

RICK NEIFELD'S PATENT CASE LAW BOOK

As of March 2018, this book is available for purchase from third party vendors. Copied in below is the current table of contents, only.

Last revised: March 9, 2018

STATUS: The contents of the book are based upon my review of the law. I normally update the book at least weekly.

SCOPE: This book is mainly directed to patent law. It contains the US Constitution; statute sections; rules; holdings; and relevant dicta.

ORGANIZATION: In sequence: Constitutional Law and generally applicable legal doctrines; federal judicial rules; and then United States Code. Relevant federal regulations are generally embedded within the code section they implement. Case citations follow in the code or regulation section heading to which they relate.

LINKS TO MAJOR SECTIONS (BOOKMARKS)

- [I. Constitutional Law](#)
- [II. Generally Applicable Legal Doctrines](#)
- [III. Federal rules of evidence](#)
- [IV. Federal Rules of Civil Procedure](#)
- [V. United States Code Titles 5 \(Administrative Procedures Act\); 11 \(Bankruptcy\); 15 \(Commerce and Trade, Antitrust\); 18 \(Crimes and Criminal Procedure\); 19 \(Customs Duties\); 21 \(Food and Drugs\)](#)
- [VI. United States Code Title 28 \(Judiciary and Judicial\)](#)
- [VII. United States Code Title 35 \(Patent Law\)](#)

TABLE OF CONTENTS

I. Constitutional Law	Book Page 1
The Constitution of the United States of America	Book Page 1
Article. I.	Book Page 1
Article. II.	Book Page 5
Article. III.	Book Page 7
Article. IV.	Book Page 8
Article. V.	Book Page 9
Article. VI.	Book Page 9
Article. VII.	Book Page 9
Amendment I	Book Page 10
Amendment II	Book Page 10
Amendment III	Book Page 10
Amendment IV	Book Page 10
Amendment V	Book Page 10
Amendment VI	Book Page 10
Amendment VII	Book Page 10
Amendment VIII	Book Page 10
Amendment IX	Book Page 11

Amendment X	Book Page 11
Amendment XI	Book Page 11
Amendment XII	Book Page 11
Amendment XIII.	Book Page 11
Amendment XIV.	Book Page 12
Amendment XV.	Book Page 12
Amendment XVI.	Book Page 13
Amendment XVII	Book Page 13
Amendment XVIII	Book Page 13
Amendment XIX	Book Page 13
Amendment XX	Book Page 13
Amendment XXI	Book Page 14
Amendment XXII	Book Page 14
Amendment XXIII	Book Page 14
Amendment XXIV	Book Page 15
Amendment XXV	Book Page 15
Amendment XXVI	Book Page 16
Amendment XXVII	Book Page 16
Constitution Article II, § 3 “take Care” clause	Book Page 16
Fifth and Fourteenth Amendments - "due process of law"	Book Page 16
<u>Mathews v. Eldridge</u> , 424 US 319, 334-35 (1976)	Book Page 17
"claim selection procedure"	Book Page 18
Fifth Amendment - Takings Clause	Book Page 20
Article III Standing	Book Page 20
Article III standing requirement applies to the appellant	Book Page 20
Standing is required for review in a federal court	Book Page 21
Standard for demonstrating standing in an appeal	
from a final agency action	Book Page 21
Injury requirement	Book Page 23
Mootness doctrine	Book Page 24
Assignment not retroactive	Book Page 25
Assignee must exist on date of assignment	Book Page 25
Name change does not affect standing	Book Page 25
Injury in fact that is redressable	Book Page 26
Qui tam injury requirement	Book Page 27
Seventh amendment right to a jury trial	Book Page 28
Seventh Amendment - “suits at common law”	
.....	Book Page 28
Seventh Amendment - Scope of suits encompassed	Book Page 29
Seventh Amendment - Two step test for applicability	Book Page 30
Seventh Amendment - Applicability to non-Article III courts	Book Page 30
Seventh Amendment - Limits on trial bifurcation	Book Page 31
State Sovereign Immunity	Book Page 32
PTAB AIA Proceedings	Book Page 33

Indian Nation Sovereign Immunity	Book Page 35
II. Generally applicable legal doctrines	Book Page 35
Statutory Construction avoiding constitutional question	Book Page 35
Law of the case doctrine	Book Page 36
Federal Preemption	Book Page 36
Erie doctrine	Book Page 37
Ripeness doctrine	Book Page 37
"preclusive effect of a federal-court judgment"	Book Page 38
Claim preclusion, issue preclusion, res judicata	Book Page 38
res judicata	Book Page 38
res judicata, Kessler doctrine	Book Page 38
Res judicata applied to changed circumstances	Book Page 40
Issue preclusion	Book Page 41
Res judicata of ex parte Board decisions	Book Page 41
No issue preclusion on a consent judgement	Book Page 42
Res judicata and subsequent claim cancellation	Book Page 44
Claim preclusion	Book Page 47
Claim preclusion, issues that could have been raised	Book Page 47
Exhaustion of administrative remedies	Book Page 49
Assignment of sovereign interest	Book Page 50
Claim accrual and tolling of statute of limitations	Book Page 51
Equitable tolling	Book Page 51
Retroactive applicability of a rule of federal law	Book Page 53
Inherent Court Powers	Book Page 54
Law-of-the-case doctrine	Book Page 54
General duty of candor to the Court	Book Page 55
Applies to notifying a court of the existence of concurrent IPRs	Book Page 58
The mandate rule	Book Page 58
<i>Forum non conveniens</i> doctrine	Book Page 59
Negligence elements	Book Page 60
Professional negligence elements	Book Page 60
Establishing the applicable standard of care	Book Page 61
Common knowledge exception to expert testimony requirement	Book Page 62
IV. Federal rules of evidence	Book Page 64
FRE 101. Scope; Definitions	Book Page 64
FRE 103. Rulings on Evidence	Book Page 64
FRE 104. Preliminary Questions	Book Page 64
FRE 401	Book Page 64
Exclusion of evidence and harmless error	Book Page 65
FRE 403 -Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons	Book Page 66
District court "may exclude"	Book Page 66
Evidence of denied PTAB petitions excluded	Book Page 66
Evidence of denied PTAB petitions not excluded	Book Page 67

Evidence of reexamination proceedings not excluded	Book Page 68
FRE 502 Attorney-Client Privilege and Work Product; Limitations on Waiver	Book Page 69
FRE 502(g) Definitions	Book Page 69
FRE 601. Competency to Testify in General	Book Page 69
FRE 602. Need for Personal Knowledge	Book Page 69
FRE 603. Oath or Affirmation to Testify Truthfully	Book Page 69
FRE 608. A Witness's Character for Truthfulness or Untruthfulness	Book Page 69
FRE 611 - Interrogation of witnesses	Book Page 69
FRE 702. Testimony by Expert Witnesses	Book Page 70
Admissibility of Expert Testimony	Book Page 70
Standard of review	Book Page 70
CAFC Case law	Book Page 72
Admissibility	Book Page 72
Weight and reliability	Book Page 73
FRE 702(a) - Qualifying as an expert	Book Page 74
Qualifications specified in declaration	Book Page 74
Inventors	Book Page 75
Testimony of unqualified expert	Book Page 75
Person of ordinary skill	Book Page 76
Patent law expert	Book Page 79
Witness admissions of lack of qualifications	Book Page 79
Lack of reliability, telling a lie under oath	Book Page 79
FRE 702(b)-(d) Basis for conclusions	Book Page 80
Basis for understanding of a PHOSITA	Book Page 80
FRE 704. Opinion on an Ultimate Issue	Book Page 81
FRE 802. The Rule Against Hearsay	Book Page 81
FRE 801(d)(2) - An Opposing Party's Statement	Book Page 81
FRE 801 - Definitions ...; Exclusions from Hearsay	Book Page 81
FRE 801(c) "offers in evidence to prove the truth of the matter asserted in the statement"	Book Page 82
FRE 802 - The Rule Against Hearsay	Book Page 83
FRE 803 - Exceptions to the Rule Against Hearsay	Book Page 83
FRE 803(16) Statements in Ancient Documents	Book Page 83
FRE 803 (17) Market Reports and Similar Commercial Publications	Book Page 84
FRE 803 - Notes of Advisory Committee	Book Page 84
FRE 807 - Residual Exemption	Book Page 85
FRE 901(b)(4) Distinctive Characteristics and the Like	Book Page 87
FRE 902. Evidence That Is Self-Authenticating	Book Page 87
FRE 1101	Book Page 88
IV. Federal Rules of Civil Procedure	Book Page 89
FRCP4(h)	Book Page 89
FRCP 6 - Computing and Extending Time; Time for Motion Papers	Book Page 89
FRCP6(b) - Extending Time	Book Page 89

FRCP 6(b)(1)(A) "good cause" standard for untimely filing	Book Page 90
FRCP 6(b)(1)(B) "excusable neglect " standard for untimely filing	Book Page 90
FRCP 8(a) Claim for Relief	Book Page 92
FRCP(8)(a) "statement of the grounds for the court's jurisdiction"	Book Page 92
Court jurisdiction raised on court's own motion	Book Page 92
Lack of jurisdiction results in reversal	Book Page 93
Diversity federal jurisdiction	Book Page 93
Diversity jurisdiction facts must appear in the record	Book Page 93
FRCP 8(a)(2) "claim showing that the pleader is entitled to relief"	Book Page 94
Separate claim for pre-issuance infringement	Book Page 96
FRCP8(b) Defenses; Admissions and Denials	Book Page 97
FRCP8(c) Affirmative Defenses	Book Page 98
Equitable estoppel must be plead	Book Page 98
FRCP 9(b)	Book Page 99
FRCP 11	Book Page 100
FRCP 11(b) Representations to the Court	Book Page 102
FRCP 11(c) Sanctions	Book Page 104
"apply an abuse-of-discretion standard"	Book Page 104
Litigation misconduct	Book Page 104
"escape Rule 11 sanctions by failing to file papers"	Book Page 105
Rule 11 - Fifth Circuit	Book Page 106
FRCP 12(b)(1)	Book Page 107
Subject matter jurisdiction	Book Page 107
Challenges to factual basis for subject matter jurisdiction	Book Page 108
FRCP 12(b)(2) How to Present Defenses	Book Page 109
FRCP 12(b)(6), Failure to state a claim	Book Page 110
Incorporation by reference	Book Page 110
Jurisdiction	Book Page 110
Sufficiency of complaint	Book Page 111
Inferences must favor the plaintiff	Book Page 112
Leave to amend upon grant of 12(b)(6) motion	Book Page 113
12(b)(6) motion based upon 35 USC 101	Book Page 113
12(b)(6) Pro se plaintiff	Book Page 114
12(b)(6) - Fifth Circuit	Book Page 115
12(b)(6) - Second Circuit	Book Page 115
FRCP 12(h) Waiving and Preserving Certain Defenses	Book Page 116
FRCP 13 Counterclaim and Crossclaim	Book Page 116
FRCP 13(a), Compulsory Counterclaim	Book Page 116
Infringement counterclaim to a suit contesting infringement	Book Page 116
Infringement counterclaim to a suit contesting ownership	Book Page 116
FRCP 13(e), Counterclaim Maturing or Acquired After Pleading	Book Page 117
FRCP 13(g) - Crossclaim Against a Coparty	Book Page 117
FRCP 15(a)(2), Leave to amend	Book Page 117
FRCP 15(b)	Book Page 117

FRCP Rule 19 and involuntary joinder	<u>Book Page 118</u>
FRCP 24 - Intervention	<u>Book Page 118</u>
Intervenor right to appeal	<u>Book Page 119</u>
FRCP 26 - Duty of Disclosure; General Provisions	
Governing Discovery	<u>Book Page 119</u>
Discovery - Choice of law in patent cases	<u>Book Page 119</u>
Discovery - Patent-agent privilege	<u>Book Page 119</u>
FRCP 26(a) - Required Disclosures	<u>Book Page 120</u>
FRCP 26(b) - (b) Discovery Scope and Limits	<u>Book Page 120</u>
Communications between experts and counsel	<u>Book Page 120</u>
FRCP 26(b)(4) - Trial Preparation: Experts	<u>Book Page 121</u>
FRCP 26(c) - (c) Protective Orders	<u>Book Page 126</u>
Protective order - access to confidential information	<u>Book Page 126</u>
Counsel bar to opponent's confidential information	<u>Book Page 128</u>
Litigation bar to participating in patent prosecution	<u>Book Page 128</u>
Litigation bar to participation in IPRs	<u>Book Page 130</u>
Litigation bar applies to IPRs on expired patents	<u>Book Page 133</u>
Litigation bar to acquisition of patents	<u>Book Page 133</u>
Confidentiality of peer review	<u>Book Page 134</u>
FRCP 28	<u>Book Page 134</u>
FRCP 37	<u>Book Page 135</u>
FRCP 37(b) Failure to Comply with a Court Order	<u>Book Page 135</u>
FRCP 37(b)(2) Sanctions Sought in the District Where the Action Is Pending	<u>Book Page 135</u>
Criteria for excluding untimely evidence	<u>Book Page 135</u>
FRCP 37(c) Failure to Disclose, Supplement, or to Admit	<u>Book Page 137</u>
Duty to preserve evidence; spoliation	<u>Book Page 137</u>
FRCP 37(c)(1) Protective Orders	<u>Book Page 138</u>
FRCP 37(e) Failure to Provide Electronically Stored Information	<u>Book Page 139</u>
FRCP 41 Dismissal of Actions	<u>Book Page 139</u>
FRCP 41(a) - Voluntary Dismissal	<u>Book Page 139</u>
Dismissal without prejudice	<u>Book Page 139</u>
41(a) dismissal automatically terminates the action, upon filing	<u>Book Page 140</u>
41(a) right to dismiss, prior to answer or summary judgement motion	<u>Book Page 140</u>
Motion to dismiss, standard of review	<u>Book Page 140</u>
Motion to dismiss, imputed knowledge of former attorney	<u>Book Page 141</u>
FRCP 45 Subpoena	<u>Book Page 143</u>
FRCP45(d) Protecting a Person Subject to a Subpoena; Enforcement	<u>Book Page 143</u>
FRCP 45(d)(2)(B) Objections and non-party fee shifting	<u>Book Page 143</u>
Fee shifting is mandatory	<u>Book Page 145</u>
Costs of non compliance may include attorneys fees	<u>Book Page 145</u>
FRCP 49(a) - Special Verdict	<u>Book Page 146</u>

FRCP49(b) - General Verdict with Answers to Written Questions	Book Page 146
Presumption that jury resolved underlying factual disputes	Book Page 146
Jury free to make credibility determinations	Book Page 146
FRCP 50. Judgment as a Matter of Law in a Jury Trial;	
Related Motion for a New Trial; Conditional Ruling	Book Page 147
FRCP 50(a) - JMOL	Book Page 147
FRCP 50(b) - Renewing a JMOL after trial	Book Page 148
FRCP 50(c) - Ruling on JMOL	Book Page 148
FRCP 50(d) - Motion for new trial under FRCP 59	Book Page 148
FRCP 50(e) - Appeal of denial of JMOL	Book Page 148
FRCP 51 Instructions to the Jury; Objections; Preserving a Claim of Error	
.....	Book Page 149
FRCP 51(a) - Requests	Book Page 149
FRCP 51(b) - Instructions	Book Page 149
FRCP 51(c) - Objections	Book Page 150
FRCP 51(c)(2) - When to Make	Book Page 150
FRCP 52. Findings and Conclusions by the Court;	
Judgment on Partial Findings	Book Page 151
FRCP 52 Findings and Conclusions by the Court	Book Page 151
FRCP 52(a)(1) In General	Book Page 151
FRCP 52(a)(6) Setting Aside the Findings	Book Page 152
Clearly erroneous standard of review	Book Page 152
Anderson v. Bessemer City, 470 US 564, 575-76 (1985)	Book Page 152
Applies to facts findings underpinning claim construction	Book Page 154
FRCP 54 - Judgment; Costs	Book Page 156
FRCP 54(a) - Definition; Form. "Judgment"	Book Page 156
Consent decree	Book Page 156
FRCP 54(b) - Judgment on Multiple Claims or Involving Multiple Parties .	Book Page 157
FRCP 56 - Summary judgement	Book Page 157
Test for summary judgement	Book Page 157
"genuine issue of material fact"	Book Page 157
FRCP 59 New Trial; Altering or Amending a Judgment	Book Page 159
FRCP 59(e) Altering or Amending a Judgment	Book Page 160
FRCP 60 - Relief from a Judgment or Order	Book Page 160
FRCP 60(b) - (b) Grounds for Relief from a	
Final Judgment, Order, or Proceeding	Book Page 160
FRCP 65 - Injunctions and Restraining Orders	Book Page 161
FRCP 65(d) - Contents and Scope of Every Injunction	
and Restraining Order	Book Page 161
Compliance of injunction with rule 65 is an issue of law	Book Page 162
Scope of subject matter of injunction	Book Page 162
Scope of entities subject to injunction	Book Page 162
Impact of dismissal	Book Page 164
FRCP 83 Rules by District Courts; Judge's Directives	Book Page 164

PTAB proceedings impact on infringement contentions	Book Page 167
Federal Rules of Appellate Procedure (FRAP)	Book Page 167
FRAP 28 - Cross-Appeals	Book Page 167
FRAP 46 - Admission, suspension, Discipline	Book Page 168
Federal Circuit Rules (FCR)	Book Page 168
FCR 36 - Judgement of Affirmance Without Opinion	Book Page 168
Statutory Construction	Book Page 169
Construction avoiding unconstitutionality	Book Page 169
United States Code intrinsic rules of construction	Book Page 169
"pure question of law"	Book Page 169
"language of the statute itself"	Book Page 170
"plain meaning"	Book Page 170
"language rejected by Congress"	Book Page 171
Title and heading are "available for the resolution of a doubt"	Book Page 171
<i>Stare decisis</i>	Book Page 172
<i>inclusio unius est exclusio alterius</i>	Book Page 173
normally the specific governs the general	Book Page 174
<i>noscitur a sociis</i>	Book Page 174
"would render another provision superfluous"	Book Page 174
"‘in light of the ‘contemporary legal context’"	Book Page 176
Common law term comes with its common law meaning	Book Page 176
Presumption against statutory abrogation of common law right	Book Page 177
The Court should choose least disruptive statutory construction	Book Page 178
Place in the overall statutory scheme	Book Page 178
Presumption against changes in fundamental legal precepts	Book Page 179
Presumption against extraterritoriality	Book Page 179
Longstanding administrative construction	Book Page 180
Statutory construction by an agency	Book Page 180
Agency interpretation of agency regulation	Book Page 181
changes in agency interpretation	Book Page 182
"prior to" or "before" recitations in a section of the statute	Book Page 183
TRIPS is not self implementing	Book Page 187
V. United States Code Titles 5 (Administrative Procedures Act); 11 (Bankruptcy); 15 (Commerce and Trade, Antitrust); 18 (Crimes and Criminal Procedure); 19 (Customs Duties); 21 (Food and Drugs)	Book Page 188
5 USC Part 1 - The Agencies Generally (§§ 101 to 903)	Book Page 188
5 USC Part 1, Chapter 5 - Administrative Procedure (§§ 500 to 596)	Book Page 188
5 USC Part I, Chapter 5, Subchapter II - Administrative Procedure (§§ 551 to 579)	Book Page 188
5 USC § 551 - Definitions	Book Page 188
5 USC 554 Adjudications	Book Page 189
IPR proceedings are subject to the APA	Book Page 189
IPR proceedings standard of review	Book Page 190

