Index

ABANDONMENT

Patentability, 3:3

Petition for express abandonment to avoid publication, App U4

Petition to revive, App Q, App U3, App U4

Records and recording, 5:7

Revival, 6:89

ABSTRACT

Disclosure, 1:54

ACCELERATED PROSECUTION

Generally, 5:23

Patent Prosecution Highway (PPH) Program, 5:26

Petition to support special handling, 5:25

Track I prioritized examination, 5:24

ADDRESS

Change of correspondence address, 5:22

Change of correspondence address application, App A14

Patent and Trademark Office (PTO), 5:39

ADEQUATE DESCRIPTION

Prosecution. 6:40

ADEQUATE DISCLOSURE

Computer programs, 1:49

AFCP 2.0

Pilot programs, request and certification, App FA

AFRICAN INTELLECTUAL PROPERTY ORGANIZATION (OAPI)

Patent Cooperation Treaty (PCT) (this index)

AFRICAN REGIONAL INDUSTRIAL PROPERTY ORGANIZATION (ARIPO)

Patent Cooperation Treaty (PCT) (this index)

AGENTS

English language declaration, App A3

Format, **1:3**

AGE OF INVENTOR

Records and recording, **5:25**

ALAPPAT

Computer-implemented inventions, 4:15

Mathematical algorithms, 4:15

ALICE CORP. AND SUBSEQUENT DECISIONS

Computer-implemented inventions, 4:12

ALICE CORP. AND SUBSEQUENT DECISIONS

—Cont'd

Mathematical algorithms, 4:12, 4:13

ALLOWANCE

Prosecution (this index)

ALLOWED APPLICATION FILE CHECK FORM

Generally, App V

ALTERNATIVE LANGUAGE

Claims, **2:9**

Responding to rejections under 35 U.S.C.A. § 112, paragraph 2, **6:48**

ALTERNATIVES TO APPEAL

Generally, 6:96

AMENDMENT

Generally, 10:2, App E

Claims, 2:25, 2:43

Design patents, 8:6

Discovery, 1:29

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., **2:43**

Format of application, 1:10

Infringement, 3:11

Patentability, 3:4

Prosecution

generally, 6:10, 6:13, 6:58, 6:61

inequitable conduct, avoiding, 6:83-6:85

substantive prosecution, 6:11-6:13

AMERICA INVENTS ACT (AIA)

First-to-file patent system, conversion to, 6:113

Micro entities, 5:3

Pre-AIA reissue application, App N1

Prosecution, third party prior art submissions under new 35 U.S.C.A.§ 122(e), **6:80**

Reissue application, pre-AIA, App N1

Reissue consent of assignee, App N5

Reissue declaration by assignee, App N4

Reissue declaration by inventor, App N3

Reissue transmittal, App N2

AMERICAN INVENTORS PROTECTION ACT OF 1999 (AIPA)

Records and recording, 5:1, 5:7, 5:33

AMINO ACIDS APPEAL AND REVIEW—Cont'd Pre-appeal brief conference, 6:95 Disclosure, 1:51 Records and recording, 5:12, 5:21 Federal Register, App B4 Rehearing, request for, 6:102 **AMUSEMENT** Reply brief, 6:98, App T3 Infringement, 3:19 Unity of invention, 6:9 **ANALOG** APPLICANT NUMBER Infringement, 3:17 Application data sheet, generally, 5:2 Prosecution, 6:61 APPLICATION DATA SHEET (ADS) **ANNUITIES** Generally, **5:2**, **5:15**, **App K** Patent Cooperation Treaty (PCT), 9:22 APPOINTMENT ANSWER Power of attorney, joint intervenors, App A13 Examiner's answer, 6:91 AS A WHOLE **ANTICIPATION** Infringement, 3:13 Patentability, 3:3 Patentability, 3:4 **APPARATUS** ASSIGNMENT Claims, 2:21, 2:24, 2:32, 2:36 Generally, 5:27-5:31 Computer programs, 2:32, 2:36 AIA reissue consent of assignee, App N5 Functional limitations in apparatus claims, 2:21 AIA reissue declaration by assignee, App N4 Limitations and restrictions, 2:24 Examiner, 5:21 Method, apparatus versus, 2:32 Recordation cover sheet (RCS), App O Responding to rejections under 35 U.S.C.A. § 112, ASSISTANCE WITH PROSECUTION paragraph 2, 6:54 Unity of invention, 6:4, 6:5 Patent Ombudsman pilot program, 1:57 APPEAL AND REVIEW AT&T CORP. v. EXCEL COMMUNICATIONS, INC. Generally, 6:90 et seq., 6:107 Computer-implemented inventions, **4:17** Alternatives, 6:96 Mathematical algorithms, 4:17 Appeal to Patent Trial and Appeal Board, 6:91, App NA Statutory subject matter, 4:17 Arguments, 6:99, 6:100 **ATTORNEYS** Board of Patent Appeals and Interferences, 6:101, 6:103 Format, 1:3 Infringement, 3:6 generally, 6:97, App T2 Patent Cooperation Treaty (PCT), 9:2 pre-appeal brief conference, 6:98 Prosecution, 6:79, 6:81, 6:89, 6:97 reply brief, 6:98, App T3 Decisions, 6:94, 6:101, 6:103 **AUTHORIZATION** Expedited patent appeal pilot program, 6:104 English language declaration, App A3 Fast Track Appeals Pilot Program, 6:102 **BEAUREGARD** Final review of allowed application, 6:112 Mathematical algorithms, 4:18 Hearings, 6:93, 6:100 Infringement, 3:11 BERKHEIMER GUIDELINES Inter partes review, 7:8 Examining procedure, App SA Judicial review, 6:92 **BEST MODE** Notice of appeal, App T1 Discovery, 1:35 Oral argument, 6:99, 6:100 Responding to rejections under 35 U.S.C.A. § 112, Oral hearing, 6:93 paragraph 1, 6:38

BILSKI

Computer-implemented inventions, 4:14

Mathematical algorithms, 4:14

Index-2

Patent Trial and Appeal Board generally, **6:91-6:94**, **App NA**

Pilot program, expedited patent appeal, 6:104

statistics, App MA

BIOLOGICAL MATERIAL

Disclosure, 1:52

BIOTECHNOLOGY

Patentability, **3:4** Process claims, **2:25**

BIOTECHNOLOGY PATENT PROTECTION ACT OF 1995

Claims, 2:25
Patentability, 3:4

BLOCK DIAGRAM

Computer programs, 1:44

Hardware-implementated system, 1:49

Responding to rejections under 35 U.S.C.A. § 112, paragraph 1, **6:40**

BOARD OF PATENT APPEALS AND INTERFERENCES

Decisions, **6:101**, **6:103**

Patent Trial and Appeal Board, 6:91-6:94, App NA

BRIEF

Appeal and Review (this index)

BUSINESS METHODS

Claims drafting, 2:37 Infringement, 3:18 Post-issuance, 7:1

Transitional program, 7:12

CALCULATION OF TERM

Wyeth forms, request for recalculation, App CA

CANADIAN INTELLECTUAL PROPERTY OFFICE (CIPO)

Patent Prosecution Highway (PPH) Program trial, 5:26

CASSIS

Patentability, 3:5

CD-R

Generally, 5:2

CDROM

Generally, **5:2** Patentability, **3:5**

CERTIFICATE OF CORRECTION

Generally, **App R**Post-issuance, **7:3**Prosecution, **6:88**

CERTIFICATION OF FACSIMILE TRANSMISSION

Generally, 5:20

CHALLENGES

Generally, **6:2**

CHANGE OR MODIFICATION

Correspondence address, **5:22**

Correspondence address application, App A14

Infringement, 3:10

Name, 5:30

Prosecution, 6:102

CHAPTER II INTERNATIONAL EXAMINATION

Patent Cooperation Treaty (PCT), 9:18

CHARACTERS

Claims, 2:30

CHARTS

Flow Charts (this index)

Patent Cooperation Treaty (PCT), chart of Paris Convention countries and two-letter codes, **App PCT1**

CHECK FORM

Allowed application, App V

CHEMICAL COMPONENTS AND COMPOUNDS

Claims, 2:15, 2:17

Combination of chemical components, 2:15

Format, 1:7

Markush claims, 2:17

Prosecution, 6:51, 6:52

Statutory subject matter, 4:2, 4:3, 4:4

CHINESE LANGUAGE DECLARATION

Power of attorney, App A10

CITATIONS

Post-issuance, 7:2

CIVILACTION

Generally, 6:103

CLAIMS

Generally, 2:1 et seq., 5:2

Alternative language, 2:9

Amendments, 2:25, 2:43

Apparatus, 2:21, 2:24, 2:32, 2:36

Background, Jepson claims, 2:16

Biotechnology Patent Protection Act of 1995, 2:25

Biotechnology process claims, 2:25

Body, generally, 2:5

Business methods, 2:37

Case studies, **2:40-2:42**

Characters relating elements in claims to elements in drawings, 2:30

Chemical cases, Markush claims, 2:17

Chemical components, combinations of, 2:15

Claim construction standard changes, PTAB, App XA

Clarification of Written Description Guidance For

Claims Drawn to Antibodies, App RA

Classifications, generally, 2:19-2:29

CLAIMS—Cont'd	CLAIMS—Cont'd
Combination claim, 2:4 , 2:5 , 2:15	Literal infringement, 2:43-2:45
Combination format, 2:36	Machines (this index)
Complete, 2:8	Markush claims, 2:17
Complex telecommunications invention, 2:42	Mathematical algorithms, 4:15, 4:19-4:21
Composed of as transitional words, 2:4	Means-plus-function, 2:18, 2:36
Composition of matter, 2:28	Mechanical invention, 2:41
Comprising as transitional word, 2:4	Method claims, 2:32, 2:35
Computer Hardware and Software (this index)	Multiple dependent claims, 2:12
Computer-Implemented Functional Claim Limitations	Novel portion, Jepson claims, 2:16
and 35 U.S.C. § 112, App BB	Physical elements or steps, combinations of, 2:15
Consisting essentially of as transitional words, 2:4	Post-issuance, 7:5
Consisting of as transitional words, 2:4	Practical claim drafting strategy, 2:39
Construction and interpretation, 2:9, 3:9	Preamble, 2:3
Correspondence of claims in Patent Prosecution	Presentation, 2:33
Highway Program, 5:26	Prior provisional application, benefit of, App WA
Cross-classification claims, 2:7	Process, 2:5, 2:23-2:25, 2:27
Definite, 2:9	Product-by-process, 2:29
Definition	Prosecution, 6:51 , 6:52 , 6:62
classifications, 2:19-2:29	Reference numerals in claims, 2:30
dependent claims, 2:11	Royalties, 2:38
external limitations, 2:13	Simple mechanical invention, 2:41
independent claims, 2:11	Single statutory class, 2:7
internal limitations, 2:13	Special considerations, generally, 2:31-2:37
machine, 2:20	Statutory class, 2:3
Dependency, 2:10-2:13	Statutory Subject Matter (this index)
Design patents, 8:12 , 8:16	Telecommunications, 2:42
Discovery, 1:26	Territorial considerations, 2:46
Drafting. See lines throughout this index topic	35 U.S.C.A., generally, 2:18-2:45
Drawing, 1:30, 2:30	37 C.F.R., 2:25
E-Commerce, 2:37, 2:46	Transitional word or phrase, 2:4
Electromechanical example, 2:44	Ultimate object of invention, 2:3
Electronics, 2:32	Value, 2:43
Equivalents, doctrine of, 2:43	CODES
External limitations, 2:13	Patent Cooperation Treaty (PCT), chart of Paris Conven-
Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 2:43	tion countries and two-letter codes, App PCT1
Format, generally, 1:4, 2:14-2:18	COMBINATION CLAIM
Functional language, 2:5	Generally, 2:4 , 2:5 , 2:15
Functional limitations in apparatus claims, 2:21	
Fundamentals, 2:6-2:9	COMBINATION FORMAT
Guidance on treatment of product and process claims in	Claims, 2:36
light of In re Ochiai, In re Brouwer and 35 U.S.C.	COMMERCIAL DATABASES
§ 103(b), App C	Patentability, 3:5
Independent claims, 2:11	COMMON OWNERSHIP OR INVENTORSHIP
Infringement (this index)	
Intended use, 2:3	Prosecution, 6:72, 6:73
Internal limitations, 2:13	Records and recording, 5:16
Internet, 2:46	COMMUNICATION
Jepson claims, 2:16	Patentability, 3:4
Language, 2:5, 2:9, 6:62	COMPETITOR
Limitations and restrictions, 2:13, 2:21, 2:24	Generally, 1:3
Emmations and restrictions, 2:13, 2:21, 2:24	Ocherally, 1.3

