

**A Dictionary of
American Intellectual Property**

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Preface

What does it mean?

What is the _____ doctrine?

What is the difference between “good cause” and “good and sufficient reason”?

What tests are applied in intellectual property law?

Only those terms and definitions are included that relate to U.S. intellectual property law.

Definitions

P	Patent
C	Copyright
T	Trademark
S	Trade Secret
U	Unfair Competition

Within a patent definition, “Board” refers to the Board of Patent Appeals and Interferences. Within a trademark definition, “Board” refers to the Trademark Trial and Appeal Board.

Information about mask works may be found under copyright entries.

Abbreviations

A.2d	Atlantic Reporter, Second Series
BPAI	Board of Patent Appeals and Interferences
CAFC	Court of Appeals for the Federal Circuit
EG	Examination Guide of the PTO
F.Supp.	Federal Supplement
F.2d	Federal Reporter, Second Series
MPEP	Manual of Patent Examining Procedure
P.2d	Pacific Reporter, Second Series
PTO	United States Patent and Trademark Office
TMEP	Trademark Manual of Examining Procedure
TTAB	Trademark Trial and Appeal Board
US	United States Reports
USC	United States Code
USPQ	United States Patents Quarterly
UTSA	Uniform Trade Secrets Act

Parts of speech, e.g. MUTILATED, but entry is MUTILATION.

Definitions

abandonment

P: One who has abandoned an invention may not receive a patent. 35 USC 102(c). See DILIGENCE. One may not obtain a patent if, “before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, suppressed or concealed it.” 35 USC 102(g). [Walker 7:1]. “[A]bandonment of the ‘invention’ (as distinguished from abandonment of an application) results in loss of right to a patent.” MPEP 706.03(s). Certain inventions may also be abandoned in the United States by filing a foreign patent application in violation of the Commissioner’s order. “The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the individual, his successors, assigns, or legal representatives, or anyone in privity with him, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of the violation.” MPEP 706.03(s).

An application for a patent is abandoned when it is not prosecuted within the time set by statute or such shorter period fixed by the Commissioner. 35 USC 133. “If an applicant of a patent application fails to respond within the time period provided ... the application will become abandoned unless an office action provides otherwise.” 37 CFR 1.135(a). “When a timely response is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for response expired.” MPEP 710.01(a). An unintentionally abandoned application for a patent may be revived upon petition to the Commissioner. 35 USC 41. An abandoned application may not be cited as a reference unless it has been opened to inspection by the public following a DEFENSIVE PUBLICATION. 37 CFR 1.108. Filing a FILE WRAPPER CONTINUATION constitutes an express abandonment of the application on which it is based. 37 CFR 1.62(g).

Statement of abandonment.

Keeping invention secret.

Delay in filing application. 35 USC 102(b), (d).

Failure to pay issue fee after notice of allowance. 35 USC 151.

By disclosure and failure to claim.

See also CONSTRUCTIVE ABANDONMENT, EXPRESS ABANDONMENT, REVIVAL.

C: Abandonment occurs when the copyright proprietor intends to surrender a copyright interest in his work. *Lopez v. Electrical Rebuilders, Inc.*, 416 F.Supp. 1133, 195 USPQ 398 (S.D. Cal. 1976). Long acquiescence in widespread circulation of unauthorized copies can result in abandonment. *Stuff v. E.C. Publications, Inc.*, 342 F.2d 143 (2d Cir. 1965), *cert. denied*, 382 US 822 (1965). Cf. FORFEITURE.

T: Either a mark or an application may be abandoned.

“A mark shall be deemed ‘abandoned’ when either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be

prima facie evidence of abandonment. ‘Use’ of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name of the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.” 15 USC 1127.

Abandonment is grounds for cancellation of a registration or partial cancellation as to certain goods or services. *Aries Systems Corp. v. World Book Inc.*, 26 USPQ 2d 1926, 1929 (TTAB 1993).

A trademark application has the status of “abandoned” if it is no longer pending and has not issued. TMEP 409. An intent-to-use application is automatically abandoned if statement of use not filed within prescribed time. 15 USC 1051(d)(4). “If an applicant fails to respond, or to respond completely, within six months after the date an action is mailed, the application shall be deemed to have been abandoned. A timely petition to the Commissioner ... is a response which avoids abandonment of the application.” 37 CFR 2.65(a). However, “When action by the applicant filed within the six-month response period is a bona fide attempt to advance the examination of the application and is substantially a complete response to the examiner’s action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.” 37 CFR 2.65(b).

Abandoned files are destroyed two years after date of abandonment. TMEP 3030.02.

See also EXPRESS ABANDONMENT, INSUFFICIENT RESPONSE, REVIVAL. *Cf.* CANCELLATION.

Abandonment is a statutory defense to TRADEMARK INFRINGEMENT. 15 USC 1115(b)(2).

Abandoned Drawing Index

T: An index maintained in the PTO of drawings from abandoned trademark applications. TMEP 302.

Abandoned Files Repository

P: The ultimate destination of abandoned application files in the Patent and Trademark Office. MPEP 707.13.

abbreviated copy

P: A redacted version of an instrument evidencing a government interest in a patent, from which matter that does not relate to such interest has been removed. Such a version may be recorded on the Register of government Interests in Patents if it is filed with a statement “giving the general nature of the entire instrument, the parties involved, the date of the instrument, the place where it is usually filed, and any docket or identifying numerals ...” 37 CFR 7.4.

abbreviation

C: In a MASK WORK NOTICE, the name of the owner of the mask work may be “an abbreviation by which the name is recognized or generally known.” 17 USC 909(b)(2).

abbreviations

Following is a list of abbreviations commonly used in intellectual property law:

DJ	declaratory judgment
McC	McCarthy
OG	Official Gazette of the United States Patent and Trademark Office
PCT	Patent Cooperation Treaty
PTO	Patent and Trademark Office
TTAB	Trademark Trial and Appeal Board
TMR	Trademark Reporter
UCC	Uniform Commercial Code, Universal Copyright Convention

Many other abbreviations are listed in this book.

abeyance

P: An applicant may request that the examiner's objections as to form be held in abeyance until allowable subject matter is indicated. 37 CFR 1.111(b).

ability

P: If a patent claim only requires an ability to perform a function, selling a device with that ability infringes even though the seller never told the customer how to use the function. *Intel Corp. v. U.S. Int'l. Trade Comm'n.*, 946 F.2d 821, 20 USPQ 2d 1161 (Fed. Cir. 1991).

about

P: [meaning of "about" in claims]

abridgment

C: An abridgment of a work may constitute a DERIVATIVE WORK. 17 USC 101.

abstract

P: A required component of an international application under the PCT. 37 CFR 1.431(a). Cf. ABSTRACT OF THE DISCLOSURE.

abstract of the disclosure

P: One of the required elements of the specification. "The purpose of the abstract is to enable the Patent and Trademark Office and the public generally to determine quickly and from a cursory inspection the nature and gist of the technology disclosed. The abstract shall not be used for interpreting the scope of the claims." 37 CFR 1.72(b).

abstract of title

P: Can be ordered from PTO. 37 CFR 1.19(b)(6).

T: See 37 CFR 2.6(r).

abstraction-filtration-comparison test

C: A test for infringement of computer programs. The test involves (1) identification of the different levels or structural abstraction in the work; (2) filtration, that is, eliminating non-protectable elements of the work; and (3) comparing the remaining elements with the corresponding elements of the accused work. *Computer Associates v. Altai* (***) ; *Autoskill, Inc. v. National Educational Support Systems*, 793 F.Supp. 1557 (D. N.M. 1992), 994 F.2d 1476 (10th Cir. 1993).

abuse of discretion

P: Standard of review. A BPIA decision pursuant to the permissive rules governing an interference is reviewed for abuse of discretion. *Gerntsen v. Shirai*, 979 F.2d 1524, 1527, 24 USPQ 2d 1912 (Fed. Cir. 1992).

T: See CLEAR ERROR.

abuse of process

P: A state action for abuse of process cannot be asserted “as a remedy for inequitable or other unsavory conduct of parties to proceedings in the PTO.” *Abbott Laboratories v. Brennan*, 952 F.2d 1346, 21 USPQ 2d 1192 (Fed. Cir. 1991)..

acceptance

T: Statement of use. 15 USC 1051(d)(3). Affidavit of continued use. 15 USC 1058(c). Cf. REFUSAL.

access

C: Copying as an element of infringement may be proven circumstantially by showing access and SUBSTANTIAL SIMILARITY. *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131 (2d Cir. 1992). No amount of similarity can dispense with the need to show access. *Selle v. Gibb*, 741 F.2d 896 (7th Cir. 1984).

accession number

P: An identifying number of a microorganism sample held by an INTERNATIONAL DEPOSITARY AUTHORITY pursuant to the Budapest Treaty, Rule 11.3(a).

accident

P: Inadvertence, mistake. [Walker].

account

C: The JOINT OWNERS of a copyright have the right to work the copyright separately but must account to each other for any profits. *Oddo v. Ries*, 743 F.2d 630.

account books

C: Account books, to the extent they are for recording rather than conveying information, are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

accounting

Accounting for profits

P: “In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.” 35 USC 262.

C: A JOINT AUTHOR has a duty to account to the other authors for use of a work.

T: McC.

accuracy

T: Certification of the accuracy with which goods have been made is one of the functions of a CERTIFICATION MARK. 15 USC 1127.

accused

Allegedly infringing an intellectual property right.

accused device

P: The device that is alleged to infringe a patent.

accused work

C: The work that is alleged to infringe a copyright.

acknowledgment

P: When a member of the public files a petition to strike an application pursuant to 37 CFR 1.56(g), it will only be acknowledged by return of a self-addressed postcard. Likewise, protests under 37 CFR 1.291 will be acknowledged but no further communication with the protester will be undertaken.

T: Acknowledgment and verifications required under this chapter may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States or before any official authorized to administer oaths in the foreign country concerned whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille or an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States and shall be valid if they comply with the laws of the state or country where made.” 15 USC 1061. “Acknowledgment shall be prima facie evidence of the execution of an assignment and when recorded in the Patent and Trademark Office the record shall be prima facie evidence of execution” 15 USC 1060.

acquiescence

C: Long acquiescence in widespread circulation of unauthorized copies can result in ABANDONMENT of copyright. *Stuff v. E.C. Publications, Inc.*, 342 F.2d 143 (2d Cir. 1965), *cert. denied*, 382 US 822 (1965).

T: Assent to the use of a confusingly similar mark by another, usually evidenced by some affirmative act or failure to act, beyond mere silence. “[E]quitable principles, including laches, estoppel, and acquiescence” are defenses to TRADEMARK INFRINGEMENT. 15 USC 1115(b)(8). “In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.” 15 USC 1069. Acquiescence is not a defense there is likelihood of confusion and the public interest is superior that of the parties. *Coach House Rest.*, 223 USPQ 176. “Acquiescence constitutes a ground for denial of relief only upon a finding of conduct on the plaintiff’s part that amounted to an assurance to the defendant, express or implied, that the plaintiff would not assert trademark rights.” *Birthright v. Birthright*, ___ F.Supp. ___ (D. N.J. 1993).

Cf. ESTOPPEL, LACHES.

acquired distinctiveness

T: A mark is said to have acquired distinctiveness when, although originally merely descriptive, it has come to be associated with a single source. The basis for registration of a mark that has acquired distinctiveness is 15 USC 1052(f): “Except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” Acquired distinctiveness is a QUESTION OF FACT. *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

acronym

T: A word consisting of the first letters of the words of a phrase. For example, “SCORE” is an acronym for “Service Corps of Retired Executives.” [McC 12.12]

act

C: See DRAMATIC WORK. To act a work constitutes a PERFORMANCE of the work. 17 USC 101.

Act of 1881

T: The trademark act of March 3, 1881. “A registrant of a mark registered under the provisions of the Acts of 1881 or 1905 may at any time prior to the expiration of the period for which the registration was issued or renewed ... file an affidavit or declaration setting forth those goods stated in the registration on which said mark is in use in commerce, specifying the nature of such commerce. and stating that the registrant claims the benefit of the Trademark Act of 1946.” 37 CFR 2.153. Notice of the claim will then be published in the Official Gazette, no OPPOSITION is permitted and notice of the publication is sent to the registrant. 37 CFR 2.154, 2.155. Re CANCELLATION, see 15 USC 1064(4).

Act of 1905

T: The trademark act of February 20, 1905. See ACT OF 1881. Re CANCELLATION, see 15 USC 1064(4).

Act of 1920

T:

Act of 1946

T: The Lanham Act, 15 USC 1051 *et seq.*, passed July 5, 1946.

action

P: In construing the Federal Rules of Evidence in an INTERFERENCE, action means interference. 37 CFR 1.671(c)(4).

action on the merits

P:

T:

activated channel capacity

C: A “cable system” ‘lacks the activated channel capacity’ to retransmit on a full-time basis all signals which it is authorized to carry only if: (i) all of its activated television channels are used exclusively for the secondary transmission of television signals; and (ii) the number of primary television transmitters secondarily transmitted by the cable system exceeds the number of its activated television channels.” 37 CFR 201.17(b)(10).

active exercise of reasonable diligence

P: See DILIGENCE.

active ingredient

P: [Find def., includes any salt or ester.] See also PATENT TERM EXTENSION.

activity abroad

P: 35 USC 104, 119. amendments.

actual confusion

T: An incident in which a potential consumer has mistaken the source of goods or services. Actual confusion, while not necessary to a finding of trademark infringement, is a factor in determining whether there is LIKELIHOOD OF CONFUSION between two marks. *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ 2d 1264 (1st Cir. 1987). “Although actual confusion is not necessary for a finding of likelihood of confusion, it is nevertheless the best evidence of likelihood of confusion.” *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 978, 219 USPQ 515 (11th Cir. 1985). Actual confusion by few customers is evidence of likelihood of confusion by many customers. See *Freedom Savings & Loan Association v. Way*, 757 F.2d 1176, 1185, 226 USPQ 123 (11th Cir. ___), *cert. denied*, 474 US 845 (1985).

actual damages

C: 17 USC ***

actual knowledge

C: See also NOTICE OF PROTECTION.

actual notice

T: A registrant who fails to give notice of registration may not recover profits or damages for infringement unless defendant had “actual notice” of the registration. 15 USC 1111.

S: A party receiving actual notice that information in its possession is the trade secret of another is liable for its disclosure.

actual reduction to practice

P: An invention is actually reduced to practice when it has been embodied in tangible form in the United States and shown to be workable. See CONSTRUCTIVE REDUCTION TO PRACTICE, REDUCTION TO PRACTICE.

ad interim copyright

C: A concept under the Copyright Act of 1909 referring to a five-year period of protection for English language materials printed abroad during which up to 1500 copies could be imported without forfeiture of the right to apply for copyright registration for an edition printed in the United States.

adaptation

C: A DERIVATIVE WORK casting the original in another medium, such as adapting a novel as a play or screenplay. The right to make an adaptation of a work is one of the basic rights of an author under the BERNE CONVENTION.

adapted

P: The “terms ‘adapted for use in’ and ‘adapted to be adhered to’ do not constitute limitations in any patentable sense.” MPEP 706.03(c). *In re Hutchinson*, 69 USPQ 138 (1946). See also FUNCTIONAL.

adaptation

C: A DERIVATIVE WORK casting the original in another medium, such as adapting a novel as a play or screenplay. The right to make an adaptation of a work is one of the basic rights of an author under the BERNE CONVENTION.

Software: 17 USC 117. ***

add-on use

T: [McC 16.02]

additional discovery

P: “Additional discovery” in an interference is discovery to which a party may be entitled under 37 CFR 1.687 in addition to discovery to which the party may be entitled under 37 CFR 1.673(a) and (b). 37 CFR 1.601(a).

additional interference

P: An INTERFERENCE, declared during the pendency of a prior interference, “(1) between an additional application not involved in the interference and owned by a party and an opponent’s application or patent involved in the interference or (2) when an interference involves three or more parties, between less than all applications and any patent involved in the interference.” 37 CFR 1.633(e).

additive

P: 35 USC 156(d)(2)(A)(ii). See COLOR ADDITIVE, FOOD ADDITIVE.

additive claim

P: [Walker 11:3].

address

C: Addresses, when published individually, are exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(3). See also LECTURE.

address books

C: Address books, to the extent they are for recording rather than conveying information, are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

adjective

T: Trademarks are properly adjectives, not nouns. See GENERIC ADJECTIVE.

administrator

[Definition]

P: The administrator of the estate of a deceased inventor may apply for a patent. 37 CFR 1.42. See also DEATH, EXECUTOR, LEGAL REPRESENTATIVE. The Administrator of NASA can issue a DIRECTION that certain patents be issued in his name.

administrative instructions

P: That “body of instructions for operating under the Patent Cooperation Treaty referred to in PCT Rule 89.” 37 CFR 1.401(c).

Administrative Procedure Act

P: Re PETITIONS, see [Walker 12:54.]

C: Abbreviated APA. “Except as provided by section 706(b) and the regulations issued thereunder, all actions taken by the Register of Copyrights under this title are subject to the provisions of the Administrative Procedure Act.” 17 USC 701(d). The Act may be found at 5 USC, Subchapter II and Chapter 7. A determination of an administrative agency may be overturned only if it is “arbitrary, capricious or otherwise not in accordance with law.” See ARBITRARY, CAPRICIOUS, NOT IN ACCORDANCE WITH LAW.

Administrator for Petitions and Classification

T: A staff member of the Director of the TMEG responsible for PETITIONS TO MAKE APPLICATION SPECIAL.

admission

P: “A statement in a patent that something is in the prior art is binding on the applicant and patenee for determination of anticipation and obviousness.” *Constant v. Advanced Micro-Devices*, 848 F.2d 1560, 7 USPQ 2d 1057 (Fed. Cir. 1988).

admit

P: 1. An amendment is “admitted” when it is accepted as part of an application. If an amendment is not admitted, it is said to be refused. 37 CFR 1.116(a). After a final rejection, an amendment need not be admitted, but may be upon a showing of good and sufficient reason why it is (i) necessary and (ii) why it was not presented earlier. 37 CFR 1.116(b). A refusal to admit may be reviewed by petition to the Commissioner. 37 CFR 1.127. Also ENTER.

2. A statement by a party. “In rejecting claims the examiner may rely upon admissions by the applicant or the patent owner in a reexamination proceeding, as to any matter affecting patentability.” 37 CFR 1.106(c). See ADMISSION TO PRACTICE.

3. See ADMISSION TO PRACTICE.

T: See REQUESTS FOR ADMISSION.

admission to practice

P:

advance

C: royalty

advance notice of potential infringement

C: In the case of a work consisting of sounds, images or both, whose first fixation is made simultaneously with its transmission, the copyright owner may institute an action for infringement before registration if any required registration is made within three months of first transmission and a notice is served “upon the infringer, not less than ten or more than thirty days before such fixation, identifying the work and the specific time and source of its first transmission, and declaring an intention to seek copyright in the work.” 17 USC 411(b)(1), 37 CFR 201.22(1)(1).

The notice must be “clearly and prominently captioned ‘ADVANCE NOTICE OF POTENTIAL INFRINGEMENT’ and must clearly state that the copyright owner objects to the relevant activities of the person responsible for the potential infringement.” 37 CFR 201.22(c).

adverse judgment

P: “A party may, at any time during an interference, request and agree to entry of an adverse judgment.” 37 CFR 1.662(a). The following are grounds for entry of an adverse judgment as to all claims corresponding to a count: written disclaimer of the invention denied by a count, concession of priority or unpatentability of the subject matter of a count, abandonment or the invention defined by a count, abandonment of the contest as to a count. “Abandonment of an application by an applicant, other than an applicant for reissue having a claim of the patent sought to be reissued involved in the interference, will be treated as a request for entry of an adverse judgment against the applicant as to all claims corresponding to all counts.” 37 CFR 1.662(a). For the effect of a reissue application filed during an interference, see 37 CFR 1.662(b).

advertising

See COMPARATIVE ADVERTISING, CORRECTIVE ADVERTISING, FALSE ADVERTISING.

T: Mere advertising is not a trademark use. [McC 16.10[1]]. Advertising one’s own products in not rendering an advertising service for purposes of service mark use. *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970).

advertising material

C: Advertising may be protected by copyright, but the copyright in a collective work does not cover the advertising it contains. “Advertising copy” is a type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i). “Pictorial advertising” is a type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii). Advertising material may not constitute a WORK OF VISUAL ART. 17 USC 101.

T: “‘Advertising’ includes newspaper and magazine advertisements, as well as types of advertising such as brochures, billboards, car cards, handbills, direct mail leaflets and the like.” TMEP 1301.06. Advertising material is not acceptable for trademark specimens. TMEP 808.05. The advertising of a service mark must relate to an existing service to constitute service mark use. TMEP 1301.02.

It is TRADEMARK INFRINGEMENT to use in commerce any reproduction of a registered mark in connection with the advertising of any goods or services if such use is likely to cause confusion, to cause mistake, or to deceive. 15 USC 1114(1)(A). It is likewise an infringement to apply a reproduction of a registered mark to advertising intended to be used in commerce where such use is likely to cause confusion, or to cause mistake, or to deceive. 15 USC 1114(1)(B). Advertisements bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

advisory action

P: An action by the Examiner ***. MPEP 706.07(f).

advisory jury

Quote Rule 39(c).

aesthetic functionality

T: The discredited doctrine that ornamentation performs the “function” of making a product more attractive and hence renders such ornamentation unregistrable even if distinctive. *In re DC Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394 (CCPA 1982), [McC 7.21]. See FUNCTIONALITY.

affidavit

P: An affidavit may be used to overcome a reference that substantially shows or describes, but does not claim, a patentable invention. 37 CFR 1.131, 1.132. The affidavit must attest to completion of the invention by the applicant prior to the filing date of the reference. If a rejection is based on personal knowledge of an employee of the PTO, it must be supported by an affidavit. 37 CFR 1.107(b).

With respect to an INTERFERENCE, affidavit means “affidavit, declaration under §1.68, or statutory declaration under 28 USC 1746. A transcript of an *ex parte* deposition may be used as an affidavit.” 37 CFR 1.601(b). An affidavit is required for correction of a MATERIAL ERROR in a PRELIMINARY STATEMENT. 37 CFR 1.628(b).

Obtaining foreign priority based on inventor’s certificate requires an affidavit. 37 CFR 1.55(b). An affidavit must also be furnished if the original patent sought to be reissued is lost or inaccessible. 37 CFR 1.178.

See also LANGUAGE.

C: See RENEWAL AFFIDAVIT FOR A UCC WORK.

T: See AFFIDAVIT OF CONTINUED USE, AFFIDAVIT OF INCONTESTABILITY, FORM AFFIDAVIT, SECTION 8 AFFIDAVIT, SECTION 15 AFFIDAVIT.

A verified complaint or affidavit is required when applying for a SEIZURE ORDER. 15 USC 1116(d).

affidavit of continued use

T: “The registration of any mark under the provisions of this chapter shall be canceled by the Commissioner at the end of six years following its date, unless within one year next preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.” 15 USC 1058(a). The affidavit is referred to as a SECTION 8 AFFIDAVIT because this provision is contained in Section 8 of the Lanham Act. It must be filed and executed by the registrant. The affidavit is accepted or refused by the Commissioner and the registrant notified. 15 USC 1058(c). *Cf.* AFFIDAVIT OF NONUSE.

affidavit of incontestability

T: A mark becomes INCONTESTABLE when the Commissioner accepts the owner’s affidavit to the effect that the mark has been in continuous use for five years and is not under challenge in the PTO or in any court. 15 USC 1065(3). Also known as a SECTION 15 AFFIDAVIT. 15 USC 1065.

affidavit of nonuse

T: A SECTION 8 AFFIDAVIT showing that failure by registrant to use a mark is “due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.” 15 USC 1058(a). *Cf.* AFFIDAVIT OF CONTINUED USE.

affiliation

T: use of a mark may imply affiliation. ***. [McC 23.01[4]d.] Confusion as to affiliation is actionable as TRADEMARK INFRINGEMENT. Flaseley suggesting affiliation

wit hte trademark owner in a manner likely to cause confusion as to source of sponsorship constitutes infringement.” *Burger King v. Mason*, 710 F.2d 1480, 1492, 219 USPQ 693 (11th Cir. 1983), cert. denied, 465 US 110 (***CHECK) (1984)

affirm

T: Refusals to register are “affirmed” by the TTAB.

affirmative defense

A defense that must be asserted specifically and proven, rather than merely a negation of an element of plaintiff’s case.

P: Invalidity. *Cornwall v. U.S. Construction Manufacturing, Inc.*, 800 F.2d 250, 231 USPQ 64 (Fed. Cir. 1986).

affirmative rule of invention

P: A general principle or consideration, as opposed to a rule of law, weighing in favor of patentability. Examples are: acceptance of invention, economy or other advantage, halt followed by progress, long-felt need, new combination of elements, outstanding unsolved problem, public acquiescence in invention, taking the last step, turning failure into success, unsuccessful efforts of others. [Walker 6:16]. See also SECONDARY CONSIDERATION. Cf. NEGATIVE RULE OF INVENTION.

affixation

T: The term derives from 15 USC 1127, which provides that a mark is deemed to be in use in commerce when “it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale ...”

A4 paper

P: Paper of DIN size A4, measuring 21.0 x 29.7 cm., which must be used for international applications under the PCT. 37 CFR 1.433(b).

after final

P: The status of an application after a FINAL REJECTION has been mailed to applicant. The proper responses that may then be made are limited. 37 CFR 1.116(a).

afterword

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101.

against public policy

See PUBLIC POLICY.

age

P: Applicant’s age or health may justify a PETITION TO MAKE APPLICATION SPECIAL. 37 CFR 1.102(i).

agent

P: See PATENT AGENT.

aggregation

P: A collection of unrelated parts that do not cooperate to perform a function. An aggregation is unpatentable as not constituting a MACHINE under 35 USC 101. MPEP 706.03(i). Also CATALOG. See also COOPERATION. However, a kit of unassembled parts has been held patentable. *In re Venezia*, 189 USPQ 149.

agreement

P: In an INTERFERENCE, the Certificate of Mailing procedure is insufficient to obtain a FILING DATE for an agreement between the parties. 37 CFR 1.81(a)(2)(iii).

agreement to arbitrate

P: “An agreement to arbitrate must be in writing, specify the issues to be arbitrated, the name of the arbitrator or a date not more than thirty (30) days after the execution of the agreement for the selection of the arbitrator and provide that the arbitrator’s award shall be binding on the parties and that judgment thereon can be entered by the board.” 37 CFR 1.690(a).

agricultural expert

P: *** 37 CFR 1.167.

Aiken exemption

C: The exemption from copyright infringement for the “communication of a transmission embodying a performance or display of a work by the public reception of the transmission on a single receiving apparatus of a kind commonly used in private homes.” 17 USC 110(5). This statutory exemption codifies an exception found in *Twentieth Century Musci Corp. v Aiken*, 422 US 151, 186 Q 65 (1975). See also STORE RECEIVER.

AIPLA

= AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION.

AIPPI

= ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE LA PROPRIÉTÉ INDUSTRIELLE.

Air Force

P: See LIAISON OFFICER.

aircraft

P: See TEMPORARY PRESENCE.

a.k.a

T: An abbreviation for “also known as,” a designator for a FICTITIOUS NAME. TMEP 802.02. An ASSUMED NAME DESIGNATION.

algorithm

P: See MATHEMATICAL ALGORITHM.

C: See FORM, FIT AND FUNCTION DATA.

Alien Property Custodian

P: *** MPEP 901.06(c).

alienation

C: See TRANSFER OF COPYRIGHT.

all claims rule

P: The obsolete rule that each joint inventor must have made an inventive contribution to each claim of a patent, or the patent is invalid. *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 8 USPQ 2d 1468 (Fed. Cir. 1988). 35 USC 116 now permits naming of joint inventores even though “each did not make a contribution to the subject matter of every claim of the patent.”

all elements rule

P: The principle that a claim is not infringed unless all elements are infringed, either literally or by equivalents. Also RULE OF OMISSION.

all limitations rule

P: The principle that the accused device must meet all limitations of a claim in order to infringe the claim. *Pennwalt v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987). Cf. ALL ELEMENTS RULE, RULE OF OMISSION.

all rights

C: A phrase sometimes used to mean “all rights under copyright,” that is, the entire copyright. See also EXCLUSIVE WORLD RIGHTS IN PERPETUITY.

all rights reserved

C: A phrase required to preserve rights under the BUENOS AIRES CONVENTION of 1910. A legend containing the phrase may still be required in Bolivia, the Dominican Republic, Honduras and Uruguay, countries that are parties to the Buenos Aires Convention but not the UCC. Also COPYRIGHT RESERVED, TODOS LES DERECHOS RESERVADOS.

All Writs Act

*** used for C and TM seizures.

allege use

T: See AMENDEMENT TO ALLEGE USE.

allowable

P: “A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.” MPEP 706.04.

allowed

P: Of a claim, ***

T: The status of a trademark application that has been published and found ready for issuance or, in the case of the Supplemental Register, approved for issuance. TMPEP 408. Also IN ISSUE. Following the TLRA of 1988, “allowed” refers to ITU (Section 1(b)) applications only. EG A.1.a.

A LETTER OF PROTEST that is passed to the Examining Attorney is said to be “allowed.”

Alphabetical List of Goods and Services

T: A list contained in the International Classification of Goods and Services for the Purpose of Registration of Marks, published by the WIPO. TMEP 804.03.

alteration

C: The owner of a building embodying an ARCHITECTURAL WORK may alter or destroy the building without the consent of the copyright owner. 17 USC 120(b).

T: “No State or other jurisdiction of the United States or any political subdivision thereof may require alteration of a [federally] registered mark.” 15 USC 1121.

alternate deposit

C:

alternative expression

P: It is improper to claim in the alternative, for example, “a phonograph or tape recorder.” which constitutes two claims combined unless the items recited are equivalents. MPEP 706.03(d). Alternative claiming can be remedied by use a “means for” clause or Markush group. See also INDEFINITE. “The mere use of an alternative expression (e.g. a Markush expression) in a claim does not necessarily render a claim INDEFINITE.” *Ex parte Holt*, 19 USPQ 2d 1211, 1213 (BPAI 199_).

amended application

P: An application “which has been acted upon by the examiner, and which has been placed by the applicant in condition for further action by the examiner.” MPEP 708.

T: An application that has been acted upon by the Examining Attorney one or more times and acted upon by applicant in response at least once, whether or not the application has actually been amended. TMEP 402. Also OLD APPLICATION.

amendment

P: “No amendment shall introduce new matter into the disclosure of the invention.” 35 USC 132. Amendments to an application may be made after examination or reconsideration. 37 CFR 1.112. Claims may be amended by cancellation, introduction of new claims or rewriting. 37 CFR 1.119. For amendment before the first Official Action, see PRELIMINARY AMENDMENT. After allowance, amendment may not be made of right and is subject to the approval of the Commissioner. 37 CFR 1.312. Amendments may be made prior to reexamination (37 CFR 1.510(e), 1.530(b)) or during reexamination (37 CFR 1.112, 1.116). Amendments after payment of the ISSUE FEE may only be made on petition to the Commissioner. 37 CFR .312.

T: A trademark application may be amended as to certain matters after filing. “The application may be amended to correct informalities, or to avoid objections made by the Patent and Trademark Office, or for other reasons arising in the course of examination.” 37 CFR 2.71(a). See also IDENTIFICATION OF GOODS.

An application may be amended by wire if followed by a signed amendment within a reasonable time. TMEP 710.03(c). See TELEGRAPHIC AMENDMENT.

A registration may be amended provided that the amendment does not “alter materially the character of the mark.” 15 USC 1057(e). For the fee for such an amendment, see 37 CFR 2.6(g). “In every amendment the exact word or words to be stricken out or inserted in the application must be specified and the precise point indicated where the deletion or insertion is to be made.” 37 CFR 2.74(a). “In certain instances, case law

permits the amendment of a mark to add an element which the applicant has already registered for the same goods or services covered by the application which is being examined. *See In re Nationwide Industries Inc.*, 6 USPQ 2d 1882 (TTAB 1988).” EG 1-92.

“An opposition may be amended under such conditions as may be prescribed by the Commissioner.” 15 USC 1063(a). See also AMENDED APPLICATION.

When an amendatory clause is amended, it must be wholly rewritten so that no interlineation or erasure will appear in the clause, as finally amended, when the application is passed to registration.” 37 CFR 2.74(b).

Amendments to the Rules of Practice are published in the OG and in the Federal Register. 237 CFR 2.189.

amendment to allege use

T: Amendment of an intent-to-use application to convert it into a regular application one the mark in question has been used in commerce. “At any time during examination of an application filed under subsection (b) [an intent-to-use application], an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this Act, by amending his or her application to bring it into conformity with the requirements of subsection (a).” 15 USC 1051(c). An amendment to allege use may not be submitted after the issuance of a NOTICE OF ALLOWANCE. 37 CFR 2.76(a) The amendment must contain (1) a VERIFIED STATEMENT that the applicant believes himself to be the owner of the mark and the mark is is use in commerce, a DATE OF FIRST USE and the relevant goods or services; (2) three SPECIMENS or FACSIMILES of the mark as used in commerce; and (3) the fee provided in 37 CFR 2.6. 37 CFR 2.76(b). An amendment to allege use is not a proper response to an outstanding OFFICE ACTION. 37 CFR 2.76(f). Cf. STATEMENT OF USE.

amendment to recite concurrent use

T: An amendment to a trademark application in which the applicant withdraws its declaration that it is the only person entitled to use the mark in commerce and recites instead known lawful concurrent users. See CONCURRENT USE.

American Intellectual Property Law Association

An American professional organization comprising approximately 5000 intellectual property attorneys. Abbreviated AIPLA.

American National Standards Institute

P: An organization that promulgates standards for microforms that have been adopted by the PTO. 37 CFR ***. Abbreviated ANSI. See also MICROFICHE APPENDIX.

American Type Culture Collection

P: An approved DEPOSITORY located at 12301 Parklawn Drive, Rockville, MD 20852. Abbreviated ATCC.

amicus curiae

A “friend of the court,” a nonparty who has an interest in the principles of a case but does not have standing to become a party. Before the CAFC, an amicus curiae must appear by counsel. CAFC Rule 47.3.

amount and substantiality

C: The “amount and substantiality of the portion used in relationship to the copyrighted work as a whole” is a statutory factor to be considered in determining whether a use is a fair use. 17 USC 107. “It has long been recognized that a commentator may fairly reproduce as much of the original, copyrighted work as is necessary to his proper purpose.” *Habermann*, 626 F.Supp. 201, 212. A “small degree of taking is sufficient to transgress fair use if the copying is the essential part of the copyrighted work.” *Cable/Home Communication Corp.* [*** MORE?], 902 F.2d ____ (***).

amplification

C: “An ‘amplification’ is appropriate: (A) To reflect additional information that could have been given, but was omitted, at the time basic registration was made; or (B) to reflect changes in facts ... or (C) to clarify information given in the basic registration.” 37 CFR 201.5(b)(2)(ii).

analogous art

P: References that are not within the field of the inventor’s endeavor may also be relied on in patentability determinations and are thus described as ‘analogous art,’ where a person of ordinary skill would reasonably have consulted those references and applied their teachings in seeking a solution to the problem that the inventor was attempting to solve. *Heidelberger Druckmaschinen v. Hantscho Comm’l Prods.*, 30 USPQ 2d 1377, 1379 (Fed. Cir. 1994). The test to determine whether art is analogous is whether the reference is “within the field of the inventor’s endeavor,” or whether the reference is “reasonably pertinent to the particular problem with which the inventor was involved.” *In re Deminski*, 796 F.2d 436, 230 Q 313 (Fed. Cir. 1986). Whether a reference is analogous art is a question of fact. *Panduit Corp. v. Dennison Mfg. Corp.*, 810 F.2d 1561, 1568, 1 USPQ 2d 1593, 1597 (Fed. Cir. 1987), *cert. den.*, 481 US 1052 (1987). *** [Walker 6:54] and MPEP 904.01(c).

In the case of a design patent, only analogous prior art is relevant to the issue of nonobviousness, meaning that the prior art article must have the same general use as the claimed article. *In re Butera*, 28 USPQ 1399.

analogous purpose

P: [Walker 6:54].

analogous use

T: Use analogous to trademark or service mark use, but not rising to the level of technical USE. “Use of a term or designation will be deemed to be use ‘analogous’ to trademark or service mark use if it is ‘of such a nature and extent as to create an association of said term with a single source.’” *PacTel Teletrac v. T.A.B. Systems*, 32 USPQ 2d 1668 (TTAB 1994). Examples of analogous use include use in advertising brochures (before goods bearing the mark are transported), at trade shows and in press releases. “Whether use of a mark in advertising prior to the actual rendition of services under the mark is adequate to establish right [sic] in the mark depends on the evidence: at least the character and amount of the advertising must have been sufficient to have created a public awareness of the mark and its connection with the services to be

offered.” *Old Swiss House, Inc. v. Anheuser-Busch, Inc.*, 196 USPQ 808 (CCPA 1978)..

analytic approach

P: A method of computing damages for lost profits due to infringement, in which several factors that affect profit are taken into account, including sales of the infringing product, the PULL EFFECT and infringer’s overhead and profit. *** *TWM Mfg. Co. v. Dura Corp.*, 789 F.2d 895 (Fed. Cir. 1986).

anatomical model

C: Anatomical models are exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(1).

ancillary jurisdiction

T: A court does not have ancillary jurisdiction to enforce a settlement agreement in an action that has been dismissed unless the court retained jurisdiction in an order. *Rolex Watch USA Inc. v. Bulova Watch Co., Inc.*, 26 USPQ 2d 1951.

animal

P: “[N]on-naturally occurring animals” constitutes patentable subject matter.

animal drug

P: A new animal drug subject to regulatory review may be eligible for a PATENT TERM EXTENSION. 35 USC 156(a)(5)(C).

annexes

P: Amendments made to the claims, descriptions or the drawings before the International Preliminary Examining Authority. 37 CFR 1.401(h).

annotations

C: A work consisting of annotations may constitute a DERIVATIVE WORK. 17 USC 101.

Annual Statement of Account

C: An “Annual Statement of Account is a statement identified in [17 USC 115(c)(3)] and required by that section to be filed for every compulsory license to make and distribute phonorecords of nondramatic musical works.” 37 CFR 201.19(a)(2). Its official designation is “Annual Statement of Account Under Compulsory License for Making and Using Phonorecords.” 37 CFR 201.19(f). *Cf.* MONTHLY STATEMENT OF ACCOUNT.

anonymous source

T: A source of goods whose identity is unknown to or not recalled by a consumer. The strength of a mark is the degree to which it tends to identify the goods sold under the mark as emanating from a particular, although a possibly anonymous, source.” *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 202 USPQ 81.

anonymous work

C: A “work on the copies or phonorecords of which no natural person is identified as author.” 17 USC 101.

ANSI

P: The AMERICAN NATIONAL STANDARDS INSTITUTE, which promulgates standards for microforms that have been adopted by the PTO. 37 CFR ***. See also MICROFICHE APPENDIX.

answer

T: On appeal. See EXAMINER'S ANSWER.

2. In opposition. The answer "shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments on which the opposer relies." 37 CFR 2.106(b).

answer material for a test

C: One of the nine statutory classes of WORKS MADE FOR HIRE. 17 USC 101. One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101. Tests and answer material for tests when published separately from other literary works are exempt from the DEPOSIT requirement. 37 CFR 202.19(c)(8).

antecedent basis

P: "All terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." CFR 1.75(d)**. Also, claims must be internally consistent. Every element referred to must have a clear antecedent. The first time an element is introduced, therefore, it is improper to use a definite article, since "the handle" has no antecedent basis.

anthology

C: An anthology may constitute a COLLECTIVE WORK if it consists of independent contributions. 17 USC 101.

antibiotic drug

P: 35 USC 156(g)(1)(B).

anticipation

P: An invention is "anticipated" if it is disclosed in a single prior art reference. *Richardson v. Suzuki Motor Co., Ltd.*, 9 USPQ 2d 1913 (Fed. Cir. 1989). A patent is barred if "the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant." 35 USC 102(a). A single prior art reference anticipates a claimed invention only if it discloses each and every claim element. *Structural Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 797, 223 USPQ 1264 (Fed. Cir. 1984). See also INHERENCY.

Anticipation may be used to show INVALIDITY of a patent. In asserting a defense of anticipation in patent litigation, a party must notify the adverse party of any patent or reference to be relied upon at least 30 days before trial. 35 USC 282.

Anti-Assignment Act

The popular name of the statute, 31 USC 3727, that renders invalid "transfer or assignment of any part of a claim against the United States Government or of an interest in the claim." Therefore, assignment of a copyright does not convey a cause of action

against the United States for past infringement. *Hayt v. U.S.*, 27 USPQ 2d 1386 (Ct. Fed. Cl. 1993).

anti-dilution statute

T: A state statute providing a remedy for trademark dilution, e.g., N.Y. G.B.L. 368-d: “Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition, notwithstanding the absence of confusion between the parties or in the absence of confusion as to the source of the goods or services.” Enforcement of anti-dilution statutes tends to be confined to famous marks or cases in which use is likely to degrade the first user’s name. See, e.g., *Steinway & Sons v. Robert De Mars and Friends*, 210 USPQ 954 (C.D. Cal. 1981).

anti-dissection rule

T: The rule that trademarks must be considered as a whole and not dissected into their component parts for analysis. [McC 23.15]. “Dissection of trademarks often leads to error.” ***

antitrust

P: “[P]atent owners may incur antitrust liability for enforcement of a patent known to be obtained through fraud.” *Atari Games Corp. v. Nintendo of America, Inc.*, 897 F.2d 1572, 14 USPQ 2d 1034 (Fed. Cir. 1990). See also RULE OF REASON, WALKER PROCESS COUNTERCLAIM.

