

# Table of Contents

## Volume 1

### PART I. BASIC PRINCIPLES OF INTELLECTUAL PROPERTY PROTECTION

#### CHAPTER 1. PATENTS

- § 1:1 Letters patent; letters close
- § 1:2 A patent as a grant; as a contract
- § 1:3 Patents as monopolies and as (intellectual) property—An inventor’s “common-law” rights
  - Rights conferred by letters patent
  - § 1:5 —Monopolies in historical context
  - § 1:6 —Is a patent a monopoly?
  - § 1:7 —Consequences of patents as monopolies
  - § 1:8 ——A patent encompasses an indefinitely large number of physical objects
  - § 1:9 ——A patent is not limited to a particular situs
  - § 1:10 ——A patent is a negative right
  - § 1:11 —— —Exclusive right/right to exclude others
  - § 1:12 —— —The hierarchy of patents (dominance/subservience)
- § 1:13 Inventions and discoveries
- § 1:14 Patent rights, physical embodiments, and implied license to use
- § 1:15 The duration of patents
- § 1:16 —Extension of term due to regulatory review—
  - Under the Patent Term Restoration Act of 1984
  - Under the Patent Term Restoration Act of 1988
- § 1:17 —Extension of term due to prosecution delay
- § 1:18 ——Factors affecting term extension—The guarantee of prompt office responses
- § 1:19 ——The guarantee of no more than three-year application pendency
- § 1:20 ——The guarantee of adjustments for delays due to interferences, secrecy orders, and appeals
- § 1:21.30 ——Adjustments in view of applicant delay
- § 1:22 ——The guarantee of adjustments for delays due to interferences, secrecy orders, and appeals—Actual period of term adjustment

§ 1:23	— — —Disputes as to the proper period of adjustment
§ 1:24	Patentability of ideas
§ 1:25	Relation between invention and patents
§ 1:26	Summary of the revisions to the Patent Act by the Leahy-Smith America Invents Act (hereinafter “AIA”)
§ 1:27	—Provisions of the AIA related to patent application and patent prosecution
§ 1:28	—Provisions of the AIA related to new post grant procedures for issued patents
§ 1:29	—Provisions of the AIA related to litigation and licensing of patents
§ 1:30	Summary table of the AIA statutory and regulatory implementation
§ 1:31	Intellectual Property Attorney Electronic Tools for Accessing USPTO Resources in Filing for Intellectual Property Rights

## CHAPTER 2. TRADE SECRETS

§ 2:1	Introduction
§ 2:1.50	Federal legislation—Defend Trade Secrets Act
§ 2:2	Trade secret distinct from the physical object
§ 2:3	Subject matter of trade secrets
§ 2:4	Factors to be considered in recognizing a trade secret
§ 2:5	Novelty or secrecy requirement
§ 2:6	Unobviousness standard does not apply
§ 2:7	Concreteness of the information
§ 2:8	Unfair (improper) means
§ 2:9	—Breach of contract
§ 2:10	—Promissory estoppel
§ 2:11	—Unjust enrichment
§ 2:12	—Tort
§ 2:13	—Lanham Act violation
§ 2:14	—Crime
§ 2:15	— —Under state law
§ 2:16	— —Under federal law
§ 2:16.50	Remedies
§ 2:17	Patenting versus maintenance as a trade secret
§ 2:18	Coexistence of patented and trade secret concepts
§ 2:19	Coexistence of copyright and trade secret concepts
§ 2:20	Significant U.S. Supreme Court Cases

## CHAPTER 3. TRADEMARKS

§ 3:1	Definition of a trademark and service mark
§ 3:2	How trademarks and service marks arise

## TABLE OF CONTENTS

§ 3:3	—Use and registration
§ 3:3.10	Trademark Prosecution and the Process of Trademark Examination for Trademark Registration
§ 3:3.12	Trademark Prosecution—Applicant’s filing of the trademark application for registration
§ 3:3.14	Trademark Prosecution
§ 3:3.16	—Trademark Examining Attorney Final Office Action; and Applicant’s Request for Reconsideration after Final and Appeal to Trademark Trial and Appeal Board
§ 3:3.18	—Trademark Examining Attorney Notice of Allowance, Registration, and Applicant’s Required Statements of Use (SOU) or Extensions to File Statement of Use
§ 3:4	How trademarks and service marks arise—Marks capable of exclusive appropriation
§ 3:5	How trademarks and service marks may be lost
§ 3:6	What constitutes trademark or service mark infringement
§ 3:7	Remedies for trademark and service mark infringement
§ 3:8	Benefits of federal registration—The Lanham Act
§ 3:8.30	The Trademark Modernization Act (TMA)
§ 3:8.50	Federal preemption of state law trademark protection
§ 3:9	Marks and the Internet
§ 3:10	International protection of U.S. marks
§ 3:11	Summary table—Supreme court trademark cases and decisions

