

Index

ACCELERATED

EXAMINATION

Generally, **29:1 to 29:6**
AIA Section 11(h), **29:3**
AIA Section 25, **29:3**
Amended statutes, **29:3**
Congressional intent, **29:2**
Fee-based revised examination conditions, **29:6**
provisions, **29:5**
Initial conditions for fee-based revised examination, **29:6**
Non-fee based revised examination provisions, **29:4**
17 C.F.R. 1.17(c), **29:6**
17 C.F.R. 1.102, **29:6**
35 U.S.C. Section 2(b), **29:3**
Track One petitions, USPTO statistics on, **29:7**

ACT TO CORRECT AND IMPROVE CERTAIN PROVISIONS OF LEAHY-SMITH AMERICA INVENTS ACT

Text, **App 7**

ACTUAL NOTICE

Marking (this index)

ADMINISTRATIVE LAW JUDGE

AIA Section 21, payment of ALJs, **31:3**

AIA SECTION 3(g)(7)(A, B)

Funding agreements, **31:2**

AIA SECTION 6(a-c)

Inter Partes Review (this index)

AIA SECTION 6(d)

Post-Grant Review (this index)

AIA SECTION 8(a)

Pre-issuance submissions, **20:3**

AIA SECTION 10

Fee setting, **25:3**

AIA SECTION 11

Fees, **25:4**

AIA SECTION 11(h)

Accelerated examination, **29:3**

AIA SECTION 12

Supplemental examination, **22:3**

AIA SECTION 13(a)

Funding agreements, **31:2**

AIA SECTION 16(a)

Marking, **6:3**

AIA SECTION 16(b)

False Patent Marking (this index)

AIA SECTION 17

Enhanced damages and advice of counsel, **10:3**

AIA SECTION 18

Covered Business Method Patents (this index)

AIA SECTION 19

Jurisdiction, **12:3**

AIA SECTION 20(i)(2)

Funding agreements, **31:2**

AIA SECTION 21

Payment of ALJs, **31:3**
Travel expenses, **31:3**

AIA SECTION 25

Accelerated examination, **29:3**

AIA: A GUIDE TO PATENT LITIGATION & PROCEDURE

AIA SECTION 26

Study on AIA implementation,
31:4

AIA SECTION 27

Study on genetic testing, **31:5**

AIA SECTION 28

Patent ombudsman program, **31:6**

AIA SECTION 29

Study on diversity of applicants,
31:7

AIA SECTION 30

Small businesses and inventors,
31:8

AIA SECTION 31

Study on international patent
protection for small busi-
nesses, **31:9**

AIA SECTION 32

Pro bono program, **31:10**

AIA SECTION 33

Ban on patents, **4:4**
Human organisms, **4:2**

AIA SECTION 35

Effective date, **32:2**
Enhanced damages and advice of
counsel, **10:4**

AIA SECTION 36

Budgetary effects, **31:12**

AIA SECTION 37(a)

Patent term extension, **30:3**

AIA SECTION 37(b)

Patent term extension, **30:2**

AIA SECTION 102

Examples of application, **2:11 to
2:22**

AMERICAN INVENTOR'S PROTECTION ACT OF 1999

Prior use defense, **8:1**

APPEAL AND REVIEW

Reexaminations, ex parte
reexaminations, **23:7**
U.S. Patent and Trademark Office.
PTAB Trial Practice (this
index)

APPLICATION DATA SHEET

Assignee filing and inventor's
oath, **24:10**

ASSIGNEE FILING AND INVENTOR'S OATH

Generally, **24:1 to 24:13**
Amendment
regulations, **24:4**
statutes, **24:3**
Applicant, **24:5**
Application data sheet, **24:10**
Background, **24:1**
Congressional intent, **24:2**
Data sheet, **24:10**
Declaration, **24:7**
Estoppel
assignor, **24:11**
licensee, **24:11**
Historical perspective, **24:1**
Name of inventor, **24:6**
New regulations, **24:4**
New statutes, **24:3**
Oath or declaration, **24:7**
Practice, generally, **24:4 to 24:11**
Priority claims, **24:9**
Substitute statements, **24:8**
USPTO recommendations, **24:11**

ATTORNEYS

Advice. Enhanced Damages and
Advice of Counsel (this
index)
PTAB trial practice, **15:6**

BACKGROUND

Accelerated examination, **29:1**
Assignee filing and inventor's
oath, **24:1**
Best mode, **3:1**

INDEX

BACKGROUND—Cont'd

- Covered business method patents, **17:1**
- Deceptive intent, removal, **27:1**
- Derivation proceedings, **19:1**
- Effective dates, **32:1**
- Enhanced damages and advice of counsel, **10:1**
- False patent marking, **9:1**
- Fee setting and fees, **25:1**
- First inventor to file system, **2:1, 2:6, 2:9**
- Human organisms, **4:1**
- Inter partes review, **18:1**
- Joinder and consolidation, **13:1**
- Jurisdiction, **12:1**
- Marking, **5:1**
- Patent term extension calculation, **30:1**
- Post-grant review, **16:1**
- Post-issuance submissions, **21:1**
- Pre-issuance submissions, **20:1**
- Prior commercial use, **2:6**
- Prioritized examination, **29:1**
- Prior user defense, **8:1**
- Satellite offices, **28:1**
- Supplemental examination, **22:1**
- Venue for review of USPTO decisions, **11:1**

BEST MODE

- Generally, **3:1 to 3:8**
- Applicable USPTO final rules, **3:4**
- Congressional intent, **3:2, 14:2**
- Defense, elimination from litigation, **3:5, 14:3**
- Disclosure requirement, **App 4**
- Effective date of amendments, **3:7**
- Elimination of best mode defense from litigation, **3:5, 14:3**
- Global harmonisation of patent laws, **3:1, 3:5**
- Historical perspective, **3:1**
- Litigation, best mode amendments, **3:5, 3:7**
- Other Section 112 requirements, **3:8**

