

# Index

## 2023

ABS Global, Inc. v. Cytonome/St, LLC, **1:381**  
Actelion Pharmaceuticals LTD v. Mylan Pharmaceuticals Inc., **1:382**  
Allgenesis Biotherapeutics Inc. v. Cloudbreak Therapeutics, LLC, **1:383**  
AlterWAN, Inc. v. Amazon.com, Inc., **1:384**  
Amgen Inc. v. Sandoz Inc., **1:385**  
Apple Inc. v. Corephotonics, Ltd., **1:386**  
Apple Inc. v. Vidal, **1:387**  
Arbutus Biopharma Corporation v. ModernaTX, Inc., **1:388**  
Axonics, Inc. v. Medtronic, Inc., **1:389**; **1:390**  
Baxalta Incorporated v. Genentech, Inc., **2:203**  
Blue Gentian, LLC v. Tristar Products, Inc., **2:204**  
Bot M8 LLC v. Sony Interactive Entertainment LLC, **2:205**  
ChromaDex, Inc. v. Elysium Health, Inc., **3:245**  
Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc., **3:246**  
Corephotonics, Ltd. v. Apple Inc., **3:247**  
Cyntec Company, Ltd. v. Chilisyn Electronics Corp., **3:248**  
CyWee Group Ltd. v. Google LLC, **3:249**  
Elekta Limited v. ZAP Surgical Systems, Inc., **5:156**  
Finjan LLC v. SonicWall, Inc., **6:108**  
FS.com Inc. v. International Trade Commission, **6:109**  
H. Lundbeck A/S v. Lupin Ltd., **8:166**  
Hawk Technology Systems, LLC v. Castle Retail, LLC, **8:167**  
Hip, Inc. v. Hormel Foods Corporation, **8:168**  
Incept LLC v. Palette Life Sciences, Inc., **9:522**

## 2023—Cont'd

Inguran, LLC v. ABS Global, Inc., **9:523**  
In re: Collect, LLC, **9:516**  
In re Couvaras, **9:517**  
In re Float 'N' Grill LLC, **9:518**  
In re Google LLC, **9:519**  
In re PersonalWeb Technologies LLC, **9:520**  
In re Stingray IP Solutions, LLC, **9:521**  
Intel Corporation v. PACT XPP Schweiz AG, **9:524**  
Ironburg Inventions Ltd. v. Valve Corporation, **9:525**  
K-fee System GmbH v. Nespresso USA, Inc., **11:91**  
Malvern Panalytical Inc. v. TA Instruments-Waters LLC, **13:254**  
Medtronic, Inc. v. Teleflex Innovations S.a.r.l., **13:255**; **13:256**  
Medtronic, Inc. v. Teleflex Life Sciences Limited, **13:257**  
Medytox, Inc. v. Galderma S.A., **13:258**  
Minerva Surgical, Inc. v. Hologic, Inc., **13:259**  
Netflix, Inc. v. DivX, LLC, **14:109**; **14:110**  
Parkervision, Inc. v. Vidal, **16:188**  
Parus Holdings, Inc. v. Google LLC, **16:189**  
Personalized Media Communications, LLC v. Apple Inc., **16:190**  
Philip Morris Products S.A. v. International Trade Commission, **16:191**  
Purdue Pharma L.P. v. Collegium Pharmaceutical, Inc., **16:192**  
Regents of the University of Minnesota v. Gilead Sciences, Inc., **18:134**  
Rembrandt Diagnostics, LP v. Alere, Inc., **18:135**  
Roku, Inc. v. Universal Electronics, Inc., **18:136**  
Salazar v. AT&T Mobility LLC, **19:344**

**2023—Cont'd**

- Sanderling Management Ltd. v. Snap Inc., **19:345**
- Sanofi-Aventis Deutschland GmbH v. Mylan Pharmaceuticals Inc., **19:346**
- Schwendimann v. Neenah, Inc., **19:347**
- Sequoia Technology, LLC v. Dell, Inc., **19:348**
- Sisvel International S.A. v. Sierra Wireless, Inc., **19:349; 19:350**
- SNIPR Technologies Limited v. Rockefeller University, **19:351**
- SSI Technologies, LLC v. Dongguan Zhengyang Electronic Mechanical LTD., **19:352**
- Trinity Info Media, LLC v. Covalent, Inc., **20:165**
- UCB, Inc. v. Actavis Laboratories UT, Inc., **21:92**
- United Cannabis Corporation v. Pure Hemp Collective Inc., **21:93**
- United Therapeutics Corporation v. Liquidia Technologies, Inc., **21:94**
- VLSI Technology LLC v. Intel Corporation, **22:68**
- Volvo Penta of the Americas, LLC v. Brunswick Corporation, **22:69**

**2024**

- AI Visualize, Inc. v. Nuance Communications, Inc., **1:391**
- AlexSam, Inc. v. Aetna, Inc., **1:392**
- Allergan USA, Inc. v. MSN Laboratories Private Ltd., **1:393**
- Amarin Pharma, Inc. v. Hikma Pharmaceuticals USA Inc., **1:394**
- Astellas Pharma, Inc. v. Sandoz Inc., **1:395**
- Backertop Licensing LLC v. Canary Connect, Inc., **2:206**
- Beteiro, LLC v. DraftKings Inc., **2:207**
- Broadband iTV, Inc. v. Amazon.com, Inc., **2:208**
- Brumfield, Trustee for Ascent Trust v. IBG LLC, **2:209**
- Celanese International Corporation v. International Trade Commission, **3:250**
- Chewy, Inc. v. International Business Machines Corporation, **3:251**

**2024—Cont'd**

- Cloudofchange, LLC v. NCR Corporation, **3:252**
- Contour IP Holding LLC v. GoPro, Inc., **3:253**
- Crown Packaging Technology, Inc. v. Belvac Production Machinery, Inc., **3:254**
- Cytiva BioProcess R&D AB v. JSR Corp., **3:255**
- CyWee Group Ltd. v. ZTE (USA), Inc., **3:256**
- DDR Holdings, LLC v. Priceline.com LLC, **4:134**
- DexCom, Inc. v. Abbott Diabetes Care, Inc., **4:135**
- Dragon Intellectual Property LLC v. DISH Network L.L.C., **4:136**
- EcoFactor, Inc. v. Google LLC, **5:157**
- Edwards Lifesciences Corporation v. Meril Life Sciences Pvt. Ltd., **5:158**
- Freshub, Inc. v. Amazon.com, Inc., **6:110**
- Galderma Laboratories, L.P. v. Lupin Inc., **7:145**
- Google LLC v. EcoFactor, Inc., **7:146**
- Inline Plastics Corp. v. Lacerta Group, LLC, **9:526**
- Intellectual Tech LLC v. Zebra Technologies Corporation, **9:527**
- IOENGINE, LLC v. Ingenico Inc., **9:528**
- Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc., **10:55**
- LKQ Corporation v. GM Global Technology Operations LLC, **12:124**
- Luv n8217 Care, Ltd. v. Laurain, **12:125**
- Maxell, Ltd. v. Amperex Technology Limited, **13:260**
- Miller Mendel, Inc. v. City of Anna, Texas, **13:261**
- Mirror Worlds Technologies, LLC v. Meta Platforms, Inc., **13:262**
- Mobile Acuity Ltd. v. Blippar Ltd., **13:263**
- Natera, Inc. v. NeoGenomics Laboratories, Inc., **14:111**
- NexStep, Inc. v. Comcast Cable Communications, LLC, **14:112**

## INDEX

### 2024—Cont'd

Osseo Imaging, LLC v. Planmeca USA Inc., **15:63**  
Packet Intelligence LLC v. NetScout Systems, Inc., **16:193**  
Palo Alto Networks, Inc. v. Centripetal Networks, LLC, **16:194**  
ParkerVision, Inc. v. Qualcomm Incorporated, **16:195**  
Pfizer Inc. v. Sanofi Pasteur Inc., **16:196**  
Platinum Optics Technology Inc. v. Viavi Solutions Inc., **16:197**  
Promptu Systems Corporation v. Comcast Corporation, **16:198**  
Provisur Technologies, Inc. v. Weber, Inc., **16:199**  
PS Products Inc. v. Panther Trading Co. Inc., **16:199**  
Rai Strategic Holdings, Inc. v. Philip Morris Products S.A., **18:137**  
Roku, Inc. v. International Trade Commission, **18:138**  
Salix Pharmaceuticals, Ltd. v. Norwich Pharmaceuticals Inc., **19:353**  
Sanho Corp. v. Kaijet Technology International Limited, Inc., **19:354**  
SnapPower v. Lighting Defense Group, **19:355**  
SoftView LLC v. Apple Inc., **19:356**  
Speck v. Bates, **19:357**  
Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc., **20:166**  
Teva Branded Pharmaceutical Products R&D, Inc. v. Amneal Pharmaceuticals of New York, LLC, **20:167**  
UTTO Inc. v. Metrotech Corp., **21:95**  
Vascular Solutions LLC v. Medtronic, Inc., **22:70**  
Virtek Vision International ULC v. Assembly Guidance Systems, Inc., **22:71**  
Voice Tech Corp. v. Unified Patents, LLC, **22:72**  
Weber, Inc. v. Provisur Technologies, Inc., **23:103**  
Wisconsin Alumni Research Foundation v. Apple Inc., **23:104**  
Zircon Corp. v. International Trade Commission, **26:17**

### 2024—Cont'd

ZyXEL Communications Corp. v. UNM Rainforest Innovations, **26:18**

### 2025

Agilent Technologies, Inc. v. Synthego Corp., **1:396**  
AliveCor, Inc. v. Apple Inc., **1:397**  
Alnylam Pharmaceuticals, Inc. v. Moderna, Inc., **1:398**  
AMP Plus, Inc. v. DMF, Inc., **1:399**  
Ancora Technologies, Inc. v. Roku, Inc., **1:400**  
Apple Inc. v. Gesture Technology Partners, LLC, **1:401; 1:402**  
Azurity Pharmaceuticals, Inc. v. Alkem Laboratories Ltd., **1:403**  
BearBox LLC v. Lancium LLC, **2:210**  
CQV Co., Ltd. v. Merck Patent GmbH, **3:257**  
Dolby Laboratories Licensing Corporation v. Unified Patents, LLC, **4:137**  
EcoFactor, Inc. v. Google LLC, **5:159**  
Eye Therapies, LLC v. Slayback Pharma, LLC, **5:160**  
Fintiv, Inc. v. PayPal Holdings, Inc., **6:111**  
Fraunhofer-Gesellschaft zur Forderung der angewandten Forschung e.V. v. Sirius XM Radio Inc., **6:112**  
HD Silicon Solutions LLC v. Microchip Technology Inc., **8:169**  
Honeywell International Inc. v. 3G Licensing, S.A., **8:170**  
ImmunoGen, Inc. v. Stewart, **9:529**  
Incyte Corporation v. Sun Pharmaceutical Industries, Inc., **9:535**  
Ingenico Inc. v. IOENGINE, LLC, **9:536**  
In re Entresto, **9:530**  
In re Forest, **9:531**  
In re Kostic, **9:532**  
In re Riggs, **9:533**  
In re Xencor, Inc., **9:534**  
IQRIS Technologies LLC v. Point Blank Enterprises, Inc., **9:537**  
Jazz Pharmaceuticals, Inc. v. Avadel CNS Pharmaceuticals, LLC, **10:56**  
Kroy IP Holdings, LLC v. Groupon, Inc., **11:92**  
Lashify, Inc. v. International Trade Commission, **12:126**

**2025—Cont'd**

- Lynk Labs, Inc. v. Samsung Electronics Co., Ltd., **12:127**  
 Maquet Cardiovascular LLC v. Abiomed Inc., **13:264**  
 Merck Sharp & Dohme B.V. v. Aurobindo Pharma USA, Inc., **13:265**  
 Mitek Systems, Inc. v. United Services Automobile Association, **13:266**  
 Odyssey Logistics & Technology Corp. v. Stewart, **15:64**  
 Optis Cellular Technology, LLC v. Apple Inc., **15:65**  
 Qualcomm Incorporated v. Apple Inc., **17:14**  
 Realtek Semiconductor Corporation v. International Trade Commission, **18:139; 18:140**  
 Recentive Analytics, Inc. v. Fox Corp., **18:141**  
 Regeneron Pharmaceuticals, Inc. v. Mylan Pharmaceuticals Inc., **18:142**  
 Regents of the University of California v. Broad Institute, Inc, **18:143**  
 Restem, LLC v. Jadi Cell, LLC, **18:144**  
 Sage Products, LLC v. Stewart, **19:358**  
 Sierra Wireless, ULC v. Sisvel S.p.A., **19:359**  
 Sigray, Inc. v. Carl Zeiss X-Ray Microscopy, Inc., **19:360**  
 Steuben Foods, Inc. v. Shibuya Hoppmann Corporation, **19:361**  
 United Services Automobile Association v. PNC Bank N.A., **21:96**  
 US Synthetic Corp. v. International Trade Commission, **21:97**  
 Wash World Inc. v. Belanger Inc., **23:105**  
 Wuhan Healthgen Biotechnology Corp. v. International Trade Commission, **23:106**

**“A”**

- Generally, **1:85; 1:130; 3:96; 11:46**  
 Claim interpretation, **2:127; 20:90**  
 One or more than one, **5:44**

**ABANDONMENT**

- Delay, unreasonable delay, **12:21**  
 Earlier devices, defendant's abandonment of, **3:3**

**ABANDONMENT—Cont'd**

- Law question, **1:111**  
 Mandamus, changing filing date on abandoned application, **9:54**  
 Revival, **1:177**  
 Suppression, **3:59; 6:33**  
 Time, length of, **4:65**  
 Unreasonable delay, **12:21**

**ABBREVIATED NEW DRUG APPLICATION (ANDA)**

- Generally, **1:116; 2:54; 2:74; 4:40; 7:55; 7:139; 13:107; 19:182; 20:79**  
 Amendments, infringement, **6:90**  
 Attorney fees, **25:7**  
 Certification pledging, **19:247**  
 Conduct before FDA, **5:95**  
 Covenant not to sue, **3:132**  
 Damages, **1:280**  
 Declaratory judgment, **10:39**  
 Dependent claims, **15:31**  
 Disclose, obligation to, **2:81**  
 Double patenting, **1:166**  
 Enablement, **3:169**  
 Exclusivity period, **4:98**  
 Infringement  
   generally, **2:88**  
   amendments, **6:90**  
 Jurisdiction over orange book, **1:135**  
 Labeling, indications and usage, **2:152**  
 Obviousness, **6:91; 16:108; 19:271**  
 180-day exclusivity period, **4:98**  
 Paragraph IV, **3:132; 13:113; 20:78**  
 Preliminary injunction, **1:202**  
 Reasonable royalty, **1:280**  
 Repetitive filing, **1:156**  
 Reverse doctrine of equivalents, **18:80**  
 Safe harbor provision of Hatch-Waxman, **13:187**  
 Sec. 271(e)(2)(A), **9:312**  
 Sec. 1337(a), **1:175**  
 Settlement agreements, **9:309**  
 Subject matter, **20:100**  
 30-month period, **1:120; 5:95**  
 Use different than claimed in method claims, **1:128**  
 Willful, **7:81**

**“ABOUT”**

- Generally, **15:27**

## INDEX

### **“ABOUT”—Cont’d**

Doctrine of equivalents, **3:136**

### **ABOUT CLAIM TERMINOLOGY**

Generally, **10:26; 13:80**

Meaning thereof, **5:20**

### **ABS GLOBAL, INC. V.**

**CYTONOME/ST, LLC**

2023, **1:381**

### **ABSOLUTE**

Intervening rights, **13:168; 19:137**

### **ABSOLUTE PREDICTABILITY**

Obviousness, **9:52; 13:18**

### **ABSOLUTE RULES**

Claim preamble, **7:61**

### **ABSTENTION**

Generally, **23:100**

### **ABSTRACT**

Generally, **8:73**

Claim interpretation, **8:73**

Sec. 101, abstract ideas, **1:95; 1:253; 1:285; 1:286; 1:290; 1:333; 2:163; 3:143; 3:212; 4:104; 5:128; 6:94; 9:286; 9:308; 13:188; 19:298; 19:301; 19:323; 20:143; 21:61; 22:58**

Sec. 112, abstract ideas, **18:85**

Statutory subject matter, **21:57**

### **ABSTRACTIONS**

Graver Tank, **20:6**

### **ABSURD RESULTS**

Statutory construction, **2:39**

### **ABUSE**

Anticipation, **18:20**

Fraud, **16:25**

### **ABUSE OF DISCOVERY**

FRCP 37, **7:23**

FRCP 37(a)(4), **13:48**

Monetary sanctions, **13:6**

### **ABUSE OF DISCRETION**

Generally, **12:76; 13:41**

Appellate review, **13:1**

Attorney fees award, **16:24**

Dismissal of pendent state law claim for unfair competition, **22:2**

Examiner’s deposition, **23:5**

### **ABUSE OF DISCRETION—Cont’d**

Found, **2:27**

FRCP 26, **8:9**

FRCP 56(f), **13:154**

Inequitable conduct, **18:78**

Interference, **5:68**

Motion for new trial, **23:10**

Motion to compel discovery, **19:17**

Permanent injunction, **1:219; 9:315**

Prejudgment interest, **3:96; 8:20**

Preliminary injunction, **1:155; 1:169; 13:89**

Sec. 271(e)(1), **5:3**

Sec. 285, **1:299; 2:170; 7:20**

Written description, **3:197; 9:318**

### **ABUSE OF PROCESS**

State tort claim, **1:42**

### **ACCEPTABLE SUBSTITUTES**

Generally, **19:96**

Availability, **7:47**

Lost profits, **13:45**

Panduit, **3:8; 4:90**

### **ACCEPTED WISDOM, CONTRARY TO**

Generally, **23:11**

Obviousness, **3:3**

### **ACCESS AND ACCESSIBILITY**

Public access, **4:101; 9:261; 12:89; 19:207; 22:42**

### **ACCESSORY SALES**

Damages base, **11:21**

### **ACCIDENTAL DUPLICATION**

Anticipation, **19:107**

### **ACCORD AND SATISFACTION**

Discharge of claim, **3:48**

### **ACCOUNTING AND ACCOUNTING PHASE**

Attorney, authoritative opinion of, **11:15**

Damages, **1:20; 1:38; 11:15**

Enhanced damages, **11:15**

Final judgment rule, **18:104**

Jurisdiction, **16:72**

Law of the case, **11:15**

Lost profits, defendant’s profits as measure of, **11:15**

**ACCOUNTING AND ACCOUNTING  
PHASE—Cont'd**

Nonparty's motion to quash discovery subpoena, **20:17**

**ACCURACY**

Claim interpretation, **19:155**

**ACCUSTOMED MEANING**

**Ordinary and Accustomed Meaning**  
(this index)

**ACTELION PHARMACEUTICALS  
LTD V. MYLAN**

**PHARMACEUTICALS INC.**

2023, **1:382**

**ACTING ON BEHALF OF**

Sec. 119(a), **2:125**

**ACTIVE INGREDIENT**

Patent term extension, **16:125**

**ACTUAL CASE**

Subject matter jurisdiction, **12:22**

**ACTUAL COMBINATION**

Sec. 271(f)(2), **23:53**

**ACTUAL COMMERCIAL  
CONSEQUENCES**

Sec. 102(e) v. sec. 102(g), **19:41**

**ACTUAL CONTROVERSY**

Declaratory judgment, **1:94; 2:122;  
3:69; 6:35; 6:38; 7:38; 7:55; 8:66;  
9:324; 23:22**

Declaratory judgment of infringement,  
**20:26**

Subject matter jurisdiction, **12:22**

**ACTUAL DEVICE SOLD**

Blonder-Tongue, **1:13**

**ACTUAL NOTICE AND  
KNOWLEDGE**

Infringement, **12:61**

Willful infringement, **3:80; 14:24**

**ACTUAL REDUCTION TO  
PRACTICE**

Interference, **14:3**

Law question, **4:27**

**ACTUAL REPORTS OF FAILURE**

Obviousness, **2:101**

**ACTUAL SKILL**

Invention, **19:34**

**ACTUAL WORDS**

Claim interpretation, **4:53**

**ADDENDA**

Motion to strike, **6:10**

Strike, motion to, **6:10**

**ADDITIONAL COMPONENTS OR  
ELEMENTS**

Compare claims with accused product,  
**12:18**

Consisting of claim language, **13:7**

Gist, **12:18**

Good faith prosecution, **12:18**

Infringement not avoided, **12:18**

Prosecution history, **12:18**

Reverse doctrine of equivalents, **12:18**

**ADDITIONAL EVIDENCE**

Generally, **21:36**

**ADDITIONAL PRECISION**

Claim interpretation, **16:55; 22:40**

**ADDITIONAL REFERENCES**

Sec. 102(b), **9:18**

**ADDITIONS**

After entry of judgment, **15:13**

CIP, **19:28**

Correcting inventorship, **1:54**

Cross-appeal to reverse validity or  
infringement component of judgment,  
**18:2**

Factual findings to support jury verdict  
presumed, **2:15**

FRCP 15(c), **6:11**

Infringement, **9:186; 14:8**

Judgment, after entry of judgment,  
**15:13**

Obviousness, **21:8**

Transfer of appeal, **7:14**

**ADDRESS OF CLAIMS**

Court findings, **1:9**

**ADJUSTMENT OF PATENT TERM**

Generally, **3:232; 7:116; 9:484; 13:205;  
13:237; 19:321**

Equitable tolling, **14:74**

Sec. 154(b), **23:69**

Summary judgment, **1:315**

## INDEX

### ADMINISTRATIVE AGENCY

**Patent and Trademark Office (PTO)**  
(this index)

### ADMINISTRATIVE BOARD

Factual underpinning, **2:37**  
Review, standard of, **13:49; 22:9**  
Substantial evidence standard, factual  
determinations reviewed under,  
**8:34**

### ADMINISTRATIVE LAW

Appeal and review, **4:38; 15:8**  
Cross-examination, right to, **4:38**  
Discretionary agency decision, standard  
of review of, **4:38**  
Inter parties review, **19:282**  
Limitation of actions, **13:62**  
Presumption that government officials  
perform their duties properly and in  
good faith, **13:70**  
Sec. 101 patentability, **3:143**  
Vitalness thereof, **4:38**

### ADMINISTRATIVE NULLIFICATION

Final judgment, **9:354**

### ADMINISTRATIVE PATENT JUDGES

Generally, **21:85**  
Appointment, **9:311**

### ADMINISTRATIVE PROCEDURE ACT (APA)

Generally, **2:202; 5:81; 15:59; 19:176**  
Comprehensive record, **2:126**  
Good cause exception under, **14:17**  
Interference, **9:263**  
Judicial review of PTO decisions under  
APA, **16:134**  
Notice requirement, **9:344**  
Own regulations, **19:180**  
Restriction requirement, **8:165**  
Sec. 553, **1:45**  
Sec. 703(c), **13:51**  
Sec. 706(2), **13:50**  
Sec. 7513, **1:354**  
Sec. 7703, **2:32**  
Sec. 7703(c), **8:31; 11:26**  
Substantial evidence standard,  
administrative board's factual  
determinations reviewed under,  
**8:34**

### ADMISSIBILITY OF EVIDENCE

Claim interpretation, **19:16**  
Discretion of court, **3:57**  
Expert testimony, **1:42; 1:43; 7:29**  
FRAP 28(e), **12:11**  
Inventor's testimony, **8:106**  
PTO examination, evidence withheld  
during, **8:111**  
Sec. 145, **8:118**

### ADMISSIONS

Antedate reference, failed attempt to,  
**3:54**  
Choice of law, **13:121**  
Dismissal, **3:19**  
Ex parte test, **3:10**  
MPEP, **16:6**  
Obviousness, **9:125; 18:70**  
Own work, **18:70**  
Presumption of validity, **18:10**  
Specifications, **16:109**

### ADR PROCEEDING

Discovery, **8:37**

### ADVERSARINESS, LACK OF

Jurisdiction, **7:8**

### ADVERTISING

Abstract ideas, **1:285**

### ADVICE OF COUNSEL

Willful infringement, **14:5; 19:154**

### ADVISORY JURY

Obviousness findings, **11:69**  
Substantial evidence standard, **18:14**  
Verdict, **20:39**

### ADVISORY OPINION

CAFC jurisdiction, **20:2**  
Declaratory judgment, **9:92**

### ADVOCACY

FRCP 15(c), **6:11**

### AESTHETICS DETERMINATION

Sec. 171, **9:73**

### AFFIDAVIT

Antedating reference, **7:19**  
Appreciation or recognition by inventor  
of invention of interference counts,  
**9:23**  
Claims construed, **9:77**

**AFFIDAVIT—Cont’d**

Declaration, **9:177**  
 Evidence, how treated, **9:23**  
 Inequitable conduct, **7:34**  
 Intent to deceive, **18:37**  
 Protested reissue, **9:23**  
 Reissue, protested, **9:23**  
 Rule 131, **7:19; 17:2**  
 Sec. 1.192(a), **9:142**  
 Sham affidavit doctrine, **17:12**  
 Skill in the art, level of, **9:23**

**AFFIRMATIVE DEFENSES**

Collateral estoppel, **4:3**  
 Double patenting, **3:4**  
 FRCP 8(c), **3:24**  
 Patent misuse, **23:9**

**AFFIRMATIVE DUTY**

Anticipation, **18:20**  
 Willful infringement, **18:29**

**AFTER-THE-FACT TESTIMONY**

Earlier writings, **14:12**

**AFTERTHOUGHT**

Secondary considerations, **9:82**

**AGENCY**

Patent and Trademark Office (PTO)  
 (this index)

**AGILENT TECHNOLOGIES, INC. V. SYNTHOGO CORP.**

2025, **1:396**

**AGREEMENT ON TRIPS**

Enforcement of patents, **22:36**

**AGREEMENTS**

Contracts and Agreements (this index)

**AI VISUALIZE, INC. V. NUANCE COMMUNICATIONS, INC.**

2024, **1:391**

**ALEXSAM, INC. V. AETNA, INC.**

2024, **1:392**

**ALGORITHM**

Mathematical Algorithm (this index)

**ALICE DECISION**

Inventive concept, **1:253; 1:277; 2:163; 2:167; 2:168; 4:104; 4:105; 5:124; 5:128; 7:118; 9:383; 9:414; 12:22;**

**ALICE DECISION—Cont’d**

**15:46; 19:292; 20:139**

**ALIENS**

State immunity from suit under Eleventh Amendment, **10:11**

**ALIVECOR, INC. V. APPLE INC.**

2025, **1:397**

**ALL ELEMENTS RULE**

Generally, **6:26; 10:7**  
 Claim interpretation, **10:7; 16:118; 16:119**  
 Claim preamble, **3:22**  
 Conflicting precedent, **10:7**  
 Doctrine of equivalents, **1:82; 5:86**  
 Law question, **10:7**

**ALLERGAN USA, INC. V. MSN LABORATORIES PRIVATE LTD.**

2024, **1:393**

**ALL EVIDENCE**

Generally, **16:36**  
 Obviousness, **1:80; 5:5; 18:15**

**ALLGENESIS BIOTHERAPEUTICS INC. V. CLOUDBREAK THERAPEUTICS, LLC**

2023, **1:383**

**ALLOWANCE OF COSTS**

Claim construction, **1:5**  
 Deposition transcripts, **19:45**  
 Transcripts, deposition transcripts, **19:45**

**“ALL THE CIRCUMSTANCES”**

Declaratory judgment, **13:155**

**ALL WRITS ACT**

Generally, **1:75**  
 Sec. 1651, **9:157**

**ALNYLAM PHARMACEUTICALS, INC. V. MODERNA, INC.**

2025, **1:398**

**ALTER EGO DOCTRINE**

FRCP 25(a), **13:25**  
 Piercing corporate veil, **13:50**

**ALTERWAN, INC. V. AMAZON.COM, INC.**

2023, **1:384**

## INDEX

### ALTVATER

JNOV motion, **6:6**  
Mootness, **13:46; 22:4**  
Vacating judgment of patent invalidity,  
**13:46**

### AMARIN PHARMA, INC. V. HIKMA PHARMACEUTICALS USA INC. 2024, **1:394**

### AMBIGUITY

See also **Certainty and Definiteness**  
(this index)  
Assignment, **5:99**  
Claim interpretation, **2:98; 4:51; 16:53;**  
**19:115**  
Contract drafter, **9:132**  
Contract interpretation, **3:44; 7:43;**  
**9:160**  
Judicial inquiry complete, **23:29**  
PTO fact findings, **9:80**  
Raises duty to inquire, **9:132**  
Sec. 156, **21:6**  
Statutory construction, **1:76; 6:24; 7:55;**  
**8:45**

### AMEND, LEAVE TO

Choice of law, **3:92**  
Defective notice, **4:25**  
FRCP 15(a), **20:5**

### AMEND, MOTION TO

Generally, **19:6**  
Denial, when appropriate, **7:33**  
FRCP 15, **3:24**

### AMENDMENT

Substitution of claims, **9:421**

### AMENDMENT, NARROWING

Claim interpretation, **8:80; 12:83;**  
**19:210**  
Prosecution history estoppel, **2:128;**  
**7:69; 18:77**

### AMENDMENT OF 1984

Sec. 103, **11:23**  
Sec. 116, **11:23**

### AMENDMENT OF CLAIMS

Burden of proof, **1:305**  
CIP, **19:28**  
Competitor's device, **13:91; 16:72**  
Consisting of claim language, **13:7**

### AMENDMENT OF CLAIMS—Cont'd

Doctrine of equivalents, **5:53; 6:64;**  
**8:65; 8:66**  
Incorporation by reference, **8:113**  
Inter partes review, **1:305**  
Motion for prejudgment interest, **10:14**  
Prosecution history, **5:44**  
Prosecution history estoppel, **2:9;**  
**2:128; 3:130; 4:73; 6:48; 8:13;**  
**20:29**  
Reexamination, **3:102; 6:8; 16:115;**  
**17:6; 20:4**  
Sec. 112, **20:6**

### AMENDMENT OF DECISION

Special master, **16:37**

### AMENDMENT OF JUDGMENT

Review, standard of, **1:102**

### AMENDMENT OF PLEADINGS

Choice of law, **1:107**  
FRCP 15(a), **20:24**  
FRCP 15(b), **2:40**  
FRCP 15(c), **6:11**

### AMENDMENTS

ANDA, infringement, **6:90**  
Doctrine of equivalents, **9:108; 9:235;**  
**12:51**  
**Eleventh Amendment** (this index)  
Incorporation by reference language,  
clarification, **8:124**  
Indefiniteness, **1:21; 8:86**  
Prosecution history estoppel, **2:66;**  
**8:47; 18:40; 19:146**  
Sec. 120, **8:19**  
**Seventh Amendment** (this index)

### AMERICA INVENTS ACT

Compulsory counterclaim, **9:430**  
Constitutionality, standing, **13:191**  
False marking, **16:134**  
Inter partes review, **19:282**  
Joinder in patent cases, **9:359**  
Partial institution, **19:282**  
Person challenging, **18:127**  
Qui tam provision, retroactive elimina-  
tion, **2:151**  
Selective institution, **19:282**

### AMERICAN RULE

Party-prepared findings not improper,  
**13:12**

**AMERICAN RULE—Cont’d**

Shifting fees, **1:62**

**AMGEN INC. V. SANDOZ INC.**

2023, **1:385**

**AMICUS CURIAE**

Intervention, motion for leave to intervene, **9:67**

Motion for leave to intervene, **9:67**

Volunteer, as, **1:41**

**AMINO ACID SEQUENCE**

Written description, **3:133; 9:264; 9:306**

**AMP PLUS, INC. V. DMF, INC**

2025, **1:399**

**“AN”**

Generally, **3:96**

Claim interpretation, **2:127; 20:90**

**ANALOGOUS ART**

Generally, **9:78; 9:114; 9:127; 19:253**

Anticipation, irrelevant, **19:154**

Anticipation, irrelevant to, **9:201**

Criteria, **23:25**

Disclosure, familiar with all that references disclose, **9:78**

Factors, **9:168**

Fact questions, **8:42; 9:121; 9:154; 10:15**

Familiar with all that references disclose, **9:78**

Field of endeavor test, **9:256**

Inventor’s reference, **19:36**

Obviousness, **9:338; 11:70; 18:23**

Ordinary skill in the art, hypothetical person of, **9:78**

Prior art, **1:329**

Reference, **9:78; 19:36**

Sec. 102(b), **19:7**

Summary judgment, **6:1; 21:7**

**ANCILLARY PROCEEDING**

Discovery from nonparty, **13:37**

**ANCILLARY TO PRIORITY**

Interference, **13:31; 16:16**

**ANCORA TECHNOLOGIES, INC. V. ROKU, INC**

2025, **1:400**

**ANDA**

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

**ANIMALS**

Interference, **3:28**

Sec. 101, **1:45**

**ANSWER**

FRCP 41(a)(1), voluntary dismissal when neither answer nor summary judgment motion filed, **5:18**

**ANTEDATING REFERENCE**

Generally, **9:163; 13:251**

Reduction to practice, **9:341**

Rule 131 affidavit, **7:19**

**ANTICIPATED PROFITS**

Lost profits, **13:131**

Reasonable royalty, **13:131**

**ANTICIPATION**

Generally, **1:101; 1:131; 1:154; 1:340; 1:341; 2:190; 3:77; 3:211; 3:212; 4:31; 5:55; 5:77; 8:71; 9:44; 9:201; 9:262; 9:280; 9:391; 9:408; 11:57; 12:13; 13:122; 14:85; 15:15; 15:51; 16:47; 16:72; 16:96; 16:145; 18:14; 19:60; 20:63; 20:72; 20:144; 21:50; 22:25**

Abuse, unfounded defenses as, **18:20**

Accidental duplication of invention, **19:107**

Addition, **1:33**

Affirmative duty of due care, **18:20**

All elements, **3:83; 19:249**

Alternatives, **2:86**

Analogous art, **9:201; 19:154**

Burden of persuasion and quantum of proof required, court must state, **18:7**

Burden of production, **20:88**

Burden of proof, **9:201**

Change of ingredient, **1:33**

Chemical compound, **10:26**

Claim, **18:20**

Claim construction, **5:142; 8:96; 8:146; 8:148; 9:285; 20:67**

Claim differentiation, **11:2**

Claim preamble, **3:22; 4:15; 13:164**

Claim-supporting vs. claim-anticipating disclosures, **22:7**

Claim terms, **8:148**

## INDEX

### ANTICIPATION—Cont'd

Clearly erroneous standard, **18:20**  
Commercial success, **1:10; 1:227**  
Conception, **1:255**  
Concepts, **16:4**  
Continuation with new matter, **1:127**  
Copying as indicium of nonobviousness, **4:15**  
Corroboration, **14:94**  
Covered business method patents, **2:168**  
Damages, **5:138**  
Defenses, unfounded defenses as abuse, **18:20**  
Design patent, **4:64; 8:62; 9:325**  
Discovery of properties, **9:257**  
Dismissal, **3:19**  
Disparagement following disclosure, **2:143**  
Doctrine of last antecedent, **6:68**  
Dominating patent, **18:20**  
Double patenting, **3:4; 21:76**  
Due care, affirmative duty of, **18:20**  
Duplication, accidental, **19:107**  
Enablement, **1:202; 2:82; 9:291; 13:120; 20:156**  
Entire market value rule, **18:35**  
Evidence, anticipation that certain thing may result in insufficient to proof, **5:19**  
Examiner's rejection, **9:427**  
Exclusion, **1:33; 1:98**  
Existence and recognized, **1:92**  
Extrinsic evidence considered, **19:51**  
Fact question, **7:34; 8:49; 9:96; 9:111; 9:154; 9:363; 13:45; 19:249; 20:11; 20:56**  
Factual determination, **20:63**  
File history estoppel, **4:15**  
Filing date, **26:12**  
Good faith, subjective, **18:20**  
Hatch-Waxman Act, **21:76**  
Hybrid sec. 102, **9:104**  
Hypothetical claim, **1:115**  
Identity of invention, **7:33; 20:20**  
Incorporation by reference, prior art, **1:238**  
Indefiniteness, **5:107**  
Inducement, **5:138**  
Inequitable conduct, **1:25; 18:20**

### ANTICIPATION—Cont'd

Inherency  
generally, **1:106; 5:61; 9:242; 20:73**  
characteristics, **3:41; 8:58; 9:220; 13:101; 18:56**  
claim limitation, **19:56**  
combination of prior art, **12:81**  
factual question, **20:56**  
inevitability, **9:360**  
prior art, recognition of, **8:148; 19:150; 19:154**  
Injunctions, **1:219**  
Interference, **3:32**  
Inter partes review, **5:139; 11:80; 11:81; 23:86**  
Ipsissimis verbis test, **1:10**  
ITC, **1:17**  
Judgment as a matter of law, determination of invalidity, **23:87**  
Jury instructions, **10:4; 19:249**  
Knowledge available to public, **23:48**  
Limitation, inherent, **19:56**  
MPEP, **16:6**  
Multiple different patents, **16:156**  
Nonobviousness, copying as indicium of, **4:15**  
Objective, **18:20**  
Obviousness, **1:255; 3:167; 3:203; 5:139; 9:442; 9:461; 10:8; 11:77; 13:204; 13:227; 20:67; 21:76**  
Oral testimony, **5:47**  
Ordinary observer test, **9:321**  
Ordinary skill in the field of the invention, recognized by, **3:103**  
Possible to alter prior device, **19:129**  
Potential claim unpatentable, **8:142**  
Presumption of validity, **19:37**  
Printed publication, **9:322; 9:327; 14:94**  
Prior art  
arranged as in claim, **14:56**  
burden of production, **20:88**  
incorporation by reference, **1:238**  
inherent anticipation does not require recognition in, **19:150; 19:154**  
means-plus-function claim, **6:68; 20:116**  
method claims, **9:48**  
single reference, must be found in, **7:48; 19:38**  
Prior device, possible to alter prior device, **19:129**

**ANTICIPATION—Cont'd**

Priority, **5:142**  
 Proper claim construction first, **20:67**  
 Public, knowledge available to, **23:48**  
 Public use, **16:167; 26:13**  
 Read in teachings not in reference, **13:85**  
 Reexamination, **9:314; 9:340; 19:225**  
 Reference, **5:66; 7:48; 7:94; 9:291; 13:85; 19:38; 19:201**  
 Relevance, analogous art irrelevant, **19:154**  
 Review, standard of, **3:54; 9:169; 18:44; 19:12**  
 Sec. 101, **1:368; 3:207**  
 Sec. 102, hybrid, **9:104**  
 Sec. 102(b), **7:99; 9:18; 9:129**  
 Sec. 102(c), **5:65**  
 Sec. 102(e), **9:28; 20:115**  
 Sec. 284, **16:167**  
 Sec. 285, **3:212**  
 Secondary considerations, **4:15**  
 Single prior art reference, must be found in, **7:48**  
 Subjective good faith, **18:20**  
 Subject matter jurisdiction, lack of, **1:7**  
 Two-step analysis, **11:43**  
 Unfounded defenses as abuse, **18:20**  
 Validity, **16:167**  
 Verbatim findings of counsel adopted, **8:22**  
 Witnesses, oral testimony, **5:47**

**ANTITRUSTS**

Generally, **9:282**  
 Choice of law, **5:30; 7:73; 9:219; 14:21; 14:25**  
 Citizen petition, **20:127**  
 Common law fraud, based on, **3:83**  
 Competitors disadvantage, changing product to, **3:83**  
 Enforcement of patent, **21:45**  
 Fraud, **3:83; 14:25; 16:48**  
 Inequitable conduct, **6:5; 14:21**  
 Jurisdiction, **3:69**  
 Jury, **1:16**  
 Licensing activities, **7:25**  
 Mandamus, **9:41**  
 Market power, **9:219; 13:133**  
 Monopoly power, **7:73**  
 Noerr immunity, **3:46; 5:108; 20:127**

**ANTITRUSTS—Cont'd**

Patent misuse, **16:126**  
 Private party, **5:30**  
 Quoting material out of context, **11:16**  
 Relevant market determination, **9:349**  
 Reverse settlement agreements, **6:86**  
 Sanctions, timing of request for, **11:16**  
 Sec. 1338(a), **21:13**  
 Settlement agreements, **9:309**  
 Standing, **9:89**  
 Timing of request for sanctions, **11:16**  
 Walker Process, **1:25; 1:42; 4:84; 11:16; 18:97**

**ANY CLAIM AMENDMENT**

Prosecution history estoppel, **6:48**

**ANY METHOD OF ANALYSIS**

Claim interpretation, **6:46**

**ANY USE OF DEVICE**

Claim interpretation, **16:120**

**APA**

**Administrative Procedure Act (APA)**  
 (this index)

**APPARATUS**

Claim interpretation, indefiniteness, **9:280; 13:220**  
 Entire market value rule, **6:36**  
 Functional language in apparatus claims, **20:110**  
 Marking, **3:146**  
 Obviousness, **4:74; 16:19**  
 Sec. 103 rejection, **9:101**

**APPEALABILITY**

Generally, **8:31**  
 Attorney disqualification, **16:3; 23:12**  
 Board decision with remand, **9:31**  
 CAFC jurisdiction, **7:8; 19:50; 22:2**  
 Cohen tripartite test, **19:71**  
 Contempt, **3:85; 5:85; 19:118**  
 Discovery, **8:9; 17:3**  
 Dismissal on merits vs. lack of subject matter jurisdiction, **1:39**  
 Finality rule, **13:23**  
 Infringement determination, **2:31**  
 Interlocutory order, **7:21; 17:3; 20:5**  
 Interlocutory partial judgment, **7:16**  
 Jurisdiction, **8:15**  
 Mandamus writ, **2:2**

## INDEX

### APPEALABILITY—Cont'd

Partial judgment, **3:9; 7:16**  
Preliminary injunction, **11:19**  
Quashing discovery, **8:9**  
Remand, board decision with, **9:31**  
Remand order, **8:97**  
Sanctions simultaneously imposed on party and its attorney, **19:64**  
Sec. 271(e)(1), **5:13**  
Sec. 1292(a)(1), **18:11; 23:13**  
Sec. 1292(c)(2), **10:12; 13:5**  
Stay order, **11:1**  
Stipulation, **10:37; 10:38**  
Willful infringement, **3:26**

### APPEAL AND REVIEW

Generally, **11:19; 16:37; 21:5**  
Abuse of discretion, **13:1**  
Administrative law, **4:38; 15:8**  
All arguments presented below, **2:87**  
APA, **8:34; 16:134**  
Assessment of costs, Sec. 145, **14:4**  
Attorneys, **6:12; 14:55; 16:29; 19:16**  
Attorneys' fees, **4:16; 18:19; 19:8**  
Board, **4:39; 7:23; 9:191; 9:195**  
Burden, **12:11**  
CAFC jurisdiction, **7:14**  
Certification of order, **20:28**  
Claim interpretation, **19:16**  
Clearly erroneous standard, **12:2**  
Clear or manifest error, **4:6**  
Collateral order doctrine, **9:343**  
Commission, not raised before, **6:40**  
Confidential information, unsealing, **1:239**  
Considerations involved, **19:49**  
Consolidation of claims, **19:95**  
**Cross-Appeal** (this index)  
Damages, **1:20**  
Dann Amendment, **19:30**  
Date of decision, **13:162**  
Decision by implication, **5:41**  
Declaratory judgment, **9:233**  
Defined on theory never presented, **4:67**  
Definitions, **10:19**  
De novo, **9:7; 11:32**  
Dependent claims not separately argued, **9:100**  
Deposition testimony introduced on appeal, **13:183**  
Design patent, **19:8; 21:4**

### APPEAL AND REVIEW—Cont'd

Discretionary authority, Board's exercise of, **7:23**  
Dismissal, **9:47**  
District Court, **6:9; 9:1; 12:36; 16:19**  
Enhanced damages, **9:125**  
Equitable tolling, **7:32**  
Escrow, **3:21**  
Examination, **9:2**  
Examiner's rejection, **9:64**  
Exhaustion, **2:143**  
Expanding scope of, **4:25**  
Ex parte test, **3:10**  
Explained, **12:43**  
Favorable judgment, **8:82**  
Filing, **10:3; 23:28**  
Final decision, **8:82**  
FRAP 2, **10:20**  
FRAP 4(a)(2), **16:110**  
FRAP 4(a)(4), **10:14**  
FRAP 30(b), **6:10**  
FRAP 39(c), **3:29**  
FRCP 26, **8:9**  
FRCP 52(a), **3:45; 12:6; 16:25**  
FRCP 60(b) motion, **3:5**  
**Frivolous Appeal** (this index)  
Immediate appeal, 28 USC Sec. 1291, **11:10**  
Implication, decision by, **5:41**  
Inequitable conduct, **23:47**  
Infringement, award to prevailing infringer, **18:19**  
Interference, **4:11; 5:68; 7:26; 7:74; 12:99; 13:119**  
Interlocutory appeal, **9:6; 13:61; 14:9**  
ITC, **1:15; 1:129; 1:254; 2:117; 6:2; 7:104; 7:105; 19:25**  
**Judgment Notwithstanding Verdict (JNOV)** (this index)  
Jurisdiction. **Appellate Jurisdiction** (this index)  
Jury, **5:41; 19:60**  
Jury verdict, generally, **4:18**  
License, **21:5**  
Limitations and restrictions, **2:9; 7:2; 7:58; 9:59**  
Mandamus, **9:41; 9:63**  
Mandate, **12:47**  
Manifest or clear error, **4:6**  
Meaningful appellate scrutiny, **15:40**

**APPEAL AND REVIEW—Cont'd**

Means-plus-function claim, **22:26**  
**Mootness** (this index)  
 Motion, **9:38; 23:10**  
 New ground of rejection, **9:22**  
 9 cir, **19:51**  
 Notice, **4:25; 9:169; 10:14; 10:18**  
 Obviousness, **9:15; 9:52; 9:56; 15:40**  
 Opinions or findings, **19:42**  
 Overturn on appeal, **23:33**  
 Patent and Trademark Office (PTO),  
**9:2; 13:162**  
 Pendency of appeal, **19:25**  
 Post-trial motions, **18:3**  
 Prejudgment interest, no award of, **8:20**  
 Preliminary injunction, **2:16; 7:81; 8:2**  
 Preservation of issue, **3:54**  
 Prima facie case, **9:37**  
 Privilege, **9:184**  
 Prosecution history estoppel, **2:9**  
 Raising argument or issue  
   generally, **7:58; 8:44; 13:85; 16:32**  
   first time, **2:34**  
   not before trial court not considered  
     on appeal, **16:35**  
   not presented below, **2:33**  
   not raised below, **8:44; 13:85**  
 Reconsideration, request for, **20:21**  
 Reexamination, **9:206**  
 Rejection, examiner's, **9:64**  
 Relationship between, **11:13**  
 Removal, Sec. 1447(d), **22:46**  
 Reply brief, first mentioned in, **23:23**  
 Reprehensible conduct, **9:159**  
 Reviewed without deference, **21:42;**  
**21:44**  
 Scope, no restriction on  
   Sec. 141 proceedings, **9:59**  
   Sec. 142 proceedings, **9:59**  
   Sec. 143 proceedings, **9:59**  
   Sec. 144 proceedings, **9:59**  
   Sec. 145 proceedings, **9:59**  
 Scope of judgment appealed from, **5:43**  
 Sec. 102(b), de novo review from PTO,  
**9:7**  
 Sec. 112, **9:40**  
 Sec. 141, **22:44**  
 Sec. 145, **6:9; 14:4**  
 Sec. 146, interference, **7:26**  
 Sec. 271(e)(1), **5:3**

**APPEAL AND REVIEW—Cont'd**

Sec. 285, award of attorney fees, **4:16**  
 Sec. 337, appellate function, **3:23**  
 Sec. 1292(b), **9:97; 14:9**  
 Sec. 1292(c)(2), interlocutory appeal,  
**9:6; 13:61**  
 Sec. 1447(d), removal, **22:46**  
 Secondary considerations, **9:82**  
 Separate argument, **9:173**  
 Special interrogatories, **8:84**  
 Special master's decision, **13:24**  
 Standard of review  
   generally, **7:2; 9:165**  
   administrative agency, **3:50**  
   administrative board action, **22:9**  
   administrative board's decision, **13:49**  
   amend the judgment, **1:102**  
   anticipation, **3:54; 9:169; 18:44;**  
     **19:12**  
   arbitration, **4:33; 6:45**  
   attorney fees award, **9:161**  
   bankruptcy court decisions, **9:213**  
   best mode, **26:4**  
   board, **9:166; 9:208; 9:217**  
   claim construction and interpretation,  
     **3:74; 12:35; 12:103; 19:12;**  
     **19:121; 20:64; 20:130**  
   claims court, **6:29; 19:67**  
   commission factual findings, **15:18**  
   conclusion of obviousness, **9:26**  
   construction of count, **7:74**  
   contempt, **3:56**  
   contract interpretation, **8:41**  
   contracts, **1:76**  
   damages, **18:35; 19:96; 20:39; 21:23**  
   declaratory judgment, **19:86**  
   directed verdict, **1:46; 1:71**  
   disclosure dedication, **20:74**  
   discovery matters, **11:7**  
   discretion of court, **7:72**  
   dismissal, **2:44; 12:44**  
   disputed material facts, **19:120**  
   district court, **7:33; 7:72**  
   enablement, **2:79**  
   evidentiary rulings, **13:71**  
   experimental use, **13:109**  
   fact finding, **4:41; 9:217**  
   factual determination, PTO, **4:56**  
   factual findings, commission, **15:18**  
   finding, **7:27; 7:33; 9:217**

## INDEX

### APPEAL AND REVIEW—Cont'd

#### Standard of review—Cont'd

FRAP 38, **16:29**  
FRCP 11, **1:42; 8:75; 16:76; 19:87**  
FRCP 52(a), **3:39**  
indefiniteness, **1:119; 12:61**  
inequitable conduct, **2:59; 3:72; 6:50; 9:35; 10:31; 11:11; 13:84; 14:19; 18:37; 18:40; 20:39**  
infringement, **3:43; 5:36; 9:254; 16:11**  
injunction, **3:56; 15:6**  
instructions, **5:30; 8:47; 21:27**  
interference, **5:46**  
inter partes review, **9:418; 13:213; 19:286**  
inventorship, **5:40**  
ITC, **2:117; 7:52; 8:28; 8:86; 19:25**  
JMOL, **2:91; 3:96; 5:30; 6:46; 12:61; 13:85; 13:101; 14:21; 14:25; 18:62**  
JNOV, **4:2; 6:36; 9:186; 12:31; 13:34; 19:12; 19:60; 22:2**  
judgment as a matter of law (JMOL), **5:21; 12:45; 13:75; 20:41**  
jury findings, **7:27**  
jury instructions, **1:136; 4:32; 5:52; 10:4; 20:64**  
jury trial, **2:34; 7:28; 23:25**  
jury verdict, **2:49; 6:26; 8:51; 21:27**  
laches, **5:30; 5:53; 8:50**  
Lanham Act, **9:249**  
license agreement, **19:104**  
limitation of actions, **12:46**  
litigation misconduct, **1:112**  
long-felt need, **19:12**  
mandamus, **9:128**  
material fact, disputed, **19:120**  
means-plus-function claim, **14:38**  
merit system board, **8:48**  
motion, JNOV, **9:186**  
new trials, **2:99; 5:54; 13:85; 14:25; 16:87**  
obviousness, **2:59; 9:26; 9:168; 9:174; 9:195; 9:202; 9:418; 16:19; 22:13**  
on-sale bar, **1:119; 22:20**  
oral testimony of anticipatory devices, **19:12**  
personal jurisdiction, **6:50**

### APPEAL AND REVIEW—Cont'd

#### Standard of review—Cont'd

preliminary injunction, **7:70; 8:46; 13:89; 20:61**  
PTO, **4:56; 4:69; 9:43; 9:165; 9:196**  
punitive damages, **18:58**  
reduction to practice, **19:90**  
regulations, **19:137**  
remitter, **15:10**  
sanctions, **9:161**  
Sec. 112(2), **9:240**  
Sec. 145, **13:115**  
Sec. 146, **23:52**  
Sec. 282, **18:6**  
Sec. 314(d), **9:418**  
secondary considerations, **9:207; 19:12**  
special verdicts, **20:35**  
specification, use of, **19:12**  
state claim, failure to, **4:29**  
statutory construction, **2:54; 3:58; 6:44; 9:162; 9:176; 16:30; 19:88**  
statutory interpretation, **13:59**  
substantial evidence, **16:31**  
summary judgment, **1:67; 1:82; 1:87; 2:44; 2:52; 2:63; 4:29; 7:7; 7:35; 9:162; 15:12; 17:5; 18:33; 19:84; 22:7; 23:36; 23:43**  
willful infringement, **19:96**  
willfulness, **5:54**  
witnesses, **19:12**  
Standard of review on appeal  
interference, **13:119**  
preliminary injunction, **2:62; 7:50; 8:71; 12:16; 16:46; 20:53; 22:16**  
Standing, **7:39; 19:48; 20:75**  
Stay of injunction pending appeal, **5:2**  
Subject matter jurisdiction, **1:37; 6:19**  
Subordinate, **9:2**  
Summary judgment, **8:17; 21:29**  
Supporting evidence, citing only, **13:45**  
Theory not raised below, **8:44**  
37 CFR Sec. 1.191, **9:2**  
Timeliness, **10:3; 11:38; 13:162**  
Tolling, equitable, **7:32**  
Transfers  
generally, **16:45**  
action, distinction between claim, **7:14**

**APPEAL AND REVIEW—Cont'd**

## Transfers—Cont'd

addition of bona fide patent claim,  
**7:14**

bona fide patent claim, addition of,  
**7:14**

CAFC jurisdiction, **7:14**

claim, distinction between action,  
**7:14**

jurisdiction, CAFC jurisdiction, **7:14**

well-pleaded complaint rule, **1:160;**  
**7:14**

Trial de novo, not, **6:12**

Trial of issues not presented to jury, **5:41**

28 USC § 1291, immediate appeal,  
**11:10**

## Validity

generally, **7:61; 8:49; 18:39**

review of jury verdict, standard of,  
**8:62**

review of jury verdict thereon, stan-  
dard of, **21:26**

Verdict, generally, **4:18; 16:14**

**APPEAL BRIEF**

File, failure to, **7:23**

Improper, **12:22**

Substitute for notice, **10:14**

Summary judgment, **2:29**

Supporting argument in, failure to  
provide any, **4:36**

**APPELLATE COURT**

Appendix documents not of record,  
improper to include in, **2:3**

Inequitable conduct, **6:4**

Infringement, **2:95**

Law of the case doctrine, **20:34**

**APPELLATE JURISDICTION**

Attorney fees award, **3:11**

Determination of, **8:1**

District Court, **1:31; 12:36**

Diversity of citizenship, not solely, **3:11**

Finality of judgment, **9:300**

FRCP 21, **1:31**

FRCP 42(b), **1:31**

Frivolous appeal, **3:11**

Infringement, threatened, **3:11**

Judgment as appealable, **8:15**

Pendent, **5:85**

**APPELLATE JURISDICTION**

## —Cont'd

Post-trial injunction pending appeal,  
denial of stay of, **19:9**

Preliminary injunction, **3:12**

Review of Board decision by expanded  
panel, **9:147**

Rumors, **3:11**

Sec. 1292, **1:31; 16:116**

Separately tried claims, **1:31**

Threatened infringement, **3:11**

Timeliness of appeal, **2:5; 13:8**

Transfer of appeal, **3:152; 21:12**

**APPENDIX DOCUMENTS**

Appellate court may consider only the  
record as it was made before the  
district court, **2:3**

**APPLE INC. V. COREPHOTONICS,  
LTD.**

2023, **1:386**

**APPLE INC. V. GESTURE  
TECHNOLOGY PARTNERS, LLC**

2025, **1:401; 1:402**

**APPLE INC. V. VIDAL**

2023, **1:387**

**APPLICATION**

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

Assignor estoppel doctrine, **17:4**

Claim interpretation, applicants' inac-  
curate statement, **19:155**

Confidence, high degree of confidence  
and trust between PTO and patent  
applicants, **10:5**

**Continuation Application** (this index)

**Continuation-in-Part Application** (this  
index)

Design patent issued as division of  
earlier utility application may be  
entitled to latter's priority date,  
**18:1**

Double patenting, **1:115**

Earlier filing date, **13:53; 26:12**

Estoppel, **23:30**

Obviousness, **9:29; 9:152**

Original application, meaning of term,  
**3:139**

Prima facie case, **9:150**

Prima facie obviousness, **2:25; 9:152**

## INDEX

### **APPLICATION—Cont'd**

Priority analysis, **9:340**  
Provisional, **5:88**  
Reissuance, 37 CFR Sec. 1.175(a)(4),  
**9:25**  
Res judicata, **11:35**  
Retroactive application of judicial deci-  
sion, **23:33**  
Sec. 119, **9:143**  
Sec. 120, **8:19; 12:10**  
Specification, **9:189**  
Statutory construction, **15:7**  
Substitute, must be obvious to, **9:29**  
37 CFR Sec. 1.175(a)(4), **9:25**  
Unrelated applications, **13:108**

### **APPOINTMENT**

Administrative patent judges, **9:311**  
Clause, **9:509**

### **APPORTIONMENT**

Damages, **1:376; 13:224; 15:61**  
Delay, **23:27**  
Infringement, **13:224**  
Reasonable royalty, **14:5**

### **APPRECIATION**

Affidavit describing work of third party  
at reasonably contemporaneous  
time, **9:23**  
Conception, **13:105**

### **APPREHENSION, REASONABLE**

Generally, **6:35**

### **ARBITRATION**

Generally, **13:127; 18:131**  
Agreement to arbitrate, **4:85; 16:136;**  
**22:55; 23:91**  
Anti-suit injunction, **19:239**  
CAFC, **18:3**  
Choice of law, **9:278**  
District court order compelling arbitra-  
tion, **16:136; 22:55**  
International Trade Commission, **9:380**  
9 USC § 3, **18:13**  
Review, standard of, **4:33; 6:45**

### **ARBUTUS BIOPHARMA CORPORATION V. MODERNATX, INC.**

2023, **1:388**

### **ARITHMETICAL ERROR**

Generally, **13:45**

### **ARO**

Contributory infringement without  
direct infringement, none, **13:29**  
Repair doctrine, **19:56**

### **ARRANGED AS IN CLAIM**

Printed publication, **14:56**

### **ART CLASS**

Interference, **4:21**

### **ARTICLE III**

Judicial error, **19:55**

### **ARTICULATED REASON FOR DECISION**

Agency, **12:64**

### **AS A WHOLE**

Generally, **19:34**  
Chemical, **9:60**  
Claim preamble, **16:58**  
Combination patent, **13:15**  
Double patenting, **5:111**  
Focus on one facet, **18:28**  
FRCP 52(a), **12:6**  
Infringement, **3:100**  
Jury instructions, **10:15**  
New prior art not considered by PTO,  
**5:11**  
Obviousness, **2:8; 2:171; 5:111; 7:17;**  
**9:46; 9:86; 9:179**  
Prima facie obviousness, **9:86**  
Printed matter and substrate, no specific  
type of functional relationship  
needed between, **9:32**  
Prior art references, **9:59**  
Sec. 102(g), **11:9**  
Special master's decision, **13:24**  
Statutory construction, **3:63**  
Summary judgment, **12:15**

### **ASSERTION OF ONLY CERTAIN CLAIMS**

Entire patent not in issue, **3:46**

### **ASSESSMENT OF COSTS ON APPEAL**

Sec. 145, **14:4**

### **ASSIGNMENT**

Generally, **19:324**

**ASSIGNMENT—Cont'd**

Ambiguity, **5:99**  
 Bayh-Dole Act, **2:135**  
 Exclusive ownership, **20:134**  
 License, **13:79; 13:87; 19:154**  
 On-sale, **13:87**  
 Patent claims, **12:84**  
 Patentee status, **4:115**  
 Patent rights, generally, **4:86; 13:28**  
 PTO, failure to record assignment, **1:60**  
 Reassignment, **5:82**  
 Requirements, **7:39; 13:79**  
 Standing, **1:191; 1:196; 1:218; 1:264; 5:38; 13:87**

**ASSIGNOR ESTOPPEL**

Generally, **3:117; 8:158; 8:163; 13:223; 16:89; 17:4**  
 Application, **17:4**  
 Challenges to validity of contract, **21:38**  
 Contradictory, **19:47**  
 Damages, reservation of, **19:47**  
 Defenses, equitable, **19:47; 19:241**  
 Equitable defenses, **19:47**  
 Equities weighed, **3:46**  
 Infringement, inefficient, **19:47**  
 Judgment, **19:47**  
 Less advantageous, **19:47**  
 License back, **1:43**  
 Privity, **9:118; 13:88; 19:47**  
 Public policy, **4:13**  
 Remand, **6:96**  
 Removal, **6:96**  
 Reservation of damages, **19:47**  
 Sec. 1447(d), **6:96**  
 Statements in declaration, **19:47**  
 Summary infringement, **13:207**  
 Validity of contract, challenges to, **21:38**

**ASSUMPTIONS**

Jurisdiction, **4:44**  
 Sec. 1400(b), control of litigation, **9:11**

**ASTELLAS PHARMA, INC. V. SANDOZ INC.**

2024, **1:395**

**“AT LEAST ONE”**

Generally, **18:50**

**“AT LEAST TWO”**

Plurality, **18:67**

**ATTORNEY-CLIENT PRIVILEGE**

Generally, **6:57; 7:52**  
 Choice of law, **1:19; 9:184**  
 Crime fraud exception, **21:58**  
 Interview of third-party inventor, **19:60**  
 ITC, **23:55**  
 Mandamus writ, **9:184; 9:293**  
 Order to produce communications, **23:74**  
 Record of invention, **9:221**  
 Third party interview, **19:60**

**ATTORNEY FEES**

Generally, **1:349; 18:132; 19:336.50**  
 Bad faith, **18:121**  
 Exceptional cases, **1:342**

**ATTORNEYS**

Appealability, **16:3; 19:64; 23:12**  
 Appeal and review, **6:12; 14:55; 16:29; 19:16**  
**Attorney-Client Privilege** (this index)  
**Attorneys' Fees** (this index)  
**Awards, Attorneys' Fees** (this index)  
 Claim interpretation, **9:94**  
 Client bound by acts or omissions of, **4:36**  
 Criticism by court, **14:55**  
 Disclosure, duty of, **9:43**  
 Disqualification  
     generally, **4:124; 11:6**  
     appealability, **9:343; 16:3; 23:12**  
     attorney, **11:6**  
     canons, **20:3**  
     confidences, sharing client's, **16:3**  
     defined, procedure, **16:3**  
     law firm, **5:12**  
     merged firms, **16:18**  
     presumption, **16:3**  
     procedural, **1:32**  
     procedure defined, **16:3**  
     rebuttal, **16:3**  
     screening, effectiveness of, **16:3**  
     settlement agreement, **19:40**  
 Drafting claims specifically directed to competitor's device, **9:158**  
 Evidence, **7:33; 19:6; 19:209**  
 FCR 7(a), **18:15**  
 Flagrant misrepresentations of record, **16:9**  
 FRCP 11, **18:95**

## INDEX

### ATTORNEYS—Cont'd

FRCP 37, **16:71; 21:69**  
Inequitable conduct, **15:3**  
Infringement, neither intent nor preparation constitutes, **12:22**  
ITC, **13:40**  
JNOV, **23:4**  
Mandamus, **9:57**  
Merged firms, **16:18**  
Misconduct, **8:35; 11:13**  
Obviousness, **3:104; 16:19**  
Opinion of counsel  
    generally, **19:101**  
    accounting phase, **11:15**  
    appeal is review and not trial de novo, **6:12**  
    competency, **4:6; 13:45**  
    competency requirement, **3:80; 10:21**  
    damages, **1:20**  
    inference that adverse, failure to introduce supports, **5:30**  
    issue preclusion, **4:9**  
    marketing, prior to, **3:72**  
    no adverse effect, **11:56**  
    prior to marketing, **3:72**  
    willful infringement, **1:62; 8:50; 9:125; 10:15; 12:32**  
    willfulness, **21:18**  
Personal jurisdiction, attorney-client relationship, **18:90**  
Preliminary injunction, denial of, **12:16**  
Qualifications. Disqualification, above Reissue, **9:84**  
Role of counsel, generally, **19:6**  
Root, **12:24; 16:4**  
Sanctioning counsel  
    Rule 11, **8:122**  
    Sec. 1292(c)(2), **9:6**  
    Sec. 10.57(b), **13:69**  
    Sec. 32, **23:15**  
    Sec. 1292(c)(2), **9:6**  
Settlement agreement, **19:40**  
Verbatim findings of counsel adopted, **8:22**  
Willful infringement  
    generally, **14:5; 19:92; 19:154; 23:26**  
    advice of counsel, **14:5; 19:154**  
    opinion of counsel, **1:62; 8:50; 9:125; 10:15; 12:32; 19:92; 23:26**

### ATTORNEYS' FEES

Generally, **1:364; 2:61; 7:81; 19:8; 23:56**  
Abuse of discretion explained, **16:24**  
ANDA, **25:7**  
Appellate jurisdiction, **3:11**  
Clearly erroneous standard, **19:23**  
Collateral estoppel, **4:3**  
Conflict of laws, **17:7; 19:163**  
Cost-plus-overhead vs. private firm market rate for in-house counsel fee award, **16:24**  
De novo review, **3:171**  
Design patent, **19:8; 21:4**  
Divided infringement, refusal to deem unreasonable, **13:208**  
Enforcement order, **4:20**  
Enhanced damages, **1:43**  
Exceptional case, **1:62; 1:299; 2:85; 4:83; 5:109; 5:143; 9:316; 9:328; 9:377; 9:455; 9:483; 11:16; 12:24; 12:32; 12:110; 13:175; 13:197; 14:58; 18:9; 19:92; 19:249; 20:87; 20:115; 20:122; 23:65**  
Experience, reliance upon, **19:65**  
Expert witness fees, **15:48**  
Findings, for remand when no express findings, **3:46**  
Fixed sum, **19:57**  
Frivolous appeal, **16:20; 18:11; 20:16**  
Inequitable conduct, **1:193; 8:18; 10:2; 13:19; 18:43; 20:97**  
Infringement, **18:19**  
In-house counsel, **16:24**  
Joint liability of inventor, **8:18**  
Jury trial, **1:300**  
Litigation misconduct, **13:167; 13:197; 19:100; 20:87**  
Local rules, **1:260**  
Mandamus, **9:68**  
Market rate, **16:24**  
Mootness, **19:200**  
Non-patent issues, **7:54**  
Other circumstances may support, **19:26**  
Party-prepared findings not improper, **13:12**  
Prevailing party, **3:35; 13:73**  
Prior experience, **19:65**  
Private firm, **16:24**  
Privity, **11:14**  
Prosecution aggressiveness, **13:116**

**ATTORNEYS' FEES—Cont'd**

Public service, **10:2**  
 Rate calculation, **22:22**  
 Reissue proceedings, **16:24; 18:82**  
 Reliance upon his prior experience,  
**19:65**  
 Remand, **3:46**  
 Restitution of award improperly granted,  
**19:58**  
 Review, standard of, **9:161**  
 Routine assessment, **18:12**  
 Sanctions, **12:36; 19:42**  
 Sec. 85, **9:159**  
 Sec. 145, **14:80**  
 Sec. 285, **1:300; 2:170; 3:42; 3:196;**  
**4:16; 4:32; 5:109; 5:137; 7:20;**  
**7:27; 8:18; 8:38; 8:130; 9:328;**  
**9:455; 12:4; 13:38; 13:175; 16:5;**  
**18:121; 18:123; 19:3; 19:33;**  
**19:35; 19:51; 19:58; 19:313; 23:6**  
 Sec. 1117(a), **18:121**  
 Sec. 2412(b), **13:48**  
 Settlement negotiations, failure to  
 engage in, **15:37**  
 Success in sustaining validity of valid  
 patent is public service, **10:2**  
 Summary judgment, **1:2; 2:71**  
 Two-prong inquiry, **13:85**  
 Two-step analysis required, **7:37**  
 Two-step process, **6:53**  
 Validity of valid patent is public service,  
**10:2**  
 Willfulness finding not upheld, **19:103**

**ATTRIBUTION**

Infringement, **20:141**

**AVAILABLE TO THE PUBLIC**

Printed publication, **9:386**

**AXIOMATIC**

Case or controversy requirement, **1:113**

**AXONICS, INC. V. MEDTRONIC,  
 INC.**

2023, **1:389; 1:390**

**AZURITY PHARMACEUTICALS,  
 INC. V. ALKEM LABORATORIES  
 LTD.**

2025, **1:403**

**BACKERTOP LICENSING LLC V.  
 CANARY CONNECT, INC.**

2024, **2:206**

**BAD AXIOM**

Sec. 102(g), **11:9**

**BAD FAITH**

Attorney fees, **13:167; 18:121; 20:115**

Damages, **20:19**

Exceptional case, **9:328; 13:69**

Litigation misconduct, **18:29**

Objectively baseless, **4:88; 7:92**

Settlement, **12:39**

Willful infringement, **10:21**

**BANKRUPTCY**

Choice of law, **9:213**

11 USC § 1141, **2:21**

Infringement, **8:94**

Jurisdiction, **9:213**

Review, standard of, **9:213**

Standing analysis, **13:148**

Summary judgment, **2:21**

**BATCH PROCESS**

Inequitable conduct, **10:2**

**BAXALTA INCORPORATED V.  
 GENENTECH, INC.**

2023, **2:203**

**BAYH-DOLE ACT**

Generally, **3:108**

Assignment, **2:135**

**BEARBOX LLC V. LANCIUM LLC**

2025, **2:210**

**BED OF ITS OWN MAKING**

FRCP 15(c), **6:11**

**BEST MODE**

Generally, **1:80; 1:161; 2:70; 3:109;**  
**9:125**

Claimed invention, **20:63**

Commercial mode, **26:4**

Concealment, **2:34; 19:231**

Defined by scope of claimed invention,  
**14:30**

Deposit, **1:44; 19:51**

Design patent, **18:1**

Disclosure, **7:37; 7:47; 9:357; 23:72**

Enablement, **2:90; 3:31; 9:177**

Fact-law question, mixed, **3:31**

## INDEX

### **BEST MODE—Cont'd**

Fact question, **14:8; 20:35**  
Interference, **4:8; 13:3**  
JNOV motion, denial of, **13:13**  
Knowledge, only disclose what aware of, **7:47**  
Law-fact question, mixed, **3:31**  
Mixed law-fact question, **3:31**  
Only disclose what aware of, **7:47**  
Possessed best mode, **5:55**  
Review, standard of, **26:4**  
Sec. 112, **1:161; 1:194; 2:14; 4:2; 5:16; 19:21; 19:60**  
Sec. 112(1), **7:34; 20:33; 23:19**  
Sec. 120, **8:19**  
Specification, **9:357**  
State of mind of inventor not sole focus, **3:31**  
Time of belief, **1:246**  
Trade name alone, **18:5**  
Two component analysis, **1:91; 7:41; 13:79; 21:25**  
Two factual inquiries, **5:49; 6:36; 14:21; 18:42; 23:41; 25:4**  
Unclaimed subject matter, **13:101**  
Unintentional omission, **8:87**  
Verbatim findings of counsel adopted, **8:22**

### **BETEIRO, LLC V. DRAFTKINGS INC.**

2024, **2:207**

### **BEYOND EXPRESS TERMS**

Consent judgment, **14:28Z**

### **BIAS**

Generally, **16:29**  
See also **Prejudice** (this index)

### **BIFURCATION**

Sec. 287, **4:12**  
Trial, **19:195**  
Willfulness, **17:3**

### **BIOGENIC**

DNA technology, **1:44**

### **BIOLOGICAL ACTIVITY**

Chemical, **9:60**

### **BIOLOGICAL DEPOSITS**

Description, **5:69**

### **BIOLOGICAL PROCESSES**

Enablement, **5:66**

### **BIOLOGICS PRICE COMPETITION AND INNOVATION ACT (BPCIA)**

Generally, **1:273**  
Doctrine of equivalents, **1:337**  
Infringement, **1:337**  
Preemption, **1:303; 19:294**

### **BIOSIMILAR PRODUCTS**

Preliminary injunction, **1:291**

### **BLEAK HOUSE**

Dickens, **19:83**

### **BLOCK DIAGRAM**

Combination patent, **13:15**

### **BLOCKING PATENT**

Obviousness, **1:314**

### **BLONDER-TONGUE**

Generally, **1:13**  
Actual device sold, **1:13**  
Collateral estoppel, **1:47; 13:26; 13:61; 19:33**  
Delay in disclaiming, **1:13**  
Earlier adjudication, not augmented by, **1:13**  
FRCP 52(a), **1:13**  
Inequitable conduct, **1:13**  
Infringement proof, **1:13**  
Law question, **1:13**  
Lear, **20:9**  
Obviousness, **1:13**  
Presumption of validity, **1:13**  
Repair parts, **1:13**  
Royalty, **1:13**  
Subjective good faith, **1:13**

### **BLUE GENTIAN, LLC V. TRISTAR PRODUCTS, INC.**

2023, **2:204**

### **BLUEPRINT**

Obviousness, **9:90**

### **BOARD**

Appealable, **9:31**  
Appropriate, when, **11:26**  
Clearly erroneous standard review of facts, **9:191**  
EIC, **7:23**  
Explanation, sufficient, **9:218**

**BOARD—Cont'd**

Fact findings, **9:195**  
 Filings, late, **18:56**  
 Findings, review for, **9:195**  
 Grounds relied upon, **1:348**  
 Interference, dissolution of, **16:7**  
 Invention ownership vs. inventorship, **2:36**  
 Late filings, **18:56**  
 Merit Systems Protection Board standard of review thereof, **4:39**  
 Review, standard of, **2:126; 9:166; 9:208; 9:217**  
 Sec. 135(a), **9:116**  
 Sufficient explanation required, **9:218**  
 37 CFR Sec. 1.191, **9:2**

**BOARD OF PATENT APPEALS**

Scope of review, **9:265**

**BOARD OF PATENT APPEALS AND INTERFERENCES**

Jurisdiction, **2:150**

**BONA FIDE PATENT CLAIM**

Transfer of appeal, **7:14**

**BONA FIDE PURCHASER**

Generally, **1:46; 8:63**  
 Choice of law, **18:61**  
 License agreement, **18:61**

**BORN VALID**

Sec. 282, **6:10**

**BOT M8 LLC V. SONY**

**INTERACTIVE ENTERTAINMENT LLC**

2023, **2:205**

**BRIEFS**

**Appeal Briefs** (this index)  
 Commissioner's brief not prior art, **9:140**  
 Confidentiality markings, **9:337**  
 Filing, **7:23**  
 First time develop fraud allegation, **12:3**  
 Sec. 143, **9:116**  
 Waiver by not raising issue, **23:25**

**BRIGHT-LINE TEST**

Fitness for intended use, **6:23**  
 Intent, **6:23**  
 On-sale bar, **3:83**

**BRIGHT-LINE TEST—Cont'd**

Owner's right to preserve patented machine's fitness for its intended use, **6:23**  
 Repair vs. reconstruction, **2:75**

**BROADBAND ITV, INC. V. AMAZON.COM, INC.**

2024, **2:208**

**BROAD DISCRETION**

Injunctive relief, **10:23**

**BROADEN BEYOND CORRECT SCOPE**

Claim differentiation, **13:91; 20:51**

**BROADENED CLAIMS**

Reissue, **9:192; 17:6**

**BROADENING REISSUE**

Filing, timely filed, **9:3**  
 Objective intent to claim is not criterion, **9:109**  
 Prosecution history, **9:368**  
 Sec. 251, **1:52**  
 Summary judgment, **20:10**  
 Timely filed, **9:3**

**BROADENING SCOPE**

Injunction, **19:48**

**BROADEN TERM**

Reexamination, **1:90**

**BROADEST REASONABLE INTERPRETATION**

Claim construction, **3:201; 9:350**  
 Claim interpretation, **9:149; 9:256**  
 Claim not read in vacuum, **9:58**  
 Claims construed, **9:77**  
 Examiner's rejection, **9:427**  
 Interference, **9:88; 23:14**  
 Interference counts, **18:56**  
 Inter partes review, **3:201; 4:112; 9:400; 9:448; 22:56**  
 Obviousness, **3:201**  
 Reexamination, **9:8; 9:154; 9:255**

**BROAD STATUTORY LANGUAGE**

Statutory construction, **20:31**

**BRUMFIELD, TRUSTEE FOR ASCENT TRUST V. IBG LLC**

2024, **2:209**

## INDEX

### BURDEN

Appeal, **12:11**  
Challenger, **16:12; 18:4**  
Coming forward, **10:18**  
Establish, PTO's burden to establish, **9:140**  
Heavy burden  
    challenging validity, **1:9**  
    FRCP 26, **8:9**  
    obviousness question, **16:19**  
    reasonable royalty, **8:51**  
    validity, **23:48**  
Interference, **15:1; 19:70**  
Mandamus writ, **9:193**  
Obviousness, **1:30**  
Prima facie obviousness, **9:153**  
Prior art, noting differences from, **4:6**  
Rebut, **9:152**  
Show, **2:96; 22:18**  
Summary judgment, **13:90; 18:47**  
Willful infringement, **16:22**

### BURDEN OF PERSUASION AND QUANTUM OF PROOF

Generally, **12:74; 18:7**  
Anticipation, **18:7**  
Burden of proof, **19:68**  
Claim element, **18:7**  
Court must state, **18:7**  
Dependent, independent vs. dependent claims, **18:7**  
Independent vs. dependent claims, **18:7**  
Means-plus-function, **18:7**  
Obviousness, **9:357; 18:7**  
Validity, **15:15**

### BURDEN OF PRODUCTION

Anticipatory prior art, **20:88**  
Reduction to practice, **12:63**

### BURDEN OF PROOF

Generally, **9:282**  
See also **Presumptions** (this index)  
Amendment of claims, **1:305**  
Anticipation, **9:201**  
Burden of persuasion, **19:68**  
Circumstantial evidence, carried by, **4:33**  
Copying claims from patent, **2:26**  
Declaratory judgment, **13:179; 13:194**  
Defenses, **9:118; 19:48**

### BURDEN OF PROOF—Cont'd

Disclosure, **13:10**  
Evidence required, **5:83**  
Exceptional case, **15:45**  
Indefiniteness, **1:21**  
Inequitable conduct, **19:92**  
Infringement, **1:123; 7:31; 13:179; 13:194**  
Interference, **2:47; 2:107; 4:8; 5:52; 13:31; 16:36**  
Invalidity, **2:92**  
ITC, **19:25**  
Jury, **1:16**  
Laches, **23:46**  
License defense, **3:56; 9:118**  
New prior art, **5:11**  
Obviousness, **14:71**  
On-sale bar, **9:171; 12:98**  
Preliminary injunction, **3:76; 5:92; 14:20; 19:235**  
Printed publication, **13:72**  
Prior art, **5:11**  
Reverse doctrine of equivalents, **19:24**  
Sec. 282, **9:80**  
Summary judgment, **1:35; 10:4**  
Validity, **14:21; 20:35; 20:39; 21:25**

### BURYING REFERENCE

Relevancy of foreign patent prosecution, **13:69**

### BUSINESS DAMAGE

Mandamus, **9:76**

### BUSINESS DAY

Timely appeal, failure to file, **23:28**

### BUSINESS METHODS EXCEPTION

Estoppel, **3:202**  
Statutory subject matter, **9:308; 19:112; 19:297**

### BUSINESS RECORDS EXCEPTION

Evidence, **3:67; 13:71**

### BUSINESS SYSTEMS

Sec. 101, **1:293; 9:286**

### BUSY COURT

FRCP 15(a), **20:5**

### BUT FOR CAUSATION

Panduit guidelines, **3:62**

**BUT FOR TEST**

Lost profits, **5:54; 6:36; 7:47; 8:51; 11:32; 13:121; 16:40; 18:35; 20:52**

**BUT ONE FACTOR FOR REJECTING**

Intent to claim, **9:39**

**CAFC**

**Court of Appeals for the Federal Circuit (CAFC)** (this index)

**CAMOUFLAGED ATTACK**

Claim interpretation, **20:8**

**CANCELLATION**

Claim interpretation, **16:118; 16:119**  
 Doctrine of equivalents, **13:106**  
 Prosecution history estoppel, **5:36**  
 Reissue claim, **9:364; 12:31**

**CANDOR**

Generally, **11:11**  
 Inequitable conduct, **12:55**

**CANONS**

Attorney disqualification, **20:3**

**CAPACITOR**

Generally, **8:58; 9:220**

**CASE OR CONTROVERSY**

Generally, **1:274; 16:144; 19:160; 20:79**  
 Axiomatic, **1:113**  
 Declaratory judgment  
     inducement, **1:319**  
     plaintiff must establish, **19:86**  
 Escrow, **3:21**  
 Infringement, **7:10**  
 Medicare Prescription Drug, Improvement, and Modernization Act, **20:78**  
 Orange book, **20:78**  
 Patent Office issuance of final decisions, challenging, **19:290**  
 Summary judgment, **7:7**

**CATALOG OF PARTS**

Generally, **12:13**

**CAUSAL RELATION MUST BE SHOWN**

Lost profits, **5:71**

**CAUSATION**

Lost profits, **13:79; 15:10**  
 Permanent injunction, **7:121**

**CAUSATION, BUT FOR**

Lost profits, **3:96**

**CAUSE OF ACTION**

Generally, **13:62**

**CCPA DECISIONS**

Binding precedent, **9:74**  
 Fast moving industry, **9:74**  
 Long-felt need, **9:74**  
 Secondary considerations, **9:74**

**CD-ROM**

FRAP 25, **25:5**

**CEASE AND DESIST LETTERS**

Corporate officers, **6:67**  
 Importation, **19:221**  
 Minimum contact, **18:45**  
 Personal jurisdiction, **24:5**

**CEILING**

Factual findings to support jury verdict presumed, **2:15**

**CELANESE INTERNATIONAL CORPORATION V. INTERNATIONAL TRADE COMMISSION**

2024, **3:250**

**CELLS**

Hepatocytes, freeze-thaw cycles, **18:109**  
 Microbiology field, **9:53; 18:109**

**CERTAINTY AND DEFINITENESS**

Generally, **2:166; 3:237; 4:111; 5:122; 8:93; 9:252; 9:396; 9:473; 14:103; 14:105 to 14:107; 15:50; 16:127; 19:161; 19:337**

See also **Ambiguity** (this index)

Amenable to construction, **5:58**  
 Amendments, **1:21; 8:86**  
 Antecedent basis, **5:81**  
 Anticipation, **5:107**  
 Apparatus method, mixed, **13:220**  
 Appeal and review, **21:44**  
 Basic and novel properties, **8:156**  
 Burden of proof, **1:21**  
 Claim construction, **3:193; 7:120; 20:99**

## INDEX

### CERTAINTY AND DEFINITENESS

#### —Cont'd

- Claim language as precise as subject matter permits, **16:47**
- Claim preclusion, indefiniteness, **4:110; 13:223**
- Clarity, **19:213**
- Competitor, potential competitor cannot determine infringement, **13:57**
- Construction, **5:58; 5:81; 8:86; 8:103**
- Damages, indefiniteness, **1:275**
- Deference, reviewed without, **21:44**
- De novo review, **9:328**
- Design patent, indefiniteness, **1:275; 5:126**
- Difficulty in determining scope of claim by one skilled in the art, **9:156**
- Discretion of court, **19:60**
- Enablement, versus, **16:60; 20:121**
- Essentially factual, when issues are, **2:99**
- Explicit antecedent basis, failure to provide, **2:84**
- Express definition of terms, **2:105**
- Extrinsic evidence, **2:156**
- Indefiniteness. See entries throughout this topic
- Infringement, **13:57**
- Inherent, **9:486**
- Intervening rights, **16:161**
- Language
  - claim language as precise as subject matter permits, **16:47**
  - indefinite, **2:169**
- Legal conclusions, **1:118; 9:253**
- Means-plus-function claim, **1:289; 5:112; 9:330; 13:200; 18:107; 26:15**
- Method and apparatus of claim, **9:280**
- Noninfringement, **21:68**
- Not amendable to construction, **8:86**
- Obviousness, **2:160**
- Opposing views of experts, **1:21**
- Ordinary artisan, **8:103**
- Ordinary skill, hypothetical person of, **5:106**
- Potential competitor cannot determine infringement, **13:57**
- Prosecution history estoppel, **1:21**
- Question of law, **9:328**

