Table of Contents

Volume 1

PART I. BASIC PRINCIPLES OF PATENT PROTECTION

CHAPTER 1. WHAT A PATENT IS

§ 1:1 Letters patent; letters close
§ 1:2 A patent as a grant; as a contract
§ 1:3 Patents as monopolies and "common-law" rights
§ 1:4 —Rights conferred by letters patent
§ 1:5 —Monopolies in historical context
§ 1:6 —Is a patent a monopoly?
§ 1:7 —Consequences of patents as monopolies
§ 1:8 — —A patent encompasses an indefinitely large number of physical objects
§ 1:9 — —Patent is not limited to a particular situs
§ 1:10 — —Patent is negative right
§ 1:11 — — —Exclusive right/right to exclude others?
§ 1:12 — — —Hierarchy of patents (dominance/subservience)
§ 1:13 —Copyrights and trademarks as monopolies
§ 1:14 —Other than intellectual property monopolies
§ 1:15 — —Government created monopolies
§ 1:16 — —Privately created monopolies
§ 1:17 Inventions and discoveries
§ 1:18 Invention and science
§ 1:19 Patent rights, physical embodiments, and implied license to use
§ 1:20 Duration of patents
§ 1:21 —Extension of term due to regulatory review
§ 1:21.50 — —USPTO revised rule for patent term adjustment in view of *Supernus Pharmaceuticals v. Iancu*
§ 1:22 — —for Delays at other Agencies (FDA) under 35 U.S.C. 156
§ 1:23 — —Under the Patent Term Restoration Act of 1988
§ 1:24 Need for patents
§ 1:25 Historical note on patents
§ 1:26 Overview of patenting process

§ 1:27 —Filing and pre-filing considerations—Effect of filing
§ 1:28 Overview of the patenting process—Filing and pre-filing considerations—What must be filed—Needed documents
§ 1:29 — —Prior Art Searching using the Cooperative Patent Classification System (CPC) and the U.S. Patent Classification System (USPC)
§ 1:29.50 Prior Art Searching Considerations using the U.S. Patent Classification System
§ 1:29.55 Prior art searching using the CPC—Cooperative Patent Classification System
§ 1:29.56 Abbreviated guide to searching the USPC and CPC and WIPO databases for prior art patents
§ 1:29.57 The Chinese Patent Office (CNIPA, formerly SIPO) and European Patent Office (EPO) agreement that CNIPA, formerly SIPO will use the Cooperative Patent Classification System (CPC)
§ 1:29.58 The Korean Patent Office (KIPO) and the USPTO agreement that KIPO will use the Cooperative Patent Classification System (CPC)
§ 1:29.60 Internet Web site tools to assist in patent searches using both the U.S. Patent Classification System (USPC) and International Patent Classification Systems
§ 1:29.70 USPTO Launches New Patent Public Search Tool for Enhanced Public Access to USPTO prior art databases
§ 1:30 Overview of the patenting process—Patent application pendency before the Patent & Trademark Office—Consequences—Confidentiality
§ 1:31 — — —Time to license
§ 1:32 — — —No actionable infringement until the patent issues
§ 1:33 — —Patent application processing timetable
§ 1:34 —Post-issuance control by the Patent & Trademark Office
§ 1:35 —Comparison of U.S. patenting process with that prevalent in European Patent Convention countries and Japan—Progress in harmonizing U.S. and foreign patent laws
§ 1:36 — —Significant points yet to be harmonized
§ 1:37 —Summary of the revisions to the Patent Act by the Leahy-Smith America Invents Act (hereinafter "AIA")
§ 1:38 Summary of approaches to obtaining and enforcing patent rights
§ 1:39 Intellectual property attorney electronic tools for accessing USPTO resources in filing for intellectual property rights

§ 1:40 Summary of essential procedures used by patent attorneys and practitioners in IP practice with guidance to these procedures in the current treatise—Patent Law Fundamentals—Organized by sections of the treatise
§ 1:41 Intellectual Property Attorney Public Locations for Accessing USPTO Resources and for Assistance with Intellectual Property Rights
Appendix 1(A) Grant in Specification of an Original U.S. Utility Patent in New Format in View of Uruguay Round Agreements Act (U.S. Patent No. 5,543,706)
Appendix 1(B) Grant and Specification of an Original U.S. Utility Patent in New Format in View of Prior Law (U.S. Patent No. 4,463.215)
Appendix 1(C) Grant and Specification of an Original U.S. Utility Patent in Old Format (U.S. Patent No. 4,123,868)
Appendix 1(D) Interim Procedures for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos, Regarding the Overlapping Delay Provisions of 35 U.S.C. 154(b)(2)(A)
Appendix 1(E) Changes to Patent Term Adjustment in View of the Federal Circuit Decision in Novartis v. Lee

CHAPTER 2. SOME POPULARLY HELD MISCONCEPTIONS ABOUT PATENTS

§ 2:1 Introduction
§ 2:2 Patentability of ideas
§ 2:3 Precautions must be observed to preserve and protect proprietary rights in inventions and other "ideas" as (intellectual) property
§ 2:4 Invention need not have been practiced before it is patented
§ 2:5 Misconception about "conception"
§ 2:6 Mathematics and the patent attorney
§ 2:7 Invention and engineering
§ 2:8 Patent is not a magic instrument that spontaneously generates money for its owner
§ 2:9 "One picture is worth a thousand words"
§ 2:10 Invention involves combination
§ 2:11 Inapplicability of certain geometric axioms to patent law
§ 2:12 —"The whole equals the sum of its parts"

§ 2:13 —"Things equal to the same thing equal each other"
§ 2:14 Personal use is as much an infringement as commercial use
§ 2:15 Independent invention does not necessarily avoid infringement
§ 2:16 "Patent pending" and patent marking
§ 2:17 —Significance of "patent pending"
§ 2:18 —Patent marking—Purpose and effect
§ 2:19 — —Statutory evolution
§ 2:20 — —What constitutes proper marking
§ 2:21 — — —When articles are to be marked
§ 2:22 — — —Method or process claims
§ 2:23 — — —Who must mark
§ 2:24 — —Construction of the marking requirement
§ 2:25 — —Consequences of failure to comply
§ 2:26 —False marking
§ 2:27 — —Qui tam action
§ 2:28 — —As unfair competition
§ 2:29 Patent medicine
§ 2:30 Patent or publish
§ 2:31 Asymmetries and resulting anomalies in patent law
§ 2:32 —The anticipation/enablement axis
§ 2:33 —The Patent & Trademark Office proceedings/patent enforcement axis—The presumption of validity
§ 2:34 — —Claim construction
§ 2:35 —The patentability/priority axis
§ 2:36 —The infringement/interference axis
§ 2:37 —The interference/inventorship axis
§ 2:38 —The utility-design patent/plant patent axis
§ 2:39 —Patent invalidity/patent validity axis
§ 2:40 —Licensee estoppel/assignor estoppel axis
§ 2:41 —The 35 U.S.C.A. § 111(a) application/ 35 U.S.C.A. § 371(c) application—35 U.S.C.A. § 102(e) date axis
§ 2:42 —The 37 C.F.R. § 1.111/ 37 C.F.R. § 1.116—Responsibility for response axis
§ 2:43 —The reexamination/nonreexamination—Extension of time axis

CHAPTER 3. THE IMPACT OF INVENTION

§ 3:1 Inventive faculty: Its nature and nurture
§ 3:2 Invention as driving force in progress of civilization
§ 3:2.10 Invention and corporate change in asset value from tangible assets (property, equipment) to intangible assets (intellectual property, e.g. patents, trademarks)
§ 3:3 Relation between invention and patents

§ 3:5 Relation of patents and intellectual property to digital assets as Non-Fungible Tokens (NFTs)

CHAPTER 3A. ARTIFICIAL INTELLIGENCE (AI)

§ 3A:1 Introduction to Artificial Intelligence and Intellectual Property
§ 3A:2 Relation of Patents and Intellectual Property to Artificial Intelligence (AI)
§ 3A:3 Relation of Artificial Intelligence (AI) to Inventorship including Co-inventorship
§ 3A:4 The Biden Administration's Executive Order on the Use and Administration of Artificial Intelligence
§ 3A:5 The USPTO Inventorship Guidance for Artificial Intelligence (AI) Assisted inventions
§ 3A:5.20 The USPTO has issued revised guidance on Artificial Intelligence (AI) inventions and inventorship
§ 3A:6 The USPTO Requests Public Comments on the Impact of the Proliferation of Artificial Intelligence (AI) on Prior Art, the Knowledge of a Person Having Ordinary Skill in the Art, and Related Determinations of Patentability
§ 3A:7 The USPTO Guidance Update on Patent Subject Matter Eligibility, Including on Artificial Intelligence (AI)
§ 3A:8 USPTO joins with the National Science Foundation (NSF) in the National AI Research Resource pilot (NAIRR)
§ 3A:9 Subject matter of copyright—Copyrightable subject matter—Works generated by or derived from Artificial Intelligence (AI)
§ 3A:10 The USPTO Establishes Artificial Intelligence (AI) Automated Search Pilot Program—(ASAP!) Program

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

CHAPTER 4. TRADE SECRETS

§ 4:1 Definition of trade secrets and distinguishing features
§ 4:1.50 Sources and characteristics of trade secret law
§ 4:2 Trade secret distinct from the physical object

§ 4:3 Subject matter of trade secrets
§ 4:4 Factors to be considered in recognizing a trade secret
§ 4:5 Trade secret misappropriation—Subject matter jurisdiction
§ 4:6 —Elements of a cause of action for trade secret misappropriation
§ 4:7 Novelty or secrecy requirement
§ 4:8 Unobviousness standard does not apply
§ 4:9 Concreteness of the information
§ 4:10 Unfair (improper) means
§ 4:11 —Breach of contract
§ 4:12 —Promissory estoppel
§ 4:13 —Unjust enrichment
§ 4:14 —Tort
§ 4:15 —Lanham Act violation
§ 4:16 —Crime
§ 4:17 — —Under state law
§ 4:18 —Under federal law—Crime—Economic Espionage Act
§ 4:18.50 —Civil—Under federal law—Defend Trade Secrets Act
§ 4:19 Establishing and maintaining a confidential relationship
§ 4:20 Security measures
§ 4:21 Misuse of confidential information
§ 4:22 Remedies
§ 4:22.40 Summary Table—Significant U.S. Supreme Court Trade Secret Cases
§ 4:23 Patenting vs. maintenance as a trade secret
§ 4:24 Trademarks in conjunction with trade secrets
§ 4:25 Coexistence of patent and trade secret concepts
§ 4:26 Coexistence of copyright and trade secret concepts
§ 4:27 Public access to information submitted to the government
§ 4:28 Trade secret and know-how licenses
§ 4:29 Taxation of trade secrets

Appendix 4(A) Economic Espionage Act of 1996
Appendix 4(B) Economic Espionage Act Cases
Appendix 4(C) Table of states adopting the Uniform Trade Secrets Act
Appendix 4(D) Uniform Trade Secrets Act (with 1985 Amendments)
Appendix 4(E) Computer Fraud and Abuse Act (CFAA), 18 U.S.C.A. 1080

Volume 2

CHAPTER 5. TRADEMARKS

I. WHAT A TRADEMARK IS

§ 5:1 In general
§ 5:2 Cognate types of marks
§ 5:3 —Service marks
§ 5:4 —Collective marks
§ 5:5 —Certification marks
§ 5:6 Trademarks distinguished from business names
§ 5:7 Trademarks and unfair competition
§ 5:8 Grade, quantity, and style designations
§ 5:9 Historical note on trademarks
§ 5:10 Trade dress

II. BASIC REQUISITES OF AN ENFORCEABLE TRADEMARK

§ 5:11 In general
§ 5:12 Priority of appropriation in trade
§ 5:13 —Use v. registration
§ 5:14 —Federal intent-to-use legislation; applying for trademark registration
§ 5:14.01 Trademark Prosecution and the Process of Trademark Examination
§ 5:14.02 Trademark Prosecution—Applicant's filing of the trademark application
§ 5:14.03 —Trademark Examining Attorney First Office Action, including prior search and formal examination; and then the Applicant's Required Response to the Examiner's Office Action
§ 5:14.04 —Trademark Examining Attorney Final Office Action; and Applicant's Request for Reconsideration after Final and Appeal to Trademark Trial and Appeal Board
§ 5:14.05 —Trademark Examining Attorney Notice of Allowance, Registration, and Applicant's Required Statements of Use (SOU) or Extensions to File Statement of Use
§ 5:15 Priority of appropriation in trade—In connection with goods or services
§ 5:16 —Use on the Internet
§ 5:17 — —Applicability of preexisting injunctions to the Internet
§ 5:18 — —Trademark and service mark versus Internet domain name acquisition

§ 5:19 — — —Conflicting means of acquisition
§ 5:20 — — —Primacy of use
§ 5:21 — — —Recourse of trademark owners under trademark law
§ 5:22 — — — —Is registering of another's mark as part of a domain name trademark infringement?
§ 5:23 — — — —Is registering of another's trademark as part of a domain name trademark dilution?
§ 5:24 — — — —Anticybersquatting Consumer Protection Act
§ 5:25 — —What can constitute infringing use of a mark on the Internet?
§ 5:26 — —Where is an infringer amenable to suit?
§ 5:27 Distinctive or nonfunctional
§ 5:28 —Inherently distinctive marks
§ 5:29 — —Fanciful or coined marks
§ 5:30 — —Arbitrary marks
§ 5:31 — —Suggestive marks
§ 5:32 — —Composite marks
§ 5:33 —Secondary meaning marks (acquired distinctiveness)
§ 5:34 Trademark and service mark subject matter
§ 5:35 —Words (brand names)
§ 5:36 — —Surnames
§ 5:37 — —Geographic designations
§ 5:38 — —Immoral or scandalous and other prohibited subject matter
§ 5:39 — —Laudation (quality)
§ 5:40 — —Pronunciation or spelling
§ 5:41 — —Foreign equivalents
§ 5:42 —Word combinations and subcombinations
§ 5:43 — —Slogans
§ 5:44 — —Literary titles
§ 5:45 — —Alphabetical letters
§ 5:46 — —Numerals
§ 5:47 — —Abbreviations
§ 5:48 —Formats (stylization)
§ 5:49 —Symbols (characters, designs, and other pictorial or graphic representations)
§ 5:50 —Configurations (product or container shape)
§ 5:51 —Color
§ 5:52 —Sound
§ 5:53 —Smell (scent)

III. RIGHTS OF TRADEMARK OWNERS

§ 5:54 Rights against infringement
§ 5:55 —Direct infringement—At common law

§ 5:56 — —Under the Lanham Act
§ 5:57 — — —Lanham Act § 43(a), 15 U.S.C.A. § 1125(a)
§ 5:58 — — —Lanham Act § 32(1), 15 U.S.C.A. § 1114(1)
§ 5:59 — —Under the Lanham Act—Federal dilution statute
§ 5:60 —Contributory infringement
§ 5:61 —Defenses
§ 5:62 —Remedies
§ 5:63 — —Criminal responsibility
§ 5:64 — —Civil liability—Injunctive relief
§ 5:65 — — —Monetary award
§ 5:66 — — —Attorney' s fees and costs
§ 5:67 — — —Interest
§ 5:68 — — —Insurance coverage against infringement
§ 5:69 —Collateral estoppel
§ 5:70 To transfer and share—Assignment
§ 5:71 —Licensing and franchising
§ 5:72 —Tax consequences

IV. LOSS AND LIMITATION OF TRADEMARK RIGHTS

§ 5:73 Nonuse—Abandonment
§ 5:74 Marks that have become generic
§ 5:75 Misuse and unlawful use
§ 5:76 Fair use
§ 5:77 —First-sale doctrine
§ 5:78 —Rebottling and repackaging
§ 5:79 —Repair or reconditioning
§ 5:80 —Comparative advertising

V. FEDERAL PREEMPTION

§ 5:81 Federal preemption in general

VI. FEDERAL REGISTRATION UNDER THE LANHAM ACT

§ 5:82 The Lanham Act or the Federal Trademark Act
§ 5:82.30 The Trademark Modernization Act (TMA)
§ 5:83 Substantive requisites of federal registrability—Marks registrable on the principal register
§ 5:84 —Marks registrable on the supplemental register
§ 5:84.50 The registration procedure—Ex parte practice—The attorney or agent authorized to represent the trademark applicant
§ 5:85 Outline of the registration procedure—Ex parte practice—The application
§ 5:85.50 Trademark International Classification Schedule

of Goods and Services and the Calculation of Trademark Application Fees based on the Classification Schedule
§ 5:85.55 Trademark international classification—USPTO uses AI tool "Class Act" to assist in trademark pre-processing classification
§ 5:86 Outline of the registration procedure—Ex parte practice—The application—Application based on actual prior use in "commerce"
§ 5:87 — — —Application based on a bona fide intention to use in "commerce"
§ 5:88 — — —Application based on foreign registration in applicant's country of origin
§ 5:89 — — —Application based on an earlier filed foreign application, the priority of which is claimed
§ 5:90 Registration procedure—Ex parte practice—Filing and accessing official trademark records online
§ 5:91 — —The examination
§ 5:92 — —Ex parte practice—Examination—Rejections
§ 5:92.40 Trademark Attorney's refusal to register trademark based on likelihood of confusion
§ 5:92.70 Trademark Attorney's refusal to register trademark based on descriptiveness
§ 5:93 Registration procedure—Ex parte practice—Examination—Responses
§ 5:94 — — —Petitions to the Director
§ 5:95 — — —Appeals to the Trademark Trial and Appeal Board
§ 5:96 — —Disclaimer
§ 5:97 — —Fraud
§ 5:98 —Inter partes proceedings
§ 5:98.50 — —Letters of Protest
§ 5:99 — —Opposition
§ 5:100 — —Interference
§ 5:101 — —Concurrent use
§ 5:102 — —Cancellation
§ 5:103 *[Reserved]*
§ 5:104 Registration and post-registration practice
§ 5:105 —Maintaining a registration in full force
§ 5:106 —Application to register on the principal register a mark already registered on the supplemental register
§ 5:107 —Attacking registration of any confusingly similar mark
§ 5:108 —Certificates of correction
§ 5:109 Effect of registration—Types of registration
§ 5:110 —Access to federal courts