BEST MODE—Cont'd

- Patent prosecution, **3:5**
- Post-grant review, inapplicability, **3:6**
- Removal of consequences for violating disclosure requirement, **3:3**
- Requirement, generally, **3:1 to 3:9**

BIOTECHNOLOGY

- Prior use defense, **8:1**
- 35 U.S.C. Section 282, **14:4**

BUDGETARY EFFECTS

- AIA Section 36, **31:12**

CALCULATION

- Patent Term Extension (this index)

CASE OR CONTROVERSY

- PTAB trial practice, **15:72**

CHECKLISTS

- Covered business method patents review, **17:7**
- Derivation proceedings, **19:5**
- Inter partes review, **18:4**
- Post-grant review, **16:4**

CLAIMED INVENTION

- Definition, **1:1**

COMMON OWNERSHIP

- Examples of application of AIA Section 102, **2:11 to 2:22**
- Joint Research Agreement (this index)
- Section 102(a)(2) exception, **2:7**

CONDITIONS

- Fee-based revised accelerated examination, **29:6**
- Joinder and consolidation, **13:6**
- Patentability, comparison of former and current Section 102, **2:3**

CONGRESSIONAL INTENT

- Generally, **2:4**
- Accelerated examination, **29:2**

CONGRESSIONAL INTENT

—Cont’d

Assignee filing and inventor’s oath, **24:2**
 Best mode, **3:2, 14:2**
 Covered business method patents, **17:1**
 Deceptive intent, removal, **27:1**
 Derivation proceedings, **2:4, 19:2**
 Ease of determining right to claimed invention, **2:4**
 Effective dates, **32:1**
 Efficiency benefits to applicants, **2:4**
 Elimination of costly, complex interference proceedings, **2:4**
 Enhanced damages and advice of counsel, **10:2**
 False patent marking, **9:2**
 Fee setting and fees, **25:1**
 First inventor to file, **2:4**
 Global uniformity of patent laws, **2:1, 2:4**
 Grace period to inventors, **2:4, 2:6**
 House Report excerpts, **App 1**
 Human organisms, **4:1**
 Inter partes reexamination statute, **23:2**
 Inter partes review, **18:1**
 Joinder and consolidation, **13:2**
 Jurisdiction, **12:2**
 Marking, **5:2**
 Patent term extension calculation, **30:1**
 Post-grant review, **16:1**
 Post-issuance submissions, **21:2**
 Pre-issuance submissions, **20:2**
 Prior art, prior to filing date, **2:4**
 Prioritized examination, **29:2**
 Prior use defense, **8:2**
 Progress of science and useful arts, **2:1**
 Reexaminations, **23:2**
 Satellite offices, **28:1**
 Supplemental examination, **22:2**

CONGRESSIONAL INTENT

—Cont’d

Tax strategies, limited patent-ability, **5:1**
 Venue for review of USPTO decisions, changes, **11:2**

CONSIDERED, RECONSIDERED, OR CORRECTED

Supplemental Examination (this index)

CONSOLIDATION

Joinder and Consolidation (this index)

CONSTITUTIONALITY

First inventor to file system, **2:2**

CORRECTION OF INFORMATION

Supplemental Examination (this index)

COUNSEL

Advice. Enhanced Damages and Advice of Counsel (this index)
 PTAB trial practice, **15:6**

COVERED BUSINESS METHOD PATENTS

AIA Section 18, generally, **17:2**
 Background, **17:1**
 Checklist for review, **17:7**
 Civil litigation, effect of CBM review, **17:11 to 17:14**
 Congressional intent, **17:1**
 Content of petition, **17:7**
 Definition, **1:1**
 Eligibility to file petition, **17:5**
 Eligible patents, **17:4**
 Estoppels, **17:15**
 Expiration of provisions, **17:3**
 Final written decisions, **17:10**
 Petition for CBM review, **17:5 to 17:7**

INDEX

COVERED BUSINESS METHOD

PATENTS—Cont'd

- Preliminary injunctions, civil litigation, effect of CBM review, **17:14**
- Prior art against “first-to-invent” patents, **17:8**
- Prior use defense, **8:1**
- Proceedings, **17:9**
 - final written decisions, **17:10**
- Restrictions, **17:5, 17:6**
- Review, generally, **17:1 to 17:11**
- Statistics, PTAB, **17:16**
- Stay of litigation, effect of CBM review, **17:13**
- Timeliness of petition, **17:6**
- Venue, civil litigation, effect of CBM review, **17:12**

DAMAGES

- Enhanced Damages and Advice of Counsel (this index)

DATA SHEET

- Assignee filing and inventor’s oath, **24:10**

DECEPTIVE INTENT, REMOVAL

- Generally, **27:1 to 27:3**
- Amended statute, **27:2**
- Background, **27:1**
- Congressional intent, **27:1**
- Elimination of defense from litigation, **14:3**
- 35 U.S.C. Section 42 revisions, **27:3**

DECLARATORY JUDGMENT ACTIONS

- False patent marking, **9:8**

DEFINITIONS

- Claimed invention, **1:1**
- Commercial use, **8:1**
- Competitive injury, **9:5**
- Covered business method patent, **1:1**
- Director, **1:1**

DEFINITIONS—Cont'd

- Effective filing date, **1:1**
- Inventor, **1:1**
- Joint inventor, **1:1**
- Joint research agreement, **1:1**
- Micro entity, **1:1**
- Office, **1:1**