544(b)(3) Applies to Petitioners	Book Page 190
5 USC 554(b) and (c), notice and opportunity to respond	Book Page 191
Applies to "essential part of its obviousness findings identifying claim elements in the prior art"	Book Page 192
Effect of consolidation of cases on notice requirement	Book Page 193
Change of theories, midstream, triggers requirement for notice and an opportunity to be heard	Book Page 194
What constitutes notice and opportunity	Book Page 196
5 USC Chapter 7 - Judicial Review	Book Page 198
5 USC 701 - Application; definitions	Book Page 198
5 USC 702 - Right of Review	Book Page 200
5 USC 704 - Actions Reviewable	Book Page 200
"challenge a PTO decision to issue a patent"	Book Page 201
Challenge a PTO decision to revive an application	Book Page 201
"tolled until the agency action is final"	Book Page 202
Review of PTO decisions governed by APA	Book Page 205
5 USC 706 - Scope of Review	Book Page 205
5 USC 706(2)(A) - Abuse of discretion standard of review	Book Page 205
5 USC 706(2)(D) - Procedure required by law	Book Page 206
Procedure required by law -	Book Page 207
Procedure required by law - "full and reasoned explanation"	Book Page 207
Procedure required by law - "must set forth the rationale on which it relies"	Book Page 208
Procedure required by law - Agency cannot rely upon policy statements, as law	Book Page 209
5 USC 706(F) - "rule of prejudicial error"	Book Page 209
"review of factual findings for substantial evidence"	Book Page 210
PTO must provide "particular findings" of fact	Book Page 210
PTAB must consider evidence required to make a decision	Book Page 211
PTAB must make an explanation of the basis for its decision	Book Page 211
PTAB must provide for meaningful appellate review	Book Page 212
PTAB, not party, bears the burden to memorialize basis for agency action	Book Page 212
Request for PTAB authorization is action protected by the APA	Book Page 213
Findings of "suggestion, teaching, or motivation"	Book Page 213
Test for finding an "implicit showing"	Book Page 214
Findings required to support combination of references	Book Page 215
"obligation to develop an evidentiary basis for its findings"	Book Page 216
PTAB credibility determinations reviewed for substantial evidence	Book Page 216
The PTAB is entitled to rely upon expert declarations asserting obviousness when underlying declaration contains underlying factual assertions	Book Page 216
The PTAB must provide an evidentiary basis in the record,	

for any finding	Book Page 217
PTAB must construe disputed claim terms upon which it relies	Book Page 217
The PTAB cannot rely upon attorney argument for the findings or the reasoned explanation required under the APA	Book Page 218
The PTAB cannot summarize and then reject certain arguments in favor of opposing arguments, without explaining why it accepts the opposing arguments	Book Page 219
The PTAB cannot rely upon a party's failure to challenge a combination as the basis for accepting the combination as proper	Book Page 219
"district court[] reviewing agency action under the APA"	Book Page 220
"factors which give it power to persuade"	Book Page 220
"grounds upon which the agency acted in exercising its powers" ...	Book Page 220
Review of Agency Interpretation of Agency Rules	Book Page 221
Standard of review of agency interpretation of agency rules	Book Page 221
Contemporaneous agency construction of a statute	Book Page 222
Review of a change in agency interpretation of a rule	Book Page 222
Review of Agency Compliance with Agency Rules	Book Page 223
Vacate and Remand considerations	Book Page 224
9 USC 2 - Federal Arbitration Act	Book Page 226
11 USC 362 - Bankruptcy	Book Page 227
11 USC 365(n) - Licensee Licensor rights	Book Page 228
15 USC 1	Book Page 229
ANDA reverse payments	Book Page 232
15 USC 2	Book Page 234
Walker process antitrust	Book Page 235
15 USC 15	Book Page 236
Antitrust Standing	Book Page 237
Federal Circuit jurisdiction on antitrust relating to patent laws	Book Page 238
Failure to License	Book Page 239
Reliance upon offer to license, deceptive business practices	Book Page 239
Settlements based antitrust	Book Page 240
Noerr-Pennington based antitrust - governmental process abuse ...	Book Page 241
Sham litigation pleadings requirements	Book Page 242
15 USC 1052(a) - Trademarks registrable on principal register; concurrent registration	Book Page 242
15 USC 1071	Book Page 242
15 USC 1117 - Recovery for violation of rights	Book Page 243
17 USC 102 - Subject matter of copyright: In general	Book Page 244
17 USC 107 - Limitations on exclusive rights: Fair use	Book Page 244
Fair use defense to copyright violation, for legal proceedings	Book Page 244
Copyright Exhaustion	Book Page 245
17 USC 505	Book Page 246
18 USC 2182	Book Page 247
19 USC 1202 - Harmonized Tariff Schedule	Book Page 248

19 USC Section 1337 -	Book Page 249
Finality	Book Page 250
19 USC 1337(a) - Unlawful activities; covered industries	Book Page 250
19 USC 1337(a)(1)(B)(i)	Book Page 251
"articles that infringe"	Book Page 252
19 USC 1337(a)(2) and (3)	Book Page 252
19 USC 1337(d) Exclusion of articles from entry	Book Page 253
Commissioner discretion to exclude articles that induce patent infringement	Book Page 253
Authority to enjoin officers, employees, agents	Book Page 254
Duration of exclusion	Book Page 255
Limitations on Scope of Exclusion Orders	Book Page 255
19 USC 1337(f) - Cease and desist orders; civil penalties	Book Page 256
19 USC 1337(f)(2) - civil penalty	Book Page 256
civil penalties on corporate officers	Book Page 256
"scope of the public interest factors"	Book Page 256
19 USC 1526 Merchandise bearing American trade-mark (Gray market goods)	Book Page 257
37 CFR 133.23 Restrictions on importation of gray market articles	Book Page 257
19 USC 1673 Imposition of antidumping duties	Book Page 257
21 USC 355 - New drugs.	Book Page 259
21 USC 355(a) Necessity of effective approval of application	Book Page 259
21 USC 355(b) Filing application; contents	Book Page 259
21 USC 355(c) Period for approval of application; period for, notice, and expedition of hearing; period for issuance of order	Book Page 259
21 USC 355(j)(1) Abbreviated new drug applications	Book Page 259
21 USC 355(j)(2)(A) - ANDA Contents	Book Page 260
21 USC 355(j)(5)(B)(iv) 180-day exclusivity period	Book Page 260
21 USC 355(j)(5) Civil action to obtain patent certainty	Book Page 260
21 USC 355(j)(5)(C)(ii) Counterclaim to infringement action	Book Page 261
FDA Patent use codes	Book Page 261
Generic may force correction of use codes	Book Page 261
VI. United States Code Title 28 (Judiciary and Judicial)	Book Page 263
28 USC 1291	Book Page 263
Collateral order doctrine	Book Page 263
Writ of mandamus exception	Book Page 266
28 USC 1292 Interlocutory decisions	Book Page 267
Exception to the final judgement rule	Book Page 269
1292(c)(1) - CAFC exclusive jurisdiction	Book Page 269
1292(c)(2) accounting	Book Page 269
28 USC 1292(d)(4)(A)	Book Page 270
28 USC 1295 - Jurisdiction of the United States Court of Appeals for the Federal Circuit	Book Page 271
Jurisdiction is "the initial inquiry in any appeal"	Book Page 272

Burden of establishing that jurisdiction exists	Book Page 273
Jurisdiction based upon well pleaded complaint rule	Book Page 273
Meaning of "arising under" in 1338	Book Page 273
Record rule	Book Page 274
Exception to the record rule	Book Page 275
Final judgement rule	Book Page 276
28 USC 1295(a)(1) - District Court, patents, plant variety protection	Book Page 277
28 USC 1295(a)(2) - District Court, certain claims against the government	Book Page 278
28 USC 1295(a)(3) - Court of Claims	Book Page 278
28 USC 1295(a)(4)(A) - PTAB decisions, patent proceedings	Book Page 278
28 USC 1295(a)(4)(B) - PTO and TTAB decisions on trademark proceedings	Book Page 278
28 USC 1295(a)(4)(C) - District Court review of PTO proceedings	Book Page 278
28 USC 1295(a)(5) - Court of International Trade decisions	Book Page 278
28 USC 1295(a)(6) - ITC decisions	Book Page 278
28 USC 1295(a)(7) - Commerce department decisions on certain tariffs	Book Page 278
28 USC 1295(a)(8) - Plant Variety Protection Act appeals	Book Page 278
28 USC 1295(a)(9) - Merit Systems Protection Board appeals	Book Page 278
2015-1977) - An agency board of contract appeals	Book Page 278
28 USC 1295(a)(11)-(14) - Miscellaneous	Book Page 278
Choice of Laws in the Court of Appeals For the Federal Circuit	Book Page 279
On appeals of patent cases	Book Page 279
CAFC Choice of Laws - Preemption	Book Page 279
CAFC Choice of Laws - Jurisdiction	Book Page 279
CAFC Choice of Laws - Transfer pursuant to 35 USC 1404(a)	Book Page 280
CAFC Choice of Laws - Counterclaim	Book Page 280
CAFC Choice of Laws - Compulsory counterclaim	Book Page 280
CAFC Choice of Laws - Substantive patent law	Book Page 280
CAFC Choice of Laws - Conflicts with federal patent law	Book Page 281
CAFC Choice of Laws - Trade secret law	Book Page 281
CAFC Choice of Laws - Settlement agreement interpretation	Book Page 281
CAFC Choice of Laws - Contracts and assignments	Book Page 281
CAFC Choice of Laws - Arbitration agreements	Book Page 281
CAFC Choice of Laws - Admissibility of evidence	Book Page 283
Second Circuit	Book Page 283
CAFC Choice of Laws - FRCP	Book Page 283
Jury instruction on an issue of patent law	Book Page 284
Jury verdict form	Book Page 284
CAFC Choice of Laws - Summary Judgment of noninfringement ...	Book Page 284
CAFC Choice of Laws - Summary Judgment	Book Page 284
Second Circuit	Book Page 284
Fourth Circuit	Book Page 285

Fifth Circuit	Book Page 285
Seventh Circuit	Book Page 285
Local rules requiring infringement contentions	Book Page 285
CAFC Choice of Laws - FRCP 12(c) judgement on the pleadings ...	Book Page 286
3rd Circuit - Judgement on the pleadings	Book Page 286
9th Circuit - Judgement on the pleadings	Book Page 286
CAFC Choice of Laws - procedural issues	Book Page 286
CAFC Choice of Laws - Motions to dismiss	Book Page 287
Third Circuit	Book Page 287
Fifth Circuit	Book Page 288
Sixth Circuit	Book Page 288
Seventh Circuit	Book Page 288
CAFC Choice of Laws - Issues of preclusion	Book Page 288
Regional circuit law - issues of preclusion	Book Page 288
CAFC Choice of Laws - Discovery	Book Page 289
CAFC Choice of Laws - Orders refusing discovery	Book Page 290
CAFC Choice of Laws - Evidentiary rulings	Book Page 290
CAFC Choice of Laws - Damage awards	Book Page 290
Fifth Circuit	Book Page 290
CAFC Choice of Laws - Rulings on motions for JMOL	Book Page 290
Fifth Circuit - Motion for JMOL	Book Page 291
Ninth Circuit - Motion for JMOL	Book Page 291
Eleventh Circuit - Motion for JMOL	Book Page 292
CAFC Choice of laws - FRCP 59(a) Motion for a new trial	Book Page 292
Fifth Circuit - Motion for a new trial	Book Page 292
Eighth Circuit - Motion for new trial on damages	Book Page 292
Ninth Circuit - Motion for a new trial	Book Page 292
CAFC Choice of Laws - FRCP 59(e) - Amendment of a Judgment ..	Book Page 293
Fifth Circuit	Book Page 293
CAFC Choice of Laws - FRCP 65(a) Preliminary injunction	Book Page 293
CAFC Choice of Laws - FRCP 65(d) Permanent injunction	Book Page 293
CAFC Choice of Laws - Contempt proceeding	Book Page 294
CAFC Choice of Laws - Disqualification and dismissal	Book Page 294
Sanction for failure to comply with FRAP	Book Page 294
Civil contempt elements	Book Page 295
Attorney liability for contempt	Book Page 295
Civil contempt judgment and non-final order	Book Page 296
Binding precedent in the Federal Circuit	Book Page 297
Irreconcilable Federal Circuit precedent	Book Page 297
CAFC Choice of law - Personal Jurisdiction	Book Page 298
Federal Circuit choice of law in patent cases	Book Page 298
CAFC Personal jurisdiction, standard of review	Book Page 298
Presumption in favor of plaintiff's jurisdictional factual assertions ..	Book Page 299

CAFC Personal jurisdiction, test	Book Page 299
Long Arm Statute, and Due Process Requirements	Book Page 299
Long Arm Statute	Book Page 299
Due Process Requirement	Book Page 299
Federal Circuit 3 factor test for due process	Book Page 300
General and specific personal jurisdiction	Book Page 300
Stream of commerce test for specific personal jurisdiction	Book Page 301
Stream of commerce test - Supreme Court split	Book Page 301
Stream of commerce test - Federal Circuit cases	Book Page 302
Stream of commerce test - Federal Circuit law	Book Page 303
Personal jurisdiction - offer for sale	Book Page 304
Personal jurisdiction - cease and desist letters	Book Page 304
Personal jurisdiction - cease and desist letters plus exclusive license	Book Page 305
"obligation on the patent holder to enforce or defend"	Book Page 305
Indemnification provisions	Book Page 307
Personal jurisdiction - Web sites	Book Page 307
Filling orders directed to the forum state	Book Page 307
CAFC choice of law - procedure	Book Page 308
Procedural requirements of service of summons	Book Page 308
New Issue Jurisdiction	Book Page 311
Subject matter jurisdiction in the Federal Circuit	Book Page 312
Issue preclusion	Book Page 312
Waiver on appeal	Book Page 313
"arguments not raised in the opening brief"	Book Page 313
"no developed argumentation"	Book Page 313
"arguments raised in footnotes are not preserved"	Book Page 314
"failing to raise it in opposing summary judgment"	Book Page 315
Issue raised only in a Response to the Petition for Institution	Book Page 316
Waiver of claim construction, on appeal	Book Page 317
arguments are not waived if they involve issues both not decided by district court and "properly considered moot" until reversal of another district court ruling	Book Page 318
"discretion to consider arguments that are not properly raised"	Book Page 318
Factors affecting whether to apply waiver	Book Page 318
"necessary to the resolution of other issues"	Book Page 319
Judicial notice	Book Page 319
Judicial notice of related proceedings	Book Page 319
scope of review	Book Page 319
28 U.S. Code Chapter 85 - District Courts; Jurisdiction	Book Page 320
28 USC 1331 - Federal Question	Book Page 320
28 USC 1332(a) - Diversity	Book Page 321
Personal jurisdiction	Book Page 321
Personal jurisdiction of a parent company	Book Page 321

Personal jurisdiction based upon government contacts	Book Page 322
Specific Jurisdiction	Book Page 322
Attorney client and work product privileges	Book Page 323
28 USC 1338 - Patents	Book Page 327
"No State court shall have jurisdiction"	Book Page 328
"federal jurisdiction over a state law claim"	Book Page 331
Inherent power to grant a stay	Book Page 332
Reasons to grant a stay	Book Page 333
Court stay - concurrent reexamination proceeding	Book Page 333
Court stay - "relationship between reexamination and litigation" ...	Book Page 334
Court stay - interference proceeding	Book Page 334
Court stay - PTAB AIA proceeding (IPR, PGR)	Book Page 335
Court stay - test based upon PTAB AIA proceeding	Book Page 335
Court stay - first factor, stage of proceedings	Book Page 336
Court stay - second factor, simplification of issues	Book Page 337
Court stay - third factor, prejudice and disadvantage	Book Page 337
Court stay - four factors for determining prejudice and disadvantage	
.....	Book Page 338
Court stay - prejudice and disadvantage, timing	
of the inter partes petitions	Book Page 338
Court stay - prejudice and disadvantage, timing of stay	
request versus status of PTAB proceeding	Book Page 338
Court stay - prejudice and disadvantage, relationship of the parties	
.....	Book Page 339
Court stay - prejudice and disadvantage, stay of	
some patents but not others	Book Page 339
Court stay - prejudice and disadvantage, assignor estoppel	Book Page 340
Plaintiff proceeding only on claims for which IPR were denied	Book Page 341
Waiver of arguments	Book Page 341
Citation of non-precedential opinions	Book Page 343
28 USC 1361 - Action to compel an officer	Book Page 346
Mandamus	Book Page 346
28 USC 1367 - Supplemental jurisdiction	Book Page 347
Foreign patent claims	Book Page 348
Treaties	Book Page 348
Paris convention	Book Page 349
PCT	Book Page 349
WTO	Book Page 349
28 USC 1391 - Venue generally	Book Page 351
28 USC 1391(a)	Book Page 351
28 USC 1391(b)	Book Page 351
28 USC 1391(e)	Book Page 352
Not applicable to personal jurisdiction under 35 USC 146	Book Page 353
28 U.S. Code Chapter 87 - DISTRICT COURTS; VENUE	Book Page 353

28 USC 1400 - Patents and copyrights, mask works, and designs	Book Page 353
28 USC 1400(a) - Venue for a civil actions for copyrights, mask works, designs	Book Page 355
28 USC 1400(b) - Venue for a "civil action for patent infringement"	Book Page 355
1400(b) "resides" - State of Incorporation and principle place of business	Book Page 355
Venue for alien defendants controlled by 1391(d)	Book Page 356
28 USC 1400(b) "where the defendant has committed acts of infringement"	Book Page 357
28 USC 1400(b) "regular and established place of business"	Book Page 358
28 USC 1400(b) "place"	Book Page 358
Registered foreign corporation and agent not relevant	Book Page 359
Subsidiary corporation's place not imputed to parent	Book Page 359
28 USC 1400(b) "regular"	Book Page 360
28 USC 1400(b) "established"	Book Page 360
28 USC 1400(b) "defendant has ... place of business"	Book Page 361
Location of employees	Book Page 361
Defendant's representations regarding place of business	Book Page 362
Nature and activity of alleged place of business	Book Page 362
28 USC 1404(a)	Book Page 362
Burden of proof	Book Page 362
Transfer, private factors	Book Page 363
Transfer, public factors	Book Page 363
Transfer, declaratory judgement	Book Page 364
Transfer, first filer rule	Book Page 365
Transfer, first filer rule, CAFC	Book Page 365
Transfer, first filer rule, Ninth Circuit	Book Page 365
Transfer, patent cases	Book Page 366
Transfer factors, Ninth Circuit	Book Page 367
Transfer factors, Fourth Circuit	Book Page 368
Transfer factors, Ed. Va.	Book Page 368
Transfer factors, Ed. Va., plaintiff choice of forum	Book Page 368
Transfer factors, Ed. Va., convenience of parties	Book Page 369
Transfer factors, Ed. Va., convenience of witnesses	Book Page 369
Transfer factors, Ed. Va., interest of justice	Book Page 370
Transfer factors, Ed. Va., interest of justice, related actions	Book Page 371
Transfer factors, Ed. Va., interest of justice, docket congestion	Book Page 371
Transfer factors, Ed. Va., interest of justice, First-to-File Rule	Book Page 371
Transfer factors, Ed. Va., contingent on severing claims	Book Page 372
Exceptions to the first to file rule	Book Page 373
Transfer does not cure lack of personal jurisdiction at time of suit	Book Page 374
Transfer to a could-have-sued jurisdiction, retains jurisdiction	Book Page 374

District Court case familiarity	Book Page 375
3rd Circuit mandamus Transfer Law	Book Page 375
28 USC 1406 - Cure or waiver of defects	Book Page 376
28 USC 1406(a) - Dismissal when venue is improper	Book Page 376
Burden of proof, dismissal for improper venue	Book Page 376
28 USC 1406(a) - Transfer when venue is improper	Book Page 377
28 USC 1407 - Multidistrict litigation	Book Page 378
28 USC 1446 - Procedure for removal of civil actions	Book Page 379
28 USC 1446(b) - Requirements; Generally	Book Page 379
28 USC 1446(b)(1)	Book Page 379
E.D. Va. Transfer Law	Book Page 380
28 USC 1447 - Procedure after removal generally	Book Page 380
28 USC 1447(d)	Book Page 380
28 USC 1447(d) Exceptions	Book Page 382
28 USC 1491 - Claims against United States generally	Book Page 383
Court of Federal Claims lacks DJ and injunctive relief jurisdiction .	Book Page 383
Jurisdictional test - "acting on behalf of the government"	Book Page 384
28 USC 1498	Book Page 384
1498(a) - Patent used or manufactured by or for the United States ..	Book Page 384
No private liability for infringement by the US Government	Book Page 384
1498(a) not limited to direct infringement	Book Page 385
1498(a) liability linked to the scope of the patent holder's rights ...	Book Page 386
28 USC 1631	Book Page 387
28 USC 1631 - Transfer to cure want of jurisdiction	Book Page 387
28 USC 1651 - Writs	Book Page 387
Writ of Mandamus	Book Page 388
Supreme Court has discretion to entertain	
bypass mandamus petitions	Book Page 389
28 USC 1661 - Transfer to cure lack of subject matter jurisdiction	Book Page 390
28 USC 1927 - Counsel's liability for excessive costs	Book Page 391
Stay order effectively denying a motion	Book Page 391
Permanent loss of ability to appeal	Book Page 391
Contempt Order not subject to interlocutory appeal	Book Page 392
Pendant appellate jurisdiction	Book Page 392
Review of subject matter jurisdiction	Book Page 393
Mandate	Book Page 394
Due process	Book Page 394
28 USC 2201- Declaratory Judgement	Book Page 394
28 USC 2202 - Further Relief	Book Page 395
Declaratory judgement jurisdiction	Book Page 395
DJ case or controversy requirement	Book Page 395
DJ jurisdiction is a question of law	Book Page 396
DJ jurisdiction evaluated claim-by-claim	Book Page 396
DJ action does not shift substantive burdens	Book Page 397