## CHAPTER 4. COPYRIGHTS

§ 4:1	Rights embraced in a copyright
§ 4:2	What a copyright does and does not protect
§ 4:3	Copyrightable subject matter
§ 4:4	How copyright protection is secured
§ 4:5	What constitutes copyright infringement
§ 4:6	Defenses to copyright infringement
§ 4:7	Conduct of copyright infringement litigation
§ 4:8	Civil remedies
§ 4:9	Criminal penalties
§ 4:10	Significant U.S. Supreme Court cases

## CHAPTER 5. MULTIPLE AND ALTERNATIVE PROTECTION: SUCCESSIVE AND SIMULTANEOUS

§ 5:1	Introduction
-------	--------------

- § 5:2 Utility patent and design patent
- § 5:3 Patent and copyright
- § 5:4 Patent and trademark
- § 5:5 Patent and trade secret
- § 5:6 Copyright and trademark

## CHAPTER 5A. DESIGN PATENTS, PLANT PATENTS, AND OTHER PATENT PROTECTIONS

- §§ 5A:1 to 5A:9 *[Reserved]*
- § 5A:10 Statutory subject matter—Designs
- § 5A:11 ——What constitutes a statutory design
- § 5A:12 ——Novelty of designs
- § 5A:13 ——Ornamentality of a design
- § 5A:14 ——Nonobviousness of designs
- § 5A:15 ——Originality of a design
- § 5A:16 ——Infringement of a design patent
- § 5A:16.20 ——Complaint for design patent infringement and initial defenses
- § 5A:16.50 ——Damages for infringement of design patents
- § 5A:16.75 Equitable Remedies for Infringement of Design Patents
- § 5A:17 Statutory subject matter—Designs—The design drawing
- § 5A:18 ——Other design patent peculiarities
- § 5A:18.30 USPTO Establishes a Design Patent Practitioner Bar for Design Patent Practitioners
- § 5A:18.50 International design applications at the USPTO under the Hague Agreement for International Registration of Industrial Designs
- § 5A:19 Statutory subject matter—Plants

## PART II. THE SUBSTANTIVE REQUISITES OF A VALID PATENT

### CHAPTER 6. STATUTORY SUBJECT MATTER

- § 6:1 Statutory subject matter
- § 6:1.50 Summary of analysis for statutory subject matter
- § 6:2 Statutory subject matter—Processes
- § 6:3 ——Computer programs
- § 6:4 ——“Use patents” and new uses
- § 6:5 ——Product-by-process claims
- § 6:6 —Products

TABLE OF CONTENTS

§ 6:7	— —Machine
§ 6:8	— —Manufacture
§ 6:9	— —Composition of matter
§§ 6:10 to 6:19	<i>[Reserved]</i>
§ 6:20	Nonstatutory subject matter
§ 6:21	—Subject matter specifically excluded by statute
§ 6:21.20	—Subject matter—Supreme Court Cases on Patent Eligible Subject Matter
§ 6:21.50	Overview of Federal Circuit 35 U.S.C. § 101 patentable subject matter analysis
§ 6:22	Nonstatutory subject matter—Discoveries
§ 6:23	—Subject matter the novel aspects of which require mental activity
§ 6:24	— —Printed matter
§ 6:25	— —Methods of doing business
§ 6:26	— —Mental processes
§ 6:27	USPTO Guidance on patentable subject matter related patent applications involving laws of nature in light of the Supreme Court’s decisions in <i>Association for Molecular Pathology v. Myriad</i> and <i>Mayo v. Prometheus</i> (the USPTO Myriad-Mayo Guidance)
§ 6:27.50	Federal Circuit cases applying the Supreme Court decisions of <i>Association for Molecular Pathology v. Myriad</i> and <i>Mayo v. Prometheus</i>
§ 6:28	USPTO Guidance on patentable subject matter related to patent applications involving computer programs and computer technology in light of the Supreme Court’s decision in <i>Alice v. CLS Bank</i>
§ 6:28.50	Federal Circuit cases applying the Supreme Court decision of <i>Alice v. CLS Bank</i>
§ 6:28.60	Practitioner guidance for computer and software related inventions after <i>Alice v. CLS Bank</i> and related Federal Circuit cases
§ 6:28.70	Summary table of Federal Circuit decisions on Patent Eligible Subject Matter under 35 U.S.C. § 101
§ 6:29	USPTO 2014 Interim Guidance on Patent Subject Matter Eligibility
§ 6:30	USPTO Guidance—July 2015 update on subject matter eligibility
§ 6:31	—May 2016 update on subject matter eligibility
§ 6:32	—July 2017—Quick reference sheet for identifying abstract ideas
§ 6:33	USPTO—2019 Revised Patent Subject Matter Eligibility Guidance
§ 6:33.50	—Specific Examples for Guidance on Patent Eligible Subject Matter

- § 6:34 —Practical Effects of the USPTO 2019 Revised Patent Subject Matter Eligibility Guidance
- § 6:34.50 USPTO Issues Review Memorandum on Subject Matter Eligibility (August 2025)
- § 6:35 Summary of USPTO Efforts to Provide Some Certainty to Patent Eligibility Subject Matter Jurisprudence

