Index

ABANDONMENT
   Validity, novelty—35 U.S.C.A. § 102, 4:10
ACQUISITIONS
   Government contracts, federal acquisition regulations and reporting requirements, 13:3
ACTIONS AND PROCEEDINGS
   Patent Office Proceedings (this index)
ADJUSTMENT
   Damages, remittitur, 7:21
   Defenses and counterclaims, adjustment of patent term, 6:7
ADMINISTRATION OF PATENT
   Generally, 1:3
   Patent Office Proceedings (this index)
ADMINISTRATIVE PROCEDURES ACT § 207
   Sovereign immunity for U.S. government action, waivers, 6:10
AGENT / ATTORNEY
   Patent Office proceedings, 11:21
AGRICULTURAL MATTERS
   Technology, year in review, 12:11
ALL ELEMENTS RULE
   Infringement under doctrine of equivalents, 3:14
ALTERNATIVE TRIAL FORUMS—Cont’d
   Board of Contract Appeals, 9:4
   Court of Federal Claims, 9:2
   Federal Claims, U.S. Court of, 9:2
   Federal Trade Commission, 9:6
   International Trade Commission, 9:1
   State law claims, infringement, 9:7
   Tax Court, 9:5
   U.S. Court of Federal Claims, 9:2
   U.S. Court of International Trade, 9:3
   U.S. Federal Trade Commission, 9:6
   U.S. Tax Court, 9:5
AMENDMENT-BASED DISCLAIMER
   Infringement, doctrine of equivalents, 3:17
AMENDMENT OF CLAIM
   Infringement litigation, motion to amend, 8:7
AMERICA INVENTS ACT (AIA)
   Selected text, App A
ANALOGOUS PRIOR ART
   Validity, nonobviousness under 35 U.S.C.A. § 103, 4:16
ANTICIPATION
   Validity, novelty—35 U.S.C.A. § 102, 4:6
ANTITRUST
   Defense to infringement, 5:6

