

Summary of Contents

Volume 1

PART I. BASIC PRINCIPLES OF PATENT PROTECTION

- Chapter 1. What a Patent Is
- Appendix 1(A) Grant in Specification of an Original U.S. Utility Patent in New Format in View of Uruguay Round Agreements Act (U.S. Patent No. 5,543,706)
 - Appendix 1(B) Grant and Specification of an Original U.S. Utility Patent in New Format in View of Prior Law (U.S. Patent No. 4,463.215)
 - Appendix 1(C) Grant and Specification of an Original U.S. Utility Patent in Old Format (U.S. Patent No. 4,123,868)
 - Appendix 1(D) Interim Procedures for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in *Wyeth v. Kappos*, Regarding the Overlapping Delay Provisions of 35 U.S.C. 154(b)(2)(A)
 - Appendix 1(E) Changes to Patent Term Adjustment in View of the Federal Circuit Decision in *Novartis v. Lee*
- Chapter 2. Some Popularly Held Misconceptions About Patents
- Chapter 3. The Impact of Invention

PART II. COMPARISON AND CONTRAST OF TRADE SECRETS, TRADEMARKS, AND COPYRIGHTS WITH PATENTS

- Chapter 4. Trade Secrets
- Appendix 4(A) Economic Espionage Act of 1996

Appendix 4(B)	Economic Espionage Act Cases
Appendix 4(C)	Table of states adopting the Uniform Trade Secrets Act
Appendix 4(D)	Uniform Trade Secrets Act (with 1985 Amendments)
Appendix 4(E)	Computer Fraud and Abuse Act (CFAA), 18 U.S.C.A. 1080

Volume 2

PART II. COMPARISON AND CONTRAST OF TRADE SECRETS, TRADEMARKS, AND COPYRIGHTS WITH PATENTS (CONTINUED)

Chapter 5.	Trademarks
Appendix 5(A)	Trademark Registration Certificate for Initial Registration Under Current Law (Reg. No. 2,025,694)
Appendix 5(B)	Trademark Registration Certificate for Renewal Registration under Prior Law (Reg. No. 1,145,766)
Appendix 5(C)	Trademark Registration Certificate for Renewal Registration (Reg. No. 581,610)
Appendix 5(D)	Trademarks on the Principal Register
Appendix 5(E)	Trademarks on the Supplemental Register
Appendix 5(F)	Service Marks on the Principal Register
Appendix 5(G)	Service Marks on the Supplemental Register
Appendix 5(H)	Certification Marks on the Principal Register
Appendix 5(I)	Certification Marks on the Supplemental Register
Appendix 5(J)	Collective Membership Marks on the Principal Register
Appendix 5(K)	Collective Membership Marks on the Supplemental Register
Appendix 5(L)	Classification of Goods and Services
Appendix 5(M)	Trademark/Service Mark Application

SUMMARY OF CONTENTS

Appendix 5(N)	Madrid Agreement Concerning the International Registration of Marks
Appendix 5(O)	Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks
Appendix 5(P)	Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement
Appendix 5(Q)	USPTO Tips for International Trademark Filing and Frequently Asked Questions Regarding International Trademarks
Appendix 5(R)	Trademark Fees at the United States Patent & Trademark Office

Volume 3

PART II. COMPARISON AND CONTRAST OF TRADE SECRETS, TRADEMARKS, AND COPYRIGHTS WITH PATENTS (CONTINUED)

Chapter 6.	Copyrights
Appendix 6(A)	Copyright Form TX for Nondramatic Literary Work
Appendix 6(B)	Copyright Form SR for Sound Recording
Appendix 6(C)	Copyright Form VA for Visual Arts
Appendix 6(D)	Copyright Form PA for Performing Arts
Appendix 6(E)	Copyright Form MW for Semiconductor Mask Works
Appendix 6(F)	Copyright Form SE for Serial Work
Appendix 6(G)	Copyright Form Copyright Form GR/PPh/CON for Group Registration of Published Photographs
Appendix 6(H)	Copyright Form RE for Renewal Registration
Appendix 6(I)	Copyright Form RE/Addendum for Works Not Registered during Original Term