T: “That the mark has been or is being used to violate the antitrust laws of the United States” is a defense to TRADEMARK INFRINGEMENT. 15 USC 1115(b)(7).

AP

C: Abbreviation for ARTIST’S PROOF.

APA

C: Abbreviation for ADMINISTRATIVE PROCEDURE ACT.

apostille

A French term literally meaning “letter of reference” or “recommendation”, used to refer to a document attesting to the authority of a notary or other official authorized to administer oaths.

P: The authority of an oath made before an officer of a foreign country may be proven by an “apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States.” 35 USC 115.

T: An apostille must be square-shaped and with sides at least 9 cm long. TMEP 803.01. See ACKNOWLEDGEMENT.

apparatus

P: Term including MACHINES and electrical devices.

apparatus claim

P: A claim drawn to a MACHINE rather than a PROCESS. An apparatus claim covers what a device is; a METHOD CLAIM covers what a device does. *Hewlett Packard Co. v.*

Bausch & Lomb, Inc., 909 F.2d 1464, 15 USPQ 2d 1525 (Fed. Cir. 1990), *cert. denied*, 110 S. Ct. 1125 (1990).

apparatus limitation

P: The patentability of a method claim cannot be based solely on an apparatus limitation. *Ex parte Dammers*, 155 USPQ 284.

appeal

P: “An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.” 35 USC 134. An applicant for reissue or owner of a patent under reexamination has analogous rights. 37 CFR 1.191(a). “An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit.” 35 USC 141. By appealing to the Federal Circuit, a party waives its right to appeal to a District Court. A Certificate of Mailing is ineffective to establish an appeal date under 35 USC 142. 37 CFR 1.8(a)(2)(ix). Appealing to the Federal Circuit requires both filing a notice of appeal in the PTO and filing with the Federal Circuit. 37 CFR 1.30***. The time for filing an appeal from the Board of Patent Appeals and Interferences expires 14 days after service of the notice of appeal or the summons and complaint or two months after the Board decision, whichever is later. 37 CFR 1.304(a). A refusal of claims in a statutory invention registration is appealable to the Board. 37 CFR 1.295(b).

On appeal from the Board, a reviewing court “will not consider arguments that were not timely raised before the Board.” *Chester v. Miller*, 960 F.2d 1574, 15 USPQ 2d 1333 (Fed. Cir. 1990).

From a FEDERAL AGENCY “decision or determination concerning the grant, denial, interpretation, modification, or termination of a license.” 37 CFR 404.11.

From a denial of an FOIA request. 37 CFR 1.15(b).

T: “An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon payment of the prescribed fee.” 15 USC 1070. In practice, any second refusal on the same grounds can be appealed, whether or not it is denominated as “final.” TMEP 1502. In most cases, a party who is “dissatisfied” with a decision of the Commissioner or the Trademark Trial and Appeal Board may further appeal to the CAFC or have remedy by means of a civil action in the District Courts. 15 USC 1071. See QUASI DE NOVO. In such a civil action, all expenses are paid by appellant unless the court finds them to be unreasonable. 15 USC 1071(b)(3).

A Certificate of Mailing is ineffective to establish an appeal date under 15 USC 1071(a)(2). 37 CFR 1.8(a)(2)(ix). After appeal, an application may not be amended to seek registration on the Supplemental Register.

The following adverse decisions of the TTAB are appealable to the courts: registration, interference, opposition, concurrent use registration and cancellation. The following actions by the Commissioner are appealable: failure to accept a Section 8 affidavit, failure to grant an application for renewal. 15 USC 1071(a)(1).

appealed case

T: An application that is ON APPEAL. TMEP 406.

appearance, sound and meaning

T: Characteristics of trademarks to be considered in evaluating similarity for determining likelihood of confusion. *Caesar's World, Inc. v. Caesar's Palace*, 209 Q 492.

appellant

One who has filed an appeal.

appellate court

P: In construing the Federal Rules of Evidence in an INTERFERENCE, "*Appellate court* means CAFC or United States district court when judicial review is under 35 USC 146." 37 CFR 1.671(c)(5).

appendix

P: Applicant's brief to the Board of Patent Appeals and Interferences must contain "an appendix containing a copy of the claims involved in the appeal." 37 CFR 1.192(c)(7).

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101.

applicant

P: The inventor or joint inventors who are applying for a patent or the person mentioned in 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor. 37 CFR 1.41(b). See also IMPROPER APPLICANT.

T: One who has applied to register a trademark. The term "applicant" embraces "the legal representatives, predecessors, successors and assigns of such applicant or registrant." 15 USC 1127. An applicant may be an INDIVIDUAL, PARTNERSHIP, CORPORATION, ASSOCIATION or JOINT VENTURE. JOINT APPLICANTS may also be applicants. *Cf.* OPPOSER.

application

P: A patent application must include (1) a specification; (2) a drawing; and (3) an oath and must be accompanied by the prescribed fee. A FILING DATE will be accorded as of the date the specification and drawing are received by the PTO. 35 USC 111. With respect to foreign filing restrictions, "application" includes "any modifications, amendments, or supplements thereto, or divisions thereof." 35 USC 184.

T: Constructive use. 15 USC 1057(c). See EXAMINATION.

application number

P: The identification number of a patent application, consisting of the SERIES CODE and the SERIAL NUMBER, separated by a slash. 37 CFR 1.5(a). See also INTERNATIONAL APPLICATION NUMBER.

T:

applied art

C: Applied art falls in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS, but may not be a WORK OF VISUAL ART. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

approval

T: An application has been approved when it is passed to publication. EG A.1.a. *Cf.* ALLOWANCE.

approved product

P: A product that has been subject to a regulatory review period before its commercial marketing or use and whose first permitted commercial use occurs after such regulatory review. 35 USC 156.

appurtenant

T: Inextricably connected with. Trademarks exist only in connection with a commercial activity and are said to be “appurtenant” to that activity.

apt

T:

apt descriptive term

T:

arbitrary

Administrative Procedure Act. ***. See also CAPRICIOUS, NOT IN ACCORDANCE WITH LAW.

arbitrary mark

T: A mark that “bears no relationship to the product with which it is associated.” 16 Q2 1613. Usually an ordinary word applied in an unfamiliar way rather than a COINED MARK. Arbitrary marks are strong. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). No proof of secondary meaning is required for protection of an arbitrary mark. *Russ Berrie and Co. v. Jerry Elsner Co.*, 492 F.Supp. 980 (S.D.N.Y. 1980). See also FANCIFUL MARK.

arbitration

P: The parties to an INTERFERENCE may have their contest decided by arbitration. 35 USC 135(d). The parties to a contract involving a patent may provide for arbitration of any dispute relating to validity or infringement. “A contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract. In the absence of such a provision, the parties to an existing patent validity or infringement dispute may agree in writing to settle such dispute by arbitration. Any such provision or agreement shall be valid, irrevocable, and enforceable, except for any grounds that exist at law or in equity for revocation of a contract.” 35 USC 294 . Arbitration of patent disputes is subject to title 9, United States Code. See also ARBITRATION AWARD.

arbitration award

P: In an INTERFERENCE, “[a]n arbitration award will be given no consideration unless it is binding on the parties, is in writing and states in a clear and definite manner (1) the issue or issues arbitrated and (2) the disposition of each issue ... the parties shall give notice to the Board of an arbitration award within twenty (20) days from the date of the award.” 37 CFR 1.690(c).

architectural plans

C: Architectural plans fall in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 101. They were added by the BCIA effective March 1, 1989. An architectural plan may be the embodiment of an ARCHITECTURAL WORK.

architectural work

C: “An ‘architectural work’ is the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.” 17 USC 101. This definition was added to the Copyright Act by the Architectural Works Copyright Protection Act. Architectural works are one of the classes of copyrightable subject matter. 17 USC 102(a). The copyright in an architectural work that has been constructed is not infringed by the making, distribution or public display of pictorial representations of the work, if the building in which the work is embodied is “located in or ordinarily visible from a public place.” 17 USC 120(a).

archive

C: An archive may reproduce or distribute not more than one copy or phonorecord of a work, without infringing the copyright therein, provided that “(1) the reproduction is made without any purpose of direct or indirect commercial advantage; (2) the collections of the library or archives are (i) open to the public, or (ii) available not only to researchers affiliated with the library or archives or with the institution of which it is a part, but also to other persons doing research in a specialized field; and (3) the reproduction or distribution of the work includes a notice of copyright.” 17 USC 108(a).

argument

A section of a brief setting forth contentions of the party and the bases therefor, including citations.

P: 37 CFR 1.192(c)(6).

armament

P: The Commissioner may extend for up to three years the time within which any action must be taken by the Government in a GOVERNMENT APPLICATION if the head of the department concerned certifies that the invention is “important to the armament or defense of the United States.” 35 USC 267.

Army

P: See LIAISON OFFICER.

arrangement

C: The right to make an arrangement of a work is one of the basic rights of an author under the Berne Convention.

arrangement and composition of spaces and elements

C: The “arrangement and composition of spaces and elements” of a building may constitute an ARCHITECTURAL WORK and are protected by copyright. 17 USC 101.

art

P: See PRIOR ART.

art reproduction

C: Art reproductions fall in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii). An art reproduction may constitute a DERIVATIVE WORK. 17 USC 101.

art unit

P:

article

P: Workpiece. Sometimes, an ARTICLE OF MANUFACTURE.

article limitation

P: See Landis 75.

article of manufacture

P: See MANUFACTURE.

artist's proof

C: In printmaking, a PROOF that is of substantially the same quality as that of the published edition. Abbreviated AP or EP (for *épreuve d'artiste*, the French equivalent).

Artist's Statement

C: A VISUAL ARTS REGISTRY STATEMENT filed by or on behalf of the author of a WORK OF VISUAL ART under 17 USC 113(d)(3). 37 CFR 201.25(c)(2). *Cf.* BUILDING OWNER'S STATEMENT.

artistic control

C:

ASCAP

C: The AMERICAN SOCIETY OF COMPOSERS, ARTISTS AND PUBLISHERS, a performing rights society. *Cf.* BMI.

asexually reproduced plant

P: A plant reproduced by budding, cutting, division, grafting, layering, not involving seeds. 167 FS 665. Patentable under 35 USC 161.

assembly

P: *Paper Converting Machine Co.*, 745 F.2d 11, 223 USPQ 591 (Fed. Cir. 1984)..

assent

P: See WRITTEN ASSENT.

assignee

P: "Patents may be granted to the assignee of the inventor of record ... upon the application made and the specification sworn to by the inventor." 35 USC 152. "The assignee of record of the entire interest in an application for patent is entitled to conduct the prosecution of the application to the exclusion of the inventor." 37 CFR 1.32.

assignee estoppel

P:

assignment

P: See also CONDITIONAL ASSIGNMENT.

C: See TRANSFER OF COPYRIGHT.

T: “A registered mark or a mark for which application to register has been filed shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the mark. ... In any assignment authorized by this section it shall not be necessary to include the goodwill of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted.” 15 USC 1060. Assignments shall be by instruments in writing duly executed. 15 USC 1060. An INTENT-TO-USE APPLICATION may not be assigned prior to the filing of a statement of use. 15 USC 1060. ACKNOWLEDGEMENT of an assignment is prima facie evidence of its execution. 15 USC 1060. “An assignment shall be void as against any subsequent purchaser for a valuable consideration without notice, unless it is recorded in the PTO within three months after the date thereof or prior to such subsequent purchase.” 15 USC 1060. An assignment in English will not be recorded unless accompanied by a translation signed by the translator. TMEP 501.05(b). See also TERRITORIAL ASSIGNMENT.

Assignment Division

T: The administrative unit within the PTO that records assignments of applications and registrations. TMEP 501.04.

assignment in gross

T:

assignor**assignor estoppel**

P: “Assignor estoppel is an equitable doctrine that prevents one who has assigned the rights to a patent (or patent application) from later contending that what was assigned is a nullity. The estoppel also operates to bar others parties in privity with the assignor, such as a corporation founded by the assignor.” *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220, 6 USPQ 2d 2028 (Fed. Cir. 1988). LICENSEE ESTOPPEL was abandoned in *Lear v. Adkins*, 395 US 653 (1969). However, “[t]he public policy favoring allowing a licensee to contest the validity of the patent is not present in the assignment situation. Unlike the licensee, who might be forced to pay for a potentially invalid patent, the assignor who would challenge the patent has already been fully paid for the patent rights.” *Diamond Scientific*.

“Where ... a party assigns an ‘invention’ or application, and the equities advise application of estoppel, the analysis is more elaborate. Unlike assignment of a patent, a party’s representations upon assignment of an application are not as clearly bounded.” *Q.G. Products, Inc. v. Shorty, Inc.*, 992 F.2d 1211, 26 USPQ 2d 1778 (Fed. Cir. 1993).

Assistant Commissioner for Patents and Trademarks

Two Assistant Commissioners, appointed by the President, are authorized in the PTO. 35 USC 3.

Assistant Secretary for Marketing and Inspection Services

P: The authority granted to the Secretary of Agriculture to determine, pursuant to 35 USC 156, whether an applicant for a product subject to regulatory review has acted with DUE DILIGENCE may not be delegated to an office below the office of Assistant Secretary for Marketing and Inspection Services.

associate power of attorney

P:

association

T: Membership in a union, association or other organization is denoted by a COLLECTIVE MARK.

Association Internationale Pour La Protection De La Propriété Industrielle

An international organization formed to encourage the protection of intellectual property. Abbreviated AIPPI.

assumed name designation

T: A designator indicating that a FICTITIOUS NAME is being used. See A.K.A., D.B.A., T.A. See also F.K.A.

at least as early as

T: A phrase used in trademark applications and affidavits to denote a date by which use of a trademark began. TMEP 806.08. The applicant is not precluded from subsequently proving an earlier date.

ATCC

P: = AMERICAN TYPE CULTURE COLLECTION.

atlas

C: One of the nine statutory classes of WORKS MADE FOR HIRE. 17 USC 101.

atomic energy

P: “The term ‘atomic energy’ means all forms of energy released in the course of nuclear fission or nuclear transformation.” 42 USC 2014(c) (the Atomic Energy Act).

Atomic Energy Act

P: The Atomic Energy Act, 42 USC 2181(a), bars patents for inventions useful solely in the utilization of ATOMIC ENERGY in a nuclear weapon.

atomic weapon

P: “The term ‘atomic weapon’ means any device utilizing atomic energy, exclusive of the means for transporting or propelling the device (where such means is a separable and divisible part of the device), the principal purpose of which is for use as, for development of, a weapon, weapon prototype, or a weapon test device.” 42 USC 2014(d) (the Atomic Energy Act).

attempt to monopolize

“The phrase ‘attempt to monopolize’ means the employment of methods, means and practices which would, if successful, accomplish monopolization, and which, though

falling short, nevertheless approach so close as to create a dangerous probability of it.” *American Tobacco Co. v. U.S.*, 328 US 781, 786 (1946).

attorney

P: An attorney who is admitted to practice before the PTO is known as a PATENT ATTORNEY.

T: An applicant may use an attorney to prosecute his application. 37 CFR 2.11.

attorney-client privilege

P: Tension between privilege and DUTY OF CANDOR.

T: Duty of candor?.

Attorney General

P: Notice of license to FEDERALLY OWNED INVENTIONS under 37 CFR 404.7 must be sent to the Attorney General. 37 CFR 404.9.

attorney's fees

P: “The court in exceptional cases may award attorney’s fees to the prevailing party.” 35 USC 285. “An award of attorney’s fees does not follow automatically from a holding of INEQUITABLE CONDUCT.” *Hewlett Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556, 11 USPQ 2d 1750 (Fed. Cir. 1989).

C: “Except as otherwise provided by this title, the court in its discretion may also award a reasonable attorney’s fee to the prevailing party as part of the costs.” 17 USC 505. “In any action under this title, other than an action instituted under section 411(b), no award of statutory damages or of attorney’s fees, as provided by sections 504 and 505, shall be made for —

(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or

(2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publications of the work.” 17 USC 412.

T: “The court in exceptional cases may award reasonable attorney fees to the prevailing party.” 15 USC 1117(a). Awards are never automatic and may be limited by equitable considerations.” *Lindy Pen Corp., Inc. v. BIC Pen Corp.*, 982 F.2d 1400, 1405, 25 USPQ 2d 1570 (9th Cir. 1993), *cert den.*, ***. In counterfeiting cases, “the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever is greater, together with a reasonable attorney’s fee, in the case of any violation of section 32(1)(a) of this Act (15 USC 1114(1)(a)) or section 110 of the Act entitled “An Act to incorporate the United States Olympic Association”, approved September 21, 1950 (35 USC 380) that consists of intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 34(d) of this Act (15 USC 1116(d)(1)), in connection with the sale, offering for sale, or distribution of goods or services.” 15 USC 1117(b).

The factors considered in determining the amount of attorneys’ fees are detailed in *Kerr v. Screen Extras Guld, Inc.*, 526 F.2d 67, 69 (9th Cir. 1975), *cert. den.*, 425 US 951 (1976):

1. Time and labor involved
2. Novelty and difficulty of the questions.

3. Skill requisite to perform the legal services properly.
4. Preclusion of other employment due to acceptance of the case.
5. The customary fee.
6. The contingent or fixed nature of the fee.
7. Limitations imposed by the client or the case.
8. Amount involved and the result obtained.
9. Experience, reputation and ability of the attorneys.
10. Undesirability of the case.
11. Nature of the professional relationship with the client.
12. Awards in similar cases.

Prevailing plaintiffs and defendants are to be treated equally with respect to attorney's fees, which are never to be routinely awarded. *Fogerty v. Fantasy, Inc.*, *** US *** (1994). The factors to be considered in deciding whether to award attorney's fees include: (1) frivolousness of claim; (2) motivation of infringer; (3) objective unreasonableness; (4) compensation of opposing party; and (5) deterrent effect. *Lieb v. Topstone Industries, Inc.*, 785 F.2d 151 (3rd Cir. 1986).

S: Reasonable attorney's fees may be awarded for a bad faith claim of misappropriation of trade secret, bad faith motion to terminate an injunction or willful and malicious misappropriation. UTSA 4.

attribution

C: The right of an author to be credited with having created a work. One of the MORAL RIGHTS, also known as the right of PATERNITY. "The author of a work of visual art — (1) shall have the right — (A) to claim authorship of that work, and (B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create; (2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation or other modification of the work which would be prejudicial to his or her honor or reputation ..." 17 USC 106A(a).

audiovisual display

C: Audiovisual displays produced by computer programs are protectible by copyright. 648 FS 1127, 231 Q 700.

audiovisual work

C: A work "that consist[s] of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied." 17 USC 101. Audiovisual works comprise one of the categories of COPYRIGHTABLE SUBJECT MATTER. 17 USC 102(a). A type of WORK OF THE PERFORMING ARTS. 37 CFR 202.3(b)(1)(ii). An audiovisual work may not constitute a WORK OF VISUAL ART. 17 USC 101.

author

C: The creator of a work of authorship. The term is used for all creators of works, regardless of the type of work produced. For example, the painter of a portrait in oils is known as the "author." Copyright "vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work." 17 USC 201(a).

The author of a work made for hire is the “employer or other person for whom the work was prepared” unless there is a written agreement to the contrary. 17 USC 201(a)***?.

authority

T: See COLOR OF AUTHORITY.

authorization

T: “Before any non-lawyer will be allowed to take action of any kind in any application or proceeding, a written authorization from the applicant ... must be filed therein.” 37 CFR 2.17(b).

authorization language

P: Phraseology required for insertion of a copyright or MASK WORK NOTICE in a specification or drawing, as follows: “A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of this patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file and records, but otherwise reserves all (copyright or mask work) rights whatsoever. 37 CFR 1.71(e).

authorized abbreviated caption

A short caption supplied to appellant by the CAFC upon the docketing of an appeal, which he may use except on specified documents.

authorship

C: ***. See also DE MINIMIS.

auxiliary reference

P:

average observer

P: The hypothetical person in whose eyes the novelty of a design patent application is judged. *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 788 (CCPA 1981). Cf. ORDINARY DESIGNER.

C: SUBSTANTIAL SIMILARITY is judged as perceived by the “average lay observer.” *Ideal Toy Corp. v. Fab-Lu, Ltd.*, 261 F.Supp. 238 (S.D.N.Y. 1966).

avoid

P: In a reply containing an amendment in response to an examiner’s objections or references, the applicant must show how the amendment avoids the references or objections. 37 CFR 1.111(c).

awaiting response

T: The status of a trademark application that is UNDER REFUSAL. TMEP 403. A response must be received from applicant or the application will become ABANDONED. Files of applications that are awaiting response may be found in the docket of the LAW OFFICE to which they were assigned.

award of priority

P: Result of INTERFERENCE. 37 CFR 1.11(e).

BAC

C: = BUENOS AIRES CONVENTION.

back page

C: For a work published in BOOK FORM, with a hard or soft cover, the back page is the outside of the back cover; where there is no cover, the back page is the page visible at the back of the copy before it is opened. 37 CFR 201.20(b)(7). Cf. FRONT PAGE. See also PAGE.

bad debts

C, T: Bad debts are excludable from GROSS RECEIPTS in computing cable royalties. 37 CFR 201.17(e)(7).

bad faith

P: No patent will be granted if the DUTY OF DISCLOSURE is violated through bad faith or GROSS NEGLIGENCE. 37 CFR 1.56(d). See also INEQUITABLE CONDUCT. Cf. GOOD FAITH.

T: “Refusal to cease using a mark upon demand is not necessarily indicative of bad faith ... such conduct may be compatible with good faith business judgment.” *Fontbank Inc. v. Pacific Data Prods., Inc.*, 28 USPQ 2d 1232, 1235 (N.D. Ill. 1993).

balance of equities

= BALANCE OF HARDSHIPS. *Farberware Inc. v. Mr. Coffee Inc.*, 16 Q2 1103 (D. Del. 1990)

balance of hardships

A consideration in deciding whether a PRELIMINARY INJUNCTION should be granted. Also BALANCE OF EQUITIES.

bank checks

C: Bank checks, to the extent they are for recording rather than conveying information, are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

bankruptcy

T: [deal with separation of mark from goodwill]

bar

P: An absolute barrier to the obtaining of a patent. See ON-SALE BAR, PUBLIC USE BAR, STATUTORY BAR.

base claim

P: The independent claim from which a dependent claim ultimately depends. Also BASIC CLAIM. Cf. PARENT CLAIM.

based on

C: A DERIVATIVE WORK is one that is “based on one or more preexisting works.” 17 USC 101.

basic claim

P: = BASE CLAIM.

basic fee

P: PCT. See also INTERNATIONAL FEE.

basic reference

P:

basic registration

C: “A ‘basic registration’ means any of the following: (A) A copyright registration made under sections 408, 409, and 410 of Title 17 of the United States Code ... (B) a renewal registration made under section 304 of Title 17 of the United States Code ... (C) a registration of claim to copyright made under Title 17 of the United States Code as it existed before January 1, 1978; or (D) a renewal registration made under Title 17 of the United States Code as it existed before January 1, 1978.” 37 CFR 201.5(a)(1)(i).

basis for filing

T: A declaration indicating that the applicant may receive a registration under law, consisting of either (1) a date of first use in commerce and a specimen of such use (15 USC 1051(a)); (2) a claim of bona fide intention to use the mark in commerce (15 USC 1051(b)); or (3) a certified copy of a foreign registration on which the application is based (15 USC 1126). A basis for filing is required element of every trademark application. 37 CFR 2.21(a)(5). A basis for filing is required to obtain a filing date. *In re Choay, S.A.*, 16 USPQ 2d 1461 (Comm’r Pats 1990). In the applicant desires to prosecute an application on more than one basis, that fact must be clearly indicated in the application. *In re Miguez*, 16 USPQ 2d 1458 (Comm’r Pats. 1990). Cf. BASIS FOR REGISTRATION.

basis for registration

T: A statutory basis on which a registration may issue from an application. In many cases, the basis for registration is the same as the BASIS FOR FILING. However, a U.S. application may be based on a foreign application under 15 USC 1126(d), but a U.S. registration cannot issue unless the foreign application issues or the mark is used in commerce in the U.S.

BCIA

C: The BERNE CONVENTION IMPLEMENTATION ACT OF 1988.

before the hearing

P: In construing the Federal Rules of Evidence in an INTERFERENCE, “*Before the hearing* in Rule 703 means before giving testimony by oral deposition or affidavit.” 37 CFR 1.671(c)(6).

beliefs

T: A mark that may disparage or falsely suggest a connection with beliefs or bring them into contempt or disrepute may be refused registration, either on the principal or the Supplemental Register. 15 USC 1052(a), 1091(a).

Benson

P: *Gottschalk v. Benson* ***.

bequest

C: Ownership of copyright may be “bequeathed by will”. 17 USC 201(d)(1). See also **INTESTATE SUCCESSION**.

Berne Convention

C: The “Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto.” 17 USC 101. It was ratified by the United States on October 31, 1988 and came into force in the United States through statutory implementation on March 1, 1989. The Berne Convention does not expand or reduce any statutory or common-law rights, 17 USC 104(c).

Berne Convention Implementation Act of 1988

C: The Berne Convention for the Protection of Literary and Artistic Works is not self-executing, so its terms have no effect in the U.S. except to the extent provided by statute. The Berne Convention Implementation Act of 1988 (102 Stat. 2853), which enacted selected portions of the Berne Convention, became effective on March 1, 1989 and is not retroactive. Abbreviated BCIA.

Berne Convention work

C: A work is a ‘Berne Convention work’ if

- (1) in the case of an unpublished work, one or more of the authors is a national of a nation adhering to the Berne Convention, or in the case of a published work, one or more of the authors is a national of a nation adhering to the Berne Convention on the date of first publication;
- (2) the work was first published in a nation adhering to the Berne Convention, or was simultaneously first published in a nation adhering to the Berne Convention and in a foreign nation that does not adhere to the Berne Convention;
- (3) in the case of an audiovisual work — (A) if one or more of the authors is a legal entity, that author has its headquarters in a nation adhering to the Berne Convention; or (B) if one or more of the authors is an individual, that author is domiciled, or has his or her habitual residence in, a nation adhering to the Berne Convention;
- (4) in the case of a pictorial, graphic, or sculptural work that is incorporated in a building or other structure, the building or structure is located in a nation adhering to the Berne Convention; or
- (5) in the case of an architectural work embodied in a building, such building is erected in a country adhering to the Berne Convention.” 17 USC 101.

best available art

P: ART that is most pertinent in showing **ANTICIPATION** or **OBVIOUSNESS**. “Prior art rejections should ordinarily be confined strictly to the best available art.” MPEP 706.02.

best edition

C: The edition of a work “published in the United States at any time before the date of deposit, that the Library of Congress determines to be the most suitable for its purposes.” 17 USC 101. See also **BEST EDITION STATEMENT**.

best edition statement

C: A popular name for the publication, “Best Edition of Published Copyrighted Works for Collections of the Library of Congress,” which gives BEST EDITION specifications. 37 CFR 202.19(b)(1)(ii). If two works differ in copyrightable contents, both are separate works and the criteria for best edition do not apply. 37 CFR 202.19(b)(1)(iv). See also COMPLETE COPY.

best mode

P: The specification of a patent application must “set forth the best mode contemplated by the inventor of carrying out his invention.” 35 USC 112. “Not complying with the best mode requirement amounts to concealing the preferred mode contemplated by the applicant at the time of filing.” *DeGeorge v. Bernier*, 768 F.2d 1318, 226 USPQ 758 (Fed. Cir. 1985). Best mode compliance is a QUESTION OF FACT. *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 221 USPQ 1241 (Fed. Cir. 1984). Lack of compliance with the best mode requirement must be shown by CLEAR AND CONVINCING EVIDENCE.

“In the case of an ‘ornamental design for an article of manufacture, ... the ‘best mode’ requirement is not applicable, as a design has only one ‘mode’ and it can be described only by illustrations showing what it looks like.” *Racing Strollers, Inc. v. TRI Industries, Inc.*, 878 F.2d 1418, 11 USPQ 2d 1300 (Fed. Cir. 1989).

bibliography

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101.

binder’s board

T: Protective material for drawings sent to the PTO. 37 CFR 2.53.

binding arbitration

P: See ARBITRATION.

biological material

P: For DEPOSIT purposes, “the term biological material shall include material that is capable of self-replication either directly or indirectly. Representative examples include bacteria, fungi including yeast, algae, protozoa, eukaryotic cells, cell lines, hybridomas, plasmids, viruses, plant tissue cells, lichens and seeds.” 37 CFR 1.801.

blackout period

T: An informal name for the interval between approval for PUBLICATION of mark that is the subject of an INTENT-TO-USE application and issuance of a NOTICE OF ALLOWANCE, during which neither a STATEMENT OF USE nor an AMENDMENT TO ALLEGE USE can be filed. 37 CFR 2.76(a).

blank forms

C: “Blank forms, such as time cards, graph paper, account books, diaries, bank checks, scorecards, address books, report forms, order forms and the like, which are designed for recording information and do not in themselves convey information” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

blanket license

C:

blind bidding

C:

blind persons

P: [Walker 9:63].

block booking

C: The practice of requiring licenising of undesirable works in order to license desirable ones. *U.S. v. Lowe's, Inc.*, 371 US 38 (1962). See also TIE-IN.

blocking patents

C: Separate patents that so cover an invention that it cannot be practiced unless all the patents are licensed.

blue pencil rule

S: The principle, adopted in some states, that a non-competition found unreasonable may be saved if it can be modified to be reasonable by only the deletion of words. *Timenterial, Inc. v. Dayata*, 277 A.2d 512 (Conn. Super. 1971).

blueprint

C: An architectural or engineering blueprint illustrating a scientific or technical work is exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(1).

BMI

C: Broadcast Mustic, Inc., a performing rights society. *Cf.* ASCAP.

Board

P: The BOARD OF PATENT APPEALS AND INTERFERENCES. 37 CFR 1.601(c).

T: The TRADEMARK TRIAL AND APPEAL BOARD.

Board of Patent Appeals and Interferences

P: "The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of an invention in interferences declared under section 135(a) of this title." 35 USC 7(b). The Board consists of the Commissioner, Deputy Commissioner, Assistant Commissioners and examiners-in-chief of the Patent and Trademark Office. 35 USC 7. ***

body of claim

P. The portion of a patent claim following the PREAMBLE and TRANSITIONAL PHRASE, in which the functioning elements or steps of the claim are recited.

bona fide

P: Assignment records of pending or abandoned applications are not available to the public but to a "bona fide prospective or actual purchaser, mortgagee, or licensee." 37 CFR 1.12(b).

T: A reply to official action must make a bona fide attempt to advance the case. 37 CFR 1.111(b). An incomplete response to an office action is not an abandonment if it is a bona fide attempt to respond. 37 CFR 1.135(c).

A trademark application under Section 1(b) must be based on a bona fide intent to use the mark in commerce. 15 USC 1051(b). The words “good faith” may be used in the application instead of “bona fide.” EG No. 1-90 (Mar. 21, 1990).

See also ABANDONMENT, BONA FIDE USE, COUNTRY OF ORIGIN.

bona fide use

T: [McC 16:02]

book

C: One of the types of works protected by the first U.S. copyright act of May 31, 1790. A book may not constitute a WORK OF VISUAL ART. 17 USC 101. See also CHART, MAP.

book form

C: A “work is published in ‘book form’ if the copies embodying it consist of multiple LEAVES bound, fastened, or assembled in a predetermined order.” 37 CFR 2.01.20(b)(4)..

bootleg

C: To make an unauthorized copy of a performance, thereby infringing copyright.

box

Box FWC. 37 CFR 1.62(i).

Box INTERFERENCE. 37 CFR 1.1(e).

Box ITU. For statements of use in ITU applications.

Box M. Fee. 37 CFR 1.1(d).

Box Patent Ext. 37 CFR 1.1(e).

Box PCT. 37 CFR 1.1(b).

Box Reexam. 37 CFR 1.1(c).

brackets

P: Deletions in amendments are denoted by enclosing the material to be removed within brackets. Brackets are also used in the specification of reissue patents.

Drawings depicting parts that are not physically connected must be enclosed in brackets to indicate that they are part of the same drawing.

brand name

T: A casual synonym for TRADEMARK.

brevet

P: The French for “patent.”

bridging the gap

T: A phrase referring to the likelihood that the plaintiff will enter the defendant’s market. *WWW Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 574, 25 USPQ 2d 1593 (Fed. Cir. 1993). A doctrine invoked when the goods sold under the accused mark do not compete with the goods of the registrant. The focus then become whether plaintiff is likely to “bridge the gap” by expanding into defendant’s market. *Centaur Communications Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1217 (2d Cir. 1987).

brief

P: Appellant's brief must be filed within two months from the notice of appeal or within the time for response to the action appealed from.

Contents:

Status of claims (pending, cancelled, on appeal)

Summary of the invention

Issues

Grouping of claims (if rejected claims should not stand or fall together)

Argument

Appendix (including claims involved in appeal)

See also OPENING BRIEF.

T: Applicant's brief, Examining Attorney's brief, Applicant's Reply brief. 37 CFR 2.142(b).

broad claim

P: A claim that covers not only the disclosed embodiments, but also potential equivalents of the invention. A claim may be drawn as broadly as the PRIOR ART will allow. MPEP 706.03(d). Cf. NARROW CLAIM.

A claim of a reissue application is broader in scope than the original claims if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent." *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 4 USPQ 2d 1450 (Fed. Cir. 1987).

broadcasting

C: The right to broadcast a work is one of the basic rights of an author under the Berne Convention.

broadened reissue

P: [Walker 14:26].

broken lines

T: "Broken lines should be used in the drawing of a mark to show placement of the mark on the goods, or on the packaging, or to show matter not claimed as part of the mark, or both." 37 CFR 2.51(d).

Brussels Satellite Convention

C: The Convention Relating to Distribution of Programmer-Carrying Signals Transmitted by Satellite, which prevents the unauthorized distribution of signals transmitted by earth satellites. The U.S. ratified the Convention in 1984.

Budapest Treaty

P: The Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purpose of Patent Procedure, which became binding on the United States on August 19, 1980. *Ex parte Hildebrand*, 15 USPQ 2d 1662.

Buenos Aires Convention of 1910

A convention for the protection of trademarks and commercial names, signed March 20, 1910 at Buenos Aires.

C: The Buenos Aires Convention on Literary and Artistic Copyright. Requires use of “all rights reserved.”

T: The Buenos Aires Convention on Inventions, Patents and Designs and Industrial Models, among the United States and countries of South and Central America. See also SUPPLEMENTAL REGISTER.

building

C: A design for a building as embodied in a tangible medium of expression is an ARCHITECTURAL WORK and is protected by copyright. 17 USC 101. A building itself is an architectural work. 17 USC 101.

Building Owner’s Statement

C: A VISUAL ARTS REGISTRY STATEMENT filed by or on behalf of the owner of a building which incorporates a WORK OF VISUAL ART. 37 CFR 201.25(c)(3). Cf. ARTIST’S STATEMENT.

bulk goods

T: affixation relaxed

bulky specimen

T: A specimen that does not conform to PTO size requirements. The Examining Attorney must require a bulky specimen to be replaced by a specimen of acceptable size and shape. TMEP 808.02. Replacements are treated as SUBSTITUTE SPECIMENS.

bundling

P: See also TYING.

burden of proof

P: “The burden is on the patent owner to prove infringement by a preponderance of the evidence.” *Morton International, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 28 USPQ 2d 1190 (Fed. Cir. 1993), *on remand from* 113 S.Ct. 1967, 26 USPQ 2d 1721 (1993).

T: carry back — clear and convincing evidence.

burden on the examiner

P: A REQUIREMENT FOR RESTRICTION is only proper when examination of distinct inventions would constitute a serious burden on the examiner. This occurs when (1) the related inventions are classified differently; or (2) while classified together, they have separate status in the art; or (3) they require different fields of search. MPEP 803.

burlesque

C: Burlesque is treated as PARODY.

business day

See HOLIDAY.

but for

P: “To recover lost profits as actual damages, a patent holder must demonstrate that there was a reasonable probability that, but for the infringement, it would have made the infringer’s sales.” 24 USPQ 2d 1321, 1336.

cable system

C: A “facility, located in any State, Territory, Trust Territory, or Possession, that in whole or in part receives signals transmitted or programs broadcast by one or more television broadcast stations licensed by the Federal Communications Commission, and makes secondary transmissions of such signals by wires, cables, or other communications channels to subscribing members of the public who pay for such service.” 17 USC 111(f). See also INDIVIDUAL CABLE SYSTEM.

CAFC

Acronym for the COURT OF APPEALS FOR THE FEDERAL CIRCUIT.

calendar

C: Standard calendars containing no original authorship are not copyrightable. 37 CFR 202.1(d).

cancellation

P: claim. Cancellation in application.

Cancellation of the claims of an issued patent may occur as the result of an interference or a judgment of invalidity by a court.

C: “Cancellation is an action taken by the Copyright Office whereby either the registration is eliminated on the ground that the registration is invalid under the applicable law and regulations, or the registration number is eliminated and a new registration is made under a different class and number.” 37 CFR 201.7(a). “The Copyright Office will cancel a completed registration only in those cases where (1) It is clear that no registration should have been made because the work does not constitute copyrightable subject matter or fails to satisfy the other legal and formal requirements for obtaining copyright; (2) registration may be authorized but the application, deposit material, or fee does not meet the requirements of the law and Copyright Office regulations, and the office is unable to get the defect corrected; or (3) an existing registration in the wrong class is to be replaced by a new registration in the correct class.” 37 CFR 201.7(b).

A court has no power to order cancellation of a copyright registration.

T: The removal of a mark from either the Principal or Supplemental Register. “A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged by the registration of the mark on the principal register ...” 15 USC 1064. When a petition to cancel is filed, notice must be sent to the parties by the Commissioner. 15 USC 1067. A trademark registration may be surrendered for cancellation voluntarily. 15 USC 1057(e).

*** Section 8 ***.

A mark may be cancelled if it is not registered according to its correct TYPE OF MARK. TMEP 108.

A filing date erroneously accorded to an application by the PTO may be “cancelled.” Also VACATE.

cancellation fee

C: A fee to be paid in compensation for the termination of a contract to create a work. Also KILL FEE.

cancellation proceeding

T: A contested proceeding before the TRADEMARK TRIAL AND APPEAL BOARD for CANCELLATION of a registered trademark.

cancellation proof

C: An impression of a LIMITED EDITION print that is struck to exhibit the defacing of the printing element, which assures that no further copies can be printed.

candor

P:

capability of operation

P: A mode or capability of operation attributed to a reference may result in the denial of a patent. 37 CFR 1.132.

capable

T: Reserved for the Supplemental Register. TMEP 1106.02(c).

capricious

Administrative Procedure Act. ***. See also ARBITRARY, NOT IN ACCORDANCE WITH LAW.

carcinogenic potential

P: Submission of a new drug product to the Food and Drug Administration for a health effects test to evaluate its carcinogenic potential may result in a PATENT TERM RESTORATION. 35 USC 155A(a)(1)(B).

carry back

P: To claim a date of REDUCTION TO PRACTICE that is prior to the EFFECTIVE FILING DATE of a patent application. See also SWEAR BACK.

T: To claim a DATE OF FIRST USE that is prior to the date of first use claimed in a trademark application.

cartoon character

C:

case-in-chief

P: In an INTERFERENCE, that “portion of a party’s case where the party has the burden of going forward with evidence.” 37 CFR 1.601(d). Cf. CASE-IN-REBUTTAL.

case-in-rebuttal

P: In an INTERFERENCE, that “portion of a party’s case where the party presents evidence in rebuttal to the CASE-IN-CHIEF of another party.” 37 CFR 1.601(e).

catalog

P: See AGGREGATION.

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i).

category

C: One of the seven groups of COPYRIGHTABLE SUBJECT MATTER as defined at 17 USC 102(a).

category of invention

P: PCT. 37 CFR 1.475(b).

cause

See GOOD AND SUFFICIENT CAUSE, GOOD CAUSE.

CCC

Acronym for the COPYRIGHT CLEARANCE CENTER.

CCPA

Acronym for the COURT OF CUSTOMS AND PATENT APPEALS.

cease and desist**certificate**

P: After REEXAMINATION.

In an INTERFERENCE, “[a] motion shall contain a certificate by the moving party stating that the moving party has conferred with all opposing parties in an effort in good faith to resolve by agreement the issues raised by the motion.” 37 CFR 1.637(b).

T: Attorney’s certificate under Rule 65(b).

certificate of correction

P: A clerical mistake or typographical error in an issued patent is corrected by means of a certificate of correction. 35 USC 255-256, 37 CFR 1.322-1.325. See also CORRECTION.

T: “Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Commissioner is authorized to issue a certificate of correction or, in his discretion, a new certificate upon payment of the prescribed fee: *Provided*, That the correction does not involve such changes in the registration as to require republication of the mark.” 15 USC 1057(h). See also CORRECTION.

certificate of filing

C: A certificate of filing can be obtained for a MONTHLY STATEMENT OF ACCOUNT. 37 CFR 201.19(e)(7).

certificate of interest

A document filed with a federal appeals court to determine whether recusal is necessary, listing parties, real parties in interest, corporate disclosures and attorneys and their law firms involved in the case. CAFC Rule 47.4.

certificate of mailing

P, T: A paper, with certain exceptions, will be taken to be timely filed if it is mailed by first-class and is accompanied by a certificate that such mailing has occurred. The paper will be considered to have been filed on the date shown on the certificate. The procedure is not available in numerous instances, including
national patent applications
international patent applications
interferences

agreements between parties to an interference
 trademark applications and renewals
 affidavits of use or nonuse
 affidavits of incontestability
 petitions to cancel
 notices of appeal
 notice to proceed by civil action
 statements under 42 USC 2182, 2457(c)
 papers ordered to be filed by express mail
 disciplinary ***.
Cf. EXPRESS MAIL. 37 CFR 1.10.

certificate of record

C: A certificate by the Copyright Office that a document has been recorded. 37 CFR 201.4(e).

certificate of reexamination

P:

certificate of registration

C: Additional *** 17 USC 706.