§ 5:111 —Marking
§ 5:112 —Renewals
§ 5:113 —Nationwide rights
§ 5:114 —Incontestability
§ 5:115 —Exclusion from importation
§ 5:116 —Criminal sanctions, treble damages, and seizure
§ 5:117 —Immunity from state mandated modification and insulation from state-based dilution claims
§ 5:117.30 Summary Table—Recent Supreme Court Trademark Cases and Decisions

VII. INTERNATIONAL AND FOREIGN TRADEMARK PROTECTION

§ 5:118 Territoriality
§ 5:119 Extra-territorial reach of U.S. trademark law
§ 5:120 Importation and exportation as trademark infringement
§ 5:121 Multilateral treaties and conventions—Paris Convention
§ 5:122 —Inter-American Convention
§ 5:123 —Trademark Law Treaty (TLT)
§ 5:124 —Trademark Registration Treaty (TRT)
§ 5:125 —Madrid Agreement
§ 5:126 —Madrid Protocol
§ 5:126.03 Filing an International Trademark Application under the Madrid Protocol
§ 5:127 Canadian trademark law
§ 5:128 European Community trade mark
§ 5:128.02 Regional authorities—European community trade mark—Eligible subject matter and eligible applicants
§ 5:128.04 — —Substantive requirements
§ 5:128.06 Regional Authorities—European Community Trade Mark—Scope and Term of Protection
§ 5:128.08 — —Protection for Unregistered Trade Marks
§ 5:128.10 Regional authorities—European Community trade mark—Requirements for a Community trade mark application
§ 5:128.12 Regional Authorities—European Community Trade Mark—Multiple Trade Marks Not Allowed One Application
§ 5:128.14 — —Fees for Community Trade Marks
§ 5:128.16 — —Filing Date and Priority of Community Trade Mark Applications
§ 5:128.18 — —Examination of Community Trade Mark Applications and Registration
§ 5:128.20 — —Opposition Proceedings before the OHMI

§ 5:128.22 — —Revocation and Invalidity Proceedings before the OHMI
§ 5:128.24 — —Appeal Proceedings before the OHMI
§ 5:128.26 — —Infringement and Litigation Proceedings before the Community Trade Mark Courts of the Member States
§ 5:128.28 — —Surrender of the Registered Community Trade Mark in order to avoid contested proceedings
§ 5:128.30 — —Proceedings and Appeals to the European Court of Justice

VIII. THE EFFECT OF FEDERAL REGISTRATIONS ISSUED UNDER ACTS PRIOR TO THE LANHAM ACT

§ 5:129 In general

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

Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement

Appendix 5(Q) USPTO Tips for International Trademark Filing and Frequently Asked Questions Regarding International Trademarks

Appendix 5(R) Trademark Fees at the United States Patent & Trademark Office

Volume 3

CHAPTER 6. COPYRIGHTS

§ 6:1 Introduction
§ 6:2 Copyright as the exclusive right to copy
§ 6:3 —Copyright does not preclude independent creation
§ 6:4 —Copyright does not extend to a utilitarian medium
§ 6:5 —Variation necessary to support a copyright and avoid infringement
§ 6:6 —Copyright distinct from the physical object
§ 6:7 — —What constitutes a "copy"?
§ 6:8 — —Internet use as generating a "copy" and as constituting copyright infringement
§ 6:9 Subject matter of copyright
§ 6:10 —Copyrightable subject matter—Literary works
§ 6:11 — — —Factual versus fictional works
§ 6:12 — — —Length (advertisements, labels, letters)
§ 6:13 — — —Compilations (directories, tests)
§ 6:14 — — —Computer programs (software)
§ 6:15 — — —Games
§ 6:16 — —Musical works (including any accompanying words)
§ 6:17 — —Dramatic works
§ 6:18 — —Pantomimes and choreographic works
§ 6:19 — —Pictorial, graphic, and sculptural works
§ 6:20 — —Motion pictures and other audiovisual works
§ 6:21 — —Sound recordings
§ 6:22 — —Architectural works
§ 6:22.30 — —Works generated by or derived from Artificial Intelligence (AI)
§ 6:23 —Noncopyrightable subject matter
§ 6:24 — —No more than de minimis originality
§ 6:25 — — —Blank forms
§ 6:26 — — —Lists of contents or ingredients
§ 6:27 — —Unprotectible "ideas"

§ 6:28 — —Subject matter protectible by patent or trademark
§ 6:29 Relationship to other rights—First Amendment
§ 6:30 —Contract
§ 6:31 —Obscenity
§ 6:32 —Defamatory and fraudulent works
§ 6:33 —Privacy and publicity
§ 6:34 —The right to copy under FOIA
§ 6:35 —Semiconductor Chip Protection Act
§ 6:36 —Semiconductor Chip Protection Act—Semiconductor chip technology
§ 6:37 — —Protection under the Semiconductor Chip Protection Act of 1984—Relation to other forms of legal protection
§ 6:38 — — —Protectible subject matter
§ 6:39 — — —Mask works eligible for protection
§ 6:40 — — —Duration of protection
§ 6:41 — — —Originality versus novelty/nonobviousness
§ 6:42 — — —Registration and deposit
§ 6:43 — — —Infringement
§ 6:44 — — —Who can sue
§ 6:45 — — —Where suit can be brought
§ 6:46 — — —Remedies
§ 6:47 — — —Ownership and transfer of rights
§ 6:48 — — —What to submit for recordation of transfer
§ 6:49 — — —Effect of the nationality of the mask work owner
§ 6:50 —Vessel Hull Design Protection Act
§ 6:51 — —Relation to other forms of legal protection
§ 6:52 — —Eligible subject matter
§ 6:53 — —Vessel hull designs not eligible for protection
§ 6:54 — —Duration of protection
§ 6:55 — —Novelty, "originality" or nonobviousness
§ 6:56 — —Priority
§ 6:57 — —Registration and its effect
§ 6:58 — —Application for registration and accompanying documents
§ 6:59 — —Filing and examination of applications for registration
§ 6:60 — —Post-registration jurisdiction
§ 6:61 — —Scope of protection
§ 6:62 — —Marking, false marking, and notice
§ 6:63 — —Acts of infringement
§ 6:64 — —Enforcement of exclusive rights
§ 6:65 — —Remedies
§ 6:66 — —Ownership and transfer of rights

§ 6:67 Exploiting copyrights—Recourse against infringement
§ 6:68 — —What constitutes copyright infringement—Direct infringement
§ 6:69 — — — —Subjective aspect—Intent irrelevant
§ 6:70 — — — —Objective aspect—"Substantial similarity," the test of copyright infringement
§ 6:71 — — —Contributory infringement
§ 6:72 — — —The Online Copyright Infringement Liability Limitation Act
§ 6:73 — — —The Audio Home Recording Act
§ 6:74 — —Defenses to copyright infringement
§ 6:75 — — —Statute of limitations, laches, and estoppel
§ 6:76 — — —Fair use and other limitations on exclusive rights
§ 6:77 — — —Copyright misuse
§ 6:78 — — —Ownership and license
§ 6:79 — —Conduct of copyright infringement litigation
§ 6:80 — — —Original subject matter jurisdiction
§ 6:81 — — —Standing to sue
§ 6:82 — — —Persons liable for infringement
§ 6:83 — — —Venue
§ 6:84 — — —Pleadings
§ 6:85 — — —Appellate review
§ 6:86 — —Remedies
§ 6:87 — — —Criminal responsibility
§ 6:88 — — —Civil liability—Injunction
§ 6:89 — — — —Impounding
§ 6:90 — — — —Damages
§ 6:91 — — — —Attorney's fees and costs
§ 6:92 —Recourse against circumvention
§ 6:93 — —Prohibition
§ 6:94 — —Effective dates
§ 6:95 — —Exceptions and exemptions
§ 6:96 — — —Classes of works exempted by administrative rule
§ 6:97 — — —Nonprofit libraries, archives, and educational institutions
§ 6:98 — — —Law enforcement, intelligence, and other government activities
§ 6:99 — — —Reverse engineering
§ 6:100 — — — —Encryption research
§ 6:101 — — — —Personally identifying information
§ 6:102 — — — —Security testing
§ 6:103 — —Remedies for violation of the anti-circumvention prohibition
§ 6:104 — — —Civil remedies

§ 6:105 — — —Criminal sanctions
§ 6:106 —Recourse against interference with copyright management information
§ 6:107 — —Definition of "copyright management information"
§ 6:108 — —The ban and its effective date
§ 6:109 — —Exception and limitations
§ 6:110 — —Remedies
§ 6:111 —Transfers
§ 6:112 —Tax treatment of copyrights
§ 6:113 Securing copyright—Copyright arises upon creation
§ 6:114 —Notice
§ 6:115 —Duration
§ 6:116 —Deposit and registration
§ 6:117 —Nationality or domicile requirement
§ 6:118 Other exclusive rights
§ 6:119 —Distribution and exclusion from importation
§ 6:120 —Performance
§ 6:120.50 — —Music Modernization Act of 2018
§ 6:121 —Display or exhibition
§ 6:122 —Derivative works
§ 6:123 —Moral rights
§ 6:124 —Rights not recognized by the United States—Performers' performance rights
§ 6:125 — —Resale rights
§ 6:126 — —Public lending right
§ 6:127 Collective works
§ 6:128 Government interest in copyrights
§ 6:129 Authorship and ownership
§ 6:129.30 Summary table—Significant Supreme Court copyright cases and decisions
§ 6:129.40 Copyright cases filed at the United States Supreme Court for which petition for writ of certiorari was not granted
§ 6:130 International and foreign copyright protection—Protection of foreign authors and their works in the United States
§ 6:131 —The rise and demise of the manufacturing clause
§ 6:132 —Protection of American authors and their works abroad
§ 6:133 — —Universal Copyright Convention (U.C.C.)
§ 6:134 — —Berne Convention
§ 6:135 — —Pan-American conventions
§ 6:136 — —WIPO copyright treaty
§ 6:137 — —Bilateral treaties
§ 6:138 — —"Neighboring rights" conventions

§ 6:139 —Extraterritorial reach of U.S. copyright law
§ 6:140 —Adjudication in the United States of claims arising under foreign copyright law
§ 6:141 —Importation and copyright infringement
§ 6:142 — —Border enforcement through the U.S. Customs Service
§ 6:143 — —Importation as an act of copyright infringement

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

PART III. THE SUBSTANTIVE REQUISITES OF A VALID PATENT

CHAPTER 7. STATUTORY SUBJECT MATTER

§ 7:1 Introduction
§ 7:2 Statutory subject matter: Inventions patentable
§ 7:3 Statutory subject matter: Animals
§ 7:4 Processes
§ 7:4.30 Summary Table of Supreme Court Decisions on Patent Eligible Subject Matter under 35 U.S.C. § 101
§ 7:4.50 Processes—Natural phenomena and applications of laws of nature—*Mayo v. Prometheus* and

Association for Molecular Pathology v. Myriad—USPTO Myriad-Mayo Guidance
§ 7:4.52 — —Diagnostic Methods as Unpatentable Subject Matter—*Athena Diagnostics v. Mayo Collaborative Services*
§ 7:5 —Computer programs
§ 7:5.40 Supreme Court's decision in *Alice Corp. Pty. Ltd. v. CLS Bank International*
§ 7:5.45 Patent & Trademark Office Preliminary Examination Instructions for Determining Subject matter Eligibility in view of the Supreme Court's decision in *Alice v. CLS Bank*
§ 7:5.46 Patent & trademark office interim guidance on patent subject matter eligibility (2014 interim eligibility guidance)
§ 7:5.47 Summary of Examples for Practitioners from USPTO Guidance on Patent Subject Matter Eligibility
§ 7:5.48 Summary of Patent & Trademark Office Guidance on Patent Subject Matter Eligibility (July 2015 Update)
§ 7:5.49 Summary of Patent & Trademark Office Guidance on Patent Subject Matter Eligibility (May 2016 Update)
§ 7:5.50 Summary of Patent & Trademark Office Guidance on Patent Subject Matter Eligibility—Business Methods (December 2016 Update)
§ 7:5.51 Summary of patent & trademark office guidance on patent subject matter eligibility (July 2017 Update)
§ 7:5.52 USPTO—2019 Revised Patent Subject Matter Eligibility Guidance
§ 7:5.54 —Practical Effects of the USPTO 2019 Revised Patent Subject Matter Eligibility Guidance
§ 7:5.56 —October 2019 Update to the 2019 Revised Patent Subject Matter Eligibility Guidance
§ 7:5.57 Summary of Patent & Trademark Office Guidance on Patent Subject Matter Eligibility—Update on Patent Subject Matter Eligibility, Including on Artificial Intelligence (July 2024 Update)
§ 7:5.57.50 USPTO Issues Revised Office Policy on Subject Matter Eligibility in view of Director review of PTAB decision in *Ex parte Desjardins*
§ 7:5.57.75 USPTO issues memoranda on new guidance for subject matter eligibility declarations (SMED) and subject matter eligibility guidance in the MPEP in view of *Ex Parte Desjardins*
§ 7:5.58 USPTO Issues Review Memorandum on Subject Matter Eligibility (August 2025)

§ 7:5.59	USPTO Report on Patent Examination outcomes after the Supreme Court's decision in *Alice v. CLS Bank*—and the 2019 Revised Patent Subject Matter Eligibility Guidance
§ 7:5.60	USPTO preparing a study on patent eligibility jurisprudence
§ 7:5.70	USPTO Commences Pilot Program for Patent Prosecution Permitting Applicants to Defer Responding to Rejections based on Subject Matter Eligibility
§ 7:5.73	Summary of USPTO Efforts to Provide Some Certainty to Patent Eligibility Subject Matter Jurisprudence
§ 7:5.80	Summary of Federal Circuit decisions—35 U.S.C. § 101 Patentable subject matter analysis
§ 7:5.81	—35 U.S.C. § 101 Patentable subject matter analysis for cases decided after the Supreme Court's decision in *Alice v. CLS Bank*
§ 7:5.82	—Patent eligibility—Determining whether a claim element is well understood, routine, and conventional—*Berkheimer v. HP Inc*
§ 7:5.83	—Summary Table of Federal Circuit Decisions on Patent Eligible Subject Matter under 35 U.S.C. § 101
§ 7:5.84	Practice guidance for patent application and claim drafting in view of the Supreme Court's decision in view *Alice v. CLS Bank*
§ 7:5.86	Patent & Trademark Office Interim Guidance for Determining Subject matter Eligibility for Process Claims in View of *Bilski v. Kappos*
§ 7:6	Processes—"Use patents" and new uses
§ 7:7	—Product-by-process claims
§ 7:8	Products
§ 7:9	—Machine (apparatus)
§ 7:10	—Manufacture
§ 7:11	—Composition of matter
§ 7:12	Nonstatutory subject matter
§ 7:13	—Subject matter specifically excluded by statute
§ 7:14	—Discoveries
§ 7:15	—Subject matter the novel aspects of which require mental activity
§ 7:16	— —Printed matter
§ 7:17	— —Methods of doing business
§ 7:18	— —Mental processes
§ 7:19	Multiple and alternative protection: Successive and simultaneous
§ 7:20	—Utility patent and design patent
§ 7:21	—Patent and copyright

§ 7:22 —Patent and trademark
§ 7:23 —Copyright and trademark

Appendix 7(A) Examination Guidelines for Computer Related Inventions M.P.E.P. § 2106, § 2106.01, and § 2106.02

Appendix 7(B) Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility

Appendix 7(C) Examination Guidelines for Living Subject Matter Inventions

Appendix 7(D) Interim Guidance for Determining Subject Matter Eligibility for Process Claims in view of Bilski v. Kappos (Interim Bilski Guidance)

Appendix 7(E) 2012 Interim Procedure for Subject Matter Eligibility Analysis Process Claims Involving Laws of Nature (Interim Mayo Guidance)

Appendix 7(F) 2014 Procedure for Subject Matter Eligibility Analysis of Claims Reciting or Involving Laws of Nature/Natural Principles, Natural Phenomena, and/or Natural Products

