVALENCY**

Technological Scope of Infringement  
(this index)

### **FACTUAL STATEMENTS**

Adequate utility, **6:13**

### **FAIRNESS, LACK OF**

Non-obviousness, **9:28**

### **FALSE ASSERTIONS**

Adequate utility, **6:13**

### **FALSE SCHEME**

Adequate utility, **6:15**

### **FAMILY AND RELATIVES**

Priority, **8:71**

### **FAR EAST**

History, **1:2**  
Policy justification, **1:43**

### **FARMERS AND FARMING**

Static physical configurations, **5:14,**  
**5:18**

### **FAROUDJA LABORATORIES, INC.**

**v. DWIN ELECTRONICS, INC.**

Adequate commerciality, **14:36**

### **FEDERAL CIRCUIT**

#### **AUTHORITIES PRIOR TO 1995**

Non-obviousness, biotechnical  
processes, Section 103(B), **9:80**

### **FEDERAL CIRCUIT COURTS**

Adequate Commerciality (this index)

Adequate utility, **6:18, 6:19**

Anticipation, lack of, **8:10, 8:29,**  
**8:31**

Claims (this index)

Computer-related inventions, **5:42,**  
**5:44, 5:53**

### **FEDERAL CIRCUIT COURTS**

#### **—Cont'd**

Correction of inventorship, **10:67,**  
**10:68**

Court of Customs and Patent Appeals  
(CCPA) for Federal Circuit,  
**2:21**

Defenses, express and implied licens-  
es, **19:24**

Disclosure (this index)

Estoppel (this index)

Examination of Original Application  
(this index)

History, **1:25**

Inventorship, **10:7, 10:11**

Joint inventorship, **10:27**

Misuse of patent, **18:22, 18:24**

Non-Obviousness (this index)

Non-Statutory Hybrid Inventions  
(this index)

Patent and Trademark Office (PTO)  
(this index)

Priority, **8:62, 8:66, 8:69**

Processes, **5:30**

Reissue of patent, **16:93-16:96**

Static physical configurations, **5:11,**  
**5:15**

Technological Scope of Infringement  
(this index)

Utility Requirement (this index)

### **FEDERAL CODE**

Defenses, **17:8**

### **FEDERAL COURTS**

History, **1:14**

Inventorship, **10:6**

### **FEDERAL JUDICIARY**

See also specific Courts in the index

Policy justification, **1:31**

### **FEDERAL JURISDICTION**

History, **1:14**

### **FEDERAL REGISTER**

Patent and Trademark Office (PTO),  
**2:27, 2:28**

**FEDERAL RULES OF APPELLATE PROCEDURE (FRAP)**  
Patent and Trademark Office (PTO), **2:39**

**FEDERAL RULES OF CIVIL PROCEDURE (FRCP)**  
Patent and Trademark Office (PTO), **2:38, 2:39**

**FEDERAL RULES OF EVIDENCE (FRE)**  
Patent and Trademark Office (PTO), **2:38, 2:39**

**FEDERAL TRADE COMMISSION (FTC)**  
Adequate commerciality, **14:58**  
Adequate utility, **6:5**

**FEDERAL TRADEMARK REGISTRATION**  
Patent and Trademark Office (PTO), **2:20**

**FEDERAL TRIAL COURTS**  
Claims, **4:80**  
History, **1:25**  
Patent and Trademark Office (PTO), **2:43**

**FEES**  
Examination of Original Application (this index)  
Processes, **5:39**

**FESTO CORP. v. SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD.**  
Technological Scope of Infringement (this index)

**FIERS v. REVEL**  
Adequate utility, **7:9**

**FILING APPLICATION**  
Anticipation, lack of, **8:21**  
Disclosure (this index)  
Effective Filing Date (this index)  
History, **1:14, 1:19, 1:25**  
Inventorship (this index)  
Joint Inventorship (this index)  
Non-Obviousness (this index)

**FILING APPLICATION—Cont'd**  
Patent and Trademark Office (PTO), generally, **2:13**  
Priority (this index)  
Static physical configurations, **5:17**  
Temporal Scope of Infringement (this index)

**FILING CIVIL ACTION**  
Processes, **5:39**

**FILING DATE OF APPLICATION**  
America Invents Act, first to file, **7:32**  
Anticipation, Lack Of (this index)  
Designs, **5:46**  
Examination of Original Application (this index)  
History, **1:19**  
Joint inventorship, **10:40**  
Non-Obviousness (this index)  
Utility Requirement (this index)

**FILING FEES**  
Examination of Original Application (this index)

**FILING FOREIGN APPLICATIONS**  
Adequate utility, **7:18**

**FILING JOINT APPLICATION**  
Joint inventorship, **10:21, 10:35, 10:36, 10:41**

**FILING LATER DUPLICATE APPLICATION**  
Joint inventorship, **10:45**

**FILING PETITION**  
Patent and Trademark Office (PTO), **2:33**

**FILING SUITS**  
History, **1:14**  
Patent and Trademark Office (PTO), **2:7**

**FINAL DETERMINATION**  
Patent and Trademark Office (PTO), **2:7, 2:29**

**FINALITY**  
Claims, **4:19**

## INDEX

**FINANCIAL DATA**  
Non-statutory hybrid inventions, **5:83**

**FINANCIAL REVENUE**  
Processes, **5:39**

**FINANCIAL REWARDS**  
Processes, **5:39**

**FINE ARTS**  
Statutory subject matter, **5:1**

**FIRST APPLICATION**  
Examination of Original Application (this index)  
Joint inventorship, **10:40, 10:46**  
Priority, **8:126**

**FIRST CIRCUIT**  
Non-obviousness, **9:60**

**FIRST CONGRESS**  
Patent and Trademark Office (PTO), **2:4**

**FIRST-GENERATION HYBRIDS**  
Static physical configurations, **5:14**

**FIRST-IN-RIGHT**  
Priority, **8:33**

**FIRST INVENTOR**  
Adequate utility, **7:28**  
Correction of inventorship, **10:67**  
History, **1:18**  
Joint inventorship, **10:19**  
Priority, **8:41, 8:64**

**FIRST INVENTORSHIP**  
Correction, **10:67**

**FIRST POSSESSOR**  
Inventorship, **10:4**

**FIRST SALE**  
Defenses, implied-in-law licenses, **19:38-19:40**

**FIRST-TO-FILE**  
Adequate disclosure, **7:32**  
America Invents Act, **7:32**  
Non-obviousness, **9:38**  
Prior inventor, prior-user rights, correction, **22:4**

**FIRST-TO-FILE—Cont'd**  
Priority, **8:35, 8:36**

**FIRST-TO-INVENT**  
Anticipation, Lack Of (this index)  
Inventorship, **10:11, 10:12**  
Priority, **8:35, 8:36, 8:56**

**FIXED CONDITIONS**  
History, **1:4**

**FIXED PRICES**  
History, **1:4**

**FIXED STANDARD**  
Utility requirement, **6:18**

**FIXED TERMS**  
History, **1:4**

**FLORIDA PREPAID POSTSECONDARY EDUCATION EXPENSE BD., v. COLLEGE SAVINGS BANK**  
Generally, **1:14**

**FOLLOW-ON DEVELOPMENTS**  
Non-obviousness, **9:46**

**FOLLOW-ON PATENTS**  
Non-obviousness, **9:11**

**FOOD, DRUG, AND COSMETIC ACT (FDCA)**  
Adequate Commerciality (this index)

**FOOD AND DRUG ADMINISTRATION (FDA)**  
Adequate Commerciality (this index)  
Adequate utility, **6:5, 6:12**  
Processes, **5:39**

**FOODSTUFFS**  
Statutory Subject Matter (this index)

**FORECLOSURE OF RIGHTS**  
Correction of inventorship, **10:67**

**FOREIGN COUNTRIES**  
Generally, **8:273-8:280**  
Adequate commerciality, **14:33**  
Adequate utility  
    generally, **6:5, 7:5**  
    filing application, **7:18**

**FOREIGN COUNTRIES—Cont'd**

Adequate utility—Cont'd  
    Germany, **6:3, 6:6**  
Anticipation, lack of, **8:1**  
Applications  
    adequate utility, **7:18**  
    identical or related applicants, **8:277**  
    Priority (this index)  
Claims, **4:8, 4:9, 4:63**  
Definitions, **8:278**  
Designs, **5:46**  
Disparate onset, generally, **8:273-8:280**  
Examination of Original Application (this index)  
Geographic Scope of Infringement (this index)  
Historical development, **8:275**  
History, **1:2, 1:14, 1:25**  
Identical or related applicants, **8:277**  
Inventorship, **10:7, 10:17**  
Modern law, **8:276-8:279**  
National effect, **8:280**  
Non-obviousness  
    generally, **9:11**  
    secret prior art, **9:28, 9:38, 9:42**  
    timeliness, Section 102, **9:38**  
Office of Legislative and International Affairs (OLIA), **2:22**  
Paragraph 102(d), generally, **8:273-8:280**  
Patent and Trademark Office (PTO), **2:1, 2:11, 2:13, 2:22**  
Patented defined, **8:278**  
Policy justification, **1:29, 1:32, 1:43, 8:274**  
Priority (this index)  
Prior-user rights internationally, **22:7-22:12**  
Processes, **5:39**  
Related applicants, **8:277**  
Same invention, **8:279**  
Static physical configurations, **5:18**  
Statutory subject matter, **5:4, 5:5**

**FORENSICS**

Adequate utility, **6:18, 6:19**

**FORESEEABILITY**

Adequate disclosure, **7:26, 7:53**  
Adequate utility, **6:1, 6:6, 6:16**

**FORMAL REJECTIONS AND RESTRICTIONS**

Technological scope, **13:107**

**FORMAL RULEMAKING**

Patent and Trademark Office (PTO), **2:28**

**FORMAL STATEMENT**

Claims, **4:2**

**FORMULAE**

Statutory subject matter, **5:24**

**FOURTEENTH AMENDMENT**

Adequate utility, **6:5**  
History, **1:14**  
Static physical configurations, **5:17**

**FRAME OF REFERENCE**

Adequate disclosure, **7:43**

**FRANCE**

Patent and Trademark Office (PTO), generally, **2:13**

**FRAUD**

Adequate utility, **6:5, 6:15**  
Correction of inventorship, **10:57**  
Estoppel distinguished, **24:22**  
Patent and Trademark Office (PTO), **2:16**

**FRCP**

Federal Rules of Civil Procedure (FRCP) (this index)

**FRE**

Federal Rules of Evidence (FRE) (this index)

**FREE ACCESS**

Non-obviousness, **9:9**

**FREE COMMERCE**

History, **1:3**

**FREEBOM OF ACTION OF LICENSEE**

Misuse of Patent (this index)

## INDEX

**FREEDOM OF CONTRACT**  
Defenses, express and implied licenses, **19:31**

**FREEMAN-WALTER-ABELE TEST**  
Non-statutory hybrid inventions, **5:81**

**FREE TRADE**  
History, **1:7**

**FRIVOLOUS**  
Adequate utility, **6:15**

**FULL AND FAIR OPPORTUNITY TO LITIGATE**  
Invalidity, **17:31**

**FUNCTION, WAY, RESULT**  
Technological scope, **13:66**

**FUNCTIONAL RELATIONSHIPS**  
Statutory subject matter, **5:12**

**FUNCTIONAL SIMILARITY**  
Non-obviousness, **9:73**

**FUNDS AND FUNDING**  
Policy justification, **1:34**

**FUNGI**  
Static physical configurations, **5:14**

**FUTURE ACTS AND MATTERS**  
Adequate disclosure  
generally, **7:5, 7:14**  
best mode, **7:53**  
combinations, control of, **7:24**  
research, **6:6**  
species, **7:24**  
technology, **6:19**  
use-based view, **6:20**  
Inventorship, **10:7**  
Justification, **1:35**  
Policy justification, **1:42**  
Statutory subject matter, **5:5**  
Utility Requirement (this index)

**GAMBLING**  
Adequate utility, **6:5, 6:15**

**GANSKE/FRISK COMPROMISE**  
Processes, **5:39**

**GARDINER v. HOWE**  
Geographic scope, **12:4**

**GASES**  
Static physical configurations, **5:9**

**GATT**  
General Agreement on Tariffs and Trade (GATT) (this index)

**GELS**  
Static physical configurations, **5:9**

**GENERAL AGREEMENT**  
Processes, **5:29**

**GENERAL AGREEMENT ON TARIFFS AND TRADE (GATT)**  
Adequate commerciality, **14:10, 14:33, 14:46**  
Prior inventor, prior-user rights, **22:11**  
Priority, **8:107**

**GENERAL CONFIGURATION**  
Non-obviousness, **9:67**

**GENERAL PATENT ACT OF 1870**  
Processes, **5:21**

**GENERIC CLAIMING**  
Adequate utility, **7:26**

**GENERIC INVENTIONS**  
Adequate utility, **7:23**  
Priority, **8:48, 8:53**

**GENERIC PHARMACEUTICALS**  
Adequate commerciality, **14:63, 14:64**  
Indirect infringement, **15:18**

**GENE SEQUENCING, ART OF**  
Adequate utility, **7:14**

**GENE THERAPY TREATMENTS**  
Processes, **5:39**

**GENETICALLY MODIFIED HUMANS**  
Adequate utility, **6:5**

**GENETIC ENGINEERING**  
Static physical configurations, **5:17**

<b>GENETIC STRUCTURE</b>	
Adequate utility, <b>6:6</b>	
<b>GENOME STRUCTURE</b>	
Adequate commerciality, <b>14:58</b>	
<b>GENOMIC INVENTIONS</b>	
Adequate commerciality, <b>14:51</b>	
Adequate utility, <b>6:19</b>	
<b>GENOMIC MATERIAL</b>	
Adequate commerciality, <b>14:58</b>	
<b>GENUS AND SPECIE</b>	
Adequate disclosure, <b>7:24, 7:26</b>	
Adequate utility, <b>6:6</b>	
Anticipation, lack of, <b>8:13</b>	
Claims, <b>4:4, 4:63, 4:65</b>	
Priority, <b>8:47, 8:80</b>	
<b>GEOGRAPHIC LIMITATIONS</b>	
Priority (this index)	
<b>GEOGRAPHIC SCOPE OF INFRINGEMENT</b>	
Generally, <b>12:1 et seq.</b>	
Accused activity. Situs of accused activity, below	
Amendments, <b>12:29, 12:36-12:38</b>	
Apparatus, <b>12:25, 12:33</b>	
Applications, <b>12:40</b>	
Asserted patent, <b>12:41</b>	
Brown v. Duchesne, <b>12:4</b>	
Case law	
Brown v. Duchesne, <b>12:4</b>	
Deepsouth Packing Co. v. Laitram Corp., <b>12:7, 12:28</b>	
early cases, <b>12:27</b>	
Gardiner v. Howe, <b>12:4</b>	
Claimed embodiments, export of, <b>12:24</b>	
Claimed process, <b>12:25</b>	
Contributing to practice of invention.	
Cross-border transactions, below	
Controlled spaces, <b>12:12</b>	
Cross-border transactions	
generally, <b>12:22-12:43</b>	
exports. Outgoing transactions, below this group	
incoming transactions	
generally, <b>12:31-12:43</b>	
<b>GEOGRAPHIC SCOPE OF INFRINGEMENT—Cont'd</b>	
Cross-border transactions—Cont'd	
incoming transactions—Cont'd	
foreign inducement of infringing acts inside United States, <b>12:43</b>	
products made by patented apparatus, <b>12:33</b>	
products made by patented process	
generally, <b>12:34-12:42</b>	
domestic application, special issues, <b>12:40</b>	
history, <b>12:35</b>	
issue date of asserted patent, relation to, <b>12:41</b>	
presumption as to making, <b>12:42</b>	
Process Patents Amendment Act of 1988, <b>12:36-12:38</b>	
product defined, <b>12:37</b>	
products made by process defined, <b>12:38</b>	
Section 271(g), generally, <b>12:34-12:42</b>	
special issues, <b>12:39-12:41</b>	
products produced with patented materials, <b>12:32</b>	
Section 271(g). Products made by patented process, above this subgroup	
outgoing transactions	
generally, <b>12:23-12:30</b>	
apparatus to perform claimed process, export of, <b>12:25</b>	
claimed embodiments, export of, <b>12:24</b>	
contributing to foreign practice of invention, Section 271(f), generally, <b>12:26-12:30</b>	
Deepsouth Packing Co. v. Laitram Corp., <b>12:28</b>	
early cases, <b>12:27</b>	
foreign practice of invention, inducing and contributing to, Section 271(f), generally, <b>12:26-12:30</b>	

## INDEX

**GEOGRAPHIC SCOPE OF INFRINGEMENT—Cont'd**

Cross-border transactions—Cont'd  
outgoing transactions—Cont'd  
inducing and contributing to  
foreign practice of invention, Section 271(f), generally, **12:26-12:30**  
Patent Law Amendments Act of 1984, **12:29**  
Section 271(f), generally, **12:26-12:30**  
special issues, **12:30**  
products made by patented process. Incoming transactions, above this group  
Section 271(g). Incoming transactions, above this group  
Decisions, **12:3, 12:5**  
Deepsouth Packing Co. v. Laitram Corp., **12:7, 12:28**  
Definitions  
product, **12:37**  
products made by process, **12:38**  
Domestic application, **12:40**  
Domestic infringement, **12:43**  
Domestic sale, requirement of, **12:21**  
Early cases, **12:27**  
Embodiments, **12:24, 12:44**  
Encompassed territory, **12:11-12:14**  
Exports. Cross-border transactions, above  
Foreign inducement of infringing acts inside United States, **12:43**  
Foreign practice of invention, inducing and contributing to, Section 271(f). Cross-border transactions, above  
Gardiner v. Howe, **12:4**  
Historical development  
generally, **12:2-12:9**  
Brown v. Duchesne, **12:4**  
controlled spaces, **12:12**  
cross-border transactions, **12:35**  
Deepsouth Packing Co. v. Laitram Corp., **12:7**  
early decisions, **12:3**  
early statutes, **12:3**

**GEOGRAPHIC SCOPE OF INFRINGEMENT—Cont'd**

Historical development—Cont'd  
encompassed territory, **12:11-12:14**  
Gardiner v. Howe, **12:4**  
outer space, **12:9, 12:14**  
Patent Act of 1870 and subsequent decisions, **12:5**  
Patent Act of 1952 and subsequent developments, **12:6-12:9**  
policy justification, **12:10**  
registered vessels, **12:13**  
section 105, **12:9**  
Section 271(f), **12:7**  
Section 271(g), **12:8**  
Incoming transactions. Cross-border transactions, above  
Inducement. Cross-border transactions, above  
Infringement, **12:43**  
Issue date of asserted patent, relation to, **12:41**  
Justification of policy, **12:10**  
Offer, situs of, **12:20**  
Offer for sale, **12:19-12:21**  
Outer space, **12:9, 12:14**  
Outgoing transactions. Cross-border transactions, above  
Patent Act of 1870 and subsequent decisions, **12:5**  
Patent Act of 1952 and subsequent developments, **12:6-12:9**  
Patent Law Amendments Act of 1984, **12:29**  
Performance, **12:25**  
Policy justification, **12:10**  
Presumption as to making, **12:42**  
Process, claimed, **12:25**  
Process Patents Amendment Act of 1988, **12:36-12:38**  
Product defined, **12:37**  
Production, **12:32**  
Products made by patented process.  
Cross-border transactions, above  
Registered vessels, **12:13**  
Sale, **12:19-12:21**  
Section 105, **12:9**

**GEOGRAPHIC SCOPE OF INFRINGEMENT—Cont'd**

Section 271(f)  
cross-border transactions, above historical development, **12:7**  
Section 271(g)  
cross-border transactions, above historical development, **12:8**  
Situs of accused activity  
generally, **12:15-12:21**  
domestic sale, requirement of, **12:21**  
making, **12:16**  
offer, situs of, **12:20**  
offer for sale, **12:19-12:21**  
sale, **12:18-12:21**  
using, **12:17**  
Special issues, **12:30, 12:39-12:41**  
Statutes  
early statutes, **12:3**  
Patent Act of 1870 and subsequent decisions, **12:5**  
Patent Law Amendments Act of 1984, **12:29**  
Process Patents Amendment Act of 1988, **12:36-12:38**  
Temporal scope, **11:4**  
Time, **12:41**  
Transitory embodiments, **12:44**  
Vessels, **12:13**

**GERMANY**

Adequate utility, **6:3, 6:6, 7:24**  
Anticipation, lack of, **8:22**  
Claims, **4:8**  
History, **1:2**

**GIANT POWDER CO. v. CALIFORNIA POWDER WORKS**

Reissue of patent, **16:24**

**GILLMAN v. STERN**

Anticipation, lack of, **8:21**

**GLAXO INC. v. NOVOPHARM LTD.**

Adequate disclosure, **7:54**

**GOLDEN BLOUNT, INC. v.**

**ROBERT H. PETERSON CO.**

Indirect infringement, **15:22**

**GOOD FAITH**

Adequate disclosure, **7:57**

**GOOD POLICY**

Adequate utility, **6:15**

**GOODYEAR v. DAY**

Reissue of patent, **16:23**

**GOTTSCHALK v. BENSON**

Computer-related inventions, **5:44**  
Processes, **5:24**

**GRACE PERIOD**

Examination of Original Application (this index)  
History, **1:19**  
Priority (this index)

**GRAFTING**

Static physical configurations, **5:14**

**GRAHAM v. JOHN DEERE**

Non-Obviousness (this index)

**GRAMMATICAL STRUCTURE**

Claims, **4:87**

**GRANT-BACK CLAUSES**

Misuse of patent, **18:39**

**GRANT v. RAYMOND**

Adequate utility, **7:31**  
Reissue of patent, **16:5**

**GRAPHICAL ILLUSTRATION**

Technological scope, **13:78**

**GRAVER TANK & MFG. CO. v. LINDE AIR PRODUCTS CO.**

Technological scope, **13:12**

**GREAT BRITAIN**

Anticipation, lack of, **8:1**

**GREAT SEAL**

History, **1:1**

**GREECE**

History, **1:2**

## INDEX

**GROUP RESEARCH**  
Joint inventorship, **10:39, 10:40**

**GUNTER v. STREAM**  
Priority, **8:45**

**HALLIBURTON OIL WELL CEMENTING CO. v. WALKER**  
Claims, **4:86**  
Processes, **5:27**

**HANDLING APPLICATIONS**  
Patent and Trademark Office (PTO),  
**2:19**

**HANSEATIC LEAGUE, MERCHANTS OF**  
History, **1:4**

**HARDWARE**  
Computer-Related Inventions (this index)

**HARMFUL**  
Adequate utility, **6:15**

**HARMONIZATION**  
Priority, **8:36**

**HASS-HENZE DOCTRINE**  
Non-obviousness, **9:73**

**HATCH-WAXMAN ACT**  
Adequate Commerciality (this index)

**HAZELTINE RESEARCH INC. v. BRENNER**  
Non-obviousness, **9:33, 9:37, 9:38**

**HEALTH CARE**  
Processes, **5:39**  
Static physical configurations, **5:18**

**HEARING**  
Patent and Trademark Office (PTO),  
**2:21, 2:28**

**HEARSAY**  
Non-obviousness, **9:59**

**HEATON-PENINSULAR BUTTON-FASTENER CO. v. EUREKA SPECIALTY CO.**  
Indirect infringement, **15:5**  
Misuse of patent, **18:10**

**HEIMLICH MANEUVER**  
Processes, **5:39**

**HENRY III**  
History, **1:4**

**HENRY v. A.B. DICK**  
Indirect infringement, **15:5-15:7, 15:10**  
Misuse of patent, **18:11**

**HIGH TECH MEDICAL INSTRUMENTATION, INC. v. NEW IMAGE INDUSTRIES, INC.**  
Adequate commerciality, **14:30**

**HILTON DAVIS CHEMICAL CO. v. WARNER-JENKINSON CO., INC.**  
Technological Scope of Infringement (this index)

**HISTORY**  
Generally, **1:2-1:25**  
Abandonment, **1:20, 1:21, 8:267-8:269**  
Adequate Commerciality (this index)  
Adequate disclosure, **7:4, 7:5, 7:31, 7:36, 7:57**  
Adequate utility, **6:15**  
Administrative law, **1:17, 1:25**  
Amendment of application, **1:18**  
Amendment of statutes, **1:14, 1:20, 1:25**  
America Invents Act, **1:26**  
Anticipation, **1:22**  
Antitrusts, **1:7**  
Appeal and review, **1:19, 1:21, 1:24**  
Application, **1:18**  
Aristotle, **1:2**  
Article I, Section 8, clause 8, **1:10**  
Assignment, **1:16**  
Associations, **1:4**  
Athenaeus, **1:2**  
Authors, **1:11**  
Best mode requirement as defense, **1:26**  
Bifurcated treatment, **1:5**  
Case law, **1:5, 1:17, 1:20, 1:21**  
Causes of action, **1:14**

**HISTORY—Cont'd**

Central claiming, **1:21, 1:23**  
 Change and modification, **1:16, 1:23, 1:25**  
 Circuit courts, **1:24**  
 Claims (this index)  
 Closed letters (litterae clausae), **1:1**  
 Colonial period, **1:9**  
 Commerce Clause, **1:15**  
 Commercialization, **1:3**  
 Commissioners, **1:19, 1:21**  
 Common law, **1:3, 1:5, 1:7, 1:17**  
 Common usage, withdrawal from, **1:15**  
 Competition, **1:4, 1:7, 1:14**  
 Conditions, fixed, **1:4**  
 Congress (this index)  
 Consent, **1:14**  
 Constitutional period, generally, **1:16-1:25**  
 Constitutional provision, generally, **1:10-1:15**  
 Construction and interpretation, generally, **1:7**  
 Contracts and agreements, **1:16, 1:25**  
 Contributory infringement, **1:23**  
 Copyright, **1:10, 1:11, 1:15**  
 Corporations, **1:4**  
 Correction, **10:55-10:58**  
 Costs and expenses, **1:3, 1:7**  
 Court of Appeals for Federal Circuit (CAFC), **1:25**  
 Court of Customs and Patent Appeals (CCPA), **1:24**  
 Courts, generally, **1:18**  
 Darcy v. Allen, **1:4, 1:5**  
 Demand, **1:3**  
 Disclaimers, **1:24**  
 Disclosure, **1:18**  
 District court, **1:25**  
 Doctrine of Equivalents, **1:20, 1:22**  
 Double patenting, **1:24**  
 Early English precedents, generally, **1:3-1:7**  
 Economics, **1:2, 1:18**  
 1870, developments up to, **1:20**  
 Eleventh amendment, **1:14**  
 Eligibility, **1:18**

**HISTORY—Cont'd**

Employment, **1:19**  
 Employment agreements, **1:16**  
 Enforcement, **1:14, 1:18, 1:24**  
 England, generally, **1:1**  
 Equitable limitations, **1:22**  
 Europe, **1:2**  
 Examination of Original Applications (this index)  
 Exceptions, **1:2, 1:7**  
 Exclusive rights, **1:2**  
 Executive Branch, **1:18, 1:25**  
 Express waiver, **1:14**  
 Far East, **1:2**  
 Federal Circuit Court, **1:25**  
 Federal courts, generally, **1:14**  
 Federal jurisdiction, **1:14**  
 Federal trial courts, **1:25**  
 Filing application, **1:14, 1:19, 1:25**  
 Filing date of application, **1:19**  
 Filing suits, **1:14**  
 First inventor, **1:18**  
 Fixed prices, terms, and conditions, **1:4**  
 Florida Prepaid Postsecondary Education Expense Bd., v. College Savings Bank, **1:14**  
 Foreign countries, **1:2, 1:14, 1:25, 8:275**  
 Fourteenth amendment, **1:14**  
 Free commerce, **1:3**  
 Free trade, **1:7**  
 Geographic Scope of Infringement (this index)  
 Germany, **1:2**  
 Grace period, **1:19**  
 Grant of rights, generally, **1:1**  
 Great Seal, **1:1**  
 Greece, **1:2**  
 Hanseatic League, merchants of, **1:4**  
 Henry III, **1:4**  
 House of Commons, **1:6**  
 House of Lords, **1:6**  
 Hume, **1:4**  
 Immunity, **1:7**  
 Implied waiver, **1:14**  
 Incentives, **1:18**  
 Indirect Infringement (this index)

## INDEX

### **HISTORY—Cont'd**

Individuals, **1:4**  
Industrial development, **1:25**  
Infringement (this index)  
Initial statutes and development up to 1836, **1:18**  
Interference, **1:18, 1:20**  
International agreements, **1:26**  
International trade agreements, **1:25**  
Invalidity, **17:35**  
Inventorship, **10:2-10:4, 10:14**  
Issuance of letters patent, **1:4**  
Issuance of patent, **1:18, 1:25**  
Joint inventorship, **10:38-10:40, 10:48**  
Judicial remedies, **1:18**  
Judicial review, **1:19**  
Judiciary, **1:17**  
Jurisdiction, **1:14**  
Laches, **1:21**  
Land patent, **1:1**  
Law-making sources in U.S. patent laws, **1:17**  
Letters patent, **1:1, 1:3-1:5, 1:7**  
Licenses and permits, **1:4**  
Limitations and restrictions, generally, **1:1**  
Literal meaning, **1:21**  
Litterae clausae, **1:1**  
Litterae patentes, **1:1**  
Lord Coke, **1:5**  
Lower courts, **1:20**  
Macaulay, **1:4**  
Magna Carta, **1:4**  
Manufacturing, **1:6**  
Means for claim language, **1:23**  
Medical and Diagnostic Procedures (this index)  
Misuse of Patent (this index)  
Monopoly, **1:4, 1:7**  
Municipalities, **1:4**  
Negotiators, **1:14**  
New, control of, **1:18**  
New arts, **1:5**  
New enterprises, **1:4**  
New matter, **1:20**  
1952, subsequent developments to, generally, **1:22**

### **HISTORY—Cont'd**

1982, subsequent developments to, generally, **1:24**  
Non-Obviousness (this index)  
Non-Statutory Hybrid Inventions (this index)  
Not before known or used, **1:18**  
Notice and knowledge, **1:18, 1:19**  
Novelty, **1:19**  
Official pronouncements, **1:1**  
Open communications, **1:1**  
Open letters (litterae patentes), **1:1**  
Open sovereign letters, **1:1**  
Ordinary skill in the art, **1:23**  
Original inventors, **1:18**  
Parallel structure, **1:11**  
Pareden v. Terminal Railway of Alabama State Docks Dept., **1:14**  
Parliament, **1:4**  
Patentability, **1:18, 1:19, 1:24**  
Patent Act of 1790 (this index)  
Patent Act of 1793, **1:18, 1:19**  
Patent Act of 1836, **1:19, 1:20**  
Patent Act of 1839, **1:19, 1:20**  
Patent Act of 1870, **1:15**  
Patent Act of 1870 and related events, **1:21**  
Patent Act of 1952, **1:23, 1:24**  
Patent and Trademark Office (PTO), generally, **1:17**  
Patent Department of Department of State, **1:18**  
Patent document, **1:1**  
Patent instrument, **1:1**  
Patent Remedy Act, **1:14**  
Peripheral claiming, **1:21, 1:22, 1:25**  
Petitions, **1:5**  
Pre-emption, **1:13**  
Preemption of state competition laws, **1:13.10**  
Pre-existing technology, **1:7**  
Price control, **1:3**  
Prior Inventor, Prior-User Rights (this index)  
Priority (this index)  
Private communications, **1:1**  
Private remedies, **1:18**  
Privileges, **1:4, 1:12**

**HISTORY—Cont'd**

Privy seal, 1:1  
Processes, 5:30  
Public, 1:18  
Public domain, 1:15  
Qualifications, 1:21  
Regional federal circuit courts of appeal, 1:24  
Registration, 1:18, 1:19  
Reissuance of application, 1:18  
Reissue of Patent (this index)  
Royal letters patent, 1:4, 1:5  
Royal signet, 1:1  
Science, 1:11  
Sealed, 1:1  
Section 102 timewise priority, 1:26  
Services, special, 1:4  
1623, inventions prior to, 1:5  
Six Year Limitation (this index)  
Sole license, 1:4  
South Carolina, 1:9  
Sovereign immunity of state, 1:14  
Special privileges, 1:4  
Special services, 1:4  
State acts, 1:9, 1:13  
State courts, 1:14  
State-owned entities, 1:14  
Static physical configurations, 5:14, 5:15  
Statute of Monopolies, 1:6  
Statutes, generally, 1:8, 1:13.80, 1:14  
Statutory Subject Matter (this index)  
Subjective abandonment, 1:21  
Subject matter jurisdiction, 1:14  
Subsequent developments, 1:13.80  
Suppression, and concealment, 1:20  
Supreme Court, generally, 1:14-1:24  
Symbols, 1:15  
Taxation, 1:3  
Technological Scope of Infringement (this index)  
Temporal Scope of Infringement (this index)  
Terminal disclaimers, 1:24  
The Clothworkers of Ipswich, 1:5  
35 USC, 1:23  
37 CFR, 1:20  
Time and date, 1:5, 1:18

**HISTORY—Cont'd**

Title, assignment of, 1:16  
Title to land, 1:1  
Towns, 1:4  
Trademarks, 1:14, 1:15  
Trade secrets, 1:15  
Underlying purpose, 1:12  
Unfair competition, 1:14  
United States, developments in, generally, 1:8-1:25  
Useful arts, 1:12  
Utility Requirement (this index)  
Validity, 1:5, 1:18, 1:24  
Void, 1:4, 1:5  
Voluntary waiver, 1:14  
Waiver of sovereign immunity, 1:14  
Withdrawal, 1:4, 1:15  
Written communications, generally, 1:1

**HOFFHEINS v. BRAND**

Reissue of patent, 16:16

**HOFFMAN-LA-ROCHE, INC. v. ZENITH LABORATORIES, INC.**

Adequate commerciality, 14:62

**HOLDING**

Adequate commerciality, 14:23

**HOTCHKISS v. GREENWOOD**

Non-obviousness, 9:3, 9:15

**HOUSE OF COMMONS**

History, 1:6

**HOUSE OF LORDS**

History, 1:6

**HOW-TO-MAKE**

Adequate utility, 7:10

**HOW-TO-USE**

Adequate utility, 7:14

Anticipation, lack of, 8:22

**HUGHES AIRCRAFT CO. v. U.S.**

Adequate commerciality, 14:27

## INDEX

**HUGHES AIRCRAFT CO.**  
v.NATIONAL SEMICONDUCTOR CORP.  
Six-year limitation, section 286  
defense, **21:15**

**HUMANS**  
Computer-related inventions, **5:41**  
Processes, **5:24, 5:25, 5:27**  
Static physical configurations, **5:11, 5:12**

**HUME**  
History, **1:4**

**HYBRID CLAIMING**  
Claims (this index)

**HYBRID COMBINATIONS**  
Static physical configurations, **5:8**

**HYBRIDS**  
Non-obviousness, **9:77**  
Non-Statutory Hybrid Inventions  
(this index)  
Static physical configurations, **5:11, 5:14**  
Statutory subject matter, **5:1**

**HYPOTHETICAL CLAIM**  
Technological scope, **13:83**

**I CLAIM**  
Policy justification and historical  
development, **4:4**

**IDEAS OF OTHERS**  
Inventorship, **10:11**

**IDENTICAL APPLICANTS**  
Foreign countries, **8:277**

**IDENTICAL DESCRIPTION**  
Non-Obviousness (this index)

**IDENTICAL SUBJECT MATTER**  
Adequate commerciality, **14:12**

**IDENTICAL TO**  
**TECHNOLOGICAL CONFIGURATION**  
Claims, **4:71**

**IDENTITY AND IDENTIFICATION**  
Claims (this index)

**IDENTITY AND IDENTIFICATION**  
—Cont'd  
Temporal scope, **11:46-11:49**

**ILLUSTRATIONS**  
Priority, **8:39**

**ILLUSTRATIVE DIAGRAM**  
Claims, **4:57, 4:59**  
Technological scope, **13:72**

**IMAGINATIVE THOUGHT**  
Processes, **5:26**

**IMMATERIAL CONTRIBUTIONS**  
Joint inventorship, **10:32**

**IMMUNITY**  
Adequate commerciality, **14:7, 14:68, 14:72**  
History, **1:7, 1:14**  
Medical and diagnostic procedures,  
section 287(c) defense, **20:19, 20:20**  
Processes, **5:30**

**IMPLICIT**  
Anticipation, lack of, **8:23**

**IMPLIED LICENSE**  
Licenses and Permits (this index)

**IMPLIED TRANSFERS**  
Joint inventorship, **10:25**

**IMPLIED WAIVER**  
History, **1:14**

**IMPORTS AND EXPORTS**  
Adequate commerciality, **14:23, 14:24**  
Defenses, implied-in-law licenses,  
**19:44**  
Geographic Scope of Infringement  
(this index)  
Static physical configurations, **5:14**

**IMPROVEMENTS**  
Adequate utility, **7:5**  
Claims, **4:2**  
Correction of inventorship, **10:68**  
Joint inventorship, **10:25, 10:31**  
Non-obviousness, **9:3, 9:59**  
Priority, **8:236**

**IMPROVEMENTS—Cont'd**  
Processes, **5:21**  
Statutory Subject Matter (this index)  
Technological scope, **13:74**

**INACTIVITY**  
Priority, **8:67**

**INADVERTENT MISTAKE AND ERROR**  
Correction of inventorship, **10:57, 10:67**  
Reissue of patent, **16:25**  
Technological scope, **13:57, 13:58**

**INCENTIVE**  
Adequate utility, **6:19**  
History, **1:18**  
Justification, **1:39, 1:41**  
Non-statutory hybrid inventions, **5:61, 5:74**  
Policy justification, **1:35, 1:41**  
Processes, **5:39**  
Static physical configurations, **5:14**  
Statutory subject matter, **5:4, 5:5**

**INCHOATE RIGHTS**  
Inventorship, **10:7, 10:8**

**INCOMING TRANSACTIONS**  
Geographic Scope of Infringement (this index)

**INCORPORATION BY REFERENCE**  
Adequate disclosure, **7:19**  
Claims, **4:102**

**INCORPORATION OF OUTSIDE SOURCES**  
Anticipation, lack of, **8:30-8:32**

**IND**  
Investigational New Drug (IND) (this index)

**INDEMNIFICATION**  
Indirect infringement, **15:17**

**INDEPENDENT CLAIMS**  
Multiple claims in single patent, **4:102**

**INDEPENDENT INVENTIONS**  
Adequate commerciality, **14:11, 14:15**

**INDEPENDENT WORK**  
Joint inventorship, **10:23**

**INDETERMINATE EVENTS**  
Priority, **8:127-8:129**

**INDIRECT INFRINGEMENT**  
Generally, **15:1 et seq.**  
Actively induces infringement, **15:15**  
Aiding and abetting, **15:17**  
Appeal and review, **15:8, 15:9, 15:12, 15:22**  
Aro Mfg. Co. v. Convertible Top Replacement Co., **15:11, 15:12, 15:20, 15:24**  
Bauer v. O'Donnell, **15:6, 15:7**  
Blake v. Smith, **15:4**  
Carbice Corporation of America v. American Patents Development Corporation, **15:8-15:10**  
Circumstantial evidence, **15:15, 15:16, 15:22, 15:24**  
Circumstantial inference, **15:15**  
Clayton Antitrust Act, **15:6**  
Combination claims, **15:5**  
Community Patent Convention, **15:14**  
Construction and interpretation, **15:2, 15:4**  
Contract limitations, **15:14**  
Contributory infringement generally, **15:1 et seq., 15:21-15:24**  
historical development, generally, **15:2**  
Patent Act of 1952, **15:10**  
policy justification, **15:14**  
section 271(b), **15:17, 15:18**  
section 271(c), **15:21-15:24**  
Corporate officers and directors, **15:19**  
Damages, **15:15, 15:16, 15:22**  
Dawson Chemical Co. v. Rohm and Haas Co., **15:12, 15:13**  
Direct infringement, **15:16, 15:17, 15:22, 15:24**

## INDEX

### INDIRECT INFRINGEMENT

#### —Cont'd

- Directing or permitting conduct of another, **15:14**
- Disclosure, **15:4**
- Dual use, **15:18**
- Dynacore Holdings Corp. v. U.S. Philips Corp., **15:16**
- Evidence
  - generally, **15:4**
  - circumstantial evidence, **15:24**
  - circumstantial proof, **15:15, 15:22**
  - direct infringement, **15:16, 15:22**
  - inducing infringement, section 271(b), **15:16**
- Exceptions, **15:4**
- Exclusive rights, **15:7, 15:18**
- Generic pharmaceuticals, **15:18**
- Golden Blount, Inc. v. Robert H. Peterson Co., **15:22**
- Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co., **15:5, 18:10**
- Henry v. A.B. Dick, **15:5-15:7, 15:10, 18:11**
- Historical development
  - generally, **15:2-15:13**
- Aro Mfg. Co. v. Convertible Top Replacement Co., **15:11**
- Blake v. Smith, **15:4**
- Carbice Corporation of America v. American Patents Development Corporation, **15:8**
- Dawson Chemical Co. v. Rohm and Haas Co., **15:12**
- early history, **15:3**
- Henry v. A.B. Dick, **15:5**
- judicial reaction, **15:6-15:9**
- license restrictions, **15:5**
- Mercoid Corp. v. Mid-Continent Inv. Co., **15:9**
- misuse, development of, **15:6**
- Motion Picture Patents Co. v. Universal Film Mfg. Co., **15:7**
- Patent Act of 1952, **15:10**
- Patent Misuse Reform Act of 1988, **15:13**
- section 271(b), (c), (d) of Patent Act of 1952, **15:10**

### INDIRECT INFRINGEMENT

#### —Cont'd

- Historical development—Cont'd  
unpatented supplies, **15:5**
- Wallace v. Holmes, **15:4**
- Indemnification, **15:17**
- Inducing infringement
  - generally, **15:1 et seq., 15:15-15:20**
  - adequate commerciality, **14:79**
  - dual use, **15:18**
  - evidence of direct infringement, **15:16**
  - intent requirement, **15:20**
  - knowledge requirement, **15:20**
  - Patent Act of 1952, **15:10**
  - policy justification, **15:14**
  - required knowledge and intent, **15:20**
  - required relationship to direct infringement, **15:17, 15:19**
  - sale of materials suited to dual use, **15:18**
  - section 271(b), generally, **15:15-15:20**
- Inferences, **15:22, 15:23**
- Injunctions, **15:18**
- Intent, **15:15, 15:17, 15:20, 15:24**
- Joint tortfeasors, generally, **15:1 et seq.**
- Judgments, policy, **15:23**
- Judicial interpretation, **15:2**
- Judicial reaction, **15:6-15:9**
- Jury trial, **15:4**
- Keplinger v. DeYoung, **15:3**
- Knowledge requirement, **15:24**
- Leeds & Catlin Co. v. Victor Talking Machine Co., **15:5, 15:9**
- License restrictions, **15:5**
- Limitations and restrictions
  - generally, **15:1**
  - historical development, **15:5-15:7, 15:10**
  - inducing infringement, **15:17**
  - policy justification, **15:14**
- Making, generally, **15:1 et seq.**
- Mercoid Corp. v. Mid-Continent Inv. Co., **15:9-15:12, 15:24**

**INDIRECT INFRINGEMENT**

—Cont'd

- Method claims, **15:5**
- Misuse of patent, **18:4-18:6, 18:8-18:11**
- Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., **15:6, 15:8, 18:6**
- Motion Picture Patents Co. v. Universal Film Mfg. Co., **15:7, 15:8**
- New trial, **15:4**
- Notice and knowledge, **15:15, 15:20, 15:24**
- Offers to sell, generally, **15:1 et seq.**
- Patent Act of 1952, **15:2, 15:10, 15:11**
- Patent Misuse Reform Act of 1988, **15:13**
- Peripheral claim theory, **15:5**
- Perishables, **15:6**
- Persons acting in concert, **15:14**
- Pharmaceuticals, **15:18**
- Policy judgments, **15:23**
- Policy justification, **15:14**
- Price, **15:6**
- Raising questions, **15:24**
- Restatement of Torts, 2nd, **15:14**
- Sales, generally, **15:1 et seq.**
- Section 271(a), generally, **15:1 et seq.**
- Section 271(b)
  - generally, **15:10**
  - inducing infringement, above
- Section 271(c), **15:10, 15:21-15:24**
- Section 271(d), **15:10**
- Six-year limitation, section 286 defense, **21:22**
- Staple versus non-staple article of commerce, **15:23**
- Stockholders, **15:19**
- Supplies, unpatented, **15:5**
- Third persons, **15:14**
- Use, generally, **15:1 et seq.**
- Wallace v. Holmes, **15:4, 15:16, 18:5**

**INDIVIDUALS**

- Generally, **1:4**

**INDIVIDUAL SPECIMENS**

- Static physical configurations, **5:17**

**INDUCEMENT**

- Geographic Scope of Infringement (this index)
- Indirect Infringement (this index)

**INDUSTRIAL APPARATUS**

- Static physical configurations, **5:8**

**INDUSTRIAL APPLICATION**

- Adequate utility, **6:8**

**INDUSTRIAL COMMERCE**

- Inventorship, **10:15**

**INDUSTRIAL DEVELOPMENT**

- History, **1:25**

**INDUSTRIAL KNOWLEDGE**

- Priority, **8:33**

**INDUSTRIAL PROCESSES**

- Generally, **5:19**
- Statutory subject matter, **5:20-5:23**

**INDUSTRIAL SOPHISTICATION**

- Priority, **8:44**

**INDUSTRY LIMITATIONS**

- Misuse of patent, **18:34**

**INFERENCE**

- Adequate disclosure, **7:1**
- Anticipation, lack of, **8:16, 8:32**
- Indirect infringement, **15:22, 15:23**
- Non-Obviousness (this index)
- Priority, **8:65**

**INFERIOR**

- Adequate utility, **6:3**

**INFERIOR PARTY**

- Priority, **8:34**

**INFORMAL RULEMAKING**

- Patent and Trademark Office (PTO), **2:28**

**INFORMATION TECHNOLOGIES**

- Non-statutory hybrid inventions, **5:81**

**INFRINGEMENT**

- Adequate Commerciality (this index)

## INDEX

**INFRINGEMENT—Cont'd**  
Anticipation, lack of, **8:18, 8:29**  
Claims (this index)  
Correction of inventorship, **10:58**  
Defense of noninfringement.  
    Noninfringement (this index)  
Designs, **5:46**  
Determinations, **4:73**  
Estoppel as defense to patent  
    infringement, **24:8-24:18**  
Examination of Original Application  
    (this index)  
Geographic scope. Geographic Scope  
    of Infringement (this index)  
History, generally, **1:7**  
Indirect Infringement (this index)  
Joint inventorship, **10:29, 10:32,**  
    **10:49, 10:52**  
Patent and Trademark Office (PTO),  
    generally, **2:6**  
Policy justification, **1:29, 1:38**  
Prior Inventor, Prior-User Rights (this  
    index)  
Priority, **8:44, 8:65**  
Processes, **5:23, 5:26, 5:30, 5:39**  
Six-Year Limitation (this index)  
Static physical configurations, **5:7**  
Statutory subject matter, **5:5**  
Technological scope. Technological  
    Scope of Infringement (this  
    index)  
Temporal scope. Temporal Scope of  
    Infringement (this index)  
Utility Requirement (this index)

**INHERENCY**  
Anticipation, Lack Of (this index)  
Computer-related inventions, **5:53**  
Inventorship, **10:4**  
Non-Obviousness (this index)  
Priority, **8:49, 8:230**

