

Table of Contents

Volume 1

CHAPTER 1. GENERAL FORMAT AND DISCLOSURE

- § 1:1 Goal of the patent law
- § 1:2 Importance of well-drafted applications
- § 1:3 —Readers of the application
- § 1:4 —Value of good quality patents
- § 1:5 Overview of U.S. patent applications
- § 1:6 —General format
- § 1:7 —Drawings
- § 1:8 —Declaration
- § 1:9 —Power of attorney
- § 1:10 —Variation of format
- § 1:11 Content of the specification
- § 1:12 —Title of the invention
- § 1:13 —Cross-reference to related applications
- § 1:14 —Statement regarding federally sponsored R&D
- § 1:15 —The names of the parties to a joint research program
- § 1:16 —Reference to a sequence listing, table or computer program listing
- § 1:17 —Background—Technical field
- § 1:18 —Technical field—Identification of copyright or mask work
- § 1:19 —Background of the invention—Description of the related art
- § 1:20 — —Identification of prior art—Mistake
- § 1:21 — —Content of background
- § 1:22 —Objects of the invention
- § 1:23 — —Replacing objects with advantages
- § 1:24 —Brief summary of the invention
- § 1:25 — —Form of summary
- § 1:26 — —Content of summary
- § 1:27 — —Post summary statement
- § 1:28 —Brief description of the drawing
- § 1:29 —Drawing
- § 1:30 — —Relationship between drawing and claims
- § 1:31 — —Prior art figures
- § 1:32 — —Computer implementations
- § 1:33 — —Copyright or mask work notice
- § 1:34 — —Identification of waveforms and signals
- § 1:35 —Detailed description of the preferred embodiments of the invention—Enablement, written description, and best mode
- § 1:36 — —Avoiding Limiting Effect of Written Description on Claims
- § 1:37 — —Theory of invention
- § 1:38 — —Language of description
- § 1:39 — —Incorporation by reference
- § 1:40 — — —Rules for incorporation by reference—General

- § 1:41 — — — Specific language
- § 1:42 — Disclosure for computer program—Implementations
- § 1:43 — — Forms of disclosure
- § 1:44 — — — Block diagrams
- § 1:45 — — — Flow charts
- § 1:46 — — — Interfacing
- § 1:47 — — — Signal timing
- § 1:48 — — — Computer-readable media
- § 1:49 — — Elements of an adequate disclosure
- § 1:50 — Disclosure for joint research under the CREATE ACT
- § 1:51 — Sequence listings for amino acid and nucleotide containing cases
- § 1:52 — Deposit of biological material
- § 1:53 — Post description summary
- § 1:54 — Abstract of the disclosure
- § 1:55 Avoiding disclosure of trade secret information
- § 1:56 Harvesting technology for patent applications
- § 1:57 Patent Ombudsman

CHAPTER 2. CLAIMS

- § 2:1 Introduction
- § 2:2 Claim structure
- § 2:3 — Preamble
- § 2:4 — Transitional word or phrase
- § 2:5 — Body of claim
- § 2:6 Fundamentals
- § 2:7 — Single statutory class
- § 2:8 — Complete
- § 2:9 — Definite
- § 2:10 Dependency
- § 2:11 — Independent and dependent claims
- § 2:12 — Multiple dependent claims
- § 2:13 — Internal and external limitations
- § 2:14 Format
- § 2:15 — Combination claims
- § 2:16 — Jepson claims
- § 2:17 — Markush claims
- § 2:18 — Means-plus-function claims
- § 2:19 Classifications
- § 2:20 — Machine
- § 2:21 — — Functional limitations in apparatus claims
- § 2:22 — Article of manufacture
- § 2:23 — Process (Method)
- § 2:24 — — Apparatus limitations in process claims
- § 2:25 — — Biotechnology process claims
- § 2:26 — Machine operation
- § 2:27 — Process of making
- § 2:28 — Composition of matter
- § 2:29 — Product-by-process