Appendix 7(G) Patent Eligibility Quick Reference Sheet for Claims Reciting or Involving Laws of Nature, Natural Phenomena, & Natural Products (Guidance)

Appendix 7(H) Collected Summary of USPTO Examiner Guidance—Examples of Patent Eligible Subject Matter Analysis under 35 U.S.C. § 101

Volume 4

CHAPTER 8. DESIGN PATENTS AS STATUTORY SUBJECT MATTER

§ 8:1 In general
§ 8:2 What constitutes statutory design
§ 8:2.50 USPTO Issues Guidance for Computer Implemented Designs and Icons
§ 8:3 Novelty of designs
§ 8:4 Ornamentality of a design
§ 8:5 Nonobviousness of designs
§ 8:6 Originality of a design
§ 8:7 Infringement of a design patent

§ 8:7.20 Complaint for design patent infringement and initial defenses
§ 8:7.50 Remedies and Damages for infringement of design patents
§ 8:8 Design drawing
§ 8:9 Design claim
§ 8:10 Presumption of validity
§ 8:11 Other design patent peculiarities
§ 8:12 Special requirements of design patent applications and applicable rules
§ 8:13 —Specification and claim
§ 8:14 —Drawing
§ 8:15 —Declaration
§ 8:16 —Fees
§ 8:17 —Foreign priority
§ 8:18 —Term
§ 8:19 Special Requirements of design patent applications and applicable rules—Accelerated examination of design patent applications
§ 8:20 USPTO Implementation of the Hague Agreement for International and Domestic Filing Design Patent Applications
§ 8:21 The USPTO Establishes a Design Patent Practitioner Bar for Design Patent Practitioners

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

CHAPTER 9. PLANT PATENTS AS STATUTORY SUBJECT MATTER

§ 9:1 Plants
§ 9:2 Plant Patent Act
§ 9:3 Plant Variety Protection Act
§ 9:4 Plants—Form S&T-470
§ 9:5 —Supporting exhibits—Exhibit A—Origin and breeding history of the variety
§ 9:6 — —Exhibit B—Statement of Distinctiveness
§ 9:7 — —Exhibit C—Objective description of the variety

§ 9:8 — —Exhibit D—Optional Supporting Information
§ 9:9 Plants—Supporting exhibits—Exhibit E—Statement of ownership
§ 9:10 Plants—Comparison of plant patent and plant variety protection
§ 9:11 —Utility patent protection for new plant varieties
§ 9:12 Outline of special requirements for plant patent applications

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

CHAPTER 10. NOVELTY

§ 10:1 Introduction
§ 10:1.50 The America Invents Act (AIA) revisions to 35 U.S.C. 102, Conditions for Patentability, novelty and loss of right to patent
§ 10:2 Prior art
§ 10:2.50 The America Invents Act (AIA) revisions to 35 U.S.C. 102, Definition of Prior Art
§ 10:2.60 Practical Effects of the First-to-File Amendments of the AIA and the Proposed Regulatory Changes
§ 10:2.70 Exceptions for Patent Applicant's Pre-Filing Activities and Grace Periods under the AIA 35 U.S.C. § 102(b)(1)(A) and 102(b)(1)(B)
§ 10:2.80 Exceptions for Prior Art under AIA 35 U.S.C. 102(b)(2)(A), (B), and (C) as applied to U.S. Patents, Patent Applications, and WIPO PCT Applications
§ 10:2.85 USPTO narrow interpretation of "subject matter" for Exceptions
§ 10:2.90 USPTO requirements for applicant submissions to benefit from exceptions
§ 10:3 Patents and printed publications as prior art
§ 10:4 Physical novelty required for anticipation
§ 10:5 Doctrine of inherency
§ 10:6 Novelty and anticipation
§ 10:7 35 U.S.C.A. § 102(a)

§ 10:8 35 U.S.C.A. § 102(b)
§ 10:8.50 The America Invents Act (AIA) revisions to 35 U.S.C. 102(b), 1-year grace period for prior disclosures by the inventor
§ 10:9 35 U.S.C.A. § 102(b)—"In public use"
§ 10:10 — —Experimental use
§ 10:11 — —Secret use
§ 10:12 —"On sale"
§ 10:12.50 The America Invents Act (AIA) revisions to 35 U.S.C. 102(b), effect on the "on sale" bar
§ 10:13 35 U.S.C.A. § 102(b)—Comparison of 35 U.S.C.A. § 102(a) and 35 U.S.C.A. § 102(b)
§ 10:14 Abandonment (35 U.S.C.A. § 102(c))
§ 10:14.50 The America Invents Act (AIA) revisions to 35 U.S.C. 102(c), common ownership exclusion from prior art
§ 10:15 35 U.S.C.A. § 102(d)
§ 10:16 35 U.S.C.A. § 102(e)
§ 10:17 35 U.S.C.A. § 102(f)
§ 10:18 35 U.S.C.A. § 102(g)
§ 10:19 Late claiming and intervening rights—Statutory time limitations on claiming
§ 10:20 Nonstatutory doctrine of late claiming
§ 10:21 Intervening rights

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

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

CHAPTER 11. UTILITY

§ 11:1 Introduction
§ 11:2 Utility as a requisite of patentability
§ 11:3 "Useful" versus "how to use"
§ 11:4 Operability
§ 11:5 Immoral or illegal
§ 11:6 Standard for mechanical-type inventions
§ 11:7 Standard for chemical and pharmacological inventions

Appendix 11(A) Examination Guidelines for the Utility Requirement

CHAPTER 12. NONOBVIOUSNESS

§ 12:1 Introduction
§ 12:2 The negative rules of invention
§ 12:3 The nonobviousness standard of 35 U.S.C.A. § 103

§ 12:3.20	The America Invents Act (AIA) revisions to 35 U.S.C. § 103, Conditions for Patentability, nonobvious subject matter
§ 12:3.40	35 U.S.C.A. § 103(b) Exception to nonobvious requirement
§ 12:3.60	35 U.S.C.A. § 103(c) Exception to nonobvious requirement
§ 12:4	Mental state of the inventor is irrelevant to patentability
§ 12:5	Proper application of 35 U.S.C.A. § 103
§ 12:6	—Making antecedent factual determinations under 35 U.S.C.A. § 103
§ 12:7	—What constitutes "prior art" under 35 U.S.C.A. § 103
§ 12:8	—What constitutes a "difference" under 35 U.S.C.A. § 103
§ 12:9	—Ascertaining the level of ordinary skill
§ 12:10	—Perspective legal drawing conclusion under 35 U.S.C.A. § 103
§ 12:11	—"The subject matter as a whole"
§ 12:12	—"At the time the invention was made" (hindsight and afterthoughts)
§ 12:13	Comparison of the application of 35 U.S.C.A. § 103 in patent application prosecution and in patent enforcement proceedings
§ 12:14	Patent application prosecution before the Patent & Trademark Office—Prima facie obviousness, motivation to combine prior art references and rebuttal
§ 12:15	Manner of adducing evidence in ex parte prosecution
§ 12:16	Patent enforcement proceedings—Presumption of patent validity
§ 12:17	— —Manner of adducing evidence in inter partes enforcement proceedings
§ 12:18	Appellate review of determinations under 35 U.S.C.A. § 103
§ 12:19	Case law prior to 35 U.S.C.A. § 103 as viable precedent
§ 12:20	The nonobviousness standard of 35 U.S.C.A. § 103—Is there a constitutional standard of invention?
§ 12:21	Analogous and nonanalogous art
§ 12:22	Impact of certain factors on the application of 35 U.S.C.A. § 103
§ 12:22.30	The doctrine of Inherency in Obviousness Determinations
§ 12:23	Impact of certain factors on the application of 35 U.S.C.A. § 103—Obviousness and equivalence

§ 12:24 —Combinations of old elements
§ 12:25 —Simplicity and sophistication
§ 12:26 —Predictability ("obvious to try"); expectation of success
§ 12:27 —Superiority, criticality, and optimization
§ 12:28 —"Teaching away from"
§ 12:29 —Identifying the source of a problem and its solution
§ 12:30 —Infringer's promotion
§ 12:31 —Chemical inventions
§ 12:32 — —Structurally obvious compounds
§ 12:32.50 The USPTO's Examiner Guidance and Training on prior art databases of the Federal Drug Administration (FDA) and National Institutes of Health (NIH) to search drugs, formulations and their methods of treatment or use
§ 12:33 Impact of certain factors on the application of 35 U.S.C.A. § 103—Chemical inventions—Purity
§ 12:34 — —Chemical processes
§ 12:35 — —Change in physical form and physical mixtures
§ 12:36 — —Genetic engineering
§ 12:37 — — —Hybridoma
§ 12:38 — — —Recombinant DNA
§ 12:39 —Computer software
§ 12:40 Secondary considerations
§ 12:41 —Unexpected results
§ 12:42 —Synergism (synergy)
§ 12:43 —Objective evidence of nonobviousness (the subtests of invention)
§ 12:44 — —Commercial success
§ 12:45 — —Long-felt demand
§ 12:46 — —Commercial acquiescence
§ 12:47 — —Skepticism of experts
§ 12:48 — —Praise for the invention
§ 12:49 — —Copying
§ 12:50 —"Blocking patents" may defeat objective evidence of nonobviousness

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

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

PART IV. OBTAINING PATENT PROTECTION

CHAPTER 13. PREPARATION OF PATENT APPLICATIONS

§ 13:1 Introduction
§ 13:1.50 Patent Law Treaty (PLT) revises requirements for USPTO application filing
§ 13:1.60 Required submissions for filing a patent application and common filing mistakes
§ 13:2 Oath or declaration
§ 13:2.50 —America Invents Act amendments for assignee filing
§ 13:3 —To accompany an application for an original patent
§ 13:4 —To accompany an application for a reissue patent
§ 13:5 Drawings
§ 13:6 Exhibits
§ 13:6.50 USPTO Rules for Electronic Submission of a Sequence Listing, a Large Table, or a Computer Program Listing Appendix in Patent Applications
§ 13:7 Specification
§ 13:7.50 USPTO notice of missing parts
§ 13:7.60 USPTO Extended Missing Parts Pilot Program
§ 13:8 Specification—Title and abstract
§ 13:9 —Cross-references to other applications
§ 13:10 —Background of invention
§ 13:11 —Summary of invention
§ 13:12 —Brief description of drawings
§ 13:13 —Detailed description
§ 13:13.50 The America Invents Act (AIA) revisions to 35 U.S.C. 112, specification
§ 13:14 Specification—Detailed description—"Written description" of invention (inter alia, "undue breadth")
§ 13:14.50 USPTO revised training materials on the written description requirement
§ 13:15 Specification—Detailed description—Enabling disclosure (inter alia "undue breadth")
§ 13:15.20 USPTO Guidance on Assessing Enablement in Utility Applications in View of the Supreme Court Decision in *Amgen v. Sanofi*
§ 13:15.30 Specification—Detailed description—Enabling disclosure (inter alia "undue breadth")—Prophetic Examples with Predicted Experimental Results

§ 13:15.40 — — —Specification and detailed description of the invention for Artificial Intelligence (AI) inventions
§ 13:16 — —Best mode
§ 13:17 —Claims
§ 13:17.10 — —Particularly pointing out and distinctly claiming the invention
§ 13:18 Duty of disclosure
§ 13:18.50 —USPTO Proposed Revision of 37 C.F.R. § 1.56
§ 13:19 Information disclosure (prior art) statements
§ 13:20 —Filing [37 C.F.R. § 1.97]
§ 13:21 —Format [37 C.F.R. § 1.98]
§ 13:21.50 Proposed rules modifying Information Disclosure Statement (IDS) practice before the USPTO
§ 13:21.60 USPTO Quick Path Information Disclosure Statement (QPIDS) Pilot Program
§ 13:22 Outline of special requirements for biotech patent applications
§ 13:23 —Biological material deposit requirement
§ 13:24 —Symbols for and format of nucleotide and amino acid sequence data
§ 13:25 —Adequate written disclosure
§ 13:26 Filing the patent application at the Patent and Trademark Office
§ 13:27 —USPTO proposed program "Modernizing Patent Application Filing"
§ 13:28 —USPTO new rule for eFiling patent applications in structured text format (DOCX)

Appendix 13(A) 37 C.F.R. § 1.76—Application Data Sheet
Appendix 13(B) Substitute Statement in Lieu of Oath or Declaration
Appendix 13(C) Applicant's Declaration for Plant Application
Appendix 13(D) Requirements for Using the Electronic Filing System for Patent Applications and Related Forms
Appendix 13(E) *[Reserved]*
Appendix 13(F) *[Reserved]*
Appendix 13(G) Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act
Appendix 13(H) USPTO's Revised Rules for Compliance with the International Sequence Listing Standard ST.26 (37 C.F.R. 1.831—1.835 and 1.839)

CHAPTER 14. PATENT CLAIMS: ANALYSIS AND SYNTHESIS

§ 14:1 Introduction
§ 14:2 Purpose of patent claims
§ 14:2.50 Breadth of Claims, Claim Language and Scope
§ 14:3 Purpose of patent claims—Defining the invention
§ 14:4 —Pointing out the invention
§ 14:5 Claims must express novel structure
§ 14:6 Structural versus functional language
§ 14:6.50 Functional Claiming
§ 14:7 Three unities implicit in all claims
§ 14:8 Claim syntax
§ 14:9 —Preamble or introductory phrase
§ 14:10 —Transitional phrase
§ 14:11 —Body of claim
§ 14:12 Claim grammar
§ 14:13 —Antecedent basis must be present
§ 14:14 —Alternative language
§ 14:15 —Markush group
§ 14:16 —Double inclusion of elements
§ 14:17 —Specific expressions—"Substantially"
§ 14:18 — —"About"
§ 14:19 — —"Close to"; "close proximity"; "closely approximate"; "in abutment with"; "joined"; and "connected"
§ 14:20 — —"Generally"
§ 14:21 — —"Normally" ("ordinarily")
§ 14:22 — —"Similar to"; "and the like"
§ 14:23 — —"Such as" ("preferably," "particularly," and "especially")
§ 14:24 — —"Optionally"
§ 14:25 — —"At least"
§ 14:26 — —"Whereby" and "so that" clauses
§ 14:27 —Relative terminology (terms of degree)
§ 14:28 —"In a manner similar to"
§ 14:29 —Ranges and proportions
§ 14:30 —Common Phrases and Claimed Element Terms
§ 14:31 Expressions of nonobviousness in claims
§ 14:32 Independent and dependent claims
§ 14:33 Broadening and narrowing of claims
§ 14:34 —Combination-subcombination relationship
§ 14:35 —Genus-species relationship
§ 14:36 —Means plus function claims
§ 14:37 —Step plus function claims
§ 14:37.25 Functional Claims in view of 35 U.S.C. § 112(f) and USPTO Guidance

§ 14:38 Claims drawn to different statutory classes
§ 14:39 —Machine
§ 14:40 —Manufacture
§ 14:41 —Method
§ 14:42 —Composition
§ 14:43 —Design
§ 14:44 —Plant
§ 14:45 Dominant and subservient claims
§ 14:46 Ascertainment of the meaning of claim terms and claim construction
§ 14:46.30 —Cases affirming infringement or reversing a finding of non-infringement in view of claim language interpretation
§ 14:46.50 —Cases affirming non-infringement in view of claim language interpretation or reversing a finding of infringement in view of claim language interpretation
§ 14:46.70 —Claim terms are to be given their ordinary and customary meaning
§ 14:46.75 Approaches to Indefiniteness under 35 U.S.C. § 112; Patent Examination, Post Grant Proceedings, and the District Courts
§ 14:47 Courts should resolve claim construction prior to analyzing a claim for patentability requirements (35 U.S.C.A. §§ 101, 102, 103, and 112)

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

Volume 5

CHAPTER 15. PROSECUTING PATENT APPLICATIONS

§ 15:1 Introduction

§ 15:1.5	Quick Primer to the Patent & Trademark Office (USPTO)
§ 15:1.6	USPTO Announces Multi-year Strategy for Improving Patent & Trademark Office Performance
§ 15:1.60	Patent & Trademark Office Publishes Initiatives To Ensure the Robustness and Reliability of Patent Rights
§ 15:1.63	The USPTO issues new guidance for patent examiners and patents employees to prevent conflicts-of-interest in making patent decisions
§ 15:1.7	USPTO Re-Evaluates Patent Examiner Time Goals
§ 15:1.75	The USPTO initiates revised performance plan for examiners and managers
§ 15:1.15	Summary of provisions for expediting examination of patent applications
§ 15:1.20	Patent & Trademark Office initiative for resolving conflicts with applicants—The Ombudsmen program
§ 15:1.50	Patent & Trademark Office proposed three track examination process
§ 15:2	Role of the patent attorney
§ 15:3	Filing patent applications
§ 15:4	—Benefit of filing dates of earlier filed applications [35 U.S.C.A. §§ 119, 120]
§ 15:5	—Benefit of filing dates of earlier filed provisional applications
§ 15:6	—Fees at the Patent and Trademark Office
§ 15:6.50	USPTO initiates new financial management system for fee payments
§ 15:7	Filing patent applications—Continuing applications, continued examination, and res judicata
§ 15:8	— —Continuation
§ 15:9	— —Continuation-in-part
§ 15:10	— —Divisional application
§ 15:11	— —Res judicata
§ 15:12	Prosecution before Primary Examiner
§ 15:12.05	—Using USPTO software tools and the software suite of Patents End to End (PE2E)
§ 15:12.10	Prosecution before the Primary Examiner—Expediting patent examination and petitions to make special
§ 15:12.25	Patent Prosecution Highway (PPH) for accelerated examination
§ 15:12.50	Prosecution before Primary Examiner—Rules for "Accelerated Examination"