Appendix 6(J)	Copyright Form RE/CON Continuation Form for Renewal Registration
Appendix 6(K)	Copyright Form D-VH for Vessel Hull Design
Appendix 6(L)	Copyright Form D-VH/CON for Vessel Hull Design Continuation

PART III. THE SUBSTANTIVE REQUISITES OF A VALID PATENT

Chapter 7.	Statutory Subject Matter
Appendix 7(A)	Examination Guidelines for Computer Related Inventions M.P.E.P. § 2106, § 2106.01, and § 2106.02
Appendix 7(B)	Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility
Appendix 7(C)	Examination Guidelines for Living Subject Matter Inventions
Appendix 7(D)	Interim Guidance for Determining Subject Matter Eligibility for Process Claims in view of <i>Bilski v. Kappos</i> (Interim <i>Bilski</i> Guidance)
Appendix 7(E)	2012 Interim Procedure for Subject Matter Eligibility Analysis Process Claims Involving Laws of Nature (Interim <i>Mayo</i> Guidance)
Appendix 7(F)	2014 Procedure for Subject Matter Eligibility Analysis of Claims Reciting or Involving Laws of Nature/Natural Principles, Natural Phenomena, and/or Natural Products
Appendix 7(G)	Patent Eligibility Quick Reference Sheet for Claims Reciting or Involving Laws of Nature, Natural Phenomena, & Natural Products (Guidance)
Appendix 7(H)	Collected Summary of USPTO Examiner Guidance—Examples of Patent Eligible Subject Matter Analysis under 35 U.S.C. § 101

Volume 4

PART III. THE SUBSTANTIVE REQUISITES OF A VALID PATENT (CONTINUED)

Chapter 8. Design Patents as Statutory Subject Matter

- APPENDIX 8(A) Guide to Filing a Design Patent Application
- APPENDIX 8(B) Grant and Specification of U.S. Design Patent (Des. 378,181)
- APPENDIX 8(C) Applicant's Declaration for Utility or Design Application
- APPENDIX 8(D) Hague Agreement on Industrial Designs—U.S. Patent Statute 35 U.S.C. § 381—35 U.S.C. § 390
- APPENDIX 8(E) Changes to Implement the Hague Agreement Concerning International Registration of Industrial Designs—Rules of Practice

Chapter 9. Plant Patents as Statutory Subject Matter

- APPENDIX 9(A) Certificate of Plant Variety Protection (No. 8200092)
- APPENDIX 9(B) Application for a Plant Variety Protection Certificate
- APPENDIX 9(C) Plant Variety Exhibit E—Statement of the Basis of Ownership
- APPENDIX 9(D) Applicant's Declaration for Plant Application
- APPENDIX 9(E) Grant and Specification of U.S. Plant Patent (Pl. 2,160)
- APPENDIX 9(F) International Convention for the Protection of New Varieties of Plants

Chapter 10. Novelty

- Appendix 10(A) Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act
- Appendix 10(B) Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act

Chapter 11. Utility

APPENDIX 11(A) Examination Guidelines for the
Utility Requirement

Chapter 12. Nonobviousness

APPENDIX 12(A) Court Decisions on the Scope of
Relevant Prior Art

APPENDIX 12(B) Level of Ordinary Skill in Particular
Arts for Obviousness

PART IV. OBTAINING PATENT PROTECTION

Chapter 13. Preparation of Patent Applications

Appendix 13(A) 37 C.F.R. § 1.76—Application
Data Sheet

Appendix 13(B) Substitute Statement in Lieu of
Oath or Declaration

Appendix 13(C) Applicant’s Declaration for Plant
Application

Appendix 13(D) Requirements for Using the
Electronic Filing System for
Patent Applications and
Related Forms

Appendix 13(E) *[Reserved]*

Appendix 13(F) *[Reserved]*

Appendix 13(G) Changes To Implement the
Inventor’s Oath or Declaration
Provisions of the Leahy-Smith
America Invents Act