## CHAPTER 7. NOVELTY

- § 7:1 Introduction
- § 7:1.40 The America Invents Act (AIA) § 102, conditions for patentability, novelty and loss of right to patent
- § 7:1.70 —Practitioner guidance
- § 7:1.72 —In view of public disclosure, in public use, or “on sale”
- § 7:2 Prior art
- § 7:3 Patents and printed publications as prior art
- § 7:4 Physical novelty required for anticipation
- § 7:5 Doctrine of inherency
- § 7:6 Novelty and anticipation
- § 7:7 35 U.S.C.A. § 102(a)
- § 7:8 35 U.S.C.A. § 102(b)
- § 7:9 —“In public use”
- § 7:10 ——Experimental use
- § 7:11 ——Secret use
- § 7:12 —“On sale”
- § 7:13 —Comparison of 35 U.S.C.A. § 102(a) and 35 U.S.C.A. § 102(b)
- § 7:14 Abandonment ( 35 U.S.C.A. § 102(c))
- § 7:15 Earlier, foreign-filed patent application ( 35 U.S.C.A. § 102(d))
- § 7:16 Prior art as of filing date ( 35 U.S.C.A. § 102(e))
- § 7:17 Applicant did not invent invention ( 35 U.S.C.A. § 102(f))
- § 7:18 Earlier making of invention by another ( 35 U.S.C.A. § 102(g))
- § 7:19 Late claiming and intervening rights—Statutory time limitations on claiming
- § 7:20 —Nonstatutory doctrine of late claiming
- § 7:21 —Intervening rights

## CHAPTER 8. UTILITY

- § 8:1 Introduction
- § 8:2 Utility as a requisite of patentability
- § 8:3 “Useful” versus “how to use”
- § 8:4 Operability
- § 8:5 Immoral or illegal

TABLE OF CONTENTS

- § 8:6 Standard for mechanical-type inventions
- § 8:7 Standard for chemical-type inventions

## CHAPTER 9. NONOBLVIOUSNESS

- § 9:1 Introduction
- § 9:2 The negative rules of invention
- § 9:3 The nonobviousness standard of 35 U.S.C.A. § 103
- § 9:4 —The mental state of the inventor is irrelevant to patentability
- § 9:5 —Proper application of 35 U.S.C.A. § 103
- § 9:6 ——Making antecedent factual determinations under 35 U.S.C.A. § 103
- § 9:7 ——What constitutes “prior art” under 35 U.S.C.A. § 103
- § 9:8 ——What constitutes a “difference” under 35 U.S.C.A. § 103
- § 9:9 ——Ascertaining the level of ordinary skill
- § 9:10 ——The perspective from which to draw a legal conclusion under 35 U.S.C.A. § 103
- § 9:11 ——“The subject matter as a whole”
- § 9:12 ——“At the time the invention was made” (hindsight, afterthoughts)
- § 9:13 —Comparison of the application of 35 U.S.C.A. § 103 in patent application prosecution and in patent enforcement proceedings
- § 9:14 ——Patent application prosecution before the Patent & Trademark Office—*Prima facie* obviousness and its rebuttal
- § 9:15 ——Manner of adducing evidence in *ex parte* prosecution
- § 9:16 ——Patent enforcement proceedings—Presumption of patent validity
- § 9:17 ——Manner of adducing evidence in *inter partes* enforcement proceedings
- § 9:18 —Appellate review of determinations under 35 U.S.C.A. § 103
- § 9:19 —Case law prior to 35 U.S.C. § 103 as viable precedent
- § 9:20 —Is there a constitutional standard of invention?
- § 9:21 Analogous and nonanalogous art
- § 9:22 Impact of certain factors on the application of 35 U.S.C.A. § 103
  - § 9:23 —Obviousness and equivalence
  - § 9:24 —Combinations of old elements
  - § 9:25 —Simplicity and sophistication
  - § 9:26 —Predictability (“obvious to try”)
  - § 9:27 —Superiority, criticality, and optimization
  - § 9:28 —“Teaching away from”

- § 9:29 —Identifying the source of a problem and its solution
- § 9:30 —Infringer's promotion
- § 9:31 —Chemical inventions
- § 9:32 ——Structurally obvious compounds
- § 9:33 ——Purity
- § 9:34 ——Chemical processes
- § 9:35 ——Change in physical form and physical mixtures
- § 9:36 Secondary considerations
- § 9:37 —Unexpected results
- § 9:38 —Synergism
- § 9:39 —The subtests of invention
- § 9:40 ——Commercial success
- § 9:41 ——Long-felt demand
- § 9:42 ——Commercial acquiescence
- § 9:43 ——Skepticism of experts
- § 9:44 ——Praise for the invention
- § 9:45 ——Copying