§ 15:12.55 — —Changes in Accelerated Examination Practice
§ 15:12.57 —USPTO has terminated the "Accelerated Examination" program in view of the "Prioritized Examination Program"
§ 15:12.58 Prosecution before the Primary Examiner—"Prioritized Examination"
§ 15:12.59 —Brief Comparison of the "Accelerated Examination" procedure with the "Prioritized Examination" procedure
§ 15:12.60 Prosecution before Primary Examiner—Petitions to make special for expedited examination under Glossary Pilot Program to promote patent claim clarity
§ 15:12.62 —Streamlined Claim Set Pilot Program
§ 15:12.70 Prosecution before the Primary Examiner—Proposed pilot program for "community patent review" including peer review
§ 15:12.80 Preissuance submissions by third parties
§ 15:13 Prosecution before Primary Examiner—Action taken by examiner and applicant
§ 15:13.01 Patent Prosecution and the Process of Patent Examination
§ 15:13.02 Patent Prosecution—USPTO Preliminary Review of a Filed Application with Notices of Requirements; and Applicant's Required Response Before Examination
§ 15:13.03 —Patent Examiner First Action, including prior art search and formal examination; and Applicant's Required Response to the Examiner's Office Action
§ 15:13.04 —Patent Examiner's Final Office Action, including prior art search and formal examination; and Applicant's Required Response to the Final Action
§ 15:13.05 —Patent Examiner's After Final Rejection, Advisory Action; and Applicant's Subsequent Response including Request for Continued Examination (RCE)
§ 15:13.06 —Patent Examiner's Notice of Allowance; and Applicant's Response
§ 15:13.07 —Challenges in Obtaining Examiner's Notice of Allowance
§ 15:14 Rejections of applicant's claims
§ 15:15 —Under 35 U.S.C.A. § 102, for lack of anticipation
§ 15:16 —Under 35 U.S.C.A. § 103, as obvious
§ 15:17 —Under 35 U.S.C.A. § 101, as nonstatutory subject matter

§ 15:18 —Under 35 U.S.C.A. § 112, as failing to provide an enabling description
§ 15:19 — —First paragraph
§ 15:20 — —Second paragraph
§ 15:20.50 Functional Claiming under 35 U.S.C. § 112 (f) and Clarity of the Record
§ 15:20.52 USPTO Guidance on Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112
§ 15:21 Rejections—Under 35 U.S.C.A. § 112—Second paragraph—Duplicate claims
§ 15:22 — — —Aggregation
§ 15:22.50 Rejections based on 35 U.S.C. 112, paragraph 6, now amended as AIA 35 U.S.C. 112(f)
§ 15:23 Rejections—Under 35 U.S.C.A. § 132, for adding new matter
§ 15:24 —Under 35 U.S.C.A. § 135(b)
§ 15:24.50 Example USPTO Office Action Rejecting a Sample Disclosure and Claims
§ 15:25 Restriction and double patenting
§ 15:25.20 Restriction Practice during Patent Prosecution before the USPTO
§ 15:25.30 Restriction and double patenting—Time periods for response in view of the Patent Law Treaty (PLT)
§ 15:25.50 USPTO's new proposed changes to restriction practice
§ 15:26 Ex parte prosecution before Primary Examiner—Response by applicant—Written response
§ 15:27 Affidavit practice
§ 15:28 —37 C.F.R. § 1.130 affidavit or declaration to disqualify commonly owned patent or published application as prior art
§ 15:29 —37 C.F.R. § 1.131 affidavit or declaration of prior invention
§ 15:30 —37 C.F.R. § 1.132 affidavits or declarations traversing rejections or objections
§ 15:31 —37 C.F.R. § 1.132 affidavits or declarations traversing rejections or objections—Comparative tests or results
§ 15:32 — —Operability of applicant's disclosure
§ 15:33 — —Inoperability of references
§ 15:34 — —Commercial success
§ 15:35 — —Sufficiency of disclosure
§ 15:36 — —Nonobviousness
§ 15:37 Ex parte prosecution before Primary Examiner—Response by applicant
§ 15:38 — —Oral interview with examiner

§ 15:38.10	— —Oral interview with examiner initiated by applicant before examiner's first office action—First Action Interview FAI Program
§ 15:38.20	— — — —Interview conducted with WebEx video technology
§ 15:38.22	— — — —Interview Contacts and Specialists in the USPTO
§ 15:38.24	Automated Interview Request (AIR) Procedure and Form
§ 15:39	Ex parte prosecution before Primary Examiner—Response by applicant—Time for response
§ 15:40	— — —How reckoned
§ 15:41	— — —Manner of transmission
§ 15:41.25	Abandonment of Patent Application, Notice of Abandonment, and Applicant Response
§ 15:41.30	Lapse of Patent and Patent Rights for Failure to Pay Maintenance Fees
§ 15:42	Ex parte prosecution before Primary Examiner—Response by applicant—Revival of abandoned application or lapsed patent
§ 15:42.3	USPTO Clarification of the Requirement for Additional Information in Petitions for Revival of Abandoned Applications and Issued Patents Based on Unintentional Delay
§ 15:43	Ex parte prosecution before Primary Examiner—Response by applicant—Revival of abandoned application or lapsed patent—Unavoidable delay
§ 15:44	— — —Unintentional delay
§ 15:45	— — —Terminal disclaimer
§ 15:45.50	— — —Appeal of USPTO decisions on revival of abandoned applications
§ 15:46	—Reconsideration by examiner
§ 15:47	—Response by applicant to final rejection [37 C.F.R. § 1.116]
§ 15:47.50	—Response by applicant to final rejection [37 C.F.R. § 1.116]—After Final Consideration Pilot (AFCP) Program
§ 15:48	—Incomplete actions and incomplete responses
§ 15:49	Patent application allowance
§ 15:49.30	Ex parte prosecution before Primary Examiner—Reasons for Allowance
§ 15:50	—Amendment after allowance [37 C.F.R. § 1.312]
§ 15:50.50	The Patent Grant and USPTO Issuing Electronic Patent Grants
§ 15:51	Petitions to the Commissioner
§ 15:52	—Delegated authority to decide petitions
§ 15:52.50	Petitions to the commissioner—Delegated authority to decide petitions—Automated filing and decision process for certain petitions

§ 15:53	Petitions to the Commissioner—Delegated authority to decide petitions—To the Group Director
§ 15:54	— —To the Office of Petitions
§ 15:55	—Ripeness for, and the timing of, filing a petition
§ 15:56	—Form of petitions
§ 15:57	—Questions not specifically provided for
§ 15:58	—Suspension of rules
§ 15:59	—Judicial review
§ 15:60	Appellate review
§ 15:61	—By USPTO Patent Trial and Appeal Board (PTAB)—Board composition and jurisdiction
§ 15:61.20	— —Ex parte appeal process
§ 15:61.40	— —Streamlined, expedited patent appeal pilot for small entities
§ 15:62	— —Procedure—Notice of appeal
§ 15:62.40	— — —Fast-Track Appeals Pilot Program
§ 15:62.45	— — —Pre-Appeal Brief Conference Pilot Program (Pre-Appeal Program)
§ 15:62.50	— — —Post-Prosecution Pilot Program (P3)
§ 15:63	— — —Appellant's brief and examiner's answer
§ 15:63.10	Common problems and causes for rejection of applicant's brief
§ 15:64	Appellate review—By USPTO Patent Trial and Appeal Board (PTAB)—Procedure—Oral hearing
§ 15:65	— —Decision and disposition
§ 15:65.10	— — —Sanctions for attorney misconduct
§ 15:66	—Court review—35 U.S.C. § 141 and 35 U.S.C. § 145
§ 15:66.50	— —the America Invents Act changes to jurisdiction and venue for appellate review
§ 15:66.60	— —35 U.S.C. § 145 provision that the applicant will pay all expenses of the proceedings
§ 15:66.63	— — —Not Expert Witness Fees
§ 15:67	— —Jurisdiction—Court of Appeals for the Federal Circuit
§ 15:68	— —Standard of review—Court of Appeals for the Federal Circuit
§ 15:69	— —Procedure—Court of Appeals for the Federal Circuit
§ 15:70	Patent bar and regulation of patent attorneys
§ 15:70.10	Authority of the Patent & Trademark Office to Regulate Patent Attorney Conduct Including Conduct Outside the USPTO
§ 15:70.15	Patent Bar and the role of the patent attorney—Privileges and responsibilities; Revised rules of patent practices before the Patent and Trademark Office

§ 15:70.17 —Privileges and responsibilities; Amended rules of patent practices before the Patent and Trademark Office
§ 15:71 —Privileges and responsibilities; Prior Rules of patent practice before the Patent and Trademark Office
§ 15:71.10 —Relationship to the client and to the USPTO
§ 15:71.20 —Attorney—Client Engagement Letter and Retainer Agreement
§ 15:71.30 —Primary Areas for Complaints against Patent Attorneys or Agents
§ 15:71.50 Practice Pointers on Avoiding a Disciplinary (OED) Investigation
§ 15:71.52 USPTO Amends the Rules of Practice to Formalize the USPTO's Diversion Pilot Program to Avoid Formal Discipline of Patent Practitioners for Minor Misconduct Issues
§ 15:71.55 Practice pointers on avoiding a complaint for attorney malpractice
§ 15:71.60 Patent Bar and the role of the patent attorney—Privileges and responsibilities; revised rules on disciplinary procedures
§ 15:71.70 —Privileges and responsibilities; Revised rules of patent practices before the patent and trademark office—Annual patent practitioner registration fees
§ 15:72 —Invention promotion services
§ 15:73 Fraud on or "inequitable conduct" in Patent and Trademark Office
§ 15:74 —What constitutes culpable conduct—Fraud versus inequitable conduct
§ 15:75 — —Duty of disclosure
§ 15:76 — — —Materiality
§ 15:77 — — — —Alteration of official records
§ 15:78 — — — —Prior art references
§ 15:79 — — — —Prior public use or sale
§ 15:80 — — — —Affidavits and other submissions
§ 15:81 — — — —Error in inventorship
§ 15:82 — — — —Competing inventorship entity
§ 15:83 — — — —Content of specification
§ 15:84 — — —Wrongful intent
§ 15:85 — — —Who owes a duty to disclose
§ 15:86 — — —When and how disclosure should be made
§ 15:87 — — —Duty of disclosure in adversarial context
§ 15:88 —Consequences—To tainted patent
§ 15:89 — —To associated patents
§ 15:90 —Quantum of evidence required; standard of appellate review

§ 15:90.50 AIA provision for supplement examination to review possible inequitable conduct matters
§§ 15:91 to 15:99 *[Reserved]*
§ 15:100 Correction of defective patents—Disclaimers
§ 15:101 — —Disclaimer of entire unexpired term
§ 15:102 — —Terminal disclaimer
§ 15:103 — — —To obviate obviousness-type double patenting rejection
§ 15:103.50 — — — —Proposed Rules to change terminal disclaimer practice
§ 15:104 — — —To revive application abandoned for unintentional failure to pay issue fee when due
§ 15:105 — — —To revive application abandoned for unavoidable delay where period of abandonment is deemed excessive
§ 15:106 Extension of patent term due to prosecution delay
§ 15:107 —The guarantee of prompt office responses
§ 15:108 —The guarantee of no more than three-year application pendency
§ 15:109 —The guarantee or adjustments for delays due to interferences, secrecy orders, and appeals
§ 15:110 — —Actual period of term adjustment
§ 15:111 — —Disputes as to the proper period of adjustment
§ 15:112 Law followed by Patent and Trademark Office
§ 15:113 Statutory invention registration (S.I.R.) and defensive publication
§§ 15:114 to 15:119 *[Reserved]*
§ 15:120 USPTO Patent Prosecution Initiatives and Improvement Programs
§ 15:121 Patent & Trademark Office initiatives for improved patent quality
§ 15:122 Patent & Trademark Office—Enhanced Patent Quality Initiative
§ 15:123 Patent & Trademark Office Pilot Program for Quality Case Studies
§ 15:124 Patent & Trademark Office Patent Quality Metrics Proposed Master Review Form
§ 15:125 Patent & Trademark Office Initiates Quality Metrics Webpage for Public Disclosure
§§ 15:126 to 15:129 *[Reserved]*
§ 15:130 Patent application backlog reduction stimulus plan and initiative
§ 15:131 USPTO extends Cancer Immunotherapy Pilot Program for expediting the examination of patent applications pertaining to cancer immunotherapy

§ 15:132 Patent application streamlined examination for Green Technology patent applications
§ 15:133 Priority examination for important technologies
§§ 15:134 to 15:139 *[Reserved]*
§ 15:140 Corona Virus Pandemic (COVID 19)—USPTO Patent Adjustments for Covid-19 Virus Pandemic Impacts
§ 15:141 USPTO Initiates COVID-19 Prioritized Examination Pilot Program
§ 15:142 USPTO Initiates Deferred-Fee Provisional Application Pilot Program to Encourage COVID-19 Related Inventions
§ 15:143 USPTO Initiates Patent Application Pilot Program to promote technologies related to Climate Change and the Effects of Climate Change
§§ 15:144 to 15:149 *[Reserved]*
§ 15:150 USPTO introduces online tools to solicit public feedback on Manual of Patent Examining Procedure (M.P.E.P) and Trademark Manual of Examining Procedure (T.M.E.P.)
§ 15:151 USPTO introduces the patent pro bono program
§ 15:152 Patent & Trademark Office proposed extension of the provisional filing period
§§ 15:153 to 15:159 *[Reserved]*
§ 15:160 USPTO rescinded new rules filing continuation patent applications
§ 15:161 USPTO rescinded new rules for filing claims in patent applications
§ 15:162 Rescinded new rules for disclosing and identifying commonly owned applications and patents
§§ 15:163 to 15:169 *[Reserved]*
§ 15:170 USPTO announces unified replacement system for Private PAIR (electronic application file access) and EFS Web (electronic application filing)
§ 15:170.50 USPTO implements the Patent Center system to replace both previous systems for online retrieving and filing of patent applications—Private PAIR (electronic application file access) and EFS Web (electronic application filing)
§ 15:171 Access to USPTO files and filing Amendments via the Patent Center
§ 15:172 Prosecution before the primary examiner, new program for Electronic Office Action (e-Office Action)

Appendix 15(A) Specification of Reissue U.S. Utility Patent (Pat. No. Re. 25,558)

Appendix 15(B)	Statutory Invention Registration (H16)
Appendix 15(C)	Defensive Publication (T964,002)
Appendix 15(D)	Reexamination Certificate (B1 3,367,320)
Appendix 15(E)	Tables Correlating Effective Dates of Components of the American Inventors Protection Act and Implementing Regulations
Appendix 15(F)	Patent & Trademark Office Fees
Appendix 15(G)	Telephone Contacts at the U.S. Patent and Trademark Office
Appendix 15(G)(1)	Patent & Trademark Resource Centers (PTRCs) Contact List
Appendix 15(H)	USPTO Rules for Representation of Others Before the United States Patent and Trademark Office
Appendix 15(H)(1)	Changes to Representation of Others Before The United States Patent and Trademark Office; Final Rule, Current Rules of Practice, Effective May 3, 2013
Appendix 15(H)(2)	Representation of Others Before The United States Patent and Trademark Office; Prior Rules of Practice, Prior to May 3, 2013
Appendix 15(I)	Rules of Practice Before the Board of Patent Appeals and Interferences Appeals (including final amendments for Ex Parte Appeals for appeals filed on or after January 23, 2012)
Appendix 15(I)(1)	Rules for Patent Appeals, Title 37 Part 41, subparts A, B,and C, Rules for Practice Before the Board of Patent Appeals and Interferences (for appeals filed prior to January 23, 2012)
Appendix 15(J)	USPTO Customer Number Form and Certificate Action Form
Appendix 15(K)	Chart Comparing Request for Continued Examination, Continued Prosecution, and URAA Transitional Practice
Appendix 15(L)	Sample Format for Revised Amendment Practice Before the U.S. Patent & Trademark Office
Appendix 15(M)	Patent and Trademark Office Final Rules for Continuation Practice for

	Patent Applications (72 FR 46716, August 21, 2007)
Appendix 15(N)	Patent and Trademark Office Final Rules for Claims Prosecution (72 FR 46716, August 21, 2007)
Appendix 15(O)	Examination Guidelines for Determining Obviousness Under 35 U.S.C.A. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.
Appendix 15(O)(1)	2010 Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex
Appendix 15(P)	Sample Pre-Examination Search Report Document for the Accelerated Examination Program
Appendix 15(Q)	Sample Accelerated Examination Support Document for the Accelerated Examination Program
Appendix 15(Q)(1)	Patent & Trademark Office Amended Rules for Track One Prioritized Examination
Appendix 15(R)	Model Format for Attorney—Client Engagement Letter and Attorney—Client Retainer Agreement for Patent Practitioners
Appendix 15(S)	Appellant's Brief on Appeal to the Board of Patent Appeals
Appendix 15(T)	Changes to Implement Micro Entity Status for Paying Patent Fees
Appendix 15(U)	Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act
Appendix 15(V)	Changes To Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and To Revise Reexamination Fees
Appendix 15(W)	USPTO Enhanced Quality Initiative Master Review Form for Patent Office Action Review