Index-1
APPEAL AND REVIEW
America Invents Act (AIA), selected provisions, App A
Board of Contract Appeals, 9:4
Choice of law on appeal, 10:3
Conflict of interest, mandamus jurisdiction, 10:6
Damages, remittitur, 7:21
Disposition, 10:8
Final judgments, jurisdiction, 10:2
Joinder, mandamus jurisdiction, 10:6
Jurisdiction generally, 10:1 to 10:8
Choice of law, 10:3
Conflict of interest, mandamus jurisdiction, 10:6
Final judgments, 10:2
Joinder, mandamus jurisdiction, 10:6
Mandamus, 10:5, 10:6
Scope and standard of review, 10:4
Transfer, mandamus jurisdiction, 10:6
Mandamus jurisdiction, 10:5, 10:6
Patent Trial and Appeal Board, selected provisions of America Invents Act, App A
Post-grant review, App A
Scope and standard of review, jurisdiction, 10:4
Transfer, mandamus jurisdiction, 10:6
U.S. Supreme Court decisions, 10:9
Waiver and estoppel, 10:7
APPLICATIONS
America Invents Act (AIA), selected provisions, App A
Patent Office proceedings, examination of, 11:1, 11:2
ARBITRATION
Case or controversy, 8:23
ARGUMENT-BASED DISCLAIMER
Infringement, doctrine of equivalents, 3:18
ATTORNEYS
Advice of counsel, selected provisions of America Invents Act, App A
Disqualification of counsel, 8:25
Fees, remedies, 7:19
Patent Office proceedings, 11:21
ATTORNEY’S FEES
Damages, 7:19
Remedies, 7:19
AUTHORITY
Generally, 1:2
BAR TO PATENTABILITY
Government contract activity as, 13:4
BEST MODE REQUIREMENT
Validity of patent, 4:22
BIAS
Judicial, infringement, 8:20
BIOLOGICS
Technology, year in review, 12:3
BIOTECHNOLOGY
Year in review, 12:2
BOARD OF CONTRACT APPEALS
Alternative trial forums, infringement, 9:4
BOND
Injunctions, 7:5
BUSINESS METHODS
Technology, year in review, 12:9
CANONS
Interpretation, canons of Claims (this index)
<table>
<thead>
<tr>
<th>CASE OR CONTROVERSY</th>
<th>CLAIMS—Cont’d</th>
</tr>
</thead>
<tbody>
<tr>
<td>Claim preclusion and issue preclusion, 8:21</td>
<td>Dictionaries, 2:12</td>
</tr>
<tr>
<td>Declaratory judgments, 8:2</td>
<td>Differentiation, 2:18</td>
</tr>
<tr>
<td>Judicial estoppel, 8:22</td>
<td>Disclaimers, prosecution, 2:17</td>
</tr>
<tr>
<td>Jury and jury trial, 8:14 to 8:16</td>
<td>Expert testimony, 2:13</td>
</tr>
<tr>
<td>Law of case, 8:22</td>
<td>Extrinsic evidence</td>
</tr>
<tr>
<td>Parties, standing, 8:3</td>
<td>dictionaries, 2:12</td>
</tr>
<tr>
<td>Preliminary infringement contentions, 8:8</td>
<td>expert testimony, 2:13</td>
</tr>
<tr>
<td>Standing and parties, 8:3</td>
<td>industry standards, 2:13</td>
</tr>
<tr>
<td>CERTAINTY AND DEFINITENESS</td>
<td>treatises, 2:12</td>
</tr>
<tr>
<td>Claim interpretation, 2:19</td>
<td>Formats</td>
</tr>
<tr>
<td>Validity of patent, 4:23</td>
<td>claim preambles and</td>
</tr>
<tr>
<td>CHEMICALS</td>
<td>transitional phrases, 2:2</td>
</tr>
<tr>
<td>Technology, year in review, 12:2</td>
<td>design claims, 2:6</td>
</tr>
<tr>
<td>CHOICE OF LAW</td>
<td>means-plus-function claims, 2:4</td>
</tr>
<tr>
<td>Appellate jurisdiction, 10:3</td>
<td>method claims, 2:3</td>
</tr>
<tr>
<td>CIRCUIT JUDGE</td>
<td>product-by-process claims, 2:5</td>
</tr>
<tr>
<td>Year in review, activity by judge, 14:1</td>
<td>Imported limitations, 2:16</td>
</tr>
<tr>
<td>CLAIM DIFFERENTIATION</td>
<td>Industry standards, 2:16</td>
</tr>
<tr>
<td>Claim interpretation, 2:18</td>
<td>Interpretation</td>
</tr>
<tr>
<td>CLAIMS</td>
<td>canons, 2:14 to 2:19</td>
</tr>
<tr>
<td>Generally, 2:1 to 2:19</td>
<td>claim language, 2:8</td>
</tr>
<tr>
<td>America Invents Act, selected provisions, App A</td>
<td>extrinsic evidence</td>
</tr>
<tr>
<td>Canons of interpretation</td>
<td>2:12, 2:13</td>
</tr>
<tr>
<td>generally, 2:14 to 2:19</td>
<td>intrinsic evidence</td>
</tr>
<tr>
<td>claim differentiation, 2:18</td>
<td>2:7 to 2:11</td>
</tr>
<tr>
<td>definiteness, 2:19</td>
<td>language of claim, 2:8</td>
</tr>
<tr>
<td>imported limitations, 2:16</td>
<td>ordinary meaning, 2:15</td>
</tr>
<tr>
<td>limitations, 2:16</td>
<td>preferred embodiment, 2:14</td>
</tr>
<tr>
<td>ordinary meaning, 2:15</td>
<td>prosecution disclaimer, 2:19</td>
</tr>
<tr>
<td>preferred embodiment, 2:14</td>
<td>specification, 2:9</td>
</tr>
<tr>
<td>preservation of validity, 2:19</td>
<td>Intrinsic evidence</td>
</tr>
<tr>
<td>prosecution disclaimer, 2:17</td>
<td>claim interpretation, 2:7 to 2:11</td>
</tr>
<tr>
<td>validity, preservation of, 2:19</td>
<td>claim language, 2:8</td>
</tr>
<tr>
<td>Definiteness, 2:19</td>
<td>prosecution history, 2:10, 2:11</td>
</tr>
<tr>
<td>Design claims, 2:6</td>
<td>specification, 2:9</td>
</tr>
<tr>
<td></td>
<td>Introduction, 2:1</td>
</tr>
<tr>
<td></td>
<td>Language. See entries throughout</td>
</tr>
<tr>
<td></td>
<td>this topic</td>
</tr>
<tr>
<td></td>
<td>Limitations, interpretative canons, 2:16</td>
</tr>
<tr>
<td></td>
<td>Markman process, infringement,</td>
</tr>
<tr>
<td></td>
<td>claim construction, 8:9</td>
</tr>
<tr>
<td></td>
<td>Means-plus-function format, 2:4</td>
</tr>
<tr>
<td></td>
<td>Method claims, 2:3</td>
</tr>
<tr>
<td></td>
<td>Ordinary meaning, 2:15</td>
</tr>
</tbody>
</table>
CLAIMS—Cont’d
Patent Office proceedings, claim construction, 11:2
Preambles and transitional phrases, 2:2
Preferred embodiment, interpretation, 2:14
Preservation of validity, 2:19
Product-by-process claims, 2:5
Prosecution disclaimer, 2:17
history, 2:10, 2:11
Related applications, 2:11
Specification, 2:9
Testimony, 2:13
Transitional phrases, 2:2
Treatises, 2:12
Validity, preservation of, 2:19
Witnesses, expert testimony, 2:13

COMMON LAW RESEARCH EXEMPTION
Defenses and counterclaims, 6:13

COMPUTERS
Hardware and software, technology, year in review, 12:5

CONCEPTION
Validity, inventorship, 4:27

CONDUCT
Inequitable Conduct (this index)

CONFIDENTIALITY
America Invents Act, selected provisions, App A

CONFLICT OF INTEREST
Appellate jurisdiction, mandamus, 10:6

CONSTITUTIONAL AUTHORITY
Generally, 1:2

CONSTRUCTION AND INTERPRETATION
Claims (this index)
Markman process, infringement, claim construction, 8:9

CONSUMER PRODUCTS
Technology, year in review, 12:12

CONTEMPT
Generally, 7:6
Injunctions, 7:6

CONTRACTS AND AGREEMENTS
Board of Contract Appeals, 9:4
Government Contracts (this index)