DERIVATION PROCEEDINGS

- Generally, **19:1 to 19:11**
- Administrative patent judge, **19:7**
- Arbitration, **19:8**
- Background, **19:1**
- Checklist for petition, **19:5**
- Common ownership, **19:8**
- Congressional intent, **19:2**
- Date invention is made, relevance, **2:8**
- Effective date, **19:10**
- Filing petition, **19:5**
- Institution of proceeding, **19:7**
- Issued patents, derivation actions between owners, **19:9**
- Mandatory notice, **19:6**
- Post-institution of proceeding, **19:8**
- Preliminary response, **19:6**
- Proceedings, generally, **19:4**
- Public availability of Board records, **19:8**
- Responses, **19:6**
- Settlements, **19:8**
- 35 U.S.C. Section 135
 - revision, **19:3 et seq.**
 - superseded by AIA first inventor to file system, **19:2**
- 35 U.S.C. Section 291, **19:3 et seq.**

DIRECTOR

- Definition, **1:1**

DISCLOSURE

- Best mode disclosure requirement, **3:3, App 4**
- Examples of application of AIA Section 102, **2:11 to 2:22**

DISCLOSURE—Cont’d

“Publicly disclosed” identified as definition missing from AIA, **1:2**
Removal of consequences for violation of best mode disclosure requirement, **3:3**

DISCOVERY

Inter partes review, **18:11**
Post-grant review, **16:11**
PTAB Trial Practice (this index)

DOUBLE PATENTING

Nonstatutory patent law provisions, **7:2**

EFFECTIVE DATES

Advice of counsel, AIA provisions, **10:4**
AIA Section 35, **32:2**
Background, **32:1**
Best mode amendments, **3:7**
Congressional intent, **32:1**
Definition of effective filing date, **1:1**
Derivation proceedings, **19:10**
First inventor to file, **2:9**
Inter partes review, **18:18**
Jurisdiction provisions of AIA Section 19, **12:3**
Post-grant review, **16:17**
Provision, **32:2**
Table of AIA effective dates, **32:3**

EFFECTIVE FILING DATE

Definition, **1:1**

EMBRYOS

Unpatentability of human organism, **4:4**

ENFORCEMENT ISSUES

Advice of Counsel (this index)
Best Mode (this index)
Biotechnology composition of matter exception in 35 U.S.C. Section 282, **14:4**
Deceptive intent defense, **14:3**

ENFORCEMENT ISSUES

—Cont’d

Enhanced Damages (this index)
False Patent Marking (this index)
Joinder and Consolidation (this index)
Jurisdiction (this index)
Prior Use (this index)
Venue for Review of USPTO Decisions (this index)

ENHANCED DAMAGES AND ADVICE OF COUNSEL

Generally, **10:1 to 10:5**
AIA Section 17, **10:3**
AIA Section 35, **10:4**
Background to new 35 U.S.C. Section 298, **10:1**
Congressional intent, **10:2**
Discussion of new 35 U.S.C. Section 298, **10:5**
Effective date of AIA provisions on advice of council, **10:4**
Willfulness and advice of council, **10:1**

ESTOPPELS

Assignor, **24:12**
Inter partes review, **18:14**
Licensee, **24:13**
Post-grant review, **16:13**
Review of covered business method patents, **17:15**

EVIDENCE

PTAB Trial Practice (this index)

EXAMINATIONS

Prioritized and Priority Examinations (this index)
Reexaminations (this index)
Supplemental Examination (this index)

EXAMPLES

First Inventor to File, application of AIA Section 102, **2:11 to 2:22**
Prior user defense, **8:4**

INDEX

EXAMPLES—Cont'd

Tax strategies, limited patent-ability, **5:3**

EX PARTES REVIEW

Reexaminations (this index)

EXPERIMENTAL USE

Prior art categories of Section 102(a)(1), **2:6**

EXPUNGEMENT OF CONFIDENTIAL INFORMATION

PTAB trial practice, **15:69**

FALSE PATENT MARKING

Generally, **9:1 to 9:10**

Activity that is not competitive injury, **9:5**

AIA Section 16(b)

amendment of 35 U.S.C. Section 292, **9:3**

Constitutional challenges, **9:9**
pending litigation, **9:4**

Background, **9:1**

Competitive injury

activity that is not competitive injury, **9:5**

meaning, **9:5**

pleading requirements, **9:6**

presumption, **9:6**

Congressional intent, **9:2**

Declaratory judgment actions, **9:8**

Historical perspective, **9:1**

Pending litigation, **9:4**

Pleading requirements for competitive injury, **9:6**

Preemption of state causes of action, **9:10**

Presumption of competitive injury, **9:6**

Prudential standing to sue for false marking, **9:7**

Qui tam action, **9:1, 9:4, 9:9**

Standing

declaratory judgment action for no false marking, **9:8**

FALSE PATENT MARKING

—Cont'd

Standing—Cont'd

false marking, standing to sue, **9:7**

State causes of action, **9:10**

Statutory standing to sue for false marking, **9:7**

35 U.S.C. Section 292, AIA statutory changes, **9:3**

FEES, FEE SETTING AND FEE DIVERSION

Accelerated examination, fee-based revised examination provisions, **29:5, 29:6**