CHAPTER 15A. POST GRANT REVIEW OF ISSUED PATENTS: CERTIFICATES OF CORRECTION, REISSUE OF PATENTS, EX PARTE REEXAMINATION, AND INTER PARTES REEXAMINATION

§ 15A:1 Correction of defective patents
§ 15A:2 —Certificates of correction
§ 15A:3 — —Patent and Trademark Office mistake
§ 15A:4 — —Applicant's mistake
§ 15A:5 —Reissue patents
§ 15A:6 — —Substantive aspects—Who can seek reissue
§ 15A:7 — — —Errors correctable by reissue
§ 15A:8 — — — —Relating to claims
§ 15A:9 — — — —Relating to inventorship
§ 15A:10 — — — —Relating to priority under 35 U.S.C.A. § 119 or § 120
§ 15A:11 — — —Errors not correctable by reissue
§ 15A:12 — — —"Error without any deceptive intention"
§ 15A:13 — — —Continuity in claiming
§ 15A:14 — — — —Scope of claims in original and reissue patents
§ 15A:15 — — — —Same invention, intent-to-claim, and no-new-matter requirements
§ 15A:16 — — — —Division of original by reissue
§ 15A:17 — — —Effect of reissue
§ 15A:18 — — —Relation to other proceedings
§ 15A:19 — —Procedural aspects—Current practice—Reissue application
§ 15A:20 — — — —Prosecution
§ 15A:21 — — —Prior reissue practice
§ 15A:22 —Reexamination and inter partes review
§ 15A:22.50 —Reexamination—Comparison of reexamination and reissue
§ 15A:23 — —Substantive aspects—Who can seek reexamination; patents subject to reexamination
§ 15A:24 — — —Issues addressed in reexamination
§ 15A:25 — — —Effect of reexamination—While reexamination is pending
§ 15A:26 — — — —Following reexamination
§ 15A:27 — — —Relation to judicial determinations of validity
§ 15A:28 — —Procedural aspects
§ 15A:29 — — —Request for reexamination
§ 15A:29.50 Pre-Order Procedure and Opposition to Request

for Reexamination—Correction of defective patents-Reexamination—Procedural Aspects
§ 15A:30 Correction of defective patents—Reexamination—Procedural aspects—Prosecution
§ 15A:31 — — —Prosecution procedures under ex parte reexamination
§ 15A:32 —Ex parte reexamination—Procedural aspects—Prosecution—Practitioner guidance
§ 15A:33 —Inter partes reexamination—Procedural aspects—Prosecution procedures under inter partes reexamination
§ 15A:34 — — —Prosecution—Practitioner guidance for Inter partes reexamination
§ 15A:35 —Reexamination—Procedural aspects—Appeal
§ 15A:36 Amending Patent Claims through Reissue or Reexamination Proceedings
§ 15A:37 Duty of Disclosure in Ex Parte Reexamination and Inter Partes Reexamination—Proposed Revised Rule

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

Volume 6

CHAPTER 15B. POST GRANT REVIEW OF ISSUED PATENTS—INTER PARTES PROCEEDINGS: INTER PARTES REVIEW (IPR), POST GRANT REVIEW (PGR), COVERED BUSINESS METHOD REVIEW (CBM)

I. *INTER PARTES REVIEW—INTRODUCTORY MATTERS*

§ 15B:1 Inter partes review—Introductory Matters

§ 15B:2 Constitutionality of Post Grant Proceedings—Inter Partes Review (IPR)—*Oil States Energy Services v. Greene's Energy Group*
§ 15B:3 Constitutionality of the Appointment of USPTO Administrative Patent Judges (APJs)—*Arthrex v. Smith & Nephew*
§ 15B:4 Challenges to USPTO Board (PTAB) Jurisdiction based on License or Contract Forum Selection Clause
§ 15B:5 The USPTO Board (PTAB) Is Required to Institute an Inter Partes Review on All Claims Raised by the Petitioner for Review—*SAS Institute v. Iancu*
§ 15B:6 USPTO amends the PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence
§ 15B:7 Challenges to the broadest reasonable interpretation (BRI) standard for construing claim language—*Cuozzo Speed Technologies v. Lee*
§ 15B:8 Patent Trial and Appeal Board (PTAB) application of the BRI standard for construing claim language
§ 15B:9 Final Rules for the Patent Trial and Appeal Board (PTAB) to change its standard for claim construction in post-grant proceedings by eliminating Broadest Reasonable Interpretation (BRI) and adopting the "ordinary and customary meaning" standard of the federal district courts
§ 15B:10 Standards of Proof in Inter Partes Review Decisions
§ 15B:11 Remedies Held to be Unavailable in Inter Partes Review (IPR) Cases
§ 15B:12 Inter partes review—Procedural requirements and timelines

II. *INTER PARTES REVIEW—INSTITUTION OF INTER PARTES REVIEW—PETITION FOR INTER PARTES REVIEW*

§ 15B:13 Inter partes review—Petition for Inter Partes Review—Petition for Inter Partes Review
§ 15B:14 —Patent Owner's Preliminary Response to Petition for Inter Partes Review
§ 15B:15 —Patent owner assertion of sovereign immunity from post grant proceedings
§ 15B:16 —Patent Owner's Preliminary Response with defense to an Inter Partes Review (IPR) in view of Indefinite Claims
§ 15B:17 —Patent Trial and Appeal Board (PTAB) Discretion Not to Institute Inter Partes Review Proceedings (IPR)

§ 15B:18 — —"Follow on" or "Serial" IPR Petitions
§ 15B:19 — —"Parallel" IPR Petitions
§ 15B:20 PTAB's Discretion to Institute AIA Trials in the case of "Parallel" IPR Petitions and the "Fintiv" Case Factors
§ 15B:20.10 Appellate challenge to USPTO's use of the *Fintiv* factors in its discretion to deny post grant proceedings without the formal rulemaking of the Administrative Procedure Act (APA)—*Apple v. Squire*s
§ 15B:21 Inter partes review—Patent Trial and Appeal Board (PTAB) Discretion Not to Institute Inter Partes Review Proceedings (IPR)—In view of prior art or arguments already considered under 35 U.S.C. § 325(d)
§ 15B:22 USPTO Request for Comments on Considerations and Rule-making for PTAB's Discretion to Institute AIA Trials before the Patent Trial and Appeal Board
§ 15B:22.30 Proposed Revision to Rules of Practice before the Patent Trial and Appeal Board
§ 15B:23 Patent Trial and Appeal Board Rules of Practice for Briefing Discretionary Denial Issues, and Rules for 325(d) Considerations, Instituting Parallel and Serial Petitions, and Termination Due to Settlement Agreement
§ 15B:24 Patent Trial and Appeal Board Guidance on Interim Processes for Workload Management, reviewing cases for (i) discretionary considerations or (ii) merit or non-discretionary statutory considerations
§ 15B:24.30 USPTO Director Institution of AIA Trial Proceedings at PTAB
§ 15B:24.70 USPTO Director's additional considerations of the small business or manufacturing status of Patent Owners or Petitioners in the Institution of IPR and PGR post grant proceedings at PTAB
§ 15B:25 Federal Circuit review of PTAB's Institution Decisions for IPR cases

III. *INTER PARTES REVIEW—AFTER DECISION TO INSTITUTE IPR PROCEEDING—SCHEDULING ORDER AND CONFERENCE CALL*

§ 15B:26 Inter partes review—After Decision to Institute IPR proceeding, Scheduling Order and Conference call
§ 15B:27 Scheduling Order and Summary Table of IPR Pleading Schedule after IPR Institution

§ 15B:28 After PTAB's decision to institute the IPR proceeding, discovery procedures
§ 15B:29 Patent owner's response to the IPR petition
§ 15B:30 Patent owner's motion to amend claims in IPR and post grant proceedings—Provision for claim amendments
§ 15B:31 Amendment of claims in IPR and post grant proceedings in view of the Federal Circuit's decision in *Aqua Products, Inc. v. Matal*
§ 15B:32 USPTO proposed rules and guidance on the petitioner's burden in Post Grant Proceedings in view of *Aqua Products, Inc. v. Matal*
§ 15B:33 USPTO final rules and guidance on the petitioner's burden of persuasion in Motions to Amend in Post Grant Proceedings in view of *Aqua Products, Inc. v. Matal*
§ 15B:34 USPTO issues Final Rules to Formalize the Pilot Program for Motions to Amend (MTA) the claims in post grant proceedings at PTAB
§ 15B:35 Petitioner's Reply to Patent Owner's Response
§ 15B:36 Patent Owner's Sur-Reply to Petitioner's Reply
§ 15B:37 Petitioner's Opposition to Patent Owner's Motion to Amend Claims
§ 15B:38 Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion to Amend Claims
§ 15B:39 Petitioner's Sur-reply to Patent Owner's Reply to the Opposition to the Motion to Amend Claims
§ 15B:40 Motions to Exclude Evidence
§ 15B:41 Final Written Decision, Conclusion and Appeal of IPR Final Written Decision

IV. *INTER PARTES REVIEW—FEDERAL CIRCUIT REVIEW OF PTAB'S FINAL WRITTEN DECISIONS FOR IPR CASES*

§ 15B:42 Inter Partes Review—Federal Circuit review of PTAB's Final Written Decisions for IPR cases
§ 15B:43 Federal Circuit Cases Affirming PTAB's Final Written Decisions by Using Federal Rule of Appellate Procedure 36 (Appellate Rule 36)
§ 15B:44 Summary Table of Federal Circuit review of PTAB's Institution Decisions and Final Written Decisions for IPR cases—Excluding Rule 36 Cases
§ 15B:45 Summary of PTAB Inter Partes Review (IPR) Cases that have been Reversed or Remanded by the Federal Circuit
§ 15B:45.30 Remedies held to be unavailable in Inter Partes Review (IPR) cases

§ 15B:46 Judgment by the USPTO Board (PTAB) and Estoppel Effect on Further Litigation
§ 15B:47 Parallel post grant proceedings at the USPTO and in the federal courts

V. *POST GRANT REVIEW*

§ 15B:48 Post grant review
§ 15B:49 Post Grant Review (PGR)—Procedural requirements and timelines
§ 15B:50 Post grant review—Petition for Post Grant Review
§ 15B:51 Post Grant Review—Patent Trial and Appeal Board (PTAB) Discretion Not to Institute Inter Partes Review under 35 U.S.C. 324—Discretionary Denial to Institute Post Grant Proceedings
§ 15B:52 —Decision to Institute PGR—Scheduling Order and Due Dates
§ 15B:53 —Patent Owner's Response to Petition for Post Grant Review (PGR)
§ 15B:54 Federal Circuit review of PTAB's Final Written Decisions for PGR Cases

VI. *COVERED BUSINESS METHOD REVIEW*

§ 15B:55 Covered Business Method Review—Transitional program for covered business method patents
§ 15B:56 Covered Business Method Review (CBM) Procedures and Timeline
§ 15B:57 Covered Business Method Review (CBM)—Petition for CBM Review
§ 15B:58 Covered Business Method Review—Patent Trial and Appeal Board (PTAB) Discretion Not to Institute Covered Business Method Review
§ 15B:59 Covered Business Method Review (CBM)—Scheduling Order and Due Dates
§ 15B:60 Covered Business Method (CBM)—Final decisions of the PTAB
§ 15B:61 Covered Business Method Review (CBM)—Patent Owner's Response to Petition for Covered Business Method Review
§ 15B:62 Federal Circuit review of PTAB's Institution Decisions and Final written decisions for CBM (Covered Business Method) cases

VII. *DIRECTOR REVIEW OF PTAB DECISIONS*

§ 15B:63 Director Review of PTAB Decisions
§ 15B:64 The USPTO in compliance with Supreme Court's decision in *Arthrex* has initiated interim procedure for Director Review (DR) in challenging PTAB post grant decisions

§ 15B:65 The USPTO in compliance with the Supreme Court's decision in Arthrex seeks to expand Director Review of challenging PTAB decisions
§ 15B:66 The USPTO Issues Final Rule for Director Review of PTAB decisions
§ 15B:67 Director Review Decisions on review of PTAB cases

VIII. *PATENT TRIAL AND APPEAL BOARD (PTAB) AND TRIAL PRACTICE BEFORE PTAB*

§ 15B:68 The Patent Trial and Appeal Board (PTAB) and Trial Practice before the PTAB
§ 15B:69 Appellate Review of USPTO Board (PTAB) Inter Partes Review (IPR) decisions and Post Grant Review (PGR) decisions
§ 15B:70 The Patent Trial and Appeal Board (PTAB) and Trial Practice before PTAB—Trial Practice Guide—August 2018 Update
§ 15B:71 — —July 2019
§ 15B:72 —Consolidated Trial Practice Guide—November 2019
§ 15B:73 Comparison of Post Grant Procedures: Ex Parte Reexamination, Post Grant Review, and Inter Partes Review
§ 15B:74 Summary Practitioner Guidance for Filing Post Grant Proceedings, including Inter Parties Review (IPR), Post Grant Review (PGR), and Covered Business Method review (CBM)
§ 15B:75 Amended Rules for PTAB Proceedings
§ 15B:76 USPTO Proposed Amended Rules for PTAB Proceedings
§ 15B:77 Amendment to Rules for PTAB Proceedings—Attorney-Client Privilege
§ 15B:78 Possible Alternative Procedures After a Patent's Claims have been Cancelled in AIA Post Grant Proceedings
§ 15B:79 The USPTO is reviewing PTAB procedures for possible changes to PTAB in order to strengthen patent rights and increase the reliability of the patent grant

IX. *APPEALS REVIEW PANEL (ARP) FOR REVIEW OF PTAB EX PARTE APPEALS, RE-EXAMINATION APPEALS, AND REISSUE APPEALS*

§ 15B:80 Appeals Review Panel (ARP) for review of PTAB ex parte appeals, re-examination appeals, and reissue appeals

§ 15B:81 Revised Standard Operating Procedures ("SOPs") for the paneling of matters before PTAB and for determining precedential and informative decisions

§ 15B:82 Re-Hearing and Review of Board (PTAB) Decisions—The initial Precedential Opinion Panel (POP)

§ 15B:83 —The Appeals Review Panel (ARP) together with Director Review (DR) including the Delegated Rehearing Panel (DRP) Replaces the Precedential Opinion Panel (POP)

Appendix 15B(A) Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act

Appendix 15B(A)(1) Rules of Practice for Trials before Patent Trial and Appeal Board and Judicial Review of Decisions

Appendix 15B(B) Inter Partes Review of Patents: Statute and Rules

Appendix 15B(B)(1) Inter Partes Review (IPR) of Patents Amended Rule for Burden of Persuasion for claim amendments

Appendix 15B(C) Post Grant Review of Patents: Statute and Rules

Appendix 15B(C)(1) Post Grant Review (PGR) of Patents Amended Rule for Burden of Persuasion for claim amendments

Appendix 15B(D) Transitional Program for Covered Business Method Patents: Statute and Rules

Appendix 15B(E) Model Scheduling Order for Inter Partes Review, Post-Grant Review, and Covered Business Method Patents Review (Based on the Trial Practice Guide, August, 2018)

Appendix 15B(F) Standing Protective Order for Trials before the Patent Trial and Appeal Board

Appendix 15B(G) Example of Claim Construction Tables in Post Grant Review Proceedings

Appendix 15B(H) Example Claim Chart for Post Grant Review

Appendix 15B(I) Patent Trial and Appeal Board—Consolidated Trial Practice Guide November 2019 Edition

Appendix 15B(I)(1) Office Trial Practice Guide Update (August 2018)

Appendix 15B(J) Proposed Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings before the Patent Trial and Appeal Board

PART V. COMPETING RIGHTS TO THE SAME INVENTION

CHAPTER 16. PRIORITY OF INVENTION, DERIVATION, AND INTERFERENCE PRACTICE

§ 16:1 Introduction
§ 16:1.50 The America Invents Act (AIA) derivation procedures that will replace interference procedures—Revisions to 35 U.S.C. 102(g) and 35 U.S.C. 135
§ 16:2 Substantive issues
§ 16:3 —Relating to priority—Conception
§ 16:4 — —Reduction to practice
§ 16:5 — —Diligence
§ 16:6 — —Abandonment, suppression, or concealment
§ 16:7 — —Derivation
§ 16:8 —Relating to patentability
§ 16:9 — —Based on prior art
§ 16:10 — —Based on sufficiency of disclosure
§ 16:11 Interference practice: Interlocutory matters
§ 16:12 —Inter partes proceedings
§ 16:13 —Types of interferences
§ 16:14 —Determination of an interference—Setting up the counts
§ 16:15 — —Preliminary inquiry
§ 16:16 —Setting up the interference—Initial memorandum
§ 16:17 —Determination of interference—Setting up the counts—Notice of interference
§ 16:18 — — —Statute of limitations
§ 16:19 —Province of the Board, Commission, and Primary Examiner—Board of Patent Appeals & Interferences in interferences—Jurisdiction
§ 16:20 — — —Imposition of sanctions
§ 16:21 — —Petitions to the Commissioner
§ 16:22 —Motions and orders
§ 16:23 — —Preliminary motions
§ 16:24 — — —Subject matter of preliminary motions