**IN HAECKEL VERBA**  
Adequate disclosure, **7:42**

**IN IPSIS VERBIS**  
Adequate utility, **7:37**

**IN LIGHT OF ALL THE  
    CIRCUMSTANCES**  
Non-obviousness, **9:58**

**IN PAIS ESTOPPELS**  
Early categories of estoppels, **24:5**

**IN PARI MATERIA**  
Patent and Trademark Office (PTO),  
    **2:3**

**IN PUBLIC USE**  
Priority (this index)

**IN RE ABELE**  
Non-statutory hybrid inventions,  
    **5:76, 5:81**

**IN RE ABRAMS**  
Computer-related inventions, **5:45**

**IN RE ALAPPAT**  
Non-statutory hybrid inventions,  
    **5:76, 5:85**

**IN RE ALBRECHT**  
Non-obviousness, **9:75**

**IN RE AMOS**  
Reissue of patent, **16:96**

**IN RE BARKER**  
Adequate utility, **7:30, 7:31**  
Subjective appreciation, **7:34**

**IN RE BARTFELD**  
Non-obviousness, **9:48**

**IN RE BASS**  
Non-obviousness, **9:37, 9:38**

**IN RE BERNHART**  
Computer-related inventions, **5:53**

**IN RE BORST**  
Priority, **8:165**

**IN RE BRANDSTADTLER**  
Adequate utility, **7:9**

**IN RE BRESLOW**  
Static physical configurations, **5:9**

**IN RE BROUWER**  
Claims, **4:77, 4:78, 4:80**  
Non-obviousness, **9:85**

**IN RE DILLON**  
Non-obviousness, **9:74, 9:76**

**IN RE DONALDSON CO.**  
Claims, **4:6, 4:80, 4:93**

**IN RE DURDEN**  
Claims, **4:76-4:78, 4:80, 4:81**  
Non-obviousness, **9:80, 9:82, 9:84, 9:85**  
Non-statutory hybrid inventions, **5:84**

**IN RE FOSTER**  
Non-obviousness, **9:26, 9:27**

**IN RE FREEMAN**  
Non-statutory hybrid inventions, **5:76, 5:81**

**IN RE GAY**  
Adequate utility, **7:9**

**IN RE GLASS**  
Adequate utility, **7:18**

**IN RE HAFNER**  
Anticipation, lack of, **8:22**

**IN RE HASS**  
Non-obviousness, **9:73**

**IN RE HENZE**  
Non-obviousness, **9:73**

**IN RE HERITAGE**  
Processes, **5:27**

**IN RE HILMER**  
Priority, **8:121, 8:153**

**IN RE HOUNSFIELDE**  
Reissue of patent, **16:94**

**IN RE HOWARTH**  
Adequate utility, **7:18**

**IN RE JOLY**  
Adequate utility, **6:17**

**IN RE KIRK**  
Adequate utility, **6:17**

**IN RE KUEHL**  
Non-obviousness, **9:79, 9:80**

**IN RE LARSON**  
Non-obviousness, **9:79, 9:80, 9:82, 9:84-9:86**

**IN RE LOWRY**  
Computer-related inventions, **5:42**  
Static physical configurations, **5:11**

**IN RE MILLER**  
Static physical configurations, **5:12**

**IN RE MUSGRAVE**  
Processes, **5:26**

**IN RE NOMIYA**  
Non-obviousness, **9:42**

**IN RE OCHIAI**  
Claims, **4:77, 4:78, 4:80**  
Non-obviousness, **9:85**

**IN RE PALMQUIST**  
Non-obviousness, **9:25, 9:26**

**IN RE PAPESCH**  
Claims, **4:82**  
Non-obviousness, **9:73, 9:76**

**IN RE PLEUDDEMANN**  
Claims, **4:77**  
Non-obviousness, **9:80, 9:85**

**IN RE PRATER**  
Processes, **5:26**

**IN RE SCHRADER**  
Processes, **5:30**

**IN RE SHERWOOD**  
Adequate disclosure, **7:57**

**IN RE SMITH**  
Non-statutory hybrid inventions, **5:84**

**IN RE SPONNOBLE**  
Non-obviousness, **9:68**

**IN RE WALTER**  
Non-statutory hybrid inventions, **5:76, 5:81**

**IN RE WANDS**  
Adequate utility, **7:20**

**IN RE WARMERDAM**  
Non-statutory hybrid inventions, **5:78, 5:80**  
Processes, **5:23**

## INDEX

### **IN RE WEILER**

Reissue of patent, **16:95**

### **IN RE WOOD**

Non-obviousness, **9:18**

### **IN RE WRIGHT**

Adequate utility, **7:25**

Non-obviousness, **9:66, 9:74**

### **IN RE ZIEGLER**

Adequate utility, **6:18**

### **IN RE ZURKO**

Patent and Trademark Office (PTO),  
**2:43**

### **IN SITU PRODUCTION**

Static physical configurations, **5:9**

### **IN THIS COUNTRY**

Defined, **8:194**

### **IN VITRO**

Adequate utility, **6:18**

### **INITIAL APPLICATION**

Examination of Original Application  
(this index)

Joint inventorship, **10:40**

Patent and Trademark Office (PTO),  
**2:13**

### **INITIAL DETERMINATION**

Priority, **8:44**

### **INITIAL EXAMINATION**

Patent and Trademark Office (PTO),  
**2:10**

### **INITIAL EXAMINATION OF APPLICATION**

Patent and Trademark Office (PTO),  
**2:22**

### **INITIAL FILING**

Adequate utility, **7:41**

### **INITIAL INVENTION**

Priority, **8:236**

### **INITIAL OCCUPANT**

Defined, **10:4**

### **INITIAL PANEL DECISIONS**

Laches, Federal Circuit decisions,  
**23:18**

### **INITIAL PARTICIPANT**

Joint inventorship, **10:34**

### **INITIAL PATENT**

Non-obviousness, **9:11**

### **INITIAL REJECTION OF APPLICATION**

Adequate utility, **6:13**

### **INITIAL TITLE**

Inventorship (this index)

### **INJUNCTIONS**

Adequate commerciality, **14:78**  
Indirect infringement, **15:18**  
Processes, **5:39**

### **INNOVATION**

Justification, **1:40, 1:41**

### **INOPERATIVE DISCLOSURE**

Anticipation, lack of, **8:22**  
Non-obviousness, **9:19**

### **INSANITY**

Priority, **8:67**

### **INSERT**

Claims, **4:98**

### **INSPECTION**

Adequate utility, **7:10, 7:11, 7:18**  
Technological configuration, **9:71**

### **INSPIRATION**

Non-obviousness, **9:41**

### **INSTRUCTIONS**

Computer-related inventions, **5:41**  
Non-obviousness, **9:66**

### **INSTRUCTIONS OF COMMISSIONER**

Patent and Trademark Office (PTO),  
**2:26**

### **INSTRUCTIONS TO JURY**

Anticipation, lack of, **8:7**  
Claims (this index)  
Non-obviousness, **9:3**

**INTELLECTUAL CREATOR**  
Inventorship, **10:14**

**INTELLECTUAL PART**  
Inventorship, **10:12**

**INTELLECTUAL POSSESSION**  
Adequate utility, **7:38**

**INTELLECTUAL PROPERTY AND COMMUNICATIONS OMNIBUS REFORM ACT OF 1999**  
Patent and Trademark Office (PTO), **2:22**

**INTELLECTUAL PROPERTY LAW AND RIGHTS**  
Adequate commerciality, **14:42**  
Statutory subject matter, **5:5**

**INTENT**  
Adequate commerciality, **14:14-14:17, 14:29, 14:79**  
Claims, **4:2, 4:3, 4:31, 4:87**  
Correction, **10:60**  
Disclosure (this index)  
Examination of Original Application (this index)  
Indirect infringement, **15:15, 15:17, 15:20, 15:24**  
Inventorship (this index)  
Non-obviousness, **9:46**  
Patent and Trademark Office (PTO), **2:20, 2:48**  
Priority, **8:55, 8:58, 8:59, 8:254**  
Processes, **5:30, 5:37**  
Static physical configurations, **5:14, 5:15, 5:17**  
Statutory subject matter, **5:1, 5:4, 5:6**  
Utility Requirement (this index)

**INTERESTED THIRD PARTIES**  
Patent and Trademark Office (PTO), **2:13**

**INTERFERENCE**  
Generally, **2:29, 2:33**  
Adequate utility, **7:41**  
Anticipation, Lack Of (this index)  
Board of Patent Appeals and Interferences (BPAI) (this index)

**INTERFERENCE—Cont'd**  
Claims, **4:9**  
Computer-related inventions, **5:42**  
Examination of Original Application (this index)  
History, **1:18, 1:20**  
Inventorship, **10:7**  
Non-obviousness, **9:11, 9:35, 9:36**  
Non-statutory hybrid inventions, **5:83**  
Patent and Trademark Office (PTO), generally, **2:22**  
Priority, **8:34, 8:38, 8:42, 8:48, 8:60, 8:65, 8:73**

**INTERIM EXTENSIONS**  
Temporal scope, **11:44**

**INTERIM SUPPLEMENTAL GUIDELINES**  
Claims, **4:89**

**INTERLOCUTORY APPEAL**  
Static physical configurations, **5:15**

**INTERNAL PROCEDURES**  
Patent and Trademark Office (PTO), **2:1, 2:19**  
Processes, **5:29, 5:30**

**INTERNAL SECRET PRIOR ART**  
Non-obviousness, **9:47**

**INTERNATIONAL ACTS AND MATTERS**  
See also Foreign Countries (this index)  
Adequate commerciality, **14:10, 14:46**  
Anticipation, lack of, **8:1**  
Defense, implied-in-law license, **19:44**  
Designs, **5:46**  
Examination of Original Application (this index)  
General Agreement on Tariffs and Trade (GATT) (this index)  
History, **1:25, 1:26**  
Patent and Trademark Office (PTO), **2:13, 2:22**  
Policy justification, **1:29**  
Priority (this index)  
Static physical configurations, **5:18**

## INDEX

**INTERNATIONAL ACTS AND MATTERS—Cont'd**  
Trade-Related Aspects of Intellectual Property Rights, Agreement on (TRIPs) (this index)

**INTERNATIONAL CONVENTION FOR PROTECTION OF NEW VARIETIES OF PLANTS**  
Static physical configurations, **5:14**

**INTERNATIONAL RECTIFIER CORP. v. IXYS CORP.**  
Technological scope, **13:59**

**INTERNATIONAL TRADE COMMISSION (ITC)**  
Adequate commerciality, **14:39, 14:40**

**INTER PARTES ACTS AND MATTERS**  
Adequate utility, **7:20**  
Patent and Trademark Office (PTO), **2:11, 2:13**  
Priority, **8:34, 8:38**  
Reexamination. Inter Partes Reexamination (this index)

**INTER PARTES REEXAMINATION**  
Generally, **16:124**  
Effect, **16:135**  
Reissue of patent, **16:66**

**INTERPRETIVE JUDGMENT**  
Processes, **5:26**

**INTERPRETIVE MENTAL ACTS**  
Processes, **5:27**

**INTERPRETIVE RULES**  
Patent and Trademark Office (PTO), **2:28, 2:48**

**INTERRELATED COMPONENT PARTS**  
Static physical configurations, **5:8**

**INTERVENTION**  
Adequate utility, **6:4, 6:10**  
Examination of Original Application (this index)  
Processes, **5:24**

**INTERVENTION—Cont'd**  
Reexamination, **16:134**  
Reissue of Patent (this index)  
Statutory subject matter, **5:4**

**INTRASIGENT**  
Inventorship, **10:8**

**INTRINSIC SOURCES**  
Claims (this index)

**INVALIDITY**  
Generally, **17:1, 17:15-17:43**  
Assignee estoppel, **17:42**  
Assignor estoppel, **17:43**  
Avoidance defense, **17:6**  
Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, **17:28-17:31**  
Breach, licensee estoppel, **17:40**  
Burdens of proof, **17:17**  
Cardinal Chemical Co. v. Morton International, Inc., **17:24, 17:25**  
Case law  
estoppel by transfer of ownership, **17:36, 17:37**  
mootness and order of resolution, **17:24, 17:25, 17:28-17:31**  
Supreme Court decisions in early developments, **17:22**  
Common law pleading, **17:7**  
Consent decrees, prior, **17:41**  
Considerations, mootness and order of resolution, **17:20**  
Current statute, pleading under, **17:2-17:13**  
Defenses, generally, **17:4-17:8, 17:15-17:43**  
Early developments, mootness and order of resolution, **17:21-17:23**  
Early history, licensee estoppel, **17:35**  
Escrow, licensee estoppel, **17:40**  
Estoppel by transfer of ownership generally, **17:33**  
assignee estoppel, **17:42**  
assignor estoppel, **17:43**  
breach, **17:40**  
consent decrees, prior, **17:41**

**INVALIDITY—Cont'd**

Estoppel by transfer of ownership  
 —Cont'd  
 early history, licensee estoppel, **17:35**  
 escrow, **17:40**  
 holding in Lear, Inc. v. Adkins, **17:37**  
 Lear, Inc. v. Adkins, **17:36, 17:37**  
 licensee estoppel, **17:34-17:41**  
 modern rule, **17:38-17:40**  
 prior consent decrees and settlements, **17:41**  
 recovery of royalties paid, **17:39**  
 settlements, prior, **17:41**  
 Federal code pleading, **17:8**  
 Full and fair opportunity to litigate, **17:31**  
 General pleading theory and current statute, **17:2-17:13**  
 Infringement actions, generally, **17:4**  
 Issue preclusion  
 generally, **17:26**  
 Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, **17:28-17:31**  
 facts in case, **17:29**  
 full and fair opportunity to litigate, **17:31**  
 holding, **17:30**  
 subsequent decisions, **17:32**  
 traditional rule, **17:27**  
 Lear, Inc. v. Adkins, **17:36, 17:37**  
 Licensee estoppel, **17:34-17:41**  
 Lower court decisions, **17:23**  
 Modern pleading, **17:8**  
 Modern rule, estoppel by transfer of ownership, **17:38-17:40**  
 Mootness and order of resolution  
 generally, **17:19**  
 Cardinal Chemical Co. v. Morton International, Inc., **17:24**  
 considerations, **17:20**  
 early developments, **17:21-17:23**  
 issue preclusion, above  
 lower court decisions prior to 1982, **17:23**  
 subsequent developments, **17:25**

**INVALIDITY—Cont'd**

Mootness and order of resolution  
 —Cont'd  
 Supreme Court decisions in early developments, **17:22**  
 Negation defense, **17:6**  
 Orders. Mootness and order of resolution, above  
 Pleading  
 application to patent statute, **17:9-17:13**  
 common law pleading, **17:7**  
 current statute, **17:2-17:13**  
 defenses, generally, **17:4-17:8**  
 federal code pleading, **17:8**  
 general pleading theory and current statute, **17:2-17:13**  
 infringement actions, generally, **17:4**  
 modern pleading, **17:8**  
 negation vs. avoidance, **17:6**  
 prior art notice, **17:14**  
 prior statutes, **17:3, 17:10**  
 section 282, **17:11**  
 Presumption of validity  
 burdens of proof, **17:17**  
 defenses, generally, **17:16**  
 standard of proof, **17:18**  
 Prior art notice as defense, **17:14**  
 Prior consent decrees and settlements, **17:41**  
 Prior statutes, general pleading theory, **17:3, 17:10**  
 Recovery of royalties paid, **17:39**  
 Resolution. Mootness and order of resolution, above  
 Section 282, **17:11**  
 Settlements, prior, **17:41**  
 Standard of proof, **17:18**  
 Subsequent to Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, **17:32**  
 Supreme Court decisions, early developments, **17:22**  
 Traditional rule, issue preclusion, **17:27**  
 Transfer. Estoppel by transfer of ownership, above

## INDEX

**INVENTIVE CONCEPT**  
Technological scope, **13:69**

**INVENTIVE CONFIGURATION**  
Adequate disclosure, **7:39**  
Inventorship, **10:12**

**INVENTIVE CONTRIBUTION**  
Joint Inventorship (this index)

**INVENTIVE ENTITIES**  
Correction of inventorship, **10:55**  
Joint Inventorship (this index)

**INVENTOR**  
Inventorship (this index)

**INVENTORSHIP**  
Generally, **10:1 et seq.**  
Abstract business entities, **10:9, 10:13, 10:17**  
Adjustments, **10:18**  
Age, **10:7**  
Agents and agency, **10:13, 10:14, 10:17**  
Application filing, **10:8, 10:10, 10:14, 10:17**  
Assignment  
generally, **10:7**  
correction of inventorship, **10:59-10:61, 10:66, 10:67**  
joint inventorship, **10:25, 10:39, 10:40**  
proper inventorship rule, **10:8**  
Author, **10:6, 10:16**  
Blackstone's Commentaries, **10:4**  
Bona fide disputes, **10:7**  
Business entities, **10:1, 10:9, 10:13**  
Business entities and employed inventors. Definition of inventor, below  
Capital expenditures, **10:17**  
Capital resources, **10:17**  
Case law, **10:6, 10:7, 10:11**  
Change and modification, **10:7, 10:14, 10:18, 10:45**  
Collaborative research, **10:1, 10:15, 10:18**  
Commercial use, **10:14**  
Commissioned works, **10:16**  
Common law, **10:14, 10:17, 10:47**

**INVENTORSHIP—Cont'd**  
Concealment, **10:3**  
Conception. Definition of inventor, below  
Configuration, **10:12**  
Congress, **10:2, 10:6, 10:7, 10:14**  
Consent, **10:14**  
Constitutional law, **10:2, 10:7**  
Construction and interpretation, **10:12**  
Contested cases, **10:7**  
Continuous effort, **10:18**  
Contracts and agreements, generally, **10:1**  
Contribution, **10:11, 10:17**  
Conveyance of title, **10:7, 10:14**  
Cooperative research effort, **10:18**  
Copyright, **10:6, 10:16-10:18, 10:53**  
Corollaries, **10:6, 10:7, 10:13**  
Correction (this index)  
Costs and expenses, **10:17**  
Damages, **10:8**  
Death, **10:8**  
Definition of invention, **10:11**  
Definition of inventor  
generally, **10:10-10:18**  
business entities and employed inventors  
generally, **10:13-10:18**  
copyright contrasted, **10:16**  
historical development, **10:14**  
modern collaborative research, conflicts with, **10:15**  
recent legislative adjustments, **10:18**  
conception, generally, **10:11**  
copyright, **10:16-10:18**  
employed inventors. Business entities and employed inventors.  
above in this group  
first-to-invent priority, partial analogy to, **10:11, 10:12**  
initial title, generally, **10:11**  
performance of act of invention, generally, **10:11**  
Definitions  
initial occupant, **10:4**  
inventor, **10:16**

**INVENTORSHIP—Cont'd**

Doctrine of shop right, **10:14, 10:17**  
 Economic justification, **10:3**  
 Economic use, **10:14**  
 Embodiment, **10:12**  
 Employment  
     generally, **10:7, 10:9**  
     definition of inventor, **10:13**  
     definition of inventor, above  
 Enforcement, **10:17**  
 English law, **10:2**  
 Entrepreneurs, **10:14**  
 European Patent Convention, **10:17**  
 Evidence, **10:14**  
 Exceptions, **10:8**  
 Exclusive rights, **10:2**  
 Express contract, **10:17**  
 Federal Circuit, **10:7, 10:11**  
 Federal courts, generally, **10:6**  
 Filing application  
     generally, **10:1, 10:8**  
     definition of inventor, **10:10, 10:14, 10:17**  
 First possessor, **10:4**  
 First-to-invent priority, partial analogy to, **10:11, 10:12**  
 Foreign countries, **10:7, 10:17**  
 Future acts and matters, **10:7**  
 Historical development, **10:14**  
 History, **10:2-10:4**  
 Ideas of others, **10:11**  
 Implied license, **10:17**  
 Inchoate patent rights, **10:7, 10:8**  
 Industrial commerce, **10:15**  
 Inherency, **10:4**  
 Initial occupant defined, **10:4**  
 Initial title  
     generally, **10:4**  
     definition of inventor, **10:14, 10:15**  
     definition of inventor, above  
 Intellectual creator, **10:14**  
 Intellectual part, **10:12**  
 Intent  
     generally, **10:6**  
     correction of inventorship, **10:57, 10:60, 10:65**  
     inventorship, **10:6**

**INVENTORSHIP—Cont'd**

Intent—Cont'd  
     joint inventorship, **10:25, 10:33, 10:40, 10:45**  
 Interference, **10:7**  
 Intransigent, **10:8**  
 Inventive configuration, **10:12**  
 Inventor. Definition of inventor, above  
 Investments, **10:14**  
 Irreparable damage, **10:8**  
 Issuance of patent, **10:7**  
 Joint Inventorship (this index)  
 Joint ownership, **10:17**  
 Justification, **10:2-10:4**  
 Large business entities, **10:1**  
 Legal ability, lack of, **10:8**  
 Legislation, **10:18**  
 Licenses and permits, **10:7, 10:17**  
 Limitations and restrictions  
     generally, **10:1, 10:2, 10:7, 10:8**  
     definition of inventor, **10:11, 10:14**  
 Majority, legal age of, **10:7**  
 Manual of Patent Examining Procedure, **10:7**  
 Marriage, **10:7**  
 Mental acts and matters  
     capacity, **10:7**  
     creativity, **10:12, 10:13, 10:16, 10:17**  
     definition of inventor, **10:12, 10:13, 10:16, 10:17**  
 Mistake and error, **10:1**  
 Modern collaborative research, conflicts with, **10:15**  
 Multiple persons. Joint Inventorship (this index)  
 Name and misnaming, **10:1**  
 Named individual inventors, **10:18**  
 Negotiations, **10:17**  
 New creation, **10:4**  
 Notice and knowledge, **10:12**  
 Novelty, **10:14**  
 Omissions, **10:12**  
 Operation of law, generally, **10:1**  
 Original inventor, **10:7, 10:9, 10:10**  
 Partnerships, **10:14**  
 Patentability, **10:7**

## INDEX

**INVENTORSHIP—Cont'd**  
Patent Act of 1839, **10:14**  
Patent and Trademark Office (PTO),  
**10:7, 10:8**  
Payments, **10:14**  
Perfection, **10:8, 10:11**  
Personal property, **10:7**  
Policy justification, **10:2-10:4**  
Possession, **10:4**  
Preserving rights of parties, **10:8**  
Prior Inventor, Prior-User Rights (this  
index)  
Priority, **10:4, 10:11, 10:12**  
Prior user right, **10:14**  
Prior work, **10:18**  
Proper inventorship rule  
generally, **10:5-10:9**  
assignee, perfection of patent  
rights by, **10:8**  
copyright compared, **10:6**  
corollary rules, **10:7**  
Proper ownership, question of, **10:7**  
Property, general law of, **10:4**  
Property, law of, **10:14**  
Public, **10:3**  
Public use or on sale, **10:14**  
Qualifications  
generally, **10:7, 10:8**  
definition of inventor, **10:10,**  
**10:16, 10:17**  
Receipt of title, **10:14, 10:17**  
Recent legislative adjustments, **10:18**  
Reduction to practice. Definition of  
invention, above  
Reissue of patent, **16:84**  
Research and development, **10:1,**  
**10:15, 10:17, 10:18**  
Royalty payments, **10:14**  
Sanity, **10:7**  
Section 273 defense. Prior Inventor,  
Prior-User Rights (this index)  
Section 102, **10:18**  
Section 102(b), **10:14**  
Section 116, **10:18**  
Section 117, **10:8**  
Services, use of, **10:13**  
Services of others, **10:11**  
Setting aside, **10:7**

**INVENTORSHIP—Cont'd**  
17 USC, Section 201(a), **10:6**  
Single-source profits, **10:3**  
Skills of the art, **10:12**  
Sole inventorship, **10:9**  
State law, **10:6**  
Superior priority of title, **10:4**  
Supreme Court, **10:7**  
Third persons, **10:11, 10:13, 10:18**  
35 USC, Section 18, **10:8**  
35 USC, Section 100, **10:10**  
35 USC, Section 101, **10:7**  
35 USC, Section 102(f), **10:7**  
35 USC, Section 115, **10:7**  
35 USC, Section 116, **10:10**  
35 USC, Section 117, **10:8**  
35 USC, Section 261, **10:7**  
Title and ownership, generally, **10:1**  
Trade secrets, **10:3**  
Transfers of Rights and Title (this  
index)  
Treatises, **10:2**  
Useful art, **10:2**  
Useful arts, **10:7**  
Validity, **10:1, 10:7, 10:10**  
Vesting of title, generally, **10:1**  
Women, **10:7**  
Work-for-hire, **10:16, 10:17**

**INVESTIGATION**  
Adequate utility, **6:18, 7:20**  
Examination of Original Application  
(this index)  
Non-obviousness, **9:6, 9:54, 9:60**  
Patent and Trademark Office (PTO),  
**2:22**  
Priority, **8:54**  
**INVESTIGATIONAL NEW DRUG  
(IND)**  
Adequate commerciality, **14:67,**  
**14:73**

**INVESTMENTS**  
Inventorship, **10:14**

**IPSIS VERBIS**  
Adequate utility, **7:42**

**IRREPARABLE DAMAGE**  
Inventorship, **10:8**

**ISSUANCE OF LETTERS PATENT**  
History, **1:4**

**ISSUANCE OF PATENT**  
Generally, **2:10, 2:16**  
Adequate disclosure, **7:1, 7:18**  
Claims, **4:6**  
Examination of Original Application (this index)  
Geographic scope, **12:41**  
History, **1:18, 1:25**  
Inventorship, **10:7**  
Joint inventorship, **10:25**  
Non-obviousness, **9:37**  
Non-statutory hybrid inventions, **5:63**  
Patent and Trademark Office (PTO), generally, **2:8**  
Priority, **8:69**  
Processes, **5:21, 5:39**  
Reissuance of Patent (this index)  
Temporal Scope of Infringement (this index)  
Utility Requirement (this index)

**ISSUE PRECLUSION**  
Claims, **4:20**  
Invalidity (this index)

**JAPAN**  
Non-obviousness, **9:11, 9:42**  
Policy justification, **1:43**  
Statutory subject matter, **5:4**

**JEPSON-STYLE CLAIMS**  
Generally, **4:99**

**JOHNSON & JOHNSTON ASSOCIATES INC. v. R.E. SERVICE CO., INC.**  
Technological scope, **13:38, 13:97**

**JOHNSON WORLDWIDE v. ZEBCO**  
Claims, **4:36**

**JOINDER**  
Correction of inventorship, **10:57**

**JOINT APPLICANTS**  
Joint Inventorship (this index)

**JOINT EMPLOYMENT**  
Non-obviousness, **9:33, 9:37**

**JOINT INVENTION**  
Joint Inventorship (this index)

**JOINT INVENTORS**  
Joint Inventorship (this index)

**JOINT INVENTORSHIP**  
Generally, **10:19-10:53**  
Abandonment, **10:52**  
Abstract business entities, **10:52**  
Accountability, **10:50-10:53**  
Agency, **10:25**  
All-claims rule, **10:38-10:41**  
Amendments. Patent Act amendments of 1984, below  
Another  
definition of another, below  
prior work performed by, **10:42**  
Anticipation, lack of, **8:8, 10:42**  
Anticipatory event, **10:33**  
Appeal and review, **10:38, 10:46, 10:51**  
Application  
generally, **10:27, 10:38**  
filing application, below  
initial application, **10:40**  
joint applicants, **10:21, 10:36-10:38**  
Assignment, **10:25, 10:39, 10:40**  
Blackledge v. Weir & Craig Mfg. Co., **10:51**  
Board of Patent Appeals and Interferences, **10:46**  
Business entities, **10:52**  
Carter rule, **10:53**  
Case law  
generally, **10:19**  
Clum v. Brewer, **10:49, 10:50**  
inventive contribution versus suggestion, **10:31, 10:33**  
prior limits on correcting inventorship, **10:25**  
tenancy in common, **10:49**

## INDEX

### **JOINT INVENTORSHIP—Cont'd**

Change and modification, **10:45, 10:50**  
Clum v. Brewer, **10:49, 10:50**  
Co-invention, **10:29**  
Co-inventors, **10:47**  
Collaboration, generally, **10:23**  
Common enterprise, **10:39**  
Common law, **10:47**  
Common ownership, **10:37**  
Complete or definite conception, **10:31**  
Conception, generally, **10:23-10:33**  
Configuration, **10:47**  
Congress, **10:39-10:41, 10:45**  
Consent  
    definition of joint invention, **10:26, 10:29, 10:34**  
    rights and obligations, **10:47, 10:49-10:51, 10:53**  
Construction and interpretation, **10:37, 10:41**  
Construction of work, **10:23, 10:31**  
Contest, **10:25, 10:52**  
Continuation application, **10:45, 10:46**  
Continuations-in-part, **10:46**  
Contribution  
    generally, **10:24, 10:28, 10:37**  
    definition of joint invention, below  
Conversion, **10:49**  
Cooperating inventors  
    generally, **10:22, 10:40**  
    joint applicants, below  
Cooperative work, **10:26**  
Co-ownership  
    definition of joint invention, **10:29, 10:30, 10:32, 10:33**  
    rights and obligations, **10:47**  
Copyright law contrasted, **10:53**  
Corporations, **10:39**  
Correction of inventorship, **10:20, 10:25, 10:40, 10:65**  
Co-tenancy, **10:47, 10:51**  
Court, generally, **10:40**  
Court of Customs and Patent Appeals, **10:38**

### **JOINT INVENTORSHIP—Cont'd**

Current interpretation of 1984 amendments, **10:41**  
Deceptive intent, **10:40**  
Defenses, **10:25**  
Definite conception, **10:31**  
Definition of another  
    generally, **10:37, 10:42-10:46**  
    amendments of 1984, effect of, **10:45**  
    examples of current rule applied, **10:46**  
joint inventors, **10:44**  
sole inventors, **10:43**  
Definition of joint invention  
    generally, **10:22-10:34**  
    amendments of 1984, effect of, **10:27**  
basic rule, **10:26**  
contribution. Inventive contribution versus suggestion, below in this group  
    examples of basic rule applied, **10:28**  
general evaluation, **10:24**  
inventive contribution versus suggestion  
    generally, **10:29-10:34**  
    complete or definite conception, **10:31**  
    consent, **10:34**  
    excess over state of the art, **10:33**  
    materiality, **10:32**  
    specific tests identified and critiqued, generally, **10:30-10:34**  
    tests, generally, **10:30-10:34**  
prior limits on correcting inventorship, **10:25**  
suggestion. Inventive contribution versus suggestion, above in this group  
    tests. Inventive contribution versus suggestion, above in this group  
Definitions  
    another. Definition of another, above

**JOINT INVENTORSHIP—Cont'd**

Definitions—Cont'd  
 derivation, **10:28**  
 inventive entities, **10:19**  
 joint inventorship. Definition of joint invention, above  
 Derivation, **10:28**  
 Disclosure, **10:44, 10:46**  
 Distribution of ownership, **10:29, 10:32**  
 Duplicate application, **10:45**  
 Economic value, **10:52**  
 Effective abandonment, **10:52**  
 Embodiment, **10:40**  
 Employment, **10:25, 10:39**  
 Enforcement, **10:29**  
 English doctrine, **10:53**  
 Examiner, **10:46**  
 Excess over state of the art, **10:33**  
 Exclusions, **10:31, 10:33**  
 Ex parte DesOrmeaux, **10:46**  
 Ex parte Gilderdale, **10:46**  
 Experiments, **10:31**  
 Exploitation, **10:29, 10:47, 10:53**  
 Federal Circuit, **10:27**  
 Filing application, **10:38, 10:40**  
 generally, **10:46**  
 date, **10:40**  
 definition of joint invention, **10:27, 10:34**  
 first application, **10:46**  
 joint application, generally, **10:21, 10:35-10:41**  
 joint filing, **10:35, 10:36**  
 later duplicate application, **10:45**  
 1984 amendments to Patent Act, generally, **10:35-10:41**  
 First application, **10:40, 10:46**  
 First inventor, **10:19**  
 Group research, **10:39, 10:40**  
 History, **10:38-10:40, 10:48**  
 Immaterial contributions, **10:32**  
 Implied transfers, **10:25**  
 Improvements, **10:25, 10:31**  
 Independent work, **10:23**  
 Infringement, **10:29, 10:32, 10:49, 10:52**  
 Initial application, **10:40**

**JOINT INVENTORSHIP—Cont'd**

Initial participant, **10:34**  
 Intent, **10:25, 10:33, 10:40, 10:45**  
 Inventive contribution versus suggestion. Definition of joint invention, above  
 Inventive entities, generally, **10:19**  
 Issuance, correction of inventorships after, **10:25**  
 Joint applicants  
 generally, **10:35-10:41**  
 all-claims rule and modern group research, conflict between, **10:39**  
 amendments of 1984, generally, **10:35-10:41**  
 application by joint inventors, **10:36**  
 cooperating inventors and 1984 amendments to Section 116, generally, **10:35-10:41**  
 current interpretation of 1984 amendments, **10:41**  
 distinguished, **10:21**  
 historical background, **10:38-10:40**  
 joint applications by cooperating inventors, **10:37**  
 joint inventors, application by, **10:36**  
 legislative purpose of 1984 amendments, **10:40**  
 Section 116 amendments of 1984, generally, **10:35-10:41**  
 Joint application  
 cooperating inventors, **10:37**  
 distinguished, **10:22**  
 filing, **10:36, 10:41**  
 filing application, above  
 non-obviousness, **9:36**  
 Joint invention defined. Definition of joint invention, above  
 Joint inventors  
 definition of another, **10:44**  
 joint applicants, **10:36**  
 obligation. Rights and obligation, below in this group  
 rights and obligation generally, **10:47-10:53**  
 copyright law contrasted, **10:53**

## INDEX

### JOINT INVENTORSHIP—Cont'd

Joint inventors—Cont'd  
rights and obligation—Cont'd  
    early history, **10:48**  
    effective abandonment, **10:52**  
    modern rule and rationale, **10:51**  
    modifications, **10:50**  
    tenancy in common, initial analogy of, **10:49**  
Later application, **10:40, 10:45**  
Later inventive entity, **10:44**  
Later participants, **10:30-10:33**  
Legislation, **10:41**  
Legislative purpose of 1984 amendments, **10:40**  
Licenses and permits, generally, **10:47-10:53**  
Limitations and restrictions  
    definition of joint invention, **10:25, 10:30, 10:31**  
    joint applicants, **10:38, 10:40**  
    rights and obligations, **10:52**  
Lost patent rights, **10:20**  
Materiality, **10:32**  
Mental creativity, **10:29**  
Mistake and error, **10:25, 10:45**  
Modern group research, **10:39**  
Monsanto Co. v. Kamp, **10:40**  
Multiple inventions, **10:37**  
Multiple inventive entities, **10:44**  
Named inventors, **10:41**  
1984 amendments. Patent Act amendments of 1984, below  
Non-obviousness, **9:37, 9:46, 10:42**  
Notice and knowledge  
    definition of another, **10:43, 10:44**  
    definition of joint invention, **10:26, 10:28, 10:33**  
    joint applicants, **10:39, 10:41**  
Oath as false, **10:40**  
Objections, **10:34, 10:49**  
Obligation. Joint inventors, above  
Omissions, **10:19**  
Ordinary artisan, **10:31**  
Original applicant, **10:34**  
Original application, **10:45**  
Original inventor, **10:19**  
Pannu v. Iolab, **10:33**

### JOINT INVENTORSHIP—Cont'd

Parent application, **10:46**  
Participant, **10:34**  
Participation, **10:28-10:30**  
Patentability, **10:42**  
Patent Act amendments of 1984  
    generally, **10:22, 10:27**  
    current interpretation, **10:41**  
    definition of another, **10:45**  
    definition of joint invention, **10:27**  
    history, **10:38**  
    joint applicants, below  
    legislative purpose, **10:40**  
Patent and Trademark Office (PTO), **10:38, 10:40, 10:46**  
Perfection of conception, **10:26**  
Peripheral claiming, **10:31**  
Pitts v. Hall, **10:49, 10:50**  
Political justifications, **10:25**  
Post hoc, **10:32**  
Prior art, **10:33, 10:38, 10:40, 10:46**  
Priority, law of, **10:31**  
Prior limits on correcting inventorship, **10:25**  
Prior work of others, **10:42**  
Profits, **10:53**  
Proper inventorship, **10:20-10:22**  
Public accessibility, **10:51**  
Qualifications  
    another defined, **10:46**  
    definition, **10:23, 10:26, 10:30**  
    later participants, **10:30**  
    proper inventorship, **10:20, 10:21**  
Qualitatively too small, **10:32**  
Qualitative small contribution, **10:23, 10:29**  
Real property or chattel, **10:49**  
Reduction-to-practice, **10:28**  
References, **10:46**  
Rejection, **10:36, 10:38, 10:39, 10:51**  
Relevant disclosure, **10:44, 10:46**  
Relevant knowledge, **10:33**  
Research and development, **10:39, 10:40**  
Rights and obligation. Joint inventors, above  
Royalties, **10:52**

**JOINT INVENTORSHIP—Cont'd**

SAB Industri AB v. Bendix Corp.,  
**10:40**  
Sanctions, **10:25**  
Section 102, **10:33, 10:42**  
Section 102(e), **10:46**  
Section 102(f), **10:28, 10:38**  
Section 103, **10:33, 10:38, 10:42**  
Section 116, **10:19, 10:27**  
Section 120, **10:45, 10:46**  
Section 262, **10:47, 10:51**  
Seventh Circuit, **10:51**  
Sole inventors, **10:43**  
State of the art, **10:33**  
Suggestions. Definition of joint  
invention, above  
Supreme Court, **10:33**  
Technical disclosure, **10:44**  
Technological knowledge, **10:33**  
Tenancy in common, **10:49, 10:50**  
Tests and testing  
    definition of another, **10:42-10:45**  
    definition of joint invention, **10:23**  
    definition of joint invention, above  
Third parties, **10:29, 10:51**  
Third persons, **10:28, 10:42, 10:47,**  
**10:49**  
Transfer of title, **10:25**  
Treatises, **10:24**  
Unilateral action, **10:52**  
Validity  
    definition of joint invention, **10:25,**  
**10:29**  
    joint applicants, **10:37, 10:41**  
    proper inventorship, **10:20**  
Value, **10:47, 10:50, 10:52**  
Void patent, **10:19**  
Vose v. Singer, **10:50**

**JOINT OWNERSHIP**

Definition of inventor, **10:17**

**JOINT TORTFEASORS**

Indirect Infringement (this index)

**JOINT VENTURES**

Non-obviousness, **9:47**

**JOY TECHNOLOGIES, INC. v.**

**FLAKT, INC.**  
Adequate commerciality, **14:27,**  
**14:28, 14:43**

**JUDGES**

Administrative patent judges (APJ),  
**2:22**  
Claims (this index)

**JUDGMENTS**

Adequate commerciality, **14:80**  
Adequate disclosure, **7:52**  
Claims, **4:2**  
Indirect infringement, **15:23**  
Non-statutory hybrid inventions, **5:85**  
Processes, **5:26, 5:30**

**JUDICIAL ACTS AND MATTERS**

Adequate disclosure, **7:5, 7:49**  
Claims, **4:73, 4:87, 4:91, 4:92**  
Congress (this index)  
History, **1:17, 1:18**  
Indirect infringement, **15:2, 15:6-**  
**15:9**  
Non-obviousness, **9:2, 9:4, 9:16**  
Non-statutory hybrid inventions,  
**5:81, 5:83**  
Patent and Trademark Office (PTO)  
    generally, **2:1, 2:2, 2:7**  
    decisions, review of. Judicial  
        Review (this index)  
    deference, **2:19**  
    notice, **2:25**  
    opposition, **2:18**  
        power to review, **2:21**  
    Peripheral claiming practice, **4:86**  
    Policy justification, **1:31**  
    Processes, **5:19, 5:37**  
    Static physical configurations, **5:10,**  
**5:16, 5:17**  
    Statutory subject matter, **5:4, 5:6**  
    Structural revision, 1982-present, **4:6**

**JUDICIAL ESTOPPEL**

Technological scope, **13:91**

**JUDICIAL REVIEW**

See also Appeal and Review (this  
index)

## INDEX

### JUDICIAL REVIEW—Cont'd

APA, review under application to USPTO review, **2:42, 2:43**  
arbitrary, capricious or abuse of discretion, **2:41**  
deference, **2:41**  
*Dickenson v. Zurko*, **2:43**  
facts, review, **2:41-2:43**  
law determinations, **2:44 et seq.**  
reasonableness, **2:41**  
substantial evidence, **2:41**  
Application, **2:43**  
Determinations of fact generally, **2:40**  
case-specific nature of substantial evidence standard, **2:43**  
common law, **2:43**  
deference, **2:41**  
reasonableness, **2:41**  
substantial evidence, **2:41, 2:42**  
Determinations of law generally, **2:44**  
application to legal rules of USPTO, **2:49-2:51**  
interpretative rules, **2:48, 2:51**  
legal rules under APA, generally, **2:45**  
procedural versus nonprocedural rules, **2:46**  
substantive/legislative rulemaking authority of USPTO, **2:50**  
substantive/legislative rules, **2:47**  
History, **1:19**  
Patent and Trademark Office (PTO) generally, **2:8, 2:29-2:51**  
administrative law. Standards of review, below in this group  
Administrative Procedures Act, review of facts, **2:41-2:43**  
arbitrary, capricious or abuse of discretion, **2:41**  
case-specific nature of substantial evidence standard, **2:43**  
consolidation in federal circuit, **2:37**  
court of customs and patent appeals, creation of, **2:36**  
current mechanisms, **2:38**

### JUDICIAL REVIEW—Cont'd

Patent and Trademark Office (PTO)  
—Cont'd  
    deference, **2:41**  
determinations of fact generally, **2:40**  
application to review, **2:42, 2:43**  
case-specific nature of substantial evidence standard, **2:43**  
clear error, **2:42**  
common law, **2:42, 2:43**  
deference, **2:41**  
*Dickenson v. Zurko*, **2:43**  
reasonableness, **2:41**  
review under APA, **2:41**  
substantial evidence, **2:41, 2:42**  
determinations of law generally, **2:44**  
application to legal rules of USPTO, **2:49-2:51**  
interpretative rules, **2:48, 2:51**  
legal rules under APA, generally, **2:45**  
procedural versus nonprocedural rules, **2:46**  
substantive/legislative rulemaking authority of USPTO, **2:50**  
substantive/legislative rules, **2:47**  
history, generally, **2:30-2:37**  
Patent Act of 1790, **2:31**  
Patent Act of 1793, **2:31**  
Patent Act of 1836, **2:32**  
Patent Act of 1839, **2:33**  
Patent Act of 1927, required election under, **2:35**  
reasonableness, **2:41**  
Reforms of 1870, **2:34**  
standards of review generally, **2:39**  
administrative law, generally, **2:48**  
determinations of fact, **2:43**  
determinations of fact, generally, **2:40**  
determinations of law, generally, **2:44-2:51**

**JUDICIAL REVIEW—Cont'd**  
Patent and Trademark Office (PTO)  
—Cont'd  
standards of review—Cont'd  
    interpretive rules, 2:48, 2:51  
    legislative rules, 2:41  
substantial evidence standard,  
    2:41, 2:42  
Reexamination, 16:126

**JURISDICTION**  
Adequate commerciality, 14:47  
Adequate utility, 6:12  
Claims, 4:6  
History, 1:14  
Patent and Trademark Office (PTO),  
    2:36, 2:37

**JURY**  
Adequate utility, 6:9  
Claims (this index)  
Indirect infringement, 15:4  
Priority, 8:34  
Reexamination, 16:126

**JUSTIFICATION**  
Adequate disclosure, 7:1, 7:4, 7:21,  
    7:33  
Correction, 10:59  
Examination of Original Application  
    (this index)  
Inventorship, 10:2-10:4  
Misuse of patent, 18:25  
Non-Obviousness (this index)  
Policy Justification (this index)  
Priority, 8:56, 8:61, 8:67  
Utility Requirement (this index)

**KEPLINGER v. DE YOUNG**  
Adequate commerciality, 14:3  
Indirect infringement, 15:3

**KEWANEE OIL CO. V. BICRON  
CORP.**  
Historical origins of patent grant,  
    1:13.60

**KITS**  
Static physical configurations, 5:8

**KNOW-HOW**  
Adequate disclosure, 7:17

**KNOWLEDGE**  
Notice and Knowledge (this index)

**KNOWLEDGEABLE IN THE ART**  
Anticipation, lack of, 8:22  
Non-obviousness, 9:57

**KNOWN ART**  
Adequate utility, 6:8

**KNOWN INTERCHANGEABILITY**  
Technological scope, 13:75, 13:76

**KNOWN PHYSICAL RULES**  
Adequate utility, 6:8

**KNOWN TO THE ART**  
Adequate utility, 6:4

**LACHES**  
Generally, 23:1-23:45  
Application to actions for patent  
    infringement, 23:6-23:20  
Aukerman v. Chaides, 23:16  
Burdens of proof and pleading, 23:39  
Campbell v. City of Haverhill, 23:8  
Cornetta v. U.S., 23:15  
Correction of inventorship, 10:61  
Defendant's unclean hands, 23:41  
Economic prejudice from unreason-  
    able delay, 23:37  
En banc decision, 23:19  
Estoppel distinguished, 24:21  
Evidentiary prejudice from unreason-  
    able delay, 23:38  
Examination of Original Application  
    (this index)  
Excuses, unreasonable delay, 23:29-  
    23:35  
Federal Circuit decisions  
    Aukerman v. Chaides, 23:16  
    Cornetta v. U.S., 23:15  
    en banc decision, 23:19  
    facts, 23:17  
    initial panel decision, 23:18  
    patent infringement actions, 23:14-  
        23:20  
    subsequent decisions, 23:20  
Forms distinguished, 23:2  
General rule, 23:22

## INDEX

### **LACHES—Cont'd**

Historical development  
generally, **1:21, 23:3**  
laches vs. statutes of limitation,  
**23:5**  
law vs. equity, generally, **23:4, 23:5**  
patent infringement actions, **23:6-23:20**  
Initial panel decision, Federal Circuit decisions, **23:18**  
Insecure title, unreasonable delay, **23:31**  
Justification of policy, **23:21**  
Lack of counsel, unreasonable delay, **23:34**  
Law and Equity Act of 1915, **23:11**  
Law vs. equity, generally, **23:4, 23:5**  
License negotiations, unreasonable delay, **23:32**  
Ongoing license negotiations, unreasonable delay, **23:32**  
Onset of period, unreasonable delay, **23:25-23:35**  
Patent Act of 1897, Section 6, **23:9**  
Patent Act of 1946, **23:12**  
Patent infringement  
application, **23:6-23:20**  
Campbell v. City of Haverhill, **23:8**  
court decisions, 1895-1915, **23:10**  
early period, **23:7**  
Federal Circuit decisions, **23:14-23:20**  
historical development, **23:6-23:20**  
Law and Equity Act of 1915, **23:11**  
Patent Act of 1897, Section 6, **23:9**  
Patent Act of 1946, **23:12**  
Pleading, **23:39**  
Policy justification, **23:21**  
Poverty, unreasonable delay, **23:33**  
Prejudice  
defendant, prejudice to, **23:36**  
economic prejudice from unreasonable delay, **23:37**  
evidentiary prejudice from unreasonable delay, **23:38**  
Priority, **8:86**

