Introduction to the Twenty-Third Edition (2021)

For any patent practitioner or researcher *Modern Patent Law Precedent: Dictionary of Key Terms and Concepts* is the first place to turn for a quick, up-to-date, on-point reference to developments in this burgeoning body of law. This book is designed to be useful in a number of ways, including the following: ascertaining basic prevailing practice and doctrines, addressing issues while preparing responses to Office Actions of the United States Patent and Trademark Office (PTO), addressing litigation issues, and accessing precedent while drafting appeal briefs. Modern Patent Law Precedent may also serve as a supplemental reference for teaching patent law and practice and as a handbook for both patent practitioners and others who are concerned with patent rights.

The 23rd Edition of *Modern Patent Law Precedent: Dictionary of Key Terms and Concepts* includes analysis of recent Federal Circuit and Supreme Court decisions covering a wide variety of issues, including, for example, decisions impacting the following topics:

- Abstention
- Anticipation
- Appellate Jurisdiction
- Attorneys Fees
- CBM
- Claim Construction
- Correction of Inventorship
- Damages
- Design Patents
- Hatch-Waxman
- Indefiniteness
- Inducement
- Infringement
- IPR
- Issue Preclusion
- Joint Owner
- Laches
- Mandamus
- Obviousness
- Patent Eligibility
- Prior Art
- PTAB
- Standing
- Summary Judgment
- Trial Conduct
- Venue
- Waiver
- ... and other topics
Dedications

This book is dedicated to my children, Karen, Sandy, David and Steven, to H. Jane Barton, her sons, John and Tom, and in memory of her son, Peter.

—Irwin M. Aisenberg
Founding Author

The work of updating this book for the most recent editions builds on a stable foundation made by Patent Attorney Irwin M. Aisenberg, and all updating is dedicated and indebted to him.

—Jerry Cohen
Updating Author
About the Founding Author

Irwin M. Aisenberg is a former partner in the Washington, D.C. law firm of Jacobson Holman, PLLC. An active patent practitioner for over 40 years and former patent examiner, Mr. Aisenberg (now retired) has written widely over the years on all aspects of patent prosecution, claims, and litigation.

In addition to lecturing and publishing numerous articles relating to patent law and practice, Mr. Aisenberg has served on the Editorial Advisory board of several leading patent law publications and was a member of the District of Columbia and American Bar Associations as well as the American Intellectual Property Law Association and the International Association for the Protection of Industrial Property.

About the Updating Author

Jerry Cohen is a senior partner in the Boston law firm, Burns & Levinson LLP. He actively practices in all areas of intellectual property law; teaches IP courses at Roger Williams School of Law (Bristol, RI) and UMass. Law School (Dartmouth, MA); is an arbitrator/mediator with JAMS Inc. and has served on Editorial Boards of Massachusetts Law Review, Rhode Island Bar Journal, AIPLA Journal and U.S. Patent Quarterly 2d; and as President of the Massachusetts Bar Foundation and of the Boston Patent Law Association. He is a member of the ITC Trial Lawyers Association and co-chairs the Boston Patent Law Association’s ITC Practice Committee.
Introduction

Patent law is increasingly driven by the rapid pace of technological change and the necessity of fitting a traditional body of law and doctrine to ever-new and novel applications. This phenomenon has been paralleled by an increase in the economic importance of patents. In this environment, even the most experienced patent professionals can find themselves swimming in a flood of precedent they are obliged to know and respect.

Some attorneys try to keep current with evolving case law by reading advance sheets as they are published. Even so, while working on their own cases, many practitioners find it difficult to maintain a broad general view.

Consequently, a reference work is needed that will provide a quick point of access to the burgeoning body of case law. This book, which is based on many years of compilation, is just such a tool. It is a handy desk reference with immediate and easy access to relevant cases.

The book is designed to be useful in a number of ways. These include: ascertaining basic prevailing practice and doctrines, addressing issues while preparing responses to Office Actions of the United States Patent and Trademark Office (PTO), addressing litigation issues, and accessing precedent while drafting motions, appeal briefs and other submissions to the PTO’s Patent Trial and Appeal Board (PTAB) and to Article III Courts and Article I Courts (e.g. International Trade Commission). Modern Patent Law Precedent may also serve as a supplemental reference for teaching patent law and practice and as a handbook for both patent practitioners and others who are concerned with patent rights, including inventors, licensing and technology transfer groups, company managements, investors, government regulatory personnel of PTO and other federal agencies and, last not least, dispute resolution people (judges, magistrate judges, arbitrators, and mediators).