CONTRIBUTORY INFRINGEMENT
35 U.S.C.A. § 271(c), 3:5

CORPORATE OFFICER
Defenses and counterclaims, 6:14

CORRECTION
Patent Office proceedings, 11:12
Validity, inventorship, 4:31

CROSSPROBATION
Validity, inventorship, 4:29

COSTS
Damages, 7:13
Remedies, 7:13

COUNTERCLAIMS
Defenses and Counterclaims (this index)

COURT OF FEDERAL CLAIMS
Alternative trial forums, infringement, 9:2

COVERED BUSINESS METHOD REVIEW
Government contracts, 13:6

Index-4
INDEX

DAMAGES
Generally, 7:7 to 7:22
America Invents Act, selected provisions, App A
Attorney’s fees, 7:19
Costs, 7:13
Enhanced damages
   exceptional case, 7:14 to 7:18
   litigation misconduct, 7:17
   opinions of counsel, 7:16
   prevailing party, 7:18
   willful infringement, 7:15, 7:16
False marking, 7:8
Interest, prejudgment and postjudgment, 7:12
Litigation misconduct, enhanced damages, 7:17
Lost profits, 7:10
Marking, 7:8
Opinions of counsel, enhanced damages, 7:16
Preissuance rights, 7:22
Prejudgment and postjudgment interest, 7:12
Prevailing party, enhanced damages, 7:18
Provisional rights, 7:22
Reasonable royalty, 7:11
Remittitur, 7:21
Sanctions, 7:20
Time limitation, 7:9
Willful infringement, enhanced damages, 7:15, 7:16

DEDICATION
Infringement, doctrine of equivalents, 3:21

DEFENSES AND COUNTERCLAIMS
As to particular defenses, see more specific topics
Generally, 5:1 to 5:9, 6:1 to 6:15
Adjustment of patent term, infringement exemptions, 6:7
Administrative Procedures Act, waivers under Section 207, sovereign immunity, 6:10
Antitrust violations, 5:6
Authority
   licensed activity, 6:2
   reconstruction, 6:3
   repair, 6:3
Common law research exemption, 6:13
Corporate officer status, 6:14
Eleventh Amendment immunity for state action, 6:9
Equitable estoppel, 5:8
Exemptions
   common law research use, 6:13
   regulatory submission use exemption under 35 U.S.C.A. § 271(e)(1), 6:12
Exhaustion, 6:8
Expiration of patent, infringement exemptions, 6:6, 6:7
Extension of patent term, infringement exemptions, 6:7
Extraterritoriality, 6:5
Federal preemption, 6:11
Intervening rights, 5:8
Invalidity, 4:1 to 4:33
Joint defense agreements, 8:25
Laches, prosecution, 5:9
License defenses, 6:2
Misuse of patent, 5:6
Noninfringement, 6:1 to 6:15

DECLARATORY JUDGMENT
Jurisdiction, 8:2
Subject matter jurisdiction, 8:2

DECREES
Judgments and Decrees (this index)
DEFENSES AND COUNTERCLAIMS—Cont’d
Patent expiration, infringement exemptions, 6:6, 6:7
Patent misuse, 5:6
Prior use, 6:15
Prosecution laches, 5:9
Regulatory submission use exemption under 35 U.S.C.A. § 271(e)(1), 6:12
Repair, 6:3
Section 1498(a) immunity for U.S. government action, 6:10
Sovereign immunity generally, 6:9, 6:10
waivers under Section 207 of Administrative Procedures Act, 6:10
State immunity under Eleventh Amendment, 6:9
Status as corporate officer, 6:14
Temporary presence, infringement exemptions, 6:4
Term extension, infringement exemptions, 6:7
Trade regulation, 5:6
Unclean hands, 5:7
Unfair competition, 5:6
Waivers, 6:10, 8:25

DEFINITYNESS
Claim interpretation, 2:19
Validity of patent, 4:23

DEFINITION OF PATENT
Generally, 1:1

DEPENDENCY

DERIVATION
America Invents Act (AIA), selected provisions, App A
Patent office proceedings, 11:8

DERIVATION—Cont’d
Validity, novelty under 35 U.S.C.A. § 102, 4:13

DESIGN
Technology, year in review, 12:13

DESIGN CLAIMS
Claim formats, 2:6

DESIGN PATENTS
Literal infringement under 35 U.S.C.A. § 271(a), 3:9
Patent office proceedings, 11:10
Validity, 4:33

DICTIONARIES
Claim interpretation, 2:12

DIFFERENTIATION
Claim interpretation, 2:18

DISCLAIMERS
Claim interpretation, prosecution disclaimers, 2:17

DISCLOSURE
Government contracts, patent secrecy, 13:5
Inequitable conduct, scope of disclosure duty, 5:3
Misrepresentations, 5:5
Omitted prior art, 5:3
Validity (this index)

DISCOVERY
Infringement, 8:10

DISMISSAL
Generally, 8:6
Infringement, 8:6

DISPOSITION
Appellate practice, 10:8

DISPUTES WITH FEDERAL GOVERNMENT
Venue for, 13:2
INDEX

DISQUALIFICATION OF COUNSEL
Infringement litigation, 8:25

DISTRICT COURTS
Infringement litigation, 8:1 to 8:25
Year in review, 14:3

DOCTRINE OF EQUIVALENTS
Infringement (this index)

