

# Index

- Absolute novelty countries 8–9 *see also*  
Novelty requirement
- Abstracts of patents 17
- African Intellectual Property Organization  
(OAPI), *see* Treaties and Conventions
- African Regional Intellectual Property  
Organization (ARIPO), *see* Treaties  
and Conventions
- Agents, *see* Attorneys and agents
- Agreements  
confidentiality or non-disclosure 8,  
52–53  
joint development 84–85  
license, *see* Licensing of patents,  
Licensing of trademarks
- Agricultural issues, *see* Biotechnology
- Amendment 26
- America Invents Act (AIA) 4  
Derivation proceedings under 153–154  
post-grant actions 28–31  
prior user rights under 31–32, 47, 164,  
185  
public disclosure under 9  
trade secrets under 47, 185
- Appeal 31
- ARIPO (African Regional Intellectual  
Property Organization), *see* Treaties  
and Conventions
- Assigning value to patents 68–72
- Attorneys and agents 1–2, 11, 68, 75–77,  
94, 122–123, 125–126, 128,  
160–161, 166, 167–179, 190–191  
dealing with the aloofness of 174–176  
differences between 167  
need for 75–77  
preparing to work with 168–170  
requests for data or experiments from  
97–98, 175, 176–177  
strategy development using 99–107  
what they want from inventors 168–169  
working arrangements with 171–173
- Bell, Alexander Graham 89
- Best mode requirement 102
- Bilski v. Kappos* decision 12
- Biotechnology 9, 13, 208
- Business method patents 12
- Citation searching 72
- Claims 16–17, 69–72, 113–114,  
152–153  
dependent 16, 106–107  
independent 16, 106–107  
interpretation of 65, 68, 72, 124–126  
Jepson 71–72  
multiple dependent 16–17  
scope of 70–72, 90
- Commercial use bar 9

- Communist countries, intellectual property climate in 108
- Community Patent Convention, *see* Treaties and Conventions
- Competitive advantage 85–86, 111–112, 119–120
- Competitive analysis, information for 67–68, 91–92
- Competitive pace 203–204
- Compulsory licensing 187–188
- Computer
  - business methods, *see* Business methods patents
  - online databases 17, 67–68, 69–70, 91–92, 122, 124
  - software, *see* Software patents
- Coordination of strategies, *see* Strategy, coordination of
- Copyrights 45
- Corporations, approaching with an invention 77
- Countries, techniques to determine the value of 191–193
- Cross-licensing 12–13, 49, 62
- Databases, online 17, 67–68, 69–70, 91–92, 122, 124
- Delayed examination 39
- Delays, patent office 21
- Design patent (Industrial designs) 14
- Derivation proceedings 153–154
- Disclosure of technology
  - control of 93–94, 100–103, 180–183
  - importance of patterns in 66–67
  - public 162–165
- Disclosure requirement 10
- Doctrine of equivalents 126
- Documentation and first-to-invent 153–154
- Dominating patent 56–58
- EAPO, *see* Eurasian Patent Office
- Edison, Thomas 86, 89, 133, 147
- Enabling disclosure 101
- Enforcement climate and enforceability 108, 190–193
- EPC (European Patent Convention), *see* Treaties and Conventions
- ESARIPO, *see* African Regional Intellectual Property Organization (ARIPO)
- Eurasian Patent Convention *see* Treaties and Conventions
- Eurasian Patent Office (EAPO) 43–44
- European Community Patent 41
- European Patent Convention, *see* Treaties and Conventions
- European Patent Office 40–41
- Exclusivity 49–56
  - function of the invention and 52
  - mechanics for the achievement of 56–62
  - research for the achievement of 53–45
  - value of 55–56
  - versus commercialization 54–55
- Ex parte* reexamination 28–29
- Extension of patent right due to delay 21
- Fees 6–7, 10, 73, 160, 188–190, 197
- File history 125–126, 160
- First-to-file countries and systems 4, 153–154
- First-to-invent countries and systems 4
- Fleming, Sir Alexander 149
- Food processing issues, *see* Biotechnology
- Foreign filing license 11, 197
- Fostering inventive activity 146–150
- Freedom to operate 155–166
  - dealing with adverse patents 160–161
  - developing a strategy for 125–126
  - interpreting adverse patents 159–160
  - research disclosures 162–165
  - searches 158–159
  - see also* Right to Practice
- Future of intellectual property 207–210
- Genetic technology patents 9, 13 *see also* Biotechnology
- Global filings 185–195
  - agreement with strategy and 198
  - competitive value of the country and 186–187
  - competitive value of the patent and 186
  - cost of 188–190, 197
  - country economic power
    - considerations and 193–195
  - decision process for 92–93, 114–115
  - determining the value of countries for 191–193