Burden of proving infringement is a substantive burden	Book Page 397
Immediacy factor	Book Page 398
Reality factor	Book Page 399
Patentee assertion test	Book Page 400
Patentee actions showing intent to enforce a patent	Book Page 401
Purpose of DJ act	Book Page 402
Definite and concrete dispute requirement	Book Page 402
Conducts of patentee and asserted infringer test	Book Page 403
DJ plaintiff actions showing real and immediate	Book Page 403
DJ specific jurisdiction requirements	Book Page 404
Activities in the forum state	Book Page 404
Relationship of activities to enforcement	Book Page 404
Exercise of specific personal jurisdiction	
must be reasonable and fair	Book Page 405
DJ jurisdiction for a licensor challenge	Book Page 406
License termination is not required	Book Page 406
Withholding payment not required	Book Page 406
Promise not to challenge validity	Book Page 406
DJ jurisdiction not a merits determination	Book Page 407
Courts have discretion to dismiss DJ claims	Book Page 407
Covenant not to sue may remove DJ jurisdiction	Book Page 408
Requirement for FDA approval of ANDA provides DJ jurisdiction .	Book Page 408
VII. United States Code Title 35 (Patent Law)	Book Page 410
35 USC 2, Powers and Duties	Book Page 410
Must execute legislative directive	Book Page 410
MPEP entitled to judicial notice as the	
agency's official interpretation	Book Page 410
Issuance of allowed applications	Book Page 411
Issuance of applications involved in ongoing proceedings	Book Page 411
"discretion to issue a patent to a winning party in an interference" .	Book Page 411
Grant and denial of petitions	Book Page 413
Office Policy to Issue Valid Patents	Book Page 413
Presumption of regularity of administrative proceedings	Book Page 413
Authority to require a terminal disclaimer, 37 CFR 1.321	Book Page 414
Application ownership disputes	Book Page 414
35 USC 2(b)(D) - Regulation of Attorneys and Agents	Book Page 415
Federal preemption of practitioner right to practice	Book Page 415
The Federal Circuit has appellate jurisdiction	Book Page 415
37 CFR PART 11- Representation of Others Before the	
United States Patent and Trademark Office	Book Page 416
Filing for a party that lacks standing is improper	Book Page 416
Referrals by a non-practitioner third party	Book Page 417
Duty to know that client has consented to liaison or agent	Book Page 419
No authority to stay reexamination pending outcome of	

district court validity determination	Book Page 419
35 USC 3 - Officers and Employees	Book Page 419
35 USC 3(a) Under Secretary and Director	Book Page 420
35 USC 3(b) - (b) Officers and Employees of the Office	Book Page 420
Prosecution laches	Book Page 420
Even the courts recognize delay in the PTO	Book Page 424
35 USC 6 Patent Trial and Appeal Board	Book Page 424
35 USC 6(a) - In General	Book Page 424
Binding precedent for the Board	Book Page 425
35 USC 6(b) - Duties	Book Page 425
Requirement to review examine all claims presented - multiplicity ..	Book Page 426
35 USC 6(c) - Panels	Book Page 426
37 CFR 1.2	Book Page 427
35 USC 21 Filing date and day for taking action	Book Page 427
35 USC 23 -Testimony in Patent and Trademark Office cases	Book Page 427
35 USC 24 Subpoenas, witnesses	Book Page 428
"contested cases"	Book Page 428
35 USC 25 Declaration in lieu of oath	Book Page 429
35 USC 26 Effect of defective execution	Book Page 430
35 USC 27 Revival of applications; reinstatement of reexamination proceedings	Book Page 430
35 USC 32 Suspension or exclusion from practice	Book Page 430
"attorney-client relationship"	Book Page 430
Jurisdiction for judicial review of action under 35 USC 32	Book Page 432
35 USC 32 does not preempt state regulation	Book Page 433
Conflicts of interest, Ethical duties to clients	Book Page 433
Disqualification	Book Page 433
"knowledge of the likelihood" of license or suit	Book Page 433
"subject matter conflicts"	Book Page 434
Terms of engagement agreement	Book Page 434
"claim shaving,"	Book Page 434
"reasonably anticipated" need for an opinion	Book Page 435
Jurisdiction over petition or motion to disqualify	Book Page 435
Burden of proof to disqualify counsel	Book Page 436
Former attorney representing adverse party	Book Page 436
Attorney Expert Witness Conflicts of Interest	Book Page 436
Meaning of "substantially related"	Book Page 437
Court will not scour the record for supporting evidence	Book Page 437
Effect of listing all firm attorneys in a power of attorney	Book Page 437
PTAB determinations of credibility	Book Page 437
"presumed that the confidences were shared "	Book Page 438
Ethical obligations of attorneys representing the Government	Book Page 438
Applicable code of professional responsibility in the USPTO	Book Page 439
Privity and Personal Jurisdiction over patent prosecutors	Book Page 439

35 USC 33	Book Page 440
35 USC 41 Patent fees; patent and trademark search systems	Book Page 441
35 USC 41(c)(2) Effect on Rights of Others	Book Page 442
Intentional delay	Book Page 444
35 USC 100 - Definitions	Book Page 446
35 USC 100(f) - Inventor (applicable to post AIA cases)	Book Page 446
35 USC 100(g) - Joint Inventor (applicable to post AIA cases)	Book Page 446
35 USC 100(h) - Joint Research Agreement (applicable to post AIA cases) .	Book Page 446
35 USC 100(i) - Effective Filing Date (applicable to post AIA cases)	Book Page 447
35 USC 100(j) - claimed invention (applicable to post AIA cases)	Book Page 447
35 USC 101 Inventions patentable	Book Page 448
<u>Diehr, Benson, and Flook</u>	Book Page 448
<u>Bilski v. Kappos</u>	Book Page 449
"machine-or-transformation test is not the sole test"	Book Page 449
Machine prong	Book Page 450
Transformation prong	Book Page 450
<u>Mayo v. Prometheus</u>	Book Page 450
"naturally occurring DNA segment"	Book Page 452
"patentability of DNA"	Book Page 452
"claims ... focus on the genetic information"	Book Page 452
"cDNA"	Book Page 453
<u>Alice v CLS Bank, Int'l</u>	Book Page 453
Holding in <u>Alice</u>	Book Page 453
Implicit exceptions to eligibility	Book Page 453
Policy concern - preemption	Book Page 454
Absence of preemption	Book Page 454
Obviousness and anticipation are	
distinct from subject matter eligibility	Book Page 454
Two-step test	Book Page 455
<u>Alice</u> step 1, abstract ideas category	Book Page 455
Application of step 1 of two-step test	Book Page 457
By the Supreme Court	Book Page 457
By the CAFC	Book Page 458
Decisional process	Book Page 458
Specification relevant in both <u>Alice</u> / <u>Mayo</u> steps	Book Page 458
Comparison of claims at issue to prior 101 decisions	Book Page 459
Unconventional technological solution to a technological problem ..	Book Page 459
Collecting, analyzing, and displaying data	Book Page 459
Computer implementing non computerized activity	Book Page 460
Purely functional claiming	Book Page 461
A user interface is an abstract idea	Book Page 462
Providing out-of-region access is an abstract idea	Book Page 462
"Configuring the memory system based on the type of processor connected to the	
memory system" is not an abstract idea	Book Page 462

New and useful method of preserving hepatocyte cells is not an abstract idea	Book Page 463
Incorporation of novel claimed rules allowing automation of further tasks, is not an abstract idea	Book Page 464
Claimed programming details might be material	Book Page 465
Classifying an image and storing the image based on its classification are an abstract idea	Book Page 465
Conventional data capture and computer storage are abstract	Book Page 466
Addition of merely novel or non-routine components is a factor to be considered only in Alice/Mayo step 2	Book Page 466
The claimed method of conducting a wagering game is an abstract idea	Book Page 467
Alice step 2, inventive concept sufficient to transform	Book Page 467
Application of step 2 of two-step test	Book Page 470
By the Supreme Court	Book Page 470
By the CAFC	Book Page 471
Patent eligibility reviewed de novo	Book Page 476
General considerations for 101 analysis	Book Page 477
CLS Bank two step process for analysis	Book Page 478
Abstractness analysis	Book Page 478
DDR Holdings Internet problem, Internet solution analysis	Book Page 479
Analysis based upon similarity to method claim	Book Page 480
Analysis based upon reference to specification	Book Page 481
Analysis by comparison to earlier CAFC cases	Book Page 482
“computer-aided”	Book Page 482
"treat claim 2 as a process claim"	Book Page 483
"signals, standing alone"	Book Page 484
"machine-readable storage medium"	Book Page 484
"purely mental steps"	Book Page 484
Step of "informing the patient"	Book Page 484
"depend entirely on the use of mental processes"	Book Page 485
Printed matter exception	Book Page 485
"operativeness is a prerequisite to validity"	Book Page 486
"could obviously be made operative"	Book Page 486
"product and a process to be separately claimed"	Book Page 486
Utility	Book Page 487
Utility of chemical compounds	Book Page 488
Effect of utility disclosed in specification	Book Page 488
Utility of products	Book Page 489
Utility of Database Structures	Book Page 489
Utility of method claims reciting structure	Book Page 489
Plants constitute patentable subject matter	Book Page 490
Same invention double patenting	Book Page 490
Non-statutory double patenting	Book Page 491

Basis for judicial rule against double patenting	Book Page 491
Question of law	Book Page 491
Obviousness-Type Double Patenting	Book Page 492
One-way versus tw-way test for OTDP	Book Page 492
Secondary indicia evidence in obviousness-type double patenting ...	Book Page 494
"two-way test"	Book Page 495
between design and utility patents	Book Page 495
"applications were never commonly owned"	Book Page 495
"disclosure must not be used as prior art"	Book Page 496
Later developed alternative process	Book Page 496
"focus on the earlier claimed compound"	Book Page 497
Method claim to a disclosed utility in a prior patent	Book Page 498
35 USC 102 Conditions for patentability; novelty	Book Page 498
Burden of proof for rejection	Book Page 499
Anticipation	Book Page 499
Single reference requirement	Book Page 499
"in the same form and order as in the claim"	Book Page 499
"arranged or combined in the same way as in the claim"	Book Page 500
"ambiguous references do not, as a matter of law, anticipate"	Book Page 500
Anticipation requires operability	Book Page 500
"‘at once envisage’ the claimed arrangement or combination"	Book Page 500
"limited number of specific preferences from a specifically defined group"	Book Page 501
printed publications of new plant varieties	Book Page 503
Proportions based upon patent drawings	Book Page 503
Enablement of claimed plant variety, based upon foreign sale	Book Page 506
Ambiguous teaching does not support anticipation rejection	Book Page 507
Burden of Proof	Book Page 507
Availability of a reference as prior art	Book Page 507
Abandoned experiment is not prior art	Book Page 508
"bound by the statements ... in his declaration to the PTO"	Book Page 508
Estoppel based upon admission of prior art	Book Page 509
Judicial Estoppel	Book Page 511
Quasi-Estoppel and Judicial Estoppel Respecting Patentability	Book Page 512
35 USC 102(a)	Book Page 515
“knowledge and use by a single person”	Book Page 516
Inherency	Book Page 516
Inherency of product based upon similar prior art process	Book Page 519
Interferent's burden to show lack of inherent support	Book Page 519
35 USC 102(b)	Book Page 520
Statutory bar events - 102(b) availability	Book Page 520
Pfaff v. Wells	Book Page 520
Offer for sale prior to when invention ready for patenting	Book Page 520
Requirements for a printed publication to be available prior art	Book Page 521

Non enabling reference does not anticipate	Book Page 527
Anticipation and incorporation by reference	Book Page 527
Incorporation test	Book Page 527
PHOSITA ability to deduce what a host document aims to incorporate	Book Page 527
"detailed particularity, clearly indicating the specific material for incorporation"	Book Page 528
"clearly indicate where that material is found in the various documents"	Book Page 529
Incorporation is a question of law	Book Page 530
Statutory bar events	Book Page 530
Public use	Book Page 531
Public use is a question of law	Book Page 531
definition of public use	Book Page 532
totality of the circumstances test	Book Page 533
Proof necessary show a prior public use	Book Page 534
Available as prior art against third parties	Book Page 534
public use policies	Book Page 534
"public did not see the inner workings"	Book Page 535
Public use applied to software	Book Page 535
On sale Bar	Book Page 535
Question of law	Book Page 535
"secrecy, or legal monopoly"	Book Page 536
"on which the invention was ready for patenting"	Book Page 537
"license to practice" process did not trigger the on-sale bar ..	Book Page 537
"exempting licenses under a patent from the on-sale bar" ...	Book Page 538
Offer for sale	Book Page 539
Offer for sale "in the United States"	Book Page 540
"within the United States"	Book Page 541
FOB shipping does not define locus of sale	Book Page 542
"what was offered for sale"	Book Page 542
"generating interest in a potential infringing product"	Book Page 543
"directed to a consumer in the United States"	Book Page 543
Definition of experimental use	Book Page 543
Experimental use is an exception to a 102(b) bar	Book Page 544
Experimental use is a question of law	Book Page 544
Factors involved in determining if use is experimental	Book Page 545
Averments in request for FDA approval	Book Page 545
Experimental use and reduction to practice	Book Page 545
Testing required to show	Book Page 546
Experimental use exception to on sale bar	Book Page 546
Experimental use exception to 102(b) bar limited to the inventors	Book Page 547
Control and customer awareness factors	Book Page 547

Enumerated objective experimental use factors	Book Page 547
35 USC 102(c)	Book Page 548
35 USC 102(d)	Book Page 549
"patented" means "a formal bestowal of patent rights"	Book Page 550
"when the patentee's rights under the patent become fixed"	Book Page 550
"not prior art provisions"	Book Page 551
German design right is 102(d) bar	Book Page 552
120 benefit avoids 102(d) bar	Book Page 552
35 USC 102(e)	Book Page 552
35 USC 102(e) date is not a Foreign Priority date	Book Page 553
The 35 USC 102(e) date based upon a provisional application	Book Page 554
The 102(e) date of a CIP application	Book Page 555
"application disclosing the patentable invention"	Book Page 556
Pre 11/29/2000 PCT applications	Book Page 560
35 USC 102(f)	Book Page 560
Requirement to actually have invented the subject matter claimed ..	Book Page 560
"§ 102(f) is a prior art provision for purposes of § 103"	Book Page 561
Burden of proof of derivation	Book Page 561
"admissible for the purpose of the derivation issue"	Book Page 562
derivation is an issue of fact	Book Page 562
"standard for finding communication"	Book Page 563
Derivation may be from a third party	Book Page 563
Burden of proof of derivation from the third party	Book Page 564
"difficult to understand why additional discovery is needed"	Book Page 564
35 USC 102(g)	Book Page 564
Conception	Book Page 565
Proof of conception of a count	Book Page 566
Proof of conception of claims	Book Page 567
Proof of appreciation	Book Page 568
Conception in the United States	Book Page 570
Conception of a species	Book Page 571
Originality	Book Page 571
Originality - identical benefit dates	Book Page 572
Diligence	Book Page 573
Diligence for activities outside the United States	Book Page 577
Attorney Diligence	Book Page 577
"excuses for inactivity"	Book Page 578
"spurring"	Book Page 580
Reduction to practice (RTP)	Book Page 580
RTP is a question of law	Book Page 580
Actual reduction to practice (ARTP) requirements	Book Page 581
ARTP requirement (1), must embody all limitations of the count ...	Book Page 581
ARTP requirement (2), must know invention works for its intended purpose	
.....	Book Page 582

ARTP requirement (2), testing showing invention	Book Page 582
ARTP requirement (2), testing must show invention worked beyond a probability of failure	Book Page 582
ARTP requirement (2), requires appreciation of a utility (intended purpose)	Book Page 582
ARTP (2) requires showing of a utility (intended purpose)	Book Page 583
ARTP requirement (2), what constitutes sufficient testing	Book Page 583
ARTP requirement (2), what constitutes sufficient testing, principles	Book Page 583
ARTP requirement (2), showing solution to the problem intended to be solved	Book Page 584
ARTP requirement (2), intended purpose defined by counts and specifications	Book Page 584
Constructive reduction to practice (CRTP)	Book Page 585
CRTP, abandoned application	Book Page 585
Requirement for corroboration	Book Page 585
Corroboration of conception	Book Page 586
Corroboration of a reduction to practice	Book Page 587
Corroboration of a public use	Book Page 589
Question of law	Book Page 591
Reduction to practice may be by the inventor's agent	Book Page 591
Inurement	Book Page 591
"uncommunicated recognition"	Book Page 592
Senior and junior party status, effective and actual filing dates	Book Page 593
Actual reduction to practice	Book Page 593
Testing	Book Page 594
Actual reduction to practice "in the United States"	Book Page 596
Indicia of an actual reduction to practice	Book Page 597
The requirements for antedating a reference - 37 CFR 1.131	Book Page 597
Possession of obvious variations	Book Page 598
Right to make a claim	Book Page 599
Incompetence of inventor's priority testimony	Book Page 599
Prima facie date of invention	Book Page 600
35 USC 102(g)/35 USC 103	Book Page 603
All inventions in the United States qualify as prior art	Book Page 604
constructive reduction to practice	Book Page 605
Same standard for foreign and domestic priority claims	Book Page 607
Constructive reduction to practice proves conception	Book Page 608
Publication is not constructive reduction to practice	Book Page 609
Possession of the invention	Book Page 609
Abandonment, Suppression or concealment	Book Page 610
Burden of proof on abandonment, suppression, or concealment	Book Page 612
Abandonment versus concealment	Book Page 612
"abandonment of work on"	Book Page 613

"abandonment of that constructive reduction to practice"	Book Page 613
Suppression or concealment of the invention	Book Page 614
Abandonment applied as a defense in infringement litigation	Book Page 620
Effect of renewed activity after suppression or concealment	Book Page 620
35 USC 102 Design patent anticipation	Book Page 621
The ordinary observer test is the sole test for anticipation	Book Page 621
The ordinary observer test	Book Page 622
"identical in all material respects"	Book Page 622
35 USC 103 (Pre AIA)	Book Page 623
35 USC 103 (AIA)	Book Page 623
<u>Graham v. John Deere Co.</u>	Book Page 623
<u>KSR Intern. Co. v. Teleflex Inc.</u>	Book Page 623
"question of law based on underlying findings of fact"	Book Page 626
Substantial evidence	Book Page 626
Reasonable mind test	Book Page 626
Finding of fact based upon substantial evidence	Book Page 626
What a reasonable mind might accept as adequate	Book Page 627
Foundational substantial evidence case law	Book Page 628
Board's factual findings reviewed for substantial evidence ...	Book Page 629
Factual findings resting on an incorrect claim construction ..	Book Page 629
Motivation to combine is a question of fact	Book Page 630
"problem was not known"	Book Page 630
"common knowledge and common sense"	Book Page 630
Common sense - missing limitation	Book Page 631
missing limitation - heart-of-invention	Book Page 632
No motivation include heart-of-invention	Book Page 632
Board's conclusory statement not	
consistent with the evidence	Book Page 632
"adapting a new technology to an existing system"	Book Page 633
<u>O'Farrell 1</u> : obvious to "vary all parameters or try each of	
numerous possible choices"	Book Page 635
<u>O'Farrell 2</u> : obvious "field of experimentation, where the prior art	gave only
general guidance"	Book Page 636
Need for <u>Graham</u> findings	Book Page 637
Level of skill of one of ordinary skill in the art	Book Page 637
Question of fact	Book Page 637
"Factors that may be considered"	Book Page 638
"educational level of the inventor"	Book Page 639
"determined by appeal to the references of record"	Book Page 640
"background of the witnesses who testified at trial"	Book Page 640
"sources for a motivation to combine"	Book Page 640
Prima facie obviousness	Book Page 641
Prima facie obviousness - definition	Book Page 641
USPTO has the initial burden of production in examination .	Book Page 641