DOUBLE PATENTING
Generally, 4:19
Validity, nonobviousness under 35 U.S.C.A. § 103, 4:19

DRUGS OR PHARMACEUTICALS
Technology, year in review, 12:3

ELECTRONICS
Technology, year in review, 12:7

ELEVENTH AMENDMENT
Sovereign immunity for state action, 6:9

ENABLEMENT REQUIREMENT
Validity of patent, 4:21

ENVIRONMENTAL MATTERS
Technology, year in review, 12:11

EQUITABLE ESTOPPEL
Defenses and counterclaims, 5:8

EQUITY
Inequitable Conduct (this index)

ESTOPPEL AND WAIVER
—Cont’d
tory estoppel, 3:16 to 3:20
Infringement litigation, 8:25
Law of case and judicial estoppel, 8:22

EVIDENCE
Generally, 8:12
Attorney-client and work product privilege, 8:13
Discovery, spoliation, 8:10
Doctrine of equivalents, 3:22
Expert testimony, 2:13
Intrinsic evidence, claim interpretation, 2:7 to 2:11
Spoliation, 8:10

EXAMINATION
Application, Patent Office examination, 11:1, 11:2

EXEMPTIONS
Defenses and Counterclaims (this index)

EXHAUSTION
Defenses and counterclaims, 6:8

EXPERIMENTAL USE
Validity, novelty under 35 U.S.C.A. § 102, 4:9

EXPERT TESTIMONY
Claim interpretation, 2:13

EXPIRATION OF PATENT
Defenses and counterclaims, 6:6, 6:7

EXTENSION OF TIME
Defenses and counterclaims, extension of patent term, 6:7

EXTRATERRITORIALITY
Defenses and counterclaims, 6:5
FALSE MARKING
America Invents Act, selected provisions, App A
Damages, 7:8

FDA FILING INFRINGEMENT

FEDERAL CIRCUIT JUDGE
Year in review, activity by judge, 14:1

FEDERAL CLAIMS, U.S. COURT OF
Alternative trial forums, 9:2

FEDERAL GOVERNMENT CONTRACTS
Government Contracts (this index)

FEDERAL PREEMPTION
Defenses and counterclaims, 6:11

FINAL JUDGMENTS
Appeal and review, jurisdiction, 10:2

FOOD TECHNOLOGY MATTERS
Generally, 12:11

FOREIGN ACTIVITY
Validity, novelty—35 U.S.C.A. § 102, 4:11

FOREIGN ASSEMBLY INFRINGEMENT

FORUM
Year in review, statistical perspective, 14:2

§ 1498(a) IMMUNITY
Sovereign immunity for U.S. government action, 6:10

FUNCTIONALITY
Validity, design patents, 4:33

GAMING
Technology, year in review, 12:10

GOVERNMENT CONTRACTS
Generally, 13:1 to 13:6
Acquisitions, regulations and reporting requirements, 13:3
Bar to patentability, government contract activity as, 13:4
Covered business method review, 13:6
Disputes, venue, 13:2
Federal acquisition regulations and reporting requirements, 13:3
Inter partes review, 13:6
Introduction, 13:1
Regulations, 13:3
Reporting requirements, 13:3
Secrecy of patent, 13:5
Venue for patent disputes with federal government, 13:2

GRANT OF PATENT
Generally, 1:3

IMMUNITY UNDER § 1498(a)
Sovereign immunity for U.S. government action, 6:10

IMPORTED LIMITATIONS
Claim interpretation, intrinsic evidence, specification, 2:9

INDISPENSABLE PARTIES
Case or controversy, standing, 8:3

INDUCING INFRINGEMENT
Generally, 3:4

INDUSTRY STANDARDS
Claim interpretation, 2:13

INEQUITABLE CONDUCT
Generally, 5:2 to 5:5
Deceit, intent, 5:5
Disclosure, duty of, 5:3
Intent to deceive, 5:5

Index-8
INDEX

INEQUITABLE CONDUCT
—Cont’d
Materiality, 5:4

INFRINGEMENT
Generally, 3:1 to 3:22, 6:1 to 6:15
All elements rule, 3:14
Amendment-based disclaimer, doctrine of equivalents, 3:17
Arbitration, 8:23
Argument-based disclaimer, doctrine of equivalents, 3:18
Bias, judicial, 8:20
Claim construction, the Markman process, 8:9
preclusion, 8:21
Contributory infringement, 35 U.S.C.A. § 271(c), 3:5
Declaratory judgment, subject matter jurisdiction, 8:2
Dedication, doctrine of equivalents, 3:21
Defenses and Counterclaims (this index)
Design patent claims, literal infringement, 4:9
Discovery, 8:10
Dismissal, 8:6
Disqualification of counsel, 8:25
Doctrine of equivalents, under generally, 3:13
all elements rule, 3:14
amendment-based disclaimer, prosecution history estoppel, 3:17
argument-based disclaimer, prosecution history estoppel, 3:18
limitations, 3:15 to 3:22
particularized testimonial evidence, 3:22
prior art, 3:15
prosecution history estoppel, 3:16 to 3:20