T: Certificates of trademark registration bear the seal and signature of the Commissioner. 15 USC 1057(a). They contain the mark, date of first use, date of first use in commerce, a description of goods or services, date of registration, term, filing date and “any conditions or limitations that may be imposed in the registration.” 15 USC 1057(a). “A certificate of registration of a mark upon the principal register ... shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.” 15 USC 1057(b). Upon the recording of an assignment, a new certificate may be issued in the name of the assignee. 15 USC 1057(d). “Unless registration is successfully opposed — (1) a mark entitled to registration on the principal register based on an application file under section 1(a) or pursuant to section 44 shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette” 15 USC 1063(b)(1). “When the requirements of the law and of the rules have been complied with and the Patent and Trademark Office has adjudged a mark registrable, a certificate will be issued to the effect that the applicant has complied with the law and that he is entitled to registration.” 37 CFR 2.157.

“The certificates of registration for marks registered on the supplemental register shall be conspicuously different from certificates issued for marks registered on the principal register.” 15 USC 1093.

certification

16 Q2 1458

C: See OFFICIAL CERTIFICATION, SWORN CERTIFICATION. A STATEMENT OF ACCOUNT must contain “a certification of the capacity of the person signing.” 37 CFR 201.17(e)(14)(iii)(D).

Certification and Documents Section

C: A section of the Copyright Office that receives copyright deposits and maintains records. 37 CFR 201.1(c).

certification mark

T: A mark whose purpose is not to indicate origin, but to certify that goods or services meet certain standards. “The term ‘certification mark’ means any word, name, symbol, or device, or any combination thereof —

(1) used by a person other than its owner, or

(2) which the owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.” 15 USC 1127. A certification mark may not be used on the goods or service of the mark’s owner, but may denote only certification. 15 USC 1054. The mark is applied by others to their goods or services with the authorization of the owner, who must take steps to ensure such goods or services contain the requisite characteristics or meet the specified requirements which the certifier/owner has established or adopted for certification. TMEP 1305.01.

Person and nations may register certification marks, which provide the same legal protections as trademarks. 15 USC 1054.

A certification mark may be cancelled at any time if “the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.” 15 USC 1064(5). An application for registration of a certification mark must “specify the manner in which and the conditions under which the certification mark is used; it shall allege that the applicant exercises legitimate control over the use of the mark and that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied.” 37 CFR 2.45.

See PETITION TO CANCEL.

certified copy

The PTO may issue certified copies of issued patents and other records available to the person applying therefor. 35 USC 10.

P: To obtain the benefit of a foreign filing date, the applicant must provide a certified copy of the foreign application, specification and drawings. 35 USC 119.

T: Certified copies of TM registrations.

certified list

P: In an appeal to the CAFC, the list of documents in the prosecution file of the Patent and Trademark Office, which the Commissioner is required to transmit to the court. CAFC Rule 17.

chain of title

T: TMEP 502.01.

channel of trade

T: The network through which a product or service is promoted, distributed and sold. Similarity of channels of trade is a factor to be considered in weighing likelihood of confusion. *Taj Mahal Enterprises, Ltd. v. Trump*, 15 Q2 1641.

characterized form

P: A European form of JEPSON CLAIM, in which the improvement is introduced by the phrase “characterized in that”

character names

T: A character name may be registered as a SERVICE MARK if it identifies a service. 15 USC 1127, TMEP 1310.10.

characters

C:

T:

chart

C: One of the types of works protected by the first U.S. copyright act of May 31, 1790. See also book, map. One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101. Charts fall in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS, but they may not be WORKS OF VISUAL ART. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

Check List

P: A portion of the REQUEST form accompanying an INTERNATIONAL APPLICATION. 37 CFR 1.434(b).

checks

C: BANK CHECKS, to the extent they are for recording rather than conveying information, are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

Chief Counsel for Advocacy of the Small Business Administration

P:

children

C: A “person’s immediate offspring, whether legitimate or not, and any children legally adopted by that person.” 17 USC 101.

choreographic work

C: One of the types of copyrightable subject matter. 17 USC 102(a)(4). A type of WORK OF THE PERFORMING ARTS. 37 CFR 202.3(b)(1)(ii).

CIP

P: Abbreviation for CONTINUATION-IN-PART.

circumvention

C: Circumvention of SERIAL COPYING regulation devices is prohibited under 17 USC 1002(c).

citable**citation of references**

P: [See 37 CFR 1.109].

citizenship

C: The citizenship of the author on the DATE OF FIRST PUBLICATION of a work must be specified in a RENEWAL AFFIDAVIT FOR A U.C.C. WORK. 37 CFR 202.17(d)(2)(i)(C).

T: The citizenship of the applicant must be specified in the application. If the applicant is not a citizen of any country, a statement to that effect is acceptable. TMEP 802.04.

civil action

An action instituted in one of the United States District Courts.

P: remedy by civil action. 35 USC 145, 146, 37 CFR 1.303. A certificate of mailing is ineffective to establish a filing date of notice to proceed by civil action. 37 CFR 1.8(a)(2)(viii).

In construing the Federal Rules of Evidence in an INTERFERENCE, civil action means interference. 37 CFR 1.671(c)(4).

T: Trademark infringement. 15 USC 1114.

Appeal from decision of the TTAB. 15 USC 1071(b).

civil proceeding

P: In construing the Federal Rules of Evidence in an INTERFERENCE, civil proceeding means interference. 37 CFR 1.671(c)(4).

claim

P: A written description of the boundaries of an invention. "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent, or, if the nature of the case admits, in dependent or multiple dependent form." 35 USC 112. Claims have been required in patent applications since the Act of 1836. Claims must be numbered in consecutive order and the numbers must be retained throughout prosecution but will be renumbered on allowance. 37 CFR 1.126. Requirements 37 CFR 1.75. *** Determine infringement, read on.

A claim is a required component of an INTERNATIONAL APPLICATION. 37 CFR 1.431(a). See APPARATUS CLAIM, BROAD CLAIM, CLOSED-ENDED, COINED NAME CLAIM, DEPENDENT CLAIM, DIAGRAM CLAIM, DOSAGE CLAIM, DUPLICATE CLAIM, EUROPEAN-TYPE CLAIM, EVIDENCE CLAIM, FINGERPRINT CLAIM, FORMAL CLAIM, GENERIC CLAIM, GROUP, HYPOTHETICAL CLAIM, IMPROVEMENT CLAIM, INDEPENDENT CLAIM, JEPSON CLAIM, LABEL CLAIM, MARKUSH CLAIM, MEANS-PLUS-FUNCTION CLAIM, METHOD CLAIM, MULTIPLE DEPENDENT CLAIM, NARROW CLAIM, OMNIBUS CLAIM, OPEN-

ENDED, ORIGINAL CLAIM, OUTLINE FORM, PARENT CLAIM, PARTIALLY CLOSED, PERIPHERAL CLAIM, PICTURE CLAIM, PREAMBLE, PROCESS CLAIM, PRODUCT CLAIM, PRODUCT-BY-PROCESS CLAIM, RESTRICTION, SINGLE MEANS CLAIM, SINGLE SENTENCE RULE, SINGLE SPECIES CLAIM, SNAPSHOT CLAIM, UNDULY MULTIPLIED.

claim-anticipating disclosure

P: A disclosure in a prior art REFERENCE that is sufficient to constitute ANTICIPATION under 35 USC 102. Cf. CLAIM-SUPPORTING DISCLOSURE. A claim-anticipating disclosure would not necessarily be claim-supporting if it were contained in a patent application. *In re Albrecht*, 168 USPQ 293; *Chester v. Miller*, 906 F.2d 1574, 15 USPQ 2d 1333 (Fed. Cir. 1990)..

claim construction

P: “In determination of the meaning and scope of a patent claim, based on the language of the claim, the prior art and the prosecution history of the patent.” In determining the meaning of a claim, it is necessary to examine closely the language of the claim, the specification, and the prosecution history.” *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 23 USPQ 2d 1284 (Fed. Cir. 1984). Claim construction is a QUESTION OF LAW. *Moeller v. Ionetics, Inc.*, 794 F.2d 653.

claim differentiation

P: Doctrine that differences in language between two claims is significant. *Tandon Corp. c. U.S. Int’l. Trade Comm’n.*, 831 F.2d 1017; 4 USPQ 2d 1283; 16 USPQ 2d 1401, 1410

claim interpretation

P: See CLAIM CONSTRUCTION.

claim involved in the interference

P: A “claim involved” under 35 USC 135(a) is a claim of an application or patent which corresponds to a COUNT. 37 CFR 1.601(f).

claim-supporting disclosure

P: A disclosure in the SPECIFICATION of a patent sufficient to support patentability of a claim in the same application. Cf. CLAIM-ANTICIPATING SPECIFICATION.

claimant

C: See COPYRIGHT CLAIMANT.

claims of varying scope

P:

class

P:

C: Category *** “Where registration is made in the wrong class, the Copyright Office will cancel the first registration, replace it with a new registration in the correct class, and issue a corrected certificate. See CANCELLATION.

T: *** international class, U.S. class. Certification marks are divided into just two classes: ‘A’ for goods and ‘B’ for services. TMEP 1305.09

class number

T: The numeral corresponding to an INTERNATIONAL CLASS.

classifiability

T: TMEP 804.02.

classification

P: The Commissioner may revise and maintain a classification system for patents and other publications “for the purpose of determining with readiness and accuracy the novelty of inventions ...” 35 USC 9.

T: “The Commissioner may establish a classification of goods and services for convenience of Patent and Trademark administration, but not to limit or extend the applicant’s or registrant’s rights.” 15 USC 1112. Beginning September 1, 1973, the international classification of goods and services became the primary classification used in the United States. 37 CFR 2.85. Classification has no bearing on likelihood of confusion. *In re Vic Boff Health and Fitness Aids, Inc.*, 189 Q 357 (TTAB 1975).

classroom use

C: See FAIR USE.

clear and convincing evidence

P:

Anticipation?

That a disclosure supports copied claims. *DeGeorge v. Bernier*, 768 F.2d 1318, 226 USPQ 758 (Fed. Cir. 1985).

Failure of compliance with best mode. *Engel Industries v. Lockformer Co.*, 946 F.2d 1526, 20 USPQ 2d 1300 (Fed. Cir. 1991).

Fraud

Functionality as a defense to design patent infringement.

Inequitable conduct. *Burlington Industries Inc. v. Dayco Corp.*, 849 F.2d 1418, 7 USPQ 2d 1158 (Fed. Cir. 1988).

Interference. *Price v. Symsek*, 988 F.2d 1887, 26 USPQ 2d 1031 (Fed. Cir. 1993).

Invalidity of patent. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick*, 730 F.2d 1452 (Fed. Cir. 1984).

Lack of enablement. *Morton Int’l Inc. v. Cardinal Chemical Co.*, 28 USPQ 2d 1190, 1194 (Fed. Cir. 1993).

Materiality of false information

On-sale bar. *Baker Oil Tools, Inc. v. Geo Vann, Inc.*, 828 F.2d 1558, 4 Q2 1210 (Fed. Cir. 1987).

Prior invention. *Pentech Int’l. v. Hayduchok*, 18 Q2 1337 (S.D. N.Y. 1990)

Prior use. *Trans-World Manufacturing Corp. v. Al Nyman & Sons, Inc.*, 750 F.2d 1552, 224 USPQ 259 (Fed. Cir. 1984);

Public use. *T.P. Labs*, 724 F.2d 965.

Violation of duty of disclosure. 37 CFR 1.56(d)

Willful infringement

clear and not in doubt

T: The defenses of laches and estoppel are not available where likelihood of confusion is “clear and not in doubt.” *Cook’s Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 Q 265 (TTAB 1977).

clear error

P: See FULL FAITH AND CREDIT.

T: An error by the PTO “which, if not corrected, would result in issuance of a registration in violation of the Act.” TEG A.3.d. It is PTO policy that the Examining Attorney may not issue a refusal of an ITU application upon examination of the statement of use if the refusal could have been issued on initial examination unless there is clear error. EG A.9.b. *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ 2d 2034 (TTAB 1989). Cf. CLEARLY ERRONEOUS.

A standard of review for PETITIONS for relief from actions of professional PTO employees having legal training. The applicant is entitled to relief only if it can show “clear error or an abuse of discretion.”

clearance

T: The process of checking the legal availability of a proposed trademark.

clearly erroneous

A finding of fact is “clearly erroneous” when, although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed.” *Kalman v. The Berlyn Corp.*, 16 Q2 1093 (Fed. Cir. 1990). Cf. CLEAR ERROR.

clerk

In Massachusetts, a corporate officer. TMEP 803.09.

T: “It shall be the duty of the clerks of [courts having jurisdiction over civil actions arising under this chapter] within one month after the filing of any action, suit, or proceeding involving a mark registered under the provisions of this chapter to give notice thereof in writing to the Commissioner setting forth in order so far as known the names and addresses of the litigants and the designating number or numbers of the registration or registrations upon which the action, suit or proceeding has been brought ...” 15 USC 1116(c).

clipping service

T: An organization that provides clippings of newspaper articles in which particular marks are mentioned. See also WATCH SERVICE.

closed

P: = CLOSED-ENDED.

closed-ended

P: Said of a patent claim that excludes elements or ingredients not specifically named, typically employing the phrase “consisting of.” Also CLOSED. Cf. OPEN-ENDED, PARTIALLY CLOSED.

coat of arms

T: A mark may be refused registration on either the principal or the supplemental register if it “consists of or comprises the coat of arms of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 USC 1052(b), 1091(a).

co-author

C: See JOINT AUTHOR.

coercive damages

Damages intended to coerce future compliance with an injunction. *Lance v. Plummer*, 353 F.2d 585 (5th Cir. 1965), *cert. denied*, 384 U.S. 929, *reh’g denied*, 384 U.S. 994 (1966).

co-inventor

P: See JOINT INVENTOR.

coin-operated phonorecord player

C: A “machine or device that —

(A) is employed solely for the performance of nondramatic musical works by means of phonorecords upon being activated by insertion of coins, currency, tokens, or other monetary units or their equivalent;

(B) is located in an establishment making no direct or indirect charge for admission;

(C) is accompanied by a list of the titles of all the musical works available for performance on it, which list is affixed to the phonorecord player or posted in the establishment in a prominent position where it can be readily examined by the public; and

(D) affords a choice of works available for performance and permits the choice to be made by the patrons of the establishment in which it is located.” 17 USC 116(e)(1).

coined mark

T: A mark that consists of an invented word not previously known or a combination of letters having no meaning. A coined mark is the strongest possible type of mark because, having no inherent meaning, it can only serve to distinguish the owner’s products or services. 1990 Bacal 1.5. See also ARBITRARY MARK, FANCIFUL MARK.

coined name claim

P: A claim to consisting of the name of a compound without recitation of its structure, proper only where the name was known in the art prior to the filing of the application. *Ex parte Brian*, 118 Q 242.

collateral estoppel

Also ISSUE PRECLUSION. See also SECOND INTERFERENCE.

T: Factual findings of the TTAB “will control in a subsequent infringement suit unless the contrary is established by evidence that, in character and amount, carries thorough conviction.” *Freedom Savings & Loan Association v. Way*, 757 F.2d 1176, 1181, 226 USPQ 123 (11th Cir. 1985).

collateral use

T: Use of the trademark of another by selling or incorporating goods that bear a pre-existing mark. Collateral use is permissible if the user does not deceive the public as to the source of goods. *Prestonettes, Inc. v. Coty*, 264 US 359 (1924).

collection

C: A combination of copyrightable elements (1) assembled in an orderly form; (2) bearing a single title identifying the collection as a whole; (3) having the same copyright claimant in all of the elements as in the collection as a whole; and (4) all having the same author, or, if they are by different authors, at least one of the authors has contributed copyrightable authorship to each element. 37 CFR 202.3(b)(3)(B).

collective mark

T: “The term ‘collective mark’ means a trademark or service mark —

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

and includes marks indicating membership in a union, an association or other organization.” 15 USC 1127. Each member applies the mark to his own goods, but the mark is owned by the collective body that controls its use. TMEP 104.

Person and nations may register collective marks, which provide the same legal protections as trademarks. 15 USC 1054. An applicant for registration of a collective mark must “specify the class of persons entitled to use the mark indicating their relationship to the applicant, and the nature of the applicant’s control over the use of the mark.” 37 CFR 2.44.

collective membership mark

T: A type of collective mark used by members of a group to indicate membership in the group or a particular organization. TMEP 105. *Ex parte The Supreme Shrine of the Order of the White Shrine of Jerusalem*, 109 Q 248 (Comm’r. Pats. 1956). A typical specimen used with an application for registration of a collective membership mark is a membership card. TMEP 1304.13.

collective organization

T: A legal entity capable of suing and being sued. It may be the “manufacturer,” “merchant” or “person” as used in the definition of a trademark or service mark. The use of a mark by an organization can be distinguished from use by its individual members.

collective work

C: A “work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions constituting separate and independent works in themselves, are assembled into a collective whole.” 17 USC 101. “Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution.” 17 USC 201(c). The owner of the copyright in the collective work obtains only the right to publish the contribution in that particular collective work, and any later collective work in the same

series.” 17 USC 201(c). *** *Oddo v. Ries*, 743 F2 630. See also COMPILATION, EXPRESS TRANSFER.

color

T: as trademark. *Owens-Corning*

In drawing ***: Since trademark drawings are black-and-white only, color must be indicated by different shadings and the introduction of patterns, called lining codes. Occasionally, shades of color are indicated by STIPPLING. TMEP 807.096(d). If color or a combination of colors is indicated in the mark on the drawing, it should be stated in the record what the colors are. TMEP 905.05. “If the mark is displayed in color or a color combination, the colors should be described in the application.”

color additive

P: 35 USC 156(d)(2)(A)(ii). See also PATENT TERM EXTENSION.

color depletion

T: The theory that color should not be registrable as a trademark because there are only a limited number of colors in the spectrum and the registration of each one deprives others in the field of another color for his goods. The principle is discredited and often not applied. *DAP Prods., Inc. v. Color Tile Mfg. Inc.*, 27 USPQ 2d 1365 (S.D. Ohio 1993). If competition will be hindered by granting exclusive rights in the mark, the color is DE JURE FUNCTIONAL. *Edward Weck, Inc. v. IM Inc.*, 17 USPQ 2d 1142 (TTAB 1990).

color drawing

P: See DRAWING.

color of authority

T: “Persons having color of authority to sign are those who have first-hand knowledge of the statements in the VERIFICATION or DECLARATION and who also have actual or implied authority to act on behalf of the applicant.” 37 CFR 2.71(c). Color of authority signatures are not acceptable on requests for extensions of time to file a STATEMENT OF USE. *In re Raychem Corp.*, 20 USPQ 2d 1355 (Comm’r Pats. 1991).

colorable imitation

P: 35 USC 284. A design patent may be infringed by applying a “colorable imitation” of the design to an article of manufacture. 35 USC 289.

T: “The term ‘colorable imitation’ includes any mark which so resembles a registered mark as to be likely to cause confusion, mistake or to deceive.” 15 USC 1127. *Cf.* COUNTERFEIT. It is an infringement of trademark to use in commerce any colorable imitation of a registered mark without the consent of the registrant, if such use is likely to confuse, or to cause mistake, or to deceive. 15 USC 1114(1)(A). Colorable imitations of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

coloring

C: “Mere variations of typographic ornamentation, lettering or coloring” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

colorization

C: The adding of color to frames of a black-and-white motion picture. 5 HTLJ 129 (1990).

COM

P: COMPUTER-OUTPUT-MICROFILM.

combination

P: *** A patent to a combination of prior art elements is scrutinized with SPECIAL CARE. See also SUBCOMBINATION. A combination is an organization of which a subcombination or ELEMENT is a part. MPEP 8806.05(a). A combination may be patentable whether it be composed of elements all new, partly new or all old. *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 221 USPQ 1 (Fed. Cir. 1984).

T: “The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof ...” 15 USC 1127.

combination of old elements

P: A combination of known elements is patentable if a SYNERGISTIC effect among the elements makes the whole greater than the sum of its parts. *Anderson’s Black Rock v. Pavement Salvage Co.*, 396 US 57 (1969).

combination patent

P: A patent drawn to a COMBINATION. See JEPSON CLAIM.

combined affidavit

T: A single affidavit containing the averments of both a SECTION 8 and a SECTION 15 affidavit.

combined application

T: = MULTIPLE CLASS APPLICATION.

combining references

P: The process of rejecting a claim as obvious by showing that its elements appear in two or more prior art references. Such a rejection is proper only if there is some teaching or suggestion in the prior art that the combination be made. *Pentech Int’l. v. Hayduchok*, 18 Q2 1337 (S.D. N.Y. 1990).

comic strip character

C: See CARTOON CHARACTER.

comment

C: It is not an infringement of copyright to make FAIR USE of a copyrighted work for purposes such as comment. 17 USC 107.

commerce

T: “The word ‘commerce’ means all commerce which may lawfully be regulated by Congress.” 15 USC 1127. Types of commerce: foreign commerce, interstate commerce, intrastate commerce, territorial commerce.

Commerce clause

T: The Congress shall have power ... “To regulate commerce with foreign nations, and among the several states, and with the Indian tribes.” Const. Art I, Sec. 8, Cl. 3. This clause is the authority for the federal trademark statutes.

commercial advertising or promotion

T: 15 USC 1125(a).

commercial impression

T:

commercial marketing or use

P: 35 USC 156(a)(5)(A).

C: Whether a use is “of a commercial nature” is one of four statutory factors in determining whether the use is a FAIR USE. 17 USC 107. The question “is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.” Penel., 702 F.Supp. 132, 137.

commercial name

T: The name of a business or company. TMEP 109. “The terms ‘trade name’ and ‘commercial name’ mean any name used by a person to identify his or her business or vocation.” 15 USC 1127.

commercial packaging

T: Packaging that is normal or the particular goods as they move in the trade. TMEP 808.04(c).

commercial speech

T: “[E]xpression related solely to the economic interests of the speaker and its audience.” *City of Cincinnati v. Discovery Network, Inc.*, 113 S.Ct. 1505, 1513 (1993).

commercial success

P: Sudden commercial success of an invention is evidence that it was not obvious. *Pentech Int’l. v. Hayduchok*, 18 USPQ 2d 1337 (S.D. N.Y. 1990). There must be a NEXUS between the claimed invention and the alleged commercial success. *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983). See SECONDARY CONSIDERATIONS.

Commercial success “presents a particular difficulty in a design patent case ... To be of value, evidence of commercial success must clearly establish that the commercial success is attributable to the design, and not to some other factor, such as a better recognized brand name or improved function.” *Litton Systems Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984).

commercially exploit

C: “To ‘commercially exploit’ a MASK WORK is to distribute to the public for commercial purposes a SEMICONDUCTOR CHIP PRODUCT embodying the mask work except that such term includes an ‘offer to sell or otherwise transfer’ a semiconductor chip product only when the offer is in writing and occurs after the mask work is FIXED in the semiconductor chip product.” 17 USC 901(a)(5). Mask work protection extends

at most to the end of the calendar year ten years following the date on which the mark work is registered or first commercially exploited anywhere in the world. 17 USC 904.

Commission

P: As used in the Atomic Energy Act, “Commission”, which formerly meant the Atomic Energy Commission, now refers to either the Department of Energy or the Nuclear Regulatory Commission. 42 USC 5871.

commissioned work

C: See WORK MADE FOR HIRE.

Commissioner

The Commissioner of Patents and Trademarks, whose duties are set forth at 35 USC 6. The title also means either the Assistant Commissioner for Patents or the Assistant Commissioner for Trademarks when referring to PETITIONS TO THE COMMISSIONER.

P: The Commissioner has rule-making authority. 35 USC 6(a).

T: “The Commissioner shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.” 15 USC 1123.

Commissioner of Patents and Trademarks

The official in charge of the Patent and Trademark Office, who is also an Assistant Secretary of Commerce. 35 USC 3.

Committee on Enrollment

P, T: [Walker 12:54].

commodity of commerce

P: One who sells a COMPONENT of a patented invention, if such component is not a “commodity of commerce suitable for substantial noninfringing use,” may be liable as a CONTRIBUTORY INFRINGER. 35 USC 371(c).

common assignee

P: “Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” 35 USC 103.

common calling

U: In the context of non-competition agreements, an employee will not be enjoined from engaging in a “common calling.” *Robbins v. Finlay*, 645 P.2d 623 (Utah 1982).

common descriptive name

T: A generic expression. *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75 (7th Cir. 1977). The common name by which a thing is known. See also INCAPABLE. Cf. MERELY DESCRIPTIVE. A merely descriptive mark can become DISTINCTIVE; a common descriptive name cannot.

common law copyright

C: Abolished by Copyright Act of 1976.

common law rights

T: Rights in a “common law,” or unregistered, trademark.

common ownership

P: 37 CFR 1.104(e). Copending applications that are commonly owned may not be cited against each other as a basis for a §102 or §103 rejection. 37 CFR 1.106(d). For subject matter that is commonly owned, see 37 CFR 1.106(d). Where a TERMINAL DISCLAIMER has been filed to obviate a DOUBLE PATENTING rejection, the disclaimer must “include a provision that any patent granted on that application shall be enforceable only for and during such period that said patent is commonly owned with the application that formed the basis for the rejection.” 37 CFR 1.321.

common property

C: “Works consisting entirely of information that is common property containing no original authorship” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(d).

commonplace

C: See STAPLE.

Commonwealth of Puerto Rico

C: For purposes of the Copyright Act, Puerto Rico is a STATE. 17 USC 101.

communicated

C: Copyright protection extends only to works capable of being “perceived, reproduced or otherwise communicated.” 17 USC 102(a).

community

C: A “community unit” as defined by the Federal Communications Commission rules and regulations. 37 CFR 201.17(e)(4).

company

T: An indefinite term usually referring to an unincorporated business. TMEP 802.03(c).

comparative advertising

T: [McC 25:14]

comparative utility

P: Criterion for infringement. [Walker 22:50].

Compendium of Copyright Office Practices

C: Publication issued by the ***

compensation

P: An inventor whose invention is the subject of a SECRECY ORDER, his successors, assigns or legal representatives may obtain compensation for the damage caused by the secrecy order and/or use of the invention by the Government resulting from his disclosure. 35 USC 183.

compensatory damages

P: “Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court. When the damages are not found by the jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.” 35 USC 284.

competing work

C: A work, not necessarily a derivative work, on the same subject as another work. A publishing contract may contain a clause restricting the author from creating a competing work to preserve the value of the manuscript contracted for.

competitive

T: Goods and services are competitive if one may be substituted for the other. Competition is not a prerequisite for LIKELIHOOD OF CONFUSION. *M & T Chemicals, Inc. v. M & T Manufacturing Co.*, 161 Q 166 (TTAB 1969). See RELATED GOODS OR SERVICES.

competitive advantage

S: A requirement to find a trade secret under Restatement of Torts 757.

compilation

C: A “work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting whole constitutes an original work of authorship. The term ‘compilation’ includes collective works.” 17 USC 101. A compilation is one of the nine statutory classes of WORKS MADE FOR HIRE. 17 USC 101. A compilation may constitute COPYRIGHTABLE SUBJECT MATTER. 17 USC 103(a). “The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.” 17 USC 103(b). A “compilation of information” is a type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i).

S: A “compilation of information” may be a trade secret. Restatement of Torts 757. UTSA 1(4) includes “compilation” in its definition of trade secret.

complete

C: A RECORDABLE DOCUMENT must be “complete by its own terms,” meaning that any exhibit or attachment referred to must be included. 37 CFR 201.4(c)(2).

complete copy

C: “A complete copy includes all elements comprising the UNIT OF PUBLICATION of the BEST EDITION of the work, including elements that, if considered separately, would not be COPYRIGHTABLE SUBJECT MATTER or would otherwise be exempt from mandatory DEPOSIT requirements ...” 37 CFR 202.19(b)(2). See CONDUCTOR’S SCORE, MOTION PICTURE, SCORE, SOUND RECORDING.

compliance with statute

T: The principle that use of a mark in connection with unlawful shipments does not constitute use for purposes of obtaining a federal trademark registration. TMEP 901, 37 CFR 2.69. The Examining Attorney may make an INQUIRY to determine whether applicable statutes have been complied with, but only for the purpose of determining whether or not use in commerce was lawful for registration purposes and not to police compliance with statutes. See also STATEMENT OF COMPLIANCE.

component

P: The seller of a “component of a patented machine” may be liable as a CONTRIBUTORY INFRINGER. 35 USC 271(c).

composite mark

T: A trademark consisting of two or more separate components. See also ANTI-DISSECTION RULE.

composition

P: A COMPOSITION OF MATTER.

composition of matter

P: Matter formed by the intermixture of two or more ingredients and possessing a property or properties different from, or additional to, the properties possessed by the several ingredients individually. 278 F. 655. One of the statutory classes of patentable subject matter under 35 USC 101.

A composition is reduced to practice when it is actually produced and its utility established. *Corona Cord Tire Co. v. Dovan Chemical Co.*, 276 US 358 (1928).

compound

P: A molecule.

compound word

T: A word consisting of two or more words joined by other characters, such as hyphens. Examples: “JANITOR-IN-A-DRUM,” “IN/OUT.” A compound word is a UNITARY EXPRESSION.

comprehensive non-literal similarity

C: In comparing two works, a situation in which there is no literal similarity but there has been large scale appropriation of structure or other elements. Nimmer 13.03. Cf. FRAGMENTARY LITERAL SIMILARITY. See STRUCTURE, SEQUENCE AND ORGANIZATION; TOTAL CONCEPT AND FEEL.

comprising

P: A standard transitional phrase in patent claims to combinations, meaning “including the following elements but not excluding others.” 171 USPQ 110; *T.J. Smith and Nephew Ltd. v. Parke David & Co.*, (***) CHECK NAME 871 F.2d 1098, 10 USPQ 2d 1946 (Fed. Cir. 1989). The word “comprising” is a term of art in patent law and is “open-ended.” *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1178, 20 USPQ 2d 1094 (Fed. Cir. 1991). The “transitional term, ‘which comprises’ does not exclude additional, unrecited elements.” *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1271, 229 USPQ 805 (Fed. Cir. 1985), cert. denied, 479 US 1030 (1987).

compulsory counterclaim

T: “A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed ... A counterclaim need not be filed if its is the subject of another proceeding between the same parties or anyone in privity therewith.” 37 CFR 2.106(b)(2)(i).

compulsory license

C: For recording of non-dramatic musical works. 17 USC 115. See also ANNUAL STATEMENT OF ACCOUNT, COMPULSORY LICENSEE, MONTHLY STATEMENT OF ACCOUNT, STATEMENT OF ACCOUNT.

compulsory licensee

C: “[A] ‘compulsory licensee’ is a person or entity exercising the COMPULSORY LICENSE to make and distribute phonorecords of nondramatic musical works as provided under [17 USC 115].” 37 CFR 201.19(a)(4).

Computer-Output-Microfilm

P: A microform comprising output taken directly from computer without the printing of an intermediate paper form. May be submitted as a MICROFICHE APPENDIX. Abbreviated COM.

computer program

P: In submitting a program as part of a patent application, a listing of less than ten pages must be included as part of the specification or drawings. 37 CFR 1.96(a). A longer listing may be submitted as a MICROFICHE APPENDIX. 37 CFR 1.96(b).

C: A “set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.” 17 USC 101.

computer shareware

C: “The term ‘computer shareware’ is accorded its customary meaning within the software industry. In general, shareware is copyrighted software which is distributed with relatively few restrictions for the purpose of testing and review, subject to the condition that payment to the copyright owner is required after a person who has secured a copy decides to use the software.” 37 CFR 201.26(b)(1). See also COMPUTER SHAREWARE REGISTRY.

Computer Shareware Registry

C: A registry in the Copyright Office establishing “a public record of licenses or other legal documents governing the relationship between copyright owners of COMPUTER SHAREWARE and persons associated with the dissemination or other use of computer shareware.

computer software

“Computer programs, computer data bases, and documentation thereof.” 48 CFR 52.227-14(a).

Computer Software Copyright Act of 1989

C: Public Law 96-517 (1980), amending 17 USC 101, 117 to include computer software implicitly within the definition of works subject to copyright and permitting copying if it is “an essential step in the utilization” of the software.

Computer Software Rental Amendments Act of 1990

C: Will terminate as of October 1, 1997..

conceal

P: One may not obtain a patent if, “before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, suppressed or concealed it.” 35 USC 102(g).

Federal agencies may conceal inventions in which the Government owns or may own a right, title or interest (including a non-exclusive license) for a reasonable time until a patent application can be filed. 35 USC 205.

concept

C: Concepts are not copyrightable. “In no case does copyright protection ... extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 USC 102(b). The same principle applies to MASK WORKS. 17 USC 902(c).

concept and feel

C: “Infringement of expression occurs only when the total concept and feel of the works in question are substantially similar.” *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600. “Concepts do not anticipate.” *Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), remanded, 475 US 809, 229 USPQ 478 (1986), *on remand*, 810 F.2d 1561, 1 USPQ 2d 153 (Fed. Cir. 1989).

conception

P: “Conception is the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice.” *Mergenthaler v. Scudder*, 11 App. DC 264 (1897). “Conception is complete when one of ordinary skill in the art could construct the apparatus without unduly extensive skill or experimentation.” *Sewall v. Walters*, 30 USPQ 2d 1356, 1359 (Fed. Cir. 1994). An invention is made when conception is followed by REDUCTION TO PRACTICE, either actual or constructive. Conception is a question of law. *Fiers v. Revel*, 984 F.2d 1164, 25 USPQ 2d 1601 (Fed. Cir. 1993). See also CORROBORATION.

Acts within and outside the US.

In the case of a chemical composition, conception requires (1) the idea of the structure of the chemical compound and (2) possession of an operative method of making it. *Oka v. Youssefyeh*, 849 F.2d 581, 7 USPQ 2d 1169 (Fed. Cir. 1988).

conclusive evidence

T: “To the extent that the right to use the registered mark has become incontestable under section 15, the registration shall be conclusive evidence of the validity of the registered mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce. Such conclusive evidence shall

relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 15, or in the renewal application filed under the provisions of section 9 if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application.” 15 USC 1115(b).

concurrent use

T: 15 USC 1051(a)(1)(A). “[I]f the Commissioner determines that confusion, mistake or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued ...” 15 USC 1052(d). When an application as a concurrent user is filed, notice must be sent to the parties by the Commissioner. 15 USC 1067. The application must state the area, the goods, and the mode of use for which the applicant seeks registration. 37 CFR 2.42. An application under section 1(a) of the Act may be amended so as to be treated as an application for a concurrent registration ...” 37 CFR 2.73(a). An intent-to-use application may not be so amended prior to the filing of an AMENDMENT TO ALLEGE USE or a STATEMENT OF USE. 37 CFR 2.73(b). The rights of the parties are determined by the TTAB in a CONCURRENT USE PROCEEDING.

concurrent use application

T: An application indicating that use of the mark is not exclusive and identifying a person or persons unrelated to the applicant who use the mark concurrently with applicant. TMEP 202.03(c). See CONCURRENT USE REGISTRATION.

concurrent use registration

T: In registering a mark based on concurrent use, the Commissioner shall determine and “fix the conditions and limitations” on use of the mark. 15 USC 1068.

condensation

C: A condensation of a work may constitute a DERIVATIVE WORK. 17 USC 101.

conditional assignment

An assignment whose effect is conditioned on the possible occurrence of a future event.

P: “Assignments which are made conditioned on the performance of certain acts or events, as the payment of money or other condition subsequent, if recorded in the office are regarded as absolute assignments for office purposes until cancelled with the written consent of both parties or by the decree of a competent court.” 37 CFR 1.333, [Walker 19:11], 35 USC 261.

conditioning

P: Setting a condition on the licensing of rights that involves the forced licensing of rights to or purchasing another product. 35 USC 271(d)(5).

conductor's score

C: “If the only publication of copies in the United States took place by the rental, lease, or lending of a conductor's score and parts, a conductor's score is a ‘complete’ copy. 37 CFR 202.19(b)(2)(ii).

conference

P: BPIA. [Walker 12:57].

confession

P: Interference. [Walker 13:24].

confidential clerk

T: An officer of a British corporation. TMEP 803.11.

confidential relationship

S: A relationship in which a party has a duty, either express or implied, not to disclose confidential information of the other. See also SPECIAL RELATIONSHIP.

confidentiality

P: “Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner. 35 USC 122.

confidentiality agreement

S: ***. Also NON-DISCLOSURE AGREEMENT.

configuration

T: In general, the appearance of an article, usually a three-dimensional object, or a container, comprising shape and color. A mark on the Supplemental Register may consist of a “configuration of goods.” 15 USC 1091(c). A configuration may function as a mark unless it is a common basic shape for the goods. *In re Chung, Jeanne & Kim Co., Inc.*, 226 USPQ 938 (TTAB 1985).

conflict

P: Between drawings and specification. [Walker 4:27].

T: “Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, each party and also the attorney shall be notified of this fact.” 37 CFR 2.61(b).

conflicting application

T: An application containing a mark which is conflicting with a mark in another application. TMEP 1206.01(a). See CONFLICTING MARKS.

conflicting claims

37 CFR 1.78(b), 1.78(c).

conflicting marks

T: “Marks in applications of different parties are in conflict when the registration of one of the marks, either on the Principal Register or the Supplemental Register, would constitute a bar against the registration of the other.” TMEP 1206.01(a). “Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the ‘Official Gazette’ for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.” 37 CFR 2.83(a).

confusingly similar

P: See ORDINARY OBSERVER TEST.

T: See TOTAL EFFECT.

The higher standard of SUBSTANTIALLY INDISTINGUISHABLE is used in the Trademark Counterfeiting Act of 1984, 18 USC 2320.

confusion

T: Confusion is mistake as to the commercial source or origin of the goods or services and also whether or not there is an association or connection between the respective parties. TMEP 1205. A mark may be refused registration on either the principal or the Supplemental Register if it “consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 USC 1052(d), 1091(a). A court of competent jurisdiction has the power to order CONCURRENT REGISTRATIONS. 15 USC 1052(d).

See also ACTUAL CONFUSION, AFFILIATION, LIKELIHOOD OF CONFUSION, SUBLIMINAL CONFUSION.

connection

T: [discuss confusion of connection] [connection with goods].

consecutively numbered

C: A WORK OF VISUAL ART must be signed by the author and consecutively numbered in an edition of 200 or fewer copies. 17 USC 101.

consent

T: Extension of time within which to oppose. 37 CFR 2.102(c). See also STIPULATION.

consent to register

T: confusion. TMEP 1205.01. Consents are considered in determining likelihood of confusion. *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1986). See also DU PONT AGREEMENT.

living person. 15 USC 1052(c), TMEP 1204.02.

deceased President during life of widow. 15 USC 1052(c)

concurrent use. 15 USC 1052(d)

consent to use

T: *Cf.* COVENANT NOT TO SUE.

consequential damages

P: [Walker 27:22].

conservation of energy resources

P: A patent application whose subject matter involves conservation of energy resources may be made SPECIAL on petition to the Commissioner. 37 CFR 1.102(c).

conservator

P: The conservator of an insane or legally incapacitated person may apply for a patent on that person's behalf. 37 CFR 1.43. See LEGAL REPRESENTATIVE.

consisting of

P: Excluding all but traces of other ingredients. Including none but the listed elements. To be definite, a MARKUSH GROUP must use the language "consisting of." MPEP ***. Cf. COMPRISING, CONSISTING ESSENTIALLY OF.

consisting essentially of

P: Excluding "additional unspecified ingredients which would affect the basic and novel characteristics of the product defined in the balance of the claim." 162 USPQ 221; *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984)..

consonance

P: "A patentee may not remove a patent from consideration as a prior art reference pursuant to 35 USC Section 121 where the principle of consonance is violated ... In order for consonance to exist, the line of demarcation between the independent and distinct inventions that prompted the RESTRICTION requirement must be maintained." *Texas Instruments Inc. v. U.S. Int'l. Trade Comm'n.*, 988 F.2d 1165, 26 USPQ 2d 1018 (Fed. Cir. 1993).

Constitution

P:
C:
T:

contribution

C: joint tortfeasors

construction

P: See CLAIM CONSTRUCTION.

constructive abandonment

P: ABANDONMENT of an application, other than EXPRESS ABANDONMENT, that occurs by failure to follow rules. [See Walker 7:13]

constructive election

P: See ELECTION.

constructive knowledge

A party has constructive knowledge of a fact when it should have known of that fact under the circumstances.

S: A party having constructive knowledge that information is a trade secret of another has a duty not to disclose or use it.

constructive notice

P: Constructive notice of *** may be given by properly marking a patented article with the numbers of the patents applicable to it. See MARKING. [Walker 21:43].

Not all documents recorded against a patent give constructive notice of their contents. 37 CFR 1.331(a).