"very large number of possible distinct compositions"	Book Page 642
"optimum value within a narrow disclosed range"	Book Page 643
"not supported by substantial evidence"	Book Page 643
"reasonable expectation of success"	Book Page 644
"organization of information and its interrelationships"	Book Page 647
"matter is not functionally related"	Book Page 647
"mere size is not ordinarily a matter of invention"	Book Page 648
"range or other variable within the claims"	Book Page 649
"analogous prior art"	Book Page 649
"analogous art presents an issue of fact"	Book Page 649
"reference must qualify as "'analogous art,'"	Book Page 649
"(1) whether the art is from the same field of endeavor"	Book Page 650
"(1) the reference must be from the same field of endeavor"	Book Page 653
Contrary "Board's opinion ... after ... final judgment"	Book Page 654
"knowledge of all material prior art to be dead"	Book Page 655
Teachings of a reference	Book Page 655
"for everything it <i>teaches</i> "	Book Page 655
"for all that it discloses"	Book Page 656
"fairly teaches in combination with the prior art as a whole"	Book Page 656
teaching away, discouraging	Book Page 657
teaching away, must be commensurate with the claims	Book Page 659
Teaching away distinguished from motivation to combine	Book Page 659
different as opposed to undesirable properties; tradeoffs	Book Page 660
result-effective variables	Book Page 661
Motivation is a question of fact	Book Page 661
"Obviousness is determined from the vantage point of"	Book Page 661
"identification of each claimed element in the prior art"	Book Page 661
"known disadvantages"	Book Page 662
"desirability, and thus the obviousness"	Book Page 662
combination destroys disclosed reference utility	Book Page 662
"make it unsuitable for its intended purpose"	Book Page 663
"consider the invention as a whole"	Book Page 663
"obvious to experiment"	Book Page 664
inferences drawn from a reference	Book Page 664
Integration of parts	Book Page 664
"reasonable expectation of success"	Book Page 664
Procedure for determining existence of	
reasonable expectation of success	Book Page 665
reasonable expectation of success is a question of fact	Book Page 665
Reasonable expectation of success, case examples	Book Page 665
Reasonable expectation of success, evidentiary weight	Book Page 667
Significant weight to contemporaneous statements	Book Page 667
Expectation what results of experiments would show	Book Page 667
Economic factors, motivation	Book Page 668

Prima facie obviousness of a compound requires obvious process to make the compound	Book Page 669
Invention as a whole of a compound includes way to produce the compound	Book Page 669
"must enable a person of ordinary skill to make and use" ...	Book Page 669
Advancement in the art test	Book Page 670
"Lead compound"	Book Page 670
"obvious to experiment" - selective hindsight	Book Page 672
"omission of an element"	Book Page 673
species encompassed within the described genus	Book Page 673
Evidence does not need to be in the specification	Book Page 674
Indefinite claim is not obvious	Book Page 674
"description of a single species"	Book Page 675
Secondary indicia of non-obviousness	Book Page 676
Secondary indicia evidence "must be considered <u>before</u> a conclusion on obviousness"	Book Page 676
Standard of review on nexus determinations	Book Page 677
Patentee burden of production to show nexus	Book Page 677
"prima facie case of nexus"	Book Page 678
Objective evidence need only be reasonably commensurate with the scope of the claims	Book Page 680
Absence of evidence of secondary considerations	Book Page 682
Prior attempts to produce a desired result	Book Page 682
Skepticism of others	Book Page 682
Weight accorded testimony	Book Page 682
Commercial success	Book Page 683
Rationale for relevance of commercial success	Book Page 683
Evidence of commercial success	Book Page 683
Relationship of commercial success to scope of claim	Book Page 683
Effect of blocked market entry on commercial success	Book Page 684
ANDA filing, per se, is not evidence of commercial success	Book Page 685
Effect of blocking patents on commercial success	Book Page 685
Copying	Book Page 686
evidence of efforts to replicate a specific product	Book Page 686
Copying and ANDA showing requirements	Book Page 688
Unexpected results	Book Page 688
Inherent property may be unexpected	Book Page 689
Unpredictability does not require expectation of failure	Book Page 689
Invention made by routine experimentation is not necessarily obvious	Book Page 690
Comparative data showings	Book Page 690
Definition of closest prior art, for comparative data	Book Page 691
"activity ... not ... possessed by a prior art compound"	Book Page 691
Timing of recognition by the inventors	Book Page 692

long felt but unresolved need	Book Page 693
Praise of the invention	Book Page 694
Praise of features not in the prior art	Book Page 694
License	Book Page 695
35 USC 103 Design patent obviousness	Book Page 696
Obviousness of a design patent	Book Page 696
Standard for motivation to modify	Book Page 696
Standard for unpatentability based upon an obvious design ..	Book Page 697
"design must be evaluated as a whole"	Book Page 697
Two step process to evaluate design obviousness	Book Page 698
First step, primary reference requirement	Book Page 698
First step, part 1, discern the correct visual impression	Book Page 698
First step, part 2, primary reference having basically	
the same visual impression	Book Page 699
Expert testimony and design obviousness	Book Page 700
Secondary considerations and design obviousness	Book Page 701
Step 2, other references suggest "a design that has	
the same overall visual appearance as the claimed design" ...	Book Page 701
Motivation must be based upon ornamental features	Book Page 701
Design prior art consideration must focus	
on visual appearance, not use	Book Page 702
Design prior art consideration must focus	
on actual appearances, not design concepts	Book Page 702
Design reference combinations must be based upon	
"specific design characteristics", not design concepts	Book Page 702
35 USC 104 [Repealed.]	Book Page 703
35 USC 104 (pre-AIA) Invention made abroad	Book Page 703
35 USC 111 Application	Book Page 703
35 USC 112 (Pre AIA), Specification	Book Page 704
35 USC 112(a) (AIA), formerly 112, first paragraph	Book Page 704
35 USC 112(a) "a written description of the invention, and of the	
manner and process of making and using it"	Book Page 705
Written description - "possession as shown in the disclosure"	Book Page 705
Written description	Book Page 705
The existence of a written description is a question of fact	Book Page 706
Written description, test for compliance	Book Page 708
Written description test for compliance for interference counts	Book Page 710
Written description, test based solely upon specification	Book Page 711
Written description, obvious errors in the	
specification are correctable	Book Page 712
Written description, definition of continuation application	Book Page 713
Written description, burden of proof for CIP parent filing date	Book Page 713
Written description, features disclosed to	
be undesirable or inferior	Book Page 713

Written description of a genus	Book Page 714
Written description of a species	Book Page 715
Written description, "unfinished invention"	Book Page 715
Written description, relying upon properties	
correlated to a structure limitation	Book Page 716
Functional claiming of genus	Book Page 716
Written description correlated to solutions to problems	Book Page 718
Written description distinct from enablement	Book Page 720
Purpose of written description requirement	Book Page 722
Written description, original claims	Book Page 722
Possession, reduction to practice, and written description	Book Page 725
"person of ordinary skill in the art would have understood"	Book Page 726
Written description support in the figures	Book Page 726
Reasonably conveys to the artisan - Support for the concept	Book Page 727
Characteristics possessed by disclosed formulations	Book Page 728
Ranges	Book Page 728
Disclosure of imprecise range, "about"	Book Page 730
Chemical genus subgenus	Book Page 731
Omitted essential element, written description	Book Page 732
Any part of specification is sufficient	Book Page 733
Incorporation by reference	Book Page 733
Incorporation - benefit and priority	Book Page 733
Incorporation "at the initial filing stage"	Book Page 734
Incorporation where "120 priority is at issue"	Book Page 734
CIP claim is not incorporation by reference	Book Page 735
Identity of incorporation to "reasonable examiner"	Book Page 735
Identity of incorporation to "to a person of ordinary skill"	Book Page 737
Incorporation by reference to a deposit	Book Page 737
Limited incorporation by reference	Book Page 738
"Negative claim limitations"	Book Page 739
Inherency - Inherent disclosure	Book Page 741
Requirements for showing Inherent support for copied claims	Book Page 743
Over breadth	Book Page 744
The enablement requirement	Book Page 744
Question of law	Book Page 744
"presumption that the patent complies with Section 112" ...	Book Page 744
"as of the effective filing date"	Book Page 745
undue experimentation	Book Page 745
Claim breadth - Scope of Claims and Scope of Enablement ..	Book Page 746
Omitted essential element, enablement	Book Page 748
Inoperative embodiments	Book Page 748
obvious limitations	Book Page 748
breadth	Book Page 748
Inability to make commercial product	Book Page 748

manufacturing specification unnecessary	Book Page 749
scope of enablement vis a vis scope of claims	Book Page 749
Undue experimentation	Book Page 750
<u>Wands</u> factors for undue experimentation	Book Page 750
Programming generally deemed enabled	Book Page 752
"may be met by animal tests or in vitro data"	Book Page 752
The best mode requirement	Book Page 753
The best mode test	Book Page 753
35 USC 112 Design patent written description	Book Page 755
Unclaimed boundary lines	Book Page 755
35 USC 112(b) (formerly 112 second paragraph)	Book Page 756
35 USC 112(b) "claims particularly pointing out and distinctly claiming" (Definiteness requirement)	Book Page 756
Functions of claims, define the scope of the patent grant	Book Page 756
Markman v. Westview Instruments	Book Page 756
Function of claims, notify the public of patentee's exclusive right ...	Book Page 757
35 USC 112 - Test for indefiniteness	Book Page 757
Must "inform, with reasonable certainty"	Book Page 757
Nautilus, Inc. v. Biosig Instruments, Inc.	Book Page 757
Definiteness is an issue of law	Book Page 758
"terms of degree" that provide certainty	Book Page 759
subjective claim recitations	Book Page 760
Test and burden of proof to show indefiniteness	Book Page 761
Definiteness of structure claims, essential cooperating elements	Book Page 761
Definiteness relating to use of antecedent basis	Book Page 761
Definiteness of functional language	Book Page 761
Definiteness of means plus function claim recitations	Book Page 763
USPTO definiteness standard for pending claims	Book Page 765
Indefiniteness, circumstantial evidence in the litigation history	Book Page 767
35 USC 112(b) "regards as his invention"	Book Page 767
"regards as his invention" is an issue of law	Book Page 767
"regards" evidence considered for patentability	Book Page 768
35 USC 112(b) claim construction	Book Page 769
Claim recitation "and/or"	Book Page 769
Claim defining a product by process	Book Page 769
Claim defining "separate statutory classes ... in a single claim"	Book Page 770
Definition of a Markush group	Book Page 771
Beauregard claim definition, treatment as method claims	Book Page 772
Claim Interpretation	Book Page 772
Claim construction is an issue of law	Book Page 772
Claim construction subject to <i>stare decisis</i>	Book Page 773
District Court Phillips claim construction standard	Book Page 773
Duty of a District Court to construe claims	Book Page 775
Scope of District Court's duty to construe claims	Book Page 775

Patent claim construction based upon patent, as issued	Book Page 778
Court construction "not bound by arguments of the parties"	Book Page 778
Proffered disclaimer generally only binds the patent owner	Book Page 779
"The claims, the specification, and the prosecution history"	Book Page 779
Claims	Book Page 780
"ordinary and customary meaning"	Book Page 780
"at the time of the invention"	Book Page 780
Weighing claim language meaning against specification	Book Page 784
Claim scope tethered to specification	Book Page 785
"inescapable conclusion that the claimed invention must include" ..	Book Page 786
Disavowal in the specification	Book Page 787
Specification "definition by implication"	Book Page 789
Doctrine of Disclaimer in the Specification	Book Page 789
Phrases consistently used interchangeably	Book Page 789
Use of "the present invention"	Book Page 789
Equating embodiment with the invention	Book Page 790
Disclosed invention viz prosecution claim broadening	Book Page 791
"makes clear that the invention does not include"	Book Page 791
Statement in the written description constituting a limitation	Book Page 792
"what was expressly disclaimed"	Book Page 793
Prosecution history	Book Page 794
Doctrine of prosecution history disclaimer	Book Page 795
Disclaimer must be clear and unmistakable	Book Page 795
scope of surrender is not limited to what is absolutely necessary to avoid a	
prior art reference	Book Page 796
Stipulated claim constructions	Book Page 796
Applicant's unambiguous remarks	Book Page 797
Applicant remarks need not result in allowance	Book Page 798
Arguments made during IPR proceedings may effect disclaimer	Book Page 798
Examiner unilateral statements	Book Page 799
Recision of disclaimer	Book Page 799
Extrinsic evidence	Book Page 800
PTAB proceeding evidence	Book Page 801
Patent changes relative to its benefit provisional application	Book Page 801
Combination of what was invented and what is claimed	Book Page 801
Claim construction procedure	Book Page 802
"terms that are recited inferentially"	Book Page 803
"two elements cannot be one and the same"	Book Page 803
Functional recitations	Book Page 803
Claim construction during examination in the USPTO	Book Page 804
"inferential limitation"	Book Page 805
"remarks made by the examiner during reexamination"	Book Page 806
35 USC 112 - USPTO Broadest Reasonable Construction	Book Page 807
Claim construction not unreasonably broad	Book Page 807

Claim construction unreasonably broad	Book Page 808
“process terms in product-by-process claims” limit infringement ...	Book Page 808
Composition claim limited by claimed property	Book Page 808
"alternative elements ...may be explicitly excluded in the claims" ...	Book Page 809
Dictionary definitions subservient to the specification	Book Page 809
"construed to encompass all consistent [dictionary] meanings"	Book Page 810
Dictionary definitions may be consulted before written description .	Book Page 811
Claims construed based upon related prosecution	Book Page 812
construed to read on the preferred embodiments	Book Page 813
"not necessary that each claim read on every embodiment"	Book Page 813
Product-by-process claims	Book Page 814
Specific claim recitations	Book Page 814
Transitional phrases	Book Page 814
"comprising"	Book Page 814
"comprised of"	Book Page 815
"consisting of"	Book Page 815
Claim recitation “consisting of” or “consists of” presumption	Book Page 816
"consisting essentially of"	Book Page 817
"claims which define or delimit the scope of the legal protection" ...	Book Page 818
"indefinite article ‘a’ or ‘an’ in patent parlance"	Book Page 819
Dependence of meaning of "a" upon context	Book Page 821
“a statistical analysis request corresponding to	
two or more selected investments”	Book Page 821
"a [thing] ... for ... [A and B]"	Book Page 822
"and"	Book Page 822
"assembl[ing] said video and audio components into	
an MPEG stream	Book Page 823
"user information", password and its hash	Book Page 823
Words directed to a plurality: "allocate" and "priority"	Book Page 824
Limitations from specification not read into claims	Book Page 824
Domination and patentable distinctness	Book Page 827
Interpretation based upon Abstract	Book Page 827
Claim Differentiation	Book Page 827
Limitations on claim differentiation	Book Page 828
Interpreted normally to read on embodiments	Book Page 830
Same recitation in different claims	Book Page 831
Different constructions for claims to different embodiments	Book Page 831
Must be consistent with the specification	Book Page 832
Direct contrasts may limit claims	Book Page 832
"the patentee used the two terms interchangeably"	Book Page 833
Specification describes the preferred embodiment as the invention ..	Book Page 833
"different terms in the claims connotes different meanings”	Book Page 833
"facially nonsensical 'cannot be correct.'"	Book Page 834
“giving effect to all terms in the claim”	Book Page 834

Addition of limitation upon application of a construed claim	Book Page 835
Construction must be consistent with parties agreement at trial	Book Page 835
Numeric limitations inherent to the improvement	Book Page 836
Recitation "at least one"	Book Page 836
Recitation "about", "approximately," in ranges	Book Page 837
Recitation "about", precision	Book Page 838
Recitation "whereby"	Book Page 839
Recitation "wherein"	Book Page 839
Recitation of probabilistic suffix "able" (obtainable)	Book Page 839
Recitation "creating a database of..."	Book Page 840
Recitation "only if"	Book Page 840
Recitation "mechanism"	Book Page 841
Recitations "adapted to" and "configured to"	Book Page 841
Recitation "configured to"	Book Page 842
Recitations "operable to" and "capable of"	Book Page 843
Capable of being mounted, versus "mountable"	Book Page 843
Recitation "adjustment"	Book Page 844
Recitation "or otherwise"	Book Page 845
Recitation "effective amount"	Book Page 845
Recitation "not interfering substantially"	Book Page 845
Recitation "in an unobtrusive manner that does not distract a user"	Book Page 846
Recitation "aesthetically pleasing"	Book Page 846
Recitation "arranged to engage"	Book Page 846
Method of treatment of a disease	Book Page 847
Method steps subject to a condition precedent	Book Page 848
Apparatus claim element "not removed ... prior to"	Book Page 848
Non functional use recitations in apparatus claims	Book Page 849
Courts shall not rewrite claims to preserve validity	Book Page 850
Summary of the invention may limit claims	Book Page 851
Related prosecution after the patent issued	Book Page 852
Summary of the invention may limit claims	Book Page 853
Examiner's claim construction not refuted by the applicant	Book Page 854
Only Ambiguous claim construed to preserve validity	Book Page 854
Claim construction cannot change following close of jury trial	Book Page 855
Claim construction left to jury stands, not challengable by JMOL ..	Book Page 855
Indefiniteness is a question of law	Book Page 856
Validity of indefinite claim	Book Page 856
35 USC 112 Design patent claim construction	Book Page 857
Disclaimer of broken lines and rule 1.152	Book Page 857
prosecution history estoppel applies to design patents	Book Page 857
Features canceled from application claims	Book Page 857
Discounting functional features	Book Page 858
Courts role in claim construction	Book Page 859

35 USC 112(d), formerly 112, Fourth Paragraph	Book Page 860
35 USC 112(f), formerly 112, 6th, means plus function (MPF)	Book Page 862
MPF: determination function and structure is a matter of law	Book Page 862
MPF: Infringement analysis	Book Page 862
MPF: whether a claim limitation is MPF	Book Page 863
MPF determination reviewed without deference	Book Page 863
Recitation including "means" raises a presumption	Book Page 864
Recitation lacking "means"; no heightened burden	Book Page 864
MPF construction: two-step process	Book Page 868
MPF: requirement to construe "limitation as a whole"	Book Page 869
MPF: recitation "circuit"	Book Page 869
MPF: adjectival qualification further narrows claimed structure ...	Book Page 870
MPF: specification must link structure to function	Book Page 870
MPF: examples of determinations	Book Page 871
MPF: applies in PTO and Courts	Book Page 872
MPF: procedure for construing a claim recitation	Book Page 872
MPF: "bare use of the term 'means'"	Book Page 873
MPF: recitation "means" not necessarily MPF	Book Page 873
MPF: "means" followed by recitation of structure	Book Page 874
MPF: means having plural functions	Book Page 875
MPF: algorithms implemented in computer code	Book Page 875
MPF: recitation "memory for storing"	Book Page 876
MPF: abstraction that describes the function is not structure	Book Page 876
MPF: insufficient structure disclosed to perform function	Book Page 877
MPF: limited to recitations containing insufficient structure	Book Page 878
MPF: means being a general purpose computer	Book Page 878
MPF: disclosure must link structure and function	Book Page 881
MPF: sufficiency of disclosure based upon PHOSITA	Book Page 881
MPF: equivalent must have been available when claim issued	Book Page 882
MPF: DOE and MPF means analysis for known means	Book Page 883
MPF: construction not limited by prior art	Book Page 883
MPF: and incorporation by reference of prior art means	Book Page 884
MPF: test for structural equivalents to disclosed means	Book Page 884
MPF: distinguished from DOE	Book Page 884
MPF: admissibility of extrinsic evidence in construction	Book Page 886
step plus function (SPF)	Book Page 886
Structural limitations in method claims	Book Page 890
Claim scope not limited to disclosed preferred embodiments	Book Page 890
Linguistic construction: recited but unclaimed element	Book Page 891
Recitation "essentially consisting of"	Book Page 891
Specification may define meaning of a claim transitional phrase	Book Page 892
Recitation "adjacent"	Book Page 893
Recitation "integral"	Book Page 893
Interpreting Relative terms	Book Page 894