INFRINGEMENT—Cont’d
Doctrine of equivalents, under
—Cont’d
public dedication, 3:21
tangentiality, prosecution history estoppel, 3:20
35 U.S.C.A. § 271(a). See entries throughout this group
unforeseeability, prosecution history estoppel, 3:19
Estoppel equitable, 5:8
waiver (prosecution history estoppel), doctrine of equivalents, 3:16 to 3:20
Evidence
attorney-client and work product privilege, 8:13
doctrine of equivalents, 3:22
Foreign
process infringement under 35 U.S.C.A. § 271(g), 3:8
Inducing infringement, 3:4
Intervening rights, 5:8
Issue preclusion, 8:21
Joint
defense agreements, 8:25
infringement, 35 U.S.C.A. § 271(a), 3:3
Judicial bias, 8:20
Jurisdiction (this index)
Jury trial, 8:14
Laches, defense, 5:8, 5:9
License, defense, 6:2
Literal infringement
analysis, generally, 3:12
design patent claims, 3:9
means-plus-function claims, 3:11
Plant Patent Variety Act claims, 3:10

Index-9
INFRINGEMENT—Cont’d
Literal infringement—Cont’d
35 U.S.C.A. § 271(a), 3:9 to 3:11
Markman process, claim construction, 8:9
Means plus function claims, literal infringement, under 35 U.S.C.A. § 271(a), 3:11
Motion to amend, 8:7
Nonfringingment and other permitted acts, 6:1 to 6:15
Parties, 8:3
Personal jurisdiction, 8:5
PPVA plant patents, 3:10
Preliminary infringement contentions, 8:8
Prior art, doctrine of equivalents, 3:15
Prosecution history estoppel, doctrine of equivalents, 3:16 to 3:20
Public dedication, doctrine of equivalents, 3:21
Right to jury and bifurcation, 8:14
Spoliation, 8:10
Standing, 8:3
Stays, 8:24
Summary judgment, 8:11
Supplemental jurisdiction, 8:4
Tangentiality, doctrine of equivalents, 3:20
35 U.S.C.A. § 271(a), under generally, 3:2
design patent claims, literal infringement, 3:9
doctrine of equivalents, 3:13 to 3:22
joint infringement, 3:3
literal infringement, 3:9 to 3:22
means plus function claims, literal infringement, 3:11
Plant Patent Variety Act claims, 3:10

INFRINGEMENT—Cont’d
35 U.S.C.A. § 271(a), under —Cont’d
PPVA claims, literal infringement, 3:10
35 U.S.C.A. § 271(b), inducing infringement under, 3:4
35 U.S.C.A. § 271(e)(1), regulatory submission use exemption, 6:12
35 U.S.C.A. § 271(c), contributory infringement, 3:5
35 U.S.C.A. § 271(f), foreign assembly infringement under, 3:7
35 U.S.C.A. § 271(g), foreign process infringement under, 3:8
Transfer, 8:5
Unforeseeability, doctrine of equivalents, 3:19
Venue, 8:5
Waiver, 8:25

INHERENT ANTICIPATION
Validity, novelty—35 U.S.C.A. § 102, 4:6

INJUNCTIONS
Generally, 7:2 to 7:6
Bond, 7:5
Contempt, 7:6
Ongoing royalty in lieu of injunction, 7:4
Permanent injunctions, 7:4
Preliminary, 7:3
Temporary, 7:3

INTENT
Inequitable conduct, 5:5

INTEREST
Damages, prejudgment and post-judgment interest, 7:12
LITIGATION MISCONDUCT
   Damages, exceptional case, 7:17

LOST PROFITS
   Damages, 7:10

MARKING
   America Invents Act, selected provisions, App A
   Damages, 7:8

MARKMAN PROCESS
   Infringement, claim construction, 8:9

MATERIALITY
   Inequitable conduct, 5:4

MEANS-PLUS-FUNCTION
   Claim formats, 2:4
   Literal infringement under 35 U.S.C.A. § 271(a), 3:11

MECHANICAL SYSTEMS AND MATERIALS
   Technology, year in review, 12:8

MEDICAL DEVICES
   Methods, technology, year in review, 12:4

METHODOLOGY
   Claim formats, 2:3

MICRO ENTITY
   Defined, America Invents Act (AIA), selected provisions, App A

MISREPRESENTATIONS
   Duty of disclosure, 5:5

MISUSE OF PATENT
   Defenses and counterclaims, 5:6

MOTIONS
   Amend, motion to, 8:7
   Judgment as matter of law, 8:18
   New trial, 8:18
   Relief, motions for, 8:19

NECESSARY PARTIES
   Standing, case or controversy, 8:3

NEW TRIAL
   Motions for, 8:18

NONOBVIOUSNESS
   Validity of patent, 4:15 to 4:19

NOVELTY
   Validity (this index)

OBVIOUSNESS
   Design patents, validity, 4:33
   Validity of patent, 4:15 to 4:19

OMITTED PRIOR ART
   Infringement defense, duty of disclosure, 5:3

ON-LINE MATTERS
   Technology, year in review, 12:6

ON-SALE BAR
   Validity, novelty under 35 U.S.C.A. § 102, 4:8

ORDINARY MEANING
   Claims, canons of interpretation, 2:15

PARTIES
   Standing, 8:3

PATENT AND TRADEMARK OFFICE
   Patent Office Proceedings (this index)

PATENT EXPIRATION
   Defenses and counterclaims, infringement exemptions, 6:6, 6:7