TABLE OF CONTENTS

- § 2:30 Reference numerals in claims
- § 2:31 Special considerations—Computer program claims
- § 2:32 —Claim formats—Apparatus versus method
- § 2:33 —Claim presentation
- § 2:34 —Types of claim formats
- § 2:35 — —Method claims
- § 2:36 — —Apparatus claims
- § 2:37 —Claim drafting for e-commerce and other business methods
- § 2:38 Claim drafting to maximize royalties
- § 2:39 Practical claim drafting strategy
- § 2:40 Case studies
- § 2:41 —Simple mechanical invention
- § 2:42 —Complex telecommunications invention
- § 2:43 Drafting a broad claim for literal infringement
- § 2:44 —Electromechanical example
- § 2:45 —Electrical example
- § 2:46 E-Commerce example—territorial considerations

CHAPTER 3. PATENTABILITY AND INFRINGEMENT

- § 3:1 Patentability—Introduction
- § 3:2 Patentable inventions
- § 3:3 Novelty
- § 3:4 Nonobviousness
- § 3:5 Patentability search
- § 3:6 Infringement—Introduction
- § 3:7 Infringement principles
- § 3:8 —Direct, contributory, and induced infringement
- § 3:9 —Literal infringement
- § 3:10 —Doctrine of equivalents
- § 3:11 —Prosecution history estoppel
- § 3:12 —Equivalency under 35 U.S.C. § 112(f) and 35 U.S.C. § 112, Paragraph 6
- § 3:13 —All elements/limitations rule
- § 3:14 —What is the bottom line?
- § 3:15 Dedication to the public
- § 3:16 Hardware versus software
- § 3:17 Analog versus digital
- § 3:18 First inventor defense to infringement of business method patents
- § 3:19 Exceptions to infringement

CHAPTER 4. STATUTORY SUBJECT MATTER

- § 4:1 Introduction
- § 4:2 —General utility requirement
- § 4:3 —Utility of chemical compounds and processes, and biotechnology related inventions
- § 4:4 2014 Interim Guidance on Patent Subject Matter Eligibility
- § 4:5 May 2016 Subject Matter Eligibility Update
- § 4:6 April 2018 Berkheimer Guidelines “Changes in Examining Procedure Pertaining to Subject Matter Eligibility”
- § 4:7 January 2019 subject matter eligibility update

- § 4:8 October 2019 subject matter eligibility update
- § 4:9 July 2024 subject matter eligibility update
- § 4:10 Computer implemented inventions and mathematical algorithms
- § 4:11 —Court decisions
- § 4:12 — —Alice Corp.
- § 4:13 — —Post Alice decisions
- § 4:14 — —Prior to Alice—In re Bilski
- § 4:15 — — —Alappat
- § 4:16 — — —State Street Bank
- § 4:17 — — —AT&T Corp. v. Excel Communications, Inc.
- § 4:18 — — —Beauregard
- § 4:19 —PTO examination guidelines—The 35 U.S.C. § 101 analysis for machines, manufactures and compositions of matter (products)
- § 4:20 — —Program as a product
- § 4:21 — —Program as a process
- § 4:22 Methods of doing business
- § 4:23 Mental steps
- § 4:24 Printed matter
- § 4:25 Products of nature
- § 4:26 Laws of nature
- § 4:27 Drafting claims to statutory subject matter
- § 4:28 —Independent physical acts
- § 4:29 —Practical application
- § 4:30 —Software on a computer-readable medium
- § 4:31 “Software” patents
- § 4:32 Tax strategies
- § 4:33 Human organism prohibition

CHAPTER 5. FILING

- § 5:1 Introduction
- § 5:2 —Application elements overview; application data sheet (ADS); Filing fee; Electronic filing
- § 5:3 —Micro entities
- § 5:4 —Overview of application types
- § 5:5 — —Rule 53(b) applications
- § 5:6 — —Rule 53(d) continued prosecution applications (CPA)
- § 5:7 —Request for continued examination (RCE)
- § 5:8 —Patent term
- § 5:9 —Regulatory approval
- § 5:10 —Patent term—Secrecy orders
- § 5:11 — —Interference proceedings
- § 5:12 — —Successful appellate review
- § 5:13 — —Patent term guarantee
- § 5:14 —Claiming priority
- § 5:15 — —Timing
- § 5:16 — —Common inventorship
- § 5:17 —Determining inventorship
- § 5:18 —Filing in a foreign language