Appendix 13(H) USPTO’s Revised Rules for
Compliance with the
International Sequence Listing
Standard ST.26 (37 C.F.R.
1.831—1.835 and 1.839)

Chapter 14. Patent Claims: Analysis and Synthesis

Appendix 14(A) Examination of Patent
Applications That Include
Claims Containing Alternative
Language, Notice of proposed
rule making (10 Aug 2007)

SUMMARY OF CONTENTS

Appendix 14(A)(1)	American Intellectual Property Law Association (AIPLA) Comments on Proposed Rules: “Examination of Patent Applications That Include Claims Containing Alternative Language,” 72 Federal Register 44992 (August 10, 2007)
Appendix 14(A)(2)	Intellectual Property Owners Association (IPO) Comments on Proposed Rules: “Examination of Patent Applications That Include Claims Containing Alternative Language,” 72 Federal Register 44992 (August 10, 2007)

Volume 5

PART IV. OBTAINING PATENT PROTECTION (CONTINUED)

Chapter 15.	Prosecuting Patent Applications
Appendix 15(A)	Specification of Reissue U.S. Utility Patent (Pat. No. Re. 25,558)
Appendix 15(B)	Statutory Invention Registration (H16)
Appendix 15(C)	Defensive Publication (T964,002)
Appendix 15(D)	Reexamination Certificate (B1 3,367,320)
Appendix 15(E)	Tables Correlating Effective Dates of Components of the American Inventors Protection Act and Implementing Regulations
Appendix 15(F)	Patent & Trademark Office Fees
Appendix 15(G)	Telephone Contacts at the U.S. Patent and Trademark Office
Appendix 15(G)(1)	Patent & Trademark Resource Centers (PTRCs) Contact List

Appendix 15(H)	USPTO Rules for Representation of Others Before the United States Patent and Trademark Office
Appendix 15(H)(1)	Changes to Representation of Others Before The United States Patent and Trademark Office; Final Rule, Current Rules of Practice, Effective May 3, 2013
Appendix 15(H)(2)	Representation of Others Before The United States Patent and Trademark Office; Prior Rules of Practice, Prior to May 3, 2013
Appendix 15(I)	Rules of Practice Before the Board of Patent Appeals and Interferences Appeals (including final amendments for Ex Parte Appeals for appeals filed on or after January 23, 2012)
Appendix 15(I)(1)	Rules for Patent Appeals, Title 37 Part 41, subparts A, B, and C, Rules for Practice Before the Board of Patent Appeals and Interferences (for appeals filed prior to January 23, 2012)
Appendix 15(J)	USPTO Customer Number Form and Certificate Action Form
Appendix 15(K)	Chart Comparing Request for Continued Examination, Continued Prosecution, and URAA Transitional Practice
Appendix 15(L)	Sample Format for Revised Amendment Practice Before the U.S. Patent & Trademark Office
Appendix 15(M)	Patent and Trademark Office Final Rules for Continuation Practice for Patent Applications (72 FR 46716, August 21, 2007)
Appendix 15(N)	Patent and Trademark Office Final Rules for Claims Prosecution (72 FR 46716, August 21, 2007)

SUMMARY OF CONTENTS

Appendix 15(O)	Examination Guidelines for Determining Obviousness Under 35 U.S.C.A. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.
Appendix 15(O)(1)	2010 Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex
Appendix 15(P)	Sample Pre-Examination Search Report Document for the Accelerated Examination Program
Appendix 15(Q)	Sample Accelerated Examination Support Document for the Accelerated Examination Program
Appendix 15(Q)(1)	Patent & Trademark Office Amended Rules for Track One Prioritized Examination
Appendix 15(R)	Model Format for Attorney—Client Engagement Letter and Attorney—Client Retainer Agreement for Patent Practitioners
Appendix 15(S)	Appellant’s Brief on Appeal to the Board of Patent Appeals
Appendix 15(T)	Changes to Implement Micro Entity Status for Paying Patent Fees
Appendix 15(U)	Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act
Appendix 15(V)	Changes To Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and To Revise Reexamination Fees
Appendix 15(W)	USPTO Enhanced Quality Initiative Master Review Form for Patent Office Action Review