### CERTAINTY AND DEFINITENESS

#### —Cont'd

- Reasonably apprise of the scope of invention, **15:21**
- Review, standard of, **1:119; 12:61**
- Sec. 112, **1:21; 1:44; 1:161; 16:114; 19:4**
- Sec. 112(1), **3:54**
- Sec. 112(2), **3:37; 5:106; 13:55; 14:12; 14:66; 14:72**
- Skilled in the art, **9:156**
- Standard to apply, **9:389**
- Subject matter, **16:47**
- Summary judgment, **2:175; 5:141; 19:131**
- Technical terms, **13:80**
- Those skilled in the art would understand the scope, **1:99**
- Understand, hard to, **19:131**

### CERTIFICATE OF CORRECTION

- Generally, **3:224; 8:154; 19:126**
- Clear and convincing standard, **3:128; 19:142**
- Material limitation omission, **8:132**
- Reasonable debate, subject to, **14:39**
- Recapture rule, **3:187**
- Sec. 254, **19:56**
- Subject to reasonable debate, **14:39**
- Terminal disclaimer, **10:44**
- Written description, **3:187**

### CERTIFICATES AND CERTIFICATION

- Choice of law, **19:155**
- Correction. **Certificate of Correction** (this index)
- FRCP 54(b), **19:141; 19:191**
- Order for appeal, **20:28**
- Reexamination, **9:239**

### CERTIFICATION PLEDGING

- Abbreviated New Drug Application (ANDA), **19:247**

### CERTIFIED APPEAL

- Limitation thereon, **6:17**

### CERTIFIED QUESTION

- Generally, **8:55**
- Federal patent policy, **6:17**

### CERTIORARI

- Sec. 135(c), **3:29**

**CFR 1.601(n)**

Generally, **5:68**

**CHAIN OF RELATED APPLICATIONS**

Sec. 120, **12:10**

**CHALLENGE**

Assignor estoppel, **21:38**

Burden, heavy, **1:9**

Burden on patent challenger, **16:12**

Claim preclusion, **8:76**

Executive Order 10096, **8:10**

Interference, **13:3**

Jurisdiction, **19:46**

Liquidated damages, **4:46**

Public policy, **4:13**

Sec. 112, **18:4**

**CHEMICAL**

Biological activity, **9:60**

Contemporaneous invention as evidence of knowledge level, **9:60**

Medicinal drug, **9:60**

Obvious to try, **9:60**

Reference read in combination with prior art as a whole, **9:60**

Structural similarity, **9:60**

**CHEMICAL CASES**

Doctrine of equivalents, **26:2**

Infringement, **13:46**

Interference, **3:28**

Obviousness, showing of nonobviousness, **9:44**

Showing of nonobviousness, **9:44**

**CHEMICAL COMPOSITION**

Obviousness, prima facie obviousness, **9:98**

Prima facie obviousness, **9:98**

**CHEMICAL COMPOUND**

Anticipation, **10:26**

Disclosure, encompassed by disclosed generic formula, **9:148**

Encompassed by disclosed generic formula, **9:148**

Exact compounds, **21:33**

Generic formula, encompassed by disclosed generic formula, **9:148**

Infringement, **5:29**

Interference, **15:1**

**CHEMICAL COMPOUND—Cont'd**

Obviousness, **5:90; 5:91**

Obviousness-type double patenting, **15:41**

**CHEMICAL GENUS**

Disclosure, **9:126**

**CHEMICAL INTERFERENCE**

Sec. 112, **2:14**

**CHEMICAL PROCESS**

Define, process defined, **9:20**

Each statutory claim class to be considered independently, **9:20**

Obvious, otherwise, **9:20**

Process defined, **9:20**

**CHEVRON DEFERENCE**

Statutory construction, **4:45; 6:31; 13:77; 26:3**

**CHEWY, INC. V. INTERNATIONAL BUSINESS MACHINES CORPORATION**

2024, **3:251**

**CHINESE WALL**

Confidences acquired, **5:12**

**CHOICE OF FORUM**

License agreement, **23:2**

**CHOICE OF LAW**

Generally, **2:34; 2:116; 6:78; 18:32; 19:61**

Admitting evidence, **13:121**

Advertising, false, **2:132**

Amend, leave to, **3:92**

Amendment of pleadings, **1:107**

Antitrust, **5:30; 7:73; 9:219; 14:21; 14:25**

Arbitration award, **9:278**

Attorney-client privilege, **1:19; 9:184**

Attorneys' fees, **17:7; 19:163**

Bankruptcy, **9:213**

Bona fide purchaser, **18:61**

CAFC, **5:67; 6:51; 7:75; 19:156; 21:44**

Certification, **19:155**

Civil contempt, **5:59**

Claim preclusion, **13:65**

Collateral estoppel, **2:88; 4:71; 16:57; 20:72; 22:24**

Common law, federal common law, **18:38**

## INDEX

### CHOICE OF LAW—Cont'd

Competition, unfair, **7:55; 16:48**  
Compliance with court rules, **5:54**  
Conflicts with other federal statutes, **13:92**  
Consent judgment, **14:28Z**  
Contracts, **19:134; 20:53**  
Co-pending actions, **12:67**  
Copyright, **1:151**  
Cost awards, **11:51**  
Counterclaim, infringement, **22:18**  
Deference to regional circuit law, **2:31**  
Discovery, **1:19; 4:47; 19:114**  
Dismissal, without-prejudice, **8:82**  
Evidence, admitting, **13:121**  
Evidentiary rulings, **1:92; 15:14; 19:142**  
Factors considered, **13:73**  
Federal common law, **18:38**  
FRCP, **19:16**  
FRCP 11, **22:14**  
FRCP 15(b), **19:105**  
FRCP 26(c)(7), **1:19**  
FRCP 37, **16:71; 21:69**  
FRCP 51, **5:60**  
FRCP 56(f), **5:83; 14:50**  
FRCP 60(b), **13:93**  
Implied-in-fact contract, **20:40**  
Inconsistent jury verdicts, **13:105**  
Infringement counterclaim, **22:18**  
Insurance policy, **21:31**  
Interpretation, **1:132**  
JMOL, **2:91; 19:137**  
Joinder, **9:268**  
Judgment disposes of fewer than all issues, **19:95**  
Judicial estoppel, **21:24**  
Jury verdict, inconsistent, **13:105**  
Justiciability, **13:30**  
Misconduct, sanctions for, **19:114**  
Motion for new trial, **5:56; 5:65; 19:165**  
Motion to remand, **19:45**  
New trial, **5:56; 5:65; 13:101; 19:126; 19:165**  
Nonparty's motion to quash discovery subpoena, **20:17**  
Patent tying, **9:276**  
Personal jurisdiction, **1:70; 4:49; 8:69; 8:79; 9:226; 18:45**  
Postjudgment interest, **20:49**

### CHOICE OF LAW—Cont'd

Prejudice, without-prejudice dismissal, **8:82**  
Preliminary injunction, **13:89; 16:33**  
Pre-trial order, **19:149**  
Procedural issues, **8:21; 19:42; 20:4**  
Purely procedural issues, **12:58**  
Recusal, **2:55**  
Regional circuit court, case transferred by, **24:1**  
Rule 60(b)(6), **6:49**  
Sanctions for misconduct during discovery, **19:114**  
Sec. 285, **23:57**  
Settlement agreement, **1:100; 7:54; 16:99**  
Sixth Circuit, **1:42**  
State law, **18:64; 18:66**  
Subject matter jurisdiction, **20:66**  
Supreme Court case law as controlling precedent, **23:24**  
Trade dress, **9:161; 15:11**  
Trade secrets, **12:65; 18:39**  
Transfer of case, **24:1**  
Unfair competition, **7:55; 16:48**  
Uniformity objective, **23:37**  
Without-prejudice dismissal, **8:82**

### CHROMADEX, INC. V. ELYSIUM HEALTH, INC.

2023, **3:245**

### CHUTZPAH

Design patent, **19:8**

### CIP

**Continuation-in-Part Application** (this index)

### CIRCUMSTANTIAL EVIDENCE

Burden of proof, **4:33**  
Direct evidence versus, **13:28**  
Inducement, **2:130**  
Infringement, **12:90**  
Process performable by person, **1:12**  
Rule of reason, **3:82**

### CITATION TO RECORD

FRAP 28(e), **12:22**

### CITED ART

Presumption re uncited art, **12:13**  
Sec. 282, **12:6**

**CITED PRIOR ART**

Generally, **13:28**  
 Inequitable conduct, **8:29**

**CITING EVIDENCE**

Only supporting evidence on appeal,  
**13:45**

**CITIZEN PETITION**

Antitrusts, **20:127**

**CIT (UNITED STATES COURT OF  
 INTERNATIONAL TRADE)**

Procedural rule corresponds to FRCP,  
**5:18**

**CIVIL ACTIONS**

Generally, **3:38**  
 Interference, **18:49**  
 Sec. 145, **8:118**

**CIVIL CONTEMPT**

Choice of law, **5:59**  
 Criminal distinguished, **19:48**  
 Damages, **7:11**  
 Severe remedy, **13:1**

**CLAIM AGAINST GOVERNMENT**

Just compensation, **12:27**

**CLAIM CONSTRUCTION AND  
 INTERPRETATION**

Generally, **1:142; 1:144; 1:336; 1:379;**  
**2:72; 2:95; 2:102; 2:110; 2:142;**  
**2:188; 2:192; 3:97; 3:179; 3:214;**  
**3:217; 4:77; 5:123; 5:145; 6:106;**  
**7:91; 7:120; 7:144; 8:104; 8:141;**  
**9:396; 9:399; 9:405; 9:409; 9:424;**  
**9:468; 9:485; 9:494; 9:495; 9:503;**  
**9:513; 11:44; 11:76; 11:84; 11:88;**  
**13:137; 13:228; 13:250; 14:49;**  
**14:51; 14:87; 14:102; 15:22;**  
**15:25; 16:93; 16:165; 16:180;**  
**16:183; 18:74; 19:169; 19:172;**  
**19:189; 19:256; 19:270; 19:277;**  
**19:289; 19:343; 20:81; 20:138;**  
**20:142; 21:83; 22:33; 22:47;**  
**23:56; 23:60; 23:79; 23:80; 23:90**  
 “A” and “an,” **2:127; 20:90**  
 Absent meaning interpret as in patent,  
**9:273**  
 Abstract, **8:73**  
 Accuracy, **19:155**  
 Accused device. Device, below  
 Accustomed and ordinary meaning, **4:60**

**CLAIM CONSTRUCTION AND  
 INTERPRETATION—Cont’d**

Actual words controlling, **4:53**  
 Additional precision, **16:55; 22:40**  
 Adequacy, **5:2**  
 Admissibility of evidence, **19:16**  
 Advantages, **7:83**  
 Affidavit, **9:77**  
 Aids, **19:19**  
 All elements rule, **10:7; 16:118**  
 Allowance during prosecution, positions  
 taken to obtain, **1:5**  
 Ambiguity, **2:98; 16:53; 19:115**  
 Amendment, narrowing, **8:80; 12:83;**  
**19:210**  
 Anticipation, **2:188; 5:142; 8:96;**  
**8:146; 8:148; 9:285; 20:67**  
 Any method of analysis, **6:46**  
 Any use of device, **16:120**  
 Apparatus and method claims, **8:125;**  
**13:220**  
 Apparatus of claim, **9:280**  
 Appeal and review, **19:16**  
 Arguing claim, **1:123; 3:7**  
 Asserted claims valid, **19:285**  
 Attorneys, **9:94**  
 Avoid ensnaring prior art, **8:57**  
 Beginning with language of claims,  
**20:71**  
 Broadening ordinary meaning, **13:156**  
 Broadest reasonable interpretation,  
**3:223; 9:77; 9:149; 9:256; 9:350**  
 Camouflaged attack, **20:8**  
 Canceled claims, **16:118; 16:119**  
 Choice between two views of evidence  
 cannot be clearly erroneous, **16:13**  
 Claim differentiation, **6:93; 23:88**  
 Claim language, **1:85; 1:125; 5:101**  
 Claim narrowing, **4:23**  
 Claim preamble, **1:313; 3:224; 9:94**  
 Claim terms, construing, **9:420**  
 Claim vs., **18:46**  
 Clearly erroneous, **4:23; 16:13**  
 Close proximity of terms, **2:105**  
 Collateral estoppel, **5:113**  
 Commercial embodiment, **1:192**  
 Commercial product, comparison to,  
**9:94**  
 Commercial success, **9:77**  
 Common meanings, several, **9:246**

## INDEX

### CLAIM CONSTRUCTION AND INTERPRETATION—Cont'd

Common term among patents, **13:128**  
Comparison to commercial product, **9:94**  
“Comprised of” construed, **3:129**  
“Comprising” construed, **19:158**  
Consistent interpretation, **3:3**  
Consistent terms, **3:119**  
Consistent with dependent claims, **23:43**  
Consisting essentially of, **1:127; 23:3**  
Consult sources other than claims, **5:30**  
Context of intrinsic record, **16:138**  
Contributory infringement, **5:98**  
Copies, claim copied from patent to provoke interference, **9:130**  
Correction of error by District Court, **3:156**  
Corroboration, **9:77**  
Cover more than preferred embodiment, **7:57**  
Critical claim term construction, **13:169**  
Crowded art, improvement in, **20:8**  
Customary meaning, **6:51**  
Dedication to public, **16:88**  
Defining the invention, claim as, **9:267**  
Definiteness, **5:114; 8:103; 20:99**  
Definition, **7:28; 8:99; 9:253; 14:30**  
Dependent claims, consistent with, **1:158; 15:31; 23:43**  
Designing around, **3:7**  
Device  
    accused device, generally, **5:83; 23:60**  
    how works, **12:28**  
Dictionary, **1:90; 1:154; 3:105; 6:51; 7:79; 9:253; 9:269; 9:396; 11:53; 13:151; 16:85; 16:94; 20:51**  
Different meaning with different words, **24:2**  
Direct infringement, **12:108**  
Disavowal of claim scope, **3:140; 5:97; 7:109; 15:47; 16:143; 16:151; 20:112; 20:148; 21:70**  
Disfavor argue own construction improves, **11:43**  
Doctrine of equivalents, **1:192; 3:170; 3:178; 4:23; 4:87; 5:120; 20:8**  
Doctrine of last antecedent, **6:68**  
Drawings, **16:82**  
Effective amount, **1:122**

### CLAIM CONSTRUCTION AND INTERPRETATION—Cont'd

Effective filing date  
    generally, **16:92**  
    ascertainment on, **16:95**  
Elaborating terse claim language, **5:50**  
Embodiment, **1:207; 7:57; 7:77; 10:23; 14:34; 16:54; 19:196; 22:12; 22:30; 22:35; 23:49**  
Enablement, **19:205; 22:49**  
Erroneous remark, **9:94**  
Erroneous statement during prosecution, **2:80**  
Essential element, **1:119**  
Estoppel  
    argument-based estoppel, **19:320**  
    marking estoppel, **19:15**  
Evidence, **1:79; 4:23; 5:53; 6:37; 16:13**  
Evolving claim construction, **15:42**  
Examiner, **9:94; 19:184; 20:72**  
Exceptional case determination, **8:122; 16:13**  
Exclusion, **1:233; 14:34; 19:138; 22:12**  
Expand or limit scope of terms, applicant, **7:76**  
Experience, **8:52**  
Experimental and physical evidence, **6:37**  
Expert or opinion evidence, **3:111; 9:77; 13:86; 19:16; 19:279; 19:340; 22:40**  
Explicit arguments, **12:54; 18:60**  
Expressly redefine claim terms, **5:48**  
Extreme skepticism, renders claim inoperable viewed with, **20:60**  
Extrinsic evidence, **2:62; 4:51; 4:59; 5:36; 11:43; 14:30; 16:53; 19:115; 20:77; 22:45; 23:79; 25:3**  
Fact, mixed question of law and fact, **13:78**  
Factors, **1:52; 1:82; 12:35; 16:40**  
Fact question, **26:1**  
File history attorney, **9:94**  
File history estoppel, **18:29**  
**File Wrapper** (this index)  
Filing date. Effective filing date, above  
Foreign prosecution activities, relevancy, **1:209; 3:7**  
FRCP 12(b)(6), **15:56**  
FRCP 52(a), **3:7**  
FRCP 56(c), **8:27**

**CLAIM CONSTRUCTION AND INTERPRETATION—Cont'd**

Functional language, **1:124**  
 Harmless error, **19:15**  
 Hatch-Waxman Act, **19:314**  
 Heavy presumption, **5:70; 18:67; 20:63**  
 Hindsight, **19:15**  
 History attorney, **9:94**  
 Identity of invention, **5:2**  
 Import limitations, **2:92; 5:62**  
 Improper to inject limitation, **9:94**  
 Improvement in crowded art, **20:8**  
 “Including” and “comprising,” **12:83**  
 Incorporation by reference, **16:128**  
 Indefiniteness and infringement, **3:193; 13:220; 20:136; 21:68**  
 Independent/dependent claim infringement, **26:1**  
 Induced infringement, **5:98**  
 Inequitable conduct, **1:138; 19:15**  
 Infringement, generally, **2:82; 2:129; 3:7; 6:93; 16:35; 19:15; 19:167; 19:242; 23:58; 23:88; 26:1**  
 Ingredients, **13:125**  
 Inimical, **8:88**  
 In light of specification vs. into the claim, **1:108**  
 Injunction, **20:149**  
 Interference, **1:5; 1:182; 2:172; 9:88; 9:130**  
 International Trade Commission, **5:98; 12:87; 19:196**  
 Inter partes review, **1:328; 8:149**  
 Intrinsic evidence, **1:140; 5:53; 11:40; 16:53; 16:58; 18:51; 19:111; 19:115; 20:117; 22:45**  
 Intrinsic evidence primary source, **1:140**  
 Intrinsic record, **11:53; 22:31**  
 Inventor’s testimony, **8:106**  
 Issue preclusion, **9:151**  
 JMOL, failure to make, **21:39**  
 JNOV motion, **6:6**  
 Joint infringement, **1:195**  
 Judge, extrinsic evidence only to educate, **5:36**  
 Judgment, acquiescence in, **19:16**  
 Jury verdict, **19:5**  
 Kessler Doctrine, **19:309**  
 Knowledgeable in the field, understanding as that of persons, **13:120**  
 Laches, **8:114**

**CLAIM CONSTRUCTION AND INTERPRETATION—Cont'd**

Language, **18:68; 20:71**  
 Last antecedent, **6:68**  
 Law, mixed question of law and fact, **13:78**  
 Law of the case, evolving claim construction, **15:42**  
 Law question, **1:50; 1:77; 2:52; 4:17; 4:23; 4:102; 5:22; 8:52; 8:74; 9:131; 12:33; 13:29; 13:45; 13:54; 13:80; 16:40; 18:30; 19:56; 19:266; 20:25; 23:16**  
 Lexicographer, **1:132; 2:81; 5:94; 9:254; 13:124; 26:1**  
 Limitations and restrictions  
   generally, **1:158; 14:32**  
   applicant may expand or limit scope of terms, **7:76**  
   attorney’s erroneous remark, **9:94**  
   certificate of correction, **8:132**  
   disclaimer, **15:38**  
   file history, **9:94**  
   import, may not, **5:62**  
   means plus function claim, **9:339; 20:116**  
   preferred embodiment, **6:56; 7:77**  
   read unwritten limitation therein, **11:47**  
   specification, **9:94; 20:61**  
   specific examples, **9:298**  
 Literal infringement, **2:139**  
 Made inside body, **14:46**  
 Malpractice, disregard of alternative claim language, **13:184**  
 Marking estoppel, **19:15**  
 Markman hearing, **5:100**  
 Markush claim, **13:218; 19:299**  
 Meaning, **9:396**  
   extrinsic evidence to contradict meaning, **4:59**  
   no meaning removed from context, **7:66**  
   same meaning, **19:15**  
   several common meanings, **9:246**  
   trial testimony not alter established meaning, **10:22**  
   useful to ascertain claim meaning, **10:32**

## INDEX

### CLAIM CONSTRUCTION AND INTERPRETATION—Cont'd

Meaning, **9:396**—Cont'd  
words given meaning as would persons experienced in field of invention, **8:52**

Means-plus-function, **20:149**

Method and apparatus claim, **8:123; 9:280; 13:195**

Minority, **5:71**

Mixed question of law and fact, **13:78**

Motion for judgment as matter of law, **5:130**

Motion for new trial, **19:16**

Motions, post-trial mottos, cannot be reserved for, **8:84**

Multiple applications, **14:47**

Multiple constructions for same claim, **1:247**

Multiple definitions of phrase, **7:28**

Multiple dictionary definitions, **9:253**

Multiple embodiments, **22:30**

Narrowing amendment, **8:80; 12:83; 19:210**

Negative claim construction, **19:234**

New property, **5:2**

New trial, motion for, **19:16**

Nexus, **9:77**

No meaning removed from context, **7:66**

Noninfringement stipulated, **1:130; 23:80**

Nonsensical result, **3:113**

Not limited to preferred embodiment, **6:56; 7:77**

Objection, waiver of, **3:200; 19:16**

Obviousness, **1:223; 1:365; 2:183; 2:185; 2:189; 3:178; 9:397; 9:459; 9:504; 19:11; 19:243; 19:315; 20:8**

Obviousness to try, **9:459**

Obviousness-type double patenting, **19:226**

“Or,” **2:86; 19:145**

**Ordinary and Accustomed Meaning**  
(this index)

Ordinary skill in the art, **2:88; 5:110; 8:88; 8:112; 20:99**

Overtake, easily, **16:13**

Patentability, reason related to, **11:49**

Patent drawings, **16:82**

Patent marking, **18:118**

### CLAIM CONSTRUCTION AND INTERPRETATION—Cont'd

Petition to make special, **7:57**

Phrase, multiple definitions of, **7:28**

Physical and experimental evidence, **6:37**

Physically combinable, references need not be, **9:77**

Pioneer invention, **20:8**

Plain meaning, **19:167**

Plain meaning of specification, **21:9**

Plurality, **1:372**

Policy driven, **19:161**

Post-trial mottos, cannot be reserved for, **8:84**

Preamble, **9:478; 16:86; 19:335; 20:131**

Preferred embodiment, **1:116; 1:207; 5:31; 6:56; 7:57; 7:77; 16:54; 22:12; 23:49**

Preferred embodiment, exclusion, **1:233**

Prejudicial error, **14:2**

Preliminary injunction, **1:241; 3:135**

Present invention, **18:64**

Presumption, **1:161; 4:73; 4:74; 5:70; 9:94; 11:48; 18:67; 20:63**

Prevailing party, JMOL, **3:161**

Printed publication, **1:313**

Prior art, **1:103; 8:57; 13:63; 19:15**

Prior art, unpatentable in view of, **19:281**

Priority, **5:142**

Priority claim, **1:199**

Priority date, **20:102**

Process, **21:61**

Prosecution disclaimer, **1:309; 7:140; 15:21; 19:336; 20:138**

Prosecution history, **1:77; 2:77; 11:12; 12:31; 14:57; 19:84; 19:193; 23:51**

Prosecution history estoppel, **9:94; 15:30; 22:37; 26:1**

PTO interpretation during prosecution, **9:199**

Publication, unpublished paper, **20:8**

Purely legal question, **3:84**

Read unwritten limitation therein, **11:47**

Reasonable interpretation, **9:77; 16:60**

Reasonable royalty, **19:279**

Reason related to patentability, **11:49**

Redefine, expressly redefine claim terms, **5:48**

**CLAIM CONSTRUCTION AND INTERPRETATION—Cont'd**

Redraft claims, **18:91**  
 Redundancy, **22:67**  
 Reexamination, broadest reasonable interpretation, **9:87; 9:154; 9:255; 9:424**  
 References need not be physically combinable, **9:77**  
 Reissue, **9:77**  
 Relevant, problem inventor was attempting to solve is, **3:75**  
 Renders claim inoperable viewed with extreme skepticism, **20:60**  
 Repeatedly and consistently characterizing claims, **7:120**  
 Reservation, **8:84**  
 Reverse doctrine of equivalents, **3:7; 19:24; 19:51**  
 Review, standard of, **3:74; 12:35; 12:103; 19:12; 19:121; 20:64**  
 Rewriting, specification, use to rewrite claim language, **18:68**  
 “Rewritten” claims, **16:91**  
 Same meaning, **19:15**  
 Same term, **1:106; 5:63; 6:43**  
 Same way construction, **23:11**  
 Scope of invention, **8:112**  
 Sec. 102(g), **11:9**  
 Sec. 103, **20:8**  
 Sec. 112, **4:23; 9:40; 20:6**  
 Sec. 112(6), **9:339; 11:28**  
 Sec. 116, **19:15**  
 Sec. 285, **1:5**  
 Sec. 291, **1:5**  
 Sequences, **9:326**  
 Several common meanings, **9:246**  
 Skill in the art, **3:75; 4:61; 4:66; 9:232; 20:8**  
 Special, petition to make special, **7:57**  
 Special definition, **14:30**  
 Specification, **1:134; 3:80; 5:2; 9:94; 13:86; 13:104; 14:57; 18:68; 19:26; 19:191; 19:196; 20:61; 21:9; 25:4**  
 Specifications, limitations, **12:68**  
 Standard of review, **3:74; 12:35; 12:103; 19:12; 19:121; 20:64; 20:130**  
 Standing, **1:264**

**CLAIM CONSTRUCTION AND INTERPRETATION—Cont'd**

Statements describing whole invention, **22:32**  
 Statement that claims not include feature, **19:136**  
 Stipulated judgment, **10:37**  
 Strong presumption ordinary meaning, **4:73**  
 Substantial evidence vs. clearly erroneous, **20:1**  
 Substantiality, **12:70**  
 Substantially, **12:61; 13:134**  
 Suggestion in prior art, **19:15**  
 Summary judgment, **1:256; 2:24; 8:17; 20:10**  
 Technical terms, **14:44; 16:56**  
 Terms, **3:91; 5:48; 6:43; 7:31; 7:76; 9:338**  
 Terse claim language, elaborating, **5:50**  
 Timing, **3:123**  
 Timing of analysis, **22:18**  
 Trial testimony not alter established meaning, **10:22**  
 True inventor, **19:15**  
 Two-step analysis, **19:15; 20:62**  
 Unambiguous meaning, extrinsic evidence not contradict, **4:51**  
 Unclaimed elements, **6:58**  
 Understood by person in field, **22:25**  
 Uniform interpretation, **9:130**  
 Useful to ascertain claim meaning, **10:32**  
 Use of evidence, **1:92; 1:129; 25:3**  
 Use of prosecution history, **19:84**  
 Vacating, **1:5**  
 Vacuum, claims not interpreted in, **9:58; 19:13**  
**Validity** (this index)  
 Varied use of a term, **2:78**  
 Vitiating, **3:178**  
 Waiver, **3:174; 3:200; 4:99; 9:234; 15:29; 19:16; 19:279**  
 Wherein clauses, **1:331**  
 Whereby clause, **8:91; 20:29**  
 Wired and wireless technologies, limitation of claims to, **18:114**  
 Witnesses, **10:22; 19:16; 22:17**  
 Words, **1:136; 8:52; 10:24**  
 Written description, **6:93; 22:49**

## INDEX

### CLAIM DIFFERENTIATION

Generally, **1:293; 2:45; 2:82; 5:5; 6:58; 6:92; 7:70; 8:141; 11:2; 11:44; 11:48; 12:35; 12:121; 13:8; 14:43; 14:48; 22:30; 23:16**  
Anticipation, **11:2**  
Broaden beyond correct scope, **13:91; 20:51**  
Claim construction and interpretation, **6:93; 23:88**  
Claim terms, construing, **9:420**  
Combinations, hypothetical, **11:2**  
Covenant not to sue, **9:411**  
Covered business method, **1:293**  
Defer to PTO, no reason to, **11:2**  
Dependent claim, **5:60; 9:237**  
Dictionaries, **19:261**  
Different words not mandate different interpretations, **20:52**  
FRCP 56(c), **8:27**  
Hard and fast rule, **19:157**  
Hindsight reconstruction, **11:2**  
Hypothetical combinations, **11:2**  
Identity of invention, **11:2**  
Immutable fixed rule, **4:17**  
Independent claims, **5:60; 9:237**  
Infringement, **6:93; 23:88**  
Inventor's theory, **6:10**  
Law question, **11:2**  
Limitations, **3:89; 9:370**  
Means-plus-function, **18:17; 23:54**  
Plain language, cannot overcome, **13:105**  
Presumption of different scope, **3:80; 19:171**  
Prosecution history, **1:162**  
PTO, defer to PTO, no reason to, **11:2**  
Reading dependent claim into independent claim, **9:237**  
Reconstruction, hindsight, **11:2**  
Reverse doctrine of equivalents, **11:2; 19:24**  
Sec. 112(6) equivalency, **12:26**  
Sec. 112 equivalency, **16:2**  
Separate claims have different scope is not rigid, **1:92**  
Uncited art, **11:2**  
Words, **19:261**  
Written description, **6:93**

### CLAIMED INVENTION

Best mode, **20:63**

### CLAIMED METHOD

Infringement, **2:52**

### CLAIMED RANGES

Obviousness, **9:277**

### CLAIM LANGUAGE

Generally, **3:41**  
Claim interpretation, **1:85; 1:125; 5:101**  
Controlling language, **18:30**  
Design patent, **7:59**  
Doctrine of equivalents, **3:136**  
Indefiniteness, **2:169; 5:114; 16:47**  
Means-plus-function claim, **2:137; 3:97; 5:112**  
Sec. 112, **9:72**

### CLAIM NOT READ IN VACUUM

Generally, **19:13**  
Broadest reasonable interpretation, **9:58**

### CLAIM PREAMBLE

Generally, **1:80; 2:82; 2:115; 4:128.50; 7:74; 9:123; 9:272; 12:28; 16:142; 18:47; 19:130; 19:145**  
Absolute rules, none, **7:61**  
All elements rule, **3:22**  
Anticipation, **3:22; 4:15; 13:164**  
As a whole, **16:58**  
Burden on patent challenger, **16:12**  
Claim construction and interpretation, **1:313; 9:94; 16:86; 19:210; 20:131**  
Claim limitation, **1:198; 9:154; 13:164; 22:41**  
Combining prior art teachings, **9:79**  
Deposition, **1:338**  
Derive antecedent basis, **5:65**  
Doctrine of equivalents, **3:22; 7:80**  
Effect, **3:22**  
Function, **3:22**  
Genus, **3:22**  
Import that claim as whole suggests, **2:52; 16:58**  
Intent, **1:103; 2:101; 9:79**  
Inter partes review, **1:338**  
Jepson claim, **5:63**  
Life and meaning, **9:154; 22:41**  
Limitations, **1:119; 3:22; 7:16; 9:154; 18:44; 19:210; 22:41**

**CLAIM PREAMBLE—Cont'd**

Litmus test, **9:242**  
 Meaning, **7:113; 9:154; 16:20; 22:41**  
 Obviousness, **9:79**  
 Printed publication, **1:313**  
 Prior art, combining, **9:79**  
 Reasonable diligence, **1:338**  
 Reciting structural limitations, **18:44**  
 Redrafting claim, **3:22**  
 Species, **3:22**  
 Statement of intended purpose, **9:79**  
 Statement of purpose, **1:208; 5:63**  
 Structural limitations, **1:198; 18:44**  
 Suggestions, **16:58**  
 Verdict, **16:14**

**CLAIM PRECLUSION**

Generally, **1:170; 2:159; 13:117; 24:8**  
 Certainty and definiteness, **4:110**  
 Challenge to validity when second  
 action involves different device,  
**8:76**  
 Choice of law, **13:65**  
 Claim limitations unchanged, **14:61**  
 Essentially the same, **1:170**  
 Identical parties, not limited to, **13:65**  
 Inter partes review, **23:86**  
 Law question, **8:76**  
 Material differences in claim limitation,  
**14:64**  
 Privity, **23:86**  
 Reexamination, **19:255**  
 Res judicata, **19:255**  
 Reverse doctrine of equivalents, **18:80**

**CLAIMS COURT**

Generally, **13:50; 19:65; 23:28**  
 Binding precedent, **19:63; 23:33**  
 Dismissal for lack of subject matter  
 jurisdiction, **20:27**  
 Findings of special master, **3:49**  
 FRCP 12(b)(4), **13:56**  
 Limitation of actions, **2:53; 3:55**  
 Review, standard of, **6:29; 19:67**  
 RUSCC 60(b) motion, **3:40**  
 Sec. 1498, **16:38**  
 Sec. 2412(b), **13:48**  
 Special master's findings, **3:49**  
 Subject matter jurisdiction, **2:41; 20:27;**  
**21:21**  
 Summary judgment, **16:30**

**CLAIM TERMS**

Anticipation, **8:148**  
 Consistently interpreted, **18:30**  
 Construction of critical claim term,  
**13:169**  
 Essentially, **26:2**  
 Expand or limit scope of terms, **7:76**  
 Expressly redefine, **5:48**  
 Inequitable conduct, **18:116**  
 Limitations, **21:53**  
 Means for cross-referencing, **20:110**  
 Ordinary meaning unless used differ-  
 ently by inventor, **3:91; 7:31;**  
**11:61**  
 Same terms appearing in different por-  
 tions, **6:43**  
 Scope, **11:61**

**CLAIM WORDS**

In first instance, **5:7**

**CLAM INDEFINITENESS**

Sec. 112(2), **2:45**

**CLASSIC TEST**

Sec. 102, **12:12**

**CLEAR AND CONCISE**

Prosecution history estoppel, **23:42**  
 Sec. 112, **15:2**

**CLEAR AND CONVINCING**

**EVIDENCE**

Certificate of correction, **3:128; 19:142**  
 Conception, **7:46**  
 Defined, **9:118**  
 Exceptional case, **9:161**  
 Inequitable conduct, **1:71; 7:68;**  
**13:141; 15:3; 19:38**  
 Infringement, **3:158**  
 Obviousness, **2:171; 14:9**  
 On-sale bar, **2:23**  
 Validity, **5:49; 5:64; 19:132; 19:142**  
 Willful infringement, **16:129; 20:39**

**CLEAR AND UNAMBIGUOUS**

Plain and ordinary meaning, they must  
 be given their, **1:56**

**CLEAR-CUT GROUNDS**

Frivolous appeal, **19:90**

**CLEAR DEMARCATION**

Sec. 121, **7:75**

## INDEX

### **CLEARLY ERRONEOUS**

Generally, **2:59; 19:23**  
Anticipation, **18:20**  
Appeal and review, **4:6; 7:2; 12:2**  
Attorney fees, **19:23**  
Board, **9:191**  
Claim construction, **4:23; 16:13**  
Defense, implied license, **19:23**  
Definition, **4:41**  
Due care, duty of, **19:23**  
Equitable estoppel, **19:23**  
Findings, PTO fact, **9:80**  
Identity of invention, **20:20**  
Implied license defense, **19:23**  
Increased damages, **19:23**  
Interference, **4:11**  
Legal, **19:23**  
License, **19:23**  
Literal infringement, **19:23**  
Mandamus, **9:57**  
Means-plus-function, **19:23**  
New evidence introduced, **6:9**  
On-sale bar, **2:23**  
Per se rule, **19:23**  
PTO fact findings, **9:80**  
PTO standard of materiality, **9:43**  
Substantial evidence versus, **20:1**  
Willful infringement, **19:23**

### **CLEARLY LINK**

Means-plus-function claim, **13:118**

### **CLEAR MEANING**

FRCP 52(a), **12:6**

### **CLEAR UNEQUIVOCAL LEGAL OPINION**

Generally, **3:8**

### **CLERICAL MISTAKE**

Sec. 255, **19:142**

### **CLOSED GROUP**

Markush group, **1:122**

### **CLOSE EXAMINATION**

Prosecution history estoppel, **8:13**

### **CLOSE PROXIMITY OF TERMS**

Claim interpretation, **2:105**

### **CLOSEST ART**

Expectation, unexpected results, **9:111**  
Unexpected results, **9:111**

### **CLOUDOFCHANGE, LLC V. NCR CORPORATION**

2024, **3:252**

### **COHEN COLLATERAL ORDER EXCEPTION**

Final judgment rule, **20:28**

### **COHEN TRIPARTE TEST**

Appealability of interlocutory nonfinal decision, **19:71**

### **CO-INVENTORS**

Generally, **16:48**  
Collaboration required, **5:40; 6:35; 22:39**  
Correcting inventorship, **6:79**  
Deceptive intent, **1:106**  
Freedom to license, **19:98**  
Interference, **4:31**  
Inventorship, **8:81; 22:54**  
License, freedom to license, **19:98**  
Non-joinder, **14:59**  
On-sale bar, **2:85**  
Ownership, **9:303**  
Physically work together or at same time, **20:68**  
Presumption named properly, **7:79**  
Requirements, **16:50**  
Same time, **20:68**  
Scope of claims first, **5:73**  
Sec. 116, **22:39**  
Sec. 262, **8:5**

### **COLLABORATION**

Co-inventors, **5:40; 6:35; 22:39**

### **COLLATERAL ESTOPPEL**

Generally, **1:152; 1:325; 7:142; 9:143; 13:111; 13:231; 14:93; 16:38; 16:160; 16:170; 19:274; 19:338; 20:68; 21:65; 21:90; 22:24; 22:60**  
Adoption of party's findings, **4:9**  
Affirmative defenses, **4:3**  
Agency acting in judicial capacity, **20:41**  
Alternative position, taking, **10:3**  
Applicable, when, **3:62**  
Attorney fee award, relevant to, **4:3**  
Attorneys, opinion of counsel, **4:9**  
Blonder-Tongue, **1:47; 13:26; 13:61; 19:33**

**COLLATERAL ESTOPPEL—Cont'd**

Choice of law, **2:88; 4:71; 16:57; 20:72; 22:24**  
 Claim construction, effect of prior litigation on, **9:151**  
 Claim construction and interpretation, **5:113**  
 Construction, narrow, **1:3**  
 Cross-examine, right to, **13:53**  
 Damages, measure of, **4:9**  
 Declaratory judgment, **10:6**  
 Defenses, affirmative defenses, **4:3**  
 Description, **1:249**  
 Expert's conclusion not controlling, **4:9**  
 Factors, **4:71**  
 Fair, full and fair opportunity to litigate, **16:57**  
 Findings, adoption of party's findings, **4:9**  
 Full and fair opportunity to litigate, **2:50; 16:57**  
 Holding of patent invalidity, **4:3**  
 Hypothetical judicial statements, **1:3**  
 Identical parties, **9:232**  
 Inequitable conduct, **4:3**  
 Infringement, **1:3; 1:155; 25:10**  
 Infringement, willful, **4:9**  
 Issues of law differ, **21:24**  
 ITC decision, **2:17**  
 ITC's decision, **20:41**  
 Judicial capacity, **20:41**  
 Lost profits, **4:9**  
 Multi-defendant cases, **9:310**  
 Non-mutual, **9:296**  
 Non-parties, **9:296**  
 Obviousness, claims are focus of, **10:3**  
 Opinion of counsel, **4:9**  
 Opportunity, **16:57**  
 Pleaded, must be, **4:3**  
 Prior adjudication, **9:90**  
 Prior decision or validity, **8:73; 13:105**  
 Prior litigation, effect on claim construction, **9:151**  
 Raise claim in second proceeding, **7:65**  
 Res judicata, **4:9; 7:99; 9:122; 13:51; 16:35**  
 Sec. 101, **22:61**  
 Second proceeding, raise claim in second proceeding, **7:65**  
 Specific devices before court, not embrace more than, **11:35**

**COLLATERAL ESTOPPEL—Cont'd**

Test thereof, **16:31**  
 Unique application to patent law, **1:244**  
 Validity, **4:3; 8:73; 13:105**  
 Willful infringement, **4:9**

**COLLATERAL ORDER DOCTRINE**

Generally, **2:190; 3:85; 3:115; 5:25; 6:84; 21:80**  
 Appeal of order disqualifying counsel, **9:343**  
 Confidential information, unsealing, **1:239**  
 Final judgment rule, **1:302; 20:28**  
 Protective order, **13:249**

**COLLATERAL SALES**

Entire market value rule, **18:35**

**COLUMBIA SPORTSWEAR NORTH AMERICA, INC. V. SEIRUS INNOVATIVE ACCESSORIES, INC.**

2023, **3:246**

**COMBINATION**

Generally, **5:5; 9:118**  
 As a whole, invention, **13:15**  
 Block diagram, **13:15**  
 Burden on patent challenger, **16:12**  
 Claim differentiation, **11:2**  
 Claim preamble, **9:79**  
 Combination patent, **12:13; 13:15; 19:52**  
 Cross-appeal, **18:2**  
 Declaratory judgment, **10:6**  
 Essence, **13:15**  
 Expert testimony, motivation, **23:68**  
 Hindsight, **13:15**  
 Inherency, **12:81**  
 Inventor's theory, **6:10**  
 Is obvious, **18:22**  
 Jury verdict, **3:17**  
 Means-plus-function claim, **3:89**  
 Modification, **9:51**  
 Motion to remand, **19:45**  
**Obviousness** (this index)  
 Pioneer invention, **13:1**  
 Prior art, **13:18**  
**Reference** (this index)  
 Repair, **19:79**  
 Sec. 271(f)(2), **16:141; 23:53**

## INDEX

### COMBINATION—Cont'd

- Sec. 282, **6:10; 18:6**
- Simplification of reference, **13:15**
- Sophistication as nonobviousness, **13:15**
- Summary judgment, **3:1**
- Synergism, **19:36**

### COMBINING REFERENCES

- Obviousness, **9:372; 23:11**

### COMBINING TEACHINGS

- Known or used by others, **3:2**
- Prior art references related to one another, **9:74**

### COMITY

- Generally, **9:238**

### COMMERCIAL BUYERS

- Design patent infringement, **1:165**

### COMMERCIAL CONSEQUENCES

- Sec. 102(e) v. sec. 102(g), **19:41**

### COMMERCIAL EMBODIMENT

- Generally, **12:3; 26:2**
- Claim construction, **1:192**
- Comparing claims with accused device, **13:9**
- Costs on appeal, **1:20**
- Obviousness, **1:4**
- Patent misuse, **23:9**
- Reverse doctrine of equivalents, **19:24**
- Verdict, **16:14**

### COMMERCIALIZATION

- Prior art, noting differences from, **4:6**

### COMMERCIALLY AVAILABLE

- MPEP, **16:6**

### COMMERCIAL MARKETPLACE

- Generally, **12:77**
- Enablement, **3:104**

### COMMERCIAL MODE

- Best mode, **26:4**

### COMMERCIAL OFFER FOR SALE

- On-sale bar, **13:102; 19:113**

### COMMERCIAL OFFER TO SELL

- On sale bar, **5:72; 8:145; 19:179**

### COMMERCIAL PRODUCT

- Claim interpretation, **9:94**
- Infringement, **1:124**

### COMMERCIAL SALE

- On-sale bar, **1:177; 1:179; 8:145; 13:122; 19:133**

### COMMERCIAL SUCCESS

- Generally, **1:87; 13:18; 13:137**
- Anticipation, **1:10; 1:227**
- Appeal is review and not trial de novo, **6:12**
- Burden on patent challenger, **16:12**
- Claims construed, **9:77**
- Inequitable conduct, **11:4**
- New features, where it includes several, **23:7**
- Nexus, **9:168; 18:28; 23:68**
- Nexus required, **2:76**
- Nonparty's motion to quash discovery subpoena, **20:17**
- Number of units sold is weak showing, **9:181**
- Obviousness, **7:108; 9:154; 9:311; 13:166; 18:15; 18:83; 20:107; 23:75**
- Presumption, **23:52**
- Results from claimed invention, **10:22**
- Sales alone, **9:111; 20:50**
- Secondary considerations, **3:41; 9:82; 9:331**

### COMMERCIAL TRANSACTIONS

- Statutory subject matter, **9:308**

### COMMERCIAL USE

- Public use bar, **11:12**

### COMMISSIONER

- Authority, **1:45**
- Brief not prior art, **9:140**
- Mandamus, **9:54**
- Reexamination, **9:194**
- Sec. 6(a), **23:15**
- Sec. 41(a)(7), **13:32**

### COMMON KNOWLEDGE

- References, **9:154**

### COMMON LAW

- Generally, **12:27**
- Antitrust, **3:83**
- Choice of law, **18:38**
- Good faith, **1:64**
- Presumption, **9:154**

**COMMONLY OWNED PATENTS**

Prosecution history estoppel, **1:115**

**COMMON MEANINGS**

See also **Ordinary and Accustomed Meaning** (this index)

Claim interpretation, **9:246**

**COMMON NUCLEUS OF OPERATIVE FACT**

Sec. 1376, **22:36**

**COMMON OCCURRENCE**

Examiner's initial rejection of all claims, **17:4**

**COMMON SENSE**

Obviousness, **9:297; 9:450**

Reasonable royalty estimation, **9:213**

**COMMUNICATION**

Attorney-client privilege, **23:74**

Domestic disclosure, **1:224**

Injunction, **7:92**

Objectively baseless, **4:88**

**COMPANIES**

Sec. 102(g), **14:7**

**COMPARATIVE DATA**

Obviousness, **9:56**

**COMPCO**

Sears, **21:11**

**COMPENSATION**

Adjudicated infringer, **11:10**

Claim against government, **8:116; 12:27**

Damages, **16:40**

Prejudgment interest, **15:10; 23:73**

**COMPETENCE**

Generally, **10:18**

Attorney, opinion of counsel, **3:80; 4:6; 10:21; 13:45**

Ordinary skill, hypothetical person of, **9:65**

Prosecution history estoppel, **23:41**

**COMPETITION**

Amendment, **16:72**

Amendment of claims, **13:91**

Antitrust, **3:83**

Attorney drafting claims specifically directed to competitor's device, **9:158**

**COMPETITION—Cont'd**

Choice of law, **7:55; 16:48**

CIP, **19:28**

Drafting claims covering competitor's product, **11:11**

Estoppel, **1:345**

Indefiniteness, **13:57**

Inducing infringement, **18:48**

Infringement, **19:87**

Inter partes review, **1:345**

ITC, **13:40**

9 Cir, **22:2**

Patent misuse, **19:227**

Patent prosecution bar, disclosure, **5:110**

Preemption, **26:7**

Prosecution history estoppel, **8:38**

Sears, **21:11**

Sec. 43(a), **15:5; 16:21**

Sec. 112, **20:6**

Standing, **1:345**

Summary judgment, **12:15**

**Unfair Competition** (this index)

**COMPETITIVE DECISION MAKING**

Definition, **4:94**

**COMPLAINT**

Generally, **8:66; 13:59; 13:107; 19:14; 19:55; 19:66**

Appropriate, when, **19:14**

Dismissal with prejudice, **19:14**

Facts before court, **12:44**

Form 16, **13:142**

FRCP 15(c), **6:11**

FRCP 37(b), **23:34**

Jurisdiction, **7:38**

Prejudice, dismissal with prejudice, **19:14**

Res judicata, **11:35**

Sec. 41(a)(7), **13:32**

Sec. 102(b), **19:31**

Transfer of appeal, **7:14**

**COMPLETE ARTICLES**

Sec. 171, **9:73**

**COMPLETENESS**

Conception, **2:48**

Reexamination, **9:239**

**COMPLEXITY**

Master, use of, **19:37**

Reverse doctrine of equivalents, **19:24**

## INDEX

### **“COMPONENT” OF PATENTED INVENTION**

Reasonable royalty rate, **12:97**  
Sec. 271(c), **18:79**  
Sec. 271(f), **1:146; 12:113**

### **COMPOSED OF**

Generally, **1:109**

### **COMPOSITION**

Generally, **9:129; 16:72**  
Discovery of inherent properties, **20:11**  
Infringement, **4:51**  
Obviousness issue, **9:12**  
Patentable, **9:104**  
Prima facie obviousness, **9:17**

### **COMPOUND**

Generally, **9:103**

### **COMPOUND INTEREST**

Delay damages, **4:24**  
Prejudgment interest, **18:35**

### **“COMPRISED OF”**

Construction of phrase, **3:129**

### **COMPRISING**

Cancellation of claims, **9:435**

### **“COMPRISING”**

Generally, **3:96**  
Claim interpretation, **5:102; 12:83**  
Construction of phrase, **19:158**  
Improvement, **3:37**  
Open claim language, **13:174**  
Presumption, **4:84**

### **COMPROMISING**

Generally, **1:109; 7:49; 9:254; 13:28; 22:18**

### **COMPULSORY ARBITRATION**

District court order, **16:136; 22:55**

### **COMPULSORY COUNTERCLAIM**

America Invents Act, **9:430**  
FRCP 13(a), **2:36; 9:430**

### **COMPUTATION**

Patent term extension, **13:144; 23:70**

### **COMPUTER**

Generally, **16:11**  
Detailed disclosure thereof unnecessary, **9:154**

### **COMPUTER—Cont’d**

Display, infringement, **20:118**  
Embodied in tangible medium, **9:164**  
Infringement, **19:220**  
Means-plus-function claim, **1:176; 6:68; 20:116**  
New way is physically different machine, **9:153**  
Organization of information, **9:153**  
Programmer’s skill, **14:8**  
Sec. 101, **1:251; 1:286; 2:147; 5:128; 6:80; 19:292**  
Sec. 120, **8:19**  
Statutory subject matter, **9:175**  
Tangible medium, embodied in, **9:164**

### **COMPUTER-FACILITATED PROCESSES**

Sec. 101 patent-eligible subject matter, **6:71; 19:292**

### **CONCEALMENT**

Best mode, **1:246; 2:34**  
Sec. 102(g), **16:9**  
Unreasonable delay, **12:21**

### **CONCEPTION**

Generally, **1:44; 3:94; 5:40; 19:149; 19:152; 21:42**  
Anticipation, **1:255; 20:115**  
Appreciation, recognition and, **13:105**  
Clear and convincing evidence, **7:46**  
Complete, when, **19:72**  
Completeness, **2:48**  
Corroborating evidence, **3:160**  
Corroboration, **4:74**  
Definition, **2:126; 4:100**  
Evidence, proven by, **9:244**  
Facts supported by clear and convincing evidence, **7:46**  
Fixed ideas, **13:72; 20:65**  
Idea must be fixed and permanent, **13:72; 20:65**  
Interference, **3:15; 9:244; 15:1; 19:240**  
Inter partes review, **1:323; 18:110**  
Inventorship, **2:99; 2:164; 6:35; 19:72; 19:195; 20:126; 21:55**  
Law question, **2:47; 2:96; 6:18; 6:20**  
Offer for sale, **1:216**  
Only ordinary skill necessary to reduce to practice, **19:124**  
Oral testimony, **16:70; 19:151**

**CONCEPTION—Cont'd**

- Ordinary skill, **19:124**
- Permanent ideas, **13:72; 20:65**
- Recognition and appreciation, **13:105**
- Reduction to practice, **9:407; 13:105; 19:124**
- Requirements thereof, **11:41**
- Sec. 131, **9:407**
- Simultaneous reduction to practice, **13:105**
- Testing, when required, **3:82**
- Verbatim findings of counsel adopted, **8:22**
- Willful infringement, **2:164**
- Witnesses, oral testimony, **16:70; 19:151**

**CONCEPTS**

- Anticipate, do not, **16:4**
- Inventive, **1:290; 13:210**

**CONCERNED PARTY**

- Inventorship, **3:93**

**CONCESSION**

- Double patenting, **15:6**
- Filing of CIP, **23:30**

**CONCLUSIONS OF LAW**

- FRCP 52(a), **3:45**

**CONCLUSORY STATEMENT**

- Evidence, **2:80**
- Routinely built, well-known and, **9:113**
- Summary judgment, **3:13; 20:62**
- Well-known and routinely built, **9:113**

**CONCURRENT LITIGATION**

- Preliminary injunction, **11:19**
- Same parties and same issues requirement, **9:116**

**CONDITIONAL CROSS-APPEAL**

- Claim construction, **14:53**

**CONDITIONAL NEW TRIAL**

- District court has wide discretion, **13:34**

**CONDUCT AND MISCONDUCT**

- See also **Inequitable Conduct** (this index)
- Attorneys, **11:13**
- Choice of law, **19:114**
- Exceptional case, litigation misconduct, **18:64**

**CONDUCT AND MISCONDUCT**

**—Cont'd**

- FDA, conduct before, **5:95**
- Flagrant misrepresentations of record, **16:9**
- Litigation Misconduct** (this index)
- Res judicata, continuing conduct, **1:229**

**CONFIDENCE**

- Attorney disqualification, **16:3**
- Chinese Wall, **5:12**
- High degree of confidence and trust between PTO and patent applicants, **10:5**

**CONFIDENTIAL BUSINESS INFORMATION**

- Preliminary injunction, **6:7**

**CONFIDENTIAL INFORMATION**

- Discovery, **1:10**
- Motion to compel discovery, **19:17**
- Protective order, **13:40**
- Public use, **1:174; 2:106**
- Unsealing, appeal and review, **1:239**

**CONFLICT OF LAWS**

- Choice of Law** (this index)

**CONGRESS**

- Agency's authority limited by, **11:26**
- Prejudgment interest, **19:83**
- Sec. 156, **6:3**
- Sec. 282, **12:5**
- Statutory Construction and Interpretation** (this index)

**CONGRESSIONAL INTENT**

- Statutory construction and interpretation, **1:61; 7:24; 8:39; 19:75**

**CONJECTURE**

- Generally, **9:125**

**CONNECTED**

- Generally, **7:49**

**“CONNECTED TO” OR “COUPLED TO”**

- Claim construction, **7:104**

**CONSENT**

- FRCP 60(b), **23:23**
- Judicial Panel on Multi-District Litigation (JPMDL), **7:6**

## INDEX

### CONSENT—Cont'd

- Personal jurisdiction, **8:79; 13:114; 16:124**
- Res judicata effect, **6:17**
- Standing, **19:263**
- Stipulated judgment, **8:6**

### CONSENT ORDER AND JUDGMENT

- Generally, **11:28**
- Beyond express terms, **14:28Z**
- Choice of law, **14:28Z**
- Contract law, **4:58; 5:60; 21:64**
- Express terms, beyond, **14:28Z**
- FRCP 60(b)(6), **3:29**
- International Trade Commission, **4:108**
- Interpreted under contract law, **4:58**
- Relitigating patent validity, **5:8**
- Validity, **5:8**
- Written agreement, need for, **3:64**

### CONSISTENCY

- Generally. **Inconsistency** (this index)

### CONSISTENT INTERPRETATION

- Generally, **3:3; 3:119**
- Claim terms to be interpreted consistently, **18:30**

### CONSISTENT TERMS

- Claim interpretation, **3:119**

### “CONSISTING ESSENTIALLY OF”

- Prosecution history disclaimer, **5:94**

### “CONSISTING OF”

- Generally, **1:109**
- Doctrine of equivalents, **3:124**

### CONSISTING OF CLAIM LANGUAGE

- Generally, **13:7**
- Additional elements, presence of, **13:7**
- Amendment, **13:7**
- Presence of additional elements, **13:7**
- Prosecution history estoppel, **13:7**

### CONSOLIDATED PRETRIAL PROCEEDINGS

- Judicial Panel on Multi-District Litigation (JPMDL), **7:6**

### CONSOLIDATION OF CLAIMS

- Appeal, **19:95**

### CONSOLIDATION ORDER

- Sec. 1651, **9:128**

### CONSONANCE

- Generally, **1:80**
- Obviousness-type double patenting, **19:246; 20:29**
- Restriction requirement, **2:140; 16:112**

### CONSTITUTIONALITY

- Decided only when court compelled to do so, **3:209; 8:31**
- IPR, **13:246.50**
- Jurisdiction, **13:191; 18:34**
- Jury trial, **16:8**
- New art, reexamination over, **16:8**
- Patent system, purpose of, **16:8**
- Property, patents are, **16:8**
- Public concern, patent grant is, **16:8**
- Punitive damages, **20:58**
- Reexamination proceeding, **10:16; 16:8**
- Retroactive application of reexamination statutes, **16:8**
- Retroactive elimination of qui tam action under AIA, **2:151; 3:195**
- Sec. 303, **16:8**
- Seventh Amendment** (this index)
- Standing, **13:191**
- Waiver, **3:33**

### CONSTRUCTION AND INTERPRETATION

- As to claims. **Claim Construction and Interpretation** (this index)
- Generally, **1:54; 9:36; 9:132; 12:31; 18:30; 21:19**
- CAFC, **12:47**
- Choice of law, **1:132**
- Claim Construction and Interpretation** (this index)
- Claim interpretation. **Claim Construction and Interpretation** (this index)
- Collateral estoppel, **1:3**
- Consent judgments, **4:58**
- Contract Construction and Interpretation** (this index)
- Design patent, **7:59**
- Entitled to deference, **11:27**
- FRCP generally, **23:34**
- Indefiniteness, **5:58; 8:86**
- Information disclosure statement, **5:31**

**CONSTRUCTION AND INTERPRETATION—Cont'd**

Interference, **7:49; 7:74**  
 Interference estoppel by judgment, **23:14**  
 Inventor's theory, **6:10**  
 Law question, **3:54; 4:31; 9:120; 9:132**  
 Means-plus-function claim, **3:166; 5:110; 9:199; 20:56**  
 Method claims, **9:223**  
 Performance of government contract, **8:8**  
 Reduction to practice, **8:67**  
 Review, standard of, **7:74**  
 Sec. 41(a)(7), **13:32**  
 Sec. 112(6), **22:10**  
 Sec. 120, **9:13**  
 Settlement agreement, **10:9**  
**Statutory Construction and Interpretation** (this index)  
 Summary judgment, **8:17; 21:46**  
 Validity, **19:145**  
 Waiver of sovereign immunity, **10:19**

**CONSTRUCTIVE NOTICE**

Generally, **19:172**

**CONSTRUCTIVE POSSESSION**

Written description, **3:157**

**CONSULTANCY AGREEMENT**

Generally, **1:46**

**CONSULT SOURCES OTHER THAN CLAIMS**

Claim interpretation, **5:30**

**CONSUMER BEHAVIOR**

Market demand, **19:6**

**CONTEMPORANEOUS ACTS AND MATTERS**

Generally, **3:49**  
 Chemical, **9:60**  
 Evidence of level of skill in the art, **9:23**  
 Invention, **19:34**  
 Obviousness issue, **9:12**

**CONTEMPT**

Generally, **5:117; 9:271; 12:3; 16:142; 19:129; 19:342**  
 Appealable decision, create, **3:85; 5:85**  
 Appealable when opportunity to purge has passed, **19:118**

**CONTEMPT—Cont'd**

Civil vs. criminal distinguished, **19:48**  
 Communications protected by attorney-client privilege, refusal to produce, **23:74**  
 Contributory infringement, **16:25**  
 Criminal, civil vs. criminal distinguished, **19:48**  
 Infringement, injunctive relief against infringer is norm, **11:17**  
 Injunction, **1:156; 1:234; 5:119; 11:17; 14:69; 16:25**  
 Modified device, infringement by, **2:119**  
 Motion, two-step procedure on ruling on motion, **11:17**  
 Proof, standard of, **1:73**  
 Reinstatement of license agreement, **16:23**  
 Review, standard of, **3:56**  
 Sec. 271(c), **16:25**  
 Sec. 283, **11:17**  
 Severe remedy, **13:1**  
 Substantial open issues, **1:88**  
 Third persons, conduct of, **20:54**  
 Two-step procedure on ruling on motion, **11:17**

**CONTINUATION**

Generally, **3:114; 7:89; 12:54**  
 Anticipation, **1:127**  
 Description, **20:47**  
 Gorham infringement test, **12:17**  
 Interference, **13:31**  
 License duration, **9:369**  
 Necessary conditions, **9:419**  
 Prosecution history, **13:100**  
 Sec. 112, **18:4**  
 Sec. 120, **20:88**  
 Sec. 1292(a)(1), **23:13**

**CONTINUATION APPLICATION**

Generally, **9:166**  
 Claims adequately described in prior application, **19:105**  
 Design patent, **9:205**  
 Means-plus-function, **4:51**  
 Reexamination inter partes, **3:139; 13:213**

**CONTINUATION-IN-PART APPLICATION (CIP)**

Added matter, newly, **19:28**

## INDEX

### CONTINUATION-IN-PART

#### APPLICATION (CIP)—Cont'd

- Amending claims to read on competitor's product, **19:28**
- Benefit of earlier filing date, **1:80; 20:35**
- Competitor's product, amending claims to read on, **19:28**
- Date, **20:35; 20:59**
- Different filing dates, **20:59**
- Earlier filing date, **5:20; 20:35**
- Filing
  - concession, not concession of inadequate disclosure in parent case, **23:30**
  - MPEP, **16:6**
  - parent case, not concession of inadequate disclosure in, **23:30**
- Filing date, **5:20; 20:35; 20:59**
- Gorham infringement test, **12:17**
- MPEP, **16:6**
- Newly added matter, **19:28**
- Restriction requirement, **16:112**
- Sec. 120, **9:73**

### CONTINUING CONDUCT

- Res judicata, **1:229**

### CONTINUOUS PROCESS

- Inequitable conduct, **10:2**

### CONTOUR IP HOLDING LLC V. GOPRO, INC.

- 2024, **3:253**

### CONTOURS OF CORRESPONDING STRUCTURE IS LAW QUESTION

- Means-plus-function claim, **19:119**

### CONTRACT CONSTRUCTION AND INTERPRETATION

- Generally, **2:65; 9:160; 9:236; 11:28; 13:76**
- Ambiguity, **3:44; 7:43; 9:160**
- Contract law, **13:47; 15:9**
- Ejusdem generis, **20:38**
- Law question, **1:56; 1:57; 3:70; 4:41; 4:42; 8:33; 9:132; 9:145; 9:159; 11:29; 17:5; 23:36**
- License agreement, **15:9**
- Meaning to all parts, **2:65; 13:47; 13:76**
- Review, standard of, **8:41**
- Spirit and purpose, **14:26**

### CONTRACTS AND AGREEMENTS

- Generally, **2:36; 13:64**
- Ambiguities are resolved against contract drafter, **9:132**
- Arbitration agreement, **4:85; 23:91**
- Assignment, **1:46; 4:86**
- Breach accrues, **8:44**
- Choice of law, **19:134; 20:53**
- Companies do not intend to be bound until written agreement is executed, **23:21**
- Consent judgments, **4:58; 5:60; 21:64**
- Damages, **8:43**
- Deference, **9:132**
- Depriving court of jurisdiction, **21:14**
- Elements of contract-based claim, **8:43**
- Enforcement in settlement agreement, **3:107**
- FNERDA, **6:18**
- Formation, **20:44**
- Good faith implied, **12:39**
- Government, **4:59**
- Illegality, **7:36**
- Implicates inequitable conduct, **4:54**
- Implied, **9:482**
- Implied, good faith, **12:39**
- Implied-in-fact contract, **12:38; 20:40**
- Inequitable conduct, implicates, **4:54**
- ITC, **13:20**
- Latent ambiguity, **3:48**
- Lear, **18:8**
- License agreement, **15:9**
- Mistake of fact, **4:34**
- Mutual mistake, **2:44; 4:34**
- On-sale bar, **26:8**
- Patent right clause, **8:8**
- Personal jurisdiction, **13:114**
- Public use, confidentiality agreement, **2:106**
- Qui tam provision, Government and relator, **2:151**
- Res judicata, **4:71**
- Review, standard of, **1:76**
- Settlement agreement, enforcement in, **3:107**
- Standard agreement, **9:252**
- Subject matter jurisdiction, **18:13; 25:1**
- Suit against former employees to obtain title to patent, **1:49**
- Trade secrets, **18:14**

**CONTRACTS AND AGREEMENTS**

—**Cont'd**

Unilateral contract, **23:39**

**CONTRADICTORY**

Assignor estoppel doctrine, **19:47**

**CONTRA PROFERENTUM RULE,  
EXCEPTION TO**

Patent ambiguity, **9:160**

**CONTRARY TO ACCEPTED  
WISDOM**

Generally, **23:11**

**CONTRARY TO PRIOR ART  
TEACHINGS**

Obviousness, **9:31**

**CONTRIBUTION**

Inventorship, **6:50**

**CONTRIBUTORY INFRINGEMENT**

Generally, **2:195; 3:199; 5:10; 8:83;  
16:20; 19:56**

ARO, **13:29**

Claim construction, **5:98**

Contempt, **16:25**

Customer end user as parties at trial, no  
necessity to have, **18:11**

Damages, **20:23**

Direct infringement, need for, **11:36;  
19:100**

Evidence, **18:11**

FRCP 52(a), **7:82**

Implied license, **13:21**

Importance of an element, **1:129**

Inducement, **7:130**

Inducing infringement, **8:24; 9:356**

Inequitable conduct, **1:210**

Noninfringing use, existence, **20:113**

Notice, single use notice, **19:79**

Obviousness, **7:130**

Patent misuse, **8:14**

Process claims, **1:222**

Sec. 271(c), **6:23; 18:79**

Sec. 337, **19:222**

Single use notice, **19:79**

Summary judgment, **3:36**

Utility, **7:130**

**CONTROL**

Direct infringement, “control” by one  
party over entire process, **1:222**

**CONTROL—Cont'd**

System use, infringement by, **3:156**

**CONTROLLING PRECEDENT**

CAFC, **19:18**

**CONTROVERSY**

Declaratory judgment, **6:35; 6:38; 7:38;  
7:55**

**CONVENTIONAL**

**Well-understood, Routine and  
Conventional** (this index)

**CONVERSION**

Proper notice required, **2:41**

**CONVEYANCE**

Damages, **3:56**

**CONVOYED SALES**

Lost profits, **1:174**

Sec. 284, **2:31**

**CO-OWNERS**

Generally, **19:98**

JNOV, **23:4**

Standing, **5:40; 19:221**

**CO-PENDENCY**

Interference, **2:70**

Markush claim rejection, **9:105**

Sec. 2201, **13:41**

Validity, **8:7**

**COPIES**

Generally, **1:87; 19:36**

Anticipation definition, **4:15**

Burden of proof, **2:26**

Costs, **11:51**

Damages, **19:29**

Designing around versus, **18:29**

Infringement, willful, **8:47**

Interference, **3:92; 4:8**

Interpretation thereof, **9:130**

Jepson format, **13:15**

Obviousness, as relevant to, **1:119**

Reissue, **11:5**

Seas and Compco decisions, **7:3**

Silence, **1:48**

Willful infringement, **8:47**

**COPYRIGHT**

Infringement, **16:110**

## INDEX

### **COREPHOTONICS, LTD. V. APPLE INC.**

2023, **3:247**

### **CORPORATE OFFICERS AND DIRECTORS**

Cease and desist order, **6:67**

FRCP 15(c), **6:11**

Sec. 112, **15:2**

### **CORPORATE VEIL, PIERCING**

**Piercing Corporate Veil** (this index)

### **CORPORATION APPEARANCE BY NONLAWYER**

FCR 7(a), **18:15**

### **CORRECTION**

Accrual of claim for correction of  
inventorship, **16:131**

Adding co-inventor, **1:54; 6:79**

Claim construction error, **3:156**

Inventorship, **1:54; 6:35; 6:79; 16:131;  
19:195; 19:218; 20:68**

Obviousness conclusion, **9:15**

Sec. 101, **18:6**

### **CORRESPONDENCE**

Customers as infringement threats, let-  
ters to, **13:41**

Doctrine of equivalents, **5:39**

### **CORRESPONDING FUNCTION**

Means-plus-function claim, **10:36;  
18:48**

### **CORRESPONDING STRUCTURE**

Means-plus-function claim, **1:114; 2:61;  
2:123; 7:70; 11:42; 19:119; 19:238**

Sec. 112(6), **2:123; 14:38; 14:56**

### **CORROBORATING EVIDENCE**

Generally, **3:117**

Conception, **3:160**

Inventorship, **19:132; 21:42**

### **CORROBORATION**

Generally, **12:63; 19:152**

Activities for proof, **2:118**

Anticipation, **14:94**

Claims construed, **9:77**

Conception, **4:74**

Criteria, **23:48**

Evidence, forms of, **2:118; 5:40**

Factors, **20:75**

### **CORROBORATION—Cont'd**

Inurement, **14:83**

Invalidity and noninfringement, declara-  
tory judgment, **20:133**

Inventor's testimony, **8:30**

New interference rules, **8:3**

Non-party inventors, **20:48**

Obviousness, **5:133**

Oral testimony, **10:31**

Physical exhibit, not necessary for, **2:96**

Printed publication, **14:94**

Rule of reason analysis, **9:288; 11:41;  
12:92; 13:72; 19:132**

Sec. 102(g), **20:48**

Sec. 102 in general, **6:40**

Witnesses, **8:30; 10:31; 20:64**

### **COST AWARD**

Generally, **11:58**

28 USC § 1920, **9:342**

### **COST-PLUS-OVERHEAD**

Attorney fees award, **16:24**

### **COST SAVINGS**

Sec. 284, **8:4**

### **COSTS OF ACTION**

**Allowance of Costs** (this index)

Commercial embodiment, comparison  
with, **1:20**

Copies, exemplifications and copies,  
**11:51**

**Cost Award** (this index)

Deposition transcripts, **13:73; 19:45**

Distortion of record, **1:20**

Doctrine of equivalents, **1:20**

E-discovery costs, **3:156**

Exemplifications and copies, **11:51**

Expert witness fees, **19:77**

FRAP 39, **11:24**

FRCP 54(d), **4:32; 15:32**

Inequitable conduct, **1:193**

Infringement, **1:20**

Local rules, **1:260**

**Prevailing Party** (this index)

Process claims, irrelevant with, **1:20**

Sec. 145, **10:16; 14:4**

Sec. 2412(b), **13:48**

Trial and deposition transcripts, **13:73**

### **COUNTERCLAIM**

Choice of law, **22:18**

**COUNTERCLAIM—Cont'd**

Declaratory judgment, **13:46**  
 Immunity, **19:141**  
 Infringement, by licensee, **13:179**  
 Jurisdiction, **4:57; 7:73**  
 Sec. 1631, **19:2**  
 Sec viii statement, **14:63**  
 Substantive merit not basis for refusal to accept, **22:18**  
 Validity, **13:91**  
 Well-pleaded complaint, **2:31**

**COUNTS**

Generally, **3:43; 13:10**  
 Affidavit describing work of third party at reasonably contemporaneous time, **9:23**  
 Broadest reasonable interpretation, **18:56**  
 Interference, **7:49; 7:74; 9:88; 9:141; 9:230; 13:31; 19:151**  
 Interference estoppel, **9:49**  
 Interference estoppel by judgment, **23:14**  
 Law question, **4:31**

**COURT ERROR**

JNOV motion, **6:6**

**COURT FINDINGS**

All claims not addressed, **1:9**

**COURT NOT LIMITED TO REASONABLE ROYALTY FIGURES URGED BY PARTIES**

Generally, **19:53**

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

Arbitration, ultimate arbiter, **18:3**  
 Choice of law, **5:67; 6:51; 7:75; 19:156; 21:44**  
 Controlling precedent, **19:18**  
 Declaratory judgment, **19:22**  
 Disregarding precedent, **1:52**  
 District court, **6:9**  
 Diversity jurisdiction determined at time action filed, **2:11**  
 Effect thereof, **17:2**  
 Evidence, failure to submit, **18:3**  
 Exclusive jurisdiction, **5:8**  
 Factfinder, **18:3**  
 Frivolous appeal, **2:11**

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

**—Cont'd**

General verdict, **18:3**  
 Inter partes reexamination, **18:103**  
 Interpretation of own mandate, **12:47**  
 Interrogatories, **18:3**  
 Judge, **18:3**  
 Jurisdiction  
     generally, **1:69; 2:11; 2:67; 2:69; 2:111; 3:60; 3:73; 5:33; 6:57; 7:70; 8:66; 8:70; 9:213; 11:50; 14:29; 16:45; 16:68; 16:73; 19:95; 19:141; 19:170; 19:175; 20:2; 20:45; 20:82; 21:35; 21:37; 22:14**  
     advisory opinion, **20:2**  
     appealability, **7:8; 10:43; 19:50; 22:2**  
     contempt, **1:263**  
     appeal and review, **7:14**  
     arising under, **10:43; 13:14**  
     equitable estoppel, **13:14**  
     exclusive jurisdiction, **5:8**  
     ex parte tests, **9:63**  
     facts vs. law, **20:2**  
     FDCA, **1:332**  
     interlocutory order, **5:85; 13:219; 22:2**  
     inventor not required to understand, **9:63**  
     ITC, **1:15**  
     lack of, **2:11**  
     law vs. facts, **20:2**  
     mandamus, **9:54; 9:63; 9:292**  
     nonpatent claims, **9:161**  
     notice, **9:63**  
     opinion, advisory, **20:2**  
     reexamination, **7:8**  
     repeal of jurisdictional statute, **6:30**  
     repeal of jurisdictional statute, after, **6:30**  
     Sec. 1651, **9:128**  
     special dispatch, conducted with, **7:8**  
     stipulation, **20:2**  
     threshold question, **23:15**  
     transfer of appeal, **7:14**  
     understand, inventor not required to understand, **9:63**  
     without notice to other party, **9:63**  
 Jury, obviousness question to, **18:3**  
 Late claiming, **18:3**

## INDEX

### **COURT OF APPEALS FOR THE FEDERAL CIRCUIT (CAFC) —Cont'd**

Motion to publish cafc decision, **9:1**  
MPEP, **9:10**  
New ground of rejection, **9:22**  
Obviousness question to jury, **18:3**  
Opinions or findings, **19:42**  
Parties, **21:22**  
Precedent, **22:7**  
Preemption, **21:42**  
Purpose, **9:76**  
Repeal, **6:30**  
Sec. 145 proceeding in district court, **6:9**  
State immunity from suit under Eleventh  
Amendment, **10:11**  
Submit evidence, failure to, **18:3**  
Trial conduct, **18:3**  
Ultimate arbiter, **18:3**

### **COURT OF CLAIMS**

**Claims Court** (this index)

### **COURT OF INTERNATIONAL TRADE STANDARD**

Summary judgment, **20:38**

### **COVENANT NOT TO SUE**

ANDA, **3:132**  
Claim differentiation, **9:411**  
Dismissal, **7:90**  
Jurisdiction, **18:81**  
Statement of nonliability, **19:55**  
Subject matter jurisdiction, **4:95**  
Summary judgment, **1:306; 13:244**

### **COVERED BUSINESS METHOD REVIEW**

Generally, **1:293; 19:297; 19:318;  
19:330; 21:71; 22:51**  
Complimentary to, **21:71**  
Estoppel, **3:202**  
Final judgment, **9:415**  
Incidental to, **21:71**  
Obviousness, **21:72**  
Sec. 101, **1:293; 18:119; 20:154; 21:71**  
Sec. 329, **7:117**  
Statutory definition, **21:71**  
Stay, **2:158; 9:415; 22:48; 22:52**  
Transitional program, **2:168**

### **CREDIBILITY OF EVIDENCE**

**Weight and Credibility of Evidence**  
(this index)

### **CREDITING EXPERT**

Sec. 145, **7:9**

### **CREDIT ONE WHEN CONFLICTING TESTIMONY**

Witness' testimony, **7:47**

### **CRIME FRAUD EXCEPTION**

Attorney-client privilege, **21:58**

### **CRIMINAL CONTEMPT**

Generally, **19:48**

### **CRITICAL CLAIM TERM**

Construction, **13:169**

### **CRITICAL DATE**

Exceptional case, **18:9**

### **CRITICALITY**

ITC, **1:17**  
Obviousness, **9:107**

### **CROPS FROM SECOND GENERATION SEEDS**

Replication of patented technology,  
**13:173**

### **CROSS-APPEAL**

Generally, **2:87; 13:8; 14:53; 18:2; 22:4**  
Conditional, **14:53**  
Different claims in issue, **8:46**  
Equitable estoppel, **18:98**  
JNOV, **22:4**  
Law of the case, **7:28**  
Reverse validity or infringement  
component of judgment  
generally, **18:2**  
adding features, **18:2**  
combination, **18:2**  
doctrine of equivalents, **18:2**  
fact question, **18:2**  
jury instruction error, **9:317**  
liability not avoided, **18:2**  
means-plus-function claim, **18:2**  
old combination rejection, **18:2**  
rejection, **18:2**  
secondary considerations must be  
considered, **18:2**

**CROSS-EXAMINATION**

Administrative law, **4:38**  
Collateral estoppel, **13:53**

**CROSS MOTIONS**

Noninfringement, **1:66**  
Summary judgment, **2:36**

**CROSS-READING**

Design patent, **19:8**

**CROWDED ART**

Claim interpretation, **20:8**

**CROWN PACKAGING**

**TECHNOLOGY, INC. V. BELVAC  
PRODUCTION MACHINERY,  
INC.**

2024, **3:254**

**CULPABILITY**

Intent to mislead, **20:35**

**CULPABLE INTENT**

Inequitable conduct, **5:16; 15:34;  
16:32; 20:25**

**CUMULATIVE PRIOR ART**

Inequitable conduct, **7:1**

**CUMULATIVE REFERENCE**

Generally, **5:16; 18:40**  
Inequitable conduct, **19:51**  
Materiality, **19:59**  
Prior art, **12:61**

**CURE**

Damages, **1:20**

**CUSTOM**

Mandamus, **9:57**

**CUSTOMER**

Contributory vs. direct infringement,  
**18:11**  
Patent license, **12:14**  
Statutory notice under Sec. 287(b)(5),  
**13:41**  
Use of system, infringement, **3:156**

**CYNTEC COMPANY, LTD. V.  
CHILISIN ELECTRONICS CORP.**

2023, **3:248**

**CYTIVA BIOPROCESS R&D AB V.  
JSR CORP.**

2024, **3:255**

**CYWEE GROUP LTD. V. GOOGLE  
LLC**

2023, **3:249**

**CYWEE GROUP LTD. V. ZTE (USA),  
INC.**

2024, **3:256**

**DAMAGES**

Generally, **1:152; 1:350; 1:373; 11:88;  
18:62; 19:38; 20:157; 21:44;  
22:65**

Accounting, **1:20; 1:38**

Accounting phase, **11:15**

Adequate to compensate for infringe-  
ment, **16:40**

Amended complaint, **1:350**

Anticipation, **5:138**

Appeal and review, **1:20; 6:12; 18:35;  
19:96; 20:39; 21:23**

Apportionment, **13:224; 15:61**

Assembly of completed machine after  
patent term, **16:5**

Assignor estoppel doctrine, **19:47**

Bad faith, **20:19**

Breach of contract limited to those rea-  
sonably foreseeable, **8:43**

Civil contempt, **7:11**

Compensation, adequate, **16:40**

Compound interest, **4:24**

Conflicting expert testimony, **1:20**

Contributory infringement, **20:23**

Conveyed sales vs. derivative sales,  
**3:56**

Copying, **19:29**

Cure trial mistakes, cannot find facts de  
novo or, **1:20**

Delay, **23:27**

Derivative sales, conveyed sales vs.,  
**3:56**

Design, **20:15**

Design patent, **1:275; 3:98**

Discretion of court, **7:15; 13:45**

District court, affirm on grounds not  
relied upon by, **2:15**

Divided infringement, **1:270; 1:271**

Double recovery, **1:148**

Doubts resolved against infringer, **19:92**

Dual-sided subject, **12:24**

Egregiousness of defendant's conduct,  
**5:54**

## INDEX

### DAMAGES—Cont'd

Enhanced damages during appeal,  
**9:125; 19:289**  
Equitable defense, **2:19**  
Exceptional case, **3:180**  
Expert testimony, **12:88; 22:43**  
Fact question, **6:26; 15:10; 21:18**  
Fact question with underlying  
discretionary decisions, **13:45**  
Foreign countries, invention not sold in  
US, **20:23**  
Foreseeability, **7:63; 13:79**  
FRCP 52(a), **1:18; 19:4**  
FRCP 60(b), **1:20**  
Good faith challenge, **16:5**  
Harm to reputation, **18:32**  
Hypothetical negotiation, **1:296; 12:97**  
Inadequacy of money damages, **14:9**  
Inducement, **5:138; 9:410**  
Infringement, **5:121; 13:146; 13:224;**  
**16:40; 19:92; 22:35**  
Injunction, **1:20; 1:262**  
Invalidity, **3:180**  
Issue preclusion, **4:9**  
JNOV, **23:4**  
Jury, **1:16; 1:199; 2:80; 23:73**  
Laches, **2:19; 3:180**  
Law of the case, **20:23**  
Lear, **18:8**  
Lost profits, **1:20; 1:59; 2:19; 2:40;**  
**3:8; 7:15; 7:63; 13:157; 16:5;**  
**18:2; 19:52; 20:23; 23:3; 23:82**  
Lump sum royalty payment, **9:235**  
Machine, assembly of completed  
machine after patent term, **16:5**  
Mandamus, **9:76**  
Mandate, **18:105**  
Marking, **4:89; 14:24; 18:2**  
Master, special master, **20:19**  
Maximum recovery rule, **19:137**  
Method, notice required for, **19:154**  
Methodology, **1:105; 11:10; 12:90;**  
**13:75**  
Modified item, **1:20**  
Multi-component products, **22:47**  
Negotiations, hypothetical, **1:296;**  
**2:189; 20:23**  
Notice, **7:66; 19:154**  
Obviousness, **19:228**  
Opinion of counsel, **1:20**

### DAMAGES—Cont'd

Other damages, **23:73**  
Panduit, **16:40; 19:56**  
Payment, lump sum royalty, **9:235**  
Pre-issuance damages with no actual  
notice of patent, **18:113**  
Prejudgment interest, **2:15; 7:15; 16:5;**  
**18:2**  
Prejudice, **8:50**  
Price erosion, **22:26**  
Prior judgment, **20:23**  
Process, notice required for method or  
process, **19:154**  
Punishment, not, **1:20**  
Punitive damages, **9:161; 18:14**  
Question of fact, **3:96; 5:71**  
Reasonable royalty  
generally, **8:20; 13:146; 16:163;**  
**19:16; 23:25**  
ANDA, **1:280**  
apportionment, **14:5**  
floor on damages, **18:35**  
future lost sales, **6:74**  
hypothetical negotiation, **1:296;**  
**12:90; 16:129**  
redetermination, **18:86**  
30 percent, **20:19**  
willfulness, **21:57**  
Reasonably foreseeable, **13:79**  
Reexamination, **12:50**  
Remand, **18:105**  
Requirement, **20:19**  
Reversal of award, **5:102**  
Royalty, lump sum royalty payment,  
**9:235**  
Royalty, reasonable royalty, **8:20**  
Sale, **3:180**  
Sears, **21:11**  
Sec. 101, **6:97**  
Sec. 271(a), **1:270; 3:180; 8:138**  
Sec. 271(f), **23:82**  
Sec. 289, **14:77; 19:293**  
Sec. 102(e), **19:41**  
Sec. 112, **8:7; 19:7**  
Sec. 271(c), **20:23**  
Sec. 284  
generally, **2:31; 4:6; 4:7; 8:4; 11:21;**  
**12:4; 19:29; 19:35; 19:53;**  
**20:23**  
enhanced damages, **2:30; 9:323**

**DAMAGES—Cont'd**

- Sec. 284—Cont'd
  - nominal damages, **12:24**
  - precision, not ascertainable with, **2:30**
- Sec. 286, **1:47**
- Sec. 287, **4:12**
- Sec. 1498, **13:35**
- Simple v. compound interest, **4:24**
- Special master, **20:19**
- Standard essential patents, **3:186**
- Standing, **23:82**
- State law punitive damages, **9:161**
- Testimonial evidence alone, **7:11**
- 30 percent reasonable royalty, **20:19**
- Two-step analysis, **10:21**
- Two-step process, **13:101**
- Unpatented accessory sales part of damages base, **11:21**
- Validity, **12:45**
- Willful infringement
  - generally, **1:20; 2:19; 2:148; 13:145; 16:5; 18:2; 19:29**
  - determination, **18:2**
  - increased damages, **9:323; 11:10; 15:14**
  - reasonable royalty, **21:57**

**DANN AMENDMENT**

- Appeals from judgments, **19:30**
- Defect reissue, **19:30**
- Opinions, **19:30**
- Reissue, **9:47; 19:30**

**DATE**

- Time and Timeliness** (this index)

**DDR HOLDINGS, LLC V.****PRICELINE.COM LLC**

- 2024, **4:134**

**DEAD INVENTOR'S VIDEOTAPE DEPOSITION**

- FRE 403, **13:4**

**DECEPTION**

- Intent to Deceive** (this index)

**DECLARATION**

- Affidavit, **9:177**
- Foreign, **19:118**
- Inequitable conduct, **9:378; 13:129**