PATENT LAW ISSUES
   Year in review, judicial statistical perspective, 14:4

PATENT OFFICE PROCEEDINGS
   Generally, 11:1 to 11:21
INDEX

PATENT OFFICE
PROCEEDINGS—Cont’d
Administration of patent, generally, 1:3
Agent regulation, 11:21
America Invents Act (AIA), selected provisions dealing with civil actions, App A
Applications, examination of, 11:1, 11:2
Attorney regulation, 11:21
Civil action to obtain patent, 11:20
Claim construction, examination, 11:2
Correction, 11:12
Derivation, 11:8
Design patents, 11:10
Interferences, 11:7
Inter partes review, 11:16
Plant patents, 11:9
Post grant review, 11:15
Preissuance submission, 11:18
Reexamination, 11:14
Reissuance, 11:11
Supplemental examination, 11:13
Term adjustment, 11:19
35 U.S.C.A. § 101, rejections under, 11:3
35 U.S.C.A. § 102, rejections under, 11:4
35 U.S.C.A. § 103, rejections under, 11:5
Transitional program for covered business method patents, 11:17

PATENT TRIAL AND APPEAL BOARD
America Invents Act (AIA), selected provisions, App A

PERSONAL JURISDICTION
Generally, 8:5

PHARMACEUTICALS
Technology, year in review, 12:3

PLANTS
Patent office proceedings, 11:9
PPVA plant patent infringement, 3:10

POST-GRANT REVIEW
America Invents Act, selected provisions, App A
Patent office proceedings, 11:15

POSTJUDGMENT INTEREST
Damages, 7:12

PPVA PLANT PATENTS
Literal infringement under 33 U.S.C.A. § 271(a), 3:10

PREAMBLES
Claim format, 2:2

PREEMPTION OF LAWS
Defenses and counterclaims, 6:11

PREFERRED EMBODIMENT
Claims, interpretation, 2:14

PREISSUANCE SUBMISSION
Patent office proceedings, 11:18

PREJUDGMENT AND POSTJUDGMENT INTEREST
Damages, 7:12

PRELIMINARY INJUNCTIONS
Remedies, 7:3

PREVAILING PARTY
Damages, exceptional case, 7:18

PRIOR ART
America Invents Act, selected provisions, App A
Duty of disclosure, omitted prior art, 5:3

Index-13
PRIOR ART—Cont’d
Infringement, doctrine of equivalents, 3:15

PRIOR INVENTION
Validity, novelty—35 U.S.C.A. § 102, 4:14

PRIORITY
America Invents Act (AIA), selected provisions, App A
Validity of patent, 35 U.S.C.A. §§ 119, 120, 4:25

PRIOR USE
America Invents Act (AIA), selected provisions, App A
Defenses and counterclaims, 6:15

PRODUCT-BY-PROCESS CLAIMS
Claims formats, 2:5

PROSECUTION DISCLAIMER
Claim interpretation, 2:17

PROSECUTION HISTORY
Claim interpretation, 2:10, 2:11

PTO
Patent Office Proceedings (this index)

PUBLICATION
Applications, America Invents Act (AIA), selected provisions, App A

PUBLIC DEDICATION
Infringement, doctrine of equivalents, 3:21

PUBLIC USE BAR
Validity, novelty—35 U.S.C.A. § 102, 4:7

RECAPTURE
Validity, 4:32

RECONSTRUCTION
Defenses and counterclaims, 6:3

REDUCTION TO PRACTICE
Validity, inventorship, 4:28

REEXAMINATION
Patent Office proceedings, 11:14

REISSUANCE
Patent Office proceedings, 11:11

REJECTED PATENTS OR APPLICATIONS
Patent Office Proceedings (this index)

REMEDIES
Generally, 7:1 to 7:22
Attorney’s fees, 7:19
Contempt, 7:6
Costs, 7:13
Damages (this index)
False marking, 7:8
Injunctions, 7:2 to 7:6
Introduction, 7:1
Marking, 7:8
Motions for relief, 8:19
Ongoing royalty in lieu of injunction, 7:4
Permanent injunctions, 7:4
Postjudgment interest, 7:12
Preissuance rights, 7:22
Prejudgment interest, 7:12
Preliminary injunctions, 7:3
Provisional rights, 7:22
Reasonable royalty, 7:11
Remittitur, 7:21
Sanctions, 7:20
Temporary injunctions, 7:3
Time limitation, 7:9
Willful infringement, enhanced damages, 7:15, 7:16

REMITTITUR
Damages, 7:21

REPAIR
Defenses and counterclaims, 6:3
INDEX

REPORTING REQUIREMENTS
Government contracts, 13:3

RESEARCH
Defenses and counterclaims, common law exemption, 6:13

REVIEW
Appeal and Review (this index)

ROYALTIES
Ongoing royalty in lieu of injunction, 7:4
Reasonable royalty, 7:11

SANCTIONS
Generally, 7:20
Damages, 7:20

SECONDARY CONSIDERATIONS
Validity, nonobviousness under 35 U.S.C.A. § 103, 4:18

SECRECY
Government contracts, patent secrecy, 13:5

SECRET PRIOR ART
Validity, novelty—35 U.S.C.A. § 102, 4:12
§ 207
Administrative Procedures Act, sovereign immunity for U.S. government action, 6:10