TABLE OF CONTENTS

§ 5:19	—Filing without declaration; Filing fee
§ 5:20	—Filing signatures by facsimile
§ 5:21	—Processing application papers
§ 5:22	—Change of correspondence address
§ 5:23	Accelerated prosecution
§ 5:24	—Track I prioritized examination
§ 5:25	—Petition to support special handling
§ 5:26	Accelerated Prosecution—Patent Prosecution Highway Program
§ 5:27	Ownership and assignment of invention; Recordation
§ 5:28	Ownership and assignment of invention—Ownership of invention
§ 5:29	—Assignment of invention
§ 5:30	— —Recordation of change of name
§ 5:31	— —Assignee’s filing of papers on behalf of inventor
§ 5:32	Small entity status
§ 5:33	Provisional applications
§ 5:34	Domestic publication of patent applications published abroad
§ 5:35	Information on status of application
§ 5:36	Status letter
§ 5:37	Application files lost by PTO
§ 5:38	Paying PTO fees
§ 5:39	Useful PTO addresses
§ 5:40	2020 Federal Holidays

CHAPTER 6. PROSECUTION

§ 6:1	Introduction
§ 6:2	Unity of invention; Restriction
§ 6:3	—Device and process for making it
§ 6:4	—Process and apparatus for carrying out the process
§ 6:5	—Apparatus and product made by it
§ 6:6	—Product and process of using it
§ 6:7	—Intermediate and product
§ 6:8	—Election of species
§ 6:9	—Review of requirement
§ 6:10	Substantive examination; Overview
§ 6:11	Substantive prosecution; Amendments
§ 6:12	—Format of amendment
§ 6:13	—Content of amendment
§ 6:14	Timing of response; Extensions of time
§ 6:15	Interviews
§ 6:16	—Selecting cases that will benefit from an interview with an examiner
§ 6:17	—When to interview
§ 6:18	—How to interview
§ 6:19	—Preparing for the interview
§ 6:20	—Conducting the interview
§ 6:21	—Possible outcomes
§ 6:22	—After the interview
§ 6:23	—Interview specialists
§ 6:24	—Automated Interview Request (AIR)

- § 6:25 Responding to rejections under 35 U.S.C.A. § 101
- § 6:26 —Mathematical algorithm
- § 6:27 —Method of doing business
- § 6:28 —Mental steps
- § 6:29 —Printed matter
- § 6:30 —Product of nature
- § 6:31 Responding to rejections under 35 U.S.C.A. § 101—Laws of nature
- § 6:32 Responding to rejections under 35 U.S.C.A. § 101—Article of manufacture
- § 6:33 —Lack of utility
- § 6:34 Responding to rejections under 35 U.S.C.A. § 112, Paragraph 1
- § 6:35 —Written description
- § 6:36 — —Undue breadth
- § 6:37 —Enablement requirement
- § 6:38 —Best mode requirement
- § 6:39 —Declarations
- § 6:40 — —Block diagrams
- § 6:41 — —Flow charts
- § 6:42 — —Avoiding failure in declarations
- § 6:43 — —Case study—Declaration example
- § 6:44 —Inoperativeness
- § 6:45 Responding to rejections under 35 U.S.C.A. § 112, Paragraph 1—New matter
- § 6:46 Responding to rejections under 35 U.S.C.A. § 112, Paragraph 2
- § 6:47 —Articles of speech
- § 6:48 —Alternative language
- § 6:49 —Negative limitations
- § 6:50 —Relative language
- § 6:51 —Functional claim—Effective amount
- § 6:52 — —Intended use
- § 6:53 —Product-by-process claims
- § 6:54 —Inherent function of apparatus
- § 6:55 Responding to rejections under 35 U.S.C.A. § 112, Paragraph 6—Functional claim
- § 6:56 — —Single means claim
- § 6:57 Responding to rejections over prior art
- § 6:58 —Prosecution strategy
- § 6:59 —Continuing application practice
- § 6:60 —Post-GATT prosecution
- § 6:61 —Further considerations relating to prosecution strategy
- § 6:62 —Interpreting and prosecuting means-plus-function claims
- § 6:63 —Tracking and correcting inventorship during prosecution
- § 6:64 —Incomplete response
- § 6:65 Final rejection
- § 6:66 Premature final rejection
- § 6:67 Overcoming rejections with declarations
- § 6:68 —Rule 131-type declarations—Removing references
- § 6:69 — —Establishing date of invention outside the U.S. for applications filed on or after January 1, 1996 and having an effective filing date before March 16, 2013
- § 6:70 — —Domestic introduction
- § 6:71 — —Types of references not removable by declaration