§ 16:25 — — —Time for filing preliminary motions
§ 16:26 — —Motions to correct the inventorship entity
§ 16:27 — — —Time for filing motions
§ 16:28 — — —Required showing
§ 16:29 — —Miscellaneous motions—Subject matter
§ 16:30 — — —Time for filing
§ 16:31 — —Motion papers—General form and content
§ 16:32 — — —Special requirements of specific motions
§ 16:33 — —Opposition of motions and reply thereto
§ 16:34 — —Service of motion papers
§ 16:35 — —Orders—Interlocutory
§ 16:36 — — —Show cause
§ 16:37 —Redeclaration
§ 16:38 —Preliminary statements
§ 16:39 Interference practice: Evidence
§ 16:40 —Applicable rules of evidence
§ 16:41 —Corroboration
§ 16:42 —Burden of proof
§ 16:43 —Inventions made abroad
§ 16:44 Interference practice: Trial and disposition of priority issues—Making a case for priority
§ 16:45 Trial of an interference
§ 16:46 —Discovery
§ 16:47 —Oral conference to set the time and place of deposition
§ 16:48 —Testimony
§ 16:49 — —Testimony by deposition
§ 16:50 — —Testimony by affidavit
§ 16:51 — —Agreed statement
§ 16:52 —Briefs and proposed findings of fact and conclusions of law
§ 16:53 —Final hearing
§ 16:54 Trial of interference—Award of priority and termination
§ 16:55 —Decision by Board
§ 16:56 —Settlement by the parties
§ 16:57 Judicial review
§ 16:58 Relation of interference to disclaimer, reissue, and reexamination proceedings
§ 16:59 Ex parte practice after termination
§ 16:60 —Interference estoppel
§ 16:61 —Resumption of jurisdiction by the Primary Examiner
§ 16:62 Interferences between patents [35 U.S.C.A. § 291]
§ 16:63 Arbitration of interferences
§ 16:64 Highlights in the historical evolution of patent

interference practice and the evolving rules of practice for interference cases
§ 16:64.05 Highlights of patent interference proceedings
§ 16:65 Requirements for an interference proceeding under the "new rules"
§ 16:66 Initiating an interference proceeding under the "new rules"
§ 16:67 Procedures after the interference is declared under the "new rules"
§ 16:68 Motions phase under the "new rules"
§ 16:68.10 Guidance on drafting motions, oppositions, and replies
§ 16:68.20 Motions phase under the "new rules"—Oral argument
§ 16:68.30 —Request for rehearing
§ 16:68.50 Priority statement under the new rules
§ 16:69 Priority phase under the "new rules"
§ 16:70 Termination of the Interference under the "new rules" by Settlement and Motion for Adverse Judgment
§ 16:71 The America Invents Act (AIA) derivation procedures that will replace interference procedures—Revisions to 35 U.S.C. 135—Determinations by the Patent Trial and Appeal Board
§ 16:72 Rules of practice for Derivation Proceedings and practitioner guidance

Appendix 16(A) 1985 Patent Interference Rules, Title 37 C.F.R. Section 1.601 to 37 C.F.R. Section 1.690
Appendix 16(B) Patent Interference Rules, Title 37, Part 41—Practice Before the Board of Patent Appeals and Interferences
Appendix 16(C) United States Patent and Trademark Office—Board of Patent Appeals and Interferences—Trial Section—Contested Case Practice Guide
Appendix 16(D) Standing Order of the Board of Patent Appeals and Interferences entered January 3, 2006
Appendix 16(E) Sample Real Party in Interest Pleading
Appendix 16(F) Sample Lead & Backup Counsel Pleading
Appendix 16(G) Sample Related Proceeding Pleading
Appendix 16(H) Sample File History Pleading
Appendix 16(I) Sample Clean Copy of Claims Pleading
Appendix 16(J) Sample Annotated Claims Pleading

Appendix 16(K) Sample Motions List Pleading
Appendix 16(L) Motion for Judgment Based on No Interference-in-Fact and supporting documents
Appendix 16(M) Priority Statement filed under 37 C.F.R. 41.204
Appendix 16(N) Motion for Judgment Based on Priority and Derivation
Appendix 16(O) Supplemental List of Exhibits In support of Motion for Priority
Appendix 16(P) Sample Exhibit and Sample Witness Declaration in Support of Motion for Priority
Appendix 16(Q) Sample Motion for Adverse Judgment and Settlement Agreement Under the "New Rules"
Appendix 16(R) Derivation Proceedings under the AIA: Statute and Rules
Appendix 16(S) Scheduling Order for Derivation Proceedings (Based on the Proposed Trial Rules)

CHAPTER 17. THE INVENTORSHIP ENTITY, PATENT OWNERSHIP, AND EMPLOYER-EMPLOYEE RIGHTS

§ 17:1 Introduction
§ 17:2 Inventorship entity—In general
§ 17:3 Joint invention—Conception as the "touchstone" of inventorship
§ 17:4 —Need for collaboration
§ 17:5 —Patent Law Amendments Act of 1984
§ 17:6 —Presumption that inventorship entity is correct as filed
§ 17:7 Inventorship versus priority of invention
§ 17:8 Inventorship entity and "prior art"
§ 17:9 Nonjoinder and misjoinder
§ 17:10 —Correcting inventorship in patent applications
§ 17:11 —Correcting inventorship in issued patents
§ 17:12 — —Administrative proceedings
§ 17:13 — —Judicial proceedings
§ 17:14 — —Presumption of correctness
§ 17:15 — —Is diligence required?
§ 17:16 — —Necessary parties
§ 17:17 — —What constitutes "error without deceptive intention"?

§ 17:18 — —Relation to interference proceedings
§ 17:19 —Other procedures for curing inventorship defects as unavailing
§ 17:20 Substitution
§ 17:21 Rights of employer and employee inter se
§ 17:22 —Shop right
§ 17:23 —General employment versus hired to invent
§ 17:24 —Contractual allocation of patent rights—Express contract
§ 17:25 — —Implied contract
§ 17:26 Enforcement
§ 17:27 —Academic faculty
§ 17:28 —Special status situations—Corporate officers
§ 17:29 Proprietary rights among joint owners
§ 17:30 Proprietary rights in biological-based inventions
§ 17:31 Patent applications by persons other than the inventor; real party in interest
§ 17:32 Involuntary assumption and transfers of title
§ 17:33 —Allocation of marital assets
§ 17:34 Employee's obligations regarding his employer's trade secrets

CHAPTER 18. GOVERNMENT INTEREST IN PATENTS: PROCUREMENT AND OWNERSHIP

§ 18:1 Introduction
§ 18:2 Inventions made with federal funds
§ 18:3 —By federal employees
§ 18:4 Licensing of patents developed by federal agencies or with federal funding
§ 18:5 —By private independent contractors-In general
§ 18:6 Bayh-Dole Act—Policy prior to the Act
§ 18:7 —A new era in government contracting of patent rights
§ 18:7.10 Government Agency "March-in rights" permitting the Government to grant additional licenses to other "reasonable applicants"—35 U.S.C.A. § 203
§ 18:7.15 Government Agency "March-in rights"—Commerce Department Request for Information on permitting the Government to grant additional licenses to other parties in part based on pricing of goods and services—35 U.S.C. § 203
§ 18:7.20 Case applications of "March-in Rights"
§ 18:7.30 Federal Acquisition Regulation (FAR) for implementing Bayh-Dole Act
§ 18:7.50 Bayh-Dole Act—A new era in government contracting of patent rights—Practitioner

Guidance on FAR and DFARS clauses for Government Procurement Contracts
§ 18:7.75 Practitioner Guidance on FAR and DFARS clauses for Government Procurement Contracts—Delivery of Technical Data and Computer Software to the Government
§ 18:8 Bayh-Dole Act—A new era in government contracting of patent rights—Policy under the Bayh-Dole Act, section 209
§ 18:9 — — —Mission agencies
§ 18:10 — — — —Department of Energy
§ 18:11 — — — —National Aeronautics and Space Administration
§ 18:12 — — —Tennessee Valley Authority
§ 18:13 Federal patent procurement
§ 18:14 Public access to government owned inventions
§ 18:15 Government access to privately owned inventions
§ 18:16 —At the patent application stage
§ 18:17 —Treatment of patents in awarding government contracts
§ 18:18 —Adjudication of claims against the United States for intellectual property infringement
§ 18:18.10 Administrative claims against defense department agencies for infringement
§ 18:19 Government access to privately owned inventions—Compulsory licensing
§ 18:20 —Invasion of patent rights by the states
§ 18:20.30 The USPTO seeks comments for Sovereign Immunity Study on State Entities Infringing Patent and Trademark Rights
§ 18:21 State procurement regulations and procurement in patent rights
§ 18:21.20 USPTO and Food and Drug Administrative Agency (FDA) collaboration on pharmaceutical patents
§ 18:22 United States Food and Drug Administration (FDA) approval of a generic drug or pharmaceutical that has been previously patented
§ 18:23 United States Food and Drug Administration (FDA) approval of a biologic and biosimilar medical products
§ 18:23.30 United States Food and Drug Administration (FDA) increases approval of a biologic and biosimilar medical products
§ 18:24 Litigation Approaches in Enforcing Biosimilar Patents
§ 18:24.25 —Continuing *Amgen v. Sandoz* Biosimilar Litigation

§ 18:25 Provisions for injunctive relief for biosimilar products
Appendix 18(A) Standard Patent Clauses for Government Contracts
Appendix 18(B) Standard Patent Clauses for U.S. Defense Department Contracts (DFARS)
Appendix 18(C) Model CRADA Agreement for Cooperative Venture with Federal Agency
Appendix 18(D) Memorandum of Invalidity in Administrative Patent Claim

Volume 7

PART VI. EXPLOITING PATENT RIGHTS

CHAPTER 19. LICENSING AND ASSIGNMENT: THE SHARING AND TRANSFER OF PATENT RIGHTS

§ 19:1 Introduction
§ 19:2 Distribution of rights embraced in a patent
§ 19:3 —Assignment vs. license
§ 19:4 — —Assignment
§ 19:5 — —License, Exclusive or Nonexclusive
§ 19:6 — —Assignment vs. Exclusive License
§ 19:6.50 Methods of valuation of patents for licenses or assignments
§ 19:6.60 Licensor and Licensee Negotiations and Due Diligence in Evaluating Patent Portfolios for License Negotiations
§ 19:6.65 Essential Considerations in Drafting the Patent License Agreement
§ 19:6.70 Terms and clauses of the patent license agreement
§ 19:7 Distribution of rights embraced in a patent—Rights embraced in the patent grant
§ 19:8 — —Duration
§ 19:9 — —Manufacture, use, sale, offer to sell, or import
§ 19:10 — —Field of use
§ 19:11 — —Geographic territory
§ 19:12 — —Quantity
§ 19:13 Patent and Invention Development Agreements
§ 19:14 —Royalties
§ 19:15 — —Periodic vs. Lump-Sum Payment

§ 19:16 — —Royalty rates and royalty bases
§ 19:17 —Exchange of patent rights
§ 19:18 —Cessation of royalty payments
§ 19:19 Ancillary provisions—Warranties
§ 19:20 —Police, security, access, and quality provisions
§ 19:21 —Most-favored licensee
§ 19:22 —Arbitration clause
§ 19:23 —Miscellaneous contract clauses and provisions
§ 19:24 Viability of restrictions on the physical object
§ 19:25 Antitrust analysis and critique
§ 19:26 —Sherman Act § 1 (15 U.S.C.A. § 1)
§ 19:27 —Clayton Act § 3 (15 U.S.C.A. § 14)
§ 19:28 —Patent Misuse Reform Act (35 U.S.C.A. § 271(d))
§ 19:29 —Sherman Act § 2 (15 U.S.C.A. § 2)
§ 19:29.10 Department of Justice (DOJ) and Federal Trade Commission (FTC) Antitrust Guidelines for Intellectual Property Licensing
§ 19:29.40 Antitrust analysis and critique—Sherman Act § 2 (15 U.S.C.A. § 2)—Standard Setting Organizations SSO
§ 19:29.70 — —Standard Essential Patents and Smartphone Patent Disputes
§ 19:29.75 Standard Essential Patents (SEPs) subject to RAND Obligations of "good faith" and "fair dealing"
§ 19:29.77 USPTO initiates Standard-Essential Patent (SEP) Working Group
§ 19:29.78 USPTO initiates SPARK pilot program for Standard-Essential Patent (SEP) Rights
§ 19:30 Antitrust analysis and critique—Joint research and development ventures
§ 19:30.50 —Reverse settlement payments or exclusion payments by generic drug applicants to brand name pharmaceutical companies
§ 19:31 Licensing patents, trade secrets, and/or trademarks under a single agreement
§ 19:32 Tax treatment of patents
§ 19:33 —Transfer
§ 19:34 —Acquisition
§ 19:35 —Litigation, licensing, and other expenses
§ 19:36 —Employee achievement awards
§ 19:37 —Tax liens

Appendix 19(A) Rules of the American Arbitration Association

Appendix 19(B) Arbitration Authorization by U.S. District Courts 28 U.S.C.A. §§ 651–658

Appendix 19(C) An Example of an Exclusive Patent License

Appendix 19(D) An Example of a non Exclusive Patent License
Appendix 19(E) An Example of an Employment Agreement with Patents Clause
Appendix 19(F) An Example of a Nondisclosure Agreement
Appendix 19(G) Sample Clauses for Royalty Rates in License Agreements
Appendix 19(H) Department of Justice (DOJ) and Federal Trade Commission (FTC) Antitrust Guidelines for Intellectual Property Licensing

CHAPTER 20. LITIGATION OF PATENT RIGHTS

I. INTRODUCTION

§ 20:1 In general
§ 20:1.25 Pre-litigation vehicles to settle the infringement case—Cease and Desist Letters and Demand Letters
§ 20:1.50 Federal Circuit's Model Order to reduce the burden and cost of patent litigation
§ 20:1.70 The pilot project for managing patent litigation in U.S. District Courts

II. CANCELLATION

§ 20:2 In general

III. PATENT INFRINGEMENT

§ 20:3 In general
§ 20:4 Direct infringement
§ 20:5 Indirect infringement
§ 20:6 —By inducement
§ 20:7 —Contributory infringement

IV. DECLARATORY JUDGMENT ACTIONS

§ 20:8 Declaratory Judgments—Essential Pleading
§ 20:8.10 —Cases Holding Substantial Controversy between the Parties, providing foundation for a Declaratory Judgment Complaint
§ 20:8.20 —Cases Holding No Substantial Controversy between the Parties, preventing foundation for a Declaratory Judgment Complaint

V. SOME CONSEQUENCES OF INVALIDITY

§ 20:9 In general

§ 20:9.10 Asserting claims held to be invalid in prior litigation; Asserting claims held to be not infringed in prior litigation

VI. PRESUMPTION OF VALIDITY

§ 20:10 In general
§ 20:11 Origin of presumption of validity
§ 20:12 Evolution of presumption of validity
§ 20:13 Basis for presumption of validity
§ 20:14 Factors affecting the weight of presumption—Prior art considered by the Primary Examiner
§ 20:15 Origin, evolution of, and rationale for presumption—Prior art or other evidence not considered by the Patent & Trademark Office
§ 20:16 —Patents allowed only after consideration by the Board of Patent Appeals & Interferences
§ 20:17 —Reissue
§ 20:18 —Reexamination
§ 20:19 —Foreign patent(s)
§ 20:20 —Prior adjudication
§ 20:21 To what does the presumption attach—Design patents
§ 20:22 —Inventorship
§ 20:23 —Anticipation/obviousness
§ 20:24 —Utility
§ 20:25 —Adequacy of the disclosure
§ 20:26 —Claims
§ 20:27 Proceedings in which the presumption is inapplicable—Reissue
§ 20:28 —Reexamination
§ 20:29 —Interference
§ 20:30 —Application for preliminary injunction
§ 20:31 Operation of the presumption as a procedural device
§ 20:32 —Presumption as being procedural
§ 20:33 —Presumption as being static
§ 20:34 —Patentee's case
§ 20:35 —Challenger's case
§ 20:36 —Standard of proof
§ 20:37 —Proving invalidity and infringement compared

VII. DEFENSES AND COUNTERCLAIMS

§ 20:38 In general
§ 20:39 Defenses
§ 20:40 —Noninfringement
§ 20:40.50 Exhaustion or first-sale doctrine
§ 20:41 Defenses—Unenforceability