## **PART III. INVENTORSHIP AND OWNERSHIP**

### **CHAPTER 10. PRIORITY OF INVENTION**

- § 10:1 Introduction
- § 10:1.40 America Invents Act (AIA) derivation procedures that will replace interference procedures—revisions to § 102(g) and 35 U.S.C.A. § 135
- § 10:1.70 —Practitioner Guidance
- § 10:2 Determination of priority
- § 10:3 —Conception
- § 10:4 —Reduction to practice
- § 10:5 —Diligence
- § 10:6 —Abandonment, suppression, and concealment
- § 10:7 —Derivation
- § 10:8 Interference practice—Inter partes proceedings
- § 10:9 —Corroborative evidence
- § 10:10 —Outline of patent interference proceedings
- § 10:11 Oral Arguments under the “new rules”
- § 10:12 Priority phase including briefs and related pleadings under the “new rules”
- § 10:13 Determinations by the Patent Trial and Appeal Board
- § 10:14 —Practitioner Guidance

### **CHAPTER 11. INVENTORSHIP**

- § 11:1 Introduction

## TABLE OF CONTENTS

§ 11:2	The inventorship entity—In general
§ 11:2.30	—Artificial Intelligence (AI) Inventions
§ 11:3	—Joint invention—Conception as the “touchstone” of inventorship
§ 11:4	—Need for collaboration
§ 11:5	—Patent Law Amendments Act of 1984
§ 11:6	—Presumption of correctness of inventorship as filed
§ 11:7	—Inventorship versus priority of invention
§ 11:8	—Inventorship entity and “prior art”
§ 11:9	Nonjoinder and misjoinder—In general
§ 11:10	—Correcting inventorship in patent applications
§ 11:11	—Correcting inventorship in issued patents
§ 11:12	—Presumption of correctness
§ 11:13	—Diligence required?
§ 11:14	—What constitutes “error without deceptive intention”?
§ 11:15	Substitution
§ 11:16	When patent application may be made by persons other than the inventor

## CHAPTER 12. OWNERSHIP

§ 12:1	Introduction
§ 12:2	Transfer and sharing of patent rights
§ 12:3	—Assignment
§ 12:4	—License
§ 12:5	—Assignment versus exclusive license
§ 12:6	Proprietary rights among joint owners
§ 12:7	Viability of restrictions on the physical object
§ 12:8	Antitrust/misuse implications
§ 12:9	Rights of employer and employee inter se—In general
§ 12:10	—Shop right
§ 12:11	—General employment versus “hired to invent”
§ 12:12	—Contractual allocation of patent rights
§ 12:13	—Corporate officers
§ 12:14	—Enforcement
§ 12:15	Employee’s obligations in regard to his employer’s trade secrets
§ 12:16	Rights of a trustee in bankruptcy
§ 12:17	Government ownership and use
§ 12:18	Practitioner guidance in government contracting—Delivery of technical data and computer software to the government
§ 12:19	Government (FDA) approval of a generic drug or pharmaceutical that has been previously patented
§ 12:20	Government (FDA) approval of a biologic and biosimilar medical products

§ 12:21 Litigation approaches in enforcing biosimilar patents

## Volume 2

### PART IV. OBTAINING PATENT PROTECTION

#### CHAPTER 13. PREPARATION OF PATENT APPLICATIONS

- § 13:1 Introduction
- § 13:1.40 Patent application filing considerations and preliminary documents
- § 13:1.50 Required submissions for filing a patent application and common filing mistakes
- § 13:2 The oath or declaration
- § 13:3 —To accompany an application for an original patent
- § 13:4 —To accompany an application for a reissue patent
- § 13:5 The drawing
- § 13:6 Exhibits
- § 13:7 The specification
- § 13:8 —Title and abstract
- § 13:9 —Cross-references to other applications
- § 13:10 —Background of the invention
- § 13:11 —Summary of the invention
- § 13:12 —Brief description of the drawings
- § 13:13 —Detailed description
- § 13:14 ——“Written description” of the invention
- § 13:15 ——Enabling disclosure
- § 13:16 ——Best mode
- § 13:17 —The claims
- § 13:18 Duty of disclosure
- § 13:18.50 —Prior art search guidance and example search using prior art search tools
- § 13:19 Information disclosure (prior art) statements and proposed rules modifying Information Disclosure Statement (IDS) practice before the USPTO
- § 13:20 Information disclosure (prior art) statements—Content of information disclosure statements
- § 13:21 —Filing of information disclosure statements (37 C.F.R. § 1.97)
- § 13:22 Filing the Patent Application at the Patent and Trademark Office
- § 13:23 Filing the patent application at the Patent and

TABLE OF CONTENTS

Trademark Office—USPTO new rule for eFiling  
patent applications in structured text format  
(DOCX)