T: “Registration of a mark on the principal register ... shall be constructive notice of the registrant’s ownership thereof.” 15 USC 1072. This provision eliminates the defense of INNOCENT INFRINGEMENT.

constructive reduction to practice

P: An invention is constructively reduced to practice when an enabling disclosure has been generated, as defined in 35 USC 112, even if the invention has never actually been made. The filing of a patent application is thus a constructive reduction to practice. *Hazeltine Corp. v. U.S.*, 820 F.2d 1190, 2 USPQ 2d 1744 (Fed. Cir. 1987). See ACTUAL REDUCTION TO PRACTICE, REDUCTION TO PRACTICE.

constructive use

T: “Contingent on the registration of a mark on the principal register ... the filing of an application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing —

- (1) has used the mark;
- (2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or
- (3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under Section 44(d) to register the mark which is pending or has resulted in registration of the mark.” 15 USC 1057(c). The preceding also applies to ITU applications.

It is a defense to trademark infringement that “the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant’s prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 7(c), (B) the registration of the mark under this Act if the application for registration is filed before the effective date of the Trademark Revision Act of 1988, or (C) publication of the registered mark under section 1062 of this title: *Provided, however*, That this defense or defect shall apply only for the area in which such continuous prior use is proved.” 15 USC 1115(b)(5).

consular officer of the United States

P: To be valid, an oath before an officer of a foreign country who has a seal requires a certificate of a “diplomatic or consular officer of the United States” or an APOSTILLE. 35 USC 114. See also ACKNOWLEDGMENT.

Consumer Price Index

P,T: The Commissioner may adjust PTO fees to reflect fluctuations in the Consumer Price Index as determined by the Secretary of Labor. 35 USC 41(f).

contempt

T: A mark may be refused registration on either the Principal or the Supplemental Register if it may bring into contempt or disrepute “persons, living or dead, institutions, beliefs, or national symbols.” 15 USC 1052(a), 1091(a).

contents

C: A “mere listing of ingredients or contents” is “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

contested case

P: See, *e.g.* 35 USC 24. When an INTERFERENCE is declared, “the interference is a contested case within the meaning of 35 USC 24.”

contiguous communities

C: See INDIVIDUAL CABLE SYSTEM.

continuation

P: A patent application disclosing the same subject matter as a previously filed and still pending application by the same inventor. 35 USC 120. The previous application is known as a PARENT APPLICATION.

continuation-in-part

P: A patent application disclosing and claiming more subject matter than a previously filed and still pending application by the same inventor. The previous application is known as a PARENT APPLICATION. 37 CFR 1.62(c). Abbreviated CIP.

“An applicant who changed an application from a Rule 60 continuation to a continuation-in-part (“CIP”) and filed a CIP declaration was, under the circumstances, estopped from arguing that the application did not add new matter to the parent application.” *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984).

continued use

T: Section 8

continuing-type application

P: [Walker 12:7].

continuity of invention

P: [Walker 4:39].

continuous prior use

T: See PRIOR USE. 15 USC 1115(b)(5).

continuous use

T: Section 8

Contract Disputes Act

P: The Contract Disputes Act (41 USC 601 *et seq.*) is not applicable to a determination by a Federal agency to exercise MARCH-IN RIGHTS. 35 USC 203(2).

Contracting State

P: PCT. A member of the INTERNATIONAL PATENT COOPERATION UNION.

contractor

P: With respect to federally funded inventions, “contractor” means “any person, small business firm, or nonprofit organization that is a party to a funding agreement.” 35 USC 201(c), 401.2(b).

contribution

C: Joint authorship. Each joint author must make an independently copyrightable contribution to the work. *Ashton-Tate v. Ross.* (***)

Copyright in a contribution to a COLLECTIVE WORK vests initially in the author of the contribution. 17 USC 201(c).

Portion of a collective work. One of the nine statutory classes of WORKS MADE FOR HIRE. 17 USC 101.

Works first published as individual contributions to collective works are exempt from the DEPOSIT requirement. 37 CFR 202.19(c)(9).

Right of contribution.

contributory infringement

P: “Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.” 35 USC 271(c). “There can be no contributory infringement in the absence of direct infringement.” *Aro Mfg. Co. v. Convertible Top Replacement Co., Inc.*, 365 US 336, 341, 128 USPQ 354 (1961). Cf. DIRECT INFRINGEMENT, INDUCEMENT OF INFRINGEMENT.

Under 35 USC 271(c), “one must show that an alleged infringer knew that the combination for which his components were especially made were both patented and infringing.” *Preemption Devices, Inc. v. Minnesota Mining & Manufacturing Co.*, 803 F.2d 1170, 231 USPQ 297 (Fed. Cir. 1986).

control

T: The owner of a collective membership mark must “exercise legitimate control over the use of the mark.” TMEP 1304.17.

CONTU

C: = NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS.

convention application

P: A U.S. application based on a patent application previously filed in a country that is a party to the Paris Convention and thus has an effective filing date earlier than its actual filing date.

conventional

P: Known in the PRIOR ART, commonly used. “What is conventional knowledge will be read into the disclosure.” *In re Howarth*, 210 USPQ 689, 691 (CCPA 1983).

convertibility of application

P: [Walker 9:20].

conveyance

C: “The ownership of copyright may be transferred in whole or in part by any means of conveyance.” 17 USC 201(d)(1). Conveyances may be recorded in the Copyright Office. 37 CFR 1.331(a). See also TRANSFER OF COPYRIGHT.

cooperation

P: The elements of an APPARATUS CLAIM must cooperate with one another to produce the desired result or the apparatus is no more than an AGGREGATION of separate parts.

cooperative

T: Membership in a cooperative is denoted by a COLLECTIVE MARK.

copending

P: Said of two or more applications that are pending at the same time. [Walker 9:11]

T:

copies

C: Copies are “material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term ‘copies’ includes the material object, other than a phonorecord, in which the work is first fixed.” 17 USC 101.

Copr.

C: “Copr.” may properly be used instead of the word “Copyright” in a notice of copyright. 17 USC 401(b)(1).

copy

C:

T: It is an infringement of trademark to use in commerce any copy of a registered mark without the consent of the registrant, if such use is likely to confuse, or to cause mistake, or to deceive. 15 USC 1114(1)(A). Infringing copies of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

copy claims

P: interference

copying

P: “Copying of the claimed invention, rather than one in the public domain, is indicative of nonobviousness.” *Windsurfing Int’l, Inc. v. AMF Inc.*, 782 F.2d 995, 228 USPQ 562 (Fed. Cir. 1986). See SECONDARY CONSIDERATIONS.

C: Copying may be proved by circumstantial evidence by showing that the works are SUBSTANTIALLY SIMILAR and that the infringer had ACCESS to the original. *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 228 USPQ 505 (2d Cir. 1986), *cert. den.*, 476 US 1159 (1986).

T: Intent to copy the first user’s mark justifies an inference of LIKELIHOOD OF CONFUSION. *Beer Nuts Inc. v. Clover Club Foods Co.*, 805 F.2d 920 (10th Cir. 1986).

copyright

C: Copyright embraces the following exclusive rights:

- (1) to reproduce the work in copies and phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.” 17 USC 106.

Copyright protection for a work begins when it is CREATED. 17 USC 102. “Copyright extends only to those components of the work that are original to the creator.” *Rogers v. Koons*, 960 F.2d 301, 307, 22 USPQ 2d 1492 (2d Cir. 1992), *cert. denied* ***. See COPYRIGHT OWNER.

“Any of the exclusive rights comprised in a copyright ... may be transferred ... and owned separately” 17 USC 201(d)(2).

copyright application

C: The formal document by which a copyright registration is requested.

Copyright Act

C: Title 17, United States Code, revised October 19, 1976 by Public Law 94-553.

copyright claimant

C: A copyright claimant is either “(i) The author of a work; (ii) A person or organization that has obtained ownership of all rights under the copyright initially belonging to the author.” 37 CFR 202.3(a)(3).

Copyright Clearance Center

C:.

Copyright Felony Act

C: Popular name for ***.

copyright infringement

C: Copyright infringement is a tort. *** To show infringement, plaintiff “must show ownership of a valid copyright and copying by the defendant.” *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 195 USPQ 1 (2d Cir. 1977). Copying can be shown by “(1) direct proof of copying; or (2) access to the work and SUBSTANTIAL SIMILARITY between the protected material and that claimed to be infringing.” *Walker v. Time Life Films*, 784 F.2d 44, 48, 228 USPQ 505 (2d Cir. 1986), *cert. denied*, 476 US 1159 (1986).

See also INDEPENDENT CREATION, INVERSE RATIO RULE, UNCONSCIOUS INFRINGEMENT.

copyright misuse

C: Copyright misuse, that is, using a copyright in a manner violative of public policy or attempting to extend the copyright monopoly, is a valid defense to infringement.

Lasercomb America, Inc. v. Reynolds, 911 F.2d 970 (4th Cir. 1990). However, it is not recognized in all Circuits.

copyright notice

C: See NOTICE OF COPYRIGHT.

Copyright Office

C: An administrative unit within the Library of Congress charged with registering copyright claims and related documents. All administrative functions and duties [under the Copyright Act], except as otherwise specified, are the responsibility of the Register of Copyrights as director of the Copyright Office of the Library of Congress. 17 USC 701(a).

Certification and Documents Section

Licensing Division

Reference and Bibliography Section

copyright owner

C: A term that “with respect to any one of the exclusive rights comprised in a copyright, refers to the owner of that particular right.” 17 USC 101. “Copyright in a work — vests originally in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.” 17 USC 201(a).

With respect to the compulsory license provisions of 17 USC 115, “the term copyright owner in the case of any work having more than one copyright owner means any one of the coowners.” 37 CFR 201.19(a)(3).

In the case of a work consisting of sounds, images or both, the first fixation of which is made simultaneously with its transmission, the copyright owner is “the person or entity that will be considered the author of the work upon its fixation (including, in the case of a work made for hire, the employer or other person or entity for whom the work was prepared), or a person or organization that has obtained ownership of an exclusive right, initially owned by such person or entity that will be considered the author of the work upon its fixation.” 37 CFR 202.22(a)(2).

copyright registration

C: A registration is not necessary to have a valid copyright. However, suit for infringement cannot be initiated unless registration has been made or refused. 17 USC ***. STATUTORY DAMAGES and ATTORNEY’S FEES are not available to the copyright owner unless the infringement occurred before the EFFECTIVE DATE OF REGISTRATION of the copyright. 17 USC ***. Registration can be made at any time during the term of copyright. Effective January 3, 1991, the fee for registering a copyright is \$20.00. See also DEPOSIT. Application, fee.

Copyright Renewal Act of 1992

C:.

Copyright Royalty Tribunal

C: The Copyright Royalty Tribunal (Tribunal) is an independent agency in the Legislative Branch, created by Pub. L. 94-553 of October 19, 1976. The Tribunal’s statutory responsibilities are: ***” 37 CFR 301.1. The Tribunal administers compulsory licenses under the Copyright Act. It is composed of five members

appointed by the President with the advice and consent of the Senate. 37 CFR 301.1. Its address is 1111 20th Street N.W., Suite 450, Washington, DC 20036.

copyrightable

Capable of being subject to copyright protection; registrable.

copyrightable subject matter

C: A type of work in which copyright protection may subsist, including the following categories: “(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.” 17 USC 102(a). By implication, a computer program may also be a work of authorship. 17 USC 117.

corporate designator

A term or abbreviation denoting that an entity is a corporation, such as “Corporation,” “Corp.,” “Incorporated,” “Inc.,” “Limited,” or “Ltd.”

T: In a trademark application, corporate designators in a mark must be disclaimed. *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984).

corporate officer

See CLERK, CONFIDENTIAL CLERK, PROCURIST, REGISTRAR. ***

P: “A corporate officer who actively aids his/her corporation’s infringement may be held liable under an INDUCEMENT of infringement theory under 35 USC Section 271(b).” *Power Lift, Inc. v. Lang Tools, Inc.*, 774 F.2d 478, 227 USPQ 435 (Fed. Cir. 1985).

corporation

T: A corporation may be an APPLICANT for a trademark registration. It must be identified by its legal name and state or country of incorporation. The application must be signed by a CORPORATE OFFICER.

correctness

T: A STANDARD OF REVIEW of PETITIONS for relief from a formal requirement of an Examining Attorney. The requirement will be upheld only if it is correct. *In re Stenographic Machines, Inc.*, 199 USPQ 313, 316 (Comm’r Pats. 1978). This is a lower standard than CLEAR ERROR or ABUSE OF DISCRETION.

correction

P: certificate of correction, cure, error. Inventorship. See also MATERIAL ERROR.

C: “A ‘correction’ is appropriate if information in the basic registration was incorrect at the time that basic registration was made, and the error is not one that the Copyright Office itself could have recognized.” 37 CFR 201.5(b)(2)(i).

T: 15 USC 1058.

corrective advertising

U: [McC 30.04]

correspond exactly

P: In an INTERFERENCE, “[a] claim of a patent or application which is identical to a count is said to ‘correspond exactly’ to the count.” 37 CFR 1.601(f).

correspond substantially

P: In an INTERFERENCE, “[a] claim of a patent or application which is not identical to a count, but which defines the same patentable invention as the count is said to ‘correspond substantially’ to the count.” 37 CFR 1.601(f).

correspondence address

P: A single address to which correspondence relating to a patent application and any patent issued thereon will be addressed, specified at initial application. 37 CFR 1.33.

T: 37 CFR 2.18. DOUBLE CORRESPONDENCE will not be undertaken by the PTO. Cf. FEE ADDRESS.

correspondence of claim and disclosure

P: “The specification, claims and drawing must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification and the drawing.” 37 CFR ***. Lack of correspondence is a GROUND OF REJECTION. MPEP 706.03(n).

correspondence with Patent and Trademark Office

In writing ***. “Double correspondence with an applicant and his attorney or agent, or with more than one attorney or agent, will not be undertaken.” 37 CFR 1.33(a).

corroboration

P: Corroboration by independent evidence is required to prove dates of conception and reduction to practice. *Hahn v. Wang*, 892 F.2d 1028, 13 USPQ 2d 1313 (Fed. Cir. 1989). An “inventor’s testimony, standing alone, is insufficient to prove conception some form of corroboration must be shown.” *Price v. Symsek*, 988 F.2d 1887, 26 USPQ 2d 1031 (Fed. Cir. 1993). Corroboration of date of conception may be made by one who has witnessed the expression of the invention in tangible form (as on a piece of paper), even if he does not understand it. To corroborate a reduction to practice, the witness must understand the operation of the invention.

costs

Award

P: 354 USC 284. [Walker 27.31]. Interference cases, dist. ct. [Walker 12:60].

C: “In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof.” 17 USC 505.

T: In trademark cases, “costs of the action” may be recovered if infringement is proven. 15 USC 1117(a).

costume

C: The artistic features of masquerade costumes have been held copyrightable. 696 F.Supp. 1348.

count

P: In a INTERFERENCE, “[a] ‘count’ defines the interfering subject matter between (1) two or more applications or (2) one or more applications and one or more patents. When there is more than one count, each count shall define a separate patentable invention.” 37 CFR 1.601(f). “Each count shall define a SEPARATE PATENTABLE INVENTION. Each application must contain, or be amended to contain, at least one claim which corresponds to each count.” 37 CFR 1.603. See also LOST COUNT, PHANTOM COUNT, PROPOSED COUNT.

counter-intelligence

See FOREIGN INTELLIGENCE.

counterclaim

T: TTAB proceedings. Counterclaim for cancellation in opposition. See also COMPULSORY COUNTERCLAIM, PERMISSIVE COUNTERCLAIM.

counterfeit

P: One who “falsely makes, forges, counterfeits, or alters any letters patent” is guilty of a criminal offense. 18 USC 497.

T: A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark. 15 USC 1127. *Cf.* COLORABLE IMITATION. It is an infringement of trademark to use in commerce any counterfeit of a registered mark without the consent of the registrant, if such use is likely to confuse, or to cause mistake, or to deceive. 15 USC 1114(1)(A). For a violation of 1114(1), the Court must award TREBLE DAMAGES and ATTORNEY’S FEES unless it finds EXCEPTIONAL CIRCUMSTANCES. 15 USC 1117(b). Counterfeits of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION. *Cf.* COUNTERFEIT MARK.

counterfeit label

C: Within the meaning of the piracy statute, 18 USC 2318, “the term ‘counterfeit label’ means an identifying label [affixed or designed to be affixed to a phonorecord, or a copy of a motion picture or other audiovisual work] or container that appears to be genuine, but is not.” See also DESTRUCTION, FORFEITURE.

counterfeit mark

T:

1. A “counterfeit mark” is “(i) a counterfeit of a mark that is registered on the principal register ... for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered; or (ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this Act are made available by reason of section 110 of the Act entitled, “An Act to incorporate the United States Olympic Association”, approved September 21, 1950; but such term does not include any mark or designation used on or in connection with goods or services of which the manufacturer or producer was, at the time of the manufacture or production in question, authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.” 15 USC 1116(d)(1)(B). See COUNTERFEIT, OLYMPIC CHARTER ACT.

2. A term defined in the Trademark Counterfeiting Act of 1984, 18 USC 2320(d)(1), as:

“(A) a spurious mark —

(i) that is used in connection with trafficking in goods or services

(ii) that is identical with, or substantially indistinguishable from, a mark registered for those goods or services on the principal register in the United States Patent and Trademark Office and in use, whether or not the defendant knew such mark was so registered; and

(iii) the use of which is likely to cause confusion, to cause mistake, or to deceive; or

(B) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of the Lanham Act are made available by reason of section 110 of the Olympic Charter Act;

but such term does not include any mark or designation used in connection with the goods or services of which the manufacturer or producer was, at the time of the manufacture or production in question, authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.”

country of origin

C: “The ‘country of origin’ of a Berne Convention work ... is the United States if —

(1) in the case of a published work, the work is first published — (A) in the United States; (B) simultaneously in the United States and another nation or nations adhering to the Berne Convention, whose law grants a term of copyright protection that is the same or longer than the term provided in the United States; (C) simultaneously in the United States and a foreign that does not adhere to the Berne Convention; or (D) in a foreign nation that does not adhere to the Berne Convention, and all of the authors of the work are nationals, domiciliaries, or habitual residents of, or in the case of an audiovisual work legal entities with headquarters in, the United States;

(2) in the case of an unpublished work, all the authors if the work are nationals, domiciliaries, or habitual residents of the United States, or, in the case of an unpublished audiovisual work, all the authors are legal entities with headquarters in the United States; or

(3) in the case of a pictorial, graphic, or sculptural work incorporated in a building or structure, the building or structure is located in the United States.” 17 USC 101.

T: The country in which a foreign applicant has a bona fide and effective commercial establishment or the country in which he or she is domiciled or the country of which he or she is a national. TMEP 1007.

course and scope of employment

court

P: In construing the Federal Rules of Evidence in an INTERFERENCE, court means examiner-in-chief or Board as may be appropriate. 37 CFR 1.671(c)(1).

court of appeals

“The — courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate jurisdiction of all actions arising under” the Lanham Act. 15 USC 1121.

Court of Appeals for the Federal Circuit

An appellate court, the successor to the Court of Customs and Patent Appeals, created by the Federal Courts Improvement Act, 28 USC 1295, that has jurisdiction over patent appeals. *** Abbreviated CAFC.

The following types of cases are reviewed by the CAFC:

- 1) appeals from the Board of Patent Appeals and Interferences.
- 2) appeals from the Trademark Trial and Appeal Board.
- 3) appealable Commissioner’s decisions.
- 4) non-appealable decisions of boards and the Commissioner.
- 5) appeals from the District Courts in patent cases. 35 USC 281.
 - a) patent-patent interferences. 35 USC 291.
 - b) qui tam actions. 35 USC 292.
 - c) actions to correct inventorship. 35 USC 256.
 - d) quasi-de novo review of the Board of Patent Appeals and Interferences. 35 USC 145, 146.
- 6) intellectual property actions of the International Trade Commission. 19 USC 1137.
- 7) appeals from the Court of Federal Claims. 28 USC 1498.

The holdings of the CCPA are precedent in the CAFC. *South Corp. v. U.S.*, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982) (*en banc*).

T: “The — courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate jurisdiction of all actions arising under” the Lanham Act. 15 USC 1121.

Court of Customs and Patent Appeals

Abbreviated CCPA. Superseded by the Court of Appeals for the Federal Circuit.

Court of Federal Claims

Cases involving appropriation of intellectual property by the U.S. government are heard in the Court of Federal Claims. Formerly known as the U.S. Claims Court.

Courts of the United States

P: In construing the Federal Rules of Evidence in an INTERFERENCE, Courts of the United States means examiner-in-chief or Board as may be appropriate. 37 CFR 1.671(c)(1).

covering material

C: Covering material (wrapping or packaging) may not constitute a WORK OF VISUAL ART. 17 USC 101.

created

C: “A work is ‘created’ when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been

prepared in different versions, each version constitutes a separate work.” 17 USC 101.
Copyright protection for a work begins at its creation. 17 USC 102.

creative spark

C: See CREATIVITY.

creativity

C: To be copyrightable, a work requires some minimum of creativity, not matter how crude humble or obvious the “creative spark.” *Feist Publications, Inc. v. Rural Telephone Service Co. Inc.*, 499 US 340 (1991). See also MODICUM OF CREATIVE WORK.

credit

C: See ATTRIBUTION.

credit line

C: A legend used on or in conjunction with a work to acknowledge its authorship.

CRF

P: Abbreviation for “computer readable form.”

criminal acts

Infringement of intellectual property rights may constitute crimes under certain circumstances.

P: 18 USC 497 makes criminal the forgery counterfeiting or false alteration of letters patent. 35 USC 186 imposes penalties for violation of a patent secrecy order. 35 USC 292 makes false patent marking criminal.

C: 17 USC 506(a)-(e).

Criminal infringement. 17 USC 506(a).

Fraudulent placement of copyright notice. 17 USC 506(c).

Fraudulent removal of copyright notice. 17 USC 506(d).

False representation in a copyright application. 17 USC 506(e).

Piracy and Counterfeiting Act of 1982.

T: Trademark Counterfeiting Act of 1984, 18 USC 2320).

S: The National Stolen Property Act, 18 USC 2314, can apply to theft of articles embodying trade secrets. *U.S. v. Seagraves*, 265 F.2d 876..

criminal infringement

C: “Any person who infringes a copyright willfully and for purposes of commercial gain shall be punished as provided in Section 2319 of title 18.” 17 USC 506(a).

critical date

P: The date one year prior to the filing of a United States patent application. Earlier public use or sale of the invention triggers the PUBLIC USE BAR. “The ‘critical date,’ the date one year before the filing date of the patent application, is determined retrospectively. Therefore, those activities that will act as a bar must be of such character that it is apparent at the time they are conducted that patent filing must be completed within a year.” *Baker Oil Tools, Inc. v. George Vana*, 828 F.2d 1558, 4 USPQ 2d 1210 (Fed. Cir. 1987).

critical limits

P: A limitation is critical if it is dictated by physical or chemical considerations. [See also Walker 10:14].

criticism

C: It is not an infringement of copyright to make FAIR USE of a copyrighted work for purposes such as criticism. 17 USC 107.

cross-action

P: 37 CFR 1.304(a).

cross-appeal

P: Party who prevailed below seeks a more favorable judgment. ***

cross-license

An arrangement in which the parties each license, and receive licenses to, an item of intellectual property. *** antitrust, tying ***

cross-reading

P: [Walker 12:17]. Claims of interfering patents cross-read on one another.

cross-references

P: An application must contain cross-references to any related applications, if any. 37 CFR 1.77(c)(1).

crowded art

P: An art is crowded if it is populated by many patents. Patents that issue in a crowded art are not PIONEER PATENTS. *Chemical Engineering Corp. v. Essef Industries, Inc.*, 795 F.2d 1565, 230 USPQ 385 (Fed. Cir. 1986).

CS/SA-3

C: A form used for STATEMENTS OF ACCOUNT. The “ ‘Long Form’ for use by cable systems whose semiannual gross receipts for secondary transmissions total \$160,000 or more.” 37 CFR 201.17(d)(2)(iii).

cultivated area

P: In an application for a patent for a newly found plant, the oath must state that it was found in a cultivated area. 37 CFR 1.162.

cumulative references

P: “A reference that is simply cumulative to other references does not meet the threshold of materiality that is a predicate to a holding of INEQUITABLE CONDUCT. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 18 USPQ 2d 1896 (Fed. Cir. 1991).

cure

P: INEQUITABLE CONDUCT can be cured during ORIGINAL PROSECUTION. *Rohm & Haas Co. v. Crystal Chemical Co.*, 722 F.2d 1556, 220 USPQ 289 (Fed. Cir. 1983), later proceeding, 736 F.2d 688, 222 USPQ 97 (Fed. Cir. 1984). See also REISSUE, in which cure is not possible.

C: Omission of notice 17 USC 405(a).

customer list

S: A customer list may be a trade secret under both Restatement of Torts 757 and the UTSA. A customer list is not a trade secret if it is “readily ascertainable.” *Fleming Sales Co. v. Bailey*, 611 F.Supp. 507.

damaged

T: Any entity “which believes it would be damaged by the registration of a mark on the Principal Register may oppose the same.”

damaged copy

C: It is not an infringement of copyright for a library or archives to make a facsimile copy or phonorecord of a published work to replace a damaged copy if after reasonable effort it determines that an unused replacement cannot be purchased at a fair price. 17 USC 108(c).

damages

See also ACTUAL DAMAGES, COERCIVE DAMAGES, COMPENSATORY DAMAGES, CONSEQUENTIAL DAMAGES, ENHANCED DAMAGES, EXEMPLARY DAMAGES, PUNITIVE DAMAGES, STATUTORY DAMAGES, TREBLE DAMAGES.

P: “Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court. When the damages are not found by the jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.” 35 USC 284. Damages may not be based on speculation, but need not be proved with unerring precision. ***, 24 USPQ 2d 1321, 1338.

C: 17 USC 504. Damages are limited only by the requirement of a relationship between the alleged damages and the infringement. *Sunset Lamp Corp. v. Alys Corp.*, 749 F.Supp. 520 (S.D.N.Y. 1990) See also STATUTORY DAMAGES.

T: In trademark cases, “any damages sustained by the plaintiff” may be recovered if infringement is proven. 15 USC 1117(a). See also TREBLE DAMAGES. The primary purpose of damages under the Lanham Act “is to take all the economic incentive out of trademark infringement.” *Polo Fashions, Inc. v. Dick Bruhn, Inc.*, 793 F.2d 1132, 1135, 230 USPQ 538 (9th Cir. 1986).

S: Damages for misappropriation of a trade secret may be based on (1) the trade secret owner’s loss; (2) the misappropriator’s gain; or (3) a reasonable royalty.

dance

C: See CHOREOGRAPHIC WORK. To dance a work constitutes a PERFORMANCE of the work. 17 USC 101.

dangerous means

P: [Walker 5:13].

Dann Amendments

P: No-fault reissue; inter partes involvement of protesters in reissue prosecution. The Dann Amendments were repealed by the PTO in 1982.

data

C: An arrangement of data may constitute a COMPILATION if it is an original work of authorship. 17 USC 101. In the context of Government contracts, “data” means “recorded information, regardless of form or the media on which it may be recorded. The term includes technical data and computer software. The term does not include information incidental to contract administration, such as financial, administrative, cost or pricing, or management information.” 48 CFR 52.227-14(a). See also FORM, FIT AND FUNCTION DATA and TECHNICAL DATA.

database

C: A database may not constitute a WORK OF VISUAL ART. 17 USC 101. An automated database available only on-line in the United States is exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(5).

date

C: See YEAR DATE.

date of determination

P: With respect to a variety of plant invented with federal funding, “date of determination” is as defined in the Plant Variety Protection Act, 7 USC 2401(d), namely: ***. 35 USC 201(e).

date of enactment

P: As used in 35 USC 156 with respect to a human drug product, medical device, food additive or color additive, September 24, 1984. With respect to an animal drug or veterinary biological product, the date of enactment of the Generic Animal Drug and Patent Restoration Act. 35 USC 156(f)(7), 156(f)(8).

date of first publication

C: *** year date in copyright notice. Also required on a RENEWAL AFFIDAVIT FOR A U.C.C. WORK. 37 CFR 202.17(d)(2)(i)(A).

date of first use

P: An inventor’s right to compensation for use by the Government of an invention subject to a secrecy order begins on the date of first use of the invention by the Government. 35 USC 183.

T: The date on which goods were first sold or transported or the services first rendered. TMEP 806.01. See also INDEFINITE DATE OF FIRST USE. In a section 2(f) registration, it is not necessary to state a date of first use. TMEP 1211.05(d).

date of first use in commerce

T: The date on which goods were first sold or transported or the services rendered in a type of commerce which may lawfully be regulated by Congress. TMEP 806.02. The date is never later than the DATE OF FIRST USE. TMEP 806.03. See also INDEFINITE DATE OF FIRST USE.

date of invention

P: The date of conception of an invention later reduced to practice. “In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity

with respect thereto, in a foreign country, except as provided in sections 119 and 365 of this title.” 35 USC 104.

date of record

P: See RECEIPT.

date priority

P: As between inventors of the SAME PATENTABLE INVENTION, the earlier date of invention.

d.b.a

T: An abbreviation for “doing business as,” a designator for a FICTITIOUS NAME. TMEP 802.02. An ASSUMED NAME DESIGNATION. “If an individual indicates that he or she is doing business under a corporate designation (e.g. Corporation, Corp., Incorporated, Inc., Limited, Ltd.), the examining attorney should confirm that the law in the relevant state permits such a practice. If so, the Office will print the DBA.” EG 2-91.

de facto functionality

T: The configuration of a product or container is de facto functional if it accommodates the normal function of the item under consideration. TMEP 1213.01(a). A mark that is de facto functional may be registered upon a showing that it is distinctive. See FUNCTIONALITY. See also COLOR DEPLETION. Cf. DE JURE FUNCTIONALITY.

de facto secondary meaning

T:

de jure functionality

T: A configuration of a product or container is de jure functional if it is dictated by its function. A mark that is de jure functional is not registrable even on a showing of distinctiveness. TMEP 1213.01(a). See FUNCTIONALITY. Cf. DE FACTO FUNCTIONALITY.

de minimis

C: “Where the Copyright Office becomes aware after registration that a work is not copyrightable, either because the authorship is de minimis or the work does not constitute authorship subject to copyright, the registration will be cancelled.” 37 CFR 201.7(c)(1). See also AUTHORSHIP, CANCELLATION.

T: de minimis use. [McC 16.02]

de novo

Cf. QUASI DE NOVO.

P: The CAFC reviews obviousness *de novo* but underlying factual questions under the CLEARLY ERRONEOUS standard. 24 USPQ 2d 1321.

T: An appeal to District Court from a decision of the TTAB is *de novo*.

death

P: The legal representatives of a deceased inventor may apply for a patent. 35 USC 117, 37 CFR 1.42. See ADMINISTRATOR, EXECUTOR, LEGAL REPRESENTATIVE.

C: Life + 50 years

deception

T: A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 USC 1052(d), 1091(a).

deceptive

T: A mark that comprises deceptive matter may be refused registration, either on the principal or the Supplemental Register. 15 USC 1052(a), 1091(a).

deceptive intention

P: If misjoinder was not the result of “deceptive intention,” amendment may be permitted by the Commissioner. 37 CFR 1.48(a); [Walker 18:14].

An invalid claim of a patent may be disclaimed if was obtained without deceptive intention. 35 USC 288.

If an application has been filed abroad in violation of 35 USC 184, a license may be granted by the Commissioner retroactively if the foreign filing was made in error and without deceptive intent.

A reissue application must state that any errors in the original patent application were made without deceptive intent. 35 USC 251, 37 CFR 1.175.

deceptively misdescriptive

T: A mark is deceptively misdescriptive if it “is of such a nature that purchasers would be led to believe that the goods to which the mark is applied possess features or qualities that the goods do not actually possess.” TMEP 1207.01. A mark may be refused registration on the principal register if it “consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them.” 15 USC 1052(e). Registration is refused if (1) the mark misdescribes the goods; and (2) the public is likely to believe the misrepresentation. *In re Woodward & Lothrop, Inc.*, 4 USPQ 2d 1412 (TTAB 1987). If the misrepresentation is material to the decision to purchase the goods, registration is refused even on a showing of acquired distinctiveness. *Tanners’ Council of America, Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979).

declaration

P: Declaration in lieu of oath. 35 USC 25. A declaration may be used “if, and only if, the declarant is, in the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 USC 1001) and may jeopardize the validity of the application or any patent issuing thereon. 37 CFR 1.68. See also OATH, SUPPLEMENTAL DECLARATION. A declaration may be used to traverse an obviousness rejection by SWEARING BACK. 37 CFR 1.132.

A notification that an interference has been declared is known as a “declaration.” 35 USC 135.

C: A declaration is required “of the veracity of the statements of fact contained in the STATEMENT OF ACCOUNT and the GOOD FAITH of the person signing in making such statement of fact.” 37 CFR 201.17(e)(14(iii)(E).

T: Procuring a registration by a “false or fraudulent declaration or representation” gives rise to a civil action by “any person injured thereby.” 15 USC 1120.

declaratory judgment

P: [Walker 24:6]. Cite Declaratory Judgment Act.

decorum and courtesy

“Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy.” 37 CFR 1.3.

default

T: In TTAB proceedings. If the answer to a notice of opposition is not filed within the required time, the opposition may be decided “as in case of default” under FRCP ***.

defect

T: An impediment to enforcement of trademark rights. 15 USC 1115(b).

defective application

T: An application that is missing one or more items necessary for the according of a FILING DATE. TMEP 709. Also INFORMAL APPLICATION.

defective execution

P: The Commissioner may provisionally accept any document that is defective in execution if a properly executed document is submitted within a prescribed time. 35 USC 26.

defense

P: The Commissioner may extend for up to three years the time within which any action must be taken by the Government in a GOVERNMENT APPLICATION if the head of the department concerned certifies that the invention is “important to the armament or defense of the United States.” 35 USC 267.

defenses

P:
Derivation
Fraudulent procurement
Invalidity
Laches, estoppel
Lack of invention
Noninfringement
Patent misuse
Prior invention
C:
Copyright misuse
Fair use
T:
Abandonment

Continuous prior use
Equitable principles: laches, estoppel, acquiescence.

Fair use

FRAUDULENT PROCUREMENT

MISREPRESENTATION.

Name

Violation of antitrust laws. See ANTITRUST.

defensive publication

P:

deference

P: Where the PTO has considered a piece of prior art, and issued a patent notwithstanding that prior art, a court owes some deference to the PTO's decision. 24 USPQ 2d 1321. The PTO's interpretation of its own rules is entitled to "considerable deference." *Kubota v. Shibuya*, 999 F.2d 517, 27 USPQ 2d 1418 (Fed. Cir. 1993).

deferral

P: Issuance of a patent may be deferred on petition to the Commissioner if GOOD AND SUFFICIENT reasons are given why deferral is necessary. 37 CFR 1.314(b).

definiteness

P: "The 'distinctly claiming' requirement means that the claims must have a clear and definite meaning when construed in the light of the complete patent document." *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870, 27 USPQ 2d 1123 (Fed. Cir. 1993). Whether the requirement of claim definiteness is met is a QUESTION OF LAW. *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 20 USPQ 2d 1094 (Fed. Cir. 1991). See INDEFINITENESS.

degree

T: An academic degree is not registrable as a collective mark unless it denotes not merely an honor but membership. TMEP 1304.04.

delay

P, T: See TIME, UNAVOIDABLE DELAY, UNINTENTIONAL DELAY.

delegation

P: The chief officers of departments and agencies of the United States may delegate their authority to recommend the imposition of SECRECY ORDERS. 35 USC 188.

deletion

T: The elimination of an existing item in an identification of goods and services in its entirety. EG A.6. Deletion occurs when goods are omitted from an extension of time to file a STATEMENT OF USE. 37 CFR 2.89(f).

delivery

P: The physical handing over of LETTERS PATENT is termed "delivery." 37 CFR 1.315.

delivery box

P: PTO.

demand

P: When “capitalized, means that document filed with the International Preliminary Examining Authority which requests an international preliminary examination.” 37 CFR 1.401(g).

demand for deposit

C: 17 USC 407(d).

Department of Agriculture

P: Plant patent applications are also sent by the PTO to the Department of Agriculture. See also DEPOSITORY.

T: Exchange of information regarding marks for seeds and plants and varietal names proposed for newly developed seeds and plants.

Department of Commerce

P: The cabinet department charged with administering patent and trademark matters. The patent function was the responsibility of the Department of the Interior prior to ***.

Department of Energy

P: The right of a non-profit organization or small business firm to retain title to an invention made under a funding agreement to operate a Government-owned facility primarily dedicated to the Department of Energy’s NAVAL NUCLEAR PROPULSION or WEAPONS programs may be restricted under 35 USC 202(a). See also GOVERNMENT AGENCY.

Department of State

P: Exchange with Commissioner. *** Patent applications for arms and ammunition. [Walker 9:5].

Department of the Treasury

T: Registration on the supplemental register or under the Act of March 19, 1920, shall not be filed in the Department of the Treasury or be used to stop importations.” 15 USC 1096. See IMPORT.

dependent claim

P: “A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” 35 USC 112. Dependent or multiple dependent claims are not permitted in plant and design patents, which must present only a single claim. 35 USC 162, 35 USC *** (designs).

depletion

T: See COLOR DEPLETION.

deposit

P: Budapest Treaty. A deposit must be made of a biotechnology invention for which a WRITTEN DESCRIPTION satisfying 35 USC 112 is impractical. 37 CFR 1.801-09. A PRIVATE DEPOSIT, with an organization that is not obliged to provide public access to

the deposit, is satisfactory for filing a United States patent application. However, a deposit must be made with an approved DEPOSITORY before issuance. A deposit may also be used to demonstrate enablement. *In re Lundak*, 773 F.2d 1216, (Fed. Cir. 1985)
C: Copyrighted works. Exemptions from the DEPOSIT requirement are enumerated in 37 CFR 202.19(c).

See also CANCELLATION, DEMAND FOR DEPOSIT.

Register of Copyrights. Deposit with a United States District Court or the Secretary of State was formerly required. See also SPECIAL RELIEF.

“Upon their deposit in the Copyright Office under sections 407 and 408, all copies, phonorecords, and identifying material, including those deposited in connection with claims that have been refused registration, are the property of the United States Government.” 17 USC 704(a). See also REPRODUCTION, RETENTION.

The following types of works are exempt from DEPOSIT requirements: ADDRESSES (when published individually), GREETING CARDS, LECTURES (when published individually), PICTURE POSTCARDS, SERMONS (when published individually), SPEECHES (when published individually), STATIONERY. 37 CFR 202.19(c). Also exempt: “diagrams and models illustrating scientific or technical works or formulating scientific or technical information in linear or three-dimensional form, such as an architectural or engineering BLUEPRINT, plan or design, a MECHANICAL DRAWING, or an ANATOMICAL MODEL. 37 CFR 202.19(c)(1). See also MOTION PICTURE.

deposit account

P: PTO. 37 CFR 1.25. An application fee may be charged.

C: “Persons or firms having a considerable amount of business with the Copyright Office may, for their own convenience, prepay copyright expenses by establishing a Deposit Account.” 37 CFR 201.6(b).

deposition

P: In an INTERFERENCE, “[w]ithin the United States or a TERRITORY or INSULAR POSSESSION of the United States a deposition shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held.” 37 CFR 1.674(a).

depository

P: An organization that receives DEPOSITS of biotechnology inventions and permits public access to them. Approved depositories in the United States are the American Type Culture Collection (ATCC), 12301 Parklawn Drive, Rockville, MD 20852, and the Northern Regional Research Laboratories (NRRL), U.S. Department of Agriculture, 1815 N. University Street, Peoria, IL 61604.

Deputy Commissioner for Patents and Trademarks

One Deputy Commissioner, to be appointed by the President, is authorized in the PTO. 35 USC 3.

derivation

P: That an invention is the work of another bars patentability, in which case the invention is said to be a “derivation.” Such a rejection under 35 USC 102(f) is also referred to as LACK OF INVENTION. Derivation may be used to show INVALIDITY of a patent. “To support a finding of derivation, a challenger to a patent must demonstrate

both that the invention was previously conceived by another person and that the complete conception was communicated to the patentee.” *Pentech Int’l. v. Hayduchok*, 18 USPQ 2d 1337 (S.D. N.Y. 1990).

If a party intends to prove derivation, the preliminary statement must also comply with §1.625.” 36 CFR 1.623(b).

derivative work

C: A “work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a ‘derivative work’.” 17 USC 101. A derivative work may constitute COPYRIGHTABLE SUBJECT MATTER. 17 USC 103(a). The exclusive right to prepare derivative works of a copyrighted work is one of the incidents of copyright. 17 USC 106(2). A work is a derivative work “only if it would be considered an infringing work if the material which it has derived from a prior work had been taken without the consent of a copyright proprietor of such prior work. *Apple Computer Inc. v. Microsoft Corp.*, 18 USPQ 2d 1097 (N.D. Cal. 1991).

Joint authorship of a prior work does not make one a joint author of a derivative work. *Ashton-Tate v. Ross*, 916 F.2d 516 (9th Cir. 1990)

derivative mark

T: A mark that is coined from an existing trademark, thereby creating a group or family of marks, each having something in common. 1990 Bacal 1.3.

description

P: Specification. A required component of an INTERNATIONAL APPLICATION. 37 CFR 1.431(a).

T: See DESCRIPTION OF GOODS, DESCRIPTION OF MARK.