SOVEREIGN IMMUNITY
Defenses and counterclaims, 6:9, 6:10
§ 1498(a) immunity
sovereign immunity for U.S. government action, 6:10
Waivers under Administrative Procedures Act Section 702, 6:10

SPECIFICATION
America Invents Act (AIA), selected provisions, App A

SPECIFICATION—Cont’d
Claim interpretation, 2:9

SPOLIATION
Infringement, discovery, 8:10

SPORTS
Technology, year in review, 12:10

STANDING
Generally, 8:3

STATE LAW
Alternative trial forums, 9:7
Defenses and counterclaims, Eleventh Amendment immunity, 6:9

STATISTICS
Year in review, judicial statistics, 14:1 to 14:5

STATUTORY AUTHORITY
Generally, 1:2

STAYS
Infringement, 8:24

SUBJECT MATTER
Jurisdiction (this index)
Validity, subject matter under 35 U.S.C.A. § 101, 4:2

SUMMARY JUDGMENT
Generally, 8:11

SUPPLEMENTAL EXAMINATION
America Invents Act (AIA), selected provisions, App A
Patent office proceedings, 11:13

SUPPLEMENTAL JURISDICTION
Generally, 8:4

SUPREME COURT DECISIONS
Infringement litigation, 10:9

Index-15
TANGENTIALITY
Infringement, doctrine of equivalents, 3:20

TEACHING AWAY
Validity, nonobviousness under 35 U.S.C.A. § 103, 4:17

TECHNOLOGY SPECIFIC LITIGATION
Generally, 12:1 to 12:13
Agriculture, 12:11
Biologics or pharmaceuticals, 12:3
Biotechnology, 12:2
Business methods, 12:9
Chemicals, 12:2
Computer
   hardware, 12:5
   software, 12:5
Consumer products, 12:12
Designs, 12:13
Electronics, 12:7
Environmental matters, 12:11
Food technology matters, 12:11
Gaming, 12:10
Internet, 12:10
Mechanical systems and materials, 12:8
Medical devices and methods, 12:4
Pharmaceuticals, 12:3
Sports, 12:10
Telecommunications, 12:6
Toys, 12:10
Year in review, 12:1 to 12:13

TELECOMMUNICATIONS
Technology, year in review, 12:6

TEMPORARY INJUNCTIONS
Remedies, 7:3

TEMPORARY PRESENCE
Defenses and counterclaims, 6:4

TERM ADJUSTMENT
Patent office proceedings, 11:19

TERM EXTENSION
Defenses and counterclaims, infringement exemptions, 6:7

TESTIMONY
Claim interpretation, expert testimony, 2:13
Infringement, doctrine of equivalents, 3:22

35 U.S.C.A. § 101
Patent office proceedings, rejections, 11:3

35 U.S.C.A. § 102
Validity (this index)
Patent Office proceedings, rejections, 11:4

35 U.S.C.A. § 103
Analogous prior art, nonobviousness under 35 U.S.C.A. § 103, 4:16
Double patenting, nonobviousness under 35 U.S.C.A. § 103, 4:19
Patent Office proceedings, rejections, 11:5
Secondary considerations, nonobviousness under 35 U.S.C.A. § 103, 4:18
Teaching away, nonobviousness under 35 U.S.C.A. § 103, 4:17
Validity, nonobviousness under 35 U.S.C.A. § 103
generally, 4:15 to 4:19
analogous prior art, 4:16
double patenting, 4:19
secondary considerations, 4:18
teaching away, 4:17

35 U.S.C.A. § 112
Patent Office proceedings, rejections, 11:6
Validity (this index)
INDEX

35 U.S.C.A. § 271(a)
Infringement (this index)

35 U.S.C.A. § 271(b)
Inducing infringement under, 3:4

35 U.S.C.A. § 271(c)
Contributory infringement, 3:5

35 U.S.C.A. § 271(e)(1)
Infringement, regulatory submission use exemption, 6:12

35 U.S.C.A. § 271(e)(2)
FDA filing infringement, 3:6

35 U.S.C.A. § 271(f)
Foreign assembly infringement, 3:7

35 U.S.C.A. § 271(g)
Foreign process infringement under, 3:8

TIME LIMITATION
Damages, 7:9

TIME PERIOD
Prior use, defenses and counterclaims, 6:15
Year in review, statistical perspective, 14:5

TOYS
Technology, year in review, 12:10

TRADE REGULATION
Defenses and counterclaims, 5:6

TRANSFER
Appellate jurisdiction, mandamus, 10:6
Infringement, 8:5

TRANSITIONAL PHRASES
Claim format, 2:2

TRANSITIONAL PROGRAM
Patent office proceedings, covered business method patents, 11:17