## CHAPTER 14. PATENT CLAIMS: ANALYSIS AND SYNTHESIS

§ 14:1	The purpose of patent claims
§ 14:1.20	Breadth of claims, claim language and scope
§ 14:1.30	Supreme Court's review of the proper standard for definiteness under 35 U.S.C. § 112 in <i>Nautilus v. Biosig Instruments</i>
§ 14:1.40	Federal Courts and the USPTO Examination and Post Grant Review of claims for definiteness after the decision of <i>Nautilus v. Biosig</i>
§ 14:1.50	Courts should resolve claim construction prior to analyzing a claim for patentability requirements (35 U.S.C. §§ 101, 102, 103, and 112)
§ 14:2	The purpose of patent claims—To define the invention
§ 14:2.50	Standard of Review for Appellate Court Review of Claim Construction
§ 14:3	The purpose of patent claims—To point out the invention
§ 14:4	Claims must express novel structure
§ 14:5	Structural versus functional language
§ 14:6	The three unities implicit in all claims
§ 14:7	Claim syntax
§ 14:8	—Preamble or introductory phrase
§ 14:9	—Transitional phrase
§ 14:10	—Body of claim
§ 14:11	Claim grammar
§ 14:12	—Antecedent basis must be present
§ 14:13	—Alternative language
§ 14:14	—Markush group
§ 14:15	—Double inclusion of elements
§ 14:16	—Relative terminology
§ 14:17	Expression of nonobviousness in the claims
§ 14:18	Independent and dependent claims
§ 14:19	Broadening and narrowing of claims
§ 14:19.50	Functional claiming under 35 U.S.C. § 112 and clarity of the record
§ 14:19.60	Functional claims in view of 35 U.S.C.A. § 112(f) and USPTO guidance
§ 14:20	Broadening and narrowing of claims—Genus-species relationship
§ 14:21	—Combination-subcombination relationship

## CHAPTER 15. PROSECUTING PATENT APPLICATIONS

§ 15:1	Introduction
§ 15:1.20	Patent & Trademark Office—Enhanced patent quality initiative
§ 15:1.30	—Pilot Program for Quality Case Studies
§ 15:1.40	—Patent Quality Metrics Proposed Master Review Form
§ 15:1.50	—Initiative for Resolving Conflicts with Applicants—Ombudsmen program
§ 15:2	The patent bar and invention promotion services
§ 15:3	—Admission to practice
§ 15:4	—Privileges and responsibilities
§ 15:4.10	— —Attorney/client agreement for legal services and engagement letter
§ 15:4.20	— —Practice pointers on avoiding a disciplinary (OED) investigation
§ 15:4.40	Practice pointers on avoiding a complaint for attorney malpractice
§ 15:4.50	The USPTO Amends the Rules of Practice to Formalize the USPTO’s Diversion Pilot Program to Avoid Formal Discipline of Patent Practitioners for Minor Misconduct Issues
§ 15:5	The patent bar and invention promotion services— Invention promotion services
§ 15:6	Filing the patent application
§ 15:7	—Benefit of the filing date of an earlier filed application [35 U.S.C.A. §§ 119, 120]
§ 15:8	—Benefit of the filing date of an earlier filed provisional application [35 U.S.C.A. § 111(b)]
§ 15:9	—Fees
§ 15:10	—Continuing applications, continued examination, and res judicata
§ 15:11	— —Continuation
§ 15:12	— —Continuation-in-part
§ 15:13	— —Division
§ 15:14	— —Res judicata
§ 15:15	Ex parte prosecution before the primary examiner—Publication and access to pending patent applications
§ 15:15.50	—Examination of pending patent applications
§ 15:15.52	Example USPTO Office Action rejecting a sample disclosure and claims
§ 15:15.55	Summary of provisions for expediting examination of patent applications
§ 15:15.60	Prosecution before primary examiner— Discontinued “accelerated examination” for utility patents

TABLE OF CONTENTS

§ 15:15.65	—Rules for “accelerated examination” procedures—Glossary Pilot Program
§ 15:15.70	Prosecution before the primary examiner—Pilot program for “community patent review” including peer review
§ 15:15.80	Preissuance submissions by third parties
§ 15:16	Ex parte prosecution before the Primary Examiner—Action taken by the examiner
§ 15:16.01	Patent Prosecution and the Process of Patent Examination
§ 15:16.02	Patent Prosecution—USPTO Preliminary Review of a Filed Application with Notices of Requirements; and Applicant’s Required Response Before Examination
§ 15:16.03	—Patent Examiner First Action, including prior art search and formal examination; and Applicant’s Required Response to the Examiner’s Office Action
§ 15:16.04	—Patent Examiner’s Final Office Action, including prior art search and formal examination; and Applicant’s Required Response to the Final Action
§ 15:16.05	—Patent Examiner’s After Final Rejection, Advisory Action; and Applicant’s Subsequent Response including Request for Continued Examination (RCE)
§ 15:16.06	—Patent Examiner’s Notice of Allowance; and Applicant’s Response
§ 15:17	Ex parte prosecution before the Primary Examiner—Response by the applicant [37 C.F.R. § 1.111]
§ 15:17.50	Access to USPTO files and filing Amendments via the electronic Patent Center
§ 15:18	Ex parte prosecution before the Primary Examiner—Response by the applicant [37 C.F.R. § 1.111]—Oral interview with examiner
§ 15:18.50	—Response by the applicant [37 C.F.R. § 1.111]—Oral interview with examiner—First Action Interview (FAI) Program
§ 15:18.70	—Practitioner guidance on obtaining and conducting interviews
§ 15:19	—Response by the applicant [37 C.F.R. § 1.111]—Written response
§ 15:20	—Time for response
§ 15:21	—How reckoned
§ 15:22	—Manner of transmission
§ 15:22.30	Abandonment of patent application, notice of abandonment, and applicant response
§ 15:23	Ex parte prosecution before the Primary