Recitation "substantially"	Book Page 894
Recitation "high frequency"	Book Page 894
Recitation "conductive"	Book Page 894
"court may, in its discretion, receive extrinsic evidence"	Book Page 894
Admission of extrinsic evidence	Book Page 896
timing of claim construction in litigation	Book Page 897
Prosecution history estoppel presumption due to amendment	Book Page 897
ambiguous limitations construed narrowly	Book Page 898
Precise definition required for unknown term	Book Page 899
Intended use recitations	Book Page 899
Intended Use Recitations	Book Page 899
Relation to inherency and anticipation	Book Page 899
Preamble	Book Page 900
Determination whether preamble is limiting	Book Page 901
Structure recitations in preamble of method claim	Book Page 903
Adjectives describing a class may be a structural limitation ..	Book Page 903
Estoppel with respect to interviews	Book Page 903
Switching Claim Construction on Appeal - Improper	Book Page 904
Scope of copied claims	Book Page 904
<u>Agilent</u> applies only to construction, not support	Book Page 907
Based upon file history and interference history	Book Page 908
Prosecution history includes interference proceedings	Book Page 909
"applicants' burden to precisely define the invention"	Book Page 909
The regards requirement	Book Page 909
"beyond that which applicant regards as his invention'"	Book Page 909
The definiteness requirement	Book Page 910
The recitation "predetermined"	Book Page 913
The recitation "at least about"	Book Page 914
claims incorporating by reference and/or based upon figures	Book Page 914
35 USC 115 Inventor Oath or Declaration	Book Page 917
35 USC 115(f) (AIA)	Book Page 917
35 USC 116 - Inventors	Book Page 917
"requiring lack of deceptive intent"	Book Page 917
Attorney duty to name the correct inventors	Book Page 918
Joint behavior requirement for joint inventorship	Book Page 919
Standing regarding "pending patent applications"	Book Page 919
35 USC 119 - Benefit of earlier filing date; right of priority	Book Page 920
35 USC 119(a)-(d) - Foreign Priority	Book Page 920
"mandatory provision"	Book Page 920
"burden of establishing its entitlement"	Book Page 921
"remedial purpose behind section 251"	Book Page 921
"during the pendency of that U. S. application"	Book Page 921
<u>Justus v. Appenzeller</u> not controlling"	Book Page 922
"119 ... requires that all intermediate applications in a priority chain contain a	

specific reference to the earlier-filed foreign application"	Book Page 922
"under 35 U.S.C. 119, each application in a "chain" of priority applications need	
not have the foreign priority claim"	Book Page 923
"only the first filed application"	Book Page 923
"more than one year" [sic; "twelve months"]	Book Page 925
"corresponding U.S. application"	Book Page 925
weekend/holiday exception	Book Page 925
"not acting on behalf of the U.S. applicant"	Book Page 926
Diversity of Inventorship and benefit	Book Page 927
not used as a reference under section 102(e)	Book Page 927
motion for benefit	Book Page 928
incorporation by reference	Book Page 929
35 USC 119(e)	Book Page 929
Claim to provisional in abandoned application	Book Page 929
PCT Article 8(2)(b)	Book Page 931
35 USC 120 - Benefit of Earlier Date of Filing in the United States	Book Page 932
Priority date is a question of law	Book Page 932
Standard of Review	Book Page 932
Burden of Proof and Persuasion	Book Page 932
112 first paragraph required support for 120 benefit	Book Page 933
Sufficient structure to support MPF recitations	Book Page 933
"compliance with both §§ 119 and 120"	Book Page 934
"this application"	Book Page 935
Test for interpreting a priority claim	Book Page 935
"language suggested by the M.P.E.P. in a contrary manner"	Book Page 936
MPEP 201.11 "such as"	Book Page 936
"similarly entitled"	Book Page 937
Continuation filed on day patent issues	
("filed before the patenting")	Book Page 937
claim "acquires an earlier filing date"	Book Page 938
benefit and best mode	Book Page 938
Requirement for continuity of disclosure	Book Page 940
Statutory interpretation of "same effect" in 35 USC 120	Book Page 940
Definition of a continuation application	Book Page 941
Continuation practice	Book Page 942
Application is a CIP if Original Claims Present New Matter	Book Page 943
"filing of a CIP application to overcome a PTO rejection"	Book Page 943
Priority claim chains	Book Page 944
"specific reference" to a PCT application	Book Page 946
Prosecution history disclaimer of priority	Book Page 947
35 USC 121 - Divisional Applications	Book Page 947
121 does not authorize rejection of a Markush claim	Book Page 947
Restriction of a Markush claim	Book Page 947
Restriction resulting from election of species	Book Page 948

Consonance	Book Page 949
Test for Existence of Restrictable Species (Election of Species)	Book Page 950
Definition of Species, Species Claim, and Generic Claim	Book Page 950
Definition of species, species claim, and genus claims	Book Page 950
Review via Petition, no Appeal	Book Page 951
Prohibition on double patenting	Book Page 951
Doctrine of election of common assignee 37 CFR 1.78(c)	Book Page 954
The requirement to name the first inventor	Book Page 956
Requirement for common ownership	Book Page 957
Standard of review for double patenting rejections	Book Page 960
Restriction and non-statutory double patenting rejections	Book Page 960
Terminal disclaimer - timing of filing	Book Page 961
divisional of a divisional	Book Page 962
the “as a result of” requirement	Book Page 962
plural "non-elected inventions"	Book Page 963
Only entered claims can be restricted	Book Page 964
"clarity and detail to show consonance"	Book Page 964
Requirement for 35 USC 121 immunity	Book Page 966
Withdrawal of restriction requirement	Book Page 968
35 USC 122 - Confidential Status of Applications	Book Page 969
35 USC 123 Micro entity defined	Book Page 969
35 USC 131 - Examination	Book Page 969
Due Process	Book Page 969
No third party right to interfere	Book Page 970
35 USC 132 Notice of rejection; reexamination	Book Page 970
35 USC 133 Time for prosecuting application	Book Page 972
Unavoidable delay standard	Book Page 972
Revival after abandonment	Book Page 973
jurisdiction for judicial review - any district court	Book Page 975
Standard of review of Commissioner's decision	Book Page 975
Client is usually bound by the actions of his attorney	Book Page 978
35 USC 134 - Appeal to the Board of Patent Appeals and Interferences	Book Page 978
Jurisdiction	Book Page 978
Standard of review on appeal of PTAB ex parte decision	Book Page 979
Dependent claim argument requirements	Book Page 981
Standard of review on appeal different than in federal court	Book Page 981
Standard of review on an expired patent	Book Page 982
Provisional non-statutory double patenting rejection	Book Page 983
Burdens of proof in the USPTO	Book Page 984
Issue preclusion due to district court claim interpretation	Book Page 984
Collateral estoppel based upon district court claim construction	Book Page 985
Test for New Grounds for Rejection On Appeal	Book Page 986
Whether a ground is a new ground is appealable	Book Page 991
Belated new argument in a reply brief	Book Page 993

35 USC 135 Derivation proceeding	Book Page 994
"substantive law of derivation of invention" under AIA	Book Page 995
135(a)(2) TIME FOR FILING	Book Page 996
42.405 Content of petition	Book Page 996
42.405(a)(2)	Book Page 997
"at least one claim" must satisfy both 42.405(a)(2)(i) and (ii)	Book Page 997
42.405(a)(2)(i)	Book Page 997
"two-way analysis" applies to a claim of petitioner and any claim of respondent	Book Page 997
42.405(a)(2)(ii)	Book Page 997
"one-way" analysis applies to claim of petitioner and invention disclosed to respondent	Book Page 997
Relying upon a claim as the "invention disclosed to the respondent"	Book Page 998
42.405(b)(2)	Book Page 998
42.405(b)(2) "from an inventor named in the petitioner's application"	Book Page 998
Conception of disclosed invention distinguished from possession ...	Book Page 998
42.405(b)(3)(i)	Book Page 999
one-way test for challenged claims from disclosed invention	Book Page 999
"the derived invention"	Book Page 1000
42.405(b)(2)(ii) and 42.405(3)(i) "P to D and the D to R analysis are not aligned"	Book Page 1000
42.405(c) Sufficiency of showing	Book Page 1000
Substantial evidence	Book Page 1001
35 USC 135 Interferences	Book Page 1001
35 USC 135(a)	Book Page 1001
Standing	Book Page 1001
No interference-in-fact	Book Page 1002
Standard of Review on Appeal of Interference to the Federal Circuit	Book Page 1003
Credibility determinations	Book Page 1003
Priority determinations; construction of count	Book Page 1003
Standard of Review	Book Page 1003
Broadest reasonable interpretation possible	Book Page 1003
37 CFR 41.120 Notice of basis for relief	Book Page 1004
37 CFR 41.121 Motions	Book Page 1004
37 CFR 41.204(a) Priority Statement	Book Page 1004
"embodiment contain every element of the count"	Book Page 1004
corroboration	Book Page 1006
Corroboration of date of document	Book Page 1006
Explanation of evidence	Book Page 1006
joint inventors cannot corroborate	Book Page 1007
"priority to Brennan because of Abbott's inequitable conduct" ...	Book Page 1008

Incorrect inventorship in the preliminary statement	Book Page 1008
Effect of admissions on justification of the assumptions of the APJ	Book Page 1009
Evidence supporting motions	Book Page 1009
Miscellaneous Interference related synthesis	Book Page 1010
Inventorship contests	Book Page 1011
Issue preclusion 35 USC 291 - 135(a)	Book Page 1011
Opinion of the Director	Book Page 1011
Standing in an interference	Book Page 1012
Stay of Interference	Book Page 1012
Subject matter jurisdiction of the Board	Book Page 1012
Due process	Book Page 1014
Confidential information	Book Page 1014
Judgment and final decision	Book Page 1015
CAFC Jurisdiction after request for entry of adverse judgment ...	Book Page 1015
Patentability and priority determinations	Book Page 1016
No presumption of validity in an interference	Book Page 1016
Burden of proof in an interference	Book Page 1016
Burden of proving joint invention	Book Page 1019
Decisions of the primary examiner not binding upon the Board ...	Book Page 1020
Construction of interference rules	Book Page 1020
Privilege in an Interference	Book Page 1021
Discretion of the APJ	Book Page 1022
37 CFR 41.4 Timeliness	Book Page 1025
37 CFR 41.4(a) Extension of time for good cause	Book Page 1025
"good cause" requirement for belated evidence	Book Page 1025
37 CFR 41.4(b) "filing"	Book Page 1026
37 CFR 41.4(b) excusable neglect for late filings	Book Page 1027
37 CFR 41.52 Rehearing	Book Page 1028
Interference-in-fact	Book Page 1029
"standard for determining whether an interference exists"	Book Page 1029
"Board must only compare the parties' claims"	Book Page 1029
Genus and species test	Book Page 1030
Antedating and a right to an interference	Book Page 1030
Interference Summary judgement, burden of proof	Book Page 1031
37 CFR 41.202(d) Requirement to Show	Book Page 1031
good cause standard for supplemental evidence	Book Page 1032
Prima facie showing by the applicant	Book Page 1033
"facially sufficient case"	Book Page 1033
Proof of <u>no</u> abandonment not required	Book Page 1034
Show cause order; suppression or concealment	Book Page 1035
Additional evidence; suppression or concealment	Book Page 1035
Authority of the Administrative Patent Judge in an Interference ..	Book Page 1036
Jurisdiction over benefit applications	Book Page 1037

Orders to Show Cause	Book Page 1037
Briefing schedules	Book Page 1037
Belated filings may be excused	Book Page 1038
Unopposed motions are normally granted	Book Page 1038
problems with claims that are raised in an interference	Book Page 1038
fully and fairly raised in an interference	Book Page 1038
Incorporation of arguments	Book Page 1039
Requirements for requests for discovery	Book Page 1040
Motions	Book Page 1040
Multiple 37 CFR 1.633(a) motions are permissible	Book Page 1043
Antedating in response to a prior art based motion	Book Page 1043
Construction of interference counts	Book Page 1044
Construction of the preamble of a count	Book Page 1045
Construction of the Intended purpose of a count	Book Page 1047
Claim count correspondence	Book Page 1048
Requirements of counts	Book Page 1048
A count need not be patentable or enabled	Book Page 1048
The count is a vehicle for contesting priority	Book Page 1048
Phantom Counts	Book Page 1049
Scope of Counts	Book Page 1049
Motion to change the count and designate claims	Book Page 1050
Unpatentable claims	Book Page 1050
Indefinite claims	Book Page 1051
Motion to Designate claims	Book Page 1054
Motion to substitute a count	Book Page 1055
Motion to Designate claims	Book Page 1056
Motion to substitute an application	Book Page 1057
Motion for an additional interference	Book Page 1057
Motion for additional counts	Book Page 1057
Motion to add a reissue application	Book Page 1057
Motion to correct inventorship	Book Page 1058
Miscellaneous Motions	Book Page 1058
Motions for additional discovery, 37 CFR 41	Book Page 1059
Motion for benefit	Book Page 1060
Motion to add opponent's application of patent	Book Page 1060
New argument in reply	Book Page 1060
Service of papers and proof of service	Book Page 1061
Ex parte Communications	Book Page 1061
<i>Pro Hace Vice</i> Motion - 37 CFR 41.5(a)	Book Page 1061
Constructive reduction to practice of a count	Book Page 1062
Interference estoppel, res judicata, and collateral estoppel	Book Page 1063
Interference collateral estoppel on priority	Book Page 1063
Interference res judicata bar to patentability	Book Page 1063
Concession of priority	Book Page 1067

Interference Estoppel in district court actions	Book Page 1067
Requirement for finality	Book Page 1067
Preclusive effect	Book Page 1069
higher burden of proof	Book Page 1070
Scope - Issues that could have been raised	Book Page 1071
Applied to parties and privies	Book Page 1071
Evidence in an Interference	Book Page 1073
Electronic records	Book Page 1073
"Documents do not speak for themselves"	Book Page 1073
Witness coaching during cross-examination prohibited	Book Page 1073
Sharing testimony of witnesses; witness coaching	Book Page 1074
Availability of evidence submitted by opposing party	Book Page 1075
The Board must always determine if the burden of proof is met ...	Book Page 1075
"failure to cross-examine"	Book Page 1075
Board required to determine issues fully developed	Book Page 1075
Suppression of evidence	Book Page 1076
41.124 Oral Argument	Book Page 1077
37 CFR 41.127 Judgment	Book Page 1078
41.127(a) Estoppel	Book Page 1078
Merger into final decision	Book Page 1079
37 CFR 41.128 Sanctions	Book Page 1079
"brief was used as a pretext to raise new arguments"	Book Page 1080
Board Cross examination guidelines	Book Page 1080
37 CFR 41.154(b) - English language translations	Book Page 1082
35 USC 135(b)	Book Page 1083
35 USC 135(b)(1)	Book Page 1083
Test for same or substantially the same subject matter	Book Page 1083
Post critical date claims must find support	Book Page 1088
Request for interference has no legal significance	Book Page 1089
Post critical date claims same as pre critical date claims	Book Page 1089
Cannot be tolled; not a statue of limitations	Book Page 1090
Statute of repose	Book Page 1090
"Threshold issue" and repose	Book Page 1091
"such a claim" limited exception to the 1 year bar	Book Page 1092
Material limitation means "necessary to patentability"	Book Page 1092
limitations in response to rejection are presumptively material ...	Book Page 1094
pre-critical date claims lacking written description compliance ...	Book Page 1095
Genus species not dispositive	Book Page 1095
Burden of proof	Book Page 1096
35 USC 135(b)(2) and 35 USC 120	Book Page 1097
"an application filed"	Book Page 1097
"comply with the written description requirement"	Book Page 1098
Claims amended after publication	Book Page 1099
Later filed claims no "material limitation" test	Book Page 1100

Substantive basis for ex parte rejection of claims	Book Page 1103
One year period includes the anniversary date	Book Page 1103
Applies on a count by count basis	Book Page 1103
Threshold issue	Book Page 1104
Applies to claims of any patent	Book Page 1105
Timely copied claim subsequently materially amended	Book Page 1105
Statute of repose	Book Page 1106
35 USC 135(c) - Interference Settlement Agreements	Book Page 1106
Access to interference settlement agreements	Book Page 1107
Filing of interference settlement agreement	Book Page 1107
35 USC 135(a) (AIA)	Book Page 1108
35 USC 135(e) (AIA)	Book Page 1110
35 USC 141, Post AIA -	
Appeal to the Court of Appeals for the Federal Circuit	Book Page 1110
35 USC 141, Pre AIA -	
Appeal to the Court of Appeals for the Federal Circuit	Book Page 1111
Note on 35 USC 141 jurisdiction for interferences	Book Page 1111
Jurisdiction	Book Page 1112
"dissatisfied with the decision"	Book Page 1112
"jurisdiction to review"	Book Page 1114
"statements must be regarded as part of the 'decision'"	Book Page 1114
Issue preclusion due to earlier interference	Book Page 1115
Waiver, for failure to raise before the Board	Book Page 1115
Exceptions to waiver	Book Page 1116
Remand to the Board to Decide Undecided Issues	Book Page 1119
Cases to be decided on their own facts	Book Page 1120
Standard for PTAB factual findings and legal conclusions ..	Book Page 1120
PTAB factual findings must be based upon evidence	Book Page 1122
PTO arguments on appeal limited to PTAB decision	Book Page 1123
Court may affirm on any ground supported by the record ..	Book Page 1123
Review on undisputed facts is a matter of law	Book Page 1124
Standard of review whether factual finding errors are harmless ...	Book Page 1124
Consideration of declaratory evidence in the USPTO	Book Page 1124
Interference appeals that are not contested by the adverse party ..	Book Page 1124
35 USC 142 Notice of appeal	Book Page 1125
"date of the decision" means date decision released to the parties ..	Book Page 1125
35 USC 145 Civil action to obtain patent	Book Page 1126
New evidence in 145 Actions	Book Page 1127
Standing	Book Page 1129
Time limit from date of "issue" of PTO decision	Book Page 1130
35 USC 146 Civil action in case of derivation proceeding	Book Page 1131
35 USC 146 (pre-AIA) Civil action in case of interference	Book Page 1131
Termination of Jurisdiction by AIA	Book Page 1131
Standard of Review	Book Page 1131

"admission of live testimony"	Book Page 1131
Jurisdiction	Book Page 1133
Venue	Book Page 1134
Adverse party status	Book Page 1134
Appellant's right to elect the 35 USC 146 forum	Book Page 1135
Scope of review in a 35 USC 146 action	Book Page 1135
"insist[ing] that the issue be resolved"	Book Page 1135
"'raise' the issue for judicial review"	Book Page 1137
Switching legal theories	Book Page 1140
Evidence that was not before the Board	Book Page 1142
Nature of 146 action	Book Page 1142
Issue not raised at final hearing	Book Page 1144
35 USC 146 Counterclaims	Book Page 1145
35 USC 154 Contents and term of patent; provisional rights	Book Page 1146
35 USC 154(a)(1) CONTENTS	Book Page 1146
Doctrine of patent exhaustion	Book Page 1146
Doctrine designed to prevent double recovery	Book Page 1149
Reserving specific claims of a patent from patent exhaustion would frustrate the purposes of the doctrine	Book Page 1149
Exhaustion applies to an authorized sale	Book Page 1150
Exhaustion doctrine applies to method patents	Book Page 1150
Exhaustion of method patent applies to downstream customers	Book Page 1150
Patent exhaustion does not apply to reproduction of patented item	Book Page 1151
Patent exhaustion applied to sale of incomplete	Book Page 1152
Authorized sale	Book Page 1153
Unconditional covenant not to sue exhausts patent right ...	Book Page 1153
Nonexclusive license is equivalent to a covenant not to sue ..	Book Page 1153
“covenant not to sue” and “license” are authorizations	Book Page 1154
35 USC 154(a)(2) TERM	Book Page 1154
Effect of priority claim on patent term	Book Page 1154
35 USC 154(b) - ADJUSTMENT OF PATENT TERM	Book Page 1155
35 USC 154(b)(1) - (1) PATENT TERM GUARANTEES	Book Page 1155
35 USC 154(b)(1) (A)	Book Page 1155
35 USC 154(b)(1)(B)	Book Page 1156
35 USC 154(b)(2) - LIMITATIONS	Book Page 1157
35 USC 154(b)(4) - APPEAL OF PTA DETERMINATION	Book Page 1157
"exclusive forum requirement"	Book Page 1157
No "prerequisite to plaintiff's cause of action"	Book Page 1158
"governed by § 154(b)(4)(A)"	Book Page 1159
35 USC 154(d) Provisional rights	Book Page 1160
35 USC 154(d)(1)(B) Actual notice	Book Page 1160
35 USC 156 Extension of patent term	Book Page 1161

“active ingredient”	Book Page 1167
35 USC 156	Book Page 1168
35 USC 161 Patents for plants	Book Page 1168
35 USC 162 Description, claim	Book Page 1170
35 USC 163 Grant	Book Page 1170
35 USC 171 - Patents for designs	Book Page 1171
35 U.S.C. 171 Patents for designs	Book Page 1171
35 U.S.C. 172 Right of priority	Book Page 1171
35 U.S.C. 173 Term of design patent.	Book Page 1171
Statutory design subject matter	Book Page 1171
"primarily functional" designs excluded	Book Page 1171
Primarily functional factors - "existence of alternative designs" ...	Book Page 1172
Functionality of manufacture not relevant	
to design functionality test	Book Page 1173
35 USC 181 Secrecy of certain inventions and withholding of patent.	Book Page 1176
35 U.S.C. 201 Definitions	Book Page 1177
35 USC 202 Disposition of Rights	Book Page 1178
35 USC 251 - Reissue (Pre AIA)	Book Page 1181
35 USC 251 - Reissue (Post AIA)	Book Page 1182
Question of law	Book Page 1182
251(a) "through error, deemed wholly or partly	
inoperative or invalid"	Book Page 1183
Failure to present linking claim after restriction is correctable error	Book Page 1187
Failure to file a divisional for restricted claims	Book Page 1188
Attorney error	Book Page 1188
251(a) “for invention disclosed in the original patent”	Book Page 1189
Intent to claim factor in determination of original patent test	Book Page 1193
Intent to claim factor in determination of error	Book Page 1194
251(d) "unless applied for within two years"	Book Page 1194
251(d) “enlarging the scope of the claims of the original patent” ...	Book Page 1195
perfecting priority is not broadening	Book Page 1195
251(d) “claims of the original patent”	Book Page 1196
Effect of reissue or reexamination certificate on laches	Book Page 1197
“presumption of validity does not apply”	Book Page 1197
Violation of USPTO’s rules on reissue applications	Book Page 1197
Broadening reissue	Book Page 1198
Recapture rule	Book Page 1199
Appellate review of recapture rule issues	Book Page 1201
Application of recapture rule to facts	Book Page 1202
Intentionally abandoned subject matter	Book Page 1203
Amendments may give rise to the recapture rule	Book Page 1203
Arguments may give rise to recapture rule	Book Page 1204
material narrowing	Book Page 1204
Reclaiming disclaimed subject matter	Book Page 1205

