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PATENT PROSECUTION: LAW, PRACTICE, AND PROCEDURE, EIGHTH EDITION

By Irah H. Donner

“"To say that Patent Prosecution is a comprehensive resource both for experienced patent practitioners, as well as new aspirants, is an understatement.”

—David J. Kappos, from the foreword
Partner, Cravath, Swaine & Moore LLP
Former Under Secretary of Commerce and Director of the U.S. Patent and Trademark Office

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Patent Prosecution: Law, Practice, and Procedure, Eighth Edition addresses the wealth of changes in patent law wrought by the passage of the Leahy-Smith America Invents Act (AIA), recent court decisions, and statutory amendments. This treatise provides essential analysis of over 45 decisions of the Supreme Court, the Federal Circuit, and the Board of Patent Appeals and Interferences. It also explains prosecution rules from the U.S. Patent and Trademark Office (PTO) and offers an element-by-element analysis of areas of law that form the basis of common PTO rejections and objections.

The Eighth Edition covers many important cases, including the Supreme Court’s ruling in Mayo Collaborative Services v. Prometheus Laboratories, Inc., and discusses PTO guidelines that set forth a new procedure for examining subject matter eligibility in view of this decision. It also analyzes the second, 9-0, Supreme Court decision in Hyatt v. Kappos, allowing a patent applicant greater freedom to introduce new evidence to a district court.


The Eighth Edition explores the AIA in detail, by explaining Patent Office final rules for the pre-issuance submission by third parties of prior art in pending applications. An accompanying searchable CD-ROM offers a comprehensive Cumulative Case Digest in HTML format, providing access to an extensive compilation of precedential language. Organized by specific issue, in favor of patentability, it contains excerpts from leading cases through December 31, 2012, and updated forms to reflect changes, with instructions, introduced by the AIA.

SUMMARY OF CONTENTS

Chapter 1. Patent Protection
Chapter 2. Prosecution and Appeals
Chapter 3. Prosecution History
Chapter 4. Inventorship
Chapter 5. Antedating Prior Art
Chapter 6. Exceptions to Patentable Subject Matter
Chapter 7. Anticipation Standard
Chapter 12. Related Application and Priority Issues
Chapter 13. Design Patent Requirements
Chapter 14. Post-Issuance Actions: Reissue, Reexamination, Certificates of Correction, and Maintenance Fees
Chapter 15. Practical Guidelines for Drafting Patent Opinions
Table of Contents for Case Digest
Appendices
Materials Table of Cases
Table of Statutes and Regulations
Index

ABOUT THE AUTHOR

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Visit www.bna.com/bnabooks/ppp for more detailed information.
Post-Grant Patent Practice provides guidance to patent professionals regarding all United States Patent and Trademark Office (PTO) post-issuance procedures that are designed to address possible mistakes made during the prosecution of a patent application, including mistakes made by the PTO. Written by four former PTO Administrative Patent Judges, this treatise marks a turning point between the ebb of the first-to-invent system and the flow of the “first-inventor-to-file” system, capturing the full nuance of the still-persisting “patent interference” practice before the PTO and the now-superseded “inter partes reexamination.”

Post-grant practice has expanded significantly due to the availability of inter partes proceedings, particularly those introduced by the America Invents Act (AIA). Post-Grant Patent Practice analyzes the procedures introduced by the AIA beginning September 16, 2012, both in text and in charts, explaining them from pre-filing considerations through appeal to the U.S. Court of Appeals for the Federal Circuit, or, alternatively, to a district court and then the Federal Circuit. Analyzed procedures consist of inter partes and post-grant review—including the transitional program for covered business method patents; supplemental examination; and derivation practice. The treatise also examines many other important procedures, including reissue, ex parte and inter partes reexamination, disclaimers, certificates of correction, and interference practice under the new rules.