AIA Section 10 fee setting, **25:3**

AIA Section 11 fees, **25:4**

Amended statutes

fee diversion, **26:2**

fee setting, **25:2**

Background

fee diversion, **26:1**

fee setting, **25:1**

Congressional intent

fee diversion, **26:1**

fee setting, **25:1**

Fee diversion, PTO funding

generally, **26:1 to 26:3**

background, **26:1**

Congressional intent, **26:1**

35 U.S.C. Section 42 revisions, **26:3**

PTO fee funding, generally, **26:1 to 26:3**

PTO fee setting, generally, **25:1 to 25:4**

Setting of fees

generally, **25:1 to 25:4**

AIA Section 10 fee setting, **25:3**

AIA Section 11 fees, **25:4**

amended statutes, **25:2**

background, **25:1**

Congressional intent, **25:1**

35 U.S.C. Section 42 revisions, **26:3**

FETUSES AND EMBRYOS

Unpatentability of human organism, **4:4**

FIRST INVENTOR'S DEFENSE ACT OF 1999

Prior user defense, **8:1**

FIRST INVENTOR TO FILE

Generally, **2:1 to 2:22**

Applications, **2:9**

Congressional intent, **2:4**

Constitutionality, **2:2**

Contrast of former and current Section 102, **2:3**

Ease of determining right to claimed invention, **2:4**

Effective date, **2:9**

Examples of application of AIA Section 102, **2:11 to 2:22**

Former and current Section 102 contrasted, **2:3**

Future litigation involving former Section 102, **2:10**

Grace period to inventors, **2:4, 2:6, 2:7**

Historical perspective, **2:1, 2:6, 2:9**

Litigation involving former and current Section 102, **2:10**

Qualification sweeps in all claims, **2:9**

Relevant claims for testing, **2:9**

Trigger date, **2:9**

FUNDING AGREEMENTS

AIA Section 3(g)(7)(A, B), **31:2**

AIA Section 13(a), **31:2**

AIA Section 20(i)(2), **31:2**

35 U.S.C. Section 202, **31:2**

GENETIC TESTING

AIA Section 27, study, **31:5**

GEOGRAPHIC RESTRICTIONS

First inventor to file, **2:6**

GLOBAL HARMONISATION OF PATENT LAWS

Best mode, **3:1, 3:5**

First inventor to file system, adoption, **2:1**

GRACE PERIOD TO INVENTORS

First inventor to file, **2:4, 2:6**

HUMAN ORGANISMS

Generally, **4:1 to 4:4**

AIA Section 33, **4:2**

Analysis re: ban, **4:4**

Background, **4:1**

Ban on patents, **4:2, 4:4**

Claims directed to or encompassing, **App 5**

Congressional intent, **4:1**

Fetuses and embryos, **4:4**

Historical perspective, **4:1**

Subject matter eligibility, 35 U.S.C. 101, **4:5**

Unpatentability, **4:1 to 4:5**

USPTO interpretation re: ban, **4:3**

Weldon Amendment, **4:1**

INITIAL CONFERENCE CALL

Inter partes review, **18:7**

Post-grant review, **16:7**

INTERNATIONAL PATENT PROTECTION FOR SMALL BUSINESSES

AIA Section 31, study, **31:9**

INTER PARTES REVIEW

Generally, **18:1 to 18:17**

AIA Section 6(a-c), generally, **18:1**

Background, **18:1**

Checklist for review, **18:4**

Civil litigation, relationship to, **18:12, 18:13**

Congressional intent, **18:1**

Discovery and trial procedure, **18:11**

Effective dates, **18:18**

Estoppels, **18:14**

INDEX

INTER PARTES REVIEW

—Cont'd

Initial conference call, **18:7**
Institution of review, **18:6**
Intervening rights, **18:16**
Joinder of multiple proceedings, **18:9**
Judicial review, **18:17**
Multiple proceedings and joinder, **18:9**
One month window, initial conference call, **18:7**
Petition, **18:4**
Preliminary response by patent owner, **18:5**
Procedures, **18:3**
Reexaminations (this index)
Rehearing, **18:17**
Response and amendment by patent owner, **18:8**
Settlements, **18:15**
Statistics, PTAB, **18:19**
Stay of litigation, **18:12, 18:13**
Supplemental information, **18:10**
35 U.S.C. Sections 311 to 319, generally, **18:1**
Three month window
 preliminary response by patent owner, **18:5**
 response and amendment by patent owner, **18:8**
Trial proceedings, **18:7**
USPTO certificate and intervening rights, **18:16**

INTERVENING RIGHTS

Inter partes review, **18:16**
Post-grant review, **16:15**

INVENTOR

Definition, **1:1**

JOINDER AND CONSOLIDATION

Generally, **13:1 to 13:11**
AIA Section 19(d), **13:3**
Any claim, **13:8**
Applicability of Section 299, **13:4**

JOINDER AND

CONSOLIDATION—Cont'd

Background, **13:1**
Conditions, **13:6**
Congressional intent, **13:2**
Different products, **13:11**
Effective date of Section 299, **13:5**
Federal Rules of Civil Procedure, Rules 20, 21 and 42, **13:1**
Historical perspective, **13:1**
Inter partes review, **18:9**
Multidistrict litigation, **13:17**
Multiple products/single defendant, **13:14**
Post-grant review, **16:9**
Pre-trial proceedings, consolidation, **13:16**
Same industry standard, **13:12**
Same or different products, **13:11**
Same patent(s), **13:10**
Same transaction, occurrence or series thereof, **13:9**
Severance motions, **13:15**
Specific applications, **13:9 to 13:14**
Specific topics, **13:8**
Table of required conditions, **13:6**
35 U.S.C. Section 299, generally, **13:3**
Trial proceedings, consolidation, **13:16**
Venue, joining insignificant parties for, **13:13**
Waiverability, **13:18**

JOINT INVENTOR

Definition, **1:1**

JOINT RESEARCH AGREEMENTS

Common ownership, Section 102(a)(2) exception, **2:7**
Definition, **1:1**
Prior art exception, **2:4**

JUDICIAL REVIEW

Inter partes review, **18:17**
Post-grant review, **16:16**

JUDICIAL REVIEW—Cont’d

U.S. Patent and Trademark Office
(this index)

