



Patent Prosecution: Law, Practice, and Procedure, Eighth Edition

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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 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. Additional highlights include these recent Federal Circuit decisions: *Apple, Inc. v. Samsung Electronics Co., Ltd.*, describing a two-step process to determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design; *In re Beineke*, holding that the discovery of new and distinct mature oak trees found in the front yard of a home was not entitled to plant patent protection under 35 U.S.C. § 161; *Thorner v. Sony Computer Entertainment Inc.*, holding that implied redefinition must be so clear that it equates to an explicit redefinition; *Sandisk Corp. v. Kingston Technology Co., Inc.*, holding that the disclosure-dedication rule did not apply to incorporated by reference subject matter when the specification did not sufficiently indicate that the incorporated by reference subject matter was an alternative to the claim limitation; *Falana v. Kent State University*, holding that a putative inventor who conceived of the structure of a novel genus of chemical compounds and contributed to the method of making that genus, was considered to be a co-inventor to the conception of that genus; *CLS Bank International v. Alice Corporation Pty. Ltd.*, holding that a computerized trading platform for exchanging obligations using a trusted third party was patent eligible. On October 9, 2012, the Federal Circuit granted the petition of CLS Bank for rehearing en banc *Plasmart, Inc. v. Kappos*, holding that drawings can be used as prior art, without referring to the surrounding description, when the prior art features are clearly disclosed by the drawing; *In re Antor Media Corporation*, holding that a prior art printed publication cited by an Examiner is presumptively enabling, barring any showing to the contrary by a patent applicant or patentee; *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, holding that an online Internet posting of an article was considered a printed publication; *Cummins-Allison Corp. v. SBM Co., Ltd.*, holding that drawings alone may provide an adequate written description under 35 U.S.C. § 112; *Ergo Licensing LLC et al. v. Carefusion 303 Inc.*, holding that the mere disclosure of the words control device was insufficient to provide the corresponding structure for the means-plus-function element control means; *In re Yo*

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