SUMMARY OF CONTENTS

Chapter 1. Introduction: An Overview of the New Legal Landscape of Post-Grant Patent Practice
Chapter 2. Reissue
Chapter 3. Ex Parte Reexamination
Chapter 4. Supplemental Examination Under the AIA
Chapter 5. Inter Partes Reexamination
Chapter 6. Other Post-Grant Practices: Disclaimers and Certificates of Correction
Chapter 7. Appellate Review by the Patent Trial and Appeal Board
Chapter 9. Practice Before the Patent Trial and Appeal Board
Chapter 10. Post-Grant and Inter Partes Review
Chapter 11. Derivation Proceedings

Chapter 12. Comparison of Post-Grant Procedures (Charts)
Chapter 13. Concurrent Reissue, Reexamination, and Interference Proceedings
Chapter 14. Petitions in Reexamination, Reissue, and Interference Practice
Chapter 15. The Duty of Disclosure and the Inequitable Conduct Defense in Post-Grant Practice
Chapter 16. Judicial Review of Board Decisions in Post-Grant Practice
Chapter 17. Strategic Considerations
Chapter 18. Epilogue
Appendix: Leahy-Smith America Invents Act Tables of Cases
Table of Laws, Regulations, and Rules
Index

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Drafting Patents for Litigation and Licensing helps practitioners draft the broadest possible patent by synthesizing and applying lessons from case law to sustain a validity challenge. Nearly every day, the courts provide patent practitioners with guidance on how best to comply with the requirements of the patent statute. This treatise offers an organized review of these lessons and guidance for applying them. It contains in-depth discussions of errors in claim drafting, dangers of means-plus-function clauses in claims, strategies to target direct infringers, recent trends regarding the scope of enablement, pitfalls with provisional patent applications, and tactics for continued prosecution of patents.

The 2012 Cumulative Supplement provides significant updates and analyses of the latest cases and legislation, including:

- The Leahy-Smith America Invents Act
- Mayo Collaborative Services v. Prometheus Laboratories
- Bilski v. Kappos
- Stanford v. Roche
- Blackboard, Inc. v. Desire2Learn Inc.
- The en banc decision in Egyptian Goddess v. Swisa
- Quanta Computer v. LG Electronics
- The en banc decision in Ariad Pharmaceutical v. Eli Lilly

SUMMARY OF CONTENTS

Chapter 1. The State of the Law of Claim Construction and Infringement
Chapter 2. Pitfalls in Patent Drafting
Chapter 3. Drafting the Winning Patent
Chapter 4. Continued Prosecution of the Patent
Chapter 5. Mechanical Patents
Chapter 6. Electrical Patents
Chapter 7. Software, E-Commerce, Internet, and Business Method Patents
Chapter 8. Chemical and Pharmaceutical Patents
Chapter 9. Biotechnology Patents
Chapter 10. Design Patents
Chapter 11. Combining Prosecution with Other Forms of Representation
Chapter 12. Drafting U.S. Patents with a View Toward Europe

ABOUT THE EDITOR-IN-CHIEF

Bradley C. Wright is a senior partner at Banner & Witcoff, Ltd., Washington, DC. He concentrates his practice in patent prosecution, litigation, and counseling, especially in the electrical and computer-related areas, including internet and e-commerce.

Contributing chapter authors are seasoned patent practitioners and members of the ABA Section of Intellectual Property Law.

Since 1984, the American Bar Association (ABA) Section of Intellectual Property Law has advanced the development of intellectual property laws and their fair and just administration. As the forum for rich perspectives and balanced insight on the full spectrum of intellectual property law, the Section serves as the ABA voice—within the profession, before policymakers, and with the public. With nearly 25,000 members, the Section is the largest intellectual property law organization in the world. For more information on Section participation, visit www.americanbar.org/groups/intellectual_property_law.html.

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By Irah H. Donner

The author, driven by the difficulties he faced in mentoring attorneys and agents on the mechanics of patent application drafting, wrote this seminal guide on Constructing and Deconstructing Patents. Walking the reader step-by-step through the complexities of drafting a patent application, this treatise provides a standard methodology that patent attorneys and agents can rely on to simplify the patent application process.

Regardless of the particular type of patent, or the level of its technical subject matter, this book helps ensure each section of the patent application is carefully considered and fully developed before its submission to the U.S. Patent and Trademark Office (PTO). It discusses the major areas of patent law that can affect the strength and vitality of a patent years later.

Patent attorneys and agents engaged in patent application drafting who practice before the PTO will find this book extremely valuable, as will litigators seeking both to understand the construction of patent applications and to deconstruct them during litigation. The detailed, organized presentation makes it accessible as a guide for the new attorney or agent, and its time-tested methodology provides valuable insights for the experienced practitioner, serving as a checklist for each phase of the constructing and deconstructing process.

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