Chapter 15A.	Post Grant Review of Issued Patents: Certificates of Correction, Reissue of Patents, Ex Parte Reexamination, and Inter Partes Reexamination
Appendix 15A(A)	Ex Parte Reexamination of Patents: Statute and Regulations
Appendix 15A(B)	Inter Partes Reexamination of Patents Prior to the AIA Amendments: Statute and Regulations
Appendix 15A(C)	Current Rules for Inter Partes Reexamination Appeals to the Board of Patent Appeals and Interferences, Title 37 Part 41, subparts A, and C
Appendix 15A(D)	Reissue Patents and Proceedings: Statute and Rules

Volume 6

PART IV. OBTAINING PATENT PROTECTION (CONTINUED)

Chapter 15B.	Post Grant Review of Issued Patents— Inter Partes Proceedings: Inter Partes Review (IPR), Post Grant Review (PGR), Covered Business Method Review (CBM)
Appendix 15B(A)	Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act
Appendix 15B(A)(1)	Rules of Practice for Trials before Patent Trial and Appeal Board and Judicial Review of Decisions
Appendix 15B(B)	Inter Partes Review of Patents: Statute and Rules
Appendix 15B(B)(1)	Inter Partes Review (IPR) of Patents Amended Rule for Burden of Persuasion for claim amendments

SUMMARY OF CONTENTS

Appendix 15B(C)	Post Grant Review of Patents: Statute and Rules
Appendix 15B(C)(1)	Post Grant Review (PGR) of Patents Amended Rule for Burden of Persuasion for claim amendments
Appendix 15B(D)	Transitional Program for Covered Business Method Patents: Statute and Rules
Appendix 15B(E)	Model Scheduling Order for Inter Partes Review, Post-Grant Review, and Covered Business Method Patents Review (Based on the Trial Practice Guide, August, 2018)
Appendix 15B(F)	Standing Protective Order for Trials before the Patent Trial and Appeal Board
Appendix 15B(G)	Example of Claim Construction Tables in Post Grant Review Proceedings
Appendix 15B(H)	Example Claim Chart for Post Grant Review
Appendix 15B(I)	Patent Trial and Appeal Board— Consolidated Trial Practice Guide November 2019 Edition
Appendix 15B(I)(1)	Office Trial Practice Guide Update (August 2018)
Appendix 15B(J)	Proposed Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings before the Patent Trial and Appeal Board

PART V. COMPETING RIGHTS TO THE SAME INVENTION

Chapter 16.	Priority of Invention, Derivation, and Interference Practice
Appendix 16(A)	1985 Patent Interference Rules, Title 37 C.F.R. Section 1.601 to 37 C.F.R. Section 1.690

Appendix 16(B)	Patent Interference Rules, Title 37, Part 41--Practice Before the Board of Patent Appeals and Interferences
Appendix 16(C)	United States Patent and Trademark Office—Board of Patent Appeals and Interferences—Trial Section— Contested Case Practice Guide
Appendix 16(D)	Standing Order of the Board of Patent Appeals and Interferences entered January 3, 2006
Appendix 16(E)	Sample Real Party in Interest Pleading
Appendix 16(F)	Sample Lead & Backup Counsel Pleading
Appendix 16(G)	Sample Related Proceeding Pleading
Appendix 16(H)	Sample File History Pleading
Appendix 16(I)	Sample Clean Copy of Claims Pleading
Appendix 16(J)	Sample Annotated Claims Pleading
Appendix 16(K)	Sample Motions List Pleading
Appendix 16(L)	Motion for Judgment Based on No Interference-in-Fact and supporting documents
Appendix 16(M)	Priority Statement filed under 37 C.F.R. 41.204
Appendix 16(N)	Motion for Judgment Based on Priority and Derivation
Appendix 16(O)	Supplemental List of Exhibits In support of Motion for Priority
Appendix 16(P)	Sample Exhibit and Sample Witness Declaration in Support of Motion for Priority
Appendix 16(Q)	Sample Motion for Adverse Judgment and Settlement Agreement Under the “New Rules”
Appendix 16(R)	Derivation Proceedings under the AIA: Statute and Rules
Appendix 16(S)	Scheduling Order for Derivation Proceedings (Based on the Proposed Trial Rules)