TABLE OF CONTENTS

§ 6:72	— —Removing inventor-authored publications
§ 6:73	— —Common ownership
§ 6:74	—Rule 132 declarations
§ 6:75	Double patenting
§ 6:76	—Types
§ 6:77	— —Terminal disclaimer
§ 6:78	Rule 130 declaration
§ 6:79	Submission of information to the PTO
§ 6:80	Third party prior art submissions
§ 6:81	Avoiding inequitable conduct
§ 6:82	—Trade secret, proprietary, and protective order materials
§ 6:83	Amendment of claims after prosecution is closed
§ 6:84	—Amendment of claims following notice of allowance and before payment of issue fee
§ 6:85	—Amendment of claims following payment of issue fee but prior to issuance
§ 6:86	Correction of inventorship
§ 6:87	—Correction of inventorship in applications
§ 6:88	—Correction of inventorship in patents
§ 6:89	Revival of abandoned applications
§ 6:90	Appeal practice
§ 6:91	Appeal Practice—Appeal to the Patent Trial and Appeal Board
§ 6:92	The Patent Trial and Appeal Board
§ 6:93	Appeal practice—The Patent Trial and Appeal Board—Oral Hearing
§ 6:94	— —The decision process
§ 6:95	Pre-appeal brief conference
§ 6:96	Appeal practice—Alternatives to appeal
§ 6:97	—The appeal brief
§ 6:98	—The reply brief
§ 6:99	—Oral argument
§ 6:100	— —Benefits and drawbacks of a hearing
§ 6:101	—Decision by the Board
§ 6:102	—Request for rehearing
§ 6:103	—Appeal from the Board’s decision
§ 6:104	—Fast Track Appeals Pilot Program
§ 6:105	Supplemental oath or declaration
§ 6:106	Ex parte Quayle actions
§ 6:107	Allowance
§ 6:108	—Payment of issue fee
§ 6:109	— —Error in paying small entity amount issue fee
§ 6:110	—Late payment of issue fee
§ 6:111	—Refund of issue fee
§ 6:112	Final review of allowed application
§ 6:113	Interference
§ 6:114	Derivation
§ 6:115	PTO initiated withdrawal from issuance
§ 6:116	Questions not provided for by the rules; suspension of rules
§ 6:117	PTO initiated correction of defects
§ 6:118	PTO initiated requirements for information
§ 6:119	Expungement of information from file

- § 6:120 Printing of patent
- § 6:121 Third party lawsuits against the USPTO
- § 6:122 First Action Interview Pilot Program

CHAPTER 7. POST-ISSUANCE

- § 7:1 Introduction
- § 7:2 Submission of information following issuance
- § 7:3 Certificate of correction
- § 7:4 Maintenance fee payment
- § 7:5 Reissue
- § 7:6 Reexamination
- § 7:7 Extension of patent term
- § 7:8 Inter partes review
- § 7:9 Patent marking
- § 7:10 Supplemental examination
- § 7:11 Post-grant review
- § 7:12 Transitional program for business method patents

CHAPTER 8. DESIGN PATENTS

- § 8:1 Introduction
- § 8:2 Patentable subject matter
- § 8:3 —Ornamental versus functional
- § 8:4 —An article with movable parts
- § 8:5 —Hidden designs
- § 8:6 —Design of portion of article of manufacture
- § 8:7 —Computer icons
- § 8:8 Content of a design application
- § 8:9 —Preamble
- § 8:10 —Drawing
- § 8:11 —Description
- § 8:12 —Claim
- § 8:13 Novelty
- § 8:14 Infringement of design patents
- § 8:15 Design patent prosecution
- § 8:16 —Specification and claim
- § 8:17 —Novelty and obviousness
- § 8:18 —Restriction requirements
- § 8:19 Expedited examination
- § 8:20 The Hague Agreement