JURISDICTION

Generally, **12:1 to 12:4**
AIA Section 19, **12:3**
Background, **12:1**
Congressional intent, **12:2**
Discussion of AIA changes, **12:4**
Effective date of AIA Section 19,
12:3
Removal and remand, **12:4**
State court jurisdiction, **12:4**
28 U.S.C. Section 1295, revision
by AIA Section 19(b), **12:3**
28 U.S.C. Section 1338, revision
by AIA Section 19(a), **12:3**
28 U.S.C. Section 1454, new sec-
tion added by AIA Section
19(c), **12:3**

**LEAHY-SMITH AMERICA
INVENTS ACT**

Act to Correct and Improve
Certain Provisions of Leahy-
Smith America Invents Act,
App 7
Text of Act, **App 2**

LITIGATION

Best mode amendments, **3:5, 3:7**
Covered business method patents,
effect of review on civil liti-
gation, **17:11 to 17:14**
Declaratory judgment actions,
false patent marking, **9:8**
First inventor to file, former and
current versions of Section
102, **2:10**
Inter partes review, relationship to
civil litigation, **18:12, 18:13**
Joinder and consolidation, multi-
district litigation, **13:17**
Pending litigation for false patent
marking, AIA Section 16(b),
9:4
Post-grant review, relationship to
civil litigation, **16:12**

LITIGATION—Cont’d

Review of covered business
method patents, **17:11 to
17:14**
Standing to sue for false marking,
9:7
Study of patent litigation by non-
practicing entities, AIA Sec-
tion 34, **31:11**

MARKING

Generally, **6:1 to 6:5**
AIA Section 16(a), **6:3**
Background on patent marking,
6:1
Congressional intent, **6:2**
Effective date, **6:4**
False Patent Marking (this index)
General comments, **6:5**
Historical perspective, **6:1**
Updating Web site, **6:5**
Virtual marking, **6:2, 6:3**

MICRO ENTITY

Definition, **1:1**

MISMARKING

False Patent Marking (this index)

MISTAKE

PTAB trial practice, **15:53**

MOTIONS

PTAB Trial Practice (this index)

MULTIDISTRICT LITIGATION

Joinder and consolidation, **13:17**

NAMES

Assignee filing and inventor’s
oath, name of inventor, **24:6**

OATH OR DECLARATION

Inventor’s oath, **24:7**

OFFICE

Defined as U.S. Patent and
Trademark Office, **1:1**

INDEX

ON SALE BAR

Prior art categories of Section 102(a)(1), **2:6**

ORAL ARGUMENT

PTAB trial practice, **15:47**

OTHERWISE AVAILABLE TO THE PUBLIC

Definition missing from AIA, **1:2**
Prior art categories of Section 102(a)(1), **2:6**

PATENT AND TRADEMARK OFFICE

U.S. Patent and Trademark Office (this index)

PATENT LAW PROVISIONS

Double patenting, nonstatutory, **7:2**
Terminal disclaimer practice, **7:2**

PATENT OMBUDSMAN PROGRAM

AIA Section 28, **31:6**

PATENT TERM EXTENSION

AIA Section 37(a), **30:3**
AIA Section 37(b), **30:2**
Amended 35 U.S.C. Section 156(d), **30:2, 30:3**
Background, **30:1**
Calculation of 60-day Period for Application for Patent Term Extension, **30:2**
Congressional intent, **30:1**
Historical perspective, **30:1**

PAYMENT

AIA Section 21, payment of ALJs, **31:3**

PENDING LITIGATION

False patent marking, AIA Section 16(b), **9:4**

POST-GRANT REVIEW

Generally, **16:1 to 16:17**
AIA Section 6(d), generally, **16:1**
Background, **16:1**

POST-GRANT REVIEW—Cont'd

Best mode, inapplicability, **3:6**
Checklist for petition, **16:4**
Civil litigation, relationship to, **16:12**
Congressional intent, **16:1**
Discovery and trial procedure, **16:11**
Effective dates, **16:17**
Estoppels, **16:13**
Filing petition, **16:4**
Initial conference call, **16:7**
Institution of review, **16:6**
Joinder of multiple proceedings, **16:9**
Judicial review, **16:16**
Multiple proceedings, **16:9**
One month window, **16:7**
Preliminary response by patent owner, **16:5**
Procedures, **16:3**
Rehearing, **16:16**
Relationship to civil litigation, **16:12**
Settlements, **16:14**
Supplemental information, **16:10**
35 U.S.C. Sections 321 to 329, generally, **16:2**
Three months window
 patent owner preliminary response, **16:5**
 patent owner response and amendment, **16:8**
“Trial” proceedings, **16:7**
USPTO certificate and intervening rights, **16:15**

POST-ISSUANCE SUBMISSIONS

Generally, **21:1 to 21:6**
Amended statute, **21:3**
Background, **21:1**
Congressional intent, **21:2**
Filing post-issue citation of art or information, **21:5**
35 U.S.C. Section 301, **21:3**
37 C.F.R. § 1.501, **21:4**

POST-ISSUANCE SUBMISSIONS

—Cont'd

USPTO use of post-issue submission, **21:6**

PRE-ISSUANCE SUBMISSIONS

Generally, **20:1 to 20:9**

AIA Section 8(a), **20:3**

Amended statute, **20:3**

Background, **20:1**

Congressional intent, **20:2**

Filing under 37 CFR Section 1.290, **20:5**

Protests under 35 U.S.C. Section 122(c) and 37 CFR Section 1.291, **20:8**

Statistics, USPTO, **20:9**

Subsequent handling of 37 CFR Section 1.290, **20:7**

Survival of protests under 35 U.S.C. Section 122(c) and 37 CFR Section 1.291, **20:8**