SUMMARY OF CONTENTS

Chapter 17.	The Inventorship Entity, Patent Ownership, and Employer-Employee Rights
Chapter 18.	Government Interest in Patents: Procurement and Ownership
Appendix 18(A)	Standard Patent Clauses for Government Contracts
Appendix 18(B)	Standard Patent Clauses for U.S. Defense Department Contracts (DFARS)
Appendix 18(C)	Model CRADA Agreement for Cooperative Venture with Federal Agency
Appendix 18(D)	Memorandum of Invalidity in Administrative Patent Claim

Volume 7

PART VI. EXPLOITING PATENT RIGHTS

Chapter 19.	Licensing and Assignment: The Sharing and Transfer of Patent Rights
Appendix 19(A)	Rules of the American Arbitration Association
Appendix 19(B)	Arbitration Authorization by U.S. District Courts 28 U.S.C.A. §§ 651–658
Appendix 19(C)	An Example of an Exclusive Patent License
Appendix 19(D)	An Example of a non Exclusive Patent License
Appendix 19(E)	An Example of an Employment Agreement with Patents Clause
Appendix 19(F)	An Example of a Nondisclosure Agreement
Appendix 19(G)	Sample Clauses for Royalty Rates in License Agreements
Appendix 19(H)	Department of Justice (DOJ) and Federal Trade Commission (FTC) Antitrust Guidelines for Intellectual Property Licensing
Chapter 20.	Litigation of Patent Rights

Appendix 20(A)	28 U.S.C.A. § 1295—Jurisdiction of U.S. Court of Appeals for the Federal Circuit
Appendix 20(B)	Federal Rules of Appellate Procedure with Modifications for the Court of Appeals for the Federal Circuit
Appendix 20(B)(1)	Proposed Amended Rules for the United States Court of Appeals for the Federal Circuit
Appendix 20(C)	Amendments to Patent Act of 1952 in Order of Enactment
Appendix 20(D)	United States Court of Appeals for the Federal Circuit Docketing Statement for Appellate Mediation Program
Appendix 20(E)	United States Court of Appeals for the Federal Circuit Confidential Joint Request to Enter Appellate Mediation Program
Appendix 20(F)	Amended Federal Rules of Civil Procedure for Electronic Discovery Rules 16, 26, 33, 34, 37, 45 and Form 35
Appendix 20(G)	Revised Fee Schedule for Filings at the United States Court of Appeals for the Federal Circuit (effective January 1, 2007)
Appendix 20(H)	Model Appeal Brief to the Federal Circuit involving a case of alleged patent infringement for the alleged unauthorized use of night vision technology
Appendix 20(I)	Complaint for Patent Infringement
Appendix 20(J)	Answer and Counterclaim to Complaint for Patent Infringement
Appendix 20(K)	Sample Expert Witness Engagement Letter
Appendix 20(L)	Model Order Limiting Excess Patent Claims and Prior Art

SUMMARY OF CONTENTS

Appendix 20(M)	Amended Federal Rules of Civil Procedure
Appendix 20(N)	Draft Legislation to Improve Patent Protection— <i>Support Technology and Research for Our Nation’s Growth and Economic Resilience (STRONGER) Patents Act of 2017</i>
Appendix 20(O)	Judicial Conduct and Disability Act
Appendix 20(P)	Code of Conduct for Justices of the Supreme Court of the United States
Chapter 20A.	Manufacturing and Marketing Patented Inventions