nfringement, 3:16 nterfacing, 1:46
Mathematical Algorithms (this index) Method claims, 2:32, 2:35 Matentability, 3:4 More sentation, 2:33 More cords and recording, 5:23, 10:3 More ignal timing, 1:47
tatutory subject matter, generally, 4:30 et seq. iming, 1:47 MPUTER-IMPLEMENTED INVENTIONS T&T Corp. v. Excel Communications, Inc., 4:17
seauregard, 4:18 Silski, 4:14 Composition of matter, 4:10 In re alappat, 4:15 Machines, 4:10 Manufacturing, 4:10 Mathematical algorithms, 4:10-4:21 TO interim examination guidelines, 4:19 tate Street Bank & Trust Co. v. Signature Financial Group, Inc., 4:16
NCLUSORY STATEMENTS rosecution, 6:42 NSENT AIA reissue consent of assignee, App N5 NSISTING ESSENTIALLY OF Fransitional words, 2:4
NSISTING OF Fransitional words, 2:4 NSTITUTIONAL LAW, ARTICLE I, SECTION 8 Generally, 1:1
NSTRUCTION AND INTERPRETATION Claims, 2:9 Infringement, 3:6, 3:9 Interpretation algorithms, 4:15 Interpretation of the content
NSULTANTS rosecution, 6:42 NTINUATION APPLICATIONS Generally, 5:5 CIP. Continuation-In-Part (CIP) (this index)

CONTINUATION APPLICATIONS—Cont'd

CPA. Continued Prosecution Application (CPA) (this index)

Discovery, 1:13

Format, **1:5**

Prosecution, 6:16, 6:59, 6:79

RCE. Continued Examination, Request For (RCE) (this index)

Responding to rejections over prior art, 6:59

CONTINUATION-IN-PART (CIP)

Generally, **5:4-5:6**

Format, **1:5**

Prosecution, 6:59, 6:79

CONTINUED EXAMINATION, REQUEST FOR (RCE)

Generally, 5:7

Rule 1.114 request for continued examination (RCE), EFS web version, **App Z6**

Rule 1.114 request for continued examination (RCE) transmittal sheet, **App Z5**

CONTINUED PROSECUTION APPLICATION (CPA)

Generally, 5:6, 5:7

Prosecution, 6:59, 6:65, 6:89

Rule 53(d) continued prosecution applications (CPA), 5:6

CONTINUOUS ACTIVITY OF INVENTION

Records and recording, 10:2

CONTRACTS AND AGREEMENTS

Discovery, 1:14

Hague Agreement, 8:20

CONTRIBUTORY INFRINGEMENT

Generally, 3:8

CONVERSION

Generally, 5:33

COOPERATIVE AGREEMENTS

Discovery, 1:14

COPENDING APPLICATIONS

Discovery, 1:13

COPYING

Infringement, 3:10

COPYRIGHT

Disclosure, identification of copyright, 1:18

Drawing, **1:33**

CORRECTIONS

Generally, App P

Certificate of Correction (this index)

Defects, 6:117

Index-6

CORRECTIONS—Cont'd

Inventorship, 6:86-6:88, App P

Issued patent, 7:5

Post-issuance, 7:3, 7:5

Prosecution, 6:63, 6:86-6:88, 6:117

CORRESPONDENCE

Address, 5:22

Change of correspondence address application, **App A14** Patent Prosecution Highway (PPH) Program claims, **5:26**

Status letter, 5:36

Transmittal letter, 9:12, App PCT2

COURT REVIEW

Prosecution, 6:92

COVER SHEETS

Assignment, **App O**

CREATE (COOPERATIVE RESEARCH AND TECHNOLOGY ENHANCEMENT) ACT

Disclosure, 1:15, 1:50

CREDIBILITY

Prosecution, 6:33, 6:42

CROSS-CLASSIFICATION

Claims, 2:7

CROSS-REFERENCE

Disclosure, 1:13

DATABASE

Generally, 5:2

DECISIONS

Appeal and review, **6:94**, **6:101**, **6:103**

Board of Patent Appeals and Interferences, **6:101**, **6:103** Memorandum to Patent Examining Corps, **App QA**

Modification, 6:102

Primary examiner, 6:90

Prosecution, 6:90, 6:102, App QA

DECLARATIONS

Generally, 5:2, 5:5

AIA reissue declaration by assignee, App N4

AIA reissue declaration by inventor, App N3

Chinese language declaration, App A10

Dutch language declaration, App A1

English language declaration, App A3

Filing without, **5:19**

Format of application, 1:8

French language declaration, App A4

German language declaration, App A5

Italian language declaration, App A6

Japanese language declaration, App A7

DECLARATIONS—Cont'd Version language declaration App A 11	DEMAND FOR EXAMINATION
Korean language declaration, App A11 Post-issuance, 7:5	Patent Cooperation Treaty (PCT), 9:7, 9:18, 9:19, App PCT4
Prosecution (this index)	
Russian language declaration, App A8	DEPENDENT CLAIMS
Spanish language declaration, App A2	Generally, 2:10-2:13
Supplemental declaration, App W	Multiple dependent claims, 2:12
Swedish language declaration, App A9	Prosecution, 6:58
37 C.F.R. 1.131, App I	DERIVATION
37 C.F.R. 1.132, App J	Prosecution, 6:114
DEDICATION TO PUBLIC	DESCRIPTION
Infringement, 3:15	Design patents, 8:11 , 8:16
	Disclosure (this index)
DEFECTS	Post-issuance, 7:5
Issued patent, correction, 7:5	Prosecution, 6:35 , 6:36 , 6:40
Prosecution, PTO initiated correction, 6:117	DESIGNING AROUND
Specification or drawing, 7:5	Infringement, 3:10
DEFENSES	DESIGN PATENT APPLICATION
Infringement, 3:18	Generally, 5:7, 8:1 et seq., App X1, App X3
Patentability, 3:3	Amendments, 8:6
Prosecution, 6:73	Claim, 8:12 , 8:16
DEFERRED EXAM	Complete article, 8:6
Request for, App U5	Computer icons, 8:7
Request for, App 03	Contents of application
DEFINITE	generally, 8:8-8:12
Claims, 2:9	claim, 8:12
DEFINITIONS	description, 8:11
Claims (this index)	drawing, 8:10 preamble, 8:9
Classifications, 2:19-2:29	Description, 8:11, 8:16
Dependent claims, 2:11	Drawing, 8:6 , 8:7 , 8:10
Essential material, 1:40	Embodiment of design invention, 8:18
External limitations, 2:13	English language declaration, App A3
Independent claims, 2:11	Examination, 8:19
Internal limitations, 2:13	Expedited examination, 8:19
Machine, 2:20	Functional design, 8:3
Micro entities, 5:3	Hague Agreement, 8:20
Nonessential material, 1:40	Hidden designs, 8:5
Novelty, 3:3	Infringement, 8:14
Patentability, 3:2	Limitations and restrictions, 8:18
Patent Cooperation Treaty (PCT), 9:2	Manual of Patent Examining procedure, 8:7
Prima facie case, 6:79	Manufacture
Printed publication, 3:3	article of, 8:4
Program as process, 4:21	design of portion of article of, 8:6
Program as product, 4:20	Movable parts, article with, 8:4
	Novelty, 8:13, 8:17
DELAY	Obviousness, 8:17
Generally, 5:13 , 5:21	Ornamental design, 8:2, 8:3
Patent Cooperation Treaty (PCT), 9:4	Patentable subject matter
Unintentional, 7:4	generally, 8:2-8:7

DESIGN PATENT APPLICATION—Cont'd	DISCLOSURE—Cont'd
Patentable subject matter—Cont'd	Description—Cont'd
computer icons, 8:7	post description summary, 1:53
hidden designs, 8:5	related art, 1:19
manufacture, design of portion of article of, 8:6	Detailed description of preferred embodiments of inven-
movable parts, article with, 8:4	tion
ornamental versus functional, 8:3	generally, 1:35 et seq.
Portion of article of manufacture, design of, 8:6	avoiding limiting effect of description, 1:36
Preamble, 8:9	incorporation by reference
Prosecution, 8:15-8:18 , App X2	generally, 1:39-1:41
PTO Board of Patent Appeals and Interferences, 8:7	rules for, 1:40, 1:41
Specification and claim, 8:16	language of description, 1:38
Surface indicia, 8:6	specific language, rules for incorporation by reference,
Written description, 8:16	1:41
DEVICE AND PROCESS	theory of invention, 1:37
Prosecution, 6:3	written description. See entries throughout this group
	Drawing (this index)
DIAGRAMS	Federally sponsored R&D, statement regarding, 1:14
Block Diagram (this index)	Federal Register, App B4
DIALOG	Field of invention, 1:17
Patentability, 3:5	Form of summary, 1:25
·	Identification, 1:18, 1:20, 1:34
DIGITAL	Incorporation by reference, 1:39-1:41
Infringement, 3:17	Information disclosure statement, App D
DILIGENCE	Infringement, 3:11 , 3:15
Generally, 10:2	Joint research program
·	CREATE (Cooperative Research and Technology
DIRECT INFRINGEMENT	Enhancement) Act, 1:15, 1:50
Generally, 3:8	names of parties to, 1:15
DISCLAIMER	Language, 1:38, 1:41
	Listings, 1:16, 1:51
Terminal Disclaimer (this index)	Manual of Patent Examining Procedure Rules, 1:54
DISCLOSURE	Mask work, identification of, 1:18
Generally, 1:11 et seq.	Mistake, 1:20
Abstract, 1:54	Names of parties to joint research program, 1:15
Amino acids, sequence listings for, 1:51	Nucleotide containing cases, 1:51
Biological material, 1:52	Objects of invention, 1:22, 1:23
Brief description of drawing, 1:28	Post description summary, 1:53
Brief summary of invention, 1:24-1:27	Post summary statement, 1:27
Computer Hardware and Software (this index)	Preferred embodiments. Detailed description of preferred
Computer program listing, reference to, 1:16	embodiments of invention, above
Content of specification, 1:11 et seq.	Prior art, 1:20
Content of summary, 1:26	Prosecution (this index)
Copyright, identification of, 1:18	Records and recording, 5:2
CREATE (Cooperative Research and Technology	Reference, 1:39-1:41
Enhancement) Act, 1:15, 1:50	Related art, description, 1:19
Cross-reference to related applications, 1:13	Replacing objects with advantages, 1:23
Deposit of biological material, 1:52	Research and development, 1:14, 1:15
Description	Rules for incorporation by reference, 1:40, 1:41
detailed description of preferred embodiments of	Sequence listings, 1:16, 1:51
invention, below	Specific language, rules for incorporation by reference,
drawing, brief description of, 1:28	1:41