### **LACHES—Cont'd**

Prior minimal infringement, unreasonable delay, **23:35**  
Remedies, effect on, **23:42**  
Six-year presumption, unreasonable delay, **23:40**  
Special issues, **23:23-23:45**  
Statutes of limitation, **23:5**  
Supreme Court cases, **23:43**  
Petrella v. Metro-Goldwyn-Mayer, Inc., **23:44**  
SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC., **23:45**  
Unclean hands of defendant, **23:41**  
Unreasonable delay  
generally, **23:24**  
economic prejudice, **23:37**  
evidentiary prejudice, **23:38**  
excuses, **23:29-23:35**  
insecure title, **23:31**  
lack of counsel, **23:34**  
license negotiations, **23:32**  
ongoing license negotiations, **23:32**  
onset of period, **23:25-23:35**  
other litigation, **23:30**  
poverty, **23:33**  
prior minimal infringement, **23:35**  
six-year presumption, **23:40**  
subsequent decisions, **23:28**  
Wanlass v. Fedders, **23:27**  
Wanlass v. General Elec. Co., **23:26**  
Wanlass v. Fedders, unreasonable delay, **23:27**  
Wanlass v. General Elec. Co., unreasonable delay, **23:26**

### **LACK OF COUNSEL**

Laches, unreasonable delay, **23:34**

### **LAND PATENT**

History, **1:1**

### **LANGUAGE ISSUES**

Technological Scope of Infringement  
(this index)

**LAPSED TIME**  
Priority, **8:65**

**LARGE BUSINESS ENTITIES**  
Inventorship, **10:1**

**LAST THEOREM OF PIERRE DE FERMAT**  
Adequate disclosure, **7:34**

**LATERAL CONTRACTS**  
Policy justification, **1:38**

**LATER APPLICATION**  
Joint inventorship, **10:40, 10:45**

**LATER-CLAIMED SUBJECT MATTER**  
Adequate disclosure, **7:42**

**LATER-DISCOVERED TECHNOLOGY**  
Technological scope, **13:56**

**LATER-INVENTED METHOD**  
Adequate disclosure, **7:14**

**LATER INVENTIVE ENTITY**  
Joint inventorship, **10:44**

**LATER PARTICIPANTS**  
Joint inventorship, **10:30-10:32**

**LATER PARTICIPATIONS**  
Joint inventorship, **10:33**

**LAUDATORY STATEMENTS**  
Non-obviousness, **9:57, 9:59, 9:62**

**LAW AND EQUITY ACT OF 1915**  
Laches, **23:11**

**LAW VS. EQUITY**  
Laches, **23:4, 23:5**

**LEAR, INC. v. ADKINS**  
Invalidity, **17:36, 17:37**

**LEARNED HAND**  
Technological scope, **13:11**

**LEDGER SHEETS**  
Processes, **5:29**

**LEEDS & CATLIN CO. v. VICTOR TALKING MACHINE CO.**  
Indirect infringement, **15:5, 15:9**

**LEGAL ABILITY, LACK OF**  
Inventorship, **10:8**

**LEGAL DEFENSES**  
Technological Scope of Infringement (this index)

**LEGISLATION**  
Claims, **4:77, 4:81, 4:87**  
Inventorship, **10:18**  
Joint inventorship, **10:40, 10:41**  
Non-obviousness, **9:5, 9:82**  
Non-statutory hybrid inventions, **5:83**  
Patent and Trademark Office (PTO), **2:41**  
Prior inventor, prior-user rights, proposed legislation, 1992-1997, **22:14**  
Processes, **5:28, 5:39**  
Static physical configurations, **5:14, 5:15**

**LE ROY v. TATHAM**  
Processes, **5:21**

**LETTER PATENT**  
History, **1:1, 1:3-1:5, 1:7**

**LICENSED HEALTH PROFESSIONALS**  
Processes, **5:39**

**LICENSEE ESTOPPEL**  
Invalidity, **17:34-17:41**

**LICENSES AND PERMITS**  
Actions in patent versus actions in contract, **19:32**  
Adequate commerciality, **14:41**  
Adequate disclosure, **7:14**  
Case law, defenses  
Bauer & Cie v. O'Donnell, **19:19**  
express limitations by patent owner. Keppell v. Bailey, below  
Heaton-Peninsular Button-Fastener  
Col v. Eureka Specialty Co., **19:15, 19:16**

## INDEX

**LICENSES AND PERMITS—Cont'd**

- Case law, defenses—Cont'd
  - Henry v. A.B. Dick Co., **19:16**
  - Miles Medical Co. v. John D. Park & Sons Co., **19:18**
  - restrictions on division of title, **19:18-19:20**
  - Supreme Court decisions, below
  - Chattel, prohibition of restraints on, **19:31**
  - Claims, **4:63**
  - Correction of inventorship, **10:61**
  - Defenses
    - generally, **19:1-19:44**
    - actions in patent versus actions in contract, **19:32**
    - chattel, prohibition of restraints on, **19:31**
    - express licenses, below
    - Federal Circuit decisions, **19:24**
    - freedom of contract, **19:31**
    - historical development
      - generally, **19:2**
      - express licenses, **19:3**
      - express limitations by patent owner, **19:9-19:23**
      - implied licenses, **19:4-19:6, 19:8**
    - implied licenses, below
    - policy justification, **19:28-19:33**
    - restraints on chattel, prohibition, **19:31**
    - Supreme Court decisions, below
  - Dispute framing, **19:12-19:16**
  - Exhaustion and implied-in-law licenses compared, **19:33**
  - Express licenses
    - generally, **19:34**
    - historical development, **19:3**
    - policy justification, express versus implied, **19:29**
  - Express limitations by patent owner
    - case law. Keppell v. Bailey, below
    - contractual powers limited, **19:22, 19:23**
    - dispute framing, **19:12-19:16**
    - early expansion, **19:11**
    - extent of limitation of contractual powers, **19:23**
- LICENSES AND PERMITS—Cont'd**
- Express limitations by patent owner
  - Cont'd
    - historical development, **19:9-19:23**
    - initial recognition, **19:10**
    - restrictions on division of title, below
    - subsequent developments, **19:21-19:23**
  - Federal Circuit decisions, express and implied licenses, **19:24**
  - First sale doctrine, implied-in-law licenses, **19:38-19:40**
  - Freedom of contract, **19:31**
  - History, **1:4, 19:2-19:27**
  - Implied licenses
    - generally, **19:35**
    - exhaustion and implied-in-law licenses compared, **19:33**
    - express versus implied, **19:29**
    - historical development, **19:4-19:6, 19:8**
    - implied-in-fact
      - generally, **19:36**
      - comparison to implied-in-law, **19:30**
    - implied-in-law
      - generally, **19:37**
      - applicability of doctrine, **19:40**
      - comparison to implied-in-fact, **19:30**
      - contract limitation, **19:39**
      - embodiments, **19:40**
      - first sale doctrine, **19:38-19:40**
      - importation, **19:44**
      - international sales, **19:44**
      - involuntary sales, **19:41**
      - parallel importation, **19:44**
      - reconstruction, **19:42**
      - recovered infringements, **19:43**
      - repair, **19:42**
      - unrestricted sales, **19:39**
    - infringement, **19:6**
    - inventorship, **10:17**
    - policy justification, **19:29, 19:30, 19:33**
    - purchase and license to use, **19:5**
    - recovered infringements, **19:6**

**LICENSES AND PERMITS—Cont'd**

Implied licenses—Cont'd  
 reissue of patent, **16:119**  
 restraints on chattel, prohibition, **19:31**  
 subsequent developments, **19:7, 19:8**  
 use following purchase, **19:5**  
 Importation, implied-in-law licenses, **19:44**  
 Indirect infringement, **15:5**  
 Infringement, defense of implied license, **19:6**  
 International sales, implied-in-law licenses, **19:44**  
 Inventorship, **10:7, 10:17**  
 Involuntary sales, implied-in-law licenses, **19:41**  
 Joint Inventorship (this index)  
 Keppell v. Bailey, express limitations by patent owner  
 ascendency of property, **19:14**  
 dispute framing, **19:12-19:16**  
 early indecision, **19:13**  
 Heaton-Peninsular Button-Fastener Col v. Eureka Specialty Co., **19:15, 19:16**  
 Henry v. A.B. Dick Co., **19:16**  
 Laches, unreasonable delay due to license negotiations, **23:32**  
 Limitations and restrictions contractual power limitations, **19:22, 19:23**  
 division of title. Restrictions on division of title, below express limitations by patent owner, above  
 Misuse of Patent (this index)  
 Parallel importation, implied-in-law licenses, **19:44**  
 Patent and Trademark Office (PTO), **2:13, 2:21**  
 Policy justification, **1:31, 19:28-19:33**  
 Processes, licensing fees, **5:39**  
 Purchase and license to use, **19:5**  
 Reconstruction, implied-in-law licenses, **19:42**

**LICENSES AND PERMITS—Cont'd**

Recovered infringements implied-in-law licenses, **19:43**  
 implied license, **19:6**  
 Repair, implied-in-law licenses, **19:42**  
 Restraints on chattel, prohibition, **19:31**  
 Restrictions on division of title Bauer & Cie v. O'Donnell, **19:19**  
 express limitations by patent owner, **19:17-19:20**  
 Miles Medical Co. v. John D. Park & Sons Co., **19:18**  
 Supreme Court decision of 1917, **19:20**  
 Static physical configurations, **5:15**  
 Supreme Court decisions Leegin Creative Leather Products, Inc. v. PSKS, Inc., **19:26**  
 Quanta Computer, Inc. v. LG Electronics, Inc., **19:27**  
 restrictions on division of title, 1917 decisions, **19:20**  
 Unrestricted sales, implied-in-law licenses, **19:39**  
 Use following purchase, implied license defense, **19:5**

**LIGHTING BALLAST CONTROL****LLC v. PHILLIPS ELECTRONIC NORTH AMERICA CORP.**

Claims, **4:17.50**

**LIMITATION OF ACTIONS**

Examination of Original Application (this index)  
 Laches, **23:5**  
 Patent and Trademark Office (PTO), **2:1**  
 Section 286 defense. Six Year Limitation (this index)

**LIMITATIONS AND RESTRICTIONS**

Adequate Commerciality (this index)  
 Anticipation, Lack Of (this index)  
 Claims (this index)  
 Correction (this index)

## INDEX

**LIMITATIONS AND RESTRICTIONS—Cont'd**  
Disclosure (this index)  
Examination of Original Application (this index)  
History (this index)  
Indirect Infringement (this index)  
Inventorship (this index)  
Joint inventorship  
Misuse of Patent (this index)  
Non-Obviousness (this index)  
Non-Statutory Hybrid Inventions (this index)  
Patent and Trademark Office (PTO) (this index)  
Policy justification, **1:32, 1:39, 1:43**  
Prior inventor, prior-user rights, limitation of section 273 defense, **22:25**  
Priority (this index)  
Processes (this index)  
Reissue of Patent (this index)  
Static physical configuration, **5:8, 5:11, 5:14-5:17**  
Statutory Subject Matter (this index)  
Technological scope, **13:107**  
Temporal scope, **11:28, 11:34**  
Utility Requirement (this index)

**LIMITATION TO BUSINESS METHODS**  
Defined, **22:20**

**LINGUAL DESCRIPTION**  
Adequate disclosure, **7:6**

**LINGUAL MEANING**  
Claims, **4:1**

**LINGUAL SCHEDULE**  
Claims (this index)

**LIQUIDS**  
Static physical configurations, **5:9**

**LITERAL INFRINGEMENT**  
Claims, **4:71**

**LITERAL LANGUAGE**  
Non-obviousness, **9:24, 9:25**

**LITERAL MEANING**  
History, **1:21**

**LITERARY EXPRESSIONS AND WORKS**  
Computer-related inventions, **5:42**  
Static physical configurations, **5:11**

**LITIGATION**  
Estoppel, communication from patent owner, **24:27**

**LITTERAE CLAUSAE**  
History, **1:1**

**LITTERAE PATENTES**  
History, **1:1**

**LIVING ORGANISMS**  
Adequate utility, **6:6**  
Static physical configurations, **5:7, 5:16**

**LOCAL PRIORITY**  
Public possession prior to patentee's date of invention, paragraph 102(a), **8:193**

**LOCAL RULES**  
Patent and Trademark Office (PTO), **2:39**

**LOCKEAN THEORY**  
Policy justification, **1:29**

**LOGARITHMIC SCALES**  
Processes, **5:27**

**LOGICAL DELIBERATE ACT**  
Non-obviousness, **9:67**

**LORD COKE**  
History, **1:5**

**LOST PATENT RIGHTS**  
Joint inventorship, **10:20**

**LOWELL v. LEWIS**  
Adequate utility, **6:9, 6:10**

**LOWER COURTS**  
Adequate disclosure, **7:45**  
Adequate utility, **6:16, 6:17**  
Claims, **4:6, 4:80**  
History, **1:20**

**LOWER COURTS—Cont'd**  
Invalidity, 17:23  
Non-obviousness, 9:33

**LUXEMBOURG**  
Adequate utility, 7:18

**MACAULAY**  
History, 1:4

**MACHINE-READABLE DATA**  
Static physical configurations, 5:11

**MACHINES**  
Adequate utility, 7:10  
Static physical configurations, 5:7, 5:8  
Statutory Subject Matter (this index)

**MADEY v. DUKE UNIVERSITY**  
Adequate commerciality, 14:59

**MAGNA CARTA**  
History, 1:4

**MAHN v. HARWOOD**  
Reissue of patent, 16:103

**MAJORITY, AGE OF**  
Inventorship, 10:7

**MAKING**  
Adequate Commerciality (this index)  
Indirect Infringement (this index)

**MANIPULATION AND MANIPULATIVE STEPS**  
Non-statutory hybrid inventions, 5:55  
Processes, 5:27, 5:36

**MANUAL OF PATENT EXAMINING PROCEDURE (MPEP)**  
Adequate utility, 7:12  
Claims, 4:73, 4:78, 4:89, 4:93  
Examination of Original Applications (this index)  
Inventorship, 10:7  
Non-statutory hybrid inventions, 5:83  
Patent and Trademark Office (PTO), 2:24, 2:26  
Processes, 5:30

**MANUAL PROCEDURES**  
Patent and Trademark Office (PTO), 2:28  
Processes, 5:30

**MANUFACTURE, ARTICLE OF**  
Adequate disclosure, 7:7  
Computer-Related Inventions (this index)  
Designs, 5:46  
Non-statutory hybrid inventions, 5:55  
Static physical configurations, 5:7, 5:8, 5:11, 5:17  
Statutory Subject Matter (this index)

**MANUFACTURING**  
History, 1:6  
Statutory Subject Matter (this index)

**MARKET FORCES**  
Utility requirement, 6:4

**MARKETING REGULATION OF FDA**  
Adequate commerciality, 14:7

**MARKETPLACE**  
Non-obviousness, 9:54

**MARKING**  
Adequate utility, 6:19

**MARKMAN v. WESTVIEW INSTRUMENTS**  
Claims, 4:16, 4:17.50, 4:17.75

**MARKUSH GROUPING**  
Adequate disclosure, 7:41  
Claims, 4:100

**MARRIAGE**  
Inventorship, 10:7

**MASS COMMUNICATION**  
Adequate disclosure, 7:5

**MATERIAL CONTRIBUTIONS**  
Joint inventorship, 10:32

**MATERIALITY**  
Joint inventorship, 10:32

**MATERIAL PREJUDICE**  
Estoppel, 24:29

## INDEX

**MATHEMATICAL ALGORITHMS**  
Computer-related inventions, **5:41**  
Non-statutory hybrid inventions, **5:78, 5:81**  
Processes, **5:30**  
Statutory subject matter, **5:44**

**MATHEMATICAL CALCULATIONS**  
Non-statutory hybrid inventions, **5:55, 5:78**

**MATHEMATICAL DEMANDS**  
Static physical configurations, **5:12**

**MATHEMATICAL FORMULAE**  
Claims, **4:79**  
Non-statutory hybrid inventions, **5:74, 5:76**  
Processes, **5:22**  
Statutory subject matter, **5:6, 5:24**

**MATHEMATICS**  
Statutory Subject Matter (this index)

**MAXWELL v. J. BAKER, INC.**  
Technological scope, **13:95**

**MEANINGFUL PATENT PROTECTION**  
Non-obviousness, **9:77**

**MEANS EXPRESSIONS**  
Claims (this index)  
Reexamination, **4:88**  
Technological scope, **13:114**

**MEANS FOR CLAIM LANGUAGE**  
History, **1:23**

**MECHANICAL ARTS**  
Adequate disclosure, **7:9, 7:24, 7:25**  
Adequate utility, **6:19**  
Claims, **4:65**  
Non-obviousness, **9:76**  
Priority, **8:48**

**MECHANICAL DEVICES**  
Static physical configurations, **5:8**

**MECHANICAL EQUIVALENTS**  
Claims, **4:84, 4:86, 4:92**

**MECHANICAL FIELD**  
Non-obviousness, **9:70**

**MEDICAL AND DIAGNOSTIC PROCEDURES**  
Affected subject matter, medical activity, **20:17**  
Case law, *Pallin v. Singer*, section 287(c) defense, **20:5**  
Defenses, section 287(c) generally, **20:1**  
basic rule, **20:15**  
case law, **20:5**  
definitions, **20:16-20:20**  
effective date, **20:22**  
exceptions, **20:21**  
historical development of section 287(c) defense, below  
patenting medical technology generally, **20:3**  
policy justification, **20:14**

Definitions  
generally, **20:16**  
affected subject matter, **20:17**  
immunized persons, **20:19, 20:20**  
medical activity as affected subject matter, **20:17**  
medical practitioner, immunized person, **20:19**  
related health-care entity, immunized person, **20:20**

Effective date, section 287(c) defense, **20:22**

Historical development of section 287(c) defense  
generally, **20:2-20:13**  
case law, **20:5**  
developments subsequent to Public Law 104-208, **20:13**  
final legislation, **20:12**  
HR 1127, **20:7**  
HR 3610 and HR 4278, **20:11**  
HR 3814, **20:9**  
legislation proposed, **20:7-20:11**  
*Pallin v. Singer*, section 287(c) defense, **20:5**  
patenting medical technology generally, **20:3**  
prior examples, **20:4, 20:5**

**MEDICAL AND DIAGNOSTIC PROCEDURES—Cont'd**  
Historical development of section 287(c) defense—Cont'd  
Public Law 104-208, **20:12**  
responses proposed, **20:6-20:11**  
S 1334, **20:8**  
S 2105, **20:10**  
Justification, section 287(c) defense, **20:14**  
Legislation, section 287(c) defense proposed, **20:7-20:11**  
Public Law 104-208, **20:12**  
subsequent to Public Law 104-208, **20:13**  
Medical activity as affected subject matter, **20:17**  
Medical practitioner, immunized person, **20:19**  
Pallin v. Singer, section 287(c) defense, **20:5**  
Patenting medical technology generally, **20:3**  
Related health-care entity, immunized person, **20:20**  
Statutory subject matter, **5:39**

**MEDICAL DEVICE, EQUIPMENT, OR MACHINE**  
Adequate commerciality, **14:69, 14:71**  
Processes, **5:39**

**MEDICAL INFORMATION**  
Processes, **5:39**

**MEDICAL PROFESSIONALS**  
Processes, **5:39**  
Section 287(c) defense, immunity, **20:19, 20:20**

**MEDICARE PRESCRIPTION DRUG, IMPROVEMENT, AND MODERNIZATION ACT**  
Adequate Commerciality (this index)

**MEDICINE**  
Static physical configurations, **5:18**

**MENTAL ACTS AND MATTERS**  
Adequate disclosure, **7:3**  
Anticipation, Lack Of (this index)

**MENTAL ACTS AND MATTERS**  
—Cont'd  
Inventorship (this index)  
Joint inventorship, **10:29**  
Priority, **8:44**  
Processes, **5:25, 5:27**  
Static physical configurations, **5:10**

**MENTAL STEPS**  
Non-statutory hybrid inventions, **5:55**  
Processes, **5:22**  
Static physical configurations, **5:12**  
Statutory subject matter, **5:6, 5:25-5:27, 5:45**

**MERCK KGAA v. INTEGRA LIFESCIENCES I, LTD.**  
Adequate commerciality, **14:67, 14:73, 14:74**

**MERCOID CORP. v. MID-CONTINENT INV. CO.**  
Indirect infringement, **15:9-15:12, 15:24**  
Misuse of patent, **18:16**

**MERGER DOCTRINE**  
Processes, **5:38**

**METABOLITES**  
Temporal scope, **11:48**

**METALLIZING ENGINEERING CO. v. KENYON BEARING & AUTO PARTS CO.**  
Anticipation, lack of, **8:21**  
Priority, **8:243**

**METHOD CLAIMS AND INVENTIONS**  
Adequate Commerciality (this index)  
Indirect infringement, **15:5**

**METHODS**  
Adequate commerciality, **14:49**  
Claims, **4:80**  
Non-statutory hybrid inventions, **5:80**  
Statutory subject matter, **5:2**

**MILES MEDICAL CO. v. JOHN D. PARK & SONS CO.**  
Express and implied licenses, **19:18**

## INDEX

**MILLER v. BRIDGEPORT BRASS CO.**  
Reissue of patent, **16:42-16:46**

**MINISTERIAL ACTS**  
Processes, **5:25**  
Statutory subject matter, **5:27**

**MISCHIEVOUS**  
Adequate utility, **6:15**

**MISJOINDER**  
Correction of inventorship, **10:57**

**MISLEADING**  
Adequate disclosure, **7:45, 7:48**

**MISTAKE AND ERROR**  
Correction (this index)  
Examination of Original Application (this index)  
Inventorship (this index)  
Joint inventorship, **10:25, 10:45**  
Non-Obviousness (this index)  
Patent and Trademark Office (PTO), **2:16, 2:39**  
Reissue of Patent (this index)  
Static physical configurations, **5:15**  
Technological scope, **13:57, 13:58**

**MISUSE OF PATENT**  
Generally, **18:1 et seq.**  
Actions required of licensee generally, **18:37**  
grant-back clauses, **18:39**  
post-expiration royalties, **18:40**  
royalty based in unpatented subject matter, **18:38**  
tying arrangements, **18:41**  
unpatented subject matter as basis of royalty, **18:38**  
*Bauer & Cie v. O'Donnell*, **18:13**  
*Carbice Corporation of America v. American Patents Development Corporation*, **18:15**  
Case law. Historical development, below  
Commercial field limitations, **18:34**  
Covenant not to deal in competing goods, **18:36**  
Customer limitations, **18:34**

**MISUSE OF PATENT—Cont'd**  
Dawson Chemical Co. v. Rohm and Haas Co., **18:21**  
Discriminatory royalties, **18:31**  
Excessive royalties, **18:30**  
Federal Circuit decisions, **18:22, 18:24**  
Grant-back clauses, **18:39**  
*Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, **18:10**  
*Henry v. A.B. Dick Co.*, **18:11**  
Historical development generally, **1:23**  
case law  
Federal Circuit decisions, **18:22, 18:24**  
pre 1913, **18:3-18:6**  
1913 to 1952, **18:13-18:15**  
1952 to present, **18:20, 18:21**  
Supreme Court decisions prior to 1982, **18:19-18:21**  
Federal Circuit decisions, **18:22, 18:24**  
pre 1913, **18:3-18:6**  
1913 to 1952, **18:12-18:15**  
1952 to present, **18:18-18:24**  
Patent Misuse Reform Act of 1988, **18:23**  
Supreme Court decisions prior to 1982, **18:19-18:21**  
Indirect infringement, **18:4-18:6, 18:8-18:11**  
Industry limitations, **18:34**  
Justification of policy, **18:25**  
Licensee and licensing  
commercial field limitations, **18:34**  
covenant not to deal in competing goods, **18:36**  
customer limitations, **18:34**  
industry limitations, **18:34**  
price fixing, **18:35**  
refusal to license, **18:29**  
resale restrictions, **18:35**  
restrictions on licensee's freedom of action, **18:32-18:36**  
territorial limitations, **18:33**

**MISUSE OF PATENT—Cont'd**

Limitations on licensee's freedom of action. Licensee and licensing, above

Market participation. Refusal of patent owner to participate in market, below

Mercoid Corp. v. Mid-Continent Inv. Co., **18:16**

Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., **18:6**

Motion Picture Patents Co. v. Universal Film Mfg. Co., **18:14**

1952 Patent Act, **18:18**

1988 Patent Misuse Reform Act, **18:23**

Para 271(b), 1952 Patent Act, **18:18**

Para 271(c), 1952 Patent Act, **18:18**

Para 271(d), 1952 Patent Act, **18:18**

Participation in market. Refusal of patent owner to participate in market, below

Patent Act of 1952, **18:18**

Patent Misuse Reform Act of 1988, **18:23**

Patent rights as property, **18:8**

Post-expiration royalties, **18:40**

Price fixing, **18:35**

Refusal of patent owner to participate in market

    generally, **18:27**

    discriminatory royalties, **18:31**

    excessive royalties, **18:30**

    licensing, **18:29**

    royalties, **18:30, 18:31**

    suppression, **18:28**

Resale restrictions, **18:35**

Restrictive covenants in patented inventions, **18:9**

Restrictive licensing, **18:7**

Royalties

    actions required of licensee, **18:38, 18:40**

    refusal of patent owner to participate in market, **18:30, 18:31**

    unpatented subject matter, **18:38**

**MISUSE OF PATENT—Cont'd**

Statutory regulation

    Mercoid Corp. v. Mid-Continent Inv. Co., **18:16**

    para 271(b), 1952 Patent Act, **18:18**

    para 271(c), 1952 Patent Act, **18:18**

    para 271(d), 1952 Patent Act, **18:18**

    Patent Act of 1952, **18:18**

    Patent Misuse Reform Act, **18:23**

Suppression, **18:28**

Supreme Court decisions prior to 1982, **18:19, 18:19-18:21**

Territorial limitations, **18:33**

Tying arrangements, **18:41**

Unpatented subject matter as basis of royalty, **18:38**

Wallace v. Holmes, **18:5**

Zenith Radio Corp. v. Hazeltine Research, Inc., **18:20**

**MITCHELL v. TIGHLMAN**

Anticipation, lack of, **8:27**

**MIXED PURPOSES**

Priority, **8:255**

**MIXED QUESTIONS OF LAW AND FACT**

Claims, **4:14**

**MIXTURES**

Static physical configurations, **5:9, 5:17**

**MODE**

Adequate Disclosure (this index)

**MODELS**

Reissue of patent, **16:39**

**MODIFICATION**

Change and Modification (this index)

**MOLECULAR PHYSICS**

Claims, **4:65**

**MONETARY RELIEF**

Adequate commerciality, **14:78**

## INDEX

**MONOPOLIES**  
History, 1:4, 1:6, 1:7  
Processes, 5:21

**MONOPOLY OF KNOWLEDGE**  
Adequate utility, 6:6, 6:17, 6:19

**MONSANTO CO. v. KAMP**  
Joint inventorship, 10:40

**MOOTNESS**  
Invalidity (this index)

**MORALITY**  
Utility Requirement (this index)

**MORGAN ENVELOPE CO. v. ALBANY PERFORATED WRAPPING PAPER CO.**  
Indirect infringement, 15:6, 15:8  
Misuse of patent, 18:6

**MOTION PICTURE PATENTS CO. v. UNIVERSAL FILM MFG. CO.**  
Indirect infringement, 15:7, 15:8  
Misuse of patent, 18:14

**MOTIVATION**  
Adequate utility, 6:13  
Correction of inventorship, 10:66  
Non-obviousness, 9:66, 9:74  
Policy justification, 1:32  
Priority, 8:71  
Processes, 5:21

**MULTICELLULAR ANIMALS**  
Static physical configurations, 5:8, 5:16

**MULTIPLE CAPABILITIES**  
Adequate commerciality, 14:31

**MULTIPLE CLAIMS**  
Dependent claims, 4:103  
Foreign priority claims, 8:125  
Policy justification and historical development, 4:5  
Single patent, 4:101-4:103

**MULTIPLE DISCLOSURES**  
Non-obviousness, 9:41

**MULTIPLE INVENTIONS**  
Joint inventorship, 10:37

**MULTIPLE INVENTIVE ENTITIES**  
Joint inventorship, 10:44

**MULTIPLE-PARTY CONTESTS**  
Priority, 8:129

**MULTIPLE PERSONS**  
Non-obviousness, 9:58  
Priority, 8:39

**MULTIPLE PRIOR APPLICATIONS**  
Non-obviousness, 9:37

**MULTIPLY DEPENDENT**  
Claims, 4:5

**MUNICIPALITIES**  
History, 1:4

**MUSIC**  
Static physical configurations, 5:11

**MUSICAL DATA**  
Non-statutory hybrid inventions, 5:83

**MUTANTS**  
Static physical configurations, 5:14

**NAFTA**  
Priority, 8:106

**NAME AND MISNAMING**  
Correction (this index)  
Definition of inventor, 10:18  
Inventorship, 10:1  
Joint inventorship, 10:41  
Priority, 8:71

**NAME-BRAND DRUGS**  
Adequate commerciality, 14:63

**NARROWING CLAIMS**  
Reissue of Patent (this index)

**NATIONAL ARCHIVES**  
Patent and Trademark Office (PTO), 2:20

**NATIONAL COURTS**  
Patent and Trademark Office (PTO), 2:11

<b>NATIONAL INSTITUTES OF HEALTH</b> Adequate utility, <b>6:18</b> Claims, <b>4:66</b>	<b>NETWORK PRINTERS</b> Processes, <b>5:24</b>
<b>NATURAL CONTROL</b> Adequate utility, <b>6:5</b>	<b>NEW, CONTROL OF</b> History, <b>1:18</b>
<b>NATURAL LAWS</b> Claims, <b>4:79</b> Justification, <b>1:29</b>	<b>"NEW"</b> Reexamination, substantial new question of patentability, <b>16:130</b>
<b>NATURALLY OCCURRING SUBSTANCES</b> Static physical configurations, <b>5:9, 5:17</b>	<b>NEW AND USEFUL</b> Statutory subject matter, <b>5:2</b>
<b>NATURAL PHENOMENA</b> Non-statutory hybrid inventions, <b>5:78</b> Statutory subject matter, <b>5:24</b>	<b>NEW APPLICATION</b> Static physical configurations, <b>5:8</b>
<b>NATURAL RIGHT</b> Temporal scope, <b>11:17</b>	<b>NEW ARTS</b> History, <b>1:5</b>
<b>NATURAL STATE</b> Processes, <b>5:24</b> Static physical configurations, <b>5:9</b>	<b>NEW CREATION</b> Inventorship, <b>10:4</b>
<b>NATURE, POWER OF</b> Processes, <b>5:21</b>	<b>NEW DEVELOPMENT</b> Non-obviousness, <b>9:77</b>
<b>NATURE, PRODUCTS OF</b> Static physical configurations, <b>5:17</b>	<b>NEW-DRUG APPLICATION (NDA)</b> Adequate Commerciality (this index)
<b>NEAREST PRIOR ART</b> Non-obviousness, <b>9:59</b>	<b>NEW ENTERPRISES</b> History, <b>1:4</b>
<b>NEAREST PRIOR TECHNOLOGY</b> Non-Obviousness (this index)	<b>NEW LIVING ORGANISM</b> Static physical configurations, <b>5:17</b>
<b>NEEDED EXPERIMENTATION</b> Priority, <b>8:54</b>	<b>NEWLY ADDED RIGHTS</b> Reissue of patent, <b>16:112-16:114</b>
<b>NEGATION</b> Defenses, <b>17:6</b>	<b>NEWLY DISCOVERED PROPERTIES</b> Non-obviousness, <b>9:77</b>
<b>NEGATIVE RULES</b> Non-obviousness, <b>9:4, 9:15</b>	<b>NEWLY FOUND SEEDLINGS</b> Static physical configurations, <b>5:14</b>
<b>NEGOTIATIONS</b> History, <b>1:14</b> Inventorship, <b>10:17</b> Policy justification, <b>1:29</b> Statutory subject matter, <b>5:5</b>	<b>NEWLY UNDERSTOOD TECHNICAL DETAILS</b> Non-obviousness, <b>9:77</b>
	<b>NEW MATTER</b> Adequate disclosure, <b>7:1, 7:31</b> Examination of Original Application (this index) History, <b>1:20</b> Reissue of Patent (this index)

## INDEX

### NEW MEDICAL PROCEDURE

Processes, **5:39**

### NEW SONG ENCODED ON PLAYER PIANO ROLL

Static physical configurations, **5:11**

### NEW TECHNOLOGICAL FIELDS

Statutory subject matter, **5:2**

### NEW TRIAL

Indirect infringement, **15:4**

### NEXUS

Non-obviousness, **9:60, 9:61, 9:64**

### NINTH CIRCUIT COURT OF APPEALS

Processes, **5:27**

### “NO-DEFECT” REISSUE PRACTICE

Generally, **16:64**

### NOMENCLATURE

Adequate disclosure, **7:2, 7:37, 7:38**

Non-statutory hybrid inventions, **5:55**

Patent and Trademark Office (PTO),  
**2:25**

Priority, **8:42**

### NONINFRINGEMENT

Avoidance defenses, **17:6**

Common law pleading, **17:7**

Current statute, pleading under,  
**17:12, 17:13**

Defenses, generally, **17:1-17:14**

Federal code, pleading, **17:8**

General pleading theory and current  
statute, **17:2-17:13**

Implied license defense, **19:6**

Modern pleading, **17:8**

Negation defenses, **17:6**

Notice of prior art, **17:14**

Pleading

application to patent statute, **17:9-  
17:13**

common law pleading, **17:7**

current statute, **17:2-17:13**

defenses, generally, **17:4-17:8**

federal code pleading, **17:8**

### NONINFRINGEMENT—Cont’d

Pleading—Cont’d

general pleading theory and cur-  
rent statute, **17:2-17:13**

infringement actions, generally,  
**17:4**

modern pleading, **17:8**

negation vs. avoidance, **17:6**

prior art notice, **17:14**

prior statutes, **17:3, 17:10**

section 282, **17:11**

Prior art notice, **17:14**

Prior statutes, **17:3, 17:10**

Section 282, **17:11**

### NON-JOINDER

Correction of inventorship, **10:57**

### NON-LIMITING RECITATIONS

Anticipation, lack of, **8:14**

### NON-OBVIOUSNESS

Generally, **9:1 et seq.**

Abandonment, **9:28, 9:29, 9:34, 9:39**

Adequacy of applicant’s subjective  
insight, **9:41-9:43**

Adequate disclosure, **7:18**

Adequate suggestion, **9:66**

Adequate utility, **6:7**

Administrative efficiency, **9:14-9:16**

Administrative matters, **9:16**

Admissibility of out-of-court state-  
ments, **9:59**

Admissions, **9:42**

Advance-over-the-art, generally, **9:31**

Advice, **9:66**

Affidavits, **9:25, 9:36, 9:37, 9:73**

Alexander Milburn Co. v. Davis

Bournonville Co., **9:33**

Ambiguity, generally, **9:7**

Amendments

generally, **9:1**

biotechnological process, Section  
103(b), **9:81, 9:85**

secret prior art, **9:41, 9:45**

starting and ending materials, **9:78**

timeliness, Section 102, **9:45, 9:48**

Analogousness, **9:18, 9:19**

Another defined, **9:46, 9:47**

Anticipation, generally, **9:1**

**NON-OBVIOUSNESS—Cont'd**

Appeal and review  
 generally, **9:3**  
 biotechnological process, Section 103(b), **9:85**  
 Court of Customs and Patent Appeals, **9:42, 9:66**  
 determination of obviousness, **9:68**  
 rule 131 affidavits, **9:36**  
 secret prior art, **9:33, 9:41, 9:46**  
 starting and ending materials, **9:79, 9:80**  
 structures accompanied by properties or uses, **9:73**  
 timeliness, Section 102, **9:25**  
 Application  
 prior application, **9:31, 9:38**  
 secret prior art, **9:28, 9:31, 9:36-9:38, 9:43**  
 starting and ending materials, **9:79**  
 timeliness, Section 102, **9:30-9:33**  
 As a whole, **9:1, 9:5, 9:6**  
 Graham v. John Deere, **9:12**  
 Assignment of invention, **9:47**  
 Assignment of rights, **9:46**  
 At time invention was made, **9:21**  
 At time invention was made, **9:21, 9:24, 9:32**  
 Background, **9:17, 9:19, 9:74**  
 Bass, **9:37**  
 Biotechnical processes, Section 103(B)  
 generally, **9:78-9:86**  
 case law developments after 1995, **9:85**  
 construction and interpretation, **9:86**  
 federal circuit authorities prior to 1995, **9:80**  
 historical development, **9:82**  
 older authorities, **9:79**  
 overall effect, **9:84**  
 specific statutory provisions, **9:83**  
 Biotechnological Process Patent Amendment Act of 1995, **9:1, 9:82, 9:83**  
 Board of Useful arts, **9:2**  
 Burden of proof, **9:75**

**NON-OBVIOUSNESS—Cont'd**

Case law  
 Bass, **9:37**  
 biotechnical processes, Section 103(B), **9:85**  
 Foster, **9:26**  
 Graham v. John Deere, **9:6**  
 Hazeltine Research Inc. v. Brenner, **9:33**  
 Hotchkiss v. Greenwood, **9:3**  
 Palmquist, **9:25**  
 Robbins, **9:36**  
 secret prior art, **9:39**  
 Certiorari, **9:33**  
 Change and modification  
 generally, **9:5**  
 determination of obviousness, generally, **9:65-9:69**  
 Graham v. John Deere, **9:14, 9:18, 9:19, 9:50**  
 secondary considerations, **9:57**  
 secret prior art, **9:46**  
 simply changing form or proportion, **9:2**  
 structures accompanied by properties or uses, **9:74, 9:77**  
 timeliness, Section 102, **9:26**  
 Chemical composition, **9:26, 9:72-9:75**  
 Chemical method, **9:77, 9:78**  
 Chemical process, **9:1, 9:36, 9:79, 9:81-9:84**  
 Chemical properties, **9:76**  
 Chemistry, **9:70**  
 Circumstantial evidence  
 generally, **9:6**  
 secondary considerations, **9:54, 9:60-9:64**  
 Claims, **4:2, 4:72, 4:78**  
 Clear and particular, **9:66**  
 Closed list, **9:55**  
 Co-employees, **9:26**  
 Collaboratives  
 groups, generally, **9:46**  
 inventors, **9:28**  
 research, **9:1, 9:47, 9:83**  
 researchers, **9:48**  
 Colorful language, **9:4**

## INDEX

### NON-OBVIOUSNESS—Cont'd

Combinations, 9:3, 9:7, 9:86  
Commercial information, 9:53  
Commercialization, 9:22  
Commercial success, 9:6, 9:51, 9:61-9:64, 9:76  
Common knowledge, 9:43  
Common law, 9:4, 9:5  
Common ownership  
    biotechnological process, Section 103(b), 9:83  
    secret prior art, 9:44, 9:47  
    timeliness, Section 102, below  
Competition, 9:11, 9:47, 9:60  
Compromise for administrative efficiency, 9:14-9:16  
Concealment, 9:28, 9:29, 9:34, 9:39  
Confidentiality, 9:28  
Configurations  
    determination of obviousness, 9:66, 9:67  
    structures accompanied by properties or uses, 9:70, 9:77  
    technological configuration, 9:19  
    timeliness, Section 102, 9:27  
Congress  
    generally, 9:2, 9:5, 9:9  
    biotechnological process, Section 103(b), 9:85  
    Graham v. John Deere, 9:16  
    secret prior art, 9:32, 9:41, 9:45-9:48  
    starting and ending materials, 9:78  
    structures accompanied by properties or uses, 9:73  
    timeliness, Section 102, 9:26  
Consequences, 9:63, 9:64  
Constitutional law, 9:9  
Construction and interpretation, generally, 9:1  
Constructive publication, 9:33  
Content of prior art. Graham v. John Deere, below  
Contracts and agreements, 9:47  
Cooperative research, 9:46  
Cooperative Research and Technology Enhancement Act of 2004, 9:48.1

### NON-OBVIOUSNESS—Cont'd

Copies and copying, 9:51, 9:60  
Copyrights, 9:47  
Corollaries, 9:55  
Corrective provisions, 9:77  
Costs and expenses, 9:10, 9:77, 9:82  
Court of Customs and Patent Appeals (CCPA)  
    biotechnological process, Section 103(b), 9:85, 9:86  
    determination of obviousness, 9:66, 9:68  
    secret prior art, 9:37, 9:42  
    starting and ending materials, 9:79  
    structures accompanied by properties or uses, 9:73  
    timeliness, Section 102, 9:25-9:27  
Courts, generally, 9:5  
Creativity of applicant, 9:43  
Cross-licenses, 9:11  
Customers, 9:62  
Definiteness, lack of, 9:3  
Definition of another, 9:46, 9:47  
Delay, 9:39  
Deliberate, 9:67, 9:68  
Derived from another under Section 102(f), 9:41  
Description as identical, generally, 9:1  
Determination of obviousness  
    Graham v. John Deere, below  
    ordinary skill in the art, generally, 9:65  
Differences between prior art and claimed invention, 9:49  
Disclosure (this index)  
Discovery, 9:9, 9:39, 9:77  
District court, 9:3  
    secret prior art, 9:33  
District courts, 9:33  
District of Columbia, 9:33  
Doctrine of inherent anticipation, 9:77  
Doctrine of lost counts, 9:35, 9:37  
Dominant authority, 9:73  
Double patenting, 9:36, 9:83  
Drawings, 9:42  
Due course, 9:28, 9:29

**NON-OBVIOUSNESS—Cont'd**

Early history, **9:53**  
 Economics, **9:38, 9:39, 9:43**  
 Education level, **9:50**  
 Effective filing date, **9:83**  
 Efficiency, **9:14-9:16**  
 Election, **9:78**  
 Electrical arts, **9:76**  
 Electrical field, **9:70**  
 Employment  
   biotechnological process, Section 103(b), **9:83**  
   collaborative employed researchers, **9:48**  
   collaborative groups of employed inventors, **9:28**  
   joint employment, **9:37**  
   jointly employed inventors, **9:33**  
   researchers, **9:46**  
   secret prior art, **9:28, 9:33, 9:37, 9:46, 9:47**  
   structures accompanied by properties or uses, **9:73**  
   timeliness, Section 102, **9:26**  
 En banc court, **9:85**  
 En banc decision, **9:74**  
 Europe, **9:5**  
 European Patent Convention, **9:38**  
 Evidence, generally, **9:3**  
 Examining Corps, **9:78**  
 Exceed established art, **9:9**  
 Exceeding the art or existing technology, generally, **9:1**  
 Exceptions and exclusions  
   Cooperative Research and Technology Enhancement Act of 2004, **9:48.1**  
   Graham v. John Deere, below  
   structures accompanied by properties or uses, **9:73**  
   timeliness, Section 102, below  
 Exclusive rights, **9:60**  
 Executive Branch, **9:82**  
 Existing public domain, **9:9**  
 Ex parte rejection, **9:37**  
 Ex parte Robbins, **9:36, 9:37**  
 Experience, **9:50**  
 Experiments, **9:67**

**NON-OBVIOUSNESS—Cont'd**

Express instructions or advice, **9:66**  
 Fairness, lack of, **9:28**  
 Federal Circuit  
   biotechnological process, Section 103(b), **9:85**  
   determination of obviousness, **9:66, 9:67**  
   Graham v. John Deere, **9:50**  
   secret prior art, **9:41, 9:48**  
   starting and ending materials, **9:80**  
   structures accompanied by properties or uses, **9:74**  
 Filing application  
   secret prior art, **9:33, 9:38, 9:39, 9:42, 9:48**  
   timeliness, Section 102, **9:22**  
 Filing date of application  
   biotechnological process, Section 103(b), **9:83**  
   Rule 131 affidavits, **9:36**  
   secret prior art, **9:28, 9:32, 9:33, 9:36**  
   timeliness, Section 102, **9:24-9:26**  
 Finding, failure to make, **9:50**  
 First Circuit, **9:60**  
 First-to-file priority, **9:38**  
 Follow-on developments, **9:46**  
 Follow-on patents, **9:11**  
 Foreign Countries (this index)  
 Foster, **9:26**  
 Free access, **9:9**  
 Functional similarity, **9:73**  
 General configuration, **9:67**  
 Graham v. John Deere  
   generally, **9:6, 9:9, 9:12-9:16**  
   compromise for administrative efficiency, **9:14-9:16**  
   content. Scope and content of prior art, below in this group  
   determination of obviousness, **9:65**  
   generally, **9:65-9:69**  
   adequate suggestion, **9:66**  
   inherent anticipation, relation to, **9:69**  
   obvious to try, **9:67**  
   small differences, **9:68**

## INDEX

### NON-OBVIOUSNESS—Cont'd

Graham v. John Deere—Cont'd  
determination of obviousness, 9:65  
—Cont'd  
unpredictable arts and optimization, 9:67  
differences between prior art and claimed invention, 9:12, 9:49  
exceptions and exclusions  
generally, 9:17  
secondary considerations, 9:60  
secret prior art, 9:32, 9:33, 9:37, 9:47  
history, 9:6, 9:15  
ordinarily skilled artisan, 9:50  
ordinary artisan in art, level of skill of, 9:12  
Patent Act of 1952, 9:16  
scope and content of prior art  
generally, 9:12, 9:17-9:48  
analogousness, 9:18, 9:19  
inoperative disclosures, 9:19  
Section 102. Timeliness, Section 102, below  
technological field, relation to, 9:18, 9:19  
timeliness, Section 102, below  
secondary considerations  
generally, 9:12, 9:51-9:64  
commercial success, 9:61-9:64, 9:62  
consequences, 9:63, 9:64  
copying, 9:60  
corollaries, 9:55  
early history, 9:53  
Graham v. John Deere, treatment in, 9:52  
laudatory statements, 9:59  
long-felt need, 9:57  
nexus, 9:64  
simultaneous invention, 9:58  
underlying policy, 9:54, 9:55  
underlying rationale of commercial success, 9:62-9:64  
Section 102. Timeliness, Section 102, below  
simultaneous invention, 9:58  
statements, 9:59

### NON-OBVIOUSNESS—Cont'd

Graham v. John Deere—Cont'd  
structures accompanied by properties or uses, 9:76  
subjectiveness, 9:7  
subsequent developments up to 1952, 9:4  
success, 9:61-9:64, 9:62  
underlying policy, 9:54, 9:55  
underlying rationale of commercial success, 9:62-9:64  
Hass-Henze doctrine, 9:73  
Hazeltine Research Inc. v. Brenner, 9:33, 9:37, 9:38  
Hearsay, 9:59  
History  
generally, 1:22-1:24, 9:2-9:7  
biotechnical processes, Section 103(B), 9:82  
Graham v. John Deere, 9:6, 9:15  
Hotchkiss v. Greenwood, 9:3  
Patent Act of 1952, 9:5, 9:6  
secondary considerations, 9:51, 9:53  
structures accompanied by properties or uses, 9:73  
subjectiveness, 9:7  
subsequent developments up to 1952, 9:4  
Hotchkiss v. Greenwood, 9:3, 9:15  
Hybrid claiming, relation to limits on, 9:77  
Identical description, generally, 9:1  
Improvements, 9:3, 9:59  
Increments, 9:9-9:11, 9:21, 9:31, 9:43  
Inferences, generally, 9:51-9:60  
Inherency  
generally, 9:1  
Graham v. John Deere, 9:69  
structures accompanied by properties or uses, 9:70, 9:72, 9:77  
In light of all the circumstances, 9:58  
In re Albrecht  
structures accompanied by properties or uses, 9:75  
In re Bartfeld  
secret prior art, 9:48