- experts 197
- filing strategies for 92–93, 191–193
- international treaties, effect on, *see also*  
Treaties and Conventions
- legal enforcement climate of countries and  
190–191
- marketing value of the invention and 187
- templates for filing 195
- timing of filing dates 195–197
- world growth considerations and  
193–195
  
- Ignoring patents 160–161
- Industrial application, *see* Utility requirement
- Industrial utility, *see* Utility requirement
- Information, obtaining and reviewing  
91–92
- Information specialists, *see* Literature  
specialists
- Informational value of patents 65–68,  
181–183
  - competitive information 181
  - technical information 65–67
- Infringement 31, 68–72, 123–126, 191,  
208
  - contributory 156–157
  - damages 157
  - dealing with adverse patents 123–126,  
160–161, 166
  - dealing with infringers 161–162
  - direct 155–157
  - imported product made by patented  
process 157
  - indirect 156–157
  - induced 156–157
  - interpreting adverse patents 160–161
  - penalties 157
  - provisional patent protection and  
165–166
  - steps taken to avoid 123–126, 158–161
  - types of 155–157
  - willful 157
- Intellectual property management in the  
future 208–209
- Intellectual property managers 87, 168,  
209–210  
*see also* Patent liaison
- Intellectual property professionals 1–2,  
208–209  
*see also* Attorneys and agents; Global  
filings, experts; Intellectual property  
managers; Literature specialists;  
Patent liaison
- International Agreement on Trade-Related  
Aspects of Intellectual Property Rights  
(TRIPS) 65
- International patent filings, *see* Global filings
- International Numbers for the Identification  
of Data (INID) codes 17–20
- International Treaties, *see* Treaties and  
Conventions
- Inter partes* reexamination/review 29–30
- Invention
  - approaching a corporation with 77
  - determining patentability of 77–79
  - novelty (newness) of 8–9
  - obviousness of (technical advance) 10
  - offer for sale 9
  - public disclosure of 7–9
  - right to practice 2–3
  - type; patentable 11–13
  - usefulness of 9
- Invention firms 76
- Inventive activity, fostering of 146–150
  - acceptance of failure 148–149
  - acceptance of inventors' personalities and  
skills 88–89, 149
  - emotional climate 146, 148–149
  - expectations 149–150
  - freedom to research 146–147
  - systems development 147–148
  - understanding creative needs 146
- Inventive processes, *see also* Research,  
methods of conducting
  - deadlines and 137, 147
  - forcing nature into new conceptual boxes  
143
  - getting ideas 136–137
  - how to invent 137–140, 143–146
  - invention and discovery defined 142
  - lateral thinking 134
  - modified scientific method 143–145
  - objectives and 146–147
  - organized thinking 140
  - practicality of inventions 139, 144–145
  - preparation for 134–135
  - serendipity and 145–146