**DECLARATORY JUDGMENTS**

- Generally, **1:243; 5:74; 16:103**

**DECLARATORY JUDGMENTS****—Cont'd**

- Actual controversy
  - generally, **1:94; 2:122; 3:69; 4:103; 6:35; 6:38; 7:38; 7:55; 8:66; 9:324; 15:24; 19:250; 23:22**
  - infringement, **20:26**
  - patented transgenic seeds, **15:44**
- Advisory opinion, **9:92**
- “All the circumstances,” **13:155**
- ANDA disputes, **10:39**
- Appeal and review, **9:233; 19:86**
- Appropriateness, **9:92**
- Burden of proof, **13:179; 13:194**
- CAFC, **19:22**
- CAPC, **3:132**
- Case or controversy requirement, **1:319; 19:86; 20:111**
- Collateral estoppel, **10:6**
- Combination invention, **10:6**
- Discretion of court, dismissal is within, **5:24; 19:198**
- Dismissal, **5:24; 19:81**
- District court follows CAFC patent law, **19:22**
- Escrow, **3:21**
- Exceptional case, **1:159**
- First to file, **3:226; 6:89**
- Immediacy requirement, **3:134; 13:177; 19:250**
- Inducement, **1:319**
- Infringement, **13:194; 19:81; 19:101**
- Inventorship, **12:86**
- Jurisdiction, **1:27; 2:122; 8:109; 13:194; 19:192; 23:9**
- Justiciable controversy, **19:61**
- Justifiable controversy, **2:42**
- Law question, **19:265**
- Licenses
  - generally, **13:133**
  - license agreement, **7:79; 13:143; 19:192**
  - licensee, **13:132**
- Limitations in specification, **10:6**
- Notice of infringement, **19:101**
- Opinion, advisory, **9:92**
- Patented transgenic seeds, actual controversy, **15:44**
- Pendent jurisdiction, **23:9**
- Personal jurisdiction, **1:374**

## INDEX

### DECLARATORY JUDGMENTS

#### —Cont'd

Redundant judgment to patentee's suit, **13:46**  
Regional circuit law, **19:22**  
Registration, trademark, **23:9**  
Requirements, **4:40; 16:42**  
Reversal of court ruling, **9:92**  
Sec. 2201, **7:25; 9:89; 9:92; 10:6; 12:23; 13:41; 19:22; 19:55; 23:9**  
Sovereign immunity, **7:25**  
Specification, limitations in, **10:6**  
Standing, **16:113**  
Subject matter jurisdiction, **1:297; 1:301; 8:109; 16:130; 19:250**  
Summary judgment, **7:7**  
Synergism, **10:6**  
Trademark registration, **23:9**  
Unasserted claims, **19:236**  
Validity, **1:312**

### DECREES

See index topics **Judgments; Orders**  
(this index)

### DEDICATION TO PUBLIC

Claim interpretation, **16:88**  
Doctrine of equivalents, disclosure-  
dedication, **19:233**  
Unclaimed subject matter, intent, **20:74**

### DEFAULT JUDGMENT

Dismissal, **20:7**  
FRCP 60(b), **9:144**  
Interference, **1:60**

### DEFAULT PROOF

Generally, **4:76**

### DEFECTS

Dann Amendment, **19:30**  
FRCP 12(b)(7), **21:56**  
Sec. 251, **7:21**

### DEFENSES

Anticipation, **18:20**  
Assignor estoppel doctrine, **19:47; 19:241**  
Burden of proof, **9:118; 19:48**  
Clearly erroneous standard, **19:23**  
Collateral estoppel, **4:3**  
Exhaustion of patent rights, **5:93**  
Factual overlap of issues, **23:24**

### DEFENSES—Cont'd

Implied license, **1:100**  
Inconsistent jury findings, **2:10**  
Infringement, **5:60**  
Inherent element of every government  
contract, **8:41**  
Interrelationship of issues, **20:5**  
Invalidity, **1:177**  
Jury trial, **20:55**  
Jury verdict, **3:75**  
Laches, **8:114**  
Licensee agreement, **18:58**  
Obviousness, **16:4**  
Patent misuse, **23:9**  
Repair, **4:1**  
Sec. 282, **16:50**  
Sec. 1631, **19:2**  
Sovereign acts, **15:8**  
Waiver, **9:159**  
Willfulness, **3:96**

### DEFERENCE

Agency's interpretation of contract,  
**9:132**  
Agency's interpretation of own regula-  
tions, **11:27**  
Certificate of correction, **10:44**  
Choice of law, **2:31**  
Claim differentiation, **11:2**  
Indefiniteness, **21:44**  
Inventorship, **21:42**  
ITC, **5:37**  
Patent term extension, **8:25**  
Sec. 41(a)(7), **13:32**  
Special master's decision, **13:24**  
Statutory construction  
generally, **2:51; 4:30; 11:39; 14:17; 14:22; 19:74; 19:82**  
chevron deference, **6:31; 26:3**  
ITO agency, **23:31**  
own statute, **11:30**  
permissible construction, **12:34**  
silent or ambiguous statute, **6:24**  
Timing of agency's decision making,  
**20:88**

### DEFINITENESS

**Certainty and Definiteness** (this index)

### DEFINITE STRUCTURE

Means-plus-function claim, **6:36**

**DEFINITIONS**

- Abuse of discretion, **8:9**
- Appeal, **4:67; 10:19**
- Best mode, **14:30**
- Certainty and definiteness, failure to define term, **2:105**
- Claim interpretation, **8:99**
- Clearly erroneous standard, **4:41**
- Competitive decision making, **4:94**
- “Comprising,” **19:158**
- Conception, **2:126; 4:100**
- Extrinsic evidence rarely probative of special definition, **14:30**
- Machine, **9:290**
- Manufacture, **9:290**
- Markush claim, **13:218**
- Mathematical algorithm, **9:42**
- Multiple definitions of phrase, **7:28**
- Multiple dictionary definitions, **9:253**
- Ordinary skill, hypothetical person for, **19:26**
- Original application, **3:139**
- Precise proportions, **8:74**
- Preponderance of the evidence, **4:33**
- Procedure, **16:3**
- Process, **9:20; 18:85**
- Prosecution history defining claim terms, **19:84**
- Relationship, **9:34**
- Substantial evidence, **2:37; 3:23; 4:33; 6:31; 6:32; 7:43; 7:44; 8:31; 9:231; 10:31; 13:68; 20:22**
- Summary judgment, **20:10**
- Trade secret, **12:27**
- Undefined terms given their ordinarily understood meaning, **8:61**

**DELAY**

- Laches or Delay** (this index)

**DELISTING**

- Federal Food, Drug and Cosmetic Act, **1:120**

**DELIVERY**

- Judicial notice, **11:24**

**DEMAND**

- Entire market value rule, **20:50**
- Sanctions, **17:2**

**DEMEANING**

- Reprehensible conduct, **9:159**

**DEMONSTRATION**

- Infringement, **13:53**

**DE NOVO REVIEW**

- Generally, **3:53**
- Attorney fee ruling, **3:171**
- Evidence, **11:32**
- Explained, **12:43**
- Prima facie obviousness, **2:133**
- Sec. 102(b), **9:7**
- Sec. 145, **14:4**
- Sec. 252, **19:4**
- Standard of review, **11:19**
- Standing, **7:39**

**DEPENDENT CLAIMS**

- Generally, **12:28**
- Burden of persuasion and quantum of proof, **18:7**
- Claim differentiation, **5:60; 9:237**
- Claim interpretation, **15:31; 23:43**
- Dependent claim tail cannot wag independent claim dog, **14:12**
- Design patent, **19:8**
- Doctrine of equivalents, **5:6; 18:65**
- Independent claims, generally, **9:100; 9:123**
- Infringement, **10:26; 13:100; 13:147; 23:17; 23:35**
- Obviousness, **9:24; 16:4; 18:23; 19:245**
- Prosecution history estoppel, **8:105**
- Reissue, **9:336**
- Sec. 1.192(c), **9:154**
- Summary judgment, **2:29**
- Validity, **8:7; 9:345**

**DEPOSIT**

- Best mode, **1:44; 19:51**
- Microbiology field, **9:53**
- Recombinant DNA technology, **19:121**

**DEPOSITION**

- Allowance of costs, **19:45**
- Appeal, introduction on, **13:183**
- Costs, **13:73**
- Declaration in conflict with prior deposition testimony, **19:62**
- Discovery, **23:5**
- FRE 403, **13:4**
- Inter partes reexamination, **1:232**
- Inter partes review, **1:338**

## INDEX

### DERIVATION OF INVENTION

Another, **12:122**  
Claim preamble, **5:65**  
Damages, **3:56**  
Interference, **4:11**  
Inurement versus, **3:82**  
Law questions, **16:36**  
Obviousness, **3:204**  
Sec. 102(f), **14:10**  
Two prong test, **7:46**

### DESCRIPTION

Generally, **16:80**  
Biological deposits, **5:69**  
Collateral estoppel, **1:249**  
Continuation, **20:47**  
Continuation application, **19:105**  
Design patent, **9:205**  
DNA, **1:131; 2:143**  
Drawings constitute an adequate description, **3:101**  
Enablement, **21:9**  
Enablement vs. description requirement, **22:7**  
Fact question, **1:118; 9:177**  
Failure to meet requirements for written description, **21:67**  
Genus claim, **2:143; 2:144**  
Haec verba, not, **3:103**  
Inherency, **5:56**  
Limitations, **12:50**  
MPEP, **16:8**  
Obvious for continuation, patent only renders, **20:47**  
Obviousness, **6:99**  
Possession, **13:124**  
Precision, reasonable precision, **6:33**  
Primarily factual, **21:33**  
Reasonable precision, **6:33**  
Sec. 112, **9:85; 18:40; 20:6**  
Secondary considerations, **6:99**  
Written description  
    generally, **3:210; 5:75; 9:488; 11:57; 12:73; 13:126; 14:42; 14:97; 18:120; 19:178; 19:283; 20:118; 20:123; 20:146**  
    abuse of discretion, **3:197; 9:318**  
    adequacy of disclosure, **1:185**  
    amino acid sequence, **3:133; 9:264; 9:306**  
    bacteria, **1:330; 3:114**

### DESCRIPTION—Cont'd

Written description—Cont'd  
    certificate of correction, **3:187**  
    claim construction, **1:215; 6:93; 19:283; 22:49**  
    claim differentiation, **6:93**  
    constructive possession, **3:157**  
    design patent, **9:376**  
    disclosure, **16:133; 17:11**  
    DNA, **2:143; 3:116**  
    doctrine of equivalents, **1:164**  
    enablement, **1:304; 9:476; 14:101; 22:49**  
    enablement requirement vs., **19:236; 21:46; 21:47**  
    fact question, **6:20; 7:112; 9:373; 21:14**  
    failure to meet requirements, **21:67**  
    features, **19:254**  
    genus claim, **2:143; 2:144**  
    genus when only disclose species, **2:107**  
    induced infringement, **22:59**  
    infringement, **9:453**  
    inherent capabilities, **13:53**  
    in haec verba, **12:54; 16:65**  
    injunction, **1:304**  
    injunctions, **22:59**  
    interference, **1:182; 2:172; 7:123; 11:65; 18:88**  
    inter partes review, **11:80**  
    jurisdiction, **22:59**  
    jury taint, **1:215**  
    lack of written description, **11:62; 19:249**  
    means-plus-function, **1:262**  
    negative limitations, **9:412**  
    obviousness, **14:101**  
    ordinary and accustomed meaning, **18:46**  
    priority filing date, **4:117; 19:120**  
    provisional application, **14:36**  
    public availability, **3:144**  
    recapture rule, **3:187**  
    reissue, **9:479**  
    Sec. 112, **1:188; 1:252; 1:258; 1:304; 8:101; 9:46; 18:4; 25:11**  
    Sec. 112(1), **1:200; 2:144; 9:125; 9:130; 19:254; 22:7; 23:25**  
    species, need not describe all, **3:106**  
    sufficiency, **1:185**

**DESCRIPTION—Cont'd**

Written description—Cont'd  
summary judgment, written description and enablement requirement, **2:144; 21:46**

**DESIGN**

See also **Design Patent** (this index)  
Combined references showing only components not overall appearance of, **9:137**  
Damages, **20:15**  
Double patenting, **3:4**  
Inequitable conduct, **6:4**  
Injunction against use, purpose of, **20:15**  
Modification, **20:15**  
Same, Sec. 171, **9:73**  
Sec. 171, **9:73; 9:106**

**DESIGNER OF ORDINARY SKILL**

Obviousness, **12:32**

**DESIGNING AROUND PATENT**

Generally, **4:35; 8:47**  
Claim interpretation, **3:7**  
Copying, versus, **18:29**  
Sec. 102(g), **11:9**  
Subject matter jurisdiction, **25:1**  
Willful infringement, **19:52**

**DESIGN IN PUBLIC DOMAIN**

Jurisdiction, **12:48**

**DESIGN PATENT**

Generally, **2:112; 3:208; 3:218; 8:157; 9:464; 12:118; 16:101; 19:333; 19:341**  
Anticipation, **3:216; 4:64; 8:62; 9:325; 9:500**  
Appeal and review, **19:8; 21:4**  
Attorneys' fees, **19:8; 21:4**  
Best mode requirement, **18:1**  
Case, **1:73**  
Chutzpah, **19:8**  
Claim language, **7:59**  
Construe claim language, **7:59**  
Continuing application, **9:205**  
Cross-reading, **19:8**  
Damages, **1:275; 3:98**  
Dependent vs. independent claims, **19:8**  
Description, **9:205**  
Double patenting, **19:8**  
Drawings, **9:137**

**DESIGN PATENT—Cont'd**

Estoppel, **1:318**  
Evidence, validity for each claim, **19:8**  
Exhibits superior characteristics over single predecessor device, **18:63**  
Experimental use, **3:81**  
FRAP 38, **19:8**  
Functional elements, **18:29**  
Functionality, **1:151; 12:32**  
Functional vs. non-functional aspects, **5:21**  
Genuine issue, **16:17**  
Gorham test, **2:33; 12:29; 15:5; 16:33; 19:8**  
Improper to use reference's drawing to negate patentability, **9:137**  
Indefiniteness, **1:275; 5:126**  
Inequitable conduct, **7:59; 16:1**  
Infringement  
generally, **3:98; 3:100; 8:126; 15:11; 19:85; 21:4**  
elements, **1:165**  
Gorham test, **15:5; 19:8**  
ordinary observer test, **1:151; 1:165; 5:89; 9:321; 18:96**  
patentability distinguished, **11:25**  
tests, **1:165; 5:89; 12:8**  
Inventor, **8:81**  
Issued as division of earlier utility application may be entitled to latter's priority date, **18:1**  
Materiality, **16:1**  
Obviousness, **1:226; 3:227.50; 8:128; 9:120; 9:135; 9:178; 9:227; 12:17; 13:198; 16:17**  
Ordinary designer standard, **4:48**  
Ordinary observer test, **1:151; 1:165; 5:89; 6:88; 9:321; 18:96**  
Ornamentality requirement, **1:151; 2:58; 8:62; 8:128; 18:87**  
Overall design standard, **18:96**  
Overall similarity compared, **2:63**  
Patentability, **9:137; 11:25**  
Points of novelty, **2:106; 9:325**  
Preliminary injunction, **1:226; 3:34; 20:93**  
Presumption not augmented by previous validity holding, **19:8**  
Primarily functional, **16:21**  
Priority claim, **9:376**

## INDEX

### DESIGN PATENT—Cont'd

- Profits and Sec. 284, not receive both, **3:98**
- Prosecution history estoppel, **16:139**
- Reference, improper to use reference's drawing to negate patentability, **9:137**
- Scope, **9:55**
- Sec. 102(b), **20:32**
- Sec. 103, **9:8**
- Sec. 284 and profits, not receive both, **3:98**
- Sec. 1337 industry requirement, **3:154**
- Stipulated judgment of noninfringement, **19:288**
- Summary judgment, **1:35; 16:17**
- Supervisory authority, **16:17**
- Two-part test, **21:28**
- Utility patent, **1:356**
- Validity, **19:8**
- Visible, not required to be, **19:118**
- Written description sufficiency, **9:376**

### DESIRABILITY

- Obviousness** (this index)

### DESTROY

- Presumption of validity, **13:81**

### DESTRUCTION OF DOCUMENTS

- Evidence, **5:1**

### DETAIL

- Sec. 112, **19:7**

### DEVICES

- Claim interpretation. **Claim Construction and Interpretation** (this index)
- Claim preclusion, **8:76**
- Doctrine of equivalents, **7:40**
- Equivalent device, not necessarily, **11:22**
- Infringement, **8:46**
- MPEP, **16:6**
- Obviousness, **20:72**
- Refining, **13:8**
- Sec. 103 rejection on single reference device capable of being operated like claimed apparatus, **9:101**
- Suggestion or motivation to modify, must be, **9:101**

### DEVOID

- Generally, **13:98**

### DEXCOM, INC. V. ABBOTT DIABETES CARE, INC.

- 2024, **4:135**

### DICKENS

- Bleak House, **19:83**

### DICTA

- Generally, **11:37**

### DICTIONARY

- Generally, **4:67; 22:19**
- Claim interpretation
  - generally, **7:79; 9:269; 16:85; 16:94**
  - definitions, **1:90; 13:151**
  - intrinsic record trumps dictionary, **11:53; 19:196**
  - less useful than patent itself, **20:51**
  - multiple dictionary definitions, **9:253**
  - not always customary meaning, **6:51**
  - sole use improper, **3:105**
- Extrinsic evidence, **22:19**
- Technical terms, use technical dictionary for, **1:109**

### DIFFERENTIATION

- Claim Differentiation** (this index)

### DILIGENCE

- Generally, **2:118; 11:82; 13:103**
- Experiment, laboratory, **19:144**
- Laboratory experimentation, **19:144**
- Reasonable, **13:105**
- Sec. 102(g), **14:7; 16:148**

### DIMENSIONS

- Jury verdict, **19:5**

### DIRECT APPEAL

- District court, **6:9**

### DIRECTED TO FACTS

- Interrogatories, **23:7**

### DIRECTED VERDICT

- Generally, **5:22**
- FRCP 50(a), **2:31**
- JNOV, **22:4**
- JNOV motion, **4:32**
- Jury instructions, **10:4**
- Renewal, **14:1**
- Review, standard of, **1:46; 1:71**
- Sufficiently specific, when, **23:17**
- Summary judgment, **10:4**
- Waiver, **10:15**

**DIRECTED VERDICT—Cont'd**

Willful infringement, **16:22**

**DIRECT EVIDENCE**

Generally, **13:28**

Disclosure, duty of, **12:52**

Inducement, **2:130**

**DIRECT INFRINGEMENT**

Generally, **5:63**

ARO, **13:29**

Claim construction, **12:108**

Contributory infringement, **11:36; 19:56**

Contributory requires direct infringement, **16:20**

“Control” or “direction” by one party over entire process, **1:222**

Customer end user as parties at trial, no necessity to have, **18:11**

Divided, **12:108**

Evidence, **18:11**

If none, then no contributory or induced infringement, **5:10**

Implied license, **13:21**

Inducing infringement, **5:63; 5:102; 12:104**

Intent not required, **9:118**

Joint infringement, party in control, **2:124**

Method claims, performance of all steps, **1:222; 5:121; 12:108**

Single direct infringer requirement, **1:222**

Single entity performing all steps, **1:242**

**DIRECTORY STATUTES**

Statutory construction, **5:17**

**DISAVOWAL OF CLAIM SCOPE**

Claim construction and interpretation, **3:140; 5:97; 15:47; 16:143; 16:151; 20:112; 20:148; 21:70**

**DISBELIEF BY EXPERTS**

Generally, **5:5**

**DISCHARGE OF CLAIM**

Accord and satisfaction, **3:48**

**DISCLAIMERS**

Disavowal of claim, **3:137; 21:70**

Doctrine of prosecution disclaimer, **3:137**

Double patenting, **15:6**

**DISCLAIMERS—Cont'd**

Fundamental precept in claim construction, **1:309; 15:21; 20:138**

Interference, **7:45**

Inter partes review, **1:326; 1:327**

Patent marking, **18:118**

Patent term extension, **13:144**

Prior art, **19:216**

Prosecution history, **1:298; 2:155; 4:84; 13:209; 19:169; 19:193; 20:157.70; 22:35**

Prosecution history estoppel, **19:153**

Purpose, **9:110**

Recapture, **8:96**

Reissue, **22:15**

Rejection, **17:2**

28 USC § 1295, **1:327**

**DISCLOSURE**

Analogous art, **9:78**

ANDA, **2:81**

Best mode, **7:37; 7:47; 9:357; 23:72**

Chemical compound, **9:148**

Chemical genus, **9:126**

Claim-supporting vs. claim-anticipating, **22:7**

Computer, **9:154**

Conception, **3:160**

**Doctrine of Equivalents** (this index)

Double patenting, **9:45; 9:307**

Duty of, **9:43; 12:52; 14:19; 20:76**

Enablement, **1:102; 1:167; 10:23**

Exceptional case, **18:9**

Expert testimony, **3:141; 13:183**

Filing of CIP, **23:30**

FRCP 26, **3:141**

FRCP 52(a), **12:6**

Generic, **19:201**

Inequitable conduct, **3:98; 6:13; 19:128**

Infringement, **9:4**

Inherent, **25:12**

Intent to mislead, **8:51**

Interference, **7:13**

Inventor's admission of invention by another, **1:8**

ITC domestic disclosure communication, **1:224**

Later reference, discredited by, **9:117**

Means-plus-function, **2:134; 4:17**

MPEP, **16:6**

Obviousness, **9:107; 16:4; 19:243**

## INDEX

### DISCLOSURE—Cont'd

- Obviousness-type double patenting, **19:226**
- Original claims, **14:8**
- Patent prosecution bar, **4:94; 5:110**
- Preemption, **21:30**
- Prior art, **4:84; 7:68; 13:18**
- Production specification, **5:16**
- References, **15:28; 15:33**
- Relative terms in claims given broadest reasonable interpretation during prosecution, **9:36**
- Rule 26(a) expert testimony disclosure, **13:183**
- Sec. 1.56, **8:29**
- Sec. 10.57(b), **13:69**
- Sec. 102(b), **9:18**
- Sec. 102(e), **9:28**
- Sec. 112, **2:123; 13:10; 16:10**
- Sec. 145, **7:9**
- Sec. 282, statutory outer limits, **23:76**
- Specification need not disclose what is well known, **9:113**
- Standard of review, disclosure dedication, **20:74**
- Standard setting organizations, **17:9**
- Substitute, must be obvious, **9:29**
- Sufficiency of
  - corresponding structure, **2:123**
  - enablement, **1:102**
  - good faith explanation of failure to disclosure, **6:80**
  - interference, **3:25**
  - Sec. 112(1), **23:30**
  - Sec. 120, **11:8**
  - some claims but not all, **22:7**
- Trade name information as failure to comply with best mode requirement, **20:33**
- Written description, **1:185**

### DISCOVERY

- Abuse of Discovery** (this index)
- ADR proceeding, documents pertaining to ADR proceeding, **8:37**
- Ancillary proceeding, **13:37**
- Anticipation, discovery of properties, **9:257**
- Appealability, **8:9**
- Choice of law, **1:19; 19:114; 20:17**
- Confidential information, **1:10; 19:17**

### DISCOVERY—Cont'd

- Documents pertaining to ADR proceeding, **8:37**
- E-discovery costs, **3:156**
- Enhanced damages, **21:3**
- Examiner's deposition, **23:5**
- Exceptional case discovery, **4:83**
- Foreign countries, **3:65**
- FRCP 26, **23:76**
- FRCP 37(b), **23:34**
- FRCP 45, **11:24**
- FRCP 56(f), **13:154**
- Interference estoppel by judgment, **23:14**
- Monetary sanctions, **13:6**
- New property or new use cannot impart patentability to known composition, **9:129**
- New property or use of known composition, **9:104**
- New trial, **22:26**
- Nonparty's motion to quash discovery subpoena, **20:17**
- Old composition, **20:11**
- Prosecution disclaimer, **3:137**
- Protective order, **13:40**
- Record of invention, **9:221**
- Review, standard of, **11:7**
- Sanctions, **2:27; 18:94**
- Summary judgment, **1:35**

### DISCOVERY ORDER

- Appealability, **17:3**
- Choice of law, **4:47**
- Mandamus review, **9:362; 9:430**

### DISCOVERY SANCTIONS

- FRCP 37(b), **20:4**
- Respond, failure to, **13:25**

### DISCRETION

- Abuse of Discretion** (this index)
- Court's. **Discretion of Court** (this index)
- Damages, **13:45**
- Difficulty of showing, **19:57**
- Injunctive relief, **10:23**

### DISCRETIONARY

- Enhanced damages award, **15:14**
- Injunction, **15:14**
- 28 USC § 1292(b), **14:40**

**DISCRETIONARY AGENCY  
DECISION**

Standard of review, **4:38**

**DISCRETIONARY AUTHORITY**

Review of EIC, standard of, **7:23**

**DISCRETIONARY EXERCISE**

Mandamus, **6:19; 9:430**

**DISCRETION OF COMMISSIONER**

Interference, **2:67**

**DISCRETION OF COURT**

Conditional new trial, **13:34**  
 Damages, **7:15**  
 Declaratory judgment, **5:24; 19:198**  
 Evidence, **3:57**  
 FRE 403, **7:5**  
 Inequitable conduct, **7:33; 13:38; 13:45**  
 JMOL, **26:9**  
 Laches, **14:11**  
 Pendent jurisdiction, **11:20**  
 Preliminary injunction, **2:60; 6:21; 8:81; 12:29; 23:20**  
 Review, standard of, **7:72**  
 Rule 60(b), **12:100**  
 Sec. 252, **19:4**  
 Sec. 283, **18:18**  
 Summary judgment, **7:7**  
 Supplemental jurisdiction, **7:39**  
 Trial management, **20:25**

**DISCRETION TO APPLY**

Doctrine of equivalents, **13:80**

**DISEASE TREATMENT METHODS**

Bacterial species, **18:109**  
 Cells, **18:109**  
 DNA (this index)  
**Recombinant DNA** (this index)

**DISMISSAL**

Generally, **8:95**  
 Abuse of discretion, **22:2**  
 Accessibility to public, **3:19**  
 Admission of prior art in specification, **3:19**  
 Anticipation, **3:19**  
 Appealable final order, **1:39**  
 Choice of law, **8:82**  
 Claims court, **20:27**

**DISMISSAL—Cont'd**

Complaint dismissed for mootness in view of settlement of controversy, **19:14**  
 Covenant not to sue, **7:90**  
 Declaratory judgment, **5:24; 19:81**  
 Default judgment, **20:7**  
 Factual allegations taken as true, **12:46**  
 Failure to state claim, **3:19; 4:121; 7:36; 10:42; 20:44**  
 Federal, **22:5**  
 Final decision, **8:82**  
 Final judgment, **16:62**  
 FRCP 12(b)(6), **1:42; 1:248; 3:147; 7:90; 8:102; 12:112; 19:237; 23:29**  
 FRCP 12(b)(7), **21:54**  
 FRCP 19(a), **22:8**  
 FRCP 37, **18:24**  
 FRCP 37(b), **23:34**  
 Harsh remedy, **7:52**  
 ITC, **25:2**  
 Joint motion, **20:95**  
 Jurisdiction  
     all patent claims dismissed, **3:112**  
     dismissal for lack of, **1:189; 6:30**  
 Jury trial, right to, **3:19**  
 Lexicographer, **3:19**  
 Limitations from specification, reading into claims, **3:19**  
 Merits vs. lack of subject matter jurisdiction, **12:38**  
 More pertinent prior art, **3:19**  
**Motion** (this index)  
 9 Cir, **22:2**  
 Printed publication, **3:19**  
 Prior art, **3:19**  
 Reissue application, **9:47**  
 Sanctions, **12:36**  
 Sec. 285, **3:42**  
 Sec. 1338(b), **13:58**  
 Sec. 1631, **19:2**  
 Sec. 2201, **7:25; 13:41**  
 Specification, admission of prior art in, **3:19**  
 State claim, failure to, **3:19; 4:121; 7:36; 10:42; 20:44**  
 Subject matter jurisdiction, merits vs. lack of, **12:38**  
 Summary judgment, **3:19**  
 Validity, **16:54**

## INDEX

### **DISMISSAL—Cont'd**

Weapon of last resort, **1:60; 7:23**

### **DISPOSITIVE MOTIONS**

Executive Order 10096, **8:10**

### **DISSOLUTION**

Interference, **16:7**

### **DISTINCTIVENESS**

Sec. 112, **12:28; 19:26; 21:17**

### **DISTORTION OF RECORD**

Costs on appeal, **1:20**

### **DISTRICT COURT**

Appellate jurisdiction, **1:31; 12:36**

Conditional new trial, **13:34**

Correction of error in claim construction, **3:156**

Damages, **2:15**

Declaratory judgment, **19:22**

Evidence, **6:12**

Findings by, need for, **18:32**

Inherent power to control its own docket, **12:36**

Injunctive relief pending appeal after patentee has prevailed, **16:19**

Mandamus, **9:41**

Preliminary injunction, **8:81**

PTO will not cite as authority district court decision reversed on appeal, **9:1**

Reexamination, **9:180**

Review, standard of, **7:33; 7:72**

Sec. 41(a)(7), **13:32**

Sec. 145 proceeding, **6:9**

### **DIVERSITY JURISDICTION**

CAFC, **2:11**

### **DIVERSITY OF CITIZENSHIP**

Appellate jurisdiction, **3:11**

### **DIVIDED INFRINGEMENT**

Refusal to deem unreasonable, **13:208**

Summary judgment, **13:211**

### **DIVISIONAL APPLICATION**

Generally, **2:106**

### **DIVORCE**

Standing, **5:105**

### **DNA**

Generally, **6:20**

### **DNA—Cont'd**

Biogenic, **1:44; 18:109**

Deposit of DNA, **19:121**

Description, **1:131; 3:116**

Interference, priority of invention, **19:240**

Isolated DNA molecules, **1:228; 9:383**

Prima facie obviousness, **9:133**

**Recombinant DNA** (this index)

Sec. 101, **1:228; 1:245; 9:383**

Sec. 112(1), **18:40**

Subject matter jurisdiction, **1:214**

Typing, **13:139**

Written description, **2:143; 3:116**

### **DOCKET**

District court's inherent power to control its own, **12:36**

### **DOCTRINE OF EQUIVALENTS**

Generally, **1:93; 1:132; 1:142; 1:145; 1:356; 2:74; 2:84; 2:114; 4:78; 5:59; 5:144; 7:41; 7:78; 8:100; 11:42; 11:46; 12:26; 12:65; 12:66; 12:123; 13:229; 14:46; 16:53; 16:99; 16:102; 16:104; 20:47; 21:18; 22:23; 26:9**

“About,” **3:136**

Additional step, **5:36**

All elements rule, **1:82; 5:86**

Amendment, narrowing, **6:70; 7:80; 8:87; 19:162**

Amendment of claims, **5:53; 6:64; 8:65; 8:66**

Amendments, **9:108; 9:235; 12:51**

Apply, no discretion to, **1:79**

Cancellation of claim and replacement with another claim, **13:106**

Chemical case, **26:2**

Claim construction and interpretation, **1:192; 3:170; 3:178; 4:23; 4:87; 5:120; 20:8**

Claiming process not perfect, **1:80**

Claim preamble, **3:22**

Claim vitiation, **18:106**

Complete identity not required, **14:1**

Correspondence, **5:39**

Costs on appeal, **1:20**

Criticism of prior art, **16:106**

Cross-appeal, **18:2**

Dependent claim, **5:6; 18:65**

**DOCTRINE OF EQUIVALENTS****—Cont'd**

Device, cannot cover prior art device, **7:40**

Direct, if none, **13:28**

Disclosure  
disclosure dedication, **5:152; 19:233; 20:74**  
unclaimed disclosed material, **13:75; 25:6**

Discretion to apply, none, **13:80**

Double patenting, **3:4**

Element-by-element analysis required, **7:61; 20:41; 22:16**

Element missing, **4:53**

Ensnarement, **4:90; 7:121**

Equivalence to non-means-plus-function limitation, **11:48**

Equivalent, generally, **1:93**

Equivalents versus, **5:32; 11:47**

Estoppel, scope of, **1:119**

Every claim limitation must be met, **9:131**

Evidence, **7:51**

Exception, Graver Tank is exception not rule, **12:28**

Experts, **1:164**

Fact question, **5:28; 9:108; 10:10**

File wrapper estoppel, **9:108**

Findings on function, **3:39**

Foreseeability, **6:52; 6:64; 18:106**

FRCP 8(a)(2), **14:91**

FRCP 12(b)(6), **14:91**

FRCP 56(c), **8:27**

Function, **5:26; 6:37; 19:84; 21:28**

Function-way-result test, **19:52; 19:199**

Generalized testimony, **3:80**

Graver Tank, **12:28; 13:39; 16:11**

Hatch-Waxman Act, **9:438**

Human, infringement of human product by structurally different nonnatural one, **7:28**

Hypothetical claim, **23:17**

Hypotheticals, **14:18**

Identity, complete identity not required, **14:1**

Independent claims, **5:6; 18:65**

Inducement, **14:91**

Inducing infringement, **13:28**

Information disclosure statement, **5:31**

**DOCTRINE OF EQUIVALENTS****—Cont'd**

Infringement  
generally, **4:35; 13:55; 20:6**  
see also other entries throughout this topic

Biologics Price Competition and Innovation Act, **1:337**

equivalence, **12:7; 13:28**

human product by structurally different nonnatural one, **7:28**

inducing infringement, **13:28**

insubstantial differences, **22:47**

inventorship, **4:125**

judgment of invalidity must be vacated when no infringement, **5:6**

method claim, **13:186**

Inspection of patentee's product, **16:15**

Insubstantial differences, **1:84; 2:101; 3:86; 4:50; 4:62; 5:30; 9:225; 15:16 to 15:18; 19:97; 19:135; 20:57; 21:33; 22:47; 23:41; 26:6**

Interchangeability, **12:42; 13:91**

Inventorship, **4:125**

Judgment as a matter of law, **5:44**

Judgment of invalidity must be vacated when no infringement, **5:6**

Jury instructions, **19:227**

Jury verdict, **8:47**

Limitations and restrictions  
generally, **11:45**  
equivalence to limitation, **16:133**  
equivalence to non-means-plus-function limitation, **11:48**  
every claim limitation must be met, **9:131**  
patentee has duty to submit evidence for limitations not literally met, **7:51**

Literal scope of claims, outside of, **5:6; 7:51**

Matter of law, judgment as, **5:44**

Meaningful claim limitations, not to be used to erase, **3:51**

Means-plus-function claims, **1:125; 4:50; 9:215; 11:48**

Narrowing amendment, **6:70; 7:80; 8:87; 19:162**

1952 Patent Act, survives, **23:42**

Numerical ranges, effect of, **1:115**

## INDEX

### DOCTRINE OF EQUIVALENTS

#### —Cont'd

Obviousness, **3:178**  
One-to-one correspondence not required, **5:39; 6:39**  
Outside literal scope of claims, **5:6; 7:51**  
Patentability, **8:60; 12:51**  
Patent Act of 1952, **23:42**  
Patentee has duty to submit evidence for limitations not literally met, **7:51**  
Pen and pencil analogy, **18:29**  
Perspective, **12:69**  
Presumption, **8:60; 21:11**  
Prior art, **7:40; 9:118; 12:78; 13:93; 20:61**  
Prosecution history, **9:108**  
Prosecution history estoppel, **1:164; 6:48; 6:64; 9:186; 9:377; 12:62; 15:29; 16:27; 20:69; 20:89; 21:77; 22:37**  
Public, unclaimed disclosed material dedicated to, **13:75**  
Recapture, surrendered, cannot recapture what has been, **13:63; 13:95**  
Replacement with another claim, cancellation of claim and, **13:106**  
**Reverse Doctrine of Equivalents** (this index)  
Rewriting dependent claim into independent form, **18:65**  
Same location, substitute need not be in exact, **26:4**  
Sec. 112(6) equivalent, **9:149**  
Sec. 112 equivalency, **16:2**  
Separate patentability, **7:77**  
Serving same function is very different ways, **1:66**  
Spectrum of effect, **9:108**  
Submission of evidence, **7:51**  
Substantial difference, **16:40**  
Substantiality of differences standard, **1:82; 8:47; 19:94**  
Substantiality test, **6:26; 18:39; 23:40**  
Substantial reason, **6:41; 8:60**  
Substitution of features, **14:45**  
Substitute need not be in exact same location, **26:4**  
Summary judgment, **2:20; 2:66; 2:114; 4:62; 8:40; 11:46; 12:42; 20:13; 22:21; 23:64**

### DOCTRINE OF EQUIVALENTS

#### —Cont'd

Surrendered, cannot recapture what has been, **13:63; 13:95**  
Tangential, **3:130; 18:74; 18:77**  
Three-part inquiry, **22:10**  
Timing, **23:63**  
Two components viewed to serve as one element, **18:62**  
Unclaimed disclosed material, **13:75; 25:6**  
Unclaimed subject matter, **10:30**  
Validity, judgment of, **5:6**  
Verdict, **16:14**  
Vitiation, **1:267; 3:178; 18:106**  
Wilson hypothetical claim, **3:52; 10:15; 11:22; 23:20**  
Witnesses, generalized testimony, **3:80**  
Written description, **1:164**

### DOCTRINE OF IMPOSSIBILITY OF PERFORMANCE

Excuse, **8:43**

### DOCUMENTARY EVIDENCE

Oral testimony, **3:49**  
Thesis, weight accorded testimony in conflict with, **13:34**

### DOCUMENTS

Discovery, documents pertaining to ADR proceeding, **8:37**  
Responses possible, document request, **2:27**  
Retention policy, **13:168**  
Sec. 287, documents not marked, **4:12**  
Summary judgment, trial by documents, **19:51**

### DOLBY LABORATORIES LICENSING CORPORATION V. UNIFIED PATENTS, LLC

2025, **4:137**

### DOMESTIC INDUSTRY

International Trade Commission (ITC), **12:105**

### DOMINATING PATENT

Anticipation, **18:20**  
Overbreadth, **21:10**

### DOMINATION

Generally, **5:49**

**DOMINATION—Cont'd**

Double patenting, **9:45**

**DOUBLE PATENTING**

Generally, **7:111; 9:45; 14:96; 19:246**

Affirmative defenses, **3:4**

Anticipation, **3:4; 21:76**

Applications, two non-related, **1:115**

Concession, terminal disclaimer as  
concession of obviousness, **15:6**

Design, **3:4**

Design patent, **19:8**

Disclaimer, **15:6**

Disclosure, **9:45; 9:307; 19:226**

Doctrine of equivalent, **3:4**

Domination, **9:45**

FRCP 8(c), **3:4**

Hatch-Waxman Act, **21:76**

Inducement, **5:132**

Later developed processes, **20:92**

Law question, **9:190**

Monopoly, **9:45**

**Obviousness** (this index)

Prior art, **9:45**

Purpose, **1:80**

Reissue, **7:115**

Same invention, **7:75**

Sec. 101, **9:463**

Sec. 121, **7:115**

Separate and patentably distinct inven-  
tions, **7:22**

Terminal disclaimer as concession of  
obviousness, **9:384; 15:6**

Two limitations, **3:4**

Use of applicant's own invention  
disclosure as prior art against him,  
**9:45**

Validity, **8:7**

Variation amount, **5:103**

**DPCA**

**Drug Price Competition Act (DPCA)**  
(this index)

**DRAFTING CLAIMS**

Generally, **11:11**

**DRAGON INTELLECTUAL  
PROPERTY LLC V. DISH  
NETWORK L.L.C.**

2024, **4:136**

**DRASTIC REMEDY**

Mandamus writ, **9:180**

Preliminary injunction, **9:95**

**DRAWINGS**

Generally, **8:150**

Claim interpretation, **16:82**

Description, **3:101**

Design patent, **9:137**

Inequitable conduct, **11:4**

Over reliance, **11:71**

Physical exhibit, **16:36**

Precise proportions, do not define, **8:74**

PTO fact findings, **9:80**

Speak louder than words, **9:137**

**“DRIVE DEMAND” FORMULATION**

Irreparable injury, **7:122**

**DRUG APPLICATION**

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

**New Drug Application** (this index)

**DRUG PRICE COMPETITION ACT**  
(DPCA)

Generally, **4:40; 7:55**

Extension of patent term, **7:18; 13:77**

Sec. 271(e)(1), **20:26**

**DRUG PRICE COMPETITION AND  
PATENT TERM RESTORATION  
ACT (DPCPTRA)**

Generally, **3:109; 13:77**

**DRUG PRODUCT**

Patent term extension, **16:125**

**DRUGS**

Medicare Prescription Drug, Improve-  
ment, and Modernization Act,  
**20:78**

Sec. 271(e)(1), **1:175; 5:3**

**DUE CARE**

Anticipation, **18:20**

Clearly erroneous standard, **19:23**

Notice of infringement, **3:96**

Summary judgment, **1:35**

**DUE PROCESS**

Generally, **18:27**

Claim selection procedure, **11:66**

Fraudulent inducement liability, not rel-  
evant to, **18:69**

## INDEX

- DUE PROCESS—Cont’d**
  - FRCP 15(c), **6:11**
  - Secondary considerations, **5:131**
  - Self-executing statutes, **18:33**
- DUPLICATE LITIGATION DOCTRINE**
  - Generally, **1:375**
- DUPLICATION**
  - Anticipation, **19:107**
- DURDEN CASE**
  - Method claims, **9:98**
- “EACH AND EVERY” LIMITATION**
  - Interference, **25:11**
- “EACH CLAIM”**
  - Sec. 263, **15:6**
  - Sec. 1498, **12:11**
  - Separate invention, **10:8**
- “EACH MOTION”**
  - Summary judgment, **5:48**
- “EACH PATENT”**
  - Property, **11:35**
  - Validity, **5:45**
- “EACH STATUTORY CLAIM CLASS”**
  - Chemical process, **9:20**
- EARLIER ADJUDICATION**
  - Blonder-Tongue, **1:13**
- EARLIER FILING DATE**
  - Generally, **13:53**
  - CIP, **5:20; 20:35**
  - Sec. 120, **12:99; 18:85; 20:33; 20:88; 26:12**
- EARLIER PATENT**
  - Prosecution estoppel, **12:3**
- EARLIER SUIT**
  - Infringement, **16:35**
- EARLIER WRITINGS**
  - After-the-fact testimony of inventor, **14:12**
- EARLY DISCLOSURE**
  - Interference, **7:13**
- ECOFACITOR, INC. V. GOOGLE LLC**
  - 2024, **5:157**
- ECOFACITOR, INC. V. GOOGLE LLC**
  - Cont’d
  - 2025, **5:159**
- ECONOMIC POSITION**
  - Prejudice, **7:30**
- ECONOMIC PREJUDICE**
  - Prejudice, **1:67**
- EDUCATION OF INVENTOR**
  - Inequitable conduct, **15:3**
- EDWARDS LIFESCIENCES CORPORATION V. MERIL LIFE SCIENCES PVT. LTD.**
  - 2024, **5:158**
- EFFECTIVE AMOUNT**
  - Generally, **7:75**
  - Claim interpretation, **1:122**
- EFFECTIVE DATE**
  - Reexamination, **13:79**
  - Reference, sec. 102(e) reference, **9:110**
  - Sec. 102(e) reference, **9:110**
- EFFECTIVE FILING DATE**
  - Interference, **19:144**
  - Sec. 112, **18:4**
- EGREGIOUSNESS**
  - Damages, enhanced, **5:54**
- EIC**
  - Board’s exercise of discretionary authority, **7:23**
  - Sec. 1.645(b), **1:60**
- 8 CIR**
  - Sec. 43(a), **10:15**
- EJUSDEM GENERIS**
  - Contract interpretation, **20:38**
- ELABORATING TERSE CLAIM LANGUAGE**
  - Claim interpretation, **5:50**
- ELECTION**
  - Sec. 120, **12:10**
  - Voiding, **3:61**
- ELEKTA LIMITED V. ZAP SURGICAL SYSTEMS, INC.**
  - 2023, **5:156**

**ELEMENT-BY-ELEMENT ANALYSIS**

Doctrine of equivalents, **7:61; 20:41; 22:16**

**ELEMENTS**

Generally, **8:43**  
 Defined, **4:35**  
 Doctrine of equivalents, **4:53**  
 Equitable estoppel, **13:44**  
 Infringement, **19:111**  
 Inspection of patentee's product, **16:15**  
 Laches, **13:44; 23:45**  
 Reduction to practice, **13:105**  
 Sec. 282, **6:10**

**11 USC § 1141**

Bankruptcy discharge, **2:21**

**ELEVENTH AMENDMENT**

Generally, **3:79; 7:56; 18:66**  
 Immunity, state, **2:120; 9:128**  
 Inventorship, **24:3**  
 Nonresidents, not limited to suits by, **10:11**  
 State as defendant, **18:40**  
 State immunity, **2:120; 9:128**

**EMBELLISHMENT**

Prior art, noting differences from, **4:6**

**EMBODIMENT**

Generally, **5:19; 12:3; 26:2**  
 Claim interpretation, **1:233; 7:57; 7:77; 10:23; 14:34; 16:54; 19:196; 22:12; 22:30; 22:35; 23:49**  
 Comparing claims with accused device, **13:9**  
 Computer program, **9:164**  
 Enablement, **3:103**  
 Exclusion of preferred embodiment, claim interpretation, **1:233**  
 Parallel, **1:132**  
 Patent misuse, **23:9**  
 Preferred embodiment, scope of invention, **1:207**  
 Reduction to practice, **19:144**  
 Sec. 271, **10:17**  
 Verdict, **16:14**

**EMERGING TECHNOLOGIES**

Statutory subject matter, **9:308**

**EMINENT DOMAIN**

Reasonable royalty, **8:56**

**EMINENT DOMAIN—Cont'd**

Valuation determinations, **8:56**

**EMPLOYMENT**

Executive Order 10096, **8:10**  
 Motion to remand, **19:45**  
 Ownership, **2:73**  
 Preliminary injunction, denial of, **12:16**  
 Title dispute, **6:15**

**ENABLEMENT AND ENABLEMENT REQUIREMENT**

Generally, **1:150; 1:362; 2:70; 2:90; 2:103; 2:192; 3:114; 5:152; 8:57; 8:130; 9:259; 9:283; 9:404; 11:57; 12:13; 13:243; 16:181; 18:72; 19:59; 19:152; 19:181; 19:304; 22:7; 23:59**

Abbreviated new drug application (ANDA), **3:169**

Anticipation, **1:202; 2:82; 9:291; 13:120**

Anticipatory reference, **2:82**

Best mode, **2:90; 3:31; 9:177; 12:80**

Biological processes, factual premises for, **5:66**

Claim construction and interpretation, **22:49**

Commercial marketplace, not success in, **3:104**

Date of filing, determined at, **5:45**

Description, **14:101; 21:9**

Determined at date of filing, **5:45**

Disclosure, **1:102; 1:167; 10:23**

Embodiments, inoperative, **3:103**

Experiment, **3:169; 9:177; 23:77**

Factual premises for biological processes, **5:66**

Factual underpinnings, **21:36**

Filing, determined at date of, **5:45**

Germ of idea not sufficient, **7:50**

How to use, **14:4**

Indefiniteness, **16:60; 20:121**

Inequitable conduct, **20:101**

Inoperative, **9:222**

Inoperativeness, **3:103; 14:12**

Interference, **3:28; 4:8; 13:3**

Jury, **1:14; 5:110**

Later broader claims of previous nonenabled claims, **1:78**

Law question, **1:80; 1:117; 1:127; 9:150; 9:154; 9:210; 16:47**

## INDEX

### ENABLEMENT AND ENABLEMENT REQUIREMENT—Cont'd

Means-plus-function, **5:124**  
Objective factors, **9:375**  
Obviousness, **14:101**  
One mode required, **1:131**  
Only as of issue date of patent, **9:53**  
Open claim language, **13:174**  
Patent must be enabled, **1:197; 4:67**  
Pioneering, **16:80**  
Plant patents, **9:259**  
Practice invention without undue experimentation, **9:177**  
Prior art reference, **9:305; 19:207**  
Priority, **19:304**  
Review, standard of, **2:79**  
Scope of claim, **14:27; 19:205**  
Sec. 101, **18:6**  
Sec. 102(b), **9:18**  
Sec. 112, **1:167; 1:252; 1:304; 2:34; 3:14; 9:83; 12:80; 13:56; 14:8; 17:1; 19:21; 21:14; 23:8**  
Sec. 112(1), **1:200; 6:20; 9:113; 9:115; 9:134; 9:142; 9:143; 13:55; 16:141; 19:51**  
Sec. 145, **7:9**  
Specifications, **23:77**  
Summary judgment, **2:144; 14:75; 15:26; 21:46**  
Time to be satisfied, **21:39**  
Undue experimentation, **1:44; 2:99; 9:177; 9:305; 19:201**  
Utility, versus, **9:319; 16:60**  
Validity of claim, **19:206**  
Verbatim findings of counsel adopted, **8:22**  
Written description, **9:476; 22:49**  
Written description vs., **1:200; 19:236; 20:119; 21:46; 21:47**

### ENFORCEMENT AND ENFORCEABILITY

Generally, **13:69**  
Agreement on TRIPS, **22:36**  
Antitrust, **21:45**  
Arbitration agreement, **16:136; 22:55**  
Attorney fees, **4:20**  
Consent of co-owners, **19:264**  
Contracts, **3:107**  
FRCP 59(e), **19:42**  
Inequitable conduct, **7:101; 8:12; 19:30**

### ENFORCEMENT AND ENFORCEABILITY—Cont'd

International Trade Commission, **22:29**  
Judicial estoppel, **23:21**  
Lear distinguished, **8:11**  
On-sale bar, **13:42**  
Res judicata effect, **6:17**  
Restrictions, **13:42**  
Sanctions, **4:20**  
Sec. 262, **19:264**  
Seizure, **4:20**  
Settlement and settlement agreement, **2:138; 8:48; 9:159**  
Single use only restriction on sale of patented device, **13:42**  
Validity, **12:40**

### ENGLISH GRAMMAR

Sec. 112, **9:40**

### ENHANCED DAMAGES

Generally, **9:125; 19:289; 19:336.50**  
Accounting phase, **11:15**  
Attorney fees, **1:43**  
Discovery, newly discovered prior art, **21:3**  
Discretionary, **15:14**  
Egregiousness of defendant's conduct, **5:54**  
Intervening rights, **21:3**  
Newly discovered prior art, **21:3**  
Prejudgment interest, **21:3**  
Principal considerations same as willfulness, **19:101**  
Prior art, newly discovered, **21:3**  
Seagate test, **8:137**  
Sec. 252, **21:3**  
Sec. 284, **1:62; 2:30; 2:40; 18:29**  
Subject matter jurisdiction, **25:1**  
Two-step analysis, **10:21**  
Willful infringement, **21:3; 23:85**  
Willfulness, **12:47**

### ENHANCEMENT

Prior art, noting differences from, **4:6**

### ENSNAREMENT

Doctrine of equivalents, **4:90; 7:121**

### ENTIRE MARKET VALUE RULE

Generally, **9:275; 11:32**  
Anticipated collateral sales vs. reasonable royalty rate, **18:35**

**ENTIRE MARKET VALUE RULE**

—Cont'd

- Apparatus, value of entire, **6:36**
- Collateral sales, **18:35**
- Demand, **20:50**
- Patented feature is reason for demand, **20:50**
- Reasonable royalty rate, **12:97; 18:35; 22:43**
- Value of entire apparatus, **6:36**

**ENTIRE PATENT**

- Assertion of only certain claims, **3:46**

**ENTIRETY**

- Direct infringement, “control” by one party over entire process, **1:222**
- Graver Tank, **20:6**
- References considered, **16:4**

**ENTITLEMENT**

- Generally, **9:243**
- Estoppel, **23:30**
- ITC, **5:37**
- Sec. 120, **11:8**

**EQUAL, NOT EQUAL TO SAME THING**

- Preliminary injunction, **4:5**

**EQUAL, THINGS EQUAL TO EACH OTHER**

- Preliminary injunction, **4:5**

**EQUITABLE CONDUCT**

- Inequitable Conduct** (this index)

**EQUITABLE DEFENSE**

- Generally, **6:14**
- Assignor estoppel doctrine, **19:47**
- Damages, **2:19**

**EQUITABLE ESTOPPEL**

- Generally, **6:53; 6:103; 7:141; 10:49; 19:252; 22:28**
- CAFC jurisdiction, **13:14**
- Clearly erroneous standard, **19:23**
- Cross-appeals, **18:98**
- Delay, unreasonable, **8:50**
- Elements, **13:44**
- Government, **26:8**
- Implied license, **13:67; 19:35; 23:55**
- Inventorship, **16:131**
- Jury verdict, **13:4**

**EQUITABLE ESTOPPEL—Cont'd**

- Misleading conduct, **1:201; 19:108**
- Performance of government contract, **8:8**
- Prejudice, **19:252**
- Summary judgment, **8:140; 19:108**
- Three-part test, **2:61; 5:53**
- Timeliness of appeal filing, **2:5**

**EQUITABLE ISSUES**

- Jury trial, **2:61**

**EQUITABLE REMEDY**

- Restitution, **20:34**

**EQUITABLE TOLLING**

- Appeal, of time for, **7:32**
- Limitation of actions, **23:38**
- Patent term adjustment, **14:74**

**EQUITIES WEIGHED**

- Assignor estoppel, **3:46**

**EQUITY POWERS**

- Sec. 112, **19:4**

**EQUIVALENCE AND EQUIVALENTS**

- Generally, **3:39; 12:26; 16:174; 16:175; 23:35**
- Amendment, effect of, **12:1**
- Doctrine of Equivalents** (this index)
- Fact finding, **7:12**
- Fact question, **5:7; 19:59**
- Infringement, **8:51; 23:40**
- Insubstantial differences, **1:93; 19:114**
- Interchangeable device, **11:22**
- Invention, **19:34**
- Jury verdict, **19:5**
- Means-plus-function claim, **9:96; 21:44**
- More pertinent art, **5:7**
- Present, not, **10:10**
- Presumption of validity, **5:7**
- Processes, **3:87**
- Sec. 112, **8:7; 11:10; 20:6**
- Sec. 282, **18:6**
- Separate patentability, **6:42**
- Validity, presumption of, **5:7**

**EQUIVALENTS, DOCTRINE OF**

- Doctrine of Equivalents** (this index)

**EQUIVOCAL OPINION OF COUNSEL**

- Willful infringement, **23:26**

## INDEX

### **ERRONEOUS JURY INSTRUCTIONS**

Indirect infringement, **3:173**  
Special verdict, **14:7**

### **ERRONEOUS STATEMENT**

Claim interpretation, **2:80**

### **ERROR**

Appeal and review, **19:16**  
Claim interpretation, **9:94**  
Obviousness, **12:79**  
Reissue, **8:64; 19:110; 19:137**  
Sec. 287, **4:12**

### **ERROR IN RECORD**

Prosecution history, **22:23**

### **ESCROW**

Arising under jurisdiction, **3:21**  
Case or controversy, **3:21**  
Declaratory judgment, **3:21**  
Future royalty payments, **3:21**  
Interlocutory, **3:21**  
Preliminary injunction, **3:21**  
Review, scope of, **3:21**  
Royalty, future, **3:21**  
Sec. 1292(d)(2), **3:21**  
Stay of patent action, **9:91**

### **ESSENCE**

Combination patent, **13:15**  
Inspection of patentee's product, **16:15**

### **ESSENTIAL ELEMENTS**

Claim interpretation, **1:119**  
Heart, **5:10**  
New legal test, not, **3:101**

### **ESSENTIALLY FACTUAL**

Indefiniteness, **2:99**

### **ESSENTIALLY THE SAME**

Claim preclusion, **1:170; 2:159**

### **ESTIMATED COST SAVINGS**

Sec. 284, **8:4**

### **ESTOPPEL**

Generally, **2:98; 3:222; 5:116; 8:40; 9:216; 12:3; 22:62; 23:14**  
See also **Waiver** (this index)  
Argument-based estoppel, **19:320**  
Assignor estoppel, **19:241**  
Business methods, **3:202**  
Claim construction, **19:320**

### **ESTOPPEL—Cont'd**

Claim interpretation, **19:15**  
Covered business methods, **3:202**  
Design patent, **1:318**  
Doctrine of equivalents, **1:119**  
Elements thereof, **7:30**  
Entitlement to priority date of parent application, **23:30**  
Equities weighed, **3:46**  
Exhaustion of appeals, **2:143**  
**File Wrapper** (this index)  
FRE 103(a)(1), **23:27**  
Hatch-Waxman Act, **9:438**  
**Interference** (this index)  
Inter partes review, **1:344**  
ITC, **25:2**  
Laches, **1:48; 19:38; 22:8**  
Marking estoppel, **6:86**  
Privity, **9:118; 13:88**  
**Prosecution History Estoppel** (this index)  
Regulation, **19:63**  
Sec. 101, **19:320**  
Sec. 285, **19:320**  
Standing, **1:344**  
Statutory estoppel, **1:344**  
Summary judgment, **10:4**  
Three-part test, **8:32**  
Three requisite elements, **1:67**

### **EVERY CLAIM**

Generally, **23:35**  
Doctrine of equivalents, **9:131**  
Infringement, **1:52; 1:84; 19:111; 23:40**

### **EVERYDAY MECHANICAL CONCEPTS**

Judicial notice, **9:127**  
Notice, judicial notice, **9:127**

### **“EVERY SUCH OFFENSE”**

Civil penalty for false marking, **6:72**

### **EVIDENCE**

As to particular evidence, see more specific topics throughout this index  
Generally, **3:49; 9:29; 9:481; 10:18; 12:24; 13:9; 13:28; 13:45; 13:53; 14:2; 16:36; 18:7; 23:18**  
Additional evidence at trial, **19:232; 21:36**

**EVIDENCE—Cont'd**

**Admissibility of Evidence** (this index)  
 Affidavit, **9:23**  
 APA, **8:34**  
 Appeal and review, **6:12; 11:32**  
 Attorney argument not substitute for substantive evidence, **7:33**  
**Burden of Persuasion and Quantum of Proof** (this index)  
**Burden of Proof** (this index)  
 Business records exception, **3:67; 13:71**  
 CAFC, **18:3**  
 Chasm, Sec. 145, Sec. 146, **20:125**  
 Chemical, **9:60**  
 Choice of law, **1:92; 13:121; 15:14; 19:142**  
**Circumstantial Evidence** (this index)  
 Claim construction and interpretation, **1:79; 4:23; 5:53; 6:37; 16:13; 23:11**  
**Clear and Convincing Evidence** (this index)  
 Conception, **9:244**  
 Conclusory statement, **2:80**  
 Contributory vs. direct infringement, **18:11**  
 Corroboration, **1:159; 2:118; 5:40**  
 Counsel's arguments, **3:3**  
 Counsel's statements, **19:6**  
 Credibility of witnesses, **19:57**  
 Delay, **23:27**  
 De novo, **11:32**  
 Design patent, **19:8**  
 Destruction of documents, **5:1**  
 Disclosure, duty of, **12:52**  
 Discretion of court, admissibility is within, **3:57**  
 Doctrine of equivalents, **7:51**  
 Document retention policy, **13:168**  
 Exception, business records, **13:71**  
 Expert opinion on obviousness, **13:53**  
**Expert or Opinion Evidence** (this index)  
**Extrinsic Evidence** (this index)  
 Good cause under 37 CFR Sec. 1.617(b) justifying, **8:35**  
 Hearsay, **1:70**  
 Identity of invention, **20:20**  
 Inequitable conduct, **2:68; 2:103; 5:42; 7:46; 13:19; 15:43; 20:106**  
 In limine, **21:41**

**EVIDENCE—Cont'd**

Integration, **13:76**  
 Interference, **2:70; 14:3**  
 Invention, **19:34**  
 Inventorship, **19:132; 21:42**  
 ITC, **23:55**  
 JMOL, **19:126**  
 JNOV, **6:6; 13:4; 13:13; 25:4**  
 Jurisdiction, **1:76**  
 Jury verdict, **3:75; 4:18**  
 Linking evidence in general, **13:103**  
 Mandamus, **9:41**  
 Means-plus-function claim, **3:83**  
 Newly discovered, **1:101; 19:235**  
 New trial, **22:26**  
**Objective Evidence** (this index)  
**Obviousness** (this index)  
 Post-trial motions, **18:3**  
 Prejudice, **18:39**  
 Preliminary injunction, **8:2**  
**Presumptions** (this index)  
 Prima facie obviousness, **9:99; 9:152**  
 Prosecution laches, **3:155**  
 PTO initial rejection, **7:19**  
 Quality vs. quantity, **12:37**  
 Reduction to practice, **13:110**  
 Rejection, **7:19**  
 Retired, **14:11**  
 Review, standard of, **13:71**  
 Scientific opinion, within reasonable range of difference of, **2:79**  
 Sec. 1.324, **23:55**  
 Sec. 102(b), **9:7; 9:18**  
 Sec. 102(e), **1:22**  
 Sec. 112, **19:7**  
 Sec. 112(2), **19:125**  
 Sec. 112 vs. validity, **19:125**  
 Sec. 145, Sec. 146, chasm, **20:125**  
 Sec. 252, **19:4**  
 Sec. 287, **4:12**  
 Sec. 1292(a)(1), **23:13**  
 Secondary considerations, **13:17; 13:45**  
 Skill in the art, level of, **9:23**  
 Special province of trier of fact, **18:12**  
 Spoliation, **8:120**  
**Substantial Evidence** (this index)  
 Summary judgment, **14:33**  
 Technological evidence, **14:32**  
 Thesis, **13:34**  
 35 USC § 146, **19:232**

## INDEX

### **EVIDENCE—Cont'd**

- Unexpected results, **9:197**
- Validity, **4:19; 13:169; 19:125**
- Verbatim findings of counsel adopted, **8:22**
- Weight and Credibility of Evidence** (this index)
- Witnesses** (this index)

### **EXACT COMPOUNDS**

- Chemical compounds, **21:33**

### **EXACT IDENTITY**

- Verdict, **16:14**

### **EXAMINATION**

- Generally, **8:42**
- Prosecution history estoppel, **8:13; 8:47; 18:40**
- Reexamination** (this index)
- Review, Board must, **9:2**
- Subject matter jurisdiction, lack of, **6:19**

### **EXAMINER**

- Appellate review, **9:64**
- Claim interpretation, **9:94; 20:72**
- Common occurrence, **17:4**
- Deposition
  - abuse of discretion, **23:5**
  - discovery, **23:5**
  - inequitable conduct, **23:5**
  - materiality, **23:5**
  - occurring, when, **23:5**
- Excuse, **11:3**
- FRE 706, **7:21**
- Infringement, **20:72**
- Interference, **4:21**
- Materiality, **12:43**
- Obviousness, **11:42**
- Prosecution history estoppel, **12:49**
- Sec. 112, **16:10**
- Sec. 121, **2:140**
- 37 CFR Sec. 1.196(a), **9:106**
- Validity, **3:77**

### **EXCEPTIONAL CASE**

- Generally, **2:112; 5:79; 5:149; 6:61; 9:280; 10:35; 17:7**
- Attorney fees, **1:62; 2:85; 4:83; 4:128; 9:316; 9:377; 9:455; 9:483; 11:16; 12:24; 12:32; 14:58; 15:45; 18:9; 19:92; 20:87; 20:115; 23:65**
- Bad faith, **13:69**

### **EXCEPTIONAL CASE—Cont'd**

- Basis, **8:75**
- Burden of proof, **15:45**
- Claim construction, **16:13**
- Clear and convincing evidence required, **9:161**
- Critical date, **18:9**
- Damages, **3:180**
- Declaratory judgment, **1:159**
- Enhanced attorney fees, **12:110**
- Exceptional finding, **3:84**
- Factors to be considered, **13:91**
- Fact question, **13:46**
- Frivolous infringement claims, **8:122**
- Inconsistent jury findings, **2:10**
- Inequitable conduct, **13:19; 15:13; 16:78; 18:9; 18:55**
- Invalidity, **3:180**
- Judgment must be considered, **16:59**
- Laches or delay, **3:180**
- Litigation misconduct, **5:63; 17:9; 18:64; 20:87**
- Merely losing, **11:18**
- Misconduct, litigation, **13:197; 18:64**
- Negligence, **18:9**
- Prosecution aggressiveness, **13:116**
- Purpose of, **1:105**
- Sale, **3:180**
- Sec. 102(b), **9:93**
- Sec. 271(a), **3:180**
- Sec. 285, **1:201; 2:33; 2:181; 5:14; 5:109; 6:13; 8:130; 9:455; 13:2; 13:175; 14:88; 15:3; 15:45; 19:52; 19:269; 20:151; 21:75**
- Simple negligence not enough, **18:9**
- Timeliness of appeal filing, **2:5**
- Two-step process, **5:45**

### **EXCEPTIONAL CIRCUMSTANCES STANDARD**

- Mandamus, **1:302; 9:63**

### **EXCEPTIONAL FINDING**

- Exceptional case, **3:84**

### **EXCEPTIONAL SKILL IN THE ART**

- Obviousness, **14:67**

### **EXCEPTIONS, EXCLUSIONS, AND EXEMPTIONS**

- Generally, **5:8; 8:40; 9:110; 13:10**
- Anticipation, **1:33; 1:98**

**EXCEPTIONS, EXCLUSIONS, AND EXEMPTIONS—Cont'd**

Claim interpretation, **14:34; 19:138; 22:12**

Crime fraud exception, **21:58**

Doctrine of equivalents, **12:28**

Evidence, **8:111; 13:71**

Experimental use, **3:142; 5:50; 8:98**

Final judgment rule, **20:28**

FRCP 13(a), **9:430; 16:81**

FRCP 19, **9:71**

FRCP 56(c), **8:27**

Good cause exception under APA, **14:17**

In banc hearing, **1:52**

ITC, **8:28; 9:118; 19:222**

Law of the case doctrine, **7:36; 13:61**

Mandamus, **9:63**

Noerr, **6:27**

On-sale bar, **19:140**

Patent ambiguity, **9:160**

Patent prosecution bar, **4:94**

Public use, **14:35**

Reverse doctrine of equivalents, **19:24**

Sec. 102(b), **19:140**

Sec. 271(e)(1), **9:299**

Sec. 287, **4:12**

Sec. 337, **3:23; 25:9; 25:10**

Secondary considerations, **13:17**

Statutory subject matter, **19:112**

**EXCLUSIONARY RIGHTS**

Preliminary injunction, **12:111**

**EXCLUSIONS**

**Exceptions, Exclusions, and Exemptions** (this index)

**EXCLUSIVE ENTERPRISE**

Standing, **9:301**

**EXCLUSIVE JURISDICTION**

Sec. 207(a)(2), **14:9**

Standing, **16:64**

**EXCLUSIVE LICENSEE**

Generally, **21:87**

Immunity, **1:190**

Standing, **1:190; 1:196; 13:157; 19:223; 23:67**

**EXCLUSIVE VENDOR**

Sec. 284, **11:18**

**EXCUSABLE DELAY**

Jury verdict, **13:4**

**EXCUSE**

Doctrine of impossibility of performance, **8:43**

PTO examiner's lapse, **11:3**

**EXECUTION**

Considerations involved, **19:49**

Written agreement, **23:21**

**EXECUTIVE ORDER 10096**

Generally, **8:10**

**EXEMPLIFICATIONS**

Costs, **11:51**

**EXEMPTIONS**

**Exceptions, Exclusions, and Exemptions** (this index)

**EXHAUSTION OF PATENT RIGHTS**

Generally, **1:133; 6:76; 8:134; 9:440; 10:45; 12:76; 13:139; 15:25**

Defense of, **5:93**

First sale doctrine, **13:67**

Preliminary injunctions, **12:102**

Repair vs. reconstruction, **10:27**

Sale of patented article, **12:107**

Sales of product, **20:105**

Specific claims, reservation, **11:72**

**EXHIBIT**

Design patent, **18:63**

Drawing, **16:36**

New interference rules, **8:3**

**EX PARTE TEST**

Admit, party's responsibility to, **3:10**

Appeal, **3:10**

CAFC jurisdiction, **9:63**

Divest court, **3:10**

Evidentiary weight, **3:10**

Expenses award, **3:10**

Fair trial, **3:10**

FRCP 37(c), **3:10**

FRCP 56(e), **3:10**

Hearsay, **9:150**

Perfect one, not, **3:10**

Summary judgment, **3:10**

**EXPECTATION**

Generally, **9:100; 9:191**

Closest art, compared with, **9:111**

## INDEX

### EXPECTATION—Cont'd

- Established by factual evidence not argument, **9:174**
- Factual evidentiary inquiry, **9:197**
- Obviousness, **9:52; 9:228; 9:250; 12:55; 16:108**
- Obvious to try, **1:44**
- On-sale bar, **5:35**
- Prima facie obviousness, **9:86**
- Secondary considerations, **16:4**
- Showing of nonobviousness, **9:44**
- Unexpected Results** (this index)

### EXPENSES AWARD

- Ex parte test, **3:10**

### EXPERIENCE

- Attorneys' fees, award by special master, **19:65**
- Claim construction, **8:52**

### EXPERIMENTAL USE

- Generally, **14:52; 19:91**
- Design patent, **3:81**
- Exception, narrow, **3:142; 5:50; 8:98**
- Experimental stage, **19:107**
- Factors, **1:119; 21:16**
- Inequitable conduct, **5:137**
- Invention, **7:12**
- Lease, **13:123**
- Narrow exception, **5:50**
- On-sale bar, **1:59; 1:177; 1:179; 2:178; 5:64; 5:137**
- Prima facie case of public use, **1:71**
- Public use, **2:178; 14:35**
- Ready for patenting, **5:64**
- Reduce to practice, **7:12**
- Review, standard of, **13:109**
- Sec. 102(b), **7:12; 12:30**
- Sec. 285, **5:137**
- Totality of circumstances standard, **2:57; 12:45; 16:44**

### EXPERIMENTS

- Generally, **19:113**
- Claim interpretation, **6:37**
- Diligence, **19:144**
- Enablement, **3:169; 9:177; 23:77**
- Experimental use, **19:107**
- Reduction to practice, **26:11**
- Sec. 112(1), **10:23**
- Sec. 282, **6:10**

### EXPERIMENTS—Cont'd

- Undue experimentation, **10:23; 23:11**

### EXPERT

- Experts** (this index)

### EXPERT OR OPINION EVIDENCE

- Generally, **9:113; 13:10; 14:9; 19:38; 21:13**
- Admissibility, **1:42; 1:43; 7:29**
- Claim interpretation, **3:111; 9:77; 13:86; 19:16; 19:279; 19:291; 22:40**
- Claims construed, **9:77; 22:40**
- Claims must be construed same way, **23:11**
- Clarify patented technology, **1:104**
- Costs award, **19:77; 20:87**
- Damages, **22:43**
- Disclosure, **3:141; 18:102**
- Fees of expert witness, **13:175; 15:48**
- FRE 702, **19:209**
- FRE 705, **19:38**
- FRE 706, **7:21; 13:161**
- Imported product, **7:96**
- Infringement, **3:90; 9:320; 14:18; 18:43; 19:242**
- Motivation to combine, **23:68**
- Obviousness, **1:235; 13:53; 19:244**
- Patent attorney, **5:32**
- Reasonable royalty, **19:279**
- Removal of expert testimony, **2:80**
- Sec. 252, **19:4**
- Summary judgment, **1:6; 3:20; 3:150**
- Waiver, **19:279**

### EXPERTS

- Generally, **5:5; 8:160; 11:90; 14:50; 16:11; 19:340; 21:17**
- Appointment, **13:163**
- Doctrine of equivalents, **1:164**
- Fee award, **13:175**
- Infringement, **9:125; 13:28**
- Issue preclusion, **4:9**
- Non-attorney, **15:42**
- Prima facie obviousness, **2:25**
- Report, **20:160**
- School, still in, **23:11**
- Sec. 145, **7:9**
- Sec. 285, **5:14**
- Summary judgment, **3:1; 8:14**

**EXPIRED PATENT**

Interference, **7:102**  
 Reexamination proceedings, during,  
**9:424**  
 Royalties, **11:79**  
 Standing, **11:78**

**EXPLANATORY NOTES**

Binding effect, **20:38**

**EXPRESSIO UNIUS**

Maxim, **4:30**  
 Statutory interpretation, **1:57**

**EXPRESSLY REDEFINE CLAIM TERMS**

Claim interpretation, **5:48**

**EXPRESS TERMS**

Consent judgment, **14:28Z**

**EXTENSION OF TERM**

Calculation of extension, **23:70**  
 Drug Price Competition Act (DPCA),  
**7:18**  
 Medical device, **16:117**  
 Obviousness-type double patenting,  
**9:112**  
 Patent term  
     generally, **14:95**  
     restoration, **13:77**  
 Sec. 156, **6:3**  
 Sec. 156(a)(4), **8:25; 15:35; 16:125**  
 Sec. 156(f), **16:125**  
 Sec. 156(g), **23:70**

**EXTRANEOUS CLAIM LIMITATION**

Generally, **9:154**

**EXTRATERRITORIAL ACTIVITIES**

Generally, **18:54**  
 Infringement, **16:138**  
 Sec. 271(a), **13:135**  
 Subject matter jurisdiction, **12:82**

**EXTRATERRITORIAL INJUNCTION**

Generally, **9:271**

**EXTRATERRITORIALITY**

Sec. 271(f)(2), **23:93**

**EXTRINSIC EVIDENCE**

Anticipation, **19:51**  
 Appellate review, **1:294**

**EXTRINSIC EVIDENCE—Cont'd**

Claim interpretation, **2:62; 4:51; 4:59;**  
**5:36; 11:43; 14:30; 16:53; 19:115;**  
**20:77; 23:79; 25:3**  
 Dictionary, **22:19**  
 Indefiniteness, **2:156**  
 Latent ambiguity vs. patent ambiguity,  
**9:160**

**EYE THERAPIES, LLC V.**

**SLAYBACK PHARMA, LLC**

2025, **5:160**

**FACILITATION**

Permission, versus, **20:54**

**FACT FINDING**

Generally, **8:31**  
 Board, **9:195**  
 CAFC, **18:3**  
 Equivalence, **7:12**  
 FRCP 52(a), **1:18; 12:6; 13:16; 19:4**  
 ITC, **1:10; 8:28**  
 Judge role, **10:15**  
 Jury role, **10:15**  
 Jury verdict presumed, supporting  
     generally, **2:15**  
     added features, **2:15**  
     ceiling, not, **2:15**  
     infringement, do not avoid, **2:15**  
     interrogatories or written opinion not  
         required, **2:15**  
     lost profits, **2:15**  
     Panduit, **2:15**  
     royalty established, **2:15**  
     timely objection to instructions, **2:15**  
 New evidence introduced, **6:9**  
 Obviousness, **1:4**  
 Review, standard of, **4:41; 9:217; 15:18**  
 Sec. 112, **8:7**

**FACT-LAW QUESTION**

See also **Law Question** (this index)  
 Best mode, **3:31**  
 Claim construction, **13:78**  
 JNOV, **22:4**  
 Obviousness-type double patenting,  
**9:52**

**FACT QUESTION**

See also **Law Question** (this index)  
 Analogous art, **8:42; 9:121; 9:154;**  
**10:15**

## INDEX

### **FACT QUESTION—Cont'd**

Anticipation, **7:34; 8:49; 9:96; 9:111; 9:154; 9:363; 13:45; 20:11; 20:56**  
Best mode, **14:8; 20:35**  
Claim construction, **26:1**  
Cross-appeal, **18:2**  
Damages, **3:96; 5:71; 6:26; 13:45; 15:10; 21:18**  
Description, **1:118; 9:177**  
Doctrine of equivalents, **5:28; 9:108; 10:10**  
Equivalence and equivalents, **5:7; 19:59**  
Exceptional case, **13:46**  
Indirect infringement, **13:190**  
Infringement, **3:101; 7:10; 7:37; 8:51; 19:19; 21:17**  
Inherency, **9:31; 9:172**  
Interference, **3:32; 4:8**  
JNOV motion, denial of, **13:13**  
Known or used by others, **3:2**  
Literal infringement, **12:1**  
Marking, **7:66**  
Motion for new trial, **23:10**  
Obviousness, **9:182; 9:217; 23:52**  
Reference, **9:119; 9:133; 9:148; 9:166; 9:169; 19:56**  
Sec. 112, **8:7**  
Utility, **13:28**  
Verbatim findings of counsel adopted, **8:22**  
Well-understood, routine and conventional, skilled artisan, **1:311**  
Willful infringement, **7:37; 8:52; 13:45; 16:40**  
Willfulness, **3:96**  
Written description, **6:20; 7:112; 21:14**  
Written findings and conclusions prepared by prevailing party, **21:2**

### **FACTUAL DETERMINATION**

Anticipation, **20:63**  
APA, **8:34**  
Review, standard of, **4:56**

### **FACTUAL EVIDENCE**

Expectation, unexpected results, **9:197**  
Obviousness conclusion, **9:15**  
Unexpected results, **9:174; 9:197**

### **FACTUAL UNDERPINNING**

Administrative board's decision, **2:37**  
Enablement, **21:36**

### **FAILURE TO STATE CLAIM**

State Claim, Failure to (this index)

### **FAIR TRIAL**

Ex parte test, **3:10**

### **FALSE ADVERTISING**

Choice of law, **2:132**

### **FALSE AND FORGED DOCUMENTS**

Fraudulent conduct, **6:22**  
Inequitable conduct, **7:34**

### **FALSE PATENT MARKING**

Generally, **1:23; 19:278**  
America Invents Act, **16:134**  
Misuse, **10:42**  
Sec. 292, **1:23; 2:151; 3:118; 9:329; 12:23; 19:224; 19:262**

### **FALSE STATEMENTS**

Inventorship, **16:61**

### **FAST MOVING INDUSTRY**

CCPA decisions, **9:74**

### **FATAL WOUND, STAUNCHING**

Sec. 102(b) on-sale bar, **4:16**

### **FAULTY JURY INSTRUCTION**

Remand, when appropriate, **7:27**

### **FCR 7(A)**

Corporation appearance by nonlawyer, **18:15**

### **FCR 12**

Generally, **21:22**

### **FCR 35**

In banc rehearing, **1:52**

### **FCR 36**

Generally, **21:27**

### **FCR 38**

Frivolous appeal, **8:37**

### **FDA**

Generally, **1:83; 7:141**  
Conduct before, **5:95**  
Delay in approval, **20:100**  
Infringement, **1:85**  
Obviousness, FDA approval, **1:235; 1:236**  
Patent term extension, **15:35; 23:70**

**FDA—Cont'd**

Use code, counterclaim to force correction, **14:68**

**FEATURES ADDED**

Infringement not avoided, **14:8**

**FEDERAL CIRCUIT LAW**

Generally, **6:17**

**FEDERAL COMMON LAW**

Choice of law, **18:38**

**FEDERAL COURTS**

Jurisdiction, **23:77**

state universities, **21:63**

**FEDERAL FOOD, DRUG, AND COSMETIC ACT**

Generally, **2:54; 13:107**

Court of Appeals of Federal Circuit, **1:332**

Delisting, **1:120**

International Trade Commission, **1:332**

Jurisdiction, **1:332**

Sec. 271(e)(1), **3:182**

**FEDERAL GOVERNMENT**

Sovereign immunity, **3:95**

**FEDERAL LAW**

Sec. 261, **18:58**

**FEDERAL NONNUCLEAR ENERGY RESEARCH AND DEVELOPMENT ACT (FNERDA)**

Research performed under government contract, **6:18**

**FEDERAL PATENT CODE**

Generally, **6:17**

Certified question, **6:17**

Preemption, **3:68**

Sec. 1292(c)(1), **6:17**

**FEDERAL QUESTION JURISDICTION**

Sec. 291, **1:11**

**FEDERAL RULES**

Spirit, **3:24**

**FEDERAL RULES OF APPELLATE PROCEDURE**

See entries beginning: **FRAP**

**FEDERAL RULES OF CIVIL PROCEDURE**

See entries beginning: **FRCP**

**FEDERAL RULES OF EVIDENCE**

See entries beginning: **FRE**

**FEDERAL UNFAIR COMPETITION CLAIMS**

Preemption, **26:7**

**FEDERAL VACANCIES REFORM ACT**

Preemption, **1:376**

**FERTILE SOURCE OF ERROR**

Inequitable conduct, **6:5**

**FEW MACHINES HAVE NO UTILITY**

Prima facie obviousness, **9:17**

**FFDCA**

**Federal Food, Drug, and Cosmetic Act** (this index)

**FICTITIOUS FACTS**

Stipulation, **13:68**

**FIELD OF ENDEAVOR TEST**

Analogous art, **9:256**

**FIELD OF USE**

Standing of licensee, **9:301**

**FILE BRIEF**

Generally, **7:23**

**FILE HISTORY ATTORNEY**

Claim interpretation, **9:94**

**FILE HISTORY ESTOPPEL**

Anticipation definition, **4:15**

Claim interpretation, **18:29**

**FILE WRAPPER**

Doctrine of equivalents, **9:108**

Estoppel, **21:66**

Inventor's theory, **6:10**

Prosecution history estoppel, **4:26**

Summary judgment, **10:13**

**FILING**

CIP (continuation-in-part application.)