TREATISES
Claim interpretation, 2:12

TRIAL ISSUES
Generally, 8:1 to 8:25
See also other entries throughout this index

U. S. CONSTITUTIONAL AUTHORITY
Generally, 1:2

UNCLEAN HANDS
Defense to infringement, 5:7

UNFAIR COMPETITION
Defenses and counterclaims, 5:6

UNFORESEEABILITY
Infringement, doctrine of equivalents, 3:19

U.S. COURT OF FEDERAL CLAIMS
Alternative trial forums, 9:2

U.S. COURT OF INTERNATIONAL TRADE
Alternative trial forums, 9:3

U.S. DISTRICTS
Year in review, activity by District, 14:3

U.S. FEDERAL TRADE COMMISSION
Infringement, 9:6

U.S. SUPREME COURT DECISIONS
Infringement litigation, 10:9

U.S. TAX COURT
Alternative trial forums, infringement, 9:5

UTILITY
Validity, utility under 35 U.S.C.A. § 101, 4:3

Index-17
VALIDITY
Generally, 4:1 to 4:33
Abandonment, loss of rights, novelty—35 U.S.C.A. § 102, 4:10
America Invents Act (AIA), selected provisions, App A
Anticipation, inherent, novelty—35 U.S.C.A. § 102, 4:6
Best mode requirement, 4:22
Claim interpretation, reserving validity, 2:19
Conception, inventorship, 4:27
Correction to inventorship, 4:31
Corroboration, inventorship, 4:29
Definiteness, 4:23
Dependency, 4:24
Derivation, novelty—35 U.S.C.A. § 102, 4:13
Design patents, functionality and obviousness, 4:33
Disclosure
   enabling, novelty under 35 U.S.C.A. § 102, 4:5
   requirements, 35 U.S.C.A. § 112
      best mode requirement, 4:22
      definiteness, 4:23
      dependency, 4:24
   enablement requirement, 4:21
   written description, 4:20 to 4:24
Double patenting, 4:19
Enablement requirement, 4:21
Experimental use bar, novelty—35 U.S.C.A. § 102, 4:9
Foreign activity, novelty—35 U.S.C.A. § 102, 4:11
Functionality, design patents, 4:33
Inherent anticipation, novelty—35 U.S.C.A. § 102, 4:6
Inventorship
   generally, 4:26

VALIDITY—Cont'd
Inventorship—Cont'd
America Invents Act, selected provisions, App A
conception, 4:27
   correction to inventorship, 4:31
   corroboration, 4:29
   joint invention, 4:30
   reduction to practice, 4:28
Joint invention, inventorship, 4:30
   abandonment, 4:10
   experimental use, 4:9
   on sale bar, 4:8
   public use bar, 4:7
Nonobviousness under 35 U.S.C.A. § 103, 4:15 to 4:19, App A
Novelty under 35 U.S.C.A. § 102
   generally, 4:4 to 4:14
   abandonment, loss of rights, 4:10
   America Invents Act, selected provisions, App A
derivation, 4:13
disclosure, enabling, 4:5
   experimental use, loss of rights, 4:9
foreign activity, 4:11
   inherent anticipation, 4:6
   on sale bar, loss of rights, 4:8
   prior invention, 4:14
   public use bar, loss of rights, 4:7
secret prior art, 4:12
Obviousness, design patents, 4:33
Obviousness under 35 U.S.C.A. § 103, 4:15 to 4:19
On sale bar bar, novelty—35 U.S.C.A. § 102, 4:8
Printed publication, public use bar, novelty—35 U.S.C.A. § 102, 4:7
INDEX

VALIDITY—Cont’d
Prior invention, derivation—35
U.S.C.A. § 102, 4:14
Priority, 35 U.S.C.A. §§ 119, 120,
4:25
Public use bar, novelty—35
U.S.C.A. § 102, 4:7
Recapture, 4:32
Reduction to practice, inventor-
ship, 4:28
Secret prior art, novelty—35
U.S.C.A. § 102, 4:12
Subject matter under 35 U.S.C.A.
§ 101, 4:2, 4:3
35 U.S.C.A. § 101, subject matter,
4:2, 4:3
35 U.S.C.A. § 102, above
35 U.S.C.A. § 103, nonobvious-
ness, 4:15 to 4:19
requirements, 35 U.S.C.A. § 112, above
35 U.S.C.A. §§ 119, 120, priority,
4:25
Utility under 35 U.S.C.A. § 101,
4:3

VENUE
Generally, 8:5
Government contracts, venue for
patent disputes with federal
government, 13:2

VERDICT
Damages, remittitur, 7:21
Infringement litigation, 8:16

WAIVER
Estoppel and Waiver (this index)

WILLFUL INFRINGEMENT
Enhanced damages, 7:15, 7:16

WRITTEN DESCRIPTION
Claim interpretation, 2:7 to 2:11
Validity, 4:20 to 4:24

YEAR IN REVIEW
Generally, 12:1 to 12:13, 14:1 to
14:5
Agriculture, 12:11
Biologics or pharmaceuticals, 12:3
Biotechnology, 12:2
Business methods, 12:9
Chemicals, 12:2
Circuit judge, activity by, 14:1
Computer
hardware, 12:5
software, 12:5
Consumer products, 12:12
Designs, 12:13
District courts, 14:3
Electronics, 12:7
Environmental matters, 12:11
Federal Circuit judge, activity by,
14:1
Food technology matters, 12:11
Gaming, 12:10
Internet, 12:10
Judicial statistical perspective,
14:1 to 14:5
Jurisdiction, activity by, 14:2,
14:3
Mechanical systems and materials,
12:8
Medical devices and methods,
12:4
Patent law issue, activity by, 14:4
Pharmaceuticals, 12:3
Sports, 12:10
Statistical perspective, judicial,
14:1 to 14:5
Technology Specific Litigation
(this index)
Telecommunications, 12:6
Time period, activity by, 14:5
Toys, 12:10
Trial forum, 14:2
U.S. Districts, activity by, 14:3