**NON-OBVIOUSNESS—Cont'd**

- In re Bass
  - secret prior art, **9:37, 9:38**
- In re Brouwer
  - biotechnological process, Section 103(b), **9:85**
- In re Dillon
  - structures accompanied by properties or uses, **9:74, 9:76**
- In re Durden
  - biotechnological process, Section 103(b), **9:82, 9:84, 9:85**
  - starting and ending materials, **9:80**
- In re Foster
  - timeliness, Section 102, **9:26, 9:27**
- In re Hass
  - structures accompanied by properties or uses, **9:73**
- In re Henze
  - structures accompanied by properties or uses, **9:73**
- In re Kuehl
  - starting and ending materials, **9:79, 9:80**
- In re Larsen
  - starting and ending materials, **9:79**
- In re Larson
  - biotechnological process, Section 103(b), **9:82, 9:84-9:86**
  - starting and ending materials, **9:80**
- In re Nomiya
  - secret prior art, **9:42**
- In re Ochiai
  - biotechnological process, Section 103(b), **9:85**
- In re Palmquist
  - timeliness, Section 102, **9:25, 9:26**
- In re Papesch
  - structures accompanied by properties or uses, **9:73, 9:76**
- In re Pleudemann
  - biotechnological process, Section 103(b), **9:85**
  - starting and ending materials, **9:80**
- In re Sponnoble
  - determination of obviousness, **9:68**
- In re Wood
  - Graham v. John Deere, **9:18**

**NON-OBVIOUSNESS—Cont'd**

- In re Wright
  - determination of obviousness, **9:66**
  - structures accompanied by properties or uses, **9:74**
- Initial patent, **9:11**
- Inoperative disclosure, **9:19**
- Inspiration, **9:41**
- Instructions, **9:66**
- Instructions to jury, **9:3**
- Intent, **9:46**
- Interference, **9:11, 9:35, 9:36**
- Internal secret prior art, **9:47**
- Inventors, **9:1, 9:48**
- Investigation, **9:6, 9:54, 9:60**
- Issued patents, **9:37**
- Japan, **9:11, 9:42**
- Joint application, **9:36**
- Joint employment, **9:37**
- Joint invention, **9:46**
- Joint inventors, **9:37**
- Joint inventorship, **10:42**
- Jointly employed inventors, **9:33**
- Joint ventures, **9:47**
- Judicial decisions, **9:2**
- Judicial interpretation, **9:4, 9:16**
- Justification
  - policy justification, **9:8-9:11**
  - timeliness, Section 102, below
- Knowledgeable in art, **9:57**
- Laudatory statements, **9:57, 9:59, 9:62**
- Law prior to 1952, **9:31**
- Legislation, **9:5, 9:82**
- Limitations and restrictions, **9:1, 9:9**
  - biotechnological process, Section 103(b), **9:81, 9:84, 9:86**
  - determination of obviousness, **9:66**
  - Graham v. John Deere, **9:18, 9:19**
  - secret prior art, generally, **9:28-9:47**
  - structures accompanied by properties or uses, **9:77**
  - timeliness, Section 102, **9:24**
- Literal language, **9:24, 9:25**
- Logical deliberate act, **9:67**
- Lower court, **9:33**
- Marketplace, **9:54**

## INDEX

### NON-OBVIOUSNESS—Cont'd

Meaningful patent protection, **9:77**  
Mechanical arts, **9:76**  
Mechanical field, **9:70**  
Minor variations, **9:1, 9:2**  
Mistake and error  
    Graham v. John Deere, **9:49**  
    reversible error, **9:7**  
    secondary considerations, **9:51, 9:54, 9:62**  
Motivation, **9:66, 9:74**  
Multiple disclosures, **9:41**  
Multiple persons working independent of each other, **9:58**  
Multiple prior applications, **9:37**  
Nearest prior art, **9:59**  
Nearest prior technology, generally, **9:1**  
Negative rules, **9:4, 9:15**  
New development, **9:77**  
Newly discovered properties, **9:77**  
Newly understood technical details, **9:77**  
Nexus, **9:60, 9:61, 9:64**  
Non-statutory hybrid inventions, **5:53, 5:71, 5:74, 5:84**  
Notice and knowledge  
    generally, **9:9**  
    determination of obviousness, **9:65, 9:67, 9:69**  
    Graham v. John Deere, **9:15, 9:18, 9:21, 9:49**  
    secondary considerations, **9:57**  
    secret prior art, below  
    secret prior art, generally, **9:38-9:43**  
    skill and level of background knowledge in the art, **9:74**  
    structures accompanied by properties or uses, **9:73, 9:74, 9:77**  
    timeliness, Section 102, **9:20, 9:21, 9:27**  
Novelty  
    biotechnological process, Section 103(b), **9:83**  
    Graham v. John Deere, **9:15**  
    starting and ending materials, **9:79**  
    structures accompanied by properties or uses, **9:73, 9:77**

### NON-OBVIOUSNESS—Cont'd

Novelty—Cont'd  
    timeliness, Section 102, **9:23, 9:26**  
Objective considerations, **9:54**  
Obvious to try, **9:67**  
Oddz On Products, Inc. v. Just Toys, Inc., **9:41, 9:43**  
Optimization, **9:67**  
Ordinarily skilled artisan, **9:50**  
Ordinary artisan, **9:54**  
Ordinary artisan, skill of, **9:6, 9:78**  
Ordinary mechanic, **9:15**  
Ordinary mechanic acquainted with business, **9:3**  
Ordinary skill, **9:12, 9:75**  
Ordinary skill in the art, generally, **9:1**  
Out-of-court statements, **9:59**  
Palmquist, **9:25**  
Patentability, generally, **9:1**  
Patent Act amendments of 1984, **9:45**  
Patent Act amendments of 1999 and Section 102(e), **9:48**  
Patent Act of 1790, **9:2**  
Patent Act of 1793, **9:2**  
Patent Act of 1952 (this index)  
Patent and Trademark Office (PTO)  
    biotechnological process, Section 103(b), **9:84, 9:85**  
    determination of obviousness, **9:68**  
    secret prior art, **9:33, 9:35-9:37, 9:42**  
    starting and ending materials, **9:78, 9:80**  
    structures accompanied by properties or uses, **9:73, 9:74**  
    timeliness, Section 102, **9:25**  
Patent-driven inventions, **9:10**  
Pending applications, **9:30, 9:33, 9:36-9:38, 9:42**  
Per curiam, **9:33**  
Per se risks, **9:77**  
Per se structure, **9:77**  
Personal knowledge, **9:43**  
Pipeline justifications. Timeliness, Section 102, below  
Policy justification, **9:8-9:11, 9:27, 9:39**

**NON-OBVIOUSNESS—Cont'd**

Possession, **9:27, 9:39, 9:70, 9:77**  
 Possession in due course, **9:39**  
 Post hoc obligations, **9:47**  
 Precision, lack of, **9:3**  
 Predictability, lack of, **9:3**  
 Preexisting technology, **9:23**  
 Preservation of existing public-domain, Section 102(B). Timeliness, Section 102, below  
 Presumptions, **9:57**  
 Prima facie, properties of chemical compositions, **9:74**  
 Prima facie case, **9:7, 9:72, 9:75**  
 Prima facie showing secondary considerations, **9:61, 9:64**  
 structures accompanied by properties or uses, **9:72, 9:74, 9:76**  
 Printed publication, description in, **9:21**  
 Prior art, see lines throughout this index topic  
 Prior-filed applications under Section 102(e), contents of, **9:30-9:33**  
 Prior Inventive Acts under Section 102(g), **9:34-9:37**  
 Priority, **8:136, 9:38**  
 Prior technology, nearest, generally, **9:1**  
 Private information, **9:46**  
 Privately known information, **9:43**  
 Pro forma, **9:84**  
 Promoting progress, **9:9**  
 Publication  
     constructive publication, **9:33**  
     secret prior art, **9:28, 9:30, 9:38**  
     structures accompanied by properties or uses, **9:73**  
     timeliness, Section 102, **9:21, 9:25, 9:26**  
 Public disclosure, **9:22, 9:42, 9:51**  
 Public domain  
     generally, **9:10**  
     determination of obviousness, **9:65**  
     existing public domain, **9:9**  
     secret prior art, **9:28, 9:29, 9:43**  
     structures accompanied by properties or uses, **9:77**

**NON-OBVIOUSNESS—Cont'd**

Public domain—Cont'd  
     timeliness, Section 102, **9:27**  
 Public events. Timeliness, Section 102, below  
 Public in due course, **9:28, 9:29**  
 Public knowledge, **9:21, 9:38**  
 Publicly available patent, **9:21**  
 Publicly known, **9:39, 9:41**  
 Publicly observable uses, **9:21**  
 Public policy, **9:28**  
 Public possession, **9:77**  
 Public use, **9:39, 9:43**  
 Qualifications  
     secret prior art, generally, **9:37-9:48**  
     timeliness, Section 102, generally, **9:20-9:27**  
 Qualitative advance, **9:16**  
 Qualitative differences, **9:23, 9:62**  
 Qualitative increments, **9:8**  
 Quality of invention, lack of, **9:4**  
 Reasonably pertinent to particular problem, **9:18**  
 Reasons, **9:66**  
 Rebuttal, **9:7, 9:74**  
 Rebuttal showings, **9:75**  
 Recited starting and/or ending materials, **9:1**  
 Reexamination, **9:26**  
 Reference  
     determination of obviousness, **9:66**  
     Graham v. John Deere, **9:19**  
     secret prior art, generally, **9:33-9:48**  
     structures accompanied by properties or uses, **9:73, 9:74**  
     timeliness, Section 102, **9:20, 9:21, 9:26**  
 Rejection of Application (this index)  
 Relevant art, **9:51**  
 Remand, **9:50**  
 Research and development  
     generally, **9:10**  
     biotechnological process, Section 103(b), **9:82**  
 collaborative employed researchers, **9:48**

## INDEX

### NON-OBVIOUSNESS—Cont'd

Research and development—Cont'd  
collaborative research, 9:1, 9:47, 9:83  
employed researchers, 9:46  
Researchers, 9:46, 9:48  
Reversal  
determination of obviousness, 9:68  
secret prior art, 9:36  
structures accompanied by properties or uses, 9:73  
timeliness, Section 102, 9:25, 9:26  
Reversible error, 9:7, 9:51  
Robbins, 9:36  
Rule 131 affidavit, 9:25, 9:36, 9:37  
Sampling, 9:9  
Secondary considerations  
generally, 9:6  
Graham v. John Deere, above  
structures accompanied by properties or uses, 9:76  
Secret prior art  
generally, 9:46, 9:48  
Cooperative Research and Technology Enhancement Act of 2004, 9:48.1  
secondary considerations. Graham v. John Deere, above  
timeliness, Section 102, below  
Section 102, generally, 9:1  
Section 103, generally, 9:1  
Showings, 9:75  
Simply changing form or proportion, 9:2  
Skill  
generally, 9:4  
Graham v. John Deere, 9:15, 9:50  
ordinary artisan's level of skill, 9:6  
starting and ending materials, 9:78  
structures accompanied by properties or uses, 9:74, 9:75  
Small differences, 9:68  
Sophistication of technology, 9:50  
Spontaneous statements, 9:59  
Starting and ending materials  
generally, 9:1  
biotechnical processes, Section 103(B), above

### NON-OBVIOUSNESS—Cont'd

State of mind, 9:43, 9:59  
State of the art, 9:28, 9:38, 9:58  
Static physical configurations, 5:9, 5:12, 5:16  
Statutory subject matter, 5:1  
Structural similarities, 9:73, 9:74  
Structures accompanied by properties or uses  
generally, 9:70-9:77  
chemical compositions, properties of, 9:72-9:75  
historical development, properties of chemical compositions, 9:73  
hybrid claiming, relation to limits on, 9:77  
prima facie, properties of chemical compositions, 9:74  
rebuttal showings, properties of chemical compositions, 9:75  
unexpected results, 9:76  
Subjective creativity, 9:20  
Subjective insight, 9:41-9:43  
Subjective judgments, 9:54  
Subjective state of mind, 9:43  
Substantial logic, 9:43  
Suggestion, 9:66, 9:77  
Superior property or advantage, 9:75  
Suppression, 9:28, 9:29, 9:34, 9:39  
Supreme Court  
generally, 9:3, 9:6  
Graham v. John Deere, 9:49, 9:50  
secondary considerations, 9:52, 9:53  
secret prior art, 9:33, 9:37  
supreme court assignment of interpretation, 9:1  
Technical community, 9:54  
Technical details, 9:77  
Technical disclosures, 9:54  
Technological configuration, 9:19, 9:65, 9:77  
Technological field, 9:17-9:19  
Technological scope, 13:81, 13:82  
Tests and experiments  
generally, 9:3  
determination of obviousness, 9:67

**NON-OBVIOUSNESS—Cont'd**

Tests and experiments—Cont'd  
 Graham v. John Deere, **9:14, 9:16**  
 structures accompanied by properties or uses, **9:74**  
 timeliness, Section 102, **9:23**  
 Third parties, **9:59**  
 Third persons, **9:28, 9:29, 9:40, 9:41**  
 Timeliness, Section 102  
 generally, **9:20-9:48**  
 at time invention was made, **9:21**  
 common ownership. Secret prior art, below in this group  
 exceptions for common ownership. Secret prior art, below in this group  
 justifications. Secret prior art, below in this group  
 law prior to 1952, **9:31**  
 pipeline justifications. Secret prior art, below in this group  
 preservation of existing public-domain, Section 102(B)  
 generally, **9:22-9:27**  
 Foster, **9:26**  
 law prior to 1952, **9:23**  
 Palmquist, **9:25**  
 Patent Act of 1952, **9:24-9:26**  
 policy justification, **9:27**  
 public events, generally, **9:22-9:27**  
 public events. Preservation of existing public-domain, Section 102(B), above in this group  
 public knowledge under Section 102(A), **9:21**  
 secret prior art  
 generally, **9:28-9:48**  
 adequacy of applicant's subjective insight, **9:41-9:43**  
 admissions, **9:42**  
 Bass, **9:37**  
 common ownership, exceptions for, generally, **9:44-9:48**  
 derived from another under Section 102(f), **9:41**  
 early law, Prior Inventive Acts under Section 102(g), **9:35**

**NON-OBVIOUSNESS—Cont'd**

Timeliness, Section 102—Cont'd  
 secret prior art—Cont'd  
 examples, Section 103(c), **9:47**  
 exceptions for common ownership, generally, **9:44-9:48**  
 foreign systems, contract with, **9:38**  
 Hazeltine Research Inc. v. Brenner, **9:33**  
 law prior to 1952, **9:31**  
 Patent Act of 1952, **9:32, 9:33**  
 patent law amendments of 1984, **9:45**  
 patent law amendments of 1999 and Section 102(e), **9:48**  
 pipeline justifications, generally, **9:29-9:39**  
 policy justification, **9:39**  
 policy rationale, **9:43**  
 prior-filed applications under Section 102(e), contents of, **9:30-9:33**  
 Prior Inventive Acts under Section 102(g), **9:34-9:37**  
 Robbins, **9:36**  
 Section 103(c), generally, **9:44-9:48**  
 title and ownership, exceptions for common ownership, generally, **9:44-9:48**  
 underlying policy, **9:46**  
 title and ownership. Secret prior art, above in this group  
 Time-wise priority, **9:38**  
 Timing, **9:17**  
 Title and ownership  
 generally, **9:3, 9:5**  
 common ownership  
 biotechnological process, Section 103(b), **9:83**  
 secret prior art, **9:44, 9:47**  
 timeliness, Section 102, **9:20**  
 secondary considerations, **9:64**  
 secret prior art, **9:44, 9:46, 9:47**  
 timeliness, Section 102, above  
 Torpharm, Inc. v. Ranbaxy Pharmaceuticals, Inc., **9:85**  
 Trial court, generally, **9:3**

## INDEX

**NON-OBVIOUSNESS—Cont'd**  
Underlying policy, **9:46**  
Undue delay, **9:39**  
Unexpected properties, **9:77**  
Unexpected results, **9:76**  
Universities, **9:47**  
Unpredictable arts and optimization, **9:67**  
Useful arts, **9:9**  
Usefulness, **9:2**  
Useful property, **9:77**  
Uses. Structures accompanied by properties or uses, above  
Validity  
generally, **9:3, 9:9**  
biotechnological process, Section 103(b), **9:83**  
secondary considerations, **9:59, 9:60**  
secret prior art, **9:37**  
structures accompanied by properties or uses, **9:72**  
timeliness, Section 102, **9:23**  
Verdict, **9:3**  
Worst case scenario, **9:65**  
Written acts and matters, **9:2**

**NON-PROFIT ENTITY**  
Prior inventor, prior-user rights, **22:22**

**NONSPECIALIST DISTRICT COURT**  
Claims, **4:6**

**NON-STATUTORY HYBRID INVENTIONS**  
Generally, **5:1, 5:47-5:85**  
Abele v., **5:76**  
Abstract idea, **5:78**  
Administrative decisions, **5:81**  
Administrative law, **5:59, 5:83**  
Advance, **5:71**  
Aggregation of elements, invention as, **5:51**  
Alappat v., **5:76**  
Algorithm, **5:80**  
Anticipation, **5:53, 5:74, 5:84**  
Anticipation (Section 102), **5:71**  
Apparatus vs. method, **5:80**

**NON-STATUTORY HYBRID INVENTIONS—Cont'd**  
Appeal and review  
Board of Patent Appeals and Interferences, **5:83**  
Court of Customs and Patent Appeals (CCPA), **5:68, 5:76**  
current law, **5:53, 5:81**  
history, **5:70, 5:72, 5:75**  
Application of technology, generally, **5:47-5:85**  
Applied technology, **5:61**  
Art-based inquiry, **5:63**  
As a whole, **5:48, 5:56**  
Binary classification, **5:58**  
Blue-pencil rule  
generally, **5:67-5:72**  
current law, generally, **5:78-5:85**  
documentation, lack of, **5:72**  
historical development, **5:68**  
nontrivial, statutory element as, **5:70**  
Sections 102 and 103, **5:71**  
Board of Patent Appeals and Interferences, **5:83**  
Bona fides, **5:74**  
Bubble hierarchies, **5:78**  
Business method, **5:80**  
Calculated quantity, **5:83**  
Calculational steps, **5:81**  
Case law, **5:53**  
Change and modification, **5:68, 5:81**  
Claimed inventions, generally, **5:48**  
Clarity, **5:80**  
Collections of smaller, included elements, **5:50**  
Combinations  
generally, **5:50, 5:51**  
calculational steps, **5:81**  
elements, **5:68, 5:76**  
statutory and non-statutory elements, **5:52**  
Commissioner of Patents, **5:83**  
Common law, **5:59**  
Compilations, **5:55**  
Computers, **5:54, 5:78**  
Considered per se, **5:84**

**NON-STATUTORY HYBRID INVENTIONS—Cont'd**

Construction and interpretation, **5:59, 5:80**  
 Contribution to discovery, **5:61**  
 Court decisions, **5:83**  
 Court of Customs and Patent Appeals (CCPA), **5:74, 5:76**  
 Courts, generally, **5:54**  
 Current law, generally, **5:76-5:83**  
 Data per se, **5:69**  
 Data structure, **5:78**  
 Decisions, **5:73-5:75**  
 Definitions, **5:55, 5:76**  
 Detailed rule, implementation of, **5:64**  
 Diagramming patent claims, **5:55**  
*Diamond v. Diehr*, **5:73-5:75, 5:84, 5:85**  
 Director of Patents, **5:83**  
 Disclosure, **5:80**  
 Discovery, **5:61**  
 Discretionary standard, **5:49**  
 Discretion of examiners, **5:64**  
 Discretion of individual decision maker, **5:64**  
 Documentation, lack of, **5:72**  
 Doing business, **5:78**  
 Economically significant, **5:84**  
 Economic importance, **5:83**  
 Elements per se, **5:74**  
 En banc decision, **5:76**  
 Examination, **5:69, 5:85**  
 Examiners, **5:48, 5:64, 5:68**  
 Examining corps, **5:56, 5:72, 5:83**  
 Expectation of enhanced profits, **5:61**  
 Factual data, **5:55**  
 Federal Circuit  
     generally, **5:76-5:83**  
     apparatus vs. method, **5:80**  
     computer-related examples, **5:78**  
     *In re Warmerdam*, **5:78**  
     non-computer related inventions, **5:82**  
     process requirements and information technologies, **5:81**  
     State Street Bank, **5:79**  
 Financial data, **5:83**

**NON-STATUTORY HYBRID INVENTIONS—Cont'd**

Freeman-Walter-Abele test, **5:81**  
 Fundamental issue of binary classification, **5:58**  
 History, **5:65-5:75**  
 Hybrids, **5:81**  
 Incentives, **5:61, 5:74**  
 Information technologies, **5:81**  
*In re Abele*, **5:81**  
*In re Alappat*, **5:76, 5:85**  
*In re Durden*, **5:84**  
*In re Freeman*, **5:76, 5:81**  
*In re Smith*, **5:84**  
*In re Walter*, **5:81**  
*In re Warmerdam*, **5:78**  
 Interferences, **5:83**  
 Issuance of patent, **5:63**  
 Judgments, **5:85**  
 Judicial decisions, **5:81, 5:83**  
 Legislation, **5:83**  
 Limitations and restrictions  
     current laws, **5:76, 5:78**  
     history, **5:70, 5:74**  
     policy objections, **5:63, 5:64**  
     section 102, **5:84**  
     section 103, **5:84**  
     standards vs. rules, **5:49**  
 Manipulative steps, **5:55**  
 Manual of Patent Examining Procedure (MPEP), Section 2106, **5:83**  
 Manufacture, articles of, **5:55**  
 Mathematical algorithm, **5:78, 5:81**  
 Mathematical calculations, **5:55, 5:78**  
 Mathematical formula, **5:74, 5:76**  
 Mental steps, **5:55**  
 Method, apparatus vs., **5:80**  
 Musical data, **5:83**  
 Natural phenomena, **5:78**  
 Nomenclature convention, **5:55**  
 Non-computer related inventions, **5:82**  
 Non-obviousness, Section 103, **5:53, 5:71, 5:74, 5:84**  
 Nontrivial, statutory element as, **5:70**  
 Notice and knowledge, **5:62, 5:72, 5:74**

## INDEX

**NON-STATUTORY HYBRID INVENTIONS—Cont'd**

Novelty (this index)  
Numerical calculations, **5:81, 5:82**  
Official statements, **5:83**  
Overall policy objectives, **5:60-5:64**  
Parker v. Flook, **5:74, 5:85**  
Patentability, generally, **5:50**  
Patent and Trademark Office (PTO), generally, **5:53**  
Peripheral claiming, **5:50**  
Peripheral claims, **5:55**  
Peripherally claimed, **5:52**  
Per se statutory subject matter, **5:69**  
Physical manipulations, **5:78, 5:81**  
Physical structure, **5:53**  
Physical transformation, **5:81**  
Poem per se, **5:62**  
Point of novelty, **5:66**  
Policy judgments, **5:85**  
Policy objectives, generally, **5:56-5:66**  
Possibly patentable, **5:84**  
Practical importance, **5:57**  
Predictability, **5:64**  
Preemption, **5:75, 5:81**  
Printed matter, **5:55, 5:82**  
Prior art, **5:63, 5:72**  
Prior knowledge, **5:62, 5:74**  
Prior state of the art, absence of inquiry into, **5:62**  
Process requirements and information technologies, **5:81**  
Profits, **5:61**  
Programmed computer, **5:78**  
Proper placement of non-statutory adjudication, **5:63**  
Qualifications, **5:74**  
Rejection of application  
    current law, **5:53, 5:80**  
    history, **5:75**  
    policy objectives, **5:57, 5:63**  
Research and development, **5:61**  
Robotic environment, **5:78**  
Rules, standards vs., **5:49, 5:50**  
Scholarship notes, **5:49**  
Section 101, generally, **5:47-5:85**  
Section 102, generally, **5:53-5:85**

**NON-STATUTORY HYBRID INVENTIONS—Cont'd**

Section 103, generally, **5:48-5:85**  
Specification, **5:80**  
Standards vs. rules, **5:49, 5:50**  
Stare decisis, **5:75, 5:76**  
State of the art, **5:62, 5:69, 5:85**  
State Street Bank & Trust Co. v. Signature Financial Group, Inc., **5:79**  
Statutory provision, **5:59**  
Statutory steps, **5:81**  
Subcombinations per se, **5:50**  
Subjective outlook, **5:49**  
Subsequent developments, generally, **5:76-5:83**  
Supervisory procedure, **5:83**  
Supreme Court, **5:53, 5:72, 5:73-5:75, 5:83-5:85**  
Supreme Court decisions, **5:73-5:75**  
Tests, **5:64, 5:74, 5:78, 5:81**  
Textual data, **5:83**  
37 CFR, **5:83**  
Training materials, **5:83**  
Transferring funds, **5:83**  
Trial court, **5:78**  
Uniformity, **5:64**  
Validity, **5:76**  
Value, **5:49**  
Viewed per se, **5:83**  
Walter v., **5:76**

## NON-STATUTORY SUBJECT MATTER

Generally, **5:1, 5:3**  
Computer-related inventions, **5:41, 5:44, 5:45**  
Non-Statutory Hybrid Inventions (this index)  
Processes (this index)  
Static physical configurations, **5:10, 5:11, 5:17**

## NONTRIVIAL STATUTORY ELEMENT

Non-statutory hybrid inventions, **5:70**

## NOT BEFORE KNOWN OR USED

History, **1:18**

**NOTICE AND KNOWLEDGE**  
Adequate commerciality, **14:14, 14:53, 14:61, 14:76**  
Anticipation, Lack Of (this index)  
Claims (this index)  
Correction of inventorship, **10:68**  
Disclosure (this index)  
Examination of Original Application (this index)  
History, **1:18, 1:19**  
Indirect infringement, **15:15, 15:20, 15:24**  
Inventorship, **10:12**  
Joint Inventorship (this index)  
Noninfringement defenses, **17:14**  
Non-obviousness (this index)  
Non-statutory hybrid inventions, **5:62, 5:72, 5:74**  
Patent and Trademark Office (PTO), generally, **2:13**  
Policy justification, **1:28, 1:35, 1:38, 1:39**  
Priority (this index)  
Processes, **5:21, 5:24**  
Technological configuration, **9:71**  
Technological scope, **13:54, 13:75, 13:76**  
Utility Requirement (this index)

**NOVELTY**  
Abandonment, **8:268**  
Anticipation, Lack Of (this index)  
Blue-pencil rule, **5:67-5:72, 5:71**  
Claims, **4:72**  
Correction, **10:59, 10:68**  
Diamond v. Diehr, **5:75**  
Examination of Original Application (this index)  
History, **1:19**  
Inventorship, **10:14**  
Non-obviousness  
biotechnological process, Section 103(b), **9:83**  
Graham v. John Deere, **9:15**  
starting and ending materials, **9:79**  
structures accompanied by properties or uses, **9:73, 9:77**  
timeliness, Section 102, **9:23, 9:26**  
Non-statutory hybrid inventions, **5:66**

**NOVELTY—Cont'd**  
Parker v. Flook, **5:73, 5:74**  
Policy justification, **1:29**  
Priority (this index)  
Processes, **5:21**  
Static physical configurations, **5:14**  
Technological scope, **13:90**

**NOXIOUS BEHAVIOR**  
Adequate utility, **6:5, 6:15**

**NOXIOUS OR OTHERWISE HARMFUL**  
Adequate utility, **6:15**

**NTP, INC. v. RESEARCH IN MOTION, LTD.**  
Adequate commerciality, **14:28**

**NULLITY**  
Processes, **5:24**

**NUMERICAL CALCULATIONS**  
Non-statutory hybrid inventions, **5:81, 5:82**  
Processes, **5:30**

**NUMERICAL CONSTRUCT**  
Processes, **5:23**

**OATH**  
Adequate disclosure, **7:28**  
Joint inventorship, **10:40**  
Reissue of patent, **16:108**

**OBJECTION**  
Claims, **4:2**  
Joint inventorship, **10:49**  
Processes, **5:26, 5:29**

**OBJECTIONABLE**  
Claims, **4:66**

**OBJECTIONABLE PER SE**  
Claims, **4:5**

**OBJECTIVE CIRCUMSTANCES**  
Priority, **8:254**

**OBJECTIVE CONSIDERATIONS**  
Non-obviousness, **9:54**

**OBSERVATIONS**  
Statutory subject matter, **5:36-5:38**

## INDEX

**OBVIOUSNESS**  
Non-Obviousness (this index)

**ODDZ ON PRODUCTS, INC. v. JUST TOYS, INC.**  
Non-obviousness, **9:41, 9:43**

**OFFENSIVE INVENTION**  
Priority, **8:53, 8:108**

**OFFENSIVE USES**  
Priority, **8:118**

**OFFER FOR SALE**  
Adequate Commerciality (this index)  
Geographic scope, **12:19-12:21**  
Indirect Infringement (this index)

**OFFERS**  
Priority, **8:228**

**OFFICE OF ENROLLMENT AND DISCIPLINE (OED)**  
Generally, **2:22**

**OFFICE OF LEGISLATIVE AND INTERNATIONAL AFFAIRS (OLIA)**  
Generally, **2:22**

**OFFICE OF THE SOLICITOR**  
Patent and Trademark Office (PTO),  
**2:22**

**OFFICERS**  
Patent and Trademark Office (PTO),  
**2:22**

**OFFICIAL GAZETTE**  
Generally, **2:20, 2:24, 2:27, 2:28**

**OFFICIAL NOTICES**  
Patent and Trademark Office (PTO),  
**2:24**

**OFFICIAL PRONOUNCEMENTS**  
History, **1:1**

**OFFICIAL STATEMENTS**  
Non-statutory hybrid inventions, **5:83**

**OLIVER EVANS**  
Patent and Trademark Office (PTO),  
**2:4**

**OMISSIONS**  
Correction (this index)  
Inventorship, **10:12**  
Joint inventorship, **10:19**

**ONGOING LICENSE NEGOTIATIONS**  
Laches, unreasonable delay, **23:32**

**ON SALE**  
Anticipation, lack of, **8:20**  
Priority (this index)

**ONSET OF PERIOD**  
Laches, unreasonable delay, **23:25-23:35**

**OPEN COMMUNICATIONS**  
History, **1:1**

**OPEN FORMATS**  
Claims, **4:98**

**OPEN LETTERS (LITTERAE PATENTES)**  
History, **1:1**

**OPEN SOVEREIGN LETTERS**  
History, **1:1**

**OPERABILITY**  
Utility Requirement (this index)

**OPERATIONAL COSTS**  
Policy justification, **1:31**

**OPERATION OF LAW**  
Inventorship (this index)

**OPERATIVE DISCLOSURE**  
Adequate disclosure, **7:18**

**OPERATIVE MEANS**  
Adequate utility, **7:2**

**OPERATIVE METHOD**  
Adequate disclosure, **7:1, 7:13**

**OPTIMIZATION**  
Non-obviousness, **9:67**

**ORAL HEARING**  
Patent and Trademark Office (PTO),  
**2:28**

**ORAL STATEMENTS**  
Priority, **8:71**

**ORAL TESTIMONY**  
Priority, **8:74**

**ORDER**  
Invalidity (this index)  
Patent and Trademark Office (PTO),  
**2:7, 2:26**  
Processes, **5:39**  
Utility requirement, **6:15**

**ORDERS OF COMMISSIONER**  
Patent and Trademark Office (PTO),  
**2:26**

**ORDINARY ARTISAN**  
Joint inventorship, **10:31**  
Non-obviousness, **9:6, 9:54, 9:78**

**ORDINARY COURSE OF PROSECUTION**  
Anticipation, lack of, **8:22**

**ORDINARY MECHANIC**  
Non-obviousness, **9:15**

**ORDINARY MECHANIC ACQUAINTED WITH BUSINESS**  
Non-obviousness, **9:3**

**ORDINARY PERSONALITY**  
Priority, **8:39**

**ORDINARY PURCHASER**  
Designs, **5:46**

**ORDINARY SKILL**  
Adequate disclosure, **7:52**  
Adequate utility, **7:9, 7:18**  
Anticipation, lack of, **8:29, 8:31**  
History, **1:23**  
Non-obviousness, **9:12, 9:75**  
Non-Obviousness (this index)  
Priority, **8:58**

**O'REILLY v. MORSE**  
Claims, **4:9**  
Processes, **5:24**

**O'REILLY v. MORSEILLY v. MORSE**  
Reissue of patent, **16:27**

**ORGANISMS, GENE SEQUENCING**  
Adequate utility, **7:14**

**ORIGINAL APPLICANT**  
Joint inventorship, **10:34**

**ORIGINAL APPLICATION**  
Adequate disclosure, **7:56**  
Anticipation, lack of, **8:22**  
Examination of Original Applications  
(this index)  
Joint inventorship, **10:45**

**ORIGINAL FILING DATE**  
Adequate disclosure, **7:29, 7:31, 7:42**

**ORIGINAL INVENTIVE ENTITY**  
Correction of inventorship, **10:60**

**ORIGINAL INVENTOR**  
History, **1:18**  
Inventorship, **10:7, 10:9, 10:10**  
Joint inventorship, **10:19**

**ORIGINALITY**  
Anticipation, Lack Of (this index)

**ORIGINALLY NAMED INVENTOR**  
Correction of inventorship, **10:60**

**ORIGINAL RIGHTS**  
Reissue of patent, **16:111**

**ORNAMENTAL EXTERIOR APPEARANCE OF ARTICLE OF MANUFACTURE**  
Designs, **5:46**

**OUTER SPACE**  
Geographic scope, **12:9, 12:14**

**OUTGOING TRANSACTIONS**  
Geographic Scope of Infringement  
(this index)

**OUT-OF-COURT STATEMENTS**  
Non-obviousness, **9:59**

**OUTSIDE SOURCES**  
Anticipation, lack of, **8:30-8:32**

## INDEX

### OVER-BREADTH

Adequate disclosure, **7:24**

### OWNERSHIP

Title and Ownership (this index)

### PAGE v. FERRY

Adequate utility, **7:45, 7:48**

### PAINTING

Static physical configurations, **5:8**

### PALLIN v. SINGER

Medical and diagnostic procedures,  
section 287(c) defense, **20:5**

### PALMQUIST

Non-obviousness, **9:25**

### PANAMA

Adequate utility, **7:18**

### PANNU v. IOLAB

Joint inventorship, **10:33**

### PAPER ACCOUNTING FORMS

Processes, **5:38**

### PAPER CONVERTING MACHINE CO. v. MAGNA-GRAPHICS CORP.

Adequate Commerciality (this index)

### PARALLEL IMPORTATION

Defenses, implied-in-law licenses,  
**19:44**

### PARALLEL PROSECUTION

Reexamination, stay of proceedings,  
**16:131**

### PARALLEL STRUCTURE

History, **1:11**

### PAREDEN v. TERMINAL RAILWAY OF ALABAMA STATE DOCKS DEPT.

History, **1:14**

### PARENT APPLICATION

Examination of Original Application  
(this index)

Joint inventorship, **10:46**

### PARIS CONVENTION

Prior inventor, prior-user rights, **22:8-22:10**

### PARKER v. FLOOK

Non-statutory hybrid inventions,  
**5:74, 5:85**

### PARKER & WHIPPLE CO. v. YALE CLOCK CO.

Reissue of patent, **16:89**

### PARLIAMENT

History, **1:4**  
Patent and Trademark Office (PTO),  
**2:7**

### PAROL EVIDENCE

Reissue of patent, **16:33, 16:34**

### PARTIAL ACTS AND MATTERS

Closed formats, **4:98**  
Continuation in part, **8:147**

### PARTIALLY CLOSED CLAIM FORMAT

Claims, **4:98**

### PARTICIPANTS AND PARTICIPATION

Correction of inventorship, **10:60**  
Joint inventorship, **10:28-10:30**  
Patent and Trademark Office (PTO),  
**2:12, 2:13, 2:18**  
Processes, **5:30**

### PARTIES

Correction of inventorship, **10:61**  
Priority, **8:129, 8:232, 8:256**

### PARTNERSHIPS

Inventorship, **10:14**

### PATENTABILITY

Anticipation, Lack Of (this index)  
Claims, **4:62, 4:67, 4:70, 4:72**  
Computer-related inventions, **5:53**  
Examination of Original Application  
(this index)  
History, **1:18, 1:19, 1:24**  
Inventorship, **10:7**  
Joint inventorship, **10:42**  
Non-Obviousness (this index)

**PATENTABILITY—Cont'd**

Non-Statutory Hybrid Inventions  
(this index)  
Patent and Trademark Office (PTO)  
(this index)  
Policy Justification (this index)  
Priority, **8:97**  
Processes, **5:22, 5:25, 5:36**  
Static Physical Configurations (this  
index)  
Statutory subject matter, **5:4**  
Substantial new question of patent-  
ability. Reexamination (this  
index)

**PATENTABLE PER SE**

Claims, **4:76**

**PATENT ACT**

Adequate Commerciality (this index)

**PATENT ACT AMENDMENT OF  
1982**

Correction of inventorship, **10:59,**  
**10:63**

**PATENT ACT AMENDMENT OF  
1984**

Joint inventorship, **10:38**

**PATENT ACT OF 1790**

Adequate disclosure, **7:45**  
Anticipation, lack of, **8:1**  
History, **1:18**  
Judicial review of US Patent and  
Trademark Office (PTO) deci-  
sions, **2:31**  
Non-obviousness, **9:2**  
Patent and Trademark Office (PTO),  
**2:7, 2:15, 2:16, 2:20**  
Priority, **8:209**  
Processes, **5:21**  
Statutory subject matter, **5:2**  
Utility requirement, **6:1**

**PATENT ACT OF 1793**

Adequate commerciality, **14:32**  
Adequate disclosure, **7:45**  
History, **1:18, 1:19**  
Judicial review of PTO decisions,  
**2:31**  
Non-obviousness, **9:2**

**PATENT ACT OF 1793—Cont'd**

Patent and Trademark Office (PTO),  
**2:17, 2:25**  
Priority, **8:202, 8:209**  
Registration, **2:16**  
Static physical configurations, **5:8,**  
**5:9**  
Statutory subject matter, **5:2**  
Utility requirement, **6:1**

**PATENT ACT OF 1832**

Adequate disclosure, **7:31**  
Reissue of patent, **16:7**

**PATENT ACT OF 1836**

Adequate commerciality, **14:4, 14:5**  
Adequate disclosure, **7:45**  
Adequate utility, **6:1**  
Anticipation, lack of, **8:1**  
Claims, **4:2, 4:94**  
Examination, **2:17**  
History, **1:19, 1:20**  
Judicial review of PTO decisions,  
**2:32**  
Patent and Trademark Office (PTO),  
**2:18, 2:20**  
Priority, **8:64, 8:203, 8:209**  
Reissue of Patent (this index)  
Statutory subject matter, **5:2**

**PATENT ACT OF 1839**

History, **1:19, 1:20**  
Inventorship, **10:14**  
Judicial review PTO decisions, **2:33**  
Priority, **8:210, 8:249**

**PATENT ACT OF 1863**

Patent and Trademark Office (PTO),  
**2:34**

**PATENT ACT OF 1870**

Adequate commerciality, **14:4**  
Adequate utility, **6:1**  
Claims, **4:94**  
Geographic scope, **12:5**  
History, **1:15, 1:21**  
Patent and Trademark Office (PTO),  
**2:18**  
Priority, **8:206**  
Reissue of patent, **16:9, 16:36**  
Statutory subject matter, **5:2**

## INDEX

### **PATENT ACT OF 1897**

Laches, Section 6, **23:9**  
Six-year limitation, **21:7**

### **PATENT ACT OF 1927**

Judicial review of PTO decisions, **2:35**

### **PATENT ACT OF 1939**

Priority, **8:212**

### **PATENT ACT OF 1946**

Laches, **23:12**

### **PATENT ACT OF 1952**

Adequate commerciality, **14:5, 14:42**

Adequate disclosure, **7:45**

Claims, **4:5, 4:87, 4:93**

Correction, **10:57, 10:64**

Geographic scope, **12:6-12:9**

History, **1:23, 1:24, 4:87**

Indirect infringement, **15:2, 15:10, 15:11**

Non-Obviousness (this index)

Patent and Trademark Office (PTO), **2:36**

Priority, **8:63**

Processes, **5:30**

Reissue of patent, **1:23, 16:91**

Six-year limitation, **21:11**

Static physical configurations, **5:14**

Statutory subject matter, **5:2, 5:6**

Technological scope, **13:19**

### **PATENT ACT OF 1977**

Adequate commerciality, **14:35, 14:49**

### **PATENT ACT OF 1980**

Reissue of patent, reexamination, **16:65**

### **PATENT ACT OF 1984**

Joint inventorship, **10:27**

### **PATENT AND TRADEMARK OFFICE (PTO)**

Generally, **2:19-2:28**

Adequate disclosure. Disclosure, below

Adequate utility. Utility requirement, below

### **PATENT AND TRADEMARK**

#### **OFFICE (PTO)—Cont'd**

Ad hoc process, **2:31**

Administrative law, generally, **2:7**

Administrative opposition, **2:18**

Administrative patent judges, **2:22**

Administrative post-grant proceedings, **2:10**

Administrative Procedure Act (APA), **2:21, 2:26, 2:28, 2:41 et seq.**

Advice, **2:22**

Advisory Committee, **2:22**

Agency action, **2:43**

Agents, **2:22**

Allocations, **2:22**

Ambiguity, **2:40**

Amendment of statutes, **2:18**

Annual Report to Congress, **2:20**

Anticipation, **2:3**

Anticipation, lack of, **8:14, 8:21**

Appeal and Review (this index)

Applications (this index)

Appointment to office, **2:22**

Article I, **2:1**

Articles of Confederation, **2:4**

Assistant Commissioners, **2:22**

Assistant Judge of Circuit Court, **2:33**

Assistant Secretary of Commerce, **2:22**

Attorney General, **2:15, 2:20**

Attorneys, **2:22**

Board of Examiners, **2:32, 2:33**

Board of Patent Appeals and Interferences (BPAI) (this index)

Burden of determining entitlement, **2:13**

Case law, **2:20, 2:26, 2:28**

Case-specific nature of substantial evidence standard, **2:43**

Certiorari, **2:34**

Challenges, **2:15**

Change and Modification (this index)

Chevron U.S.A., Inc. v. Natural Resources Defense Council, **2:48**

Chief Clerk, **2:20**

Chief Justice, **2:33**

**PATENT AND TRADEMARK OFFICE (PTO)—Cont'd**

Chief Justice of District Court of District of Columbia, **2:33**  
 Circuit Courts, **2:33**  
 Civil actions, **2:7, 2:38**  
 Claims (this index)  
 Clerk of Department of State, **2:20**  
 Codified rules, **2:25**  
 Commissioner, generally, **2:7**  
 Commissioner for Patents, **2:20, 2:22**  
 Commissioner for Trademarks, **2:22**  
 Commissioner in United States  
     District Court for District of Columbia, **2:38**  
 Commission for the Promotion of the Useful Arts, **2:15**  
 Commission of Useful Arts, **2:31**  
 Commission on the Useful Arts, **2:20**  
 Common law, **2:6, 2:13, 2:43**  
 Complaints, **2:22**  
 Computer-related inventions, **5:44**  
 Configuration, **2:1**  
 Congress  
     generally, **2:1, 2:37**  
     Annual Report to Congress, **2:20**  
     Continental Congress, **2:4**  
     Manual of Patent Examining Procedure (MPEP), **2:26**  
     Serial Set of Congressional Documents, **2:4**  
 Consent, **2:22**  
 Consolidated notices, **2:27**  
 Consolidation in federal circuit, **2:37**  
 Constitutional law, **2:1, 2:4, 2:21, 2:44**  
 Construction and Interpretation (this index)  
 Continental Congress, **2:4**  
 Contracts and agreements, **2:13**  
 Copyright, **2:29**  
 Correction of inventorship, **10:58-10:61, 10:64**  
 Costs and expenses, **2:13, 2:22**  
 Court of Appeals for Federal Circuit, **2:37, 2:38, 2:43**  
 Court of Customs and Patent Appeals (CCPA) (this index)

**PATENT AND TRADEMARK OFFICE (PTO)—Cont'd**

Court proceeding, generally, **2:28**  
 Daughters of Confederacy, **2:4**  
 Decisions, review of. Judicial Review (this index)  
 Declaratory Judgments Act of 1934, **2:18**  
 Declaratory relief, **2:18**  
 Defenses, **2:7, 2:17**  
 Delay, **2:13**  
 Demands, **2:22**  
 De novo, **2:18**  
 De novo review on appeal, **2:39**  
 Department of Agriculture, **2:20**  
 Department of Interior, **2:20**  
 Department of State, **2:16, 2:20, 2:31**  
 Deputy Commissioner, **2:22**  
 Deputy Director, **2:22**  
 Designs, **5:46**  
 Determination, **2:7, 2:34**  
 Dickenson v. Zurko, **2:43**  
 Dickinson v. Zurko, **2:43**  
 Director of Patent and Trademarks, **2:7**  
 Directors, **2:22**  
 Disclosure  
     adequate disclosure, generally, **2:3**  
     administration of initial grant, **2:13**  
     background knowledge, **7:18, 7:19**  
     claimed configuration, **7:8, 7:9**  
     description requirements, **7:28, 7:29**  
     history, **7:5**  
     how to use, **7:14**  
     range of embodiment, **7:25**  
     time frame, **7:21, 7:22**  
 Disseminating official notices, **2:20**  
 District Court (this index)  
 Election, **2:35**  
 Employment, **2:22**  
 En banc, **2:36, 2:43**  
 Enforcement, **2:7, 2:13, 2:21**  
 English, **2:1, 2:4, 2:7, 2:16**  
 Entitlement, **2:13**  
 European Patent Convention (EPC), **2:11, 2:13**  
 European Patent Office, **2:11**

## INDEX

**PATENT AND TRADEMARK OFFICE (PTO)—Cont'd**  
Evidence, **2:28, 2:39, 2:43**  
Examination (this index)  
Examination of Application (this index)  
Examination of Original Application (this index)  
Examiners, **2:22**  
Examiners-in-Chief, **2:22**  
Examining Clerk, **2:20**  
Examining corps, **2:22**  
Exclusive power, **2:7**  
Exclusive rights, **2:1**  
Executive Branch, generally, **2:3**  
Ex parte  
    generally, **2:13, 2:17, 2:18**  
    determination, **2:29, 2:34**  
    examination, **2:12, 2:18, 2:38**  
    nature, **2:6**  
Experiment, **2:2**  
Experts, **2:37, 2:39**  
Fact, determinations of, **2:43**  
Fact finding, **2:39**  
Factual determination, **2:19**  
Federal Circuit  
    administration of initial grant, **2:18**  
    consolidation, **2:37**  
    Court of Customs and Patent Appeals (CCPA) for Federal Circuit, **2:21**  
    reexamination, **2:10**  
    standard of review, **2:43**  
Federal Register, **2:27, 2:28**  
Federal Rules of Appellate Procedure (FRAP), **2:39**  
Federal Rules of Civil Procedure (FRCP), **2:38, 2:39**  
Federal Rules of Evidence (FRE), **2:38, 2:39**  
Federal trademark registration, **2:20**  
Filing Applications (this index)  
Filing petition, **2:33**  
Filing suit, **2:7**  
Final determination, **2:7, 2:29**  
First Congress, **2:4**  
Foreign countries, **2:1, 2:11, 2:13, 2:22**