**Continuation-in-Part Application** (this index)

Complaint, jurisdiction, **7:38; 13:59; 19:66**

## INDEX

### **FILING—Cont'd**

- Counterclaim, immunity, **19:141**
- Disclaimer, reissue, **22:15**
- First-filed suit rule, **6:89; 7:25**
- Interference, **16:9**
- Late filing, Board, **18:56**
- Motions
  - Executive Order 10096, **8:10**
  - FRCP 41(a)(1), **5:18**
- Only as of issue date of patent, **9:53**
- Party's argument will not be addressed, **10:18**
- Performance of government contract, filing application, **8:8**
- Reexamination, **9:180**
- Timeliness of
  - appeal dismissal, **10:3**
  - broadening reissue, **9:3**
  - first business day after weekend or holiday, filing made on, **23:28**
  - reissue, broadening reissue, **9:3**

### **FILING DATE**

- CIP, **5:20; 20:35; 20:59**
- Claim Construction and Interpretation** (this index)
- Description, **19:120**
- Earlier Filing Date** (this index)
- Enablement, **5:45**
- First business day after weekend or holiday, **23:28**
- Interference, **6:20; 19:144; 19:164**
- Mandamus, **9:54**
- Microbiology field, **9:53**
- On-sale bar, **1:97; 4:93; 20:102**
- Priority filing date, **9:258**
- Sec. 102(d), **9:136**
- Sec. 111, **19:32**
- Sec. 112, **18:4; 23:11**
- Sec. 119, **9:143**
- Sec. 120, **5:104; 11:8; 20:33**

### **FINAL DECISION**

- Appeal without-prejudice dismissal, **8:82**
- Director of Board of Patent Appeals and Interferences, **2:150**

### **FINAL DISPOSITION**

- FRCP 54(b), **1:289; 8:55**

### **FINALITY**

- Appealability, **13:23**
- Appellate jurisdiction, **9:300**
- Law of the case doctrine, **19:14**

### **FINAL JUDGMENT**

- Generally, **14:40; 16:90; 16:177; 19:175; 23:60**
- Cohen collateral order exception, **20:28**
- Collateral order, Cohen collateral order exception, **1:302; 20:28**
- Covered business method review, **9:415; 21:71**
- Dismissal, **16:62**
- Exception, Cohen collateral order exception, **20:28**
- Form, consent to, **20:98**
- FRCP 60(b)(2), **19:14**
- Interference estoppel by judgment, **23:14**
- Jurisdiction, **18:104**
- Nullification, **9:354**
- Order staying case, **19:110**
- Partial summary judgment, **3:86**
- Preliminary injunction, **9:304**
- Reexamination, **5:25; 6:84; 6:85; 9:353**
- Sec. 1292(c)(2), **13:8**
- Stay, **9:415**
- Staying, order staying case, **19:110**
- Summary judgment, **21:29**
- Withdrawal of claims, **19:233**

### **FINAL ORDER**

- Summary judgment, denial of, **12:41**

### **FINDINGS**

- Generally, **8:22; 13:12**
- Attorney fees, **3:46**
- Board, **9:195**
- Claims court, **3:49**
- Clearly erroneous standard, **9:80**
- Doctrine of equivalents, **3:39**
- FRCP 41(b) motion, FRCP 50 vs. FRCP 41(b) motion, **12:11**
- FRCP 50 vs. FRCP 41(b) motion, **12:11**
- FRCP 52(a), **3:45; 12:13; 13:16; 16:25**
- Improper, **21:2**
- Interference, **4:11; 7:48**
- Is obvious, **18:22**
- Issue preclusion, **4:9**
- ITC, **1:17; 8:28**
- Jury verdict, **20:39**

**FINDINGS—Cont'd**

Motion, FRCP 50 vs. FRCP 41(b), **12:11**  
 Preliminary injunction, denial of, **12:16**  
 Review, standard of, **7:27; 7:33; 9:217**  
 Sec. 112, **8:7**  
 Sec. 271(e)(1), **5:13**

**FINES**

**Sanctions** (this index)

**FINE TUNING**

Offer for sale, **19:130**

**FINJAN LLC V. SONICWALL, INC.**

2023, **6:108**

**FINTIV, INC. V. PAYPAL HOLDINGS, INC.**

2025, **6:111**

**FIRST-FILED**

Generally, **6:89; 7:25; 17:2**  
 Customer suit exception, **19:230**  
 Stay order, **11:1**

**FIRST IDENTIFY CLAIMED FUNCTION**

Means-plus-function claim, **12:62; 13:100**

**FIRST MENTIONED IN REPLY BRIEF**

Issue on appeal, **23:23**

**FIRST SALE DOCTRINE**

Generally, **6:59**  
 Exhausts patent rights, **13:67**  
 Foreign products, **10:27**  
 Timeliness of appeal filing, **2:5**

**FITNESS FOR INTENDED USE**

Bright-line test, **6:23**

**FIXED IDEAS**

Conception, **13:72; 20:65**

**FIXED SUM**

Attorney fees award, **19:57**

**FLAGRANT**

**MISREPRESENTATIONS OF RECORD**

Conduct of counsel, **16:9**

**FLAWED OPINION OF COUNSEL**

Willful infringement, **19:92**

**FNERDA (FEDERAL NONNUCLEAR ENERGY RESEARCH AND DEVELOPMENT ACT )**

Research performed under government contract, **6:18**

**FOCUS ON ONE FACET**

Invention to be considered as a whole, **18:28**

**FOOD, DRUG, AND COSMETIC ACT**

**Federal Food, Drug, and Cosmetic Act** (this index)

**FOOD AND DRUG**

**ADMINISTRATION**

**FDA** (this index)

**FORCE OF LAW**

**MPEP**, **18:1**  
 Sec. 6(a), **23:15**

**FOREIGN CORRUPT PRACTICES ACT**

Sec. 292, qui tam provision, **2:151**

**FOREIGN COUNTRIES**

Generally, **8:42; 12:13**  
 Burying reference in prior art statement, **13:69**

Choice of law, **6:78**

Claim interpretation, **3:7**

Damages, **20:23**

Date of invention, **9:61**

Declaration, **19:118**

Discovery, **3:65**

First sale doctrine, **10:27**

FRCP 52(a), **13:16**

German Geschmacksmuster as prior art reference under Sec. 102(a), **9:120**

Interference, **6:20; 6:66**

ITC, **13:20**

Jurisdiction, **7:60; 22:36**

**MPEP**, **16:6**

New prior art not considered by PTO, **5:11**

Offer for sale, infringement, **8:129**

Ownership, **1:172; 9:238**

Personal jurisdiction, **1:181; 1:186; 1:189; 2:142; 8:79; 14:15**

Preliminary injunction, **19:32**

Prior art, German Geschmacksmuster as prior art reference under Sec. 102(a), **9:120**

## INDEX

### **FOREIGN COUNTRIES—Cont'd**

- Reference, **9:120; 17:1**
- Reissue, claim construction, **1:209**
- Sec. 102(a), **9:120**
- Sec. 102(g), **19:10**
- Sec. 104, **8:30**
- Sec. 112, **17:1**
- Sec. 119, **2:125; 6:66; 9:143; 19:144**
- Sec. 271(f), **21:52**
- Subject matter jurisdiction, **12:81**
- Summary judgment, **20:38**

### **FOREIGN SALES**

- Patent exhaustion, **12:107**

### **FORESEEABILITY**

- Generally, **8:43**
- Damages, **7:63; 13:79**
- Doctrine of equivalents, **6:52; 6:64**
- Prosecution history estoppel, **4:96**
- Unexpected Results** (this index)

### **FORESEEABILITY PLUS TEST**

- Personal jurisdiction plus something more, **1:221**

### **FORFEITURE**

- Generally, **9:492; 12:27**

### **FORGERY**

- Fraudulent conduct, **6:22**

### **FORM**

- Final judgment, **20:98**
- Jury verdict, **22:4**

### **FORM 8**

- Complaint, **11:73**

### **FORM 16**

- Complaint, **13:142**

### **FORM 18**

- State claim, motion to dismiss for failure to, **12:114**

### **FORMER**

- See index topics beginning: **“Prior”**

### **FORM-OF-CLAIM REQUIREMENT**

- Sec. 1.153, **9:137**

### **FORUM NON CONVENIENS**

- Generally, **2:116; 8:136**
- Public interest factors, **13:58**

### **FOUND**

- Abuse of discretion, **2:27**

### **FOUNDRY ARRANGEMENT**

- Semiconductor chip, **9:145**

### **FRAP**

- Sec. 1927, **1:41**

### **FRAP 2**

- Summary disposition of appeal, **10:20**

### **FRAP 3**

- Notice of appeal, **9:317**

### **FRAP 3(c)**

- FRAP 4(a)(4), **4:25**
- Notice of appeal, **2:46**

### **FRAP 4**

- Timeliness of appeal filing, **9:317**

### **FRAP (4)**

- Generally, **19:170**

### **FRAP 4(a)**

- FRCP 7(b)(1), **18:25**
- Timeliness of appeal filing, **2:5**

### **FRAP 4(a)(2)**

- Appeal and review, **16:110**

### **FRAP 4(a)(4)**

- Generally, **11:38**
- Appeal and review, **10:14**
- FRAP 3(c), **4:25**
- Notice of appeal, **10:14**
- Renders of no effect any prior notice of appeal, **10:14**

### **FRAP 4(a)(5)**

- Generally, **20:132**

### **FRAP 25**

- CD-ROM, **25:5**

### **FRAP 28(a)(6)**

- Generally, **7:60**

### **FRAP 28(e)**

- Generally, **12:11**
- Admissibility of evidence, failure to argue, **12:11**
- Citation to record, need for, **12:22**

### **FRAP 28(g)**

- Page limit, circumvention of, **12:22**

**FRAP 30(b)**

Raising issues, only issues raised in appellant's statement may properly be presented on appeal, **6:10**

**FRAP 35**

Generally, **9:182**

**FRAP 36**

Collateral estoppel, **16:160**

**FRAP 38**

Design patent, **19:8**  
 Frivolous appeal, **1:28; 2:31; 3:40; 3:42; 4:36; 5:14; 6:16; 13:43; 14:16; 16:4; 18:24; 18:27; 19:42; 19:57; 19:87**  
 Infringement, **12:22; 16:4**  
 Injunctions, **16:29**  
 Jury verdict, **3:17**  
 Meaning, **16:4**  
 Purpose, **16:29**  
 Representative claims, **16:4**  
 Review, standard of, **16:29**  
 Sanctions, **9:102**  
 Settlement agreement, **19:1**

**FRAP 39**

Costs award, **11:24**

**FRAP 39(a)**

FRAP 39(b), **18:19**

**FRAP 39(b)**

FRAP 39(a), **18:19**

**FRAP 39(c)**

Appeal, reimbursable costs on, **3:29**

**FRAP 41**

Cause for stay, **1:349**

**FRAP 47.6(b)**

Generally, **2:72**

**FRAP 50**

Generally, **9:185**

**FRAP 289(c)**

Generally, **5:37**

**FRAUD**

Generally, **12:3**  
 Abused, much, **16:25**  
 Antitrust, **3:83; 14:25; 16:48**  
 Fraud upon the court, **1:163**

**FRAUD—Cont'd**

Inequitable conduct, **5:5; 6:4; 6:5; 10:2; 11:4; 18:19**  
 Intent, specific intent to deceive, **6:28**  
 Interference, **4:21**  
 Jury, **1:16**  
 Law of the case doctrine, **19:14**  
 Malpractice, **12:96**  
 Obviousness, **22:1**  
 Ownership, **13:150**  
 Patent prosecution, applied to, **3:83**  
 Sec. 282, **8:23**  
 Sec. 285, **15:3**  
 Specific intent to deceive, **6:28**

**FRAUDS, STATUTE OF**

Settlement agreement, **19:40**

**FRAUDULENT CONCEALMENT**

Generally, **19:93**

**FRAUDULENT CONDUCT**

False and forged documents, **6:22**

**FRAUDULENT INDUCEMENT**

Due process clause, **18:69**

**FRAUDULENT NON-DISCLOSURE**

Preemption, **21:30**

**FRAUNHOFER-GESELLSCHAFT  
 ZUR FORDERUNG DER  
 ANGEWANDTEN FORSCHUNG  
 E.V. V. SIRIUS XM RADIO INC.**

2025, **6:112**

**FRCP**

Generally, **5:78; 19:16**  
 All civil actions, generally, **3:38**  
 Choice of law, **19:16**  
 CIT, procedural rule corresponds to  
 FRCP, **5:18**  
 Interpretation, **23:34**  
 New trial, motion for, **18:111**

**FRCP 4**

Personal jurisdiction, **13:181**

**FRCP 4(k)(2)**

Generally, **19:212; 19:215**  
 Personal jurisdiction, **13:234**

**FRCP 7(b)(1)**

FRAP 4(a), **18:25**

## INDEX

### **FRCP 8**

Statement of claim, **9:356**

### **FRCP 8(a)(2)**

Doctrine of equivalents, **14:91**

FRCP 12(b)(6), **14:91**

Inducement, **14:91**

Short and plain statement of claim,  
**11:73**

### **FRCP 8(c)**

Affirmative defense, **3:24**

Double patenting, **3:4**

### **FRCP 11**

Generally, **1:121**

Attorney's inquiry reasonable under  
circumstances, **18:95**

Bad faith, **4:88**

Choice of law, **22:14**

Infringement analysis, **22:22**

Review, standard of, **1:42; 8:75; 16:76;**  
**19:87**

Sanctions, **1:41; 3:150; 5:109; 9:125;**  
**18:24; 18:95**

### **FRCP 12(b)**

Generally, **2:69; 18:54**

Joint infringement, **12:112**

Rule 12(b)(1) versus Rule 12(b)(6), **8:66**

### **FRCP 12(b)(1)**

Rule 12(b)(6) versus, **8:66**

Subject matter jurisdiction, lack of, **1:7**

### **FRCP 12(b)(4)**

Generally, **8:45**

Claims court, **13:56**

### **FRCP 12(b)(6)**

Generally, **1:45; 1:143; 3:95; 3:229.50;**  
**16:62; 16:81; 21:38; 24:3**

Claim construction and interpretation,  
**15:56**

Dismissal, **1:42; 3:147; 7:90; 19:237;**  
**23:29**

Doctrine of equivalents, **14:91**

FRCP 8(a)(2), **14:91**

Inducement, **14:91**

Motion to dismiss, **1:54; 1:248; 2:41;**  
**19:237; 23:29**

Res judicata, **7:99**

Rule 12(b)(1) versus, **8:66**

### **FRCP 12(b)(6)—Cont'd**

State claim, failure to, **2:41; 7:99;**  
**8:102; 19:237; 23:29**

State claim, motion to dismiss for failure  
to, **2:41; 7:99; 8:102; 12:114;**  
**19:237; 23:29**

### **FRCP 12(b)(7)**

Dismissal, **1:45**

Dismissal without prejudice, **21:56**

### **FRCP 12(f)**

Materials outside pleadings,  
consideration of, **4:13**

### **FRCP 12(g)(2)**

Venue, **9:447**

### **FRCP 12(h)(1)(A)**

Venue, **9:447**

### **FRCP 13(a)**

Generally, **7:56; 21:24; 22:18**

Compulsory counterclaim, **2:36**

28 USC § 2202, exception of, **16:81**

### **FRCP 15**

FRCP 21, **11:18**

Motion to amend pleadings, **3:24**

### **FRCP 15(a)**

Generally, **6:27; 6:28; 11:58**

Amending pleading, **20:5; 20:24**

Busy court need not allow to be imposed  
upon by presentation of theories  
seriatim, **20:5**

FRCP 21, **4:28**

### **FRCP 15(b)**

Generally, **19:105**

Amendment of pleadings, **2:40**

Choice of law, **19:105**

### **FRCP 15(c)**

Adding party, amendment of complaint  
to add party, **6:11**

Advocacy, **6:11**

Amendment of complaint to add party,  
**6:11**

Bed of its own making, **6:11**

Complaint, amendment of complaint to  
add party, **6:11**

Corporate officers and directors, **6:11**

Due process, **6:11**

Personal liability, **6:11**

**FRCP 15(c)—Cont'd**

- Road tryout, not, **6:11**
- Scattergun approach, **6:11**
- Trial should be main event, **6:11**

**FRCP 16**

- Pretrial order, **19:14**

**FRCP 19**

- Joinder of patentee with exclusive licensee, **9:71**

**FRCP 19(a)**

- Generally, **1:68**
- Dismiss, motion to dismiss, **22:8**
- Involuntary joinder, **11:19; 19:264**
- Motion to dismiss, **22:8**
- Standing, **9:302**
- Voluntariness, involuntary joinder, **11:19; 19:264**

**FRCP 19(b)**

- Patent holding subsidiary, **4:49**

**FRCP 21**

- Generally, **1:135; 13:101**
- Appellate jurisdiction, lack of, **1:31**
- FRCP 15, **11:18**
- FRCP 15(a), **4:28**
- Mandamus review, **9:359**

**FRCP 24**

- Motion to intervene, **3:38**

**FRCP 24(b)**

- Intervention, **8:36**
- Motion to intervene, **8:36**

**FRCP 25(a)**

- Alter ego, **13:25**
- In personam jurisdiction, **13:25**
- Piercing corporate veil, **13:25**
- Venue, **13:25**

**FRCP 26**

- Abuse of discretion defined, **8:9**
- Appellate review, standard for, **8:9**
- Burden, heavy burden, **8:9**
- Defined, abuse of discretion defined, **8:9**
- Disclosure, **3:141; 18:102**
- Discovery, **23:76**
- Discretion, abuse of discretion defined, **8:9**
- Heavy burden, **8:9**

**FRCP 26(a)**

- Disclosure of written expert report, **13:183**

**FRCP 26(c)**

- FRCP 45(d), **13:37**

**FRCP 26(c)(7)**

- Choice of law, **1:19**

**FRCP 26(e)**

- FRCP 37(b), **18:22**

**FRCP 36**

- Imposition of discovery sanctions, **18:94**

**FRCP 37**

- Abuse, discovery abuse, **7:23**
- Attorney, pro se lawyer, **16:71**
- Choice of law, **16:71; 21:69**
- Discovery abuse, **7:23**
- Dismissal of action, **18:24**
- Pro se lawyer, **16:71**
- Regional circuit law, **21:69**

**FRCP 37(a)(4)**

- Abuse of discovery, **13:48**
- Discovery abuse, **13:48**

**FRCP 37(b)**

- Discovery sanctions, **20:4**
- Dismissal of complaint for failure to comply with discovery deadlines, **23:34**
- FRCP 26(e), **18:22**
- Sanctions, **14:14**

**FRCP 37(c)**

- Ex parte test, **3:10**

**FRCP 41(a)**

- Voluntary dismissal without prejudice, **18:76**

**FRCP 41(a)(1)**

- Voluntary dismissal when neither answer nor summary judgment motion filed, **5:18**

**FRCP 41(a)(1)(B)**

- Inducement, **1:279**
- Sec. 1498, **1:279**

**FRCP 41(b)**

- Generally, **11:35**
- Findings, **12:11**

INDEX

**FRCP 41(b)—Cont'd**

Sec. 102(b), **19:31**

**FRCP 42(b)**

Appellate jurisdiction, lack of, **1:31**

Mandamus, **9:41**

**FRCP 45**

Quashing of discovery of nonparty,  
**11:24**

**FRCP 45(d)**

FRCP 26(c), **13:37**

**FRCP 49(a)**

Generally, **2:49; 7:27**

Jury verdict, **19:5**

Special verdict, **19:37; 23:1**

Validity of claims not infringed, **19:21**

Waiver of jury trial, **19:21**

**FRCP 49(b)**

Inconsistent jury findings, **1:50**

Jury instructions, **19:60**

Jury verdict, **13:4**

**FRCP 50**

Findings, **12:11**

Motion for judgment as matter of law,  
**7:27**

**FRCP 50(a)**

Generally, **1:71; 2:49; 5:77; 10:35;**  
**13:72**

Directed verdict motion, **2:31**

JMOL, **2:48**

Judgment as a matter of law, **2:34**

Jury, **11:12**

**FRCP 50(a)(1)**

Generally, **3:98; 5:21**

JMOL, **16:106**

**FRCP 50(b)**

Generally, **6:98; 7:27; 8:52; 14:25**

JMOL motion, **13:54**

JNOV, prerequisite for, **23:25**

JNOV motion, **1:43**

Motion for judgment, **2:33**

**FRCP 51**

Generally, **1:101; 5:73; 18:70; 19:60;**  
**19:185**

Choice of law, **5:60**

Jury instructions, **12:20**

**FRCP 51—Cont'd**

Means-plus-function, **12:106**

**FRCP 52**

Generally, **20:40**

**FRCP 52(a)**

Generally, **11:32; 18:63**

Adopted findings, **12:13**

Appeal and review, **3:45; 12:6; 16:25**

As a whole, invention, **12:6**

Blonder-Tongue, **1:13**

Claim interpretation, **3:7**

Clear, meaning clear in specification,  
**12:6**

Conclusions of law, **3:45**

Contributory infringement, **7:82**

Damages, increased, **1:18**

Damages methodology, **19:4**

Disclosure, use of inventor's testimony  
to supplement, **12:6**

Fact findings, **12:6; 19:4**

Factual findings, **1:18; 13:16**

Findings, **3:45; 12:13; 13:16; 16:25**

Foreign proceedings not relevant, **13:16**

FRCP 65, **4:14**

Lexicographer, **12:6**

Meaning clear in specification, **12:6**

Need for findings, **1:52**

Preliminary injunction, **3:12; 15:5;**  
**16:26**

Remand necessary when inadequate  
factual findings, **1:59**

Review, standard of, **3:39**

Royalty offered when coupled with  
infringement charge, **1:18**

Specification, meaning clear in, **12:6**

Specific factual findings, failure to  
make, **13:16**

Summary judgment, **20:26**

Trial court, **3:45**

Willful infringement, **1:18**

Witnesses, **12:6**

**FRCP 52(b)**

Generally, **7:88**

**FRCP 52(c)**

Generally, **25:7**

**FRCP 53(e)**

Generally, **6:26**

**FRCP 54**

Generally, **11:85; 16:87**  
 Entry of single judgment order for all claims not necessary, **6:16**

**FRCP 54(b)**

Generally, **14:40; 19:155; 19:301**  
 Certification, **19:141; 19:191; 23:24**  
 Final disposition, **8:55**  
 Motion in limine, **21:41**

**FRCP 54(d)**

Generally, **11:58**  
 Costs award, **4:32; 15:32**

**FRCP 54(d)(1)**

Generally, **18:55; 19:190**

**FRCP 56**

Generally, **4:79; 14:18**  
 High degree of confidence and trust between PTO and patent applicants, **10:5**  
 Material information defined, **13:158**  
 Summary judgment, **2:29; 9:89; 13:36; 16:28; 16:32; 19:44**

**FRCP 56(c)**

Generally, **2:52; 3:103; 19:135**  
 Claim differentiation, **8:27**  
 Claim interpretation, **8:27**  
 Doctrine of equivalents, **8:27**  
 Exclusion, expansion of right to exclude, **8:27**  
 Expansion of right to exclude, **8:27**  
 Infringement, summary judgment of noninfringement, **3:52; 9:131**  
 Summary judgment, **3:36; 3:52; 4:26; 8:27; 9:131; 11:25; 16:35; 18:28; 21:13**  
 Term thereof, **8:27**

**FRCP 56(d)**

Partial summary judgment, **7:5**

**FRCP 56(e)**

Generally, **19:135**  
 Ex parte test, **3:10**  
 Summary judgment, **3:1**

**FRCP 56(f)**

Generally, **19:93**  
 Abuse of discretion, **13:154**  
 Choice of law, **14:50**

**FRCP 56(f)—Cont'd**

Rejection of submissions, **2:80**  
 Submissions, rejection of, **2:80**  
 Summary judgment, oppose, **11:7**  
 Summary judgment appropriateness, **19:20**

**FRCP 59**

Generally, **11:38; 12:43; 12:61; 21:43**  
 Order ambiguous, **19:50**  
 Willful infringement, **3:26**

**FRCP 59(a)**

Generally, **1:101**

**FRCP 59(e)**

Generally, **1:102; 6:98; 13:123**  
 Limitations, **19:42; 19:58**  
 Mootness, **19:42**  
 Motion for prejudgment interest, **10:14**  
 Post-judgment motion, **2:46; 4:25**  
 10 day limit on modifying judgment, **19:42**  
 Time limit, **19:58**  
 Vacating judgment of invalidity and unenforceability when noninfringement finding undisturbed, **19:42**

**FRCP 60**

Generally, **11:38**

**FRCP 60(a)**

FRCP 60(b), **21:19**  
 Post-judgment relief, **16:37**

**FRCP 60(b)**

Generally, **5:78; 7:32; 22:23**  
 Appeal, untimely, **3:5**  
 Choice of law, **6:49; 13:93**  
 Consent, **23:23**  
 Damages, **1:20**  
 Default judgment, **9:144**  
 FRCP 60(a), **21:19**  
 Injunction, **23:23**  
 Judgment, relief from, **1:29; 13:59**  
 Master, **16:54**  
 Modification of injunction under consent under entered pursuant to settlement, **23:23**  
 Motion, **2:43; 6:22; 9:144**  
 Post-judgment relief, **16:37**  
 Set aside, motion, **6:22**  
 Settlement, **23:23**

## INDEX

### **FRCP 60(b)—Cont'd**

Untimely appeal, **3:5**

### **FRCP 60(b)(2)**

Final judgment, relief from, **19:14**

### **FRCP 60(b)(3)**

Fraud upon court, **1:163; 3:229**

### **FRCP 60(b)(6)**

Generally, **6:49**

Choice of law, **6:49**

Motion to modify consent judgment,  
**3:29**

### **FRCP 61**

Generally, **1:101; 19:94**

Harmless error, **4:7**

### **FRCP 65**

FRCP 52(a), **4:14**

Injunction, **7:3**

### **FRCP 65.1**

Motion to execute on bond, **2:30**

### **FRCP 65(d)**

Generally, **1:75; 1:88; 9:270; 15:20**

Injunction, **1:53; 5:4**

### **FRCP 68**

Generally, **19:99**

### **FRCP 79(a)**

Separate document, **5:45**

### **FRCP 391(c)(1)**

Advisory jury, **11:69**

### **FRCP FORM 18**

Pleading requirements, **19:237**

Sample complaint for direct patent  
infringement, **9:356**

### **FRE 103(a)(1)**

Estoppel, **23:27**

### **FRE 403**

Generally, **13:53; 13:81; 25:4**

Dead inventor's videotape deposition,  
**13:4**

Discretion of court, **7:5**

### **FRE 407**

Generally, **16:40**

### **FRE 408**

Generally, **14:18**

### **FRE 501**

Privileges, **9:362**

### **FRE 701**

Generally, **19:59**

### **FRE 702**

Generally, **13:121; 19:209**

Damages award, **12:88**

### **FRE 705**

Expert opinion, **19:38**

Prima facie case of infringement, **19:59**

### **FRE 706**

Generally, **20:62**

Appointment of expert, **13:163**

Examiners as expert witnesses, **7:21**

Expert or opinion evidence, **13:161**

### **FRE 801(C)**

Hearsay, **23:27**

### **FRE 803(6)**

Generally, **23:101**

### **FRE 803(24)**

Generally, **3:67**

### **FRE 804(B)(5)**

Generally, **3:67**

### **FREEDOM TO LICENSE**

Co-inventors, **19:98**

### **FREEMAN-WALTER-ABELE TEST**

Generally, **1:95; 19:112**

### **FRESHUB, INC. V. AMAZON.COM, INC.**

2024, **6:110**

### **FRIVOLITY OR FRIVOLOUSNESS**

Mandamus, **9:68**

Rehearing, request for, **9:97**

### **FRIVOLOUS APPEAL**

Generally, **14:19**

Appellate jurisdiction, **3:11**

Attorney fees, **16:20; 18:11; 20:16**

CAFC, **2:11**

Clear-cut grounds, based on, **19:90**

FCR 38, **8:37**

FRAP 38, **1:28; 2:31; 3:40; 3:42; 4:36;**

**5:14; 6:16; 13:43; 14:16; 16:4;**

**18:24; 18:27; 19:42; 19:57; 19:87;**

**23:89**

**FRIVOLOUS APPEAL—Cont'd**

JNOV, **22:4**  
 Jury verdict, **3:17**  
 New argument, **13:46**  
 Non-final order, **18:11**  
 Pro se litigant, **2:38**  
 Sanctions, **3:150; 5:96; 13:71**  
 Settlement agreement, **19:1**  
 Standard, **19:127**  
 Unsupported allegation, **1:52**  
 Venue, **23:98**

**FS.COM INC. V. INTERNATIONAL  
 TRADE COMMISSION**

2023, **6:109**

**FULL AND FAIR OPPORTUNITY TO  
 LITIGATE**

Collateral estoppel, **2:50; 16:57**

**FUNCTIONAL ASPECTS**

Design patent, **5:21**

**FUNCTIONALITY**

Construction, **2:154**  
 Design patent, **12:32; 18:29**  
 Preliminary injunction, **2:16**  
 Suggestion or motivation to modify,  
 must be, **9:101**

**FUNCTIONAL LANGUAGE**

Apparatus claims, **20:110**  
 Claim interpretation, **1:124**

**FUNCTIONAL LIMITATION,**

Means-plus-function claim, **23:54**

**FUNCTIONAL RECITATION**

Generally, **9:201**

**FUNCTIONAL RELATIONSHIP**

Obviousness, **9:32**

**FUNCTIONAL REQUIREMENTS**

Preliminary injunction, **3:34**

**FUNCTION-WAY-RESULT TEST**

Doctrine of equivalents, **19:52; 19:199**

**FUNDAMENTAL PRINCIPLE**

Sec. 101, **1:95**

**FUTILITY**

Interference, **13:31**

**FUTURE ACTS AND MATTERS**

Claims must be construed same way,  
**23:11**  
 Escrow, **3:21**  
 Interference, **18:49**  
 Lost profits, **19:137**  
 Lost sales, **6:74**  
 Sec. 286, **19:27**

**GALDERMA LABORATORIES, L.P. V.  
 LUPIN INC.**

2024, **7:145**

**GENERALIZED TESTIMONY**

Doctrine of equivalents, **3:80**

**GENERAL VERDICT**

Generally, **12:20; 19:259**  
 CAFC, **18:3**

**GENERIC, TRADEMARK**

Patent misuse, **23:9**

**GENERIC CLAIM**

Generally, **1:44**  
 Premarketing approval, Sec. 271(e)(1),  
**3:159**  
 Sec. 102(e), **9:28**

**GENERIC FORMULA**

Chemical compound, **9:148**

**GENUINE ISSUE**

Design patent, **16:17**

**GENUS**

Generally, **9:126**  
 Claim preamble, **3:22**  
 Interference, **9:88**  
 Obviousness, **3:167**  
 Species, **2:107; 18:40**  
 Written description, **2:143; 2:144**

**GERM**

Enablement, **7:50**

**GERMAN GESCHMACKSMUSTER**

Prior art reference under sec. 102(a),  
**9:120**

**GIST**

Additional components, **12:18**  
 Heart, **22:7**  
 Heart of invention, **23:11**

## INDEX

### **GOOD CAUSE**

Evidence, **8:35**  
Exception under APA, **14:17**  
Later submission of evidence, **8:35**  
New interference rules, **8:3**

### **GOOD FAITH**

Additional components, **12:18**  
Administrative law, **13:70**  
Anticipation, **18:20**  
Common law definition thereof, **1:64**  
Contract law, **12:39**  
Explanation of failure to disclosure,  
**6:80**  
FRCP 11, **4:88**  
Induced infringement, invalidity, **3:185**  
Inequitable conduct, **11:3; 13:138**  
Inventorship, **3:59**  
Notice, **7:92**  
PTO rejection of claims, **1:43**  
Summary judgment, **16:54**

**GOOGLE LLC V. ECOFACTOR, INC.**  
2024, **7:146**

### **GORHAM**

CIP, **12:17**  
Continuation, **12:17**  
Design patent, **12:29; 15:5; 16:33; 19:8**  
Design patent infringement, **2:33**  
Infringement, generally, **12:32**  
Novelty must be appropriated, **12:17**  
Summary judgment, **1:35**  
Trade dress, **12:17**

### **GOVERNING LAW**

**Conflict of Laws** (this index)

### **GOVERNMENT**

Contract, **4:59**  
Equitable estoppel doctrine, **26:8**  
FNERDA, **6:18**  
Just compensation, **8:116; 12:27**  
Prejudgment interest, **19:83**  
Regulation, **19:63**  
Sec. 207(a)(2), **14:9**  
Sec. 1498, **9:398; 20:18**  
Sec. 2412(b), **13:48**

### **GOVERNMENT CONTRACT**

Patent right clause, **8:8**  
Sovereign act doctrine as defense, **8:41**

### **GOVERNMENT EMPLOYEES**

Executive Order 10096, **8:10**

### **GOVERNMENT LIABILITY**

Method claims, **26:10**

### **GOVERNMENT OFFICIALS**

Administrative law, **13:70**  
Regulations, **19:78**

### **GRAHAM**

Generally, **9:170; 13:17**  
Obviousness, **2:8; 3:30; 19:244**  
Rule 131 affidavit, **7:19**  
Secondary considerations, **13:17**

### **GRAMMATICAL STRUCTURE AND SYNTAX**

Interference, **1:117**

### **GRAVER TANK**

Abstractions, **20:6**  
Doctrine of equivalents, **12:28; 13:39; 16:11**  
Entirety of technology test, **20:6**  
Inventing around, **20:6**  
Same result, **20:6**

### **GROSS NEGLIGENCE**

Inequitable conduct, **3:104; 6:4; 8:26; 14:8**  
Intent to mislead, **2:68**

### **GUARANTEE**

Same invention-type, **19:39**

### **GVR ORDER**

Generally, **6:39; 8:65**

### **H. LUNDBECK A/S V. LUPIN LTD.**

2023, **8:166**

### **HAEC VERBA**

Description, **3:103**

### **“HALF THE PRACTICE OF A DECENT LAWYER”**

Root or roots, **1:20; 12:24; 16:4**

### **HARD AND FAST RULE**

Claim differentiation, **19:157**

### **HARDWARE AND SOFTWARE**

Interchangeability, **15:16**

### **HARMFUL ERROR**

JNOV, **22:4**

**HARMFUL ERROR—Cont'd**

Procedural errors, **4:37**

**HARMLESS ERROR**

Claim interpretation, **19:15**

FRCP 61, **4:7**

Summary judgment, **3:1**

**HARMONIZATION**

Enforcement, **22:36**

**HARM TO REPUTATION**

Adequacy of monetary damages, **18:32**

**HARSH REMEDY**

Dismissal, **7:52**

**HATCH-WAXMAN ACT**

Generally, **1:120; 5:144; 13:144**

Anticipation, **21:76**

Claim construction and interpretation,  
**19:314**

**Doctrine of Equivalents** (this index)

Double patenting, **21:76**

Obviousness, **21:76**

Patent information, **14:62; 14:63**

Subject matter jurisdiction, **3:159;**  
**19:247**

**HAVING**

Generally, **3:96**

**HAWK TECHNOLOGY SYSTEMS,  
LLC V. CASTLE RETAIL, LLC**

2023, **8:167**

**HD SILICON SOLUTIONS LLC V.  
MICROCHIP TECHNOLOGY  
INC.**

2025, **8:169**

**HEADINGS**

Statutory interpretation, **7:25**

**HEARING**

Generally, **1:41**

Markman hearing, **5:100**

Panel hearing or rehearing en banc,  
**11:67**

**HEARSAY**

Generally, **1:70**

Ex part proceeding, use in PTO proceed-  
ing, **9:150**

FRE 801(c), **23:27**

PTO ex part proceeding, use in, **9:150**

**HEART**

Essential elements, **5:10**

Gist, **22:7; 23:11**

Inspection of patentee's product, **16:15**

Obviousness, **16:41**

Sec. 102(g), **19:10**

**HEAVY BURDEN**

FRCP 26, **8:9**

Obviousness question, **16:19**

Reasonable royalty, **8:51**

Validity, **23:48**

**HEAVY LINES**

Sec. 1.84, **9:137**

**HEAVY PRESUMPTION**

Claim interpretation, **5:70; 18:67; 20:63**

**HIGH DEGREE OF CONFIDENCE  
AND TRUST BETWEEN PTO  
AND PATENT APPLICANTS**

Generally, **10:5**

Materiality, **10:5**

Rule 56, **10:5**

**HIGHLY RELEVANT PRIOR ART**

Inequitable conduct, **13:69**

**HINDSIGHT**

Claim differentiation, **11:2**

Claim interpretation, **19:15**

Combination patent, **13:15**

Infringement, **7:10**

Obviousness, **3:103; 3:109; 4:91; 5:47;**  
**9:274; 13:185; 15:42; 16:4; 19:92;**  
**21:8**

Reference, **9:16**

Template, use as, **9:114**

Use as template, **9:114**

**HIP, INC. V. HORMEL FOODS  
CORPORATION**

2023, **8:168**

**HIRED TO INVENT**

Standing, **10:47**

**HISTORY ATTORNEY**

Claim interpretation, **9:94**

**HOLDER OF LEGAL TITLE**

Standing, **1:68**

**HOLDING OF PATENT**

Collateral estoppel, **4:3**

## INDEX

**HONEYWELL INTERNATIONAL  
INC. V. 3G LICENSING, S.A.**  
2025, **8:170**

**“HOW TO DO IT”**  
Sec. 145, **7:9**

**“HOW TO MAKE”**  
Interference, **13:3**

**“HOW TO USE”**  
Enablement, **14:4**

**HUMAN**  
Doctrine of equivalents, **7:28**

**HYBRID NATURE**  
Interference, **3:6**

**HYBRID SEC. 102**  
Anticipation, **9:104**

**HYPOTHETICAL CLAIM**  
Generally, **21:32**  
Anticipated by single prior art reference,  
**1:115**  
Doctrine of equivalents, **23:17**  
Wilson, **9:146**

**HYPOTHETICAL COMBINATIONS**  
Claim differentiation, **11:2**

**HYPOTHETICAL INVENTOR**  
Ordinary skill, hypothetical person for,  
defined, **19:26**

**HYPOTHETICAL JUDICIAL  
STATEMENTS**  
Collateral estoppel, **1:3**

**HYPOTHETICAL NEGOTIATION**  
Reasonable royalties, **12:90; 16:129**  
Sec. 284, **1:296**

**IDEAS**  
Generally, **10:8**  
Analysis begins with claims, **10:8**  
Conception, **13:72; 20:65**

**IDENTICAL ACTS AND MATTERS**  
Claim preclusion, **13:65**  
Issue preclusion, **9:232**  
Means-plus-function claim, **11:32**  
Means without substantive change,  
**12:25**  
Product-by-process claims, **9:58; 9:81**  
Reexamination, **6:8**

**IDENTIFIABLE BENEFIT**  
Useful, **10:25**

**IDENTIFICATION OR  
DESCRIPTION**  
Description (this index)

**IDENTIFIED, FUNCTION MUST BE**  
Means-plus-function, **1:125**

**IDENTIFY FACTS**  
Summary judgment, **22:21**

**IDENTIFY FUNCTION**  
Means-plus-function claim, **1:125; 7:67;**  
**7:79; 12:66**

**IDENTITY**  
Anticipation, **20:20**  
Applicable, where, **20:20**  
Claim construction, **5:2**  
Claim differentiation, **11:2**  
Clearly erroneous standard, **20:20**  
Court can decide validity differently  
from PTO on same evidence, **20:20**  
Doctrine of equivalents, **14:1**  
Evidence, **20:20**  
Law question, **9:90**  
Verdict, **16:14**

**IDENTITY OF INVENTION**  
Anticipation, **7:33**

**IF CLAIM LIMITATION OR  
EQUIVALENT**  
Present, not, **10:10**

**IGNORANCE**  
Mandamus, **9:57**  
Reissue, **9:84**

**IMMEDIATE APPEAL**  
28 USC § 1291, **11:10**  
Sec. 1292(a)(1), **23:13**

**IMMUNITY**  
Antitrusts, Noerr immunity, **3:46; 5:108**  
Counterclaim, filing of counterclaim,  
**19:141**  
Eleventh Amendment, **2:120; 9:128**  
Exclusive immunity, **1:190**  
Filing of counterclaim, **19:141**  
Nonresidents, not limited to suits by,  
**10:11**  
**Sovereign Immunity** (this index)

**IMMUNITY—Cont’d**

Strictly construed, **10:19**

**IMMUNOGEN, INC. V. STEWART**

2025, **9:529**

**IMMUTABLE FIXED RULE**

Claim differentiation, **4:17**

**IMPLICATES INEQUITABLE CONDUCT**

Intentional interference with contractual relations, **4:54**

**IMPLICATIONS**

Appeal, **5:41**

Narrow vs. broad claims, **13:39**

Statutory construction, **18:34**

**IMPLICIT DECISIONS**

Mandate, **12:47**

**IMPLICIT REPEALS**

Statutory construction, **6:30; 19:80**

**IMPLIED GOOD FAITH**

Contract law, **12:39**

**IMPLIED-IN-FACT CONTRACT**

Generally, **20:40**

Choice of law, **20:40**

Contract law, **12:38**

**IMPLIED LICENSE**

Generally, **8:59**

Clearly erroneous standard, **19:23**

Contributory infringement, **13:21**

Defense to infringement, **1:100**

Direct infringement, **13:21**

Equitable estoppel, **13:67; 19:35; 23:55**

Factors, **23:41**

Inducing infringement, **13:21**

Infringement, **7:62; 13:21**

Law question, **3:56**

Public use, **26:13**

Repair, **4:1; 11:36**

Restrictions, upon unrestricted sale of unpatented article, **13:21**

Sec. 287, **4:12**

Third party production, **3:147**

Timeliness of appeal filing, **2:5**

**IMPLIED ORDER**

Method claims, **9:234**

**IMPLIED WAIVER**

Standard setting organization, **3:206**

Standard setting organizations, **8:120**

**IMPORTS**

Expert testimony, **7:96**

Sec. 337 (this index)

**IMPROVEMENT**

Claim interpretation, **20:8**

Comprising, **3:37**

Obviousness, **18:23**

Refining, **13:8**

Secondary considerations, **9:82**

Special master’s decision, **13:24**

Surprising results, **9:118**

**INCENTIVE**

Generally, **9:96**

Modification, **9:51**

Subject matter jurisdiction, **25:1**

**INCEPT LLC V. PALETTE LIFE SCIENCES, INC.**

2023, **9:522**

**INCLUDING**

Generally, **20:51**

**“INCLUDING” AND “COMPRISING”**

Claim interpretation, **12:83**

**INCONSISTENCY**

Generally, **2:47**

Agency’s interpretation of own regulations, **22:9**

Injunction, **16:5**

Jury, **1:14**

Jury findings, **2:10**

Jury verdicts, **13:105; 18:14**

Procedural issue, **8:21**

**INCORPORATION BY REFERENCE**

Generally, **1:101; 8:143; 13:80; 20:56; 24:4**

Amendment, **8:113**

Anticipation, International Trade Commission, **1:238**

Disclosure-dedication to public, **19:233**

Interference, **8:113; 8:119**

Inter partes review, **8:143**

Obviousness, **16:164**

Particularity, **26:12**

Reasonable examiner standard, **8:124**

## INDEX

### INCORPORATION BY REFERENCE

#### —Cont'd

- Sec. 102(b), **1:101**
- Sec. 120, **4:122**
- Specification, **16:128**

### INCREASED DAMAGES

- Clearly erroneous standard, **19:23**
- Injunction, **16:5**
- Willful infringement, **15:14**

### INCREASING SUPERSEDEAS BOND

- Sec. 1291, **19:42**

### INCYTE CORPORATION V. SUN PHARMACEUTICAL INDUSTRIES, INC.

- 2025, **9:535**

### INDEFINITENESS

- Generally, **7:144**
- Certainty and Definiteness** (this index)

### INDEMNIFICATION AGREEMENT

- Deterrent effect of patent laws, **8:24**

### INDEPENDENT CLAIMS

- Generally, **3:41; 9:123; 12:28; 14:12**
- Chemical process, **9:20**
- Claim construction, **26:1**
- Claim differentiation, **5:60; 9:237**
- Court must state burden of persuasion and quantum of proof required, **18:7**
- Dependent claims, **10:26; 13:100**
- Doctrine of equivalents, **5:6; 18:65**
- Infringement, **23:35**
- Sec. 282, **13:55**
- Substantial evidence test, **19:43**
- Validity, **5:45; 8:7; 19:86**

### INDEPENDENT RIGHT

- Property, **11:35**

### INDEXING

- Public accessibility, **22:42**

### INDIRECT INFRINGEMENT

- As to infringement, generally. **Infringement** (this index)
- Generally, **4:75**
- Anticipation, **21:73**
- Claim construction, **16:153**
- Inequitable conduct, **21:73**
- Question of fact, **13:190**

### INDIRECT INFRINGEMENT—Cont'd

- Summary judgment, **3:36**
- Verdict form, **16:153**

### INDUCED INFRINGEMENT

- Generally, **1:129; 1:142; 2:195; 3:96; 4:80; 5:10; 6:59; 7:135; 8:24; 18:133; 19:295; 19:322; 20:157**
- Active inducement, **5:102**
- Case or controversy, **1:319**
- Claim construction, **5:98**
- Competition, **18:48**
- Contributory infringement, **8:24; 9:356**
- Damages, **9:410**
- Declaratory judgments, **1:319**
- Direct infringement, **1:222; 5:63; 5:102; 12:104**
- Direct or circumstantial evidence, **2:130**
- Divided infringement, **1:222**
- Doctrine of equivalents, **13:28; 14:91**
- Double patenting, **5:132**
- Due process clause, **18:69**
- FRCP 8(a)(2), **14:91**
- FRCP 12(b)(6), **14:91**
- FRCP 41(a)(1)(B), **1:279**
- Good faith belief invalidity, **3:185**
- Implied license, **13:21**
- Inference, **1:202**
- Infringement, **8:24**
- Injunctions, **22:59**
- Intent, **1:133; 13:135; 19:217**
- Intent for infringement cases, **23:87**
- Interference, **18:48**
- Jurisdiction, **22:59**
- Knowingly, **1:222; 7:103; 23:3**
- Limitation to actions by single entity, **1:222**
- Manual, instructions in, **13:186**
- Obviousness, **8:24**
- Operational differences over prior art, lack of, **8:24**
- Personal liability, invoke, **19:92**
- Pre-issuance inducement, **14:18**
- Prior art, **8:24**
- Sec. 172(b), **26:2**
- Sec. 271(b), **1:157; 7:103; 8:24; 11:60; 16:22**
- Sec. 271(c), **8:24**
- Sec. 1498, **1:279**
- Snuggle use doctrine, **19:79**
- Specific intent, **18:79**

**INDUCED INFRINGEMENT—Cont'd**

Tortious interference and unfair competition, versus, **18:48**  
 Unfair competition, **18:48**  
 Written description, **22:59**

**INDUCEMENT**

Anticipation, **5:138**  
 Contributory infringement, **7:130**  
 Damages, **5:138**  
 FRCP 46, **15:57**  
 Obviousness, **7:130**  
 Utility, **7:130**

**INDUSTRIAL AND COMMERCIAL BUYERS**

Design patent infringement, **1:165**

**INDUSTRY REQUIREMENT**

Design patent, Sec. 1337, **3:154**  
 Validity, **19:206**

**INDUSTRY STANDARD**

Infringement, **6:77**  
 Patent misuse, **16:126**

**INEQUITABLE CONDUCT**

Generally, **1:9; 1:116; 1:131; 1:138; 2:43; 2:139.50; 3:234; 4:72; 4:79; 5:65; 6:60; 7:138; 9:272; 10:31; 11:58; 13:250; 16:105; 18:117; 19:19; 23:55; 23:59**  
 Abuse of discretion, **18:78**  
 Affidavit, **7:34**  
 Anticipation, **1:25; 18:20; 21:73**  
 Antitrust, **6:5; 14:21**  
 Appeal and review, **6:4; 23:47**  
 Attorney, **15:3**  
 Attorney fees, **1:193; 8:18; 10:2; 13:19; 18:43; 20:97**  
 Balancing materiality and intent, **6:5**  
 Batch process, continuous vs., **10:2**  
 Blonder-Tongue, **1:13**  
 Burden of proof, **19:92**  
 Candor with PTO, **12:55**  
 Cited prior art, **8:29**  
 Claim interpretation, **19:15**  
 Claim terms, **18:116**  
 Clear and convincing evidence, **1:71; 7:68; 13:141; 15:3; 19:38**  
 Collateral estoppel, **4:3**  
 Commercial success, **11:4**  
 Consider, **6:4**

**INEQUITABLE CONDUCT—Cont'd**

Continuous vs. batch process, **10:2**  
 Contracts, **4:54**  
 Contributory infringement, **1:210**  
 Costs of action, **1:193**  
 Culpable intent, **5:16; 16:32; 20:25**  
 Cumulative prior art, **7:1**  
 Cumulative reference, **19:51**  
 Deception. **Intent to Deceive** (this index)  
 Decisions, **1:25; 11:4**  
 Declaration, **9:378; 13:129**  
 Design, **6:4**  
 Design patent, **7:59; 16:1**  
 Disclosure, **3:98; 6:13; 19:128**  
 Discretion of court, **7:33; 13:38; 13:45**  
 Distinguished from fraud, **1:25**  
 Drawings of hypothetical devices, **11:4**  
 Education of inventor, **15:3**  
 Enablement, **20:101**  
 Enforceability, **1:210; 7:101; 8:12; 19:30**  
 Evidence, **2:68; 2:103; 5:42; 7:46; 13:19; 15:43; 20:106**  
 Examiner's deposition, **23:5**  
 Exceptional case, **13:19; 15:13; 16:78; 18:9; 18:55**  
 Experimental use, **5:137**  
 False, **7:34**  
 Fertile source of error, **6:5**  
 Fraud, **5:5; 6:4; 6:5; 10:2; 11:4; 18:19**  
 Good faith, **11:3; 13:138**  
 Gross negligence, **3:104; 6:4; 8:26; 14:8**  
 Highly relevant prior art, withholding, **13:69**  
 Induced infringement, **5:102**  
 Inference, **1:3; 1:102; 12:92**  
 Infringement, **6:4; 7:10**  
 Intent, **1:169; 1:257; 2:33; 2:68; 4:54; 5:16; 6:4; 6:5; 7:34; 7:46; 9:378; 13:19; 13:91; 13:141; 16:32; 20:25**  
 Interference, **4:21; 4:54**  
 Invalidity and noninfringement, declaratory judgment, **20:133**  
 Inventorship, **16:48**  
 Jury, **1:14; 1:16; 2:49**  
 Knowledge of reference, **13:101**  
 Law of the case doctrine, **19:14**  
 Litigation misconduct, **1:112; 1:180**

## INDEX

### INEQUITABLE CONDUCT—Cont'd

Maintenance fees, **14:70; 21:40**  
Manifest injustice, **14:58**  
Material, **2:85**  
**Materiality** (this index)  
Mention, failure to, **6:4**  
Mere knowledge of reference, **13:101**  
Misrepresentations, **8:85**  
Misrepresentations or omissions material to patentability, **15:49**  
Motion to compel discovery, **19:17**  
Negligence, gross, **6:4; 14:8**  
Nondisclosure of known prior art, **1:3**  
Non-final judgment, **1:237**  
Obviousness, **1:231; 18:84; 19:202; 22:1**  
Omissions, **7:46**  
On-sale bar, **5:137; 12:30**  
Other circumstances may support, **19:26**  
Patentability, **18:116**  
Patent prosecution, **6:42**  
Per se materiality rule, none, **12:20**  
Petition to make special, **7:29**  
Presumption, **13:19**  
Printed publication, **15:34**  
Prior art, **7:1; 8:29; 8:62; 12:30; 19:128**  
Process, continuous vs. batch, **10:2**  
Procurement, **13:19**  
Prosecution irregularities, **3:149; 13:81**  
PTO, **1:203; 7:19; 9:43; 10:2; 12:55; 12:85; 16:114; 19:118**  
Raised on appeal, must review if, **23:47**  
Reasonableness of examiner's rejection, **1:3**  
Reference, **6:80; 13:101; 19:51**  
Reissue, **8:26**  
Relevant prior art, withholding highly relevant prior art, **8:62**  
Resubmitting references, **1:92**  
Review, standard of, **2:59; 3:72; 6:50; 9:35; 10:31; 11:11; 13:84; 14:19; 14:54; 18:37; 18:40; 20:39**  
Sec. 102(b), **5:80; 9:7; 13:35**  
Sec. 112, **8:7**  
Sec. 282, **8:23**  
Sec. 285  
    generally, **16:59**  
    attorney fees, **5:137; 18:43**  
Secondary considerations, **4:10; 11:4**  
Separate nonjury trial, **7:1**

### INEQUITABLE CONDUCT—Cont'd

Several patents, one of, **12:3**  
Sham litigation, **8:98**  
Skill, level of, **15:3**  
Special, petition to make, **7:29**  
Standard of review, **19:202**  
Starting point, **7:1**  
Summary judgment, **2:24**  
Surprising results, **11:4**  
Synergism, **11:4**  
Threshold intent, **6:4**  
Threshold level, **1:44; 21:36**  
Translation, **1:154**  
Two step analysis, **1:89**  
Two-step analysis, **16:61; 16:70**  
Unclean hands doctrine, **3:35**  
Unfair competition, **16:48**  
Very material omissions require less evidence to show intent, **7:46**  
Walker process, **3:71; 14:21; 14:25**  
Withheld prior art, **8:29; 8:62; 12:30**  
Withholding reference, **6:80**  
Witnesses, **11:4**

### INFERENCE

Inequitable conduct, **1:3; 1:102; 12:92**  
Intent to deceive, **13:69**  
Intent to induce infringement, **1:202**  
Intent to mislead, **8:51; 20:35**  
Opinion of counsel, **5:30**  
Sec. 285, **5:14**

### INFERIOR INFRINGEMENT

Special verdict, **23:1**

### INFORMATION DISCLOSURE STATEMENT

Doctrine of equivalents, **5:31**  
Interpret scope of claims, used to, **5:31; 7:113**  
Prior art, no admission material, **1:122; 18:86**

### INFRINGEMENT

Generally, **1:137; 1:147; 1:161.50; 1:356; 2:94; 2:109; 2:114; 2:162; 2:195; 3:99; 3:232.50; 5:62; 5:65; 6:55; 9:287; 9:477; 10:10; 10:36; 12:72; 13:52; 13:53; 13:125; 14:45; 14:48; 14:51; 14:73; 16:87; 16:91; 16:93; 16:95; 16:178; 18:2; 18:13; 18:62; 19:53; 19:159; 19:168; 20:77; 23:18; 23:96**

**INFRINGEMENT—Cont'd**

Abbreviated new drug application (anda), **6:65; 19:247**  
 Abbreviated new drug application (ANDA), **2:146; 13:233**  
 Access validity not examiner's potential act, **20:72**  
 Actual controversy required, **20:26**  
 Actual notice, **12:61**  
 Add elements, avoided if, **9:186**  
 Additional components, **12:18**  
 ANDA, **1:252; 2:88; 2:146; 6:65**  
 Appeal and review, **2:95**  
 Appellate jurisdiction, **3:11**  
 Appropriate, when, **23:35**  
 ARO, **13:29**  
 As a whole, visual appearance, **3:100**  
 Asserted equivalents need not be known, **20:6**  
 Assignor estoppel doctrine, **19:47**  
 Attorney fee on appeal, **18:19**  
 Attorneys, **12:22**  
 Attribution, **20:141**  
 Avoidance, inefficiency does not avoid, **6:26**  
 Awareness of material prior art insufficient by itself, **7:10**  
 Bankruptcy, **8:94**  
 Basic, **20:6**  
 Blonder-Tongue, **1:13**  
 Burden of proof, **1:123; 7:31; 13:179; 13:194**  
 Capable of modified to operate infringing means, **20:56**  
 Capable of operating in infringing mode, **6:74**  
 Careful consideration, **12:29**  
 Case or controversy, **7:10**  
 Chemical case, **13:46**  
 Chemical compound, **5:29**  
 Choice of law, **22:18**  
 Circumstantial evidence, **12:90**  
 Claim, **8:61**  
 Claim construction and interpretation, **2:82; 2:129; 3:7; 6:93; 16:35; 19:15; 19:167; 19:242; 23:58; 23:88; 26:1**  
 Claim differentiation, **6:93; 23:88**  
 Claimed method, sometimes embodies, **2:52**  
 Claim preclusion, **1:170**

**INFRINGEMENT—Cont'd**

Claims must be construed same way, **23:11**  
 Clear and convincing evidence, **3:158**  
 Collateral estoppel, **1:3; 1:155; 25:10**  
 Commercial product, **1:124**  
 Composition of process or product undisputed, **4:51**  
 Computer claims, **19:220**  
 Contempt, **11:17**  
**Contributory Infringement** (this index)  
 Copyright, **16:110**  
 Costs on appeal, **1:20**  
 Counterclaim, **13:179**  
 Court can observe with its own eyes, **9:4**  
 Customer end user as parties at trial, no necessity to have, **18:11**  
 Damages, **5:121; 13:146; 16:40; 16:135; 19:92; 22:35**  
 Declaratory judgment, **13:194; 19:81**  
 Defense, practicing the prior art not, **5:60**  
 Dependent claim, **10:26; 13:100; 13:147; 23:17**  
 Design patent, **1:165; 3:98; 3:100; 8:126; 11:25; 12:8; 15:5; 15:11; 19:8; 19:85; 21:4**  
 Device alterable so as to infringe, **8:46**  
**Direct Infringement** (this index)  
 Disclosure, not measure of what is discloses, **9:4**  
 Divided infringement, **1:270; 1:271**  
 Doctrine of equivalents, **4:125; 7:121**  
**Doctrine of Equivalents** (this index)  
 Earlier suit, preclusive effect on claim construction of, **16:35**  
 Elements, every claim element must be present, **19:111**  
 Ensnarement, **7:121**  
 Equivalency, **8:51**  
 Equivalent, **23:40**  
 Every claim, **1:52; 1:84; 19:111; 23:40**  
 Evidence, **3:158; 8:120; 14:33; 18:11**  
 Examiner, **20:72**  
 Expert, technical, **9:125**  
 Expert testimony, **3:90; 9:320; 14:18; 18:43; 19:242; 19:291**  
 Extraterritorial production, **16:138**  
 Fact question, **3:101; 7:10; 8:51; 19:19; 21:17**

## INDEX

### INFRINGEMENT—Cont'd

Factual findings to support jury verdict presumed, **2:15**  
FDA approval, **1:85**  
Features added, **14:8**  
File wrapper, **10:13**  
Final assembler theory, **1:361.50**  
First to file, **6:89**  
Foreign patent, **22:36**  
Foreign sales, **8:129**  
FRAP 38, **12:22; 16:4**  
FRCP 11, **22:22**  
FRCP 49(a), **19:21**  
FRCP 59(e), **19:42**  
FRE 705, **19:59**  
Gorham, **12:32**  
Hindsight, **7:10**  
Implied license, **7:62; 13:21**  
Imported product, **2:80; 11:60**  
Improper to compare claims with patent's preferred embodiment or patentee's commercial embodiment, **1:52**  
Indefiniteness, **13:57**  
Independent v. dependent claims, **23:35**  
**Induced Infringement** (this index)  
Industry standard, **6:77**  
Inefficiency does not avoid, **6:26**  
Inequitable conduct, **6:4; 7:10**  
Intent not required, **9:118**  
International Trade Commission, **1:17; 3:198; 5:98; 25:2**  
Inventorship, **4:125**  
Inventor's theory, **6:10**  
ITC, **1:17; 25:2**  
JNOV, **6:6; 22:4**  
Joint infringement, **1:195; 1:222; 2:124; 13:159; 13:160**  
Jurisdiction, **7:73**  
Jury verdict, **8:47; 19:5; 20:25**  
Law question, **12:31; 13:64; 13:74**  
License, implied, **7:62**  
Limitations, **23:40; 25:3**  
**Literal Infringement** (this index)  
Lost profits, **13:45; 16:135; 26:4**  
Manufacture, pre issuance manufacture, **10:23**  
Markush claim, **1:155; 19:299**  
Means-plus-function claim limitation, **3:46**

### INFRINGEMENT—Cont'd

Minor differences, **16:33**  
Mixed question, **19:19**  
Modified device, **2:119**  
Mootness, **11:23**  
Motion, **12:36; 23:10**  
New trial, **8:51**  
Nonobviousness, **7:10**  
Nonparty's motion to quash discovery subpoena, **20:17**  
Notice and knowledge  
generally, **1:62; 3:96; 13:42; 20:6**  
awareness of material prior art insufficient by itself, **7:10**  
declaratory judgment, versus, **19:101**  
due care, duty of, **3:96**  
knowledge, asserted equivalents need not be known, **20:6**  
marking, **4:89**  
marking as constructive notice, **6:78**  
notice, actual notice, **12:61**  
sufficiency, **11:70**  
Novelty must be appropriated, **12:17**  
Observation, court can observe with its own eyes, **9:4**  
Obviousness, **18:23; 19:11; 19:19**  
Occurs at place where sales are made, **14:15**  
Offer for sale, **8:129**  
Only claims may be, **5:6**  
Patent misuse, **8:14; 23:9**  
Pioneer invention, **20:6**  
Pleading, **9:356**  
Preclusive effect on claim construction of earlier suit, **16:35**  
Pre issuance manufacture, **10:23**  
Preliminary injunction, **1:40; 1:155**  
Prior art, **5:60; 7:10; 19:19**  
Process, **1:12; 4:51**  
Product, composition of process or product undisputed, **4:51**  
Prosecution history, **5:84; 13:126**  
Prosecution history estoppel, **22:8**  
Reconsideration, new theory, **7:113**  
Remand for clarification, **10:38**  
Replication of patented technology, **13:173**  
Review, standard of, **3:43; 5:36; 9:254; 16:11**  
Reviewability, **2:31**

**INFRINGEMENT—Cont'd**

Sale of spare parts after patentee fully compensated, **11:10**  
 Sales, **8:129**  
 Sample is potent witness, **9:4**  
 Sanctions on counsel, **12:22**  
 Sec. 102(b), **19:31**  
 Sec. 112(6), **9:215**  
 Sec. 112(6), invoking, **16:51**  
 Sec. 112 equivalency, **16:2**  
 Sec. 271(a), **23:53**  
 Sec. 271(b), **8:24**  
 Sec. 271(c), **6:23**  
 Sec. 271(e)(1), **5:13**  
 Sec. 271(g), **13:105**  
 Sec. 285, **3:42; 3:212**  
 Sec. 337, **3:23**  
 Separate patentability, **8:52**  
 Settlement on product, effect of, **16:40**  
 Special master's decision, **1:207; 13:24**  
 Special verdict, **23:1**  
 Spoliation of evidence, **8:120**  
 Standard essential patent, **7:136**  
 Standing, **13:170; 19:154**  
 Statutory notice under Sec. 287(b)(5), **13:41**  
 Step-two analysis, **20:63**  
 Strict liability offense, **10:21**  
 Structure, no dispute concerning, **7:57**  
 Substantial evidence, **25:10**  
 Substitute, **7:63**  
 Success on merits, likelihood of, **7:50**  
 Summary judgment, **1:35; 1:79; 2:29; 3:36; 3:52; 3:189; 4:75; 4:113; 5:10; 8:40; 9:131; 14:14; 16:20; 16:88; 16:155; 21:28; 21:46; 23:58**  
 Superiority of accused product, **19:38**  
 Switching not establish noninfringing substitute during past infringement, **7:63**  
 Technical expert, **9:125**  
 Technological advance, **22:32**  
 Technologic equivalency are fact questions, **8:51**  
 Two-part analysis, **2:83**  
 Two-step analysis, generally, **1:118; 1:134; 2:62; 2:78; 3:66; 3:105; 4:66; 5:26; 6:47; 7:40; 7:67; 8:77; 9:269; 10:28; 10:32; 11:44 to 11:46; 12:42; 12:49; 12:65; 12:70;**

**INFRINGEMENT—Cont'd**

**13:112; 13:118; 14:32; 14:46; 15:12; 15:17; 16:66; 16:77; 16:82; 18:46; 18:51; 18:57; 19:103; 19:135; 19:158; 23:49; 24:2; 26:6**  
 Two-step inquiry, **2:74**  
 Two-step process, **14:14; 18:30; 23:35**  
 Two-step test, **13:75**  
 Unfair competition, **19:87**  
 Use of system, **3:156**  
 Vacate, **7:8**  
 Validity, **1:113; 1:169; 7:61; 8:49; 12:45; 15:15; 16:74; 18:39; 19:86; 20:72**  
 Venue, **8:53**  
 Vicarious liability, **4:75**  
 Visual appearance as a whole, **3:100**  
**Willful Infringement** (this index)  
 Withdrawn claims, **7:10**  
 Within United States, **12:81**  
 Witnesses, **9:4**  
 Written description, **1:252; 6:93; 9:453**  
**INGENICO INC. V. IOENGINE, LLC**  
 2025, **9:536**  
**INGREDIENTS**  
 Claim construction and interpretation, **13:125**  
**INGURAN, LLC V. ABS GLOBAL, INC.**  
 2023, **9:523**  
**INHERENCY**  
 Generally, **5:61; 6:40; 7:81; 9:212; 9:242; 9:486; 12:36; 13:94; 16:172**  
**Anticipation** (this index)  
 Certain thing may result is not sufficient, **9:140**  
 Circumstances insufficient, may result from set of, **3:103**  
 Composition, discovery of inherent properties, **20:11**  
 Defense, sovereign act doctrine as defense, **8:41**  
 Descriptive matter, recognition that missing descriptive matter is necessarily present, **5:56**  
 Disclosure, **25:12**  
 Discovery, **20:11**  
 Escrow, **3:21**

## INDEX

### **INHERENCY—Cont'd**

- Fact question, **9:31; 9:172**
- Must necessarily be present, **20:59**
- Necessary function, **2:143**
- Necessary present, **20:47**
- Obviousness, **5:136; 8:147; 16:140; 19:303; 20:67**
- Old composition, **20:11**
- On-sale bar, **19:113**
- Privity, **11:14**
- Recognition that missing descriptive matter is necessarily present, **5:56**
- Sec. 112(1), **18:52**
- Sec. 120, **11:8**
- Sovereign act doctrine as defense, **8:41**
- Unexpected properties, **8:147**
- Written description requirement, **13:53**

### **IN-HOUSE COUNSEL**

- Attorney fees award, **16:24**

### **IN BANC HEARING**

- Correction of panel opinions, **16:107**
- Exception not rule, **1:52**
- FCR 35, **1:52**
- Malpractice, **2:152**

### **IN CAMERA DOCUMENT INSPECTION**

- Generally, **17:3**

### **IN FIRST INSTANCE**

- Claim words, **5:7**

### **IN HAEC VERBA**

- Written description, **12:54; 16:65**

### **IN LIGHT OF SPECIFICATION**

- Claim interpretation, **1:108**

### **IN LIMINE**

- Evidence, **21:41**

### **“IN THIS COUNTRY”**

- Sec. 102(g), **1:111**

### **IN TOTO**

- Generally, **8:31**

### **IN VIVO**

- Generally, **1:44**
- Interference, **3:28**

### **INITIAL BURDEN TO SHOW**

- Summary judgment, **22:18**

### **INITIAL CONSIDERATION OF EVIDENCE**

- Preliminary injunction, **8:2**

### **INJUNCTIONS**

- Generally, **1:240; 2:189; 5:8; 5:125; 11:28; 13:136; 16:19; 16:142; 18:14**
- Anti-suit injunction, **19:239**
- Appealability of interlocutory order having injunction effect, **7:21; 13:219**
- Biosimilar products, **1:291**
- Broad discretion, **10:23**
- Broadening scope, **19:48**
- Claim construction, **20:149**
- Claims must be construed same way, **23:11**
- Communication regarding rights, **7:92**
- Considerations involved, **19:49**
- Contempt, **1:156; 1:234; 2:119; 5:119; 11:17; 14:69; 16:25**
- Damages, **1:20; 1:262**
- Design, **20:15**
- Discretion, broad discretion, **10:23**
- Discretionary, **2:157; 15:14**
- Extraterritorial, **9:271**
- FRAP 38, **16:29**
- FRCP 60(b), **1:173; 23:23**
- FRCP 65, **7:3**
- FRCP 65(d), **1:53; 5:4**
- Inconsistency, **16:5**
- Increased damages award, **16:5**
- Induced infringement, **22:59**
- Interlocutory decision, **12:41; 16:116**
- Irreparable Harm or Injury** (this index)
- Jurisdiction, **1:234; 19:9; 22:50; 22:59**
- Jury trial, **20:55**
- Licenses, **22:37**
- Means-plus-function, **20:149**
- Non-parties, **1:75**
- Party enjoined, **16:5**
- Patent misuse, **23:9**
- Permanent injunction, **1:308; 5:110; 12:88; 19:329**
- Preliminary Injunction** (this index)
- Res judicata, continuing conduct, **1:229**
- Review, standard of, **3:56; 15:6**
- Same parties and same issues requirement, **9:116**
- Sec. 112, **1:304; 19:4**

**INJUNCTIONS—Cont'd**

Sec. 271(e)(1), **5:3; 5:13**  
 Sec. 283, **10:17; 18:18**  
 Sec. 337, **19:222**  
 Sec. 1292(a)(1), **23:13**  
 Stay, **5:2; 9:91**  
 Tailoring permanent injunction, **5:110**  
 Territoriality of U.S. patent laws, **13:181**  
 Third parties, **1:296**  
 Willful infringement, **9:323; 16:5**  
 Written description, **22:59**

**INJURY**

Standing, **3:177; 4:116**  
 Standing criteria, **1:45; 4:116**

**INLINE PLASTICS CORP. V. LACERTA GROUP, LLC**

2024, **9:526**

**INNOVATION**

Obviousness, **18:15**

**INOPERABLE**

Utility, **5:56**

**INOPERATIVE**

Enablement, **9:222**  
 Utility, **9:222**

**INOPERATIVE EMBODIMENTS**

Enablement, **3:103**

**INOPERATIVENESS**

Enablement, lack of, **14:12**  
 Utility, lack of, **6:9**

**IN PERSONAM**

**Personal Jurisdiction** (this index)

**INQUIRE, DUTY TO**

Patent ambiguity doctrine, **3:48**

**IN RE: CELLECT, LLC**

2023, **9:516**

**IN RE COUVARAS**

2023, **9:517**

**IN RE ENTRESTO**

2025, **9:530**

**IN RE FLOAT 'N' GRILL LLC**

2023, **9:518**

**IN RE FOREST**

2025, **9:531**

**IN RE GOOGLE LLC**

2023, **9:519**

**IN RE KOSTIC**

2025, **9:532**

**IN RE PERSONALWEB TECHNOLOGIES LLC**

2023, **9:520**

**IN RE RIGGS**

2025, **9:533**

**IN RE STINGRAY IP SOLUTIONS, LLC**

2023, **9:521**

**IN RE XENCOR, INC.**

2025, **9:534**

**INSPECTION**

Generally, **16:15**  
 Concept, no claim on, **16:15**  
 Doctrine of equivalents, **16:15**  
 Elements, interchangeability of elements, **16:15**  
 Essence, **16:15**  
 Heart of invention, **16:15**  
 In camera document inspection, **17:3**  
 Interchangeability of elements, **16:15**  
 Pioneer invention, **16:15**

**INSTITUTION**

Inter partes review, **1:328**

**INSTRUCTIONAL LIMITATION**

Sec. 101, printed matter, **11:64**

**INSTRUCTIONAL MANUAL**

Template, claimed invention used as, **9:123**

**INSTRUCTIONS TO JURY**

**Jury Instructions** (this index)

**INSUBSTANTIAL DIFFERENCES**

Doctrine of equivalents, **1:84; 2:101; 3:86; 4:62; 5:30; 9:225; 15:16 to 15:18; 19:97; 19:135; 20:57; 23:41; 26:6**  
 Equivalence, **1:93**  
 Equivalency, **19:114**

**INSURANCE POLICY**

Choice of law, **21:31**

## INDEX

### INTEGRAL

Generally, **8:58; 9:199**

### INTEGRATION

Parol evidence, **13:76**

### INTEL CORPORATION V. PACT XPP SCHWEIZ AG

2023, **9:524**

### INTELLECTUAL TECH LLC V. ZEBRA TECHNOLOGIES CORPORATION

2024, **9:527**

### INTENT

All facts and circumstances considered,  
**11:13**

Bright-line test, **6:23**

Broadened reissue, **9:109**

But one factor for rejecting, **9:39**

Claim preamble, **1:103; 2:101; 9:79**

Deceive. **Intent to Deceive** (this index)

Dedication to public of unclaimed  
subject matter, **20:74**

Direct infringement, **9:118**

Disclosure, duty of, **12:52**

Fraud, **6:28**

Implicates inequitable conduct, **4:54**

Inducement, **1:133; 7:88; 13:135;**  
**19:217**

Inequitable conduct, **1:169; 2:33; 2:68;**  
**4:54; 5:16; 6:4; 6:5; 7:34; 7:46;**  
**9:378; 13:19; 13:91; 13:141;**  
**16:32; 20:25**

Infringement, direct, **9:118**

Jurisdiction, **3:27**

Materiality, **12:93; 14:19**

Mislead. **Intent to Mislead** (this index)

Performance of government contract,  
**8:8**

PTO, **7:19; 9:43**

Reduction to practice, **13:72**

References, **12:43**

Rejection, **9:39**

Sec. 102(g), **11:9**

Sec. 282, **12:5**

Sec. 285, **5:14**

Statutory construction, **7:24; 7:55; 8:39;**  
**8:45; 13:60**

Willful infringement, **18:14**

Written agreement is executed, **23:21**

### INTENT TO DECEIVE

Generally, **11:58**

Affidavit ipso facto material, **18:37**

Clear and convincing evidence, **1:187**

Coinventors, **1:106**

Conjecture alone does not show intent to  
deceive, **9:125**

Deception, specific intent to deceive,  
**6:28**

Inequitable conduct, **1:178; 1:180;**  
**1:187; 3:98; 5:87; 8:42; 11:23;**  
**12:85; 15:42; 19:208**

Inferred, can be, **13:69**

Misrepresentation, **6:28**

Negligence, **19:59**

### INTENT TO MISLEAD

Generally, **13:80**

Culpability. inferential culpability doc-  
trine, **20:35**

Disclosure, **8:51; 14:19**

Factors involved, **3:72**

Gross negligence alone insufficient,  
**2:68**

Inference, not inferred solely from infor-  
mation not disclosed, **8:51**

Inferential culpability doctrine, **20:35**

Materiality, **12:30; 12:43**

Mere denial, sufficiency thereof, **19:128**

Not inferred solely from information not  
disclosed, **8:51**

### INTERCHANGEABILITY

Generally, **8:47**

Doctrine of equivalents, **13:91**

Equivalent device, not necessarily, **11:22**

Hardware and software, **15:16**

Inspection of patentee's product, **16:15**

### INTEREST OF JUSTICE

Sec. 1651, **3:14**

### INTEREST RATE

Generally, **4:6**

### INTERFERENCE

Generally, **2:118; 4:11; 4:21; 4:132;**  
**8:67; 9:163; 9:198; 13:10; 13:105;**  
**15:1; 18:124; 19:10; 19:149**

Abuse of discretion, permissive rules  
reviewed for, **5:68**

Actual reduction to practice, evidence  
of, **14:3**

**INTERFERENCE—Cont'd**

Administrative Procedure Act, **9:263**  
 Affidavit describing work of third party at reasonably contemporaneous time, **9:23**  
 All issues of patentability and priority decided in one proceeding, **16:16**  
 Already known, no teaching required of what is, **3:6**  
 Ancillary to priority, **13:31; 16:16**  
 Animal testing, **3:28**  
 Anticipation, **3:32**  
 Appeal and review, **4:11; 5:68; 7:26; 7:74; 12:99; 13:119**  
 Art class, examiner's search of, **4:21**  
 Best mode, **4:8; 13:3**  
 Board has no authority to dissolve interference, **16:7**  
 Broadest interpretation, **9:88**  
 Broadest reasonable interpretation, **18:56**  
 Burden, junior party's burden, **15:1; 19:70**  
 Burden of proof, **2:47; 2:107; 4:8; 5:52; 13:31; 16:36**  
 Burden to show date of invention, senior party's, **2:96**  
 Challenges, **13:3**  
 Chemical case, **3:28**  
 Chemical compound, **15:1**  
 Civil action, **18:49; 19:232**  
 Claim construction and interpretation, **1:5; 1:182; 2:172; 9:88**  
 Clearly erroneous standard, reviewed under, **4:11**  
 Conception, **3:15; 9:244; 15:1; 19:240**  
 Construction and interpretation, **7:49; 7:74; 9:130**  
 Continued, proceeding not to be, **13:31**  
 Co-pending application, standard of proof for, **2:70**  
 Copies, **3:92; 4:8**  
 Counts, **7:49; 7:74; 9:49; 9:88; 9:141; 9:230; 13:31; 19:151**  
 Dates, effective filing dates, **8:122; 19:144**  
 Default judgment awards, **1:60**  
 Delay, long delay in filing, **16:9**  
 Delusion to cite sentence as precedent, **3:6**  
 Derivation, **4:11**

**INTERFERENCE—Cont'd**

Disclaimer, statutory, **7:45**  
 Disclosure, **3:25; 7:13**  
 Discretion of Commissioner to declare, **2:67**  
 Dissolve, motion to, **16:7**  
 "Each and every" limitation, **25:11**  
 Early disclosure of inventions, **7:13**  
 Effective filing dates, **8:122; 19:144**  
 Enablement, **3:28; 4:8; 13:3**  
 Estoppel  
   judgment, by, broadest interpretation, **23:14**  
   section 141, **2:165**  
   section 146, **2:165**  
 Evidence, **2:70; 14:3**  
 Examiner's search of art class, **4:21**  
 Expired patent, **7:102**  
 Fact question, **3:32; 4:8**  
 Filing, long delay in filing, **16:9**  
 Filing date, **6:20; 8:122; 19:144; 19:164**  
 Findings, **4:11; 7:48**  
 Foreign countries, **6:20**  
 Fraud, **4:21**  
 Futility, exercise in, **13:31**  
 Future use of non-contested priority in civil action, **18:49**  
 Genus, **9:88**  
 Grammatical structure and syntax, **1:117**  
 How to make, **13:3**  
 Hybrid nature, **3:6**  
 Implicates inequitable conduct, **4:54**  
 Incorporation by reference, **8:113; 8:119**  
 Inducing infringement, **18:48**  
 Inequitable conduct, **4:21; 4:54**  
 In vivo, **3:28**  
 Interpretation thereof, **9:130**  
 Inurement, **3:94**  
 Inventorship, **3:15; 19:109**  
 Inventorship proof, **5:73**  
 Joint inventors deemed single party, **4:31**  
 Joint vs. sole inventorship, **19:72**  
 Junior party's burden, **15:1; 19:70**  
 Lapse, procedural, **5:57**  
 Late claiming, **3:25**  
 Law question, **4:8**  
 Long delay in filing, **16:9**  
 Lost count, **9:88**

## INDEX

### INTERFERENCE—Cont'd

Motions, untimely challenges not raised during motions period, **13:3**  
Motion to dissolve, **16:7**  
Necessary findings must be expressed with sufficient particularity, **7:48**  
**New Interference Rules** (this index)  
New practice, **16:16**  
New rules. **New Interference Rules** (this index)  
Obviousness, **18:89**  
Overlapping dates, **3:54**  
Particularity, **7:48**  
Patentability, **9:230; 16:16; 18:44; 23:44**  
Patent and Trademark Office (PTO), **7:102**  
Patent Cooperation Treaty (PCT), **6:66**  
Pending applications, **13:31**  
Permissive rules reviewed for abuse of discretion, **5:68**  
Phantom count, **9:49**  
Physical embodiment must meet every limitation of count, **3:25**  
Preamble, **4:8**  
Pre-critical date claiming, **16:132**  
Preliminary statement with two distinct nonoverlapping dates, **3:54**  
Prima facie case of priority, **7:13**  
Priority, **2:107; 3:6; 3:82; 6:20; 7:13; 7:100; 8:30; 8:78; 9:88; 11:65; 13:31; 15:1; 16:16; 18:49; 19:90; 19:240**  
Prior possession of invention vitiates any contention, **4:11**  
Procedural lapse, **5:57**  
Production specifications, not, **4:8**  
Provocation, **18:88**  
Public disclosure, **3:25**  
Public policy, **7:13**  
Raisable against patent in interference, **13:3**  
Raising issues, **13:3**  
Reasonable diligence, **2:13**  
Reduction to practice, **3:25; 12:2; 14:3**  
Reexamination v. litigation, **4:8**  
Review, standard of, **5:46**  
Sec. 1.633(g), **11:27**  
Sec. 1.640, **3:32**  
Sec. 1.662(b), **7:23**  
Sec. 13(b), **2:93**

### INTERFERENCE—Cont'd

Sec. 102(b), **25:11**  
Sec. 112, **3:6; 3:28**  
Sec. 135(b)(1), **1:220**  
Sec. 135(c), **3:29**  
Sec. 136, **4:27**  
Sec. 146, **1:42; 3:6; 3:53**  
Sec. 146 appeal, **7:26**  
Sec. 291, **1:11; 7:102; 11:23; 19:149**  
Sec. 1346(b), **3:6**  
Sec. 2201, **13:41**  
Senior party, **2:96; 15:1**  
Specifications, **1:182; 2:172; 4:8; 19:151**  
Stated time period, acts within, **15:1**  
Statutory disclaimer, **7:45**  
Subsequent litigation, effect of prior interference on, **2:36**  
Sufficiency of disclosure, **3:25**  
Third party inventorship, **3:6**  
Tie, if, **15:1**  
Timeliness, **16:132**  
Time period, acts within, **15:1**  
Underlying facts found by Board, **4:11**  
Utility, **6:33**  
Warranty, breach of, **1:58**  
Withdrawal, **9:217**  
Written description, **1:182; 2:172; 7:123; 11:65; 18:88; 25:11**

### INTERLOCUTORY

Escrow, **3:21**

### INTERLOCUTORY APPEAL

Collateral order doctrine, **4:129**  
Jurisdiction, **16:184**  
Sec. 1292(b), **10:43; 14:9**  
Sec. 1292(c)(2), **9:6; 13:61**

### INTERLOCUTORY DECISION

Cohen tripartite test, **19:71**  
Preliminary injunction when seeking permanent injunction, **12:41**

### INTERLOCUTORY ORDER

Generally, **7:21**  
Appealability, **17:3; 18:75; 20:5**  
CAFC jurisdiction, **5:85; 13:219**  
CAFC jurisdiction limited, **13:219; 22:2**  
Leave to file counterclaim, **2:43**  
Preliminary injunction, **11:19**

**INTERLOCUTORY ORDER—Cont'd**

Question certified, not confined to precise, **21:24**  
 Sec. 1292(a)(1), **16:116; 18:16; 23:13**  
 Sec. 1292(b), **9:97**  
 Sec. 1292(c)(1), **16:116**  
 Sec. 1292(c)(2), **10:12**  
 Stay order, **19:230**

**INTERLOCUTORY PARTIAL JUDGMENT**

Appealability, **7:16**

**INTERNATIONAL TRADE COMMISSION**

Generally, **6:56; 6:63; 11:54; 22:28**  
 Access by party's in-house counsel to proprietary information of its competitor, **13:40**  
 Anticipation, **1:17; 1:238**  
 Appeal and review, **1:129; 1:254; 3:191; 6:2; 7:104; 7:105; 19:25**  
 Arbitration, **9:380**  
 Articles, **19:280**  
 Attorneys, **13:40; 23:55**  
 Burden of proof, **19:25**  
 CAFC jurisdiction, **1:15**  
 Choice of remedy, **3:198**  
 Claim construction and interpretation, **5:98; 9:513; 12:87; 19:196**  
 Collateral estoppel, **20:41**  
 Competitors, **13:40**  
 Consent order, **4:108**  
 Contract law, **13:20**  
 Criticality, **1:17**  
 Deference, entitled to, **5:37**  
 Dismissal, prior, **25:2**  
 Domestic disclosure communication, **1:224**  
 Domestic industry, **2:200; 12:105**  
 Enforcement proceedings, **22:29**  
 Entitled to deference, **5:37**  
 Estoppel to assert patent, **25:2**  
 Evidence, **2:117; 8:28; 10:27; 23:55**  
 Exclusions, **8:28; 9:118; 19:221; 19:222**  
 Factual findings, **1:10; 3:225; 8:28**  
 FDCA, **1:332**  
 Foreign law, **13:20**  
 Infringement, **1:17; 3:198; 5:98; 25:2**  
 Initial determination, appeal and review, **1:254**

**INTERNATIONAL TRADE COMMISSION—Cont'd**

Invalidity, **13:242**  
 Inventor's admission of invention by another, **1:8**  
 Issue preclusion, **2:17**  
 Jurisdiction, **1:332; 3:183**  
 Law question, **13:20**  
 License agreement, **9:379; 20:53**  
 Limited exclusion order, **8:28**  
 Modification of orders, **3:73**  
 Mootness during appeal, **20:6**  
 New and surprising result, **1:17**  
 Orders, modification of, **3:73**  
 Parties, purpose of, **13:20**  
 Penalties, **4:130; 14:65; 15:52**  
 Pendency, appeal pendency, **19:25**  
 Presumption of validity, **19:25**  
 Prior dismissal of earlier infringement suit, effect of, **25:2**  
 Process patents, **1:184**  
 Rescission, **4:130**  
 Requirements, **25:2**  
 Review, standard of, **3:59; 7:52; 8:28; 8:86; 19:25**  
 Review of initial determinations on matters other than temporary relief, **7:105**  
 Sec. 102(g) prior invention under pre-AIA law, **1:224**  
 Sec. 211.54(a), **1:15**  
 Sec. 271(e)(1) exempt purpose, **1:184**  
 Sec. 282, **19:25**  
 Sec. 337, **1:15; 2:12; 3:23; 5:98; 12:5; 18:26; 19:25; 20:105; 21:64**  
 Sec. 337(a), **1:39**  
 Sec. 337(c), **6:14**  
 Sec. 1337, **3:154; 25:2**  
 Sec. 1337(c), **8:28**  
 Sec. 1337(d), **8:28**  
 Sec. 1337(e), **8:28**  
 Self-initiated investigation, terminating, **2:17**  
 Standard of review, **2:117**  
 Substantial evidence, **2:117; 8:28**  
 Summary determination, **8:58**  
 Tariff Act, **13:11**  
 37 CFR Sec. 1.321, **13:20**  
 Validity, **19:25**

## INDEX

### INTERNET

Abstract ideas, Sec. 101, **1:285; 9:437; 13:188**

### INTER PARTES REEXAMINATION

CAFC, **18:103**

Jurisdiction of Board of Patent Appeals and Interferences, **2:150**

Subpoena, **1:232**

Third parties, **3:138**

### INTER PARTES REVIEW

Generally, **1:266; 1:268; 1:316; 1:339; 1:349 to 1:351; 1:354; 2:176; 2:194; 3:234; 3:238; 3:242; 4:119; 6:95; 7:132; 9:401; 9:441; 9:443; 13:199; 13:203; 13:252; 15:54; 16:146; 16:179; 19:291; 19:308; 19:338; 21:84; 23:95**