§ 20:42 —Invalidity
§ 20:43 — —On substantive grounds
§ 20:43.30 —Assignor estoppel
§ 20:44 —Invalidity—On formal grounds
§ 20:45 —Statute of limitations, laches, and estoppel
§ 20:46 —Intervening rights
§ 20:46.50 First Inventor Defense (Prior User Rights) expanded under the America Invents Act (AIA)
§ 20:47 Counterclaims
§ 20:47.50 The defense of "Anti-SLAPP" statutes in intellectual property litigation
§ 20:47.52 The "PREP Act" (Public Readiness and Emergency Preparedness Act) as a Defense to Patent Infringement based on a Public Health Emergency

VIII. CONSTRUCTION OF PATENT CLAIMS IN INFRINGEMENT LITIGATION

§ 20:48 In general
§ 20:49 Doctrine of equivalents
§ 20:50 Doctrine of file wrapper estoppel (prosecution history estoppel)
§ 20:51 Reverse (inverse) doctrine of equivalents
§ 20:52 Conduct not constituting infringement

IX. REMEDIES FOR PATENT INFRINGEMENT

§ 20:53 In general
§ 20:54 Damages
§ 20:55 —Compensatory damages
§ 20:56 — —Direct damages—Measured by patent owner's lost profits
§ 20:57 — — —Measured by a reasonable royalty
§ 20:58 — — — —Established royalty
§ 20:59 — — — —Hypothetical negotiations
§ 20:60 — — — —Analytical approach
§ 20:60.50 — — — —Investment Return Analysis
§ 20:61 — — —Additional remedy in the case of a design patent
§ 20:62 — —Indirect or consequential damages
§ 20:62.50 — — —Entire Market Value Rule
§ 20:63 — —Interest on damages award
§ 20:64 —Exemplary (punitive) damages
§ 20:65 Injunction
§ 20:66 Attorney's fees
§ 20:67 Costs
§ 20:67.50 Provisional rights in damages

X. CONDUCT OF PATENT LITIGATION

§ 20:68 In general
§ 20:69 The parties
§ 20:70 —Jurisdiction
§ 20:71 —Who may and who must bring suit (standing to sue)
§ 20:72 —Persons liable
§ 20:73 —Notice of infringement
§ 20:74 Subject matter jurisdiction
§ 20:75 Venue
§ 20:75.50 Multidistrict litigation
§ 20:76 Pleadings
§ 20:77 —Complaint
§ 20:78 —Answer
§ 20:79 Discovery—Matters discoverable
§ 20:79.50 —New Rules of Civil Procedure for electronic discovery
§ 20:80 —Limitations on discovery
§ 20:81 — —Trade secrets
§ 20:82 — —Patent applications and copyrights
§ 20:83 — —Patent examiner testimony
§ 20:84 — —Work product privilege
§ 20:85 — —Attorney-client privilege
§ 20:86 — —Joint defense privilege
§ 20:87 — —Conflict with foreign law
§ 20:88 —Court involvement
§ 20:89 Preliminary injunction
§ 20:90 —Required showing
§ 20:91 — —Likelihood of success on merits
§ 20:92 — — —Validity and enforceability
§ 20:93 — — —Infringement
§ 20:94 — — —Relation of likelihood of success to irreparable harm
§ 20:95 — —Irreparable harm
§ 20:96 — — —Delay in seeking the preliminary injunction
§ 20:97 — — —Adequacy of monetary compensation
§ 20:98 — —Balance of hardships
§ 20:99 — —Impact on the public interest
§ 20:100 —Procedure—District court level
§ 20:101 — —Federal Circuit level
§ 20:101.50 Pre-Trial Motions and Procedure
§ 20:101.60 Motions in Limine and Daubert Motions and Procedure
§ 20:102 Trial
§ 20:103 —Consolidation, severance, and sequence of issues for trial

§ 20:104 —Jury trial including "Markman Hearing"
§ 20:104.50 Grant of new trial
§ 20:105 Trial—Testimony, witnesses, and evidence
§ 20:106 —Judicial hearing officers
§ 20:107 Consent judgments and settlement agreements
§ 20:108 Summary judgment
§ 20:109 Class actions
§ 20:110 Federal Court Appellate Jurisdiction
§ 20:111 —Ripeness for appellate review
§ 20:112 — —Final decisions and orders
§ 20:113 — —Piecemeal appeals in actions with multiple claims
§ 20:114 — —Interlocutory orders
§ 20:115 —Extraordinary writs
§ 20:116 —Scope of appellate review
§ 20:117 —"Frivolous" appeals
§ 20:118 —Procedure
§ 20:118.25 Ethics and Code of Conduct for Federal Judges
§ 20:118.50 Federal Circuit Appellate Mediation Program
§ 20:119 Supreme Court Appellate Jurisdiction
§ 20:119.10 Summary Table—Recent Supreme Court Patent Cases and Decisions
§ 20:119.20 Other Patent and Intellectual Property cases filed at the United States Supreme Court on Petition for Writ of Certiorari
§ 20:119.40 Supreme Court Appellate Jurisdiction—Recent trademark cases filed at the United States Supreme Court in which a petition for writ of certiorari was granted
§ 20:119.50 Summary Table—Supreme Court Trademark Cases and Decisions
§ 20:120 Judgment enforcement and execution on patents
§ 20:121 Law applied in patent infringement actions

XI. ARBITRATION AND OTHER FORMS OF ALTERNATIVE DISPUTE RESOLUTION IN LIEU OF LITIGATION

§ 20:122 Alternative Dispute Resolution and Arbitration
§ 20:123 Parallel proceedings: arbitration and litigation

Appendix 20(A) 28 U.S.C.A. § 1295—Jurisdiction of U.S. Court of Appeals for the Federal Circuit

Appendix 20(B) Federal Rules of Appellate Procedure with Modifications for the Court of Appeals for the Federal Circuit

Appendix 20(B)(1) Proposed Amended Rules for the United

States Court of Appeals for the Federal Circuit

Appendix 20(C) Amendments to Patent Act of 1952 in Order of Enactment

Appendix 20(D) United States Court of Appeals for the Federal Circuit Docketing Statement for Appellate Mediation Program

Appendix 20(E) United States Court of Appeals for the Federal Circuit Confidential Joint Request to Enter Appellate Mediation Program

Appendix 20(F) Amended Federal Rules of Civil Procedure for Electronic Discovery Rules 16, 26, 33, 34, 37, 45 and Form 35

Appendix 20(G) Revised Fee Schedule for Filings at the United States Court of Appeals for the Federal Circuit (effective January 1, 2007)

Appendix 20(H) Model Appeal Brief to the Federal Circuit involving a case of alleged patent infringement for the alleged unauthorized use of night vision technology

Appendix 20(I) Complaint for Patent Infringement

Appendix 20(J) Answer and Counterclaim to Complaint for Patent Infringement

Appendix 20(K) Sample Expert Witness Engagement Letter

Appendix 20(L) Model Order Limiting Excess Patent Claims and Prior Art

Appendix 20(M) Amended Federal Rules of Civil Procedure

Appendix 20(N) Draft Legislation to Improve Patent Protection—*Support Technology and Research for Our Nation's Growth and Economic Resilience (STRONGER) Patents Act of 2017*

Appendix 20(O) Judicial Conduct and Disability Act

Appendix 20(P) Code of Conduct for Justices of the Supreme Court of the United States

CHAPTER 20A. MANUFACTURING AND MARKETING PATENTED INVENTIONS

§ 20A:1 Introduction to manufacturing and marketing patented inventions

§ 20A:2 Production and manufacturing products in the United States
§ 20A:3 Production and manufacturing products outside the United States
§ 20A:4 Developing a prototype and selecting a manufacturing facility
§ 20A:5 Ordering production of a quantity of deliverable patented products—Purchase order
§ 20A:6 Transporting and delivering the production run of patented products.
§ 20A:7 Marketing and distributing the patented products
§ 20A:8 USPTO Offers Stake Holder and Inventor Support for Commercializing Patented Inventions
§ 20A:9 USPTO Solicits Stake Holder and Inventor Support for Commercializing Patented Inventions

CHAPTER 20B. STANDARD ESSENTIAL PATENTS

§ 20B:1 Standard Essential Patents and the USPTO's Standard Essential Patent Working Group
§ 20B:2 USPTO initiates SPARK pilot program for Standard-Essential Patent (SEP) Rights
§ 20B:3 Standard Essential Patents (SEPs) subject to RAND obligations of "good faith" and "fair dealing"
§ 20B:4 Standard Essential Patents (SEPs) and the smart phone patent wars

Volume 8

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

CHAPTER 21. ELEMENTS OF TRANSNATIONAL PATENT LAW

I. INTRODUCTION

§ 21:1 In general

II. TERRITORIALITY AND INTELLECTUAL PROPERTY

§ 21:2 In general
§ 21:3 Acquiring intellectual property rights abroad

§ 21:4 Enforcement of foreign patent rights and judgments in the United States
§ 21:4.50 Enforcement of foreign judgments in intellectual property disputes under the Draft Hague Convention

III. INTERNATIONAL AUTHORITIES AND AGREEMENTS

1. *THE PATENT COOPERATION TREATY—WORLD INTELLECTUAL PROPERTY ORGANIZATION (W.I.P.O)*

§ 21:4.70 In general
§ 21:5 World Intellectual Property Organization (W.I.P.O.)
§ 21:6 —Paris Convention
§ 21:7 —Patent Cooperation Treaty (PCT)
§ 21:8 —Patent Cooperation Treaty—International stage (35 U.S.C.A. §§ 362–368)
§ 21:9 — — —PCT Chapter I
§ 21:9.01 International Patent Prosecution and the Process of PCT Patent Examination
§ 21:9.02 International Patent Prosecution—Preliminary review by the PCT Receiving Office (RO) for PCT applications, and the Applicant's response to the PCT Receiving Office preliminary requirements
§ 21:9.03 —PCT Patent Examiner International Search Report and Written Opinion of the International Searching Authority including prior art search and application of prior art to submitted claims
§ 21:9.04 —PCT Applicant's Response to the International Search Report and Written Opinion
§ 21:10 World Intellectual Property Organization (W.I.P.O.)—Patent Cooperation Treaty—International stage (35 U.S.C.A. §§ 362–368)—PCT Chapter II
§ 21:10.10 —Patent Cooperation Treaty (PCT)—Practitioner Guidance
§ 21:10.25 Amended PCT procedures under the Enhanced International Search and Preliminary Examination System (EISPE)
§ 21:10.50 Revised Patent Cooperation Treaty Proposal and Draft
§ 21:11 World Intellectual Property Organization (W.I.P.O.)—Patent Cooperation Treaty—International stage (35 U.S.C.A. §§ 362–368)—Summary of amended procedures for PCT Chapter I and PCT Chapter II

§ 21:11.3 The USPTO To Implement ePCT online service to prepare patent applications for foreign filing
§ 21:12 World Intellectual Property Organization (W.I.P.O.)—Patent Cooperation Treaty—U.S. national stage (35 U.S.C.A. §§ 371–376)
§ 21:13 — — —How the U.S. national stage is initiated
§ 21:14 — — —Differences in treatment between U.S. national stage application and regular U.S. national application
§ 21:15 — — — —As prior art
§ 21:16 — — —Can the differences in treatment be obviated?

2. *THE PATENT LAW TREATY AND EXAMINATION/CLASSIFICATION COOPERATION*

§ 21:16.50 Patent Law Treaty (PTL)
§ 21:16.55 —Common application format agreement for the United States Patent & Trademark Office (USPTO), European Patent Office (EPO), and the Japanese Patent Office (JPO)
§ 21:16.56 "Triway" pilot program for sharing prior art search results among the United States Patent and Trademark Office, the European Patent Office, and the Japan Patent Office
§ 21:16.60 International Agreements for International Classification Systems for prior art searches

3. *UNION FOR THE PROTECTION OF NEW PLANT VARIETIES*

§ 21:17 Union for the Protection of New Plant Varieties (U.P.O.V.)
§ 21:18 *[Reserved]*

4. *THE REGIONAL PATENT SYSTEMS—*

§ 21:19 Regional authorities

The European Patent Office

§ 21:20 Regional authorities—European Patent Office (E.P.O.)
§ 21:21 — —The European patent—Substantive law
§ 21:21.50 Enforcement and Litigation of European Patents—Standard Essential Patents
§ 21:22 Regional authorities—European Patent Office (E.P.O.)—The European patent—Procedure
§ 21:23 — — —Application content

§ 21:23.50 Software Patent Applications in the EPO
§ 21:24 Regional authorities—European Patent Office (E.P.O.)—The European patent—Filing and ex parte examination
§ 21:24.5 Corona Virus Pandemic (COVID 19)—European Patent Office (EPO) Adjustments for Covid-19 Virus Pandemic Impacts
§ 21:25 Regional authorities—European Patent Office (E.P.O.)—The European patent—Opposition
§ 21:26 — — —Appeals

The European Union—Unitary Patent and Uniform Patent Court

§ 21:26.30 The European Union Directive on the Enforcement of Intellectual Property Rights
§ 21:26.45 The European Union agreement to establish a Unitary Patent for patent protection throughout the European Union (EU)
§ 21:26.70 The European Union agreement to establish a Unified Patent Court and a Unitary Patent
§ 21:26.71 Application Process for a EU Unitary Patent
§ 21:26.72 Practitioner Guidance on the Unified Patent Court (UPC) and Unitary Patent
§ 21:26.74 European Union Regulation on Artificial Intelligence (AI) Development and Innovation

The African Intellectual Property Organization (O.A.P.I.)

§ 21:27 Regional authorities—African Intellectual Property Organization (O.A.P.I.)

The African Regional Industrial Property Organization (A.R.I.P.O.)

§ 21:28 Regional authorities—African Regional Industrial Property Organization (A.R.I.P.O.)

The Eurasian Patent Office (E.A.P.O.)

§ 21:29 Regional authorities—Eurasian Patent Office (E.A.P.O.)

The Andean Community Regional Intellectual Property Agreement

§ 21:29.50 Andean Community Regional Intellectual Property Agreement

IV. FOREIGN PRIORITY UNDER THE PARIS CONVENTION

§ 21:30 In general
§ 21:31 Procedure for perfecting priority

§ 21:32 Scope of subject matter entitled to priority
§ 21:33 What constitutes "benefit" of earlier filing date

V. U.S. RESTRICTIONS ON PATENTING ABROAD INVENTIONS MADE IN THE UNITED STATES (EXPORT LICENSES)

§ 21:34 U.S. restrictions on patenting abroad inventions made in the United States (Export Licenses)

VI. IMPORTATION AND EXPORTATION OF PATENTED GOODS

§ 21:35 Problems
§ 21:36 Recourse against infringing imports
§ 21:37 —Importation/exportation as acts of infringement
§ 21:38 —Border enforcement
§ 21:39 — —U.S. Customs Service
§ 21:40 — —U.S. International Trade Commission (ITC)
§ 21:41 — — —Subject matter jurisdiction
§ 21:42 — — — —Scope of § 337 in general
§ 21:42.50 — — — —Scope of § 337—Trade secret enforcement
§ 21:43 — — — —Elements of a § 337 violation based on patent infringement
§ 21:44 — — — —Process claims under § 337
§ 21:45 — — —Forms of relief
§ 21:46 — — —Procedure
§ 21:47 — — — —Overview of noteworthy features
§ 21:48 — — — —Principal procedural phases
§ 21:48.50 — — — —Cases relating to Smartphone Patents and Patent Infringement by Imported Smartphone Technologies
§ 21:49 Action by the United States Trade Representative
§ 21:50 —Under the Trade Act of 1974, secs. 301–309 (19 U.S.C.A. §§ 2411–2419)
§ 21:51 —Under the Trade Act of 1974, sec.182 (19 U.S.C.A. § 2242)

Appendix 21(A) Patent Cooperation Treaty("PCT")
Appendix 21(B) Regulations under the PCT
Appendix 21(C) Forms Submitted to Begin PCT Chapter I Case
Appendix 21(D) Forms Returned to Applicant in Response to a PCT Chapter I Case
Appendix 21(D)a. Article 19 Model Set of Replacement Claims and Accompanying Letter

Appendix 21(E)	Forms submitted by applicant to begin a PCT Chapter II Case
Appendix 21(F)	Forms returned to applicant in response to a PCT Chapter II Case
Appendix 21(G)	Forms for initiating U.S. National Stage Patent Application
Appendix 21(H)	European Patent Convention
Appendix 21(I)	European Patent Office Guidelines for Substantive Examination
Appendix 21(I)a.	European Patent Office Amended Rules for Divisional Applications
Appendix 21(J)	Guidelines for Opposition Procedure
Appendix 21(K)	International Trade Commission's (ITC's) Rules of Practice and Procedure
Appendix 21(L)	The Patent Law Treaty
Appendix 21(M)	Regulations Under the Patent Law Treaty
Appendix 21(N)	Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the Enforcement of Intellectual Property Rights
Appendix 21(O)	Conclusions on an Enhanced Patent System in Europe, Proposal for a Council Regulation
Appendix 21(P)	Agreement on a Unified Patent Court
Appendix 21(Q)	Draft Convention of the Hague Special Commission on the Recognition and Enforcement of Foreign Judgments
Appendix 21(R)	Andean Community Regional Intellectual Property Law Decision 486