The purpose for two year broadening limit on reissues	Book Page 1205
No diligence requirement for narrowing reissue application	Book Page 1205
Correction of inventorship via reissue	Book Page 1206
37 CFR 1.71 et seq.	Book Page 1206
35 USC 252 Effect of reissue	Book Page 1207
Intervening rights for reissued patents	Book Page 1208
35 USC 253 - Disclaimer	Book Page 1210
Disclaimer's become effective when filed	Book Page 1210
Not an admission of obviousness	Book Page 1210
Terminal Disclaimer must be filed in the name of the patent owner	Book Page 1211
35 USC 254 Certificate of Correction of Office mistake	Book Page 1212
35 USC 255 - Certificate of Correction of Applicant's Mistake	Book Page 1213
"actions for causes thereafter arising"	Book Page 1213
Standard of review of validity of corrected claims	Book Page 1213
Effect of invalidated Certificate of Correction	Book Page 1214
"clerical or typographical nature"	Book Page 1215
"minor character"	Book Page 1216
Limitation on a certificate broadening a claim	Book Page 1217
Correction of indefinite claim term	Book Page 1220
Certificate of Correction - Intervening rights	Book Page 1221
Judicial Correction, by interpretation, of Patents	Book Page 1221
35 USC 256 Correction of named inventor	Book Page 1224
Joint inventorship	Book Page 1227
Contribution to method of making	Book Page 1228
Declaratory judgement jurisdiction	Book Page 1229
No requirement for diligence to correct	Book Page 1229
Presumption of validity applies to inventorship	Book Page 1229
Omitted co-inventor	Book Page 1229
"256 expressly applies the standards of the entire section"	Book Page 1231
misjoinder error includes "all varieties of mistakes"	Book Page 1231
"standing to sue to correct inventorship"	Book Page 1232
Laches applied to an inventorship claim	Book Page 1233
35 USC 257 Supplemental examinations to consider, reconsider, or correct information	Book Page 1235
35 USC 261 - ownership and assignment	Book Page 1235
Ownership	Book Page 1235
"state law, not federal law, typically governs patent ownership" ...	Book Page 1236
Assignment	Book Page 1238
"requires assignments ... be in writing"	Book Page 1238
Construction of patent assignments	Book Page 1239
"assign the 'inventions and discoveries'"	Book Page 1239
Assignment of continuation applications	Book Page 1240
Contract language determines whether assignment is automatic ...	Book Page 1241

Automatic assignment language	Book Page 1241
Bone Fide purchaser for value without notice	Book Page 1243
"the statute is intended to cut off prior legal interests"	Book Page 1243
"without notice"	Book Page 1244
constructive or inquiry notice	Book Page 1244
"recording ... assignment creates a presumption of validity" ...	Book Page 1245
transferring patent ownership by other than assignment	Book Page 1245
"implied-in-fact contract to assign patent rights"	Book Page 1245
Passage of title via state law of property	Book Page 1246
"final adjudication of ... property rights"	Book Page 1247
"assignment of legal title ... to the receiver or trustee"	Book Page 1248
Pleading an obligation to assign	Book Page 1250
Trade secrets	Book Page 1250
35 USC 262 - Joint owners	Book Page 1251
Release and the right to sue	Book Page 1251
Exclusive licensee	Book Page 1252
35 USC 271 Infringement of patents	Book Page 1253
35 USC 271(a)	Book Page 1254
No Jurisdictional Limit	Book Page 1255
Foreign sale does not exhaust patent right	Book Page 1255
Literal infringement	Book Page 1256
Reasonably capable of satisfying the claim limitation	Book Page 1257
Literal infringement of a design patent- ordinary observer test	Book Page 1258
Direct Infringement, multiple actors	Book Page 1259
“personally or through another acting under his direction or control”	Book Page 1261
“acting as agents of or were contractually obligated”	Book Page 1262
Joint infringement of method claims	Book Page 1264
Joint infringement of system claims	Book Page 1265
damages only for acts of infringement after the issuance	Book Page 1267
Literal infringement under 35 USC 112, paragraph 6	Book Page 1268
Equivalents Infringement	Book Page 1268
Burden of Proof	Book Page 1269
Standard of Review of court infringement determination	Book Page 1269
Standard of review of denial of JMOL	Book Page 1269
Doctrine of dedication	Book Page 1269
Domination	Book Page 1270
Doctrine of equivalents	Book Page 1270
DOE for numerical ranges	Book Page 1272
DOE requirement for all elements, the all elements rule	Book Page 1274
DOE prosecution history estoppel limitation	Book Page 1275
DOE definition of function	Book Page 1279
DOE may not read on the prior art	Book Page 1279
Hypothetical claim analysis	Book Page 1280

Prosecution history estoppel	Book Page 1281
disclosure-dedication rule	Book Page 1283
Admissions on non-equivalency	Book Page 1284
DOE: Claim vitiation	Book Page 1285
DOE: no "forseeability exception" for MPF recitations	Book Page 1285
DOE: applicability to function of MPF recitations	Book Page 1285
"unless each of the steps is performed within this country"	Book Page 1286
35 USC 271(b)	Book Page 1287
Elements of inducement	Book Page 1288
Belief in invalidity not a factor	Book Page 1288
"must show, first that there has been direct infringement"	Book Page 1288
"knowledge that the induced acts constitute patent infringement" ..	Book Page 1289
Opinion of-counsel evidence may be relevant	Book Page 1291
personal liability for inducement tort	Book Page 1291
35 USC 271(c)	Book Page 1292
Contributory infringement require direct infringement	Book Page 1292
35 USC 271(d)	Book Page 1293
Damages for breach of license	Book Page 1293
Royalty "beyond the expiration date of the patent is unlawful per se"	Book Page 1294
"recovery of damages"	Book Page 1295
35 USC 271(e)	Book Page 1295
35 USC 271(e)(1) - safe harbor provision	Book Page 1295
"post-approval studies"	Book Page 1297
35 USC 271(e)(2)	Book Page 1298
35 USC 271(e)(5)	Book Page 1300
35 USC 271(f)	Book Page 1301
35 USC 271(f)(1)	Book Page 1301
Supreme Court holding in <u>Life Technologies Corp. c. Promega Corp.</u>	Book Page 1301
271(f)(1) "Substantial portion"	Book Page 1301
Single commodity component can never infringe	Book Page 1302
271(f)(1) "actively induce"	Book Page 1303
271(f) Generally	Book Page 1303
271(f) - Master disks shipped abroad	Book Page 1303
271(f) and method claims	Book Page 1303
271(f) - Design of components within the United States	Book Page 1304
Lost profits from overseas service contracts	Book Page 1305
35 USC 271(g)	Book Page 1305
Limitation on defenses to infringement in ITC actions	Book Page 1305
35 USC 271 Infringement of design patents	Book Page 1307
The "ordinary observer" test	Book Page 1308
"field of purchase by the ordinary observer"	Book Page 1309
prior art context in which the ordinary observer test is applied	Book Page 1310
"the 'point of novelty' test should no longer be used"	Book Page 1311

35 USC 281 - Remedy for infringement of patent	Book Page 1312
Standing to sue for patent infringement	Book Page 1312
Patentee right to sue	Book Page 1312
"effective patentee"	Book Page 1313
Nonexclusive licensee lacks standing	Book Page 1315
Standing requirement co-owners be joined	Book Page 1315
Lack of standing requires dismissal without judgement	Book Page 1315
"right to sue for prior infringement"	Book Page 1316
Infringement finding in contempt proceedings	Book Page 1318
Lack of intent is not a defense to contempt	Book Page 1319
Requirements to hold a contempt proceeding	Book Page 1319
Test for contempt	Book Page 1320
Injunction of non infringing activities	Book Page 1321
35 USC 282 - Presumption of Validity - Defenses	Book Page 1321
Presumption of validity	Book Page 1322
Defenses	Book Page 1325
Improper revival	Book Page 1325
Shop rights license	Book Page 1328
Effect of subsequent assignment on license	Book Page 1328
License royalties, invalid patent	Book Page 1328
Doctrine of permissible repair or reconstruction	Book Page 1328
Concept of proportionality	Book Page 1328
Replacement of spent part is permissible	Book Page 1328
Replacement of a part that must be broken or removed to repair, is permissible	Book Page 1329
Permissible repair defense limited to patent right exhausted by sale in the United States	Book Page 1329
Implied license	Book Page 1330
Implied license is a legal issue	Book Page 1330
Test for Implied license - sale of equipment to practice patent	Book Page 1330
License not implied by entry of infringement judgement	Book Page 1330
Implied license, and equitable and legal estoppel	Book Page 1331
Implied license to continuation patents	Book Page 1331
Disclaimer of implied rights excludes continuation patents	Book Page 1332
Sales under judicial decree or self help	Book Page 1332
License to foreign patent	Book Page 1332
Restrictive license	Book Page 1333
Equitable defenses - Standard of review	Book Page 1333
Equitable estoppel	Book Page 1333
Equitable estoppel -Defense to patent infringement	Book Page 1333
Laches	Book Page 1335
Laches - Bars pre-suit damages	Book Page 1335

Laches - Does not preclude an ongoing royalty	Book Page 1336
Laches may counsel against an injunction	Book Page 1336
Laches - Preponderance of the evidence standard	Book Page 1336
Laches - Duration of delay	Book Page 1337
Laches - Forms of prejudice	Book Page 1337
Laches - Justifications for delay	Book Page 1338
Laches - Egregious infringer conduct	Book Page 1338
Unclean hands	Book Page 1338
Conditional sale does not exhaust patent rights	Book Page 1339
Test of patent misuse	Book Page 1339
Patent Misuse	Book Page 1340
Test - Rule of reason analysis	Book Page 1340
Patent misuse - Licenses	Book Page 1341
Patent misuse - Patent pool licenses	Book Page 1341
Patent misuse - Restrictions on use	Book Page 1342
Patent misuse - Remedies	Book Page 1343
Patent misuse - Standing	Book Page 1343
Exhaustion based upon foundry services	Book Page 1343
Laches	Book Page 1344
Issue preclusion	Book Page 1344
Legal title	Book Page 1345
Patent Invalidity	Book Page 1345
Blonder-Tongue	Book Page 1345
collateral estoppel based upon a judgement of invalidity	Book Page 1345
Timeliness	Book Page 1345
B & B Hardware v. Hargis Industries, 135 S. Ct. 1293 (2015)	Book Page 1346
Presumption that preclusion applies to Agency determination	Book Page 1346
Issue preclusion applies to likelihood of confusion	Book Page 1346
Factors determining whether preclusion applies to TTAB determinations	Book Page 1347
Error does not prevent preclusion	Book Page 1348
Scope of estoppel limited by issues, not claims	Book Page 1348
Waiver of affirmative defense that is not timely raised	Book Page 1348
Decisions relating to prior art	Book Page 1349
references cited in parent applications	Book Page 1350
"clear and convincing evidence that its version of the facts is true"	Book Page 1352
Burden of proof on invalidity due to prior invention of another ...	Book Page 1354
Patent misuse	Book Page 1355
Assignor estoppel	Book Page 1355
Fraud and inequitable conduct	Book Page 1358
Test for fraud	Book Page 1358
Test for inequitable conduct	Book Page 1359
intent	Book Page 1359

Intent due to failure to identify related litigation	Book Page 1361
Intent due to failure to pay small entity fees	Book Page 1362
Intent due to misrepresentations	Book Page 1362
materiality	Book Page 1363
rule 56 not adopted for defining inequitable conduct	Book Page 1365
burden of proof to establish inequitable conduct	Book Page 1366
Inequitable conduct due to actions in related PTO proceeding	Book Page 1369
37 CFR 1.56 Duty of Candor	Book Page 1369
To whom duty of candor applies	Book Page 1369
Scope of duty of candor	Book Page 1370
Timing of duty of candor - delay	Book Page 1370
Duty of candor extended to reexamination requestor	Book Page 1371
What constitutes disclosure	Book Page 1371
No duty to respond to the examiner's confusion	Book Page 1371
"reasonable examiner" standard	Book Page 1372
Standard of review of inequitable conduct holding	Book Page 1372
Equitable in nature	Book Page 1373
"misrepresentation that he is entitled to the benefit"	Book Page 1373
Materiality due to failure to identify related litigation	Book Page 1374
Reference anticipates	Book Page 1375
Contradictory representations in different forums	Book Page 1375
Litigation statements	Book Page 1375
Identification of source of copied claims	Book Page 1376
False statements in petitions	Book Page 1376
False sworn statements are inherently material	Book Page 1377
Inventorship is material to patentability	Book Page 1378
Narrowing claims does not moot misinformation	Book Page 1378
References need not be resubmitted in continuing application	Book Page 1378
Examiners have a duty to examine	Book Page 1379
Foreign search report per se is not material	Book Page 1379
Effect of holding of inequitable conduct	Book Page 1380
Patent unenforceable	Book Page 1380
Inequitable conduct in a related applications and patents ..	Book Page 1380
duty of candor	Book Page 1384
failure to disclose material information	Book Page 1385
intent	Book Page 1385
Evidence indicating lack of intent	Book Page 1387
Curing	Book Page 1388
Experimental Use Exemption to Liability for infringement	Book Page 1388
Opinion of counsel	Book Page 1389
35 USC 283 - Injunction	Book Page 1389
Permanent injunction	Book Page 1390
Irreparable injury factor	Book Page 1392
Licensing and irreparable harm	Book Page 1393

Remedies at law inadequate factor	Book Page 1393
Balancing the hardships factor	Book Page 1394
Public interest not disserved factor	Book Page 1394
Ongoing royalty for patent infringement	
in lieu of a permanent injunction	Book Page 1395
Ongoing royalty, court can consider new evidence	Book Page 1395
Ongoing royalty, court may weigh evidence differently	Book Page 1395
Ongoing royalty, court may enhance damages for willfulness	Book Page 1396
Ongoing royalty, willfulness presumed	Book Page 1396
Ongoing royalty, products covered	Book Page 1397
Preliminary Injunction, criteria and legal standards	Book Page 1397
Preliminary injunction, specific factors	Book Page 1398
"short time left to run on the patent"	Book Page 1398
Likelihood of success	Book Page 1398
Likelihood of success, related interference	Book Page 1399
Likelihood of success -	
Impact of parallel PTAB decisions	Book Page 1399
Irreparable Harm	Book Page 1399
Loss of good will	Book Page 1400
Loss of market share and customers	Book Page 1400
Loss of employees	Book Page 1400
Direct competitors	Book Page 1400
Evidence pre-dating patent issuance, supporting a conclusion	
of irreparable harm	Book Page 1401
Balance of equities and the public interest	Book Page 1401
Stay of preliminary injunction, pending appeal	Book Page 1402
Effect on stay of a decision on appeal reducing scope of infringement	
.....	Book Page 1403
35 USC 284 - Damages	Book Page 1403
35 USC 284 "damages adequate to compensate for the infringement"	Book Page 1403
<i>Garretson v. Clark</i> - apportionment versus entire value	Book Page 1403
Damages adequate to compensate - Lost sales	Book Page 1404
Damages adequate to compensate - Price erosion	Book Page 1404
Damages adequate to compensate - Lost profits	Book Page 1404
Lost profits - Patentee need not sell patented product	Book Page 1405
Jury award covering future infringement precludes ongoing royalty	
.....	Book Page 1405
35 USC 284 "but in no event less than a reasonable royalty"	Book Page 1406
Reasonable royalty - "smallest salable infringing unit"	Book Page 1406
Reasonable royalty - Entire market value	Book Page 1406
"drives demand for the entire product"	Book Page 1407
Reasonable royalty - "for the use made of the invention"	Book Page 1407
Reasonable Royalty - <i>Georgia Pacific</i> Factors	Book Page 1408
Reasonable royalty - Value of the benefit conferred to the infringer	

.....	Book Page 1409
Reasonable Royalty - Evidence must relate to the claimed invention	
.....	Book Page 1410
Reasonable Royalty - Settlement agreement evidence	Book Page 1411
Reasonable Royalty - Anticipated incremental profits	Book Page 1411
Ongoing royalty - no net profit margin limit	Book Page 1412
RAND - Reasonable and nondiscriminatory license terms	Book Page 1412
SEPs - Standards Essential Patents	Book Page 1413
35 USC 284 - Evidence and proof of damages	Book Page 1413
Jury verdicts, infringement, and damages	Book Page 1414
35 USC 284 - Pre-judgement interest	Book Page 1414
35 USC 284	Book Page 1414
"the court may increase the damages up to three times"	Book Page 1414
<u>Halo Electronics, Inc. v. Pulse Electronics, Inc.</u> (2016)	Book Page 1414
<u>Halo</u> -Rejecting <u>Seagate</u>	Book Page 1414
<u>Halo</u> - Increased damages limited to "egregious cases of culpable behavior"	
.....	Book Page 1415
<u>Halo</u> - knowledge of the actor at the time of the	
challenged conduct	Book Page 1416
<u>Halo</u> - Distinguishing 284 and 285	Book Page 1416
CAFC Restating the Supreme Court's test for willful infringement	
.....	Book Page 1417
CAFC restating the Supreme Court's test for enhanced damages ..	Book Page 1417
post- <u>Halo</u>	Book Page 1418
Factor - Institution of a PTAB AIA Trial	Book Page 1418
Factor - Patentee consideration of prior art	Book Page 1419
Factor - Conduct in related litigation	Book Page 1420
Improper Factor - Rule 11	Book Page 1421
Improper Factor - Enforcement, per se	Book Page 1421
"de novo standard of review ... on ... constitutionality"	Book Page 1421
"no adverse inference that an opinion of counsel"	Book Page 1421
35 USC 285 - Attorney's Fees	Book Page 1422
Octane Fitness	Book Page 1422
"exceptional"	Book Page 1422
Preponderance of the evidence burden	Book Page 1423
<i>Highmark Inc.</i>	Book Page 1423
Abuse of discretion standard of review	Book Page 1424
CAFC restating the Supreme Court's test for attorney fee awards ..	Book Page 1424
35 USC 285 - Abuse of discretion standard of review	Book Page 1425
Exceptional case factors	Book Page 1425
Prevailing party's conduct is a factor	Book Page 1425
Factors for determining "reasonable attorney fees"	Book Page 1429
Fee shifting in exceptional cases	Book Page 1429
Attorney fees award reviewed for abuse of discretion	Book Page 1430

Reasonable attorney fees abuse of discretion factors	Book Page 1430
Attorney fees under 285 based upon patent issues	Book Page 1431
285 liability of non-named parties	Book Page 1432
35 USC 286 Time limitation on damages	Book Page 1432
35 USC 287 Limitation on damages and other remedies	Book Page 1433
287(a) Notice and Marking	Book Page 1433
Patent is directed to a process or method	Book Page 1434
Patent contains both apparatus and method claims	Book Page 1434
Both apparatus and method claims asserted	Book Page 1434
Only method claims asserted	Book Page 1435
Independence of asserted patents in marking determination	Book Page 1435
Constructive notice; marking	Book Page 1435
Damages from time of constructive notice	Book Page 1436
Whether the patentee made reasonable efforts to ensure compliance with the marking requirements	Book Page 1436
Claim disclaimer does not moot failure to mark	Book Page 1437
Federal law supremacy relating to notice	Book Page 1438
Claim by claim, versus patent by patent marking	Book Page 1438
Notice of its patent rights and the intent to enforce them	Book Page 1438
Notice based upon good faith of possible infringement	Book Page 1440
Bad faith standard for asserting claims	Book Page 1440
"burden of pleading and proving at trial"	Book Page 1441
Marking is an extrajudicial admission	Book Page 1441
Marking does not shift burden	Book Page 1442
Marking estoppel doctrine	Book Page 1443
35 USC 271(b) - Limitations to remedies under 271(g)	Book Page 1443
35 USC 271(c) - Inapplicability of 35 USC 281, 283, 284, and 285 against medical activity of medical practitioners	Book Page 1443
35 USC 289 Additional remedy for infringement of design patent	Book Page 1443
"total profit"	Book Page 1443
"article of manufacture"	Book Page 1444
Two part test for damages determination	Book Page 1445
Causation	Book Page 1445
"shall not twice recover the profit made from the infringement" ..	Book Page 1445
Recovery limited to the greater of either 284 or 289	Book Page 1445
Recovery does not require willful infringement	Book Page 1446
One recovery per infringing act, not per infringed patent ..	Book Page 1446
Recovery limited to damages from infringing products	Book Page 1447
35 USC 291	Book Page 1447
Interference-in-fact test	Book Page 1447
Jurisdiction	Book Page 1448
Jurisdiction under 291 requires interference-in-fact	Book Page 1450
"discretion to stay proceedings"	Book Page 1450
"sufficient finality to make the stay order a 'final decision'"	Book Page 1451