Administrative agencies, **19:282**

Amendment of claims, **1:305; 1:371; 3:237; 8:164**

America Invents Act, **19:282**

Anticipation, **5:139; 11:80; 11:81; 23:86**

Broadest reasonable interpretation, **3:201; 4:112; 9:400; 9:448; 17:13**

Burden of proof, **1:305**

Cancellation of claims  
generally, **16:154**

motion to amend to request, **14:78**

Claim construction, **1:328; 8:149; 9:489**

Claims, amendment of, **1:305**

Conception, **1:323**

Conception and reduction to practice, **18:110**

Consolidation, **19:284**

Constitutionality, **13:246.50; 19:325**

Contested cases, **1:232; 13:213**

Deposition, **1:338**

Disclaimers, **1:326; 1:327**

Discontinue, **13:213**

Errors, **12:120**

Estoppel, **1:345**

Expiration of patent, **9:424**

Incorporation by reference, **4:122**

Indefiniteness, **19:323**

Institute review, **8:143**

Institution, **1:328; 9:469**

Joinder, **6:104; 14:86**

Jurisdiction to review, **9:425**

Mandamus, **9:385; 9:469; 9:498.70**

### INTER PARTES REVIEW—Cont'd

Multiple proceedings, **9:512**

Obviousness, **1:278; 1:295; 1:321; 1:326; 2:173; 3:201; 4:123; 5:134; 5:135; 5:139; 8:139; 9:418; 9:426; 9:428; 13:222; 14:99; 16:166; 19:334; 22:56**

Party in interest, **1:324; 23:97**

Patent and trademark office (PTO),  
**19:282**

Potential claim unpatentable, **8:142**

Privity, **23:86; 23:94**

Proposed substitute claims, **9:418**

Ranges, **5:134**

Rehearing en banc, **13:214**

Review proceedings, **7:119**

Sanctions, **2:174; 3:237**

Sec. 101, **14:99**

Sec. 120, **4:122**

Sec. 314, **8:143; 19:260**

Sec. 314(d), **8:143; 9:390; 9:418**

Sec. 315(b), **1:324**

Sec. 316(a)(3), **21:74**

Sovereign immunity, **19:305**

Standard of review, **9:418**

Standing, **1:345; 1:361; 10:50; 16:157**

Substitution of claims, **9:421**

Supplemental information, **21:74**

Takings, **3:228; 3:231**

Third-party petition, **3:194**

Time barred, **12:115; 23:94**

28 USC § 1295, **1:327**

Unpatentable claims, **2:173; 16:152**

Validity of claims, **4:114**

Written description, **11:80; 13:252**

### INTERPRETATION

Generally. **Construction and Interpretation** (this index)

**Claim Construction and Interpretation** (this index)

### INTERRELATIONSHIP OF ISSUES

Defenses, **20:5**

### INTERROGATORIES

CAFC, **18:3**

Contention interrogatories, **23:76**

Directed to facts, **23:7**

JNOV, **23:4**

Obviousness, **5:7**

**Special Interrogatories** (this index)

**INTERVENING RIGHTS**

Indefiniteness, **16:161**  
 Protection of investments, **10:51**

**INTERVENTION**

Generally, **23:26**  
 Absolute intervening rights, **13:168;**  
**19:137**  
 Amicus curiae, **9:67**  
 Enhanced damages, **21:3**  
 Ex parte reexamination, **13:176**  
 FRCP 24, **3:38**  
 FRCP 24(b), **8:36**  
 Motion, **1:68**  
 Patent misuse, **23:9**

**INTESTACY**

Ownership, **1:172**

**INTRINSIC EVIDENCE**

Claim construction and interpretation,  
**1:140; 5:53; 11:40; 16:53; 16:58;**  
**18:51; 19:111; 19:115; 20:117**

**INTRINSIC RECORD**

Claim interpretation, **11:53; 22:31**

**INUREMENT**

Generally, **3:82; 7:64**  
 Corroboration, **14:83**  
 Derivation, **3:82**  
 Interference, **3:94**  
 Requirements, **3:94**

**INVALIDITY**

**Validity** (this index)

**INVENTION SECRECY ACT**

Claim against government, **8:116**  
 Sec. 183 use of invention, **8:117**

**INVENTIVE CONCEPT**

Generally, **1:355**

**INVENTOR**

Generally, **6:10; 19:62**  
 Analogous art, **19:36**  
 Attorney fee award, **8:18**  
 CAFC jurisdiction, **9:63**  
 Claim differentiation, **6:10**  
 Combinations, **6:10**  
 Construed by those skilled in art, **6:10**  
 Corroboration, need for, **8:30**  
 Design patent, **8:81**  
 Disavowal of feature, **16:151**

**INVENTOR—Cont'd**

Disclosure, **1:8**  
 Discovery of new property or use of  
 known composition, **9:104**  
 Feature, disavowal of, **16:151**  
 File wrapper, **6:10**  
 First inventor, Sec. 102(a)(2), **7:98**  
 Infringement, literal, **6:10**  
 ITC, **1:8**  
 Jury verdict, **19:5**  
 Literal infringement, **6:10**  
 Presumption, none, **1:8**  
 Prima facie obviousness, **9:17**  
 Prior art under Sec. 102(g) and Sec. 103,  
**1:8**  
 Public use, **14:36**  
 Rebuttal, **1:8**  
 Reissue, **9:84**  
 Scientific principles, **6:10**  
 Sec. 282, **1:8**  
 Sec. 337, **1:8**  
 Skilled in art, construed by those, **6:10;**  
**20:126**  
 Testimony, **8:106**

**INVENTORSHIP**

Generally, **2:194; 2:201; 3:215; 4:74;**  
**4:126; 5:73; 5:148; 7:79; 7:110;**  
**7:143; 20:159**  
 Appeal and review, **21:42**  
 Claim preamble, **19:210**  
 Conception, **2:99; 2:164; 6:35; 19:72;**  
**19:195; 20:126; 21:55**  
 Concerned party, **3:93**  
 Contribution, **6:50**  
 Correction, **6:35; 6:79; 16:131; 19:195;**  
**19:218; 20:68**  
 Corroborating evidence, **19:132; 21:42**  
 Declaratory judgment, **12:86**  
 Deference, **21:42**  
 Disclosure to public, **6:83**  
 Doctrine of equivalents, **4:125**  
 Eleventh Amendment, **24:3**  
 Equitable estoppel, **6:103**  
 Evidence, **19:132; 21:42**  
 False statements, **16:61**  
 Good faith error, **3:59**  
 Inequitable conduct, **16:48**  
 Infringement, **4:125**  
 Interference, **3:15; 5:73; 19:72; 19:109**  
 Joint inventor, **8:81; 22:54**

## INDEX

### **INVENTORSHIP—Cont'd**

Laches or delay, **16:131**  
Large number of individuals, **3:76**  
Law question, **1:106; 3:83**  
Means-plus claim, **23:55**  
Nonjoinder, **14:59; 16:50**  
Ownership, **5:40**  
Presumption that correct, **6:35**  
Private right of action, challenge, **8:115**  
Provisional application, **5:88**  
Reissue, **3:83**  
Review, standard of, **5:40**  
Sec. 102(b), **19:7**  
Sec. 256, **12:86**  
Standing, **19:272**  
Third party, filed in name of, **1:102**  
Touchstone, conception is, **2:99**  
Unclean hands doctrine, **16:131**  
Willful infringement, **2:164**

### **INVITED ERROR**

JNOV, **23:4**

### **INVOCATION**

Means-plus-function claim, **3:66; 25:3**

### **IOENGINE, LLC V. INGENICO INC.**

2024, **9:528**

### **IPSISSIMIS VERBIS TEST**

Anticipation, **1:10**

### **IQRIS TECHNOLOGIES LLC V. POINT BLANK ENTERPRISES, INC.**

2025, **9:537**

### **IRONBURG INVENTIONS LTD. V. VALVE CORPORATION**

2023, **9:525**

### **IRREPARABLE HARM OR INJURY**

Evidence, **18:26**  
License, **8:46**  
Permanent injunction, **4:102; 7:122;  
18:93**  
Preliminary injunction, **1:169; 1:225;  
3:34; 18:21; 19:14**  
Presumption, **1:110; 14:9; 18:32; 19:94**  
Procedural issue, **8:21**

### **IS OBVIOUS**

Combination, **18:22**

### **IS OBVIOUS—Cont'd**

Findings prepared by prevailing party,  
**18:22**  
Improper, **18:22**  
Patentable, **18:22**

### **ISOLATED DNA MOLECULES**

Patentability, **1:228; 9:383**  
Subject matter jurisdiction, **1:214**

### **ISOLATION**

Claims do not live in, **11:11**

### **ISSUANCE**

Judicial notice, **8:40**  
Preliminary injunctions, standard for  
issuance, **11:67**  
Reexamination, **9:239**  
**Reissue** (this index)  
Sec. 283, **18:18**

### **ISSUE DATE**

Sec. 112, **9:53**  
Sec. 153, **5:17**

### **ISSUE FEE**

Small entity, **4:52**

### **ISSUE JURISDICTION**

Generally, **20:34**

### **ISSUE PRECLUSION**

**Collateral Estoppel** (this index)

### **ITC**

**International Trade Commission** (this  
index)

### **“IT WOULD BE OBVIOUS”**

Verbatim findings of counsel adopted,  
**8:22**

**JANSSEN PHARMACEUTICALS,  
INC. V. TEVA  
PHARMACEUTICALS USA, INC.**  
2024, **10:55**

### **“JAWBONING” AT LICENSING NEGOTIATIONS**

Generally, **19:61**

**JAZZ PHARMACEUTICALS, INC. V.  
AVALDEL CNS  
PHARMACEUTICALS, LLC**  
2025, **10:56**

**JEPSON CLAIM**

Generally, **5:28; 11:40; 13:15; 18:44**  
 Claim preamble, **5:63**  
 Copying while lauding prior art, **13:15**

**JMOL**

**Judgment as Matter of Law** (this index)

**JNOV**

**Judgment Notwithstanding Verdict (JNOV)** (this index)

**JOINDER**

America Invents Act, **9:359**  
 Choice of law, **9:268**  
 FRCP 19, **9:71**  
 FRCP 19(a), **11:19; 19:264**  
 Inter partes review, **14:86**  
 Inventorship, **16:50**  
 Involuntary plaintiff, **9:302; 14:9; 15:9**  
 Owner, **19:194**  
 Sovereign immunity, **7:134**

**JOINED**

Generally, **7:49**

**JOINT DEVELOPMENT EXCEPTION**

On-sale bar, **2:23**

**JOINT INFRINGEMENT**

Claim construction, **1:195**  
 Control or direction over process, **13:159; 13:160**  
 FRCP 12(b), **12:112**  
 Performance of different steps by each infringer, **2:124**

**JOINT INVENTORS**

Generally, **16:48**  
 Collaboration required, **5:40; 6:35; 22:39**  
 Deceptive intent, **1:106**  
 Freedom to license, **19:98**  
 Interference, **4:31**  
 Inventorship, **8:81; 22:54**  
 License, freedom to license, **19:98**  
 Non-joinder, **14:59**  
 On-sale bar, **2:85**  
 Ownership, **9:303**  
 Physically work together or at same time, **20:68**  
 Presumption named properly, **7:79**  
 Requirements, **16:50**

**JOINT INVENTORS—Cont'd**

Same time, **20:68**  
 Scope of claims first, **5:73**  
 Sec. 116, **22:39**  
 Sec. 256, **22:54**  
 Sec. 262, **8:5**

**JOINT INVENTORSHIP**

Interference, **19:72**  
 Sec. 116, **2:48**

**JOINT LIABILITY**

Attorney fee award, **8:18**

**JOINT MOTION TO DISMISS**

Vacation of lower court decision, **20:95**

**JOINT MOTION TO VACATE**

**JUDGMENTS BELOW**

Settlement agreement, **21:22**

**JOINT VENTURES**

Patent misuse, research joint ventures, **16:126**

**JPML**

**Judicial Panel on Multi-District Litigation** (this index)

**JUDGE**

CAFC, **18:3**  
 Claim interpretation, **5:36**  
 Disqualification, **1:65; 16:19**  
 Fact finding, **10:15**  
 Improper, **16:25**  
 Judicial disqualification, **16:19**  
 Presumed jury fact findings, **10:15**  
 Qualification, judicial, **16:19**  
 Recusal, **1:65**  
 Sec. 284, **2:31**  
 Sec. 455, **8:14**  
 Weight and credibility of testimony, **19:54**

**JUDGMENT AS MATTER OF LAW (JMOL)**

Generally, **3:106; 5:54; 5:65; 5:71; 6:62; 9:237; 12:72; 13:99; 13:100; 13:103; 13:105; 13:118; 13:122; 14:45; 16:86; 18:41; 18:58; 18:64; 18:70; 19:123; 19:166; 20:52; 20:63; 20:81; 21:44; 22:23; 23:56; 25:7; 26:11**  
 Anticipation, **23:87**  
 Appropriate, when, **3:75; 12:43; 13:64**

## INDEX

### JUDGMENT AS MATTER OF LAW (JMOL)—Cont'd

Choice of law, **2:91; 19:137**  
Claim interpretation, **21:39**  
Discretion of court, **26:9**  
Doctrine of equivalents, **5:44**  
Evidence, effect of, **19:126**  
Experimental use, **5:50**  
FRCP 50(a), **2:34; 2:48; 13:194**  
FRCP 50(a)(1), **16:106**  
FRCP 50(b), **13:54**  
Jury findings, **2:45**  
Jury verdict, **11:28**  
Method claims, **13:195**  
Motion, **1:101; 13:54; 13:64; 13:194**  
New construction, **8:84**  
Obviousness, **1:171; 1:178; 2:136**  
Prevailing party, **3:161**  
Raising issues, **8:84**  
Reissue, **4:64**  
Review, standard of, **2:91; 3:96; 5:21;**  
**5:30; 6:46; 12:45; 12:61; 13:75;**  
**13:85; 13:101; 14:21; 14:25;**  
**18:62; 20:41**  
Substantial evidence, **10:40**  
Wide discretion to trial judge, **26:9**

### JUDGMENT NOTWITHSTANDING VERDICT (JNOV)

Appeal and review  
generally, **13:38; 21:5; 22:4**  
standard of review  
generally, **4:2; 12:31; 22:2**  
motion, **6:36; 9:186; 13:13; 13:34;**  
**19:12**  
new trial motions, **19:60**  
Attorney arguments, **23:4**  
Co-owners' right to relief, **23:4**  
Counsel arguments, **23:4**  
Cross-appeal, **22:4**  
Damages, **23:4**  
Directed verdict, **22:4**  
Evidence rules, **13:4**  
Fact, infringement mixed fact-law ques-  
tion, **22:4**  
FRCP 50(b), **23:25**  
Frivolous appeal, **22:4**  
Harmful error, **22:4**  
Infringement mixed fact-law question,  
**22:4**  
Instructions, **23:4**

### JUDGMENT NOTWITHSTANDING VERDICT (JNOV)—Cont'd

Interrogatories, **23:4**  
Invited error, **23:4**  
Jury and jury trials, **1:14; 19:7; 19:16;**  
**23:17**  
Jury findings, **18:29**  
Jury instruction, **22:2**  
Jury verdict, **3:17; 13:17; 19:56; 20:15**  
Law, infringement mixed fact-law ques-  
tion, **22:4**  
Law question, **13:38**  
Means-plus-function claim language,  
**4:4**  
Motion  
generally, **19:37; 23:7**  
Altwater, **6:6**  
best mode, **13:13**  
claim ambiguity, **13:13**  
claim construction, **6:6**  
Court error, **6:6**  
directed verdict, **4:32; 19:41**  
evidence, **6:6; 13:13; 25:4**  
extrinsic evidence, **13:13**  
fact question, **13:13**  
fair, **6:6**  
FRCP 50(b), **1:43**  
infringement, **6:6**  
jury and jury trials, **9:125; 13:39**  
jury instruction, **6:6**  
jury verdict, **5:7**  
limitations and restrictions, **13:13**  
nonasserted claims, **6:6**  
objection, timely, **6:6**  
perfect, not, **6:6**  
review, standard of, **6:36; 9:186;**  
**13:34; 19:12**  
review limited to sufficiency of evi-  
dence, **13:13**  
same meaning, words to be given,  
**13:13**  
substantial evidence, **6:6**  
substantial rights must be affected,  
**6:6**  
timely objection, **6:6**  
verdict, **16:14**  
New trial, **4:4; 13:4; 19:16; 23:4**  
Objections, **22:2; 23:4**  
Obviousness, **13:38; 20:15**  
Post-trial motions, **1:50**

**JUDGMENT NOTWITHSTANDING**

**VERDICT (JNOV)—Cont'd**

- Presumption of validity, **22:2**
- Prevailing party, **22:4**
- Procedural, **13:4**
- Sec. 112 equivalent, **4:4**
- Sec. 284, **23:4**
- Submission, **23:4**
- Substantial evidence, **15:2**
- Summary judgment, **10:4**
- Timely objection, **22:2**
- Validity, presumption of validity, **22:2**

**JUDGMENTS**

- Generally, **19:171**
- See also **Orders** (this index)
- Adding party, **15:13**
- Affirmed on any ground supported by record, **19:86**
- Appealability** (this index)
- Appeal and Review** (this index)
- Appropriate, when, **14:13**
- Assignor estoppel doctrine, **19:47**
- Choice of law, **19:95**
- Claim interpretation, **19:16**
- Considerations involved, **19:49**
- Cross-appeal to reverse validity or infringement, **18:2**
- Dann Amendment, **19:30**
- Doctrine of equivalents, **5:6**
- Enforcement, court's power, **1:83**
- Exceptional case, **16:59**
- FRCP 50, **7:27**
- FRCP 54, **6:16**
- FRCP 59(e), **19:42**
- FRCP 60(b), **1:29; 13:59**
- Interference estoppel by judgment, **23:14**
- Judgment as Matter of Law (JMOL)** (this index)
- Judgment Notwithstanding Verdict (JNOV)** (this index)
- No form of words necessary, **16:74**
- Opinions or findings, **19:42**
- Settlement agreement, **21:22**
- Special master's decision, **13:24**
- State court decision, **19:45**
- Vacation of Judgments** (this index)
- Validity, **2:169; 14:1**
- Verdict, **16:14**

**JUDICIAL BIAS**

- Generally, **16:29**

**JUDICIAL CAPACITY**

- Issue preclusion, **20:41**

**JUDICIAL DECISION**

- Retroactive application, **23:33**

**JUDICIAL ERROR**

- Article III, **19:55**

**JUDICIAL ESTOPPEL**

- Generally, **2:116; 4:43; 11:43; 12:3; 13:122; 14:30; 19:169; 21:24; 23:3**
- Choice of law, **21:24**
- Enforceability of unexecuted settlement agreement, **23:21**

**JUDICIAL FUNCTION**

- Judicial legislation, **5:3**

**JUDICIAL INQUIRY**

- Unambiguous, if language of statute is, **23:29**

**JUDICIAL LEGISLATION**

- Judicial function, **5:3**

**JUDICIAL NOTICE**

- Generally, **9:139**
- Delivery, **11:24**
- Everyday mechanical concepts, **9:127**
- Issued patent, **8:40**
- Mail delivery, **11:24**
- Mechanical concepts, everyday, **9:127**
- MPEP, **9:374**
- Proper subject matter, **6:10**
- Stay of execution of judgment and injunction pending appeal, **19:49**
- Time required for mail delivery, **11:24**

**JUDICIAL PANEL ON  
MULTI-DISTRICT LITIGATION  
(JPML)**

- Generally, **7:6**
- Consent, parties cannot confer by, **7:6**
- Consolidated pretrial proceedings governed by Sec. 1407(a), **7:6**
- Jurisdiction, transfer divests, **7:6**
- Sec. 1651, **9:128**
- Transfer divests jurisdiction, **7:6**

## INDEX

### JUDICIAL POWER

Generally, **3:57**

### JUDICIAL REDRAFTING

Summary judgment, **2:29**

### JUDICIAL REVIEW

Proper respondent, **19:89**

Restriction of access to, **1:72**

### JUNIOR PARTY'S BURDEN

Interference, **15:1; 19:70**

### JURISDICTION

Generally, **1:281; 1:352; 2:197; 3:121; 8:144; 11:74; 13:248; 16:184; 19:155; 19:337; 20:83; 21:89; 22:53**

Accounting remains only, **16:72**

Adversariness, lack of, **7:8**

Agreement depriving court, **21:14**

ANDA, **1:135; 3:132**

Antitrust claims, **3:69**

**Appellate Jurisdiction** (this index)

Arising under, **3:27**

    constitutionality, **13:191**

Assumption that party will establish contested, **4:44**

Bankruptcy court, **9:213**

Board of Patent Appeals and Interferences, **2:150**

Case jurisdiction, issue jurisdiction versus, **20:34**

Challenge to PTO determination in reexamination proceeding, **19:46**

Claims not asserted by patentee, **23:26**

Complaint, determined at time filed, **7:38; 13:59; 19:66**

Constitutionality, **13:191; 18:34**

Contempt, **1:263**

Counterclaim, **4:57; 7:73**

**Court of Appeals for the Federal Circuit (CAFC)** (this index)

Covenant not to sue, **18:81**

Declaratory judgment, **1:27; 2:122; 8:109; 13:194; 19:192; 23:9**

Design in public domain, **12:48**

Discretion of court to assume pendent jurisdiction, **11:20**

**Dismissal** (this index)

Disputed facts resolved in favor of petitioner, **5:27**

### JURISDICTION—Cont'd

Evidence outside pleadings, consideration of, **1:76**

Federal, **22:5; 23:77**

    state universities, **21:63**

Final judgment rule, **18:104**

Foreign defendant, **7:60**

Foreseeability plus test, **1:221**

Induced infringement, **22:59**

Infringement, **7:73**

In personam, **4:49; 9:226; 18:45; 22:11; 26:5**

Injunctions, **1:234; 19:9; 22:50; 22:59**

Intentions may change over time, **3:27**

International Trade Commission, **3:183**

Inter partes review, **1:377**

Issue jurisdiction vs. case jurisdiction, **20:34**

Judicial Panel on Multi-District Litigation (JPMDL), **7:6**

Law question, **16:43; 19:66**

Legal malpractice, **1:160**

Mandamus, **9:41; 9:63; 9:292; 23:92**

Non-final appeals from Patent Office, **9:422**

Nunc pro tunc order, **13:59**

Only accounting remains, **16:72**

Out-of-state defendant, **7:60**

Patent Cooperation Treaty (PCT), **2:116**

Pending appeal, **19:9**

Personal jurisdiction, **1:284**

**Personal Jurisdiction** (this index)

Post-trial injunction pending appeal, denial of stay of, **19:9**

Preliminary injunction, **3:12**

Raised at any time, **2:56**

Reissue application, **9:47**

Sanctions, **20:129**

Sec. 41(a)(7), **13:32**

Sec. 145, **9:394**

Sec. 1267, **7:25**

Sec. 1292(a)(1), **14:6**

Sec. 1338(a), **1:160; 3:150; 4:22; 4:92**

Settlement agreement, breach of, **7:54**

State law claims, **12:91; 12:96; 13:180; 21:60**

State universities, federal courts, **21:63**

Stay, **19:9**

Stream-of-commerce plus theory, **1:221**

**JURISDICTION—Cont'd**

**Subject Matter Jurisdiction** (this index)  
 Summary judgment and subject matter jurisdiction, **13:216**  
 Time complaint is filed, determined at, **7:38**  
 Timely, inquiry is always, **15:8**  
 Transfer, appeal transferred, **21:12**  
 Walker process claim, **24:6**  
 Well-pleaded complaint, **1:135; 1:160**  
 Written description, **22:59**

**JURISDICTIONAL GRANTS**

Sovereign immunity, **13:66**

**JURISDICTIONAL LIMITATION**

Limitation of actions, **8:44**

**JURISDICTIONAL RULES**

Generally, **21:21**

**JURISDICTIONAL STATUTE**

Statutory construction, **3:60**

**JURY AND JURY TRIALS**

Antitrust, **1:16**  
 Appeal, reversal on, **5:41**  
 Attorneys' fees, **1:300**  
 Burden of proof, **1:16**  
 CAFC, **18:3**  
 Constitutionality, **16:8**  
 Damages, **1:16; 1:199; 2:80; 23:73**  
 Defenses, **20:55**  
 Dismissal, **3:19**  
 Enablement, **1:14; 5:110**  
 Equitable issues over objection, **2:61**  
 Fact findings of, **19:9**  
 Findings, **2:45; 7:27; 18:29**  
 Fraud, **1:16**  
 FRCP 49(a), **19:21**  
 FRCP 50(a), **11:12**  
 Inconsistent findings, **1:14**  
 Inequitable conduct, **1:14; 1:16; 2:49**  
 Injunction, **20:55**  
 Instructions, **1:14**  
 JNOV, **1:14; 19:7; 19:16; 23:17**  
 JNOV motion, **9:125; 13:39**  
 Law question, **1:14**  
 Materiality, **1:14**  
 Motion, JNOV, **9:125**  
 Non-advisory, **19:9**  
 Objection, **1:14; 2:61**

**JURY AND JURY TRIALS—Cont'd**

Obviousness, **1:16; 3:153; 18:84; 19:37**  
 Presumed jury fact findings, **10:15**  
 Presumption of validity, **1:16**  
 Priority claim, **1:199**  
 Prosecution history estoppel, **6:26**  
 Reissue, **1:16**  
 Relevant market, **1:16**  
 Reversal on appeal, **5:41**  
 Reverse doctrine of equivalents, **19:24**  
 Review, standard of, **2:34; 7:28; 23:25**  
 Review of verdict, **19:60**  
 Royalty rate, **20:147**  
 Sec. 102(e) v. sec. 102(g), **19:41**  
 Sec. 112, **17:1**  
 Seventh Amendment, **1:58; 3:71; 9:170; 13:64; 13:74; 19:195**  
 Special interrogatories, **1:16**  
 Special verdicts, **13:53; 20:50**  
 Substantial evidence standard, **18:14**  
 Synergism, **1:16**  
 Tainted jury, written description, **1:215**  
 Validity, **21:26**  
**Verdict** (this index)  
 Waiver, **20:39**

**JURY BIAS**

Generally, **3:110**

**JURY INSTRUCTIONS**

Generally, **8:157; 13:53; 16:104; 19:165**  
 Anticipation, **10:4**  
 Directed verdict, **10:4**  
 Doctrine of equivalents, **19:227**  
 Error, **3:173; 9:317**  
 FRCP 49(b), **19:60**  
 FRCP 51, **12:20**  
 JNOV, **6:6; 22:2**  
 Meaning is requirement, **19:156**  
 New trial, **5:60**  
 Objection, **1:43; 13:38**  
 Prejudice, considered as a whole in determination, **10:15**  
 Prejudicial error, **2:31**  
 Remand, when appropriate, **7:27**  
 Review, standard of, **1:136; 4:32; 5:52; 10:4; 20:64**  
 Same invention, substantially, **10:4**  
 Special verdict, **6:88; 14:7**  
 Substantially same invention, **10:4**

## INDEX

### **JURY INSTRUCTIONS—Cont'd**

- Sufficiency, **2:143**
- Timely objection, **13:38**

### **JUST COMPENSATION**

- Claim against government, **8:116; 12:27**

### **JUSTICIABILITY**

- Choice of law, **13:30**

### **JUSTICIABLE CONTROVERSY**

- Ability to supply relief, **1:69**
- Declaratory judgment, **19:61**

### **JUSTIFICATION**

- Evidence, **8:35**

### **KESSLER DOCTRINE**

- Generally, **19:276**
- Claim construction and interpretation, **19:309**

### **K-FEE SYSTEM GMBH V. NESPRESSO USA, INC.**

- 2023, **11:91**

### **KICKER**

- Panduit guidelines, **13:72**

### **KNOWLEDGE**

- Notice and Knowledge (this index)

### **KNOWLEDGE ECONOMY**

- Sec. 101, **6:71**

### **KUEHL**

- Method of using versus method of making, **9:103**

### **LABELING**

- See also **Marking** (this index)
- Patent license, **12:14**

### **LABORATORY EXPERIMENTATION**

- Diligence, **19:144**

### **LACHES OR DELAY**

- Generally, **9:272; 9:377; 19:252; 19:267; 19:296**
- Apportionment, **23:27**
- Blonder-Tongue, **1:13**
- Burden of proof, **23:46**
- Claim preamble, **19:210**
- Compound interest, **4:24**
- Contribution, **23:27**
- Damages, **2:19; 3:180; 23:27**
- Defense, **8:114**

### **LACHES OR DELAY—Cont'd**

- Discretion of court, **14:11**
- Elements, **7:30; 13:44; 23:45**
- Equitable estoppel doctrine, **8:50**
- Estoppel, **1:48; 19:38; 22:8**
- Evidence, **3:155; 23:27**
- Exceptional case, **3:180**
- FDA approval, **20:100**
- Inequitable conduct, **3:149**
- Interference, **16:9**
- Intervening rights, evidence, **3:155**
- Invalidity, **3:180**
- Inventorship, **16:131**
- Inventorship dispute, **12:109**
- Jury verdict, **13:4**
- Laches, **5:53; 13:36; 19:151**
- Maintenance fees, **18:33**
- More than six years delay, **8:32**
- Notice of other proceeding, **8:16**
- Ownership, **19:204**
- Patent term adjustment, **23:69**
- Period of delay, **5:53**
- Plaintiff's, **14:9**
- Prejudgment interest, **21:20**
- Prejudice, **19:252**
- Preliminary injunction, **20:12**
- Presumption of validity, **12:9**
- Prosecution laches doctrine, generally, **19:181**
- PTO proceedings, **1:42**
- Reasonably prudent person standard, **18:33**
- Resulting prejudice, **13:44**
- Review, standard of, **5:30; 5:53; 8:50**
- Sale, **3:180**
- Sale during laches period, **15:14**
- Sec. 102(e) v. sec. 102(g), **19:41**
- Sec. 271(a), **3:180**
- Separately, each patent treated separately even if related, **19:76**
- Simple v. compound interest, **4:24**
- Standard, **19:154**
- Summary judgment, **1:36; 8:140; 10:4; 23:45**
- Totality of circumstances, **3:155**
- Trademark infringement, willfulness, **18:112**
- Two-elements required, **8:34**
- Unclean hands, **19:204**
- Undue delay, **9:241**

**LACHES OR DELAY—Cont'd**

- Unexplained delay, **19:151**
- Unreasonable delay, **1:54; 3:149; 12:21; 13:36; 19:151**
- Waiver due to failure to file belated preliminary motion, **7:26**

**LANGUAGE**

- See also **Claim Language** (this index)
- Claim interpretation, **18:68; 20:71**
- Claim preamble, **13:164**
- Consisting of claim language, **13:7**
- Indefiniteness, **16:47**
- Rewrite claim language, **18:68**
- Statutory construction and interpretation, **6:29; 11:33; 12:37; 19:67**

**LANHAM ACT**

- Generally, **19:185**
- Review, standard of, **9:249**
- Sec. 43(a), **12:23**
- Willful infringement, **3:26**

**LAPSE**

- Excuse, **11:3**
- Interference, **5:57**

**LARGE NUMBER OF REFERENCES**

- Obviousness, effect on, **9:114**

**LATCHES**

- Prosecution, **8:161**

**LATE CLAIMING**

- CAFC, **18:3**
- Interference, **3:25**

**LATE FILINGS**

- Board, **18:56**

**LATENT AMBIGUITY**

- Contract, **3:48**
- Extrinsic evidence, **9:160**

**LATENT PROPERTIES**

- Generally, **9:111**

**LATE PAYMENT**

- Maintenance fees, **6:51**

**LATER BROADER CLAIMS**

- Enablement, **1:78**

**LATER DEVELOPMENTS**

- Double patenting, **20:92**
- Skill, level of, **19:34**

**LATER REFERENCE**

- Prior art reference relevant for all that it discloses, **9:117**

**LATER SUBMISSION OF DATA**

- New interference rules, **8:3**

**LATER SUBMISSION OF EVIDENCE**

- Good cause under 37 CFR Sec. 1.617(b) justifying, **8:35**

**LAW-FACT QUESTION**

- Best mode, **3:31**
- Claim construction, **13:78**

**LAW FIRM**

- Disqualification of attorney, **5:12**

**LAW OF OBVIOUSNESS**

- All-purpose criteria for applying, none, **9:99**

**LAW OF THE CASE**

- Generally, **2:40; 3:8; 3:40; 19:57; 20:58**
- Accounting phase, **11:15**
- Appellate court need not explicate rationale for its ruling, **20:34**
- Applicable, when, **8:56**
- Applicable, when not, **12:59**
- Better term than fraud, **19:14**
- Cross-appeal, **7:28**
- Damages, **20:23**
- Evolving claim construction, **15:42**
- Exceptions, **7:36; 13:61**
- Finality, provides, **19:14**
- Fraud, better term than, **19:14**
- Inequitable conduct, **19:14**
- Prima facie case, **20:114**
- Reissuance, **1:276**
- Sec. 102(b), **19:31**
- Sec. 271(e)(1), **13:206**
- Sec. 271(g), **13:206**
- Special circumstances exception, **13:61**
- Summary judgment, **2:29; 10:4**

**LAW QUESTION**

- See also **Fact Question; Fact-Law Question** (this index)
- Abandonment, **1:111**
- Actual reduction to practice, **4:27**
- All elements rule, **10:7**
- Blonder-Tongue, **1:13**
- CAFC jurisdiction, **20:2**

## INDEX

### LAW QUESTION—Cont'd

Claim construction, **1:50; 1:77; 4:23; 8:74; 13:45; 13:54; 13:78**  
Claim differentiation, **11:2**  
Claim identity, **9:90; 19:59**  
Claim interpretation, **2:52; 4:17; 5:22; 8:52; 9:131; 12:33; 13:29; 13:80; 16:40; 18:30; 19:56; 20:25; 23:16**  
Claim preclusion, **2:159; 8:76**  
Claims, scope of, **7:4**  
Conception, **2:47; 2:96; 6:18; 6:20**  
Contract construction and interpretation, **1:56; 1:57; 3:70; 4:41; 4:42; 8:33; 9:132; 9:145; 9:159; 11:29; 17:5; 23:36**  
Count interpretation, **3:54; 4:31**  
Court's jurisdiction, **19:66**  
Declaratory judgment, **19:265**  
Derivation vs. priority of invention, **16:36**  
Double patenting, **9:134; 9:190**  
Enablement, **1:80; 1:117; 1:127; 9:150; 9:154; 9:210; 16:47**  
Identity, claim identity, **9:90**  
Implied license, **3:56**  
Indefiniteness, **9:328**  
Infringement, **12:31; 13:64; 13:74**  
Interference, **4:8**  
Inventorship, **1:106; 3:83**  
ITC, **13:20**  
JNOV, **13:38; 22:4**  
Jurisdiction, **16:43**  
Jury, **1:14**  
Means-plus-function claim, **11:47; 19:119**  
Motion to compel discovery, **19:17**  
Motion to dismiss, **2:54**  
Obviousness  
    generally, **1:171; 7:46; 9:24; 9:172; 9:216; 10:15; 12:40; 14:2; 16:48; 18:23; 18:41; 19:36; 21:8; 22:1; 23:7**  
    determination, **2:141; 9:100**  
    double patenting, **9:134**  
On-sale bar, **2:31; 7:71; 12:60**  
Ownership, **11:33**  
Personal jurisdiction, **8:69**  
Priority, **3:53**  
Procedural issue, **8:21**  
Prosecution history estoppel, **13:63; 23:25**

### LAW QUESTION—Cont'd

Public use, **1:159; 2:57**  
Reduction to practice, **2:96; 4:27; 5:34; 9:163; 19:70**  
Reexamination, **20:43**  
Reissue, **9:188**  
Repair, **4:1**  
Res judicata, **21:29**  
Sec. 145, **7:9**  
Stare decisis, **13:53**  
Statutory construction and interpretation, **1:74; 2:67; 4:40; 9:166; 9:200; 10:18; 13:49; 19:102**  
Statutory terms, interpretation of, **9:120**  
Stay pending clarification of law, **1:204**  
Substantial evidence vs. clearly erroneous, **20:1**  
Summary judgment, **1:35; 7:66; 20:10**  
Undue experimentation, **5:45**  
Validity, **14:8**

### LEAHY-SMITH AMERICA INVENTS ACT

**America Invents Act** (this index)

### LEAR

Generally, **6:45; 19:105**  
Blonder-Tongue, **20:9**  
Contract damages, breach of, **18:8**  
Damages, breach of contract, **18:8**  
Enforceability of settlement agreements when patent later held invalid, **8:11**

### LEASE

Experimental use, **13:123**

### LEGAL CONCLUSION

Definiteness, **1:118**  
Indefiniteness, **9:253**  
Printed publication, **3:101**

### LEGAL TITLE

Standing to recover money damages, **1:46**

### LEGISLATIVE HISTORY

Statutory construction, **7:35**

### LEXICOGRAPHER

Generally, **2:81; 6:10; 9:254; 13:124**  
Claim construction and interpretation, **1:132; 2:81; 9:254; 13:124; 26:1**  
Dismissal, **3:19**  
FRCP 52(a), **12:6**

**LEXICOGRAPHER—Cont'd**

Inventor as, **13:18**  
 Inventor as own, **14:20**  
 Ordinary meaning, **1:132**  
 Patentability standard, **13:18**  
 Patentee as own, **9:154; 10:13**  
 Summary judgment, **2:24; 10:13**

**LICENSE AGREEMENT**

Bona fide purchaser, **18:61**  
 Choice of forum clause, **23:2**  
 Contract law, **15:9**  
 Declaratory judgment, **7:79; 13:143; 19:192**  
 Defense, **6:102; 18:58**  
 ITC, litigation includes, **20:53**  
 Litigation includes ITC, **20:53**  
 On sale bar, **16:86**  
 Review, standard of, **19:104**  
 Sec. 1631, **19:2**  
 Subject matter jurisdiction, lack of, **1:7**  
 Third party making product, **3:70; 3:145**

**LICENSE BACK**

Assignor estoppel, **1:43**

**LICENSE DEFENSE**

Burden of proof, **3:56; 9:118**

**LICENSES**

Agreement. **License Agreement** (this index)  
 Antitrust violation, **7:25**  
 Assignment, **13:79; 13:87; 19:154**  
 Burden of proof, **19:48**  
 Co-inventors, **19:98**  
 Comparability to hypothetical license at issue in suit, **12:97**  
 Contempt, denial of, **16:23**  
 Continuation patent, **9:369**  
**Declaratory Judgments** (this index)  
 Domestic industry requirement, **9:370**  
**Exclusive Licensee** (this index)  
 FRCP 19, **9:71**  
**Implied License** (this index)  
 Injunctions, **22:37**  
 International Trade Commission, **9:379**  
 Invalidity of patent, licensee, **13:132**  
 Irreparable harm, **8:46**  
 Jawboning at licensing negotiations, **19:61**

**LICENSES—Cont'd**

Labeling, licensee's manufacture with customer's labeling, **12:14**  
 Marking, **13:75**  
 Non-exclusive, **10:33**  
 Nunc pro tunc assignments, **13:87**  
 Patent misuse, **19:6**  
 Reasonable royalty rate, **19:38**  
 Review of decision on JNOV motion, **21:5**  
 Royalty as compulsory license, **16:106**  
 Sec. 262, **8:5**  
 Special master's decision, **13:24**  
 Standing, **9:301; 13:133; 13:157; 15:9; 16:64; 18:35; 19:174; 20:45**  
 Stay of patent action, **9:91**  
 Subject matter jurisdiction, lack of, **1:7**

**LIFE AND MEANING**

Claim preamble, **9:154; 22:41**

**LIKELIHOOD OF SUCCESS**

Generally, **18:32**  
 Preliminary injunctions, **1:169; 1:183**

**LIMITATION OF ACTIONS**

Administrative proceeding does not toll statute unless proceeding is mandatory prerequisite to suit, **13:62**  
 Claims court, **2:53; 3:55**  
 Equitable tolling thereof, **23:38**  
 Jurisdictional limitation versus, **8:44**  
 Limitations, jurisdictional limitation versus, **8:44**  
 Litigation misconduct, **9:284**  
 Relation back doctrine, **1:350**  
 Review, standard of, **12:46**  
 RICO, **1:47**  
 Sec. 286, **1:48; 19:27**

**LIMITATIONS AND RESTRICTIONS**

Generally, **1:80; 8:71**  
 Agency's authority limited by grant from congress, **11:26**  
 All claim limitations must be considered, **9:153**  
 Anticipation, **19:56**  
 Appealable interlocutory order, **22:2**  
 Appeal and review, **2:9; 7:2; 7:58; 9:59**  
 Certified appeal, **6:17**  
 Claim amendment, **13:27**  
**Claim Construction and Interpretation** (this index)

**LIMITATIONS AND RESTRICTIONS****—Cont'd**

Claim differentiation doctrine, **3:89; 9:370**

Claim preamble  
generally, **1:119; 7:16**  
life and meaning, **9:154; 22:41**  
reciting structural limitations, **1:198; 18:44**  
series of limitations, **3:22**

Claim preclusion, **13:65**

Continuation-in-part applications, **16:112**

Damages for breach of contract limited to those reasonably foreseeable, **8:43**

Declaratory judgment, **10:6**

Description, **12:50**

Dismissal, **3:19**

**Doctrine of Equivalents** (this index)  
“Each and every” limitation, **25:11**

Enforceability, **13:42**

Every claim limitation or substantial equivalent must be present, **23:35**

Extraneous claim limitation, **9:154**

FRAP 28(g), **12:22**

FRCP 59(e), **19:42; 19:58**

Implied license, **13:21**

Infringement, **23:40; 25:3**

Instructional limitation added to method, **11:64**

ITC, **8:28**

JNOV motion, denial of, **13:13**

Judicial review, **1:72**

Material, each claim limitation is, **12:28**

Materiality, **1:220**

Means-plus-function claim, **23:54**

Negative limitation, **9:412; 12:108**

Not raised below, **7:58**

Obviousness, **16:4**

Ordinary and accustomed meanings, terms given their, **12:33**

Patent claims, **14:79**

Patent Cooperation Treat (PCT), **8:70**

Post-trial motions, **18:3**

Present, not, **10:10**

Prior art, added to overcome, **11:22**

Prior art reference, **12:80**

Prosecution history, **21:9**

Prosecution history estoppel, **18:101; 19:115**

**LIMITATIONS AND RESTRICTIONS****—Cont'd**

Reasonable royalty figures urged by parties, **19:53**

Reduction to practice, **3:82**

Reexamination, **9:194**

Reissue, **4:70; 22:15**

Sec. 112(6), **9:149; 22:10**

Sec. 121, **2:140; 7:16; 16:112**

Sec. 141-145, **9:59**

Sec. 171, **9:73**

Sec. 271(e)(1), **5:3**

Sec. 1491, **20:16**

Sec. 1821(b), **1:62**

Specification, limitation not required by, **9:118**

State immunity from suit under Eleventh Amendment, **10:11**

Statutory construction, **20:31**

Structural equivalency, **9:96**

Summary judgment, **20:13**

Validity, **4:68**

Written description, **9:412**

**LIMITED EXCLUSION ORDER**

ITC, **11:60**

**LINGUISTICS**

Motion, **9:233**

**LINKING CLAIM**

Reissue, **4:70**

**LIQUIDATED DAMAGES**

Challenges, **4:46**

**LITERAL CLAIM SCOPE**

Prosecution history estoppel, **2:77; 23:54**

**LITERAL INFRINGEMENT**

Claim construction, **2:139; 26:1**

Claim does not read exactly on accused device, **14:14**

Clearly erroneous standard, **19:23**

Exact corresponding, **12:33**

Fact question, **12:1**

Function not relevant to, **20:39**

Inventor's theory, **6:10**

Nonobvious, no requirement that accused device be, **2:49**

Summary judgment, **2:22; 20:13**

Willful infringement, **23:50**

**LITERALLY MET**

Doctrine of equivalents, **7:51**

**LITERAL SCOPE**

Doctrine of equivalents, **5:6**  
 Prosecution history estoppel, **13:95**

**LITERATURE OF THE ART**

Relative terms in claims given broadest reasonable interpretation during prosecution, **9:36**

**LITIGATION MISCONDUCT**

Bad faith behavior, **13:167; 18:29**  
 Exceptional case, **5:63; 13:197; 17:9; 18:64**  
 Inequitable conduct, **1:112; 1:180; 8:98**  
 Jurisdiction, **1:160**  
 Review, standard of, **1:112**  
 Sanctions, **1:193; 2:121; 13:85**  
 Statute of limitations, **9:284**

**LIVING THINGS**

Statutory subject matter, **16:63**

**LKQ CORPORATION V. GM GLOBAL TECHNOLOGY OPERATIONS LLC**

2024, **12:124**

**LOCAL RULE**

Generally, **15:23**  
 Attorneys' fees, costs, **1:260**  
 Patent-ineligibility defense, **13:217**  
 Privilege, **4:47**

**LONG DELAY IN FILING**

Interference, **16:9**

**LONG-FELT NEED**

Generally, **5:5; 20:29**  
 Burden on patent challenger, **16:12**  
 CCPA decisions, **9:74**  
 Obviousness, **21:8**  
 Review, standard of, **19:12**

**LOST COUNT**

Interference, **9:88**

**LOST PROFITS**

Generally, **7:88; 10:34; 13:223**  
 Acceptable noninfringing substitutes, **13:45**  
 Accounting phase, **11:15**  
 Anticipated profits, **13:131**

**LOST PROFITS—Cont'd**

But for test, **5:54; 6:36; 7:47; 8:51; 11:32; 13:121; 16:40; 16:161; 18:35; 20:52**  
 Causal relation must be shown, **5:71**  
 Causation, **3:96; 13:79; 15:10**  
 Convoyed sales, **1:174**  
 Damages, **1:20; 1:59; 2:19; 2:40; 3:8; 7:15; 7:63; 13:145; 13:157; 16:5; 16:135; 18:2; 19:52; 20:23; 23:3; 23:82**  
 Factual findings to support jury verdict presumed, **2:15**  
 Future lost profits, **19:137**  
 Infringement, **13:45; 26:4**  
 Issue preclusion, **4:9**  
 Market niche, **13:8**  
 Market share, **3:62; 21:18**  
 Obviousness, **18:23**  
 Panduit, **3:2; 11:28; 16:40; 19:56**  
 Price erosion, **2:34**  
 Reasonable royalty, **1:308; 23:81; 23:99**  
 Sec. 271(f), **23:82**  
 Sec. 284, **2:31**  
 Sec. 1498, **13:35**  
 Speculative, **21:35**  
 Standing, **23:82**  
 Subject matter jurisdiction, **25:1**  
 Substitutes, **13:45**  
 Two-supplier market, **6:26**

**LOST SALES**

Sears, **21:11**

**LUMP SUM ROYALTY PAYMENT**

Damages, **9:235**

**LUV N8217 CARE, LTD. V. LAURAIN**

2024, **12:125**

**MACHINE**

Damages, **16:5**  
 Definition, **9:290**  
 Means-plus-function claims, **19:112**  
 Prima facie obviousness, **9:17**  
 Sec. 101, **19:112**

**MACHINE-OR-TRANSFORMATION TEST**

Sec. 101, **3:164; 9:308; 16:123; 21:62**

**MAIL DELIVERY**

Judicial notice, **11:24**

## INDEX

### MAINTENANCE FEES

- Delay
  - generally, **9:470**
  - unavoidable, **18:33**
- Failure to pay, **2:131**
- Inequitable conduct, **14:70; 21:40**
- Late payment, **6:51**
- Payment, late, **6:51**
- Reinstatement of lapsed patent, **3:38**
- Sec. 285, **9:470**
- Small entity, **21:40**

### MALPRACTICE

- Generally, **14:76**
- Alternative claim language disregarded, **13:184**
- Negligence, **21:60**
- Personal jurisdiction, filing patent application, **20:94**
- State law claims, **12:96; 13:180; 21:60**
- Subject matter jurisdiction, patent law issues, **23:71**

### MALVERN PANALYTICAL INC. V. TA INSTRUMENTS-WATERS LLC 2023, **13:254**

### MANDAMUS

- Generally, **9:6; 9:229; 9:515**
- Abandoned application, changing filing date on, **9:54**
- Antitrust and patent claims separated for trial, **9:41**
- Appealability, **2:2**
- Appeal and review, **9:41; 9:63**
- Attorney-client privilege, **9:184; 9:293**
- Attorney fees award, **9:68**
- Attorney misconduct, **9:57**
- Attorneys, counsel misconduct, **9:57**
- Burden, **9:193**
- Business damage, suit for, **9:76**
- CAFC jurisdiction, **9:54; 9:63**
- Changing filing date on abandoned application, **9:54**
- Clearly erroneous finding, **9:57**
- Commissioner's decision, **9:54**
- Consolidation, **19:284**
- Custom, **9:57**
- Damages, **9:76**
- Discovery orders, review, **9:362; 9:430**
- Discretionary exercise, **6:19; 9:430**

### MANDAMUS—Cont'd

- Dismiss or transfer infringement suit, **9:432**
- Disregard law or ignore statute, courts not at liberty to, **9:57**
- District court jurisdiction, **9:41**
- Drastic remedy, **9:170; 9:180**
- Evidence, same, **9:41**
- Exceptional circumstances standard, **1:302; 9:63**
- Exclusive jurisdiction, **9:63**
- Filing date, **9:54**
- FRCP 21, **9:359**
- FRCP 42(b), **9:41**
- Frivolity, **9:68**
- Ignore statute or disregard law, courts not at liberty to, **9:57**
- Inter partes review, **9:385; 9:469**
- Jurisdiction, **9:41; 9:54; 9:63; 9:292; 23:92**
- Mandate, **9:388**
- Patent prosecution bar, **4:94**
- Petitions, **2:2; 9:54**
- Privilege, attorney-client privilege, **9:184**
- Remand to state court, **9:68**
- Remedial sanction, **9:57**
- Review, standard of, **9:128**
- Same evidence, **9:41**
- Sanction, remedial sanction, **9:57**
- Sec. 1651, **2:2; 9:41; 9:54; 9:68; 9:71; 9:76**
- Sec. 1782, **9:406**
- Separated for trial, antitrust and patent claims, **9:41**
- Severance, **9:359**
- Standing, **9:313**
- State courts, **9:68; 9:76**
- Strong medicine, **9:11**
- Subject-matter jurisdiction, **9:68**
- Threats to sue, **9:76**
- Transfer venue, **9:76; 9:336; 14:60; 26:14**
- Two juries, prohibition against, **9:41**
- Untimely appeal, **3:5**
- Venue, **9:445; 9:447; 9:457; 9:462; 9:472; 9:480; 9:490; 9:493; 9:498.50; 9:515**
- Waiver, **9:447**
- Writ, generally, **3:85**

**MANDAMUS—Cont'd**

Writ of mandamus, compelling production, **9:429; 9:490**

**MANDATE**

Appeal and review, **12:47**  
 Damages, **18:105**  
 Mandamus, **9:388**

**MANDATORY STATUTES**

Statutory construction, **5:17**

**MANIFEST INJUSTICE**

Attorney fees, **14:58**

**MANIFEST OR CLEAR ERROR**

Appellate role, **4:6**

**MANUAL OF PATENT EXAMINING PROCEDURE (MPEP)**

Admission or acquiescence in rejection, **16:6**  
 Anticipation, foreign publication, **16:6**  
 Binding force, none, **19:46**  
 CAFC, **9:10**  
 CIP, filing, **16:6**  
 Commercially available, **16:6**  
 Describes procedures on which public can rely, **16:8**  
 Devices, published, **16:6**  
 Disclosure, **16:6**  
 Filing CIP, **16:6**  
 Force of law, **18:1**  
 Foreign publication, efficacy as anticipation, **16:6**  
 Judicial notice, **9:374**  
 Publication, **16:6**  
 Published devices, **16:6**  
 Rejection, **16:6**  
 Reliance, **16:6**  
 Sec. 706, **9:114**  
 Sec. 711.01, **5:57**  
 Sec. 714.19, **5:57**  
 Sec. 717.05, **2:103**  
 Sec. 1302.10, **13:100**  
 Sec. 2001.06(a), **12:61**  
 Sec. 2152, **9:110**  
 Sec. 2217, **17:2**  
 Standing to sue, **19:46**

**MANUFACTURE**

Definition, **9:290**  
 Infringement, **10:23**

**MANUFACTURE—Cont'd**

Intervening rights, **13:168**  
 Jury verdict, **19:5**  
 Patent license, **12:14**  
 Reasonable royalty, **8:51**

**MAQUET CARDIOVASCULAR LLC V. ABIOMED INC.**

2025, **13:264**

**MARKET DEMAND**

Consumer behavior, **19:6**

**MARKETING**

Attorney, opinion of counsel, **3:72**

**MARKET NICHE**

Lost profits, **13:8**

**MARKET POWER**

Generally, **9:282**  
 Antitrusts, **9:219; 13:133**

**MARKET RATE**

Attorney fees award, **16:24**

**MARKET SHARE**

Lost profits, **3:62; 14:9; 21:18**

**MARKET SUCCESS**

Ultimate recognition, **9:90**

**MARKET VALUE**

Anticipated collateral sales vs. reasonable royalty rate, **18:35**  
 Patented feature is reason for demand, **20:50**

**MARKING**

Generally, **16:178**  
 Apparatus and method claims, **3:146**  
 Briefs, confidentiality markings, **9:337**  
 Civil penalty, false marking, **6:72**  
 Claim construction, **18:118**  
 Claim interpretation, **19:15**  
 Constructive notice of infringement, **6:78**  
 Damages, **4:89; 14:24; 18:2**  
 Estoppel, **6:86**  
 Fact question, **7:66**  
 Indications and usage, **2:152**  
 Licensees, **13:75**  
 Method claims, **3:146; 3:148**  
 No products to mark, **20:64**  
 Patent license, **12:14**

## INDEX

### MARKING—Cont'd

- Rationale, **12:58**
- Sec. 284, **14:24**
- Sec. 287, **4:12; 8:4; 13:33**
- Sec. 289, **14:24**
- Sec. 292, **12:23**
- Typographical error, manifestly obvious, **1:119**
- Writ of mandamus, **9:329**

### MARKUSH CLAIM

- Claim construction, **13:218; 19:299**
- Closed group, **1:122; 1:356**
- Consisting, **7:85**
- Co-pendency requirement, **9:105**
- Defined, **13:218**
- Infringement, **1:155**
- Sec. 121, not proper under, **9:105**

### MASK WORKS

- SCPA, **2:34**

### MASS PRODUCTION

- Sec. 112(1), **23:19**

### MASTER

- Generally, **19:38**
- Complex cases, **19:37**
- Damages, **20:19**
- Reliance upon his prior experience, **19:65**
- Special Master** (this index)

### MATERIAL FACT

- Executive Order 10096, **8:10**
- Review, standard of, **19:120**
- Summary judgment
  - generally, **3:81; 6:26**
  - absence of disputed issue of, **12:10**
  - disputed questions of, **5:36**
  - genuine issue, **1:103**
  - initial burden to show, **22:18**

### MATERIALITY

- Generally, **2:113; 6:60; 9:283; 15:24**
- CFR 1.56(a), **9:43**
- Cumulative reference, **19:59**
- Design patent, **16:1**
- Each claim limitation, **12:28**
- Examiner, **12:43; 23:5**
- FRCP 12(f), **4:13**

### MATERIALITY—Cont'd

- High degree of confidence and trust between PTO and patent applicants, **10:5**
- Inequitable conduct
  - generally, **1:3; 1:10; 1:257; 1:261; 2:85; 7:1; 12:56; 13:80; 13:102; 13:141; 14:8; 19:122; 21:26**
  - but-for materiality, **20:106**
  - every material omission requires less evidence to show intent, **2:68**
  - intent, balancing, **6:5; 19:208**
  - intent as essential element even when materially false affidavit involved, **7:34**
  - misstatement, **12:93**
  - omission, **4:84; 12:93; 16:112**
  - per se materiality rule, none, **12:20**
  - reference, **6:80**
  - requirement, **20:35**
  - withheld art less material than cited prior art, **8:29**
- Intent, **12:30; 12:43; 14:19**
- Jury, **1:14**
- Limitations, **1:220**
- Post- and pre-critical date claims, **1:220**
- Process Patent Amendment Act (PPAA), **2:60; 5:23**
- Prosecuting similar claims in separate patent, **4:72**
- PTO Rule 56, **13:158**
- Reasonable examiner, **2:103; 12:43; 13:69**
- Reference, **15:33; 19:59**
- Relevant, less, **2:68**
- Sec. 102(b), **13:35**
- Sec. 102(g), **11:9**
- Separate patent, **4:72**
- Summary judgment, **3:13**
- Surprising discovery, **16:105**
- Unclean hands doctrine, **18:40**

### MATHEMATICAL ALGORITHM

- Generally, **1:95**
- Definition, **9:42**
- Means-plus-function claim, **1:176; 9:42**
- Performing function, does not cover all means for, **9:42**
- Printed matter and substrate, **9:32**
- Sec. 101, **1:290; 9:308**

**MATTER OF LAW**

- Generally, **5:50**
- Doctrine of equivalents, **5:44**
- FRCP 50, **7:27**
- Obviousness conclusion, **9:15**

**MAXELL, LTD. V. AMPEREX TECHNOLOGY LIMITED**

2024, **13:260**

**MAXIM**

- Expressio unius, **4:30**

**MAXIMUM RECOVERY RULE**

- Damages, **19:137**
- Remittitur, **21:23**

**MEANING**

- About claim terminology, **5:20**
- Accustomed meaning. **Ordinary and Accustomed Meaning** (this index)
- Claim Construction and Interpretation** (this index)
- Claim preamble, **9:154; 16:20; 22:41**
- Contract Construction and Interpretation** (this index)
- Doctrine of equivalents, **3:51**
- FRAP 38, **16:4**
- FRCP 52(a), **12:6**
- Jury instructions, **19:156**
- Ordinary and Accustomed Meaning** (this index)
- Prosecution history, **8:74**
- Statutory Construction** (this index)
- Words** (this index)

**MEANINGFULNESS**

- Claim interpretation, nonsensical result, **3:113**

**MEANS-PLUS-FUNCTION**

- Generally, **1:130; 3:123; 4:120; 4:131; 5:32; 5:129; 5:148; 6:55; 7:83; 9:118; 13:239; 14:43; 16:94; 19:300; 20:81; 20:157.90; 22:30**
- Accused device must perform identical function, **11:32**
- Act, versus, **19:100**
- Adequate disclosure, **1:99**
- Adequate structure, **2:83**
- All functions must be performed, **12:3**
- Claim, generally, **3:176; 5:118; 13:221; 18:17**

**MEANS-PLUS-FUNCTION—Cont'd**

- Claim construction, **3:166; 5:110; 6:81; 9:199; 13:239; 16:138; 20:56; 20:149; 23:79**
- Claim differentiation, **18:17; 23:54**
- Claim language
  - express means-plus-function language, **2:137**
  - improper to narrow function beyond, **3:97**
- Clearly erroneous standard, **19:23**
- Clearly link structure with function, **13:118**
- Combination, **3:89**
- Component by component equivalence improper, **15:14**
- Computer, general purpose, **1:176; 6:68; 20:116**
- Continuation application with narrower claims, **4:51**
- Contours of corresponding structure is law question, **19:119**
- Corresponding function, **10:36; 18:48**
- Corresponding structure, **1:114; 2:61; 2:123; 7:70; 11:42; 14:56; 19:119; 19:238**
- Court must state burden of persuasion and quantum of proof required, **18:7**
- Cross-appeal to reverse validity or infringement component of judgment, **18:2**
- Definite structure, **6:36**
- Determining meaning of means, **13:87**
- Disavowal of claim scope, **3:140**
- Disclosure, **2:134; 4:17**
- Doctrine of equivalents versus, **1:125; 4:50; 9:215; 11:48**
- Enablement, **5:124**
- Equivalent structure, **9:96; 21:44**
- Evidence, standard of proof, **3:83**
- Extend to all means, does not, **10:28**
- First identify claimed function, **12:62; 13:100**
- FRCP 51, **12:106**
- Functional limitation, import, **23:54**
- Function different from claim, improper to adopt, **3:102**
- Identical function, **11:32**
- Identify function, **1:125; 7:67; 7:79; 12:66**

## INDEX

### MEANS-PLUS-FUNCTION—Cont'd

Import functional limitations, **23:54**  
Inconsistent construction, **20:56**  
Indefiniteness, **5:112; 9:330; 13:200; 18:107; 18:129; 26:15**  
Infringement, **1:289; 3:46**  
Injunction, **20:149**  
Inventorship, **23:55**  
Invocation, **3:66**  
Invoked, when, **25:3**  
JNOV, **4:4**  
Law question, **11:47; 19:119**  
Limitation, functional, **11:66; 23:54**  
Link structure in specification to recited function, **20:64**  
Machine claims, **19:112**  
Mathematical algorithm, **1:176; 9:42**  
Means, generally, **19:116**  
“Means” absent from claim, **16:138**  
Means for generally invokes, **15:12; 21:28; 22:17**  
Mechanism, **23:63**  
Multiple claim interpretation, may include, **9:225**  
Patentability, **4:97**  
Performance, **12:3; 12:26**  
Pioneer invention, **20:6**  
Plain meaning of claim, **2:31**  
Presumption with means, **1:134; 3:91; 5:51; 13:96; 18:107; 19:97; 23:51**  
Prior art, **6:75**  
“Program loading device,” **18:107**  
“Program recognition device,” **18:107**  
Proof, standard of, **3:83**  
Prosecution history, **4:51**  
Prosecution history estoppel, **3:84**  
PTO, construed same way in PTO as in litigation, **9:199**  
Review, standard of, **14:38**  
Review function and structure, **22:26**  
Scope, **3:78; 7:42; 13:84; 13:91**  
Sec. 101, **5:129**  
Sec. 112, **2:123; 16:11; 20:6; 23:63**  
Sec. 112(6), **1:51; 3:37; 9:130; 9:131; 9:149; 10:7; 10:13; 14:56; 18:107; 19:59; 22:10**  
Secondary considerations, **13:17**  
Specification, **6:36; 13:182; 20:64**  
Statements during prosecution related to structure, **1:77**

### MEANS-PLUS-FUNCTION—Cont'd

Steps without function, **5:63**  
Structural analysis, **6:75**  
Structural equivalency, **9:96**  
Structural support absent, **5:114**  
Structure, **6:73; 7:70; 12:26; 22:26**  
Structure performing function, **20:91**  
Test, **23:50**  
Two patents, **2:77**  
Two-step analysis, **3:88**  
Two-step approach, **15:21**  
Use of means, **12:69; 16:51**  
Whereby clause, **12:62**  
Willful infringement, **18:17**  
Written description, **1:262**

### MEANS WITHOUT SUBSTANTIVE CHANGE

Identical claims, **12:25**

### MEASUREMENT OF PHYSICAL PROPERTY

Patentability, **9:247**

### MECHANICAL CONCEPTS

Judicial notice, **9:127**

### MECHANICAL MISFIT

Sec. 103, **15:4**

### MECHANISM

Means-plus-function, **23:63**

### MEDICAL DEVICES

Sec. 271(e)(1), **5:13; 16:117**

### MEDICARE PRESCRIPTION DRUG, IMPROVEMENT, AND MODERNIZATION ACT

Case or controversy, **20:78**

### MEDICINAL DRUG

Chemical, **9:60**

### MEDTRONIC, INC. V. TELEFLEX INNOVATIONS S.A.R.L.

2023, **13:255; 13:256**

### MEDTRONIC, INC. V. TELEFLEX LIFE SCIENCES LIMITED

2023, **13:257**

### MEDYTOX, INC. V. GALDERMA S.A.

2023, **13:258**

**MEETING OF THE MINDS**

Generally, **23:21**

**MEMORANDUM DECISION**

Timeliness of appeal filing, **2:5**

**MENTAL PROCESSES**

Sec. 101 patentability. **Abstract** (this index)

**MENTION, FAILURE TO**

Inequitable conduct, **6:4**

**MERCK SHARP & DOHME B.V. V. AUROBINDO PHARMA USA, INC.**

2025, **13:265**

**MERE DENIAL**

Intent to mislead, **19:128**

**MERE DISSEMINATION**

Generally, **13:52**

**MERE KNOWLEDGE**

Inequitable conduct, **13:101**

**MERE PROCEDURAL DEVICE**

Presumption of validity, **13:53**

**MERGED FIRMS**

Disqualification of counsel, **16:18**

**MERIT SYSTEM**

Review, standard of, **8:48**

Standard of review thereof, **4:39**

**METAPHYSICAL DOUBT, MORE THAN**

Summary judgment, **10:32**

**METHOD**

Certainty and definiteness, **9:280**

Claim interpretation, **9:280**

Damages, **19:154**

FDA use code, patented method of use, **14:68**

Indefiniteness, **9:280**

Instructional limitation added, **11:64**

Kuehl, **9:103**

On-sale bar, sec. 102(b), **4:16; 13:212**

Sec. 102(b) on-sale bar, **4:16; 13:212**

Sec. 287(a), **3:96**

Summary judgment, **21:7**

**METHOD AND APPARATUS CLAIM**

Claim construction, **8:123; 9:280**

**METHOD CLAIMS**

Claim construction, method and apparatus claim, **8:123**

Computer-facilitated processes, **6:71**

Construction, **13:195**

ordinarily construed an order, **9:223**

Direct infringement, performance of all steps, **1:222**

Durden, **9:98**

Government liability, **26:10**

Implied, order not implied, **9:234**

Infringement, **5:121; 13:53; 13:186**

JMOL, **13:195**

Joint infringement, **13:159; 13:160**

Make requirement, **7:99**

Marking, **3:146; 3:148**

Order not implied, **9:234**

Ordinarily construed an order, **9:223**

Sec. 271(a), **1:269**

**METHODOLOGY**

Damages, **1:105; 11:10; 12:90; 13:75**

**MICROBIOLOGY FIELD**

Deposit of cell sample line not required at time of filing, **9:53**

**MILITARY AND STATE SECRETS PRIVILEGE**

Generally, **3:122**

**MILLER MENDEL, INC. V. CITY OF ANNA, TEXAS**

2024, **13:261**

**MINDS, MEETING OF**

Generally, **23:21**

**MINERVA SURGICAL, INC. V. HOLOGIC, INC.**

2023, **13:259**

**MINIMUM CONTACTS**

Cease and desist letters, **18:45**

Personal jurisdiction, **1:70; 1:181; 5:67; 6:150; 20:94**

**MINOR DIFFERENCES**

Infringement, **16:33**

**MINOR IMPROVEMENT**

Surprising results, **9:118**

**MINORITY**

Claim interpretation, **5:71**

## INDEX

### **MIRROR WORLDS**

**TECHNOLOGIES, LLC V. META  
PLATFORMS, INC.**

2024, **13:262**

### **MISLEAD, INTENT TO**

Generally, **13:80**

Disclosure, duty of, **14:19**

Materiality, **12:30**

### **MISLEADING CONDUCT**

Equitable estoppel, **19:108**

### **MISREPRESENTATION**

Conduct of counsel, **16:9**

Court's prior ruling, **19:57**

Exceptional case, **8:122**

Inequitable conduct, **8:85**

Intent to deceive, **6:28**

Prior art search, **7:29**

### **MISTAKE**

Generally. **Error** (this index)

### **MISTAKE AT TRIAL**

Jury verdict, **4:18**

### **MISTAKE OF FACT**

Contract rescission, **4:34**

### **MISUSE OF PATENT**

**Patent Misuse** (this index)

### **MITEK SYSTEMS, INC. V. UNITED SERVICES AUTOMOBILE**

**ASSOCIATION**

2025, **13:266**

### **MIXED QUESTION**

Best mode, **3:31**

Claim construction, **13:78**

Infringement, **19:19**

### **MOBILE ACUITY LTD. V. BLIPPAR LTD.**

2024, **13:263**

### **MODIFICATION**

Combination, **9:51**

Damages, **1:20**

FRCP 60(b), **23:23**

FRCP 60(b)(6), **3:29**

Incentive, **9:51**

ITC, **3:73**

Obviousness, **9:51**

Prior art, **9:51**

### **MODIFICATION—Cont'd**

References, **3:3; 9:51**

Secondary considerations, **9:82**

Summary judgment, **3:20**

### **MONETARY DAMAGES**

Harm to reputation, **18:32**

Preliminary injunction, **1:34**

### **MONETARY SANCTIONS**

Abuse of discovery process, **13:6**

Discovery, abuse of discovery process,  
**13:6**

### **MONOPOLY**

Antitrust, **7:73**

Double patenting, **9:45**

Power, **9:214**

### **MOOTNESS**

Generally, **16:43**

Altwater, **13:46; 22:4**

Burden, **8:155**

Dismissal of complaint, **19:14; 19:200**

Equivalence, **5:7**

FRCP 59(e), **19:42**

Infringement, **9:118; 11:23; 25:9; 25:10**

ITC, **20:6**

Partial settlement, **7:8**

Possibility of, **13:41**

Post-filing events, effect of, **19:55**

Post-trial settlement of infringement  
issues, **11:23**

Settlement, **1:237**

Standing, **13:226**

Test thereof, **8:54; 14:16**

Vacation of judgment, **20:95**

Validity, **1:113**

### **MORE PERTINENT ART**

Dismissal, **3:19**

Presumption of validity, **12:9**

### **MOTION IN LIMINE**

FRCP 54(b), **21:41**

Precluding testimony on issue not raised  
before the Board, **7:26**

### **MOTIONS**

Abuse of discretion, **19:17**

Add counts or parties, **3:43**

Amend pleadings, **3:24; 7:33; 19:6**

Amicus curiae, **9:67**

Choice of law, **20:17**

**MOTIONS—Cont'd**

Claim interpretation, **8:84**  
 Confidential information, **19:17**  
 Conflict of laws, **19:45; 19:165**  
 Contempt, **11:17**  
 Default judgment, relief from, **9:144**  
 Denial, when appropriate, **7:33**  
 Directed verdict, **1:1; 4:32; 19:41**  
 Discovery, compel, **19:17**  
 Dismiss  
   generally, **7:36; 8:44**  
   FRCP 12(b)(6), **1:54; 1:248; 1:343**  
   FRCP 19(a), **22:8**  
   Question of law, **2:54**  
   Section 101, **1:343**  
   state a claim, failure to, **2:41**  
   state claim, failure to, FRCP 12(b)(6),  
     **8:102; 19:237; 23:29**  
   subject matter jurisdiction, lack of,  
     **1:7**  
 Dispositive motions with no material  
   facts challenged, **8:10**  
 Disqualify trial judge, **8:12**  
 Dissolve, **16:7**  
 Employee's general knowledge, **19:45**  
 Execute on bond, **2:30**  
 Executive Order 10096, **8:10**  
 Findings, **12:11**  
 FRCP 12(b)(6), **2:41; 8:102; 19:237;**  
   **23:29**  
 FRCP 15, **3:24**  
 FRCP 24, **3:38**  
 FRCP 24(b), **8:36**  
 FRCP 41(a)(1), **5:18**  
 FRCP 41(b), **12:11; 19:31**  
 FRCP 50, **7:27; 12:11**  
 FRCP 50(b), **2:33; 13:54**  
 FRCP 59(e), **10:14**  
 FRCP 60(b), **2:43; 6:22; 9:144**  
 FRCP 60(b)(6), **3:29**  
 FRCP 65.1, **2:30**  
 Inequitable conduct, **19:17**  
 Infringement, **12:36**  
 Interference, **13:3; 16:7**  
 Intervene, **1:68; 3:38; 8:36; 9:67**  
 JMOL, **1:101; 7:27; 13:54; 13:194**  
 Joint motion to vacate judgments below,  
   **21:22**  
 Judgment, **2:33**

**MOTIONS—Cont'd**

**Judgment Notwithstanding Verdict**  
 (JNOV) (this index)  
 Jury, **9:125**  
 Jury verdict, **4:18**  
 Knowledge, trade secret in combination  
   of known components, **19:45**  
 Law question, **19:17**  
 Limitation of review, **13:13; 18:3**  
 Linguistic, substance not linguistic form,  
   **9:233**  
 Modify consent judgment, **3:29**  
**New Trial** (this index)  
 Particularity, failing in, **18:25**  
 Pendency, **12:36**  
 Pending, **19:45**  
 Petition for rehearing pending, **19:45**  
 Prejudgment interest, **10:14**  
 Preliminary motions, **7:26**  
 Publish CAFC decision, **9:1**  
 Quash discovery subpoena, **20:17**  
 Rehearing, **19:45**  
 Reissue proceeding, **12:36**  
 Remand, **9:38; 19:45**  
 Review, standard of, **9:186; 19:60**  
 Sec. 102(b), **19:31**  
 Sec. 455(a), **8:12**  
 Set aside judgment, **2:43; 6:22**  
 Settlement agreement, **21:22**  
 Stay, **11:1; 12:36**  
 Strike, **6:10**  
 Substance not linguistic form, **9:233;**  
   **19:86**  
 Summary judgment, **5:48; 9:215; 10:4;**  
   **13:82; 23:16**  
 Supplement record, **23:26**  
 Timeliness, **9:38; 16:37; 19:45**  
 Trade secret in combination of known  
   components, **19:45**  
 Vacate, **16:19**  
 Voluntary dismissal when neither  
   answer nor summary judgment  
   motion filed, **5:18**  
 Waiver, **7:26; 10:15**

**MOTIVATION**  
 Generally, **9:114; 9:428**  
**Obviousness** (this index)

**MOT PERTINENT ART**  
 Prior art, noting differences from, **4:6**

## INDEX

### MOVABLE

Construction of term, **9:338**

### MPEP

**Manual of Patent Examining Procedure (MPEP)** (this index)

### MULTI-COMPONENT PRODUCTS

Damages, **22:47**

### MULTIPLE APPLICATIONS

Claim construction and interpretation, **14:47**

### MULTIPLE CLAIM INTERPRETATION

Means-plus-function claim, **9:225**

### MULTIPLE DEFINITIONS OF PHRASE

Claim construction, **7:28**

### MULTIPLE DICTIONARY DEFINITIONS

Claim interpretation, **9:253**

### MULTIPLE EMBODIMENTS

Claim construction and interpretation, **22:30**

### “MURDERING Y, X ON TRIAL FOR”

Specious argument, **18:24**

### MUTUAL MISTAKE

Contract, **2:44**

Contract rescission, **4:34**

### NARROW CLAIM CONSTRUCTION

Prejudicial error, **14:2**

### NARROW CLAIMS

Implications, **13:39**

Manual of Patent Examining Procedure (MPEP) § 706, **9:114**

### NARROW EXCEPTION

Experimental use, **5:50**

### NARROWING AMENDMENT

Claim interpretation, **8:80; 12:83; 19:210**

Prosecution history estoppel, **2:128; 6:70; 7:69; 18:77**

### NATERA, INC. V. NEOGENOMICS LABORATORIES, INC.

2024, **14:111**

### NATURAL LAW

Generally, **1:355**

### NDA

**New Drug Application** (this index)

### NEGLIGENCE

Exceptional case, **18:9**

Inequitable conduct, **6:4; 14:8**

Intent to deceive, **19:59**

Malpractice, **21:60**

### NEGOTIATIONS

Damages, **12:90; 12:97; 16:129; 20:23**

Jawboning at licensing, **19:61**

Refusal to engage in settlement negotiations, **15:37**

Settlement negotiation privilege, **9:362**

### NETFLIX, INC. V. DIVX, LLC

2023, **14:109; 14:110**

### NEW ARGUMENT

Appeal, frivolous appeal, **13:46**

Frivolous appeal, **13:46**

### NEW ART

Constitutionality, **16:8**

### NEW BENEFIT OF OLD PRODUCT

Generally, **8:57**

### NEW COMPOSITION

Prima facie obviousness, **9:17**

### NEW CONSTRUCTION

JMOL, **8:84**

### NEW COUNSEL

Reissue, **9:84**

### NEW DRUG APPLICATION

Generally, **13:107; 14:33**

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

CAPC, **3:132**

### NEW EVIDENCE

Clearly erroneous, **6:9**

Rule 202, **9:288**

Sec. 145, **7:9; 8:118; 11:68**

### NEW FACTUAL SITUATION

Squeezing into preestablished pigeonholes, **9:99**

**NEW FEATURES**

Accused machine's commercial success, **23:7**

**NEW GROUND**

Rejection, **9:15; 9:22; 9:37; 9:127; 9:372**

**NEW INTERFERENCE RULES**

Generally, **8:35**  
 Corroboration, **8:3**  
 Exhibit must be discussed, **8:3**  
 Good cause standard, **8:3**  
 Later submission of data, **8:3**  
 Prima facie showing, **8:3**  
 Reduction to practice, **8:3**  
 Right to make count, **3:53**  
 Sec. 1.671, **8:3**  
 Submissions, **8:3**  
 37 CFR Sec. 1.608, **8:3**  
 37 CFR Sec. 1.609, **8:3**  
 37 CFR Sec. 1.617, **8:3**

**NEW ISSUE RAISED**

PTO motion to remand, **9:130**

**NEW JUDGMENT**

Sec. 271(e)(1), **5:13**

**NEW LEGAL TEST**

Essential element test, **3:101**

**NEWLY ADDED MATTER**

CIP, **19:28**

**NEWLY DISCOVERED EVIDENCE**

Generally, **1:101**  
 New trial, **22:26**

**NEWLY DISCOVERED PRIOR ART**

Enhanced damages, **21:3**

**NEWLY FOUND SEEDINGS**

Plant patents, **9:355**

**NEW MATTER**

Generally, **19:121**  
 Sec. 132, **2:34**

**NEW PRACTICE**

Interference, **16:16**

**NEW PRIOR ART**

As whole, prior art as whole, **5:11**  
 Burden of proof more easily carried, **5:11**

**NEW PRIOR ART—Cont'd**

Foreign references not well known, **5:11**  
 Operation of inventor's brain, **5:11**  
 Presumption of validity, **18:10**  
 Prior art as whole, **5:11**  
 Reference, **5:11**  
 Relevance, **5:11**  
 Secondary considerations, **5:11**

**NEW PROPERTY**

Claim construction, **5:2**  
 Discovery, **9:129**  
 Patentable, **9:104**

**NEW QUESTION**

Inter partes reexamination, substantial new question of patentability, **2:150**  
 Reexamination, **9:183; 9:314**

**NEW RESULT**

ITC, **1:17**

**NEW RULES**

Interference. **New Interference Rules** (this index)

**NEW TRIAL**

Generally, **3:123; 3:205; 18:14; 19:126; 19:156**  
 Choice of law, **5:56; 5:65; 13:101; 19:126**  
 Claim interpretation, **19:16**  
 Conflict of laws, motion for new trial, **19:165**  
 Discovery, newly discovered evidence, **22:26**  
 District court has wide discretion, **13:34**  
 Evidence, newly discovered, **22:26**  
 Grounds thereof, **21:27**  
 Infringement, **8:51**  
 JNOV, **4:4; 13:4; 23:4**  
 Jury instruction, **5:60**  
 Jury verdict, **3:17; 4:18**  
 Motion  
     generally, **21:39**  
     abuse of discretion, reviewed for abuse of discretion, **23:10**  
     choice of law, **5:56; 5:65**  
     claim interpretation, **19:16**  
     fact question, **23:10**  
     infringement, **23:10**

## INDEX

### **NEW TRIAL—Cont'd**

- Motion—Cont'd
  - reviewed for abuse of discretion, **23:10**
  - willful infringement, **16:22**
- Newly discovered evidence, **22:26**
- New trial, timely motion for new trial, **18:25**
- Retrial of infringement not necessarily validity, **8:51**
- Review, standard of, **2:99; 5:54; 13:85; 14:25; 16:87; 19:60**
- Timeliness for JNOV, **19:16**
- Timely motion for new trial, **19:165**
- Validity, **8:51**
- Willful infringement, **3:26; 16:22**

### **NEW UNAPPRECIATED PROPERTY OF PRIOR ART**

- Patentable subject matter, **5:56**

### **NEW USE**

- Generally, **9:201**
- Discovery, **9:129**
- Patentable subject matter, **2:82**
- Prior art article, **9:48**

### **NEXSTEP, INC. V. COMCAST CABLE COMMUNICATIONS, LLC**

- 2024, **14:112**

### **NEXUS**

- Burden on patent challenger, **16:12**
- Claims construed, **9:77**
- Commercial success, **2:76; 9:168; 18:28**
- Objective evidence of nonobviousness, **1:292; 12:43; 18:53**
- Obviousness, **1:292; 14:90; 18:15; 18:99**
- Prejudice, **8:32**
- Secondary considerations, **9:168; 9:331; 16:49; 19:36**
- Summary judgment, **3:1**

### **9 CIR**

- Generally, **16:21; 19:6**
- Appeal, scope of, **19:51**
- Dismissal of pendent state law claim for unfair competition, **22:2**
- Inconsistent verdicts, **18:14**
- Summary judgment, **3:1**
- Timeliness of appeal filing, **2:5**
- Verdicts, inconsistent, **18:14**

### **9 USC § 3**

- Arbitration, **18:13**

### **1952 PATENT ACT**

- Doctrine of equivalents, **23:42**

### **NOERR**

- Generally, **9:219; 14:21**
- Antitrust claim, **3:46; 20:127**
- Exception to, **6:27**

### **NOMINAL DAMAGES**

- Sec. 284, **12:24**

### **NONANALOGOUS ART**

- Reference, **9:16**

### **NONASSERTED CLAIMS**

- JNOV motion, **6:6**

### **NON-EXCLUSIVE LICENSES**

- Generally, **10:33**

### **NON-PARTIES**

- Appeal, standing to appeal, none, **19:48**
- Corroboration, **20:48**
- Injunction, **1:75**
- Issue preclusion, **9:296**
- Motion to quash discovery subpoena, **20:17**
- Sec. 102(g), **20:48**
- Standing to appeal, none, **19:48**
- Standing to oppose, **21:22**

### **NONSTATUTORY DOUBLE PATENTING**

- Sec. 101, **5:103**

### **NONSTATUTORY SUBJECT MATTER**

- Sec. 101, **9:30; 13:210**

### **NORMAL ORDINARY SKILL IN THE ART**

- Inventive acts involved, **9:436; 19:72**

### **NOSE OF WAX**

- Jury verdict, **19:5**

### **NOTICE AND KNOWLEDGE**

- Generally, **13:89**
- Administrative Procedure Act (APA), **9:344**
- Amend defective notice, leave to, **4:25**
- Anticipation, **23:48**

**NOTICE AND KNOWLEDGE—Cont'd**

Appeal and review, **4:25; 9:169; 9:317; 10:14; 10:18**  
 Best mode, **7:47**  
 CAFC jurisdiction, **9:63**  
 Chemical, **9:60**  
 Claim interpretation, **8:112; 13:120**  
 Combining references, **9:126**  
 Constructive notice, **19:172**  
 Contributory infringement, **19:79**  
 Damages, **7:66; 19:154**  
 Discovery, **9:129**  
 Everyday mechanical concepts, **9:127**  
 Evidence, **10:18**  
 FRAP 3(c), **2:46**  
 FRAP 4(a)(4), **10:14**  
 FRCP 49(a), **19:21**  
 Good faith, **7:92**  
 Hypothetical person of ordinary skill, **9:65**  
 Inducing infringement, knowingly, **1:222; 7:103; 23:3**  
 Inequitable conduct, **13:101**  
**Infringement** (this index)  
**Judicial Notice** (this index)  
 Laches, **8:16**  
 Letters to customers as infringement threats, **13:41**  
 Operation, principle of, **14:4**  
 Ordinary skill, hypothetical person of, **9:65**  
 Party's argument will not be addressed, **10:18**  
 Patentable, **9:104**  
 Preliminary injunction, **3:12**  
 Prior art, **9:114**  
 Reconsideration, request for, **20:21**  
 Reference  
     common knowledge of the art, **9:154**  
     materiality, **6:80**  
 Remand, motion to, **19:45**  
 Sec. 1.56, **8:29**  
 Sec. 271(b), **13:124**  
 Sec. 282, **1:92; 5:1; 20:15**  
 Sec. 285, **5:14**  
 Sec. 287, **2:6; 4:12; 7:92; 13:33; 21:53**  
 Specification need not disclose what is well known, **9:113**  
 Subject matter for judicial notice, **6:10**  
 Third persons, known or used by, **3:2**

**NOTICE AND KNOWLEDGE—Cont'd**

35 USC § 282, pre-trial disclosure, **23:76**  
 Timeliness, **2:5; 4:25**  
 Willful infringement, **3:80; 14:24**  
 Willfulness, **3:51; 3:96**