Third party preissuance submissions, **20:2 et seq.**

35 U.S.C. Section 122, **20:3**

35 U.S.C. Section 122(c) protests, **20:8**

37 CFR Section 1.290, **20:4, 20:5**

37 CFR Section 1.291 protests, **20:8**

Timing, **20:6**

PRELIMINARY INJUNCTIONS

Covered business method patents, civil litigation, effect of CBM review, **17:14**

PRINTED PUBLICATION

PTAB trial practice, proof, **15:92**

35 U.S.C. section 102, bar to novelty, **2:6**

PRIOR ART

Congressional intent, art prior to filing date, **2:4**

Grace period

Congressional intent, **2:4**

earlier filed application, **2:7**

Section 102(a)(1), **2:6**

PRIOR ART—Cont'd

Grace period—Cont'd

Section 102(a)(2), **2:7**

Joint research agreement exception, **2:4**

Published applications effective as prior art, **2:7**

Section 102(a)(1) prior art categories and exceptions, **2:6**

Section 102(a)(2) prior art categories and exceptions, **2:7**

Tax Strategies (this index)

PRIORITIZED AND PRIORITY EXAMINATIONS

Generally, **29:1 to 29:6**

AIA Section 11(h), **29:3**

AIA Section 25, **29:3**

Amended statutes, **29:3**

Congressional intent, **29:2**

Fee-based revised examination conditions, **29:6**

provisions, **29:5**

Initial conditions for fee-based revised examination, **29:6**

Non-fee based revised examination provisions, **29:4**

17 C.F.R. 1.17(c), **29:6**

17 C.F.R. 1.102, **29:6**

35 U.S.C. Section 2(b), **29:3**

Track One petitions, USPTO statistics on, **29:7**

PRIORITY CLAIMS

Assignee filing and inventor's oath, **24:9**

PRIORITY SYSTEM

First Inventor to File (this index)

PRIOR USER DEFENSE

Generally, **8:1 to 8:4**

AIA revisions, **8:3**

American Inventor's Protection Act of 1999, **8:1**

Analysis of expanded prior use defense, **8:4**

Background, **8:1**

INDEX

PRIOR USER DEFENSE—Cont'd

- Burden of proof, **8:4**
- Business methods, **8:1, 8:4**
- Change in title of defense, **8:4**
- Congressional intent, **8:2**
- Continuity, **8:1**
- Domestic commercial requirement, **8:1, 8:4**
- Examples, **8:4**
- Expanded prior use defense, **8:4**
- First Inventor's Defense Act of 1999, **8:1**
- Good faith, **8:1, 8:4**
- Limitation on university exception, **8:4**
- Location, **8:1**
- Nonderivation requirement, **8:4**
- Nonprofit laboratory use, **8:4**
- Originality, **8:1**
- Personal defense expansion, **8:4**
- Personal defense limitation, **8:1**
- Premarket regulatory review, **8:4**
- Proof, **8:1**
- Sanctions, **8:1, 8:4**
- Site requirements, **8:4**
- Time, **8:1, 8:4**
- Type of patent, **8:1, 8:4**
- University exception, **8:4**
- USPTO report, **8:4**

PRO BONO PROGRAM

- AIA Section 32, **31:10**

PROGRESS OF SCIENCE AND USEFUL ARTS

- First inventor to file system, adoption, **2:1**

PROTECTIVE ORDERS

- PTAB trial practice, **15:8, 15:9**

PTAB TRIAL PRACTICE

- Generally, **15:1 to 15:93**
- Acceptance, petition, **15:10**
- Amending claim, motions, deadline, **15:40**
- Appeal and review
 - generally, **15:70 to 15:75**

PTAB TRIAL PRACTICE

—Cont'd

- Appeal and review—Cont'd
 - burden shifting, **15:74**
 - case or controversy requirement, **15:72**
 - court review, **15:71**
 - procedural issues, **15:75**
 - standard of review, **15:73**
- Board, generally, **15:1**
- Claim construction, **15:4**
- Correction of mistakes, **15:53**
- Counsel, **15:6**
- Decisions on motions and petitions, **15:64 to 15:67**
- Default protective order, **15:8**
- Discovery
 - generally, **15:48 to 15:52**
 - patent owner's discovery and motion period, **15:40**
 - patent owner's further discovery period, **15:43**
 - petitioner's discovery, reply and opposition period, **15:42**
- Due date
 - 1A, motion to amend claim, **15:40**
 - 1B, patent owner's response to petition and close of discovery and motion period, **15:41**
 - 2, petitioner's discovery, reply and opposition period, **15:42**
 - 3, patent owner's further discovery period, **15:43**
 - 4, various motion deadlines, **15:44**
 - 5, reply and opposition deadlines, **15:45**
 - 6, replies to motions to exclude evidence, **15:46**
 - 7, oral argument, **15:47**
- Evidence
 - generally, **15:61, 15:62**
 - exclude evidence, motions, **15:46**

PTAB TRIAL PRACTICE

—Cont'd

Evidence—Cont'd
 objections to petition evidence, **15:39**
 ruling on petition, **15:21, 15:25**
 Final decision, **15:64 to 15:67**
 Form of petition and other filings, **15:7**
 Institution of trial, **15:16**
 Mandatory notices, preliminary proceeding, **15:5, 15:6**
 Mistake corrections, **15:53**
 Motions
 generally, **15:56 to 15:60**
 amending claim, deadline, **15:40**
 decisions on motions, **15:64 to 15:67**
 exclude evidence, **15:59**
 joinder, **15:57**
 motions to exclude evidence, replies, **15:46**
 patent owner's discovery and motion period, **15:41**
 strike, **15:60**
 termination, **15:58**
 various motion deadlines, **15:44**
 Non-default protective order, **15:9**
 Objections to petition evidence, **15:39**
 Oral argument, **15:47**
 Petition, **15:3, 15:7**
 acceptance or rejection, **15:10**
 claim construction, **15:4**
 Preliminary proceeding, **15:3**
 Printed publication, proof, **15:92**
 Proof, printed publication, **15:92**
 Protective orders, **15:8, 15:9**
 Public availability, **15:8**
 Rehearing requests, **15:68**
 Rejection, petition, **15:10**
 Responses by patent owner prior to trial
 generally, **15:11 to 15:14**
 initial disclosure, agreed, **15:14**