	Examiner—Response by the applicant [37 C.F.R. § 1.111]—Revival of abandoned application
§ 15:23.50	USPTO Clarification of the Requirement for Additional Information in Petitions for Revival of Abandoned Applications and Issued Patents Based on Unintentional Delay
§ 15:24	Ex parte prosecution before the Primary Examiner—Response by the applicant [37 C.F.R. § 1.111]—Revival of abandoned application—Unavoidable delay
§ 15:25	— — —Unintentional delay
§ 15:26	—Reconsideration by the examiner
§ 15:27	—Response by the applicant to a final rejection
§ 15:28	—Incomplete actions and incomplete responses
§ 15:29	—Allowance
§ 15:30	—Amendment after allowance [37 C.F.R. § 1.312]
§ 15:30.10	The Patent Grant and the USPTO Issuing Electronic Patent Grants
§ 15:31	Appellate review
§ 15:32	—By the Patent and Trademark Office Patent Trial and Appeal Board (PTAB)—Composition and jurisdiction of the Board
§ 15:33	—By USPTO Patent Trial and Appeal Board (PTAB)—Ex parte appeal process
§ 15:33.10	—By Patent Trial and Appeal Board (PTAB)—Procedure—Fast-Track Appeals Pilot Program
§ 15:33.20	Pre-Appeal brief conference (Pre-Appeal Program)
§ 15:33.50	Appellate review—By the Patent and Trademark Office Patent Trial and Appeal Board (PTAB)—Procedure—Post-Prosecution Pilot Program (P3)
§ 15:34	— — —Appellant’s brief and examiner’s answer
§ 15:34.50	Common problems and causes for rejection of applicant’s brief
§ 15:35	Appellate review—By the Patent and Trademark Office Patent Trial and Appeal Board (PTAB)—Procedure—Oral hearing
§ 15:36	—By the Patent and Trademark Office Patent Trial and Appeal Board—Decision and disposition
§ 15:37	—Court review
§ 15:38	— — —Jurisdiction
§ 15:39	— — —Standard of review
§ 15:40	— — —Procedure
§ 15:41	Petitions to the Commissioner
§ 15:42	—Delegated authority to decide petitions
§ 15:43	— — —To the Group Director
§ 15:44	— — —To the Office of Petitions
§ 15:44.50	— — —Automated Filing and Decision Process for Certain Petitions

TABLE OF CONTENTS

§ 15:45	—Ripeness for, and the timing of, filing a petition
§ 15:46	—Form of petitions
§ 15:47	—Questions not specifically provided for
§ 15:48	—Suspension of rules
§ 15:49	—Judicial review
§ 15:50	Restriction, divisional applications, and double patenting
§ 15:50.50	Terminal Disclaimers to obvious-type double patenting rejections
§ 15:51	Rejections
§ 15:52	—Under 35 U.S.C.A. § 102 (anticipation)
§ 15:53	—Under 35 U.S.C.A. § 103 (obviousness)
§ 15:53.50	Practitioner guidance for overcoming obviousness rejections
§ 15:54	Rejections—Under 35 U.S.C.A. § 101 (unpatentability)
§ 15:55	—Under 35 U.S.C.A. § 112
§ 15:56	—First paragraph (insufficient disclosure; undue breadth)
§ 15:57	—Second paragraph (indefinite claims)
§ 15:58	—Duplicate claims
§ 15:59	—Aggregation
§ 15:60	—Under 35 U.S.C.A. § 132 (reconsideration)
§ 15:61	—Under 35 U.S.C.A. § 135(b)
§ 15:62	Affidavit practice
§ 15:63	—37 C.F.R. § 1.130 affidavit or declaration to disqualify commonly owned patent or published application as prior art
§ 15:64	—37 C.F.R. § 1.131 (affidavit of prior invention)
§ 15:65	—37 C.F.R. § 1.132 (affidavit traversing grounds of rejection)
§ 15:66	Fraud on or “inequitable conduct” before the Patent and Trademark Office
§ 15:67	AIA provision for Supplement Examination to review and resolve possible inequitable conduct matters
§ 15:68	<i>[Reserved]</i>
§ 15:69	<i>[Reserved]</i>
§ 15:70	<i>[Reserved]</i>
§ 15:71	<i>[Reserved]</i>
§ 15:72	<i>[Reserved]</i>
§ 15:73	<i>[Reserved]</i>
§ 15:74	Correction of defective patents—Disclaimer
§ 15:75	The law followed by the Patent and Trademark Office
§ 15:76	Statutory invention registration (S.I.R.) and defensive publication