CHAPTER 9. FILING THROUGH THE PATENT COOPERATION TREATY

- § 9:1 Introduction
- § 9:2 Terminology
- § 9:3 Where to get help
- § 9:4 Advantages of PCT filing
- § 9:5 Pre-filing considerations

TABLE OF CONTENTS

§ 9:6	—Prior art effect of international filing
§ 9:7	The international application
§ 9:8	Filing the application
§ 9:9	—The application
§ 9:10	—The request
§ 9:11	—The fee
§ 9:12	—The transmittal letter
§ 9:13	PCT initial processing
§ 9:14	Unity of invention
§ 9:15	International search and written opinion
§ 9:16	Publication
§ 9:17	National phase (due at twenty months for the particular States; at thirty months for others)
§ 9:18	Chapter II international preliminary examination
§ 9:19	International preliminary examination
§ 9:20	Exception for certain technologies
§ 9:21	National phase
§ 9:22	Annuities
§ 9:23	PCT-East and PCT-Safe filing software

CHAPTER 10. *[Reserved]*

Volume 2

APPENDICES

APPENDIX A1.	Dutch Language Declaration- Declaration and Power of Attorney for Patent Application
APPENDIX A2.	Spanish Language Declaration - Declaration and Power of Attorney for Patent Application
APPENDIX A3.	English Language Declaration - Declaration for Utility or Design Patent Application; and Power of Attorney or Authorization of Agent
APPENDIX A4.	French Language Declaration - Declaration and Power of Attorney for Patent Application
APPENDIX A5.	German Language Declaration - Declaration and Power of Attorney for Patent Application
APPENDIX A6.	Italian Language Declaration - Declaration and Power of Attorney for Patent Application
APPENDIX A7.	Japanese Language Declaration - Declaration and Power of Attorney for Patent Application
APPENDIX A8.	Russian Language Declaration - Declaration and Power of Attorney for Patent Application
APPENDIX A9.	Swedish Language Declaration - Declaration and Power of Attorney for Patent Application
APPENDIX A10.	Chinese Language Declaration - Declaration and Power of Attorney for Patent Application

APPENDIX A11.	Korean Language Declaration—Declaration and Power of attorney for Patent Application
APPENDIX A12.	Power of Attorney to Prosecute Applications Before the USPTO
APPENDIX A13.	Power of Attorney to One or More of the Joint Inventors and Change of Correspondence Address
APPENDIX A14.	Change of Correspondence Address Application
APPENDIX C.	Guidance on Treatment of Product and Process Claims in Light of <i>In re Ochiai</i> , <i>In re Brouwer</i> and 35 U.S.C. § 103(b)
APPENDIX D.	Information Disclosure Statement
APPENDIX D1.	Kind Codes
APPENDIX E.	Amendment
APPENDIX F.	2023 Fee Schedule
APPENDIX G.	Case Study on ISDN Application
APPENDIX H.	Case Study on Computerized Combination Lock
APPENDIX I.	Declaration Under 37 C.F.R. 1.131
APPENDIX J.	Declaration Under 37 C.F.R. 1.132
APPENDIX K.	Application Data Sheet
APPENDIX L.	Terminal Disclaimer
APPENDIX M.	Request for Reexamination
APPENDIX N1.	Pre-AIA Reissue Application
APPENDIX N2.	AIA Reissue Transmittal
APPENDIX N3.	AIA Reissue Declaration by Inventor
APPENDIX N4.	AIA Reissue Declaration by Assignee
APPENDIX N5.	AIA Reissue Consent of Assignee
APPENDIX O.	Assignment Form and Recordation Cover Sheet
APPENDIX P.	Correction of Inventorship
APPENDIX Q.	Petition to Revive Abandoned Application
APPENDIX R.	Certificate of Correction
APPENDIX S.	Request for Supplemental Examination Transmittal
APPENDIX T1.	Notice of Appeal
APPENDIX T2.	Appeal Brief
APPENDIX T3.	Reply Brief
APPENDIX U1.	Request for Non-Publication
APPENDIX U2.	Request to Rescind Non-Publication
APPENDIX U3.	Petition for Revival of an Application for Patent Abandoned for Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f))
APPENDIX U4.	Petition for Express Abandonment to Avoid Publication Under 37 CFR 1.138(c)
APPENDIX U5.	Request for Deferred Exam
APPENDIX V.	Allowed Application File Check Form