**PATENT AND TRADEMARK OFFICE (PTO)—Cont'd**  
Formal rulemaking, **2:28**  
France, **2:13**  
Fraud, **2:16**  
General supremacy of judiciary, **2:8**  
Handling applications, generally, **2:1**  
Hearings, **2:21, 2:28**  
History, generally, **1:17**  
Hybrid claim presentations and nonlimiting recitations, **4:78**  
Informal rulemaking, **2:28**  
Infringement  
In pari materia, **2:3**  
In re Zurko, **2:43**  
Initial application, **2:13**  
Initial examination, **2:10**  
Initial examination of application, **2:22**  
Instructions of Commissioner, **2:26**  
Intellectual Property and Communications Omnibus Reform Act of 1999, **2:22**  
Intent, **2:20, 2:48**  
Interested third parties, **2:13**  
Interference (this index)  
Internal procedures, **2:1**  
Internal structures, **2:19, 2:22**  
International affairs, **2:13, 2:22**  
Inter partes configuration, **2:13**  
Inter partes proceeding, **2:11**  
Interpretive rules, **2:28, 2:48, 2:51**  
Inventorship, **10:7, 10:8**  
Investigation, **2:22**  
Issuance of Patent (this index)  
Joint inventorship, **10:38, 10:40, 10:46**  
Judges, **2:22**  
Judicial Acts and Matters (this index)  
Judicial Review (this index)  
Jurisdiction, **2:36, 2:37**  
Legislative rules, **2:45**  
Licenses and permits, **2:13, 2:21**  
Limitation of actions, **2:1**  
Limitations and restrictions  
    generally, **2:1, 2:21**  
    administration of initial grant, **2:18**  
    judicial review, **2:26, 2:38**

**PATENT AND TRADEMARK  
OFFICE (PTO)—Cont'd**

Limitations and restrictions—Cont'd  
judicial v. executive authority, 2:7  
Manual of Patent Examining Procedure (MPEP), 2:26  
Local rules, 2:39  
Manual of Patent Examining Procedure (MPEP), 2:24, 2:26, 2:28  
Means expressions, 4:93  
Mistake and error, 2:16, 2:39  
National Archives, 2:20  
National courts, 2:11  
Nomenclature, 2:25  
Non-Statutory Hybrid Inventions (this index)  
Notice and Knowledge (this index)  
Office of Enrollment and Discipline (OED), 2:22  
Office of Legislative and International Affairs (OLIA), 2:22  
Office of the Solicitor, 2:22  
Officers, 2:22  
Official Gazette, 2:20, 2:24, 2:27, 2:28  
Official notices, 2:24  
Oliver Evans, 2:4  
Oral hearings, 2:28  
Orders, 2:7, 2:26  
Orders of Commissioner, 2:26  
Parliament, 2:7  
Participation, 2:12, 2:13, 2:18  
Patentability, generally, 2:8  
Patent Act of 1790, 2:7, 2:15, 2:16, 2:20, 2:31  
Patent Act of 1793, 2:17, 2:25, 2:31  
Patent Act of 1836, 2:18, 2:20, 2:32  
Patent Act of 1839, 2:33  
Patent Act of 1863, 2:34  
Patent Act of 1870, 2:18  
Patent Act of 1927, 2:35  
Patent Act of 1952, 2:36  
Patent and Trademark Office Efficiency Act, 2:22  
Patent Bureau, 2:20  
Patent Department, 2:25

**PATENT AND TRADEMARK  
OFFICE (PTO)—Cont'd**

Patent Rules of Practice of Title 37, 2:26  
Payment, 2:22  
Pending Applications (this index)  
Petitions, 2:4, 2:33  
Policy Justification (this index)  
President, 2:22  
Prior inventor, 2:16  
Priority, 8:75  
Private act, 2:2, 2:4  
Private action, 2:18  
Private corporations, 2:22  
Private parties, 2:17  
Processes (this index)  
Prosecution of complaints, 2:22  
Public Advisory Committees, 2:22  
Publication, 2:20, 2:24  
Public domain, 2:4  
Public participation, 2:13  
Reexamination, 2:18, 2:26  
Reforms of 1870, 2:34  
Regional circuit courts, 2:37  
Registration  
generally, 2:2  
administration of initial grant, 2:16, 2:17  
Federal trademark registration, 2:20  
history, 2:20  
internal structures and personnel, 2:22  
judicial review, 2:31  
permits, 2:13  
Rehearings, 2:22  
Rehearing sua sponte, 2:22  
Rejection of Application (this index)  
Report of Decisions of Commissioner of Patents, 2:20  
Reprints, 2:27  
Revisions, 2:28  
Revocation, 2:8, 2:21  
Rule-making activities, generally, 2:23-2:28  
Rules of Practice in Patent Cases, 2:25  
Scire facias, 2:16

## INDEX

**PATENT AND TRADEMARK OFFICE (PTO)—Cont'd**  
Secretary of Commerce, 2:22  
Secretary of State, 2:15, 2:20  
Secretary of War, 2:15, 2:20  
Section 101, 2:7  
Section 102, 2:7  
Section 103, 2:7  
Section 112, 2:7  
Section 131, 2:7, 2:22  
Section 132, 2:22  
Section 141, 2:38  
Section 145, 2:38  
Section 281, 2:7  
Section 282, 2:7  
Section 303, 2:10  
Senate, 2:22  
Senior Executive Service, 2:22  
Serial Set of Congressional Documents, 2:4  
Sources of rule, 2:24-2:27  
Special acts, 2:2  
Static physical configurations, 5:9, 5:11, 5:14-5:17  
Statutory subject matter, 2:3, 5:2  
Sua sponte patents, 2:10  
Subject matter jurisdiction, 2:37  
Substantial evidence, 2:39, 2:43  
Substantive rule-making, 2:21  
Superintendent of Patents, 2:20, 2:31  
Supreme Court, 2:34, 2:43, 2:48  
Supreme Court of District of Columbia (SCDC), 2:34, 2:36  
Term, 2:22  
Third parties, 2:12, 2:13, 2:18  
Third-party participation, 2:13  
35 USCA, generally, 2:3  
37 CFR, 2:25, 2:27, 2:28  
Time and date, 2:1  
37 CFR, 2:24  
Under Secretary of Commerce for Intellectual Property, 2:22  
Useful arts, 2:15, 2:20  
Utility requirement  
    history, 6:4, 6:6  
    operability, 6:10, 6:13, 6:14  
Validity, generally, 2:7  
Vice President, 2:22

**PATENT AND TRADEMARK OFFICE (PTO)—Cont'd**  
Weight of evidence, 2:39

**PATENT AND TRADEMARK OFFICE EFFICIENCY ACT**  
Generally, 2:22

**PATENT AND TRADEMARK OFFICE (PTO) JUDICIAL REVIEW**  
Determinations of law, generally, 2:44 et seq.

**PATENT BUREAU**  
Patent and Trademark Office (PTO), 2:20

**PATENT CLAIMS**  
Claims (this index)

**PATENT COOPERATION TREATY**  
Claims, 4:103  
Priority, 8:154

**PATENT DEPARTMENT**  
Patent and Trademark Office (PTO), 2:25

**PATENT DEPARTMENT OF DEPARTMENT OF STATE**  
Claims, 4:2  
History, 1:18

**PATENT DOCUMENT**  
History, 1:1

**PATENT-DRIVEN INVENTIONS**  
Non-obviousness, 9:10

**PATENTED**  
Defined, 8:278  
Priority, 8:224

**PATENT INSTRUMENT**  
History, 1:1

**PATENT LAW AMENDMENTS ACT OF 1984**  
Adequate commerciality, 14:24  
Geographic scope, 12:29

**PATENT LAW JUDGES**  
Claims, 4:63

**PATENT LAW TREATY**

Prior inventor, prior-user rights,  
**22:12**

**PATENT MISUSE REFORM ACT  
OF 1988**

Indirect infringement, **15:13**

**PATENT REMEDY ACT**

History, **1:14**

**PATIENT PRIVACY**

Processes, **5:39**

**PAULIK v. RIZKALLA**

Priority, **8:130**

**PAYMENT**

Examination of Original Application  
(this index)

Inventorship, **10:14**

Patent and Trademark Office (PTO),  
**2:22**

**PEERLESS ROLL LEAF CO. v. H.  
GRIFFIN & SONS**

Anticipation, lack of, **8:21**

**PENDING APPLICATIONS**

Adequate disclosure, **7:1, 7:18, 7:19,  
7:28**

Correction (this index)

Examination of Original Application  
(this index)

Non-obviousness, **9:30-9:33, 9:36-  
9:38, 9:42**

Patent and Trademark Office (PTO),  
generally, **2:13**

Priority, **8:69**

**PENDING CIVIL ACTION**

Adequate commerciality, **14:80**

**PENDING CLAIMS**

Generally, **4:1**

**PENNOCK v. DIALOGUE**

Priority, **8:203**

**PER CURIAM**

Non-obviousness, **9:33**

**PERFECTION**

Inventorship, **10:8, 10:11**

**PERFECTION—Cont'd**

Joint inventorship, **10:26**

**PERFORMANCE**

Adequate commerciality, **14:36**

Geographic scope, **12:25**

Inventorship, **10:11**

Priority, **8:57**

Processes, **5:25, 5:26, 5:30**

Static physical configurations, **5:8**

Statutory subject matter, **5:1**

**PERIPHERAL CLAIMING**

Claims (this index)

**PERISHABLES**

Indirect infringement, **15:6**

**PERJURY**

Priority, **8:69**

**PERSONAL JURISDICTION**

Adequate commerciality, **14:47**

**PERSONAL KNOWLEDGE**

Non-obviousness, **9:43**

Priority, **8:35, 8:37**

**PERSONAL PROPERTY**

Inventorship, **10:7**

Prohibition of restraints on chattel,  
implied license defense, **19:31**

**PERSONS ACTING IN CONCERT**

Indirect infringement, **15:14**

**PERTINENT ART**

Adequate utility, **6:3**

**PETERS v. HANGER**

Six-year limitation, **21:9**

**PETITION**

Adequate disclosure, **7:9**

History, **1:5**

Patent and Trademark Office (PTO),  
**2:4, 2:33**

Static physical configurations, **5:17**

**PFAFF v. WELLS ELECTRONICS**

Priority, **8:234**

## INDEX

**PFIZER v. INTERNATIONAL RECTIFIER**  
Adequate commerciality, 14:63

**PHARMACEUTICAL ARTS**  
Anticipation, lack of, 8:29  
Processes, 5:39

**PHARMACEUTICALS**  
Adequate Commerciality (this index)  
Indirect infringement, 15:18

**PHILLIPS v. AWH**  
Claims, 4:39

**PHILOSOPHICAL GRATIFICATION**  
Adequate commerciality, 14:63

**PHILOSOPHICAL INQUIRY**  
Adequate commerciality, 14:12

**PHYSICAL ASPECTS**  
Anticipation, Lack Of (this index)

**PHYSICAL CONFIGURATIONS**  
Generally, 9:71

**PHYSICAL CONSTRUCTION**  
Priority, 8:59

**PHYSICAL EMBODIMENT**  
Priority, 8:44

**PHYSICAL MANIPULATIONS**  
Non-statutory hybrid inventions,  
5:78, 5:81

**PHYSICAL OBJECTS**  
Processes, 5:19, 5:30

**PHYSICAL PROXIMITY**  
Static physical configurations, 5:9

**PHYSICAL STRUCTURE**  
Generally, 5:6  
Adequate utility, 7:14  
Non-statutory hybrid inventions, 5:53

**PHYSICAL TRANSFORMATION**  
Generally, 5:37, 5:53  
Computer-related inventions, 5:53  
Non-statutory hybrid inventions, 5:81  
Processes, 5:23, 5:26

**PHYSICIANS**  
Processes, 5:39

**PHYSICS**  
Claims, 4:65

**PIONEER HI-BRED V J.E.G. AG SUPPLY**  
Static physical configurations, 5:15  
Statutory subject matter, 5:15

**PIONEER INVENTIONS**  
Technological scope, 13:74

**PIPELINE JUSTIFICATIONS**  
Non-Obviousness (this index)

**PITTS v. HALL**  
Joint inventorship, 10:49, 10:50

**PLANT BREEDING**  
Static physical configurations, 5:15

**PLANT PATENT ACT (PPA)**  
Static physical configurations, 5:13,  
5:15, 5:17

**PLANTS**  
Generally, 5:13-5:15  
Sexually reproduced plants, 5:8

**PLANT VARIETY PROTECTION ACT**  
Static physical configurations, 5:13

**PLEADING**  
Defenses (this index)

**PLEUDEMANN**  
Claims, 4:78, 4:80

**POEM PER SE**  
Non-statutory hybrid inventions, 5:62

**POETIC LICENSE**  
Adequate utility, 7:14

**POLICY DISCUSSIONS**  
Priority, 8:158

**POLICY JUDGMENTS**  
Indirect infringement, 15:23  
Non-statutory hybrid inventions, 5:85

**POLICY JUSTIFICATION**  
Generally, 1:27-1:43

**POLICY JUSTIFICATION—Cont'd**

Adequate Commerciality (this index)  
 Adequate disclosure, 7:4  
 Adequate price, 1:38  
 Anticipation, lack of, 8:18, 8:21, 8:26-8:28  
 Applications, 1:38  
 Bilateral contract analogy, 1:38  
 Claims (this index)  
 Commercialization and commercial exploitation, 1:38, 1:39, 1:41  
 Competition, 1:32, 1:38, 1:39, 1:43  
 Congress, 1:31  
 Consumers, 1:33  
 Contracts and agreements, 1:38, 1:39  
 Copyright, 1:29  
 Correction, 10:59  
 Costs and expenses, 1:30, 1:31, 1:42  
 Decreased supply, 1:33  
 Demand, 1:33  
 Disclosure (this index)  
 Discretion, economic, generally, 1:30-1:43  
 Disseminating knowledge, 1:38  
 Duplicate research, 1:42  
 Economic discretion, generally, 1:30-1:43  
 Employment, 1:34  
 Enforcement, 1:31  
 Equipment, 1:34, 1:39  
 Estoppel, 24:20-24:20  
 Europe, 1:43  
 Exclusivity, 1:38  
 Expectations, 1:37, 1:39  
 Far East, 1:43  
 Federal judiciary, 1:31  
 Foreign countries, 1:29, 1:32, 1:43, 8:274  
 Funds, 1:34  
 Future invention activity, decreased rate of, 1:35  
 Future research, 1:42  
 Geographic scope, 12:10  
 Incentives, 1:35, 1:39, 1:41  
 Indirect infringement, 15:14  
 Infringement, 1:29, 1:38  
 Innovation, 1:40, 1:41  
 International trade, 1:29

**POLICY JUSTIFICATION—Cont'd**

Inventorship, 10:2-10:4  
 Japan, 1:43  
 Judiciary, federal judiciary, 1:31  
 Laches, 23:21  
 Lateral contracts, 1:38  
 Licenses and permits, 1:31  
 Limitations and restrictions, 1:32, 1:39, 1:43  
 Lockean theory, 1:29  
 Motivation, 1:32  
 Natural law, 1:29  
 Negotiations, 1:29  
 Non-obviousness, 9:8-9:11, 9:27, 9:39  
 Notice and knowledge, 1:28, 1:35, 1:38, 1:39  
 Novelty, 1:29  
 Operational costs, 1:31  
 Orderly control of economic prospects, 1:42  
 Patentability, generally, 1:39  
 Patent and Trademark Office (PTO), generally, 1:31  
 Possession, 1:28  
 Predictability, 1:42  
 Price, 1:38  
 Prior inventor, prior-user rights, 22:17  
 Priority (this index)  
 Private entities, 1:39  
 Processes, 5:26, 5:29  
 Profits, 1:34, 1:39, 1:41  
 Property, invention as form of, 1:28  
 Prospects, 1:40, 1:42  
 Public, generally, 1:27  
 Public funds, 1:39  
 Public knowledge, 1:38  
 Raw materials, 1:39  
 Reissue of Patent (this index)  
 Research and development, 1:39, 1:41, 1:42  
 Saleable product, 1:41  
 Scarcity, 1:34  
 Secrecy, 1:38  
 Single-source control, impact of, 1:32  
 Six-year limitation, 21:16

## INDEX

**POLICY JUSTIFICATION—Cont'd**

- Social benefits of patenting
  - generally, **1:37-1:43**
  - bilateral contract analogy, **1:38**
  - disclosure, exchange of control for, **1:38**
  - incentive to innovate, **1:41**
  - incentive to invent, **1:39**
  - innovation, **1:40, 1:41**
  - orderly control of economic prospects, **1:42**
  - prospects, **1:40, 1:42**
  - unilateral contract analogy, **1:39**
- Social costs of patenting
  - generally, **1:31-1:36**
  - decreased supply, **1:33**
  - future invention activity, decreased rate of, **1:35**
  - overall balance, **1:36**
  - resource scarcity, **1:34**
  - single-source control, impact of, **1:32**
  - Specification, **1:38**
  - Statutory Subject Matter (this index)
  - Supply, decreased, **1:33**
- Supreme Court, **1:29**
- Technological Scope of Infringement (this index)
- Temporal Scope of Infringement (this index)
- Temporary National Emergency Committee (TNEC), **1:29**
- Third parties, **1:29**
- Title and ownership, **1:28**
- Trade secrets, **1:38**
- Unilateral contract analogy, **1:39**
- Utility Requirement (this index)
- Value, **1:39**

**POLITICAL INTEREST**

- Static physical configurations, **5:15**

**POLITICAL JUSTIFICATIONS**

- Joint inventorship, **10:25**

**POLLEN v. FORD INSTRUMENTS CO.**

- Six-year limitation, **21:10**

**POSSESSION**

- Adequate commerciality, **14:32, 14:41**
- Anticipation, lack of, **8:10, 8:18-8:20, 8:30**
- Disclosure (this index)
- Inventorship, **10:4**
- Non-obviousness, **9:27, 9:39, 9:70, 9:77**
- Policy justification, **1:28**
- Priority (this index)
- Static physical configurations, **5:7**

**POSSESSION IN DUE COURSE**

- Non-obviousness, **9:39**

**POSSIBLY PATENTABLE**

- Non-statutory hybrid inventions, **5:84**

**POST-EXPIRATION ROYALTIES**

- Misuse of patent, **18:40**

**POST-GRANT REVIEW**

- Processes, **5:35**

**POST HOC OBLIGATIONS**

- Joint inventorship, **10:32**
- Non-obviousness, **9:47**

**POTENTIAL CONFLICTS**

- Anticipation, lack of, **8:29**

**POTENTIAL INTERPRETATIONS**

- Priority, **8:151**

**POTENTIALLY DANGEROUS PRODUCTS OR SUBSTANCES**

- Adequate utility, **6:12**

**POTENTIAL USES**

- Utility requirement, **6:19**

**POVERTY**

- Laches, unreasonable delay, **23:33**

**POWDERS**

- Static physical configurations, **5:9**

**PRACTICAL APPLICATION**

- Processes, **5:21**

**PRACTICAL UTILITY**

- Generally, **6:16-6:19**
- Adequate utility, **6:19**

**PRACTICAL UTILITY—Cont'd**

Anticipation, lack of, **8:22**  
Claims, **4:66**  
Priority, **8:50, 8:51**

**PRACTICING PATENT COMMUNITY**

Claims, **4:89**

**PRAGMATIC MEANINGS**

Claims, **4:55-4:57**

**PREAMBLE**

Claims, **4:96, 4:99**

**PRECISION, LACK OF**

Non-obviousness, **9:3**

**PRECLUSION OF ISSUE**

Claims, **4:20**  
Invalidity (this index)

**PREDICTABILITY**

Adequate disclosure, **7:20, 7:23, 7:25, 7:26**  
Non-obviousness, **9:3**  
Non-statutory hybrid inventions, **5:64**  
Policy justification, **1:42**  
Priority, **8:54**

**PREEMPTION**

History, **1:13**  
Non-statutory hybrid inventions, **5:75, 5:81**  
State competition laws, **1:13.10**

**PREJUDICE**

Estoppel, material prejudice, **24:29**

**PRELIMINARY INJUNCTION**

Adequate commerciality, **14:31**

**PRE-MARKET REGULATORY APPROVAL**

Adequate Commerciality (this index)

**PREPONDERANCE OF EVIDENCE**

Priority, **8:68, 8:69**

**PRESERVATION OF EXISTING PUBLIC-DOMAIN**

Non-Obviousness (this index)

**PRESERVATION OF RIGHTS OF PARTIES**

Inventorship, **10:8**

**PRESIDENT**

Patent and Trademark Office (PTO),  
**2:22**

**PRESUMPTIONS**

Adequate disclosure, **7:43**  
Adequate utility, **6:14**  
Claims, **4:89**  
Geographic scope, **12:42**  
Non-obviousness, **9:57**  
Priority, **8:109**  
Validity, **17:16-17:18**

**PRICE**

Adequate Commerciality (this index)  
Indirect infringement, **15:6**  
Policy justification, **1:38**  
Processes, **5:39**

**PRICE CONTROL**

History, **1:3**

**PRICE FIXING**

Misuse of patent, **18:35**

**PRIMA FACIE CASE**

Claims, **4:93**  
Non-obviousness, **9:7, 9:72, 9:74, 9:75**

**PRIMA FACIE SHOWING**

Non-obviousness, **9:64, 9:72, 9:74, 9:76**

**PRINTED**

Defined, **8:177**

**PRINTED MATTER**

Claims, **4:79**  
Computer-related inventions, **5:41**  
Non-statutory hybrid inventions, **5:55, 5:82**  
Static physical configurations, **5:7**  
Statutory subject matter, **5:4, 5:6, 5:10-5:12, 5:42**

**PRINTED PUBLICATION**

Adequate disclosure, **7:18**  
Anticipation, lack of, **8:19**

## INDEX

### **PRINTED PUBLICATION—Cont'd**

Non-obviousness, **9:21**

Priority (this index)

### **PRINTERS**

Processes, **5:24**

### **PRINTING**

Processes, **5:29**

### **PRIOR ACTS AND MATTERS**

Adequate disclosure, **7:18, 7:22**

Adequate utility, **6:7**

Anticipation, Lack Of (this index)

Inventorship, **10:14, 10:18**

Joint inventorship, **10:25, 10:42**

Non-Obviousness (this index)

Non-statutory hybrid inventions, **5:62, 5:74**

Patent and Trademark Office (PTO), **2:16**

Priority (this index)

Section 273 defense. Prior Inventor, Prior-User Rights (this index)

Static physical configurations, **5:17**

### **PRIOR ART**

Adequate disclosure, **7:20**

Anticipation, lack of, **8:7, 8:24**

Claims, **4:93**

Computer-related inventions, **5:42**

Correction of inventorship, **10:67**

Invalidity, **17:14**

Joint inventorship, **10:33, 10:38, 10:40, 10:46**

Noninfringement, **17:14**

Non-Obviousness (this index)

Non-statutory hybrid inventions, **5:63, 5:72**

Processes, **5:30**

Technological Scope of Infringement (this index)

### **PRIOR INVENTOR, PRIOR-USER RIGHTS**

Generally, **22:1-22:26**

Amendments to Paris Convention, **22:10**

American Inventors Protection Act of 1999, **22:15**

Basic rule of law, **22:18**

### **PRIOR INVENTOR, PRIOR-USER RIGHTS—Cont'd**

Case law decisions, prior-user rights in United States, **22:16**

Commercial use defined, **22:21, 22:22**

Defenses, section 273

generally, **22:1**

basic rule, **22:18**

definitions, **22:19-22:23**

extension by exhaustion, **22:26**

historical development of section 273 defense, below

limitation to particular uses, **22:25**

policy justification, **22:17**

scope of defense, **22:24-22:26**

Definitions

commercial use, **22:21, 22:22**

defenses, section 273, **22:19-22:23**

effective filing date, **22:23**

limitation to business methods, **22:20**

non-profit entity, commercial use by, **22:22**

section 273 defense, **22:19-22:23**

Domestic prior-user rights

generally, **22:13**

American Inventors Protection Act of 1999, **22:15**

case law decisions, **22:16**

historical development of section 273 defense, **22:13-22:16**

prior inventor defense, **22:15**

proposed legislation, 1992-1997, **22:14**

Effective filing date, defined, **22:23**

1883 text of Paris Convention, **22:9**

Extension by exhaustion, **22:26**

First-to-file, correction, **22:4**

GATT/TRIPs, **22:11**

Historical development of section 273 defense

generally, **22:2**

prior-user rights, generally, **22:3, 22:6**

prior-user rights internationally, **22:7-22:12**

prior-user rights in United States, **22:13-22:16**

## PRIOR INVENTOR, PRIOR-USER RIGHTS—Cont'd

International prior-user rights generally, **22:7**  
 amendments to Paris Convention, **22:10**  
 1883 text of Paris Convention, **22:9**  
 GATT/TRIPs, **22:11**  
 historical development of section 273 defense, **22:7-22:12**  
 Paris Convention, **22:8-22:10**  
 Patent Law Treaty, **22:12**  
 Justification of policy, **22:17**  
 Limitation of defense to particular uses, **22:25**  
 Limitation to business methods, defined, **22:20**  
 Non-profit entity, commercial use by, defined, **22:22**  
 Paris Convention, **22:8-22:10**  
 Patent Law Treaty, **22:12**  
 Policy justification, **22:17**  
 Prior inventor defense in United States, **22:15**  
 Prior-user rights, section 273 defense generally, **22:3-22:6**  
 domestic prior-user rights, above first-to-file, correction, **22:4**  
 historical development of defense, **22:3-22:16**  
 internationally, **22:7-22:12**  
 international prior-user rights, above protectionism, **22:5**  
 shelter for trade secret user, **22:6**  
 United States, **22:13-22:16**  
 Proposed United States legislation, 1992-1997, **22:14**  
 Protectionism, **22:5**  
 Scope of section 273 defense, **22:24-22:26**  
 Shelter for trade secret user, **22:6**  
 United States. Domestic prior user rights, above

## PRIORITY

Generally, **8:33-8:198**

## PRIORITY—Cont'd

Abandonment conceptual inconsistencies, **8:94**  
 description in previously filed patent, paragraph 102(e), **8:143**  
 first-to-invent priority, Section 102(g), below novelty in relation to filing date of application, Paragraph 102(b), **8:204, 8:210**  
 public possession prior to patentee's date of invention, paragraph 102(a), **8:168, 8:189**  
 Absolute novelty. Novelty, Paragraph 102(b), below  
 Accidental discovery, **8:44**  
 Actual reduction to practice, impact on, **8:96**  
 Adams v. Edwards, **8:44**  
 Added subject matter, **8:147**  
 Adequate diligence, **8:78**  
 Adequate disclosure generally, **8:48**  
 description requirements, **7:27, 7:38**  
 time-wise priority, **7:5**  
 Adequate evidence of experimentation, **8:260**  
 Adequate justification, **8:67**  
 Administrative justification, **8:192**  
 Affidavits under Rule 131. Date of invention in paragraphs 102(a) and (e), below  
 Alexander Milburn Co. v. Davis-Bournonville Co., **8:140**  
 All-elements rule, **8:57**  
 Amended foreign application, **8:124**  
 American Standard, Inc. v. Pfizer Inc., **8:66**  
 Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., **8:45**  
 Analogy to obviousness standard under section 103, **8:136**  
 Andrews v. Hovey, **8:206, 8:251**  
 Anticipation, Lack Of (this index)  
 Appeal and review, **8:46, 8:60**

## INDEX

### PRIORITY—Cont'd

Application  
conceptual inconsistencies, **8:94, 8:124, 8:126**  
description in previously filed patent, paragraph 102(e), below  
novelty, Paragraph 102(b), below  
public possession prior to patentee's date of invention, paragraph 102(a), **8:162, 8:168**  
Appreciation, **8:46, 8:58**  
Bain v. Morse, **8:101, 8:197**  
Beyond a reasonable doubt, **8:68, 8:69**  
Bigham v. Godtfredsen, **8:66**  
Biotechnology, **8:50**  
Board of Appeals, **8:46**  
Board of Patent Interferences, **8:66**  
Brenner v. Manson, **8:50, 8:53, 8:57**  
Case law, **8:56, 8:63**  
Charge to jury, **8:44**  
Chemical structure, **8:46**  
Chemical subject matter, **8:48**  
Chemistry, **8:50**  
Circumstantial evidence. Public possession prior to patentee's date of invention, paragraph 102(a), below  
City of Elizabeth v. Nicholson Pavement Co., **8:250**  
Civil cases, **8:68**  
Claimed invention, **8:253**  
Claim language, relation to, **8:47-8:49, 8:57**  
Claims (this index)  
Classical abandonment, **8:85**  
Coleman v. Dines, **8:45**  
Combination, **8:47**  
Commercialization, **8:67**  
Compensation, **8:36**  
Competence, **8:72**  
Competition, **8:38, 8:103**  
Completeness, **8:47-8:49, 8:57**  
Completion of claimed invention, **8:253**

### PRIORITY—Cont'd

Concealment  
description in previously filed patent, paragraph 102(e), **8:143**  
first-to-invent priority, Section 102(g), below  
Conception, generally, **8:44-8:70**  
Conceptual inconsistencies  
generally, **8:90-8:130**  
constructive reduction to practice  
generally, **8:91-8:97**  
actual reduction to practice, impact on, **8:96**  
inconsistencies with patentability, **8:97**  
justification by issuance of patent, **8:93-8:95**  
prior abandoned applications, **8:94**  
prior issued patent, **8:95**  
theoretical justification, **8:92**  
evidence of prior invention, foreign activities as. Foreign countries, Section 104, below  
in this group  
foreign countries, Section 104  
generally, **8:98-8:109**  
Bain v. Morse, **8:101**  
discovery presumption, **8:109**  
Electric Storage Battery Co. v. Shimadzu, **8:102**  
evidence of prior invention, foreign activities as  
generally, **8:104-8:108**  
GATT/TRIPs, **8:107**  
law prior to 1993, **8:105**  
NAFTA, **8:106**  
offensive vs. defensive invention, **8:108**  
history and policy justifications, generally, **8:99-8:103**  
international competitiveness, **8:103**  
justifications, generally, **8:99-8:103**  
policy justifications, generally, **8:99-8:103**  
symmetry arguments, **8:100**

**PRIORITY—Cont'd**

Conceptual inconsistencies—Cont'd  
 foreign filing, Section 119  
 generally, **8:110-8:126**  
 amended foreign application,  
**8:124**  
 claims, same invention, **8:114**  
 counter-arguments, **8:119**  
 current law, **8:122**  
 disclosure, same invention,  
**8:115**  
 eligible countries, **8:112**  
 first and subsequent foreign  
 applications, **8:126**  
 history and policy justifications,  
**8:111, 8:120**  
*in re Hilmer*, **8:121**  
 multiple foreign priority claims,  
**8:125**  
 novelty requirement under  
 102(b), interaction with,  
**8:116**  
 offensive vs. defensive uses,  
**8:118**  
 paragraph 102(e), generally,  
**8:117-8:122**  
 same invention, **8:113-8:115**  
 12-month period, computation  
 of, **8:123**  
 history and policy justification  
 foreign countries, Section 104,  
 above in this group  
 foreign filing, Section 119,  
**8:111, 8:120**  
 indeterminate events, **8:127-8:129**  
 justifications. History and policy  
 justification, above in this  
 group  
 multiple-party contests, **8:129**  
 paragraph 102(e). Foreign filing,  
 Section 119, above in this  
 group  
*Paulik v. Rizkalla*, **8:130**  
 prior invention, foreign activities  
 as. Foreign countries, Section  
 104, above in this group  
 renewed activity, **8:130**  
 Section 104. Foreign countries,  
 Section 104, above in this  
 group

**PRIORITY—Cont'd**

Conceptual inconsistencies—Cont'd  
 simultaneous events, **8:128**  
 Configuration, **8:49, 8:57**  
 Conflicting authorities, **8:183**  
 Conflicting policy arguments, **8:152**  
 Construction and interpretation, **8:63,**  
**8:151, 8:259**  
 Constructive publication, **8:141**  
 Constructive reduction to practice.  
 Conceptual inconsistencies,  
 above  
 Contests, **8:38, 8:39, 8:46, 8:129**  
 Continuations in part, **8:147**  
 Continuing applications  
 description in previously filed  
 patent, paragraph 102(e),  
 below  
 novelty in relation to filing date of  
 application, Paragraph 102(b),  
**8:215**  
 Continuity, standard of, **8:66**  
 Contracts and agreements. Description  
 in previously filed patent,  
 paragraph 102(e), below  
 Contribution, **8:56**  
 Copending applications, **8:69**  
 Corporeal property, **8:39**  
 Correction for otherwise private acts,  
**8:82**  
 Corroboration. First-to-invent prior-  
 ity, Section 102(g), below  
 Corroboration and proof, **8:245.50**  
 Counter-arguments, **8:119**  
 Court of Customs and Patent Appeals  
 (CCPA), **8:46, 8:62**  
 Court proceedings, **8:75**  
 Credibility substitute, **8:73**  
 Critical date, information known as  
 of, **8:219**  
 Cross examination, **8:75**  
 Current law, **8:122**  
 Date of invention in paragraphs  
 102(a) and (e)  
 generally, **8:131-8:137**  
 affidavits under Rule 131, gener-  
 ally, **8:131-8:137**  
 analogy to obviousness standard  
 under section 103, **8:136**

## INDEX

### **PRIORITY—Cont'd**

Date of invention in paragraphs 102(a) and (e)—Cont'd anomalies, **8:134-8:136** basic rule, **8:132** procedure, **8:133** Rule 131, generally, **8:131-8:137** technical content of showing, required, **8:135** Defenses, **8:43** Defensive invention, **8:53, 8:108** Defensive uses, **8:118** Definiteness, **8:171** Definitions, **8:177, 8:194** Delay, **8:64** Deliberate secrecy, **8:87** Described in patent, **8:178-8:181** Description in previously filed patent, paragraph 102(e) generally, **8:138-8:155** applications. Continuing applications and requirement of description, below in this group continuing applications and requirement of description generally, **8:145-8:149** added subject matter, **8:147** continuations in part, **8:147** discontinued subject matter, **8:146** provisional and published applications, **8:149** reference, importance of subject matter claimed in, **8:148** contracts and agreements. Foreign applications, above in this group foreign applications generally, **8:150-8:155** conflicting policy arguments, **8:152** in re Hilmer, **8:153** international agreements, generally, **8:150-8:155** patent cooperation treaty, **8:154** potential interpretations of statutory language, **8:151** provisional applications, **8:155**

### **PRIORITY—Cont'd**

Description in previously filed patent, paragraph 102(e)—Cont'd historical development and policy justification generally, **8:139-8:144** abandoned, suppressed or concealed, relationship to, **8:143** Alexander Milburn Co. v. Davis-Bournonville Co., **8:140** constructive publication, **8:141** evidence of superior priority, **8:142** published applications, **8:144** international agreements. Foreign applications, above in this group justification. Historical development and policy justification, below in this group policy justification. Historical development and policy justification, above in this group Description in printed publication, **8:220-8:223** Designs, **5:46** Difficulties and unsettled issues, **8:257-8:260** Diffusion, speed of, **8:194** Diligence generally, **8:44, 8:70** first-to-invent priority, Section 102(g), below Disclosure, **8:115, 8:159** Discontinued subject matter, **8:146** Discovery, **8:44** Discovery presumption, **8:109** District courts, **8:66, 8:75** Documentary evidence, **8:73** Drawing, **8:74** Due process, **8:73** Economics, **8:36** Effective date of publication, **8:176** Electrical arts, **8:48** Electric Storage Battery Co. v. Shimadzu, **8:102**

**PRIORITY—Cont'd**

Eligible countries, **8:112**  
 Embodiment, **8:44, 8:55**  
 Employment, **8:67, 8:71**  
 Estoppel, **8:86**  
 Evidence  
     conception, **8:48, 8:49**  
     conceptual inconsistencies, above  
     description in previously filed  
     patent, paragraph 102(e),  
     **8:142**  
     diligence, **8:65, 8:66**  
     first-to-invent priority, Section  
     102(g), below  
     nomenclature, **8:42**  
     novelty in relation to filing date of  
     application, Paragraph 102(b),  
     **8:260**  
     public possession prior to patentee's date of invention,  
     paragraph 102(a), below  
     reduction-to-practice, **8:56**  
     Exact claim language, **8:259**  
     Examination of Original Application  
     (this index)  
     Exclude, right to, **8:38**  
     Exclusions, **8:34, 8:39, 8:54**  
     Exclusive control, **8:242-8:244**  
     Excuses for inactivity, **8:67**  
     Executive Branch, **8:34**  
     Existing authorities, synthesis of.  
         Public possession prior to patentee's date of invention,  
         paragraph 102(a), below  
     Ex parte proceeding, **8:69**  
     Ex parte prosecution, **8:73**  
     Experimental use. Novelty, Paragraph  
     102(b), below  
     Experiments, **8:54, 8:64, 8:189**  
     Expert, **8:58, 8:69**  
     Extensions, **8:242-8:244**  
     Extreme poverty, **8:67**  
     Fact, law vs., **8:261**  
     Family and relatives, **8:71**  
     Federal Circuit, **8:62, 8:66, 8:69**  
     First and subsequent foreign applications, **8:126**  
     First-in-right, **8:33, 8:34**  
     First-in-time, **8:33, 8:34**

**PRIORITY—Cont'd**

First inventor, **8:41, 8:64**  
 First-to-file, **8:35, 8:36**  
 First-to-invent priority, Section  
     102(g)  
     generally, **8:44-8:137**  
     abandoned, suppressed, and concealed  
     generally, **8:81-8:89**  
     classical abandonment, **8:85**  
     correction for otherwise private  
     acts, **8:82**  
     deliberate secrecy, **8:87**  
     diligence, relation to, **8:89**  
     evidence, **8:88**  
     historical development, **8:83**  
     laches or estoppel, **8:86**  
     underlying rationales, **8:84-8:87**  
     adequate diligence, **8:78**  
     appreciation, **8:46, 8:58**  
     basic rule, generally, **8:76-8:80**  
     claim language, relation to, **8:47-8:49, 8:57**  
     completeness, **8:47-8:49, 8:57**  
     concealed. Abandoned, suppress,  
     and concealed, above in this  
     group  
     conceptual inconsistencies, above  
     corroboration. Evidence, below in  
     this group  
     diligence  
         generally, **8:63-8:67**  
         continuity, standard of, **8:66**  
         excuses for inactivity, **8:67**  
         historical development, **8:64**  
         modern law, **8:65**  
     evidence  
         generally, **8:68-8:75**  
         corroboration, generally, **8:70-8:75**  
         credibility substitute, **8:73**  
         quantified probativeness, **8:72**  
         reason, rule of, **8:74**  
         standard of evidence, **8:69**  
         traditional justification, **8:71**  
     US Patent and Trademark Office  
         (PTO) vs. court proceedings, **8:75**

## INDEX

### **PRIORITY—Cont'd**

First-to-invent priority, Section 102(g)—Cont'd  
first-to-file distinguished, **8:35, 8:36**  
generic inventions, **8:48**  
genus and specie, **8:80**  
inherency, **8:49**  
knowledge, implementing, **8:50-8:53**  
mental aspects, generally, **8:45-8:54**  
needed experimentation, **8:54**  
offensive vs. defensive invention, **8:53**  
physical aspects, generally, **8:55-8:62**  
policy rationale, **8:56**  
practical utility, **8:51**  
race of diligence, **8:79**  
resolution, **8:62**  
suppressed. Abandoned, suppress, and concealed, above in this group  
testing required, degree of, **8:59-8:62**  
tripartite analysis, **8:60**  
unexpected properties, **8:52**  
unified standard, **8:61**  
Foreign countries  
generally, **8:276**  
applications, **8:215**  
conceptual inconsistencies, above  
description in previously filed patent, paragraph 102(e), above  
temporal scope, **11:23**  
GATT/TRIPs, **8:107**  
General absence of policy discussions, **8:158**  
Generic inventions, **8:48, 8:53**  
Genus and specie, **8:80**  
Geographic limitations  
novelty in relation to filing date of application, Paragraph 102(b), **8:262-8:265**  
public possession prior to patentee's date of invention, paragraph 102(a), below

### **PRIORITY—Cont'd**

Grace period. Novelty, Paragraph 102(b), below  
Gunter v. Stream, **8:45**  
Harmonizatoin, **8:36**  
Historical development and policy justification  
generally, **8:33**  
conceptual inconsistencies, below  
description in previously filed patent, paragraph 102(e), above  
first-to-invent priority, Section 102(g), **8:64, 8:83**  
novelty, Paragraph 102(b), below  
priority of title, **1:18**  
public possession prior to patentee's date of invention, paragraph 102(a), below  
Illustrations, **8:39**  
Improper analogies to paragraph 102(b), **8:184**  
Improvement inventions, **8:236**  
Inactivity, **8:67**  
Inconsistencies with paragraph 102(g), **8:163**  
Inconsistencies with patentability, **8:97**  
Indeterminate events, **8:127-8:129**  
Individual uses, **8:187**  
Industrial knowledge, **8:33**  
Industrial sophistication, **8:44**  
Inference, **8:65**  
Inferior party, **8:34**  
Infringement, **8:44, 8:65**  
Inherency, **8:49**  
Inherent anticipation, doctrine of, **8:49**  
Inherent details, **8:230**  
In public use. Novelty, Paragraph 102(b), below  
In re Borst, **8:165**  
In re Hilmer, **8:121, 8:153**  
In this country defined, **8:194**  
Initial and improvement inventions, **8:236**  
Initial determiniation, **8:44**  
Insanity, **8:67**  
Intent, **8:55, 8:58, 8:59, 8:254**

**PRIORITY—Cont'd**

Interference, **8:38, 8:60, 8:65, 8:73**  
 Interference priority, generally, **8:37-8:43**  
 Interference proceedings, **8:48**  
 International agreements. Description in previously filed patent, paragraph 102(e), above  
 International competitiveness, **8:103**  
 Inter partes proceedings, **8:34, 8:38**  
 Invention-based priority, **8:36**  
 Inventorship, **10:4, 10:11, 10:12**  
 Investigation, **8:54**  
 Issuance of patent, **8:69**  
 Joint inventorship, **10:31**  
 Jury, **8:34**  
 Justification  
     conceptual inconsistencies, above  
     description in previously filed patent, paragraph 102(e), above  
     diligence, **8:67**  
     first-to-invent priority, Section 102(g), **8:71**  
     historical development and policy justification, above  
     novelty, Paragraph 102(b), below  
     public possession prior to patentee's date of invention, paragraph 102(a), below  
     reduction-to-practice, **8:56, 8:61**  
 Knowledge, implementing, **8:50-8:53**  
 Laches, **8:86**  
 Laches or estoppel, **8:86**  
 Lapse, **8:65**  
 Law vs. fact, **8:261**  
 Limitations and restrictions  
     diligence, **8:64, 8:65**  
     evidence, **8:73**  
     nomenclature, **8:42**  
     novelty in relation to filing date of application, Paragraph 102(b), **8:262-8:265**  
     public possession prior to patentee's date of invention, paragraph 102(a), below  
     reduction-to-practice, **8:58**  
 Local priority, symmetry with, **8:193**

**PRIORITY—Cont'd**

Low probabilities, acceptance of, **8:170**  
 Mechanical arts, **8:48**  
 Mental aspect, **8:44**  
 Mental aspects. First-to-invent priority, Section 102(g), above  
 Metallizing Engineering v. Kenyon Bearing, **8:243**  
 Mixed purposes, **8:255**  
 Modern law, **8:65**  
 Motivation, **8:71**  
 Multiple foreign priority claims, **8:125**  
 Multiple-party contests, **8:129**  
 Multiple persons, **8:39**  
 NAFTA, **8:106**  
 Named party, **8:71**  
 Needed experimentation, **8:54**  
 Nomenclature, **8:42**  
 Non-obviousness, **9:38**  
 Notice and knowledge. Public possession prior to patentee's date of invention, paragraph 102(a), below  
 Novelty, Paragraph 102(b)  
     generally, **8:116**  
     filing date of application  
         generally, **8:199-8:265**  
     absolute novelty v. grace period  
         generally, **8:208-8:216**  
         continuing vs. foreign priority applications, **8:215**  
         current law, **8:214-8:216**  
         modern rationale, **8:213**  
         Patent Act of 1790, **8:209**  
         Patent Act of 1793, **8:209**  
         Patent Act of 1836, **8:209**  
         Patent Act of 1839, **8:210**  
         Patent Act of 1939, **8:212**  
         post-Hovey rationale, **8:211**  
         provisional applications, **8:216**  
         quantified abandonment, **8:210**  
     experimental use  
         generally, **8:246-8:261**

## INDEX

### **PRIORITY—Cont'd**

Novelty, Paragraph 102(b)—Cont'd  
    filing date of application—Cont'd  
        experimental use—Cont'd  
            adequate evidence of  
                experimentation, **8:260**  
    Andrews v. Hovey, **8:251**  
    City of Elizabeth v. Nicholson  
        Pavement Co., **8:250**  
    completion of claimed invention, **8:253**  
    difficulties and unsettled  
        issues, **8:257-8:260**  
    early cases, **8:248**  
    historical development, generally, **8:247-8:251**  
    intent of inventor vs. objective circumstances, **8:254**  
    law vs. fact, **8:261**  
    mixed purposes, **8:255**  
    modern rationale and law, generally, **8:252-8:256**  
    Patent Act of 1839, **8:249**  
    reduction to practice, **8:258**  
    reliance on exact claim language, **8:259**  
    third parties, experiments by, **8:256**  
    geographic limitations, **8:262-8:265**  
    grace period. Absolute novelty v. grace period, above this subgroup  
    historical development and policy justification generally, **8:201-8:207, 8:263**  
    abandonment, **8:204**  
    Andrews v. Hovey, **8:206**  
    complications, **8:205**  
    experimental use, above this subgroup  
    modern authorities, **8:207**  
    Patent Act of 1793, **8:202**  
    Patent Act of 1836, **8:203**  
    Patent Act of 1870, **8:206**  
    Pennock v. Dialogue, **8:203**  
    Shaw v. Cooper, **8:203**

### **PRIORITY—Cont'd**

Novelty, Paragraph 102(b)—Cont'd  
    filing date of application—Cont'd  
        in public use  
            generally, **8:239-8:245**  
            historical development, **8:240**  
            Metallizing Engineering v. Kenyon Bearing, **8:243**  
        time-wise extension of applicant's period of exclusive control, **8:242-8:244**  
        unresolved issues, **8:244**  
    withdrawal of material from public domain, **8:241**  
    justification. Historical development and policy justification, above in this group  
        novelty and priority distinguished, **8:200**  
    on sale  
        generally, **8:225-8:238, 8:265**  
        historical development, **8:226**  
        inherent details, **8:230**  
        initial and improvement inventions, **8:236**  
        modern rationale, generally, **8:227-8:237**  
        onset of bar, generally, **8:233-8:237**  
        patent right, sale of, **8:231**  
        Pfaff v. Wells Electronics, **8:234**  
        prefiling commercialization, generally, **8:225-8:238**  
        private offers for sale, **8:228**  
        ready for patenting, **8:235**  
        records and recording. Prefiling commercialization, above this subgroup  
        settled issues, **8:228-8:231**  
        sufficiency of single offer, **8:229**  
        sufficient commercialization, **8:237**  
        sufficient technological completion, **8:233**  
    third-party offers, **8:232**  
    unsettled issues, **8:232**

**PRIORITY—Cont'd**

Novelty, Paragraph 102(b)—Cont'd  
     filing date of application—Cont'd  
         paragraph 102(a), relationship  
             to, **8:264**  
     policy justification. Historical  
         development and policy  
         justification, above this  
         subgroup  
     possession. Prior possession by  
         public, below this subgroup  
     prior possession by public  
         generally, **8:217-8:224**  
         critical date, information  
             known as of, **8:219**  
         description in printed publica-  
             tion, **8:220-8:223**  
         historical development, **8:222**  
         paragraph 102(a), analogy to,  
             **8:218**  
         paragraph 102(a), relationship  
             to, **8:221**  
         patented, **8:224**  
         substantive law, **8:223**  
     public  
         in public use, above this  
         subgroup  
         prior possession by public,  
             below this subgroup  
     records and recording. Prefiling  
         commercialization, above  
         this subgroup  
     sales. On sale, above this  
         subgroup  
     time and date. Absolute novelty  
         v. grace period, above this  
         subgroup  
 Objective circumstances, **8:254**  
 Obviousness standard, **8:136**  
 Offensive vs. defensive invention,  
     **8:53, 8:108**  
 Offensive vs. defensive uses, **8:118**  
 Offers, **8:228**  
 On sale. Novelty, Paragraph 102(b),  
     above  
 Oral statements, **8:71**  
 Oral testimony, **8:74**  
 Ordinary personality, **8:39**  
 Ordinary skill, **8:58**