DISCLOSURE—Cont'd Summary, 1:24-1:27, 1:53	DIVISIONAL APPLICATIONS—Cont'd Format, 1:5
Tables, reference to, 1:16 Theory of invention, 1:37 35 U.S.C.A., generally, 1:21 et seq. 37 C.F.R., 1:29, 1:51, 1:52 Time, 1:1	DOCUMENTS AND DOCUMENTATION Generally, 10:3 See also Records and Recording (this index) "Kind codes" in PTO patent documents, App D1
Title of invention, 1:12 Trade secret information, avoiding disclosure of, 1:55 Written description. Detailed description of preferred	DOING BUSINESS Responding to rejections under 35 U.S.C.A. § 101, 6:27 DOMESTIC ACTS AND MATTERS
embodiments of invention, above	Foreign Countries (this index)
Advantages, 1:23, 1:27 Amendments, 1:29	DOUBLE PATENTING Prosecution, 6:75-6:78
Best mode for practicing invention, 1:35 Block diagram, 1:49 Charts, 1:32, 1:49 Claims, independent and significant dependent, 1:26	DRAFTS AND DRAFTING Claims (this index) Infringement, 3:6, 3:8, 3:11 Patentability, 3:5
Continuation application, 1:13 Copending applications, 1:13 Definitions, 1:40 Diagrams, 1:29 Essential material, 1:40 Flow charts, 1:32, 1:49 General Agreements of Tariff and Trade (GATT), 1:13 Hardware-implementated system, block diagram, 1:49 Identification of earlier filed applications, 1:13 Incorporation by reference, 1:52 Integrated circuit layout design, 1:33 Language, 1:29 Manufacturing, 1:30 Mechanical applications, 1:29 Mistaken prior art, 1:20 Nonessential material, 1:40 Objectives, 1:22 Petition, 1:29 Photographs, 1:29 Plain language, 1:38 Program code, 1:33 Program-implemented system, flow chart, 1:49	Claims, 1:30, 2:30 Computer implementations, 1:32 Copyright or mask work notice, 1:33 Design patents, 8:6, 8:7, 8:10 Disclosure generally, 1:29-1:34 brief description of drawing, 1:28 claims, relationship between drawing and, 1:30 computer implementations, 1:32 copyright or mask work notice, 1:33 identification of waveforms and signals, 1:34 prior art figures, 1:31 Discovery, 1:29 Format of application, 1:7 Identification of waveforms and signals, 1:34 Mask work, 1:33 Notice, 1:33 Patentability, 3:3 Post-issuance, 7:5 Prior art figures, 1:31 Signals, 1:34 Waveforms, 1:34
Records and recording, 1:13, 1:29 Reference characters, 1:29 Sequence of operations, 1:32	DUTCH LANGUAGE DECLARATION Power of attorney, App A1
35 U.S.C.A., 1:35 Time, 1:13	E-COMMERCE Claims, 2:37, 2:46
DISTRICT COURT OF DISTRICT OF COLUMBIA Prosecution, 6:103	EFFECTIVE AMOUNT Prosecution, 6:51
DIVISIONAL APPLICATIONS Generally, 5:4, 5:5, 5:17	EFS-WEB Generally, App BA

EFS-WEB—Cont'd

Electronic filing, 5:2

Frequently asked questions, 5:2

Rule 1.114 request for continued examination (RCE),

EFS web version, App Z6

Rule 53(c) provisional application transmittal sheet, EFS web version, **App Z2**

ELECTION OF SPECIES

Prosecution, 6:8

ELECTRICAL DRAWINGS

Format, **1:7**

ELECTROMECHANICAL CLAIMS

Example, 2:44

ELECTRONIC FILING SYSTEM (EFS)

Generally, 5:34

User guide, App BA

ELECTRONICS

Claims, 2:32

Patentability, 3:4

Records and recording, 5:23

Retrieval of electronic priority applications, App Z3

EMBODIMENT

Design patents, 8:18

Infringement, 3:11

Patentability, 3:3

Prosecution, 6:8

EMPLOYMENT

Exceptions, 5:28

Patentability, 3:4

ENABLEMENT REQUIREMENT

Prosecution, 6:37

ENERGY

Records and recording, 5:25

ENFORCEMENT

Format, 1:4

Records and recording, 5:17

ENGINEERING

Records and recording, 10:3

ENGLISH LANGUAGE DECLARATION

Utility or design patent application, power of attorney or authorization of agent, **App A3**

ENVIRONMENTAL QUALITY

Records and recording, 5:25

EQUIVALENTS, DOCTRINE OF

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., **2:43**

Infringement, 3:10, 3:12

ERROR

Mistake or Error (this index)

ESSENTIAL MATERIAL

Discovery, 1:40

ESTOPPEL

Infringement, 3:11

EURASIAN PATENT CONVENTION (EA)

Patent Cooperation Treaty (PCT) (this index)

EUROPEAN PATENT CONVENTION (EPC)

Patent Cooperation Treaty (PCT) (this index)

EUROPEAN PATENT OFFICE (EPO)

Patent Cooperation Treaty (PCT), 9:3, 9:7

Prosecution, 6:79

EVIDENCE

Infringement, 3:10

Patentability, public use, 3:3

Prosecution, 6:33

Records and recording, establishing proof of invention, 10:2

EXAMINATION AND EXAMINERS

Chapter II international examination, 9:18

Demand for international examination, 9:18

Design patents, 8:19

Expedited examination, 8:19

Fees, 5:2

Infringement, 3:11

International examination, 9:19

International preliminary examination, demand for, 9:7

Manual of Patent Examining Procedure (MPEP),

selected provisions of, App B3

Mathematical algorithms, 4:19-4:21

Patent Cooperation Treaty (PCT), 9:7, 9:18, 9:19

Preliminary examination report, 9:7

Preliminary examining authority, 9:18

Prosecution (this index)

PTO interim examination guidelines, 4:19

Records and recording, 5:2, 5:21, 5:33

Request for deferred exam, App U5

Rule 1.114 request for continued examination (RCE),

EFS web version, App Z6

Rule 1.114 request for continued examination (RCE)

transmittal sheet, App Z5

Supplemental examination, 7:10

Track I prioritized examination, 5:24

EXAMINATION REPORT

Patent Cooperation Treaty (PCT), App PCT5

EXAMINER'S ACTION

Office Action (this index)

EXCEPTIONS AND EXCLUSIONS

Infringement, 3:19

Patent Cooperation Treaty (PCT), 9:6, 9:7, 9:20

Records and recording, **5:28**Statutory subject matter, **4:2**, **4:3**

EXECUTION

Generally, 5:5

Format, **1:8**

EX PARTE QUAYLE ACTIONS

Prosecution, 6:106

EX PARTE REEXAMINATION

Generally, 7:6

EXPEDITED EXAMINATION

Design patents, 8:19

EXPERIMENTAL USE

Infringement, 3:19

EXPIRATION OF PATENT

Generally, 7:4

EXPUNGEMENT

Prosecution, expungement of information from file, 6:119

EXTENSIONS OF TIME

Patent term, 7:7

Prosecution, 6:14

EXTERNAL LIMITATIONS

Claims, 2:13

FACSIMILE

Signatures, 5:20

FAILURE, AVOIDING

Prosecution, 6:42

FEDERAL CIRCUIT COURT OF APPEALS

Generally, 6:103

FEDERAL HOLIDAYS

2020, 5:40

FEDERALLY SPONSORED R&D

Disclosure, 1:14

FEDERAL REGISTER

Notice of requirements for patent applications containing nucleotide sequence and/or amino acid disclosures,

App B4

FEES

Allowance, 6:108-6:111

Examination fee. 5:2

Filing fee, generally, 5:2, 5:19

Inequitable conduct, avoiding, 6:84, 6:85

Issue fees, generally, 6:79

Late payment of issue fee, 6:110

Maintenance fee payment, 7:4

Micro entities, 5:3

Notice of allowance and before payment of issue fee,

amendment of claims following, **6:84**Patent Cooperation Treaty (PCT), **9:1**, **9:11**, **9:18**

Payment

generally, 5:25, 5:38

amendment of claims following payment issue fee but

prior to issuance, 6:85

issue fee, **6:85**, **6:108**, **6:109**

Post-issuance, 7:4, 7:6

Prosecution

allowance, 6:108-6:111

inequitable conduct, avoiding, 6:84, 6:85

issue fees, 6:79

Records and recording

generally, 5:7, 5:33

examination fee, 5:2

filing fee, **5:2**, **5:19**

payment of fees, 5:25, 5:38

search fee. 5:2

Refund of issue fee, 6:111

Reinstatement fee. 7:4

Search fee. 5:2

Small entity amount issue fee, error in paying, 6:109

2020 schedule, App F

FESTO CORP. v. SHOKETSU KINZOKU KOGYO KABUSHIKI CO.

Claims, 2:43

Infringement, 3:11

FIELD OF INVENTION

Disclosure, 1:17

FILE WRAPPER CONTINUATION (FWC) APPLICATION

Generally, **5:4**

FILE WRAPPER ESTOPPEL

Prosecution, 6:61

FILING

Records and Recording (this index)

FINAL REJECTION

Prosecution, **6:65**, **6:66**

FINAL REVIEW

Prosecution. 6:112

FIRST ACTION INTERVIEW PROGRAM

Form, request for participation, App DA Pilot program, 6:122

FIRST INVENTOR DEFENSE

Infringement, 3:18

FIRST TO FILE PATENT SYSTEM

Conversion to, 6:113

FLOW CHARTS

Disclosure, 1:45 Discovery, 1:32, 1:49 Prosecution, 6:41

FOREIGN COUNTRIES

Prosecution, **6:69**, **6:70**

Records and recording, 5:14, 5:15, 5:34

FOREIGN LANGUAGE

Prosecution, 6:79

Records and recording, 5:18

FOREIGN PATENT APPLICATIONS

Patentability, 3:3

Prosecution, 6:70, 6:71, 6:79

Records and recording, 5:14, 5:16, 10:2

Revival of application for patent abandoned for failure to notify office of foreign or international filing, petition for, App U3

FOREIGN PRIORITY

Generally, 5:15

FORMAT

Generally, 1:1-1:10

Agents, 1:3

Amendments, 1:10, 6:12

Attorneys, 1:3

Chemical applications, 1:7

Claims (this index)

Competitor, 1:3

Continuation applications, 1:5

Continuation-in-part (CIP), 1:5

Declaration, 1:8

Divisional applications, 1:5

Drawings, 1:7

Electrical drawings, 1:7

Enforcement, 1:4

Execution of declaration by inventor, 1:8

Infringement, 1:4

Judge, 1:3

Jury member, 1:3

Mechanical drawings, 1:7

FORMAT—Cont'd

Notary public, 1:8

Oath, notarization of, 1:8

Patent agent, 1:3

Patent attorneys, 1:3

Patent examiner, 1:3

Power of attorney, 1:9

Prior art, 1:4

Professional searcher, 1:3

Prospective competitor, 1:3

Provisional applications, 1:5

Readers of application, 1:3

Registered representative, 1:9

Rule § 1:76, **1:6**

Skill in relevant art, 1:3

Substitute applications, 1:5

35 U.S.C.A., 1:5

Value, 1:4

Variation, 1:10

FORM PTOL-413A

Generally, 6:15

FORMS

Allowed application file check form, App V

Demand form, App PCT4

First action interview program, request for participation,

App DA

International application transmittal letter and request form, App PCT2

Patent Cooperation Treaty (PCT), App PCT2, App PCT4

Transmittal Form (this index)

Wyeth forms for recalculation of patent term, App CA

FRENCH LANGUAGE DECLARATION

Power of attorney, App A4

FUNCTIONAL CLAIM

Prosecution, 6:51, 6:52, 6:55, 6:56

FUNCTIONAL DESIGN

Patentable subject matter, 8:3

FUNCTIONAL LANGUAGE

Claims, 2:5

FUNCTIONAL LIMITATIONS

Apparatus claims, 2:21

FUNCTION-WAY-RESULT TEST

Infringement, 3:10

GENERAL AGREEMENTS OF TARIFF AND TRADE (GATT)

Discovery, 1:13

Prosecution, **6:2**, **6:60**

GENERAL AGREEMENTS OF TARIFF AND TRADE (GATT)—Cont'd

Records and recording, 5:33

GENERAL UTILITY REQUIREMENT

Statutory subject matter, 4:2, 4:3

GERMAN LANGUAGE DECLARATION

Power of attorney, App A5

GLOSSARY

Generally, App CC

Prosecution, first action interview pilot program, 6:122

GOOD FAITH

Infringement, 3:10

Records and recording, 5:32

GUARANTEE

Records and recording, 5:13

GUIDES AND GUIDELINES

Berkheimer guidelines, 4:6

Computer-implemented inventions, prosecution guidelines for examination, **6:32**