A SEIZURE ORDER must set forth “a particular description of the matter to be seized.” 15 USC 1116(d)(5)(A).

description of goods

T: The description of goods in a trademark application must be definite and cannot include terms that clearly encompass more than one CLASS. TMEP 804.01. See also IDENTIFICATION OF GOODS, INCLUSIVE TERMINOLOGY.

description of mark

T: “A description of the mark, which must be acceptable to the Examiner of Trademarks, may be included in the application, and must be included if required by the Examiner.” 37 CFR 2.35. If a drawing is omitted, the application must contain an “adequate description of the mark.” 37 CFR 2.51(c). The purpose is to provide information by which the mark may be filed in the search library according to word, letter or design. TMEP 905.02. “Amendments may not be made to the description or drawing of the mark if the character of the mark is materially altered.” 37 CFR 2.72(a).

descriptive

T: A mark is descriptive if it “identifies a characteristic or quality of a product, for example, color, odor, function, dimensions, or ingredients.” 15 USPQ 2d 1613. *Cf.* MERELY DESCRIPTIVE.

descriptive material

C: Descriptive material may not constitute a WORK OF VISUAL ART. 17 USC 101.

descriptiveness

T: It is a defense to trademark infringement that “the use of the name, term or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.” 15 USC 1115(b)(4).

design

P:

C: One of the types of works protected by the Copyright Act of April 29, 1802. See also engraving, etching, print. A “design of a useful article” may fall in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 101. On the other hand, “familiar symbols or designs” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

T: When a mark consists of both a word and a design, it is generally the word portion that dominates the purchaser’s memory. *In re Mack*, 197 USPQ 755 (TTAB 1977).

design around

P: To “design around” a patent means to produce a design that avoid infringement.

design mark

T: A trademark consisting of a design only, without words. *Cf.* WORD MARK.

design patent

P: “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor.” 35 USC 171. The priority period under 35 USC 119 and the statutory bar under 102(d) for foreign filings is six months for design patent applications. 35 USC 172. The term of a design patent is fourteen years. 35 USC 173. Design patents were first permitted in 1842. The rules applicable to design patent applications are the same as those for utility patents except for 37 CFR 1.151-1.155. *Cf.* UTILITY PATENT. No description of the invention is allowed other than a reference to the drawing. 37 CFR 1.153(a). Only one (formal) claim permitted. “The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.” 37 CFR 1.153(a).

A design patent protects the non-functional aspects of an ornamental design as shown in a patent.” *Key Stone Retaining Wall Systems, Inc. v. Westrock, Inc.*, 997 F.2d 1444, 27 USPQ 2d 1297 (Fed. Cir. 1993).

A design patent is infringed “if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one

supposing it to be the other, the first one patented is infringed by the other.” *Gorham v. White*, 81 US 511 (1871). The accused device must also appropriate the novelty in the patented device which distinguishes it from the prior art. *Avia Group Int’l. Inc., v. L.A. Gear California, Inc.*, 853 F.2d 1565, 7 USPQ 2d 1548 (Fed. Cir. 1988). Design patents do not include claims to the structural or functional aspects of the article. *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1193, 5 USPQ 2d 1625 (Fed. Cir. 1988).

[Def. of infringement *** quote 35 USC 289]

A supplemental test and remedy are provided in the statute for infringement of a design patent. “Whoever, during the term of a patent for a design, without license of the owner,

(1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or

(2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.” 35 USC 289.

A utility application can claim PRIORITY based on a prior design application if the conditions of 35 USC 120 are met. *Kangaroos USA, Inc. v. Caldor, Inc.*, 778 F.2d 1571, 228 USPQ 32 (Fed. Cir. 1985).

See also COMMERCIAL SUCCESS, EXPERIMENTAL USE, OBVIOUSNESS, VALIDITY.

design utility

P: [Walker 12:17].

designated office

P: PCT. Abbreviated DO.

Designated States

P: Those countries designated in a PCT application. See also DESIGNATION FEE.

designation

P: PCT

designation fee

P: PCT

destruction

C: A remedy for copyright infringement. When infringement has been established, the infringer may be ordered by the Court to deliver up for destruction all infringing copies, ** means for making such infringing copies. 17 USC 503(b). A court may refuse to order destruction of a machine that has legitimate non-infringing uses. *RSO Records Inc. v. Peri*, 596 F.Supp. 849 (S.D.N.Y. 1984).

The author of a WORK OF VISUAL ART has the right to prevent its destruction. 17 USC 106A. The owner of a building embodying an ARCHITECTURAL WORK may alter or destroy the building. 17 USC 120(b). Destruction is a penalty imposed on conviction for trafficking in COUNTERFEIT LABELS. 18 USC 2318.

T:

1. A remedy for trademark infringement and violations of Section 43(a) of the Lanham Act, 15 USC 1125(a). The court “may order that all labels, signs, prints,

packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the registered mark or, in the case of a violation of section 43(a), the word, name, symbol, device, combination thereof, designation, description or representation that is the subject of the violation, or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed.” 15 USC 1118.

2. A remedy for violations of the Trademark Counterfeiting Act of 1984, 18 USC 2320. The counterfeit marks and the articles on which they appear may be destroyed. 18 USC 2320(b). A seizure order will not be granted, however, unless “the person against whom seizure would be ordered ... would destroy, move, hide or otherwise make such matter inaccessible to the court.” 15 USC 1116(d)(4)(B)(vii).

deteriorating copy

C: It is not an infringement of copyright for a library or archives to make a facsimile copy or phonorecord of a published work to replace a deteriorating copy if after reasonable effort it determines that an unused replacement cannot be purchased at a fair price. 17 USC 108(c).

determination

P: Before restricting the right of a non-profit organization or small business firm to retain title to an invention made under a funding agreement with the Government, a Federal agency must first file with the Secretary of Commerce a determination that one of the provisions of 35 USC (a)(i)-(iii) applies, including an analysis justifying such determination. If a small business firm is involved, the determination is also sent to the Chief Counsel for Advocacy of the Small Business Administration. 35 USC 202(b)(1).

device

C: Perceived. *** The term ”device” includes one now known or later developed. 17 USC 101. Devices are not copyrightable. “Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(b).

T: A graphic insignia. A “device” may serve as a trademark. 15 USC 1127.

S: A “device” may constitute a trade secret. UTSA 1(4).

diagram

P: See DRAWING.

C: A diagram falls in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS, but may not be a WORK OF VISUAL ART. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

diagram claim

P: A claim that makes reference to a diagram, often to specify proportions that cannot be defined by a simple mathematical relationship. Such claims are only permitted where dictated by necessity. *Ex parte Lewin*, 154 USPQ 487.

diaries

C: Diaries, to the extent they are for recording rather than conveying information, are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

diaries

C: Diaries, to the extent they are for recording rather than conveying information, are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

diffusion

C: *** distribution.

digital audio copied recording

C: A “reproduction in a digital recording format of a digital musical recording, whether that reproduction is made directly from another digital musical recording or indirectly from a transmission.” 17 USC 1001(1).

digital audio interface device

C: Any “machine or device that is designed specifically to communicate digital audio information and related interface data to a digital audio recording device through a nonprofessional interface.” 17 USC 1001(2).

digital audio recording device

C: 17 USC 1001(3)(A).

digital audio recording medium

C: 17 USC 1001(4)(A).

digital musical recording

C: 17 USC 1001(5)(A). See also SERIAL COPYING.

diligence

P: [QUOTE 35 USC 102(g)] In evaluating diligence, courts may consider the reasonable everyday problems and limitations encountered by an inventor. *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ 2d 1361 (Fed. Cir. 1987). In an INTERFERENCE, a party’s preliminary statement must state for the invention corresponding to each count the “date after the inventor’s conception of the invention when active exercise of reasonable diligence toward reducing the invention to practice began.” 37 CFR 1.624(a)(6). Diligence is a QUESTION OF FACT. *Bell Telephone Laboratories, Inc. v. Hughes Aircraft Co.*, 564 F.2d 654, 195 USPQ 695 (3rd Cir. 1977), *cert. denied*, 197 USPQ 448 (1978).

diligent effort

P: See 37 CFR 1.47(a), 1.425(a). A diligent effort must be made to locate an inventor who cannot be found ***. See also *refusal*. Cf. REASONABLE EFFORT.

diligently filed

P: “A motion under 1.634 shall be diligently filed after an error is discovered in the inventorship of an application or patent involved in an INTERFERENCE unless otherwise ordered by an examiner-in-chief.” 37 CFR 1.636(c).

dilution

T: Reduction in the distinctive quality of a trademark, with or without likelihood of confusion. Dilution may occur if the public's tendency to associate the mark with a single source is blurred or if the reputation of the mark's owner becomes tarnished. *The Black Dog Tavern Co., Inc. v. Hall*, 28 USPQ 2d 1173 (D. Mass. 1993). A dilution claim does not depend on LIKELIHOOD OF CONFUSION. *Ringling Bros.* ***, 855 F.2d 480. Dilution is not a federal claim; state laws vary in their level of protection against dilution. See ANTI-DILUTION STATUTE.

diplomatic or consular officer of the United States

P: To be valid, an oath before an officer of a foreign country who has a seal requires a certificate of a "diplomatic or consular officer of the United States" or an APOSTILLE. 35 USC 114. See also ACKNOWLEDGEMENT.

direct infringement

P: literal infringement, doctrine of equivalents. Whether direct infringement has occurred is a question of fact. Cf. CONTRIBUTORY INFRINGEMENT.

direction

P: An order by the AEC directing the Commissioner to issue an atomic energy patent to the AEC. See DIRECTION PROCEEDING.

direction proceeding

P: A proceeding to determine the entitlement of the AEC to a direction. Under Atomic Energy Act, 42 USC 2182. NAS Act of 1958, 42 USC 2457. Appeal of a direction proceeding is to the CAFC.

Director of Enrollment and Discipline

P: 37 CFR 10.2(c).

directory

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i). A directory is copyrightable as a compilation if it satisfies the requirement of originality. *** 1991 Rural Tel case.

disciplinary proceeding

P:
35 USC 32. A certificate of mailing is insufficient to establish a date for filing papers in a disciplinary proceeding before the PTO. See also NOTICE OF PROCEEDING UNDER 35 USC 32.

disclaimer

A renunciation of rights.

P: "Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit. 35 USC 288.

35 USC 253, patent term. See also FAILURE TO DISCLAIM, INVOLUNTARY DISCLAIMER, STATUTORY DISCLAIMER, TERMINAL DISCLAIMER.

“Claims may be rejected on the ground that the applicant has disclaimed the subject matter involved. Such disclaimer may arise, for example, from the applicant’s failure: (a) to make claims suggested for interference with another application under 37 CFR 1.605,

(b) to copy a claim from a patent when suggested by the examiner,

(c) to respond or appeal, within the time limit fixed, to the examiner’s rejection of claims copied from a patent.” MPEP 706.03(u).

When the examiner suggests a claim for interference, “[f]ailure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer of the invention defined by the suggested claim.” 37 CFR 1.605(a).

T: A statement made in an application to register to the effect that the applicant does not claim a right to exclusive use of a specific element or elements of a mark. The purpose of disclaimers is to preserve the commercial impression of a mark without creating a false impression of the extent of registrant’s rights with respect to individual elements in the mark. TMEP 904. “The Commissioner may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.” 15 USC 1056(a). “No disclaimer ... shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive or his goods or services.” 15 USC 1056(b). A disclaimer may be added to an existing registration provided that the disclaimer does not “alter materially the character of the mark.” 15 USC 1057(e). See also VOLUNTARY DISCLAIMER. Failure to comply with a requirement of disclaimer is a basis for refusal of registration. TMEP 904.01(b). Matter may disclaimed whether or not it is registrable. *In re MCI Communications Corp.*, Petition 91-33 (Comm’r Pats. July 15, 1991). Disclaimers now appear in a single standardized form in the Official Gazette, regardless of how they appear in the trademark application. The form is: “No claim is made to the exclusive right to use _____, apart from the mark as shown.” TMEP 904.06. See also CORPORATE DESIGNATOR, MISSPELLING, UNITARY EXPRESSION.

2. association with

disclose

P: *Cf.* TEACH.

disclosure

P: See also CLAIM-ANTICIPATING DISCLOSURE, CLAIM-SUPPORTING DISCLOSURE.

See also DUTY OF DISCLOSURE.

C: The MORAL RIGHT of an artist to determine when his work is completed and may be disclosed to the public.

S:

disclosure document

P: A document containing evidence of the date of conception of an invention. Upon payment of a fee, the PTO will preserve a disclosure document for up to two years, when it will be destroyed unless referred to in a patent application. ***refs

discovered use doctrine

P: The principle that a newly discovered use or property of an old invention is not patentable. See also NEW USE.

discovery

P: 1. Something found or learned unexpectedly.” [Walker 6:2]. Congress has the power to grant, for limited times, exclusive rights to “writings and discoveries.” Const. Art I, Sec. 8, Cl. 8.

2. Discovery is limited in interferences. “A party is not entitled to discovery except as authorized in this subpart.” 37 CFR 1.687(a).

C: Discoveries are not copyrightable. “In no case does copyright protection ... extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 USC 102(b). The same principle applies to MASK WORKS. 17 USC 902(i).

T: Discovery in TTAB proceedings ***

discretionary jurisdiction

P: [Walker 24:10]. Declaratory judgment.

dismiss

T: Petitions, oppositions are “dismissed.”

disparagement

T: A mark that may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, may be refused registration, either on the principal or the Supplemental Register. 15 USC 1052(a), 1091(a).

display

C: To “display a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images nonsequentially.” 17 USC 101. See also PUBLICLY. The exclusive right to display literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work publicly is one of the incidents of copyright. 17 USC 106(5). The owner of a particular copy lawfully made may display the copy publicly, to viewers present at the place where the copy is located, without the permission of the copyright owner. 17 USC 109(c). Display covers “the projection of an image on a screen or other surface by any method, the transmission of an image by electronic or other means, and the showing of an image on a cathode ray tube, or similar viewing apparatus connected with any sort of information storage and retrieval system.” Hr Rep. No. 1476, 94th Cong., 2d Sess. 64 (Sep. 3, 1976).

T: display associated with goods.

display associated with the goods

T: Point-of-sale material, such as banners, shelf-talkers, window displays, menus and other similar devices. The use of a display associated with goods can constitute use for trademark purpose. Any such display must be designed to catch the attention of purchasers as an inducement to consummate a sale. TMEP 808.06.

disrepute

T: A mark may be refused registration on either the principal or the Supplemental Register if it may bring into contempt or disrepute “persons, living or dead, institutions, beliefs, or national symbols.” 15 USC 1052(a), 1091(a).

disreputable

A person, agent or representative who is shown to be “incompetent, disreputable, or guilty of gross misconduct” by be suspended or excluded from practice before the PTO. 35 USC 32.

dissatisfied

The legal grounds for standing to appeal from a BPIA or TTAB decision.

P: “An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences may appeal to the United States Court of Appeals for the Federal Circuit.” 35 USC 141.

T: 15 USC 1071(a)(1). *** Also remedy by civil action.

dissection

T: The decomposition of a trademark into components for separate analysis. See also ANTI-DISSECTION RULE.

dissolution

P: *** interference. [Walker 3:15].

distant signal equivalent

C: The “value assigned to the secondary transmission of any nonnetwork television programming carried by a cable system in whole or in part beyond the local service area of the primary transmitter of such programming.” 17 USC 111(f). Abbreviated DSE.

distant station

C: “A primary transmitter is a ‘distant station’ ... if the programming of such transmitter is carried by the cable system in whole or in part beyond the local service area of such primary transmitter.” 37 CFR 201.17(b)(6).

distinct

P: “The term ‘distinct’ means that two or more subjects as disclosed are related , for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). See also INDEPENDENT, INDEPENDENT AND DISTINCT INVENTIONS, ONE-WAY DISTINCTIVENESS, TWO-WAY DISTINCTIVENESS. See also PATENTABLY DISTINCT.

distinctive

T:

distinctiveness

T: A mark that is distinctive of goods may be registered unless prohibited by 15 USC 1502(a)-(d). 15 USC 1052(f). It is prima facie evidence of distinctiveness that the

applicant has made “substantially exclusive and continuous use” of the mark in commerce for five years. 15 USC 1052(f). “[I]f the mark is said to have become distinctive of applicant’s goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness was made, a showing by way of statements, which are verified or which include declarations in accordance with §2.20, in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness.” 37 CFR 2.41(b). Distinctiveness must be found in the minds of the purchasing public. TMEP 1211. Distinctiveness is a question of fact, not law. TMEP 1211.02. See also INHERENTLY DISTINCTIVE.

distinctly claiming

P: ***quote 35 USC 112. Claims must have a clear and *** meaning when construed in the light of the complete patent document.” *Miles* ***, 27 USPQ 2d 1123.

distinguish over the prior art

P: A claim must ***

distortion

C: The author of a WORK OF VISUAL ART has the right to prevent a distortion of it that would be prejudicial to his honor or reputation and, if it is so distorted, has the right to prevent his name from being used as its author. 17 USC 106A.

distribute

C: The exclusive right to distribute copies or phonorecords of a copyrighted work to the public by sale or other transfer of ownership or by rental, lease or lending is one of the incidents of copyright. 17 USC 106(3).

With respect to a mask work, to “distribute” means to “sell, or to lease, bail, or otherwise transfer, or to offer to sell, lease, bail, or otherwise transfer.” 17 USC 901(a)(4).

With respect to digital audio recording devices, “to ‘distribute’ means to sell, lease or assign a product to consumers in the United States or to sell, lease or assign a product in the United States for ultimate transfer to consumers in the United States. 17 USC 1001(6).

distribution

T: It is an infringement of trademark to use in commerce any reproduction of a registered mark in connection with the distribution of any goods or services if such use is likely to cause confusion, to cause mistake, or to deceive. 15 USC 1114(1)(A). See also TRADEMARK INFRINGEMENT.

distributor

C: An “entity which contracts to distribute secondary transmissions from a satellite carrier and, either as a single channel or in a package with other programming, provides the secondary transmission either directly to individual subscribers for private home viewing or indirectly through other program distribution entities.” 17 USC 119(d)(1).

district courts

P: An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences may appeal to the Federal District Court for the District of Columbia. 35 USC 141. A party to an interference dissatisfied with the Board's decision may appeal to the United States District Court in any district in which an adverse party may be sued. 35 USC 146. If the adverse parties reside in a plurality of districts not in the same state or if an adverse party is a resident of a foreign country, the United States District Court for the District of Columbia shall have jurisdiction. 35 USC 146.

T: "The district and territorial courts of the United States shall have original jurisdiction ... of all actions arising under" the Lanham Act. 15 USC 1121.

District of Columbia

C: For purposes of the Copyright Act, the District of Columbia is a STATE. 17 USC 101.

T: Use of a mark in the District of Columbia constitutes USE IN COMMERCE because commerce in the District of Columbia is regulated by Congress.

divestive publication

C: A publication causing loss of common law copyright. *Cf.* INVESTIVE PUBLICATION.

division

P: = RESTRICTION. 37 CFR 1.142(a).

T: The separation of a multiple-class application into distinct applications. "An application may be physically divided into two or more separate applications upon submission by the applicant of a request therefor." 37 CFR 2.87(a). "A REQUEST TO DIVIDE an application may be filed at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication or the date of expiration of the six-month response period after issuance of a final action, or during an opposition, upon motion granted by the TTAB." 37 CFR 2.87(b). A request for division is "given priority in processing over any other paper in the case." EG 3-89, 58.

Opposition in less than all classes. Reference in less than all classes. No new application is created. TMEP 1113.03.

divisional application

P: A patent application restricted to fewer than all claims of an earlier filed U.S. application but that is entitled to the filing date of the earlier application. 35 USC 121. The earlier application is known as the PARENT APPLICATION. A divisional application usually results from a requirement of RESTRICTION by the PTO when an inventor claims two or more separate inventions in the same application. By dividing the application, the applicant may learn whether he is entitled to patent on some claims before prosecuting the remainder. A patent issuing on an application after the filing of a divisional application based on it may not be used as a reference against the divisional.

DJ

:declaratory judgment

docketing statement

A record maintained by the clerk of a federal court indicating the names of parties to an action.

T: See also SEAL ORDER.

doctrines

See DOCTRINE OF EQUIVALENTS, DOCTRINE OF FOREIGN EQUIVALENTS, REVERSE DOCTRINE OF EQUIVALENTS. See also RULE.

doctrine of equivalents

P: [ELABORATE ***] The principle that a claim that is not literally infringed because an element is absent is nevertheless infringed if an EQUIVALENT of that element is substituted. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 US 605 (1950). Does not extend to include prior art. *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677, 14 USPQ 2d 1942 (Fed. Cir.), *cert. denied* (1990). See also EQUIVALENT, FUNCTION-WAY-RESULT, HYPOTHETICAL CLAIM. Equivalence is a QUESTION OF FACT. Cf. LITERAL OVERLAP, REVERSE DOCTRINE OF EQUIVALENTS.

doctrine of foreign equivalents

T: The principle that a mark in a foreign language is regarded as the equivalent of its english translation. For example, a term that is generic in french is also generic in english, regardless of consumer perception. A trademark which is not in english is first translated into english before being classified. *French Transit Ltd. v. Modern Coupon Systems*, 29 USPQ 2d 1626 (S.D.N.Y. 1993). The doctrine is not applicable to marks that are combinations of english and foreign terms. *In re Johanna Farms*, 8 USPQ 2d 1408, 1413 (TTAB 1988).

doctrine of multiple performances

C: retransmission by CATV not mult. perf., radio broadcast may be mult perf.

document designated as pertaining to computer shareware

C: “[L]icenses or other legal documents governing the relationship between copyright owners of COMPUTER SHAREWARE and persons associated with the dissemination or use of computer shareware.” 37 CFR 201.26(b)(2).

dolls

C: The year date may be omitted from the copyright notice on a pictorial, graphic or sculptural work as reproduced on dolls. 17 USC 401(b)(2).

domestic applicant

T: A person whose business is located in the United States or its territories. TMEP 202.04(a). Cf. FOREIGN APPLICANT.

domestic representative

T: “An assignee not domiciled in the United States shall by written document signed by such assignee designate a domestic representative.” TMEP 501.07. “If an applicant is not domiciled in the United States the application must designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings

affecting the mark.” 37 CFR 2.24. “The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified ... and authorized under 2.17(b).” 37 CFR 2.24.

domicile

C: Domicile of the author on the date of first publication of a work is required in a RENEWAL AFFIDAVIT FOR A UCC WORK. 37 CFR 202.17(d)(i)(D).

domiciliary

C: Published works of domiciliaries of the U.S. or of a foreign nation that is a party to a copyright treaty to which the U.S. is also a party are subject to copyright protection. 17 USC 104(b)(1).

T: “An assignee not domiciled in the United States shall by written document signed by such assignee designate a domestic representative.” TMEP 501.07. See DOMESTIC REPRESENTATIVE.

dominant

P: A patent claim A is “dominant” over another claim B if B is NARROWER than A, in which case B is said to be SUBSERVIENT to A.

dominant portion

T: Likelihood of confusion may be found if the dominant portions of two marks are the same. 15 USPQ 2d 1613.

dosage claim

A claim to an old composition drawn only to making it into a tablet or capsule is not patentable unless an unobvious dosage is claimed. *In re Craige*, 90 USPQ 22.

double correspondence

See CORRESPONDENCE WITH PATENT AND TRADEMARK OFFICE.

double inclusion

The improper practice in claim drafting of naming the same element twice but differently in a claim or by reference in a chain of dependent claims. Example: claim 1 recites a “grasping means” and claim 2 recites “further comprising a clamp.”

double patenting

P: An attempt to extend the patent monopoly by securing a later patent for substantially the same invention. Double patenting may involve copending applications, issued patents or pending applications and issued patents. Two types of double patenting are recognized, OBVIOUSNESS TYPE DOUBLE PATENTING and SAME INVENTION TYPE DOUBLE PATENTING.

“Double patenting results when two or more patents are granted containing CONFLICTING CLAIMS, that is, claims in each patent that recite either the same inventive concept or obvious variations of the same concept.” MPEP 804. “A good test for double patenting under 35 USC 101 is whether one of the claims could be literally infringed without infringing the other.” MPEP 804.

Double patenting occurs only where the conflicting claims are owned by (1) the same inventive entity; (2) a common assignee; or (3) different inventive entities sharing a common inventor. “Where an application claims an invention which is not patentably

distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application.” 37 CFR 1.78(d). An obviousness type double patenting rejection may sometimes be overcome by a TERMINAL DISCLAIMER. See also PROVISIONAL DOUBLE PATENTING REJECTION, SAME INVENTION TYPE OBVIOUSNESS.

Double patenting between a design and utility patent can be found only if their claims cross-read or constitute obvious variations in both directions. There is no double patenting where the utility aspect does not flow from the design even though the design might have been obvious in view of the claimed utility features. *Carman Industries Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983).

double patenting protection

P: The protection afforded by 35 USC 121, which provides, “***,” which can allow double patenting where there has been an improper REQUIREMENT FOR RESTRICTION by the PTO. MPEP 804.01. Double patenting protection does not apply where the requirement for restriction was only made by the ISA or IPEA.

double trademarking

T:

double use

P: [Walker 4:50].

doubt

P: Doubt as to obviousness is resolved in favor of the applicant. *In re Citron*, 251 F.2d 619, 116 USPQ 407 (CCPA 1958). “Doubt as to (1) definiteness or sufficiency of any allegation in a preliminary statement or (2) compliance with formal requirements will be resolved against the party filing the statement by restricting the party to the earlier of its FILING DATE or EFFECTIVE FILING DATE or to the latest date of a period alleged in the preliminary statement as may be appropriate.” 37 CFR 1.629(a).

C: See RULE OF DOUBT.

T: Doubt as to likelihood of confusion in an application for registration is resolved in favor of the prior registrant. Doubt as to descriptiveness or genericness is resolved in favor of the applicant. ***cite

dramatic composition

C: Dramatic compositions first received copyright protection by the Act of August 18, 1856.

dramatic work

C: Includes “any accompanying music.” 17 USC 102(a). A type of WORK OF THE PERFORMING ARTS. 37 CFR 202.3(b)(1)(ii). It may also constitute a DERIVATIVE WORK. 17 USC 101. A dramatic work published only as embodied in PHONORECORDS is exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(4).

dramatization

C: A dramatization may constitute a DERIVATIVE WORK. 17 USC 101.

drawing

P: “The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.” 35 USC 114, 37 CFR 1.81(a). The drawing must show every feature of the invention specified in the claims. 37 CFR 1.83(a)**. [See 113 and Rule 83] An amendment to a drawing may be made only by permission of the PTO. 37 CFR 1.123. The specification may not contain drawings or flow diagrams. 37 CFR 1.58(a). A color drawing will be accepted only on petition to the Commissioner under 37 CFR 1,183. MPEP 608.02(p).

C: A drawing may be a WORK OF VISUAL ART. 17 USC 101. See also TECHNICAL DRAWING.

T: An applicant for federal trademark registration must submit “a drawing of the mark.” 15 USC 1051(a)(1)(B). The drawing is the part of the application which presents the elements which constitute the mark sought to be registered. “[T]he drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods.” 37 CFR 2.51(a). “The drawing of a mark may be dispensed with in the case of a mark not capable of representation by a drawing, but in any such case the application must contain an adequate description of the mark.” 37 CFR 2.51(c). “Amendments may not be made to the description or drawing of the mark if the character of the mark is materially altered.” 37 CFR 2.72(a). The drawing is used to reproduce the mark in the Official Gazette and in the registration certificate. TMEP 807.2. Color in the drawing is shown by LINING. 37 CFR 2.52(e). See also BROKEN LINES, INK DRAWING, MUTILATION, SPECIAL FORM DRAWING, TYPED DRAWING.

“The drawing of a service mark may be dispensed with in the case of a mark not capable or representation by a drawing, but in any such case the application must contain an adequate description.” 37 CFR 2.51(b).

Drawings must be limited to ***. Oversized drawings are rejected. *In re Fuller-Jeffrey Broadcasting Corp. of Santa Rosa*, 16 USPQ 2d 1456 (Comm’r Pats. 1990).

Matter that is not part of a mark must be removed from the drawing. *In re Automotive Filters, Inc.*, 168 USPQ 186 (TTAB 1970).

droit de suite

C: The right of an artist to participate in the profit from future transfers of a work. See also RESALE RIGHTS. Under French copyright law, the droit de suite is conferred for the life of the artist plus 50 years, provides for a payment to the artist that is a fixed percentage of the sale price (unlike California, which bases the payment on seller’s profit). See S.P.A.D.E.M.

droit moral

C:

drug

P: See EXTENSION OF PATENT TERM, PATENT TERM EXTENSION, PATENT TERM RESTORATION.

drug product

P: A term used in 35 USC 156 to mean “the active ingredient of — (A) a new drug, antibiotic drug, or human biological product (as those terms are used in the Federal

Food, Drug, and Cosmetic Act and the Public Health Service Act), or (B) a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques.” 35 USC 156(f)(2).

DSE

C: = DISTANT SIGNAL EQUIVALENT. 17 USC 111(f); 37 CFR 201.17.

du Pont agreement

T: [to avoid likelihood of confusion].

due care

P: See DUTY OF DUE CARE.

due diligence

P: That “degree of attention, continuous directed effort, and timeliness as may reasonably be expected from, and are ordinarily exercised by, a person during a regulatory review period.” 35 USC 156(d)(3). *** See statute and 37 CFR 1.131(b).

The period by which a patent is extended for a product or manufacturing method is extended because the product was subject to regulatory review is reduced by any period during such review in which the applicant for extension did not act with due diligence. 35 USC 156(c)(1). See EXTENSION OF PATENT TERM. A due diligence determination is not subject to review *** 35 USC 282.

T: “Applicants must exercise due diligence in monitoring the status of application to ensure that remedies available through petition or otherwise are preserved where they are otherwise proper ... If no action has issued, the applicant must submit a petition, a request to restore the filing date or an inquiry with due diligence, normally within six months of the asserted filing date.” EG 1-92.

duplicate claim

P: Claims must “differ substantially” from one another. 37 CFR 1.75, MPEP 706.03(k). “When two claim sin an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim.” MPEP 706.03(k).

duplicate registrations

T: “Registrations which are in all respects identical to each other will be refused.” TMEP 1103.06.

duplicate specimen

T: Specimens submitted with a trademark application should be “duplicates” of labels or tags actually used on the goods, not likenesses produced by duplication or copying, but samples taken out of existing supply. TMEP 808.04.

duration

C: See TERM.

Durden rejection

P: A REJECTION of a process claim for OBVIOUSNESS on the ground that a new starting material or product of the process does not make the process new even though both the starting material and the resulting compound are noobvious and patentable. Named for the result in *In re Durden*, 763 F.2d 1406 (Fed. Cir. 1985). Durden does not apply to process of using claims. *In re Pleuddemann*, 910 F.2d 823 (Fed. Cir. 1990).

duty of candor

P: “A duty of candor and good faith toward the Patent and Trademark Office rests on the inventor, on each attorney or agent who prepares or prosecutes the application and on every other individual who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application. All such individuals have a duty to disclose to the Office information they are aware of which is material to the examination of the application.” 37 CFR 1.56(a). Violation of the duty will result in no patent being issued. 37 CFR 1.56(d).

The duty of candor rests on the inventor as well as the patent attorney. *Fox Industries, Inc. v. Structural Preservation Systems Inc.*, 922 F.2d 801, 17 USPQ 2d 1579 (Fed. Cir. 1990). “Applicants for patents are required to conduct themselves with candor in their dealings with the PTO. Thus, if an applicant withholds material information from the PTO with intent to affect the allowance of claims, the applicant may be found guilty of inequitable conduct and the patent obtained would be rendered unenforceable.” *LaBounty Manufacturing, Inc. v. U.S. Int’l. Trade Comm’n.*, 958 F.2d 1066, 22 USPQ 2d 1025 (Fed. Cir. 1992).

“A duty of candor and good faith toward the Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture rests on the patent owner or its agent, on each attorney or agent who represents the patent owner and on every other individual who is substantively involved on behalf of the patent owner in a PATENT TERM EXTENSION PROCEEDING.” 37 CFR 1.765(a).

duty of disclosure

P: he duty to disclose to the PTO all information of which one is aware that is material to the examination of an application. 37 CFR 1.56(a).

duty of due care

P: potential infringer having actual notice of another’s patent has an affirmative duty of cue care that normally requires the potential infringer to obtain competent legal advice before infringing or continuing to infringe.” 24 USPQ 2d 1321, 1339.

duty to account

The obligation among JOINT OWNERS to divide profits from exploitation of a work.

P: Joint owners of a patent have no duty to account.

C: Joint owners of copyright have a duty to account to one another.

duty to publish

C: The contractual obligation of a publisher to publish an author’s manuscript within a given period of time.

EA

C: Abbreviation for *épreuve d'artiste*, the French for ARTIST'S PROOF.

earlier filing date

P: An EFFECTIVE FILING DATE that is earlier than the actual date on which a patent application is filed. An applicant may obtain an earlier filing date based on (1) a foreign application for a patent or inventor's certificate; (2) an earlier U.S. application naming an inventor named in the later application that discloses the invention, if the later application is filed before the issuance of a patent on or the abandonment of the earlier application. 35 USC 120.

edition

C: A version of a work differing in copyrightable content. 37 CFR 202.19(b)(1)(iv). Cf. BEST EDITION.

editorial notes

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101.

editorial revisions

C: A work consisting of editorial revisions may constitute a DERIVATIVE WORK. 17 USC 101.

educational purposes

C: See FAIR USE.

effective date

C: "In any case in which time limits are prescribed under this title for the performance of any action in the Copyright Office, and in which the last day of the prescribed period falls on a Saturday, Sunday, holiday, or other nonbusiness day within the District of Columbia or the Federal Government, the action may be taken on the next succeeding business day, and is effective as of the date when the period expired." 17 USC 703. See also EFFECTIVE DATE OF REGISTRATION.

effective date of registration

C:

effective filing date

P: The "effective filing date" of an application or a patent is the filing date of an earlier application accorded to the application or patent under 35 USC 119, 120 or 365." 37 CFR 1.601(g). If an applicant has filed a patent application in a foreign country and within twelve months files an application in the United States, the U.S. application will receive an effective filing date for priority purposes as of the date of foreign filing. 35 USC 119. An effective filing date may also be claimed on an application for a foreign inventor's certificate under certain circumstances. 35 USC 119.

For requirements for claiming an invention disclosed in a prior application, see 37 CFR 1.78(a).

C: See EFFECTIVE DATE OF REGISTRATION.

T: The effective filing date of a trademark application is its filing date except where the application is based on foreign priority under section 44(d). TMEP 706.

elaborations

C: A work consisting of elaborations may constitute a DERIVATIVE WORK. 17 USC 101.

elected office

P: PCT. Abbreviated EO.

election

P: "Election is the designation of the particular one of two or more disclosed inventions that will be prosecuted in the application." MPEP 818. Election of species is not required "if the species claimed are clearly unpatentable (obvious) over each other." MPEP 808.01(a). A holding by the examiner that claims are not directed to the elected subject matter, if TRAVERSED, is appealable. MPEP 821.

See also CONSTRUCTIVE ELECTION, ORIGINAL PRESENTATION, PROVISIONAL ELECTION, SHIFT

election of species

P: If no generic claim is allowable, the examiner may require election of one species or may require RESTRICTION to "not more than a reasonable number of species." 35 USC 121, 37 CFR 1.141, 1.142, 1.146.

electronic communication

T: An injunction restraining publication of an issue of an electronic communication containing infringing matter or violating matter is not available if the result would be to delay dissemination of the communication beyond the regular time for its transmission. 15 USC 1114(2)(C). *** Obtain definition from 18 USC 2510(12).

electronic information service

C: An electronic information service may not constitute a WORK OF VISUAL ART. 17 USC 101.

electronic publication

C: An electronic publication may not constitute a WORK OF VISUAL ART. 17 USC 101.
T: See ELECTRONIC COMMUNICATION.

element

P:

embodiment

P:

emergency basis

P: The PTO permits claims that would otherwise be improper on an "emergency basis" where no other method claiming is possible. See, for example, FINGERPRINT CLAIM.

employee

C: See WORK FOR HIRE.

employer

C: The author of a work made for hire is the “employer or other person for whom the work was prepared” unless there is a written agreement to the contrary. 17 USC 201(a)***?.

enablement

P: The requirement that in an application for a patent, the invention be described “:in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains ... to make and use the same.” 35 USC 112. See also UNDUE EXPERIMENTATION.

enabling disclosure

P: A disclosure that satisfies the requirement of ENABLEMENT. In the case of biological materials, an enabling disclosure may be made by depositing a viable sample of the biological material in a recognized depository. MPEP 608.01(p).

encumbrance

P: Encumbrances upon a patent are recordable. 37 CFR 1,331(b).

encyclopedia

C: An encyclopedia may constitute a COLLECTIVE WORK if it consists of independent contributions. 17 USC 101.

endorsement

T: use of a mark may imply endorsement. See FALSE ENDORSEMENT. See also AFFILIATION, SPONSORSHIP.

energy

P: See ATOMIC ENERGY, PETITION TO MAKE SPECIAL.

engine

P: One of the original classes of patentable subject matter enumerated in the Act of 1790.

English

P: See LANGUAGE.

engraving

C: One of the types of works protected by the Copyright Act of April 29, 1802. See also design, etching, print.

enhanced damages

P: [Walker 27:44].

enter

P,T: An amendment is said to be “entered” when the examiner gives effect to it and thereby causes the change requested by the applicant to be physically made in the application file. 37 CFR 1.122(a). See ADMIT.

A reply brief is “entered” by the examiner and entry may be refused if argument is directed to new points not present in the examiner’s brief. 37 CFR 1.193(b), TMEP 1110.

entire market value rule

P: [Walker 27:35].

entity

P: See INVENTIVE ENTITY.

T: As used in the trademark rules of procedure, “entity” includes both natural and juristic persons. 37 CFR 2.2(b).

entity type

T: INDIVIDUAL, PARTNERSHIP, CORPORATION, ASSOCIATION.

entry of appearance

A form used to record appearance of counsel in CAFC cases.

environment

P: An patent application for an invention materially enhancing the quality of the environment may be made SPECIAL on petition to the Commissioner. 37 CFR 1.102(c) ***?.

ephemeral recording

C: 17 USC 112.

EPO

P: Abbreviation for the European Patent Office.

equitable defense

T: “Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action ... shall not preclude another person from proving any legal or equitable defense or defect ... which might have been asserted if such mark had not been registered ” 15 USC 1115(a).

equitable estoppel

A party is estopped to advance an infringement claim when (1) plaintiff knows the facts of the defendant’s infringing conduct; (2) plaintiff intends that his conduct be acted upon or so acts that the defendant has a right to believe that it is so intended; (3) defendant is ignorant of the true facts; and (4) defendant detrimentally relies on plaintiff’s conduct. *Hadady Corp. v. Dean Witter Reynolds, Inc.*, 16 USPQ 2d 1149 (C.D. Cal. 1990).

equitable principles

T: “[E]quitable principles, including laches, estoppel, and acquiescence” are defenses to TRADEMARK INFRINGEMENT. 15 USC 1115(b)(8). “In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.” 15 USC 1069.

equitable remuneration

P: 20-year extension. Infringements commenced before June 8, 1995.

equivalent

P: 1. Also 35 USC 113. 27 USPQ 1329. Equivalence is determined on an element-by-element basis. *Pennwalt Corp. v. Durand-Wayland*, 833 F.2d 931, 4 USPQ 2d 1737 (Fed. Cir. 1987).

2. See DOCTRINE OF EQUIVALENTS.

Expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. MPEP 706.02. *In re Scott*, 139 USPQ 297 (1963). Equivalence is a QUESTION OF FACT. *Graver Tank ****, 339 US 605.

erasure

P: Any erasure must be made before signing the oath or declaration and should be dated and initialled or signed by the applicant. 37 CFR 1.52(c).

error

P: drafting. [Walker 14:12]. See PLAIN ERROR.

C: Omission of notice 17 USC 405(a). See also CURE.

T: See CLEAR ERROR, ERROR OR ENTITLEMENT.

error or entitlement

T: A standard of review for PETITIONS for relief from actions of PTO employees other than professionals with legal training. The applicant is entitled to relief if it can show error by the PTO or that it is entitled to relief under statute or regulations even in the absence of error.

especially adapted

P: See ESPECIALLY MADE. 35 USC 271(c).

especially made

P: One who sells a component of a patented invention, “knowing the same to be especially made or especially adapted for use in infringement of such patent,” may be liable as a CONTRIBUTORY INFRINGER. 35 USC 271(c).

essential and integral

T: A trademark drawing is considered MUTILATED if “essential and integral subject matter is missing.” TMEP 807.

essential step

C: A criterion for determining whether a copying of a computer program is an infringement. The owner of a copy of a program may make a copy if doing so is an “essential step in the utilization of the computer program in conjunction with a machine and that it is used in no other manner.” 17 USC 117.

essential to the ends of justice

P: A MATERIAL ERROR in a PRELIMINARY STATEMENT may be corrected only if the correction is “essential to the ends of justice.” 37 CFR 1.628(a).

estoppel

P: *** An infringer is estopped to challenge UTILITY. *E. I. du Pont de Nemours & Co v. Berkley & Co.*, 620 F.2d 1247, 205 USPQ 1 (8th Cir. 1980). See also ASSIGNEE ESTOPPEL, ASSIGNOR ESTOPPEL, COLLATERAL ESTOPPEL, ESTOPPEL BY LACHES, FILE

WRAPPER ESTOPPEL, LICENSEE ESTOPPEL, LICENSOR ESTOPPEL, PROSECUTION HISTORY ESTOPPEL.

C: Equitable estoppel + detrimental reliance. “The defense is more potent than laches.” *Boothroyd Dewhurst Inc. v. Poli*, 783 F.Supp. 670 (D. Mass 1991).