**PRIORITY—Cont'd**

Paragraph 102(a)  
     date of invention in paragraphs  
         102(a) and (e), above  
     novelty in relation to filing date of  
         application, Paragraph 102(b),  
             **8:218, 8:221, 8:264**  
     public possession prior to paten-  
         tee's date of invention,  
         paragraph 102(a), below  
 Paragraph 102(b)  
     novelty, Paragraph 102(b), above  
     public possession prior to paten-  
         tee's date of invention,  
         paragraph 102(a), **8:184**  
 Paragraph 102(d), **8:179**  
 Paragraph 102(e)  
     conceptual inconsistencies, above  
     date of invention in paragraphs  
         102(a) and (e), above  
     description in previously filed  
         patent, paragraph 102(e),  
         above  
 Paragraph 102(g), **8:163**  
 Partial acts and matters, **8:147**  
 Parties, **8:129, 8:232, 8:256**  
 Patentability, generally, **8:37-8:43**  
 Patent Act of 1790, **8:209**  
 Patent Act of 1793, **8:202, 8:209**  
 Patent Act of 1836, **8:64, 8:203,**  
     **8:209**  
 Patent Act of 1839, **8:210, 8:249**  
 Patent Act of 1870, **8:206**  
 Patent Act of 1939, **8:212**  
 Patent Act of 1952, **8:63**  
 Patent Cooperation Treaty, **8:154**  
 Patented, **8:224**  
 Patent right, sale of, **8:231**  
 Paulik v. Rizkalla, **8:130**  
 Pending applications, **8:69**  
 Pennock v. Dialogue, **8:203**  
 Performance, **8:57**  
 Perjury, **8:69**  
 Personal property law, **8:35, 8:37**  
 Pfaff v. Wells Electronics, **8:234**  
 Physical aspects. First-to-invent  
     priority, Section 102(g), above  
 Physical construction, **8:59**

## INDEX

### **PRIORITY—Cont'd**

Physical embodiment, **8:44**  
Policy discussions, **8:158**  
Policy justification. Historical development and policy justification, above  
Policy rationale, **8:56**  
Possession  
    generally, **8:33**  
    first-to-invent, Section 102(g), **8:46, 8:47, 8:50**  
    first-to-invent vs. first-to-file, **8:35**  
    novelty, Paragraph 102(b), above  
    public possession prior to patentee's date of invention, paragraph 102(a), below  
    use, rights to, **8:38**  
Potential interpretations of statutory language, **8:151**  
Potential relation to paragraph 102(d), **8:179**  
Practical utility, **8:50, 8:51**  
Predictability, **8:54**  
Preponderance of evidence, **8:68, 8:69**  
Presumptions, **8:109**  
Previously filed patent. Description in previously filed patent, paragraph 102(e), above  
Printed defined, **8:177**  
Printed publication  
    novelty in relation to filing date of application, Paragraph 102(b), **8:220-8:223**  
    public possession prior to patentee's date of invention, paragraph 102(a), below  
Prior acts and matters  
    conceptual inconsistencies, above  
    law, **8:105**  
    novelty, Paragraph 102(b), above  
    public possession prior to patentee's date of invention, paragraph 102(a), below  
    work, **8:162**  
Private acts and activity, **8:69, 8:82**  
Private laboratory notebooks and drawings, **8:74**  
Private offers for sale, **8:228**

### **PRIORITY—Cont'd**

Probabilities, **8:170**  
Property-based compensation, **8:36**  
Property law, **8:36, 8:38**  
Provisional application, **8:149, 8:155, 8:216**  
Public. Novelty, Paragraph 102(b), above  
Publication  
    description in previously filed patent, paragraph 102(e), **8:141**  
    novelty in relation to filing date of application, Paragraph 102(b), **8:220-8:223**  
    public possession prior to patentee's date of invention, paragraph 102(a), below  
Public disclosure, **8:64, 8:159**  
Public domain, **8:36, 8:40**  
Public invention, interference priority vs., **8:43**  
Public knowledge. Public possession prior to patentee's date of invention, paragraph 102(a), below  
Public possession prior to patentee's date of invention, paragraph 102(a)  
    generally, **8:156-8:198**  
    circumstantial proof of public knowledge  
    generally, **8:169-8:190**  
    conflicting authorities, **8:183**  
    described in patent, **8:178-8:181**  
    existing authorities, synthesis of generally, **8:186-8:190**  
    abandoned and failed experiments, **8:189**  
    individual uses, **8:187**  
    reduction to practice, relation to, **8:188**  
    secret, noninforming uses, **8:190**  
improper analogies to paragraph 102(b), **8:184**  
low probabilities, acceptance of, **8:170**  
potential relation to paragraph 102(d), **8:179**

**PRIORITY—Cont'd**

Public possession prior to patentee's date of invention, paragraph 102(a)—Cont'd  
 circumstantial proof of public knowledge—Cont'd  
 printed publication generally, **8:173-8:177**  
 effective date of publication, **8:176**  
 historical development, **8:174**  
 printed defined, **8:177**  
 prior public knowledge, evidence of, **8:175-8:177**  
 publication defined, **8:177**  
 printed publications, relation to, **8:180**  
 prior use and prior invention, **8:185**  
 rule-based definiteness, **8:171**  
 secret patents, **8:181**  
 social disutility, **8:172**  
 used, generally, **8:182-8:190**  
 evidence. Circumstantial proof of public knowledge, above in this group  
 existing authorities, synthesis of. Circumstantial proof of public knowledge, above in this group  
 geographic limitations generally, **8:191-8:198**  
 administrative justification, **8:192**  
*Bain v. Morse*, **8:197**  
 diffusion, speed of, **8:194**  
 historical development, **8:195-8:197**  
 in this country defined, **8:194**  
 local priority, symmetry with, **8:193**  
*Shaw v. Cooper*, **8:196**  
 historical development and policy justification generally, **8:157-8:163**  
 evidence of superior priority, **8:160-8:162**  
 general absence of policy discussions, **8:158**

**PRIORITY—Cont'd**

Public possession prior to patentee's date of invention, paragraph 102(a)—Cont'd  
 historical development and policy justification—Cont'd  
 inconsistencies with paragraph 102(g), **8:163**  
 knowledge and circumstantial evidence of prior knowledge, **8:161**  
 public disclosure, **8:159**  
 status of applicant's own prior work, **8:162**  
 justification. Historical development and policy justification, above in this group  
 limitations and restrictions. Geographic limitations, above in this group  
 notice and knowledge. Public knowledge, below in this group  
 policy justification. Historical development and policy justification, above in this group  
 printed publication. Circumstantial proof of public knowledge, above in this group  
 publication. Circumstantial proof of public knowledge, above in this group  
 public knowledge generally, **8:164-8:168**  
 abandoned applications, **8:168**  
 circumstantial proof of public knowledge, above in this group  
 extent of knowledge required, **8:166**  
 extent of publicness required, **8:167**  
*In re Borst*, **8:165**  
 Published applications, **8:144, 8:149**  
 Qualification, **8:57**  
 Quantified abandonment, **8:210**  
 Quantified probativeness, **8:72**  
 Race of diligence, **8:79**

## INDEX

### **PRIORITY—Cont'd**

Ready for patenting, **8:235**  
Reason, rule of, **8:70, 8:71, 8:74**  
Reasonable diligence, **8:65**  
Reduction to practice  
    generally, **8:44**  
    conception, **8:53**  
    diligence, **8:63-8:65, 8:67**  
    evidence, **8:70**  
    experimental use, **8:258**  
    novelty, **8:258**  
    used, **8:188**  
Reed v. Cuter, **8:44**  
Reference, **8:36, 8:48, 8:62**  
Reference, importance of subject  
    matter claimed in, **8:148**  
Reissue of patent, **16:82**  
Rejection of application, **8:73, 8:74**  
Reliance on exact claim language,  
    **8:259**  
Renewed activity, **8:130**  
Research and development, **8:46**  
Resolution, **8:62**  
Reversal, **8:46**  
Rule 131. Date of invention in  
    paragraphs 102(a) and (e), above  
Rule-based control, **8:72**  
Rule-based definiteness, **8:171**  
Sales. Novelty, Paragraph 102(b),  
    above  
Same invention, **8:113-8:115**  
Secrecy, **8:87**  
Secret, **8:64, 8:190**  
Secret patents, **8:181**  
Section 103, **8:136**  
Section 104. Conceptual inconsisten-  
    cies, above  
Settled issues, **8:228-8:231**  
Shaw v. Cooper, **8:196, 8:203**  
Showing, **8:135**  
Simultaneous events, **8:128**  
Sinko Tool & Mfg. Co. v. Automatic  
    Devices Corp., **8:61**  
Skilled in the art, **8:46, 8:58**  
Skilled person, **8:54**  
Social costs, **8:33**  
Social disutility, **8:172**  
Sophistication, **8:44**

### **PRIORITY—Cont'd**

Species and genus, **8:47**  
Spero v. Ringold, **8:46**  
Standard of evidence, **8:69**  
State of mind, **8:58**  
Status of applicant's own prior work,  
    **8:162**  
Subcombination of elements, **8:47**  
Subjective knowledge, **8:52**  
Subjective possession, **8:46**  
Subsequent applications, **8:126**  
Substantive law, **8:223**  
Sufficiency of single offer, **8:229**  
Sufficient commercialization, **8:237**  
Sufficient technological completion,  
    **8:233**  
Superior priority, **8:34, 8:142, 8:160-**  
    **8:162**  
Superior title, **8:40**  
Suppression  
    description in previously filed  
    patent, paragraph 102(e),  
    **8:143**  
    first-to-invent priority, Section  
    102(g), above  
Supreme Court  
    generally, **8:50**  
    Alexander Milburn Co. v. Davis-  
    Bourbonville Co., **8:140**  
    Andrews v. Hovey, **8:206, 8:251**  
    Bain v. Morse, **8:101, 8:197**  
    City of Elizabeth v. Nicholson  
        Pavement Co., **8:250**  
    Electric Storage Battery Co. v.  
        Shimadzu, **8:102**  
    In re Borst, **8:165**  
    In re Hilmer, **8:121, 8:153**  
    Metallizing Engineering v. Kenyon  
        Bearing, **8:243**  
    Paulik v. Rizkalla, **8:130**  
    Pennock v. Dialogue, **8:203**  
    Pfaff v. Wells Electronics, **8:234**  
    Shaw v. Cooper, **8:196, 8:203**  
    Sydeman v. Thoma, **8:60-8:62**  
    Symmetry arguments, **8:100**  
    Technical content of showing,  
        required, **8:135**  
    Technology, **8:233**

**PRIORITY—Cont'd**

Temporal scope, **11:23**  
Testing required, degree of, **8:59-8:62**  
Tests, **8:55, 8:57, 8:59, 8:60, 8:62, 8:67**  
Theoretical justification, **8:92**  
Third parties, experiments by, **8:256**  
Third-party offers, **8:232**  
Time and date  
    conceptual inconsistencies, **8:123**  
    date of invention in paragraphs 102(a) and (e), above  
    novelty, Paragraph 102(b), above  
    public possession prior to patentee's date of invention, paragraph 102(a), above  
Time-wise priority, **8:34**  
Traditional justification, **8:71**  
Treaties, **8:154**  
Tripartite analysis, **8:60**  
12-month period, computation of, **8:123**  
Underlying rationales, **8:84-8:87**  
Unexpected properties, **8:52**  
Unified standard, **8:61**  
Unresolved issues, **8:244**  
Unsettled issues, **8:232, 8:257-8:260**  
Use, right to, **8:38**  
Useful arts, **8:56**  
US Patent and Trademark Office (PTO) vs. court proceedings, **8:75**  
Utility, **8:51**  
Vacations, **8:67**  
Validity, **8:69**  
Value, **8:56**  
Voluntariness, **8:67**  
Weight and sufficiency of evidence, **8:72**  
Withdrawal of material from public domain, **8:241**  
Witnesses  
    generally, **8:34, 8:68, 8:69**  
    competency of, **8:72**  
    corroboration, generally, **8:70-8:75**  
    oral testimony, **8:74**  
    standard of proof, **8:69**

**PRIORITY—Cont'd**

Workability, **8:60**  
Written acts and matters, **8:74**

**PRIOR MINIMAL INFRINGEMENT**

Laches, unreasonable delay, **23:35**

**PRIOR STATUTES**

Defenses, general pleading theory, **17:3, 17:10**

**PRIOR USER RIGHT**

Inventorship, **10:14**  
Section 273 defense. Prior Inventor, Prior-User Rights (this index)

**PRIVACY**

Processes, **5:39**

**PRIVATE ACTION**

Patent and Trademark Office (PTO), **2:18**

**PRIVATE ACTS AND ACTIVITIES**

Patent and Trademark Office (PTO), **2:2, 2:4**  
Priority, **8:69, 8:82**

**PRIVATE COMMUNICATIONS**

History, **1:1**

**PRIVATE CORPORATIONS**

Patent and Trademark Office (PTO), **2:22**

**PRIVATE ENTITIES**

Policy justification, **1:39**

**PRIVATE INFORMATION**

Non-obviousness, **9:46**

**PRIVATE KNOWLEDGE**

Adequate disclosure, **7:17**

**PRIVATE LABORATORY NOTEBOOKS AND DRAWINGS**

Priority, **8:74**

**PRIVATELY KNOWN INFORMATION**

Non-obviousness, **9:43**

## INDEX

**PRIVATE OFFERS FOR SALE**  
Priority, 8:228

**PRIVATE PARTIES**  
Patent and Trademark Office (PTO), 2:17

**PRIVATE REMEDIES**  
History, 1:18

**PRIVATE SINGLE-SOURCE CONTROL**  
Statutory subject matter, 5:5

**PRIVILEGES**  
History, 1:4, 1:12

**PRIVY SEAL**  
History, 1:1

**PROBABILITIES**  
Priority, 8:170

**PROCESS CONTROL CORP. v. HYDRECLAIM CORP.**  
Adequate utility, 6:19

**PROCESSES**  
Generally, 5:1 *et seq.*  
Abandonment, 5:30  
Abstract business entity, 5:39  
Abstract ideals, 5:19  
Abstract method in, 5:26  
Accounting, 5:28  
Adequate differences, 5:29  
Aesthetic thought, 5:26  
Amendment to statute, 5:39  
America Invents Act, 5:33  
American Medical Association (AMA), 5:39  
Anticipation, lack of, 5:24, 8:28  
Any mental activity, 5:27  
Apparatus  
    business methods, apparatus-independent, 5:23  
    descriptions, 5:29  
    manipulation of physical apparatus, 5:27  
    variations of disclosed apparatus, 5:21  
Appeal and review, 5:21, 5:26, 5:27, 5:30

**PROCESSES—Cont'd**  
Application, 5:24, 5:26  
Arts, 5:21  
AT&T v. Excel Communications, Inc., 5:23, 5:37  
Bilski v. Kappos, 5:32  
Biotech industry, 5:39  
Biotechnology industry, 5:39  
Board of Appeals, 5:27  
Bubble hierarchy, 5:23  
Business methods  
    generally, 5:28-5:33  
    apparatus-independent business methods, 5:23  
    early history, 5:29  
    hybrid claiming, 5:38  
    modern developments, 5:30  
    observations, 5:36-5:38  
    physical transformation, adapting requirement of, 5:37  
Case law, 5:24-5:26  
Central claiming, 5:21  
Challenges, 5:39  
Change and modification, 5:19, 5:24, 5:28, 5:30  
Chemical compositions, 5:39  
Circuit court, 5:27  
Civil action, 5:39  
Clarity, 5:28  
CLS v. Alice, 5:32.50  
Cochran v. Deener, 5:22  
Commercial manufacture, 5:39  
Commercial processes, 5:37  
Common law, 5:24  
Competition, 5:39  
Compositions, 5:39  
Compromise, 5:39  
Computers, 5:24, 5:26, 5:27, 5:30  
Congress, 5:30  
Consent orders, 5:39  
Construction and interpretation, 5:21, 5:23, 5:27  
Consumer, 5:39  
Contracts and agreements, 5:29  
Contribution to the art, 5:21  
Conversion, 5:30  
Copyright, 5:38  
Corning v. Burden, 5:21

**PROCESSES—Cont'd**

Costs and expenses, **5:39**  
 Coupons, **5:29**  
 Court of Customs and Patent Appeals (CCPA), **5:26, 5:27, 5:30**  
**CPR, 5:39**  
 Creative thought, **5:26**  
 Current developments, **5:31**  
 Customer records, handling, **5:28**  
 Damages, **5:39**  
 Data constructs, manipulation of, **5:19**  
 Data systems, **5:30**  
**Defenses, 5:23**  
**Definiteness, 5:26**  
**Definition, 5:19**  
**Demand, 5:39**  
**Descriptions, 5:29**  
**Developments, 5:31**  
 Diagnostic procedures, **5:39**  
 Dicta, asserted in, **5:21**  
 Directed summary judgment, **5:30**  
 Disclosure, **5:19, 5:21**  
**Discovery, 5:24**  
 Discretion of human participant, **5:27**  
**District court, 5:30**  
 Dolbear v. American Bell Telephone Co., **5:24**  
**Drugs, 5:39**  
 Economic control, **5:38**  
**Electricity, 5:21**  
**Embodiments, 5:21, 5:22**  
 Emotional thought, **5:26**  
 End results, **5:24**  
**Enforcement, 5:39**  
 English law, **5:21**  
 European Patent Convention (EPC), **5:39**  
 Examination process, **5:30**  
**Examining corps, 5:38**  
 Exception for Ministerial Acts, **5:27**  
 Exceptions, exclusions, and exemptions  
     business methods, **5:29, 5:30, 5:39**  
     exclusions, generally, **5:22, 5:24, 5:26, 5:29**  
     mathematical formulae, scientific principles, natural phenom-

**PROCESSES—Cont'd**

Exceptions, exclusions, and exemptions—Cont'd  
     ena, and end results, **5:24**  
     mental steps, **5:26**  
     peripheral claiming, **5:22**  
**Exclusive power, 5:21**  
 Expanded post-grant review, **5:35**  
**Ex parte McNabb, 5:27**  
**Ex parte Read, 5:27**  
 Facsimile machines, **5:24**  
**Federal Circuit, 5:30**  
**Fees, 5:39**  
 Filing civil action, **5:39**  
**Financial revenue, 5:39**  
**Food and Drug Administration, 5:39**  
**Foreign countries, 5:39**  
 Ganske/Frisk compromise, **5:39**  
**General agreement, 5:29**  
**General Patent Act of 1870, 5:21**  
**Gene therapy treatments, 5:39**  
**Geographic scope, 12:25**  
 Gottschalk v. Benson, **5:24**  
 Halliburton Oil Well Cementing Co. v. Walker, **5:27**  
**Health care entities, 5:39**  
**Heimlich maneuver, 5:39**  
 Historical developments, industrial processes, **5:21**  
**History, 5:30**  
**Human interpretive, 5:25**  
**Human intervention, 5:24**  
**Human participant, 5:25, 5:27**  
 Hybrid claims, **4:74, 5:29, 5:36**  
 Imaginative thought, **5:26**  
**Immunity, 5:30**  
**Improvements, 5:21**  
**Incentives, 5:39**  
 Industrial processes, generally, **5:19-5:23**  
**Infringement, 5:23, 5:26, 5:30, 5:39**  
**In re Heritage, 5:27**  
**In re Musgrave, 5:26**  
**In re Prater, 5:26**  
**In re Schrader, 5:30**  
**In re Warmerdam, 5:23**  
**Injunctions, 5:39**  
**Intent, 5:30, 5:37**

## INDEX

### PROCESSES—Cont'd

Internal decisions of Patent and Trademark Office (PTO), **5:29**  
Internal operations of Patent and Trademark Office (PTO), **5:30**  
Interpretive judgment, **5:26**  
Interpretive mental acts, **5:27**  
Intervention, **5:24**  
Issuance of patent, **5:21, 5:39**  
Judgments, **5:26, 5:30**  
Judicial decisions, **5:19, 5:37**  
Ledger sheets, **5:29**  
Legislation, **5:28, 5:39**  
Le roy v. Tatham, **5:21**  
Licensed health professionals, **5:39**  
Licensing fees, **5:39**  
Limitations and restrictions  
    generally, **5:19**  
    business methods, **5:29, 5:30, 5:37**  
    industrial processes, **5:21, 5:22**  
    medical and surgical procedures,  
        **5:39**  
    mental steps, **5:26**  
Logarithmic scales, **5:27**  
Manipulation of physical apparatus,  
    **5:27**  
Manipulation of raw, physical materials, **5:36**  
Manual implementation of computer technology, **5:30**  
Manual of Patent Examining Procedure (MPEP), **5:30**  
Mathematical algorithm, **5:30**  
Mathematical formulae, **5:22, 5:24**  
Medical and surgical procedures,  
    **5:39**  
Medical device or machine, **5:39**  
Medical equipment, **5:39**  
Medical information, **5:39**  
Medical professionals, **5:39**  
Mental activity, **5:25, 5:27**  
Mental acts, **5:27**  
Mental steps, **5:22, 5:25-5:27**  
Merger doctrine, **5:38**  
Ministerial acts, **5:25**  
Modern developments, **5:31**  
Modern developments, industrial processes, **5:23**

### PROCESSES—Cont'd

Monopolies, **5:21**  
Motive, **5:21**  
Natural phenomena, **5:24**  
Natural state, **5:24**  
Nature, power of, **5:21**  
Network printers, **5:24**  
New medical procedure, **5:39**  
Ninth Circuit Court of Appeals, **5:27**  
Non-statutory, **5:23, 5:26, 5:29-5:32**  
Non-statutory hybrid inventions, **5:81**  
Non-statutory subject matter, **5:29**  
Notice and knowledge, **5:21, 5:24**  
Novelty, **5:21**  
Nullity, **5:24**  
Numerical calculation, **5:30**  
Numerical construct, **5:23**  
Objections, **5:26, 5:29**  
Orders, **5:39**  
O'Reilly v. Morse, **5:24**  
Paper accounting forms, **5:38**  
Participation, **5:30**  
Patentability, generally, **5:22**  
Patent Act of 1790, **5:21**  
Patent Act of 1952, **5:30**  
Patent and Trademark Office (PTO)  
    business methods, **5:28-5:30**  
    industrial processes, **5:21**  
    internal decisions of Patent and Trademark Office (PTO),  
        **5:29**  
    mathematical formulae, scientific principles, natural phenomena, and end results, **5:24**  
    medical and surgical procedures,  
        **5:39**  
        mental steps, **5:26, 5:27**  
    Patient privacy, **5:39**  
    Performance, **5:25, 5:26, 5:30**  
    Peripheral claiming, **5:21, 5:22, 5:24**  
    Per se invention, **5:29**  
    Per se method, **5:21**  
    Per se patentable subject matter, **5:21**  
    Per se processes, **5:21**  
    Pharmaceuticals, **5:39**  
    Physical objects, **5:19, 5:30**  
    Physical transformation, **5:23, 5:26**  
    Physicians, **5:39**

**PROCESSES—Cont'd**

Policy justification, **5:26, 5:29**  
Policy rationales, mental steps, **5:26**  
Post-grant review, **5:35**  
Practical application, **5:21**  
Price, **5:39**  
Printers, **5:24**  
Printing on ledger sheets, **5:29**  
Prior art, **5:30**  
Privacy, **5:39**  
Publication, **5:39**  
Purely manual implementations, **5:26**  
Purely mental acts, **5:27**  
Pure method, **5:22**  
Purity, increase in, **5:24**  
Qualifications, **5:21**  
Qualitative judgment, **5:26**  
Quality of life, **5:39**  
References, **5:22, 5:38**  
Rejection of application  
    business methods, **5:29, 5:30, 5:38**  
    mathematical formulae, scientific  
        principles, natural phenomena,  
        and end results, **5:24**  
    mental steps, **5:26, 5:27**  
Research and development, **5:39**  
Researchers, **5:39**  
Reversal, **5:30**  
Review, **5:35**  
Robotic environment, **5:23**  
Royalties, **5:39**  
Scientific laws and principles, **5:22,**  
    **5:24**  
Secrecy, **5:39**  
Section 102, **5:38**  
Section 103, **5:38**  
Section 273, **5:30**  
Section 281, **5:39**  
Section 283, **5:39**  
Section 285, **5:39**  
Section 287(c), **5:39**  
Section 616, **5:39**  
Social cost, **5:39**  
Social underutilization, **5:39**  
Software, **5:43-5:45**  
Specification, **5:19, 5:21, 5:26**

**PROCESSES—Cont'd**

State Street Bank & Trust Co. v.  
    Signature Financial Group, Inc.,  
    **5:30, 5:38**  
Statute of Monopolies, **5:21**  
Statutes, **5:33-5:35**  
Step-by-step, **5:38**  
Subjective thought to perform, **5:25**  
Summary judgment, **5:30**  
Supreme Court, **5:21, 5:22, 5:24**  
Tax strategies, **5:34**  
Telecommunications industry, **5:23**  
Tilghman v. Mitchell, **5:21**  
Trade secrets, **5:30**  
Transformation, **5:19, 5:22, 5:30**  
Treatises, **5:30**  
Trial court, **5:21**  
True method, **5:27**  
Unassisted human thought, **5:26**  
Validity  
    business methods, **5:28, 5:30**  
    industrial processes, **5:21**  
    medical and surgical procedures,  
        **5:39**  
    mental steps, **5:27**  
Variations of disclosed apparatus,  
    **5:21**  
Void, **5:24**  
Wyeth v. Stone, **5:24**

**PROCESS PATENTS**

**AMENDMENT ACT OF 1988**

Geographic scope, **12:36-12:38**

**PRODUCT**

Defined, **12:37**

**PRODUCT-AND-METHOD**

Claims, **4:63**

**PRODUCT-BY-PROCESS**

Claims, **4:73, 4:74, 4:82, 4:102**

**PRODUCTION AND  
PRODUCTION PROCESS**

Adequate disclosure, **7:52, 7:53**

Geographic scope, **12:32**

Static physical configurations, **5:9**

## INDEX

**PRODUCTION DETAILS**  
Adequate disclosure  
best mode, **7:52**

**PRODUCTIVE KNOWLEDGE**  
Adequate utility, **7:5**

**PRODUCTIVE USE**  
Adequate utility, **7:1, 7:6**

**PRODUCT METHOD**  
Claims, **4:66**

**PRODUCTS MADE BY PATENTED PROCESS**  
Geographic Scope of Infringement  
(this index)

**PROFITS**  
Adequate commerciality, **14:12**  
Adequate utility, **6:19, 7:5**  
Claims, **4:63**  
Joint inventorship, **10:53**  
Non-statutory hybrid inventions, **5:61**  
Policy justification, **1:34, 1:39, 1:41**  
Statutory subject matter, **5:4**

**PRO FORMA**  
Non-obviousness, **9:84**

**PROGRAMS**  
Computer-Related Inventions (this index)

**PROMOTING PROGRESS**  
Non-obviousness, **9:9**

**PROPER INVENTORSHIP**  
Inventorship (this index)  
Joint inventorship, **10:20-10:22**

**PROPER OWNERSHIP**  
Inventorship, **10:7**

**PROPER PLACEMENT**  
Non-statutory hybrid inventions, **5:63**

**PROPERTY-BASED COMPENSATION**  
Priority, **8:36**

**PROPERTY LAW**  
Inventorship, **10:4, 10:14**

**PROPERTY LAW—Cont'd**  
Misuse of patent, patent rights as  
property, **18:8**  
Priority, **8:36, 8:38**

**PROSECUTION**  
Adequate utility, **6:13**  
Claims, **4:93**  
Correction of inventorship, **10:56**  
Examination of Original Application  
(this index)  
Patent and Trademark Office (PTO),  
**2:22**  
Reissue of Patent (this index)

**PROSECUTION HISTORY**  
Claims, **4:45**  
Estoppel. Technological Scope of  
Infringement (this index)

**PROSPECTIVE-USE-BASED VIEW**  
Adequate utility, **6:19**

**PROSPECTS**  
Justification, **1:40, 1:42**

**PROTECTIONISM**  
Prior inventor, prior-user rights, **22:5**

**PROVERIS SCIENTIFIC CORP. v.  
INNOVASYSTEMS, INC.**  
Safe harbor, **14:74**

**PROVISIONAL APPLICATION**  
Priority, **8:149, 8:155, 8:216**

**PROVISIONAL RIGHTS**  
Temporal Scope of Infringement (this  
index)

**PTO**  
Patent and Trademark Office (PTO)  
(this index)

**PUBLIC ACCESSIBILITY**  
Joint inventorship, **10:51**

**PUBLIC ADVISORY COMMITTEES**  
Patent and Trademark Office (PTO),  
**2:22**

**PUBLICATION**  
Adequate disclosure, **7:5, 7:18**

**PUBLICATION—Cont'd**  
Anticipation, lack of, **8:31**  
Claims, **4:2**  
Examination of Original Application (this index)  
Non-Obviousness (this index)  
Patent and Trademark Office (PTO), **2:20, 2:24**  
Priority (this index)  
Processes, **5:39**  
Temporal Scope of Infringement (this index)

**PUBLIC DISCLOSURE**  
Non-obviousness, **9:22, 9:42, 9:51**  
Policy justification, **1:37, 1:38**  
Priority, **8:64, 8:159**

**PUBLIC DOMAIN**  
Anticipation, lack of, **8:27-8:29**  
Correction of inventorship, **10:68**  
Examination of Original Application (this index)  
History, **1:15**  
Non-Obviousness (this index)  
Patent and Trademark Office (PTO), **2:4**  
Priority, **8:36, 8:40**  
Static physical configurations, **5:18**

**PUBLIC EVENTS**  
Non-Obviousness (this index)

**PUBLIC FUNDS**  
Policy justification, **1:39**

**PUBLIC IN DUE COURSE**  
Correction of inventorship, **10:67**  
Non-obviousness, **9:28, 9:29**

**PUBLIC INSENSITIVITY**  
Adequate utility, **6:10**

**PUBLIC INSPECTION**  
Adequate utility, **7:18**

**PUBLIC INVENTION**  
Priority, **8:43**

**PUBLIC KNOWLEDGE**  
Adequate commerciality, **14:53**  
Non-obviousness, **9:21, 9:38, 9:39, 9:41**

**PUBLIC KNOWLEDGE—Cont'd**  
Policy justification, **1:38**  
Priority (this index)

**PUBLIC LAW**  
Claims, **4:77**

**PUBLICLY AVAILABLE PATENT**  
Non-obviousness, **9:21**

**PUBLICLY OBSERVABLE USES**  
Non-obviousness, **9:21**

**PUBLIC ORDER**  
Utility Requirement (this index)

**PUBLIC PARTICIPATION**  
Patent and Trademark Office (PTO), **2:13**

**PUBLIC POLICY**  
Non-obviousness, **9:28**

**PUBLIC POSSESSION**  
Anticipation, lack of, **8:19, 8:30**  
Non-obviousness, **9:77**  
Priority (this index)

**PUBLIC SALE**  
Adequate utility, **6:12**

**PUBLIC USE**  
Anticipation, lack of, **8:21**  
Correction of inventorship, **10:68**  
Examination of Original Application (this index)  
Inventorship, **10:14**  
Non-obviousness, **9:39, 9:43**

**PUBLIC WELFARE**  
Static physical configurations, **5:14**

**PURCHASE**  
Defense, license to use, **19:5**

**PURELY MANUAL IMPLEMENTATIONS**  
Processes, **5:26**

**PURELY MENTAL ACTS**  
Processes, **5:27**

**PURE MATHEMATICS, MATTERS OF**  
Statutory subject matter, **5:4**

## INDEX

**PURE METHOD**  
Processes, **5:22**

**PURE SCIENTIFIC, MATTERS OF**  
Statutory subject matter, **5:4**

**PURITY, ELEVATED LEVELS OF**  
Static physical configurations, **5:9**

**PURITY, INCREASE IN**  
Processes, **5:24**

**PVPA**  
Static physical configurations, **5:15, 5:17**

**QUALIFICATIONS**  
Adequate disclosure, **7:14, 7:18**  
Adequate utility, **6:7, 6:18**  
Anticipation, Lack Of (this index)  
History, **1:21**  
Inventorship (this index)  
Joint Inventorship (this index)  
Non-Obviousness (this index)  
Non-statutory hybrid inventions, **5:74**  
Priority, **8:57**  
Processes, **5:21**  
Static physical configurations, **5:15**

**QUESTIONS OF CAPACITY FOR USE**  
Adequate commerciality, **14:29-14:31**

**QUESTIONS OF LAW**  
Claims (this index)

**QUID PRO QUO**  
Claims, **4:91**

**RACE OF DILIGENCE**  
Priority, **8:79**

**RACE-TO-INVENT**  
Adequate utility, **7:5**

**RADIO CORP. OF AMERICA v. ANDREA**  
Adequate commerciality, **14:21, 14:22, 14:26**

**RAISING QUESTIONS**  
Indirect infringement, **15:24**

**RAW MATERIALS**  
Policy justification, **1:39**

**REACTIVE MEASURES**  
Reissue of patent, **16:17-16:46**

**READY FOR PATENTING**  
Priority, **8:235**

**REAL PARTY IN INTEREST**  
Adequate disclosure, **7:54**

**REAL PROPERTY OR CHATTEL**  
Joint inventorship, **10:49**

**REASON, RULE OF**  
Priority, **8:70, 8:71, 8:74**

**REASONABLE APPREHENSION**  
Adequate commerciality, **14:80**

**REASONABLE DILIGENCE**  
Priority, **8:65**

**REASONABLE EXPERIMENTATION**  
Adequate disclosure, **7:20**

**REASONABLE MIND**  
Patent and Trademark Office (PTO), **2:43**

**REASONABLENESS**  
Adequate commerciality, **14:72**  
Judicial review, **2:41**

**REASONABLE NOTICE**  
Claims, **4:2**

**REASONABLE PEOPLE**  
Claims, **4:3**

**REASONABLE RELATIONSHIP**  
Adequate commerciality, **14:68, 14:73**

**REASONABLY CAPABLE OF USE**  
Adequate commerciality, **14:19**

**REASONABLY CLEAR**  
Claims, **4:94**

**REASONABLY CORRELATED**  
Adequate utility, **7:23**

**REASONABLY PERTINENT**

Non-obviousness, **9:18**

**REASONABLY RELATED USES**

Adequate commerciality, **14:72-14:74**

**REASONABLY STABLE**

Static physical configurations, **5:9**

**REASONS**

Non-obviousness, **9:66**

**REBUTTAL**

Claims, **4:93**

Non-obviousness, **9:7, 9:74, 9:75**

**RECITAL AND RECITATIONS**

Anticipation, lack of, **8:14**

Claims (this index)

Non-obviousness, **9:1**

**RECOMMENDATION**

Reissue of patent, **16:97**

**RECONSTRUCTION**

Defenses, implied-in-law licenses, **19:42**

**RECOVERY**

Invalidity, royalties paid, **17:39**

**REDUCTION**

Reissues of patents, **16:38**

**REDUCTION-TO-PRACTICE**

Anticipation, lack of, **8:5, 8:6, 8:8**

Inventorship (this index)

Joint inventorship, **10:28**

Priority (this index)

**REED v. CUTER**

Priority, **8:44**

**REEXAMINATION**

Generally, **16:121 et seq.**

Constitutional questions

generally, **16:125**

court review, **16:126**

due process, **16:127**

estoppel, **16:127**

jury trial, **16:126**

retroactivity, **16:126**

Court review, **16:126**

**REEXAMINATION—Cont'd**

Due process, **16:127**

Effect of reexamination, **16:133-16:135**

Estoppel

constitutional questions, **16:127**

effect of reexamination, **16:135**

Ex parte procedures, **16:123**

Inter partes reexamination

effect of reexamination, **16:135**

overview, **16:124**

Intervening rights, effect of reexamination, **16:134**

Jury trial, **16:126**

Means expressions, **4:88**

Non-obviousness, **9:26**

Original application. Examination of Original Application (this index)

Overview of procedures, **16:122-16:124**

Parallel proceedings, stays, **16:131**

Patentability question. Substantial new question of patentability, below

Patent and Trademark Office (PTO), **2:18, 2:26**

Reissue of Patent (this index)

Retroactivity, **16:126**

Review by court, **16:126**

Scope of reexamination, **16:132**

Stay of parallel proceedings, **16:131**

Substantial new question of patentability

generally, **16:128-16:130**

“new,” **16:130**

“substantial,” **16:129**

Success of third-party requester, **16:135**

Third-party requester, **16:135**

**REFERENCE**

Adequate disclosure. Disclosure (this index)

Adequate utility, **6:7**

Anticipation, lack of, **8:13, 8:22, 8:25**

Correction of inventorship, **10:65, 10:66, 10:68**

Disclosure (this index)

## INDEX

### **REFERENCE—Cont'd**

Examination of Original Application (this index)  
Joint inventorship, **10:46**  
Non-Obviousness (this index)  
Priority, **8:36, 8:48, 8:62, 8:148**  
Processes, **5:22, 5:38**

### **REFORM MOVEMENT**

Reissue of patent, **16:41**

### **REGENTS OF THE UNIVERSITY OF CALIFORNIA v. ELI LILLY & CO.**

Adequate disclosure, **7:37, 7:39**

### **REGIONAL CIRCUIT COURTS**

Patent and Trademark Office (PTO), **2:37**

### **REGIONAL FEDERAL CIRCUIT COURTS OF APPEAL**

History, **1:24**

### **REGISTRATION**

Congress, **2:16**  
Designs, **5:46**  
Geographic scope, registered vessels, **12:13**  
History, **1:18, 1:19**  
Patent and Trademark Office (PTO), generally, **2:2**

### **REGULAR RESULT**

Anticipation, lack of, **8:25**

### **REHEARINGS**

Patent and Trademark Office (PTO), **2:22**

### **REHEARING SUA SPONTE**

Patent and Trademark Office (PTO), **2:22**

### **REISSUE OF PATENT**

Generally, **16:1, 16:72**  
Accident, mistake or inadvertence, pre-1882 broadening reissues, **16:25**  
Amendments, Patent Act of 1852, **16:61**  
Analysis and recommendation, same invention, **16:97**

### **REISSUE OF PATENT—Cont'd**

Battin v. Taggart, Patent Act of 1836, **16:21**  
Broadening changes, defect claims, **16:77-16:79**  
Broadening defined, requirements for eligibility, **16:78**  
Burr v. Duryee, pre-1882 broadening reissues, reactive measures, **16:28**  
Calculation on date of reissue grant, **16:117**  
Carlton v. Bokee, pre-1882 broadening reissues, reactive measures, **16:29**  
Carter v. Braintree, Patent Act of 1836, **16:19**  
Causes of action, effect of reissue on existing, 1882-1952 developments, **16:48, 16:49**  
Claims, **4:4, 4:9**  
Continuation status under Section 120, eligibility, **16:83**  
Dann amendments, “no-defect” reissue practice, **16:64**  
Deceptive intent lacking, **16:98**  
Defect generally, **16:74**  
broadening changes claims, **16:77-16:79**  
claims, generally, **16:75-16:80**  
continuation status under Section 120, **16:83**  
definiteness, changes to improve, **16:80**  
definition of broadening, broadening changes claims, **16:78**  
disclosure, **16:81**  
inventorship changes, **16:84**  
narrowing changes claims, **16:76**  
new matter prohibition, **16:81**  
priority, assertions under Section 119, **16:82**  
reexamination, “no-defect” reissue practice under Dann amendments, **16:64**  
Section 119 priority, **16:82**  
Section 120 continuation status, **16:83**

**REISSUE OF PATENT—Cont'd**

Defect—Cont'd  
 two-year time limit, broadening changes claims, **16:79**

Definiteness, changes to improve, eligibility, **16:80**

Definitions  
 broadening, **16:78**  
 error, general definition, **16:105-16:107**

Disclosure, eligibility, **16:81**

1846-1884, Stimpson v. West Chester R Co. decision as to error, **16:102**

1884-1952, Mahn v. Harwood decision as to error, **16:103**

Eligibility. Requirements for eligibility, below

Error, mechanisms to prevent expanded prosecution, **16:99-16:107**

Examination of Original Application (this index)

Existing embodiments, implied license as to, **16:119**

Expiration date of new rights, limitations on remedies, **16:114**

Federal Circuit decisions, same invention, **16:93-16:96**

General claiming requirements, pre-1882 broadening reissues, **16:26-16:29**

Giant Powder Co. v. California Powder Works, pre-1882 broadening reissues, same invention, **16:24**

Goodyear v. Day, pre-1882 broadening reissues, same invention, **16:23**

Grant of reissue, calculation on date, **16:117**

Grant v. Raymond, prestatutory history, **16:5**

Historical development  
 generally, **16:2, 16:3**  
 accident, mistake or inadvertence, pre-1882 broadening reissues, **16:25**  
 amendments, Patent Act of 1852, **16:61**

**REISSUE OF PATENT—Cont'd**

Historical development—Cont'd  
 Burr v. Duryee, pre-1882 broadening reissues, reactive measures, **16:28**

Carlton v. Bokee, pre-1882 broadening reissues, reactive measures, **16:29**

causes of action, effect of reissue on existing, 1882-1952 developments, **16:48, 16:49**

court decisions post-1870, pre-1882 broadening reissues, new matter prohibition, **16:37**

developments up to 1882, broadening reissues, **16:5-16:46**

early statutory history, **16:7-16:9**

effect on reissuance practice, Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, **16:46**

1882-1952 developments, **16:47-16:56**

factual setting, Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, **16:43**

general claiming requirements, pre-1882 broadening reissues, **16:26-16:29**

Giant Powder Co. v. California Powder Works, pre-1882 broadening reissues, same invention, **16:24**

Goodyear v. Day, pre-1882 broadening reissues, same invention, **16:23**

Grant v. Raymond, prestatutory history, **16:5**

Hoffheins v. Brand, broadening problem, **16:16**

inadvertence, accident, or mistake, pre-1882 broadening reissues, **16:25**

inclusion of later inventions, **16:13**

intervening rights, 1882-1952 developments, **16:51-16:56**

invalidity, intervening rights, 1882-1915, **16:53**

judicial reactions, pre-1882 broadening reissues, new mat-

## INDEX

### REISSUE OF PATENT—Cont'd

Historical development—Cont'd  
ter prohibition, **16:35**  
limitations on remedies, intervening rights, **16:116**  
mechanisms to prevent expanded prosecution, error, **16:100-16:104**  
Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, time limit, **16:41-16:46**  
mistake, accident, or inadvertence, pre-1882 broadening reissues, **16:25**  
mistaken reliance, **16:12**  
models as lingering problem, pre-1882 broadening reissues, new matter prohibition, **16:39**  
new matter prohibition, pre-1882 broadening reissues, reactive measures, **16:30-16:39**  
1915-1952, intervening rights, rise of personal defense, **16:54-16:56**  
1952, developments subsequent to, **1:22**  
O'Reilly v. Morseilly v. Morse, pre-1882 broadening reissues, reactive measures, **16:27**  
parol evidence, pre-1882 broadening reissues, new matter prohibition, **16:33, 16:34**  
Patent Act of 1832, **16:7**  
Patent Act of 1836, below  
Patent Act of 1852, below  
Patent Act of 1870, below  
Patent Act of 1928, effect of reissue on existing causes of action, **16:49**  
Patent Act of 1952, **1:23**  
Patent Act of 1980, reexamination, **16:65**  
Patent Office, pre-1882 broadening reissues  
earliest practices, **16:31**  
new matter prohibition, **16:32**  
post-2002 developments, reexamination, **16:68**  
pre-1882, intervening rights, no defense, **16:52**

### REISSUE OF PATENT—Cont'd

Historical development—Cont'd  
pre-1882 developments, broadening reissues, **16:5-16:46**  
prestatutory history, **16:4, 16:5**  
private remedies, **1:18**  
reactive measures, pre-1882 broadening reissues, **16:17-16:46**  
reduction in reissues, pre-1882 broadening reissues, new matter prohibition, **16:38**  
reexamination, below  
reform movement, Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, **16:41**  
rule against recapture, 1882-1952 developments, **16:50**  
same invention, pre-1882 broadening reissues, **16:22-16:24**  
Sontag Chain Stores Co. Limited v. National Nut Co. of California, intervening rights, 1915-1952, rise of personal defense, **16:56**  
speculation, **16:14**  
subsequent acceptance, Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, **16:45**  
Supreme Court decision, Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, **16:44**  
time limit imposition, pre-1882 broadening reissues, **16:40-16:46**  
2002 amendments, reexamination, **16:67**  
Woodworth patents, broadening problem, **16:15**  
Hoffheins v. Brand, broadening problem, **16:16**  
Implied license as to existing embodiments, **16:119**  
Inadvertence, accident, or mistake, pre-1882 broadening reissues, **16:25**

**REISSUE OF PATENT—Cont'd**

In re Amos decision in Federal Circuit, same invention, **16:96**  
 In re Hounsfiede decision in Federal Circuit, same invention, **16:94**  
 In re Weiler decision in Federal Circuit, same invention, **16:95**  
 Inter partes reexamination under 1999 amendments, **16:66**  
 Intervening rights  
   1882-1952 developments, **16:51-16:56**  
   limitations on remedies, **16:115-16:120**  
 Invalidity, intervening rights, 1882-1915, **16:53**  
 Inventorship changes, eligibility, **16:84**  
 Judicial reactions, pre-1882 broadening reissues, new matter prohibition, **16:35**  
 Limitations on remedies  
   generally, **16:109**  
   calculation on date of reissue grant, **16:117**  
   expiration date of new rights, **16:114**  
   historical development, intervening rights, **16:116**  
   implied license as to existing embodiments, **16:119**  
   intervening rights, **16:115-16:120**  
   narrowing claims, application of intervening rights, **16:118**  
   newly added rights, **16:112-16:114**  
   original rights, **16:111**  
   potential license to continue other utilization, **16:120**  
   starting date of new rights, **16:113**  
   time span, **16:110-16:114**  
 Mahn v. Harwood decision as to error, **16:103**  
 Mechanisms to prevent expanded prosecution  
   generally, **16:85**  
   analysis and recommendation, same invention, **16:97**  
   court decisions prior to 1952, same invention, **16:88-16:90**

**REISSUE OF PATENT—Cont'd**

Mechanisms to prevent expanded prosecution—Cont'd  
   deceptive intent lacking, **16:98**  
   early history, same invention, **16:87**  
   early statutory provisions as to error, **16:101**  
   1846-1884, Stimpson v. West Chester R Co. decision as to error, **16:102**  
   1884-1952, Mahn v. Harwood decision as to error, **16:103**  
   error, generally, **16:99-16:107**  
   Federal Circuit decisions, same invention, **16:93-16:96**  
   general definition of error, **16:105-16:107**  
   historical development, error, **16:100-16:104**  
 In re Amos decision in Federal Circuit, same invention, **16:96**  
 In re Hounsfiede decision in Federal Circuit, same invention, **16:94**  
 In re Weiler decision in Federal Circuit, same invention, **16:95**  
 1952-1982 court decisions, same invention, **16:92**  
 nonelected subject matter, error, **16:106**  
 Parker & Whipple Co. v. Yale Clock Co. decision, same invention, **16:89**  
 Patent Act of 1952, **16:91, 16:104**  
 rule against recapture, error, **16:107**  
 same invention, **16:86-16:97**  
 U.S. Industrial Chemicals v. Carbide & Carbon Chemicals Corporation decision, same invention, **16:90**  
 Miller v. bridgeport brass co., **16:42**  
 Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, time limit, **16:41-16:46**  
 Mistake, accident, or inadvertence, pre-1882 broadening reissues, **16:25**  
 Mistaken reliance, **16:12**