Electronic filing system (EFS), user guide, App BA

Mathematical algorithms, PTO, 4:19-4:21

Statutory subject matter, 4:4, 4:5, 4:7, 4:8, 4:9, App HA,

App IA, App OA

HAGUE AGREEMENT

Design patent application, 8:20

HANDLING

Patent Prosecution Highway (PPH) Program, **5:26** Petition to support special handling, **5:25**

HARVESTING TECHNOLOGY

Generally, 1:56

HEARINGS

Appeal and review, **6:93**, **6:100**

Prosecution, **6:94**, **6:99**, **6:100**

Request for rehearing, 6:102

HIDDEN DESIGNS

Patentable subject matter, 8:5

HISTORY ESTOPPEL

Infringement, 3:11

HOLIDAYS

2020 federal holidays, 5:40

HUMAN ORGANISM

Statutory subject matter, 4:33

IDENTIFICATION

Disclosure, 1:18, 1:20, 1:34

Discovery, 1:13

IDENTIFICATION—Cont'd

Drawing, **1:34**

IDLE CURIOSITY

Infringement, 3:19

IGNORANCE OF PURCHASER

Patentability, 3:3

IMMORAL INVENTIONS

Statutory subject matter, 4:2, 4:3

INADEQUATE DISCLOSURE

Prosecution (this index)

INCOMPLETE RESPONSE

Prosecution, 6:64

INCORPORATION BY REFERENCE

Disclosure, 1:39-1:41

Discovery, 1:52

INDEFINITE ARTICLES

Prosecution. **6:47**

INDEPENDENT CLAIMS

Generally, 2:11

INDEPENDENT CONSULTANTS

Prosecution, **6:42**

INDEPENDENT INVENTION

Infringement, 3:10

INDEPENDENT INVENTOR

Records and recording, 5:32

INDEPENDENT PHYSICAL ACTS

Statutory subject matter, 4:28

INDUCED INFRINGEMENT

Generally, 3:8

INDUSTRIAL PROPERTY

States party to Paris Convention, App PCT1A

INEQUITABLE CONDUCT

Prosecution (this index)

INFORMATION DISCLOSURE STATEMENT

Generally, App D

Prosecution, 6:79

INFRINGEMENT

Generally, 3:6-3:19

Amendments, 3:11

Amusement, 3:19

Analog versus digital, 3:17

Appeals, 3:11

As a whole, **3:13**

Attorneys, 3:6

INFRINGEMENT—Cont'd	INFRINGEMENT—Cont'd
Business method patents, 3:18	Strictly philosophical inquiry, 3:19
Change or modification, 3:10	Tests, 3:10
Claims	35 U.S.C.A., generally, 3:7-3:18
generally, 3:7 , 3:8 , 3:17	Tripartite test, 3:10
construction and interpretation, 3:9	INHERENT FUNCTION
drafting broad claim for literal infringement, 2:43 -2:45	Prosecution, 6:54
Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki	IN RE ALAPPAT
Co., 2:43	Mathematical algorithms, 4:15
Computers, 3:16	IN RE BEAUREGARD
Construction and interpretation, 3:6 , 3:9	Computer-implemented inventions, 4:18
Contributory infringement, 3:8	Mathematical algorithms, 4:18
Copying, 3:10	•
Dedication to public, 3:15	IN RE BILSKI
Defenses, 3:18	Mathematical algorithms, 4:14
Designing around, 3:10	IN RE BROUWER
Design patents, 8:14	Guidance on treatment of product and process claims.
Digital, 3:17	App C
Direct infringement, 3:8	
Disclosure, 3:11, 3:15	IN RE OCHIAI
Drafting, 3:6, 3:8, 3:11	Guidance on treatment of product and process claims.
Embodiment disclosure, 3:11	App C
Equivalents, doctrine of, 3:10, 3:12	INOPERATIVENESS
Estoppel, 3:11	Claims, 7:5
Evidence, 3:10	Prosecution, 6:44
Examiner, 3:11 Example 2:10	Statutory subject matter, 4:2, 4:3
Exceptions, 3:19 Experimental use, 3:19	INSUBSTANTIAL CHANGE
Festo, 3:11	Infringement, 3:10
First inventor defense, 3:18	initing chiche, 3.10
Format, 1:4	INTEGRATED CIRCUIT LAYOUT DESIGN
Function-way-result test, 3:10	Discovery, 1:33
Good faith, 3:10	INTENT
Hardware versus software, 3:16	Claims, 2:3
History estoppel, 3:11	Infringement, 3:10
Idle curiosity, 3:19	Post-issuance, 7:4
Independent invention, 3:10	Prosecution, 6:52 , 6:89
Induced infringement, 3:8	
Insubstantial change, 3:10	INTERCHANGEABILITY
Intent, 3:10	Infringement, 3:10
Interchangeability, 3:10	INTERFACING
Limitations and restrictions, 3:13 , 3:16	Disclosure, 1:46
Literal infringement, 3:9, 3:10	
Notice and knowledge, 3:6	INTERFERENCE
Pennwalt Corp. v. Durand-Wayland, Inc., 3:13	Generally, 6:113
Post-issuance, 7:6	Appeal and Review (this index)
PTO, 3:6	Proof of invention, interference, 10:2
Public, dedication to, 3:15	Prosecution, 6:113
Records and recording, 5:25	Records and recording, 5:11, 10:2
Scientific inquiries, 3:19	INTERIM EXAMINATION
Software versus hardware, 3:16	Instruction, subject matter eligibility, App AA
bottmare versus maraware, 3.10	moduction, subject matter engineers, App AA

INTERMEDIATE AND PRODUCT

Prosecution, **6:7**

INTERNAL LIMITATIONS

Claims, 2:13

INTERNATIONAL ACTS AND MATTERS

Patent Cooperation Treaty (PCT) (this index) Preliminary examination report, **App PCT5**

Preliminary report on patentability, App PCT6

Records and recording, 5:7

Revival of application for patent abandoned for failure to notify office of foreign or international filing, petition for, App U3

Search report, App PCT3
Transmittal letter, App PCT2

Written opinion, international search and, 9:15

INTERNET

Claims, 2:46

EFS-Web (this index)

Patent prosecution highway (pph) program web site, **5:26**

INTER PARTES REEXAMINATION

Generally, 7:6

INTER PARTES REVIEW

Post-issuance, 7:8

INTERVENING RIGHTS

Post-issuance, 7:6

INTERVENORS

Power of attorney, App A13

INTERVIEWS

Prosecution (this index)

INVENTOR-AUTHORED PUBLICATIONS

Prosecution, **6:72**

ISDN APPLICATION

Case study, App G

ITALIAN LANGUAGE DECLARATION

Power of attorney, **App A6**

JAPANESE LANGUAGE DECLARATION

Power of attorney, App A7

JAPANESE PATENT OFFICE (JPO)

Patent Prosecution Highway (PPH) Program requirements, 5:26

Request for PPH between JPO and USPTO, App Z4

JEPSON CLAIMS

Generally, 2:16

JOINT DEVELOPERS

Patentability, 3:3

JOINT INVENTORS

Records and recording, 5:17

JOINT RESEARCH PROGRAM

Disclosure (this index)

JUDGE

Format, 1:3

JUDICIAL REVIEW

Prosecution, 6:92

JURY MEMBER

Format, 1:3

"KIND CODES"

PTO patent documents, App D1

KOREAN INTELLECTUAL PROPERTY OFFICE (KIPO)

Patent Prosecution Highway (PPH) Program trial, 5:26

KOREAN LANGUAGE DECLARATION

Generally, App A11

LABORATORY NOTEBOOKS

Generally, 10:3

LANGUAGE

Chinese language declaration, App A10

Claims, 2:5, 2:9

Disclosure, 1:38, 1:41

Discovery, 1:29

Dutch language declaration, App A1

English language declaration, App A3

Foreign language, generally, 5:18

French language declaration, App A4

German language declaration, App A5

Italian language declaration, App A6

Japanese language declaration, App A7

Korean language declaration. App A11

Korean language declaration, App A11

Patent Prosecution Highway (PPH) Program translations, 5:26

Prosecution, 6:48, 6:50, 6:62

Records and recording, 5:18

Russian language declaration, App A8

Spanish language declaration, App A2

Swedish language declaration, App A9

LATE PAYMENT

Prosecution, 6:110

LAWS OF NATURE

Prosecution, 6:31

Statutory subject matter, 4:26

LEAHY-SMITH AMERICA INVENTS ACT

America Invents Act (AIA) (this index)

LETTERS AND CORRESPONDENCE

Change of correspondence address application, App A14

LEXIS

Patentability, 3:5

LIBRARIES

Patentability, 3:5

LICENSING AND REVIEW BRANCH

Generally, 5:21

LIMITATIONS AND RESTRICTIONS

Apparatus limitations in process claims, 2:24

Claims, 2:13, 2:21, 2:24 Design patents, 8:18

External limitations, 2:13

Functional limitations in apparatus claims, 2:21

Infringement, 3:13, 3:16 Internal limitations, 2:13

Mathematical algorithms, 4:15, 4:19 Means-plus-function limitations, 4:15

Post-issuance, 7:6 Prosecution (this index)

LISTINGS

Disclosure, 1:16, 1:51

LITERAL INFRINGEMENT

Generally, 3:9 Avoidance of, 3:10 Claims, 2:43-2:45

LOST FILES

Generally, 5:37

LOST PARTS

Generally, **5:21**

MACHINE OPERATION

Claims, 2:26

MACHINES

Claims

generally, 2:4, 2:20, 2:21 combination claims on, 2:5

operation, 2:26

Computer-implemented inventions, **4:10** Mathematical algorithms, 4:10, 4:19

MAINTENANCE FEE

Payment, 7:4

MANUAL OF PATENT EXAMINING PROCEDURE (MPEP)

Generally, 5:22

MANUAL OF PATENT EXAMINING PROCEDURE

(MPEP)—Cont'd

Design patents, 8:7 Disclosure, 1:54 Prosecution, 6:15

Selected provisions of, App B3

MANUFACTURING

Computer-implemented inventions, **4:10**

Design patents, 8:4, 8:6

Discovery, 1:30

Mathematical algorithms, 4:10

Prosecution, 6:32

Records and recording, 5:25

MARKUSH CLAIMS

Generally, 2:17

MASK WORK

Disclosure, identification of mask work, 1:18

Drawing, **1:33**

MATHEMATICAL ALGORITHMS

Generally, 4:10-4:21

Alappat, **4:15**

AT&T Corp. v. Excel Communications, Inc., 4:17

Beauregard, 4:18 Bilski, 4:14

Claims, 4:15, 4:19-4:21 Composition of matter, 4:19

Computer-implemented inventions, generally, 4:10-4:21

Construction and interpretation, 4:15 Court decisions, generally, 4:11-4:18

Examination, 4:19-4:21 In re Alappat, 4:15 In re Beauregard, 4:18 In re Bilski, 4:14

Limitations and restrictions, 4:15, 4:19

Machines, 4:19 Manufacturing, 4:19

Means-plus-function limitations, 4:15

Process, program as, 4:21 Product, program as, 4:20 Prosecution, 6:26

PTO interim examination guidelines, 4:19

process, program as, 4:21 product, program as, 4:20

State Street Bank & Trust Co. v. Signature Financial

Group, Inc., 4:16

Statutory subject matter, generally, 4:10-4:21

35 U.S.C.A. § 101, **4:19**

Validity, 4:16

MEANS-PLUS-FUNCTION

Claims, 2:18, 2:36

MEANS-PLUS-FUNCTION—Cont'd

Mathematical algorithms, 4:15

Prosecution. 6:62

MECHANICAL APPLICATIONS

Discovery, 1:29

MECHANICAL DRAWINGS

Format, **1:7**

MECHANICAL INVENTION

Claims, 2:41

MENTAL CONCEPTION OF INVENTION

Generally, 10:2

MENTAL STEPS

Prosecution, 6:28

Statutory subject matter, 4:23

MERGER

Records and recording, 5:30

METHOD

Claims, 2:32, 2:35

Computer programs, 2:32, 2:35

Prosecution, 6:27

MICRO ENTITIES

Fees reduction, 5:3

Records and recording, 5:3

MISTAKE OR ERROR

See also Corrections (this index)