Volume 8

PART VII. PATENTS IN GLOBAL CONTEXT: OBTAINING AND MAINTAINING RIGHTS ABROAD

Chapter 21.	Elements of Transnational Patent Law
Appendix 21(A)	Patent Cooperation Treaty(“PCT”)
Appendix 21(B)	Regulations under the PCT
Appendix 21(C)	Forms Submitted to Begin PCT Chapter I Case
Appendix 21(D)	Forms Returned to Applicant in Response to a PCT Chapter I Case
Appendix 21(D)A.	Article 19 Model Set of Replacement Claims and Accompanying Letter
Appendix 21(E)	Forms submitted by applicant to begin a PCT Chapter II Case
Appendix 21(F)	Forms returned to applicant in response to a PCT Chapter II Case
Appendix 21(G)	Forms for initiating U.S. National Stage Patent Application
Appendix 21(H)	European Patent Convention
Appendix 21(I)	European Patent Office Guidelines for Substantive Examination
Appendix 21(I)A.	European Patent Office Amended Rules for Divisional Applications

Appendix 21(J)	Guidelines for Opposition Procedure
Appendix 21(K)	International Trade Commission's (ITC's) Rules of Practice and Procedure
Appendix 21(L)	The Patent Law Treaty
Appendix 21(M)	Regulations Under the Patent Law Treaty
Appendix 21(N)	Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the Enforcement of Intellectual Property Rights
Appendix 21(O)	Conclusions on an Enhanced Patent System in Europe, Proposal for a Council Regulation
Appendix 21(P)	Agreement on a Unified Patent Court
Appendix 21(Q)	Draft Convention of the Hague Special Commission on the Recognition and Enforcement of Foreign Judgments
Appendix 21(R)	Andean Community Regional Intellectual Property Law Decision 486
Chapter 21A.	Bilateral Agreements in Transnational Patent Law
Chapter 21B.	International and Transnational Design Patents and Applications
Appendix 21B(A)	European Community Design, Council Regulation (EC) No 6/2002
Appendix 21B(B)	Regulations Implementing the Community Design Patent Legislation
Appendix 21B(C)	Hague Agreement Application for International Registration
Appendix 21B(D)	The Hague Agreement Concerning the International Registration of Industrial Designs, Geneva Act of July 2, 1999
Chapter 21C.	The World Trade Organization (WTO)
Chapter 22.	Comparative Patent Law: Survey of

SUMMARY OF CONTENTS

Principal Foreign Patent Systems

- APPENDIX 22(A) European Union Proposal for Council Regulation on the Community
- APPENDIX 22(B) European Union Proposal for a Council Decision Establishing the Community Patent Court and Concerning Appeals before the Court of First Instance
- APPENDIX 22(C) European Union Proposal for a Council Decision Conferring Jurisdiction on the Court of Justice in Disputes Relating to the Community Patent
- APPENDIX 22(D) International Convention for the Protection of New Varieties of Plants

Volume 9

**PART VII. PATENTS IN GLOBAL CONTEXT:
OBTAINING AND MAINTAINING RIGHTS ABROAD
(CONTINUED)**

- Chapter 23. Argentina
- Chapter 24. Brazil
- Chapter 25. Canada
- APPENDIX 25(A) Application for Registration of an Industrial Design
- APPENDIX 25(B) Guide to Plant Breeder' Rights
- APPENDIX 25(C) Application for Registration of an Integrated Circuit Topography
- APPENDIX 25(D) Canada—Petition for Grant of a Patent
- Chapter 26. People's Republic of China
- Appendix 26(A) China's Patent Law, 1992, as amended 2008
- Chapter 27. France
- Chapter 28. Germany
- Chapter 29. India

APPENDIX 29(A) India Patent Offices and Patent Law

- Chapter 30. Japan
- Chapter 31. Republic of Korea (South Korea)
- Chapter 32. Russian Federation
- Chapter 33. United Kingdom

APPENDIX 33(A) United Kingdom—Patents County Court Rules

- Chapter 34. Australia
- Chapter 35. Singapore
- Chapter 36. Finland
- Chapter 37. Israel
- Chapter 38. Mexico
- Chapter 39. Chile

Table of Laws and Rules

Table of Cases

Index