CHAPTER 21A. BILATERAL AGREEMENTS IN TRANSNATIONAL PATENT LAW

§ 21A:1	Bilateral Agreement for Patent Prosecution Highway (PPH) to expedite the examination of patent applications when an applicant seeks patent protection for the same invention in more than one participating country
§ 21A:1.40	Agreements and initiatives for work-sharing and efficiency among the five major patent offices—IP5
§ 21A:1.50	Global Patent Prosecution Highway (GPPH) and IP5 Agreements based on the Bilateral Agreement for Patent Prosecution Highway (PPH) to expedite the examination of patent

applications when an applicant seeks patent protection for the same invention in more than one participating country
§ 21A:1.51 Patent cooperation treaty collaborative search and examination pilot project between the IP5 offices
§ 21A:1.52 The Global Patent Dossier for the IP5 Country Patent Systems
§ 21A:1.55 Agreements for Accelerating Patent Grants for Participating Signatory Nations
§ 21A:2 Patent Prosecution Highway (PPH) between the USPTO and the Japanese Patent Office
§ 21A:3 Patent Prosecution Highway (PPH) between the USPTO and the United Kingdom Intellectual Property Office (UK IPO)
§ 21A:4 Patent Prosecution Highway (PPH) between the USPTO and the Korean Intellectual Property Office
§ 21A:5 Patent Prosecution Highway (PPH) between the USPTO and the Canadian Intellectual Property Office
§ 21A:6 Patent Prosecution Highway (PPH) between the USPTO and the Australian Intellectual Property office
§ 21A:7 Patent Prosecution Highway (PPH) between the USPTO and the EPO European Patent Office
§ 21A:8 Patent Prosecution Highway (PPH) between the USPTO and the DKPTO Danish Patent Office
§ 21A:9 —Patent Prosecution Highway (PPH) between the USPTO and the German Patent Office DPMA
§ 21A:10 —Patent Prosecution Highway (PPH) between the USPTO and the Finnish Patent Office
§ 21A:11 Patent Prosecution Highway (PPH) between the USPTO and the Singapore Patent Office
§ 21A:12 The "new route" pilot program between the United States Patent Trademark Office and the Japan Patent Office
§ 21A:13 Patent Prosecution Highway between the USPTO and the Hungarian Patent Office
§ 21A:14 The U.S. Patent & Trademark Office, the European Patent Office and the Japan Patent Office Expand Patent Prosecution Highway (PPH) to include work products of Patent Cooperation Treaty (PCT)
§ 21A:14.50 The U.S. Patent & Trademark Office in Conjunction with other National Intellectual Property Offices has Expanded the Patent Prosecution Highway to include work products of the Patent Cooperation Treaty

§ 21A:15 Patent Prosecution Highway (PPH) between the USPTO and the Spanish Patent Office (SPTO)
§ 21A:16 Patent Prosecution Highway (PPH) between the USPTO and the Austrian Patent Office (APO)
§ 21A:17 Global initiatives for accelerated patent examination based on inventions for green technologies
§ 21A:18 Patent Prosecution Highway (PPH) between the USPTO and the Russian Patent Office (Rospatent)
§ 21A:19 Patent Prosecution Highway (PPH) between the USPTO and the Mexican Institute of Industrial Property (IMPI)
§ 21A:20 Patent Prosecution Highway (PPH) between the USPTO and the Israeli Patent Office
§ 21A:21 Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Nordic Patent Institute based on Patent Cooperation Treaty Work Products
§ 21A:22 United States Patent and Trademark Office and Japan Patent Office Collaborative Search Pilot Program
§ 21A:23 United States Patent and Trademark Office and Korean Intellectual Property Office Collaborative Search Pilot Program
§ 21A:24 Patent Prosecution Highway (PPH) between the USPTO and the National Institute of Industrial Property of France
§ 21A:25 Patent Prosecution Highway (PPH) Pilot between the USPTO and the Intellectual Property Corporation of Malaysia

CHAPTER 21B. INTERNATIONAL AND TRANSNATIONAL DESIGN PATENTS AND APPLICATIONS

§ 21B:1 Introduction to International Design Patent Protection
§ 21B:2 Regional authorities—European community design patent
§ 21B:3 — —Eligible subject matter
§ 21B:4 — —Substantive requirements including novelty
§ 21B:5 — —Scope and term of protection
§ 21B:6 — —Scope and term of protection for Unregistered Community Designs (UCD)
§ 21B:7 — —Multiple applications or many designs in one application
§ 21B:8 — —Fees for community design patents

§ 21B:9 — —Filing date and priority of community design patent applications
§ 21B:10 — —Examination of community design applications and registration
§ 21B:11 — —Invalidity proceedings before the office (OHIM)
§ 21B:12 — —Appeal proceedings before the office (OHIM)
§ 21B:13 — —Infringement and litigation proceedings before the community design courts of the member states
§ 21B:14 — —Surrender of the registered community design in order to avoid contested proceedings
§ 21B:15 — —Proceedings and appeals to the European Court of Justice (ECJ)
§ 21B:16 Hague Agreement Concerning International Registration of Industrial Designs
§ 21B:17 Application for international industrial design application
§ 21B:18 Filing date and priority
§ 21B:19 Examination of hague agreement design patent applications
§ 21B:20 Enforcing design rights
§ 21B:21 International Design Protection in Australia

Appendix 21B(A) European Community Design, Council Regulation (EC) No 6/2002

Appendix 21B(B) Regulations Implementing the Community Design Patent Legislation

Appendix 21B(C) Hague Agreement Application for International Registration

Appendix 21B(D) The Hague Agreement Concerning the International Registration of Industrial Designs, Geneva Act of July 2, 1999

CHAPTER 21C. THE WORLD TRADE ORGANIZATION (WTO)

§ 21C:10 World Trade Organization (W.T.O.)
§ 21C:20 World Trade Organization (WTO)—Selected Cases of International Intellectual Property Disputes
§ 21C:30 —Compiled List of International Intellectual Property Disputes
§ 21C:40 Waiver and Exceptions to the WTO Treaty and TRIPS Requirements

CHAPTER 22. COMPARATIVE PATENT LAW: SURVEY OF PRINCIPAL FOREIGN PATENT SYSTEMS

§ 22:1 Introduction

§ 22:2 Features determinative of a patent system's character—Screening of applications prior to grant of patent rights
§ 22:3 —Content of the description of the invention and the extent to which such may be amended
§ 22:4 —Claiming the invention
§ 22:5 —Priority of invention
§ 22:6 —Obligations of the patentee to the state
§ 22:7 —Nonstatutory subject matter
§ 22:8 —Petty patents (utility models)
§ 22:9 Foreign plant breeders' rights laws
§ 22:10 International patent law resources and Internet website addresses

Appendix 22(A) European Union Proposal for Council Regulation on the Community

Appendix 22(B) European Union Proposal for a Council Decision Establishing the Community Patent Court and Concerning Appeals before the Court of First Instance

Appendix 22(C) European Union Proposal for a Council Decision Conferring Jurisdiction on the Court of Justice in Disputes Relating to the Community Patent

Appendix 22(D) International Convention for the Protection of New Varieties of Plants

Volume 9

CHAPTER 23. ARGENTINA

§ 23:1 Background and history
§ 23:2 Patentable subject matter
§ 23:3 Patent application and prosecution
§ 23:4 Patent grant and rights to prevent infringement

CHAPTER 24. BRAZIL

§ 24:1 Background and history
§ 24:2 Patentable subject matter
§ 24:3 Requirements for patentability—Novelty and nonobviousness
§ 24:4 Patent application and prosecution
§ 24:4.10 Application and registration of industrial designs
§ 24:5 Patent grant and rights to prevent infringement
§ 24:6 Offers to license and compulsory licensing

CHAPTER 25. CANADA

I. HISTORY

§ 25:1 Historical and constitutional underpinnings

II. SUBSTANTIVE LAW

§ 25:2 In General

A. SUBJECT MATTER ELIGIBLE FOR PROTECTION

§ 25:3 Utility inventions
§ 25:4 Industrial designs
§ 25:5 Botanical plant varieties
§ 25:6 Integrated circuit topographies

B. REQUIREMENT FOR PATENTABILITY

§ 25:7 Novelty
§ 25:8 Utility
§ 25:9 Nonobviousness
§ 25:10 Priority—Among competing inventorship entities
§ 25:11 —Foreign priority
§ 25:12 —Continuing applications

C. OBTAINING PATENT PROTECTION

§ 25:13 Patent application
§ 25:14 Patent Office proceedings
§ 25:14.5 Corona Virus Pandemic (COVID 19)—Canadian Intellectual Property Office Adjustments for Covid-19 Virus Pandemic Impacts
§ 25:15 Practitioner Guidance for Canadian Patent Office Proceedings

D. INVENTORSHIP, OWNERSHIP AND TRANSFERS

§ 25:16 Inventorship
§ 25:17 Assignment and voluntary licenses
§ 25:18 Employer/employee rights
§ 25:19 Compulsory licenses
§ 25:20 Antitrust implications

E. INFRINGEMENT AND IMPEACHMENT

§ 25:21 In general
§ 25:22 Litigation Awards of Damages, Injunctive Relief, and Costs

APPENDIX 25(A) Application for Registration of an Industrial Design
APPENDIX 25(B) Guide to Plant Breeder' Rights
APPENDIX 25(C) Application for Registration of an Integrated Circuit Topography
APPENDIX 25(D) Canada—Petition for Grant of a Patent

CHAPTER 26. PEOPLE'S REPUBLIC OF CHINA

§ 26:1 Background and patent administration
§ 26:2 Statutory basis
§ 26:3 Requirements for patentability
§ 26:4 Patent applications and patent prosecution
§ 26:4.25 Amendments to Chinese Patent Applications
§ 26:4.50 Patent applications and patent prosecution—Contrasted with U.S. practice
§ 26:4.75 Accelerating Patent Prosecution and Examination in China
§ 26:5 Rights and benefits after the patent has been granted
§ 26:6 Petty patents and utility models
§ 26:7 Patent enforcement and litigation

Appendix 26(A) China's Patent Law, 1992, as amended 2008

CHAPTER 27. FRANCE

§ 27:1 Background and history
§ 27:2 Patentable subject matter
§ 27:3 Requirements for patentability—Novelty and nonobviousness
§ 27:4 Patent application and prosecution
§ 27:5 Patent grant and actions for patent infringement

CHAPTER 28. GERMANY

§ 28:1 Background and patent administration
§ 28:2 Statutory subject matter
§ 28:3 Novelty
§ 28:4 Nonobviousness; inventive step
§ 28:5 Publication and examination of patent applications
§ 28:6 Patent infringement and litigation

CHAPTER 29. INDIA

§ 29:1 Background and history of the India Patent Act
§ 29:1.50 India Design Act
§ 29:2 Patentable subject matter

§ 29:3 India requisites for patentability novelty and obviousness (inventive step)
§ 29:4 Prosecution and examination of patent applications
§ 29:5 Opposition to the patent grant
§ 29:6 Litigation and enforcement of patent rights
§ 29:7 Criminal penalties and sanctions
APPENDIX 29(A) India Patent Offices and Patent Law

CHAPTER 30. JAPAN

§ 30:1 Background and Japanese Patent Office
§ 30:2 Statutory subject matter
§ 30:3 Description requirements of the patent application specification
§ 30:3.10 Amendments and claim drafting before the Japanese Patent Office
§ 30:3.20 Expediting examination before the Japanese Patent Office
§ 30:3.25 Japanese Patent Office patent prosecution
§ 30:3.27 Corona Virus Pandemic (COVID 19)—Japanese Patent Office Adjustments for Covid-19 Virus Pandemic Impacts
§ 30:3.30 Japanese Patent Office Examination Guidelines for Medical Inventions
§ 30:3.50 Japanese Patent Office Patent Prosecution Highway (PPH) Program
§ 30:3.60 Japanese Patent Office Conversion of PCT application into a National Phase Japanese Application
§ 30:4 Divisional applications
§ 30:5 Novelty
§ 30:6 Nonobviousness
§ 30:7 Inventorship
§ 30:8 Publication of patent applications
§ 30:8.50 Opposition proceedings
§ 30:9 Trial for invalidity procedure
§ 30:9.50 Appellate review of Japanese Patent Office decisions
§ 30:10 Petty patents
§ 30:10.10 Provisional rights granted prior to issuance of Japanese Patents
§ 30:11 Patent infringement and litigation

CHAPTER 31. REPUBLIC OF KOREA (SOUTH KOREA)

I. IN GENERAL

§ 31:1 Background and patent administration

§ 31:2 Patentable subject matter

II. REQUIREMENTS FOR PATENTABILITY

§ 31:3 Novelty
§ 31:4 —Obviousness; inventive step

III. PATENT OFFICE PROCEDURE

§ 31:5 Patent application and prosecution
§ 31:5.50 —Korean patent office adopts accelerated examination under the patent prosecution highway procedures
§ 31:6 Amendments
§ 31:7 Patent examination on request
§ 31:8 Opposition proceeding
§ 31:9 Invalidation proceeding
§ 31:9.10 Examination and registration of utility model applications
§ 31:9.20 Examination and registration of design applications

IV. LITIGATION

§ 31:10 Patent infringement and litigation
§ 31:11 Defenses to patent infringement
§ 31:12 Criminal penalties for patent infringement

CHAPTER 32. RUSSIAN FEDERATION

§ 32:1 Russia—Background and patent administration
§ 32:2 Priority of invention
§ 32:3 Statutory subject matter
§ 32:4 Novelty
§ 32:5 Obviousness; inventive step
§ 32:6 Patent examination procedures
§ 32:7 Patent infringement and litigation
§ 32:8 Petty patents and utility models

CHAPTER 33. UNITED KINGDOM

§ 33:1 Background and patent administration
§ 33:2 Statutory subject matter
§ 33:3 Novelty
§ 33:4 Obviousness; inventive step
§ 33:5 Inventorship
§ 33:6 Publication and examination of patent applications
§ 33:6.50 —United Kingdom Patent Office adopts Accelerated Examination under the Patent Prosecution Highway Procedures
§ 33:7 Amendments and added matter during patent prosecution

§ 33:8 Patent infringement and litigation
§ 33:9 Effect of the United Kingdom's "Brexit" Vote to Leave the European Union on the Procurement and Protection of Patents in the UK

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

CHAPTER 34. AUSTRALIA

§ 34:1 Background and history of Australian patent system
§ 34:2 Statutory subject matter
§ 34:3 Novelty
§ 34:4 Obviousness and inventive step
§ 34:5 Publication and examination of patent applications
§ 34:5.10 Fast track examination procedure—The modified examination option
§ 34:5.20 The innovation patent
§ 34:5.25 The design patent
§ 34:5.30 Claim interpretation in Australian courts
§ 34:5.40 Drafting considerations for foreign applicants for australian patents
§ 34:6 Infringement of Australian patents
§ 34:7 Remedies for infringement of Australian patents

CHAPTER 35. SINGAPORE

§ 35:1 Background and patent administration in Singapore
§ 35:2 Statutory subject matter
§ 35:3 Requirements for patentability: novelty, inventive step, industrial application
§ 35:4 Patent application process
§ 35:5 Preliminary examination and search and examination process
§ 35:6 Postgrant search and examination and revocation of patents
§ 35:7 Patent enforcement and litigation

CHAPTER 36. FINLAND

§ 36:1 Background and patent administration
§ 36:2 Statutory subject matter
§ 36:3 Novelty
§ 36:4 Nonobviousness; inventive step
§ 36:5 Publication and examination of patent applications
§ 36:6 Mainenance, termination, and revocation of patent protection
§ 36:7 Enforcement of patent rights, infringement, and remedies

CHAPTER 37. ISRAEL

§ 37:1 Background and History
§ 37:2 Patentability and Patentable Subject Matter
§ 37:3 The Patent Application
§ 37:4 Acceptance and Publication of the Application
§ 37:5 The Examination and Patent Prosecution Process
§ 37:6 Opposition to Grant of Patent
§ 37:7 Rights Conferred by the Patent Grant
§ 37:8 Enforcement and Infringement of Patents
§ 37:9 Revocation of Patents
§ 37:10 Compulsory Licenses

CHAPTER 38. MEXICO

§ 38:1 History and General Intellectual Property Law Provisions in Mexico
§ 38:2 Patentability and Patentable Subject Matter in Mexico
§ 38:3 The Patent Application in Mexico
§ 38:4 Examination and Patent Prosecution Process in Mexico
§ 38:5 Enforcement and Infringement of Patents in Mexico
§ 38:6 Invalidity and Lapse of Patents in Mexico
§ 38:7 Licenses and Transfer of Rights in Mexico
§ 38:8 Compulsory Licenses in Mexico

CHAPTER 39. CHILE

§ 39:1 History and General Intellectual Property Law Provisions in Chile
§ 39:2 Patentability and Patentable Subject Matter in Chile
§ 39:3 The Patent Application in Chile
§ 39:4 Examination and Patent Prosecution Process in Chile
§ 39:5 Rights Conferred by the Patent Grant in Chile
§ 39:6 Basis for Invalidating a Patent in Chile
§ 39:7 Enforcement and Infringement of Patents in Chile
§ 39:8 Compulsory Licenses in Chile
§ 39:9 Statutory Penalties for Patent Infringement in Chile

Table of Laws and Rules

Table of Cases

Index