"estopped from asserting another interference"	Book Page 1452
35 USC 292 - False Marking	Book Page 1452
35 USC 302	Book Page 1454
35 USC 303 - Determination of Issue by the Commissioner	Book Page 1454
Prior district court validity decision	Book Page 1455
Whether question of patentability is "new"	Book Page 1455
Question decided in an IPR is not a substantial "new" question ...	Book Page 1456
"priority can be considered and determined"	Book Page 1457
Whether question is new determined from prosecution history	Book Page 1458
showing that examiner actually considered issue	Book Page 1458
"rejected this presumption of full consideration"	Book Page 1459
"inquiry occasioned by a request for reexamination"	Book Page 1460
35 USC 304 - Reexamination Order by the Commissioner	Book Page 1460
Burden of proof on patentability in a reexamination	Book Page 1461
Obviousness type double patenting rejections in reexamination ...	Book Page 1461
Doctrine of equivalents not relevant to broadening analysis	Book Page 1462
reexamination during interference	Book Page 1462
35 USC 305 Conduct of reexamination proceedings	Book Page 1463
Right to present new and amended claims	Book Page 1463
"enlarging the scope of a claim of the patent"	Book Page 1463
Issue preclusion	Book Page 1465
Admissibility of evidence relating to reexamination proceeding ...	Book Page 1465
Civil Action by third party for action in a Reexamination	Book Page 1465
Violation of 35 USC 305 not a basis for review	Book Page 1466
35 USC 306 Appeal	Book Page 1467
35 USC 307 Certificate	Book Page 1468
"amended or new claim"	Book Page 1468
Effect of Reexamination	Book Page 1470
Damage Period	Book Page 1470
Test for Identical Claims	Book Page 1471
Standard of Review on Scope of Reexamined Claims	Book Page 1473
35 USC 311 [PRE-AIA]	Book Page 1473
35 USC 312 - Determination of issue by Director [PRE-AIA]	Book Page 1474
35 USC 312(c) pre-AIA	Book Page 1474
Cross appeals in inter partes reexamination	Book Page 1475
35 USC 314(b) - [PRE-AIA]	Book Page 1476
35 USC 314(b)(2) - [PRE AIA]	Book Page 1477
35 USC 315 (pre-AIA) Appeal	Book Page 1478
35 USC 315(c) CIVIL ACTION	Book Page 1478
35 USC 316 [PRE-AIA]	Book Page 1478
35 USC 317 [PRE-AIA]	Book Page 1479
CHAPTER 31—INTER PARTES REVIEW [POST-AIA]	Book Page 1481
Constitutional challenges	Book Page 1481
Uncodified dead zone change	Book Page 1483

35 USC 311 Inter partes review	Book Page 1483
Assignor estoppel inapplicable in IPRs	Book Page 1483
Contractual estoppel inapplicable in IPRs	Book Page 1485
35 USC 312 Petitions	Book Page 1485
35 USC 312(a)	Book Page 1486
Lapse in 312(a) does not deprive the Board of jurisdiction	Book Page 1486
35 USC 312(a)(2)	Book Page 1486
"petition identifies all real parties in interest"	Book Page 1486
Consequence of failing to name all RPIs in petition	Book Page 1487
Burden of proof on RPI	Book Page 1488
RPI definition - "party that 'desires review' of the patent"	Book Page 1489
RPI - Factors	Book Page 1489
RPI - Determinations	Book Page 1490
Privies	Book Page 1494
35 USC 312(a)(3) - Grounds	Book Page 1495
Evidence of background understanding of a PHOSITA must be considered	Book Page 1495
Motion to add dependent claim to proceeding	Book Page 1496
35 USC 312(a)(5) - Service	Book Page 1496
35 USC 313 Preliminary response to petition	Book Page 1496
35 USC 314 - Institution of inter partes review	Book Page 1497
314(a) - Director has may partially institute	Book Page 1497
314(a) - Director is not required to institute review	Book Page 1497
Same PTAB panel can institute and make final written decision ...	Book Page 1498
Director has discretion whether to institute follow-on petitions ...	Book Page 1498
Factors in determining whether to grant follow-on petitions	Book Page 1499
Application of test for granting follow-on petitions	Book Page 1500
Factor 3 - Learning from failed petitions	Book Page 1500
Factors 4 and 5 - Delay and explanation	Book Page 1501
Factor 6 - Use of Board finite resources	Book Page 1501
"patent has expired"	Book Page 1502
35 USC 314(a) "reasonable likelihood"	Book Page 1502
Effective Filing Date	Book Page 1502
Relationship of petition arguments to claims	Book Page 1503
35 USC 314(d)	Book Page 1503
Board decision to institute is not appealable	Book Page 1503
CAFC lack of institution review authority	Book Page 1504
"under this section"	Book Page 1506
Board determination that dismissal without prejudice nullifies 315(b) is not appealable	Book Page 1506
Board determination of 315(b) time bar is not appealable	Book Page 1506
Board decision whether to institute is not appealable	Book Page 1507
Decision to institute not appealable after a final decision	Book Page 1507
Mandamus review of institution decision	Book Page 1508

"final"	Book Page 1509
"nonappealable"	Book Page 1509
"merits of the PTAB's decision"	Book Page 1510
"whether to institute"	Book Page 1510
35 USC 315 Relation to other proceedings or actions	Book Page 1510
35 USC 315(a)(1)	Book Page 1511
"is served"	Book Page 1512
35 USC 315(a)(1) "filed a civil action"	Book Page 1513
35 USC 315(a)(1) "challenging the validity"	Book Page 1513
35 USC 315(a)(1) "civil action"	Book Page 1514
35 USC 315(a)(1) "before the date"	Book Page 1515
35 USC 315(a)(2) - Stay of Civil Action	Book Page 1515
35 USC 315(b) - Purpose	Book Page 1516
35 USC 315(b) "a complaint"	Book Page 1516
35 USC 315(b) "complaint alleging infringement of the patent"	Book Page 1516
Lack of standing when complaint served	Book Page 1517
35 USC 315(b) "petitioner, real party in interest, or privy of the petitioner"	Book Page 1517
35 USC 315(b) "served with a complaint"	Book Page 1518
315(b), when a "petitioner is officially a defendant in a law suit" ..	Book Page 1518
315(b), complaint limited to actions under 35 USC 271 and 281 ...	Book Page 1520
315(b), case consolidation under FRCP 42	Book Page 1521
315(b), dismissal without prejudice under FRCP 41(a)	Book Page 1522
315(b), dismissal with prejudice	Book Page 1523
315(b), proving date of service; filing waiver or proof	Book Page 1524
315(b), service of motion for leave to file "complaint"	Book Page 1524
35 USC 315(b) "privy of the petitioner"	Book Page 1525
315(b) Privy timing - "up until the time a petition is filed"	Book Page 1534
315(b) Privy timing - Merger after petition is filed	Book Page 1535
315(b), Late payment of petition fee	Book Page 1535
35 USC 315(b) last sentence, request for joinder	Book Page 1536
35 USC 315(c) Joinder	Book Page 1537
315(c) " <i>any person who properly files a petition</i> under section 311"	Book Page 1538
315(c) "may join as a party ... <i>any person who</i> properly files a petition"	Book Page 1539
315(c) "properly files" (Supreme Court case law)	Book Page 1540
315(c) "the Director, in his or her discretion, <i>may</i> join"	Book Page 1541
New issue joinder	Book Page 1542
Joinder test factors	Book Page 1542
Factor "(1) set forth the reasons why joinder is appropriate"	Book Page 1543
"construed to secure the just, speedy, and inexpensive resolution"	Book Page 1543
Impact of both substantive issues and procedural matters ..	Book Page 1543

Burden and prejudice to the existing parties	Book Page 1543
Efficient resolution of related inter partes reviews	Book Page 1544
Prior petition by the same petitioner, no corresponding complaint alleging infringement	Book Page 1544
Prior petition by the same petitioner, no corresponding complaint alleging infringement	Book Page 1544
Prior petition by the same petitioner, 315(b) bar and split at the Board	Book Page 1545
Prejudice, new references	Book Page 1545
Prejudice, stay of related PTO proceeding	Book Page 1545
Timely addressing issues in prior proceeding	Book Page 1546
Impact of estoppel, on a different party	Book Page 1546
Delay in asserting new ground, lack of excuse	Book Page 1547
Delay in asserting new arguments and evidence, addressing deficiencies identified in prior institution decision	Book Page 1547
Factor "(2) identify any new grounds of unpatentability"	Book Page 1547
Factor "(3)... impact ... joinder would have on the trial schedule" ..	Book Page 1549
Factor "(4) specifically address how briefing and discovery may be simplified"	Book Page 1550
Time delay between petitions, factor	Book Page 1551
New evidence factor	Book Page 1551
Authorization for Joinder motions	Book Page 1551
Opposition to motion for joinder	Book Page 1552
Reply to motion for joinder	Book Page 1553
35 USC 315(d) Multiple Proceedings	Book Page 1553
315(d) "consolidation"	Book Page 1553
Concurrent Office proceedings on involved patent	Book Page 1554
Consolidating IPR proceedings	Book Page 1554
Consolidated consideration of related petitions	Book Page 1554
PTAB Stays - same patent	Book Page 1555
PTAB stay of reexamination - PTAB petition filing	Book Page 1555
PTAB stay of AIA proceeding, pre-institution - reexamination	Book Page 1556
PTAB Stay of AIA proceeding, pre-institution - reissue	Book Page 1558
PTAB Stay of AIA proceeding, pre-institution - ongoing Court proceedings	Book Page 1558
PTAB Stay of AIA proceeding, pre-institution - court appeal	Book Page 1559
PTAB stay - supplemental examination	Book Page 1559
PTAB lifting stay - reexamination	Book Page 1560
Office proceedings of family members of the involved patent	Book Page 1560
Stay of concurrent related applications	Book Page 1560
Correction of related patents	Book Page 1561

Effect on reissue application of a Certificate canceling all claims of the patent	Book Page 1561
35 USC 315(e) Estoppel	Book Page 1562
315(e) IPR estoppel does not apply to any denied ground	Book Page 1562
315(e) IPR estoppel may apply to subcombination of denied ground	Book Page 1564
Inter Partes Reexamination Estoppel does not apply to estop IPRs	Book Page 1564
35 USC 315(e)(1) - Proceedings Before the Office	Book Page 1565
315(e)(1) awareness of grounds in related proceedings	Book Page 1565
315(e)(1) right to request joinder	Book Page 1566
315(e)(1) Does not preclude PTAB from reaching a decision	Book Page 1566
315(e)(1) evidence of a skilled searcher conducting a diligent search	Book Page 1567
315(e)(1) lack of awareness of reference	Book Page 1568
315(e)(1) Response to arguments in an earlier proceeding	Book Page 1568
315(e)(1) References identified in related proceedings	Book Page 1568
315(e)(1) Claim not challenged in prior IPR proceeding	Book Page 1569
315(e)(1) Same prior art asserted in prior IPR proceeding	Book Page 1569
35 USC 315(e)(2) - Estoppel in Civil Actions and Other Proceedings	Book Page 1569
Proponent of estoppel bears the burden of proof	Book Page 1569
Cumulative evidence not reasonably available in IPR	Book Page 1571
35 USC 316 Conduct of inter partes review	Book Page 1572
316(a)(1) and 42.14 Public Availability	Book Page 1573
316(a)(2) and 326(a)(2) - Showing of sufficient grounds to institute	Book Page 1573
Independent review of claim construction	Book Page 1573
316(a)(4)	Book Page 1574
316(a)(5)	Book Page 1574
42.51 IPR Additional Discovery	Book Page 1574
Interests of justice standard for IPR Additional Discovery	Book Page 1574
Five factors test for IPR Additional Discovery	Book Page 1575
Examples of IPR Additional Discovery Decisions	Book Page 1577
"need only indicate its own claim construction"	Book Page 1579
"non-public information"	Book Page 1582
"relevance of the additional discovery"	Book Page 1582
Explaining how the discovery burden can be reduced	Book Page 1585
35 USC 316(a)(9) and (d) - Amendment of the patent	Book Page 1585
Substantive requirements for motions to amend	Book Page 1585
PTAB authority to deny a motion to amend	Book Page 1585
Prior art not of record but known to the patent owner	Book Page 1586
Must show patentable distinction over prior art of record	Book Page 1586
Patent owner retains ultimate burden on motion to amend	Book Page 1589
Conclusory statements by counsel are insufficient	Book Page 1590
Must address the level of ordinary skill	Book Page 1590

Motion must construe new claim terms	Book Page 1592
Amendment must respond to a ground of unpatentability	Book Page 1593
Opposition may rely upon new evidence and reasoning	Book Page 1593
Procedure for motions to amend	Book Page 1593
requirement to confer with the Board	Book Page 1593
Motion must identify which claim a substitute replaces	Book Page 1594
"support must be shown in the original disclosure"	Book Page 1594
"support in an earlier-filed disclosure "	Book Page 1595
support must be shown	Book Page 1595
co-pendency and common inventor benefit requirements	Book Page 1596
additional motion to amend	Book Page 1597
"counting substitute claims"	Book Page 1597
separate contingent motions not authorized	Book Page 1598
motion should not include text of original claims	Book Page 1598
Board prefers substitute instead of amended claims	Book Page 1598
Claims may not be broadened	Book Page 1598
Important requirements for motion to amend	Book Page 1600
One for one claim replacement, absent special circumstances	Book Page 1600
Patentable distinction special circumstance	Book Page 1601
Substituted and substitute claim must be clearly stated	Book Page 1602
Effect of amendment on unamended dependent claims	Book Page 1602
Substitute claim need not be written in independent form	Book Page 1602
Patentable distinction requirement, special circumstance	Book Page 1603
Backup positions is not a special circumstance	Book Page 1603
One for one substitution, per se, is insufficient	Book Page 1604
Presenting multiple claims not a basis for page limit enlargement ..	Book Page 1604
35 USC 316(c) - Patent Trial and Appeal Board	Book Page 1605
35 USC 316(e) - Evidentiary Standards	Book Page 1605
burden of persuasion	Book Page 1607
burden of production	Book Page 1607
Response to patentee rebuttal argument	Book Page 1607
Burden of persuasion remains on petitioner	Book Page 1608
IPR institution decision does not shift burden of persuasion	Book Page 1608
IPR institution decision does not shift burden of production	Book Page 1608
Improper burden shifting	Book Page 1609
PTAB "must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond"	Book Page 1609
35 USC 317 Settlement	Book Page 1610
Timing of joint request, "has decided the merits"	Book Page 1610
35 USC 318 Decision of the Board	Book Page 1611
35 USC 318(a)	Book Page 1611
Basis for findings in final written decision	Book Page 1612
35 USC 319 Appeal	Book Page 1612

CHAPTER 32—POST-GRANT REVIEW	<u>Book Page 1613</u>
PGR availability	<u>Book Page 1613</u>
35 USC 321 Post-grant review	<u>Book Page 1614</u>
35 USC 322 Petitions	<u>Book Page 1616</u>
35 USC 323 Preliminary response to petition	<u>Book Page 1616</u>
35 USC 324 Institution of post-grant review	<u>Book Page 1616</u>
35 USC 324(e) - Institution decision non-appealable	<u>Book Page 1618</u>
35 USC 325 Relation to other proceedings or actions	<u>Book Page 1620</u>
325(a)(1) "civil action challenging the validity of a claim of the patent" ...	<u>Book Page 1621</u>
315(c) - Joinder	<u>Book Page 1622</u>
party and issue joinder, time bars	<u>Book Page 1622</u>
Joinder of parties and issues	<u>Book Page 1622</u>
Joinder of "any person"	<u>Book Page 1622</u>
325(c) "more than 1 petition"	<u>Book Page 1623</u>
325(d) rejecting petitions that present the "same or substantially the same prior art or arguments"	<u>Book Page 1624</u>
Second petition based upon substantially the same prior art	<u>Book Page 1624</u>
Same prior art and same claim	<u>Book Page 1624</u>
Additional prior art and same claim	<u>Book Page 1624</u>
Additional prior art	<u>Book Page 1625</u>
Different prior art reference and the same claims	<u>Book Page 1625</u>
Prior art previously known when prior petition filed	<u>Book Page 1626</u>
Art previously determined by the Office to not be prior art	<u>Book Page 1626</u>
Using a prior PTAB decision to bolster challenges	<u>Book Page 1627</u>
Correcting deficiency identified in a prior PTAB decision	<u>Book Page 1627</u>
New reference providing substantially the same teachings	<u>Book Page 1628</u>
New reference providing substantially more probative teaching	<u>Book Page 1628</u>
Impact of additional reference in related proceeding	<u>Book Page 1630</u>
Correcting identification of evidence	<u>Book Page 1630</u>
Miscellaneous decision on 325(d)	<u>Book Page 1630</u>
35 USC 325(e) - Estoppel	<u>Book Page 1632</u>
35 USC 325(e)(1) Proceedings Before the Office	<u>Book Page 1632</u>
35 USC 325(e)(1) Reviewability	<u>Book Page 1632</u>
Estoppel applied "on a claim-by-claim basis"	<u>Book Page 1633</u>
"any ground"	<u>Book Page 1634</u>
"maintain a proceeding"	<u>Book Page 1635</u>
325(e)(1) does not limit actions of the PTAB	<u>Book Page 1635</u>
325(e)(1) Applies to CBMs	<u>Book Page 1636</u>
35 USC 326 Conduct of post-grant review	<u>Book Page 1636</u>
326(a)(1) and 42.14 Public Availability	<u>Book Page 1637</u>
326(a)(4) "establishing and governing"	<u>Book Page 1639</u>
326(a)(5) and 42.224 Additional discovery	<u>Book Page 1640</u>
35 USC 326(a)(9) and (d) - See 35 USC 316(a)(9) and (d)	<u>Book Page 1642</u>
35 USC 327 Settlement	<u>Book Page 1642</u>

35 USC 328 Decision of the Board	Book Page 1643
35 USC 328(a) - Final Written Decision	Book Page 1643
35 USC 329 Appeal	Book Page 1644
37 CFR 42	Book Page 1644
Subpart A—Trial Practice and Procedure	Book Page 1644
General	Book Page 1644
42.1 Policy	Book Page 1644
42.1(c) Decorum	Book Page 1650
42.2 Definitions	Book Page 1650
"involved"	Book Page 1650
42.3 Jurisdiction	Book Page 1651
Patent Owner initiating Office proceedings on an involved patent .	Book Page 1651
Application to reissue the involved patent	Book Page 1651
42.4 Notice of trial	Book Page 1652
42.5 Conduct of the proceeding	Book Page 1652
Initiating communication with the PTAB	Book Page 1652
Extensions of time	Book Page 1654
Motions to expedite	Book Page 1654
No new arguments in demonstrative exhibits	Book Page 1655
42.5(c)(3) Late action	Book Page 1655
Good cause	Book Page 1656
42.6 Filing of documents, including exhibits; service	Book Page 1656
42.6(a) - General Format	Book Page 1656
37 CFR 42.6 - Filing of documents, including exhibits; service	Book Page 1657
42.6(a) General format requirements	Book Page 1657
42.6(a)(1) Page size	Book Page 1657
42.6(a)(2) Markings, fonts, spacing	Book Page 1657
42.6(a)(3) Incorporation by reference	Book Page 1657
Test for incorporation by reference	Book Page 1657
Footnotes citing another document	Book Page 1658
Claim charts citing to a declaration	Book Page 1658
Conclusory statements citing to a declaration	Book Page 1658
Declaration argument need not be considered	Book Page 1659
Declaration citing to another declaration	Book Page 1659
Referring to claim elements by numbers identified	
in another document	Book Page 1659
Sanction for improper incorporation	Book Page 1660
42.6(b) Modes of filing	Book Page 1660
"incorrectly filed the petition in (PRPS)	Book Page 1660
42.7 Management of the record	Book Page 1661
42.8(a)(3) - 21 days to update mandatory notice information	Book Page 1661
42.8(b)(1) Real party-in-interest	Book Page 1661
Belated identification of change in real party-in-interest	Book Page 1661
Belated identification of related proceedings	Book Page 1662