Disclosure, 1:20

Discovery, 1:20

Post-issuance, 7:3, 7:5

Prosecution, 6:86-6:88, 6:109

Records and recording, 5:17, 5:32, 10:3

MODIFICATION

Change or Modification (this index)

MODIFIERS

Prosecution, 6:46

MOVABLE PARTS

Design patents, 8:4

MULTIPLE CONCURRENT REEXAMINATION **PROCEEDINGS**

Generally, 7:6

MULTIPLE DEPENDENT CLAIMS

Generally, 2:12

NAMES

Change of name, recordation of, 5:30

Disclosure, names of parties to joint research program,

1:15

NATIONAL PHASE

Patent Cooperation Treaty (PCT), 9:2, 9:17, 9:21

NATURE

Guidelines on eligibility, App IA

Prosecution, 6:30, 6:31

Statutory subject matter, 4:25

NEGATIVE LIMITATIONS

Prosecution, 6:49

NEGLIGENCE

Prosecution, 6:89

NEW GROUND OF REJECTION

Prosecution, 6:66

NEWLY DISCOVERED CITATIONS

Post-issuance, 7:2

NEWLY DISCOVERED PRODUCTS OF NATURE

Prosecution, 6:30

NEW MATTER

Prosecution, 6:13

NONESSENTIAL MATERIAL

Discovery, 1:40

NONOBVIOUS

Obvious and Nonobvious (this index)

NON-PROFIT ORGANIZATIONS

Records and recording, 5:32

NON-PROVISIONAL APPLICATION

Generally, 5:4, 5:14

Prosecution, 6:63, 6:87

NON-PUBLICATION

Request for non-publication, App U1

Request to rescind non-publication, App U2

NOTARY PUBLIC

Oath. 1:8

NOTICE AND KNOWLEDGE

Generally, 5:13, 5:21

Appeal and review, 6:91, App T1

Drawing, 1:33

Federal Register, App B4

Infringement, 3:6

Patentability, 3:3, 3:4

Prosecution, **6:84**, **6:108**

NOVELTY

Design patents, 8:13, 8:17

Jepson claims, 2:16

Patentability, 3:3, 3:4

Prosecution, 6:75

NUCLEOTIDE SEQUENCE

Disclosure, 1:51

Federal Register, App B4

OATH

Notarization of, 1:8

Post-issuance, 7:5

Records and recording, 5:2, 5:19

Supplemental oath or declaration, 6:105

OBJECTS OF INVENTION

Disclosure, 1:22, 1:23

OBVIOUS AND NONOBVIOUS

Design patents, 8:17

Patentability, 3:4

Prosecution, 6:58, 6:61, 6:75, 6:77

OED DIVERSION PILOT PROGRAM

Generally, App VA

OFFICE ACTIONS

Prosecution (this index)

OFFICE OF INITIAL PATENT EXAMINATION

(OIPE)

Generally, **5:21**

ON-BRIEF DOCKET

Prosecution, 6:94

ON BEHALF OF INVENTOR

Records and recording, 5:31

OPERATIONAL

Prosecution, 6:44

ORAL ARGUMENT

Appeal and review, **6:99**, **6:100**

ORAL HEARING

Appeal and review, 6:93

Prosecution, 6:94, 6:99, 6:100

ORDERS

Protective order materials, 6:82

Secrecy orders, 5:10

ORDINARY SKILL

Patentability, 3:4

ORIGINAL APPLICATION

Generally, 5:5, 5:37

Post-issuance, 7:5

Prosecution, 6:2

ORNAMENTAL DESIGN

Design patents, generally, 8:2

Patentable subject matter, 8:3

Index-18

PARIS

Patent Cooperation Treaty (PCT), App PCT1

States party to Paris Convention, App PCT1A

PARTIES

Third party patents, 7:6

PART OR PORTION

Continuation-In-Part (CIP) (this index)

Design patents, 8:4, 8:6

Records and recording, lost parts, 5:21

Tripartite test, 3:10

PATENTABILITY

Generally, **3:1-3:5**

Abandonment, 3:3

Act of 1995, **3:4**

Amendments, 3:4

Anticipation, 3:3

As a whole, **3:4**

Biotechnology, 3:4

CASSIS, 3:5

CDROM, **3:5**

Commercial databases, 3:5

Communication, 3:4

Computer implementations, 3:4

Defense to public use, 3:3

Definition

novelty, 3:3

printed publication, 3:3

statutory definition, 3:2

DIALOG, 3:5

Drafts, 3:5

Drawings, 3:3

Electronics, 3:4

Embodiment of invention, 3:3

Employment, communication between employees, 3:4

Evidence, public use, 3:3

Foreign patents, 3:3

Ignorance of purchaser, 3:3

Joint developers, 3:3

LEXIS, **3:5**

Libraries, 3:5

Notice and knowledge, 3:3, 3:4

Novelty, 3:3, 3:4

Obvious and nonobvious, 3:4

Ordinary skill, 3:4

Patent Cooperation Treaty (PCT), 9:1

preliminary report on patentability, App PCT6

Personal knowledge, 3:4

Printed publication defined, 3:3

Prior art, 3:3-3:5

Priority, 3:3

PATENT COOPERATION TREATY (PCT)—Cont'd PATENTABILITY—Cont'd Professional searcher, 3:5 European Patent Convention (EPC), generally, 9:1 Prosecution, 6:58, 6:67, 6:79, 6:82 European Patent Office (EPO), 9:3, 9:7 Publication, 3:3 Examination, 9:7, 9:18, 9:19 Public databases, 3:5 Exceptions, 9:6, 9:7, 9:20 Fees, 9:1, 9:11, 9:18 Public domain, 3:3 Public libraries, 3:5 Filing, advantages of, 9:4 Public use, 3:3 Filing software, PCT Easy and PCT Safe, 9:23 Initial processing, 9:13 Relevant prior art, 3:4 Sale of offer for sale, 3:3 International application, 9:7 Search. 3:5 International application transmittal letter and request form, App PCT2 Selected sections of Title 35 of U.S.C., App B1 International examination, 9:18, 9:19 Skill, 3:3, 3:4 International phase, 9:2 Statutory definition, 3:2 International preliminary examination, demand for, 9:7 Tests, 3:4 35 U.S.C.A., generally, **3:1** International preliminary examination authority (IPEA), Time, 3:3 International preliminary examination report, App PCT5 Usefulness, 3:4 International preliminary report on patentability, **App** Validity, 3:4 PCT6 PATENTABLE SUBJECT MATTER International search and written opinion, 9:15 Design Patents (this index) International search report, 9:7, App PCT3 National phase, 9:2, 9:17, 9:21 PATENT AGENT Patentability, 9:1 Agents (this index) Patent and Trademark Office (PTO), generally, 9:3 PATENT AND TRADEMARK OFFICE (PTO) Payment, 9:22 Generally, 1:1 Pre-filing considerations, 9:5, 9:6 Addresses, 5:39 Preliminary examination, 9:7 Third party lawsuits against PTO, 6:121 Preliminary examination report, 9:7 Preliminary examining authority, 9:18 PATENT ATTORNEYS Prior art effect of international filing, 9:6 Attorneys (this index) Priority, 9:4 PATENT BUSINESS GOALS (PBG) Publication, 9:7, 9:16 Post-issuance, 7:5 Records and recording, 5:34 Records and recording, 5:1 Reports and reporting, 9:7 Request, 9:10 PATENT COOPERATION TREATY (PCT) Search, 9:7, 9:15 Generally, 9:1 et seq. States party to PCT, App PCT1A African Intellectual Property Organization (OAPI), gen-Terminology, 9:2 erally, 9:1 Time, 9:17 African Regional Industrial Property Organization Transmittal letter, 9:12 (ARIPO), generally, 9:1 Unity of invention, 9:14 Amendments, 9:16 WIPO, 9:2, 9:3 Annuities, 9:22 Written opinion, 9:19 Application, generally, 9:9 Attorneys, 9:2 PATENT MAKING Chapter II international examination, 9:18

Chart of Paris Convention countries and two-letter codes,

App PCT1

Correspondence, 9:12

Demand, 9:7, 9:18, 9:19, App PCT4

Eurasian Patent Convention (EA), generally, 9:1

Delay, 9:4

Post-issuance, 7:9

PATENT OMBUDSMAN PILOT PROGRAM

Patent prosecution assistance, 1:57

PATENT PROSECUTION HIGHWAY (PPH) **PROGRAM**

Accelerated prosecution, 5:26

PATENT PROSECUTION HIGHWAY (PPH) PROGRAM—Cont'd

Request for PPH between Japanese Patent Office and USPTO, App Z4

Web site, **5:26**

PAYMENTS

Fees, generally, **5:25**, **5:38** Maintenance fee payment, **7:4**

Patent Cooperation Treaty (PCT), 9:22

Post-issuance, **7:4** Prosecution (this index)

PENDING ACTS AND MATTERS

Prosecution, 6:79, 6:91

Records and recording, 5:13, 5:23, 5:34

PENNWALT CORP. v. DURAND-WAYLAND, INC.

Infringement, 3:13

PERSONAL KNOWLEDGE

Patentability, 3:4

PERSONAL PROPERTY

Patents as, generally, 5:29

PETITION

Generally, **5:7** Discovery, **1:29**

Prosecution, 6:9, 6:89, 6:103, 6:116

Reinstate, 7:4

Revive abandoned application, App Q

Special handling, 5:25

PHARMACEUTICAL-RELATED INVENTIONS

Statutory subject matter, 4:2, 4:3

PHILOSOPHICAL INQUIRY

Infringement, 3:19

PHOTOGRAPHS

Discovery, 1:29

PHRASEOLOGY

Prosecution, 6:46

PHYSICAL ACTS

Statutory subject matter, 4:28

PHYSICAL ELEMENTS

Claims, 2:15

Records and recording, 10:2

PILOT PROGRAMS

Patent ombudsman, 1:57

Prosecution

expedited patent appeal patent program, 6:104

first action interview, 6:122

PILOT PROGRAMS—Cont'd

Request and certification AFCP 2.0, **App FA** QPIDS, **App GA**

PLAIN LANGUAGE

Discovery, 1:37

PLANT PATENT

Records and recording, 5:7

PORTION

Part of Portion (this index)

POST-GATT

Post-issuance, 7:5 Prosecution, 6:60

POST GRANT REVIEW

Post-issuance, 7:11

POST-ISSUANCE

Generally, 7:1 et seq.