- Inventive processes, *see also* Research,  
 methods of conducting (*continued*)  
 synthesizing concepts 134–136
- Inventive step, *see* Obviousness requirement
- Inventors  
 characteristics of, casual 140–142  
 characteristics of, prolific 136–140, 143  
 dealing with, when patent applications  
 are not filed 129–131
- Joint developments 84
- Know-how 46–47, 72–73, 85, 122–123
- Laid-open application 27
- Leahy-Smith America Invents Act, *see*  
 America Invents Act (AIA)
- Licensing fees 73
- Licensing of patents 12–13, 72–73, 85,  
 121–123, 125–126, 129, 209
- Licensing of trademarks 46
- Literature searches, *see* Prior art and prior  
 art searches
- Literature specialists 91–92, 127–128,  
 168, 178–179
- Litigation 125–126, 160–162
- Maintenance Fees 6–7, 73, 160, 188–190,  
 205–206
- Medical issues, *see* Biotechnology
- Newness requirement *see* Novelty  
 requirement
- Novelty requirement 8–9, 77–78
- OAPI (African Intellectual Property  
 Organization), *see* Treaties and  
 Conventions
- Objection 26
- Obviousness requirement 10, 77–78
- Operating ranges 152–153
- Opposition proceedings 27–31, 90–91,  
 209
- Paris Convention, *see* Treaties and  
 Conventions
- Patent  
 adequate resources for obtaining a  
 88–89
- approaching a large corporation with 77  
 as a source of information, *see*  
 Informational value of patents
- assigning value to 68–72, 77–79
- ‘broad’ type 56–62, 70–72, 98,  
 103–107, 152–153
- ‘engineering around’ a 53–54, 184
- examination of 5–7
- exclusivity of, *see* Exclusivity
- expense of 108–109, 116–117,  
 188–190, 197
- expiration date 20–21
- filing date 25
- governmental basis for 2, 49
- issuance of 205–206
- maintenance fees for 160, 188–190,  
 205–206
- misconceptions of 62–65
- ‘narrow’ type 57–62, 70–72, 103–107,  
 129–130, 152–153, 180
- opposition of 7, 184
- publication of 7–8, 26–27, 165–166,  
 202–203
- required disclosure for 10
- requirements for obtaining 8–11
- steps for obtaining 5–8
- term of 20–21
- traps with, *see* Patent, misconceptions of  
 types of:  
 biotechnology, *see* Biotechnology  
 computer 11–13 *see also* Computer  
 design 14  
 industrial designs 14  
 plant 14  
 software 11–13 *see also* Software  
 patents  
 utility 11–14  
 utility model 13
- value, product versus process versus  
 apparatus 183–185
- wall strategy for 62
- Patent agent, *see* Attorneys and agents
- Patent application  
 abstract in 17  
 accuracy of 169–170, 173–174  
 appeal of 31  
 completeness of 173–174  
 coordinating filing of 92–93

- declaration and oaths of inventorship and ownership for 10, 14
- details and critical components in 66, 169–171, 173–174
- drawings in 10, 14, 66
- examples in 15–16, 65–68, 152–153
- filing decision for 51–52, 70, 86–88, 92–93, 114–115, 129, 183–185, 195–197
- form and sections of 10, 14–20, 66–68
- INID codes in 17–20
- parts of a 14–20, 66–67
- precision of 168–170
- publication of 7–8, 26–27
- specification for 14–16
- specific forms for 10, 14
- truthfulness in 169–170, 182
- Patent attorney, *see* Attorneys and agents
- Patent blanketing, *see* Patent flooding
- Patent Cooperation Treaty (PCT), *see* Treaties and Conventions
- Patent enforcement 108
- Patent estate 114–115, 116–117, 195, 204–205
- Patent fees, *see* Fees
  - see also* Patent, expense of
- Patent flooding 58, 60–62
- Patent information
  - databases online, *see* Databases, online
  - patents cited during prosecution 67
  - value of 65–68
- Patent law
  - basic concepts of 2–32
  - country differences in 3–4
- Patent liaison 87, 110, 127, 177–179, 204–205, 209
- Patent licensing, *see* Licensing of patents
- Patent litigation 123–126, 160–162
- Patent office delays 21
- Patent office operations 5–8
- Patent pending 26
- Patent professionals, *see* Intellectual property professionals
- Patent prosecution 25, 199–204
  - cited patents 67, 201
  - first office action after filing 199–201
  - issuance fee payment 201
  - modification of claims during 200–202
  - patent office actions 25, 199–202
  - researcher's help with 201–202
- Patent strategy model 82–96
  - adequate resources for 88–89
  - competitive advantage, identifying 85–86
  - competitive patents, maintaining
    - up-to-date with 91–92
  - competitive patents, response to 90–91
  - coordination of patent application filings with 92–93
  - decisions using 86–88
  - extent of coverage desired by 82–83
  - focus of efforts for 88–89
  - methods of acquiring intellectual property using 83–85
  - methods of changing 94–96
  - protection of unprotected intellectual property using 93–94
- Patenting at all cost 64
- PCT (Patent Cooperation Treaty), *see* Treaties and Conventions
- Pharmaceuticals 65
- Plant patent 14
  - see also* Biotechnology
- Post-grant reviews 30–31, 209
- Practical utility 9, 13
- Preliminary examination 36
- Principles for developing strategy 81–96
- Prior art and prior art searches 24, 91–92, 105, 125–126, 127–128, 151–152, 171–173
  - distinguishing over 77–79, 201
  - literal interpretation of 171
  - review for attorney or agent 170–171
- Prior user rights 31–32
- Priority date 24–25
- Professional help
  - the need for 1–2, 75–77, 167–168 *see also* Attorneys and agents
- Prosecution 25
  - see also* Patent prosecution
- Provisional patent protection 22–24, 165–166
- Published for Opposition 27–28
- Real-world utility 9, 13
- Registration countries 5