T: “[E]quitable principles, including laches, estoppel, and acquiescence” are defenses to TRADEMARK INFRINGEMENT. 15 USC 1115(b)(8). “In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.” 15 USC 1069.

estoppel by laches

T: LACHES, coupled with reliance by defendant on plaintiff’s failure to act, may estop plaintiff from asserting its mark against defendant. But see CLEAR AND NOT IN DOUBT.

etching

C: One of the types of works protected by the Copyright Act of April 29, 1802. See also design, engraving, print.

European-type claim

P: A claim reciting an improvement to a known device. So-called because such claiming is common in European countries. See also JEPSON CLAIM.

eviction

P: [Walker 20:25].

evidence

P: “A preliminary statement shall not be used as evidence on behalf of the party filing the statement.” 37 CFR 1.629(e).

evidence claim

P: A claim indicating that a combination does not rely on the specific details of a particular subcombination for its patentability. In such a case, a claim to the subcombination alone will be RESTRICTED. For example, of the combinations and subcombinations AB and AC are claimed in which C is a broader subcombination than B, then AC is an evidence claim showing the non-essentialness of B to the invention and a claim to B will be restricted. If AB is subsequently rejected, REJOINDER of B will be considered,” MPEP 806.05(c).

ex parte

P,T: A proceeding involving only a single party before the Patent and Trademark Office. Cf. INTER PARTES.

ex parte application

T: “In the case of a civil action arising under section 32(1)(a) of this Act (15 USC 1114) or section 110 [of the Olympic Charter Act] with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order ... providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.” 15 USC 1116(d)(1)(A).

Ex parte Quayle action

P: An OFFICE ACTION specifying that the application is in condition for allowance except for formal matters, thereby terminating prosecution on the merits. *Ex parte Quayle*, 1935 C.D 11, 453 OG 213.

Ex parte White action

P: [Walker 12:18].

examination

P: The Commissioner shall cause an examination to be made of the application and the alleged new invention; and of on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.” 35 USC 131. See also ORDER OF EXAMINATION. In some foreign countries, examination does not take place until it is requested by the applicant (and a fee is paid).

T: “Upon the filing of an application for registration and payment of the prescribed fee, the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the application is entitled to registration, or would be entitled to registration upon acceptance of the statement of use required by section 1(d) of this Act, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office ...” 15 USC 1062(a). If the mark is not entitled to registration, the examiner must advise the applicant of the reasons therefor and the applicant has six months in which to file a response. 15 USC 1062(b). See PUBLICATION.

examiner

P:

T: An informal term for EXAMINING ATTORNEY.

examiner-in-chief

P: The Secretary of Commerce, upon nomination of the Commissioner of Patents and Trademarks, appoints examiners-in-chief, who “shall be persons of competent legal knowledge and scientific ability.” 35 USC 3. The examiners-in-chief sit on the Board of Patent Appeals and Interferences. The Commissioner may designate any examiner of primary grade or higher as an examiner-in-chief for six-month periods. 35 USC 7(c).

Party seeking suspension of INTERFERENCE pending an appeals court decision should request it from the examiner-in-chief. 16 USPQ 2d 1441. The examiner-in-chief interacts with the LEAD ATTORNEY or LEAD AGENT of each party to an interference proceeding.

examiner’s amendment

P: See MPEP 1302.04(b).

T: An amendment by the Examining Attorney on his or her own initiative, usually after telephone contact with the applicant. The procedure may be used for any amendment not requiring VERIFICATION. “An Examiner’s amendment is a communication to the applicant in which the Examining Attorney states that the application has been amended in a specified way.” TMEP 1111.

examiner's answer

P: BPAI. [Walker 72:57].

T: The Examiner's answer to applicant's appeal brief. 37 CFR 1.193. Sometimes known as the EXAMINER'S BRIEF. See also REPLY BRIEF.

examiner's brief

T: = EXAMINER'S ANSWER.

examining attorney

T: An attorney at the PTO who examines trademark applications. Also TRADEMARK ATTORNEY.

examining group

P: An administrative unit within the PTO that examines patent applications relating to a particular area of technology.

exceptional case

P: "The court in exceptional cases may award reasonable attorney's fees to the prevailing party." 35 USC 285. Whether a case is exceptional is a question of fact. *Reactive Metals and Alloys Corp. v. ESM, Inc.*, 769 F.2d 1578, 226 USPQ 821 (Fed. Cir. 1985).

T: "The court in exceptional cases may award reasonable attorney's fees to the prevailing party." 15 USC 1117(a). "Generally, a trademark case is exceptional for purposes of awarding attorneys' fees "when the infringement is malicious, fraudulent, deliberate or willful." *Lindy Pen Co. Inc. v. BIC Pen Corp.*, 982 F.2d 1400, 1405 (9th Cir. 1993) cert _____ .

exceptional circumstances

Cf. EXTRAORDINARY CIRCUMSTANCES.

S: Future use of a misappropriated trade secret is permissible upon payment of a reasonable royalty under "exceptional circumstances." UTSA 2(b).

exclusion from practice

A person, agent or representative who is shown to be "incompetent, disreputable, or guilty of gross misconduct" by be suspended or excluded from practice before the PTO. 35 USC 32.

exclusive license

P

Non-profit or small business that has retained title may not issue exclusive license to use or sell unless item will be manufactured in U.S. 35 USC 204.

exclusive licensee

P:

C: See TRANSFER OF COPYRIGHT.

exclusive right

C: Copyright embodies the five exclusive rights enumerated at 17 USC 106, namely, reproduce, prepare derivative works, distribute copies or phonorecords, perform publicly and display publicly. These "exclusive rights," however, are subject to the

FAIR USE limitation (17 USC 107), reproduction by libraries and archives (17 USC 108), transfer of particular copies or phonorecords (17 USC 109), exemption of certain performances and displays (17 USC 110), secondary transmissions (17 USC 111) and ephemeral recordings (17 USC 112).

T: “Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence ... of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein ... ” 15 USC 1115(a). “To the extent that the right to use the registered mark has become incontestable under section 15, the registration shall be conclusive evidence ... of the registrant’s exclusive right to use the registered mark in commerce.” 15 USC 1115(b).

exclusive use

exclusive world rights in perpetuity

C: A phrase used in serial publication agreements to mean the entire copyright in a work. See ALL RIGHTS.

excusable neglect

P: The Commissioner may extend the time to file an appeal from a decision of the Board of Patent Appeals and Interferences after expiration of the time period “upon a showing that the failure to act was the result of excusable neglect.” 37 CFR 1.304(a); 16 USPQ 2d 1479

excusable nonuse

T: Nonuse of a trademark that is not motivated by an intent not to resume use. A registrant whose nonuse is excusable must file a statement of nonuse in place of a STATEMENT OF USE.

executor

[Definition]

P: The executor of the estate of a deceased inventor may apply for a patent. 37 CFR 1.42. See also ADMINISTRATOR, DEATH, LEGAL REPRESENTATIVE.

C: See RENEWAL CLAIMANT.

exhausted combination

P: = OLD COMBINATION.

exhaustion

P: See PATENT EXHAUSTION.

exhaustion of remedies

P: District Court action 35 USC 145. [Walker 12:59].

exhibit

P: District Court proceeding in interference. [Walker 12:60].

exhibition purposes

C: A photographic image qualifies as a WORK OF VISUAL ART only if it was produced for exhibition purposes only. 17 USC 101.

expedited handling

P: Foreign filing license. 37 CFR 5.12, 5.13, 5.14.

expenses

T: 1. Expenses of an infringer are deductible where they are “of actual assistance in the production, distribution or sale of the infringing product.” *Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc.*, 772 F.2d 505, 516, 227 USPQ 687 (9th Cir. 1985).

2. In a civil action appealing from a decision of the TTAB, “[unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not.” 15 USC 1071(b)(3).

experimental use

P: 1. Experimental use of an invention for purposes of testing or evaluation, does not constitute PUBLIC USE so as to BAR patentability under 35 USC 102(b). *Baker Oil Tools v. Geo. Vann*,*** 828 F.2d 1558.

The “reasonable purpose test” for experimental use of *In re Smith*, 714 F.2d 1127 *** includes the following factors:

- 1) whether the inventor inspected the invention regularly;
- 2) whether the inventor retained control over the invention;
- 3) whether payment was made for the device;
- 4) whether users were subject to confidentiality agreements;
- 5) whether the label “experimental” appeared to be an afterthought;
- 6) whether the tests went on longer than necessary.

However, after reduction to practice, continued prototyping or development is not experimental use that escapes the bar. *Atlantic*,*** 28 USPQ 2d 1343. It is not generally settled whether an experimental use exception exists generally for design patents. *IKO Chicago, Inc. v. CertainTeed Corp.*, 29 USPQ 2d 1953, 1954 (N.D. Ill. 1993).

2. Non-infringing experimental use by other than the patent owner is recognized under certain circumstances.

Statutory 35 USC 271(e)(1).

experimentation

P: A disclosure is not enabling if undue experimentation is required to make or use the invention.

expert

See AGRICULTURAL EXPERT, HORTICULTURAL EXPERT.

expert witness**expired patent**

P:

exploit

See COMMERCIALY EXPLOIT.

express abandonment

P: An application may be abandoned by written declaration of the applicant, assignee of record, attorney or agent of record. 37 CFR 1.137, 1.138. Filing a FILE WRAPPER CONTINUATION constitutes an express abandonment of the application on which it is based. 37 CFR 1.62(g). An “amendment cancelling all of the claims, even though said amendment is signed by the applicant himself and the assignee, is not an express abandonment.” MPEP 711.01; *Ex parte Laiscell*, 1884 C.D. 66, 29 O.G. 861.

T: “An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application.” 37 CFR 2.68. Also FORMAL ABANDONMENT. See ABANDONMENT.

express mail

For a paper mailed by express mail and accompanied by a certificate of mailing by express mail, the PTO will accord the paper the filing date as certified without further proof unless a question is present regarding the date of mailing. 37 CFR 1.10. *Cf.* CERTIFICATE OF MAILING.

“Where reasonably possible, service of the request for reconsideration [of a final decision in an interference] shall be such that delivery is accomplished by hand or ‘Express Mail’.” 37 CFR 1.658(b).

express reverse palming off

T: See REVERSE PALMING OFF.

express transfer

C: In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproduction and distribution of the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series. 17 USC 201(c).

expression

C: “[T]he purpose or function of a utilitarian work would be the work’s idea, and everything else would be part of the expression of the idea.” *Whelan Associates, Inc. v. Jaslow Dental Lab.*, 797 F.2d 1202, 1236, 230 USPQ 481 (3rd Cir. 1986). *Cf.* idea.

expropriation

C: The government may not expropriate a copyright of an individual author. 17 USC 201(c). See also INVOLUNTARY TRANSFER.

expungement

P: [Walker 12:54]. petition.

extended term

P: See PATENT TERM EXTENSION, PATENT TERM RESTORATION.

extension application

P: An application for EXTENSION OF PATENT TERM. 35 USC 156.

extension fee

P:

extension of patent term

P: The terms of patents to certain products subject to regulatory review and methods of using or manufacturing them have been extended by statute. 35 USC 156. See also PATENT TERM EXTENSION, PATENT TERM RESTORATION.

Mail relating to applications for extension of patent term should be marked “Box Patent Ext.” 37 CFR 1.1(f).

extension of time

P:

appeal from Board. 37 CFR 1.136(b).

appeal to Federal Circuit. 37 CFR 1.304.

commence civil action. 37 CFR 1.304.

interference. 37 CFR 1.645

petitions. [Walker 12:19, 12:54].

reexamination. 37 CFR 1.550(c).

response. 37 CFR 1.136.

shortened statutory period. Petition for extension. 37 CFR 1.136(b).

Showing sufficient cause. 37 CFR 1.136(b).

T: file statement of use. Initial period: 6 months. Next: 6 months. Good cause: up to 24 additional months. Total time: 36 months. 37 CFR 2.89.

file notice of opposition: 30 days. Good cause: ***. With consent of applicant: indefinite. See also OPPOSITION.

extenuating circumstances

T: The court in certain trademark counterfeiting cases must award TREBLE DAMAGES and ATTORNEY’S FEES unless it finds EXTENUATING CIRCUMSTANCES. It may also award PREJUDGMENT INTEREST. 15 USC 1117(b).

extra element test

C: A test to determine whether a state law claim is preempted by the Copyright Act. To avoid PREEMPTION, the state claim must have an “extra element” that changes the nature of the claim so that it is qualitatively different from a copyright infringement claim. *Computer Associates*, *** 982 F.2d 693, 716.

extraordinary circumstances

Cf. EXCEPTIONAL CIRCUMSTANCES.

T: 1. The Commission may waive a Rule of Practice that is not a requirement of or reflective of statute if the circumstances are extraordinary, the waiver will not injure any third party and “justice requires” the waiver. *In re Tetrafluor, Inc.*, 17 USPQ 2d 1160 (Comm’r Pats. 1990).

2. Extensions of time to oppose aggregating more than 120 days may be granted upon a showing of extraordinary circumstances. 37 CFR 2.102(c).

3. The Commissioner may declare an interference under “extraordinary circumstances.” 15 USC 1066. Extraordinary circumstances are required to extend the time within which to file a opposition beyond 120 days without consent of the applicant. 37 CFR 2.012.

extraterritoriality

P: The patent laws of the United States have no extraterritorial effect.

C: The doing or authorizing of wholly extraterritorial acts is not an infringement of copyright. *Subafilms*. ***. However, if some infringing activity occurs in the U.S., continued infringement outside the U.S. can be remedied as part of the claim for infringement of the U.S. copyright. *Famous Music Corp. v. Seeco Records, Inc.*, 201 F.Supp. 560 (S.D.N.Y. 1961). See also IMPORT.

T: In order to give rise to jurisdiction under the Lanham Act, extraterritorial acts must satisfy the following three-part test:

1. there must be some effect on American foreign commerce.
2. the effect must be sufficiently great to present a cognizable injury to the plaintiffs under the federal statute;
3. the interests and links to American foreign commerce must be sufficiently strong in relation to those of other nations.

Timberlon Lumber Co. v. Bank of America, N.T. & S.A., 549 F.2d 597, 613 (9th Cir. 1976).

Importing, gray market ***

extrinsic test

Sid & Marty Krofft, 562 F.2d 1157.

facsimile

T: An applicant for federal trademark registration must submit “such number of specimens or facsimiles of the mark as used as may be required by the Commissioner.” 15 USC 1051(a)(1)(C). Facsimiles are submitted when actual SPECIMENS would be too bulky or when they have intrinsic value or cannot practically be furnished. TMEP 808.08. “When, due to the mode of applying or affixing the trademark to the goods, or to the manner of using the mark on the goods, or to the nature of the mark, specimens ... cannot be furnished, three copies of a suitable photograph or other acceptable reproduction ... shall be furnished. 37 CFR 2.57(a). “In the case of service marks not used in printed or written form, three audio cassette tape recordings will be accepted.” 37 CFR 2.58(b).

failure of others

P: “An accused infringer’s failed attempt to design a product the patented invention makes possible is evidence suggesting nonobviousness.” *Intel Corp. v. U.S. Int’l. Trade Comm’n.*, 946 F.2d 821, 20 USPQ 2d 1161 (Fed. Cir. 1991). See SECONDARY CONSIDERATIONS.

failure to disclaim

P: Prior to the enactment of 35 USC 253 and 258, failing to disclaim invalid claims in a patent rendered its valid claims unenforceable. *Allen Archery, Inc. v. Browning Manufacturing Co.*, 819 F.2d 1087, 2 USPQ 2d 1490 (Fed. Cir. 1987). See DISCLAIMER. *** QUOTE STATUTE ***

fair use

C: The “fair use of a copyrighted work ... for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or

research, is not an infringement of copyright.” 17 USC 107. The following factors are weighed in determining whether a given use is fair:

“(1) the PURPOSE AND CHARACTER of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
 (2) the NATURE OF THE COPYRIGHTED WORK;
 (3) the AMOUNT AND SUBSTANTIALITY of the portion used in relation to the copyrighted work as a whole; and
 (4) the effect of the use upon the potential MARKET for or value of the copyrighted work.” 17 USC 107.

“[E]very commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright.” *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 US 539, 560, 25 USPQ 2d 1073 (1985). Whether a use is fair is a MIXED QUESTION of law and fact. *Harper & Row*, 471 US at 562. Showing that copying is justified as a fair use is the burden of the defendant. 792 F.Supp. 132.***

See also COMMERCIAL MARKETING OR USE, FUNCTIONAL EQUIVALENTS TEST, PROPORTIONALITY, SCIENTIFIC USE, SUBSTANTIALITY.

T: It is a defense to trademark infringement that “the use of the name, term or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.” 15 USC 1115(b)(4).

fall

P: A patent or claim of a patent is said to “fall” if it is rejected after appeal. 37 CFR 1.193(c)(5). *Cf.* STAND.

false advertising

U: False advertising is unfair competition under Section 43(a) of the Lanham Act. [McC 27.01]

false association

A Lanham Act 43(a) claim.

false declaration

T: Procuring a registration by a “false or fraudulent declaration or representation” gives rise to a civil action by “any person injured thereby.” 15 USC 1120. Also FRAUDULENT DECLARATION.

false designation of origin

T: “Any person who shall affix, apply, or annex, or use in connection with any goods or services, any container or containers for goods, a false designation of origin, or any false description or representation including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable in a civil action by any person doing business in the locality falsely indicated as

that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.” 15 USC 1125(a). The test is whether the public is likely to be deceived by the similarity of the “marks” of origin displayed in the product, such that there is a likelihood of confusion as to the source of the product. *Frances Denney, Inc. v. New Process Co.*, 670 F.Supp. 661 (W.D. Va. 1985), *aff’d*, 228 USPQ 360 (4th Cir. 1986).

false endorsement

False endorsement is cognizable as a Lanham Act 43(a) claim. *Wails v. Frito-Lay, Inc.*, 978 F.2d 1093, 23 USPQ 2d 1721 (9th Cir. 1992).

false marking

P: “Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words “patent, “patentee” or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee ***.” 35 USC 292. The preceding also applies to use of “patent pending” or “patent applied for” when no application has been made.

C: Fraudulent use of copyright notice. 17 USC 506(c).

T: Improper use of notice

Misbranding.

false suggestion of connection

T: A mark that may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, may be refused registration, either on the Principal or the Supplemental Register. 15 USC 1052(a), 1091(a).

false teaching

P: A materially misleading error in a specification. False teaching is grounds for invalidating a patent under 35 USC 112. However, if one skilled in the art would not be misled, that patent will not be voided. *Pentech Int’l. v. Hayduchok*, 18 USPQ 2d 1337 (S.D.N.Y. 1990).

familiar

C: “Familiar symbols and designs” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a). MASK WORKS that are “familiar in the semiconductor industry” are not eligible for mask work protection. 17 USC 902(b)(2).

family of marks

T: A collection of marks having a distinctive common feature may constitute a family of marks if, through extensive use and promotion of the marks, the relevant public has come to identify the source by the common feature. *Reynolds and Reynolds Co. v. I. E. Systems, Inc.*, 5 USPQ 2d 1749 (TTAB 1987), *aff’d*. No. 88-1372 (Fed. Cir., Oct. 20, 1988). Mere ownership of a number of marks having a common feature does not by itself suffice to create a family.

famous mark

T: “[F]amous or strong marks enjoy a wide latitude of legal protection.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ 2d 1453 (Fed. Cir. ***), *cert. denied* *** (1992). “The fame of a mark cuts both ways with respect to likelihood of confusion. The better known it is, the more readily the public becomes aware of even a small difference.” *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 6 USPQ 2d 1712 (Fed. Cir. 1988).

fanciful mark

T: A mark is “fanciful” if it “bears no relationship to the product with which it is associated.” 16 USPQ 2d 1613. Usually applied to words invented solely for their use as trademarks. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1980). See also ARBITRARY MARK, COINED MARK.

feature

T: feature of mark. Color must be stated if a feature. ***

February 28

In computing times for filing a notice of appeal from the Board “one day shall be added to any two-month period which includes February 28.” 37 CFR 1.304(b): feature of mark.

Federal Agency

P: With respect to federally funded inventions, “Federal agency” means “any executive agency as defined in section 105 of Title 5, United States Code, and the military departments as defined by section 102 of title 5, United States Code.” 35 USC 201(a). An “executive department, military department, government corporation, or independent establishment, except the Tennessee Valley Authority, which has custody of a federally owned invention.” 37 CFR 404.3(b).

Federal Circuit

P,T: See COURT OF APPEALS FOR THE FEDERAL CIRCUIT.

Federal Communications Commission

C: A nonsimultaneous transmission by a cable system located in Hawaii is a secondary transmission if carriage of the transmission is authorized by the Federal Communications Commission. 17 USC 111(f).

Federal Food, Drug, and Cosmetic Act

P: 35 USC 156. See also VETERINARY BIOLOGICAL PRODUCT.

Federal Holiday

P, T: If the time for taking an action in the PTO falls on a Federal holiday “within the District of Columbia, the action will be considered timely taken if it is performed on the next succeeding day that is not a Saturday, Sunday or Federal holiday. 27 CFR 1.7. Below is a list of Federal holidays and the days on which they fall.

New Year’s Day	Jan. 1	Labor Day	1st Mon. in Sep.
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Inauguration Day	Jan 20th each 4th year after 1965	Columbus Day	2nd Mon. in Oct.
President's Day	3rd Mon. in Feb.	Veterans' Day	Nov. 11
Memorial Day	last Mon. in May	Thanksgiving Day	4th Thurs. in Nov.
Independence Day	July 4	Christmas Day	Dec. 25

A list of holidays can be found at 5 USC 6103.

Federal pre-emption

See PRE-EMPTION.

Federal records center

C: "In the case of unpublished works, the Library is entitled ... to select any deposits ... for transfer to the National Archives of the United States or to a Federal records center, as defined in section 2901 of title 44." 17 USC 704(b).

Federal Register

P: Fees prescribed by the Commissioner of Patents and Trademarks do not take effect until 60 days after notice in the Federal Register. 35 USC 41(g).

federal registration

T: A trademark registration granted by the PTO. *Cf.* STATE REGISTRATION.

Federal Rules of Civil Procedure

C: The Federal Rules are only applicable in copyright cases to the extent provided by the Supreme Court.

T: The Federal Rules apply to INTER PARTES proceedings in the TTAB.

Federal Technology Transfer Act

An act, 15 USC 3710(d), requiring a government agency to allow the inventor to retain title to any covered invention when the agency does not intend to file a patent application or otherwise promote commercialization. See also GOVERNMENT EMPLOYEE.

Federal Trade Commission

T: The FTC may apply (without paying a fee) to cancel a trademark registered on the principal register on substantially the same grounds that a party having standing may bring a PETITION TO CANCEL. 15 USC 1064(5).

U: FTC Guides. Celebrity Endorsement

federally owned invention

P: An "invention, plant, or design which is covered by a patent, or patent application in the United States, or a patent, patent application, plant variety protection, or other form of protection, in a foreign country, title to which has been assigned to or otherwise vested in the United States Government." 37 CFR 404.3(a). The Secretary of Commerce may "promulgate regulations specifying the terms and conditions upon which any federally owned inventions" may be licensed (except those of the Tennessee

Valley Authority). 35 USC 208. “Federally owned inventions shall be made available for licensing as deemed appropriate in the public interest. FEDERAL AGENCIES having custody of federally owned inventions may grant nonexclusive, partially exclusive or exclusive licenses thereto.” 37 CFR 404.4. *Cf.* GOVERNMENT-OWNED INVENTION.

fee address

An address to which correspondence relating to maintenance fees will be addressed, usually specified by the patentee at issuance. 37 CFR 1.363. *Cf.* CORRESPONDENCE ADDRESS.

feel

See LOOK AND FEEL.

fees

P: Fees for filing patent applications are set forth at 35 USC 41. Fees may be adjusted by the Commissioner based on the Consumer Price Index. 35 USC 41(f). See also BASIC FEE, DESIGNATION FEE, INTERNATIONAL FEE, SEARCH FEE, SURCHARGE, TRANSMITTAL FEE.

C: Copyright Office fees are provided in 17 USC 708(a).

T: “The Commissioner will establish fees for the filing and processing of an application for the registration of a trademark or other mark and for all other services performed by and materials furnished by the Patent and Trademark Office ...” 15 USC 1113. Fees for application, assignment and renewal may not be adjusted more often than once every three years. 15 USC 1113. “The Commissioner may waive the payment of any fee for any service or material ... in connection with an occasional request made by a department or agency of the Government ..” 15 USC 1113. See also INDIAN ARTS AND CRAFTS BOARD.

fiction

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i).

fictionalization

C: A fictionalization may constitute a DERIVATIVE WORK. 17 USC 101.

fictitious name

C: See PSEUDONYMOUS WORK.

T: A trade name that is not the legal name of the entity doing business. In many states, fictitious names must be registered with state authorities.

field of search

P:

For RELATED INVENTIONS, the fact that both lie in different fields of search is a basis for RESTRICTION. MPEP 808.02.

file

1. In general, to deposit a writing with an administrative agency.

P:

file history

P:

file history estoppel

An obsolete term for PROSECUTION HISTORY ESTOPPEL.

file wrapper

P: The PTO file containing all of the papers relating to the prosecution of a patent application.

T: The PTO file containing all of the papers relating to the prosecution of a patent application. TMEP 710. In the event a judgment is entered in any action, suit or proceeding involving a registered mark, the Commissioner must endorse the same on the file wrapper of said registration. 15 USC 1115(c).

file wrapper continuation

P: "A continuation, continuation-in-part or division which uses the specification, drawings and oath from a prior complete application." 37 CFR 1.62. Filing a file wrapper continuation constitutes an express abandonment of the application on which it is based. 37 CFR 1.62(g). Abbreviated FWC. See also WAIVER OF SECRECY.

file wrapper estoppel

P: The principle that a patentee cannot RECAPTURE claims SURRENDERED by AMENDMENT during prosecution. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 US 126 (1942). Now known as PROSECUTION HISTORY ESTOPPEL.

filing date

P: The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office." 35 USC 111. The oath and filing fee may be submitted later. 37 CFR 1.53. "In the case of a patent, "filing date" means the filing date assigned to the application which issued as the patent." 37 CFR 1.601(h). See EFFECTIVE FILING DATE. See also INTERNATIONAL FILING DATE.

:16 USPQ 2d 1451

C: See EFFECTIVE DATE OF REGISTRATION. The concept of a filing date is not applicable to copyright applications.

T: The following elements must be present for an application to receive a filing date:

- (1) name of applicant;
- (2) name and address for communications;
- (3) drawing;
- (4) identification of goods;
- (5) basis for filing;
- (6) verification or declaration;
- (7) filing fee for at least one class.

The filing date accorded is the date on which the last of these elements is filed. 37 CFR 2.21(a). A filing date erroneously accorded by the PTO may be "vacated." TMEP 708.01. See also CANCELLATION.

filing fee

See FEE.

filing receipt

P: 37 CFR 1.54(b). Filing receipt contains license for foreign filing.

T: TMEP 705.01.

final

P, T: Said of a REFUSAL or REJECTION that brings prosecution to an end if no response is filed. See also AFTER FINAL.

final action

P: See also AFTER FINAL.

T: See FINAL REFUSAL.

final decision

P: (Interference) “After final hearing, the Board shall enter a decision resolving the issues raised at final hearing ... A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims which correspond to the count. When the Board enters a decision awarding judgment as to all counts, the decision shall be regarded as a final decision.” 37 CFR 1.658(a). “After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 USC 141) or other review (35 USC 146) has been or can be taken or had.” 37 CFR 1.661.

T: “An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks ...” 15 USC 1070.

final hearing

P: (Interference) “At an appropriate stage of the interference, the parties will be given an opportunity to appear before the Board to present oral argument at a final hearing.” 37 CFR 1.654. See also FINAL DECISION.

final product

P: See INTERMEDIATE.

final refusal

T: “On the first or any subsequent reexamination or reconsideration, the refusal of the or the insistence upon a requirement may be stated to be final, whereupon applicant’s response is limited to an appeal or to a compliance with any requirement, or to a petition to the Commissioner if permitted ... “ 37 CFR 2.64(a). Any action after the first may be a final refusal. TMEP 1105.04(a). See REQUEST FOR RECONSIDERATION.

*** After final refusal an amendment may be entered to place the application in condition for publication or issue or to put the application in better form for appeal. ***. A request for reconsideration is not proper. TMEP 1110.

final rejection

P: On the second or any subsequent examination or consideration, rejection may be made final. 37 CFR 1.113(a). After a final rejection, the applicant may (1) appeal to the Board of Patent Appeals and Interferences. 37 CFR 1.191; or (2) amend the application to cancel claims, comply with matters of form, or present rejected claims in better form for appeal. 37 CFR 1.116.

finality

T: The status, with respect to an office action, of having been made final, which limits the applicant’s possible responses and brings prosecution to an end in the absence of a proper response. TMEP 1105.04(n).

fine art

C: Fine art falls in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

fine art multiple

C: Any “fine print, photograph (positive or negative), sculpture cast, collage or similar art object produce in more than one copy.” *** CA Artist’s Law.

fine print

C: An “impression produced by a printing method in more than one copy from an image or design created by an artist and includes impressions produced by or from such printing methods as engraving, etching, woodcutting, lithography, serigraphy and similar printing methods.” *** NY Artist’s Law.

fingerprint claim

P: A type of CLAIM, permitted in chemical cases, in which a substance is defined by its properties, such as its infrared absorption spectrum, when its structure is unknown. *Benger Labs, Ltd. v. R. K. Laros Co.* 135 USPQ 11.

firm

T: A proprietorship, partnership or joint venture. In general, a business organization other than a corporation. TMEP 802.01. However, the term has no generally accepted meaning. TMEP 802.03(b).

first North American serial rights

C: The right to be the first magazine to publish a work in North America.

first serial rights

C: Usually, a short form for FIRST NORTH AMERICAN SERIAL RIGHTS.

first sale doctrine

C: The principle that once a copyright owner has parted with title to a copy of a work, it is not an infringement of the exclusive right of distribution for a subsequent legal owner of the copy to transfer it. The doctrine applies only to lawfully made copies. 599 F.Supp. 241. *U.S. v. Gallo.* *** 17 USC 109.

first to conceive

P:

five-year case

P: “Any case that has been pending five years should be carefully studied by the supervisory primary examiner and every effort made to terminate its prosecution. In order to accomplish this result, the case is to be considered ‘special’ by the examiner.” MPEP 707.02(a).

T: An application that has been pending for five years or more and hence is treated as SPECIAL. TMEP 1106.05.

fixed

C: A “work is fixed in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced or otherwise communicated for a period

of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is ‘fixed’ for purposes of this title if a fixation of the work is being made simultaneously with its transmission.” 17 USC 101.

A MASK WORK is fixed in a SEMICONDUCTOR CHIP PRODUCT when its embodiment in the product is sufficiently permanent or stable to permit the mask work to be perceived or reproduced from the product for a period of more than transitory duration.” 17 USC 901(a)(2).

fixation

C: The requirement that a work be “fixed” to constitute copyrightable subject matter. 17 USC 102(a).

f.k.a

Abbreviation for “formerly known as,” to designate that an entity previously did business under a different name.

flag

T: A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises the flag of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 USC 1052(b), 1091(a).

flash of creative genius

P: An obsolete standard of invention requiring inspiration as a prerequisite of patentability. *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 US 84. *** “Patentability shall not be negated by the manner in which the invention was made.” 35 USC 103. [Walker 6:4].

flow diagram

P: A flow diagram is not permitted in the specification, but must be placed in a drawing. 37 CFR 1.58(a).

folder

C: See SINGLE-LEAF WORK.

food additive

P: 35 USC 156(d)(2)(A)(ii). See PATENT TERM EXTENSION.

foreign applicant

T: “A person whose country of origin is a foreign country which is a party to any convention or treaty relating to trademarks to which the United States is also a party, or which extends reciprocal rights to nationals of the United States by law.” TMEP 202.04(b). Cf. DOMESTIC APPLICANT.

foreign application

P: A patent application made in one of the countries that affords earlier filing date privileges to U.S. applicants. The Commissioner may require a translation of the foreign application. 35 USC 119.

foreign commerce

T: The only type of foreign commerce that may lawfully regulated by Congress is that between the United States and a foreign country. Commerce between foreign countries does not qualify. TMEP 806.05(a).

foreign country

A country other than the United States.

P: An applicant is not entitled to a patent if the invention was “patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” 35 USC 102(a). A patent is also barred if “the invention was patented or described in a printed publication in this or a foreign country ... more than one year prior to the date of application for patent in the United States.” 35 USC 102(b). See BAR.

Testimony in an INTERFERENCE may be taken in a foreign country when authorized by an examiner-in-chief. 37 CFR 1.684.

T: In a civil action appealing from a decision of the TTAB, “summons against adverse parties residing in foreign countries may be served by publication.” “If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction.” 15 USC 1071(b)(4).

foreign equivalent

T: See DOCTRINE OF FOREIGN EQUIVALENTS.

foreign filing

P: The filing of a patent application in a foreign country for an invention made in the United States. Unless a license has been obtained by the Commissioner, no person “shall cause or authorize to be filed in any foreign country prior to six months after filing in the United States any application for a patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country.” 35 USC 184. The purpose of requiring a license is to give the PTO an opportunity to determine whether the application should be subject to a SECRECY ORDER. The consequence of failure to procure a license is loss of U.S. patent rights. 35 USC 185.

*** Expedited handling for foreign filing licenses. 37 CFR 5.12, 5.13, 5.14.

foreign intelligence

P: A non-profit organization or small business firm making an invention under a funding agreement with the Government may not retain title to the invention if a Government Agency authorized to conduct foreign intelligence or counter-intelligence determines that elimination of the right to retain title is necessary to protect the security of such activities. 35 USC 202.

foreign language

P: A specification may be in a foreign language provided that an English translation is ***. The oath must be in a foreign language if the individual making it cannot understand English. See OATH.

foreign nation

T: A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 USC 1052(b), 1091(a).

foreign patent

P: The Commissioner may exchange printed copies of U.S. patents for those of foreign countries. 35 USC 12.

foreign priority

P: 37 CFR 1.55.

T: A foreigner who is ultimately entitled to registration in the United States in view of a foreign registration will be accorded priority as to his or her U.S. filing date. The effective filing date will be the date of filing in the foreign country if filing in the U.S. is within six months of filing in a treaty country. TMEP 1003.

foreword

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101.

forfeiture

C: 1. Forfeiture occurs when the copyright owner fails to affix the copyright notice to published copies of the work. *Lopez v. Electrical Rebuilders, Inc.*, 416 F.Supp. 1133, 195 USPQ 398 (S.D. Cal. 1976). Cf. ABANDONMENT.

2. A penalty imposed upon conviction for trafficking in COUNTERFEIT LABELS. 18 USC 2318(d). See also DESTRUCTION.

forgotten art

P: [Walker 4:15].

form

C: A blank used to apply for copyright registration. Forms may be obtained free from the Public Information Office, United States Copyright Office, Library of Congress, Washington, DC 20559.

Form CA correction of registrations

Form GR/CP group registrations

Form PA audiovisual works

Form RE renewal application

Form SR sound recordings

Form TX non-dramatic literary works

Form VA pictorial, graphic and sculptural works

See also FORMS.

form affidavit

T: [McC 15.24]

form, fit and function data

C: “Data relating to items, components or processes that are sufficient to enable physical and functional interchangeability, as well as data identifying source, size, configuration, mating, and attachment characteristics, functional characteristics and

performance requirements; except that for computer software it means data identifying source, functional characteristics, and performance requirements but specifically excludes the source code, algorithm, process, formulae, and flow charts of the software. 48 CFR 52.227-14(a).

formal abandonment

P: = EXPRESS ABANDONMENT. MPEP 711.01

T: = EXPRESS ABANDONMENT. TMEP 1112.01

formal claim

P: A claim in a predetermined format that must be presented without variation. Design and plant patents require and permit only a single formal claim.

formal drawing

P: A drawing that complies with ***. *Cf.* INFORMAL DRAWING.

formal rejection

P: A rejection based on failure to conform to administrative requirements rather than on substantive grounds (prior art). A formal rejection may be issued for claims in improper form, NEW MATTER and PROLIXITY, among others. Also NON-ART REJECTION.

forms

C: BLANK FORMS are not copyrightable. “Blank forms, such as time cards, graph paper, account books, diaries, bank checks, scorecards, address books, report forms, order forms and the like, which are designed for recording information and do not in themselves convey information” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

formula

P: Mathematical formulas are not patentable.

Chemical and mathematical formulas may appear in a specification, but they must be suitable for camera reproduction. 37 CFR 1.58.

S: A formula for a chemical compound may constitute a trade secret. Restatement of Torts 757, UTSA 1(4).

fragmented literal similarity

C: A concept from Nimmer §13.03. Partially identical or nearly identical copying *Cf.* COMPREHENSIVE NON-LITERAL SIMILARITY.

fragrance mark

T: = SCENT MARK.

franchise

U: [McC 31.33[5]]

fraud

P: Fraud on the Patent Office is grounds for invalidating any patent that may issue thereby. Fraud must always be shown by CLEAR AND CONVINCING EVIDENCE. “[T]he party asserting the fraud must prove the specific intent to mislead the Office or at least

gross negligence; inadvertent nondisclosures will not suffice.” *Pentech Int’l. v. Hayduchok*, 18 USPQ 2d 1337 (S.D.N.Y. 1990). See also FRAUDULENT PROCUREMENT.

An invention fraudulently claimed to perform a function will be rejected as not having utility. MPEP 706.03(p).

T: “Willful withholding from the ... Office by an applicant or registrant of material information or facts which, if transmitted and disclosed to the Examiner, would result in the disallowance of the registration sought.” 176 USPQ 280, *aff’d*. 181 USPQ 169.

fraudulent declaration

T: Procuring a registration by a “false or fraudulent declaration or representation” gives rise to a civil action by “any person injured thereby.” 15 USC 1120. Also FALSE DECLARATION.

fraudulent procurement

P: Obtaining a patent by misleading the PTO. ** Failing to comply with duty of disclosure, failing to reveal prior art, concealing best mode. Must be material.*** A fraudulently procured patent is unenforceable. *Driscoll v. Cebalo*, 731 F.2d 878. See also FRAUD, INEQUITABLE CONDUCT.

T: It is a defense to TRADEMARK INFRINGEMENT “[t]hat the registration or incontestable right to use the mark was obtained fraudulently.” 15 USC 1115(b)(1). Procuring a registration by a “false or fraudulent declaration or representation” gives rise to a civil action by “any person injured thereby.” 15 USC 1120.

Freedom of Information Act

Abbreviated FOIA. **stat ref*** Plans for commercialization of federally funded inventions are not subject to this act. 37 CFR 404.14.

Freedom of Information Request

A request for records not disclosed to the public as part of the regular informational activity of the PTO. 37 CFR 1.15(a).

Freedom of Information Request Control Desk

Address in the PTO for Freedom of Information Requests.

frivolous

P: Not having a useful purpose. A rejection based on frivolousness can be traversed by affidavit. 37 CFR 1.132. See also UTILITY.

front page

C: For a work published in BOOK FORM, with a hard or soft cover, the front page is the outside of the front cover; where there is no cover, the front page is the page visible at the front of the copy before it is opened. 37 CFR 201.20(b)(7). See PAGE. Cf BACK PAGE.

full faith and credit

P: “When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner, unless there is a clear error in the previous action or knowledge of the prior art.” MPEP 704.

full search

T: A trademark search that encompasses state registrations, common-law marks, telephone listings and trade names, in addition to federal registrations and applications for registration. 1900 Bacal 1.15.

full term retention

C: See RETENTION.

fully met

P: A claim that is anticipated, that is, found in a single reference is said to be “fully met.”

function/way/result

P: A test used in applying the DOCTRINE OF EQUIVALENTS to determine whether equivalents of elements of a claim read on an accused device. The determination is to be made whether the accused device or method “performs substantially the same function in substantially the same way to obtain the result.” *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 US 605, 85 USPQ 328, 330 (1950). The latter clause was expanded to cover “the same or substantially the same result” in *Perkin-Elmer v. Computervision*, 732 F.2d 888, 221 USPQ 669, 678 (Fed. Cir. 1984).

functional

P: 1. A claim is rejected as functional if it recites only function without means of carrying out the function or if it “recites only a single means and this encompasses all possible means for performing a desired function.” MPEP 706.03(c).

2. A functional claim element is an element that is described in terms of what it does, not by its structure. *Halliburton Oil Well Cementing Co. v. Walker*, 329 US 1, 9, 71 USPQ 175 (1946). [See also Walker 11:14].

3. If a patented design is primarily functional rather than primarily ornamental, the patent is invalid. *Avia Group Int’l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1563, 7USPQ 2d 1548 (Fed. Cir. 1988). Functionality must be demonstrated by clear and convincing evidence. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123, 25 USPQ 2d 1913 (Fed. Cir. 1993), *cert denied*, 114 S.Ct. 291 (1993).

T: A trademark is functional if it “constitute[s] the actual benefit that the consumer wished to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product.” *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 197, 208 USPQ 718 (9th Cir. 1980, *cert denied*, 452 US 941 (9181)). A particular feature of a product is “functional” if it is substantially related to its value as a product, i.e., if the feature is part of the function served, or whether the primary value of a particular feature is the identification of the provider. *United States Golf Ass’n. v. St. Andrews Systems*, 749 F.2d 1028, 224 USPQ 646 (3rd Cir. 1984). The feature is functional if it has a “significant relation to the utilitarian function of the product.” *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1 USPQ 2d 1001 (3rd Cir. 1986). A feature is functional if is essential to the use or purpose of the article or if it affects the cost or quality of the article. *Ferrari*, 944 F.2d 1235. A mark that performs a useful function in relation to a product is not registrable since registration would prevent others in the trade from performing the same function, and in essence grant a design patent of indefinite duration.