**NOVELTY**

See also **Point of Novelty** (this index)  
 Design patent infringement, **1:165**  
 Gorham infringement test, **12:17**  
 Specifications, applies to claims not, **20:67**  
 Summary judgment, **21:7**

**NULLIFICATION**

Final judgment, **9:354**

**NUMBER OF PREVAILING PARTIES**

Award of costs, **19:219**

**NUMBER OF UNITS SOLD**

Commercial success, **9:181**

**NUMERICAL RANGES**

Doctrine of equivalents, **1:115**

**NUNC PRO TUNC**

Jurisdictional defect, cannot be used to cure, **13:59**  
 Licensee, **13:87**  
 Reduction to practice, **3:94**

**OATH**

Reissue, **4:69**

**OBJECTION**

Agency, **9:311**  
 Claim interpretation, **19:16**  
 JNOV, **6:6; 22:2; 23:4**  
 Jury and jury trials, **1:14; 2:61**  
 Jury instructions, **1:43; 13:38**  
 Partial summary judgment, **7:5**  
 Secondary considerations, **13:17**  
 Special verdict, **8:52**  
 Testing protocol, **14:4**

**OBJECTIVE**

Anticipation, **18:20**  
 Reasonable apprehension, **16:42**  
 Sec. 282, **6:10**  
 Secondary, **19:19**

**OBJECTIVE CRITERIA**

Obviousness, **11:55**

## INDEX

### OBJECTIVE EVIDENCE

Generally, **9:168**  
Must be commensurate with claimed invention, **9:100**  
Nexus, **12:43; 18:53**  
Obviousness, **3:30; 21:8**  
Probative, often most, **7:46**  
Valid, inappropriate to declare, **4:19**  
Verbatim findings of counsel adopted, **8:22**

### OBJECTIVE FACTORS

Prima facie obviousness, **9:86**

### OBJECTIVE INDICIA

Secondary considerations, **14:2**

### OBJECTIVE INTENT

Broadened reissue, **9:109**

### OBJECTIVE STANDARD

Prosecution history estoppel, **1:96; 2:74; 13:80; 16:57**

### OBSERVATION

Generally, **13:41**  
Claims determine what infringes patent, **9:4**

### OBSCURITY

Presumption of validity, **9:21**

### OBVIOUSNESS

Generally, **1:265; 1:348; 1:367; 1:378; 1:380; 2:182; 2:193; 3:78; 3:98; 3:184; 3:228; 4:81; 4:123; 5:135; 5:140; 5:154; 6:107; 7:83; 7:133; 9:243; 9:256; 9:260; 9:265; 9:413; 9:417; 9:439; 9:450; 9:456; 9:458; 9:460; 9:475; 9:514; 13:137; 13:189; 13:202; 13:225; 13:235; 13:246.70; 13:253; 14:42; 14:89; 14:100; 15:53; 15:55; 16:97; 16:158; 17:10; 18:15; 18:122; 18:126; 18:130; 19:251; 19:268; 19:273; 19:302; 19:310; 19:312; 19:319; 19:330; 20:126; 20:157.50; 21:79; 21:88; 22:57; 25:13; 25:14; 26:16**  
Absolute predictability of success not required, **13:18**  
Accepted wisdom, contrary to, **3:3**  
Actual reports of failure, **2:101**  
Adding features, **21:8**  
Admission of prior art, **18:70**

### OBVIOUSNESS—Cont'd

Admissions, effect of inventor's, **9:125**  
Advisory jury, **11:69**  
All evidence to be considered, **1:80; 5:5; 18:15**  
All-purpose criteria for applying, none, **9:99**  
Analogous art, **4:127; 9:338; 11:70; 18:23**  
ANDA, **6:91; 16:108; 19:271**  
Anticipation, **1:255; 3:203; 4:15; 5:139; 9:442; 9:461; 10:8; 11:77; 13:204; 13:227; 20:67; 21:76**  
Apparatus and obvious methods of use suggested, **4:74**  
Appeal and review, **7:2; 9:56; 15:40**  
Applicant's disclosure cannot be used to fill in gaps, **9:29**  
As a whole, **2:8; 2:171; 5:111; 7:17; 9:46; 9:179**  
Attorney, **3:104**  
Blocking patent, **1:314**  
Blonder-Tongue, **1:13**  
Blueprint, **9:90**  
Broadest reasonable interpretation, **3:201**  
Burden, **1:30; 14:71**  
Burden of persuasion and quantum of proof required, **9:357; 18:7**  
Cancellation of claims  
generally, **16:154**  
motion to amend to request, **14:78**  
Case or controversy, **19:317**  
Chemical cases, **9:44**  
Chemical composition, **9:98**  
Chemical compound, **5:90; 5:91**  
Chemical process, **9:20**  
Claim construction, **1:223; 2:183; 2:186; 3:178; 8:103; 9:397; 9:459; 19:11; 19:226; 19:243; 19:327; 20:8**  
Claimed ranges, **9:277**  
Claim preamble, **9:79**  
Claims  
generally, **2:171; 21:8**  
as a whole, **1:166; 5:111; 18:71**  
Clear and convincing evidence, **2:171; 14:9**  
Clear error, **12:79**  
Coextensiveness, **20:157.30**  
Collateral estoppel, **10:3**

**OBVIOUSNESS—Cont'd**

Combination  
 generally, **9:29; 13:15**  
 motivation to combine, **9:372; 23:68**  
 references, **1:4; 1:30; 3:138; 8:42; 9:121; 23:11**  
 suggestion to combine, **2:92**  
 Commercial embodiment, comparison with patentee's, **1:4**  
 Commercial success, **7:108; 9:154; 9:311; 13:166; 18:15; 18:83; 20:107; 23:75**  
 Common sense, **9:297; 9:450**  
 Comparative data, **9:56**  
 Composition claim, recitation in, **9:12**  
 Conclusion, **9:15**  
 Contemporaneous beliefs, **9:12**  
 Contrary to prior art teachings, **9:31**  
 Contributory infringement, **7:130**  
 Copying, **1:119; 12:116; 23:75**  
 Correctness, reviewed for, **9:15**  
 Corroboration, **5:133**  
 Covered business method review, **21:72**  
 Criticality of claimed range, **9:107**  
 Damages, **19:228**  
 Defenses, **16:4**  
 Dependent claim, **9:24; 16:4; 18:23; 19:245**  
 Derivation of invention, **3:204**  
 Description, **6:99; 14:101; 20:47**  
 Designer of ordinary skill, **12:32**  
 Design patent, **8:128; 9:120; 9:135; 9:178; 9:227; 12:17; 13:198; 16:17**  
 Desirability  
 generally, **9:260**  
 prior art, combination proposed, must suggest desirability of, **9:29**  
 Device on sale more than one year, **20:72**  
 Differences, **3:3; 3:41; 18:15**  
 Disclaimers, **1:326**  
 Disclosure, **9:107; 16:4; 19:243**  
 DNA, **9:248**  
 Doctrine of equivalents, **3:178**  
 Double patenting  
 generally, **1:250; 5:49; 5:55; 9:110; 9:194; 9:203; 9:211; 9:488; 16:112; 16:147; 19:246; 21:76**  
 absolute predictability, not, **9:52**  
 claim comparison, **16:122**

**OBVIOUSNESS—Cont'd**

Double patenting—Cont'd  
 claim consideration, **1:166**  
 claim construction, **19:226**  
 claims “as a whole,” **5:111**  
 consonance, need for, **20:29**  
 disclosure, **9:45; 9:307; 19:226**  
 doctrines purpose is to prevent improper timewise extension of patent right, **9:112**  
 expectation, reference teaching requires only reasonable expectation of success, **9:52**  
 extension, doctrines purpose is to prevent improper timewise extension of patent right, **9:112**  
 fact vs. law questions, **9:52**  
 judicial notice of MPEP, **9:374**  
 law question, **9:134**  
 lead compound selection, **15:41**  
 obviated by terminal disclaimer, **17:2**  
 predictability, not absolute, **9:52**  
 prosecution rate, **6:69**  
 PTO, review of decisions, **9:52**  
 reasonable expectation, **9:52**  
 reference composition, **15:38**  
 reference teaching requires only reasonable expectation of success, **9:52**  
 review of PTO decisions, **9:52**  
 same invention, **9:52**  
 Sec. 121, **19:59**  
 terminal disclaimer as concession, **15:6**  
 variation amount, **5:103**  
 Enablement, **14:101**  
 Established by factual evidence not argument, **9:15**  
 Evidence  
 all evidence must be considered, **5:5; 18:15**  
 commercial success and copying, **23:75**  
 established by factual evidence not argument, **9:15**  
 examiner, evidence not before, **11:42**  
 expert opinion, **13:53**  
 independent evidence of nonobviousness, **3:175; 13:185**  
 nexus, **1:292; 18:99**  
 objective evidence, **21:8**

## INDEX

### OBVIOUSNESS—Cont'd

Evidence—Cont'd  
strong evidence, **13:85**  
substantial evidence, **3:208; 20:152**  
weight and credibility of evidence,  
**1:30; 3:165; 13:84; 16:19;**  
**16:137**  
Examiner, evidence not before, **11:42**  
Examiner's rejection, **9:427; 9:434**  
Expectation, unexpected results, **1:168;**  
**9:228; 9:250**  
Expectation of success, reasonable,  
**12:55; 16:108; 16:109**  
Expert testimony, **1:235; 13:53; 19:244**  
Fact findings, **1:4**  
Fact question, **9:182; 9:217; 23:52**  
Facts needed, **3:104**  
Factual evidence, **9:15**  
Failure to satisfy burden of proving,  
**20:135**  
FDA approval, **1:235; 1:236**  
Four-part factual inquiry, **1:87; 1:92;**  
**2:59; 3:83; 6:37; 9:181; 9:211;**  
**9:231; 11:40; 13:90; 16:49; 18:47;**  
**18:51; 18:53; 18:55; 19:119;**  
**21:34; 23:47; 23:50; 25:7**  
Four-part test, **1:126; 13:116; 22:27**  
Fraud, **1:171; 22:1**  
Functional relationship, **9:32**  
Genus, **3:167**  
Graham factors, **2:8; 19:244**  
Guidelines, **16:4; 18:23**  
Hatch-Waxman Act, **21:76**  
Heart of invention, **16:41**  
Hindsight, **1:149; 3:103; 3:109; 5:47;**  
**9:274; 13:185; 15:42; 16:4;**  
**16:137; 19:92; 21:8**  
Hypothetical person, **2:8**  
Improvement, **18:23**  
Incorporation by reference, **16:164**  
Indefiniteness, **2:160**  
Independent evidence of nonobvious-  
ness, **13:185**  
Inducement, **7:130**  
Inducing infringement, **8:24**  
Inequitable conduct, **1:231; 18:84;**  
**19:202; 22:1**  
Infringement, **7:10; 18:23; 19:11; 19:19**  
Inherency, **5:136; 8:147; 8:159; 16:140;**  
**16:171; 19:303; 20:67**  
Innovation is always invention, **18:15**

### OBVIOUSNESS—Cont'd

Interference, **18:89**  
Inter partes reexamination, **12:101**  
Inter partes review, **1:283; 1:295;**  
**1:321; 1:326; 2:173; 3:201; 5:131;**  
**5:134; 5:139; 8:139; 9:418; 9:426;**  
**9:428; 11:86; 11:283; 13:222;**  
**14:99; 14:104; 16:166; 20:153;**  
**22:56**  
Interrogatories, **5:7**  
JMOL, **1:171; 1:178; 2:136**  
JNOV, **13:38; 20:15**  
Jurisdiction to review, **7:128; 9:425**  
Jury and jury trials, **1:16; 3:153; 18:84;**  
**19:37**  
Known or used by others, **3:2**  
Large number of references, **9:114**  
Law question, **1:171; 2:141; 3:151;**  
**7:46; 9:24; 9:100; 9:172; 9:216;**  
**10:15; 11:75; 12:40; 14:2; 16:48;**  
**18:23; 18:41; 19:36; 21:8; 22:1;**  
**23:7**  
Lead compound, **21:58**  
Legal determination, **2:76**  
Limitations, **6:101; 16:4; 16:137**  
Literal infringement, **2:49**  
Long-felt need, **21:8**  
Lost profits, **18:23**  
Marketplace response, **20:107**  
Matter of law, **9:15**  
Minor changes, **9:166**  
Modification, **9:51**  
Motivation  
generally, **9:207; 11:49; 16:140;**  
**22:26**  
combine, **7:127; 9:428**  
expert testimony, **23:68**  
fact question, **9:217; 23:52**  
modify prior art reference, **9:124**  
Multiple different patents, **16:156**  
New ground of rejection, **9:15; 9:127;**  
**9:372**  
Nexus, **1:292; 6:101; 12:43; 14:90;**  
**17:13; 18:15; 18:53; 18:99**  
Non-enabling reference may qualify as  
prior art on obviousness, **19:59**  
Non-technical arts, **13:166**  
Objective criteria, **11:55**  
Objective evidence, **1:255; 21:8**  
Objective indicia of nonobviousness,  
**11:69**

**OBVIOUSNESS—Cont'd**

Obvious to try, **9:66; 9:459; 14:37**  
 Obvious to try distinguished, **11:63**  
 On-sale bar, **20:50; 20:72**  
 Opinion testimony, **1:30**  
 Optimizing result-effective variable, **9:352**  
 Ordinary skill, **2:8; 12:32; 19:231; 20:126**  
 Others, failed attempts of, **1:101**  
 Papesch, **9:9**  
 Patentability, **9:66; 9:107; 19:59**  
 Patent marking, **1:307**  
 Patent term extension, **14:95**  
 Per se obviousness rejection, **9:173**  
 PETITION for rehearing en banc, **19:287**  
 PHOSITA (person having ordinary skill in the art), **9:436**  
 Pick and choose, **2:8**  
 Policy, **16:4**  
 Potential claim unpatentable, **8:142**  
 Predictability of success not required, **1:255**  
 Prejudicial error, **18:15**  
 Prerequisite is determining pertinent references, **19:154**  
 Presumptions, **1:4; 1:30; 13:99; 16:4**  
 Prevaling party, **19:259**  
 Prima facie cases  
   generally, **9:37; 9:167; 9:174; 9:197; 9:207; 9:245**  
   see also **Prima Facie Obviousness** (this index)  
 Prima facie showing, **1:283**  
 Printed matter, **16:169**  
 Printed matter and substrate, **9:32**  
 Prior art  
   generally, **2:157; 9:167; 9:371; 9:446; 15:43; 16:4**  
   admission of, **18:70**  
   combination proposed, must suggest desirability of, **9:29**  
   contrary to teachings, **9:31**  
   found or suggested, **19:59**  
   lack of suggestion, **9:148**  
   must be some teaching or suggestion in, **14:8**  
   reference, need for teaching, suggestion or motivation to modify, **9:124**  
   same as before PTO, **2:8**

**OBVIOUSNESS—Cont'd**

Prior art—Cont'd  
   scope and content, **18:92**  
   some suggestions or incentive in, **1:30**  
   specification, statement of purpose in, **9:19**  
   state of art at time invention made, **4:91**  
   suggestion, generally, **21:8**  
   teachings, generally, **9:19; 16:4**  
   though not, **1:30**  
 Prior suit, validity holding in, **7:17**  
 Privity, **11:14**  
 Process performable by person, **1:12**  
 Proposed substitute claims, **9:418**  
 Prosecution history estoppel, **19:275**  
 PTAB, **9:403**  
 Question  
   apparatus distinctions not claimed in process claims, **16:19**  
   attorneys, counsel arguments, **16:19**  
   burden, heavy, **16:19**  
   CAFC, **18:3**  
   credibility, **16:19**  
   evidence, objective, **3:30**  
   Graham, **3:30**  
   heavy burden, **16:19**  
   jury verdict, **3:17**  
   law question, above  
   objective evidence, **3:30**  
   reissue, **3:30**  
   reject witness' testimony, **16:19**  
   review, standard of, **16:19**  
   Sec. 103, **1:294; 16:19; 23:84**  
   skill in the art, level of, **3:30**  
   witnesses, reject of testimony, **16:19**  
 Ranges of obviousness, **5:134; 9:352; 22:63**  
 Reasonable expectation of success, **8:131; 9:52; 12:55; 15:58; 16:140**  
 Rebuttal evidence, **9:99**  
 Recitation in composition claim, **9:12**  
 Reexamination, **4:109; 9:329; 9:351; 9:442; 18:99**  
**Reference** (this index)  
 Rehearing, **2:161**  
 Rehearing en banc, **13:214**  
 Rejection, **9:15; 9:56; 9:173; 9:333**  
 Remand and reassignment, **20:104**  
 Research, weight, **13:84**

## INDEX

### OBVIOUSNESS—Cont'd

Review, standard of, **2:59; 9:26; 9:168; 9:174; 9:195; 9:202; 22:13**  
Routine optimization, **9:449**  
Rule 131 affidavit, **7:19**  
Same invention-type, **19:39**  
Same way for validity and infringement, **19:11**  
Sec. 101, **14:99**  
Sec. 102, **3:168**  
Sec. 103, **3:168; 13:225**  
Sec. 314(d), **9:418**  
Sec. 102(g), **11:9; 20:126**  
Sec. 103, **9:27; 9:62; 9:103; 9:117; 9:139; 9:295; 15:4; 23:84**  
Sec. 112, **9:86**  
Sec. 171, **9:73**  
Sec. 282, **1:4**  
Secondary considerations, **3:175; 3:190; 6:99; 8:153; 9:331; 13:45; 13:253; 16:4; 16:168; 18:15; 19:11; 21:8; 23:66; 25:14**  
Separately argued, **18:23**  
Simultaneous inventions, **7:97**  
Single reference, **19:123**  
Skill in the art, level of, **2:197; 4:82; 15:19**  
Sophisticated inventions, not limited to, **16:4**  
Special master's decision, **13:24**  
Specification, **9:19; 9:56**  
Specificity, need for, **12:64**  
Standard of review, **9:418**  
Standing, **1:334; 7:129**  
Statement of purpose in specification not prior art, **9:19**  
Strong evidence showing nonobviousness, **13:85**  
Subject matter as a whole, **9:46; 9:436**  
Substantial evidence test, **9:394; 19:43**  
Substrate, **9:32**  
Suggestion, **9:124; 9:148; 9:204; 11:49; 14:8; 21:8; 22:26**  
Summary judgment, **8:14; 9:454; 12:15; 21:7**  
Superior work, **18:23**  
Teach away, **9:361; 19:234; 20:50**  
Teaching-suggestion-motivation test, **3:153**  
Test, **18:23**  
Third persons, failure of, **21:8**

### OBVIOUSNESS—Cont'd

Time and timeliness, **4:91**  
Time invention made, **12:43; 19:227**  
Two-step analysis, **11:43**  
Underlying factual inquiries, but based on, **9:197**  
Unexpected properties, **8:147**  
Unexpected results, **7:108; 8:40; 9:15; 9:228; 9:250; 9:295; 19:211; 19:214**  
Unpatentable, **9:423**  
Unpatentable claims, **2:173; 16:152**  
Utility, **7:130**  
**Validity** (this index)  
Values, range of, **9:191**  
Verdict, **16:14**  
Vitiation, **3:178**  
Waiver, **9:439**  
Weight, years of research entitled to, **13:84**  
Weight and credibility of evidence, **1:30; 3:165; 13:84; 16:19**  
Willful infringement, **8:129; 18:23**  
Work better, **18:23**

### OBVIOUS TO TRY

Generally, **9:99; 13:18**  
Chemical, **9:60**  
Claim construction, **9:459**  
Conventional knowledge, **2:133**  
Expectation of success, **1:44**  
Lack of written description, **11:62**  
Obviousness, **14:37; 16:107**  
Obviousness distinguished, **11:63**  
Standard, not, **9:26**  
Standard of patentability, **9:66**  
Test, improper, **9:167**  
Verbatim findings of counsel adopted, **8:22**

### ODYSSEY LOGISTICS & TECHNOLOGY CORP. V. STEWART

2025, **15:64**

### OFFER FOR SALE

Generally, **6:61; 8:69; 19:137; 20:46**  
Fine tuning, **19:130**  
Sec. 102(b) on-sale bar, **1:216; 13:212; 18:8**  
Sec. 271(a), **18:54; 20:46; 20:103**  
Sham affidavit doctrine, **17:12**

**OFFICERS**

Sec. 102(b), **13:35**

**OFFSHORE PATENTED PROCESS**

Generally, **11:54**

**OLD COMBINATION REJECTION**

Cross-appeal, **18:2**

**OLD COMPOSITION**

Discovery of inherent properties, **20:11**

**OLD PROCESS**

Durden, **9:98**

**OLD PRODUCT**

Generally, **8:57**

**OMISSIONS**

Attorney, **4:36**

Best mode, unintentional omission, **8:87**

Inequitable conduct, **7:46**

Materiality, **12:93**

Reissue application, **9:294**

Statutory construction, **12:37**

Walker Process antitrust, **4:84**

**180-DAY EXCLUSIVITY PERIOD**

Abbreviated new drug application (ANDA), **4:98**

**ONE MODE**

Enablement, **1:131**

**ONE OR MORE THAN ONE**

A, **5:44**

**ONE-TO-ONE CORRESPONDENCE**

Doctrine of equivalents, **5:39; 6:39**

**ONLY AS OF ISSUE DATE OF PATENT**

Enablement, **9:53**

**ONLY DISCLOSE WHAT AWARE OF**

Best mode, **7:47**

**ONLY GOD WORKS FROM NOTHING**

Generally, **9:86**

Sec. 282, **6:10**

**ON-SALE BAR**

Generally, **3:96; 8:127; 8:145; 8:152; 9:279; 10:53; 13:204; 16:44; 16:103; 20:145; 21:45**

Assignment of invention as sale, **13:87**

**ON-SALE BAR—Cont'd**

Bright lie rule, none, **3:83**

Burden of proof, **9:171; 12:98**

Claim not invalid under, **13:215**

Clear and convincing evidence, **2:23**

Clearly erroneous definition, **2:23**

Commercial offer for sale, **13:102; 19:113**

Commercial offer to sell, **5:72; 19:179**

Commercial sale, **13:122; 19:133**

Contracts, **26:8**

Enforceability, **13:42**

Exception, supplier, **19:140**

Expectation, **5:35**

Experimental use, **1:59; 1:177; 1:179; 2:178; 5:64; 5:137**

Factors, **13:84; 18:42**

Filing date, **1:97; 4:93; 20:102**

Incidental to experimentation, **1:113**

Inequitable conduct, **5:137; 12:30**

Inherency, **19:113**

Invention submission organizations, **8:62**

Joint development exception, **2:23**

Joint inventors, between, **2:85**

Law question, **2:31; 7:71; 12:60**

License agreement, **16:86**

Method performed by hand, **4:16**

Obviousness, **20:50; 20:72**

Offer to sell, **18:8**

Pfaff test, **2:71**

Policy considerations, **16:49; 19:107**

Process, sale of, **11:52**

Public policy, **1:71**

Public use, **2:178**

Ready for patenting, **1:179; 1:216; 8:145; 9:310; 14:35; 19:139**

Reduction to practice, **16:52**

Research agreement, **5:76**

Review, standard of, **1:119; 22:20**

Sale contract, **26:8**

Sec. 102(b), **1:52; 2:7; 3:41; 3:142; 5:15; 5:64; 6:25; 9:5; 9:7; 9:93; 9:118; 9:279; 10:1; 11:10; 11:25; 13:212; 16:32; 19:7; 19:31; 19:54; 21:1; 21:16; 23:6**

Sec. 285, **5:137**

Submissions, **8:62**

Substantially completed with reason to expect it will work, **5:35**

## INDEX

### ON-SALE BAR—Cont'd

- Sufficiently complete is improper test, **19:91**
- Summary judgment motion, **1:2**
- Supplier exception, **19:140**
- Totality of circumstances, **3:81**
- Trademark declaration cannot establish on-sale date, **16:25**
- Triggering bar, **1:216**
- True sale, **13:123**
- Two-part test, **8:71; 18:59; 23:47**

### OPERATIONAL DIFFERENCES

- Inducing infringement, **8:24**

### OPERATION OF INVENTOR'S BRAIN

- New prior art not considered by PTO, **5:11**

### OPINION

- Advisory opinion, **9:92; 20:2**
- Attorneys** (this index)
- CAFC, **17:2; 19:42**
- Dann Amendment, **19:30**
- Expert opinion. **Expert or Opinion Evidence** (this index)
- Sec. 112, **9:40**
- Summary judgment, **8:17**
- Witnesses, **1:30; 3:1**

### OPINION TESTIMONY

- Expert or Opinion Testimony** (this index)

### OPPORTUNITY

- Generally, **19:57**
- Collateral estoppel, **16:57**

### OPTIS CELLULAR TECHNOLOGY, LLC V. APPLE INC.

- 2025, **15:65**

### “OR”

- Claim interpretation, **2:86; 19:145**

### ORAL FINDINGS

- Sec. 291, **1:11**

### ORAL TESTIMONY

- Anticipation, **5:47**
- Conception, **16:70; 19:151**
- Contemporaneous documentary evidence, **3:49**
- Corroboration, **10:31**

### ORAL TESTIMONY—Cont'd

- Prior use, **3:2**
- Public use, **10:31**
- Review, standard of, **19:12**
- Validity, **23:48**

### ORANGE BOOK

- Generally, **10:54**
- Case or controversy, **20:78**
- Listing of patents, **1:135; 20:100**
- Patent information, **14:62**
- Tying, **16:121**

### ORDERS

- See also **Judgments** (this index)
- Final judgment rule, **19:110**
- FRCP 59, **19:50**
- GVR order, **6:39**
- ITC, **3:73**
- Sec. 1.640, **1:60**
- Transfer orders, **6:34**

### “ORDINARILY AWARDED”

- Prejudgment interest, **1:38; 13:72; 19:92**

### “ORDINARILY CONSTRUED”

- Method claims, **9:223**

### ORDINARY AND ACCUSTOMED MEANING

- Generally, **1:126; 2:101; 2:104; 3:51; 4:60; 8:74; 10:24; 11:61; 15:17; 19:157; 20:56; 20:64; 23:58**
- All limitations considered meaning, **12:33**
- Broadening ordinary meaning, **13:156**
- Heavy presumption claim, **20:63**
- Heavy presumption terms, **5:70; 18:67**
- Jury verdict, **19:5**
- Presumption of ordinary meaning, **11:48**
- Statutory construction, **8:61**
- Strong presumption, **4:73**
- Surrounding words, **12:95**
- Used differently by inventor, **3:91; 7:31**
- Written description, **18:46**

### ORDINARY DESIGNER STANDARD

- Design patent, **4:48**

### ORDINARY MEANING

- Ordinary and Accustomed Meaning** (this index)

**ORDINARY OBSERVER TEST**

Anticipation, **9:321**  
 Design patent infringement, **1:151; 1:165; 5:89; 6:88; 9:321; 18:96**  
 Point of novelty test, **3:100**

**ORDINARY SKILL IN THE ART**

Generally, **9:139**  
 Analogous art, **9:78**  
 Anticipation, **3:103**  
 Burden on patent challenger, **16:12**  
 Claim construction, **2:88; 5:110; 8:88; 8:112; 20:99**  
 Competency of Board, **9:65**  
 Conception, **19:124**  
 Factors, **9:168; 18:28**  
 Hypothetical inventor defined, **19:26**  
 Indefiniteness, **5:106**  
 Obviousness, **2:8; 12:32; 19:231**  
 Ordinary skill in the art, exercise of normal skill expected of person of, **9:436; 19:72**  
 Prior art, **9:65; 9:114**  
 Reliance upon, **9:141**  
 Sec. 102(g), **11:9**  
 Technical qualifications, **9:65**

**ORGANIZATION OF INFORMATION**

Computer memory, **9:153**

**ORIGINAL CLAIMS**

Part of patent disclosure, **14:8**  
 Prior art, **9:90**

**ORNAMENTALITY**

Design patent, **2:58; 8:62; 18:87**  
 Summary judgment, **1:35**

**OSSEO IMAGING, LLC V. PLANMECA USA INC.**

2024, **15:63**

**OVERALL SIMILARITY**

Design patent, **2:63**

**OVERBREADTH**

Adequacy of support, **21:10**  
 Dominating patent, **21:10**  
 Principle of invention, **21:10**  
 Reverse doctrine of equivalents, **21:10**  
 Sec. 101, **21:10**  
 Utility, **21:10**

**OVERLAPPING DATES**

Interference, **3:54**

**OVERRULING**

Generally, **21:24**  
 Determining law, not appropriate source for, **4:16**

**OVERSIGHT**

Sec. 455, **8:14**

**OVERTURN**

Appeal and review, **23:33**  
 Claim construction, **16:13**  
 Sec. 112, **19:7**

**OWNERSHIP**

See also **Title** (this index)  
 Assignment of claim, **12:84**  
 Bright-line test, **6:23**  
 Claim preamble, **19:210**  
 Employer and employee, between, **2:73**  
 Executive Order 10096, **8:10**  
 Foreign law, **1:172; 9:238**  
 Fraud in procurement, **13:150**  
 Inventorship, versus, **5:40; 9:303**  
 Joinder, **19:194**  
 Laches, **19:204**  
 Law question, **11:33**  
 Springs from invention, **20:40**  
 Standing, **1:172; 3:93; 9:303; 16:111**

**OWN MERITS**

Rule 147, **12:10**  
 Summary judgment, **5:48**

**PACKET INTELLIGENCE LLC V. NETSCOUT SYSTEMS, INC.**

2024, **16:193**

**PAGE LIMIT**

FRAP 28(g), **12:22**

**PALO ALTO NETWORKS, INC. V. CENTRIPETAL NETWORKS, LLC**

2024, **16:194**

**PANDUIT**

Generally, **6:26; 6:36; 18:35; 20:52**  
 Acceptable substitutes, **3:8; 4:90**  
 But for causation, not exclusive test for, **3:62**  
 Damages, lost profits damages award, guidelines for, **16:40**

## INDEX

### **PANDUIT—Cont'd**

- Factual findings to support jury verdict presumed, **2:15**
- Kicker, none, **13:72**
- Lost profits, **3:2; 11:28; 16:40; 19:56**
- Substitutes, acceptable, **3:8**
- Two-supplier market test, **13:121**

### **PAPESCH**

- Improper, **9:9**
- Obviousness, rebutting, **9:9**
- Rebutting obviousness, **9:9**
- Rejection, undue breadth, **9:9**
- Undue breadth rejection, **9:9**

### **PARALLEL**

- Embodiment, **1:132**

### **PARDON**

- False patent marking, **19:262**

### **PARENT APPLICATION**

- Estoppel, **23:30**
- Sec. 120, **8:19**

### **PARENT CASE**

- Filing of CIP, **23:30**
- Prosecution history, **13:100**

### **PARKERVISION, INC. V. QUALCOMM INCORPORATED** 2024, **16:195**

### **PARKERVISION, INC. V. VIDAL** 2023, **16:188**

### **PAROL EVIDENCE**

- Integration, **13:76**

### **PARTIAL JUDGMENT**

- Appealability, **7:16**

### **PARTIAL SETTLEMENT**

- Generally, **7:8**

### **PARTIAL SUMMARY JUDGMENT**

- Appealability, **3:9**
- Final judgment rule, **3:86**
- FRCP 56(d), **7:5**
- Object, failure to, **7:5**
- Preliminary injunction, **19:32**

### **PARTICULARITY**

- Incorporation by reference, **26:12**
- Interference, **7:48**
- Pleading, **9:329**

### **PARTICULARITY—Cont'd**

- Timely motion for new trial, **18:25**

### **PARTICULAR LANGUAGE**

- Statutory construction, **12:37**

### **PARTIES**

- Customer end user as parties at trial, no necessity to have—contributory vs.direct infringement, **18:11**

#### **Non-Parties** (this index)

- Prevailing party, **9:266**
- Real party in interest, inter partes review, **1:324; 23:97**
- Sec. 315(b), **1:324**
- Standing** (this index)

### **PARUS HOLDINGS, INC. V. GOOGLE LLC**

- 2023, **16:189**

### **PATENTABILITY**

- Generally, **3:172; 9:127; 9:129; 9:133**
- Abstract ideas, **1:95; 9:286**
- Claim interpretation, **11:49**
- Claims, **2:173**
- Design patent, **9:137; 11:25**
- Doctrine of equivalents, **8:60; 12:51**
- Inequitable conduct, **18:116**
- Interference, **9:230; 16:16; 18:44; 23:44**
- Inter partes review, **2:173**
- Jury, fact findings of, **19:9**
- Lexicographer, inventor as, **13:18**
- Man-made organisms, **1:228**
- Means-plus-function claim, **4:97**
- Measurement of physical property, **9:247**
- New unappreciated property of prior art, **5:56**
- New use known process, **2:82**
- Not dependent on how invention was made, **12:55**
- Obviousness, **2:173; 9:66; 9:107; 19:59**
- Physical property, measurement of, **9:247**
- Prima facie obviousness, **9:17**
- Printed matter, **9:32; 11:64; 13:232**
- Product-by-process claims, **9:81**
- Prosecution history estoppel, **9:199; 16:69**
- Reexamination, **9:183; 9:314**
- Sec. 1.1641, **9:141**

**PATENTABILITY—Cont'd**

Sec. 135(a), **9:116**  
Signal, **9:290**

**PATENTABLE**

Is obvious, **18:22**

**PATENT ACT OF 1952**

Generally, **9:136**  
Doctrine of equivalents, **23:42**

**PATENT AGENTS**

Writ of mandamus, compelling production, **9:429**

**PATENT AND TRADEMARK OFFICE (PTO)**

Generally, **1:3; 1:60; 9:1; 9:150; 10:5; 11:11; 12:31; 13:45; 18:19**  
Appeal and review, **9:2; 13:162; 16:134**  
Articulated reason for decision, **12:64**  
Assignee failing to record assignment, **1:60**  
Attorneys, **12:75**  
Authority limited by grant from Congress, **11:26**  
Claim construction, **9:199**  
Claim differentiation, **11:2**  
Clearly erroneous standard, **12:2**  
Construction and interpretation, **1:81; 9:337**  
Controlling unless plainly erroneous or inconsistent with regulation, **22:9**  
Deference, entitled to, **9:337; 11:27**  
Defined, relationship, **9:34**  
Delay in prosecution, **23:69**  
**Design Patent** (this index)  
Discipline, **2:121**  
Entitled to deference, **11:27**  
**Examiners** (this index)  
Excuse, **11:3**  
Fact findings, **9:80**  
Good faith belief, **1:43**  
Hearsay, **9:150**  
Identity of invention, **20:20**  
Inconsistency, **22:9**  
Inequitable conduct, **1:203; 7:19; 9:43; 10:2; 12:55; 12:85; 16:114; 19:118**  
Initial rejection, **7:19**  
Interference, **7:102**  
Inter partes review, **19:282**  
Issue preclusion, **20:41**

**PATENT AND TRADEMARK OFFICE (PTO)—Cont'd**

Judicial review of PTO decision under Administrative Procedure Act, **16:134**  
Jurisdiction, **19:46**  
Materiality, standard of, **9:43**  
Means-plus-function claim, **9:199**  
Motion to remand, **9:130**  
Objection to agency, **9:311**  
Obviousness, **9:52; 9:56**  
Own regulations, **12:75**  
Plainly erroneous, **22:9**  
Presumption of validity, **19:235**  
Prima facie obviousness, **9:140; 9:153**  
Prior art, noting differences from, **4:6**  
Regulation, **19:63**  
Reissue, **19:110**  
Relationship defined, **9:34**  
Res judicata, **2:60**  
Review, standard of, **3:50; 4:56; 4:69; 9:165; 9:196**  
Rule making, **12:37**  
Sec. 2(b)(2)(D), **2:121**  
Sec. 32, **23:15**  
Sec. 41(a)(7), **13:32**  
Sec. 102(b), **9:7**  
Sec. 103, **9:140**  
Sec. 282, **12:6**  
**Statutory Construction and Interpretation** (this index)  
Subject matter jurisdiction, lack of, **6:19**  
37 CFR Sec. 1.56, duty of candor and good faith to PTO, **1:203**  
Timing requirement, failure to observe, **9:187; 11:31**  
Treaties. **Patent Cooperation Treaty** (this index)  
Weight given thereto, **20:28**

**PATENT COOPERATION TREATY (PCT)**

Interference, **6:66**  
Jurisdiction, **2:116**  
Revival, **5:127**  
Time limits, **8:70**

**PATENT MARKING**

Generally, **1:352**  
Obviousness, **1:307**

## INDEX

### **PATENT MISUSE**

- Generally, **13:130; 21:51**
- Affirmative defense, **23:9**
- Anticompetitive effects, **16:126; 19:227**
- Claims, **23:9**
- Commercial embodiment, **23:9**
- Contributory infringement, **8:14**
- Dismissal for failure to state claim, **10:42**
- Industry standard, **16:126**
- Injunction against small infringer, **23:9**
- Intervening rights, **23:9**
- Lawsuit brought for improper purpose, **7:33**
- Licensing, **19:6**
- Scope of patent exceeded, **19:227**  
Sec. 2, **20:2**
- Trademark generic, **23:9**
- Tying, **16:121**
- Unenforceable until misuse purged, **2:61**

### **PATENT POLICY**

- Obviousness, **16:4**

### **PATENT POOLS**

- Tying, **16:121**

### **PATENT PROPERTY**

- Sec. 261, **10:4**

### **PATENT PROSECUTION**

- Bar, generally, **4:94**
- Fraud, **3:83**
- Inequitable conduct, **6:42**

### **PATENT RIGHT CLAUSE**

- Performance of government contract, **8:8**

### **PATENT TERM**

- Adjustment of Patent Term** (this index)
- Computation of extension, **13:144; 23:70**
- Deference to agency's interpretation, **8:25**
- Drug Price Competition Act (DPCA), **7:18**
- Drug Price Competition and Patent Term Restoration Act (DPCPTRA), **3:109; 13:77**
- Extension, **14:95; 19:339**
- Extension, generally, **6:3; 7:18; 13:77; 13:120; 16:149**

### **PATENT TERM—Cont'd**

- Hatch-Waxman amendment, **13:144**
- Obviousness, **14:95**
- Restoration, **16:84**
- Sec. 154(b), **23:69**
- Sec. 156, **6:3; 21:6**
- Sec. 156(a)(4), **8:25; 16:125**
- Sec. 156(e)(2), **19:197**
- Sec. 156(f), **16:125**
- Statutory construction rules, **8:25**

### **PATENT TERM RESTORATION ACT (PTRA)**

- Generally, **4:40; 7:55**
- Extensions, **13:77**

### **PATENT TRIAL AND APPEAL BOARD (PTAB)**

- Obviousness, **9:403**

### **PATENT TYING**

- Generally, **9:276; 21:51**
- Choice of law, **9:276**

### **PCT**

- Patent Cooperation Treaty (PCT)** (this index)

### **PENALTIES**

- Sanctions** (this index)

### **PEN AND PENCIL ANALOGY**

- Doctrine of equivalents, **18:29**

### **PENDENT JURISDICTION**

- Appeal of unquantified sanctions order, **15:39**
- Lack of, **19:9**

### **PENDING ACTS AND MATTERS**

- Generally, **5:2; 11:20; 16:19**
- Choice of law, co-pending actions, **12:67**
- Considerations involved, **19:49**
- Declaratory judgment, **23:9**
- Document retention policy, **13:168**
- Interference, **13:31**
- ITC, **19:25**
- Motion, **12:36; 19:45**
- 9 Cir, **22:2**
- Reexamination, **22:23**
- Sec. 2201, **13:41**
- Stay, **8:52**

**PENDING ACTS AND MATTERS**

—Cont'd

Suspension of proceedings on appeal,  
1:24

Willfulness, 3:51

**PER ARTICLE**

Sec. 292 penalty, 6:72

**PERFORMANCE**

Generally, 8:43

Administrative law, 13:70

Constructive reduction to practice, 8:8

Equitable estoppel, 8:8

Filing of application is constructive  
reduction to practice, 8:8

Four elements, 8:8

Intent, 8:8

Mathematical algorithm, 9:42

Means-plus-function claim, 12:3; 12:26

Patent right clause, 8:8

Probability, invention performs its  
intended function beyond prob-  
ability of failure, 8:8

Product-by-process claims, 9:81

Reduction to practice, 8:8

Sec. 102(g), 19:10

**PERMANENT IDEAS**

Conception, 13:72; 20:65

**PERMANENT INJUNCTION**

Generally, 10:54

Abuse of discretion, 1:219; 9:315;  
14:84

Anticipation, 1:219

Causation, 7:122

Drive demand, 7:122

Interlocutory decision, 12:41

Irreparable injury, 7:122; 18:93

Sec. 271(e)(1), 5:13

Sunset provision, 1:219

**PERMISSIBLE**

Facilitation, 20:54

Interference, 5:68

Statutory construction, 8:54; 12:34

**PER SE MATERIALITY RULE**

Inequitable conduct, 12:20

**PER SE OBVIOUSNESS REJECTION**

Obviousness, 9:173

**PER SE RULE**

Clearly erroneous standard, 19:23

**PERSONALIZED MEDIA**

**COMMUNICATIONS, LLC V.  
APPLE INC.**

2023, 16:190

**PERSONAL JURISDICTION**

Generally, 3:120; 3:181; 7:53; 7:107;  
12:57; 13:230; 14:81; 18:73;

20:82; 20:158; 21:91; 24:5

Additional activities beyond warning  
letter, 1:181; 3:131

Attorney-client relationship, 18:90

Cease and desist letters, 24:5

Choice of law, 1:70; 4:49; 8:69; 8:79;  
9:226; 18:45

Consent, 8:79; 13:114

Contractual consent or waiver, 13:114

Federal circuit law, 19:215

Foreign countries, 1:181; 1:186; 1:189;  
2:142; 8:79; 14:15

Foreseeability, 1:374

FRCP 4(k)(2), 13:234

Law question, 8:69

Malpractice claim based on filing patent  
application, 20:94

Minimum contacts, 1:70; 5:67; 6:150;  
20:94

Negation requirement, 19:215

Nonconsenting party outside forum  
state, 8:79; 16:124

Review, standard of, 6:50

Rule 4(k), 13:181; 19:212; 19:215

Specific jurisdiction, 20:46

Stream of commerce plus theory, 1:221

Stream of commerce theory, 1:181; 2:46

Use, 13:153

Venue, 8:69

Waiver, contractual consent or, 13:114

**PERSONAL LIABILITY**

Generally, 12:119

FRCP 15(c), 6:11

Inducing infringement, 19:92

Motion for directed verdict, 1:1

Sec. 102(b), 13:35

Sec. 112, 15:2

**PERSPECTIVE**

Doctrine of equivalents, 12:69

INDEX

**PERSUASION**

Burden of Persuasion and Quantum of Proof (this index)

**PERTINENCY OF WITHHELD INFORMATION**

Known or used by others, 3:2

**PETITIONS**

Mandamus, 2:2; 9:54

Motion to remand, 19:45

Panel hearing or rehearing en banc, 11:67

Special, petition to make generally, 7:57; 12:56  
claim interpretation, 7:57  
inequitable conduct, 7:29  
prosecution history estoppel, 7:57

**PFAFF TEST**

Generally, 22:20

On-sale bar, 2:71

**PFIZER INC. V. SANOFI PASTEUR INC.**

2024, 16:196

**PHANTOM COUNT**

Interference estoppel, 9:49

**PHILIP MORRIS PRODUCTS S.A. V. INTERNATIONAL TRADE COMMISSION**

2023, 16:191

**PHOSITA**

Obviousness, person having ordinary skill in the art, 9:436; 19:72

**PHRASE, MULTIPLE DEFINITIONS OF**

Claim construction, 7:28

**PHYSICAL EMBODIMENT**

Interference, 3:25

**PHYSICAL EVIDENCE**

Claim interpretation, 6:37

**PHYSICAL EXHIBIT**

Corroboration, 2:96

Drawing, 16:36

**PHYSICALLY COMBINABLE**

Claims construed, 9:77

Presumption of validity, 9:21

**PHYSICALLY COMBINABLE**

—Cont'd

Sec. 103, 15:4

**PHYSICALLY WORK TOGETHER**

Co-inventors, 20:68

**PHYSICAL PROPERTY**

Patentability, 9:247

**PHYSICAL SUBSTITUTION**

Reexamination, 9:87

**PICK AND CHOOSE**

Nonobviousness, 2:8

Prima facie case, 9:37

**PIERCING CORPORATE VEIL**

Generally, 8:53

Alter ego doctrine, 13:50

FRCP 25(a), 13:25

**PIONEER**

Generally, 1:115

Claim interpretation, 20:8

Combinations, virtually all inventions are, 13:1

Enablement, 16:80

Infringement, 20:6

Inspection of patentee's product, 16:15

Means-plus-function claim, 20:6

Sec. 102(e) v. sec. 102(g), 19:41

Sec. 120, 8:19

**PLAIN LANGUAGE**

Claim differentiation doctrine, 13:105

**PLAINLY ERRONEOUS**

Agency's interpretation of own regulations, 22:9

**PLAIN MEANING**

Claim construction or interpretation, 19:167; 21:9

Clear and unambiguous, where contract provisions are, 1:56

Means-plus-function claim, 2:31

Sec. 156, 6:3

Statutory construction and interpretation, 1:69; 3:50; 6:14; 9:138; 9:149; 10:19; 12:19; 13:48; 17:5; 20:26; 23:32

**PLANT PATENTS**

Newly found seedlings, 9:355

Public use, 4:107; 94:106

**PLANT PATENTS—Cont'd**

Sec. 161, **9:355**

**PLANTS**

Enablement, **9:259**

Sec. 271, **10:17**

Single claim, **9:162**

**PLANT VARIETY PROTECTION ACT  
(PVPA)**

Generally, **4:55; 13:114; 19:173**

Sec. 101, versus, **16:63**

Sexually reproduced variety, **9:162**

**PLATINUM OPTICS TECHNOLOGY  
INC. V. VIAVI SOLUTIONS INC.**

2024, **16:197**

**PLEADED, MUST BE**

Collateral estoppel, **4:3**

**PLEADING**

Form 18, **9:356; 19:237**

Infringement, **9:356**

**PLURALITY**

Can mean more than two, **4:61**

Mean more than two, can, **20:29**

At least two, **18:67**

**POINT OF NOVELTY**

Generally, **23:18**

Design patent, **2:106; 9:325**

Ordinary observer test, **3:100**

**POSSESSION**

Best mode, **5:55**

Description, **13:124**

Sec. 102(b), **9:18**

**POST- AND PRE-CRITICAL DATE  
CLAIMS**

Materiality, **1:220**

**POST-GRANT REVIEW**

Standing, **1:320**

**POST-JUDGMENT INTEREST**

Generally, **20:49**

Choice of law, **20:49**

Sec. 1961(a), **7:27**

Sovereign immunity, **1:55**

**POST-JUDGMENT MOTION**

FRCP 59(e), **2:46; 4:25**

**POST-JUDGMENT RELIEF**

FRCP 60(b) vs. FRCP 60(a), **16:37**

**POST-TRIAL INJUNCTION**

Jurisdiction, lack of, **19:9**

**POST-TRIAL MOTIONS**

Claim interpretation, **8:84**

Evidence, no requirement to prove  
validity, **18:3**

JNOV, **1:50**

Limitations, review limited, **18:3**

Review limited, **18:3**

Validity, no requirement to prove, **18:3**

**POST-TRIAL SETTLEMENT**

Mootness, **11:23**

**POST VERDICT MOTIONS**

Preserve ground, failure to, **5:22**

**POWER GRIDS**

Sec. 101, abstract ideas, **5:128**

**PRACTICAL UTILITY**

Generally, **6:33**

Sec. 101, **9:143**

**PRACTICE**

Enablement, **9:177**

Reduction. **Reduction to Practice** (this  
index)

Sec. 287, **4:12**

**PREAMBLE**

**Claim Preamble** (this index)

**PRECEDENTS**

**Stare Decisis** (this index)

**PRECISE PROPORTIONS**

Drawings, **8:74**

**PRECISION**

Description, **6:33**

Primary reference, **8:62**

**PRE-CLINICAL RESEARCH**

Sec. 271(e)(1), **9:251**

**PRECLUSION**

See also **Claim Preclusion** (this index)

Infringement, **16:35**

**Issue Preclusion** (this index)

Motion in limine, **7:26**

Res judicata, **6:14**

## INDEX

### **PREDICTABILITY**

- Obviousness, **13:18**
- Obviousness-type double patenting, **9:52**

### **PREEMPTION OF LAWS**

- Generally, **8:66; 12:123; 21:49**
- Biologics Price Competition and Innovation Act of 2009, **1:303**
- CAFC, **21:42**
- Competition, **26:7**
- Conflict preemption, **11:50**
- Disclosure, **21:30**
- Federal patent code and UCC, **3:68**
- Federal unfair competition claims, **26:7**
- Fraudulent non-disclosure state inventorship law, **21:30**
- State law, **21:30; 21:42**
- State law tort liability, **7:81**
- Tort liability, state law tort liability, **7:81**
- UCC, federal patent code and, **3:68**

### **PREFERENCE**

- Claim interpretation, **1:116; 5:31; 6:56; 7:57; 7:77; 16:54; 22:12; 23:49**
- Claims, scope of, **1:79**
- Comparing claims with accused device, **13:9**
- Summary judgment, **10:4**

### **PREJUDGMENT INTEREST**

- Generally, **5:54; 11:21; 19:38; 19:324; 20:49**
- Abuse of discretion, **3:96; 8:20**
- Award against government requires either contract or Act of Congress, **19:83**
- Compensatory purpose, **15:10; 23:73**
- Compound vs. simple interest, **18:35**
- Congress, **19:83**
- Damages, **2:15; 7:15; 16:5; 18:2**
- Delay in bringing suit, **21:20**
- Enhanced damages, **21:3**
- FRCP 59(e) motion to alter or amend judgment, **10:14**
- Government, **19:83**
- Ordinarily awarded, **1:38; 13:72; 19:92**
- Presumption of validity, **12:9**
- Prevailing party, **19:259**
- Purpose, **2:30**
- Rate, **21:18**

### **PREJUDGMENT INTEREST—Cont'd**

- Reviewed only for abuse of discretion, **8:20**
- Sec. 284, **4:7**
- Simple interest, **18:35**
- Time, withheld, when, **12:20**
- Withheld, when, **12:20**
- Witnesses, **14:5**

### **PREJUDICE**

- Generally, **1:54; 10:15; 18:39**
- Change in economic position, **7:30**
- Choice of law, **8:82**
- Complaint dismissed for mootness in view of settlement of controversy, **19:14**
- Damages to proper focus, **8:50**
- Economic position, change in, **7:30**
- Economic prejudice, **1:67**
- Equitable estoppel, **19:252**
- Final decision, **8:82**
- Laches or delay, **19:252**
- Nexus required, **8:32**
- Reliance on delay not required, **13:44**

### **PREJUDICIAL ERROR**

- Jury instructions, **2:31**
- Narrow claim construction, **14:2**
- Obviousness, **18:15**

### **PRELIMINARY AMENDMENT**

- Four-factor test, **1:110**

### **PRELIMINARY INJUNCTIONS**

- As to injunctions, generally. **Injunctions** (this index)
- Generally, **1:366; 2:199; 5:8; 7:85; 11:89; 12:123; 13:226; 13:245; 14:41; 19:183; 20:124; 20:128; 20:140; 20:155**
- Abuse of discretion, **1:155; 1:169; 13:89**
- ANDA filing, **1:202**
- Appealability, **11:19**
- Appeal and review, **2:16; 3:12; 7:81; 8:2**
- Attorney, proposed by, **12:16**
- Balance of hardships, **1:169**
- Biosimilar products, **1:291**
- Burden of proof, **3:76; 5:92; 14:20; 19:235**
- Causal nexus requirement, **1:225**
- Choice of law, **13:89; 16:33**

**PRELIMINARY INJUNCTIONS****—Cont'd**

Claim construction and interpretation, **1:241; 3:135**  
 Concurrent litigation, stay of concurrent litigation, **11:19**  
 Confidential business information is property, **6:7**  
 Counsel, proposed by, **12:16**  
 Delay, **20:12**  
 Denial, **4:5; 10:41; 14:10; 18:75; 20:12**  
 Design patent, **1:226; 3:34; 20:93**  
 Discretion of court, **1:220; 2:60; 6:21; 8:81; 12:29; 23:20**  
 District court's discretion, **1:220; 8:81**  
 Doctrine of equivalents, **13:229**  
 Drastic remedy, **9:95**  
 Employee mobility, **12:16**  
 Equal, not equal to same thing, **4:5**  
 Equal, things equal to each other, **4:5**  
 Escrow, **3:21**  
 Evidence, **8:2**  
 Exclusionary rights, **12:111**  
 Exhaustion of patent rights, **12:102**  
 Factors, **6:15**  
 Final judgment, **9:304**  
 Findings, **12:16**  
 Foreign patent in foreign court, **19:32**  
 Four-factor test, **1:133; 3:34; 7:69; 8:2; 9:145; 10:26; 10:29; 13:88; 13:107; 13:114; 14:9; 15:20; 16:70; 18:26; 18:32; 18:65; 19:94**  
 FRCP 52(a), **3:12; 15:5; 16:26**  
 Functionality, **2:16; 3:34**  
 Infringement suit presumed in good faith, **1:40**  
 Initial consideration of evidence, **8:2**  
 Interlocutory decision, **12:41**  
 Interlocutory order, **11:19**  
 Irreparable harm, **1:169; 1:225; 3:34; 19:14; 20:12**  
 Irreparable injury, **18:21**  
 Issuance, standard for, **11:67**  
 Jurisdiction, **3:12**  
 Lawsuits, against filing, **1:40**  
 Likelihood of success on merits, **1:169; 1:183; 11:67**  
 Money damages, **1:34**  
 Notice and knowledge, **3:12**  
 Partial summary judgment, denial of, **19:32**

**PRELIMINARY INJUNCTIONS****—Cont'd**

Preserve status quo, **1:34**  
 Presumption, **3:34; 20:12**  
 Priority filing date, **1:199; 5:88**  
 Procedural issue, **8:21**  
 Property, confidential business information is, **6:7**  
 Reissue, **1:259**  
 Restraining against use of stolen trade secrets, **6:7**  
 Review, standard of, **7:70; 8:46; 13:89; 20:61**  
 Review on appeal, standard of, **2:62; 7:50; 8:71; 12:16; 16:46; 20:53; 22:16**  
 RICO, **6:7**  
 Same thing, not equal to, **4:5**  
 Sec. 1292(a)(1), **23:13**  
 Serious question, **1:40**  
 Stay of concurrent litigation, **11:19**  
 Stolen trade secrets, **6:7**  
 Summary judgment, **19:32**  
 Threshold issue, **12:16**  
 Trademark, **2:16**  
 Trade secrets, restraining against use of stolen secrets, **6:7**  
 Validity, **1:169; 18:21; 20:12**

**PRELIMINARY MOTIONS**

Generally, **7:26**

**PRELIMINARY STATEMENT**

Interference, **3:54**  
 Purpose thereof, **7:26**

**PREPONDERANCE OF EVIDENCE**

Defined, **4:33**  
 Reexamination, **5:9**

**PRESUMPTIONS**

See also **Burden of Proof** (this index)  
 Attorney disqualification, **16:3**  
 Claim construction and interpretation, **1:161; 4:73; 4:74; 5:70; 9:94; 11:48; 18:67; 20:63**  
 Claim differentiation doctrine, **1:162; 3:80; 19:171**  
 Co-inventors, naming properly, **7:79**  
 Commercial success, **23:52**  
 Common law, **9:154**  
 Design patent, **19:8**  
 Different scope, **3:80; 11:48**

## INDEX

### **PRESUMPTIONS—Cont'd**

Doctrine of equivalents, **8:60; 21:11**  
Evidence, **18:26**  
Inequitable conduct, **13:19**  
Inventor's admission of invention by another, **1:8**  
Inventorship, **6:35**  
Irreparable harm, **1:110; 18:26; 18:32; 19:94; 20:12**  
Judge and jury roles, **10:15**  
Means-plus-function claims, **1:134; 3:91; 5:51; 13:96; 18:107; 19:97; 23:51**  
No presumption re uncited art, **12:13**  
Notice and knowledge, **9:114**  
Obviousness, **16:4**  
Ordinary meaning, **11:48**  
Preliminary injunction, **3:34; 20:12**  
Prosecution history estoppel, **2:66; 5:115; 6:39; 12:53; 19:146; 23:42**  
Public officer perform their duties correctly, **1:55**  
Regularity, **1:55**  
Sec. 102(b), **9:7**  
Sec. 282, **6:10; 8:23**  
Special verdict, **20:50**  
Summary judgment, **10:4**  
Validity  
generally, **1:80; 3:41; 8:119; 19:37; 19:129; 19:189**  
admission as prior art, **18:10**  
anticipation, **19:37**  
Blonder-Tongue, **1:13**  
combining references, criterion for, **9:21**  
criterion for combining references, **9:21**  
delay, **12:9**  
destroyed, **13:81**  
equivalence, **5:7**  
evidence to be weighed, **14:10**  
irreparable harm, **14:9**  
ITC, **19:25**  
JNOV, **22:2**  
jury, **1:16**  
laches, **12:9**  
mere procedural device, **13:53**  
more pertinent art, effect of, **12:9**  
new prior art, effect of, **18:10**  
obsolescence need not necessarily defeat reference, **9:21**

### **PRESUMPTIONS—Cont'd**

Validity—Cont'd  
obviousness, **1:4; 1:30; 13:99**  
physically combined, not whether they can be, **9:21**  
prejudgment interest, **12:9**  
prior art, **18:10**  
process performable by person, **1:12**  
publication, **18:10**  
reference, **9:21**  
Sec. 102(e), **1:22**  
Sec. 282, **9:21; 9:57; 9:80; 12:6; 13:87; 16:4; 18:6**  
substantive law, **19:36**  
summary judgment, **3:13**  
verbatim findings of counsel adopted, **8:22**  
weakened or destroyed, never, **13:81**  
Warner-Jenkinson, **9:209**  
Well-established common law principles not changed, **9:154**

### **PRETRIAL ORDER**

Choice of law, **19:149**  
FRCP 16, **19:14**

### **PRETRIAL PROCEEDINGS**

Judicial Panel on Multi-District Litigation (JPMDL), **7:6**

### **PRETRIAL STIPULATION**

Effect thereof, **11:28**

### **PREVAILING PARTY**

Generally, **9:266; 15:60**  
Costs, **2:179**  
JMOL, **3:161**  
Number of prevailing parties, **19:219**  
Obviousness, **19:259**  
Voluntary dismissal, **18:76**  
Willful infringement, **19:259**

### **“PREVIOUSLY DONE, SOMETHING NOT”**

Sec. 145, **7:9**

### **PRICE**

Selling lower priced product does not justify infringement, **16:33**

### **PRICE EROSION**

Damages, **22:26**  
Lost profits, **2:34**

**PRIMA FACIE CASE**

See also **Prima Facie Obviousness** (this index)  
 Appeal and review, **9:37**  
 Experimental use, **1:71**  
 Explained, **9:104**  
 FRE 705, **19:59**  
 Interference, **7:13**  
 Lack of written description rejection, **8:101**  
 New ground of rejection, **9:37; 9:127**  
 Obviousness. **Prima Facie Obviousness** (this index)  
 Pick and choose, cannot, **9:37**  
 Prior art teachings, among, **9:37**  
 Rebuttal, **9:150**  
 Rejection, **9:37; 9:127**  
 Sec. 112, **16:10**

**PRIMA FACIE OBVIOUSNESS**

Generally, **9:37; 9:50; 9:167; 9:174; 9:197; 9:207; 9:245**  
 As a whole, **9:86**  
 Broadest possible construction, **2:25**  
 Chemical composition, **9:98**  
 Claims not argued separately, **9:98**  
 Combining references, **9:123**  
 Composition, **9:17**  
 De novo review, **2:133**  
 DNA, **9:133**  
 Establish, burden to, **9:140**  
 Evidence, **9:99; 9:152**  
 Expectation, unexpected results, **9:86**  
 Experts, disbelief by, **2:25**  
 Factors in determining patentability of claims to new composition and its method of use, **9:17**  
 Few machines have no utility, **9:17**  
 Inventor, problem facing, **9:17**  
 Law of the case, **20:114**  
 Machines, **9:17**  
 New composition, **9:17**  
 Objective factors, **9:86**  
 Patentability, **9:17**  
 PTO's burden, **9:140; 9:153; 9:387**  
 Rebuttal, **2:25; 9:99; 9:119; 9:152**  
 References, combining, **9:123**  
 Sec. 103, **9:115**  
 Structural obviousness, **9:50**  
 Structural similarity, **1:183; 9:126**  
 Unexpected results, **9:86**

**PRIMA FACIE OBVIOUSNESS**

—Cont'd

Utility, few machines have no, **9:17**

**PRIMA FACIE SHOWING**

New interference rules, **8:3**

**PRIMARILY FACTUAL**

Description, **21:33**

**PRIMARILY FUNCTIONAL**

Design patent, **16:21**

Validity, **12:8**

**PRIMARY REFERENCE**

Absence of precision in verdict, **8:62**

**PRINCIPAL CONSIDERATIONS**

Enhanced damages award, **19:101**

**PRINTED MATTER**

Generally, **9:402**

As a whole, **9:32**

Claim to be read as a whole, **9:32**

Mathematical algorithm, **9:32**

Need for substrate relationship, **9:153**

Obviousness, **9:32; 16:169**

Patentability, **9:32; 11:64; 13:232**

Sec. 101, also extends to, **9:32; 11:64**

**PRINTED PUBLICATION**

Generally, **7:125; 10:48; 13:246**

Anticipation, **9:322; 9:327; 14:94**

“Arranged as in the claim,” **14:56**

Burden of proof, **13:72**

Claim construction, **1:313**

Claim preamble, **1:313**

Corroboration, **14:94**

Dismissal, **3:19**

Inequitable conduct, **15:34**

Legal conclusion, **3:101**

Publicly accessible, **9:261; 9:386; 19:266**

Sec. 102(b), **9:14; 9:18; 9:33; 11:60; 12:89; 14:8; 16:25**

Technical paper, **13:11**

**PRINTER MATTER REJECTION**

Generally, **9:262**

**PRIOR ACTIONS**

Generally, **13:53**

Issue preclusion, **9:151**

Obviousness, **7:17**

## INDEX

### **PRIOR ADJUDICATION**

Collateral estoppel, **9:90**

### **PRIOR APPLICATION**

Continuation application, **19:105**

### **PRIOR ART**

Generally, **3:39; 4:6; 7:29; 9:48; 9:96; 9:103; 9:110; 9:114; 13:18; 13:28; 13:45; 16:97; 17:2; 19:34; 22:66**

Admission of own work, **18:70**

Analogous art, **1:329**

**Anticipation** (this index)

Burden less easily carried, **4:6**

Burden of proof more easily carried, **5:11**

Chemical, **9:60**

Claim interpretation, **1:103; 8:57; 13:63; 19:15**

Claim preamble, **9:79**

Collateral estoppel, **8:73; 13:105**

Combining references, **9:126; 9:127; 16:109**

Combining teachings, **9:74**

Commercialization, lack of, **4:6**

Cumulative references, **12:61**

Disclaimer, **19:216**

Disclose potential priority conflicts, **7:68**

Dismissal, **3:19**

Doctrine of equivalents, **7:40; 9:118; 12:78; 13:93; 20:61**

Double patenting, **9:45**

Embellishment, **4:6**

Enablement, **9:305; 19:59; 19:207**

Enhanced damages, **21:3**

Enhancement, **4:6**

Foreign country, patented in, **9:120**

**Highly Relevant Prior Art** (this index)

Improper, **1:10**

Inducing infringement, **8:24**

Inequitable conduct, **7:1; 8:29; 8:62; 12:30; 19:128**

Information disclosure statement, **1:122; 18:86**

Infringement, **5:60; 7:10; 19:19**

Intrinsic, cited art as, **22:31**

Inventor's admission of invention by another, **1:8**

Jepson format, **13:15**

Jury verdict, **3:17**

Later reference, discredited by, **9:117**

### **PRIOR ART—Cont'd**

Limitations added to overcome prior art, **11:22**

Litigated, claims not, **4:6**

Means-plus-function claims, **6:75**

Modification, **9:51**

New prior art not considered by PTO, **5:11**

New use for an old structure, **9:48**

Not pertinent art before PTO, **4:6**

**Obviousness** (this index)

Ordinary skill, hypothetical person of ordinary skill, **9:65**

Original versus reissue claims, **9:90**

Own work, admission of own work, **18:70**

Patentable subject matter, **5:56**

Presumption of validity, **18:10**

Prima facie case, **9:37**

Priority, disclose potential priority conflicts, **7:68**

Product-by-process claim, **9:58**

Prosecution history estoppel, **6:39; 20:29; 23:42**

PTO, generally, **4:6**

Public accessibility, **19:207; 22:42**

Reexamination, **9:194; 9:200**

**Reference** (this index)

Reissue, **9:90**

Relevancy of foreign patent prosecution, **13:69**

Scientific formula, **9:48**

Sec. 102, **19:257**

Sec. 102(b), **4:84; 9:46; 9:150**

Sec. 102(g), **5:2**

Sec. 112(6), **1:91; 9:118; 11:28**

Sec. 282, **6:10**

Secondary considerations, **4:10**

**Secret Prior Art** (this index)

Structure, new use for an old structure, **9:48**

Suggestion or motivation to modify, must be, **9:101**

Summary judgment, **3:1; 3:20; 6:1; 21:7**

Teaching or suggestion must appear in reference, **9:140**

Technical paper, **13:11**

Uncited, **3:90**

Validity, **3:77; 4:6**

Weight, must be given, **13:53**

**PRIOR DECISION**

Res judicata, **13:22**

**PRIOR DISMISSAL**

ITC, **25:2**

**PRIOR EXPERIENCE**

Attorneys' fees, award by special master, **19:65**

**PRIOR FILING**

**Earlier Filing Date** (this index)

**PRIOR INTERFERENCE**

Subsequent litigation, effect of prior interference on, **2:36**

**PRIOR INVENTION**

Sec. 102(g), **9:158**  
Third party, **12:55**

**PRIOR INVENTOR**

Sec. 102(g)(2), **4:65**

**PRIORITY**

Generally, **18:1; 19:152**  
Anticipation, **5:142; 25:12**  
Claim, **25:12**  
Claim construction, **5:142**  
Description, written description required, **19:120**  
Enablement and enablement requirement, **19:304**  
Estoppel, **23:30**  
Foreign application filed earlier, **2:125**  
Inherent disclosure, **25:12**  
Interference, **2:107; 3:6; 3:82; 6:20; 6:66; 7:13; 7:100; 8:30; 8:78; 9:88; 11:65; 13:31; 15:1; 16:16; 18:49; 19:90; 19:240; 23:14**  
Law questions, **3:53; 16:36**  
Prior art, **7:68**  
Reduction to practice, **8:108**  
Reexamination, **9:340; 19:110**  
Reissue, **9:294**  
Sec. 111, **19:32**  
Sec. 119, **9:143**  
Sec. 119(a), **2:125**  
Sec. 120, **20:88**  
Sec. 135(a), **9:116**  
Stay order, **11:1**  
Written description required, **19:120**

**PRIORITY FILING DATE**

Generally, **1:376; 9:258**  
On-sale bar, **20:102**  
Preliminary injunction, **1:199; 5:88**  
Sec. 120, **2:142**  
Written description, **4:117**

**PRIOR JUDGMENT**

Damages, **20:23**

**PRIOR MUST BE ENABLING**

Inconsistent jury findings, **2:10**

**PRIOR NOTICE**

FRAP 4(a)(4), **10:14**

**PRIOR POSSESSION**

Interference, **4:11**

**PRIOR RULING**

Generally, **5:9; 19:57**  
Factual differences must be material to prevent operation of collateral estoppel doctrine, **1:63**

**PRIOR TO MARKETING**

Opinion of counsel, **3:72**

**PRIOR USE**

Generally, **3:2**

**PRIVATE FIRM**

Attorney fees award, **16:24**

**PRIVATE PARTY**

Antitrust, **5:30**

**PRIVILEGE**

Generally, **11:56**  
Appellate review, appropriate for, **9:184**  
**Attorney-Client Privilege** (this index)  
Local rule compliance, **4:47**  
Mandamus writ, **9:184**  
Settlement negotiation privilege, **9:362**

**PRIVITY**

Assignor estoppel, **9:118; 13:88; 19:47**  
Attorneys fees, **11:14**  
Bound by related party's acts, **5:4**  
Inherent property, **11:14**  
Inter partes review, **23:86; 23:94**  
Obviousness, **11:14**  
Related party, **5:4; 11:14**  
Res judicata, **9:224**  
Time-bar, **16:176**  
Willful infringement, **11:14**

## INDEX

### PROBABILITY

Performance of government contract,  
**8:8**

### PROCEDURAL ERRORS

Harmful error must be shown, **4:37**

### PROCEDURAL ISSUE

Choice of law, **8:21; 19:42; 20:4**

Inconsistent positions, **8:21**

Irreparable harm, **8:21**

Law question, **8:21**

Preliminary injunction, **8:21**

Sec. 112, **8:21**

### PROCEDURAL LAPSE

Interference, **5:57**

### PROCEDURAL PRESUMPTION

Sec. 282, **6:10**

### PROCEDURAL RULE

CIT, **5:18**

### PROCESS

Abstract mental process, Sec. 101  
patentability. **Abstract** (this index)

Chemical process, **9:20**

Claim construction, **21:61**

Costs on appeal, **1:20**

Damages, **19:154**

Definition, **9:20; 18:85**

Equivalence, **3:87**

Inequitable conduct, **10:2**

Infringement, **4:51**

International Trade Commission, **1:184**

Obviousness question, **16:19**

On-sale bar, **11:52**

Performable by person

generally, **1:12**

abstract mental process, Sec. 101  
patentability. **Abstract** (this  
index)

circumstantial evidence, **1:12**

infringement, **1:12**

inquiry essential into secondary  
considerations, **1:12**

obviousness, most probative on, **1:12**

presumption of validity, effect on,  
**1:12**

uncited prior art, **1:12**

Product-by-process claim, **1:52**

Sec. 101, **3:164; 6:71; 9:308**

### PROCESS—Cont'd

Sec. 102(g), **19:10**

Sec. 271, **10:17**

Sec. 271(a), **18:79**

Sec. 271(g), **2:97**

Sec. 287, **8:4**

Sec. 287(a), **3:96**

Subject matter jurisdiction, process  
claim, generally, **3:164**

### PROCESS PATENT AMENDMENT

#### ACT (PPAA)

Import, sell, or use, **14:20**

Materially changed, **2:60; 5:23**

### PROCUREMENT

Inequitable conduct, **13:19**

### PRODUCT-BY-PROCESS

Generally, **9:466; 11:87; 19:51; 19:186;**  
**19:187**

Claim limitations, **1:52**

How product is made not how it is used,  
**13:54**

Identical, performances of compounds,  
**9:81**

Patentability determined by product  
itself, **9:81**

Performances of compounds identical,  
**9:81**

Prior art product identical, **9:58**

Sec. 295, **14:31**

Structures not necessarily identical, **9:81**

### PRODUCTION DOCUMENTS

Generally, **3:14**

### PRODUCTION SPECIFICATIONS

Interference, **4:8**

### PROFESSIONAL CONDUCT

Settlement agreement, **19:40**

### PROFITS

Design patent, **3:98**

**Lost Profits** (this index)

Sec. 289 election, **2:33**

### PRO HAC VICE

Sanctions, **2:55**

### PROMPTU SYSTEMS

#### CORPORATION V. COMCAST

#### CORPORATION

2024, **16:198**

**PROPER CLAIM CONSTRUCTION  
FIRST**

Anticipation, **20:67**

**PROPER NOTICE**

Conversion of FRCP 12(b) motion into a  
FRCP 56 motion for summary  
judgment, **2:41**

**PROPER STANDARD**

Jury verdict, **3:75**

**PROPERTY**

Constitutionality, **16:8**  
Each patent establishes independent  
right, **11:35**  
Independent, each patent establishes  
independent right, **11:35**  
Preliminary injunction, **6:7**

**PRO SE APPEARANCE**

Generally, **6:16**

**PROSECUTION ESTOPPEL**

Earlier patent, **12:3**

**PROSECUTION HISTORY**

Generally, **1:107; 13:28; 13:111;  
19:146; 19:171; 21:91**  
Additional components, **12:18**  
Ambiguous, improper, **9:246**  
Amendments, **5:44**  
Arguments made therein, **3:75; 16:66;  
19:111**  
Arguments same weight as claim  
amendments, **5:44**  
Claim construction, **1:298; 14:57**  
Claim differentiation, **1:162**  
Claim interpretation, **1:77; 2:77; 11:12;  
12:31; 19:84; 23:51**  
Continuation, parent case in construing,  
**13:100**  
Disavowal of particular aspect of claim  
meaning, **8:74; 16:151**  
Disclaimer, **2:155; 5:94; 13:209;  
19:169; 19:193; 22:35**  
Doctrine of equivalents, **9:108**  
Error in record, **22:23**  
Estoppel. **Prosecution History Estop-  
pel** (this index)  
Failure to satisfy burden of proving,  
**20:135**  
Foreign prosecution, claim construction,  
**1:209**

**PROSECUTION HISTORY—Cont'd**

Hatch-Waxman Act, **9:438**  
Infringement, **13:126**  
Limitations not present in issued claims,  
**21:9**  
Meaning, disavowal of particular aspect  
of claim meaning, **8:74; 21:70**  
Means-plus-function, **4:51**  
Other patents, relevance of, **13:128**  
Parent case, **13:100**  
Prior art, unpatentable in view of,  
**19:281**  
Reissued patent, **6:37**  
Relevance of other patents, **13:128**  
Sec. 102(g) prior work, **5:2**  
Sec. 1498, **12:11**  
Subject matter relinquished or  
disclaimed, **1:116**  
Wilson hypothetical claim, **19:84**

**PROSECUTION HISTORY  
ESTOPPEL**

Generally, **1:131; 1:135; 1:142; 2:84;  
2:109; 3:99; 4:51; 5:115; 5:144;  
7:80; 7:107; 16:56; 19:84; 19:94**  
Amendment, **2:9; 2:66; 2:128; 3:130;  
4:73; 6:48; 7:69; 8:13; 8:47;  
18:40; 19:146; 20:29**  
Any claim amendment, **6:48**  
Appeal and review, **2:9**  
Argument based estoppel vs. amend-  
ment based estoppel, **4:73**  
Cancellation of broader claim, **5:36**  
Claim construction and interpretation,  
**15:30; 20:118; 26:1**  
Claims statement made regarding, not  
limited to, **1:84**  
Clarity, **6:39; 19:153**  
Clear, presumption to overcome prior art  
if unclear, **23:42**  
Close examination of reason for amend-  
ment, **8:13**  
Commonly owned patents, **1:115**  
Competition, **8:38; 23:41**  
Consisting of claim language, **13:7**  
Defining claim terms, distinguished  
from, **19:84**  
Definition, **19:84**  
Dependent claims, **8:105**  
Design patents, **16:139**  
Disclaimer with clarity, **19:153**

## INDEX

### PROSECUTION HISTORY

#### ESTOPPEL—Cont'd

Distinguished from prosecution history defining claim terms, **19:84**

Doctrine of equivalents, **1:164; 6:48; 6:64; 9:186; 9:377; 12:1; 12:62; 15:29; 16:27; 16:174; 20:69; 20:89; 21:77; 22:37**

Estoppel context, **9:186**

Examination, **8:13; 8:47; 18:40**

Examiner's reliance unnecessary, **12:49**

Explanation, prosecution only where no explanation, **9:209**

File wrapper estoppel, **4:26**

Foreseeability, **4:96**

Indefiniteness, **1:21**

Infringement determination, **22:8**

Jury case, **6:26**

Law question, **13:63; 23:25**

Limitations, **19:115**

Literal claim scope, **2:77; 13:95; 23:54**

Means-plus-function, **3:84**

Narrowing amendment, **2:128; 6:70; 7:69; 18:77**

Objective standard, **1:96; 2:74; 13:80; 16:57**

Obviousness, **19:275**

Patentability, **9:199; 16:69**

Petition to make special, **7:57**

Policy-oriented limitations, **19:115**

Presumption, **2:66; 5:115; 6:39; 12:53; 19:146; 23:42**

Prior art, **6:39; 20:29; 23:42**

Purpose, **3:86; 8:47**

Reasonable competition, **8:38; 23:41**

Reasons for allowance, **19:168**

Rebuttable presumption, **12:53**

Recapture, **16:40**

Reexamination, **9:237**

Relevance, **2:31; 23:54**

Replacing claims, **13:105**

Scope of claim limitations, **18:101**

Sec. 102(e) v. sec. 102(g), **19:41**

Sec. 120, **8:19**

Similar limitation, applies to all claims with, **5:59**

Source, **3:84**

Special, petition to make special, **7:57**

Specification, effect of advantages in, **22:16**

Statutory requirements, related to, **12:59**

### PROSECUTION HISTORY

#### ESTOPPEL—Cont'd

Subject matter, prevents recapture of, **8:72**

Substantial reason for related to patentability, **6:41**

Summary judgment, **20:13**

Summary judgment of non-infringement, **8:40**

Surrender, **16:40**

Tangentially rebuttable, **3:130; 9:326; 18:77**

Vague assertions of patentability, **9:199**

Viewed from standpoint of reasonable competitor, **8:38; 23:41**

Voluntary, **16:79**

Wilson hypothetical claim, **7:28**

### PROSECUTION IRREGULARITIES

Generally, **13:81**

Inequitable conduct, **13:81**

### PROSECUTION LACHES DOCTRINE

Generally, **19:181**

Laches or Delay (this index)

### PROSECUTION RATE

Double patenting, **6:69**

### PRO SE LAWYER

FRCP 37, **16:71**

### PRO SE LITIGANT

Failure to state claim, **13:142**

Frivolous appeal, **2:38**

### PROTECTIVE ORDER

Confidential information, **13:40**

unsealing, appeal and review, **1:239**

Discovery of confidential information, **13:40**

Patent prosecution bar, **4:94**

### PROTESTED REISSUE

Affidavit, **9:23**

### PROVISIONAL APPLICATION

Inventorship, **5:88**

Written description as related to nonprovisional, **14:36**

### PROVISIONAL REJECTION

Sec. 102(e), **9:110**

**PROVISUR TECHNOLOGIES, INC. V. WEBER, INC.**

2024, **16:199**

**PS PRODUCTS INC. V. PANTHER TRADING CO. INC.**

2024, **16:199**

**PTO**

**Patent and Trademark Office (PTO)**  
(this index)

**PUBLIC ACCESSIBILITY**

Indexing, **22:42**  
**Printed Publication** (this index)  
Sec 102(b) printed publication, **11:60**  
Sec 112 written description, **3:144**  
Standing, **19:316**

**PUBLICATION**

Claim interpretation, **20:8**  
Motion to publish CAFC decision, **9:1**  
MPEP, **16:6**  
Pre-issuance damages with no actual notice of patent, **18:113**  
Presumption of validity, **18:10**  
**Printed Publication** (this index)

**PUBLIC CONCERN**

Constitutionality, **16:8**  
Validity of patent is matter of, **6:22**

**PUBLIC DISCLOSURE**

Interference, **3:25**

**PUBLIC INTEREST**

Generally, **3:229**  
Forum non conveniens, **13:58**  
Preliminary injunction, **1:169**  
Sec. 282, **12:5**  
Vacation of judgment, **15:36**

**PUBLICLY ACCESSIBLE**

Generally, **9:261; 20:150**  
Indexing, **22:42**

**PUBLIC OFFICER**

Presumption of regularity, **1:55**

**PUBLIC POLICY**

Assignor estoppel bars validity challenge, **4:13**  
Interference, **7:13**  
On-sale, **1:71**  
Public use bars, **12:45**

**PUBLIC POLICY—Cont'd**

Reexamination, **2:64; 9:200**

**PUBLIC SERVICE**

Attorney fees, **10:2**

**PUBLIC USE**

Generally, **9:279; 12:72**  
Anticipation, **16:167; 26:13**  
Commercial use, secret commercial use, **11:12**  
Confidentiality agreement, **1:174; 2:106**  
Experimental use exception, **2:178; 8:98; 14:35**  
Implied license, **26:13**  
Inventor testing claimed features, **14:36**  
Law question, **2:57**  
On-sale bar, **2:178; 13:28**  
Oral testimony, **10:31**  
Plant patents, **4:107; 94:106**  
Policy, **2:57**  
Printed publication, publicly accessible, **9:261**  
Proof, standard of, **1:71**  
Public policy, **12:45**  
Rule of reason, **1:159**  
Sale, **7:21**  
Sec. 102(b), **2:1; 2:45; 3:16; 4:84; 4:101; 8:23; 9:34; 9:75; 10:31; 13:35; 13:149; 20:14; 23:11**  
Sec. 262, **8:5**  
Sec. 284, **16:167**  
Secret commercial use, **11:12**  
Third party, **4:101**  
Totality of circumstances, **12:45; 16:44**  
Validity, **16:167**  
Witnesses, oral testimony, **10:31**

**PUBLIC UTILITIES**

Power grid monitoring, abstract ideas, **5:128**

**PUBLISHED DEVICES**

MPEP, **16:6**

**PUNISHMENT**

Damages, **1:20**

**PUNITIVE DAMAGES**

Generally, **18:14**  
Constitutionality of large award, **20:58**  
Review, standard of, **18:58**  
State law punitive damages, **9:161**