## INDEX

### REISSUE OF PATENT—Cont'd

Models as lingering problem, pre-1882 broadening reissues, new matter prohibition, **16:39**  
Narrowing claims  
application of intervening rights, **16:118**  
intervening rights application, **16:118**  
requirements for eligibility, **16:76**  
Newly added rights, limitations on remedies, **16:112-16:114**  
New matter prohibition  
pre-1882 broadening reissues, reactive measures, **16:30-16:39**  
requirements for eligibility, **16:81**  
1915-1952, intervening rights, rise of personal defense, **16:54-16:56**  
1952, developments subsequent to, **1:22**  
“No-defect” reissue practice under Dann amendments, **16:64**  
Nonelected subject matter, error, **16:106**  
Oath, **16:108**  
O'Reilly v. Morse, pre-1882 broadening reissues, reactive measures, **16:27**  
Original rights, limitations on remedies, **16:111**  
Other utilization, potential license to continue, **16:120**  
Parker & Whipple Co. v. Yale Clock Co. decision, same invention, **16:89**  
Parol evidence, pre-1882 broadening reissues, new matter prohibition, **16:33, 16:34**  
Patent Act of 1832, **16:7**  
Patent Act of 1836  
ban on broadening, **16:18-16:21**  
Battin v. Taggart, allowance of broadening reissues, **16:21**  
Carter v. Braintree, impact of central claiming, **16:19**  
developments up to 1870, **1:20**  
disagreement over statutory interpretation, **16:20**

### REISSUE OF PATENT—Cont'd

Patent Act of 1836—Cont'd  
early statutory history, **16:8**  
Patent Act of 1852  
generally, **16:57-16:61**  
Section 251, **16:58**  
Section 252, **16:59**  
Section 253, **16:60**  
subsequent amendments, **16:61**  
Patent Act of 1870  
early statutory history, **16:9**  
pre-1882 broadening reissues, new matter prohibition, **16:36**  
Patent Act of 1928, effect of reissue on existing causes of action, **16:49**  
Patent Act of 1952  
history, **1:23**  
mechanisms to prevent expanded prosecution, **16:91, 16:104**  
Patent Act of 1980, reexamination, **16:65**  
Patent Office, pre-1882 broadening reissues  
earliest practices, **16:31**  
new matter prohibition, **16:32**  
Policy justification  
generally, **16:69**  
reexamination, **16:71**  
reissue, **16:70**  
Potential license to continue other utilization, limitations on remedies, **16:120**  
Priority under Section 119, eligibility, **16:82**  
Private remedies, historical developments, **1:18**  
Reactive measures, pre-1882 broadening reissues, **16:17-16:46**  
Reduction in reissues, pre-1882 broadening reissues, new matter prohibition, **16:38**  
Reexamination  
Dann amendments, “no-defect” reissue practice, **16:64**  
early developments, **16:63**  
history, generally, **16:62-16:68**

**REISSUE OF PATENT—Cont'd**

Reexamination—Cont'd  
 inter partes reexamination under 1999 amendments, **16:66**  
 "no-defect" reissue practice under Dann amendments, **16:64**  
 Patent Act of 1980, **16:65**  
 policy justification, **16:71**  
 post-2002 developments, **16:68**  
 2002 amendments, **16:67**  
 Reform movement, Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, **16:41**  
 Reissue oath, **16:108**  
 Remedies, limitations. Limitations on remedies, above  
 Requirements for eligibility generally, **16:73**  
 defect, above  
 mechanisms to prevent expanded prosecution, above  
 reissue oath, **16:108**  
 Rule against recapture  
 1882-1952 developments, **16:50**  
 error, **16:107**  
 Same invention  
 mechanisms to prevent expanded prosecution, **16:86-16:97**  
 pre-1882 broadening reissues, **16:22-16:24**  
 Section 119 priority, eligibility, **16:82**  
 Section 120 continuation status, eligibility, **16:83**  
 Sontag Chain Stores Co. Limited v. National Nut Co. of California, intervening rights, 1915-1952, rise of personal defense, **16:56**  
 Speculation, historical development, **16:14**  
 Starting date of new rights, limitations on remedies, **16:113**  
 Stimpson v. West Chester R Co. decision as to error, **16:102**  
 Subsequent acceptance, Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, **16:45**  
 Supreme Court decision, Miller v. Bridgeport Brass Co., pre-1882 broadening reissues, **16:44**

**REISSUE OF PATENT—Cont'd**

Technological scope, **13:62**  
 Time limit, pre-1882 broadening reissues, **16:40-16:46**  
 Time span, limitations on remedies, **16:110-16:114**  
 2002 amendments, reexamination generally, **16:67**  
 post-2002 developments, **16:68**  
 Two-year time limit, broadening changes claims, eligibility, **16:79**  
 U.S. Industrial Chemicals v. Carbide & Carbon Chemicals Corporation decision, same invention, **16:90**  
 Woodworth patents, broadening problem, **16:15**

**REJECTION IN PART**

Non-obviousness, **9:33**

**REJECTION OF APPLICATION**

Adequate disclosure, **7:1, 7:9, 7:14, 7:25**  
 Adequate utility, **6:6, 6:13**  
 Claims (this index)  
 Computer-related inventions, **5:42, 5:44, 5:45**  
 Joint inventorship, **10:36, 10:38, 10:39, 10:51**  
 Non-obviousness  
 determination of obviousness, **9:68**  
 Rule 131 affidavits, **9:36**  
 secret prior art, **9:36, 9:37, 9:42**  
 starting and ending materials, **9:79, 9:80**  
 structures accompanied by properties or uses, **9:73, 9:77**  
 timeliness, Section 102, **9:23, 9:25**  
 Non-statutory hybrid inventions, **5:53, 5:63, 5:75, 5:80**  
 Patent and Trademark Office (PTO), **2:32**  
 Priority, **8:73, 8:74**  
 Processes, **5:24-5:27, 5:29, 5:30, 5:38**  
 Static physical configurations, **5:9, 5:17**  
 Technological configuration, **9:71**

## INDEX

**REJECTION OF APPLICATION**  
—Cont'd  
Technological scope, **13:107, 13:108**

**RELATED APPLICANTS**  
Foreign countries, **8:277**

**RELATED CLAIMS AND APPLICATIONS**  
Technological scope, **13:106**

**RELATED HEALTH-CARE ENTITY**  
Medical and diagnostic procedures, section 287(c) defense, **20:20**

**RELATED INFORMATION**  
Adequate disclosure, **7:52, 7:53**

**RELATIVE SKILL**  
Adequate utility, **7:20**

**RELEVANCE OF PROOF**  
Adequate commerciality, **14:16**

**RELEVANT ART**  
Non-obviousness, **9:51**

**RELEVANT DISCLOSURE**  
Joint inventorship, **10:46**

**RELEVANT FIELD**  
Adequate utility, **7:15**

**RELEVANT KNOWLEDGE**  
Joint inventorship, **10:33**

**RELEVANT PARTICIPANTS**  
Correction of inventorship, **10:60**

**RELEVANT PARTIES**  
Correction of inventorship, **10:61**

**RELEVANT TECHNICAL DISCLOSURE**  
Joint inventorship, **10:44**

**RELIANCE**  
Estoppel, **24:28**  
Priority, **8:259**  
Reissue of patent, **16:12**

**REMAND**  
Claims, **4:74**  
Non-obviousness, **9:50**

**REMAND—Cont'd**  
Technological scope, **13:26, 13:30, 13:35-13:37**

**RENEWED ACTIVITY**  
Priority, **8:130**

**REPAIR**  
Defenses, implied-in-law licenses, **19:42**

**REPRINTS**  
Patent and Trademark Office (PTO), **2:27**

**REPRODUCTION**  
Static physical configurations, **5:14, 5:15**

**RESALE RESTRICTIONS**  
Misuse of patent, **18:35**

**RESEARCH AND DEVELOPMENT**  
Adequate commerciality, **14:74**  
Adequate disclosure, **7:5**  
Adequate utility, **6:6, 6:15, 6:17**  
Anticipation, lack of, **8:27**  
Claims, **4:63, 4:77**  
Computer-related inventions, **5:44**  
Correction of inventorship, **10:64**  
Inventorship, **10:1, 10:15, 10:17, 10:18**  
Joint inventorship, **10:39, 10:40**  
Non-Obviousness (this index)  
Non-statutory hybrid inventions, **5:61**  
Policy justification, **1:39, 1:41, 1:42**  
Priority, **8:46**  
Processes, **5:39**  
Static physical configurations, **5:14**  
Statutory subject matter, **5:5**

**RESOLUTION**  
Invalidity (this index)  
Priority, **8:62**

**RESPONSE**  
Examination of Original Applications (this index)

**RESTATEMENT OF CONTRACTS**  
Adequate commerciality, **14:47**

**RESTATEMENT OF TORTS, 2ND**

Indirect infringement, **15:14**

**RESTORATION**

Temporal Scope of Infringement (this index)

**RESTRICTIONS**

Limitations and Restrictions (this index)

**RESTRICTIVE COVENANTS**

Misuse of patent, **18:9**

**RETROACTIVITY**

Reexamination, **16:126**

**REVERSAL**

Adequate disclosure, **7:14**

Adequate utility, **6:6**

Non-Obviousness (this index)

Priority, **8:46**

Processes, **5:30**

Static physical configurations, **5:9, 5:11, 5:12**

**REVERSE ENGINEERING**

Adequate disclosure, **7:50**

**REVERSIBLE ERROR**

Non-obviousness, **9:7, 9:51**

**REVIEW**

Appeal and Review (this index)

**REVISED STATUTES OF 1874**

Six-year limitation, **21:5**

**REVOCATION**

Patent and Trademark Office (PTO), **2:8, 2:21**

**REX v. ARKWRIGHT**

Adequate utility, **7:46**

**RHODESIA**

Adequate utility, **7:18**

**RICHARDSON v. SUZUKI MOTOR COMPANY, LTD.**

Correction of inventorship, **10:68**

**ROBBINS**

Non-obviousness, **9:36**

**ROBOTIC ENVIRONMENT**

Non-statutory hybrid inventions, **5:78**

Processes, **5:23**

**ROCHE PROD. INC. v. BOLAR PHARMACEUTICAL CO., INC.**

Adequate Commerciality (this index)

**ROTEC INDUS., INC. v. MITSUBISHI CORP.**

Adequate commerciality, **14:40, 14:47**

**ROUTINE DETAILS**

Adequate disclosure, **7:52**

**ROYAL LETTERS PATENT**

History, **1:4, 1:5**

**ROYAL SIGNET**

History, **1:1**

**ROYALTIES**

Invalidity, **17:39**

Inventorship, **10:14**

Joint inventorship, **10:52**

Misuse of Patent (this index)

Processes, **5:39**

**RULE 71(B)**

Adequate utility, **7:8**

**RULE AGAINST RECAPTURE**

Reissue of patent, **16:50, 16:107**

**RULE 131**

Non-obviousness, **9:25, 9:36, 9:37**

Priority (this index)

**RULE-BASED CONTROL**

Priority, **8:72**

**RULE-BASED DEFINITENESS**

Priority, **8:171**

**RULE-BASED IMPLEMENTATION**

Adequate commerciality, **14:13**

**RULE-OF-REASON APPROACH**

Adequate utility, **7:12**

**SAB INDUSTRI AB v. BENDIX CORP.**

Joint inventorship, **10:40**

## INDEX

**SAFE AND EFFECTIVE**  
Adequate utility, **6:12**

**SAFE HARBOR**  
Adequate Commerciality (this index)

**SALEABLE PRODUCT**  
Policy justification, **1:41**

**SALES**  
Adequate Commerciality (this index)  
Adequate utility, **6:8**  
Anticipation, lack of, **8:20**  
Examination of Original Application (this index)  
Geographic scope, **12:18-12:21**  
Indirect Infringement (this index)  
Misuse of patent, **18:35**  
Priority (this index)  
Static physical configurations, **5:14, 5:15**

**SALTS**  
Temporal scope, **11:47**

**SAME INVENTION**  
Foreign countries, **8:279**  
Priority, **8:113-8:115**  
Reissue of Patent (this index)

**SAMPLES AND SAMPLING**  
Adequate utility, **7:11**  
Non-obviousness, **9:9**

**SANCTIONS**  
Joint inventorship, **10:25**

**SANITARY REFRIGERATOR CO. v. WINTERS**  
Technological scope, **13:70**

**SANITY**  
Inventorship, **10:7**

**SCARCITY**  
Justification, **1:34**

**SCHOLARSHIP NOTES**  
Non-statutory hybrid inventions, **5:49**

**SCIENCE**  
Adequate utility, **6:5**  
History, **1:11**  
Statutory subject matter, **5:1, 5:4**

**SCIENTIFIC DEVELOPMENT**  
Adequate utility, **6:19**

**SCIENTIFIC LAWS**  
Processes, **5:22**

**SCIENTIFIC PRINCIPLES**  
Statutory subject matter, **5:24**

**SCIRE FACIAS**  
Patent and Trademark Office (PTO), **2:16**

**SCREENING PROCESS**  
Adequate utility, **7:22**

**SCRIPPS CLINIC & RESEARCH FOUNDATION v. GENENTECH**  
Claims, **4:74**

**SEALS**  
Claims, **4:97**  
History, **1:1**

**SECONDARY CONSIDERATIONS**  
Non-Obviousness (this index)

**SECOND REMAND**  
Technological scope, **13:35-13:37**

**SECRETARY OF COMMERCE**  
Patent and Trademark Office (PTO), **2:22**

**SECRETARY OF STATE**  
Patent and Trademark Office (PTO), **2:15, 2:20**

**SECRETARY OF WAR**  
Patent and Trademark Office (PTO), **2:15, 2:20**

**SECRET PRIOR ART**  
Adequate utility, **7:18**  
Non-Obviousness (this index)

**SECRETS AND SECRECY**  
Adequate disclosure, **7:5, 7:18, 7:44, 7:55**  
Policy justification, **1:38**  
Priority, **8:64, 8:87, 8:181, 8:190**  
Processes, **5:39**

**SECTION 102**

America Invents Act, amendment of  
Section 102 timewise priority,  
**1:26**

**SECTION 282**

Defenses, **17:11**

**SECTION 287(C)**

Defenses. Medical and Diagnostic  
Procedures (this index)  
Processes, **5:39**

**SEEDS**

Static physical configurations, **5:14**,  
**5:15**

**SEMANTIC MEANING**

Claims, **4:55-4:57**

**SENATE**

Patent and Trademark Office (PTO),  
**2:22**

**SENIOR EXECUTIVE SERVICE**

Patent and Trademark Office (PTO),  
**2:22**

**SEPARATE DELEGATIONS**

Congress, **2:7**

**SERIAL PERFORMANCE**

Adequate commerciality, **14:36**

**SERIAL SET OF**

**CONGRESSIONAL  
DOCUMENTS**

Patent and Trademark Office (PTO),  
**2:4**

**SERIES OF ACTS**

Statutory Subject Matter (this index)

**SERVICEABLE IN VIVO**

Adequate utility, **6:18**

**SERVICES**

History, **1:4**  
Inventorship, **10:11, 10:13**

**SETTING ASIDE**

Inventorship, **10:7**

**SETTLEMENT**

Invalidity, **17:41**

**7 USCA §§ 2321 ET SEQ.**

Static physical configurations, **5:13**

**17 USC, SECTION 201(A)**

Inventorship, **10:6**

**SEVENTH CIRCUIT**

Joint inventorship, **10:51**

**SEXUALLY REPRODUCING  
PLANTS**

Static physical configurations, **5:8**,  
**5:13, 5:15**

**SEYMOUR v. OSBOURNE**

Anticipation, lack of, **8:18, 8:31**

**SHAW v. COOPER**

Priority, **8:196, 8:203**

**SHELTER FOR TRADE SECRET  
USER**

Prior inventor, prior-user rights, **22:6**

**SHOWINGS**

Non-obviousness, **9:75**

Priority, **8:135**

**SILENCE**

Estoppel, communication from patent  
owner, **24:26**

**SIMULTANEOUS ACTS AND  
MATTERS**

Adequate disclosure, **7:51**

Non-obviousness, **9:58**

Priority, **8:128**

**SINGLE-CELLED  
MICROORGANISMS**

Static physical configurations, **5:17**

**SINGLE-EMBODIMENT**

Adequate Disclosure (this index)

**SINGLE INVENTIVE ACT**

Correction of inventorship, **10:66**

**SINGLE MEANS CLAIMS**

Generally, **4:87**

**SINGLE-SOURCE CONTROL**

Adequate commerciality, **14:12**

Anticipation, lack of, **8:20**

Justification, **1:32**

## INDEX

**SINGLE-SOURCE CONTROL**  
—Cont'd  
    Statutory subject matter, **5:4, 5:5**

**SINGLE-SOURCE PROFITS**  
    Inventorship, **10:3**

**SINKO TOOL & MFG. CO. v. AUTOMATIC DEVICES CORP.**  
    Priority, **8:61**

**SITUS OF ACCUSED ACTIVITY**  
    Geographic Scope of Infringement  
        (this index)

**SIX-YEAR LIMITATION**  
    Generally, **21:1-21:24**  
    Accrual, **21:21, 21:22**  
    Basic rule of law, **21:17**  
    Burden of pleading, **21:20**  
    Burden of proof, **21:19**  
    Campbell v. City of Haverhill, **21:6**  
    Contractual agreements, **21:24**  
    Court decisions between 1897 and  
        1952  
        historical development of section  
            286 defense, **21:8-21:10**  
        Peters v. Hanger, **21:9**  
        Pollen v. Ford Instrument Co.,  
            **21:10**  
    Court decisions since 1982  
        historical development of section  
            286 defense, **21:12-21:15**  
        Hughes Aircraft Co. v. National  
            Semiconductor Corp., **21:15**  
        Standard Oil Co. v. Nippon  
            Shokubai Kagaku Kogyo Co.,  
                **21:13**  
        Stucki Co. v. Buckeye Steel Cast-  
            ings Co., **21:14**  
    Date of filing of complaint or  
        counterclaim, **21:1**  
    Defenses, section 286  
        generally, **21:1**  
        accrual, **21:21, 21:22**  
        basic rule, **21:17**  
        burden of pleading, **21:20**  
        burden of proof, **21:19**  
        complaints, **21:20**  
        contractual agreements, **21:24**

**SIX-YEAR LIMITATION—Cont'd**  
    Defenses, section 286—Cont'd  
        historical development of section  
            286 defense, below  
        indirect infringers, **21:22**  
        pleading, **21:20**  
        policy justification, **21:16**  
        subsidiary issues, **21:18-21:24**  
        tolling, **21:23, 21:24**  
    Early cases, **21:3**  
    Historical development of section  
        286 defense  
        generally, **21:2**  
        Campbell v. City of Haverhill,  
            **21:6**  
        court decisions between 1897 and  
            1952, **21:8-21:10**  
        court decisions since 1982, **21:12-**  
            **21:15**  
        early cases, **21:3**  
        Hughes Aircraft Co. v. National  
            Semiconductor Corp., **21:15**  
        Patent Act of 1870, **21:4**  
        Patent Act of 1897, **21:7**  
        Patent Act of 1952, **21:11**  
        Peters v. Hanger, cases following  
            Patent Act of 1897, **21:9**  
        Pollen v. Ford Instruments Co.,  
            **21:10**  
        Revised Statutes of 1874, **21:5**  
        Standard Oil Co. v. Nippon  
            Shokubai Kagaku Kogyo Co.,  
                **21:13**  
        Stucki Co. v. Buckeye Steel Cast-  
            ings Co., **21:14**  
        subsequent cases, 1897 to 1952,  
            **21:8-21:10**  
        Hughes Aircraft Co. v. National  
            Semiconductor Corp., **21:15**  
    Indirect infringers, **21:22**  
    Patent Act of 1870, **21:4**  
    Patent Act of 1897, **21:7**  
    Patent Act of 1952, **21:11**  
    Peters v. Hanger, **21:9**  
    Policy justification, section 286  
        defense, **21:16**  
    Pollen v. Ford Instruments Co., **21:10**  
    Revised Statutes of 1874, **21:5**

**SIX-YEAR LIMITATION—Cont'd**  
Standard Oil Co. v. Nippon Shokubai Kagaku Kogyo Co., **21:13**  
Stucki Co. v. Buckeye Steel Castings Co., **21:14**  
Subsequent cases, 1897 to 1952, **21:8-21:10**  
Subsidiary issues, **21:18-21:24**  
Tolling, **21:23, 21:24**

**SIX-YEAR PRESUMPTION**  
Laches, unreasonable delay, **23:40**

**SKILL**  
Adequate utility, minimal skill, **7:16**  
Adequate utility, relative skill, **7:20**  
Non-obviousness, **9:4, 9:6, 9:15, 9:50, 9:74, 9:75**  
Ordinary artisan  
generally, **9:50**  
non-obviousness, **9:78**  
Priority, skilled person, **8:54**

**"SKILL IN THE ART"**  
Adequate disclosure, **7:34**  
Adequate utility, **6:13**  
Anticipation, lack of, **8:31**  
Claims, **4:2, 4:91, 4:92**  
Disclosure (this index)  
Inventorship, **10:12**  
Priority, **8:46, 8:58**

**SOCIAL BENEFITS**  
Policy Justification (this index)

**SOCIAL COST**  
Adequate utility, **6:2, 6:4, 6:10**  
Policy Justification (this index)  
Priority, **8:33**  
Processes, **5:39**  
Statutory subject matter, **5:5**

**SOCIAL DISUTILITY**  
Priority, **8:172**

**SOCIAL UNDERUTILIZATION**  
Processes, **5:39**

**SOFTWARE**  
Computer-Related Inventions (this index)

**SOLE INVENTORS**  
Generally, **10:9**  
Joint inventorship, **10:43**

**SOLE LICENSE**  
History, **1:4**

**SOLE-TO-SOLE CONVERSIONS**  
Correction (this index)

**SOLIDS**  
Static physical configurations, **5:9**

**SONTAG CHAIN STORES CO.**  
**LIMITED v. NATIONAL NUT CO. OF CALIFORNIA**  
Reissue of patent, **16:56**

**SOPHISTICATION**  
Adequate utility, **7:5, 7:10**  
Non-obviousness, **9:50**  
Priority, **8:44**

**SOUND MORALS**  
Adequate utility, **6:15**

**SOUTH CAROLINA**  
History, **1:9**

**SOVEREIGN IMMUNITY**  
History, **1:14**

**SOYBEANS**  
Static physical configurations, **5:14**

**SPECIAL ACTS**  
Patent and Trademark Office (PTO), **2:2**

**SPECIAL DAMAGES**  
Adequate commerciality, **14:78**

**SPECIAL PRIVILEGES**  
History, **1:4**

**SPECIAL SERVICES**  
History, **1:4**

**SPECIAL SUB-RULES**  
Claims (this index)

**SPECIES**  
Genus and Species (this index)

**SPECIFICATION**  
Anticipation, lack of, **8:22**

## INDEX

**SPECIFICATION—Cont'd**  
Claims, 4:44  
Non-statutory hybrid inventions, 5:80  
Policy justification, 1:38  
Processes, 5:19, 5:21, 5:26  
Utility Requirement (this index)

**SPECIFIC USES**  
Adequate utility, 6:18

**SPECIMENS**  
Adequate utility, 7:11

**SPECTRA-PHYSICS, INC. v. COHERENT, INC.**  
Adequate utility, 7:48

**SPECULATION**  
Reissue of patent, 16:14

**SPERO v. RINGOLD**  
Priority, 8:46

**SPONTANEOUS STATEMENTS**  
Non-obviousness, 9:59

**SPORADIC RESULT**  
Anticipation, lack of, 8:25

**STANDARD HAVENS PRODUCTS, INC. v. GENCOR INDUSTRIES, INC.**  
Adequate commerciality, 14:27

**STANDARD OF PROOF**  
Invalidity, 17:18

**STANDARD OIL CO. v. NIPPON SHOKUBAI KAGAKU KOGYO CO.**  
Six-year limitation, 21:13

**STAPLE ARTICLES**  
Indirect infringement, 15:23

**STARE DECISIS**  
Claims, 4:20  
Non-statutory hybrid inventions, 5:75, 5:76

**STARTING AND ENDING MATERIALS**  
Adequate disclosure, 7:10, 7:12  
Non-Obviousness (this index)

**STARTING DATE**  
Reissue of patent, 16:113

**STATE ACTS**  
History, 1:9

**STATE COURTS**  
Generally, 1:14

**STATE DEPARTMENT**  
Claims, 4:2

**STATEMENTS**  
Non-obviousness, 9:59

**STATE OF MIND**  
Adequate commerciality, 14:17  
Adequate disclosure, 7:49  
Correction of inventorship, 10:60  
Non-obviousness, 9:43, 9:59  
Priority, 8:58

**STATE OF PRIOR ART**  
Adequate utility, 7:20

**STATE OF THE ART**  
Joint inventorship, 10:33  
Non-obviousness, 9:28, 9:38, 9:58  
Non-statutory hybrid inventions, 5:62, 5:69, 5:85

**STATE-OWNED ENTITIES**  
History, 1:14

**STATES**  
Sovereign immunity, 1:14

**STATE STATUTES**  
History, 1:13  
Inventorship, 10:6

**STATE STREET BANK & TRUST CO. v. SIGNATURE FINANCIAL GROUP, INC.**  
Non-statutory hybrid inventions, 5:79  
Processes, 5:30, 5:38

**STATIC PHYSICAL CONFIGURATION**  
Generally, 5:1, 5:7-5:18  
Abstractions, 5:10  
Agency decisions, 5:16  
Alloys, 5:9  
Amendment to statute, 5:14

**STATIC PHYSICAL  
CONFIGURATION—Cont'd**

Animal husbandry, **5:18**  
 Animals and related biotechnology, **5:8, 5:16-5:18**  
 Anticipation, lack of, **5:9, 5:16**  
 Anti-slavery provisions, **5:17**  
 Apparatus, **5:8**  
 Appeal and review, **5:9, 5:12, 5:15, 5:17**  
 Application, **5:8, 5:9**  
 Art, **5:11**  
 Article of manufacture, **5:8, 5:11, 5:17**  
 Asexually reproduced plants, **5:12**  
 Author's control, **5:11**  
 Bacteria, **5:14, 5:17**  
 Bioengineering, **5:13**  
 Biological components, **5:17**  
 Biotechnological advances, **5:14**  
 Breeding, **5:15, 5:17**  
 Budding, **5:14**  
 Business forms, **5:10**  
 Certificates, **5:14**  
 Certification, **5:15**  
 Certiorari, **5:17**  
 Change and modification, **5:14**  
 Chemicals and Chemistry (this index)  
 Claims, **5:8**  
 Combinations of mechanical powers and devices, **5:8**  
 Combinations of two or more substances, **5:9**  
 Commercial importance, **5:13**  
 Communication, **5:11**  
 Compilations, **5:11**  
 Complete living organisms, **5:17**  
 Compositions, **5:7-5:9, 5:17**  
 Compounds, **5:9**  
 Computer-related inventions, **5:8, 5:10**  
 Congress, **5:8, 5:14, 5:15, 5:17**  
 Constitutional law, **5:17**  
 Construction and interpretation, **5:8, 5:14, 5:15, 5:18**  
 Control, level of, **5:11**  
 Copying, **5:14**  
 Copyright, **5:11**

**STATIC PHYSICAL  
CONFIGURATION—Cont'd**

Corning v. Burden, **5:8**  
 Costs and expenses, **5:14**  
 Cotton, **5:14**  
 Court of Customs and Patent Appeals (CCPA), **5:9, 5:12, 5:17**  
 Courts, generally, **5:10**  
 Crops, **5:14**  
 Cultivated spores, **5:14**  
 Database, **5:11**  
 Definition, **5:8**  
 Delivery of health care and medicine, **5:18**  
 Denial, **5:8**  
 Department of Agriculture, **5:14**  
 Devices, **5:8**  
 Diamond v. Chakrabarty, **5:17**  
 Disclosure, **5:12, 5:14**  
 Ecology, **5:18**  
 Economics, **5:14, 5:15, 5:18**  
 Electronic field, **5:8**  
 Engineering processes, **5:14**  
 English law, **5:9**  
 Ethical issues, **5:18**  
 European Union, **5:18**  
 Every article devised by man except machinery upon the one side and compositions of matter on the other, **5:8**  
 Evidence, **5:17**  
 Examination of application, **5:17**  
 Exceptions, exclusions, and exemptions generally, **5:7**  
 functional relationships, **5:12**  
 judicial exceptions, **5:10, 5:17**  
 machines and articles of manufacture, **5:8**  
 plants, **5:14, 5:17**  
 printed matter, **5:11**  
 Exclusive rights, **5:15**  
 Ex parte Allen, **5:17**  
 Ex parte examination, **5:17**  
 Factual compilations, **5:11**  
 Factual information stored on computer-readable media, **5:11**  
 Farmers and farming, **5:14, 5:18**

## INDEX

**STATIC PHYSICAL  
CONFIGURATION—Cont'd**  
Federal Circuit, **5:11, 5:15**  
Filing, **5:17**  
First-generation hybrids, **5:14**  
Foodstuffs, production of, **5:18**  
Foreign countries, **5:18**  
Fourteenth Amendment, **5:17**  
Fungi, **5:14**  
Gases, **5:9**  
Gels, **5:9**  
Generating subsequent seed stock, **5:15**  
Genetically engineered animals, **5:17**  
Grafting, **5:14**  
Handmade mechanical clock, **5:8**  
Health care, **5:18**  
History, **5:14, 5:15, 5:17**  
Human audience, communication to, **5:11**  
Human-directed expression, **5:11**  
Human manipulation, **5:12**  
Human operator, **5:12**  
Hybrid combinations, **5:8**  
Hybrid for, **5:11**  
Hybrids, **5:14**  
Imports and exports, **5:14**  
Incentives, **5:14**  
Individual specimens, **5:17**  
Industrial apparatus, **5:8**  
Infringement, **5:7**  
In re Breslow, **5:9**  
In re Lowry, **5:11**  
In re Miller, **5:12**  
In situ production, **5:9**  
Intent, **5:14, 5:15, 5:17**  
Interlocutory appeal, **5:15**  
International community, **5:18**  
International Convention for Protection of New Varieties of Plants, **5:14**  
Interrelated component parts, **5:8**  
Judicial decisions, **5:16**  
Judicial exceptions, **5:10, 5:17**  
Kits, **5:8**  
Legislation, **5:15**  
Legislative history, **5:14, 5:15**  
Licenses and permits, **5:15**

**STATIC PHYSICAL  
CONFIGURATION—Cont'd**  
Limitations and restrictions, **5:8, 5:11, 5:14-5:17**  
Liquids, **5:9**  
Literary works, **5:11**  
Living organisms, **5:7, 5:16**  
Machine-readable data, **5:11**  
Machines, **5:7, 5:8**  
Manufactures, **5:7**  
Mathematical demands, **5:12**  
Mechanical devices, **5:8**  
Medicine, **5:18**  
Mental steps, **5:12**  
Mental theories, **5:10**  
Mistake and error, **5:15**  
Mixture of naturally occurring bacteria, **5:17**  
Mixtures, **5:9**  
Multicellular animals, **5:8, 5:16**  
Music, **5:11**  
Mutants, **5:14**  
Naturally occurring substances, **5:9, 5:17**  
Natural state, **5:9**  
Nature, products of, **5:17**  
New applications, **5:8**  
New living organism, **5:17**  
Newly found seedlings, **5:14**  
New song encoded on player piano roll, **5:11**  
Non-obviousness, **5:9, 5:12, 5:16**  
Non-statutory subject matter, **5:10, 5:11, 5:17**  
Novelty, **5:14**  
Painting, **5:8**  
Patentability, generally, **5:7**  
Patent Act of 1793, **5:8, 5:9**  
Patent Act of 1952, **5:14**  
Patent and Trademark Office (PTO), **5:9, 5:11, 5:14-5:17**  
Performance, **5:8**  
Petition for certiorari, filing of, **5:17**  
Physical proximity, **5:9**  
Pioneer Hi-Bred v J.E.G. Ag Supply, **5:15**  
Plant breeding, **5:15**

**STATIC PHYSICAL CONFIGURATION—Cont'd**  
Plant Patent Act (PPA), **5:13, 5:15, 5:17**  
Plants, **5:8, 5:13-5:15**  
Plant Variety Protection Act (PVPA), **5:13, 5:15, 5:17**  
Policy, animals and related biotechnology, **5:17**  
Policy justification, **5:11**  
Political interest, **5:15**  
Possession, **5:7**  
Powders, **5:9**  
Primitive living organisms, **5:16**  
Printed matter, **5:7, 5:10-5:12**  
Prior generations, **5:17**  
Production process, **5:9**  
Public domain, **5:18**  
Public welfare, **5:14**  
Purity, elevated levels of, **5:9**  
Qualifications, **5:15**  
Reasonably stable, **5:9**  
Rejection of application, **5:9, 5:17**  
Reproduction, **5:14, 5:15**  
Research and development, **5:14**  
Reversal, **5:9, 5:11, 5:12**  
Sales, **5:14, 5:15**  
Section 12, **5:14**  
Section 102, **5:9**  
Section 103, **5:9**  
Section 161 et seq., **5:13**  
Seeds, **5:15**  
Seed varieties, **5:14**  
7 USCA §§ 2321 et seq., **5:13**  
Sexually reproducing plants, **5:8, 5:13, 5:15**  
Single-celled microorganisms, **5:17**  
Solids, **5:9**  
Soybeans, **5:14**  
Supreme Court, **5:8, 5:15, 5:17**  
Technological methods distinguished, **5:7**  
Title and ownership, **5:18**  
Traditional animal husbandry, **5:17**  
Trial court, **5:15**  
Tuber-propagated plants, **5:14**  
Utility patents, **5:14**  
Validity, **5:8, 5:17**

**STATIC PHYSICAL CONFIGURATION—Cont'd**  
Value, **5:15**  
**STATUTE OF MONOPOLIES**  
Adequate Commerciality (this index)  
History, **1:6**  
Processes, **5:21**  
**STATUTE OF REPOSE**  
Section 286 defense. Six Year Limitation (this index)  
**STATUTES**  
See also specific statutes throughout this index  
Abandonment, **8:269**  
Adequate disclosure, **7:8**  
Claims, **4:5, 4:27, 4:51**  
Construction and interpretation, **8:151**  
Defend Trade Secrets Act of 2016, **1:13.90**  
Federal common law, relationship to, **1:13.20**  
Geographic Scope of Infringement (this index)  
History, **1:8, 1:13.80, 1:14**  
Initial statutes and development up to 1836, **1:18**  
Misuse of Patent (this index)  
Non-obviousness, **9:5, 9:6, 9:16, 9:34-9:37**  
Non-statutory hybrid inventions, **5:59**  
Preemption of state competition laws, **1:13.10**  
Processes, **5:33-5:35**  
Reforms of 1870, **2:34**  
Six-year limitation, revised statutes of 1874, **21:5**  
Technological scope, **13:19**  
**STATUTORY STEPS**  
Non-statutory hybrid inventions, **5:81**  
**STATUTORY SUBJECT MATTER**  
Generally, **5:1 et seq.**  
Advances, **5:5**  
Amendment of statute, **5:6**  
Animals and related biotechnology, **5:16-5:18**

## INDEX

### STATUTORY SUBJECT MATTER

#### —Cont'd

Anticipation, **5:1**  
Any new and useful art, machine, manufacture, or composition of matter, generally, **5:2**  
Any new and useful process, machine, manufacture, or composition of matter, generally, **5:1 et seq.**  
Any useful art, manufacture, engine, machine, or device, or any improvement therein, generally, **5:2**  
Application of technology, generally, **5:4**  
Applied technology, generally, **5:2**  
Articles of manufacture, generally, **5:4**  
Arts, generally, **5:4**  
Biological materials, **5:6**  
Biotechnology, **5:1, 5:2, 5:16-5:18**  
Bona fide questions, **5:1**  
Business methods. Processes (this index)  
Change and modification, **5:2**  
Chemicals and Chemistry (this index)  
Claims (this index)  
Cochran v. Deener, industrial processes, **5:22**  
Commercialization, **5:4, 5:5**  
Competition, **5:4, 5:5**  
Composition of matter, generally, **5:1 et seq.**  
Computer-Related Inventions (this index)  
Configuration, **5:1**  
Congressional intent, **5:1 et seq.**  
Constitutional law, **5:2**  
Construction and interpretation, **5:1 et seq.**  
Contests, **5:1**  
Copyrights, **5:4**  
Costs on society, **5:5**  
Courts, generally, **5:1**  
Defenses, **5:5**  
Designs, **5:46**  
Devices, generally, **5:2**  
Disclosure, **5:1**

### STATUTORY SUBJECT MATTER

#### —Cont'd

Doing business, methods of, **5:2, 5:6**  
End results, **5:24**  
Engines, generally, **5:2**  
European Patent Convention, **5:4**  
Exceptions and exclusions generally, **5:1-5:6**  
functional relationships, **5:12**  
ministerial acts, **5:27**  
Expectations, **5:4**  
Exploitation, **5:4, 5:5**  
Factual compilations, **5:42**  
Fine arts, **5:1**  
Foodstuffs, generally, **5:5**  
Foreign countries, **5:4, 5:5**  
Formulae, **5:24**  
Functional relationships, **5:12**  
Future research, **5:5**  
Historical development and policy justification, generally, **5:2-5:5**  
Hybrid claiming, **5:38**  
Hybrid inventions. Non-Statutory Hybrid Inventions (this index)  
Improvements, generally, **5:2**  
Incentives, **5:4, 5:5**  
Industrial processes, **5:20-5:23**  
Infringement, **5:5**  
Intellectual property, generally, **5:2**  
Intellectual property law, **5:5**  
Intent, **5:1, 5:4, 5:6**  
Intervention, **5:4**  
Japanese, **5:4**  
Judicial decisions, **5:6**  
Judicial exceptions, **5:4**  
Limitations and restrictions, generally, **5:1**  
Machines, generally, **5:1 et seq.**  
Manufacturing, generally, **5:1 et seq.**  
Mathematics generally, **5:1**  
algorithms, **5:44**  
formulae, **5:6, 5:24**  
pure mathematics, matters of, **5:4**  
Medical and surgical procedures, **5:39**  
Mental steps, **5:6, 5:25-5:27, 5:45**  
Methods per se, **5:2**

**STATUTORY SUBJECT MATTER**

—Cont'd

- Ministerial acts, 5:27
- Natural phenomena, 5:24
- Negotiations, 5:5
- New and useful, generally, 5:2
- New technological fields, 5:2
- Non-obviousness, 5:1
- Non-Statutory Hybrid Inventions (this index)
- Non-Statutory Subject Matter (this index)
- Observations, 5:36-5:38
- Patentability, 5:4
- Patent Act of 1790, 5:2
- Patent Act of 1793, 5:2
- Patent Act of 1836, 5:2
- Patent Act of 1870, 5:2
- Patent Act of 1952, 5:2, 5:6
- Patent and Trademark Office (PTO), 2:3, 5:2
- Performance of sequential acts over period of time, 5:1
- Peripheral claiming, industrial processes, 5:22
- Pharmaceuticals, generally, 5:5
- Physical structures, generally, 5:1 et seq.
- Physical transformation, 5:37, 5:53
- Pioneer hi-bred case, 5:15
- Plants, 5:13-5:15
- Policy justification, generally, 5:2-5:5
- Printed matter, 5:4, 5:6, 5:10-5:12, 5:42
- Private single-source control, 5:5
- Processes (this index)
- Profits, 5:4
- Pure mathematics, matters of, 5:4
- Pure scientific, matters of, 5:4
- Quality of life, 5:5
- Research and development, 5:5
- Science, 5:1, 5:4
- Scientific principles, 5:24
- Section 101, generally, 5:1 et seq.
- Series of acts or steps of method, 5:1 et seq.
- Single-source control, 5:4, 5:5
- Social cost, 5:5

**STATUTORY SUBJECT MATTER**

—Cont'd

- Static Physical Configuration (this index)
- Steps of method, 5:1 et seq.
- Structures, generally, 5:6
- Surgical methods, generally, 5:5
- Surgical procedures, 5:39
- Technical ideas, 5:4
- Time and date, 5:1, 5:4
- Undue social cost, 5:5
- Useful art, generally, 5:2
- Usefulness, generally, 5:1 et seq.
- Utility patents, 5:14
- Validity, 5:4
- Value, 5:5

**STAY OF PROCEEDINGS**

- Reexamination, parallel proceedings, 16:131

**STEARNS-ROGER MFG. CO. v.**

**RUTH**

- Adequate commerciality, 14:29

**STEP-BY-STEP**

- Processes, 5:38

**STEPS OF METHOD**

- Statutory Subject Matter (this index)

**STIFFEL CO. v. SEARS,**

**ROEBUCK & CO.**

- Historical origins of patent grant, 1:13.40

**STIMPSON v. WEST CHESTER R CO.**

- Reissue of patent, 16:102

**STOCKHOLDERS**

- Indirect infringement, 15:19

**STORAGE MEDIA**

- Computer-Related Inventions (this index)

**STRATEGIES**

- Processes, 5:34

**STRICT LIABILITY**

- Adequate commerciality, 14:14

## INDEX

**STRUCTURAL EQUIVALENTS**  
Claims, 4:92

**STRUCTURAL SIMILARITIES**  
Non-obviousness, 9:73, 9:74

**STRUCTURES ACCOMPANIED BY PROPERTIES OR USES**  
Non-Obviousness (this index)

**STUCKI CO. v. BUCKEYE STEEL CASTINGS CO.**  
Six-year limitation, 21:14

**STUDIENGESELLSCHAFT KOHLE MBH v. EASTMAN KODAK CO.**  
Adequate utility, 7:48

**SUA SPONTE ACTS AND MATTERS**  
Patent and Trademark Office (PTO), 2:10

**SUBCOMBINATION**  
Adequate disclosure, 7:24  
Adequate utility, 6:6  
Anticipation, lack of, 8:12  
Claims, 4:63, 4:64  
Non-statutory hybrid inventions, 5:50  
Priority, 8:47

**SUBCOMBINATIONS**  
Temporal scope, 11:49

**SUB-ISSUE**  
Adequate utility, 6:7

**SUBJECTIVITY**  
Abandonment, history, 1:21  
Appreciation  
    adequate disclosure, 7:34, 7:39  
    adequate utility, 7:27  
Creativity, non-obviousness, 9:20  
Insight, non-obviousness, 9:41-9:43  
Judgments, non-obviousness, 9:54  
Knowledge, priority, 8:52  
Non-obviousness, 9:7, 9:20, 9:41-9:43, 9:54  
Outlook, non-statutory hybrid inventions, 5:49  
Possession, 7:31, 8:46  
State of mind, non-obviousness, 9:43

**SUBJECTIVITY—Cont'd**  
Thought to perform, processes, 5:25

**SUBJECT MATTER**  
Claims (this index)  
Medical activity, section 287(c)  
defense, 20:17

**SUBJECT MATTER JURISDICTION**  
Claims, 4:6  
History, 1:14  
Patent and Trademark Office (PTO), 2:37

**SUBSEQUENT ACTS AND MATTERS**  
Adequate commerciality, 14:24, 14:27, 14:74  
Claims, 4:40  
Non-obviousness, 9:4  
Priority, 8:126  
Reissue of patent, 16:45  
Technological scope, 13:39, 13:112

**SUBSERVIENCE**  
Claims (this index)

**SUBSTANTIALITY**  
Claims, substantially as described, 4:2  
Evidence  
    judicial review, 2:41, 2:42  
    Patent and Trademark Office (PTO), 2:39, 2:43  
Logic, non-obviousness, 9:43  
New question on patentability.  
    Reexamination (this index)  
Patent and Trademark Office (PTO), 2:21, 2:39, 2:43  
Prior conception, lack of anticipation, 8:7  
Reexamination, substantial new question of patentability, 16:129  
Rule-making, substantive, 2:21  
Technological scope of infringement, inessential differences, 13:67  
Uses, adequate utility, 6:18

**SUBSTITUTIONS**  
Technological scope, 13:104

**SUCCESS**  
Non-obviousness, **9:61-9:64, 9:62**  
Reexamination, **16:135**

**SUGGESTION**  
Joint Inventorship (this index)  
Non-obviousness, **9:66, 9:77**

**SUMMARY JUDGMENT**  
Adequate commerciality, **14:36, 14:79**  
Adequate disclosure, **7:52**  
Processes, **5:30**

**SUPERINTENDENT OF PATENTS**  
Patent and Trademark Office (PTO),  
**2:20, 2:31**

**SUPERVISORY PROCEDURE**  
Non-statutory hybrid inventions, **5:83**

**SUPPLEMENTS**  
Adequate utility, **7:18**  
Anticipation, lack of, **8:31**  
Materials, patents, sources, **7:10, 7:18**

**SUPPLY**  
Social costs of patenting, **1:33**

**SUPPRESSION**  
Anticipation, Lack Of (this index)  
Misuse of patent, **18:28**  
Non-obviousness, **9:28, 9:29, 9:34, 9:39**  
Priority, **8:143**

**SUPREME COURT**  
Adequate Commerciality (this index)  
Adequate disclosure, **7:14, 7:31, 7:48**  
Adequate utility, **6:6, 6:17**  
Alexander Milburn Co. v. Davis-Bourbonville Co., **8:140**  
Andrews v. Hovey, **8:206, 8:251**  
Anticipation, lack of, **8:18, 8:22, 8:27**  
Bain v. Morse, **8:101, 8:197**  
Bilski v. Kappos, **5:32**  
City of Elizabeth v. Nicholson Pavement Co., **8:250**  
Claims (this index)  
CLS v. Alice, **5:32.50**

**SUPREME COURT—Cont'd**  
Computer-related inventions, **5:44**  
Electric Storage Battery Co. v. Shimadzu, **8:102**  
Estoppel (this index)  
Examination of Original Application (this index)  
Geographic Scope of Infringement (this index)  
History, **1:5, 1:14-1:24**  
In re Borst, **8:165**  
In re Hilmer, **8:121, 8:153**  
Invalidity, early development, **17:22**  
Inventorship, **10:6, 10:7, 10:11**  
Joint inventorship, **10:33**  
Joint Inventorship (this index)  
Laches, Supreme Court cases  
Petrella v. Metro-Goldwyn-Mayer, Inc., **23:44**  
SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC., **23:45**  
Licenses and Permits (this index)

**SUPREME COURT OF DISTRICT OF COLUMBIA (SCDC)**  
Patent and Trademark Office (PTO),  
**2:34, 2:36**

**SURGICAL METHODS AND PROCEDURES**  
Statutory Subject Matter (this index)

**SYDEMAN v. THOMA**  
Priority, **8:60-8:62**

**SYMBOLS**  
History, **1:15**

**SYMMETRY**  
Conceptual inconsistencies, **8:100**  
Priority, **8:100, 8:193**

**SYNTHESIS**  
Technological Scope of Infringement (this index)

**TANGIBLE BENEFIT**  
Adequate utility, **6:16**

**TARGET AUDIENCE**  
Adequate disclosure, **7:16**

## INDEX

### TARIFFS

Adequate commerciality, **14:39**  
General Agreement on Tariffs and  
Trade (GATT) (this index)

### TAXATION

History, **1:3**  
Processes, **5:34**

### TEACHING

Anticipation, lack of, **8:19, 8:31**  
Disclosure  
background knowledge, **7:15, 7:16, 7:19**  
claimed configuration, **7:6, 7:9**  
how to use, **7:13**  
method of making single-embodi-  
ment, **7:10**