## CHAPTER 15A. POST-GRANT REVIEW OF ISSUED PATENTS

- § 15A:1 Introduction
- § 15A:2 Correction of defective patents
- § 15A:3 —Certificates of correction
- § 15A:4 ——Patent and Trademark Office mistake
- § 15A:5 ——Applicant's mistake
- § 15A:6 —Reissue patents
- § 15A:7 —Reexamination
- § 15A:8 —Comparison of reexamination and reissue
- § 15A:9 Inter partes review
- § 15A:10 Constitutionality of post grant proceedings—Inter Partes Review (IPR)
- § 15A:11 Constitutionality of the Appointment of USPTO Administrative Patent Judges (APJs)
- § 15A:12 The USPTO Board (PTAB) is required to institute an inter partes review on all claims raised by the petitioner for review
- § 15A:13 Inter Partes Review—Institution of Inter Partes Review—Petition must comply with 37 C.F.R. § 42.104(b)(4)
- § 15A:14 Final rules for the Patent Trial and Appeal Board (PTAB) to change its standard for claim construction in post-grant proceedings by eliminating Broadest Reasonable Interpretation (BRI) and adopting the “ordinary and customary meaning” standard of the federal district courts
- § 15A:15 The USPTO Board (PTAB) Has Discretion Not to Institute Inter Partes Review (IPR) under 35 U.S.C. 314—Discretionary Denial to Institute Post Grant Proceedings—Serial “Follow-on” Petitions and Parallel Petitions for IPR
- § 15A:16 Patent Trial and Appeal Board Guidance on Interim Processes for Workload Management
- § 15A:17 Inter partes review—Procedural requirements and timelines
- § 15A:18 Scheduling Order and Summary Table of IPR Pleading Schedule after IPR Institution
- § 15A:19 Inter partes review—Selected cases
- § 15A:20 Summary Table Comparing—Inter Partes Review (IPR) and Post Grant Review (PGR)
- § 15A:21 Post-grant review
- § 15A:22 Covered Business Method Patent Review
- § 15A:23 Comparison table for requirements for post-grant administrative procedures
- § 15A:24 The Patent Trial and Appeal Board (PTAB) and Trial Practice before the PTAB
- § 15A:25 —Trial Practice Guide—August 2018 Update

## TABLE OF CONTENTS

- § 15A:26 — —July 2019 Update
- § 15A:27 Summary practitioner guidance for filing post grant proceedings, including Inter Parties Review (IPR), Post Grant Review (PGR), and Covered Business Method review (CBM)
- § 15A:28 USPTO institutes Pilot Program for Motions to Amend (MTA) claims for post grant proceedings at PTAB
- § 15A:29 Judgment by the USPTO Board (PTAB) and Estoppel Effect on Further Litigation
- § 15A:30 Possible alternative procedures after a patent's claims have been cancelled in AIA post grant proceedings
- § 15A:31 Summary of selected PTAB Inter Partes Review (IPR) cases that have been reversed or remanded by the Federal Circuit
- § 15A:32 Remedies Held to be Unavailable in Inter Partes Review (IPR) Cases
- § 15A:33 The USPTO in compliance with Supreme Court's decision in *Arthrex* initiates interim procedure for Director Review of challenges to PTAB decisions
- § 15A:34 The USPTO issues Final Rule for Director Review of PTAB decisions
- § 15A:35 Patent Trial and Appeal Board—Consolidated Trial Practice Guide November 2019 Edition

## PART V. PATENT INFRINGEMENT

### CHAPTER 16. SUBSTANTIVE ASPECTS OF PATENT INFRINGEMENT

- § 16:1 Introduction
- § 16:2 Types of patent infringement
- § 16:3 —Direct infringement
- § 16:4 —Indirect infringement
- § 16:5 — —By inducement
- § 16:6 — —Contributory infringement
- § 16:7 Construction of patent claims in infringement litigation
- § 16:8 —Doctrine of equivalents
- § 16:9 —Doctrine of prosecution history estoppel (file wrapper estoppel)
- § 16:10 —Reverse (inverse) doctrine of equivalents
- § 16:11 Presumption of validity
- § 16:12 Some consequences of invalidity
- § 16:13 Asserting claims held to be invalid in prior litigation

## CHAPTER 17. PROCEDURAL ASPECTS OF PATENT INFRINGEMENT

- § 17:1 Introduction
- § 17:1.50 Pre-litigation vehicles to settle the infringement case—Cease and desist letters and demand letters
- § 17:2 Jurisdiction
- § 17:3 Venue
- § 17:4 Parties
- § 17:5 Declaratory judgment actions
- § 17:6 Pleadings—Complaint
- § 17:7 —Answer (defenses and counterclaims)
- § 17:8 Summary judgment
- § 17:9 Preliminary injunction
- § 17:9.50 Permanent injunction
- § 17:10 Discovery
- § 17:11 Trial
- § 17:11.30 —Testimony, witnesses, and evidence
- § 17:12 Appeal
- § 17:13 Supreme Court appellate jurisdiction in patent cases
- § 17:14 Summary table—Recent supreme court patent cases and decisions