The basic principle of the patent system is to protect inventions which meet the statutory requirements. Valuable inventions should be given protection of value in the real world of business and the courts, while improvidently granted patent claims should be invalidated in courts or by the PTO in post-issuance proceedings or better yet blocked from issuance.

The inherent tensions in the patent system, however, immediately introduce complications:

The public purpose on which the patent law rests requires the granting of claims commensurate in scope with the invention disclosed. This requires as much the granting of broad claims on broad inventions as it does granting of specific claims on more specific inventions. It is neither contemplated by the public purpose of the patent laws nor required by the statute that an inventor shall be forced to accept claims narrower than his invention in order to secure allowance of his patent. In re Sus and Schaefer, 306 F.2d 494, 134 U.S.P.Q. 301, 304 (C.C.P.A. 1962).

In theory, the ideal patent would depend on a perfect fit between the claims and the invention. To achieve or to scrutinize this fit, however, patent professionals are
obliged to apply an enormous amount of scientific, technical, and legal learning.

The book places considerable emphasis on diverse issues that arise before the United States Patent and Trademark Office (PTO) during prosecution of applications for letters patent, as well as extensive material even more relevant to patent litigation, sale and licensing of patent rights and other forms of exploitation of such rights.

The text presents court holdings and context, often in the language from cited decisions or close paraphrases thereof. The evaluation and interpretation of these opinions, however, necessarily depends upon the actual facts and issues of each case, upon the nature of the proceeding, and upon the tribunal in which the case was heard. Factors relating to prosecution of an application for patent, reissue, post grant, inter partes and business methods review along with ex parte reexamination, and derivation proceedings, preliminary or permanent injunctions, summary judgments, verdicts, judgments, damages, JMOL, and appeals may all significantly influence the relevance of reported statements. The advice of In re Ruscetta and Jenny, 255 F.2d 687, 118 U.S.P.Q. 101, 103 (C.C.P.A. 1958), is pertinent:

Undue liberties should not be taken with a court or agency decision, which should be construed in accord with the precise issue before the court or agency. A fertile source of error in patent law is the misapplication of a sound legal principle established in one case to another case in which the facts are essentially different and the principle has no application whatsoever.

Users of this work will be accorded access to a vast array of precedent, including that which may bear precisely on the factual details of their own work.

In addition to the discussion of individual terms, the system of cross references in this book is a quick guide through the maze of interrelated issues and concepts. Many of these interconnections are far from obvious. For example, a practitioner who begins by looking up the entry for Estoppel will immediately find access to a network of cases dealing with such related topics as Assignor Estoppel, Collateral Estoppel, File Wrapper, Marking and Prosecution Disclaimer. This is only one example of the flexibility of approach we have created for this text generally.


This publication is also available on Westlaw® Database Identifier: MPATLAWP
How To Use This Book

The words and phrases covered in this book have been drawn from a variety of sources: (1) key terms from the United States Code; (2) particular terms that have sometimes raised problems in claims challenged by PTO Examiners; (3) terms of art; and (4) general legal concepts as they apply to patent law. In addition, the book includes a variety of scientific and technical entries.

Entries keyed to statutory provisions refer to related concepts. Title 35 of the United States Code (the Patent Act of 1952, as amended by several later statutes including, e.g. the America Invents Act (2011), the American Inventors Protection Act (1999), the Uruguay Round Amendments Act (1994) and the America Invents Act (2011)) is the basic patent statute and 37 C.F.R., part 1, provide relevant regulation as to PTO practice. Section 100 (35 U.S.C. § 100), for instance, refers to such terms as Art, Composition, Invention, Manufacture, Material, Method, New Use, Patent, and Process. Section 102 refers to Invention, Novelty, On Sale, Printed Publication, and Public Use. Section 103 refers to Obviousness, Ordinary Skill, Prior Art, and Subject Matter as a Whole. These key terms all have appropriate entries, along with others corresponding to further sections of Title 35. Statutory provisions and concepts outside 35 U.S.C. affecting patent law and practice include, Title 28, the Judicial Code (28 U.S.C. secs. 1331, 1338, 2498), the Bankruptcy Act (e.g., 11 U.S.C. sec. 365n), the Tariff Act of 1930 (19 U.S.C. § 1337), antitrust laws and health laws (e.g. the Food, Drug and Cosmetics Act, the Hatch-Waxman Act and the Biological Price Competition and Innovation Act) including their provisions for regulating marketing and use of pharmaceuticals/biologics and medical instruments in relation to patent rights and law relating to government contracts and grants and to technological innovation, and implementing regulations.

Drawing upon practical experience, this work also contains entries for particular words found in claims that have sometimes been challenged by PTO Examiners. These terms include About, Acid, Adapted, Alkyl, An, Approximately, Aromatic, Automatic, Comprise, Consisting, Effective, and Substantially. Most of these entries assume some familiarity with patent law and practice.