INDEX

**PURDUE PHARMA L.P. V.  
COLLEGIUM  
PHARMACEUTICAL, INC.**

2023, **16:192**

**PURELY LEGAL QUESTION**

Claim interpretation, **3:84**

**PURELY PROCEDURAL ISSUES**

Choice of law, **12:58**

**PVPA**

**Plant Variety Protection Act** (this index)

**QUALCOMM INCORPORATED V.  
APPLE INC.**

2025, **17:14**

**QUALIFICATION**

**Attorneys** (this index)

Judge, **8:12; 8:14**

Judicial disqualification, **16:19**

Prior art on obviousness, non-enabling reference may qualify as, **19:59**

Technical qualifications, **9:65**

**QUANTUM OF EVIDENCE**

Generally, **14:2**

**Burden of Persuasion and Quantum of Proof** (this index)

Court must state, **18:7**

**QUASHAL**

Appealability, **8:9**

Choice of law, **20:17**

FRCP 45, **11:24**

**QUASI-ESTOPPEL**

Generally, **9:216**

**QUESTION CERTIFIED**

Interlocutory order, **21:24**

**QUESTIONS**

**Fact Question** (this index)

**Law Question** (this index)

**QUI TAM ACTION**

Retroactive elimination under AIA, **2:151**

**Sec. 292** (this index)

**RACKETEER INFLUENCED AND  
CORRUPT ORGANIZATIONS  
ACT**

**RICO** (this index)

**RAISING ISSUES**

Ambiguity, patent, **9:132**

Appeal and review, **2:87; 7:58; 8:44; 13:85**

Argument not raised at trial, **13:45**

Collateral estoppel, **7:65**

FRAP 30(b), **6:10**

Inequitable conduct, **23:47**

Interference, **13:3**

JMOL, **8:84**

Jurisdiction, **2:56**

Motion in limine, **7:26**

PTO motion to remand, **9:130**

Sec. 282, **4:58**

Secondary considerations, **9:82**

Summary judgment, **2:71**

Waiver, **4:58; 6:16; 23:25**

**RAI STRATEGIC HOLDINGS, INC. V.  
PHILIP MORRIS PRODUCTS  
S.A.**

2024, **18:137**

**RANGES**

Inter partes review, **5:134**

Obviousness, **5:134**

**READY FOR PATENTING**

Experimental use, **5:64**

On-sale bar, **1:179; 8:145; 9:310; 14:35; 19:139**

**REALTEK SEMICONDUCTOR  
CORPORATION V.  
INTERNATIONAL TRADE  
COMMISSION**

2025, **18:139; 18:140**

**REAL WORLD CONSIDERATIONS**

Generally, **13:45**

**REASONABLE APPREHENSION**

Generally, **6:35**

Objective, **16:42**

**REASONABLE COMPETITION**

Prosecution history estoppel, **8:38; 23:41**

**REASONABLE DEBATE**

Certificate of correction, **14:39**

**REASONABLE DELAY**

Laches, **19:151**

**REASONABLE DILIGENCE**

Generally, **13:105**

Interference, **2:13**

Inter partes review, **1:338**

Preamble, **1:338**

Rule 131 affidavit, **1:344**

**REASONABLE EXAMINER  
STANDARD**

Incorporation by reference language,  
**8:124**

Materiality, **12:43; 13:69**

**REASONABLE EXPECTATION**

Obviousness, **8:131; 9:52; 12:55;  
16:140**

**REASONABLE INTERPRETATION  
Broadest Reasonable Interpretation  
(this index)**

Only one, **16:60**

Statutory construction, **13:83; 20:42**

**REASONABLENESS OF  
EXAMINER'S REJECTION**

Inequitable conduct, **1:3**

**REASONABLE PATENT EXAMINER**

Materiality, **2:103**

**REASONABLE PRECISION**

Description, **6:33**

**REASONABLE ROYALTY**

Generally, **1:152; 2:84; 24:7**

ANDA, **1:280**

Anticipated profit, **13:131**

Appeal is review and not trial de novo,  
**6:12**

Apportionment of damages, **14:5**

Claim construction, **19:279**

Common sense estimation, **9:213**

**Damages** (this index)

Determined, when, **21:23**

Eminent domain, **8:56**

Entire market value rule, **12:97; 18:35;  
22:43**

Established royalty as measure, **13:72**

Expert or opinion evidence, **19:279**

**REASONABLE ROYALTY—Cont'd**

Heavy burden if no manufacture to  
exceed, **8:51**

Industry-wide licensing agreement, **1:38**

License, willing licensor, **19:38**

Limitations, court not limited to figures  
urged by parties, **19:53**

Lost profits, **1:308; 23:81; 23:99**

Sec. 284, **2:6**

Waiver, **19:279**

Willing licensor, **19:38**

**REASONABLY APPRISED**

Indefiniteness, **15:21**

**REASONABLY  
CONTEMPORANEOUS**

Evidence of level of skill in the art, **9:23**

**REASONABLY FORESEEABLE**

Damages, **8:43; 13:79**

**REASONABLY PRUDENT PERSON  
STANDARD**

Delay, unavoidable, **18:33**

**REASONABLY RELATED**

Safe harbor provision of Hatch-Wax-  
man, **13:187**

**REASONS OF ALLOWANCE**

Prosecution history estoppel, **19:168**

**REASSIGNMENT**

Articulation of reasoning, **20:104**

**REBUTTABLE PRESUMPTION**

Prosecution history estoppel, **3:130;  
12:53; 18:77**

**REBUTTAL**

Attorney disqualification, **16:3**

Inventor's admission of invention by  
another, **1:8**

Obviousness, prima facie obviousness,  
**9:99**

Papesch, **9:9**

Prima facie obviousness, **2:25; 9:99;  
9:119**

**RECAPTURE**

Generally, **16:67**

Disclaimer, **8:96**

Doctrine of equivalents, **13:63**

Prosecution history estoppel, **16:40**

## INDEX

### **RECAPTURE—Cont'd**

Reissue, **7:106; 9:335; 9:368; 13:54; 13:140; 13:165; 23:16**

### **RECAPTURE RULE**

Certificate of correction, **3:187**  
Written description, **3:187**

### **RECEIVERS**

Standing, **13:148**

### **RECENTIVE ANALYTICS, INC. V. FOX CORP.**

2025, **18:141**

### **RECOMBINANT DNA**

As to DNA, generally. **DNA** (this index)  
Generally, **7:28; 9:128; 9:167; 18:40; 19:121**  
Deposit of DNA, **19:121**  
Encoding protein sequence, **9:167**

### **RECONSIDERATION**

Infringement, new theory, **7:113**  
New ground of rejection, **9:22**  
Rejection, new ground of, **9:22**  
Summary judgment, **10:4**  
Timely notice of appeal, **20:21**

### **RECONSTRUCTION**

Claim differentiation, **11:2**  
Exhaustion of patent rights, **10:27**  
Implied license to repair with sale, **11:36**  
**Repair** (this index)  
Replacement of worn part, **16:20**  
Template, use as template, **9:114**  
Use as template, **9:114**

### **RECTIFY**

Patent license, **12:14**

### **RECUSAL**

Generally, **2:55**  
Choice of law, **2:55**  
Judicial disqualification, **1:65**

### **REDEFINING**

Claim interpretation, **5:48**  
Claim terms during prosecution, **1:136**

### **REDRAFTING CLAIM**

Claim construction, **18:91**  
Claim preamble, **3:22**

### **REDUCTION TO PRACTICE**

Generally, **2:118; 11:10**

### **REDUCTION TO PRACTICE—Cont'd**

Burden of production, **12:63**  
Conception, **9:407; 13:105; 19:124**  
Constructive interference, **8:67**  
Elements, **7:64; 13:105**  
Embodied in tangible form, **19:144**  
Evidence, standard of, **13:110**  
Experimental use, **7:12**  
Intended purpose, need to show device works for, **13:72**  
Interference, **3:25; 12:2; 14:3**  
Invention of claims, **16:70**  
Law question, **2:96; 4:27; 5:34; 9:163; 19:70**  
Limitations, includes all, **3:82**  
New interference rules, **8:3**  
Nunc pro tunc, **3:94**  
On-sale bar, **16:52**  
Performance of government contract, **8:8**  
Priority of invention, **8:108**  
Reasonable diligence, **1:344**  
Reference, antedate, **9:341**  
Requirements, **20:70**  
Review, standard of, **19:90**  
Rule 131, **1:344**  
Sec. 102(g), **6:83; 19:10**  
Sec. 120, **9:13**  
Sec. 131, **9:407**  
Tangible form, embodied in, **19:144**  
Testing, **26:11**  
Two prong test, **5:46**  
Verbatim findings of counsel adopted, **8:22**

### **REDUNDANT JUDGMENT**

Declaratory judgment suit or counterclaim as, **13:46**

### **REEXAMINATION**

Generally, **18:108**  
Amendment of claims, **3:102; 6:8; 16:115; 17:6; 20:4**  
Anticipation, **9:314; 9:340; 19:225**  
Broadening uses, reissue test, **8:68**  
Broaden term is not fatal, **1:90**  
Broadest reasonable interpretation, **9:87; 9:154; 9:255**  
CAFC jurisdiction, **7:8**  
Certificate, **9:239**  
Claim preclusion, **19:255**

**REEXAMINATION—Cont'd**

Commissioner not limited to prior art, **9:194**  
 Completed upon issuance of reexamination certificate, **9:239**  
 Constitutionality, **10:16; 16:8**  
 Court review of decision to institute, **9:206**  
 Damages, **12:50**  
 District court cannot order party to file, **9:180**  
 Effective date, **13:79**  
 Enlargement of claims question of law, **20:43**  
 Estoppel, **1:369**  
 Expiration of patent, **9:424**  
 Extrinsic evidence, **20:120**  
 Filing, district court cannot order party to, **9:180**  
 Final judgment rule, **5:25; 6:84; 6:85**  
 Identical to original claim, **6:8**  
 Incremental, **9:501**  
 Interference, **4:8**  
**Inter Partes Reexamination** (this index)  
 Intervention, **13:176**  
 Issuance of certificate, **9:239**  
 Jurisdiction, **19:46**  
 Law question, **20:43**  
 Limitations, commissioner not limited to prior art, **9:194**  
 Manual of Patent Examining Procedure (MPEP) § 2217, **17:2**  
 New claims, **19:255**  
 New question, **2:150; 9:183**  
 Obviousness, **4:109; 9:329; 9:351; 9:442; 18:99**  
 Parties, **9:180**  
 Patentability, **9:183**  
 Pending litigation, stay as result of, **22:23**  
 Physical substitution of one reference into structure of another, **9:87**  
 Possibility, **9:87**  
 Preponderance of the evidence standard, **5:9**  
 Prior art, **9:194; 9:200**  
 Priority, **9:340; 19:110**  
 Priority cannot be determined, **19:110**  
 Prosecution history estoppel, **9:237**  
 Public policy, **2:64; 9:200**

**REEXAMINATION—Cont'd**

Reference, **9:87**  
 Reissue, **6:8; 8:68; 11:5**  
 Reissue versus, **9:151**  
 Rejection, adding new grounds, **9:344**  
 Request not litigation suit in court, **10:9**  
 Review of decision to institute, **9:206**  
 Rule 131 affidavit, **7:19**  
 Sec. 252, **12:25**  
 Sec. 282, **9:80**  
 Sec. 304, **19:46**  
 Sec. 305, **9:151**  
 Stay, **8:52; 16:116; 19:49; 22:23**  
 Substantial new question of patentability, **2:150; 9:183; 9:314**  
 Substantively identical, amended claims, **6:8**  
 Substitution, **9:87**  
 Summary judgment, **3:192**  
 Termination, **1:282**  
 Third-party requester, **1:287**  
 35 USC § 252, **6:8**

**REFERENCE**

Admission from failed attempt to antedate reference, **3:54**  
 All that it fairly suggests, **9:148**  
 All that it teaches, **9:123**  
 Analogous art, **9:16; 9:78; 19:36**  
**Antedating Reference** (this index)  
 Anticipation, **5:66; 7:48; 7:94; 7:99; 9:291; 13:85; 19:38; 19:201**  
 Chemical, **9:60**  
 Claims construed, **9:77**  
 Combination patent, **13:15**  
 Combining references  
   express teaching, **9:119**  
   obviousness, **3:138; 8:42; 9:121; 16:109**  
   prima facie obviousness, **9:123**  
   prior art, teaching or suggestion in, **9:126; 9:127**  
   showing only components not overall appearance of design, **9:137**  
 Combining teachings, **9:74**  
 Commissioner's brief not prior art, **9:140**  
 Common knowledge of the art, **9:154**  
 Cumulative reference, **5:16; 18:40; 19:51; 19:59**  
 Design patent, **9:137**

## INDEX

### REFERENCE—Cont'd

Disclosure document, **15:28**  
Earlier filing date, **5:104**  
Effective date, **9:110**  
Enabling reference may qualify as prior art on obviousness, **19:59**  
Fact findings of PTO, **9:80**  
Fact question, teachings of, **9:119; 9:133; 9:148; 9:166; 9:169; 19:56**  
First-filed patent as prior art, **17:2**  
Foreign countries, **9:120; 17:1**  
Hindsight analysis improper, **9:16**  
**Incorporation by Reference** (this index)  
Inequitable conduct, **13:101**  
In their entireties, **16:4**  
Intentionally withheld, cannot be, if PTO considers, **12:43**  
Later reference, discredited by, **9:117**  
Modification, **3:3; 9:51**  
New prior art not considered by PTO, **5:11**  
Notice and knowledge  
    common knowledge of the art, **9:154**  
    materiality, **6:80**  
Obviousness  
    generally, **9:16**  
    combining references, **3:138; 23:11**  
    entirety, considered in its, **2:8**  
    establishment, teaches away from claimed invention as a general rule cannot be used to, **9:152**  
    large number of, **9:114**  
    prerequisite is determining pertinent references, **19:154**  
    prior art, **9:124; 19:59**  
    reasonable expectation of success, **9:52**  
    reference composition, **15:38**  
    single reference, **19:123**  
    teaching away, **3:151; 9:289; 9:361**  
Presumption of validity, **9:21**  
Prior art  
    generally, **9:59; 12:61**  
    combining references, **9:126; 9:127**  
    combining teachings, **9:74**  
    Commissioner's brief, **9:140**  
    enabling reference, **19:59**  
    first-filed patent, **17:2**  
    later reference, discredited by, **9:117**

### REFERENCE—Cont'd

Prior art—Cont'd  
    limitations, **12:80**  
    new prior art not considered by PTO, **5:11**  
    obviousness, **9:124; 19:59**  
    relevancy of foreign patent prosecution, **13:69**  
Reexamination, **9:87**  
Relative terms, **9:36**  
Relevancy of foreign patent prosecution, **13:69**  
Rule 131 affidavit, **7:19**  
Sec. 1.56, **8:29**  
Sec. 102(b), **9:18**  
Sec. 103, **15:4**  
Sec. 103 rejection, **9:101**  
Sec. 112, foreign references, **17:1**  
Sec. 282, **5:1**  
Special master's decision, **13:24**

### REFINING

Improving device, **13:8**

### REGENERON PHARMACEUTICALS, INC. V. MYLAN PHARMACEUTICALS INC.

2025, **18:142**

### REGENTS OF THE UNIVERSITY OF CALIFORNIA V. BROAD INSTITUTE, INC

2025, **18:143**

### REGENTS OF THE UNIVERSITY OF MINNESOTA V. GILEAD SCIENCES, INC.

2023, **18:134**

### REGIONAL CIRCUIT COURT

Choice of law, **24:1**

### REGIONAL CIRCUIT LAW

Declaratory judgment, **19:22**

### REGIONAL LAW

Motion to vacate, **16:19**

### REGISTRATION

Declaratory judgment, **23:9**  
Sec. 32, **23:15**  
Statutory invention registration, **8:67**

### REHEARING

Frivolous, **9:97**

**REHEARING—Cont'd**

Motion to remand, **19:45**  
Obviousness, **2:161**

**REINSTATEMENT**

License agreement, **16:23**  
Maintenance fee, failure to pay, **3:38**

**REISSUE**

Generally, **14:51**  
Affidavit describing work of third party at reasonably contemporaneous time, **9:23**  
Application, **9:47**  
Attorney fees award, **16:24; 18:82**  
Attorneys, **9:84; 9:294**  
Broadened claims, **9:192; 9:365; 17:6**  
Cancelled original claim, **6:85; 9:364; 12:31**  
Change, **9:10**  
Claim construction in foreign prosecution, **1:209**  
Claims construed, **6:100; 9:77**  
Copying before patent issued, **11:5**  
Dann Amendment, **19:30**  
Dependent claims, **9:336**  
Disclaimer filed and two-year limit, **22:15**  
Double patenting, **7:115**  
Error, **8:64; 19:110; 19:137**  
Filing, **9:3; 22:15**  
Foreign prosecution, claim construction, **1:209**  
Ignorance of inventor, **9:84**  
Inequitable conduct, **8:26**  
Insight, new counsel's, **9:84**  
Intervening rights to manufacture, **13:168**  
Inventorship, **3:83**  
Inventor's ignorance, **9:84**  
JMOL, **4:64**  
Jury, **1:16**  
Law of the case, **1:276**  
Law question, **9:188**  
Limitation, disclaimer filed and two-year limit, **22:15**  
Linking claim, **4:70**  
Motion, **12:36**  
New counsel's insight, **9:84**  
Oath invalidating, **4:69**  
Objective intent to claim is not criterion, **9:109**

**REISSUE—Cont'd**

Obviousness question, **3:30; 9:366**  
Omissions, **9:294**  
Preliminary injunctions, **1:259**  
Prior art, **9:90**  
Priority, **9:294**  
Prosecution history, **6:37**  
PTO error in two patents for same invention, **19:110**  
Recapture rule, **7:106; 9:335; 9:368; 9:507; 13:54; 13:140; 13:165; 23:16**  
Reexamination, **6:8; 8:68; 11:5**  
Reexamination versus, **9:151**  
Remedial statutes, **9:3**  
Requirements, **14:23**  
Restriction, **4:70**  
Same invention, **19:110**  
Sec. 26, **9:3**  
Sec. 116, **9:3**  
Sec. 121, **7:115**  
Sec. 251  
generally, **2:4; 8:12; 9:69; 9:84; 9:85; 9:105; 9:138; 19:51**  
compelling patentee to seek no defect reissue, **7:21**  
Sec. 252, **19:4; 19:13; 19:55; 23:26**  
Sec. 252(2), **2:40**  
Specify every different, **4:63**  
Summary judgment, **8:17**  
Suspend proceedings, **3:72**  
Terminal disclaimer, withdrawal, **9:367**  
37 CFR Sec. 1.175(a)(4), **9:25**  
Two patents, **19:110**  
Unrelated claims, **9:365**  
Validity, oath, **4:69**  
Willful infringement, **11:5**  
Written description, **9:479**

**REJECTION**

Acquiescence of applicant, **12:31**  
Appellate review, **9:64**  
Common occurrence, **17:4**  
Cross-appeal, **18:2**  
Evidence of validity, **7:19**  
Factfinder not obliged, **8:31**  
FRCP 56(f), **2:80**  
Grounds, **9:344**  
Intent to claim, **9:39**  
MPEP, **16:6**  
New ground, **9:15; 9:22; 9:37; 9:127**

## INDEX

### REJECTION—Cont'd

Obviousness, **9:56; 9:173; 9:333; 16:19; 17:2**  
Papesch, **9:9**  
Sec. 1.192(c)(7), **8:107; 13:108**  
Sec. 1.196(a), **9:140**  
Sec. 102(b), **9:18**  
Sec. 102(e), **9:110**  
Sec. 103, **9:101**  
Sec. 112, **16:10**  
Sec. 132, **3:32**  
Sec. 145, **7:9**  
37 CFR Sec. 1.196(a), **9:106**  
Timeliness, **9:38**  
Validity, evidence of, **7:19**

### RELATED APPLICATIONS

Sec. 120, **12:10**

### RELATED LITIGATION

Generally, **19:61**

### RELATED PARTY

Privity, **5:4; 11:14**

### RELATIVE TERMS

Generally, **9:36**

### RELEVANCE

All that it teaches, **9:123**  
Anticipation, **19:154**  
Claim interpretation, **3:75**  
Due process clause, **18:69**  
Facts to be found by trial court, **18:25**  
Foreign patent prosecution, **13:69**  
Inequitable conduct, **8:62**  
Jury verdict, **18:25**  
Later reference, discredited by, **9:117**  
Materiality, **2:68**  
New prior art not considered by PTO, **5:11**  
Sec. 1498, **12:11; 15:4**  
Selection of transferee forum, **9:128**  
Subsequent patent, **8:40**  
Substantial evidence, **16:39**  
Transfer, selection of transferee forum, **9:128**

### RELEVANT MARKET

Jury, **1:16**

### RELITIGATING

Consent judgment, **5:8**

### REMAND

Appealable, **9:31**  
Appropriateness, **7:37; 12:26**  
Assignor estoppel, **6:96**  
Attorney fees, **3:46**  
Clarification, **10:38**  
Damages, **18:105**  
Faulty jury instruction, **7:27**  
FRCP 52(a), **1:59**  
Jury instructions, faulty, **7:27**  
Mandamus, **9:68**  
Necessity of, **3:35**  
Non-party, **9:116**  
Notice and knowledge, **19:45**  
Scope, **5:43**  
Sec. 284, **2:31**  
Sec. 1367, **8:97**  
Sec. 1447, **8:97**  
Senior party introduces no evidence, **2:26**  
Timeliness, **9:38**

### REMBRANDT DIAGNOSTICS, LP V. ALERE, INC.

2023, **18:135**

### REMEDIAL SANCTION

Mandamus, **9:57**

### REMEDIAL STATUTES

Reissue, broadening, **9:3**

### REMITTITUR

Maximum recovery rule, **21:23**  
Review, standard of, **15:10**

### REMOVAL

Assignor estoppel, **6:96**  
Expert opinion testimony, **2:80**  
Sec. 141, **9:116; 9:496**  
Sec. 1447(d), appeal and review, **22:46**

### RENEWAL

Directed verdict, **14:1**

### REPAIR

ARO, **19:56**  
Blonder-Tongue, **1:13**  
Combination, when component effectively spent, **19:79**  
Implied license defense, **4:1**  
Law question, **4:1**

**REPAIR—Cont'd**

Reconstruction versus  
generally, **1:86; 4:1; 8:59; 10:27; 12:20; 13:42**  
bright-line test, none therefore, **2:75**  
exhaustion of patent rights, **10:27**  
extent of change not its purpose, **19:143**  
implied license to repair with sale, **11:36**  
replacement of worn part, **6:67; 16:20**  
Three situations, **8:83**

**REPEAL**

CAFC, **6:30**  
Implication, by, **18:34**  
Statutory construction, **6:30; 19:80**

**REPEATED BITES AT THE APPLE, NO SUPPORT FOR**

Repose, law reaches for, **2:26**

**REPLACEMENT**

Doctrine of equivalents, **13:106**  
Prosecution history estoppel, **13:105**  
Reconstruction vs. repair, **6:67; 16:20**

**REPLICATION OF PATENTED TECHNOLOGY**

Infringement, **13:173**

**REPLY BRIEF**

Generally, **1:351**  
Fraud allegation, **12:3**  
Raising issue for first time, **1:79; 12:3; 23:23**

**REPOSE**

Repeated bites at the apple, no support for, **2:26**

**REPREHENSIBLE CONDUCT**

Appellant's demeaning trial court, **9:159**

**REPRESENTATIVE CLAIMS**

Generally, **2:57**  
FRAP 38, **16:4**  
Sec. 1.192(c)(7), **8:107**  
Valid, inappropriate to declare, **4:19**

**REPUDIATION**

Generally, **4:59**

**REPUTATION**

Adequacy of monetary damages, **18:32**

**RESALE**

Review of decision on JNOV motion, **21:5**

**RESCISSION**

Generally, **4:59**

**RESEARCH**

FNERDA, **6:18**  
Obviousness, **13:84**  
On sale bar, research agreement, **5:76**  
Sec. 271(e)(1), **9:251; 9:299**

**RESEARCH JOINT VENTURES**

Patent misuse, **16:126**

**RES JUDICATA**

Generally, **8:92; 19:332**  
Agency decision, effect of, **2:60**  
Agreement, effect of, **4:71**  
Application to patents not in complaint, **11:35**  
Claim preclusion, **19:255**  
Collateral estoppel, **9:122; 16:35**  
Complaint, application to patents not in, **11:35**  
Consent decree on validity and enforceability, **6:17**  
Continuing conduct, **1:229**  
Enforcement, consent decree on, **6:17**  
Issue preclusion, **4:9; 13:51**  
Law question, **21:29**  
Material differences in claim limitation, **14:64**  
Preclusion, **4:9; 6:14; 13:51**  
Prior state court decision, **13:22**  
Privity, **9:224**  
Sec. 337, **3:23**  
State court decision, prior, **13:22**  
Summary judgment, **1:78**  
Validity, consent decree on, **6:17**

**RESPONSE**

Discovery sanctions, **13:25**  
Document request, **2:27**

**RESTEM, LLC V. JADI CELL, LLC**

2025, **18:144**

**RESTITUTION**

Attorney fees award improperly granted, **19:58**  
Equitable remedy, **20:34**

## INDEX

### RESTORATION OF PATENT TERM

Generally, **16:84**

### RESTRICTIONS

**Limitations and Restrictions** (this index)

### RESUBMITTING REFERENCES

Inequitable conduct, **1:92**

### RESULTING PREJUDICE

Delay, **13:44**

### RETENTION OF DOCUMENTS

Preservation of evidence, **13:168**

### RETIRED

Evidence, loss of, **14:11**

### RETRIAL

Infringement, **8:51**

### RETROACTIVITY

Constitutionality, **16:8**

Judicial decision, **23:33**

Not favored, **2:32**

Order, **1:46**

Standing, **8:63**

Statutory construction, **15:7**

### RETROSPECTIVE EFFECT

Change in law, **7:25**

### REVERSAL

Appropriateness, **12:26**

Damages award, **5:102**

Declaratory judgment, **9:92**

District Court decision, **9:1**

Jury and jury trials, **5:41**

State immunity from suit under Eleventh Amendment, **10:11**

Summary judgment, **8:17**

Validity, **7:8**

Willful infringement, **3:26**

### REVERSE DOCTRINE OF EQUIVALENTS

Generally, **1:131; 9:149; 13:9; 20:61**

Abbreviated new drug application (ANDA), **18:80**

Additional components, **12:18**

Burden of proof, **19:24**

Claim construction and interpretation, **3:7; 19:24; 19:51**

Claim differentiation, **11:2; 19:24**

### REVERSE DOCTRINE OF EQUIVALENTS—Cont'd

Claim preclusion, **18:80**

Commercial embodiment, comparison with, **19:24**

Complexity exception, **19:24**

Exception, complexity, **19:24**

Jury, **19:24**

Lethal weapon, **19:24**

Overbreadth, **21:10**

Specification, **19:24**

Summary judgment, **19:24**

### REVERSE PAYMENT

Settlement agreement, **9:309**

### REVERSE SETTLEMENT AGREEMENT

Antitrust, **6:87**

### REVERSE VALIDITY

Cross-appeal, **18:2**

### REVERSIBLE ERROR

Difficulty of showing, **19:57**

### REVIEWABILITY

**Appealability** (this index)

### REVIVAL

Abandoned patent, **1:177**

Patent cooperation treaty (PCT), **5:127**

### REWRITTEN ACTS AND MATTERS

Claim interpretation, **16:91; 18:68**

Claims, rewritten to suit needs, **14:14**

Doctrine of equivalents, **18:65**

Validity, **1:119**

### RICO

Preliminary injunction, **6:7**

Statute of limitations, **1:47**

### RIGHT TO SUE

Standing, **19:154**

### ROAD TRYOUT

FRCP 15(c), **6:11**

### ROKU, INC. V. INTERNATIONAL TRADE COMMISSION

2024, **18:138**

### ROKU, INC. V. UNIVERSAL ELECTRONICS, INC.

2023, **18:136**

**ROOTS**

Half the practice of a decent lawyer,  
**1:20; 12:24; 16:4**

**ROUTINE**

**Well-understood, Routine and  
 Conventional** (this index)

**ROUTINE ASSESSMENT**

Attorney fees, **18:12**

**ROUTINELY BUILT**

Conclusory statements, **9:113**

**ROUTINE OPTIMIZATION**

Obviousness, **9:449**

**ROYALTIES**

Appeal is review and not trial de novo,  
**6:12**

Blonder-Tongue, **1:13**

Damages, **8:20; 9:235**

Escrow, **3:21**

Expired patent, **11:79**

Factual findings to support jury verdict  
 presumed, **2:15**

FRCP 52(a), **1:18**

In lieu of injunction, **16:106**

**Reasonable Royalty** (this index)

Running royalty agreement, **23:73**

Sales to subsidiary, **9:159**

Sec. 1631, **19:2**

Stay of patent action, **9:91**

Unpatented components, may be based  
 on, **5:26**

**RUBIK'S CUBE CASE**

Generally, **13:28**

**RULE 11**

Generally, **19:258**

**RULE 27(1)**

Generally, **6:57**

**RULE 28(D)**

Confidentiality markings in brief, **9:337**

**RULE 60(b)**

Discretion of court, **12:100**

**RULE 129(B)(1)(II)**

Generally, **8:165**

**RULE 131 AFFIDAVIT**

Generally, **17:2**

**RULE 131 AFFIDAVIT—Cont'd**

Antedating reference, **7:19**

Four-part Graham inquiry, **7:19**

Graham inquiry, four-part, **7:19**

Obvious determination, **7:19**

Reasonable diligence, **1:344**

Reduction to practice, **1:344**

Reexamination, **7:19**

Reference, antedating, **7:19**

**RULE 147**

Generally, **12:10**

Own merits, each claim considered on,  
**12:10**

**RULE 196**

Rule 198, **9:31**

**RULE 198**

Rule 196, **9:31**

**RULE 202**

New evidence, **9:288**

**RULE OF REASON**

Corroboration, **9:288; 11:41; 12:92;  
 13:72; 19:132**

Sufficient circumstantial evidence, **3:82**

**RUMORS**

Appellate jurisdiction, **3:11**

**RUSCC 60(B) MOTION**

Claims court, **3:40**

**SAFE HARBOR**

ANDA, Hatch-Waxman safe harbor,  
**13:187**

Drug product importation, **1:175;  
 16:117**

Sec. 121, **2:140; 19:246**

URAA, **2:54; 4:40**

**SAGE PRODUCTS, LLC V. STEWART**

2025, **19:358**

**SALAZAR V. AT&T MOBILITY LLC**

2023, **19:344**

**SALES**

Adjudicated infringer, **11:10**

Commercial success, **9:111**

Damages, future lost sales, **6:74**

Infringement, **8:129**

Infringement, selling lower priced prod-  
 uct does not justify, **16:33**

## INDEX

### **SALES—Cont'd**

- Laches, **15:14**
- Offer for sale, infringement, **8:129**
- Public use, **7:21**
- Royalty calculation, **9:159**
- Sec. 271, **10:17**
- Summary judgment motion, **1:2**

### **SALES CONTRACT**

- On-sale bar, **26:8**

### **SALIX PHARMACEUTICALS, LTD. V. NORWICH PHARMACEUTICALS INC.**

- 2024, **19:353**

### **SAME BURDEN**

- Sec. 1498, **12:11**

### **SAME CLAIM**

- Claim interpretation, **1:106**

### **SAME CLAIM INTERPRETATION**

- Used for validity and infringement, **2:45**

### **SAME CONCEPTS**

- Sec. 287, **13:33**

### **SAME DESIGN**

- Sec. 171, **9:73**

### **SAME EVIDENCE**

- Identity of invention, **20:20**
- Mandamus, **9:41**

### **SAME INVENTION**

- Double patenting, **7:75; 9:52**
- Expiration of patent right is not  
guarantee of right to use, **19:39**
- Jury instructions, **10:4**
- Obviousness-type, **19:39**
- Obviousness-type double patenting,  
**9:52**
- Reissue, **19:110**

### **SAME ISSUES**

- Enjoining concurrent litigation, **9:116**

### **SAME LOCATION**

- Doctrine of equivalents, **26:4**

### **SAME MEANING**

- Claim interpretation, **19:15**
- JNOV motion, denial of, **13:13**

### **SAME PARTIES**

- Enjoining concurrent litigation, **9:116**

### **SAME PHRASES**

- Sec. 287, **13:33**

### **SAME RESULT**

- Graver Tank, **20:6**

### **SAME TERMS**

- Claim interpretation, **1:106; 5:63; 6:43**

### **SAME THING, NOT EQUAL TO**

- Preliminary injunction, **4:5**

### **SAME TIME**

- Co-inventors, **20:68**

### **SAME WAY**

- Construed same way, **11:9; 23:11**
- Obviousness, **19:11**
- Sec. 102(g), **11:9**

### **SAMPLE AS WITNESS**

- Claims determine what infringes patent,  
**9:4**

### **SANCTIONS**

- Generally, **1:364; 13:131; 13:135;  
19:188**
- Antitrust, **11:16**
- Appeal and review, **13:71; 19:64**
- Attorney fees, **12:36; 19:42; 20:115**
- Choice of law, **19:114**
- Confidentiality markings in briefs filed,  
**9:337**
- Demand therefor must be supported,  
**17:2**
- Discovery violation, **2:27; 18:94**
- Dismissal without prejudice, **12:36**
- Enforcement order, **4:20**
- FRAP 38, **9:102; 23:89**
- FRCP 11, **1:41; 3:150; 5:109; 9:125;  
18:24; 18:95**
- FRCP 37(b), **14:14; 20:4**
- Frivolous appeal, **3:150; 5:96; 13:71**
- Improper behavior in courtroom, **14:19**
- Infringement, neither intent nor prepara-  
tion constitutes, **12:22**
- Inter partes review, **2:174**
- ITC orders, violations, **14:65; 15:52**
- Jurisdiction, **20:129**
- Litigation misconduct, **1:193; 13:85;  
20:87**
- Mandamus, **9:57**
- Patent and Trademark Office (PTO),  
**2:121**

**SANCTIONS—Cont'd**

Pro hac vice, **2:55**  
 Respond, failure to, **13:25**  
 Review, standard of, **9:161**  
 Sec. 1.287(d)(2), **23:14**  
 Sec. 1.616, **1:60**  
 Sec. 284, **2:31**  
 Sec. 285, **19:57**  
 Sec. 292, **6:72**  
 Sec. 455, **8:14**  
 Sec. 1292(c)(2), **9:6**

**SANDERLING MANAGEMENT LTD.  
 V. SNAP INC.**

2023, **19:345**

**SANHO CORP. V. KAIJET  
 TECHNOLOGY  
 INTERNATIONAL LIMITED,  
 INC**

2024, **19:354**

**SANOFI-AVENTIS DEUTSCHLAND  
 GMBH V. MYLAN  
 PHARMACEUTICALS INC.**

2023, **19:346**

**SATELLITE LITIGATION**

Generally, **3:42**

**SCATTERGUN APPROACH**

FRCP 15(c), **6:11**

**SCHOOL, EXPERT STILL IN**

Generally, **23:11**

**SCHWENDIMANN V. NEENAH, INC.**

2023, **19:347**

**SCIENCE**

Validity, **5:56**

**SCIENTIFIC FORMULA**

Prior art article, **9:48**

**SCIENTIFIC OPINION**

Evidence, **2:79**

**SCIENTIFIC PRINCIPLES**

Inventor's theory, **6:10**

**SCIENTIFIC THEORY**

Generally, **26:2**

**SCIENTIST**

Test results, **8:30**

**SCPA**

Mask works, **2:34**

**SCREENING**

Attorney disqualification, **16:3**

**SEAGATE TEST**

Enhanced damages, **8:137**

**SEALED DOCUMENTS**

Generally, **21:89**

**SEARCH**

Misrepresentation re prior art search,  
**7:29**

**SEARS**

Compco, **21:11**  
 Copying an article, **7:3**  
 Damages, **7:3; 21:11**  
 Lost sales caused by introduction of  
 competitive product, **21:11**

**SEC. 1.**

Generally, **3:241; 8:67**

**SEC. 1.11(b)**

Sec. 1.195, **9:74**

**SEC. 1.28**

Generally, **4:52**

**SEC. 1.48**

Sec. 256, **19:76**

**SEC. 1.51(a)**

Generally, **5:57**

**SEC. 1.54(d)(1)**

Generally, **19:163**

**SEC. 1.54(d)(2)**

Generally, **19:163**

**SEC. 1.56**

Generally, **19:180**  
 Disclose references showing each  
 known step, no obligation to, **8:29**

**SEC. 1.84**

Heavy lines show light direction, **9:137**

**SEC. 1.137**

Generally, **4:52**

**SEC. 1.153**

Form-of-claim requirement, **9:137**

## INDEX

- SEC. 1.192(a)**  
Affidavit, **9:142**
- SEC. 1.192(c)**  
Dependent claims not separately argued,  
**9:154**
- SEC. 1.192(c)(7)**  
Generally, **13:108**  
Representative claim, **8:107**
- SEC. 1.195**  
Sec. 1.11(b), **9:74**
- SEC. 1.196(a)**  
Rejection, grounds not specifically  
addressed by Board, **9:140**
- SEC. 1.287(d)(2)**  
Sanctions, **23:14**
- SEC. 1.324**  
Evidence, **23:55**
- SEC. 1.601**  
Generally, **9:240**
- SEC. 1.601(c)**  
Sec. 135(b), versus, **9:240**
- SEC. 1.601(i)**  
Generally, **1:107; 9:163**
- SEC. 1.601(n)**  
Generally, **1:107**
- SEC. 1.616**  
Sanctions, **1:60**
- SEC. 1.633(a)**  
Generally, **18:44**
- SEC. 1.633(g)**  
Interference, **11:27**
- SEC. 1.640**  
Interference, **3:32**  
Order to show cause, **1:60**
- SEC. 1.640(b)**  
Generally, **2:93**
- SEC. 1.645(b)**  
EIC has broad discretion on late filings,  
**1:60**
- SEC. 1.657(a)**  
Generally, **2:96**
- SEC. 1.662(b)**  
Interference, **7:23**
- SEC. 1.671**  
New interference rules, **8:3**
- SEC. 1.671(f)**  
Generally, **2:96**
- SEC. 1.1641**  
Patentability considered, **9:141**
- SEC. 2**  
“Before the Office,” **2:121**  
Patent misuse, **20:2**
- SEC. 2(b)(2)(D)**  
Generally, **11:50**  
Disciplinary action, **2:121**
- SEC. 6(a)**  
Commissioner’s regulation if not incon-  
sistent have force of law, **23:15**
- SEC. 10.57(b)**  
Propriety of nondisclosure by attorney  
of another client’s application,  
**13:69**
- SEC. 13(b) CONDITION PRECEDENT**  
Interference, **2:93**
- SEC. 26**  
Reissue, broadening, **9:3**
- SEC. 32**  
Generally, **11:50**  
“Before the Office,” **2:121**  
PTO registration of attorneys, **23:15**
- SEC. 41(a)(7)**  
Agency’s interpretation of statute, **13:32**  
Commissioner’s jurisdiction, **13:32**  
Complaint, well-pleaded, **13:32**  
Deference, entitled to, **13:32**  
District court, **13:32**  
Interpretation of statute, agency’s, **13:32**  
Jurisdiction, commissioner’s, **13:32**  
Well-pleaded complaint, **13:32**
- SEC. 41(c)(1)**  
Generally, **7:87**
- SEC. 43(a)**  
Competition, unfair, **15:5; 16:21**  
8 Cir, **10:15**  
Lanham Act, **12:23**

**SEC. 43(a)—Cont'd**

Summary judgment, **3:1**  
 Unfair competition, **15:5; 16:21**  
 Willful infringement, **3:26**

**SEC. 85**

Attorney fees award in contract action,  
**9:159**

**SEC. 100**

Generally, **19:174**

**SEC. 100(d)**

Generally, **1:68**  
 Patentee, **1:46**

**SEC. 101**

Generally, **1:277; 1:286; 1:322; 1:349;**  
**1:368; 2:177; 2:191; 3:172; 3:213;**  
**3:219 to 3:221; 3:232.70; 3:235;**  
**3:239; 4:118; 5:146; 5:150; 5:153;**  
**6:105; 9:393; 9:414; 9:416; 9:451;**  
**9:465; 9:474; 9:487; 9:497; 9:498;**  
**9:506; 9:511; 13:188; 14:98;**  
**15:46; 16:178; 18:115; 18:125;**  
**19:257; 19:306; 19:307; 19:328;**  
**20:139; 21:81; 21:82; 21:86;**  
**23:102; 24:8**

Abstract ideas, **1:95; 1:253; 1:285;**  
**1:286; 1:290; 2:163; 3:143; 4:104;**  
**5:128; 6:94; 9:286; 9:308; 13:188;**  
**19:298; 19:301; 19:331; 20:143;**  
**22:58**

Animals as patentable subject matter,  
**1:45**

Anticipation, **3:207**

Claim construction, **13:241; 19:320**

Computer-aided, **6:80; 19:292**

Computer-related limitations to significant part of invention, **1:251;**  
**1:286; 2:147**

Correctness of inventor's theories, **18:6**

Covered business method review,  
**18:119; 20:154**

Damages, **6:97**

Definitions, **9:290**

Dismiss, motion to, **1:343**

DNA, **1:228; 1:245; 9:383**

Double patenting, **9:463**

Economic practice, **19:331**

Enablement, **18:6**

Estoppel, **19:320**

Failure to claim patent-eligible subject matter, **9:433**

**SEC. 101—Cont'd**

Failure to state a claim, **2:167**

Indefiniteness, **2:175**

Infringement allegations, **7:118**

Internet, abstract ideas, **1:285; 4:104;**  
**9:437**

Inter partes review, **14:99**

Issue preclusion, **22:61**

Machine, **19:112**

Machine-or-transformation test, **9:308;**  
**16:123; 21:62**

Man-made organisms, **1:228**

Mathematical algorithm, **9:308**

Means-plus-function claim, **4:97**

Nonstatutory subject matter, **9:30**

Obviousness, **14:99**

Overbreadth, **21:10**

Patent-ineligibility defense, **13:217**

Patent-ineligible subject matter, **1:310;**  
**3:219; 3:227; 6:94; 9:431; 9:437;**  
**13:210; 18:109**

Power grid monitoring, **5:128**

Practical utility requirement, **9:143**

Printed matter and substrate, **3:219;**  
**9:32; 11:64**

Process claim, **3:164; 6:71; 9:308**

PVPA, **16:63**

Sec. 112, **18:6**

Sec. 285, **9:455**

Sovereign immunity, **21:78**

Standing, **9:452**

Statutory subject matter, **1:51; 3:164;**  
**4:105; 6:82; 9:30; 9:154; 9:155;**  
**9:286; 9:437; 13:178; 21:62**

Subject matter, **11:83**

Summary judgment, **2:175**

Utility, **2:34; 3:37; 5:7; 13:55; 14:4;**  
**18:6; 20:25**

Vacation of summary judgment based on anticipation, **5:129**

**SEC. 102**

Anticipation, **9:104**

Classic test, **12:12**

Corroboration, **6:40**

Obviousness, **3:168**

Prior art, **19:257**

Public accessibility, **19:207**

**SEC. 102(a)**

Generally, **13:72; 13:122; 23:48**

First inventor, **7:98**

## INDEX

### SEC. 102(a)—Cont'd

Foreign country, patented in, **9:120**  
Known or used by others, **3:2**  
Prior art reference, **9:120**  
Third parties, **3:2**

### SEC. 102(b)

Generally, **1:71; 3:96; 5:21; 5:77; 9:171; 13:122; 14:35; 14:44; 19:161; 23:48**  
Additional references can be used for anticipation rejection to show possession by public, **9:18**  
Analogous art, **19:7**  
Anticipation, **7:99; 9:18; 9:129; 21:73**  
Appeal, de novo review from PTO, **9:7**  
Applicability, **19:31**  
Complaint charging infringement of only certain claims, **19:31**  
Court's role, **19:31**  
Dates, obscuring, **2:1**  
De novo review from PTO, **9:7**  
Design patent, **20:32**  
Disclosure, **9:18**  
Enablement, **9:18**  
Evidence, **9:7; 9:18**  
Exception, supplier, **19:140**  
Exceptional case, **9:93**  
Experimental use, **7:12; 12:30**  
Fatal wound, staunching, **4:16**  
FRCP 41(b) motion, **19:31**  
Incorporation by reference, **1:101**  
Inequitable conduct, **9:7; 13:35; 21:73**  
Infringement, **19:31**  
Inventorship, **19:7**  
Law of the case doctrine, **19:31**  
Materiality, **13:35**  
Method performed by hand, **4:16**  
Motion, FRCP 41(b) motion, **19:31**  
Offer to sell, **18:8**  
Officers, **13:35**  
On-sale bar, **1:52; 2:7; 3:41; 4:16; 5:15; 5:64; 6:25; 8:127; 9:5; 9:7; 9:93; 9:118; 9:279; 10:1; 11:10; 11:25; 16:32; 19:7; 19:31; 19:54; 21:1; 21:16; 23:6**  
Patent applications not entitled to presumption of validity, **9:7**  
Personal liability, **13:35**  
Possession by public, **9:18**  
Presumption of validity, **9:7**

### SEC. 102(b)—Cont'd

Printed publication, **9:14; 9:18; 9:33; 12:89; 14:8; 16:25**  
Prior art, **9:46; 9:150**  
PTO, de novo review from, **9:7**  
Public, possession of, **9:18**  
Public use, **2:1; 2:45; 3:16; 8:23; 9:34; 9:75; 10:31; 13:35; 13:149; 20:14; 23:11**  
References, **9:18**  
Rejection, **9:18**  
Sec. 1.195, **6:57**  
Sec. 103, **2:1; 9:46**  
Sec. 262, **8:5**  
Skilled in art, failure by those, **9:18**  
Staunching the fatal wound, **4:16**  
Summary judgment, **1:2; 19:62**  
Supplier exception, **19:140**  
Technical paper, **13:11**  
Third persons, activities of, **19:7**  
Unfair competition, not, **3:16**  
Validity, **9:7**

### SEC. 102(c)

Anticipation, **5:65**

### SEC. 102(d)

Generally, **2:90**  
Filing date, **9:136**  
Policy, **9:136**  
Statutory bar, **9:136**

### SEC. 102(e)

Generally, **9:212**  
Actual commercial consequences, **19:41**  
Anticipation, **20:115**  
Commercial consequences, actual, **19:41**  
Damages, jury damages award, **19:41**  
Delay, **19:41**  
Different inventive entities sharing common inventor, **1:22**  
Disclosure of species anticipates generic claim, **9:28**  
Effective date, **9:110**  
Evidence before PTO on validity was material, **1:22**  
Jury damages award, **19:41**  
Laches, **19:41**  
Pioneer, **19:41**  
Presumption of validity, **1:22**  
Prosecution history estoppel, **19:41**

**SEC. 102(e)—Cont'd**

Provisional rejection, **9:110**  
 Sec. 103 provisional rejection practice,  
**9:110**  
 Secret prior art, **19:41**  
 Separate steps, **19:41**

**SEC. 102(f)**

Generally, **3:117; 9:471; 12:40; 15:11;**  
**16:50; 19:125**  
 Derivation of invention, **14:10**  
 Sec. 103, **15:11**

**SEC. 102(g)**

Generally, **3:59; 3:94; 5:77; 13:72;**  
**13:103; 18:63; 21:39**  
 Arguments, **5:2**  
 As a whole, **11:9**  
 Bad axiom, **11:9**  
 Claims construed same way, **11:9**  
 Companies, **14:7**  
 Corroboration of non-party inventors,  
**20:48**  
 Design around, **11:9**  
 Diligence irrelevant when not first to  
 conceive, **14:7; 16:148**  
 Foreign country, imported product  
 produced by process performed in,  
**19:10**  
 Heart of process invention, process is,  
**19:10**  
 Intent, **11:9**  
 In this country, **1:111**  
 Materiality, **11:9**  
 Necessary, when, **19:10**  
 Non-party inventors, corroboration of,  
**20:48**  
 Obviousness, **11:9; 20:126**  
 Ordinary skill, hypothetical person of,  
**11:9; 20:126**  
 People conceive, **14:7**  
 Performance, **19:10**  
 Prior art, **5:2; 20:126**  
 Prior invention, **9:158**  
 Priority, **26:11**  
 Process, **19:10**  
 Prosecution history, **5:2**  
 Reduction in practice in U.S., **19:10**  
 Reduction to practice, **6:83**  
 Same, claims construed same way, **11:9**  
 Sec. 103, **11:9**  
 Sec. 103 prior art, as, **5:2; 20:126**

**SEC. 102(g)—Cont'd**

Sec. 104, **19:10**  
 Secret prior art, **19:41**  
 Sufficient, **19:10**  
 Suppression or concealment, **16:9**  
 Tests, **19:10**  
 Third party invention, **14:7**  
 Utility for any purpose, **19:10**

**SEC. 102(g)(2)**

Generally, **13:103; 13:105; 18:63;**  
**19:132**  
 Prior inventor, **4:65**

**SEC. 103**

Amendment of 1984, **11:23**  
 Claim interpretation, **20:8**  
 Design patent, **9:8**  
 Mechanical misfit, **15:4**  
 Obviousness, **1:294; 3:168; 9:27; 9:62;**  
**9:103; 9:117; 9:139; 9:295;**  
**13:225; 15:4; 16:19; 23:84**  
 Physically combining references, **15:4**  
 Prima facie obviousness, **9:115**  
 Prior art, **5:2; 9:46**  
 PTO's burden to establish, **9:140**  
 References, **9:101; 15:4**  
 Rejection on single reference device  
 capable of being operated like  
 claimed apparatus, **9:101**  
 Sec. 102(b), **2:1**  
 Sec. 102(e), **9:110**  
 Sec. 102(f), **15:11**  
 Sec. 102(g), **11:9**

**SEC. 103(2)**

Prior art, exclusion of, **9:110**

**SEC. 104**

Foreign activity, **8:30**  
 Sec. 102(g), **19:10**

**SEC. 111**

Claims not in patent, **19:32**  
 Priority filing date, **19:32**

**SEC. 112**

Generally, **5:57; 11:8; 16:89**  
 Able to produce standard, **15:2**  
 Abstract ideas, **18:85**  
 Amend claims, **20:6**  
 Appealed, decisions are, **9:40**

## INDEX

### SEC. 112—Cont'd

Best mode, **1:161; 1:194; 2:14; 4:2; 5:16; 19:21; 19:60**  
Burden on patent challenger, **18:4**  
Challenger, burden on, **18:4**  
Chemical interference, **2:14**  
Claim construction and interpretation, **4:23; 9:40; 9:339; 20:6**  
Claim differentiation, **16:2**  
Claim language itself, **9:72**  
Claims too broadly written, **9:104**  
Clear and concise, **15:2**  
Competitor's product, to cover, **20:6**  
Continuation case, effective filing date of, **18:4**  
Corporate officer, **15:2**  
Damages, **8:7; 19:7**  
Date, effective filing date of continuation case, **18:4**  
Definiteness, **1:161; 8:103; 16:114; 19:4**  
Description, **9:46; 9:85; 18:4; 18:40; 20:6**  
Detail required, **19:7**  
Disclosure, **13:10**  
Distinctiveness, **12:28; 16:2; 19:26; 21:17**  
Doctrine of equivalents, distinct from, **16:2**  
Effective filing date of continuation case, **18:4**  
Enablement, **1:167; 1:304; 2:34; 3:14; 9:83; 13:56; 14:8; 17:1; 21:14; 23:8**  
English grammar, read with precepts of, **9:40**  
Equity powers, **19:4**  
Equivalents, **8:7; 11:10; 20:6**  
Evidence, **19:7; 19:125**  
Fact question, **8:7**  
Factual finding, **8:7**  
Filing date, **18:4; 23:11**  
Finding, factual, **8:7**  
Foreign references, ignorance of, **17:1**  
Functionality, construction, **2:154**  
Indefiniteness, **1:21; 1:44**  
Inequitable conduct, **8:7**  
Injunctive relief, **1:304; 19:4**  
Interference, **3:6; 3:28**  
Issue date, only as of issue date of patent, **9:53**

### SEC. 112—Cont'd

JNOV, **4:4**  
Jury, **17:1**  
Means-plus-function claims, **2:123; 16:11; 20:6; 23:63**  
Obviousness, **9:86**  
Only as of issue date of patent, **9:53**  
Opinions, not, **9:40**  
Overturn, easy, **19:7**  
Paragraphs 1, 2, 6 contrasted, **1:99**  
Personal liability, **15:2**  
Prima facie case of acquiescence in examiner's rejection for inadequate disclosure, **16:10**  
Procedural issue, **8:21**  
Records, failure to keep, **8:7**  
References, foreign references, ignorance of, **17:1**  
Sec. 101, **18:6**  
Sec. 120, **8:19**  
Single means claim, **9:40**  
Special verdict, **17:1**  
Statements out of context, improper to take, **9:86**  
Support, lack of, **9:86**  
Totality of circumstances, **15:2**  
Validity, claims construed to preserve, **20:6**  
Willful infringement, **15:2; 19:7**  
Written description, **1:252; 1:258; 8:101; 9:46; 18:4**

### SEC. 112(1)

Generally, **2:90; 5:69; 7:57; 9:189; 10:24; 12:73**  
Best mode, **7:34; 20:33; 23:19**  
Description, written, **1:200; 9:125; 9:130; 19:254; 22:7; 23:25**  
Disclosure, sufficiency of, **23:30**  
DNA, **18:40**  
Enablement, **6:20; 9:113; 9:115; 9:134; 9:142; 9:143; 13:55; 16:141; 19:51**  
Experiment, undue experimentation, **10:23**  
Indefiniteness, **3:54**  
Inherently present, **18:52**  
Mass production specifications, inventor not required to supply, **23:19**  
Sources and techniques, **23:19**  
Specification, **3:54; 23:19**

**SEC. 112(1)—Cont'd**

Undue experimentation, **10:23**  
 Utility, **9:165**  
 Written description, **1:200; 9:125;**  
**9:130; 19:254; 22:7; 23:25**

**SEC. 112(2)**

Generally, **5:58; 9:189; 15:20; 19:131**  
 Certainty and definiteness, **5:106**  
 Clam indefiniteness, **2:45**  
 Definiteness, **3:37; 14:66; 14:72**  
 Evidence beyond specification, **19:125**  
 Indefiniteness, **13:55; 14:12**  
 Need to particularly point out and  
 distinctly claim, **9:149**  
 Review, standard of, **9:240**  
 Specification, evidence beyond  
 specification, **19:125**

**SEC. 112(6)**

Generally, **1:130; 9:130; 9:189; 12:66;**  
**13:111; 19:131; 20:59**  
 Argument, **10:7**  
 Claim construction, means-plus-function  
 claim, **6:81; 23:79**  
 Claim differentiation doctrine versus,  
**12:26**  
 Claim interpretation, prior art, effect on,  
**11:28**  
 Corresponding structure, **14:38; 14:56**  
 Doctrine of equivalents distinguished,  
**9:149**  
 Infringement, **9:215; 16:51**  
 Interpretation of means-plus-function  
 claim limitation, **22:10**  
 Limitations and restrictions, **9:149;**  
**22:10**  
 Means-plus-function, **1:51; 3:37; 6:81;**  
**9:131; 9:149; 10:7; 10:13; 14:56;**  
**14:66; 18:107; 19:59; 22:10;**  
**23:79**  
 Prior art, **1:91; 9:118; 11:28**

**SEC. 116**

Generally, **16:50; 19:102**  
 Amendment of 1984, **11:23**  
 Claim broadened if broader in any  
 respect, **9:3**  
 Claim interpretation, **19:15**  
 Inventorship, **8:115**  
 Joint inventorship, **2:48; 22:39**  
 Purpose of reissue statute, **9:3**

**SEC. 116—Cont'd**

Reissue, purpose of reissue statute, **9:3**  
 Sec. 256, **9:3**

**SEC. 117**

Generally, **23:57**

**SEC. 119**

Acting on behalf of, **2:125**  
 Activity outside U.S., **19:144**  
 Benefit of filing date of foreign priority  
 application, **9:143**  
 Foreign countries, **6:66; 9:143; 19:144**  
 Sec. 120, **9:28**

**SEC. 120**

Generally, **2:90; 5:20; 9:205; 9:243;**  
**13:193; 18:52**  
 Amendments, **8:19**  
 Application, **8:19; 12:10**  
 Benefit of earlier filing date, **12:99;**  
**20:33**  
 Best mode, **8:19**  
 Chain of related applications, **12:10**  
 CIP, **9:73**  
 Computer, **8:19**  
 Constructive reduction to practice, **9:13**  
 Disclosure, sufficiency of, **11:8**  
 Earlier filing date, **2:142; 5:104; 12:99;**  
**18:85; 20:33; 20:88; 26:12**  
 Election of species, **12:10**  
 Entitlement to earlier filing date, **11:8**  
 Filing date, **11:8; 20:33**  
 Incorporation by reference, **4:122;**  
**26:12**  
 Inherent property, **11:8**  
 Parent application, **8:19**  
 Pioneer, **8:19**  
 Post-invention technology, **8:19**  
 Prosecution history estoppel, **8:19**  
 Reduction to practice, constructive, **9:13**  
 Related applications, chain of, **12:10**  
 Sec. 112, **8:19**  
 Sec. 119, **9:28**  
 Sec. 121, **18:1**  
 Serve different functions, **8:19**  
 Species, election of species, **12:10**  
 Submit claims, failure to, **2:68**

**SEC. 121**

Clear demarcation required, **7:75**  
 Double patenting, **7:115**

## INDEX

### **SEC. 121—Cont'd**

- Markush claim rejection, **9:105**
- Obviousness-type double patenting, **19:59**
- Reissue, **7:115**
- Restriction, requirement for, **2:140; 7:16; 16:112**
- Sec. 120, **18:1**

### **SEC. 121(1)**

- Generally, **1:80**

### **SEC. 121(2)**

- Generally, **1:80**

### **SEC. 121(3)**

- Generally, **1:80**

### **SEC. 121(4)**

- Generally, **1:80**

### **SEC. 122(a)**

- Special circumstances exception, **8:135**

### **SEC. 131**

- Conception, **9:407**
- Reduction to practice, **9:407**

### **SEC. 132**

- Generally, **20:59**
- New matter, **2:34**
- Rejection, reasons for, **3:32**

### **SEC. 135(a)**

- Board can decide both priority and patentability, **9:116**

### **SEC. 135(b)**

- Generally, **1:107; 2:93; 9:198**
- Interference, **1:219; 1:220**
- Sec. 1.601(c), **9:240**

### **SEC. 135(c)**

- Certiorari possibility, **3:29**
- Interference settlement agreement, failure to file, **3:29**

### **SEC. 136**

- Interference, **4:27**

### **SEC. 141**

- Generally, **13:115**
- Appeal and review, **9:59; 16:173; 22:44**
- District court, **6:9**
- Estoppel, **2:165**
- Interference, **2:165**

### **SEC. 141—Cont'd**

- Removal procedure, **9:116**
- Sec. 146, **2:165; 9:116**

### **SEC. 142**

- Appellate review, no restriction on scope of, **9:59**

### **SEC. 143**

- Appellate review, no restriction on scope of, **9:59**
- Brief required, **9:116**

### **SEC. 144**

- Appellate review, no restriction on scope of, **9:59**

### **SEC. 145**

- Generally, **13:115; 14:92**
- Admissibility of evidence, **8:111**
- Appeal and review, **6:9; 9:59**
- Assessment of costs on appeal, **14:4**
- Attorneys fees, **8:162; 14:80**
- CAFC, **6:9**
- Costs of action imposed on patentee, **10:16**
- Costs on appeal, assessment of, **14:4**
- Crediting expert, **7:9**
- De novo determination, **14:4**
- Direct appeal, **6:9**
- Disclosure, reject, **7:9**
- Enablement, **7:9**
- Expert, crediting, **7:9**
- How to do it, **7:9**
- Jurisdiction, **9:394**
- Law question, **7:9**
- New evidence, **7:9; 8:118; 11:68**
- Previously done, something not, **7:9**
- Reject disclosure of how to do it, improper to, **7:9**
- Review, standard of, **13:115**
- Sec. 146 actions, **20:11; 20:125**
- Skilled at time of invention, **7:9**
- Standing, **2:18**

### **SEC. 146**

- Generally, **23:44; 23:52**
- Estoppel, **2:165**
- Interference, **1:42; 2:165; 3:6; 3:53; 7:26**
- Review, standard of, **20:125; 23:52**
- Sec. 141, **2:165; 9:116**
- Sec. 145, **20:11; 20:125**

- SEC. 151**  
 Generally, **4:52**
- SEC. 153**  
 Issue date, whether patent was validly issued on, **5:17**
- SEC. 154**  
 Generally, **4:106**
- SEC. 154(b)**  
 Patent term adjustment, **23:69**
- SEC. 156**  
 Generally, **2:187; 8:61; 13:120**  
 Ambiguity, **21:6**  
 Congress, policy for, not courts, **6:3**  
 Extension of patent term, **21:6**  
 Patent term extension, **21:6**  
 Plain meaning rule, **6:3**  
 Statutory construction and interpretation, **6:3; 21:6**  
 Summary judgment, **1:139**  
 Term, extension of, **6:3**  
 Terminal disclaimers, **13:144**
- SEC. 156(a)**  
 Generally, **3:72**
- SEC. 156(a)(4)**  
 Extension of term, **16:125**  
 Patent term extension, **8:25; 15:35**
- SEC. 156(d)(1)**  
 Generally, **1:74**
- SEC. 156(e)(2)**  
 Patent term extension, **19:197**
- SEC. 156(f)**  
 Generally, **13:120**  
 Extension of term, **16:125**
- SEC. 156(g)**  
 Patent term extension, **23:70**
- SEC. 161**  
 Plant patents, **9:355**
- SEC. 171**  
 Aesthetics determination, **9:73**  
 Complete articles, not limited to designs for, **9:73**  
 Design, **9:73; 9:106**  
 Differences, whether are significant, **9:73**
- SEC. 171—Cont'd**  
 Limitations, **9:73**  
 Obviousness, **9:73**  
 Same, designs same, **9:73**
- SEC. 172(b)**  
 Inducing infringement, **26:2**
- SEC. 183**  
 Use of invention, **8:117**
- SEC. 207(a)(2)**  
 Government as necessary party to suit by its exclusive licensee, **14:9**
- SEC. 210.30**  
 Generally, **7:52**
- SEC. 210.36**  
 Generally, **7:52**
- SEC. 211.54(a)**  
 ITC, **1:15**
- SEC. 236**  
 Generally, **16:50**
- SEC. 251**  
 Generally, **8:64**  
 Broadening reissue, **1:52**  
 Compelling patentee to seek no defect reissue, **7:21**  
 Reissue, **2:4; 7:21; 8:12; 9:69; 9:84; 9:85; 9:105; 9:138; 19:51**  
 Sec. 255, versus, **19:142**
- SEC. 252**  
 Discretion of trial court, **19:4**  
 Enhanced damages, **21:3**  
 Evidence not considered de novo, **19:4**  
 Expert witnesses, **19:4**  
 Reexamination, **12:25**  
 Reissue, **19:4; 19:13; 19:55; 23:26**  
 Sec. 255, versus, **19:142**  
 Summary judgment, **8:17**
- SEC. 252(2)**  
 Reissue patent, **2:40**
- SEC. 254**  
 Generally, **7:87; 14:39**  
 Certificate of correction, **19:56**
- SEC. 255**  
 Generally, **6:44; 14:39**

## INDEX

### **SEC. 255—Cont'd**

- Clerical or typographical mistake, **19:142**
- Sec. 251 versus, **19:142**
- Sec. 252 versus, **19:142**

### **SEC. 256**

- Generally, **6:35; 6:44; 19:102; 23:55**
- Correction of inventorship, **16:131**
- Joint inventors, **22:54**
- Sec. 1.48, **19:76**
- Sec. 116, **9:3**

### **SEC. 261**

- Federal law, **18:58**
- Patent property, **10:4**
- Validity, patent not to be found valid, **10:4**

### **SEC. 262**

- Enforcement and enforceability, **19:264**
- Joint inventor's freedom to license, **8:5**
- License, joint inventor's freedom to, **8:5**
- Public use, **8:5**
- Sec. 102(b), **8:5**

### **SEC. 263**

- Each claim must be evaluated, **15:6**

### **SEC. 271**

- Generally, **9:268**
- Sale of plant embodying patented process not sale of invention, **10:17**

### **SEC. 271(a)**

- Generally, **14:47**
- Damages, **1:270; 3:180; 8:138**
- Divided infringement, **1:270**
- Exceptional case, **3:180**
- Extraterritorial activities, **13:135**
- Inducement, **19:322**
- Infringement, testing, **23:53**
- Invalidity, **3:180**
- Laches or delay, **3:180**
- Method claim, **1:269**
- Offer for sale, **18:54; 20:46; 20:103**
- Process, **18:79**
- Sale, **3:180; 8:138**
- Sec. 271(e), **18:18**

### **SEC. 271(b)**

- Generally, **13:122; 13:136; 19:92; 20:54**

### **SEC. 271(b)—Cont'd**

- Inducing infringement, **7:103; 8:24; 11:60; 16:22**
- Knowingly, **13:124**

### **SEC. 271(c)**

- Contempt, **16:25**
- Contributory infringement, **6:23; 18:79**
- Damages, **20:23**
- Inducing infringement, **8:24**

### **SEC. 271(d)(5)**

- Generally, **21:51**

### **SEC. 271(e)**

- Infringement, **6:65**
- Sec. 271(a), **18:18**

### **SEC. 271(e)(1)**

- Generally, **1:85**
- Abuse of discretion, **5:3**
- Appealability, **5:13**
- DPCA, **20:26**
- Drugs, restricted to drugs alone, not, **5:3**
- FDCA, **3:182**
- Findings, new judgment as negating, **5:13**
- Generic drugs, **3:159**
- Infringement, **5:13**
- Injunction, **5:3; 5:13**
- International Trade Commission, **1:184**
- Law of the case, **13:206**
- Medical devices, infringement exception for, **5:13; 16:117**
- New judgment as negating prior findings, **5:13**
- Permanent injunction, when proper, **5:13**
- Pre-clinical research, **9:251**
- Premarketing approval of generic drugs, **3:159**
- Research, pre-clinical, **9:251**
- Research tool exception, **9:299**
- Restricted to drugs alone, not, **5:3**
- Reviewed under abuse of discretion standard, **5:3**
- Safe harbor for drug products, **1:175; 16:117**
- Sec. 271(g), **13:206**
- Threat of sale, **5:13**
- Willful contempt order, **5:13**

**SEC. 271(e)(2)**  
 Generally, **1:128; 7:55; 7:69; 20:78**

**SEC. 271(e)(2)(A)**  
 Generally, **2:74; 7:55; 13:137; 14:33**  
 Abbreviated new drug application,  
**9:312**

**SEC. 271(e)(4)**  
 Generally, **1:128; 7:81**

**SEC. 271(f)**  
 Generally, **5:77; 18:54**  
 Combination, Sec. 271(f)(2), **16:141; 23:53**  
 “Component” of patented invention,  
**1:146**  
 Damages, **23:82**  
 Lost profits, **23:82**  
 Outside United States, **21:52**  
 Standing, **23:82**

**SEC. 271(f)(1)**  
 Generally, **16:83**

**SEC. 271(f)(2)**  
 Actual combination, not require, **23:53**  
 Extraterritoriality, **23:93**

**SEC. 271(g)**  
 Generally, **1:102; 2:60; 11:54**  
 Importation, prohibits, **2:80**  
 Inducement, **19:322**  
 Infringement, when, **13:105**  
 Law of the case, **13:206**  
 Process patented, product which is made  
 by, **2:97**  
 Sec. 271(e)(1), **13:206**

**SEC. 272**  
 Generally, **14:41**

**SEC. 281**  
 Generally, **1:68**  
 Patentee’s civil action for infringement,  
**1:222**  
 Standing, **4:116**

**SEC. 282**  
 Born valid, patents are, **6:10**  
 Burden of proof, **9:80**  
 Cited art considered by PTO, **12:6**  
 Combination, **18:6**  
 Combination of old elements, **6:10**  
 Congress, intent as clear, **12:5**

**SEC. 282—Cont’d**  
 Defenses available, **16:50**  
 Disclosure, statutory outer limits, **23:76**  
 Each claim treated independently, **13:55**  
 Elements, combination of, **6:10**  
 Equivalency finding, **18:6**  
 Experiment, failed, **6:10**  
 Fraud, **8:23**  
 Independently, each claim treated, **13:55**  
 Inequitable conduct, **8:23**  
 Intent of Congress is clear, **12:5**  
 Inventor’s admission of invention by  
 another, **1:8**  
 ITC, **19:25**  
 Notice and knowledge, **1:92; 5:1; 20:15**  
 Objective, **6:10**  
 Obviousness, **1:4**  
 Only God works from nothing, **6:10**  
 Presumption, **6:10; 8:23; 9:21; 9:57;**  
**9:80; 12:6; 13:87; 16:4; 18:6**  
 Prior art, not, **6:10**  
 Procedural presumption, **6:10**  
 PTO, cited art considered by, **12:6**  
 Public interest not involved, **12:5**  
 Raised or waived, **4:58**  
 Reexamination, **9:80**  
 Reference, failure to notice, **5:1**  
 Review, standard of, **18:6**  
 Secondary considerations, **6:10**  
 Statutory construction, **12:5**  
 30-day notice, **20:15**  
 Valid, patent born valid, **12:5**  
 Validity  
     generally, **6:10**  
     presumption of, **9:21; 9:57; 9:80;**  
     **12:6; 13:87; 18:6**  
     reexamination, **9:80**  
 Waived or raised, **4:58**  
 Waiver, **20:15**

**SEC. 283**  
 Generally, **10:23**  
 Contempt, **11:17**  
 Discretion of court, **18:18**  
 Injunction, **10:17; 18:18**  
 Issuance of injunction is discretionary,  
**18:18**

**SEC. 284**  
 Generally, **3:96; 10:21; 13:72; 13:79;**  
**19:92; 21:23**

## INDEX

### SEC. 284—Cont'd

Anticipation, **16:167**  
Convoyed sales, **2:31**  
Cost savings, estimated cost savings, **8:4**  
Damages, generally, **2:31; 4:6; 4:7; 8:4; 11:21; 12:4; 13:157; 19:29; 19:35; 19:53; 20:23**  
Design patent, **3:98**  
Enhanced damages, **1:62; 2:30; 2:40; 8:123; 18:29**  
Estimated cost savings, **8:4**  
Exclusive vendor as co-plaintiff, damages, **11:18**  
Hypothetical negotiation, **1:296**  
Infringement, willful, **4:32; 7:27**  
JNOV, **23:4**  
Judge, assignment of different, **2:31**  
Lost profits, **2:31**  
Marking statute, **14:24**  
Nominal damages, **12:24**  
Precision, not ascertainable with, **2:30**  
Prejudgment interest, **4:7**  
Public use, **16:167**  
Reasonable royalty, **2:6**  
Records, failure to keep, **2:30**  
Remanded cases, **2:31**  
Sanctions, **2:31**  
Sec. 285, **18:22**  
Sec. 1927, **2:31**  
Settlement agreement, breach of, **7:54**  
Validity, **16:167**  
Weight and credibility of evidence, **2:31**  
Willful infringement, **4:32; 5:19; 7:12; 7:27; 8:123; 19:57**

### SEC. 285

Generally, **2:55; 3:221; 5:155; 6:53; 7:57; 7:114; 9:266; 11:10; 13:72; 15:60; 15:62; 19:311**  
Abuse of discretion, **2:170; 7:20**  
Appeal, award of attorney fees on, **4:16**  
Attorneys' fees, **2:170; 3:42; 3:196; 4:16; 4:32; 5:137; 7:20; 7:27; 8:18; 8:38; 8:130; 12:4; 13:38; 16:5; 18:121; 18:123; 19:3; 19:33; 19:35; 19:51; 19:58; 19:313; 23:6**  
Choice of law, **23:57**  
Claim construction, **1:5; 19:320**  
Dismissal of action, **3:42; 19:200**  
Estoppel, **19:320**

### SEC. 285—Cont'd

Exceptional case, **1:299; 2:9; 2:33; 5:14; 5:109; 5:151; 6:13; 8:130; 9:316; 13:2; 13:175; 14:88; 15:3; 15:45; 19:52; 19:269; 20:151; 21:75**  
Experimental use, **5:137**  
Expert's report, **5:14**  
Fraud, exceptional case for reasons other than, **15:3**  
Inequitable conduct, **5:137; 16:59; 18:43**  
Inference drawn from party's failure to offer its expert's report, **5:14**  
Infringement, **2:170; 3:42; 7:20**  
Intent, **5:14**  
Jury trial, **1:300**  
Maintenance fees, **9:470**  
Notice and knowledge, **5:14**  
On-sale bar, **5:137**  
Purpose, **2:27**  
Sanctions, **19:57**  
Sec. 101, **9:455**  
Sec. 284, **18:22**  
Settlement agreement, breach of, **7:54**  
Should have known, **5:14**  
Willful infringement, **1:201; 2:170; 7:20; 15:6; 19:28**  
Willfulness, **2:34**

### SEC. 286

Damages, **1:47**  
Future acts of others, **19:27**  
Liability arises when acts are committed, **19:27**  
Limitation of actions, **19:27**  
Statute of limitations, not, **1:48**  
Third persons, future acts of others, **19:27**

### SEC. 287

Bifurcation, **4:12**  
Damages-notice, **4:12**  
Documents not marked, **4:12**  
Error harmless where no evidentiary basis for contrary verdict, **4:12**  
Excludable, **4:12**  
Implied license, **4:12**  
Marking, **4:12; 8:4; 13:33**  
Notice and knowledge, **2:6; 4:12; 7:92; 13:33**  
Patent marking notice, **13:33**

**SEC. 287—Cont'd**

Practice, **4:12**  
 Process, marking not necessary for, **8:4**  
 Same concepts, **13:33**  
 Same phrases, **13:33**

**SEC. 287(a)**

Generally, **12:58; 13:75**  
 Actual notice requirement, **21:53**  
 Method or process, not applying to, **3:96**  
 Patent marking, **1:58; 1:62**  
 Process or method, not applying to, **3:96**

**SEC. 287(b)(5)**

Letters to customers as infringement threats, **13:41**

**SEC. 289**

Damages, **14:77; 19:293**  
 Marking statute, **14:24**  
 Profits, **2:33**

**SEC. 291**

Change of circumstances, not defeated by, **1:11**  
 Claim construction, **1:5**  
 Federal question jurisdiction, **1:11**  
 Interference, **19:149**  
 Interfering patents, **1:11; 7:102; 11:23**  
 Oral findings sufficient, **1:11**  
 Subject-matter jurisdiction, lack of, **1:11**

**SEC. 292**

Generally, **3:118**  
 Constitutionality of AIA elimination of qui tam provision, **2:151; 3:195**  
 False patent marking, **1:23; 3:118; 9:329; 12:23; 19:224; 19:262**  
 Per article interpretation, **6:72**

**SEC. 295**

Generally, **14:31**  
 Product by process, **14:31**

**SEC. 303**

Constitutionality of procedures, **16:8**

**SEC. 304**

Reexamination in subsequent litigation, effect of, **19:46**  
 Sec. 305, **19:46**

**SEC. 305**

Reexamination, **9:151; 16:115**  
 Sec. 304, **19:46**

**SEC. 314(d)**

Appeal dismissal, **2:180**  
 Jurisdiction to review, **9:425**  
 Obviousness, **9:418**  
 Scope of review, **9:418; 13:236; 19:260**  
 Standard of review, **9:418**

**SEC. 315(b)**

Inter partes review, **1:324**  
 Real party in interest, **1:324**

**SEC. 315(c)**

Generally, **13:240**

**SEC. 316(a)(3)**

Inter partes review, **21:74**

**SEC. 329**

Covered business method review, **7:117**

**SEC. 335B(a)(1)**

Generally, **2:74**

**SEC. 337**

Generally, **19:106; 19:176; 19:177**  
 Appellate function, **3:23**  
 Commission findings, **3:23**  
 Contributory infringement, **19:222**  
 Defined, substantial evidence, **3:23**  
 Exclusion orders, **3:23; 25:9; 25:10**  
 Imports, exclusion order against, **3:23**  
 Infringement, no injury despite, **3:23**  
 Injunctions, **19:222**  
 Inventor's admission of invention by another, **1:8**  
 ITC, **1:15; 2:12; 3:23; 5:98; 12:5; 18:26; 19:25; 20:105; 21:64**  
 No injury despite patent infringement, **3:23**  
 Purpose, **3:23**  
 Res judicata, not, **3:23**  
 Substantial evidence, **3:23**

**SEC. 337(a)**

Generally, **13:107**  
 ITC, **1:39**

**SEC. 337(c)**

ITC, **6:14**

**SEC. 355(j)**

Generally, **1:128**

**SEC. 355(j)(2)**

Generally, **1:128**

## INDEX

- SEC. 355(j)(2)(A)(vii)**  
Generally, **1:128**
- SEC. 355(j)(2)(A)(viii)**  
Generally, **1:128**
- SEC. 355(j)(5)(B)(iii)(iii)**  
Generally, **13:107**
- SEC. 455**  
Judge disqualification, **8:14**  
Sanctions reserved for matters more serious than mere oversight, **8:14**  
Statute is self-enforcing and self-executing, **1:65**
- SEC. 455(a)**  
Motion to disqualify trial judge, **8:12**
- SEC. 553**  
APA, **1:45**
- SEC. 703(c)**  
APA, **13:51**
- SEC. 706(2)**  
APA, **13:50**
- SEC. 1117(a)**  
Attorneys' fees, **18:121**
- SEC. 1267**  
Supplemental jurisdiction, **7:25**
- SEC. 1291**  
Increasing supersedeas bond, **19:42**
- SEC. 1292**  
Appellate jurisdiction, lack of, **1:31**
- SEC. 1292(a)(1)**  
Appealability, **18:11; 23:13**  
Beginning of patent term, needed more at, **23:13**  
Continue, evidence that status quo can, **23:13**  
Evidence that status quo can continue, **23:13**  
Immediately appealable interlocutory order denying injunction, **23:13**  
Injunctive relief, **16:116; 23:13**  
Interlocutory order, **18:16; 23:13**  
Jurisdiction, **14:6**  
Preliminary injunction, failure to seek, **23:13**
- SEC. 1292(b)**  
Generally, **21:41**  
Appeal from interlocutory order, **9:97**  
Interlocutory appeal, **10:43; 14:9**  
Interlocutory order, appeal from, **9:97**  
Sec. 1292(c) certification, **17:3**
- SEC. 1292(c)**  
Sec. 1292(b), **17:3**
- SEC. 1292(c)(1)**  
CAFC has exclusive jurisdiction of appeals involving preliminary injunctions in patent cases, **5:8**  
Federal patent policy, **6:17**  
Sec. 1292(a), **16:116**
- SEC. 1292(c)(2)**  
Appeal, interlocutory appeal, **9:6**  
Appealability of interlocutory order, **10:12**  
Appealable judgment, **13:5**  
Attorney, sanctioning counsel, **9:6**  
Final judgment, **13:8**  
Interlocutory appeal, **9:6; 13:61**  
Interlocutory order, appealability of, **10:12**  
Sanctioning counsel, **9:6**
- SEC. 1292(d)(2)**  
Escrow, **3:21**
- SEC. 1337**  
Generally, **16:51**  
ITC, **3:154; 25:2**
- SEC. 1337(a)**  
Imported drug products, **1:175**
- SEC. 1337(c)**  
Generally, **11:54**  
ITC, **8:28**
- SEC. 1337(d)**  
ITC, **8:28**  
Limited exclusion order, **11:60**
- SEC. 1337(e)**  
ITC, **8:28**
- SEC. 1338**  
Generally, **22:5**  
Arising under jurisdiction, **3:14**  
Subject matter jurisdiction, **1:49; 11:20**

- SEC. 1338(a)**  
 Antitrust claim, **21:13**  
 Arising under subject matter jurisdiction of distinct court, **1:53**  
 Jurisdiction, **1:160; 4:22; 4:92**  
 Subject matter jurisdiction, **1:7; 5:17**
- SEC. 1338(b)**  
 Dismissal for lack of subject matter jurisdiction, **13:58**
- SEC. 1346(b)**  
 Interference, **3:6**
- SEC. 1355**  
 Generally, **19:106**
- SEC. 1367**  
 Supplemental jurisdiction, **8:97; 13:58; 14:82; 22:36**
- SEC. 1391(c)**  
 Sec. 1400(b), **22:6**
- SEC. 1400(b)**  
 Assuming control of litigation does not waive venue, **9:11**  
 Sec. 1391(c), **22:6**  
 Venue, **9:11; 9:445**  
 Waiver, **9:11**
- SEC. 1406(a)**  
 Venue, **9:447**
- SEC. 1407(a)**  
 Judicial Panel on Multi-District Litigation (JPMDL), **7:6**
- SEC. 1447**  
 Assignor estoppel, **6:96; 22:46**
- SEC. 1491**  
 Limited to claim court, **20:16**
- SEC. 1498**  
 Generally, **7:47; 15:4**  
 Claims court, **16:38**  
 Damages, **13:35**  
 Each claim element essential, **12:11**  
 FRCP 41(a)(1)(B), **1:279**  
 Government, acting by or for, **9:398; 20:18**  
 Inducement, **1:279**  
 Lost profits, **13:35**  
 Paramount, **20:16**  
 Prosecution history, **12:11**
- SEC. 1498—Cont'd**  
 Relevant, always, **12:11**  
 Relevant art field, **15:4**  
 Sales to government, **13:35**  
 Same burden, **12:11**  
 Skill, level of, **15:4**
- SEC. 1498(a)**  
 Generally, **8:56; 13:109**
- SEC. 1500**  
 Subject matter jurisdiction, **21:15**
- SEC. 1631**  
 Counterclaims, **19:2**  
 Defenses, **19:2**  
 Dismiss or transfer, **19:2**  
 License agreement, suit for royalties due under, **19:2**
- SEC. 1651**  
 All Writs Act, **9:157**  
 CAFC jurisdiction over JPML consolidation order, **9:128**  
 Interest of justice, **3:14**  
 Mandamus, **2:2; 9:41; 9:54; 9:68; 9:71; 9:76**
- SEC. 1657(b)**  
 Generally, **2:96**
- SEC. 1659**  
 Stay, **9:292**
- SEC. 1782**  
 Generally, **9:193**  
 Mandamus, **9:406**
- SEC. 1821(b)**  
 Limitation on award of expert witness fees, **1:62**
- SEC. 1927**  
 Generally, **7:126**  
 Comply with court rules, failure to, **10:10**  
 FRAP, **1:41**  
 Sec. 284, **2:31**
- SEC. 1961(a)**  
 Post-judgment interest, **7:27**
- SEC. 2201**  
 Declaratory judgment, **7:25; 9:89; 9:92; 10:6; 12:23; 13:41; 19:22; 19:55; 23:9**

## INDEX

### **SEC. 2201—Cont'd**

Dismissal, **7:25; 13:41**

### **SEC. 2201(a)**

Generally, **19:81**

### **SEC. 2412(b)**

Costs and attorney fees award against government in Claims Court, **13:48**

### **SEC. 2501**

Generally, **2:53**

### **SEC. 2516(a)**

Generally, **19:83**

### **SEC. 2568(a)**

Generally, **19:173**

### **SEC. 7703**

APA, **2:32**

### **SEC. 7703(c)**

APA, **8:31; 11:26**

## **SECOND ACTION**

Claim preclusion, **8:76**

## **SECONDARY**

Objective, **19:19**

## **SECONDARY CONSIDERATIONS**

Generally, **1:87; 2:59; 13:253; 16:48**

Afterthought, **9:82**

Anticipation definition, **4:15**

Appeal, theory raised for first time on, **9:82**

CCPA decisions, **9:74**

Commercial success, **3:41; 9:82; 9:331**

Cross-appeal to reverse validity or infringement component of judgment, **18:2**

Description, **6:99**

Due entirely to improvements and modifications made by others, **9:82**

Evidence, **13:17; 13:45**

Exclusion, **13:17**

Expectation, unexpected result, **16:4**

Function of patent claims, **9:82**

Improvements, **9:82**

Inequitable conduct, **4:10; 11:4**

Instructions, **13:17**

Means-plus-function claims, **13:17**

Modification, **9:82**

## **SECONDARY CONSIDERATIONS**

### **—Cont'd**

Must always be considered when present, **9:82**

Must be considered, **9:70**

Neutral factor, absence of, **13:17**

New prior art not considered by PTO, **5:11**

Nexus, **9:168; 9:331; 16:49; 19:36**

Nonparty's motion to quash discovery subpoena, **20:17**

Object, failure to, **13:17**

Objective indicia, **14:2**

Obviousness, **3:175; 3:190; 5:131; 6:99; 8:153; 9:331; 13:45; 16:4; 16:168; 18:15; 19:11; 21:8; 23:66**

Prior art, invention need not be superior to, **4:10**

Raising issues, **9:82**

Review, standard of, **9:207; 19:12**

Sec. 282, **6:10**

Settlement evidence excluded, **13:17**

Summary judgment, **3:1; 8:14; 21:7**

Theory raised for first time on appeal, **9:82**

Third persons, **9:82**

Unexpected results, **12:13; 16:4**

Valid, inappropriate to declare, **4:19**

Weight given thereto, **18:28**

## **SECOND BITE AT APPLE**

Generally, **12:31**

## **SECOND PROCEEDING**

Collateral estoppel, **7:65**

## **SECRET COMMERCIAL USE**

Public use bar, **11:12**

## **SECRET PRIOR ART**

Sec. 102(e) v. sec. 102(g), **19:41**

## **SEIZURE**

Enforcement order, **4:20**

## **SELECTION OF TRANSFEREE FORUM**

Relevant factors, **9:128**

## **SELF-EXECUTING STATUTES**

Due process, **18:33**

## **SELF-INITIATED INVESTIGATION**

ITC decision, **2:17**

**SEMICONDUCTOR CHIP**

Foundry arrangement, **9:145**

**SEMICONDUCTOR CHIP PROTECTION ACT (SCPA)**

Mask works, **2:34**

**SENIOR PARTY**

Interference, **2:96; 15:1**  
Remand, when appropriate, **2:26**  
Testimony, right to stand on its position and take no, **2:47**

**SENIOR SCIENTIST**

Test results, **8:30**

**“SEPARATE”**

Appellate jurisdiction, lack of, **1:31**  
Argued, claims not, **9:119**  
Argued separately, **9:30; 9:173**  
Claim differentiation doctrine, **1:92**  
Compound and its properties are inseparable, **9:103**  
Dependent claims not separately argued on appeal, **9:100**  
Doctrine of equivalents, **7:77**  
Double patenting, **7:22**  
Each claim, **10:8**  
Equivalence, **6:42**  
FRCP 79(a), **5:45**  
Inequitable conduct, **7:1**  
Infringement, **8:52**  
Laches, **19:76**  
Mandamus, **9:41**  
Materiality, **4:72**  
Obviousness, **18:23**  
Sec. 1.192(c), **9:154**  
Sec. 102(e) v. sec. 102(g), **19:41**  
Stand or fall together, claims not argued separately, **9:117**  
Statutory construction, **1:72**  
Statutory interpretation, **8:43**  
Treated separately, **16:25**