Business method patents, 7:1 Certificate of correction, 7:3

Citations, 7:2 Claims, 7:5

Correction, 7:3, 7:5
Declaration, 7:5

Defect in issued patent, 7:5

Defective specification or drawing, 7:5

Delay as unintentional, 7:4

Description, 7:5 Drawing, 7:5

Ex parte reexamination, **7:6** Expiration of patent, **7:4** Extension of patent term, **7:7**

Fees, **7:4**, **7:6** Infringement, **7:6** Inoperative claims, **7:5**

Intent, **7:4**

Inter partes reexamination, **7:6** Inter partes review, **7:8** Intervening rights, **7:6**

Limitations and restrictions, **7:6** Maintenance fee payment, **7:4** Mistake or error, **7:3**, **7:5**

Multiple concurrent reexamination proceedings, 7:6

Newly discovered citations, 7:2

Oath, 7:5

Original application, 7:5

Patent Business Goals (PBG), 7:5

Patent making, **7:9** Payments, **7:4**

Petition to reinstate, 7:4

POST-ISSUANCE—Cont'd

Post-GATT, 7:5

Post grant review, 7:11

Prior art, 7:6

Records and recording, 7:5, 7:6

Reexamination, 7:6
Reinstatement fee, 7:4

Reissue, 7:5

Revival of application, 7:4

Specification, 7:5

Submission of information following issuance, 7:2

Supplemental examination, 7:10

Testing validity, 7:6

Third party patents, 7:6

Transitional program for business method patents, 7:12

Utility patents, maintenance fee payments, 7:4

Validity, 7:5, 7:6

Written description, 7:5

POWER OF ATTORNEY

Assignment, App A12

Change of correspondence address, App A14

Chinese language declaration, App A10

Dutch language declaration, App A1

English language declaration, App A3

Format of application, 1:9

French language declaration, App A4

German language declaration, App A5

Italian language declaration, App A6

Japanese language declaration, App A7

Joint intervenors, App A13

Korean language declaration, App A11

Records and recording, 5:22

Russian language declaration, App A8

Spanish language declaration, App A2

Swedish language declaration, App A9

USPTO prosecutions, App A12

PPH

Patent Prosecution Highway (PPH) Program, 5:26

PRACTICAL APPLICATION

Statutory subject matter, 4:29

PRACTICAL CLAIM DRAFTING

Strategy, 2:39

PREAMBLE

Claims, 2:3

Design patents, 8:9

PREFERRED EMBODIMENTS

Disclosure (this index)

PRELIMINARY EXAMINATION

Patent Cooperation Treaty (PCT), 9:7

PRELIMINARY EXAMINATION REPORT

Patent Cooperation Treaty (PCT), 9:7, App PCT5

PRELIMINARY EXAMINING AUTHORITY

Patent Cooperation Treaty (PCT), 9:18

PRELIMINARY REPORT ON PATENTABILITY

Patent Cooperation Treaty (PCT) international report, **App PCT6**

PREMATURE FINAL REJECTION

Prosecution. 6:66

PRESENTATION

Claims, 2:33

PRIMA FACIE CASE

Defined, 6:79

PRINTED MATTER

Patentability, 3:3

Prosecution, 6:29, 6:120

Statutory subject matter, 4:24

PRIOR ART

Disclosure, 1:20

Drawing, 1:31

Format, **1:4**

Identification of prior art, 1:20

Patentability, 3:3-3:5

Patent Cooperation Treaty (PCT), 9:6

Post-issuance, 7:6

Prosecution (this index)

Records and recording, 5:34

Third party submissions, 6:80, App EA

PRIORITY

Accelerated prosecution, Track I prioritized examination, 5:24

Electronic priority applications, App Z3

Patentability, 3:3

Patent Cooperation Treaty (PCT), 9:4

Prosecution, 6:2

Records and recording, 5:14-5:16, 5:33, 10:2

PRIOR PATENT

Prosecution, 6:71

PRIVATE PAIR

Accessing your private records, 5:2

PROCESS

Claims, 2:5, 2:23-2:25, 2:27

Combination claims, 2:5

Device and process, 6:3

PROCESS—Cont'd	PROSECUTION—Cont'd
Guidance on treatment of product and process claims in	Allowance—Cont'd
light of In re Ochiai, In re Brouwer and 35 U.S.C.	payment of issue fee, 6:108 , 6:109
§ 103(b), App C	refund of issue fee, 6:111
Mathematical algorithms, 4:21	Alternative language, 6:48
Prosecution, 6:3 , 6:4 , 6:6 , 6:53	Amendment (this index)
Responding to rejections under 35 U.S.C.A. § 112, paragraph 2, 6:53	America Invents Act, third party prior art submissions, 6:80
Statutory subject matter, 4:3, 4:4, 4:21	Analgous art, 6:61
Unity of invention, 6:4	Answer, examiner's, 6:91
Utility of chemical compounds and processes, 4:3, 4:4	Apparatus, 6:4 , 6:5 , 6:54
PRODUCT	Appeal and Review (this index)
Computer-implemented inventions, 4:20	Article of manufacturer, 6:32
Guidance on treatment of product and process claims in	Articles of speech, 6:47
light of In re Ochiai, In re Brouwer and 35 U.S.C.	Assistance by Patent Ombudsman, 1:57
§ 103(b), App C	Attorneys, 6:79 , 6:81 , 6:89 , 6:97
Mathematical algorithms, 4:20	Best mode requirement, 6:38
Nature, product of, 4:25 , 6:30	Block diagrams, 6:40
Newly discovered products of nature, 6:30	Certificate of correction, 6:88
Prosecution, 6:6 , 6:7 , 6:30	Challenges, 6:2
Statutory subject matter, 4:25	Charts, 6:41
	Chemical compositions, 6:51 , 6:52
PRODUCT-BY-PROCESS	Civil action, 6:103
Claims, 2:29 , 6:53	Claim language, 6:62
Prosecution, 6:53	
Responding to rejections under 35 U.S.C.A. § 112,	Claims, 6:52, 6:62
paragraph 2, 6:53	Commonality between authors and inventors, 6:72 , 6:73
PROFESSIONAL SEARCHER	Complete, 6:64
Format, 1:3	Complex systems, 6:41
Patentability, 3:5	Conclusory statements, 6:42
•	Conducting interviews, 6:20
PROGRAM CODE	Construction and interpretation, 6:46 , 6:62
Discovery, 1:33	Consultants, 6:42
PROGRAM-IMPLEMENTED SYSTEM	Content of amendments, 6:13
Discovery, 1:49	Continuation applications, 6:16 , 6:79
•	Continuation-in-part (CIP), 6:59, 6:79
PROPRIETARY MATERIALS Prosecution, 6:82	Continued prosecution application (CPA), 6:59 , 6:65 , 6:89
PROSECUTION	Corrections, 6:63 , 6:86-6:88 , 6:117
Generally, 6:1 et seq.	Credibility, 6:33 , 6:42
Abandonment, 6:89	Decisions, 6:90 , 6:102 , App QA
Accelerated prosecution	Declarations
generally, 5:23	overcoming rejections
Patent Prosecution Highway (PPH) Program, 5:26	generally, 6:67 et seq.
petition to support special handling, 5:25	common ownership, 6:73
Adequate description, 6:40	domestic introduction, 6:70
Allowance	inventor-authored publications, removal of, 6:72
generally, 6:21 , 6:107 et seq.	references
error in paying small entity amount issue fee, 6:109	removal of, 6:68
inequitable conduct, avoiding, 6:84	types not removable by declaration, 6:71
late payment of issue fee, 6:110	Rule 131-type declarations, generally, 6:68 et seq.
notice of allowability, 6:84	Rule 132 declarations, 6:74
nonec of anowability, 0.07	Ruic 132 decidiations, U.77

PROSECUTION—Cont'd	PROSECUTION—Cont'd
Declarations—Cont'd	Foreign countries, 6:69
overcoming rejections—Cont'd	Foreign language document, 6:79
time, establishing date of invention outside U.S. for	Foreign patents, 6:71 , 6:79
post-January 1, 1996 applications, 6:69	Format of amendments, 6:12
responding to rejections under 35 U.S.C.A. § 112,	Form PTOL-413A, 6:15
paragraph 1, below	Functional claim, 6:51 , 6:52 , 6:55 , 6:56
Rule 130 declaration, 6:78	General Agreements of Tariff and Trade (GATT), 6:2,
supplemental, 6:105	6:60
Defects, 6:117	Guidelines for Examination of Computer-Implemented
Defenses, 6:73	Inventions, 6:32
Definitions, 6:79	Hearings, 6:94 , 6:99 , 6:100
Dependent claims, 6:58	Inadequate disclosure. Responding to rejections under 35
Derivation, 6:114	U.S.C.A. § 112, paragraph 1, below
Description, 6:35 , 6:36 , 6:40	Incomplete response, 6:64
Design patent applications, 8:15-8:18, App X2	Indefinite articles, 6:47
Device and process, 6:3	Independent consultants, 6:42
Disclaimer, 6:77	Inequitable conduct, avoiding
Disclosure	generally, 6:81-6:85
generally, 6:40	amendment of claims after prosecution closed, 6:83 -
document, 6:70	6:85
information disclosure statements, 6:79	notice of allowance and before payment of issue fee,
Patent Ombudsman pilot program, 1:57	amendment of claims following, 6:84 payment of issue fee but prior to issuance, amendment
responding to rejections under 35 U.S.C.A. § 112, paragraph 1, below	of claims following, 6:85
supplemental information disclosure statement, 6:79	proprietary materials, 6:82
Distrust Court of District of Columbia, 6:103	protective order materials, 6:82
Doing business, 6:27	trade secrets, 6:82
Domestic introduction, 6:70	Information
Double patenting, 6:75-6:78	disclosure statements, 6:79
Effective amount, 6:51	expungement of information from file, 6:119
Election of species, 6:8	PTO initiated requirements for, 6:118
Embodiments of claimed invention, 6:8	Information disclosure statements, 6:79
Enablement requirement, 6:37	Inherent function of apparatus, 6:54
Error or mistake, 6:86-6:88 , 6:109	Inoperativeness, 6:44
European Patent Office (EPO), 6:79	Intent, 6:52 , 6:89
Evidence, 6:33	Interference, 6:113
Examination. See lines throughout this index topic	Intermediate and product, 6:7
Examiner's action. Office action, below	Interviews
Ex parte Quayle actions, 6:106	generally, 6:15-6:22, 6:61
Expedited patent appeal pilot program, 6:104	after interview, 6:22
Expungement of information from file, 6:119	Automated Interview Request (AIR), 6:24
Extensions of time, 6:14	conducting, 6:20
Failure, avoiding, 6:42	first action interview program, request to participate,
Federal Circuit Court of Appeals, 6:103	App DA
Fees (this index)	interview specialists, 6:23
File wrapper estoppel, 6:61	possible outcomes, 6:21
Final rejection, 6:65 , 6:66	preparing for, 6:19
Final review of allowed application, 6:112	selection of cases, 6:16
First action interview program participation, App DA	time, 6:17
Flow charts, 6:41	Inventor-authored publications, removal of, 6:72
Foreign applicant, 6:70	Issue fees, 6:79
i oroigii appiroani, 0070	10000 1000, 0117

PROSECUTION—Cont'd	PROSECUTION—Cont'd
Judicial review, 6:92	Printing of patent, 6:120
Language, 6:48 , 6:50 , 6:62	Prior art
Late payment of issue fee, 6:110	declarations, overcoming rejections with, 6:67, 6:72
Limitations and restrictions	double patenting, 6:78
generally, 6:59	responding to rejections over prior art, below
unity of invention, below	responding to rejections under 35 U.S.C.A. § 112
Manual of Patent Examining Procedure (MPEP), 6:15	paragraph 1, 6:40, 6:41
Manufacturing, 6:32	paragraph 2, 6:54
Mathematical algorithm, 6:26	search, 6:10
Means-plus-function claims, 6:62	submission of information to PTO, 6:79
Mental steps, 6:28	third party submissions, 6:80
Method of doing business, 6:27	Priority, 6:2
Mistake or error, 6:86-6:88 , 6:109	Prior patent, 6:71
Modification, 6:102	Process, 6:3 , 6:4 , 6:6 , 6:53
Modifiers, use of, 6:46	Product, 6:6 , 6:7
Nature, product of—newly discovered products of	Product-by-process claims, 6:53
nature, 6:30	Product of nature, 6:30
Negative limitations, 6:49	Proprietary materials, 6:82
Negligence, 6:89	Protective order materials, 6:82
New ground of rejection, 6:66	
Newly discovered products of nature, 6:30	Provisional application, 6:63 , 6:87
New matter, 6:13	Publication date, 6:71
Non-provisional application, 6:63 , 6:87	Publications, 6:72
Notice and knowledge, 6:84 , 6:91 , 6:108	Question not provided for by rules, 6:116
Novelty, 6:75	Records and recording, 6:20 , 6:79 , 6:89 , 6:108
Oaths, 6:105	References, 6:58 , 6:68 , 6:71
Obviousness, 6:58 , 6:61 , 6:75 , 6:77	Refund of issue fee, 6:111
Office action	Relative language, 6:50
appeal and review, 6:96 interview, conducting, 6:20	Remarks, 6:13
pending office action, 6:91	Request to participate in first action interview program,
responding to rejections over prior art, 6:64	App DA
submission of information to PTO, 6:79	Responding to rejections over prior art
substantive examination, 6:10	generally, 6:57 et seq.
Ombudsman, assistance with patent prosecution, 1:57	continuing application practice, 6:59
On-brief docket, 6:94	incomplete response, 6:64
Operational, 6:44	interpreting and prosecuting means-plus-function
Oral hearing, 6:94 , 6:99 , 6:100	claims, 6:62
Orders, 6:82	post-GATT prosecution, 6:60
Original application, 6:2	strategy of prosecution, 6:58, 6:61
Patentability, 6:58 , 6:67 , 6:79 , 6:82	tracking and correcting inventorship during prosecu-
Payment, 6:84 , 6:85 , 6:108-6:110	tion, 6:63
Pending acts and matters, 6:79 , 6:91	Responding to rejections under 35 U.S.C.A. § 101
Petition, 6:9 , 6:89 , 6:103 , 6:116	generally, 6:25-6:35
Phraseology, 6:46	article of manufacturer, 6:32
Pilot Programs (this index)	mathematical algorithm, 6:26
Post-GATT prosecution, 6:60	mental steps, 6:28
Premature final rejection, 6:66	method of doing business, 6:27
Preparing for interviews, 6:19	nature, product of, 6:30
Prima facie case defined, 6:79	printed matter, 6:29
Printed matter, 6:29	utility, lack of, 6:33
i ilitica ilititoi, v.m/	diffity, factor, 0.55