PTAB TRIAL PRACTICE

—Cont'd

Responses by patent owner prior to trial—Cont'd
 mandatory initial disclosure, agreed, **15:14**
 preliminary response, **15:13**
 Rules, generally, **15:1**
 Ruling on petition
 institution of trial, **15:16**
 institution of trial denied generally, **15:17 to 15:37**
 claim terms, **15:32**
 clarity, lack of, **15:19**
 combinations, **15:30**
 conclusory testimony, **15:22**
 disclaimers, statutory, **15:31**
 discretion, **15:33, 15:34**
 estoppel, **15:35**
 evidence, **15:21, 15:25**
 expert opinions, **15:24**
 judicial expectations, **15:18**
 obviousness analysis, **15:26**
 reasonableness of expectations, **15:29**
 references, **15:20, 15:27, 15:28**
 sovereign immunity, **15:36**
 statutory disclaimers, **15:31**
 technology, **15:23**
 time of petition, **15:36**
 Scheduling order, **15:38**
 Settlement, **15:63**
 Statistics, **15:93**
 Trial practice, generally, **15:2, App 3**

PUBLICATION

Prior art categories of Section 102(a)(1), **2:6**

PUBLIC DISCLOSURE

Disclosure (this index)

PUBLICLY DISCLOSED

Definition missing from AIA, **1:2**

INDEX

PUBLIC USE

Prior art categories of Section 102(a)(1), **2:6**

QUALIFICATION

First inventor to file, all claims, **2:9**

QUI TAM ACTION

False Patent Marking Statute, **9:1**

RECONSIDERATION OF INFORMATION

Supplemental Examination (this index)

REEXAMINATIONS

Generally, **23:1 to 23:7**

AIA Section 6(a)-(c), inter partes reexamination, **23:3**

AIA Section 6(h), ex partes reexamination, **23:5**

Appeal and review, ex parte reexaminations, **23:7**

Congressional intent, **23:2**

New USPTO Rules

ex partes reexamination, **23:6**

inter partes reexamination, **23:4**

Reasonable likelihood of success, **23:2**

35 U.S.C. Sections 303 and 306, ex partes reexamination, **23:5**

35 U.S.C. Sections 312 and 313, inter partes reexamination, **23:3**

REHEARINGS

Inter partes review, **18:17**

Post-grant review, **16:16**

PTAB trial practice, requests, **15:68**

REMOVAL AND REMAND

Jurisdiction changes, **12:4**

SATELLITE OFFICES

Generally, **28:1 to 28:3**

AIA provisions, **28:2**

Background, **28:1**

Congressional intent, **28:1**

SATELLITE OFFICES—Cont'd

Discussion of provisions, **28:3**

SCHEDULING ORDER

PTAB trial practice, **15:38**

SETTLEMENTS

Derivation proceedings, **19:8**

Inter partes review, **18:15**

Post-grant review, **16:14**

PTAB trial practice, **15:63**

SMALL BUSINESSES AND INVENTORS

AIA Section 30, **31:8**

STATE COURT JURISDICTION

Jurisdiction changes, **12:4**

STAY OF LITIGATION

Covered business method patents, effect of CBM review, **17:13**

Inter partes review, **18:12, 18:13**

STUDY ON AIA

IMPLEMENTATION

AIA Section 26, **31:4**

SUBMISSIONS OF ART

Post-Issuance Submissions (this index)

Pre-Issuance Submissions (this index)

SUBSTITUTE STATEMENTS

Assignee filing and inventor's oath, **24:8**

SUPPLEMENTAL

EXAMINATION

Generally, **22:1 to 22:9**

AIA Section 12, **22:3**

Background, **22:1**

Benefits, **22:8**

Conclusion, **22:7**

Congressional intent, **22:2**

Content of request, **22:5**

General overview, **22:4**

New question of patentability, USPTO determination, **22:6**

New statute, **22:3**

SUPPLEMENTAL

EXAMINATION—Cont'd

Request, **22:5**
 Statistics, USPTO, **22:9**
 35 U.S.C. Section 257, **22:3**
 Time for USPTO determination,
22:6
 USPTO determination, **22:6**

**SUPPLEMENTAL
 INFORMATION**

Inter partes review, **18:10**
 Post-grant review, **16:10**

TABLES

AIA effective dates, **32:3**
 Patentability, table comparing former and AIA-based Section 102, **2:3**

TAX STRATEGIES

Generally, **5:1 to 5:4**
 AIA Section 14
 analysis, **5:4**
 statutory provisions, **5:2**
 USPTO guidance, **5:3, App 6**
 Congressional intent, **5:1**
 Electronic tax return preparation, **5:3**
 Examples, **5:3**
 Limited patentability, **5:1 to 5:4**
 Manufacturing hybrid vehicle, **5:3**
 Payroll processing, **5:3**
 Prior art, **5:1 to 5:4, App 6**
 Software related inventions, **5:3**
 Tax Deferrals, **5:3**
 Tax reduction, **5:3**

**TERMINAL DISCLAIMER
 PRACTICE**

Patent law provisions, **7:2**

THIRD PARTIES

Pre-Issuance Submissions (this index)