## CHAPTER 18. REMEDIES FOR PATENT INFRINGEMENT

- § 18:1 Introduction
- § 18:2 Damages
- § 18:3 —Compensatory damages
- § 18:4 ——Direct damages—Measured by patent owner's lost profits
- § 18:5 ——Measured by a reasonable royalty
- § 18:6 ——Additional remedy in the case of a design patent
- § 18:7 ——Indirect damages
- § 18:8 ——Interest on damages award
- § 18:9 —Patent marking
- § 18:10 —Exemplary (punitive) damages
- § 18:11 Injunction
- § 18:12 Attorney fees

TABLE OF CONTENTS

## **PART VI. PATENTS IN GLOBAL CONTEXT: OBTAINING AND MAINTAINING RIGHTS ABROAD**

### **CHAPTER 19. ELEMENTS OF TRANSNATIONAL PATENT LAW**

§ 19:1	Introduction
§ 19:2	The territorial nature of intellectual property
§ 19:3	The Paris Union and UPOV
§ 19:4	The Patent Cooperation Treaty
§ 19:4.30	World Trade Organization (W.T.O.)
§ 19:4.70	Regional Patent Authorities and Jurisdictions
§ 19:5	—International stage (35 U.S.C.A. §§ 362–368)— PCT Chapter I
§ 19:5.30	Amending a PCT Application filed under PCT Chapter 1—World Intellectual Property Organization (W.I.P.O.)—Patent Cooperation Treaty—International stage (35 U.S.C.A. §§ 362–368)—PCT Chapter I
§ 19:6	Regional Patent Authorities and Jurisdictions— International stage (35 U.S.C.A. §§ 362–368)— PCT Chapter II
§ 19:7	—U.S. national stage ( 35 U.S.C.A. §§ 371–376)
§ 19:8	Export licenses
§ 19:9	Problems arising from importation and exportation of patented goods

### **CHAPTER 20. COMPARATIVE PATENT LAW: BRIEF SURVEY OF PRINCIPAL FOREIGN PATENT SYSTEMS**

§ 20:1	Progress in harmonizing U.S. and foreign patent laws
§ 20:2	—Patent term and the event from which it is measured
§ 20:2.30	Highlights of some foreign laws—Japan
§ 20:2.50	—Germany
§ 20:2.70	—United Kingdom
§ 20:2.80	—Canada
§ 20:2.85	Highlights of some foreign patent laws—China
§ 20:3	Highlights of some foreign laws—Publication of pending applications
§ 20:4	—Accrual of infringement damages and the right to institute enforcement proceedings
§ 20:5	—Inter partes opposition proceeding
§ 20:6	Significant points yet to be harmonized

§ 20:7	—Novelty-defeating activities
§ 20:8	— —Relative versus absolute novelty
§ 20:9	— —Public use or “on sale” grace period
§ 20:10	—Priority of invention: First-to-invent versus first-to-file
§ 20:11	Patent Prosecution Highway (PPH) between the USPTO and the Patent Offices of Japan, the United Kingdom, Canada, Korea, Australia, Denmark, Singapore, Germany, Finland, the European Patent Office, and Hungary
§ 20:11.30	Suspended Participation of the USPTO in PPH proceedings with the Russian Intellectual Property Office (Rospatent), the Eurasian Patent Organization, and the Intellectual Property Office of Belarus—in view of Russia’s invasion into Ukraine
§ 20:12	International patent law resources and Internet Website addresses
§ 20:13	Global initiatives for accelerated patent examination based on inventions for green technologies
§ 20:14	USPTO—Global/IP 5 PPH Pilot Program—Global Patent Prosecution Highway (GPPH) and IP5 Agreements based on the Bilateral Agreement for Patent Prosecution Highway (PPH) to expedite the examination of patent applications when an applicant seeks patent protection for the same invention in more than one participating country
§ 20:15	The Global Patent Dossier

## FORMAT OF UNITED STATES PATENTS AND REEXAMINATION CERTIFICATES

- APPENDIX 1. Grant and Specification of an Original U.S. Utility Patent (Title Copy) (No. 5,543,706)
- APPENDIX 2. Grant and Specification of an Original U.S. Design Patent (Des. 378,181)
- APPENDIX 3. Specification of an Original U.S. Plant Patent (Pl. 2,160)
- APPENDIX 4. Specification of a Reissue of a U.S. Utility Patent (Re. 25,558)
- APPENDIX 5. Reexamination Certificate (B1 3,367,320)
- APPENDIX 6. Form requesting First Office Action Interview Program in order to Expedite Patent Examination and Prosecution
- APPENDIX 7. Sample Format for Revised Amendment Practice before the U.S. Patent & Trademark Office

TABLE OF CONTENTS

APPENDIX 8. Model Scheduling Order and Model Standing  
Protective Order for Trials and Post Grant  
Proceedings before the USPTO Patent Trial  
and Appeal Board (PTAB)

**Table of Cases**

**Index**