PROSECUTION—Cont'd	PROSECUTION—Cont'd
Responding to rejections under 35 U.S.C.A. § 112	Rule 131—Cont'd
paragraph 1	declarations, above
generally, 6:34-6:45	Rule 132 declarations, 6:74
best mode requirement, 6:38	Rule 312, 6:84
case study, 6:43	Search, 6:10 , 6:79
declarations	Selection of cases, 6:16
generally, 6:39-6:43	Single means claim, 6:56
block diagrams, 6:40	Skill, 6:35 , 6:37 , 6:39 , 6:58
case study, 6:43	Small entity amount issue fee, 6:109
failure, avoiding, 6:42	Speech, 6:47
flow charts, 6:41	Strategy of prosecution, 6:58 , 6:62
enablement requirement, 6:37	Submission of information to PTO, 6:79 , 6:80
inadequate disclosure, generally, 6:34-6:45	Substantive examination, 6:10
inoperativeness, 6:44	Substantive prosecution, 6:11-6:13
new matter, 6:45	Summary, 6:20
undue breadth, 6:36	Supplemental information disclosure statement, 6:79
written description, 6:35, 6:36	Supplemental oath or declaration, 6:105
paragraph 2	Suspension of rules, 6:116
generally, 6:46-6:54	Telephone interview, 6:18 , 6:61
alternative language, 6:48	Terminal disclaimer, 6:77
articles of speech, 6:47	Term of patent, 6:60
effective amount, 6:51	Third party lawsuits against PTO, 6:121
functional claim, 6:51 , 6:52	Third party prior art submissions under 35
inherent function of apparatus, 6:54	U.S.C.A.§ 122(e), 6:80
intended use, 6:52	35 U.S.C.A., generally, 6:25-6:35
negative limitations, 6:49	Time, 6:14 , 6:17 , 6:69 , 6:71
product-by-process claims, 6:53	Title and ownership, 6:73
relative language, 6:50	Tracking and correcting inventorship during prosecution.
paragraph 6	6:63
generally, 6:55 , 6:56	Trade secrets, 6:82
functional claim, 6:55 , 6:56	Undue breadth, 6:36
single means claim, 6:56	Unity of invention
Response	generally, 6:2-6:9
examiner's action, after, 6:11, 6:15	apparatus and product made by it, 6:5
interview, filed after, 6:22	device and process, 6:3
prior art. Responding to rejections over prior art,	election of species, 6:8
above	intermediate and product, 6:7
35 U.S.C.A. § 101. Responding to rejections under 35	limitations and restrictions, generally, 6:2-6:9
U.S.C.A. § 101, above	process and apparatus for carrying out process, 6:4
35 U.S.C.A. § 112	product and process of using it, 6:6
paragraph 1. Responding to rejections under 35	
U.S.C.A. § 112, paragraph 1, above	review of requirement, 6:9
paragraph 2. Responding to rejections under 35	Utility, lack of, 6:33
U.S.C.A. § 112, paragraph 2, above	Withdrawal, 6:115
Review of requirement, 6:9	Written description, 6:12 , 6:35 , 6:36
Revival of abandoned applications, 6:89	Written interview summary record, 6:20
Rule 53(b), 6:59 , 6:65	PROSPECTIVE COMPETITOR
Rule 53(d) continuation application, 6:59	Format, 1:3
Rule 130 declaration, 6:78	•
Rule 131	PROTECTIVE ORDER MATERIALS
generally, 6:72	Prosecution, 6:82

PROVISIONAL APPLICATIONS

Generally, 5:7, 5:17, 5:33, 5:34

Format, **1:5**

Prosecution, **6:63**, **6:87**

PUBLIC, DEDICATION TO

Infringement, 3:15

PUBLICATION

Generally, 5:2

Domestic publication of patent applications published abroad, 5:34

Patentability, 3:3

Patent Cooperation Treaty (PCT), 9:7, 9:16

Petition for express abandonment to avoid publication,

App U4

Prosecution, **6:71**, **6:72**

Request for non-publication, App U1

Request to rescind non-publication, App U2

PUBLIC DATABASES

Patentability, 3:5

PUBLIC DOMAIN

Patentability, 3:3

PUBLIC LIBRARIES

Patentability, 3:5

PUBLIC PAIR

Accessing publicly available PTO records, 5:2

PUBLIC POLICY

Statutory subject matter, 4:2, 4:3

PUBLIC USE

Patentability, 3:3

OPIDS

Pilot programs, request and certification, App GA

RECOMBINANT DNA

Records and recording, 5:25

RECORDATION

Records and recording

ownership and assignment of invention, 5:27

RECORDS AND RECORDING

Generally, 5:1 et seq., 10:1-10:3

Abandonment, 5:7

Accelerated prosecution, 5:23-5:25

Addresses, 5:22, 5:39

Age of inventor, 5:25

Allowed application file check form, App V

Amendments, 10:2

America Invents Act, conversion to first-to-file patent

system, 6:113

RECORDS AND RECORDING—Cont'd

American Inventors Protection Act of 1999 (AIPA), 5:1,

5:7, 5:33

Appeal and review, 5:12, 5:21

Application Data Sheet (ADS) (this index)

Approval, regulatory, 5:9

Assignment, 5:21, 5:27-5:31, App O

CD-R, **5:2** CDROM. **5:2**

Certification of facsimile transmission, 5:20

Change or modification, 5:22, 5:30

Claim, **5:2**

Claiming priority, 5:14-5:16

Common inventorship, 5:16

Complete application, 5:21

Computer-implemented inventions, 5:23

Computer records, **10:3** Conflicting inventions, **5:11**

Conflicting inventions, 5.11

Continuation-in-part (CIP), **5:4-5:6**

Continued examination, request for (RCE), **5:7** Continued prosecution application (CPA), **5:6**, **5:7**

Continuing application, 5:4

Continuous activity of invention, 10:2

Conversion, 5:33

Correspondence, 5:22, 5:36

Database, 5:2

Declaration, 5:2, 5:5, 5:19

Delay, 5:13, 5:21

Design patent, 5:7

Determining inventorship, 5:17

Diligence, 10:2

Disclosure, 5:2

Divisional application, 5:4, 5:17

Documentation, 10:3

Domestic priority, 5:14, 5:15

Domestic publication of patent applications published

abroad, **5:34**

EFS-Web, **5:2**

Electronic filing system (EFS)

generally, 5:34

user guide, App BA

Electronics, 5:23

Employment exceptions, 5:28

Energy, **5:25**

Enforcement, 5:17

Engineering record keeping, 10:3

Environmental quality, 5:25

Evidence, establishing proof of invention, 10:2

Examination, **5:4**, **5:33**

Examiner, 5:21, 5:33

Exceptions, 5:28

Execution by applicant, 5:5

Index-26

RECORDS AND RECORDING—Cont'd	RECORDS AND RECORDING—Cont'd
Facsimile, 5:20	Prior art, 5:34
Fees (this index)	Priority, 5:14-5:16, 5:24, 5:33, 10:2
File wrapper continuation (FWC) application, 5:4	Private PAIR, 5:2
First-to-file patent system, conversion to, 6:113	Processing application papers, 5:21
Foreign application, 5:14 , 5:16 , 10:2	Prosecution, 6:20, 6:79, 6:89, 6:108
Foreign countries, 5:34	Provisional application, 5:7 , 5:17 , 5:33 , 5:34
Foreign language, 5:15	PTO, generally, 5:1 et seq. PTO Addresses, 5:39
Foreign priority, 5:15 Consert Agreements of Toriff and Trade (CATT), 5:23	,
General Agreements of Tariff and Trade (GATT), 5:33 Good faith, 5:32	Publication, 5:2, 5:34
Guarantee, 5:13	Public PAIR, 5:2 Recombinant DNA, 5:25
Handling, special, 5:25	Recordation, ownership and assignment of invention,
Independent inventor, 5:32	5:27
Information on status of application, 5:35	Reexamination, 5:7
Infringement, 5:25	Regulatory approval, 5:9
Interference, 5:11, 10:2	Reply, 5:13
International application, 5:7	Response, 5:13
Joint inventors, 5:17	Rule 1.114 request for continued examination, 5:7
Laboratory notebooks, 10:3	Rule 53(b), 5:5
Languages, 5:18	Rule 53(d) continued prosecution applications (CPA),
Legal holidays, 5:40	5:6
Licensing and review branch, 5:21	Rule 60, 5:4 , 5:5
Lost files, 5:37	Rule 62, 5:4
Lost parts, 5:21	Secrecy orders, 5:10
Manual of Patent Examining Procedure § 403, 5:22	Signatures, filing by facsimile, 5:20
Manufacturing, 5:25	Small Business Administration, 5:32
Mental conception of invention, 10:2	Small entity status, 5:32
Merger, 5:30	Special handling, 5:25
Micro entities, 5:3	Status letter, 5:36
Mistake or error, 5:17 , 5:32 , 10:3	Substantive contribution, 5:17
Name, 5:30	Substitute application, 5:4
Non-profit organization, 5:32	Successful appellate review, 5:12
Non-provisional application, 5:4, 5:14	Superconductivity, 5:25
Notice and knowledge, 5:13, 5:21	Terms
Oath, 5:2, 5:19	generally, 5:8-5:13
Office of Initial Patent Examination (OIPE), 5:21	guarantee, 5:13
On behalf of inventor, filing papers, 5:31	interference proceedings, 5:11
Orders, 5:10	secrecy orders, 5:10
Original application, 5:5, 5:37	successful appellate review, 5:12
Ownership of invention, 5:27, 5:28	35 U.S.C.A., generally, 5:7-5:22
Patent Business Goals (2000), 5:1	37 C.F.R., generally, 5:1 et seq.
Patent Cooperation Treaty (PCT) (this index)	Time
Patent Prosecution Highway (PPH) Program, 5:26	generally, 5:2, 5:4, 5:7, 5:14, 5:23
Payment of fees, 5:25 , 5:38	term, above
Pending acts and matters, 5:13, 5:23, 5:34	Timing, 5:7, 5:15
Personal property, patents as, 5:29	Title and ownership, 5:27, 5:28
Petition, 5:7, 5:25	Track I prioritized examination, 5:24
Physical reduction to practice, 10:2	Transmittal sheet, 5:2
Plant patent, 5:7	USPTO Rules of Practice, 5:7
Post-issuance, 7:5, 7:6	Utility patent, 5:7
Power of attorney, 5:22	Witnesses, 10:3

RECORDS AND RECORDING—Cont'd

Written records, 10:3

REDUCTION OF FEES

Micro entities, 5:3

REEXAMINATION

Post-issuance, 7:6

Records and recording, 5:7

Request for reexamination, App M

REFERENCE CHARACTERS

Discovery, 1:29

REFERENCE NUMERALS

Claims, 2:30

REFERENCES

Prosecution, **6:58**, **6:68**, **6:71**

REFUND

Issue fee, **6:111**

REGISTRATION

Format, **1:9**

Representative, 1:9

REGULATORY APPROVAL

Filing, **5:9**

REHEARING

Request for, 6:102

REINSTATEMENT FEE

Generally, 7:4

REISSUE APPLICATION

Post-issuance, 7:5

Pre-AIA reissue application, App N1

REISSUE CONSENT OF ASSIGNEE

America Invents Act (AIA), App N5

REISSUE DECLARATION

AIA reissue declaration by assignee, **App N4** AIA reissue declaration by inventor, **App N3**