35 U.S.C. SECTION 2(b)

Accelerated examination, **29:3**

35 U.S.C. SECTION 42

Deceptive intent removal, revisions of statute, **27:3**
 Fee diversion, PTO funding, **26:3**

35 U.S.C. SECTION 102

Common ownership exception, **2:7**
 Conditions for patentability, contrast of former and current Section 102, **2:3**
 Current Section 102, former Section 102 rewritten, **2:3**
 Described in printed publication, bar to novelty, **2:6**
 Disclosure by actual or joint inventor, Section 102(a)(1), **2:6, 2:7**
 Experimental use, **2:6**
 Former Section 102(a) to (g), generally, **2:3**
 Geographic restrictions, **2:6**
 Grace period
 Congressional intent, **2:4**
 disclosure by actual or joint inventor, **2:6, 2:7**
 Section 102(a)(1), **2:6**
 Section 102(a)(2), **2:7**
 Joint research agreements, common ownership exception, **2:7**
 One-year grace period, disclosure by actual or joint inventor, **2:6, 2:7**
 On sale, bar to novelty, **2:6**
 Otherwise available to public, bar to novelty, **2:6**
 Printed publication, bar to novelty, **2:6**
 Prior art
 Section 102(a)(1) and exceptions, **2:6**
 Section 102(a)(2) and exceptions, **2:7**
 Prior commercial use, historical perspective, **2:6**
 Public use, bar to novelty, **2:6**

INDEX

35 U.S.C. SECTION 102—Cont'd

Published applications effective as prior art, **2:7**

Section 102(a) bars

generally, **2:5**

Section 102(a)(1), prior art categories and exceptions, **2:6**

Section 102(a)(2), prior art categories and exceptions, **2:7**

Section 102(b) exceptions from bars, **2:5**

Statutory language, **2:5**

35 U.S.C. SECTION 103

Amendment of Section 282, **2:8**

Obviousness before effective filing date of claimed invention, **2:8**

35 U.S.C. SECTION 104

Repealed by AIA Section 3(d), **7:1**

35 U.S.C. SECTION 122

Pre-issuance submissions, **20:3**

35 U.S.C. SECTION 122(c)

PROTESTS

Pre-issuance submissions, **20:8**

35 U.S.C. SECTION 135

Derivation Proceedings (this index)

35 U.S.C. SECTION 157

Repealed by AIA Section 3(e)(1), **7:1**

35 U.S.C. SECTION 202

Funding agreements, **31:2**

35 U.S.C. SECTION 257

Supplemental examination, **22:3**

35 U.S.C. SECTION 273

AIA revisions to prior user defense, **8:3**

35 U.S.C. SECTION 282

Biotechnology composition of matter exception, **14:4**

35 U.S.C. SECTION 291

Derivation Proceedings (this index)

35 U.S.C. SECTION 292

False patent marking, AIA statutory changes, **9:3**

35 U.S.C. SECTION 298

Enhanced Damages and Advice of Counsel (this index)

35 U.S.C. SECTION 299

Joinder and Consolidation (this index)

35 U.S.C. SECTION 301

Post-issuance submissions, **21:3**

35 U.S.C. SECTIONS 311 TO 319

Inter Partes Review (this index)

35 U.S.C. SECTIONS 321 TO 329

Post-Grant Review (this index)

37 CFR SECTION 1.290

Pre-issuance submissions, **20:4, 20:5, 20:7**

Third party preissuance submissions, **20:4**

37 CFR SECTION 1.291

PROTESTS

Pre-issuance submissions, **20:8**

TRACK ONE PETITIONS

USPTO statistics on, **29:7**

TRAVEL EXPENSES

AIA Section 21, **31:3**

TRIGGER DATE

First inventor to file, **2:9**

28 U.S.C. SECTION 1295

Jurisdiction, revision by AIA Section 19(b), **12:3**

UNITED STATES DISTRICT COURT OF EASTERN DISTRICT OF VIRGINIA

Venue for review of USPTO decisions, **11:4**

UNIVERSITY PATENT

Date invention is made, relevance,
2:8

**U.S. PATENT AND
TRADEMARK OFFICE**

Appellate review of USPTO
actions

generally, **11:1**

Venue for Review of USPTO
Decisions (this index)

Assignee filing and inventor's
oath, USPTO recommenda-
tions, **24:11**

Best mode, applicable USPTO
final rules, **3:4**

Definition of Office, **1:1**

Ex partes reexamination, new
USPTO Rules, **23:6**

Fees, Fee Setting and Fee Diver-
sion (this index)

“Human organism” patent ban,
USPTO interpretation, **4:3**

Inter partes reexamination, new
USPTO Rules, **23:4**

Non-trial proceedings

Post-Issuance Submissions (this
index)

Pre-Issuance Submissions (this
index)

Reexaminations (this index)

Supplemental Examination (this
index)

**U.S. PATENT AND
TRADEMARK OFFICE
—Cont'd**

Office defined, **1:1**

Reexaminations (this index)

Supplemental Examination (this
index)

Trial proceedings

Covered Business Method
Patents (this index)

Derivation Proceedings (this
index)

Inter Partes Review (this index)

Post-Grant Review (this index)

PTAB Trial Practice (this index)

**VENUE FOR REVIEW OF
USPTO DECISIONS**

Generally, **11:1 to 11:4**

AIA Section 9, **11:3, 11:4**

Background to venue changes,
11:1

Congressional intent in venue
changes, **11:2**

Historical perspective to venue
changes, **11:1**

Technical amendments relating to
venue, **11:3**

United States District Court of
Eastern District of Virginia,
11:4

WELDON AMENDMENT

Unpatentability of “human organ-
isms,” **4:1**