TABLE OF CONTENTS

APPENDIX W.	Supplemental Declaration
APPENDIX X1.	Design Application
APPENDIX X2.	Prosecution of Design Application
APPENDIX X3.	Design Patent
APPENDIX Y.	Rule 53(b) Application Transmittal Sheet
APPENDIX Z1.	Rule 53(c) Provisional Application Transmittal Sheet
APPENDIX Z2.	Rule 53(c) Provisional Application Transmittal Sheet—EFS Web Version
APPENDIX Z3.	Request to Retrieve Electronic Priority Application(s)
APPENDIX Z4.	Request to Participate in PPH Program Between JPO and USPTO
APPENDIX Z5.	Rule 1.114 Request for Continued Examination (RCE) Transmittal Sheet
APPENDIX Z6.	Rule 1.114 Request for Continued Examination (RCE)—EFS Web Version
APPENDIX AA.	Under <i>Bilski</i> Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101
APPENDIX BA.	Electronic Filing System User Guide
APPENDIX BB.	Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112
APPENDIX CA.	Wyeth Forms for Requesting Recalculation of Patent Term
APPENDIX DA.	Form for Requesting Participation in the First Action Interview Program
APPENDIX EA.	Third Party Prior Art Submission
APPENDIX FA.	AFCP 2.0 Pilot Program Request and Certification
APPENDIX GA.	QPIDIS Pilot Program Request and Certification
APPENDIX HA.	2014 Interim Guidance on Patent Subject Matter Eligibility
APPENDIX IA.	2014 Interim Guidance on Patent Subject Matter Eligibility Nature-Based Products Examples
APPENDIX JA.	2014 Interim Guidance on Patent Subject Matter Eligibility Abstract Ideas Examples
APPENDIX KA.	July 2015 Update: Subject Matter Eligibility
APPENDIX LA.	Examples: Abstract Ideas
APPENDIX MA.	Trial Statistics IPR, PGR, CBM Patent Trial and Appeal Board July 2023
APPENDIX NA.	Appeal and Interference Statistics Patent Trial and Appeal Board July 2023
APPENDIX OA.	May 2016 Subject Matter Eligibility Update
APPENDIX PA.	May 4, 2016 Memorandum to Patent Examining Corps: Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant's Response to a Subject Matter Eligibility Rejection
APPENDIX QA.	November 2, 2016 Memorandum to Patent Examining Corps: Recent Subject Matter Eligibility Decisions
APPENDIX RA.	February 2018 Clarification of Written Description Guidance For Claims Drawn to Antibodies and Status of 2008 Training Materials
APPENDIX SA.	April 2018 Berkheimer Guidelines “Changes in Examining Procedure Pertaining to Subject Matter Eligibility”

APPENDIX TA.	January 2019 Subject Matter Eligibility Update
APPENDIX UA.	October 2019 Subject Matter Eligibility Update
APPENDIX VA.	OED Diversion Pilot Program
APPENDIX WA.	Critical Reference Date Under pre-AIA 35 U.S.C. § 102(e) of a U.S. Patent or U.S. Published Application Claiming the Benefit of a Prior U.S. Provisional Application During Examination of an Application
APPENDIX XA.	Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board
APPENDIX YA.	Orange Book Patent/Biologic Patent Study and District Court Pharma Litigation Study
APPENDIX ZA.	Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019
APPENDIX PCT1.	Chart of Paris Convention Countries and Two-Letter Codes [Note: Not All Paris Convention Countries are also PCT countries.]
APPENDIX PCT1A.	States Party to the PCT and the Paris Convention and Members of the World Trade Organization
APPENDIX PCT2.	PCT International Application Transmittal Letter and PCT Request Form
APPENDIX PCT3.	PCT International Search Report
APPENDIX PCT4.	PCT Demand Form
APPENDIX PCT5.	PCT International Preliminary Examination Report
APPENDIX PCT6.	PCT International Preliminary Report on Patentability
APPENDIX CC.	Glossary

Table of Laws and Rules

Table of Cases

Index