### TECHNOLOGICAL SCOPE OF INFRINGEMENT

Generally, **13:1 et seq.**  
Abandonment, **13:89**  
Accuracy, **13:54**  
All-elements rule, **13:22, 13:113**  
Applications, **13:106**  
Arguments, **13:105**  
Burden of proof, **13:84**  
Cancellations, **13:104**  
Case law  
Festo Corp. v. Shoketsu Kinzoku  
Kogyo Kabushiki Co., Ltd.  
generally, **13:111**  
Equivalents, Doctrine of, below  
Graver Tank & Mfg. Co. v. Linde  
Air Products Co., **13:12**  
Hilton Davis Chemical Co. v.  
Warner-Jenkinson Co., Inc.  
Equivalents, Doctrine of,  
below  
International Rectifier Corp. v.  
Ixys Corp., **13:59**  
Johnson & Johnston v. R.E. Ser-  
vice Co., **13:38**  
Maxwell v. J. Baker, Inc., **13:95**  
Wilson Sporting Goods case,  
**13:82**  
Winans v. Denmead, **13:6**  
YBM Magnex, Inc. v. USITC,  
**13:96**

### TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd

Central claiming, **13:5-13:7, 13:114**  
Claimed defined, **13:98**  
Claiming  
central claiming and means expres-  
sions, **13:114**  
Equivalents, Doctrine of, below  
peripheral claiming, below  
Claim theory, impact of  
generally, **13:4-13:8**  
central claiming, **13:5-13:7**  
peripheral claiming, **13:8**  
Winans v. Denmead, **13:6**  
Claim theory, role of, **13:42**  
Classical estoppel, **13:89**  
Claude Neon Lights v. E. Machlett &  
Son, **13:71**  
Commentary and synthesis.  
Equivalents, Doctrine of, below  
Concurrences, **13:25, 13:33, 13:37**  
Context and inadvertent mistakes,  
**13:57, 13:58**  
Decisions. Equivalents, Doctrine of,  
below  
Defenses. Equivalents, Doctrine of,  
below  
Definitional accuracy, **13:54**  
Definitions  
claimed, **13:98**  
disclosed, **13:99**  
Descriptions by learned hand, **13:11**  
Disclosed defined, **13:99**  
Disclosure dedication. Equivalents,  
Doctrine of, below  
Discovery, **13:56**  
Dissenting opinions, **13:17, 13:33,**  
**13:37**  
Doctrine of Equivalents. Equivalents,  
Doctrine of, below  
Early Federal Circuit decisions,  
**13:94-13:96**  
Early history, **13:3**  
Early procedural history, **13:28**  
Element-by-element inquiry, **13:73**  
En banc decision, **13:31-13:33**  
Equity, **13:20, 13:61**

**TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd**

Equivalents, Doctrine of  
generally, **13:52-13:113**  
commentary and synthesis. Factual  
equivalency, below this group  
decisions  
early Federal Circuit decisions,  
**13:94-13:96**  
en banc decision, **13:31-13:33**  
patentee's conduct, subsequent  
decisions, **13:112**  
peripheral claiming, below this  
group  
defenses. Legal defenses, below  
this group  
disclosure dedication. Patentee's  
conduct, below this group  
estoppel  
generally, **13:23**  
patentee's conduct, below this  
group  
factual equivalency  
generally, **13:63-13:76**  
Claude Neon Lights v. E.  
Machllett & Son, **13:71**  
commentary and synthesis, gen-  
erally, **13:68-13:72**  
element-by-element inquiry,  
**13:73**  
formulation of test, generally,  
**13:65-13:71**  
function, way, result, **13:66**  
history, **13:64**  
illustrative diagram, **13:72**  
insubstantial differences, **13:67**  
inventive concept, **13:69**  
known interchangeability,  
**13:75, 13:76**  
peripheral claiming, **13:21**  
pioneer inventions versus  
improvements, **13:74**  
policy justification, **13:64**  
Sanitary Refrigerator Co. v.  
Winters, **13:70**  
synthesis, generally, **13:68-**  
**13:72**  
test, formulation of, generally,  
**13:65-13:71**

**TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd**

Equivalents, Doctrine of—Cont'd  
factual equivalency—Cont'd  
time frame, **13:76**  
Federal Circuit  
generally, **13:94-13:96**  
peripheral claiming, below this  
group  
Festo Corp. v. Shoketsu Kinzoku  
Kogyo Kabushiki Co., Ltd.  
generally, **13:111**  
peripheral claiming, below this  
group  
formulation of test. Factual  
equivalency, above this group  
Graver Tank & Mfg. Co. v. Linde  
Air Products Co., **13:12**  
Hilton Davis Chemical Co. v.  
Warner-Jenkinson Co., Inc.  
Peripheral claiming, below  
this group  
history. Patentee's conduct, below  
this group  
Johnson & Johnston v. R.E. Ser-  
vice Co., **13:38**  
language issues. Policy justifica-  
tion, below this group  
legal defenses  
generally, **13:77-13:113**  
all-elements rule, **13:113**  
graphical illustration, **13:78**  
patentee's conduct, below this  
group  
prior art, below this group  
1950, developments to, **13:10,**  
**13:11**  
1994, developments to, **13:13**  
patentee's conduct  
generally, **13:87-13:112**  
abandonment, **13:89**  
arguments, **13:105**  
cancellations, **13:104**  
claimed defined, **13:98**  
classical estoppel, **13:89**  
dedication via other activities,  
**13:100**  
disclosed defined, **13:99**

## INDEX

**TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd**

Equivalents, Doctrine of—Cont'd  
patentee's conduct—Cont'd  
disclosure dedication, generally,  
**13:92-13:100**  
early Federal Circuit decisions,  
**13:94-13:96**  
estopping events, generally,  
**13:103-13:108**  
extent of estoppel, **13:109-13:112**  
Festo case, **13:111**  
formal rejections and restrictions, **13:107**  
historical development, **13:93**  
history, prosecution history  
estoppel, generally, **13:101-13:112**  
insufficient disclosure rejections,  
**13:108**  
Johnson & Johnston Associates  
Inc. v. R.E. Service Co.,  
**13:97**  
judicial estoppel, **13:91**  
Maxwell v. J. Baker, Inc., **13:95**  
narrowing of related claims and  
applications, **13:106**  
novelty requirement, analogy to,  
**13:90**  
policy justification, **13:88-13:91, 13:102**  
prosecution history estoppel,  
generally, **13:101-13:112**  
subsequent decisions, **13:112**  
substitutions, **13:104**  
underlying purpose, **13:110**  
YBM Magnex, Inc. v. USITC,  
**13:96**  
peripheral claiming  
generally, **13:10-13:39, 13:52-13:113**  
decisions  
Festo Corp. v. Shoketsu  
Kinzoku Kogyo  
Kabushiki Co., Ltd.,  
below this subgroup  
Hilton Davis Chemical Co. v.  
Warner-Jenkinson Co.,

**TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd**

Equivalents, Doctrine of—Cont'd  
peripheral claiming—Cont'd  
decisions—Cont'd  
Inc., below this subgroup  
descriptions by learned hand,  
**13:11**  
Federal Circuit  
generally, **13:13**  
developments to 1994, **13:13**  
Festo Corp. v. Shoketsu  
Kinzoku Kogyo  
Kabushiki Co., Ltd.,  
**13:30-13:33, 13:35-13:37**  
Hilton Davis Chemical Co. v.  
Warner-Jenkinson Co.,  
**13:15-13:17, 13:26**  
Festo Corp. v. Shoketsu  
Kinzoku Kogyo Kabushiki  
Co., Ltd.  
generally, **13:27-13:37**  
concurrences, Federal Circuit  
decision on second  
remand, **13:37**  
concurrences, Federal Circuit  
en banc decision, **13:33**  
dissents, Federal Circuit decision  
on second remand,  
**13:37**  
dissents, Federal Circuit en  
banc decision, **13:33**  
early procedural history,  
**13:28**  
facts, **13:29**  
Federal Circuit 3-judge decision  
on remand, **13:30**  
Federal Circuit decision on  
second remand, **13:35-13:37**  
Federal Circuit en banc decision,  
**13:31-13:33**  
majority opinion, Federal  
Circuit decision on  
second remand, **13:36**  
majority opinion, Federal  
Circuit en banc decision,  
**13:32**

**TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd**

Equivalents, Doctrine of—Cont'd  
 peripheral claiming—Cont'd  
 Festo Corp. v. Shoketsu  
 Kinzoku Kogyo Kabushiki  
 Co., Ltd.—Cont'd  
 Supreme Court opinion,  
**13:34**  
 Graver Tank & Mfg. Co. v.  
 Linde Air Products Co.,  
**13:12**  
 Hilton Davis Chemical Co. v.  
 Warner-Jenkinson Co., Inc.  
 generally, **13:14-13:26**  
 all-element rule, **13:22**  
 concurring opinion, **13:25**  
 dissenting opinions, **13:17**  
 equity vs. law, **13:20**  
 factual equivalency, **13:21**  
 Federal Circuit decision,  
 initial, **13:15-13:17**  
 Federal Circuit decision on  
 remand, **13:26**  
 majority opinion, initial  
 Federal Circuit decision,  
**13:16**  
 Patent Act of 1952, effect of,  
**13:19**  
 prosecution history estoppel,  
**13:23**  
 Supreme Court decision, gen-  
 erally, **13:18-13:25**  
 time frame, **13:24**  
 Johnson & Johnston v. R.E. Ser-  
 vice Co., **13:38**  
 1950, developments to, **13:10,**  
**13:11**  
 1994, developments to, **13:13**  
 subsequent developments, **13:39**  
 policy justification  
 generally, **13:53-13:62**  
 context and inadvertent  
 mistakes, **13:57, 13:58**  
 factual equivalency, **13:64**  
 infringement by equivalents as  
 reaction, **13:60**  
 International Rectifier Corp. v.  
 Ixys Corp., **13:59**

**TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd**

Equivalents, Doctrine of—Cont'd  
 policy justification—Cont'd  
 language issues, generally,  
**13:55-13:60**  
 later-discovered technology,  
**13:56**  
 law versus equity, **13:61**  
 non-patent example, context and  
 inadvertent mistakes, **13:58**  
 notice versus definitional  
 accuracy, **13:54**  
 patentee's conduct, **13:88-**  
**13:91, 13:102**  
 patent example, **13:59**  
 prior art, **13:80**  
 reissue, relation to, **13:62**  
 prior art  
 generally, **13:79-13:86**  
 burden of proof, **13:84**  
 history, **13:80**  
 hypothetical claim, **13:83**  
 obvious variations, **13:81, 13:82**  
 other issues of patentability,  
**13:86**  
 patent claim, required relation  
 to, **13:85**  
 policy justification, **13:80**  
 Wilson Sporting Goods case,  
**13:82**  
 prosecution history estoppel. Pate-  
 ntee's conduct, above this  
 group  
 subsequent developments, **13:39**  
 synthesis. Factual equivalency,  
 above this group  
 test. Factual equivalency, above  
 this group  
 Estoppel. Equivalents, Doctrine of,  
 above  
 Facts, **13:29**  
 Factual equivalency. Equivalents,  
 Doctrine of, above  
 Federal Circuit. Equivalents, Doc-  
 trine of, above  
 Festo Corp. v. Shoketsu Kinzoku  
 Kogyo Kabushiki Co., Ltd.  
 Equivalents, Doctrine of, above

## INDEX

### TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd

Formal rejections and restrictions, **13:107**  
Formulation of test. Equivalents, Doctrine of, above  
Function, way, result, **13:66**  
Graphical illustration, **13:78**  
Graver Tank & Mfg. Co. v. Linde Air Products Co., **13:12**  
Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc. Equivalents, Doctrine of, above  
Historical development, **13:93**  
History generally, **13:2-13:39**  
claim theory, impact of, above  
early history, **13:3**  
Equivalents, Doctrine of, above  
Hypothetical claim, **13:83**  
Illustrative diagram, **13:72**  
Improvements, **13:74**  
Inadvertent mistakes, **13:57, 13:58**  
Infringement by equivalents as reaction, **13:60**  
Insubstantial differences, **13:67**  
Insufficient disclosure rejections, **13:108**  
International Rectifier Corp. v. Ixys Corp., **13:59**  
Inventive concept, **13:69**  
Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc., **13:97**  
Johnson & Johnston v. R.E. Service Co., **13:38**  
Judicial estoppel, **13:91**  
Justification. Policy justification, below  
Known interchangeability, **13:75, 13:76**  
Language issues. Equivalents, Doctrine of, above  
Later-discovered technology, **13:56**  
Law versus equity, **13:20, 13:61**  
Learned hand, **13:11**  
Legal defenses. Equivalents, Doctrine of, above  
Limitations and restrictions, **13:107**

### TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd

Literal infringement generally, **13:44-13:51**  
additional elements or functions, **13:49**  
all-elements rule, **13:47-13:50**  
alternative species, **13:50**  
claim interpretation, relation to, **13:46**  
history, **13:45**  
methods, all-elements rule, **13:48**  
peripheral claiming, generally, **13:44-13:51**  
policy justification, **13:45**  
reverse doctrine of equivalents, **13:51**  
Majority opinion, **13:16, 13:32, 13:36**  
Maxwell v. J. Baker, Inc., **13:95**  
Means expressions, **13:114**  
Mistakes, **13:57, 13:58**  
1994, developments to, **13:13**  
Notice and knowledge, **13:54, 13:75, 13:76**  
Novelty requirement, analogy to, **13:90**  
Obvious variations, **13:81, 13:82**  
Opinions. Case law, above  
Patent Act of 1952, effect of, **13:19**  
Patentee's conduct. Equivalents, Doctrine of, above  
Peripheral claiming generally, **13:43-13:113**  
claim theory, impact of, **13:8**  
Equivalents, Doctrine of, above  
literal infringement, above  
Pioneer inventions versus improvements, **13:74**  
Policy justification generally, **13:40-13:42**  
claims, role of, **13:42**  
claim theory, role of, **13:42**  
Equivalents, Doctrine of, above  
Prior art. Equivalents, Doctrine of, above  
Procedural history, **13:28**

**TECHNOLOGICAL SCOPE OF INFRINGEMENT—Cont'd**

Prosecution history estoppel.  
Equivalents, Doctrine of, above  
Reissue, **13:62**  
Rejections, **13:107, 13:108**  
Related claims and applications, **13:106**  
Remand, **13:26, 13:30, 13:35-13:37**  
Sanitary Refrigerator Co. v. Winters, **13:70**  
Second remand, **13:35-13:37**  
Statutes, effect of Patent Act of 1952, **13:19**  
Subsequent decisions, **13:112**  
Subsequent developments, **13:39**  
Substitutions, **13:104**  
Sufficiency, **13:108**  
Supreme Court. Case law, above  
Synthesis. Equivalents, Doctrine of, above  
Temporal scope, **11:5**  
Time frame, **13:24, 13:76**  
Variations, **13:81, 13:82**  
Wilson Sporting Goods case, **13:82**  
Winans v. Denmead, **13:6**  
YBM Magnex, Inc. v. USITC, **13:96**

**TECHNOLOGY**

Community, technical, non-obviousness, **9:54**  
Completeness, technical. Anticipation, Lack Of (this index)  
Completeness, technological, lack of anticipation, **8:32**  
Configuration, technical  
Inspection, **9:71**  
Non-obviousness, **9:19, 9:65, 9:70, 9:77**  
Configuration, technological claims, **4:65, 4:71, 4:94**  
Content of showing, technical, priority, **8:135**  
Details, technical, non-obviousness, **9:77**  
Disclosure, technical claims, **4:8**  
Joint inventorship, **10:44**  
Non-obviousness, **9:54**

**TECHNOLOGY—Cont'd**

Field, technological, non-obviousness, **9:17-9:19**  
Ideas, technical, statutory subject matter, **5:4**  
Knowledge, technological, joint inventorship, **10:33**  
Methods, technological, static physical configurations, **5:7**  
Scope of infringement. Technical scope of infringement (this index)  
Sophistication, technological, adequate disclosure, **7:5**  
Sufficiency, technical. Anticipation, Lack Of (this index)

**TELECOMMUNICATIONS INDUSTRY**

Processes, **5:23**

**TELEFLEX, INC. v. FICOSA NORTH AMERICA CORP.**

Adequate disclosure, **7:52, 7:53**

**TEMPORAL SCOPE OF INFRINGEMENT**

Generally, **11:1 et seq.**  
Adequate commerciality, **11:6**  
Appeals, **11:29**  
Applications  
extension of term under Section 156, application for, **11:43**  
onset at issuance versus filing, below  
PCT applications, **11:24**  
Basic 20-year patent term, **11:21-11:24**  
Basic extension, **11:42**  
Beginning of term, **11:38**  
Changes, **11:12-11:15**  
Claims, **11:22-11:24**  
Combinations and subcombinations, identity of drug products, **11:49**  
Commerciality, adequacy, **11:6**  
Domestic priority, **11:23**  
Drug products, **11:46-11:49**  
Economic justifications, **11:18**  
Effective date, **11:30, 11:35**

## INDEX

**TEMPORAL SCOPE OF INFRINGEMENT—Cont'd**

- 18-month publication. Onset at issuance versus filing, below
- Ending of term, **11:39**
- Esters, identity of drug products, **11:47**
- Extension of term under Section 156 generally, **11:40-11:49**
  - application for extension, **11:43**
  - basic extension, **11:42**
  - history, **11:41**
  - interim extensions, **11:44**
  - policy justification, **11:41**
  - special issues generally, **11:45-11:49**
    - combinations and subcombinations, **11:49**
    - identity of drug products, **11:46-11:49**
    - pro-drugs and metabolites, **11:48**
    - salts and esters, **11:47**
- Filing
  - history and policy justification, 20 years from filing, **11:14**
  - onset at issuance versus filing, below
- Foreign and domestic priority, claims of, **11:23**
- Geographic scope, **11:4**
- History
  - generally, **11:9-11:15**
  - convoyed changes, **11:15**
  - early U.S. law, **11:10**
  - extension of term under Section 156, **11:41**
  - intermediate period, 17 years from issuance, **11:11**
  - modern changes, **11:12-11:15**
  - onset at issuance versus filing, **11:20**
  - restoration of term, **11:13**
  - 20 years from filing, **11:14**
- Identity of drug products, **11:46-11:49**
- Infringement
  - generally, **11:1-11:7**
  - adequate commerciality, **11:6**

**TEMPORAL SCOPE OF INFRINGEMENT—Cont'd**

- Infringement—Cont'd
  - geographic scope, **11:4**
  - qualities of patent right, generally, **11:2-11:6**
  - technological scope, **11:5**
- Interim extensions under Section 156, **11:44**
- Issuance. Onset at issuance versus filing, below
- Justification. History and policy justification, above
- Limitations, **11:28, 11:34**
- Metabolites, identity of drug products, **11:48**
- Natural right, **11:17**
- 1994 provisions, applications filed on or after June 8, 1995, **11:26**
- 1999 provisions, applications filed on or after May 29, 2000, **11:27-11:30**
- Onset at issuance versus filing
  - generally, **11:19-11:37**
    - applications filed on or after June 8, 1995, **11:21-11:24**
    - basic 20-year patent term, **11:21-11:24**
  - 18-month publication. Provisional rights and 18-month publication, below this group
  - foreign and domestic priority, claims of, **11:23**
  - history, **11:20**
  - policy, **11:20**
  - prior PCT applications, claims to, **11:24**
  - provisional rights and 18-month publication
    - generally, **11:31-11:36**
    - effective date, **11:35**
    - limitations, **11:34**
    - policy justification, **11:32**
    - requirement of published application, **11:33**
    - value, general impact of value of patent, **11:36**

- restoration of term
- generally, **11:25-11:30**

**TEMPORAL SCOPE OF INFRINGEMENT—Cont'd**  
Onset at issuance versus filing  
—Cont'd  
restoration of term—Cont'd  
appeals, 1999 provisions, **11:29**  
effective date, 1999 provisions,  
**11:30**  
limitations, 1999 provisions,  
**11:28**  
1994 provisions, applications  
filed on or after June 8,  
1995, **11:26**  
1999 provisions, applications  
filed on or after May 29,  
2000, **11:27-11:30**  
procedures, 1999 provisions,  
**11:29**  
Sections 120 and 121, claims of  
benefit under, **11:22**  
term  
basic 20-year patent term,  
**11:21-11:24**  
restoration of term, above this  
group  
transitional provisions, applica-  
tions filed before June 8,  
1995, **11:37**  
Policy, onset at issuance versus filing,  
**11:20**  
Policy justification  
generally, **11:16-11:18**  
economic justifications, **11:18**  
extension of term under Section  
156, **11:41**  
natural right, **11:17**  
onset at issuance versus filing,  
**11:20, 11:32**  
Priority, **11:23**  
Prior PCT applications, claims to,  
**11:24**  
Procedures, 1999 provisions, **11:29**  
Provisional rights and 18-month pub-  
lication. Onset at issuance  
versus filing, above  
Publication. Onset at issuance versus  
filing, above  
Restoration of term  
history and policy justification,  
**11:13**

**TEMPORAL SCOPE OF INFRINGEMENT—Cont'd**  
Restoration of term—Cont'd  
onset at issuance versus filing,  
above  
Salts, identity of drug products, **11:47**  
Section 120, claims of benefit under,  
**11:22**  
Section 121, claims of benefit under,  
**11:22**  
Section 156. Extension of term under  
Section 156, above  
Special issues. Extension of term  
under Section 156, above  
Subcombinations, identity of drug  
products, **11:49**  
Technological scope, **11:5**  
Term  
beginning of term, **11:38**  
ending of term, **11:39**  
extension of term under Section  
156, above  
onset at issuance versus filing,  
above  
restoration of term, above  
Transitional provisions, applica-  
tions filed before June 8, 1995, **11:37**  
Value, general impact of value of  
patent, **11:36**

**TEMPORARY NATIONAL EMERGENCY COMMITTEE (TNEC)**  
Policy justification, **1:29**

**TENANCY IN COMMON**  
Joint inventorship, **10:49, 10:50**

**TERMINAL DISCLAIMERS**

History, **1:24**

**TERMINATION**

Examination of Original Application  
(this index)

**TERRITORIAL LIMITATIONS**

Adequate commerciality, **14:22**  
Misuse of patent, **18:33**

**TESTS AND EXPERIMENTS**

Adequate utility, **6:1, 6:8, 6:18**  
Anticipation, lack of, **8:5**

## INDEX

### TESTS AND EXPERIMENTS

#### —Cont'd

- Claims, **4:74, 4:92**
- Disclosure (this index)
- Joint Inventorship (this index)
- Non-Obviousness (this index)
- Non-statutory hybrid inventions, **5:59, 5:74, 5:78, 5:81**
- Patent and Trademark Office (PTO), **2:2**
- Priority (this index)
- Technological Scope of Infringement (this index)

### TEVA PHARMACEUTICALS USA, INC. v. PFIZER, INC.

Adequate commerciality, **14:80**

### TEVA PHARMACEUTICALS USA, INC. v. SANDOZ, INC.

Claims, **4:17.75**

### TEXAS DIGITAL INSTRUMENTS v. TELEGENIX

Claims, **4:38**

### TEXT

- Adequate disclosure, **7:5**
- Non-statutory hybrid inventions, **5:83**

### THE CLOTHWORKERS OF IPSWICH

History, **1:5**

### THEORETICAL JUSTIFICATION

Priority, **8:92**

### THIRD PARTIES

- Adequate commerciality, **14:32**
- Adequate disclosure, **7:24**
- Adequate utility, **6:7**
- Inventorship, **10:11, 10:13, 10:18**
- Joint inventorship, **10:28, 10:29, 10:42, 10:47, 10:49, 10:51**
- Non-obviousness, **9:28, 9:29, 9:40, 9:41, 9:59**
- Patent and Trademark Office (PTO), **2:12, 2:13, 2:18**
- Policy justification, **1:29**
- Priority, **8:232, 8:256**
- Reexamination, **16:135**

### THIRD-PARTY PARTICIPATION

Patent and Trademark Office (PTO), **2:13**

### THIRD PERSONS

- Indirect infringement, **15:14**
- Third Parties (this index)

### 35 USC

- Generally, **1:23**
- Adequate commerciality, section 271(e)(2)(a), **14:79**
- Claims, **4:5**
- Inventorship, **10:7**
- Section 01, **10:7**
- Section 102(f), **10:7**
- Section 115, **10:7**
- Section 261, **10:7**

### 37 CFR

- History, **1:20**
- Non-statutory hybrid inventions, **5:83**
- Patent and Trademark Office (PTO), **2:24, 2:25, 2:27, 2:28**

### THREAT

Estoppel, communication from patent owner, **24:26**

### 3D SYSTEMS, INC. v. AAROTECH LABORATORIES, INC.

Adequate commerciality, **14:47**

### TIGHLMAN v. PROCTOR

Anticipation, lack of, **8:27**

### TILGHMAN v. MITCHELL

Processes, **5:21**

### TIME OR DATE AND RELATED MATTERS

- Adequate Commerciality (this index)
- Adequate disclosure, **7:21, 7:22, 7:29, 7:56**
- Anticipation, Lack Of (this index)
- Correction of inventorship, **10:62, 10:68**
- Disclosure, **7:29, 7:52, 7:56**
- Effective Filing Date (this index)
- Examination of Original Application (this index)
- Geographic scope, **12:41**

<b>TIME OR DATE AND RELATED MATTERS—Cont'd</b>	
History, 1:5, 1:18	
Inventorship, 10:14	
Non-obviousness, 9:17, 9:57	
Non-Obviousness (this index)	
Patent and Trademark Office (PTO), 2:1	
Priority (this index)	
Reissue of patent, 16:40-16:46, 16:110-16:114	
Statutory subject matter, 5:1, 5:4	
Technological scope, 13:24, 13:76	
Temporal Scope of Infringement (this index)	
Utility Requirement (this index)	
<b>TIME-WISE PRIORITY</b>	
Adequate disclosure, 7:5	
Anticipation, lack of, 8:5	
Non-obviousness, 9:38	
Priority, 8:33	
<b>TITLE AND OWNERSHIP</b>	
Adequate commerciality, 14:18	
Claims, 4:2	
History, 1:16	
Inventorship (this index)	
Laches, insecure title, 23:31	
Non-Obviousness (this index)	
Policy justification, 1:28	
Static physical configurations, 5:18	
<b>TITLE TO LAND</b>	
History, 1:1	
<b>TOLLING</b>	
Six-year limitation, 21:23, 21:24	
<b>TOPPAN v. TIFFANY REFRIGERATOR CAR CO.</b>	
Adequate commerciality, 14:42	
<b>TORO v. WHITE CONSOL. INDUSTRIES</b>	
Claims, 4:37	
<b>TORPHARM, INC. v. RANBAXY PHARMACEUTICALS, INC.</b>	
Non-obviousness, 9:85	
<b>TOTAL INCAPACITY</b>	
Adequate utility, 6:11	
<b>TOTAL USES</b>	
Adequate utility, 6:16	
<b>TOWNS</b>	
History, 1:4	
<b>TRADEMARKS</b>	
See also Patent and Trademark Office (PTO) (this index)	
Adequate disclosure, 7:12	
Designs, 5:46	
History, 1:14, 1:15	
<b>TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS, AGREEMENT ON (TRIPs)</b>	
Adequate commerciality, 14:10, 14:27, 14:46	
Prior inventor, prior-user rights, 22:11	
<b>TRADE SECRETS</b>	
Adequate disclosure	
generally, 7:1	
best mode, 7:46, 7:50	
history and policy justification, 7:5	
single-embodiment, 7:17, 7:21	
Adequate utility, 6:5	
Correction of inventorship, 10:68	
History, 1:15	
Inventorship, 10:3	
Policy justification, 1:38	
Prior inventor, prior-user rights, 22:6	
Processes, 5:30	
<b>TRADE SHOWS</b>	
Adequate commerciality, 14:33	
<b>TRAINING AND TRAINING MATERIALS</b>	
Adequate disclosure, 7:16	
Non-statutory hybrid inventions, 5:83	
<b>TRANSCO PRODUCTS INC. v. PERFORMANCE CONTRACTING, INC.</b>	
Adequate disclosure, 7:56	

## INDEX

**TRANSFERRING FUNDS**  
Non-statutory hybrid inventions, **5:83**

**TRANSFERS OF RIGHTS AND TITLE**  
Adequate commerciality, **14:42**  
Correction of inventorship, **10:61, 10:64, 10:68**  
Invalidity (this index)  
Inventorship, generally, **10:7-10:17**  
Joint inventorship, **10:25**

**TRANSFORMATION**  
Processes, **5:19, 5:22, 5:30**

**TRANSITIONAL PHRASE**  
Claims, **4:96, 4:98, 4:99**

**TRANSITIONAL PROVISIONS**  
Temporal scope, **11:37**

**TRANSITORY EMBODIMENTS**  
Geographic scope, **12:44**

**TREATISES**  
Inventorship, **10:2**  
Joint inventorship, **10:24**  
Priority, **8:154**  
Processes, **5:30**

**TRIAL-AND-ERROR**  
Adequate disclosure, **7:20**

**TRIAL COURTS**  
Claims, **4:2, 4:80**  
Non-obviousness, **9:3, 9:50**  
Non-statutory hybrid inventions, **5:79**  
Processes, **5:21**  
Static physical configurations, **5:15**

**TRIPARTITE ANALYSIS**  
Priority, **8:60**

**TRIPARTITE FORM OF INDIVIDUAL CLAIMS**  
Generally, **4:96-4:99**

**TRIPS**  
Trade-Related Aspects of Intellectual Property Rights, Agreement on (TRIPs) (this index)

**TROPIX INC. v. LUMIGEN INC.**  
Claims, **4:74**

**TRUE INVENTOR**  
Adequate disclosure, **7:28**  
Correction of inventorship, **10:60, 10:66**

**TRUE METHOD**  
Processes, **5:27**

**TUBER-PROPAGATED PLANTS**  
Static physical configurations, **5:14**

**TUBULAR BODY**  
Claims, **4:97, 4:98**

**21 USCA §§ 151 TO 158**  
Adequate commerciality, **14:76**

**28 USCA § 1498**  
Adequate commerciality, **14:55**

**TWO-PRONG TEST**  
Adequate disclosure, **7:49**

**2002 AMENDMENTS**  
Reissue of patent, **16:67, 16:68**

**TWO-YEAR TIME LIMIT**  
Reissue of patent, **16:79**

**TYING ARRANGEMENTS**  
Misuse of patent, **18:41**

**TYPICAL SOPHISTICATION**  
Adequate disclosure, **7:10**

**UNASSISTED HUMAN THOUGHT**  
Processes, **5:26**

**UNCLEAN HANDS**  
Estoppel, **24:31**  
Laches, **23:41**

**UNDERLYING POLICY**  
Non-obviousness, **9:46**

**UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY**  
Patent and Trademark Office (PTO), **2:22**

**UNDERSTANDING OF CONFIGURATIONS**  
Technological configuration, **9:71**

**UNDUE DELAY**

Non-obviousness, **9:39**

**UNDUE EXPERIMENTATION**

Adequate disclosure, **7:20, 7:25**

**UNDUE SOCIAL COST**

Statutory subject matter, **5:5**

**UNEXPECTED PROPERTIES**

Non-obviousness, **9:77**

Priority, **8:52**

**UNEXPECTED RESULTS**

Non-obviousness, **9:76**

**UNFAIR COMPETITION**

History, **1:14**

**UNIFIED STANDARD**

Priority, **8:61**

**UNIFORMITY**

Non-statutory hybrid inventions, **5:59**

**UNILATERAL ACTION**

Joint inventorship, **10:52**

**UNILATERAL CONTRACT**

Justification, **1:39**

**UNION OIL CO. OF CALIFORNIA  
v. ATLANTIC RICHFIELD CO.**

Adequate commerciality, **14:37**

**UNIVERSITIES**

Non-obviousness, **9:47**

**UNPREDICTABLE ARTS**

Non-obviousness, **9:67**

**UNRESTRICTED SALES**

Defenses, implied-in-law licenses,  
**19:39**

**UNSCRUPULOUS ENTITY**

Adequate utility, **6:15**

**UNWANTED ACTIVITY**

Adequate utility, **6:5**

Utility requirement, **6:5**

**UNWANTED BEHAVIOR**

Adequate utility, **6:5**

**UNWANTED FIELDS**

Adequate utility, **6:5**

**URUGUAY ROUND**

Adequate commerciality, **14:10**

**U.S. INDUSTRIAL CHEMICALS v.  
CARBIDE & CARBON  
CHEMICALS CORPORATION**

Reissue of patent, **16:90**

**USEFUL ARTS**

Copyright clause, **1:11**

History, **1:12**

Inventorship, **10:2, 10:7**

Non-obviousness, **9:9**

Patent and Trademark Office (PTO),  
**2:15, 2:20**

Priority, **8:56**

Statutory subject matter, **5:2**

Statutory Subject Matter (this index)

Utility Requirement (this index)

**USEFULNESS**

Claims, **4:66**

Non-obviousness, **9:2**

Statutory Subject Matter (this index)

Utility Requirement (this index)

**USEFUL PROPERTY**

Non-obviousness, **9:77**

**USES**

Non-Obviousness (this index)

**UTILITY PATENT**

Designs, **5:46**

Statutory subject matter, **5:14**

**UTILITY REQUIREMENT**

Generally, **6:1 et seq.**

Abstract acts and matters, **6:18**

Adequate disclosure, **6:6, 6:19**

Administrative law and procedure,  
**6:4**

Advance in art, **6:3**

Amusement, **6:15**

Animals, **6:5, 6:18**

Anticipation, lack of, **6:7, 8:22**

Apparatus, **6:15**

Appeal and review, **6:6, 6:17**

Art, advance in, **6:3**

## INDEX

**UTILITY REQUIREMENT—Cont'd**

Bedford v. Hunt, **6:4, 6:6, 6:7, 6:9**  
Biotechnological arts, **6:6**  
Brenner v. Manson, **6:6, 6:7, 6:17-6:19**  
Burden of proof, **6:16**  
Case law, **6:14**  
Certiorari, **6:6**  
Change and modification, **6:18**  
Charge to the jury, **6:9**  
Chemical arts, **6:7, 6:19**  
Chemical markers, construction of, **6:18**  
Chemical process, **6:17**  
Chemical products, **6:1, 6:6, 6:16**  
Circumstantial evidence, **6:20**  
Clear and convincing evidence, **6:14**  
Cloning of multicellular animals or humans, **6:5**  
Combinations, **6:6**  
Commercialized, **6:4**  
Commercially salable, **6:8, 6:11**  
Commissioner of Patents, **6:6**  
Compounds, **6:18**  
Congress, **6:9**  
Constitutional law, **6:2, 6:5, 6:9**  
Construction and interpretation, generally, **6:1**  
Consumer fraud, **6:5, 6:15**  
Consumer Products Safety Commission, **6:5**  
Correctness, **6:13**  
Costs and expenses, **6:4, 6:10**  
Court of Customs and Patent Appeals (CCPA), **6:6, 6:17**  
Current, tangible benefit, **6:16**  
Currently available, **6:18**  
Dangerous, **6:12**  
Date of invention, **6:7**  
Deceptive scheme, **6:15**  
Defensive, **6:7**  
Demand, **6:4, 6:10**  
Disclosure, **6:6, 6:16-6:19**  
Discovery, **6:18**  
Disdainful amusement devices, **6:15**  
Dominant-subservient relationships, **6:6**  
Duplication, **6:3**

**UTILITY REQUIREMENT—Cont'd**

Economic considerations, **6:2**  
Economic costs, **6:4, 6:10**  
Economic justification, **6:10**  
Electrical arts, **6:19**  
Embodiment, **6:14**  
Enforcement, **6:19**  
European Patent Convention (EPC), **6:3**  
Evidence  
adequate utility generally, **6:4**  
burden of proof, **6:16**  
circumstantial evidence, **6:20**  
clear and convincing evidence, **6:14**  
burden of proof, **6:16**  
circumstantial evidence, **6:20**  
clear and convincing evidence, **6:14**  
history, **6:4**  
practical utility, **6:18**  
prosecution, **6:13**  
Examination, **6:13**  
Exceptions and exclusions, **6:5**  
Expectations, **6:19**  
Factual statements, **6:13**  
False assertions, **6:13**  
False scheme, **6:15**  
Federal Circuit, **6:18, 6:19**  
Federal Trade Commission, **6:5**  
Fixed standard, **6:18**  
Food and Drug Administration, **6:5, 6:12**  
Foreign countries, **6:3, 6:5, 6:6**  
Forensics, **6:18, 6:19**  
Foreseeability, **6:1, 6:6, 6:16**  
Fourteenth amendment, **6:5**  
Fraud, **6:5, 6:15**  
Frivolous or injurious to well-being, good policy, or sound morals of society, **6:15**  
Future acts and matters  
practical utility, **6:16-6:19**  
research, **6:6**  
technology, **6:19**  
use-based view, **6:20**  
Gambling, **6:5, 6:15**

**UTILITY REQUIREMENT—Cont'd**

Genetics, **6:5, 6:6**  
 Genomic inventions, **6:19**  
 Genus dominate a species, **6:6**  
 Germany, **6:3, 6:6**  
 Good policy, **6:15**  
 Harmful, **6:15**  
 Historical development and policy justification  
     generally, **6:2-6:7, 6:15**  
     advance in art, **6:3**  
     date of invention, **6:7**  
     limiting scope of control over future uses, **6:6**  
     market forces, use of, **6:4**  
     operability, **6:9**  
     unwanted activity, deterring, **6:5**  
 Humans, **6:5, 6:18**  
 Incentives, **6:19**  
 Industrial application, **6:8**  
 Inferior, **6:3**  
 Infringement, **6:4, 6:20**  
 In re Joly, **6:17**  
 In re Kirk, **6:17**  
 In re Ziegler, **6:18**  
 In vitro tests, **6:18**  
 Initial rejection of application, **6:13**  
 Intent, **6:1**  
 Interactions with restriction on use, **6:12**  
 Intervention, **6:4, 6:10**  
 Investigation, **6:18**  
 Issuance of patent, **6:13, 6:14, 6:19**  
 Jurisdiction, **6:12**  
 Jury, **6:9**  
 Justification  
     economic justification, **6:10**  
     enablement, **6:15**  
     policy justification. Historical development and policy justification, above  
 Known art, **6:8**  
 Known to the art, **6:4**  
 Limitations and restrictions, **6:5, 6:9, 6:11, 6:15, 6:16, 6:18**  
 Limitations and restrictions, generally, **6:1, 6:5**  
 Living organisms, **6:6**

**UTILITY REQUIREMENT—Cont'd**

Lowell v. Lewis, **6:9, 6:10**  
 Lower courts, **6:16, 6:17**  
 Market forces, use of, **6:4**  
 Marking, **6:19**  
 Mechanical arts, **6:19**  
 Minimum operability, **6:12, 6:20**  
 Mischiefous, **6:15**  
 Monopoly of knowledge, **6:6, 6:17, 6:19**  
 Morality or public order, contrary to, generally, **6:1 et seq.**  
 Motivation, **6:13**  
 National Institutes of Health, **6:18**  
 Natural control, **6:5**  
 Non-obviousness, **6:7**  
 Notice and knowledge  
     history, **6:3, 6:4, 6:6, 6:7**  
     infringement, **6:20**  
     operability, **6:8**  
     practical utility, **6:17, 6:19**  
 Notice and knowledge, generally, **6:3**  
 Noxious behavior, **6:5, 6:15**  
 Operability  
     generally, **6:8-6:14**  
     corollaries, **6:11**  
     economic justification, **6:10**  
     evidence during prosecution, **6:13**  
     historical developments, **6:9**  
     interactions with restriction on use, **6:12**  
     treatment in litigation, **6:14**  
 Order, public, **6:15**  
 Patentability, generally, **6:1, 6:4**  
 Patent Act of 1790, **6:1**  
 Patent Act of 1793, **6:1**  
 Patent Act of 1836, **6:1**  
 Patent Act of 1870, **6:1**  
 Patent and Trademark Office (PTO), generally, **6:4-6:14**  
 Pertinent art, advance in, **6:3**  
 Potentially dangerous products or substances, **6:12**  
 Potential uses, **6:19**  
 Practical utility, **6:16-6:19, 6:19**  
 Presumption of validity, **6:14**  
 Primitive, **6:4**  
 Prior activity of another, **6:7**

## INDEX

**UTILITY REQUIREMENT—Cont'd**

- Priority, **8:51**
- Process Control Corp. v. Hydrexclaim Corp., **6:19**
- Profits, **6:19**
- Prosecution, **6:13**
- Prospective-use-based view, **6:19**
- Public insensitivity, **6:10**
- Public order or morality, contrary to, generally, **6:1 et seq.**
- Public sale, **6:12**
- Qualifications, **6:7, 6:18**
- References, **6:7**
- Rejection of application, **6:6, 6:13**
- Research and development, **6:6, 6:15, 6:17**
- Reversal, **6:6**
- Safe and effective, **6:12**
- Sale, **6:8**
- Scientific development, **6:19**
- Scientific field, **6:5**
- Section 101, generally, **6:1**
- Section 103, **6:7**
- Section 112, **6:6, 6:19**
- Section 282, **6:14**
- Serviceable in vivo, **6:18**
- Skill in the art, **6:13**
- Social costs, **6:2, 6:4, 6:10**
- Sound morals, **6:15**
- Specification, **6:1, 6:7, 6:19**
- Specific uses, **6:18**
- Sub-combination dominate more comprehensive combinations, **6:6**
- Sub-issue, **6:7**
- Substantial uses, **6:18**
- Supreme Court, **6:6, 6:17**
- Tangible benefit, **6:16**
- Tests, **6:1, 6:8, 6:18**
- Third persons, **6:7**
- Total incapacity, **6:11**
- Total uses, **6:16**
- Trade secrets, **6:5**
- Unscrupulous entity, **6:15**
- Unwanted activity, deterring, **6:5**
- Unwanted behavior, **6:5**
- Unwanted fields, **6:5**
- Useful, generally, **6:1**

**UTILITY REQUIREMENT—Cont'd**

- Useful arts, generally, **6:2**
- Validity, **6:4, 6:7, 6:11-6:14**
- Value, **6:20**
- Well-being, **6:15**

**VACATIONS**

- Priority, **8:67**

**VALIDITY**

- Anticipation, Lack Of (this index)
- Claims, **4:49, 4:62**
- Correction (this index)
- Defense of invalidity. Invalidity (this index)
- Examination of Original Application (this index)
- History, **1:5, 1:18, 1:24**
- Inventorship, **10:1, 10:7, 10:10**
- Joint Inventorship (this index)
- Non-Obviousness (this index)
- Non-statutory hybrid inventions, **5:76**
- Patent and Trademark Office (PTO) (this index)
- Priority, **8:69**
- Processes (this index)
- Static physical configurations, **5:8, 5:17**
- Statutory subject matter, **5:4**
- Utility Requirement (this index)

**VALUE**

- Adequate utility, **6:20**
- Anticipation, lack of, **8:1**
- Joint inventorship, **10:47, 10:50, 10:52**
- Non-statutory hybrid inventions, **5:49**
- Policy justification, **1:39**
- Priority, **8:56**
- Static physical configurations, **5:15**
- Statutory subject matter, **5:5**
- Temporal scope, **11:36**

**VAN KANNELL REVOLVING DOOR CO. v. REVOLVING DOOR & FIXTURE CO.**

- Adequate commerciality, **14:39, 14:40, 14:46**

**VARIATIONS**

- Processes, **5:21**

**VARIATIONS—Cont'd**  
Technological scope, **13:81, 13:82**

**VENN DIAGRAM**  
Claims, **4:63**

**VERDICT**  
Claims (this index)  
Non-obviousness, **9:3**

**VESSELS**  
Geographic scope, **12:13**

**VESTING OF TITLE**  
Inventorship (this index)

**VETERINARY BIOLOGICAL PRODUCTS**  
Adequate Commerciality (this index)

**VICE PRESIDENT**  
Patent and Trademark Office (PTO),  
**2:22**

**VIEWED PER SE**  
Non-statutory hybrid inventions, **5:83**

**VITRONICS CORP. v. CONCEPTRONIC, INC.**  
Claims, **4:34**

**VOID AND VOIDABLE ACTS AND MATTERS**  
Correction of inventorship, **10:56**  
History, **1:4, 1:5**  
Joint inventorship, **10:19**  
Processes, **5:24**

**VOLUNTARINESS**  
Defenses, implied-in-law licenses,  
involuntary sales, **19:41**  
History, **1:14**  
Priority, **8:67**

**VOSE v. SINGER**  
Joint inventorship, **10:50**

**WAIVER**  
History, **1:14**

**WALLACE v. HOLMES**  
Indirect infringement, **15:4, 15:16**  
Misuse of patent, **18:5**

**WANLASS v. FEEDERS**  
Laches, unreasonable delay, **23:27**

**WANLASS v. GENERAL ELEC. CO.**  
Laches, unreasonable delay, **23:26**

**WARNER JENKINSON v. HILTON DAVIS**  
Claims, **4:6**

**WARNER-LAMBERT CO. v. APOTEX CORP.**  
Adequate commerciality, **14:79**

**WAYMARK CORP. v. PORTA SYSTEMS CORP.**  
Adequate commerciality, **14:27**

**WEBSTER LOOM CO. v. HIGGINS**  
Adequate disclosure, **7:48**

**WEED CHAIN TIRE GRIP CO v. CLEVELAND CHAIN & MFG CO.**  
Adequate commerciality, **14:31**

**WEIGHT AND SUFFICIENCY OF EVIDENCE**  
Patent and Trademark Office (PTO),  
**2:39**  
Priority, **8:72**

**WELL-BEING**  
Adequate utility, **6:15**

**WHITE v. WALBRIDGE**  
Adequate commerciality, **14:20**

**WHITTEMORE v. CUTTER**  
Adequate commerciality, **14:3, 14:52**

**WHOLE TRUTH**  
Adequate disclosure, **7:45**

**WILSON SPORTING GOODS CASE**  
Technological scope, **13:82**

**WINANS v. DENMEAD**  
Technological scope, **13:6**

**WITHDRAWAL**  
History, **1:4, 1:15**  
Priority, **8:241**

## INDEX

### **WITNESSES**

Priority (this index)

### **WOMEN**

Inventorship, **10:7**

### **WOODWORTH PATENTS**

Reissue of patent, **16:15**

### **WORKABILITY**

Priority, **8:60**

### **WORK-FOR-HIRE**

Inventorship, **10:16, 10:17**

### **WORLD TRADE ORGANIZATION (WTO) AGREEMENT**

Adequate commerciality, **14:46**

### **WORST CASE SCENARIO**

Non-obviousness, **9:65**

### **WRITTEN ACTS AND MATTERS**

Adequate disclosure, **7:8, 7:11, 7:27, 7:37**

Claims (this index)

Correction of inventorship, **10:56**

Examination of Original Application (this index)

### **WRITTEN ACTS AND MATTERS**

#### **—Cont'd**

History (this index)

Non-obviousness, **9:2**

Priority, **8:74**

Utility Requirement (this index)

### **WTO**

World Trade Organization (WTO)

Agreement (this index)

### **WYETH v. STONE**

Estoppel as defense to patent infringement, **24:9**

Processes, **5:24**

### **YBM MAGNEX, INC. v. USITC**

Technological scope, **13:96**

### **YET-TO-BE-INVENTED**

#### **TECHNOLOGY**

Adequate disclosure, **7:14, 7:24**

### **ZENITH RADIO CORP. v. HAZELTINE RESEARCH, INC.**

Misuse of patent, **18:20**