Functionality is a QUESTION OF FACT.

Restatement definition. Ives definition (Justice O'Connor).

A particular trade dress is functional if “it is something that other producers of the product in question would have to have as part of the product in order to compete effectively in the market.” *Abbot Laboratories v. Mead Johnson & Co.*, 971 F.2d 6, 20, 23 USPQ 2d 1663 (7th Cir. 1992).

See also AESTHETIC FUNCTIONALITY, DE FACTO FUNCTIONAL, DE JURE FUNCTIONAL, UTILITARIAN FUNCTIONALITY. Cf. UTILITARIAN.

functional equivalents test

C: A test to determine whether a that makes use of a copyrighted work is a FAIR USE. It requires comparison of the works to determine whether the copy performs the same function as the original. *Metro-Goldwyn Mayer, Inc. v. Showcase Atlanta Cooperative Productions, Inc.*, 479 F.Supp. 351 (N.D. Ga. 1979).

functional limitation

P: A limitation on an element of a claim drawn to the function performed by that element, e.g. “a transformer for isolating the circuit from the power source.” A risk in using functional statements is that they may tell only what the function is and omit how it can be achieved, resulting in a rejection. Typical functional limitations begin with the words “for,” “to” or “whereby.”

A functional limitation does not distinguish over the PRIOR ART. *Clements Ind. Inc. v. A. Meyers & Sons Corp.*, 712 F.Supp. 317, 12 USPQ 2d 1874 (S.D.N.Y. 1989).

funding agreement

P: With respect to federally funded inventions, “funding agreement” means “any contract, grant, or cooperative agreement entered into between any Federal agency other than the Tennessee Valley Authority, and any contractor for the performance of experimental, developmental, or research work funded in whole or in part by the Federal Government. Such term includes any assignment, substitution of parties, or subcontract of any type entered into for the performance of experimental, developmental, or research work under a funding agreement as herein defined.” 35 USC 201(b), 37 CFR 401.2(a).

FWC

= FILE WRAPPER CONTINUATION. 37 CFR 1.62.

Gazette

See OFFICIAL GAZETTE.

general nature of the invention

P: 35 USC 184 (license for foreign filing).

generally receivable

C: An “FM radio signal is ‘generally receivable’ if: (i) it is usually carried by the system whenever it is received at the system’s HEADEND, and (ii) as a result of monitoring at reasonable times and intervals, it can be expected to be received at the system’s headend, with the system’s FM antenna, at least three consecutive hours each day at the same time each day, five or more days a week, for four or more weeks during

any calendar quarter, with a strength of not less than fifty microvolts per meter measured at the foot of the tower or pole to which the antenna is attached.” 37 CFR 201.17(4).

generic

P: See GENERIC CLAIM, GENUS. Cf. SPECIES.

T: Identifying a genus or class of things or services. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 217 USPQ 988 (5th Cir. 1983). Generic terms are never eligible for trademark protection. *Union Nat’l. Bank, Laredo v. Union Nat’l. Bank, Austin*, 16 USPQ 2d 1129 (5th Cir. 1990). “A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.” 15 USC 1064(3)

Generic Animal Drug and Patent Restoration Act

P: 35 USC 156(f)(8)

generic claim

P: A claim that includes “two or more embodiments within the scope of definition.” MPEP 806.04(e). Also called a GENUS CLAIM. “A generic claim cannot include limitations not present in each of the added SPECIES CLAIMS.” MPEP 806.04(d). “Generic claims covering two or more species which are separately claimed in two or more patents to the same inventive entity, a common inventor, and/or common assignee issued on copending applications must all be present in single one of the patents.” MPEP 806.04(j). [SEE ALSO Walker 4:8].

generic adjective

T: [McC 12.02[j]]

genus

P: class including more than one embodiment. Cf. SPECIES.

T:

genus claim

P: = GENERIC CLAIM.

geographic origin

T: It is a defense to trademark infringement that “the use of the name, term or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.” 15 USC 1115(b)(4).

geographic restriction

U: A contractual limitation preventing competition in a particular geographic area.

geographical name

T: A mark on the Supplemental Register may consist of a “geographical name.” 15 USC 1091(c).

geographically descriptive

T: Said of a trademark, describing a geographical location. See also GEOGRAPHIC ORIGIN, PRIMARILY GEOGRAPHICALLY DESCRIPTIVE.

get back, get behind

P:

globe

C: A globe falls in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS, but cannot be a WORK OF VISUAL ART. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

good and sufficient cause

P: Standard for granting suspension. 37 CFR 1.103(a). *Cf.* GOOD CAUSE.

T: Standard for suspending action on an application. 37 CFR 2.67. *Cf.* GOOD CAUSE.

good and sufficient reason

P: Amendments after final may be admitted “upon a showing of good and sufficient reason why they are necessary and were not earlier presented.” 37 CFR 1.116(b). Petition for withdrawal from issue after allowance. 37 CFR 1.313(a). See WITHDRAWAL.

DEFERRAL. 37 CFR 1.314(b).

T: “Action by the Patent and Trademark Office ...” 37 CFR 2.67. See also SUSPENSION.

good cause

P: “Good cause“ must be shown for the Commissioner to extend the time for filing an appeal to the Board. 37 CFR 1.304(n).

“Unless good cause is shown, an INTERFERENCE shall not be declared or continued between (1) applications owned by a single party or (2) applications and an unexpired patent owned by a single party.” 37 CFR 1.602(a). See also INTERFERENCE SETTLEMENT AGREEMENT.

T: Extension of time to file statement of use beyond twelfth month. 15 USC 1051(d)(2).

Schedule hearing on SEIZURE ORDER sooner than ten or later than fifteen days after it is issued. 15 USC 1116(d)(10)(A).

good faith

P: See DUTY OF CANDOR. 35 USC 287(b). See 35 USC 271, process patents.

Conduct of attorneys, specification, best mode. [Walker 10:20].

C: In a STATEMENT OF ACCOUNT, a declaration is required “of the veracity of the statements of fact ... and the GOOD FAITH of the person signing in making such statement of fact.” 37 CFR 201.17(e)(14)(iii)(E).

See also INNOCENT PURCHASER.

T: “Good faith“ is required for:

1(b) application under 15 USC 1051(b). “under circumstances showing the good faith of such person.”

It is a defense to trademark infringement that “the use of the name, term or device charged to be an infringement is a use, otherwise than as a mark, ... which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.” 15 USC 1115(b)(4).

Issuance of a CERTIFICATE OF CORRECTION. 15 USC 1057(h).

good moral character

P, T: Agents, attorneys and other persons representing applicants before the PTO must be show that they are of “good moral character.” 35 USC 31.

goods, wares and merchandise

S: The National Stolen Property Act prohibits the transportation in interstate or foreign commerce of “goods, wares or merchandise,” known to have been stolen. This definition includes trade secrets. *U.S. v. Seagraves*, 265 F.2d 876 However, tangible articles must be involved. *U.S. v. Bottone*, 365 F2 389, *cert denied*, 385 US 974.

goodwill

T:

Government agency

P: Any “Executive department or independent establishment of the Executive branch of the Government (including any independent regulatory commission or board, any corporation wholly owned by the United States, and the Smithsonian Institution) but does not include the Department of Energy for inventions made or conceived under the provisions of 42 USC 2182. 37 CFR 501.3(b).

Government application

P: A patent application that has become the property of the United States Government. The Commissioner may extend for up to three years the time within which any action must be taken by the Government in such an application if the head of the department concerned certifies that the invention is “important to the armament or defense of the United States.” 35 USC 267.

Government contacts principle

P: The doctrine that the personal jurisdiction of the courts of the District of Columbia may not be exercised over non-resident parties who enter the District for the sole purpose of contacting federal government agencies. *Lex Tex Ltd. Inc. v. Skillman*, 16 USPQ 2d 1137 (D.C. App. 1990).

Government employee

P: Any “officer or employee, civilian or military, of any Government agency, including any part-time consultant or part-time employee except as may otherwise be provided for by agency regulation approved by the [Under] Secretary [of Commerce for Economic Affairs].” 37 CFR 501.3(c).

“The Government shall obtain ... the entire domestic right, title and interest in and to any invention made by a Government employee:

(i) During working hours, or

(ii) With a contribution by the Government of facilities, equipment, material, funds or information, or of time or services of other Government employees on official duty, or (iii) Which bears a direct relation to or is made in consequence of the official duties of the inventor.” 37 CFR 501.6(a)(1). If it is inequitable to require assignment to the Government of the entire right, title and interest, “the Government agency concerned shall leave title to such invention in the employee, subject however, to the reservation to the Government of a nonexclusive, irrevocable, royalty-free license in the invention with the power to grant licenses for all governmental purposes, such reservation, where practicable, in any patent, domestic or foreign, which may issue on such invention.” 37 CFR 501.6(a)(2). If the Government neither obtains entire right nor reserves a nonexclusive license, “the Government shall leave the entire right ... in and to the invention in the Government employee, subject to law. 37 CFR 501.6(b)(4). See also FEDERAL TECHNOLOGY TRANSFER ACT.

Government-owned invention

P: The Secretary of Commerce is authorized to “assist Federal agency efforts to promote the licensing of Government-owned inventions.” 35 USC 207(b)(1). *Cf.* FEDERALLY-OWNED INVENTION.

grace period

P: A grace period of six months is allowed for payment of a patent maintenance fee. 35 USC 41(b). After the grace period has expired, the Commissioner may still accept the fee on a showing of unavoidable delay. 35 USC 41(c). The rights of one who makes, uses or sells a patented invention after the grace period for the payment of a maintenance fee has expired but before the acceptance of the maintenance fee by the PTO may continue to do so with restrictions. 35 USC 41(c)(2).

Grace period for one-year statutory bars 102(b)

C: Statutory damages and attorney’s fees are allowed, even after infringement has commenced, if registration of copyright is made within a grace period of three months after first publication. 17 USC 412(2).

grade designation

T: A mark indicating the quality or other characteristic of a product and used to distinguish among different goods of the same producer. Normally grade designations are not registrable.

grade mark

T: = GRADE DESIGNATION. A mark that designates a particular grade or other property of a product. 1990 Bacal 1.3. A grade mark is not registrable if its only function is to differentiate goods from the same source. *Cf.* STYLE MARK.

grant

P: Grants are recordable. 37 CFR 1.331(a).

grant-back

P:

graph paper

C: Graph paper, to the extent it is for recording rather than conveying information, is “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

graphic art

C: Graphic art falls in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

graphic work

C: 17 USC 102(a).

gray market

T: The distribution of genuine goods by unauthorized distributors, usually in violation of a territorial restriction.

greeting card

C: The year date may be omitted from the copyright notice on a pictorial, graphic or sculptural work as reproduced on a greeting card. 17 USC 401(b)(2). Greeting cards exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(2).

gross misconduct

A person, agent or representative who is shown to be “incompetent, disreputable, or guilty of gross misconduct” may be suspended or excluded from practice before the PTO. 35 USC 32.

gross negligence

P: “No patent will be granted on an application in connection with which fraud on the Patent Office was practiced or attempted or the duty of disclosure was violated through bad faith or gross negligence.” 37 CFR 1.56(d). Gross negligence does not mandate a finding of inequitable conduct. *Dana Corp. v. IPC Limited Partnership*, 15 USPQ 2d 1658.

C: Grossly negligent destruction of a WORK OF VISUAL ART violates the rights of the author of the work. 17 USC 106A.

gross receipts

C: “Gross receipts for the ‘basic service of providing secondary transmissions of primary broadcast transmitters’ include the full amount of monthly (or other periodic) service fees for any and all services or tiers of services which include one or more secondary transmissions of television or radio broadcast signals, for additional set fees, and for converter fees ... Gross receipts for secondary transmission services do not include installation (including connection, relocation, disconnection or reconnection) fees, alarm or facsimile services, charges for late payments, or charges for pay cable or other program origination services: provided that the origination services are not offered in combination with secondary transmission services for a single fee.” 37 CFR 201.17(b)(1).

ground for rejection

P:

group

- P: 1. A set of claims that logically comprise a single invention. See RESTRICTION.
2. = EXAMINING GROUP.

group director

P: Among the responsibilities of a group director are: the approval of DOUBLE PATENTING rejections (MPEP 804.04); determining whether an amendatory paper contains objectionable remarks under 37 CFR 1.3 (MPEP 714.19).

group registration

C: A single registration may be made for “a group of related works.” 17 USC 408(c)(1). 37 CFR 202.3 ***

grouping of claims

P: A required section of applicant’s appeal brief to the Board in which the applicant indicates which claims are separately patentable, unless it is desired that all claims shall stand or fall together. 37 CFR 1.192(c)(5).

guardian

P: The guardian of an insane or legally incapacitated person may apply for a patent on that person’s behalf. 37 CFR 1.43. See LEGAL REPRESENTATIVE.

GUI

An abbreviation for “graphical user interface.”

habitual residence

C: A concept used in defining a BERNE CONVENTION WORK.

Hague Convention

T: The Hague Convention Abolishing the Requirement of Legislation for Foreign Public Documents, which provides that a document may be verified by certain foreign officials by attaching an APOSTILLE. TMEP 803.01.

handling fee

P: PCT. 35 USC 376(a).

handwritten signature

C: A handwritten signature is required on a Monthly Statement of Account, an Annual Statement of Account (37 CFR 201.19(e)(6)) and an ADVANCE NOTICE OF POTENTIAL INFRINGEMENT (37 CFR 201.22(d)(2)).

harmonization

P: The effort to integrate the intellectual property statutes and policies of various countries.

Hawaii

C: Hawaii enjoys a different status from Alaska under the Copyright Act with respect to SECONDARY TRANSMISSION. 17 USC 111(f).

head of government department

P: The head of a government department may request that an application be made special. 37 CFR 1.102(b).

Secrecy ***.

head-start injunction

S: An injunction against use of a trade secret until it becomes public and then for a period equal to the time it would take a competitor who did not know previously know the secret to learn how to make use of it. *Winston Research Corp. v. Minnesota Mining and Manufacturing Co.*, 350 F.2d 134.

headend

C: See INDIVIDUAL CABLE SYSTEM.

heading

T: Matter at the top of a drawing, identifying the applicant and the goods or services for which registration is sought. TMEP 807.02.

headquarters

C: The location of a LEGAL ENTITY for Berne Convention purposes is determined by the location of its headquarters. 17 USC 101.

health

P: Applicant's age or health may justify a petition to make application special. 37 CFR 1.102(i).

heard

T: Every "case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark ... shall be heard by at least three members of the Board." 15 USC 1067. "Heard" in this context means "considered," and oral argument is not required. *In re Bose Corp.*, 227 USPQ 1 (Fed. Cir. 1985).

hearing

P: Before BPAI. [Walker 12:56. Interference 13:15. Reexamination 15:6].

In an INTERFERENCE, "[a] hearing on a motion may be held in the discretion of the examiner-in-chief." 37 CFR 1.640(a).

T: 1. TTAB.

2. A hearing on a SEIZURE ORDER must be held "not sooner than ten days after the order is issued and not later than fifteen days." 15 USC 1116(d)(10)(A).

height and weight charts

C: Height and weight charts containing no original authorship are not copyrightable. 37 CFR 202.1(d).

highly descriptive

T:

hindsight

P: It is not permissible to use hindsight to establish OBVIOUSNESS, i.e., to use the claimed invention as a template to piece together the teachings of the prior art. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992).

hole

P: Holes and other terms indicating absence of material may not usually be claimed positively, as in “a hole in said container.” A proper construction would be, “said container having a hole, said hole permitting the extraction of liquid.” The claiming of voids such as gaps, furrows, ridges and slots is a form of NEGATIVE LIMITATION.

holiday

“When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on a Saturday, Sunday or FEDERAL HOLIDAY within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day.” 35 USC 21.

horticultural expert

P: *** 37 CFR 1.167.

house mark

T: A trademark applied to multiple goods of the same producer. TMEP 804.02. The fact that a mark is a house mark may be stated in the identification of goods or services. EG 1-90. Cf. PRODUCT MARK.

how-to-use

P: The disclosure must specify not only how to make the invention, but also how to use it.

human biological product

P: 35 USC 156(g)(1)(B). See PATENT TERM EXTENSION.

human drug

P: [get def from Fed FDC Act]. See PATENT TERM EXTENSION.

hybrid

P: Plant. 35 USC 161.

hybridoma technology

P: 35 USC 156(f)(2)(B), 271(e). Inventions involving hybridoma technology are excluded from PATENT TERM EXTENSION.

hypothecation

C: See TRANSFER OF COPYRIGHT.

hypothetical claim

P: A fictional claim used in alleging infringement under the Doctrine of Equivalents. The plaintiff must show that a hypothetical claim consisting of the claim relied on but expanded to include equivalents would have been allowed by the PTO during prosecution of the application. *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677.

IDA

P: Abbreviation for INTERNATIONAL DEPOSITARY AUTHORITY for microorganisms. See BUDAPEST TREATY.

idea

P: Ideas alone are not patentable.

C: Ideas are not copyrightable. “In no case does copyright protection ... extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 USC 102(b). The same principle applies to MASK WORKS. 17 USC 902(c). “Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(b).

idea/expression merger

C: If an idea can only be expressed in a limited number of ways, the idea and its expression are said to “merge” and the resulting work is not copyrightable. *Morrissey v. Procter & Gamble*, 379 F.2d 675.

identification of goods

T: “The identification of goods or services may be amended to clarify or limit the identification, but additions will not be permitted.” 37 CFR 2.71(b). An application who identification is too broad will not be accorded a FILING DATE. “If an applicant identifies the goods and services by indicating the CLASS NUMBERS only, the applicant must be denied a filing date.” EG 1-91 (Mar. 26, 1991). See also DESCRIPTION OF GOODS, RECITATION.

identifying material

C:

identity of invention

P: Identity of invention is a necessary prerequisite to ANTICIPATION. 24 USPQ 2d 1321, 1326. The claim in issue cannot be anticipated unless every element can be found, either expressly or under the principle of INHERENCY, in a single prior art reference. Identity of invention is a QUESTION OF FACT. [Walker 4:42].

IDS

P: = INFORMATION DISCLOSURE STATEMENT.

illegal extension of patent term

P: See PATENT MISUSE.

illegal purpose

P: [Walker 5.13].

illegal use

T: Illegal use is not USE for trademark purposes that would support a registration.

imagination test

T: A test for a SUGGESTIVE MARK in which the trier of fact measures “the relationship between the actual words of the mark and the product to which they are applied.” That a word requires imagination to apply it to the product tends to show that it is suggestive. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 217 USPQ 988 (5th Cir. 1983). See also IMAGINATION, THOUGHT OR PERCEPTION.

imagination, thought or perception

T: A mark is suggestive if it requires “imagination, thought or perception to reach a conclusion as to the nature” of the goods or services. *Stix Products, Inc. v. United States Merchants and Mfrs., Inc.*, 160 USPQ 777. See also IMAGINATION TEST.

immoral

T: A mark that comprises immoral matter may be refused registration, either on the Principal or the Supplemental Register. 15 USC 1052(a), 1091(a).

immunity

See SOVEREIGN IMMUNITY.

implied license

P: [Walker 20:14].

implied palming off

T: The sale or offering for sale of goods or services under conditions that lead purchasers to believe that they emanate from another, without express use of the trademark of another. See PALMING OFF. Cf. IMPLIED REVERSE PALMING OFF, in which the goods of another are misbranded.

implied reverse palming off

T: The practice of removing the name or trademark from another party’s goods and selling them in an unbranded state. *Shaw v. Lindheim*, 15 USPQ 2d 1525 (9th Cir. 1990). Cf. REVERSE PALMING OFF, in which the goods of another are misbranded.

implied warranties

See WARRANTY OF NON-INFRINGEMENT, WARRANTY OF VALIDITY.

import

P: “Whoever without authority imports into the United States or sells or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, sale or use of the product occurs during the term of such process patent.” 35 USC 271(g).

[Walker Appx 57, 22:12].

C: Importation 17 USC 602.

Importation of infringing copies may give rise to subject matter jurisdiction in the U.S. over a foreign entity. *GB Marketing USA, Inc. v. Gerolsteiner Brunnen GmbH*, 782 F.Supp. 763 (W.D.N.Y 1991).

T: It is unlawful to import into the United States “any merchandise of foreign manufacture ... if such merchandise ... bears a trademark owned by a citizen of the, or by a corporation or association created or organized within, the United States, and registered in the Patent and Trademark Office.” 19 USC 1526(a). See also GRAY MARKET, PARALLEL IMPORT.

Registration on the supplemental register or under the Act of March 19, 1920, shall not be filed in the Department of the Treasury or be used to stop importations.” 15 USC 1096.

import statement

C: *** 17 USC 601.

impoundment

C: A remedy for copyright infringement. All copies alleged to infringe (***) and means for making) may be impounded during the pendency of litigation. 17 USC 503.

impoverishment of the language

T: “In determining the strength of a suggestive mark, it is relevant to consider whether ‘impoverishment of the language’ would occur if a person were permitted to preclude any one else from using one of the only terms which instantly evokes a certain image or association.” *Taj Mahal Enterprises, Ltd. v. Trump*. 15 USPQ 2d 1641.

improper joinder

P: The inclusion of PATENTABLY DISTINCT inventions in the same application. “The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention. 35 USC 121. See also MPEP 805.

improper Markush group

P: A non-art GROUND OF REJECTION. See MARKUSH GROUP.

improper means

P: A PCT applicant “not qualified under chapter 11 of this title to be an applicant for the purpose of filing a national application in the United States.” 35 USC 373.

improper applicant

S: Improper means of acquiring a trade secret include “theft, bribery, misrepresentation, breach or inducement of a breach of a duty to maintain secrecy, or espionage through electronic or other means.” UTSA 1(1). In general, illegal acts or fraud will constitute improper means. *Cf.* PROPER MEANS.

improper use

T: Fraudulent intent and purpose in using a federally registration symbol is known as “improper use” and is a basis for refusal of registration. TMEP 902.03.

improvement

P: An addition, simplification or variance relating to an existing machine, process, manufacture or composition of matter. 191 F 579. One of the statutory classes of patentable subject matter under 35 USC 101. “In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, article of manufacture or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or an may be necessary to a complete description of it.” 37 CFR 1.71(c).

improvement claim

P: See JEPSON CLAIM.

in connection with

T:

in gross

T: See ASSIGNMENT IN GROSS.

in issue

T: = ALLOWED.

in publication

T: = PUBLISHED.

in view of

P: language used in rejections for anticipation or obviousness.

in vitro test

P: In vitro tests alone do not establish utility of biotechnology inventions. A reasonable correlation between in vitro tests and in vivo results must be shown. *Cross v. Iizuka*, 224 USPQ 739, 747 (Fed. Cir. 1985).

inadvertence

P: See MATERIAL ERROR.

incapable of functioning as a trademark

T: A term that is generic or so highly descriptive as to be “incapable of functioning as a trademark” may not be registered. TMEP 1106.02(c).

incapacity

P: The legal representatives of an incompetent inventor may apply for a patent. 35 USC 117.

inchoate mark

T: [McC 18.03]

incidental

C: With respect to music accompanying a SPOKEN WORD RECORDING, “related to and relatively minor by comparison.” 17 USC 1001(5)(i).

including

P: A transitional phrase between the body and the preamble of a claim, meaning COMPRISING.

C: In the Copyright Act, 17 USC 101 *et seq.*, the use of the word “including” is illustrative and not limiting.

inclusive terminology

T: Indefinite terminology that is intended to allow the inclusion of unspecified additional items, e.g., “and similar goods,” “and the like,” “comprising” and “such as.” TMEP 804.04(c). Such terminology is usually not acceptable in a description of goods, which must be definite. TMEP 804.04(c).

incompetent

A person, agent or representative who is shown to be “incompetent, disreputable, or guilty of gross misconduct” by be suspended or excluded from practice before the PTO. 35 USC 32.

incomplete

P: A “claim can be rejected as incomplete if it omits essential elements, steps or necessary structural cooperative relationship of elements, such omission amounting to a gap between the elements, steps or necessary structural connection.” MPEP 706.03(f).

incongruous meaning

T: A trademark may be shown to be not merely descriptive if its otherwise descriptive component(s) can be shown to be incongruous or contradictory, requiring cogitation to understand.

incontestable

T: A trademark is “incontestable” when certain defenses to trademark infringement may not be asserted against it. A mark achieves incontestable status when it “has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in such commerce ... Provided, That —

- (1) there has been no final decision adverse to registrant’s claim of ownership of such mark for such goods or services, or to registrant’s right to register the same on the register; and
- (2) there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of, and
- (3) an affidavit is filed with the Commissioner within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and the other matters specified in paragraphs (1) and (2) of this section; and
- (4) no incontestable right shall be acquired in a mark which is the generic name of the goods or services or a portion thereof, for which it is registered.” 15 USC 1065. See also AFFIDAVIT OF INCONTESTABILITY.

An incontestable mark may not be challenged as descriptive. ***

No INTERFERENCE can be declared between an application and an incontestable mark. 35 USC 1066.

“To the extent that the right to use the registered mark has become incontestable under section 15, the registration shall be conclusive evidence of the validity of the registered mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 15, or in the renewal application filed under the provisions of section 9 if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application.” 15 USC 1115(b).

incorporation by reference

P: “A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” 35 USC 112.
prior disclosure, written description. [Walker 10:12].

incumbrance

See ENCUMBRANCE.

indefinite

P: A claim is invalid if it does not “distinctly ***.” 35 USC 112. A claim is indefinite if it is ambiguous or imprecise to the point that one could not readily determine what it might read on. See also VAGUE.

A “claim is INFERENTIAL and therefore indefinite when it recites ‘said lever’ and there was no earlier reference or no antecedent in the claim to a lever.” MPEP 706.03(d). In such a case, the claim would be rejected as “indefinite” or having “no antecedent.”

An INDIRECT LIMITATION also affords a ground of rejection as indefinite. If a ‘lever’ is set forth and, later in the claim, ‘said aluminum lever’ is recited, the claim is rejected as indefinite.” MPEP 706.03(d). See also NEGATIVE LIMITATION.

indefinite date of use

T: Phraseology that serves to give notice that, when called upon to do so, applicant may be able to prove a date earlier than the one specifically set forth. TMEP 806.08. Phrases such as “at least as early as,” “before,” “in,” “on or about,” and “prior to” are acceptable but will not be printed on the registration certificate. TMEP 806.08.

indemnity

P: UCC

independent

P: “The term ‘independent’ (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (2) SPECIES under a GENUS, which species are not usable together as disclosed, or (2) process and apparatus incapable of being used in practicing the process.” MPEP 802.01. See also DISTINCT, INDEPENDENT AND DISTINCT INVENTIONS.

“Two different COMBINATIONS, not disclosed as capable of use together, having different modes of operation, different functions, or different effects are independent.” MPEP 806.04.

independent and distinct inventions

P: Inventions that are both INDEPENDENT and DISTINCT but claimed in the same applications and therefore subject to RESTRICTION. “Two or more independent and distinct inventions may not be claimed in one NATIONAL APPLICATION, except that more than one SPECIES of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form ... or otherwise include all the limitations of the GENERIC CLAIM.” 37 CFR 1.141.

independent claim

P: A claim that contains no reference to any other claim in the same patent or patent application.

independent contractor

C: Work made for hire.

independent creation

P: Independent creation is not a defense to PATENT INFRINGEMENT.

C: Creation of a work without reference to preexisting material. Independent creation is a defense to copyright infringement because there is then no copying. *Eden Toys Inc. v. Marshall Field & Co.*, 675 F.2d 498, 500, 216 USPQ 560, (2d Cir. 1982).

independent derivation

C: = INDEPENDENT CREATION.

independent invention

P: Independent invention does not entitle the inventor to a patent nor is it a defense to infringement.

S: Independent invention is a defense to misappropriation. *Kewanee Oil Co. v. Bicron Corp.*, 416 US 470.

independent inventor

P: A concept used in determining whether an applicant is entitled to reduced patent fees. One “who (1) has not assigned, granted, conveyed or licensed and (2) is under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who could not likewise be classified as an independent inventor ... or to any concern which would not qualify as a small business concern or a non-profit organization under this section.” 37 CFR 1.9(c). See also SMALL ENTITY.

independent station

C: A “commercial television broadcast station other than a network station.” 17 USC 111(f).

index

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101.

T: See ABANDONED DRAWING INDEX, INDEX OF MARKS IN PENDING APPLICATIONS.

Index of Applicants

T: An index composed of the filing receipts for applications in alphabetical order by applicant name. TMEP 711.

Index of Claims

P: [See MPEP 717.04].

Index of Marks in Pending Applications

T: An index of marks in pending applications for registration. 37 CFR 2.27.

Indian Arts and Crafts Board

T: “The Indian Arts and Crafts Board will not be charged any fee to register Government trademarks of genuineness and quality for Indian products or for products of particular Indian tribes and groups.” 15 USC 1113.

indicator of source

T:

indirect limitation

P: The improper practice of introducing a limitation on an element in a later reference to the element rather than in its initial definition. For example, if an “acid” has been defined, a later use of “said organic acid” would be an indirect limitation. MPEP 706.03(d). See INDEFINITE.

individual

T: An individual applicant must be identified by full name and a country of citizenship. The individual must sign the application.

individual cable system

C: A “CABLE SYSTEM recognized as a distinct entity under the rules, regulations, and practice of the Federal Communications Commission ***” 37 CFR 201.17(b)(2).

individual name

T: See NAME.

individual standard features

C: The “individual standard features” of a building are not protected by copyright. 17 USC 101.

inducement of infringement

P: “Whoever actively induces infringement of a patent shall be liable as an infringer.” 35 USC 271(b). Actual knowledge of the patent and the infringement must be shown. *Dynamis Inc. v. Leepoxy Plastics Inc.*, 27 USPQ 2d 1355 (N.D. Ind. 1993). Cf. CONTRIBUTORY INFRINGEMENT, DIRECT INFRINGEMENT. [Walker 22:6].

industrial design

P:

industrial espionage

S: Industrial espionage, even if confined to legal acts, may result in acquisition of a trade secret by improper means if “unreasonable.” *E. I. DuPont de Nemours & Co. v. Christopher*, 431 F.2d 1012 (***), cert. denied, 400 US 1024.

industrial property office

P: The administrative body of a country authorized to grant patent protection.

industrially applicable

P: PCT. Ref. 37 CFR 1.416(c)(5).

industrious collection

C: See SWEAT OF THE BROW.

inequitable conduct

P: Conducting comprising (1) a material misrepresentation or omission; and (2) intent to mislead. 24 USPQ 2d 1321, 1336. The factors considered in evaluating the conduct are: (a) materiality of the nondisclosed prior art; (b) knowledge chargeable to the applicant of the prior art or information and its materiality; and (c) failure of the applicant to disclose the art or information resulting from an intent to mislead the United States Patent and Trademark Office. *FMC Corp. v. Manitowoc Co.*, 835 F.2d

1311, 1415, 5 USPQ 2d 1112 (Fed Cir. 1987). Inequitable conduct must be shown by CLEAR AND CONVINCING EVIDENCE. The standard of review of a finding of inequitable conduct is ABUSE OF DISCRETION.

Defense, invalidity. Inequitable conduct does not invalidate a patent, but may render it unenforceable. 24 USPQ 2d 1321. See also ATTORNEY'S FEES, CUMULATIVE REFERENCES, CURE, FRAUDULENT PROCUREMENT.

inferential claiming

P: The improper practice of introducing a new element of a claim within a clause describing another element. A “claim is inferential and therefore INDEFINITE when it recites ‘said lever’ and there was no earlier reference or no antecedent in the claim to a lever.” MPEP 706.03(d).

informal

P: Said of an application or component thereof that does not conform to the RULES OF PRACTICE. MPEP 702.01.

T: Said of a paper so defective that it cannot be accorded a filing date. TMEP 410. Also UNACCEPTED. See DEFECTIVE APPLICATION.

informal drawing

P: A drawing that does not comply with ***. Cf. FORMAL DRAWING.

informal hearing

P: As used in 35 USC 156, an “informal hearing” as defined in section 201(y) of the Federal Food, Drug, and Cosmetic Act. 35 USC 156(f)(5).

informality

P: A component of an application that fails to conform to the RULES OF PRACTICE. An informality is not substantive and results in an objection rather than a rejection.

T: A component of an application that fails to conform to the RULES OF PRACTICE. An informality is not substantive and results in a REQUIREMENT rather than a REFUSAL.

information

C: “Works consisting entirely of information that is common property containing no original authorship” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(d).

S: “Information” may constitute a trade secret under UTSA 1(4). See also NEGATIVE INFORMATION.

information disclosure statement

P: A list of relevant “patents, publications or other information” that constitute prior art with respect to an application. 37 CFR 1.98. Filing the statement does not imply that a search has been made or that no other 1.56(b) material exists. 37 CFR 1.97. Abbreviated IDS.

infringement

P: Infringement must be shown by a preponderance of the evidence. *Manesmann Demag Corp. v. Engineered Metal Products Co.*, 230 USPQ 45 (Fed. Cir. 1986). See CONTRIBUTORY INFRINGEMENT, DIRECT INFRINGEMENT, INDUCEMENT OF INFRINGEMENT, PATENT INFRINGEMENT.

C: See COPYRIGHT INFRINGEMENT.

T: See TRADE DRESS INFRINGEMENT, TRADEMARK INFRINGEMENT.

infringement opinion

P: Fed. Cir. requirement of prosecution history.

infringement search

P:

infringement test

P: “The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends ... or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.” MPEP 608.01(n).

infringer

P: One who makes, uses or sells a patented invention. 35 USC

C: . 17 USC ***

T: One who. 15 USC

infringer’s profits

C: A component of an award for copyright infringement. 35 USC 101(d). Plaintiff must prove revenue; defendant must prove deductions. *Sheldon v. MGM*, 309 US 390.

infringing semiconductor chip product

C: See SEMICONDUCTOR CHIP PRODUCT.

ingredient

C: A “mere listing of ingredients or contents” is “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

P: “If the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.” 35 USC 114.

ingredient mark

T: A mark which is used to identify an ingredient of a particular product and associate that ingredient with the product’s manufacturer. 1990 Bacal 1.4. *Cf.* GRADE MARK.

inherent function

P: Prior to *In re Tarczy-Hornoch*, 158 USPQ 141 (1968), the “inherent function” of a disclosed apparatus was not patentable. ***

inherency

P: Matter is inherent in a prior art reference only where the consequence of following the reference always inherently produces or results in the claimed invention. *W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 314 (Fed. Cir. 1983).

See also IDENTITY OF INVENTION. [Walker 4:7].

inherently distinctive

T: A trademark that is inherently distinctive is protectable immediately upon use and without a showing of SECONDARY MEANING. [McC 16.02].

Initial Clerical Review

T: An administrative stage in the review of an AMENDMENT TO ALLEGE USE prior to review by the Examining Attorney.

Initial Notice of Identity and Signal Carriage Complement

C: See 37 CFR 201.17(b)(2). Cf. NOTICE OF CHANGE OF IDENTITY OR SIGNAL CARRIAGE COMPLEMENT.

injunction

Preliminary, permanent. The issuance of an injunction is within the sound discretion of the trial court. It is unavailable against the government. *Motorola, Inc. v. U.S.*, 729 F.2d 765. COERCIVE DAMAGES can be used to enforce future compliance with an injunction. See also HEAD-START INJUNCTION, LEAD-TIME INJUNCTION, PRO CONFESSO INJUNCTION, UNTIL PUBLIC DISCLOSURE INJUNCTION.

P: In an action for patent infringement, the court “may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.” 35 USC 283.

C: A court having jurisdiction may grant “temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.” 17 USC 502.

T: Courts in trademark cases “shall have power to grant injunctions, according to the principles of equity, and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation of section 43(a).” 15 USC 1116(a).

“Where the infringement or violation complained of is contained in or part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section 2510(12) of title 18, United States Code, the remedies of the owner of the right infringed or person bringing the action under section 43(a) as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.” 15 USC 1114(2)(B).

“Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section 43(a) with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter in any particular issue of such periodical or in an electronic communication would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter or violating matter.” 15 USC 1114(2)(C).

injurious to public health or morals

P: An invention that is injurious to public health or morals is regarded as lacking UTILITY. A rejection on these grounds may be overcome by affidavit. 37 CFR 1.132.

ink drawing

T: A drawing that presents “a substantially exact representation of the mark as it appears on the specimens,” TMEP 807. Also SPECIAL FORM DRAWING. Cf. TYPED DRAWING.

innocent infringement

C: *** 17 USC 405(b). *** Proper use and placement of a notice of copyright cuts off any defense of innocent infringement except for certain fair use exceptions as provided in the last sentence of 17 USC 504(c)(2). 17 USC 402(d). “In a case where the infringer sustains the burden of proving, and the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court in its discretion may reduce the availability of statutory damages to a sum of not less than \$200.” 17 USC 04(c).

innocent infringer

C: In order for a defendant to avail himself of the innocent infringement defense, he must have “acted in complete ignorance of the fact that [his] conduct might somehow infringe upon the rights of another party.” *Halnat Publishing Co. v. L.A.P.A., Inc.*, 669 F.Supp. 933, 937, 5 USPQ 2d 1288 (D. Minn 1981).

T: An infringer who does not have notice ***. 15 USC 1114(2)(A). See also INNOCENT VIOLATOR, INJUNCTION, TRADEMARK INFRINGEMENT.

innocent purchaser

C: With respect to a mask work, “an ‘innocent purchaser’ is a person who purchases a semiconductor chip product in good faith and without having notice of protection with respect to the semiconductor chip product.” 17 USC 901(a)(7).

innocent user

S: A party who uses a trade secret without constructive knowledge of its secrecy and without notice that it is a secret. See MATERIAL CHANGE IN POSITION.

innocent violator

T: A VIOLATOR who does not have notice ***. 15 USC 1114(2)(A). See also INNOCENT INFRINGER, INJUNCTION, TRADEMARK INFRINGEMENT.

inoperable

P: Capable of operating, that is, performing an intended purpose. See OPERABILITY, UTILITY.

inquiry

T: 37 CFR 2.61(b). Examiner may inquire.

On status of application suspended awaiting foreign registration. TMEP 1003.01.

insert

T: Material inserted with goods is not an acceptable trademark specimen. TMEP 808.07. The material may be accepted if it is affixed to the goods or if the goods cannot

practically be used without the insert, such as instructions for a kit of parts. *** Case ref.

insignia

T: A formally adopted design or device. TMEP 1202.03(b). A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises the insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 USC 1052(b), 1091(a). *U.S. Navy v. U.S. Mfg. Co.*, 2 USPQ 2d 1254 (TTAB 1987). *Cf.* NATIONAL SYMBOL.

inspection

P: Where it is not possible to furnish the required specimen of a plant, the plant must be made “available for official inspection where grown.” 37 CFR 1.166.

institution

T: A mark that may disparage or falsely suggest a connection with institutions or bring them into contempt or disrepute may be refused registration, either on the Principal or the Supplemental Register. 15 USC 1052(a), 1091(a).

instructional text

C: A “literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.” One of the nine statutory classes of WORKS MADE FOR HIRE. 17 USC 101.

insufficient intellectual labor hurdle

C: A test a work must pass to rise to the level of copyrightability. Also 797 F2 1222, 230 Q 481.

insufficient response

T: A response to an official action that fails to address one or more refusals or requirements may be deemed insufficient and may result in ABANDONMENT of the application. TMEP 1112.02(a).

insular possession

T: See also DEPOSITION. *Cf.* POSSESSION.

INTA

T: = INTERNATIONAL TRADEMARK ASSOCIATION.

integrity

C: The right of an artist to prevent distortion, mutilation or modification of his work. One of the MORAL RIGHTS. The Copyright Act, 17 USC 106A(1)(2), provides for a right of integrity for WORKS OF VISUAL ART. “[The author of a work of visual art] shall have the right — (A) to prevent any intentional distortion, mutilation or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation or other modification of that work is a violation of that right, and (B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.” 17 USC 106A(3).

intellectual property**Intellectual Property Bankruptcy Protection Act**

P: Allows licensees to retain licenses in the event of licensor's bankruptcy. 11 USC 365.

intent

T: Intent of the purported infringer in adopting a mark is a factor to be considered in determining whether there is likelihood of confusion between two marks. *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ 2d 1264 (1st Cir. 1987).

intent not to resume use

T: See ABANDONMENT. *Cf.* INTENT TO ABANDON.

intent to abandon

T: *Cf.* INTENT NOT TO RESUME USE.

intent to mislead

P: There is no INEQUITABLE CONDUCT without an intent to mislead.

intent-to-use

T: "A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may apply to register the trademark under this Act on the principal register hereby established." 15 USC 1051(b). Abbreviated ITU. "[n]o application to register a mark under section 1(b) shall be assignable prior to the filing of the verified statement of use under section 1(d), except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing." 15 USC 1060

intent-to-use application

T: An application whose basis for filing is section 1(b) of the Lanham Act, 15 USC 1051(b).

intention to secure copyright

C: In the case of a work consisting of sounds, images or both, whose first fixation is made simultaneously with its transmission, it is possible to institute suit for infringement without first obtaining a registration if the infringer is given ADVANCE NOTICE OF POTENTIAL INFRINGEMENT and the owner intends to secure copyright. 17 USC 411(b)

inter partes

Cf. EX PARTE.