**SEPARATION OF POWERS**

Generally, **1:376**

**SEQUOIA TECHNOLOGY, LLC V. DELL, INC.**

2023, **19:348**

**SERIES OF LEGAL PROCEEDINGS**

Sham litigation, **5:108**

**SERIOUS QUESTION**

Preliminary injunction, **1:40**

**SET ASIDE**

FRCP 60(b), **6:22**  
Jury verdict, **3:173; 14:47**  
New evidence introduced, **6:9**

**SETTLEMENT AND SETTLEMENT AGREEMENT**

Generally, **19:1; 19:326; 20:80**  
Antitrusts, **9:309**  
Attorney, disqualification of counsel, **19:40**  
Bad faith not requirement for breach thereto, **12:39**  
Breach thereof, **7:54**  
Choice of law, **1:100; 7:54; 16:99**  
Complaint dismissed for mootness, **19:14**  
Contracts, **3:107**  
Discovery, settlement negotiation privilege, **9:362**  
Disqualification of counsel, **19:40**  
Enforcement thereof, **2:138; 8:48; 9:159**  
FRAP 38, **19:1**  
Frauds, Statute of, **19:40**  
Frivolous appeal, **19:1**  
Infringement, **16:40**  
Interpretation, **10:9**  
Joint motion to vacate judgments below, **21:22**  
Judgment, joint motion to vacate, **21:22**  
Judicial estoppel, **23:21**  
Jurisdiction, **7:54**  
Lear distinguished, **8:11**  
Mootness, **11:23**  
Motion, joint motion to vacate judgments below, **21:22**  
Partial settlement may moot appeal, **7:8**  
Professional conduct, local bar standards of, **19:40**  
Refusal to engage in settlement negotiations, **15:37**  
Reverse settlement, **6:87**  
Sec. 284, **7:54**  
Sec. 285, **7:54**  
Secondary considerations, **13:17**  
Vacation, **21:22**

## INDEX

### SEVENTH AMENDMENT

Jury trial, right to, **1:58; 3:71; 9:170; 13:64; 13:74; 16:8; 19:195**

### SEVERAL COMMON MEANINGS

Claim interpretation, **9:246**

### SEVERAL PATENTS, ONE OF

Inequitable conduct, **12:3**

### SEVERANCE

Mandamus, **9:359**

### SEVERE REMEDY

Civil contempt, **13:1**

### SEXUALLY REPRODUCED VARIETY

Plant Variety Protection Act (PVPA), **9:162**

### SHAM LITIGATION

Generally, **3:83; 14:25**  
Affidavit doctrine, **17:12**  
Inequitable conduct, **8:98**  
Offer for sale, **17:12**  
Series of legal proceedings, **5:108**  
Two-tiered test, **6:27**  
Winning lawsuit, **21:24**

### SHOP RIGHTS

Generally, **12:27**  
Totality of circumstances evaluated, **13:52**

### SHOULD HAVE KNOWN

Sec. 285, **5:14**

### SHOWING OF NONOBVIOUSNESS

Chemical cases, **9:44**  
Expectation, unexpected results, **9:44**  
Independent evidence of nonobviousness, **13:185**  
Relative effectiveness, **9:44**

### SIERRA WIRELESS, ULC V. SISVEL S.P.A.

2025, **19:359**

### SIGNAL CLAIMS

Patentable subject matter, **9:290**

### SIGNIFICANCE

Developments occurring after filing date, **9:142**

### SIGRAY, INC. V. CARL ZEISS X-RAY MICROSCOPY, INC.

2025, **19:360**

### SILENCE

Copying, **1:48**  
Statutory construction, **6:24**

### SIMILARITY

Chemical, **9:60**  
Evidence of similar properties, **9:29**  
Prima facie obviousness and structural similarity, **1:183**  
Prosecution history estoppel, **5:59**

### SIMPLE INTEREST

Damages, delay, **4:24**  
Delay damages, **4:24**  
Prejudgment interest, **18:35**

### SIMPLE NEGLIGENCE NOT ENOUGH

Exceptional case, **18:9**

### SIMPLICITY

Generally, **9:127**

### SIMPLIFICATION OF REFERENCE

Combination patent, **13:15**

### SIMULTANEOUS ACTS AND MATTERS

Generally, **5:5; 12:13**  
Appealability of sanctions, **19:64**  
Conception, **13:105**  
Obviousness, **7:97**

### SINGLE CLAIM

Plant patents, **9:162**

### SINGLE INVENTION

Generally, **9:103**

### SINGLE MEANS CLAIM

Sec. 112, **9:40**

### SINGLE REFERENCE

Obviousness, **19:123**

### SINGLE USE

Contributory infringement, **19:79**  
Enforceability, **13:42**  
Inducing infringement, **19:79**

### SISVEL INTERNATIONAL S.A. V. SIERRA WIRELESS, INC.

2023, **19:349; 19:350**

**SIXTH CIRCUIT**

Choice of law, **1:42**

**SKILL**

Actual skill of inventor not pertinent, **19:34**  
 Computer programmer, **14:8**  
 Inequitable conduct, **15:3**  
 Later developments not evidence, **19:34**  
 Patent attorney, **19:36**  
 Sec. 1498, **15:4**  
 Summary judgment, **12:15; 21:7**

**SKILLED ARTISAN**

Fact question, well-understood, routine and conventional, **1:311**

**SKILLED IN THE ART**

Claim interpretation, **3:75; 4:61; 4:66; 9:232; 20:8**  
 Claims speak to those, **5:19**  
 Disclosure of corresponding structure, **2:123**  
 Exceptional skill in the art, **14:67**  
 Factors, **5:5**  
 Indefiniteness, **9:156**  
 Inventor's theory, **6:10**  
 Obviousness, **4:82; 15:19**  
 Obviousness question, **3:30**  
 Sec. 102(b), **9:18**  
 Specification directed to, **9:125**

**SMALL ENTITY**

Issue fee, **4:52**  
 Maintenance fees, **21:40**

**SMOOTH**

Generally, **23:43**

**SNAPPOW V. LIGHTING DEFENSE GROUP**

2024, **19:355**

**SNIPR TECHNOLOGIES LIMITED V. ROCKEFELLER UNIVERSITY**

2023, **19:351**

**SOFTVIEW LLC V. APPLE INC.**

2024, **19:356**

**SOLE INVENTORSHIP**

Interference, **19:72**

**SOPHISTICATION**

Combination patent, **13:15**

**SOPHISTICATION—Cont'd**

Obviousness, **16:4**

**SO THAT**

Generally, **23:43**

**SOUTH**

Generally, **20:34**  
 Precedent, **23:28**

**SOVEREIGN ACT DOCTRINE**

Inherent element of every government contract, **8:41**

**SOVEREIGN ACTS**

Defenses, **15:8**

**SOVEREIGN IMMUNITY**

Generally, **3:79; 3:115; 26:10**  
 Declaratory judgment suit, **7:25**  
 Federal government, **3:95**  
 Inter partes review, **18:128; 19:305**  
 Joinder, **7:134**  
 Jurisdictional grants, **2:190; 13:66**  
 Narrowly construed, **19:75**  
 Post-judgment interest, **1:55**  
 Sec. 101, **21:78**  
 State immunity from declaratory judgment suit, **7:25**  
 State universities, **21:63**  
 Strictly construed, **10:19**  
 Waiver, **13:48; 23:28**

**SPECIAL, PETITION TO MAKE**

Generally, **7:57; 12:56**  
 Claim interpretation, **7:57**  
 Inequitable conduct, **7:29**  
 Prosecution history estoppel, **7:57**

**SPECIAL CIRCUMSTANCES EXCEPTION**

Law of the case doctrine, **13:61**  
 Sec. 122(a), **8:135**

**SPECIAL DEFINITION**

Claim interpretation, **14:30**

**SPECIAL DISPATCH**

CAFC jurisdiction, **7:8**

**SPECIAL INTERROGATORIES**

Generally, **11:28; 14:1**  
 Appellate review, aid in, **8:84**  
 Jury, **1:16**  
 Unresolved deadlock, **2:49**

## INDEX

### SPECIAL MASTER

- As a whole, reference must suggest invention, **13:24**
- Authority to amend decision, **16:37**
- Claims court, **3:49**
- Damages, **20:19**
- Deference, **13:24**
- Improvement, **13:24**
- Infringement determination, **1:207; 13:24**
- Judgments not opinions are reviewed, **13:24**
- License, need for, **13:24**
- Obviousness, **13:24**
- Reference as a whole must suggest invention, **13:24**
- Reliance upon his prior experience, **19:65**

### SPECIAL PROVINCE OF TRIER OF FACT

- Weight and credibility of evidence, **18:12**

### SPECIAL VERDICT

- Generally, **13:53**
- Advantage thereof, **18:41**
- Erroneous jury instructions, **14:7**
- Form, **12:20**
- Forms, **19:9**
- FRCP 49(a), **19:37; 23:1**
- Hypothesize, **13:85**
- Inferior infringement, **23:1**
- Infringement, inferior infringement, **23:1**
- Jury instructions, **6:88; 14:7**
- Objections, waiver of objections, **8:52**
- Presume jury resolved facts in favor of verdict winner, **20:50**
- Review, standard of, **20:35**
- Sec. 112, **17:1**
- Waiver of objections, **8:52**

### SPECIES

- Claim preamble, **3:22**
- Disclosure of species, **2:107; 9:126**
- Genus, **2:107; 18:40**
- Sec. 102(e), **9:28**
- Sec. 120, **12:10**
- Written description, **3:106**

### SPECIFICATIONS

- Admissions, **16:109**
- Application, **9:189**
- Best mode, **9:357**
- Claim construction and interpretation, **1:134; 3:80; 5:2; 9:94; 12:68; 13:86; 13:104; 14:57; 18:68; 19:191; 19:196; 20:61; 21:9; 25:4**
- Declaratory judgment, **10:6**
- Disavowal of scope, **5:97**
- Disclosure, **5:16; 9:113**
- Dismissal, **3:19**
- Embodiments appearing in specification will not be read into claims, **5:19**
- Enablement, **23:77**
- FRCP 52(a), **12:6**
- Incorporation by reference, **16:128**
- Interference, **1:182; 2:172; 4:8; 19:151**
- Limitation not required by, **9:118**
- Means-plus-function claim, **6:36; 13:182; 20:64**
- Mere dissemination of invention's specifications is not infringement, **13:52**
- Novelty, **20:67**
- Obviousness, **9:19; 9:56**
- Only as of issue date of patent, **9:53**
- Primary basis for construing claims, **19:26**
- Prosecution history estoppel, **22:16**
- Reverse doctrine of equivalents, **19:24**
- Review, standard of, **19:12**
- Sec. 112(1), **3:54**
- Sec. 112(2), **19:125**
- Skilled in the art, **9:125**

### SPECIFIC CLAIMS

- Exhaustion of patent rights, reservation, **11:72**

### SPECIFIC DEVICES

- Issue preclusion, **11:35**

### SPECIFIC FACTUAL FINDINGS

- FRCP 52(a), **13:16**

### SPECIFIC INTENT

- Active inducement of infringement, **1:157**

### SPECIFIC INTENT TO DECEIVE

- Fraud, **6:28**

### SPECIFICITY

- Jury verdict, **8:52**

**SPECIFICITY—Cont'd**

Obviousness, **12:64**

**SPECIFIC JURISDICTION**

Generally, **2:46**

Personal jurisdiction, **20:46**

**SPECIFY EVERY DIFFERENT**

Reissue, **4:63**

**SPECIOUS ARGUMENT**

Murder, x on trial for murdering Y,  
**18:24**

**SPECK V. BATES**

2024, **19:357**

**SPECTRUM OF EFFECT**

Doctrine of equivalents, **9:108**

**SPECULATIVE**

Lost profits, **21:35**

**SPIRIT**

Federal Rules, **3:24**

**SPRINGS FROM INVENTION**

Ownership, **20:40**

**SSI TECHNOLOGIES, LLC V.  
DONGGUAN ZHENGYANG  
ELECTRONIC MECHANICAL  
LTD.**

2023, **19:352**

**STANDARD ESSENTIAL PATENTS**

Damages, **3:186**

**STANDARD OF REVIEW**

Appeal and Review (this index)

Jurisdiction to review, **9:425**

**STANDARD SETTING**

**ORGANIZATIONS**

Disclosure, **17:9**

Implied waiver, **3:206; 8:120**

**STANDING**

Generally, **1:317; 1:353; 1:363;  
1:363.50; 3:230; 5:79; 7:137;  
16:74; 16:159; 19:174; 19:251**

All co-owners, **5:40**

All substantial rights, **9:233**

Antitrust claim, **9:89**

Appeal and review, **7:39; 19:48; 20:75**

Assignment, **1:153; 1:191; 1:196;  
1:218; 1:264; 5:38; 13:87**

**STANDING—Cont'd**

Bankruptcy, **13:148**

Claim construction and interpretation,  
**1:264**

Consent, **19:263**

Constitutionality, **13:191**

Co-owners, all, **5:40; 19:221**

Damages, **23:82**

Declaratory judgment, **16:113**

De novo review, **7:39**

Dismissal without prejudice, **20:96**

Divorce, **5:105**

Exclusive licensee, **1:190; 1:196;  
13:157; 19:223; 23:67**

Exclusive ownership, **20:134**

Exclusive rights, licensee with exclusive  
right to sell abroad, **15:9**

Exclusive territorial license, **16:64**

Expired patent, **11:78**

False patent marking, **19:262**

Hard termination date, **1:153**

Hired to invent, **10:47**

Holder of legal title must be joined in  
action, **1:68**

Infringement, **13:170; 19:154**

Injury, **1:45; 3:177; 4:116**

Inter partes review, **10:50; 16:157**

Inventorship, **19:272**

Joining involuntarily, **9:302**

Legal title vs. equitable title, **1:46**

Licenses and licensees, **1:153; 9:301;  
13:133; 15:9; 16:64; 18:35; 20:45**

Lost profits, **23:82**

Mootness, **13:226**

MPEP, **19:46**

Non-parties, **19:48; 21:22**

Obviousness, **1:334; 1:355; 7:129**

Ownership, **1:172; 3:93; 9:303; 16:111**

Patentee, **1:272**

Post-grant review, **1:320**

Preliminary injunction, **12:111**

Public accessibility, **19:316**

Qui tam plaintiff, **19:224; 19:262**

Receivers and trustees, **13:148**

Retroactive, **8:63**

Review, de novo review, **7:39**

Sec. 101, **9:452**

Sec. 145 review, parties entitled to, **2:18**

Sec. 271(f), **23:82**

Sec. 281, **4:116**

## INDEX

### **STANDING—Cont'd**

- Substantial rights, **6:54; 12:117; 19:128**
- Territorial license, exclusive territorial license, **16:64**
- Three elements, **16:75**
- Title, **12:58; 19:154**
- Vesting title and right to sue infringer, **19:154**
- Virtual assignment, **5:38**
- Waived, cannot be, **2:18**

### **“STAND OR FALL TOGETHER”**

- Generally, **9:117**

### **STARE DECISIS**

- Appropriate, when, **2:50**
- Law question, application is, **13:53**

### **STARTING POINT**

- Inequitable conduct, **7:1**
- Statutory construction, **11:33; 20:30**

### **“START WITH STATUTE ITSELF”**

- Statutory construction, **19:73**

### **STATE CLAIM, FAILURE TO**

- Dismissal, **3:19; 4:121; 7:36; 20:44**
- Form 18, **12:114**
- FRCP 12(b)(6), **2:41; 7:99; 8:102; 12:112; 12:114; 19:237; 23:29**
- Pro se litigant, **13:142**
- Review, standard of, **4:29**

### **STATE COURT**

- Eleventh Amendment, **10:11**
- Judgment, **19:45**
- Mandamus, **9:68; 9:76; 26:14**
- Patent questions, **3:14**
- Res judicata, **13:22**
- Sec. 1447, **8:97; 22:46**

### **STATE OF MIND**

- Best mode, **3:31**

### **STATES**

- Abuse of process, **1:42**
- Choice of law, **18:64; 18:66**
- Damages, **9:161**
- Dismissal, **22:2**
- Eleventh Amendment, **10:11; 18:40**
- Immunity
  - declaratory judgment suit, **7:25**
  - Eleventh Amendment, **2:120; 9:128; 10:11**

### **STATES—Cont'd**

- Jurisdiction in state law contract dispute, **12:91**
- Preemption, **21:30; 21:42**
- Stay of patent action, **9:91**
- Summary judgment, **12:15**

### **STATE SECRETS PRIVILEGE**

- Generally, **3:95**

### **STATE UNIVERSITIES**

- Jurisdiction, federal courts, **21:63**

### **STATUTE OF LIMITATIONS**

- Limitation of Actions (this index)

### **STATUTE OF MONOPOLIES**

- Statutory subject matter, **9:308**

### **STATUTORY CLAIM**

- Chemical process, **9:20**

### **STATUTORY CONSTRUCTION AND INTERPRETATION**

- Generally, **1:39**
- Absurd results to be avoided, **2:39**
- Administrative agency, **19:74**
- Ambiguity, **6:24; 7:55; 8:45**
- Appellate subject matter jurisdiction, **1:37**
- Applicable rules, **22:6**
- Application, **15:7**
- As a whole, **3:63; 19:77**
- Begins with, **6:29; 23:29**
- Broad statutory language, **20:31**
- Chevron deference, **4:45; 6:31; 13:77; 26:3**
- Conflicts, **2:35; 9:183; 20:36**
- Deference, **2:51; 4:30; 4:43; 6:24; 11:30; 11:39; 14:17; 14:22; 19:74; 19:82; 23:31**
- Definition, **8:61**
- Directory vs. mandatory statutes, **5:17**
- Expressio unius, **1:57**
- Headings, effect of, **7:25**
- Implication, repeals by, **18:34**
- Implicit repeals disfavored, **6:30; 19:80**
- Intent, **1:61; 7:24; 7:55; 8:39; 8:45; 13:60; 19:75**
- Judicial not agency function, **11:26**
- Jurisdictional statute begins with its language, **3:60**
- Language, **6:29; 11:33; 12:37; 19:67**

**STATUTORY CONSTRUCTION AND INTERPRETATION—Cont'd**

Law question, **1:74; 2:67; 4:40; 9:166; 9:200; 10:18; 13:49; 19:102**  
 Legislative history, **7:35**  
 Mandatory vs. directory statutes, **5:17**  
 Meaning and effect, to give to all its parts, **19:69**  
 Omissions, **12:37**  
 Ordinary meaning, **8:61**  
 Particular language in statutory sec. omitted in another, **12:37**  
 Patent term extension, **8:25**  
 Permissible construction, **1:81; 8:54; 12:34**  
 Plain meaning rule, **1:69; 3:50; 6:14; 9:138; 9:149; 10:19; 12:19; 13:48; 14:9; 17:5; 20:26; 23:32**  
 Question at issue, **20:37**  
 Reasonable interpretation, **13:83; 20:42**  
 Regulations, conflict with, **9:183**  
 Repeals, **6:30; 18:34; 19:80**  
 Restrictive, **20:31**  
 Retroactive application, **15:7**  
 Review, standard of, **2:54; 3:58; 6:44; 9:162; 9:176; 13:59; 16:30; 19:88**  
 Sec. 156, **6:3; 21:6**  
 Sec. 282, **12:5**  
 Separate provisions to be construed together, **1:72; 8:43**  
 Silent statute, **6:24**  
 Starting point, **11:33; 19:73; 20:30**  
 Summary judgment, written description and enablement requirement, **21:46**  
 Terms, **8:61**  
 Tools therefore, **18:36**  
 Undefined terms given their ordinarily understood meaning, **8:61**

**STATUTORY DISCLAIMER**

Interference, **7:45**

**STATUTORY INVENTION**

Registration, **8:67**

**STATUTORY NOTICE**

Letters to customers as infringement threats, **13:41**

**STATUTORY SUBJECT MATTER**

Generally, **13:178**  
 Abstract principles, **21:57**  
 Business methods, **3:202; 9:308; 19:297**

**STATUTORY SUBJECT MATTER—Cont'd**

Business methods exception, **19:112**  
 Computer software, **9:175**  
 Living things, **16:63**  
 Sec. 101, **1:51; 3:164; 4:105; 9:30; 9:154; 9:155; 9:286; 9:437; 13:178; 21:62**  
 Signals, **9:290**

**STATUTORY TERMS**

Law question, **9:120**

**STATUTORY TIME PERIODS**

Two types, **23:28**

**STAUNCHING THE FATAL WOUND**

Sec. 102(b) on-sale bar, **4:16**

**STAY**

See also **Vacation of Judgment** (this index)  
 Clarification of law, **1:204**  
 Covered business method review, **2:158; 9:415; 22:48; 22:52**  
 Execution of judgment and injunction pending appeal  
     considerations involved, **19:49**  
     court actions, **19:49**  
     judicial notice of fact, **19:49**  
     reexamination, **19:49**  
     37 CFR Sec. 1.11(b), **19:49**  
 Final judgment, **9:415**  
 Final judgment rule, **19:110**  
 Injunction pending appeal, **5:2**  
 Interlocutory review, **19:230**  
 Jurisdiction, lack of, **19:9**  
 Motion, **12:36**  
 Order, **11:1; 14:40**  
 Patent action, **9:91**  
 Pending reexamination, **8:52**  
 Preliminary injunction, **11:19**  
 Reexamination, **8:52; 16:116; 22:23**  
 Sec. 1659, **9:292**

**STEPS WITHOUT FUNCTION**

Means-plus-function claim, **5:63**

**STEP-TWO ANALYSIS**

Infringement, **20:63**

**STEBEN FOODS, INC. V. SHIBUYA HOPPMANN CORPORATION**

2025, **19:361**

## INDEX

### **STIMULATION OF INVENTIONS**

Generally, **1:45**

### **STIPULATED JUDGMENT**

Claim construction, **10:37**

Consent decree, **8:6**

### **STIPULATION**

Generally, **1:379**

Appealability, **10:37; 10:38**

CAFC jurisdiction, **20:2**

Fictitious facts, may not stipulate, **13:68**

Willful infringement, **12:24**

### **STOCK ACQUISITION**

Motion for directed verdict, **1:1**

### **STOLEN TRADE SECRETS**

Preliminary injunction, **6:7**

### **STREAM-OF-COMMERCE PLUS THEORY**

Personal jurisdiction plus something more, **1:221**

### **STREAM OF COMMERCE THEORY**

Personal jurisdiction over nonresident foreign defendant, **1:181; 2:46**

### **STRICT LIABILITY OFFENSE**

Infringement, **10:21**

### **STRICTLY CONSTRUED**

Waiver of sovereign immunity, **10:19**

### **STRIKE, MOTION TO**

Addenda, **6:10**

### **STRIKING PLEADING**

Appealability, **20:5**

### **STRONG EVIDENCE**

Obviousness, **13:85**

### **“STRONG MEDICINE”**

Mandamus, **9:11**

### **STRONG PRESUMPTION**

Claim interpretation, **4:73**

### **STRUCTURAL EQUIVALENCY**

Means-plus-function claim limitation, **9:96**

### **STRUCTURAL LIMITATIONS**

Claim preamble, **18:44**

### **STRUCTURAL OBVIOUSNESS**

Prima facie obviousness, **9:50**

### **STRUCTURAL SIMILARITY**

Chemical, **9:60**

Prima facie obviousness, **1:183; 9:126**

### **STRUCTURE**

Infringement, **7:57**

Means-plus-function claim, **5:114; 6:73; 7:70; 12:26; 20:91; 22:26**

Prior art article, **9:48**

Product-by-process claims, **9:81**

### **SUA SPONTE**

Summary judgment, **9:146**

### **SUBJECTIVE GOOD FAITH**

Anticipation, **18:20**

Blonder-Tongue, **1:13**

### **SUBJECT MATTER**

Generally, **20:25; 21:17**

ANDA, **20:100**

Inventorship, conception, **21:55**

Judicial notice, **6:10**

Jurisdiction, **7:36; 13:66; 13:196**

Obviousness, **9:46; 9:436**

Prosecution history, **1:116**

Prosecution history estoppel, **8:72**

**Statutory Subject Matter** (this index)

Summary judgment, **3:13**

### **SUBJECT MATTER JURISDICTION**

Generally, **7:36; 8:151; 13:66; 13:196; 16:162**

Actual case or controversy, **12:22; 19:250**

Anticipation of defense, asserted in, **1:7**

Appeal and review, **6:19**

Arising under, **3:18**

Arose out of agreement, **18:13**

Choice of law, **20:66**

Claims court, **2:41; 20:27; 21:21**

Contracting parties, **25:1**

Covenant not to sue, **4:95**

Declaratory judgment, **1:297; 1:301; 8:109; 16:130; 19:250**

Design around, **25:1**

Dismissal, **12:38**

Enhanced damages, **25:1**

Examination, **6:19**

Extraterritorial activities, **12:82**

**SUBJECT MATTER JURISDICTION**

—Cont'd

Federal, **22:5**  
 FRCP 12(b)(1), **1:7**  
 Hatch Waxman amendments, **3:159**  
 Imported product, **12:81**  
 Incentive, **25:1**  
 Isolated DNA molecules, **1:214**  
 License, **1:7**  
 Lost profits, **25:1**  
 Malpractice, **23:71**  
 Mandamus, **9:68**  
 Motion to dismiss, **1:7**  
 Process claim, **3:164**  
 Sec. 291, **1:11**  
 Sec. 1338, **1:49; 11:20**  
 Sec. 1338(a), **1:7; 5:17**  
 Sec. 1338(b), **13:58**  
 Sec. 1500, **21:15**

**SUBMISSIONS**

CAFC, **18:3**  
 Doctrine of equivalents, **7:51**  
 FRCP 56(f), **2:80**  
 Good cause under 37 CFR Sec. 1.617(b) justifying, **8:35**  
 JNOV, **23:4**  
 New interference rules, **8:3**  
 On-sale bar, **8:62**  
 Sec. 120, **2:68**

**SUBORDINATE**

Appeal, Board failure to review all claims on, **9:2**

**SUBPOENA**

Choice of law, **20:17**  
 Inter partes reexamination, **1:232**

**SUBSEQUENT LITIGATION**

Generally, **2:36**  
 Sec. 304, **19:46**

**SUBSEQUENT PATENT**

Generally, **8:40**

**SUBSTANCE NOT LINGUISTIC FORM**

Motion, **9:233; 19:86**

**SUBSTANTIAL DIFFERENCE**

Doctrine of equivalents, **16:40**

**SUBSTANTIAL EQUIVALENT**

Generally, **12:1**

**SUBSTANTIAL EVIDENCE**

Generally, **1:117; 2:31; 2:34; 7:131; 13:103; 15:19; 20:1; 20:25**  
 Advisory jury, **18:14**  
 APA, **8:34**  
 Claim interpretation, **20:1**  
 Defined, **2:37; 4:33; 6:31; 6:32; 7:43; 7:44; 8:31; 9:231; 13:68; 20:22**  
 Definition, **10:31**  
 Independent substantiation, **19:43**  
 Infringement, **25:10**  
 ITC, **8:28**  
 JMOL, **10:40**  
 JNOV, **6:6; 15:2**  
 Jury verdict, **7:29**  
 Law question, **20:1**  
 Obviousness, **19:43**  
 Relationship between, **11:13**  
 Relevance, **16:39**  
 Review, standard of, **16:31**  
 Sec. 337, **3:23**  
 Test devised, **19:43**

**SUBSTANTIALITY**

Claim interpretation, **12:70**  
 Doctrine of equivalents, **1:82; 6:26; 8:47; 18:39; 19:94; 23:40**

**SUBSTANTIALLY**

Generally, **22:25; 26:9**  
 Claim interpretation, **12:61; 13:134**  
 Jury instructions, **10:4**  
 On-sale bar, **5:35**

**SUBSTANTIAL NEW QUESTION**

Reexamination, **2:150; 9:183; 9:314**

**SUBSTANTIAL OPEN ISSUES**

Contempt, **1:88**

**SUBSTANTIAL QUESTION**

Success on merits, likelihood of, **16:70**

**SUBSTANTIAL REASON**

Doctrine of equivalents, **6:41; 8:60**  
 Prosecution history estoppel, **6:41**

**SUBSTANTIAL RIGHTS**

JNOV motion, **6:6**  
 Standing, **6:54; 12:117; 19:128**

## INDEX

### **SUBSTANTIATION OF FEATURES**

Doctrine of equivalents, **14:45**

### **SUBSTITUTE**

Acceptable substitutes, **19:96**  
Appellate brief is no substitute for notice of appeal, **10:14**  
Applicant's disclosure cannot be used to fill in gaps, **9:29**  
Availability of acceptable noninfringing substitutes, **19:53**  
Disclosure, **9:29**  
Doctrine of equivalents, **26:4**  
Infringement, **7:63**  
Lost profits, **13:45**  
Panduit, **3:8; 4:90**  
Reexamination, **9:87**  
Untimely appeal, **3:5**

### **SUBSTRATE**

Obviousness, **9:32**

### **SUCCESS**

Attorney fees, **10:2**  
**Commercial Success** (this index)  
Reasonable expectation, **9:352; 12:55; 16:108; 16:109**  
Testing, **5:34**

### **SUCCESS ON MERITS, LIKELIHOOD OF**

Infringement, nonmovant infringes, **7:50**  
Nonmovant infringes, **7:50**  
Preliminary injunction, **1:169; 11:67**  
Substantial question, **16:70**  
Validity and enforcement challenges, withstand, **1:110**

### **SUCCESSOR**

Motion for directed verdict, **1:1**

### **SUFFICIENCY**

Jury instructions, **2:143**  
Testimonial evidence alone, **7:11**  
Written description, **1:185**

### **SUFFICIENCY OF DISCLOSURE**

Interference, **3:25**

### **SUFFICIENT CIRCUMSTANTIAL EVIDENCE**

Rule of reason, **3:82**

### **SUFFICIENT EXPLANATION**

Board, **9:218**

### **SUFFICIENTLY COMPLETE**

On-sale bar, **19:91**

### **SUFFICIENTLY SPECIFIC**

Directed verdict motion, **23:17**

### **SUGGESTION**

Generally, **9:96; 9:114; 9:148**  
Claim interpretation, **19:15**  
Claim preamble, **16:58**  
Combining references, **9:126; 9:127**  
Commissioner's brief not prior art, **9:140**  
Device, prior art, **9:101**  
Functional characteristic, **9:101**  
Modification, **9:51**  
Obviousness, **9:124; 9:148; 9:204; 11:49; 14:8; 21:8; 22:26**  
Prior art device, **9:101**  
References, combining, **9:126**  
Special master's decision, **13:24**  
Summary judgment, **3:20**

### **SUMMARY DETERMINATION**

Collateral estoppel, **16:160**  
ITC, **8:58**

### **SUMMARY DISPOSITION OF APPEAL**

FRAP 2, **10:20**

### **SUMMARY JUDGMENT**

Generally, **1:141; 3:89; 7:86; 9:220; 9:237; 9:252; 9:267; 9:281; 12:71; 13:104; 13:123; 15:17; 16:77; 19:100; 19:159; 19:189; 21:48; 23:51**  
Abandonment as law question, **1:111**  
Abbreviated new drug application (ANDA), **2:88**  
Adjustment of patent term, **1:315**  
Affidavits, **19:99**  
Ambiguity, claim construction, **2:98**  
Analogous art, **21:7**  
Analogous prior art, **6:1**  
Appeal and review, **1:288; 2:29; 8:17; 21:29**  
Appropriateness, **1:6; 3:44; 4:34; 7:30; 13:63; 14:14; 19:79; 19:91; 20:32; 20:39; 21:25; 23:35; 25:4**  
As a whole, invention considered, **12:15**  
Attorneys' fees, **1:2; 2:71**  
Bankruptcy discharge, **2:21**

**SUMMARY JUDGMENT—Cont'd**

Broadened reissue, **20:10**  
 Burden, viewed with trial burden,  
**13:90; 18:47**  
 Burden of production, **12:63**  
 Burden of proof, **1:35; 10:4**  
 Burden to show, **22:18**  
 Care, approached with, **13:27**  
 Case or controversy, **7:7**  
 Claim construction or interpretation,  
**1:108; 1:256; 2:24; 2:78; 8:17;**  
**11:53; 19:161; 20:10; 23:58**  
 Claim differentiation, **11:44**  
 Claim management, **2:153**  
 Claims court, **16:30**  
 Combine references, suggestion to, **3:1**  
 Competition, state unfair competition  
 claim, **12:15**  
 Conclusory, **3:13; 20:62**  
 Conflicting views, **8:14**  
 Contributory or indirect infringement,  
**3:36**  
 Court of International Trade standard,  
**20:38**  
 Covenant not to sue, **1:306**  
 Cross-motions, **2:36**  
 Decision, justifies and detracts from,  
**1:126**  
 Declaratory judgment, **7:7**  
 Defined, **20:10**  
 Dependent claims, **2:29**  
 Design patent, **1:35; 16:17**  
 Devoid, **13:98**  
 Directed verdict, JNOV over, **10:4**  
 Disclosure dedication, **20:74**  
 Discovery, right to, **1:35**  
 Discretion of court not to proceed, **7:7**  
 Dismissal, **3:19**  
 Disputed questions of material facts,  
**5:36**  
 Divided infringement, **13:211**  
 Doctrine of equivalents, **2:20; 2:66;**  
**2:114; 4:62; 8:40; 11:46; 12:42;**  
**20:13; 22:21; 23:64**  
 Documents, trial by, **19:51**  
 Doubt resolved in favor of nonmovant,  
**9:215**  
 Due care, duty of, **1:35**  
 Each motion on own merits, **5:48**  
 Eliminate factually unsupported claims,  
**15:15**

**SUMMARY JUDGMENT—Cont'd**

Enablement, **1:127; 2:82; 2:90; 14:75;**  
**15:26**  
 Enforcement of judgments, court's  
 power, **1:83**  
 Equitable estoppel, **19:108**  
 Estoppel, **1:48; 10:4**  
 Evidence, infringer provides evidence of  
 noninfringement, **14:33**  
 Exceptional case, **18:55**  
 Executive Order 10096, **8:10**  
 Ex parte test, **3:10**  
 Experts, **3:1; 8:14**  
 Expert testimony, **1:6; 3:20; 3:150**  
 Facts viewed most favorably for  
 nonmovant, **23:16**  
 File wrapper, infringement, **10:13**  
 Final judgment, appeal after, **21:29**  
 Final order rule, **12:41**  
 Foreign countries, Court of International  
 Trade standard, **20:38**  
 FRAP 47.6(b), **2:72**  
 FRCP 41(a)(1), **5:18**  
 FRCP 52(a), **20:26**  
 FRCP 56, **2:29; 9:89; 13:36; 16:28;**  
**16:32; 19:44**  
 FRCP 56(c), **3:36; 3:52; 4:26; 8:27;**  
**9:131; 11:25; 16:35; 18:28; 21:13**  
 FRCP 56(e), **3:1**  
 FRCP 56(f), **11:7; 19:20**  
 Good faith dispute regarding claims,  
**16:54**  
 Gorham test, **1:35**  
 Granted by court sua sponte, **9:146**  
 Granting, standard for, **6:1**  
 Harmless error, **3:1**  
 Heavy presumption terms, **5:70**  
 Hypothetical vs. real person, **8:14**  
 Identify facts, **22:21**  
 Indefiniteness, **2:175; 5:141; 19:131**  
 Indirect infringement, **4:75**  
 Indirect or contributory infringement,  
**3:36**  
 Inequitable conduct, **2:24**  
 Infringement, **1:79; 1:137; 3:189;**  
**16:20; 21:28**  
 Inherent anticipation, **19:154**  
 Initial burden to show no material fact,  
**22:18**  
 Interplay of prosecution history estoppel  
 and doctrine of equivalents, **8:40**

## INDEX

### SUMMARY JUDGMENT—Cont'd

Interpretation, **8:17**  
Invalidity, **3:20**  
Inventorship, **2:99**  
JNOV over directed verdict, **10:4**  
Judicial redrafting, **2:29**  
Laches, **1:36; 10:4; 23:45**  
Law of the case, **2:29; 10:4**  
Law question, **1:35; 7:66; 20:10**  
Lexicographer, **2:24; 10:13**  
License agreement, **3:70**  
Limitations, **20:13**  
Literal infringement, **2:22; 20:13**  
Material, unnecessary fact not, **3:13**  
**Material Fact** (this index)  
Metaphysical doubt, more than, **10:32**  
Method patentable even though device using it is not, **21:7**  
Modification of prior art device, **3:20**  
Motion, **5:48; 9:215; 10:4; 13:82; 23:16**  
Nexus, **3:1**  
9 Cir, **3:1**  
Noninfringement, **2:22**  
Noninfringement of asserted claims, **4:113**  
Nonmovant, **13:82**  
Novel combination, **21:7**  
Obviousness, **8:14; 9:274; 9:454; 12:15; 21:7**  
Only facts affect outcome, **13:102**  
On-sale bar, **1:2; 7:71**  
Opinion, **8:17**  
Opinion testimony, **3:1**  
Ordinary and accustomed meaning, **2:104; 4:60**  
Ornamental v. functional obviousness, **1:35**  
Ownership, employer and employee, **2:73**  
Own merits, each motion on, **5:48**  
**Partial Summary Judgment** (this index)  
Patentee as own lexicographer, **10:13**  
Preference, **10:4**  
Preliminary injunction, **19:32**  
Presumption of validity, **3:13**  
Presumptions, **10:4**  
Prior art, **3:1; 3:20; 6:1; 21:7**  
Proper, when, **19:76**

### SUMMARY JUDGMENT—Cont'd

Prosecution history, **1:116**  
Prosecution history estoppel, **2:74; 8:40; 8:72; 12:59; 16:79; 20:13**  
Purpose, **3:41**  
Raising attorney fees claim, **2:71**  
Real vs. hypothetical person, **8:14**  
Reconsidering motion, **10:4**  
Reconstruction versus repair, **19:143**  
Reexamination, **3:192**  
Reissue statute, **8:17**  
Res judicata, **1:78**  
Reversal, when required, **8:17**  
Reverse doctrine of equivalents, **19:24**  
Review, standard of, **1:67; 1:82; 1:87; 2:44; 2:52; 2:63; 4:29; 7:7; 7:35; 9:162; 15:12; 17:5; 18:33; 19:84; 22:7; 23:36; 23:43**  
“Rewritten” claims, **16:91**  
Sales, **1:2**  
Sec. 43(a), **3:1**  
Sec. 101, **2:175**  
Sec. 102(b), **1:2; 19:62**  
Sec. 156, **1:139**  
Sec. 252, **8:17**  
Secondary considerations, **3:1; 8:14; 21:7**  
Skill, level of, **12:15; 21:7**  
Standards for granting, **1:26; 6:1**  
Standing, **20:75**  
State unfair competition claim, **12:15**  
Statutory construction and interpretation, **1:74**  
Sua sponte, granted by court, **9:146**  
Subject matter easily discernible, **3:13**  
Suggested, must be, **3:20**  
Supplanting prior art device, **21:7**  
Synergism, **3:13**  
Taxable costs, **3:13**  
Tenets, **8:14**  
Testimony on claim terms, **12:25**  
Time, when appropriate, **2:153; 13:63**  
Transcript, **3:13**  
Trial by documents, **19:51**  
Unfair competition, **12:15**  
Validity, **1:35; 3:13; 20:10; 21:46**  
Validity, presumption of, **13:99; 19:129**  
Viewed with trial burden, **18:47**  
Walker Process, **12:15**  
Willfulness, **1:35; 1:222; 1:230**

**SUMMARY JUDGMENT—Cont'd**

Witnesses, **12:25; 21:7**

**SUNSET PROVISION**

Permanent injunction, **1:219**

**SUPERIORITY**

Infringement not avoided, **19:38**

Obviousness, **18:23**

**SUPERSEDEAS BOND**

Surety, **2:30**

**SUPERVISORY AUTHORITY**

Design patent, **16:17**

**SUPPLANTING PRIOR ART DEVICE**

Summary judgment, **21:7**

**SUPPLEMENTAL INFORMATION**

Inter partes review, **21:74**

**SUPPLEMENTAL JURISDICTION**

Discretion of court declined, **7:39**

Sec. 1267, **7:25**

Sec. 1367, **8:97; 13:58; 14:82; 22:36**

**SUPPLEMENT RECORD**

Generally, **23:26**

**SUPPLIER EXCEPTION**

On-sale bar, **19:140**

Sec. 102(b), **19:140**

**SUPPORT, LACK OF**

Sec. 112, **9:86**

**SUPPRESSION**

Generally, **6:62**

Abandonment, **3:59; 6:33**

Purpose of patent system, **16:9**

Sec. 102(g), **16:9**

Unreasonable delay, **12:21**

Vacuum, does not operate in, **16:9**

**SUPREME COURT**

Generally, **1:52**

**SURETY**

Supersedeas bond, **2:30**

**SURPRISING RESULTS**

Improvement, minor improvement,  
**9:118**

Inequitable conduct, **11:4**

Minor improvement, **9:118**

**SURRENDER**

Doctrine of equivalents, **13:63; 13:95**

Prosecution history estoppel, **13:140;**  
**16:40**

**SUSPENSION**

Pendency of earlier case involving same  
patent, **1:24**

Reissue, **3:72**

**SYNERGISM**

Appellate standard of review, **7:2**

Combination, **19:36**

Declaratory judgment, **10:6**

Inequitable conduct, **11:4**

Jury, **1:16**

Summary judgment, **3:13**

**TANGENTIAL**

Doctrine of equivalents, **3:130; 9:377;**  
**18:74; 18:77**

**TANGENTIALLY**

Prosecution history estoppel, **3:130;**  
**18:77**

**TANGIBLE FORM**

Computer program, **9:164**

Reduction to practice, **19:144**

**TARIFF ACT**

ITC, **13:11**

**TAXABLE COSTS**

Summary judgment, **3:13**

**TEACHING**

Combining references, **9:119**

Commissioner's brief not prior art,  
**9:140**

New prior art not considered by PTO,  
**5:11**

Obviousness, **3:153**

Prior art, **9:96; 9:140**

Reference, **9:289**

Reference, must appear in, **9:140**

Requirement, **9:114**

**TECHNICAL EXPERT**

Infringement, **9:125**

Testimony, **16:11**

**TECHNICAL PAPER**

Prior art printed publication under Sec.  
102(b), **13:11**

## INDEX

### TECHNICAL QUALIFICATIONS

Ordinary skill, hypothetical person of,  
**9:65**

### TECHNICAL TERMS

Claim integration, **13:91**  
Claim interpretation, **14:44; 16:56**  
Dictionary, **1:109**  
Indefiniteness, **13:80**

### TECHNOLOGICAL ADVANCE

Infringement, **22:32**

### TECHNOLOGICAL ARTS TEST

Statutory subject matter, **9:308**

### TECHNOLOGICAL EVIDENCE

Generally, **14:32**

### TECHNOLOGIC EQUIVALENCY

Infringement, **8:51**

### TELEFONAKTIEBOLAGET LM ERICSSON V. LENOVO (UNITED STATES), INC.

2024, **20:166**

### TEMPLATE

Hindsight reconstruction, **9:114**  
Instructional manual, **9:123**

### TEMPORARY RESTRAINING ORDER (TRO)

Generally, **12:16**

### 10-DAY LIMIT

FRCP 59(e), **19:42**

### TERM

Generally, **Patent Term** (this index)  
Contract construction, **16:34**  
FRCP 56(c), **8:27**

### TERMINAL DISCLAIMER

Certificate of correction, **10:44**  
Double patenting, **9:384; 15:6**  
Purpose, **9:110**  
Reissue, withdrawal of disclaimer, **9:367**  
Rejection, **17:2**  
URAA, **2:89**

### TERMS

See also **Claim Terms; Patent Term**  
(this index)  
Law question, **9:120**  
Statutory construction, **8:61**

### TERRITORIAL LICENSE

Standing, **9:301; 16:64**

### TERSE CLAIM LANGUAGE

Claim interpretation, **5:50**

### TEVA BRANDED

#### PHARMACEUTICAL PRODUCTS R&D, INC. V. AMNEAL PHARMACEUTICALS OF NEW YORK, LLC

2024, **20:167**

### THESIS

Documentary evidence, weight accorded  
testimony in conflict with, **13:34**

### THIRD PARTIES

Generally, **9:118**  
Attorney-client privilege, **19:60**  
Contempt, **20:54**  
Evidence of level of skill in the art, **9:23**  
Implied license, **3:147**  
Injunction, **1:296**  
Interference, **3:6**  
Inter partes reexamination, **3:138**  
Invention, **19:34**  
Inventorship, **1:102**  
License agreement, **3:70; 3:145**  
Obviousness, **21:8**  
Prior invention by, **12:55**  
Public use, **4:101**  
Reexamination, third-party requester,  
**1:287; 3:194**  
Sec. 102(a), **3:2**  
Sec. 102(b), **19:7**  
Sec. 102(g), **14:7**  
Sec. 286, **19:27**  
Secondary considerations, **9:82**

### 30-DAY NOTICE

Sec. 282, **20:15**

### 30-MONTH PERIOD

ANDA, **1:120; 5:95**

### 30-PERCENT REASONABLE ROYALTY

Damages, **20:19**

### 35 USC § 101

Abstract ideas, **1:333**  
Laws of nature, **1:333**  
Natural phenomena, **1:333**

**35 USC § 146**  
 Civil action for interference, **19:232**

**35 USC § 252**  
 Reexamination, **6:8**

**35 USC § 282**  
 Disclosure, statutory outer limit, **23:76**

**35 USC § 1124(4)**  
 Generally, **16:100**

**37 CFR SEC. 1.6(c)**  
 Generally, **7:45**

**37 CFR SEC. 1.11(b)**  
 Stay of execution of judgment and  
 injunction pending appeal, **19:49**

**37 CFR SEC. 1.56**  
 Generally, **19:180**  
 Disclose references showing each  
 known step, no obligation to, **8:29**  
 Duty of candor and good faith to PTO,  
**1:203**

**37 CFR SEC. 1.56(a)**  
 Generally, **2:113; 16:98**  
 Materiality, **9:43**

**37 CFR SEC. 1.105 (a)(1)**  
 Generally, **19:180**

**37 CFR SEC. 1.142**  
 Generally, **7:75**

**37 CFR SEC. 1.145**  
 Generally, **7:75**

**37 CFR SEC. 1.175**  
 Generally, **14:23**

**37 CFR SEC. 1.175(a)(4)**  
 No defect reissue application, **9:25**

**37 CFR SEC. 1.191**  
 Board failure to review all claims on  
 appeal, **9:2**

**37 CFR SEC. 1.196(a)**  
 Examiner, ground of rejection not part  
 of Examiner's decision, **9:106**

**37 CFR SEC. 1.321**  
 ITC, **13:20**

**37 CFR SEC. 1.608**  
 New interference rules, **8:3**

**37 CFR SEC. 1.609**  
 New interference rules, **8:3**

**37 CFR SEC. 1.617**  
 New interference rules, **8:3**

**37 CFR SEC. 1.617(b)**  
 Good cause, **8:35**

**THREATENED INFRINGEMENT**  
 Appellate jurisdiction, **3:11**

**THREAT OF SALE**  
 Sec. 271(e)(1), **5:13**

**THREATS TO SUE**  
 Mandamus, **9:76**

**THREE-JUDGE PANEL**  
 State immunity from suit under Eleventh  
 Amendment, **10:11**

**THREE-PART INQUIRY**  
 Doctrine of equivalents, **22:10**

**THREE-PART TEST**  
 Equitable estoppel, **2:61; 5:53**  
 Estoppel, **8:32**

**THREE REQUISITE ELEMENTS**  
 Estoppel, **1:67**

**“THREE SITUATIONS”**  
 Repair, **8:83**

**THRESHOLD INTENT**  
 Inequitable conduct, **6:4**

**THRESHOLD ISSUE**  
 Preliminary injunction, denial of, **12:16**

**THRESHOLD LEVEL**  
 Inequitable conduct, **1:44; 21:36**

**THRESHOLD QUESTION**  
 CAFC jurisdiction, **23:15**

**TIE**  
 Interference, **15:1**

**TIME AND TIMELINESS**  
 Generally, **18:1**  
 Abandonment, **4:65**  
 Agency, **9:187; 11:31**  
**Antedating Reference** (this index)  
 Antitrust, **11:16**  
 Appeal and review, **4:25; 9:38; 9:317;**  
**10:3; 11:38; 13:162; 16:37**

## INDEX

### TIME AND TIMELINESS—Cont'd

Appellate jurisdiction, **2:5; 13:8**  
Application entitled to benefit of earlier filing date, **13:53**  
Attorney fees award, **7:54**  
Barred, inter partes review, **12:115; 23:94**  
Best mode belief, **1:246**  
Broadening reissue, **9:3**  
Business day, **23:28**  
CIP, **20:35; 20:59**  
Claim construction, **3:123; 22:18**  
Concealment, **4:65**  
Damages, date of hypothetical negotiation, **1:296; 12:97**  
Declaratory judgment, **3:134; 13:177; 19:250**  
Description, **19:120**  
Doctrine of equivalents, **23:63**  
Enablement, **5:45; 21:39**  
Equitable estoppel, **2:5**  
Estoppel, **23:30**  
Exceptional case, **2:5; 18:9**  
Factual findings to support jury verdict presumed, **2:15**  
False marking, civil penalty, **6:72**  
**Filing Date** (this index)  
First sale doctrine, **2:5**  
Foreign activities, **9:61**  
FRAP 4(a), **2:5**  
Implied license, **2:5**  
Interference, **8:122; 13:3; 16:132; 19:144**  
Inter partes review, **23:94**  
JNOV, **6:6; 22:2**  
Judicial notice, **11:24**  
Jurisdiction, **7:38; 13:8; 15:8**  
Jury instructions, **13:38**  
Memorandum decision, **2:5**  
Motion to remand, **9:38; 19:45**  
New trial, **19:16**  
9 Cir, **2:5**  
Notice of appeal, **4:25; 9:317**  
Notice of patent, **2:5**  
Obviousness, **4:91; 9:112; 12:43**  
Particularity, failing in, **18:25**  
Permanent injunction, sunset provision, **1:219**  
Priority analysis, **9:340**  
PTO motion to remand, **9:130**

### TIME AND TIMELINESS—Cont'd

Raising argument, **3:32**  
Reconsideration, request for, **20:21**  
Reduction to practice, antedate of reference, **9:341**  
Rejection, **9:38**  
Remand, **9:38**  
Sec. 102(b), **2:1**  
Sec. 111, **19:32**  
Sec. 112, **18:4**  
Sec. 120, **12:99; 20:33**  
Trademark, **2:5**  
Trademark declaration cannot establish on-sale date, **16:25**  
Waiver, **10:15**  
Weekend or holiday, **23:28**

### TIME LIMITS

FRCP 59(e), **19:58**  
Patent Cooperation Treaty (PCT), **8:70**

### TIME PERIOD

Interference, **15:1**

### TITLE

See also **Ownership** (this index)  
Automatically vests in United States, **6:18**  
Employer-employee, **6:15**  
Standing, **5:105; 12:58; 19:154**

### TOLLING

Appeal, of time for, **7:32**

### TORT

Occurs at place where sales are made, **14:15**

### TORTIOUS INTERFERENCE

Generally, **19:185**  
Inducing infringement, **18:48**

### TORT LIABILITY

Preemption of laws, state law tort liability, **7:81**

### TOTALITY OF CIRCUMSTANCES

Experimental use, **2:57; 12:45; 16:44**  
On-sale bar, **3:81**  
Public use, **12:45; 16:44**  
Sec. 112, **15:2**  
Shop rights, **13:52**  
Willful infringement, **1:58; 11:18; 11:56; 19:38**

**TOUCHSTONE**

Inventorship, **2:99**

**TRADE DRESS**

Choice of law, **9:161; 15:11**  
Gorham infringement test, **12:17**

**TRADEMARK**

Declaration cannot establish on-sale date, **16:25**  
Declaratory judgment, **23:9**  
Patent misuse, **23:9**  
Preliminary injunction, **2:16**  
Timeliness of appeal filing, **2:5**

**TRADE NAME**

Best mode, **18:5**  
Disclose supplier, failure to, **20:33**

**TRADE SECRETS**

Generally, **15:22; 16:103**  
Choice of law, **12:65; 18:39**  
Contract, **18:14**  
Defined, **12:27**  
Motion to remand, **19:45**  
Preliminary injunction, **6:7**

**TRANSCRIPT**

Summary judgment, **3:13**

**TRANSFER**

Dismiss or transfer infringement suit, **9:432**

**“TRANSFER FROM”**

Claim construction, **7:104**

**TRANSFERS**

Action, transfer of, **18:40**  
**Appeal and Review** (this index)  
Choice of law, **24:1**  
Clear abuse of discretion, **9:381; 9:382**  
Judicial Panel on Multi-District Litigation (JPMDL), **7:6**  
Jurisdiction declined, **21:12**  
Orders, **6:34**  
Ownership, **9:303**  
Relevant factors, **9:128**  
Sec. 1631, **19:2**  
Stay order, **11:1**  
Venue, **7:93; 8:69; 8:110; 9:334; 9:336; 9:395; 14:60; 22:38; 26:14**

**TREBLE DAMAGES**

Appeal is review and not trial de novo, **6:12**

**TRIAL BY DOCUMENTS**

Summary judgment, **19:51**

**TRIAL CONDUCT**

CAFC, **18:3**

**TRIAL DE NOVO**

Appeal is review and not trial de novo, **6:12**

**TRIAL JUDGE**

Sec. 455(a), **8:12**  
Weight and credibility of testimony, **19:54**

**TRIER OF FACT**

Weight and credibility of evidence, **18:12**

**TRINITY INFO MEDIA, LLC V. COVALENT, INC.**

2023, **20:165**

**TRO (TEMPORARY RESTRAINING ORDER)**

Generally, **12:16**

**TRUE INVENTOR**

Claim interpretation, **19:15**

**TRUE SALE**

On-sale bar, **13:123**

**TRUSTEES**

Standing, **13:148**

**21 CFR 314.53(c)(3)**

Generally, **1:135**

**21 CFR 314.53(f)**

Generally, **1:135**

**21 CFR 355(c)(2)**

Generally, **1:135**

**21 CFR 355(j)(2)(A)(vii)**

Generally, **1:135**

**21 USC § 355**

Generally, **13:120**

**28 USC § 1291**

Generally, **14:40**  
Immediate appeal, **11:10**

## INDEX

- 28 USC § 1292(b)**
  - Discretionary, **14:40**
- 28 USC § 1295**
  - Inter partes review, disclaimers, **1:327**
  - Stay orders not final, **14:40**
- 28 USC § 1338**
  - Generally, **14:40**
  - Arising under jurisdiction, **2:3**
  - Jurisdiction, **20:83**
- 28 USC § 1361**
  - Generally, **8:92**
- 28 USC § 1498(a)**
  - Generally, **20:66**
- 28 USC § 1920**
  - Cost award, **9:342**
- 28 USC § 2202**
  - Generally, **16:81**
  - FRCP 13(a), **16:81**
- TWO-STEP ANALYSIS**
  - Infringement** (this index)
- TYING ARRANGEMENTS**
  - Generally, **9:282**
- TYPOGRAPHICAL ERROR**
  - Marking, **1:119; 16:183**
- UCB, INC. V. ACTAVIS LABORATORIES UT, INC.**
  - 2023, **21:92**
- ULTIMATE ARBITER**
  - CAFC, **18:3**
- ULTIMATE LEGAL ISSUE**
  - Expert's opinion, **9:113**
- ULTIMATE RECOGNITION**
  - Market success, **9:90**
- UNCITED PRIOR ART**
  - Claim differentiation, **11:2**
  - Prior art, **3:90**
  - Process performable by person, **1:12**
- UNCLAIMED DISCLOSED MATERIAL**
  - Doctrine of equivalents, **13:75**
- UNCLAIMED ELEMENTS**
  - Claim interpretation, **6:58**
- UNCLAIMED SUBJECT MATTER**
  - Best mode, **13:101**
  - Dedication, intent, **20:74**
  - Doctrine of equivalents, **10:30**
- UNCLEAN HANDS DOCTRINE**
  - Generally, **7:124**
  - Inequitable conduct, **3:35**
  - Inventorship dispute, **16:131**
  - Laches, **19:204**
  - Materiality required, **18:40**
- UNCONTRADICTED EXPERT TESTIMONY**
  - Generally, **21:13**
- UNDEFINED TERMS**
  - Statutory construction, **8:61**
- UNDERLYING FACTS**
  - Interference, **4:11**
  - Obviousness, **9:197**
- UNDERSTANDING**
  - CAFC jurisdiction, **9:63**
  - Claim interpretation, **22:25**
  - Discovery of new property or use of known composition, **9:104**
  - Indefiniteness, **19:131**
- UNDUE BREADTH REJECTION**
  - Papesch, **9:9**
- UNDUE DELAY**
  - Laches, **9:241**
- UNDUE EXPERIMENTATION**
  - Generally, **16:181; 23:11**
  - Enablement, **1:44; 2:99; 9:177; 9:305; 19:201**
  - Law question with facts, **5:45**
  - Quantitative, not merely, **10:23**
  - Sec. 112(1), **10:23**
- UNEXPECTED BENEFIT**
  - Generally, **9:100**
- UNEXPECTED PROPERTIES**
  - Obviousness, **8:147**
- UNEXPECTED RESULTS**
  - Generally, **9:191**
  - Closest art, compared with, **9:111**
  - Established by factual evidence not argument, **9:174**
  - Factual evidence, **9:174; 9:197**

**UNEXPECTED RESULTS—Cont'd**

Finding tantamount to nonobviousness,  
**7:108; 8:40**  
 Obviousness, **1:168; 9:15; 9:228;**  
**9:250; 9:295; 19:211; 19:214**  
 Prima facie obviousness, **9:86**  
 Secondary considerations, **12:13; 16:4**

**UNEXPECTED SETTLEMENT**

Judicial estoppel, **23:21**

**UNFAIR COMPETITION**

Generally, **15:25**  
 Choice of law, **7:55; 16:48**  
 Inducing infringement, **18:48**  
 Inequitable conduct as, **16:48**  
 Infringement, **19:87**  
 Sec. 43(a), **15:5; 16:21**  
 Sec. 102(b), **3:16**  
 Sec. 337 (this index)  
 Summary judgment, **12:15**

**UNFOUNDED DEFENSES**

Anticipation, **18:20**

**UNIFORM COMMERCIAL CODE  
 (UCC)**

Preemption, **3:68**

**UNIFORMITY OBJECTIVE**

Choice of law, **23:37**

**UNILATERAL CONTRACT**

Contract law, **23:39**

**UNITED CANNABIS CORPORATION  
 V. PURE HEMP COLLECTIVE  
 INC.**

2023, **21:93**

**UNITED SERVICES AUTOMOBILE  
 ASSOCIATION V. PNC BANK  
 N.A.**

2025, **21:96**

**UNITED STATES**

Site of infringement, **12:81**  
 Sovereign interests, qui tam actions,  
**19:224**  
 Title automatically vests in, **6:18**

**UNITED STATES COURT OF  
 INTERNATIONAL TRADE (CIT)**

Procedural rule corresponds to FRCP,  
**5:18**

**UNITED THERAPEUTICS  
 CORPORATION V. LIQUIDIA  
 TECHNOLOGIES, INC.**

2023, **21:94**

**UNJUST ENRICHMENT**

Generally, **21:49**

**UNPATENTED ACCESSORY SALES**

Generally, **11:21**

**UNPUBLISHED CAFC OPINION**

Effect thereof, **17:2**

**UNREASONABLE DELAY**

Abandonment, suppression or conceal-  
 ment, **12:21**  
 Laches, **1:54; 13:36**

**UNRELATED APPLICATIONS**

Prosecution, **13:108**

**UNRESOLVED DEADLOCK**

Special interrogatories, **2:49**

**UNSUPPORTED ALLEGATION**

Frivolous appeal, **1:52**

**URAA (URUGUAY ROUND  
 AGREEMENTS ACT)**

Generally, **13:77; 14:36**  
 Offer to sell in United States, **20:103**  
 Safe harbor provision, **2:54; 4:40**  
 Terminal disclaimer, **2:89**

**USE**

Infringement, **9:453**  
 Not covered by patent, **14:63**  
 Personal jurisdiction, **13:153**  
 System use, infringement by, **3:156**  
 Written description, **9:453**

**USE CODE OF FDA**

Counterclaim to force correction, **14:68**

**US FOOD AND DRUG  
 ADMINISTRATION**

FDA (this index)

**US SYNTHETIC CORP. V.  
 INTERNATIONAL TRADE  
 COMMISSION**

2025, **21:97**

**UTILITY**

Application, **18:1**  
 Collateral estoppel, **9:143**

## INDEX

### UTILITY—Cont'd

Contributory infringement, **7:130**  
Design patent, **1:356**  
Enablement, **9:319; 16:60**  
Fact question, **13:28**  
Inducement, **7:130**  
Inoperable, **5:56**  
Inoperative, **6:9; 9:222**  
Interference, **6:33**  
Obviousness, **7:130**  
Overbreadth, **21:10**  
Practical, **6:33**  
Prima facie obviousness, **9:17**  
**Public Utilities** (this index)  
Sec. 101, **2:34; 3:37; 5:7; 13:55; 14:4; 18:6; 20:25**  
Sec. 102(g), **19:10**  
Sec. 112(1), **9:165**

### VACATION OF JUDGMENT

See also **Stay** (this index)  
Altwater, **13:46**  
Claim construction, **1:5**  
FRCP 59(e), **19:42**  
Judgment of patent invalidity, **3:188**  
Mootness of case, **20:95**  
Public interest, **15:36**  
Regional law controls, **16:19**  
Settlement agreement, **21:22**  
Summary judgment based on anticipation, **5:129**  
Validity, **7:8; 10:10; 23:18**

### VACATUR

Generally, **3:236**

### VACUUM, CLAIMS NOT INTERPRETED IN

Generally, **9:58; 19:13**

### VAGUE ASSERTIONS OF PATENTABILITY

Prosecution history estoppel, **9:199**

### VAGUENESS

See index topics **Ambiguity; Certainty and Definiteness** (this index)

### VALIDITY

Generally, **2:199; 3:59; 8:93; 9:253; 16:87; 21:32; 22:23**  
Altwater, **13:46**  
Anticipation, **1:340; 1:341; 16:167**

### VALIDITY—Cont'd

Appeal and review, **7:61; 8:49; 8:62; 18:39; 21:26**  
Assignor estoppel, **21:38**  
Attorney fees, **10:2**  
Burden, heavy, **23:48**  
Burden of persuasion, **15:15**  
Burden of proof, **14:21; 20:35; 20:39; 21:25**  
Challenging each claim, **3:114**  
Claim by claim basis, **1:110**  
Claim construction and interpretation  
generally, **21:33**  
declared valid, **4:23**  
domestic industry requirement,  
**19:206**  
each claim presumed valid, **4:74**  
infringement, construed same way for,  
**1:131; 2:82**  
preserve validity, **18:50; 23:16**  
uphold if possible, **12:12**  
Claim itself recites incorrect science,  
**5:56**  
Claim preclusion, **8:76**  
Clear and convincing evidence, **5:49; 5:64; 19:132; 19:142**  
Collateral estoppel, **4:3; 8:73; 13:105**  
Consent judgment, **5:8**  
Coping application, **8:7**  
Counterclaim, **13:91**  
Cross-appeal, **18:2**  
Damages, **3:180; 12:45**  
Declaratory judgment, **1:312**  
Declare, inappropriate to  
evidence, objective, **4:19**  
objective evidence, **4:19**  
representative, unless claim is, **4:19**  
secondary consideration, **4:19**  
Dependent, independent versus, **8:7**  
Dependent claims as hedge against invalidity, **9:345**  
Design patent, **19:8**  
Determination to be vacated when  
infringement not present, **23:18**  
Dismissal, **16:54**  
Doctrine of equivalents, **5:6**  
Domestic industry requirement, **19:206**  
Double patenting, **8:7**  
Each claim has independent validity  
presumption, **3:41**

**VALIDITY—Cont'd**

Each patent independent, **5:45**  
 Enforceability issue, **12:40**  
 Equivalence, **5:7**  
 Examiner, prior art before, **3:77**  
 Exceptional case, **3:180**  
 FRCP 49(a), **19:21**  
 FRCP 56, **16:32**  
 FRCP 59(e), **19:42**  
 Heavy burden when only oral testimony, **23:48**  
 Identity of invention, **20:20**  
 Indefiniteness, **2:169**  
 Independent, each patent as, **5:45**  
 Independent of infringement, **19:86**  
 Independent vs. dependent claim, **8:7**  
 Infringement  
   access validity not examiner's potential act, **20:72**  
   appeal and review, **7:61; 8:49; 18:39**  
   burden of persuasion, **15:15**  
   eliminates need to consider, **12:45**  
   independent of, **16:74; 19:86**  
   lack of written description, **19:249**  
   validity, effect on, **1:113**  
 Judgment, **2:169; 14:1**  
 Jury verdict, **4:18; 8:62; 12:94; 21:26**  
 Laches or delay, **3:180**  
 Lack of written description, infringement, **19:249**  
 Law question, **14:8**  
 Lear distinguished, **8:11**  
 Licensee, **13:132**  
 Limitations, must construe dispute limitations first, **4:68**  
 Mootness, **1:113**  
 New trial, **8:51**  
 Obviousness  
   generally, **18:47**  
   dependent claims, **9:24**  
   dependent claim validity, **16:4**  
   eliminates need to consider, **12:45**  
   holding in prior suit, **7:17**  
   same way for validity and infringement, **19:11**  
 Oral testimony, **23:48**  
 Patents born valid, **4:6**  
 Post-trial motions, **18:3**  
 Preliminary injunction, **18:21; 20:12**

**VALIDITY—Cont'd**

Presumption of  
   generally, **1:80; 19:37; 19:129**  
   irreparable harm, **14:9**  
 ITC, **19:25**  
 JNOV, **22:2**  
 mere procedural device, **13:53**  
 new prior art, effect of, **18:10**  
 obviousness, **13:99**  
 prejudgment interest, **12:9**  
 PTO, **19:235**  
 Sec. 282, **8:119; 9:21; 9:57; 9:80; 12:6; 13:87; 16:4; 18:6**  
 substantive law, **19:36**  
 summary judgment, **3:13**  
 verbatim findings of counsel adopted, **8:22**  
 Primarily functional, **12:8**  
 Prior art, **3:77; 4:6**  
 Prior ruling upholding patent validity, **5:9**  
 PTO initial rejection, **7:19**  
 Public concern, matter of, **6:22**  
 Public policy, **4:13**  
 Public use, **16:167**  
 Reexamination, **6:85**  
 Regulation invalid when contrary to purposes of statute, **7:24**  
 Reissue, **4:69**  
 Rejection, **7:19**  
 Remand and reassignment, **20:104**  
 Res judicata effect, **6:17**  
 Rewrite claim to preserve validity, not court's function to, **1:119**  
 Science, claim itself recites incorrect science, **5:56**  
 Sec. 271(a), **3:180**  
 Sec. 102(b), **9:7**  
 Sec. 112, **20:6**  
 Sec. 153, **5:17**  
 Sec. 261, **10:4**  
 Sec. 282, **6:10; 9:80; 12:5**  
 Sec. 284, **16:167**  
 Standard of proof, **13:169**  
 State immunity from suit under Eleventh Amendment, **10:11**  
 Success on merits, likelihood of, **1:110**  
 Summary judgment, **1:35; 20:10; 20:107; 21:46**  
 Two-step analysis, **19:119**

## INDEX

### **VALIDITY—Cont'd**

Vacation of judgment, **7:8; 10:10**  
Witnesses, **19:145; 23:48**

### **VALUE AND VALUATION**

Anticipated collateral sales vs. reasonable royalty rate, **18:35**  
Bona fide purchaser, **8:63**  
Demand, patented feature is reason for, **20:50**  
Eminent domain, **8:56**  
Entire market value rule, **6:36**  
Obviousness, **9:191**

### **VARIED USE OF A TERM**

Claim interpretation, **2:78**

### **VASCULAR SOLUTIONS LLC V. MEDTRONIC, INC.**

2024, **22:70**

### **VENUE**

Generally, **1:362.50; 2:196; 3:229.50; 9:499; 9:505; 9:508; 9:515; 10:46; 20:82; 22:64**  
Corporation, domestic, **20:137**  
Dismiss or transfer infringement suit, **9:432**  
Domestic corporation, **20:137**  
Frcp 12(g)(2), **9:447**  
Frcp 12(h)(1)(a), **9:447**  
FRCP 25(a), **13:25**  
Frivolous appeal, **23:98**  
Infringement, **8:53**  
Mandamus, **9:445; 9:447; 9:449; 9:457; 9:462; 9:472; 9:480; 9:491; 9:493; 9:510; 9:515**  
Personal jurisdiction, lack of, not properly transfer, **8:69**  
Sec. 1400(b), **9:11**  
Transfers, **7:93; 8:69; 8:110; 9:334; 9:336; 9:395; 9:447; 14:60; 22:38; 26:14**  
Waiver, **9:447**

### **VERBAL DIFFERENCES**

Appellate standard of review, **7:2**

### **VERBATIM FINDINGS OF COUNSEL ADOPTED**

Generally, **8:22**  
Anticipation, **8:22**  
Best mode, **8:22**  
Conception, **8:22**

### **VERBATIM FINDINGS OF COUNSEL**

#### **ADOPTED—Cont'd**

Enablement, **8:22**  
Evidence, objective, **8:22**  
Fact question, **8:22**  
It would be obvious, **8:22**  
Objective evidence, **8:22**  
Obvious to try, **8:22**  
Presumption of validity, **8:22**  
Reduction to practice, **8:22**  
Validity, presumption of, **8:22**

### **VERDICT**

Generally, **12:74; 14:44**  
Advisory jury still need findings of fact, **20:39**  
Alternate legal theories, **13:97**  
**Appeal and Review** (this index)  
Choice of law, **13:105**  
Claim interpretation, **19:5**  
Claim preamble, **16:14**  
Combination patent, **3:17**  
Commercial embodiment comparison, **16:14**  
Conflict, **4:18**  
Defenses, **3:75**  
Delay, excusable, **13:4**  
Dimensions, **19:5**  
**Directed Verdict** (this index)  
Doctrine of equivalents, **8:47; 16:14**  
Equitable estoppel, **13:4**  
Equivalents, range of, **19:5**  
Evidence, **3:75; 4:18; 7:29**  
Exact identity, **16:14**  
Excusable delay, **13:4**  
Findings of fact, **20:39**  
Form, **22:4**  
FRAP 38, **3:17**  
FRCP 49(a), **19:5**  
FRCP 49(b), **13:4**  
Frivolous appeal, **3:17**  
Identity. exact identity, **16:14**  
Improper, **16:14**  
Indirect infringement, **16:153**  
Infringement, **8:47; 19:5; 20:25**  
Instruction, **4:18**  
Insufficient, **3:17**  
Inventor's claim interpretation, **19:5**  
JMOL, **11:28**  
JNOV, **3:17; 5:7; 13:17; 19:56; 20:15**

**VERDICT—Cont'd**

JNOV motion, **16:14**  
 Judgments reviewed, **16:14**  
 Jury trial, **16:14; 19:60**  
 Laches, **13:4**  
 Manufacturing tolerances, **19:5**  
 Mistakes at trial, not to cure, **4:18**  
 Motion, **4:18; 5:7**  
 New trial, **3:17; 4:18**  
 9 Cir law, **18:14**  
 Noninfringement, **1:50**  
 Nose of wax, **19:5**  
 Obviousness, **3:17; 3:153; 16:14**  
 Ordinary meaning, term given its, **19:5**  
 Primary reference, **8:62**  
 Prior art, distinguishing features in, **3:17**  
 Proper standard, **3:75**  
 Relevant facts to be found by trial court,  
**18:25**  
 Review, standard of, **2:49; 6:26; 8:51;**  
**21:27**  
 Sec. 287, **4:12**  
 Set aside, **3:173; 14:47**  
**Special Verdict** (this index)  
 Specificity thereof, **8:52**  
 Substantial evidence, **7:29**  
 Validity, **4:18; 8:62; 21:26**

**VESTING OF TITLE**

Infringement, **19:154**  
 United States, **6:18**

**VICARIOUS LIABILITY**

Infringement, **4:75**  
 Joint infringement, **13:159; 13:160**

**VIDEOTAPE**

FRE 403, **13:4**

**VIRTEK VISION INTERNATIONAL  
 ULC V. ASSEMBLY GUIDANCE  
 SYSTEMS, INC.**

2024, **22:71**

**VIRTUAL ASSIGNMENT**

Standing, **5:38**

**VISIBLE, NOT REQUIRED TO BE**

Design patent, **19:118**

**VISUAL APPEARANCE AS A WHOLE**

Infringement, **3:100**

**VITALNESS**

Administrative law, **4:38**

**VITIATION**

Claim construction, **3:178**  
 Doctrine of equivalents, **1:267; 3:178;**  
**18:106**  
 Obviousness, **3:178**

**VLSI TECHNOLOGY LLC V. INTEL  
 CORPORATION**

2023, **22:68**

**VOICE TECH CORP. V. UNIFIED  
 PATENTS, LLC**

2024, **22:72**

**VOIDING**

Election, **3:61**

**VOLUNTARY AND INVOLUNTARY  
 ACTS AND MATTERS**

Dismissal, **18:76**  
 FRCP 19(a), **11:19; 19:264**  
 FRCP 41(a)(1), **5:18**  
 Joinder, **9:302; 14:9; 15:9**  
 Prosecution history estoppel, **16:79**

**VOLUNTEER**

Amicus curiae, **1:41**

**VOLVO PENTA OF THE AMERICAS,  
 LLC V. BRUNSWICK  
 CORPORATION**

2023, **22:69**

**WAIVER**

Generally, **1:363; 9:246; 9:492; 18:66**  
 See also **Estoppel** (this index)  
 Belated preliminary motion, **7:26**  
 Claim construction and interpretation,  
**3:174; 3:200; 4:99; 9:234; 15:29;**  
**19:16; 19:279**  
 Constitutional immunity, **3:33**  
 Defenses, **9:159**  
 Directed verdict, failure to timely move  
 for, **10:15**  
 Eleventh amendment waiver, **18:66**  
 Expert or opinion evidence, **19:279**  
 FRCP 49(a), **19:21**  
 Implied waiver, standards setting organi-  
 zation, **3:206; 8:120**  
 Jury trial, **20:39**  
 Legal issues not raised at trial, **6:16**

## INDEX

### **WAIVER—Cont’d**

Obviousness, **9:439**  
Opening brief, raising issue in, **23:25**  
Patent term extensions, **16:149**  
Personal jurisdiction, **13:114**  
Reasonable royalty, **19:279**  
Sec. 282, **4:58; 20:15**  
Sec. 1400(b), **9:11**  
Sovereign immunity, **10:19; 13:48; 19:75; 23:28**  
Special verdict, **8:52**  
Standing, **2:18**  
Time bar, **1:350**  
Transfers, **9:447**  
Venue, **9:447**

### **WALKER PROCESS**

Generally, **3:69; 3:83; 3:230; 8:102; 9:221; 14:21; 14:25**  
Antitrust, **1:25; 1:42; 4:84; 11:16; 18:97**  
Inequitable conduct, **3:71; 14:21; 14:25**  
Invalidity and noninfringement, declaratory judgment, **20:133**  
Jurisdiction, **24:6**  
Summary judgment, **12:15**

### **WARNER-JENKINSON**

Presumption, **9:209**

### **WARRANTY, BREACH OF**

Interference, **1:58**

### **WASH WORLD INC. V. BELANGER INC.**

2025, **23:105**

### **WATERMAN**

Generally, **15:9**

### **WEAKENED**

Presumption of validity, **13:81**

### **WEBER, INC. V. PROVISUR TECHNOLOGIES, INC.**

2024, **23:103**

### **WEEKEND OR HOLIDAY**

Timely appeal, failure to file, **23:28**

### **WEIGHT AND CREDIBILITY OF EVIDENCE**

Generally, **19:57; 22:27**  
Agency regulations and pronouncements, **20:28**

### **WEIGHT AND CREDIBILITY OF EVIDENCE—Cont’d**

Determinations, **4:41; 6:28**  
Obviousness, **1:30; 3:165; 13:84; 16:19**  
Reviewability, **8:31**  
Sec. 284, **2:31**  
Secondary considerations, **18:28**  
Special province of trier of fact, **18:12**  
Trial court, **14:10**  
Trial judge, **19:54**  
Trier of fact, special province of, **18:12**

### **WELL-ESTABLISHED COMMON LAW PRINCIPLES**

Presumption, **9:154**

### **WELL-KNOWN AND ROUTINELY BUILT**

Conclusory statements, **9:113**

### **WELL-PLEADED COMPLAINT**

Generally, **1:76; 8:66; 12:44; 13:107; 19:55**  
Counterclaim included, **2:31**  
Jurisdiction, **1:135; 1:160**  
Sec. 41(a)(7), **13:32**  
Transfer of appeal, **7:14**

### **WELL-UNDERSTOOD, ROUTINE AND CONVENTIONAL**

Fact question, skilled artisan, **1:311**

### **WHEREBY CLAUSE**

Claim construction, **8:91; 20:29**  
Means-plus-function claim, **12:62**

### **WHOLE INVENTION**

Claim interpretation, statements describing whole invention, **22:32**

### **WHOLE OF STATUTE TO BE CONSIDERED**

Statutory construction, **19:77**

### **WIDE DISCRETION**

JMOL, **26:9**

### **WILLFUL BLINDNESS**

Inducement, **7:103**

### **WILLFUL CONTEMPT ORDER**

Sec. 271(e)(1), **5:13**

### **WILLFUL INFRINGEMENT**

Generally, **1:152; 2:33; 3:2; 6:59; 8:133; 13:126**

**WILLFUL INFRINGEMENT—Cont'd**

Actual knowledge of infringer, **14:24**  
 Actual notice creates affirmative duty, **3:80**  
 Advice of counsel, **14:5; 19:154**  
 Affirmative duty, **18:29**  
 Appealable issue, **3:26**  
**Attorneys** (this index)  
 Avoidance of literal infringement factor, **23:50**  
 Bad faith not required, **10:21**  
 Burden, **16:22**  
 Clear and convincing evidence required, **16:129; 20:39**  
 Clearly erroneous standard, **19:23**  
 Conception, **2:164**  
 Copying, **8:47**  
**Damages** (this index)  
 Designing around, **19:52**  
 Directed verdict, **16:22**  
 Enhanced damages, **21:3; 23:85**  
 Equitable estoppel, **1:201**  
 Equivocal opinion of counsel, **23:26**  
 Factors, **19:101**  
 Fact question, **7:37; 8:52; 13:45; 16:40**  
 Flawed opinion of counsel, **19:92**  
 FRCP 52(a), **1:18**  
 FRCP 59, **3:26**  
 Increased damages, **15:14**  
 Injunction, **9:323; 16:5**  
 Intent, **18:14**  
 Inventorship, **2:164**  
 Issue preclusion, **4:9**  
 Jury, fact findings of, **19:9**  
 Knowledge, actual knowledge of infringer, **14:24**  
 Lanham Act, **3:26**  
 Literal infringement, avoidance of, **23:50**  
 Means-plus-function, **18:17**  
 Motion for new trial, **16:22**  
 Negative finding reversed, **3:26**  
 New trial, **3:26; 16:22**  
 Notice, **3:80**  
 Obviousness, **8:129; 18:23**  
 Prevailing party, **19:259**  
 Privity, **11:14**  
 Reissue, **11:5**  
 Reversal, negative finding reversed, **3:26**

**WILLFUL INFRINGEMENT—Cont'd**

Review, standard of, **19:96**  
 Sec. 43(a), **3:26**  
 Sec. 112, **15:2; 19:7**  
 Sec. 284, **4:32; 5:19; 7:12; 7:27; 8:123; 9:323; 19:57**  
 Sec. 285, **1:201; 2:170; 7:20; 15:6; 19:28**  
 Stipulation, **12:24**  
 Totality of circumstances, **1:58; 11:18; 11:56; 19:38**

**WILLFULNESS**

Generally, **2:80; 9:275**  
 Abbreviated new drug application (ANDA), **7:81**  
 All relevant aspects given appropriate weight, **19:129**  
 Appeal is review and not trial de novo, **6:12**  
 Attorney fees award, **19:103; 20:122**  
 Attorneys, opinion of counsel, **21:18**  
 Bifurcated trial, **17:3**  
 Defenses prepared for trial after notice, **3:96**  
 Enhanced damages, **12:47**  
 Factors, **14:18**  
 Infringement. **Willful Infringement** (this index)  
 Notice and knowledge, **3:51; 3:96**  
 Pending patent, defendant's knowledge of, **3:51**  
 Question of fact, **3:96**  
 Relevance, **19:129**  
 Review, standard of, **5:54**  
 Sec. 285, **2:34**  
 Summary judgment, **1:35; 1:222**

**WILLINGNESS**

Licenses, **13:75; 18:35**  
 Reasonable royalty rate, **19:38**

**WILSON HYPOTHETICAL CLAIM**

Generally, **13:93; 19:117**  
 Doctrine of equivalents, **3:52; 10:15; 11:22; 23:20**  
 Hypothetical claim, **9:146**  
 Prosecution history, does not address, **19:84**  
 Prosecution history estoppel, **7:28**

## INDEX

**WISCONSIN ALUMNI RESEARCH  
FOUNDATION V. APPLE INC.**  
2024, **23:104**

### **WITHDRAWAL**

Interference, **9:217**

### **WITHDRAWN CLAIMS**

Final judgment, **19:233**

Infringement, **7:10**

### **WITHHOLDING**

Admissibility of evidence withheld during PTO examination, **8:111**

Inequitable conduct, **1:187; 8:29; 8:62; 12:30**

Known or used by others, **3:2**

Prejudgment interest, **12:20**

### **WITHOUT NOTICE TO OTHER PARTY**

CAFC jurisdiction, **9:63**

### **WITHOUT-PREJUDICE DISMISSAL**

Choice of law, **8:82**

FRCP 12(b)(7), **21:56**

### **WITNESSES**

Claim interpretation, **10:22; 19:16; 22:17**

Claims determine what infringes patent, **9:4**

Conflicting testimony, credit one when, **7:47**

Corroboration, need for, **8:30**

Credit one when conflicting testimony, **7:47**

Damages, **7:11**

Doctrine of equivalents, **3:80**

Evidence, loss of, **14:11**

**Expert or Opinion Evidence** (this index)

Factfinder not obliged to accept or reject witness' testimony in toto, **8:31**

FRCP 52(a), **12:6**

Inequitable conduct, **11:4**

Inventor's declaration in conflict with prior deposition testimony, **19:62**

Inventor's testimony, **8:106**

Motion in limine, **7:26**

Observation of witnesses, **13:41**

Obviousness question, **16:19**

Oral testimony, **5:47; 10:31; 16:70; 19:12; 19:151**

### **WITNESSES—Cont'd**

Prejudgment interest, **14:5**

Rule of reason, **11:41**

Selection of one witness testimony over another, **14:5**

Senior party, **2:47**

Sufficient to establish damages, **7:11**

Summary judgment, **12:25; 21:7**

Test results, **8:30**

These, **13:34**

Trial judge is in best position to determine weight and credibility of testimony, **19:54**

Validity, **19:145; 23:48**

Writings, earlier, **14:12**

### **WORDS**

Cases not cited for mere words, **19:38**

Claim differentiation, **19:261**

Considered, context surrounding, **1:136**

Experienced in field of invention, **8:52**

Has many meanings in Patent Act, **9:136**

Means nothing outside claim, **16:11**

Misappropriated, **12:3**

No form of words necessary, **16:74**

Ordinary meaning, **10:24**

### **“WORK BETTER”**

Obviousness, **18:23**

### **WRIGHT**

Generally, **9:98**

### **WRITTEN ACTS AND MATTERS**

After-the-fact testimony of inventor, **14:12**

Agreements, **3:64; 23:21**

Court's findings and conclusions prepared by prevailing party, **21:2**

Decision, **2:193.70**

Description, **2:196; 2:198; 9:502; 10:52; 14:108**

**Description** (this index)

Failure to meet requirements, **21:67**

### **WUHAN HEALTHGEN**

**BIOTECHNOLOGY CORP. V.**

**INTERNATIONAL TRADE**

**COMMISSION**

2025, **23:106**

### **ZIRCON CORP. V. INTERNATIONAL TRADE COMMISSION**

2024, **26:17**

**ZYXEL COMMUNICATIONS CORP.  
V. UNM RAINFOREST  
INNOVATIONS**  
2024, **26:18**