Preface to *Patent Prosecution Case Digest on CD-ROM*, and Suggestions for How to Use the Materials

The case digest and accompanying materials appear on the CD-ROM contained in the envelope at the back of this supplement to the main volumes of *Patent Prosecution, Seventh Edition*. The information is presented in a format that can be easily searched and stored. The CD-ROM also contains all of the appendix material. The contents list for both the case digest and the appendixes are provided in print in the Detailed Table of Contents in the front of this book, as well as on the CD-ROM.

When prosecuting U.S. patent applications, oftentimes an Examiner refuses to allow a patent for reasons not supported by current law. If the patent attorney can in turn cite a relevant decision favorable to the applicant, the Examiner is then forced to review the cited decision and determine whether, in fact, the cited decision governs the grant of a patent. To assist attorneys to find favorable decisions, the Case Digest is organized in accordance with the common rejections received from the U.S. Patent Office. To assist the patent attorney or patent agent in overcoming the most common rejections—and to permit easy insertion of into Amendments or Responses to Official Actions—the case digest materials include self-explanatory quotes from important decisions from the Supreme Court, the Federal Circuit, the Court of Customs and Patent Appeals, and the Board, followed by quotes from PTO publications, if any, followed by quotes from treatises, if any. Within each of those three categories (decisions, PTO publications, treatises), entries appear in reverse chronological order (i.e., most recent first). Category entries appear in the table of contents in both the print supplement and on the CD for the convenience of the user.

As noted, not all sections of the Case Digest have all three types of entries. References to cases cited in the Case Digest are incorporated into the Table of Cases for this treatise, by section number.

Of course, there is no guarantee that the Examiner will in fact follow the cited decision(s), but citing legal opinions to an Examiner will also assist the patent attorney or patent agent in defining the appropriate issues.
that might be appealed, where the decision is unfavorable to an attorney’s client, to the Board of Patent Appeals and Interferences (the Board).

The Case Digest includes additional case law predating the 1952 Patent Act, including decisions at the U.S. Patent Office. As indicated previously, the 1952 Act has altered the precedential effect of many of these cases, and therefore the reader is cautioned not to cite these early cases without confirming their precedential status. Nevertheless, these cases continue to illuminate the purposes, if not always the present-day mechanisms, of U.S. patent law. For this reason, I believe you will find them useful.

To use these products, I recommend that you first familiarize yourself with the Case Digest by reviewing the table of contents. You may use either the printed table of contents or the table of contents on the CD to identify and locate the basic legal issues. Note the outline number associated with that issue (e.g., “Anticipation of Ranges in a Claim” would be “III.M.” or “Obviousness and Applicant’s Statements/Admissions as Prior Art” would be “V.P.”), and then, on the CD, link from the table of contents to the specific section you wish to review. Once at the beginning of the legal issue, you can simply browse through all quotes in that section, or you can search for a specific word or phrase.

You can aid your search and save keystrokes by using the CD-ROM’s text files in your word processor, where entries for previous volumes have been combined, with most recent entries first. The file is in Microsoft Word® format. (Microsoft® and Microsoft® Word are either registered trademarks or trademarks of Microsoft Corporation in the United States and/or other countries.)

Because of the dynamic nature of patent law, regular updates to this Case Digest are planned. However, this product can only improve with feedback from those who use it. I therefore ask for your help as a reader. If there are any quotes that you think should be included, please send them to my attention. Suggestions regarding improvements to this book and to the CD-ROM would also be greatly appreciated. Please send comments to me c/o Bloomberg BNA Editorial Offices, 1801 S. Bell Street, Arlington, VA 22202, or e-mail: books@bna.com.

Special thanks to Barbara Gabor, who, as always, spends much time patiently reviewing and verifying the numerous citations in this Case Digest.

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