42.8(b)(1) Identification of real party-in-interest	Book Page 1662
Exclusive licensee as real party-in-interest	Book Page 1662
42.8(b)(2) Related matters	Book Page 1663
42.8(b)(2) Related matters	Book Page 1663
42.8(b)(3) Lead and backup counsel	Book Page 1664
42.8(b)(4) Service Information	Book Page 1664
42.9 Action by patent owner	Book Page 1664
42.10 Counsel	Book Page 1664
42.10 (c) <i>pro hac vice</i>	Book Page 1664
Requirements for a motion <i>pro hac vice</i>	Book Page 1665
Facts sufficient to show good cause	Book Page 1667
Facts insufficient to show good cause	Book Page 1667
Insufficient factual assertions	Book Page 1667
Failure to address litigation misconduct	Book Page 1667
Failure to show power of attorney	Book Page 1668
Presence at oral hearing	Book Page 1668
42.10(e) Withdrawal	Book Page 1669
42.11 Duty of candor	Book Page 1669
42.12 Sanctions	Book Page 1671
42.12(b)(8) Judgment in the trial or dismissal of the petition	Book Page 1672
42.13 Citation of authority	Book Page 1672
42.14 Public availability	Book Page 1672
42.15 Fees	Book Page 1673
Petition and Motion Practice	Book Page 1673
42.20 Generally	Book Page 1673
42.20 (c) Burden of proof	Book Page 1673
Burden of persuasion on showing inherent disclosure	Book Page 1673
Burden of persuasion on obviousness grounds	Book Page 1674
Burden of persuasion to identify specific proposed references combination	Book Page 1674
Identification of differences from prior art	Book Page 1674
Burden of persuasion on claim construction	Book Page 1674
Burden of persuasion on credibility of declarant	Book Page 1675
Burden of persuasion must be met in the petition	Book Page 1675
Arguments lacking in the petition	Book Page 1675
Evidence not submitted with the petition	Book Page 1676
Motion to belatedly add a citation to evidence	Book Page 1676
42.21 Notice of basis for relief	Book Page 1677
Proposed motions lists	Book Page 1677
42.22 Content of petitions and motions	Book Page 1678
concise, well organized, easy-to-follow arguments	Book Page 1678
Claim chart - portrait orientation	Book Page 1679
Include certificate of service in petition	Book Page 1679
Petition claim chart requirements	Book Page 1679

No substantive changes in corrected claim charts	Book Page 1680
No attorney argument in claim charts	Book Page 1680
Claim chart correction by sentence deletion	Book Page 1681
Claim charts margin requirements	Book Page 1681
42.23 Oppositions and replies	Book Page 1682
Oppositions to unauthorized motions are not unauthorized	Book Page 1682
42.23(b) - Replies	Book Page 1682
Remedy for improper reply	Book Page 1682
Scope of proper reply	Book Page 1683
Petitioner gets the last word	Book Page 1684
Improper replies	Book Page 1684
"does more than merely respond to, or rebut"	Book Page 1684
Test data in support of ground in petition	Book Page 1685
Interpreting petition's prior art reference	Book Page 1685
Further developing petition arguments	Book Page 1686
Analysis of claim construction	Book Page 1686
Analysis of petition's prior art	Book Page 1686
"changing the unpatentability rationale"	Book Page 1687
evidence supporting petition's inherency	Book Page 1689
Proper replies	Book Page 1690
Claim in POR of earlier benefit "opens the door"	Book Page 1690
42.24 Page limits for petitions, motions, oppositions and replies	Book Page 1691
42.24(a) Petitions and motions	Book Page 1691
Expert declaration citations in claim charts in petitions	Book Page 1692
Expert declaration citations in petitions	Book Page 1692
Petition page limit defects	Book Page 1693
Motions to enlarge petition page limits	Book Page 1694
42.24(b) Patent owner responses and oppositions	Book Page 1696
42.24(c) Replies	Book Page 1696
42.25 Default filing times	Book Page 1698
Testimony and Production	Book Page 1698
42.51 Discovery	Book Page 1698
42.51(b)(1) - Routine Discovery	Book Page 1698
42.51(b)(1)(i) -Exhibit must be served with citing paper	Book Page 1698
"exhibit cited in a paper or in testimony"	Book Page 1698
42.51(b)(1)(ii) Cross examination of affidavit testimony	Book Page 1698
Failure to make witness available for cross examination	Book Page 1698
Cross examination of a translator	Book Page 1699
42.51(b)(1)(iii) - inconsistent information	Book Page 1700
"privileged information excepted"	Book Page 1700
Cross examination of supplemental evidence declarant	Book Page 1700
"directed toward documents and things"	Book Page 1700
42.52 Compelling testimony and production	Book Page 1700

42.53 Taking testimony	Book Page 1700
42.53(a) Uncompelled direct testimony	Book Page 1700
Review and signature	Book Page 1700
Belated cross-examination	Book Page 1701
Instructing a witness not to answer	Book Page 1701
Questions about redacted material	Book Page 1702
Conferring with the witness after cross-examination	Book Page 1702
Scope of redirect examination	Book Page 1704
Relevance of an exhibit for inquiry during a deposition	Book Page 1704
Entitlement to full deposition time	Book Page 1704
Who can attend or observe a deposition	Book Page 1704
Cross examination with an interpreter	Book Page 1705
Extraterritorial depositions	Book Page 1710
42.53(c) Duration	Book Page 1712
Extending time limits	Book Page 1712
Competing time limit motions	Book Page 1712
number of claims and references	Book Page 1713
length of declaration and pauses in cross-examination	Book Page 1713
Contracting time limits	Book Page 1713
42.53(d) Notice of deposition	Book Page 1714
42.53(d)(2) cross examination of supplemental evidence	Book Page 1714
42.53(d)(5)(ii) - Scope of cross-examination	Book Page 1714
Single deposition and transcript in related proceedings	Book Page 1714
42.53(f) Manner of taking deposition testimony	Book Page 1715
42.53(f)(5) - read and sign	Book Page 1715
42.53(f)(7) Dissemination and filing testimony	Book Page 1715
Filing errata sheets not authorized	Book Page 1715
42.53(g) Costs	Book Page 1718
42.54 Protective order	Book Page 1719
Motion to enter protective order; requirements	Book Page 1719
Scope of protective order	Book Page 1719
Persons authorized access	Book Page 1719
Attorneys eyes only	Book Page 1720
Parties, as defined by a protective order	Book Page 1721
Clarification of default protective order	Book Page 1721
Sanctions	Book Page 1722
Factors in sanction determination	Book Page 1722
42.55 Confidential information in a petition	Book Page 1722
42.56 Expungement of confidential information	Book Page 1722
42.61 Admissibility	Book Page 1723
Timeliness	Book Page 1724
Board "administrative expertise"	Book Page 1724
Rebuttal evidence not subject to exclusion	Book Page 1725
"weight to be assigned testimony," as opposed to admissibility	Book Page 1726

42.62 Applicability of the Federal Rules of Evidence	Book Page 1726
Board competency in hearing evidence	Book Page 1727
Failure to present a declarant for cross-examination	Book Page 1727
42.63 Form of evidence	Book Page 1728
42.63(b) Translation required	Book Page 1728
42.63(c) - Exhibit numbering	Book Page 1729
42.64 Objection; motion to exclude; motion in limine	Book Page 1729
42.64 (a) Deposition evidence	Book Page 1729
42.64(b)(1) Objection	Book Page 1731
42.64(b)(2) - Supplemental evidence	Book Page 1731
Filing supplemental evidence	Book Page 1731
42.64(c) - Motion to exclude	Book Page 1732
Motion to exclude pleadings improper	Book Page 1732
Declarations containing improper portions	Book Page 1733
Motion to exclude Petitioner Reply declaration	Book Page 1733
Motion to exclude Patent Owner motion-to-amend declaration	Book Page 1734
Motion to exclude deposition testimony	Book Page 1735
Improper impermissible conversation with counsel	Book Page 1735
Leading questions	Book Page 1735
Contextual cues in redirect questioning	Book Page 1735
Motion to exclude other testimony from another proceeding	Book Page 1736
Motion to exclude non testimony exhibits	Book Page 1736
Exhibits in support of belated arguments	Book Page 1736
Motion to exclude timing and procedure	Book Page 1736
Motion to exclude declaration in response to deposition	Book Page 1737
42.65 Expert testimony; tests and data	Book Page 1738
Failure to provide expert witness for cross-examination	Book Page 1738
Weight accorded to the expert testimony	Book Page 1738
Motion to disqualify an expert witness	Book Page 1739
Oral Argument, Decision, and Settlement	Book Page 1739
42.70 Oral argument	Book Page 1739
42.70(a) Request for oral argument	Book Page 1740
Key factual assertion first made at oral argument	Book Page 1740
42.70 (b) Demonstrative exhibits	Book Page 1740
Appropriate content of demonstrative exhibits	Book Page 1741
Demonstratives filed without authorization	Book Page 1742
42.71 Decision on petitions or motions	Book Page 1742
42.71(c) Petition decisions	Book Page 1743
Non-institution in response to motion to not institute trial	Book Page 1743
Reviewed for abuse of discretion	Book Page 1743
42.71(d) Rehearing	Book Page 1743
Failure to request rehearing not prejudicial to appeal	Book Page 1744
No right to request an expanded panel	Book Page 1744
Standard of review	Book Page 1745

Erroneous interpretation of law	Book Page 1745
Lack of substantial evidence	Book Page 1746
Response to request for rehearing	Book Page 1746
42.72 Termination of trial	Book Page 1746
42.73 Judgment	Book Page 1747
42.73(a) Judgement	Book Page 1747
"relates to the scope of a judgment"	Book Page 1747
42.73(b) Request for adverse judgement	Book Page 1748
42.73(d) Estoppel	Book Page 1748
Different claims and grounds	Book Page 1748
42.74 Settlement	Book Page 1749
Motion to terminate	Book Page 1749
Motion to terminate as to less than all Petitioners	Book Page 1750
42.80 Certificate	Book Page 1751
Subpart B—Inter Partes Review	Book Page 1751
General	Book Page 1751
42.100 Procedure; pendency	Book Page 1751
42.100(b) [42.200(b); 42.300(b)] - "broadest reasonable interpretation" ...	Book Page 1751
Basis for BRI includes record evidence	Book Page 1751
Effect of intrinsic record fully determining the proper construction	Book Page 1752
BRI applies to PGR proceedings	Book Page 1752
BRI ordinary meaning presumption	Book Page 1753
BRI excludes configuration expressly disclaimed in the specification	Book Page 1753
BRI preamble construction	Book Page 1753
PTAB initial construction limited to contested terms	Book Page 1754
Exceptions to BRI in PTO proceedings	Book Page 1754
BRI, disavowal, same proceeding	Book Page 1755
BRI, disavowal,same proceeding, when prosecution has closed	Book Page 1755
BRI, disavowal, prosecution history	Book Page 1756
BRI, disavowal in the specification	Book Page 1757
Particular words and phrases	Book Page 1758
Recitation "/" means "or"	Book Page 1758
Recitation "especially"	Book Page 1759
Exemplary applications of BRI	Book Page 1759
42.101 Who may petition for inter partes review	Book Page 1759
42.102 Time for filing	Book Page 1759
42.103 Inter partes review fee	Book Page 1759
42.104 Content of petition	Book Page 1759
42.104(a) Grounds for standing	Book Page 1759
42.104(b) Identification of challenge	Book Page 1760
42.104(b)(1) and (2) - Claims and grounds	Book Page 1760
42.104(b)(3) How the challenged claim is to be construed	Book Page 1760

42.104(b)(3) "must identify the specific portions of the specification"	Book Page 1760
42.104(b)(4) Basis for unpatentability and point cites to prior art ..	Book Page 1761
General Failure to identify the challenge to a claim	Book Page 1762
Requirement for point cites to prior art relied upon	Book Page 1762
Prior art figures are point citations to the prior art	Book Page 1763
42.104(b)(5) Citation to evidence and relevance	Book Page 1763
42.104(c) Correction of clerical or typographical mistake in a petition	Book Page 1764
42.105 Service of petition	Book Page 1768
Good faith attempt at service rule compliance	Book Page 1769
Consequence of service rule non-compliance	Book Page 1769
42.106 Filing date	Book Page 1771
42.106(a) Complete petition	Book Page 1771
42.106(b) Incomplete petition	Book Page 1772
Incomplete petition receives no filing date	Book Page 1772
Failure to identify RPI in petition	Book Page 1772
Lack of a rule to correct RPI	Book Page 1773
Faulty uploading and clerical error	Book Page 1773
What constitutes electronic filing	Book Page 1773
Technical failure of filing system	Book Page 1773
35 USC 21 not applicable to electronic filing	Book Page 1774
Compliance with 41.105(b) not required for obtaining a filing date	Book Page 1775
42.107 Preliminary response to petition	Book Page 1775
42.107(a) Preliminary response may include new evidence	Book Page 1775
42.107(b) Preliminary response due date	Book Page 1775
42.107(c) Preliminary response may not include new testimonial evidence	Book Page 1775
"new testimonial evidence" in a preliminary response	Book Page 1775
New testimony not permitted to attack credibility	Book Page 1777
New testimony permitted "in the interest of justice"	Book Page 1777
42.107(e) Disclaim Patent Claims	Book Page 1778
Instituting Inter Partes Review	Book Page 1778
42.108 Institution of inter partes review	Book Page 1778
After Institution of Inter Partes Review	Book Page 1779
42.120 Patent owner response	Book Page 1779
42.121 Amendment of the patent	Book Page 1780
42.122 Multiple proceedings	Book Page 1780
42.123 Filing of supplemental information	Book Page 1780
PTAB has discretion to grant or deny	Book Page 1780
Supplemental information not filed with the motion	Book Page 1780
Burden of proof and required showings	Book Page 1780
To confirm that petition evidence is prior art, granted	Book Page 1781
To bolster challenges in the petition, denied	Book Page 1781
Markman briefs, Joint Claim Constructions	Book Page 1782

To cure objections to evidence, denied	Book Page 1783
42.123(b) -Late submission of supplemental information	Book Page 1784
Subpart C—Post Grant Review	Book Page 1784
42.200 Procedure; pendency	Book Page 1785
42.200(b) "broadest reasonable construction" - See 41.100(b)	Book Page 1785
42.201 Who may petition for a post-grant review	Book Page 1785
42.202 Time for filing	Book Page 1785
42.203 Post-grant review fee	Book Page 1785
42.204 Content of petition	Book Page 1785
42.205 Service of petition	Book Page 1785
42.206 Filing date	Book Page 1785
42.207 Preliminary response to petition	Book Page 1785
Instituting Post-Grant Review	Book Page 1785
42.208 Institution of post-grant review	Book Page 1785
AIA, Public Law 112-29, sec. 6(f), 125 Stat. 284	Book Page 1786
AIA, Public Law 112-29, sec. 18, 125 Stat. 284 - Section 18	Book Page 1787
AIA Sec. 18(a)(1)(A) except for 321(c), 325(b), (e)(2), and (f)	Book Page 1788
Statutory construction of "a patent that claims"	Book Page 1789
Statutory construction of "a financial product or service"	Book Page 1789
AIA Sec. 18(a)(1)(B) "sued for infringement"	Book Page 1791
Federal Circuit has jurisdiction to review	Book Page 1791
Sued for infringement applies to Federal Court of Claims suits	Book Page 1791
AIA Sec. 18(a)(1)(C) limitation on pre-AIA prior art	Book Page 1793
AIA Sec. 18(b)(1) "relating to a transitional proceeding for that patent," .	Book Page 1793
AIA Sec. 18(a)(1)(E) "covered business method patent"	Book Page 1794
AIA Sec. 18(b)(1)(A)-(D) four separate factors	Book Page 1795
AIA Sec. 18(b)(1)(A) "simplify ... and streamline"	Book Page 1796
AIA Sec. 18(b)(1)(B) "discovery and ... trial date"	Book Page 1797
AIA Sec. 18(b)(1)(C) "prejudice ... clear tactical advantage"	Book Page 1797
AIA Sec. 18(b)(1)(D) "burden of litigation"	Book Page 1798
AIA Sec. 18(b)(2) "review may be de novo"	Book Page 1798
AIA Sec. 18(d)(1) "financial product or service"	Book Page 1799
Disclaimer of CBM claims, and standing	Book Page 1802
AIA Sec. 18 101 law	Book Page 1803
Subpart D - Transitional Program for Covered Business	
Method Patents	Book Page 1806
42.300 Procedure; pendency	Book Page 1806
42.301 Definitions	Book Page 1806
42.301(a) "financial product or service"	Book Page 1807
Specification describes a financial product or service application ..	Book Page 1807
Assertion of patent against a financial institution	Book Page 1808
42.301(a) "except that the term does not include	
patents for technological inventions"	Book Page 1808
42.301(b) "Technological Invention"	Book Page 1808

42.301(b) "claimed subject matter as a whole"	Book Page 1809
42.301(b) "recites a technological feature that is novel and unobvious over the prior art"	Book Page 1811
Showing claimed elements were known	Book Page 1811
Showing normal, expected, or predictable result of a combination ..	Book Page 1811
Showings failure due to mis-characterizing claims	Book Page 1812
Failure to address either selecting or storing steps	Book Page 1812
Failure to address either receiving or selecting steps	Book Page 1812
Failure to account for software product limitations	Book Page 1813
Failure to account for "software elements"	Book Page 1813
42.301(b) "solves a technical problem using a technical solution"	Book Page 1813
Showing lack of support for claim is insufficient	Book Page 1814
Lack of persuasive reasoning and expert testimony	Book Page 1814
42.302 Who may petition for a covered business method patent review ...	Book Page 1815
42.302(c)	Book Page 1817
42.303 Time for filing	Book Page 1817
42.304 Content of petition	Book Page 1817
35 USC 364	Book Page 1817
35 USC 374 Publication of international application	Book Page 1817
35 USC 393 - Non-Resident Patentee; Service and Notice	Book Page 1818
Litigation/Licensee Estoppel	Book Page 1818
Licensed product estoppel	Book Page 1819
License payments as evidence of infringement	Book Page 1819
42 USC 262 - Regulation of biological products	Book Page 1819
42 USC 262(a) Biologics license	Book Page 1819
42 USC 262(i) "Biological product" defined	Book Page 1820
42 USC 262 (j) Application of Federal Food, Drug, and Cosmetic Act	Book Page 1820
42 USC 262(k) Licensure of biological products as biosimilar or interchangeable	Book Page 1820
42 USC 262(k)(1) In general	Book Page 1820
42 USC 262(k)(5) General rules	Book Page 1821
42 USC 262(k)(6) Exclusivity for first interchangeable biological product	Book Page 1821
42 USC 262(k)(7) Exclusivity for reference product	Book Page 1822
42 USC 262(l) Patents	Book Page 1822
42 USC 262(l)(1) Confidential access to subsection (k) application	Book Page 1822
42 USC 262(l)(1)(A) Application of paragraph	Book Page 1822
42 USC 262(l)(1)(B) In general	Book Page 1823
42 USC 262(l)(1)(C) Limitation on disclosure	Book Page 1823
42 USC 262(l)(1)(D) Use of confidential information	Book Page 1823
42 USC 262(l)(1)(E) Ownership of confidential information	Book Page 1823
42 USC 262(l)(1)(F) Effect of infringement action	Book Page 1824
42 USC 262(l)(1)(G) Rule of construction	Book Page 1824
42 USC 262(l)(1)(H) Effect of violation	Book Page 1824

42 USC 262(l)(2) - Subsection (k) application information	Book Page 1824
42 USC 262(l)(2) Subsection (k) application information	Book Page 1825
42 USC 262(l)(3) List and description of patents	Book Page 1825
42 USC 262(l)(4) Patent resolution negotiations	Book Page 1826
42 USC 262(l)(5) Patent resolution if no agreement	Book Page 1826
42 USC 262(l)(5)(A) Number of patents	Book Page 1827
42 USC 262(l)(5)(B) Exchange of patent lists	Book Page 1827
42 USC 262(l)(5)(B)(i) In general	Book Page 1827
42 USC 262(l)(7) Newly issued or licensed patents	Book Page 1827
42 USC 262(l)(8) Notice of commercial marketing and preliminary injunction	Book Page 1828
42 USC 262(l)(9) Limitation on declaratory judgment action	Book Page 1829
42 USC 262(l)(9)(A) Subsection (k) application provided	Book Page 1829
42 USC 262(l)(9)(B) Subsequent failure to act by subsection (k) applicant	Book Page 1829
42 USC 262(l)(9)(C) Subsection (k) application not provided	Book Page 1829
42 USC 262(n) Date of approval in the case of recommended controls under the CSA	Book Page 1830