In addition to terms used in the statutes, regulations, or in actual claims, the book also discusses numerous legal terms in patent law, such as Abandoned Experiment, All Claims Rule, Allowed Application, Analogous Art, Antecedent Basis, Anticipation, Markush group, Overclaiming, Reference, and Restriction.

The book also discusses such general legal concepts as Abuse of Discretion, Action, Administrative Regularity, Antitrust, Best Evidence, Consent Judgment, Damages, Estoppel, JMOL, Preliminary Injunction, Privilege, and Summary Judgment.

The preceding paragraphs merely indicate the framework on which this book was created. Repeatedly faced issues, such as Breadth, Combining References, Double Patenting, Enablement and Indefiniteness are also included, along with numerous other relevant considerations.

Related entries are cross-referenced. Quoted text, therefore, does not necessarily include the particular word or expression under which it is found. The entry for At-
torney leads to Advice of Counsel, Affidavit, Attorney’s Fees, Billings, Conclusions, Conduct, Disqualification, Docket Number, Opinion, Privilege, Work Product Doctrine. The entry for Breadth leads to Indefiniteness, Inoperative Embodiments, Overclaiming, 35 U.S.C. § 112. Such cross-referencing facilitates finding pertinent text from published cases.

Under each entry cases are cited in chronological order and thus reflect, in some instances, historical development or changes of court pronouncements of rules of law, sometimes forced by a change of statute or regulation and sometimes a change of outlook in the absence of relevant statutory or regulatory change (including, it must be said, changes of tribunal personnel in courts and in the PTO or other administering agencies). All entries under any heading of interest should be considered in making an evaluation of current practice, predictability and areas of likely change by statute, regulation and/or new directions of case law precedents.

Whenever any issue is being researched and relevant material is found in language cited in this work, it is always necessary to refer to text of the cited case to make certain that the facts adequately correspond to those of the matter involved. If not, the cited case may refer to others which are even more pertinent. Before citing a particular case, the case should always be checked using Keycite on Westlaw® (or other electronic data base resources) to make certain that further proceedings in the case itself do not modify or reverse the decision or affirm on different grounds or that the precedent relied upon or established in the case has not been modified or even over-ruled in a later case.

In evaluating any statement taken from a court’s opinion, the opinion should be reviewed to obtain an understanding of the context in which the statement was made. Due consideration should be accorded the nature of the involved proceeding (ex parte, interference, de novo, judgment after trial, appeal, infringement, validity, declaratory judgment, summary judgment) and the nature of the issue (one under the exclusive jurisdiction of the Federal Circuit or one decided under regional circuit precedent).

It is also necessary to consult statute and regulation developments and their effective dates, set against court opinions dealing with case facts occurring pre- and post- such effective dates.

Last but not least, the language of patent law and practice, including acronyms evolves, Interferences are ended, except for legacy cases and replaced in part by derivation proceedings through the change from first-to-invent to first-inventor-to-file. The Court of Customs and Patent Appeals (C.C.P.A.) of earlier days was replaced by the Court of Appeals for the Federal Circuit (CAFC or Fed. Cir.) and the PTO Board of Appeals of Patent Appeals and Interferences (BPAI) and that in turn by Patent Trial and Appeal Board (PTAB). The legal fiction of the prototypical person of ordinary skill in the art (POSA) continues. Great portions of patent litigation involve deemed acts of infringement under the Hatch-Waxman Act by filing an Abbreviated New Drug Application (ANDA) with the Food and Drug Administration (FDA) and in suits brought by new classes of patent owners/plaintiffs styled Patent Assertion Entities (PAEs), Non-Practicing Entities (NPEs), trolls and other appellations. This book, among other uses, helps to track and understand that evolution.
Important Transition

In going from the prior Thirteenth Edition to the Fourteenth through Seventeenth Editions and the present Twenty Third Edition, note that the content of the book has been limited to precedents of the period from January 1, 2000 to June 30, 2020. Older (pre-2000) precedents under the same topic headings can be found in the prior Thirteenth Edition running from the 1976 beginning up to December 31, 2011. This change was done to make the book more manageable physically, for efficiency of searching and because newer precedents, to a great degree, repeat the doctrines of older ones, and in some instances expand their scope, over-rule them or otherwise modify them to limit their precedential force. Where useful, the abstracts or extracts from recent cases of the 2000-June 30, 2020 range of this Twenty Third Edition show citations made in the recent case to older cases.

Contact Information

The Publisher and updating author welcome questions/observations about this book’s past, present and future editions.

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