REISSUE TRANSMITTAL

America Invents Act (AIA), App N2

RELATIVE LANGUAGE

Prosecution, 6:50

RELEVANT PRIOR ART

Patentability, 3:4

REMARKS

Prosecution, 6:13

REPLY

Generally, 5:13

Index-28

REPLY BRIEF

Appeal and review, 6:98, App T3

REPORTS AND REPORTING

Generally. See Records and Recording (this index)

Patent Cooperation Treaty (PCT), 9:7, App PCT3, App

PCT5, App PCT6

Preliminary report on patentability, App PCT6

RESEARCH AND DEVELOPMENT

Disclosure, 1:14, 1:15

RESPONSE

Generally, 5:13

Prosecution (this index)

RETRIEVAL

Electronic priority applications, App Z3

REVIEW

Appeal and Review (this index)

REVIVAL

Generally, 7:4

Abandoned application, 6:89, App Q

ROYALTIES

Claims drafting to maximize, 2:38

RULES OF PRACTICE

Title 37 of Code of Federal Regulations (CFR), selected sections, **App B2**

RUSSIAN LANGUAGE DECLARATION

Power of attorney, App A8

SALE OR OFFER FOR SALE

Patentability, 3:3

SCIENTIFIC INQUIRIES

Infringement, 3:19

SEARCH

Fees, 5:2

Patentability, 3:5

Patent Cooperation Treaty (PCT), 9:7, 9:15, App PCT3

Prosecution, 6:10, 6:79

SECRECY ORDERS

Terms, **5:10**

SELECTED PROVISIONS

Manual of Patent Examining Procedure (MPEP), **App B3**

SELECTED SECTIONS

Title 35 of U.S.C., App B1

Title 37 of Code of Federal Regulations (CFR), App B2

SELECTION OF CASES

Prosecution, **6:16**

SEQUENCE

Discovery, 1:32

Federal Register, App B4

SEQUENCE LISTINGS

Disclosure, 1:16, 1:51

SIGNALS

Drawing, 1:34

SIGNAL TIMING

Computer programs, 1:47

SIGNATURES

Facsimile, 5:20

S-signature, 5:2

SIMPLE MECHANICAL INVENTION

Claims, 2:41

SINGLE MEANS CLAIM

Prosecution, 6:56

SINGLE STATUTORY CLASS

Claims, **2:7**

SKILL

Format, 1:3

Patentability, 3:3, 3:4

Prosecution, 6:35, 6:37, 6:39, 6:58

SMALL BUSINESS ADMINISTRATION

Records and recording, 5:32

SMALL BUSINESS CONCERN

Records and recording, 5:32

SMALL ENTITY AMOUNT

Prosecution, 6:109

SMALL ENTITY STATUS

Records and recording, 5:32

SOCIETY, BENEFIT TO

Statutory subject matter, 4:2, 4:3

SOFTWARE

Computer Hardware and Software (this index)

"SOFTWARE" PATENTS

Statutory subject matter, 4:31

SPANISH LANGUAGE DECLARATION

Power of attorney, App A2

SPECIAL HANDLING

Petition, 5:25

SPECIFICATION

Amendment, App E

Claims (this index)

Disclosure (this index)

Post-issuance, 7:5

SPECIFIC LANGUAGE

Disclosure, 1:41

SPEECH

Prosecution, 6:47

S-SIGNATURE

Generally, 5:2

STATE STREET BANK & TRUST CO. v. SIGNATURE FINANCIAL GROUP, INC.

Computer-implemented inventions, 4:16

Mathematical algorithms, 4:16

STATISTICS

Patent Trial and Appeal Board, App NA

Trial, App MA

STATUS LETTER

Generally, 5:36

STATUTORY CLASS

Claims, 2:3

STATUTORY DEFINITION

Patentability, 3:2

STATUTORY SUBJECT MATTER

Generally, 4:1-4:33

Algorithms. Mathematical Algorithms (this index)

Alice Corp. and subsequent decisions, **4:12**, **4:13**

AT&T, 4:27

Berkheimer guidelines, 4:6, App SA

Chemical compounds and processes, 4:2, 4:3, 4:4

Claims

generally, **4:27**, **4:28-4:33**

drafting, generally, 4:28-4:33

independent physical acts, 4:28

practical application, 4:29

software on computer-readable medium, 4:30

Compounds and processes, 4:3, 4:4

Computer Hardware and Software (this index)

Doing business, methods of, 4:22

Eligibility update, January 2019, App TA

Eligibility update, October 2019, App UA

Examples, abstract ideas, App JA, App LA

Exclusions, 4:2, 4:3

General utility requirement, 4:2, 4:3

Guidelines on eligibility, 4:4, 4:5, 4:7, 4:8, 4:9, App

HA, App IA, App JA, App KA, App OA

Human organism prohibition, 4:33

STATUTORY SUBJECT MATTER—Cont'd

Immoral inventions, 4:2, 4:3

Independent physical acts, 4:28

Inoperable inventions, **4:2**, **4:3**

Interim examination instructions for evaluating subject matter eligibility, **App AA**

Laws of nature, 4:26

Mathematical Algorithms (this index)

Memorandum to Patent Examining Corps, rejection,

App PA

Mental steps, 4:23

Methods, 4:22

Methods of doing business, 4:22

Nature, 4:25

Patents, 4:31

Pharmaceutical-related inventions, 4:2, 4:3

Physical acts, 4:28

Printed matter, 4:24

Processes, 4:3, 4:4

Products, 4:25

Products of nature, 4:25

Public policy, contrary to, 4:2, 4:3

Rejection, App PA

Society, benefit to, 4:2, 4:3

State Street Bank, 4:16

Sufficiency of utility, 4:2, 4:3, 4:4

35 U.S.C.A., generally, **4:19**

2016 Memorandum to Patent Examining Corps, rejec-

tion, **App PA**Utility, **4:2**, **4:3**, **4:4**

Value, **4:2, 4:3**

STRICTLY PHILOSOPHICAL INQUIRY

Infringement, 3:19

STUDIES

District Court Pharma Litigation Study, **App YA**Orange Book Patent/Biologic Patent Study, **App YA**

SUBMISSION OF INFORMATION

Post-issuance, 7:2

Prosecution, 6:79, 6:80

Third party prior art submissions, 6:80

SUBSTANTIVE CONTRIBUTION

Records and recording, 5:17

SUBSTANTIVE EXAMINATION

Prosecution, 6:10

SUBSTANTIVE PROSECUTION

Generally, **6:11-6:13**

SUBSTITUTE APPLICATION

Generally, 5:4

Format, **1:5**

Disclosure, 1:24-1:27, 1:53

SUFFICIENCY OF UTILITY

Statutory subject matter, 4:2, 4:3, 4:4

Prosecution, 6:20

SUMMARY

SUPERCONDUCTIVITY

Records and recording, 5:25

SUPPLEMENTAL APPLICATION DATA SHEET

(ADS)
Generally, 5:2

SUPPLEMENTAL DECLARATION

Generally, App W

SUPPLEMENTAL EXAMINATION

Post-issuance, 7:10

Request for supplemental examination transmittal, **App**

SUPPLEMENTAL INFORMATION DISCLOSURE

STATEMENT

Prosecution, 6:79

SUPPLEMENTAL OATH OR DECLARATION

Prosecution, 6:105

SURFACE INDICIA

Design patents, 8:6

SUSPENSION OF RULES

Prosecution, 6:116

SWEDISH LANGUAGE DECLARATION

Generally, App A9

TABLES

Disclosure, reference to table, 1:16

TAX STRATEGIES

Statutory subject matter, **4:32**

TELECOMMUNICATIONS

Claims, 2:42

TELEPHONE

Interview, 6:18, 6:61

TERMINAL DISCLAIMER

Generally, App L

Prosecution, 6:77

TERMS

Prosecution, 6:60

Records and Recording (this index)

TERRITORIAL CONSIDERATIONS

Claims, 2:46

TESTS AND TESTING

Function-way-result test, 3:10

Infringement, 3:10

Obviousness test, 3:4

Patentability, 3:4

Post-issuance, 7:6

Tripartite test, 3:10

Validity testing, 7:6

THIRD PARTIES

Lawsuits against Patent and Trademark Office, **6:121** Prior art submissions, **6:80**, **App EA**

THIRD PARTY PATENTS

Post-issuance, 7:6

35 U.S.C.A.

See more specific topics throughout this index

37 C.F.R.

See more specific topics throughout this index

TIME

Disclosure, 1:1

Discovery, 1:13

Extension of patent term, 7:7

Patentability, 3:3

Patent Cooperation Treaty (PCT), 9:17

Prosecution, 6:14, 6:17, 6:69, 6:71

Records and recording, 5:2, 5:4, 5:7, 5:14, 5:23, 5:24

Terms (this index)

Wyeth forms, request for recalculation of patent term,

App CA

TIMING

Computer programs, 1:47

Records and recording, 5:7, 5:15

TITLE AND OWNERSHIP

Generally, 5:27, 5:28

Disclosure, 1:12

Prosecution, 6:73

TRACKING

Prosecution, 6:63

TRADE SECRETS

Disclosure, 1:55

Prosecution, 6:82

TRANSITIONAL WORD OR PHRASE

Claims, **2:4**

TRANSMITTAL FORM

AIA reissue transmittal, App N2

Supplemental examination transmittal, request, App S

TRANSMITTAL LETTER

Patent Cooperation Treaty (PCT), 9:12, App PCT2

TRANSMITTAL SHEET

Generally, 5:2

Rule 1.114 request for continued examination (RCE)

transmittal sheet, App Z5

Rule 53(b) application transmittal sheet, App Y

Rule 53(c) provisional application transmittal sheet, \mathbf{App} $\mathbf{Z1}$

EFS web version, App Z2

TREATIES

Patent Cooperation Treaty (PCT) (this index)

TRIAL

Patent Trial and Appeal Board, trial practice guide, **App ZA**

TRIPARTITE TEST

Infringement, 3:10

2020 SCHEDULE

Fees, App F

TWO-LETTER CODES

Patent Cooperation Treaty (PCT), App PCT1

2020 FEDERAL HOLIDAYS

Generally, **5:40**

ULTIMATE OBJECT OF INVENTION

Claims, **2:3**

UNDUE BREADTH

Prosecution, 6:36

UNITED KINGDOM INTELLECTUAL PROPERTY OFFICE (UKIPO)

Patent Prosecution Highway (PPH) Program trial, 5:26

UNITY OF INVENTION

Patent Cooperation Treaty (PCT), 9:14

Prosecution (this index)

UNOBVIOUSNESS

Obvious and Nonobvious (this index)

USEFULNESS

Patentability, 3:4

UTILITY

Prosecution, 6:33

Statutory subject matter, 4:2, 4:3, 4:4

UTILITY PATENT APPLICATION

Generally, 5:7

English language declaration, App A3

Post-issuance, 7:4

VALIDITY

Claims, **7:5**

Mathematical algorithms, 4:16

Patentability, 3:4

Post-issuance, **7:5, 7:6**

VALUE

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,

2:43

Format of application, 1:4

Statutory subject matter, 4:2, 4:3

VARIATION

Format of application, 1:10

WAVEFORMS

Drawing, 1:34

WEB SITE

Patent Prosecution Highway (PPH) Program, 5:26

WIPO

Patent Cooperation Treaty (PCT), 9:2, 9:3

WITHDRAWAL

Prosecution, 6:115

WITNESSES

Records and recording, 10:3

WORLD TRADE ORGANIZATION

Member states, App PCT1A

WRITTEN DESCRIPTION

Design patents, 8:16

Disclosure (this index)

Post-issuance, 7:5

Prosecution, **6:12**, **6:35**, **6:36**

WRITTEN INTERVIEW SUMMARY RECORD

Prosecution, 6:20

WRITTEN OPINION

International search and, 9:15

Patent Cooperation Treaty (PCT), 9:19

WRITTEN RECORDS

Generally, 10:3

WYETH FORMS

Request for recalculation of patent term, App CA