- Rejection 25
  - final 26
- Research
  - after filing a patent application 202–204
  - contracting 83–84
  - developing intellectual property by 83–84, 103–107
  - disclosures 162–165
  - documentation 153–154
  - effects of researcher's actions 150–153
  - identifying of operating ranges 152–153
  - inventor's responsibility for details 173–174
  - knowledge of technology area 151–152
  - methods of conducting 150–153
  - scouting 83
  - with intellectual property in mind 133–154
- Right to Practice 2–4, 49, 155 *see also* Freedom to Operate
- Search reports, PCT 166
- Secrecy Agreements, *see* Agreements
- Secrecy 52–53, 93–94, 128
- Service marks 46
- Software patents and protection thereof 11–13, 208
- State Street v. Signature* decision 12
- Strategy
  - business 107–108, 131–132
  - change of 94–96
  - competitive pace concept 203–204
  - coordination of 131–132
  - decision-making for 86–88
  - definition of 79–81
  - developing a model 82–96
  - development, coordination of 131–132
  - development of, for a business 95
  - development of, for a series of inventions 110–118
    - building a global patent estate 114–115
  - competitive advantage through proprietary position 111–112
  - consistency of technical disclosures 117–118
  - cost 116–117
  - desired claims 113–114
  - identification of difficult patents and disclosures 114
  - measuring success 115
  - non-proprietary aspects 113
  - personnel for 115–116
  - vision for a product line 110–111
- development of, for an existing product 118–121
  - assessing current situation 118–119
  - focusing overall efforts 118
  - identifying existing competitive advantages of 119–120
  - identifying existing market needs 120
  - three part document of 121
  - understanding enduse trends and thrusts 120
  - vision statement with 119
- development of, for handling a potentially adverse patent 123–126
  - claim interpretation 124–125
  - decision process 125
  - determining status of 123–124
  - taking action with 125–126
- development of, for an invention 96–109
  - applicant's motive for a patent 96–97
  - breadth of claims 97–98
  - constructing a strategy 109
  - disclosure of technology 100–103
  - information for the patent application 97–98
  - invention definition 96, 103–107
  - obtaining information for 97–98
  - personnel for 99–100
  - selecting countries for patents 107–109
  - timing 98–99
- development of, for licensing patents 121–123
  - from other companies 122–123
  - to other companies 122
- development of, for oddball inventions 127–129
  - availability of resources for 127
  - filing decisions for 129
  - newness and practicality of 127–128
  - prior use and disclosure of 128
  - proper attention to 127–128

- documentation of 95
  - for dealing with inventors 129–131
  - military strategy model 81–82
  - patent model, *see* Patent strategy model
  - principles behind the 81–96
  - technical 131–132
  - wall strategy concept 62
- Submarine patents 7
- Tracking patents 67–68
- Trademarks 45–46
- Trade secrets 46–47, 72–73, 204–205
- Treaties and Conventions 32–44
- African Intellectual Property Organization (OAPI) 42
  - African Regional Intellectual Property Organization (ARIPO) 42–43
  - Community Patent Convention 41
  - Eurasian Patent Convention (EAPO) 43–44
  - European Patent Convention (EPC) 40–41
  - Paris Convention 21, 32–35
  - Patent Cooperation Treaty (PCT) 35–40
- TRIPS *see* International Agreement on Trade-Related Aspects of Intellectual Property Rights
- Unsolicited inventions 77
- Usefulness requirement 9, 77–78
- Utility model registrations 13
- Utility patent 11–13
- see also* Patent
- Utility requirement, *see* Usefulness requirement
- Validity of patents 106–107, 125–126, 159–160, 208–209
- WIPO, *see* World Intellectual Property Organization
- World Intellectual Property Organization (WIPO) 36, 44
- Written description requirement 101