T: "In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied." 15 USC 1069.

interest

P: The proper measure of interest is the cost of borrowing money, not the rate of return on invested money. *Studiengesellschaft Kohle, M.B.H. v. Dart Industries*, 862 F.2d

1564, 9 USPQ 2d 1273 (Fed. Cir. 1988).*** [Walker 27:47]. See also PREJUDGMENT INTEREST.

interested copyright party

C: 17 USC 1001(7).

interference

P: Two applications or an application and a unexpired patent “interfere” when both claim the SAME PATENTABLE INVENTION. “An ‘interference’ is a proceeding instituted in the Patent and Trademark Office before the Board to determine any questions of patentability and priority of invention between two or more parties claiming the same patentable invention.” 37 CFR 1.601(i). The statutory authority for such a determination is 35 USC 102(g), known as the “interference provision.” See SAME PATENTABLE INVENTION. Interferences are resolved in an inter partes proceeding before the Board of Patent Appeals and Interferences. There can be no interference between two issued patents and the Board is without authority to decide priority in such a case, which must be determined in a civil action. 35 USC 291. See also AGREEMENT.

When an interference is declared, ex parte prosecution of an application involved in the interference is suspended.” 37 CFR 1.615(a).

Mail relating to interferences should be marked “Box INTERFERENCE.” 37 CFR 1.1(e).

See also ADDITIONAL DISCOVERY, ADDITIONAL INTERFERENCE, ADVERSE JUDGMENT, CASE-IN-CHIEF, CASE-IN-REBUTTAL, CORRESPOND EXACTLY, CORRESPOND SUBSTANTIALLY, COUNT, FINAL DECISION, FINAL HEARING, INTERFERENCE-IN-FACT, JUNIOR PARTY, LEAD ATTORNEY, LOST COUNT, PHANTOM COUNT, PROPOSED COUNT, SECOND INTERFERENCE, SENIOR PARTY, STATUTORY DISCLAIMER, STYLE, SUGGESTION OF CLAIM.

T: A “proceeding before the TTAB by which rights to registration between pending applications, or between a pending application and a registration, are determined.” An interference proceeding is initiated by the Office rather than by one of the parties concerned ... ” TMEP 1501. While an interference is declared by the PTO, it may be requested by petition: “Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion, or mistake or to deceive.” 15 USC 1066. “An interference will not be declared between an application and a registration except upon petition to the Commissioner. Interferences will be declared by the Commissioner only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference.” 37 CFR 2.91(a). SUPPLEMENTAL REGISTRATIONS are not subject to interference. 37 CFR 2.91(b). Prejudice occurs when OPPOSITION and CANCELLATION would be inadequate. TMEP 1206.03(b). An INCONTESTABLE registration may not be involved in an interference. 15 USC 1066. When an interference is declared, notice must be sent to the parties by the Commissioner. 15 USC 1067.

“The issue in an interference between applications is normally priority of use but the rights of the parties to registration may also be determined.” 37 CFR 2.96. See also JUNIOR PARTY.

interference settlement agreement

P: A settlement agreement terminating an interference. “Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference.” 37 CFR 1.666(a). The agreement must be in writing and “filed before the termination of the interference.” 37 CFR 1.666(a). An interference settlement agreement is “permanently unenforceable” unless it is filed or the Commissioner grants a petition “on a showing of GOOD CAUSE” to permit writs filing within six months of the termination of the interference. 37 CFR 1.666(c).

An interference settlement agreement determines priority only and does not preclude a patentability determination by the PTO.

interference-in-fact

P: An ‘interference-in-fact’ exists when at least one claim of a party which corresponds to a COUNT and at least one claim of an opponent which corresponds to the same count define the same patentable invention.” 37 CFR 1.601(j).

interlineation

P: Any interlineation must be made before signing the oath or declaration and should be dated and initialled or signed by the applicant. 37 CFR 1.52(c).

T: See AMENDMENT.

interlocking patents

P: A group of patents covering a technology such that practicing the technology would infringe all the patents. It is not PATENT MISUSE to enforce interlocking patents.

interlocutory amendment

P: [Walker 12:39].

interlocutory appeal

Preliminary injunction.

intermediate

P: An intermediate product that is created in the making of a final product may or may not be PATENTABLY DISTINCT from the final product. “Distinctness is proven if the intermediate product is useful to make other than the final product, and the species are patentably distinct.” MPEP 806.04(b). [Walker 5:8]. See also SNAPSHOT CLAIM.

intermeddler

T: One who does not have STANDING to initiate a proceeding. A party having no direct economic interest does not have standing to bring an opposition or cancellation proceeding.

international application

P: An “international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.” 35 USC 351(c),

37 CFR 1.9(b). An applicant is not entitled to a patent if “the invention was described in a patent ... on an international application by another who has fulfilled the requirements of [35 USC 371(C)(1),(2) and (4)] before the invention thereof by the applicant.” 35 USC 102(e). A patent issued based on an international application designating the United States “shall have the force and effect of a patent issued on a national application.” 35 USC 375(a).

“An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required).” 37 CFR 1.431(a).

Communications relating to international applications prior to the assignment of a national serial number should be marked “Box PCT.” 37 CFR 1.1(b).

international application designating the United States

P: An “INTERNATIONAL APPLICATION specifying the United States as a country in which a patent is sought, regardless where such international application is filed.” 35 USC 351(e).

international application number

P:

international application originating in the United States

P: An INTERNATIONAL APPLICATION “filed in the Patent and Trademark Office when it is acting as a Receiving Office under the [Patent Cooperation] treaty, irrespective of whether or not the United States has been designated in that international application.” 35 USC 351(d).

International Bureau

P: The international intergovernmental organization which is recognized as the coordinating body under the [Patent Cooperation] treaty and the Regulations. 35 USC 351(h). Its function is set forth at 37 CFR 1.415. Currently, the International Bureau is the World Intellectual Property Organization (WIPO) located in Geneva, Switzerland. 37 CFR 1.401(b).

international class

T: A grouping of goods and services according to the International Classification of Goods and Services for the Purpose of Registration of Marks.

International Classification of Goods and Services for the Purpose of Registration of Marks

T: An internationally accepted classification scheme adopted by the U.S. for indexing trademarks. 37 CFR 1.52(c). WIPO***

international depositary authority

P: A site designated to receive deposits of microorganisms pursuant to the BUDAPEST TREATY. Abbreviated IDA.

international fee

P: PCT. 35 USC 376(a). See also BASIC FEE PORTION, DESIGNATION FEE, SEARCH FEE, TRANSMITTAL FEE.

international filing date

P: PCT.

“An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that

- (1) The applicant is a United States resident or national.
- (2) The application is in the English language.
- (3) The international application contains at least the following elements:
 - (i) An indication that it is intended to be an international application;
 - (ii) The designation of at least one Contracting State of the International Patent Cooperation Union;
 - (iii) The name of the applicant, as prescribed;
 - (iv) A part which on the face of it appears to be a description; and
 - (v) A part which on the face of it appears to be a claim.” 37 CFR 1.431(b).

International Gazette

P: PCT

International Patent Classification

P: Abbreviated IPC.

International Patent Cooperation Union

P: PCT

International Preliminary Examining Authority

P: A “national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.” 35 USC 351(g). Abbreviated IPEA.

international preliminary examining report

P: PCT. A “non-binding opinion on the question whether the claimed invention appears to be novel, to involve an inventive step (non-obvious), and to be industrially applicable.” 37 CFR 1.416(c)(5).

International Searching Authority

P: A “national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.” 35 USC 351(g).

international stage

P: PCT.

International Trademark Association

T: Formerly the United States Trademark Association. Abbreviated INTA.

international-type search

P: A search to produce a search report conforming to international requirements. 37 CFR 1.104.

interrogatory

T: Limited to 75.

interstate commerce

Cf. INTRASTATE COMMERCE, USE IN COMMERCE.

intervention

P: The REQUESTOR may intervene in an appeal from a REEXAMINATION.

intervening rights

P: A REISSUE or REEXAMINATION may result in allowance of claims not present in the original patent. A party that began activities in reliance on the original patent that would infringe the new claims is said to possess intervening rights. [Walker 14:31].

interview

P: No interview will be granted on a pending application before the first office action. 37 CFR 1.133. See also INTERVIEW RECORD.

T: “The personal appearance of an applicant or attorney before the Examining Attorney presenting matters for the latter’s consideration is considered an interview. If the presentation is by means of a telephone conversation, it is commonly referred to as a “telephone interview.” TMEP 1107. “An interview should be had only when the nature of the subject matter is such that the interview would serve to develop and clarify specific issues and lead to a mutual understanding between the Examining Attorney and the applicant, and thereby advance the prosecution of the application ... ” TMEP 1107.01.

interview record

P:

intestate succession

C: Ownership of copyright and rights in a MASK WORK may pass as “personal property by the applicable laws of intestate succession.” 17 USC 201(d)(1), 17 USC 903(b). See also BEQUEST.

intrastate commerce

T: Commerce conducted wholly within a single state. Intrastate commerce may lawfully be regulated by Congress if it directly affects a type of commerce that may lawfully be regulated by Congress. TMEP 806.05. *Cf.* INTERSTATE COMMERCE, USE.

intrinsic test

Sid & Marty Krofft, 562 F.2d 1157.

intrinsic utilitarian function

C: An article having an “intrinsic utilitarian function” is a USEFUL ARTICLE. 17 USC 101.

inure

T: Use of a mark by a related company inures to the benefit of the registrant or applicant for registration. 15 USC 1055.

invalidity

P: A defense to patent infringement that consists of showing that the asserted patent should not have been issued for failure to meet the statutory requirements of 35 USC 101, 102, 103, 112 or 251. Invalidity must be shown by clear and convincing evidence.

293 US 1???. *Radio Corp. v. Radio Eng'g. Laboratories*. Among the grounds for invalidating a patent are ANTICIPATION, DERIVATION, FALSE TEACHING, FRAUD ON THE PATENT OFFICE, LACK OF INVENTION, OBVIOUSNESS and ON-SALE BAR.

invention

P: 1. As used in the Patent Act, “invention” means invention or discovery. 35 USC 100(a). With respect to Government employees, an “invention” is “any art, machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States.” 37 CFR 501.3(d). With respect to federally funded inventions, “invention” means “any invention or discovery which is or may be patentable or otherwise protectable under this title or any novel variety of plant which is or may be protectable under the Plant Variety Protection Act (7 USC 2321 et seq.)” 35 USC 201(d), 37 CFR 401.2(c), 48 CFR 52.227(a)(1). See also SUBJECT INVENTION.

An invention is “something definitely sought or created and usually predictable.” [Walker 6:7].

An invention is considered made when it is reduced to practice, either actually or constructively. See REDUCTION TO PRACTICE.

2. The subject matter claimed in a patent or application.

Invention Secrecy Act

P: [Walker].

inventive

P: A characteristic of a job or employment. A position is “inventive” if its occupant is expected to make inventions. See GENERALLY INVENTIVE.

inventive concept

P: MPEP 804.

inventive entity

P: The applicant must identify the inventive entity of the subject matter of each claim. 37 CFR 1.110.

inventive step

P: Under the PCT, an invention is non-obvious if it involves an “inventive step.”

inventor

P: One who conceives an invention that is later reduced to practice. For purposes of a U.S. patent application, an inventor can only be a person. While a corporation or other legal entity may be the assignee of an application or a patent, it cannot be an inventor. For purposes of an INTERFERENCE, “an ‘inventor’ is the individual named as the inventor in an application involved in an interference or the individual named as the inventor in a patent involved in an interference.” 37 CFR 1.601(l).

inventor’s certificate

P: An applicant is not entitled to a patent if the invention “was the subject of an inventor’s certificate, by the applicant or his legal assigns in a foreign country prior to the date of the application for patent in this country on an application ... filed more than

twelve months before the filing of the application in the United States.” 35 USC 102(d).

Applicants for a U.S. patent may claim an earlier filing date based on an application for an inventor’s certificate in a foreign country if the applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of foreign filing. 35 USC 119, 37 CFR 1.55(b).

inventorship

P: “Inventorship is a question of who actually invented the subject matter claimed in a patent.” *Sewall v. Walters*, 30 USPQ 2d 1358 (Fed. Cir. 1994). Inventorship is a QUESTION OF LAW. See also MOTION TO CORRECT INVENTORSHIP.

inverse ratio rule

C: The rule that, in proving infringement, more proof of access requires a lesser degree of substantial similarity and vice versa. *Sid & Marty Krofft Television Productions v. McDonald’s Corp.*, 562 F.2d 1157, 196 USPQ 97 (9th Cir. 1977).

investive publication

C: A publication giving rise to statutory copyright. Cf. DIVESTIVE PUBLICATION.

involuntary disclaimer

P: [Walker 12:68].

involved

P: “Any claim of an application or patent which corresponds to a COUNT is a claim involved in the interference within the meaning of 35 USC 135(a).” 37 CFR 1.601(f).

involuntary transfer

C: “When an individual author’s ownership of a copyright, or of any of the exclusive rights under a copyright, has not previously been transferred voluntarily or by that individual author, no action by any governmental body or other official or organization purporting to seize, expropriate, transfer or exercise rights of ownership with respect to the copyright ... shall be given effect under this title, except as provided under title 11.” 17 USC 201(e). See also SEIZURE.

IPC

P: (PCT) = INTERNATIONAL PATENT CLASSIFICATION.

irreparable harm

P:

C:

T: A presumption of irreparable harm attaches once the moving party demonstrates probable success in proving likelihood of confusion. *Int’l. Kennel Club v. Mighty Star, Inc.*, 846 F.2d 1079, 6 USPQ 2d 1977 (7th Cir. 1988). Trademark infringement results in irreparable harm unless the infringed mark is weak. 15 USPQ 2d 1613.

ISA/US

P: PCT. United States International Searching Authority.

issue date

P: The date of ISSUANCE of a patent.

issuance

P: The ministerial act of emitting letters patent once an application has been allowed. Issuance of a patent may be deferred on petition to the Commissioner. 37 CFR 1.314.

T: For other than an ITU application for which no AMENDMENT TO ALLEGE USE has been accepted, “if no OPPOSITION is filed within the time permitted or all oppositions filed are dismissed, and if no INTERFERENCE is declared and no CONCURRENT USE PROCEEDING is instituted, the application will be prepared for issuance of the CERTIFICATE OF REGISTRATION ...” 37 CFR 2.81(a).

issue preclusion

See COLLATERAL ESTOPPEL.

issued patent

P:

issues

P: A required section of applicant’s belief to the Board, laying out the issues on appeal. 37 CFR 1.192***.

ITU

T: = INTENT-TO-USE, referring to a section 1(b) application.

Jepson claim

P: A claim for an IMPROVEMENT in which old elements are recited in the preamble and the invention is introduced with a transitional phrase such as, “wherein the improvement comprises.” 37 CFR 1.75. It consists of (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known; (2) a phrase such as “wherein the improvement comprises”; and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.” 37 CFR 1.75(e). See MPEP 608.01(m).

The original Jepson claim recited the old by means of an “in” clause, as follows, “In an electrical system .., the combination with ...” *Ex parte Jepson*, 1917 C.D. 62, 243 O.G. 525). A Jepson claim suffers from the disability that the elements recited in the preamble are admitted to be old.

jewelry

C: The year date may be omitted from the copyright notice on a pictorial, graphic or sculptural work as reproduced on jewelry. 17 USC 401(b)(2). Works “published only in or on jewelry” are exempt from DEPOSIT requirements. 37 CFR 202.19(c)(6).

joinder

P: *** See also IMPROPER JOINDER.

joinder of inventors

P: [Walker 3:7].

joint and several liability

Cf. SEVERAL LIABILITY.

C:

joint applicants

T: Under appropriate circumstances, two or more parties may apply jointly to register a trademark. *Ex parte Pacific Intermountain Express Co.*; *Ex parte Spector Motor Service, Inc.*, 111 USPQ 187 (Comm'r. Pats. 1956). Each joint applicant must execute the application.

joint author

C: "The authors of a joint work are coowners of copyright in the work." 17 USC 201. *** Independent copyrightable contribution req'd. *Erickson*, 29 USPQ 2d 1347. See also JOINT OWNER.

joint inventor

P: One or more of several persons who make an invention. It is not necessary for joint inventors (1) to physically work together or at the same time; (2) to make the same type of amount of contribution; or (3) to work on the subject matter of every claim. 35 USC 116, 37 CFR 1.45(b). Each must have made a contribution individually or jointly to the subject matter of at least one claim of the application. 37 CFR 1.45(c). Joint inventors must apply for a patent jointly and each must make the required oath or declaration. 37 CFR 1.45(a). "If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the omitted inventor." 37 CFR 1.45(a). See also JOINDER OF INVENTORS, MISJOINDER, NON-JOINDER, REFUSAL.

joint owner

P: "In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners." 35 USC 262.

C: Joint owners of copyright have a DUTY TO ACCOUNT to one another for exploitation of the work.

joint venture

T: A joint venture may be an APPLICANT for a trademark registration if the citizenship and ENTITY TYPE of each joint venturer is identified. Each joint venturer must execute the application.

joint work

C: A "work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." 17 USC 101. "The authors of a joint work are coowners of copyright in the work." 17 USC 201(a). *Sid & Marty Krofft*, 562 F.2d 1157. Each joint owner may use or license the joint work but must account to the co-owners for any profit. *Oddo v. Ries*, 743 F.2d 630.

JPO

P: Abbreviation for the Japanese Patent Office.

judge

P: In construing the Federal Rules of Evidence in an INTERFERENCE, judge means examiner-in-chief. 37 CFR 1.671(c)(2).

judgment

P:

“A judgment in an interference settles all issues which (1) were raised and decided in the interference, (2) could have been properly raised and decided in the interference by a motion under §1.633(a) through (d) and (f) through (j) or §1.634 and (3) could have been properly raised and decided in an ADDITIONAL INTERFERENCE with a motion under §1.633(e).” 37 CFR 1.658(c). See also 37 CFR 1.633(a).

judicial notice

P: In construing the Federal Rules of Evidence in an INTERFERENCE, judicial notice means official notice. 37 CFR 1.671(c)(3).

T: The TTAB does not take judicial notice of registrations, so certified copies are required to prove their existence and content.

jukebox exemption

C:

jumbo patent

P: “Any United States patent in excess of 40 pages.” MPEP 707.05(a). Copies of jumbo patents cited as references in office actions are ordered by the clerical staff of the examining group. MPEP 707.05(a).

junior party

P: Any party to an INTERFERENCE other than the SENIOR PARTY. 37 CFR 1.601(m). In essence, a party whose application does not have the earliest EFFECTIVE FILING DATE.

T: “The party whose application involved in the INTERFERENCE has the latest filing date is the junior party and has the burden of proof.” 37 CFR 2.96.

junior user

T: One who is not the first user of a mark, that is, who is not a SENIOR USER. As between two parties, the junior user is the one whose use is later in time.

jurat

T: A statement by the officer administering an oath that he is authorized to do so. TMEP 803.01(a).

jurisdiction

See also ANCILLARY JURISDICTION, PENDENT JURISDICTION, PERSONAL JURISDICTION, SUBJECT MATTER JURISDICTION, SUPPLEMENTAL JURISDICTION.

P: Federal jurisdiction over patent matters arises under 28 USC 1338(a), which confers exclusive jurisdiction on the District Courts.

Within the PTO, jurisdiction over an application or patent under reexamination passes to the Board upon transmittal of the file and briefs.

C: ***. Federal jurisdiction arises under the Copyright Act only when the complaint asks for a remedy expressly granted by the Act, asserts a claim requiring construction of the Act, or presents a case where distinctive policy of the Act requires that federal principles control.” *T.G. Harms Co. v. Eliscu*, 339 F.2d 823, 144 USPQ 46 (4th Cir. 1964), *cert denied*, ***.

T: 1. “The district and territorial courts of the United States shall have original jurisdiction and the courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate jurisdiction of all actions arising under” the Lanham Act. 15 USC 1121.

In a civil action appealing from a decision of the TTAB, “If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction.” 15 USC 1071(b)(4).

2. “The examiner may exercise jurisdiction over an application up to the date the mark is published in the Official Gazette.” After such time, permission of the Commissioner is required. 37 CFR 2.84(b).

juristic person

T: The term ‘juristic person’ includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.” 15 USC 1127. *Cf.* NATURAL PERSON. See also ENTITY.

jury

See also ADVISORY JURY.

just

C: STATUTORY DAMAGES are awarded “as the court considers just.” 17 USC 504.

Kerr factors

See ATTORNEY’S FEES.

kill fee

C: = CANCELLATION FEE.

kit

P: Under proper conditions, a kit of parts may be patentable, despite the fact that it may resemble an AGGREGATION. *In re Venezia*, 189 USPQ 149 (CCPA 1976).

knock-off

C, T: (Colloq.) A copy of an article, often cheaply made.

know-how

S: Covered by Uniform Trade Secrets Act, 14 ULA 403 (Commissioners’ Comment).

knowledge

P: Knowledge of the existence of a patent is not a prerequisite to infringement. Knowledge of both the patent and the fact of infringement is required for one to be a contributory infringer. 35 USC 271(c). Knowledge is required for one to be liable as an inducer of infringement. *Honeywell, Inc. v. Metz Apparatewerke*, 509 F.2d 1137. Proving knowledge to show WILLFUL INFRINGEMENT may entitle the patentee to TREBLE DAMAGES. 35 USC 284. Modification of remedies of 35 USC 287 are not available to an importer who had knowledge before the infringement that a patented process was used to make the imported product.

T: Knowledge that an imitation of a mark applied by defendant to goods or used in connection with services was intended to cause confusion, or to cause mistake, or to deceive is a prerequisite to an award of damages or profits under 15 USC 1114(1)(B).

It is a defense to trademark infringement that “the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant’s prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 7(c), (B) the registration of the mark under this Act if the application for registration is filed before the effective date of the Trademark Revision Act of 1988, or (C) publication of the registered mark under section 1062 of this title: *Provided, however*, That this defense or defect shall apply only for the area in which such continuous prior use is proved.” 15 USC 1115(b)(5).

known mark

T: An unregistered mark “known to the Examining Attorney and cited as a basis for refusing registration under section 2(d) of the Trademark Act, which allows refusal in view of “a mark or trade name previously used in the U.S. by another and not abandoned.” 15 USC 1052(d), TMEP 1205.04.

known or used by others in this country

P: An applicant is not entitled to a patent if the invention was “known or used by others in this country ... before the invention thereof by the applicant ...” 35 USC 102(a). An invention is “known” by another within the meaning of this provision if information concerning the complete invention was publicly available or accessible. *Carella v. Starlight Archery & Pro Line Co.*, 804 F2 135.

label

C: A pictorial label is a type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii). See also COUNTERFEIT LABEL.

T: A mark on the Supplemental Register may consist of a “label.” 15 USC 1091(c).

It is TRADEMARK INFRINGEMENT to apply a reproduction of a registered mark to a label intended to be used in commerce where such use is likely to cause confusion, or to cause mistake, or to deceive. 15 USC 1114(1)(B). Labels bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

label claim

P: A claim for a new use of a composition in which the use is recited in the preamble as a limitation.

laches

The equitable doctrine that one who does not exercise his legal rights within a reasonable time, which inaction is relied upon by defendant to his prejudice or detriment, is estopped to exercise them later. *Cf. ESTOPPEL*.

P: A defense to past patent infringement.

C: Laches requires a showing of (1) inexcusable delay; and (2) intervening prejudice. *Gordon v. Vincent Youmans, Inc.*, 358 F.2d 261 (2d Cir. 1965).

T: Laches consists of “two essential elements: (1) inexcusable delay in instituting suit, and (2) prejudice resulting to the defendant from the delay.” *Univ. of Pittsburgh v. Champion Products, Inc.*, 686 F.2d 1040, 1044, 215 USPQ 921 (3rd Cir. ***). Laches

is a defense to unfair competition. *Skippy, Inc. v. CPC International, Inc.*, 674 F.2d 209 (4th Cir. ***), *cert denied*, 459 US 969 (1982).

It is said that mere passage of time cannot constitute laches and that a plaintiff may always have an injunction against trademark infringement, though time may bar an accounting for profits. However, where defendant has relied on plaintiff's failure to act and has changed its position by expending substantial sums, an ESTOPPEL BY LACHES may arise to bar any relief. *Birthright v. Birthright*, *** F.Supp. *** (D. N.J. 1993). "[E]quitable principles, including laches, estoppel, and acquiescence" are defenses to TRADEMARK INFRINGEMENT. 15 USC 115(b)(8). "In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied." 15 USC 1069. But see CLEAR AND NOT IN DOUBT.

Laches is not necessarily tolled by an OPPOSITION. *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 572 F.2d 574, 578, 197 USPQ 277 (7th Cir. 1978).

lack of invention

P: One may not receive a patent if "he did not himself invent the subject matter sought to be patented." 35 USC 102(f). Lack of invention, sometimes known as DERIVATION, is a defense to patent infringement and may be used to show INVALIDITY of the patent.

lacks the activated channel capacity

C: A "cable system 'lacks the activated channel capacity' to retransmit on a full-time basis all signals which it is authorized to carry only if: (i) All of its activated television channels are used exclusively for the secondary transmission of television signals; and (ii) the number of primary television transmissions secondarily transmitted by the cable system exceeds the number of its activated television channels." 37 CFR 201.17(b)(10).

language

P: "The application, any amendments or correspondence thereto, and the oath or declaration must be in the English language except as provided for in 1.69 and paragraph (d) of this section, or be accompanied by a verified translation of the application and a translation of any corrections or amendments into the English language." 37 CFR 1.52(a). However, a non-English specification may be accepted upon petition to the Commissioner. 37 CFR 1.52(d). See also RECORDATION.

"When a party relies on a document in a language other than English, a translation of the document into English and an AFFIDAVIT attesting to the accuracy of the translation shall be filed with the document." 37 CFR 1.647.

T: "The application must be in the English language." 37 CFR 2.31.

Lanham Act

T: The act governing federal regulation of trademarks, 15 USC 1051-1127, inclusive. Also known as the TRADEMARK ACT. "The intent [of the Lanham Act] is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties

and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.” 15 USC 1127.

lapsed reserve

C: A PHONORECORD RESERVE that has lapsed because of a failure to offset the reserve within nine months. 37 CFR 201.19(e)(4).

last known address

P: An application made on behalf of a joint inventor who refuses to sign or cannot be found “must state the last known address of the omitted inventor.” 37 CFR 1.47(a), 37 CFR 1.425(a).

late

T: A designation marked on papers received by the PTO after the statutory period for submitting them has expired. TMEP 710.03(b).

late claiming

P: Demise of doctrine: *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986).

later presentation

P: See PRESENTATION.

laudatory

P: Complimentary terminology that does not describe any structure or function of a claimed invention. Laudatory statements are not permitted in patent claims except in plant patents.

T: Laudatory phrases as trademarks may be unregistrable as merely descriptive.

law of nature

P: Laws of nature by themselves are not patentable.

Law Office

T: An administrative unit with in the PTO, under the charge of a MANAGING ATTORNEY.

lawful use in commerce

T: Formerly, an applicant for registration on the Supplemental Register was required to allege that the mark had been “in lawful use in commerce” for one year preceding the date of application. 37 CFR 2.47.

lay open

T: If an application is based upon a subsequent regularly filed application in the same foreign country, the application shall so state and shall show that any prior filed application has been withdrawn, abandoned or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority.” 37 CFR 2.39(a).

lead agent

P: See LEAD ATTORNEY.

lead attorney

P: A 'lead' attorney or agent is a registered attorney or agent of record who is primarily responsible for prosecuting an INTERFERENCE on behalf of a party and is the attorney or agent whom an examiner-in-chief may contact to set times and take other action in the interference." 37 CFR 1.601(k). "Each party may be required to designate one attorney or agent of record as the lead attorney or agent." 37 CFR 1.613(a).

T: An attorney employed by the PTO ***.

lead-time injunction

S: An injunction limited in duration to a time period necessary to negate the commercial advantage obtained by a party who has misappropriated a trade secret over good-faith competitors. UTSA 2(a).

leaf

C: A physical sheet. If a preponderance of a leaf of a work on *** fill in ***. 37 CFR 201.20(b)(3). Leaf and PAGE have the same meaning. See also SINGLE-LEAF WORK.

lease

C: Distribution of copies or phonorecords by lease to the public is a PUBLICATION. 17 USC 101.

leave

T: to file brief exceeding 25 pages
to to submit more than 75 interrogatories.

lecture

C: Lectures, sermons, speeches and addresses, when published individually, are exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(3).

legal entity

C: An entity other than a natural person. The concept is used in the definition of a Berne Convention work and the country of origin thereof. 17 USC 101.

legal representative

P: One who is authorized to act for a party. An executor, administrator, guardian or conservator may apply for a patent for a dead, insane or legally incapacitated inventor. 37 CFR 1.42, 1.43. See also PROOF OF AUTHORITY.

legible

C: A RECORDABLE DOCUMENT must be "legible and capable of being reproduced in legible microform copies." 37 CFR 201.4(c)(3).

lending

C: Distribution of copies or phonorecords by lending to the public is a PUBLICATION. 17 USC 101. See also LOAN.

letter mark

T: A trademark consisting of a letter or letters that do not form a word. TMEP 807.09. Cf. NUMERAL MARK, WORD MARK.

letter of action

T: A letter by which the Examining Attorney communicates an OFFICIAL ACTION to the applicant. TMEP 1106.

letter of objection

T: = LETTER OF PROTEST.

letter of protest

T: A protest from a third party who objects to the registration of a mark. The letter will not be shown to the Examining Attorney unless it “sets forth facts which clearly would affect or prevent registration.” TMEP 1503.03. If the letter is ALLOWED, the applicant will be given an opportunity to meet the objections raised therein.

letterboxing

C: Transforming the frames of a wide-screen motion picture so they can be viewed undistorted on a television screen ***.

lettering

C: “Mere variations of typographic ornamentation, lettering or coloring” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

letters patent

P: Letters patent are “delivered.” 37 CFR 1.315.

It is a criminal offense to forge letters patent. 18 USC 497. See COUNTERFEIT.

lexicographer

P: The patentee may define a term himself and that definition may be utilized to give clear meaning to phrases used in claims and in the specification. A patentee may be his own lexicographer. *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 6 USPQ 2d 1557 (Fed. Cir. 1988).

lexiconning

C: Producing a print of a motion picture that runs at a slightly speeded-up rate to reduce running time.

liaison officer

T: An individual responsible for coordinating the activities of a GOVERNMENT AGENCY with respect to government patent policy. “Each Government agency shall designate a liaison officer to represent the agency before the [Under] Secretary [of Commerce for Economic Affairs]; Provided, however, that the Departments of the Army, the Navy, and the Air Force may each designate a liaison officer.” 37 CFR 501.5.

liber and page

T: Documents recorded prior to 1955 were bound in books and referenced by liber and page. *Cf.* REEL AND FRAME.

library

C: A library may reproduce or distribute not more than one copy or phonorecord of a work, without infringing the copyright therein, provided that “(1) the reproduction is made without any purpose of direct or indirect commercial advantage; (2) the

collections of the library or archives are (i) open to the public, or (ii) available not only to researchers affiliated with the library or archives or with the institution of which it is a part, but also to other persons doing research in a specialized field; and (3) the reproduction or distribution of the work includes a notice of copyright.” 17 USC 108(a).

Librarian of Congress

C: The Librarian of Congress appoints the Register of Copyrights and subordinate officers and employees of the Copyright Office. 17 USC 701(a).

Library of Congress

C: The administrative unit within the Legislative Branch charged through its COPYRIGHT OFFICE with registering copyright claims and related documents.

license

P: 1. Licenses to patents are RECORDABLE in the PTO. 37 CFR 1.331(b).
 2. A license is required from the Commissioner to make a foreign filing on an invention made in the United States prior to six months after filing in the United States. “Except where authorized by a license obtained from the Commissioner a person shall not file or cause to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country.” 35 USC 184. A patent is barred if a filing is made without such license. 35 USC 185.

licensee

P:
 C:
 T:

licensee estoppel

P: Abolished by *Lear v. Adkins*, 395 US 653 (1969). Cf. ASSIGNOR ESTOPPEL.

Licensing Division

C: A division of the Copyright Office that receives filings concerning COMPULSORY LICENSES. 37 CFR 201.1(b).

licensor

P:
 C:
 T:

licensor estoppel

P:
 C:
 T:

lien

P: Liens on patents are RECORDABLE in the PTO. 37 CFR 1.331(b).

life and meaning

P: A limitation in the PREAMBLE of a claim is considered to the extent it gives “life and meaning” to the claim. 164 Q 632. In re Szujna.

life of the author

C: Term

lighthouse

P: No member of the light-house service may own a patent relating to light-houses. “No Commandant of the Coast Guard, light keeper, or other person in any manner connected with the light-house service, shall be interested, either directly or indirectly, in any contract for labor, materials, or supplies for the light-house service, or in any patent, plan, or mode of construction or illumination, or in any article of supply for the light-house service.” 33 USC 725.

likelihood of confusion

T: *** Likelihood more than a possibility ***

Among the factors to be considered in evaluating likelihood of confusion are SIMILARITY of marks, similarity of goods, relationship between the CHANNELS OF TRADE in which the goods move, evidence of ACTUAL CONFUSION, defendant’s INTENT in adopting the mark and the STRENGTH of plaintiff’s mark. *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ 2d 1264 (1st Cir. 1987). In re *E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1958), lists 13 factors to be considered in determining likelihood of confusion: ***

Likelihood of confusion is a question of fact. *Forum Corp.*, 903 F.2d 434.

likelihood of success on the merits

preliminary injunction

limitation

P: claim. See also NEGATIVE LIMITATION.

limited edition

C: An edition of a work that is confined to a particular number of copies, usually less than a few hundred. The concept of a limited edition arises in the definition of a WORK OF VISUAL ART. That an edition of prints is limited is evidenced by means of a CANCELLATION PROOF.

limited publication rule

C: The common law rule that copyright in a published work from which NOTICE has been omitted is not lost if the “author communicates the contents of a manuscript to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale.” *White*, 193 F.2d 744, 746 (***). This rule is not superseded by 17 USC 405(a).

limited rights

The “rights of the Government in limited rights data as set forth in the Limited Rights Notice of subparagraph (g)(2) if included in this clause.” 48 CFR 52.227-14(a). Cf RESTRICTED RIGHTS, UNLIMITED RIGHTS.

limited rights data

In the context of Government procurement, “data (other than computer software) that embody trade secrets or are commercial or financial and confidential or privileged, to the extent that such data pertain to items, components, or processes developed at private expense, including minor modifications thereof.” 48 CFR 52.227-14(a). See also LIMITED RIGHTS NOTICE.

Limited Rights Notice

A legend *** “These data are submitted with limited rights under Government Contract No. _____ (and subcontract _____, if appropriate). These data may be reproduced and used by the Government with the express limitation that they will not, without written permission of the Contractor, be used for purposes of manufacture nor disclosed outside the Government; except that the Government may disclose these data outside the Government for the following purposes, if, any, provided that the Government makes such disclosure subject to prohibition against further use and disclosure. 48 CFR 52.227-14(g)(2)(a).

limited times

P, C: Const.

line number

P: For convenience, the lines of each page of the disclosure and the lines of each claim are usually numbered consecutively. However, this is not required. *Cf.* PAGE NUMBERS.

C: A method of identifying items on a copyright registration. 37 CFR 201.4-201.5(c)(v)

lining

T: Trademark drawings, which are printed in black and white, may be lined to indicate color using lining codes consisting of standard shading patterns. TMEP 807.06. *** + 37 CFR 2.52(e). See also STIPPLING.

linking claim

P: To avoid RESTRICTION ***. “There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application would be proper, but presented in the same case are one or more claims (generally called ‘linking claims’) inseparable therefrom and thus linking together the inventions otherwise divisible.” MPEP 809.03. “If the apparatus claims include a claim to ‘means’ for practicing the process, the claim is a linking claim and must be examined with the elected invention. If it is ultimately allowed rejoinder is required.” MPEP 806.05(e).

[Walker 12:16].

List of Classes

T: The list in the INTERNATIONAL CLASSIFICATION OF GOODS AND SERVICES FOR THE PURPOSE OF REGISTRATION OF MARKS. See also INTERNATIONAL CLASS.

listing

C: A “mere listing of ingredients or contents” is “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

literal element

C: software. 15 USPQ 2d 1577

literal infringement

P: A finding of literal infringement requires that the asserted claims, as properly construed, read on the accused product. *Envirotech Corp. v. A. R. George, Inc.*, 730 F.2d 753, 221 USPQ 473, 477 (Fed. Cir. 1984). “Literal infringement requires that every claim limitation be met exactly in the accused device.” *Conroy*, 27 USPQ 2d 1794, 1796.

literal overlap

P: The principle that even if a claim reads on an accused device, there is no infringement if the structures do not perform “the same work in substantially the same way and accomplish substantially the same result.” *Autogiro Co. of America v. United States*, 384 F2 391 (Ct. Cl. 1969). See FUNCTION/WAY/RESULT. Cf. DOCTRINE OF EQUIVALENTS.

literary work

C: “‘Literary works’ are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.” 17 USC 101. Literary works are copyrightable as provided in 17 USC 102(a). A literary work published only as embodied in PHONORECORDS is exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(4).

little FTC act

A state law prohibiting unfair trade practices, often analogous to the federal FTC act. See also UDAP.

litigation

Litigation papers required to be served on the Solicitor of the PTO should be hand-delivered to the Office of the Solicitor or mailed to Office of the Solicitor, P.O. Box 15667, Arlington, Virginia 22215. 37 CFR 1.1(g).

living individual

T: A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises a name, portrait or signature identifying a particular living individual except by his written consent.” 15 USC 1052(c), 1091(a). The name of a living individual includes nicknames and pseudonyms. *In re New John Nissen Mannequins*, 227 USPQ 569 (TTAB 1985).

living person

T: .

loan

C: See LENDING.

local service area of a primary transmitter

C: An region that, “in the case of a television broadcast station, comprises the area in which such station is entitled to insist upon its signal being retransmitted by a cable system pursuant to the rules, regulations and authorization of the Federal Communications Commission in effect on April 15, 1976.” 17 USC 111(f). The statute also deals with television broadcast stations in Canada and Mexico and radio stations.

logo

C:

long-felt need

P: “The patented invention’s solution of a longstanding problem or satisfaction of a need supported into nonobviousness.” *Under Sea Industries, Inc. v. Dacor Corp.*, 833 F.2d 1551, 4 USPQ 2d 1772 (Fed. Cir. 1987). See SECONDARY CONSIDERATIONS.

look and feel

C: *Whelan Associates, Inc. v. Jaslow Dental Lab.*, 797 F.2d 1202, 230 USPQ 481 (3rd Cir. 1986). See also STRUCTURE, SEQUENCE AND ORGANIZATION.

loss

S: In trade secret misappropriation cases, the trade secret owner’s loss may include lost profits, loss in value of a business, the value of the trade secret, the cost of developing the trade secret and the cost of rectifying the misappropriation.

lost

P: If the original patent sought to be reissued is lost and therefore cannot be surrendered, an affidavit to that effect may be made instead. 37 CFR 1.178.

lost art

P: [Walker 4:15].

lost copy

C: It is not an infringement of copyright for a library or archives to make a facsimile copy or phonorecord of a published work to replace a lost copy if after reasonable effort it determines that an unused replacement cannot be purchased at a fair price. 17 USC 108(c).

lost inventor

P: If an inventor “cannot be found or reached after diligent effort,” his assignee, one to whom he had a duty to assign or “one who shows sufficient proprietary interest in the matter” may file a patent application in his behalf. 35 USC 118.

lost profits

P: Lost profits may be recovered from an infringer for (1) potential sales lost to actual sales made by the infringer; (2) price cuts necessitated by competition from the infringer; and (3) projected lost sales. *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056 (***) . Lost profits may be proven by (1) demand for the patented product; (2)

absence of acceptable noninfringing substitutes; (3) manufacturing and marketing capability to exploit the demand; and (4) the amount of profit that would have been made. 24 USPQ 2d 1321, 1337.

[Walker 27.24].

lost specimen

T: If at least one SPECIMEN is submitted with an application but is determined by the PTO to have been lost, the applicant's remedy is by PETITION TO THE COMMISSIONER including an "affidavit, copies of the relevant specimens and any relevant evidence establishing that the specimens were submitted with the papers as filed." EG 1-91 (Mar. 26, 1991).

*** M ***

C: See MASK WORK NOTICE.

machine

P: A mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. 56 US 252. A function of a machine, apart from the machine itself, is not patentable.

C: The term "machine" includes one now known or later developed. 17 USC 101.

made

P: With respect to a federally funded invention, "made" means "the conception or first actual reduction to practice of such invention." 35 USC 201(g), 37 CFR 401.2(f), 48 CFR 52.227-11(a)(2). See also ESPECIALLY MADE.

Madrid Convention

T: US not a signatory.

magazine

P: A "magazine is effective as a printed publication under 35 USC 102(b) as of the date it reached the addressee and not the date it was placed in the mail." MPEP 706.02., *Protein Foundation, Inc. v. Brenner*, 151 USPQ 561 (D. D.C. 1966).

C: A magazine may not constitute a WORK OF VISUAL ART. 17 USC 101.

T: An injunction restraining publication of an issue of a magazine containing infringing matter or violating matter is not available if the result would be to delay dissemination of the issue beyond the regular time for its delivery. 15 USC 1114(2)(C).

mail

P,T: Mail intended for the PTO "must be addressed to 'Commissioner of Patents and Trademarks,' Washington, D.C. 20231." 37 CFR 1.1(a). Letters concerning patent applications should be designated "PATENT APPLICATION." 37 CFR 1.5(a).

C: "Mail and other communications shall be addressed to the Register of Copyrights, Library of Congress, Washington, DC 20559." 37 CFR 201.1(a).

mailing date

maintenance fee

P: Maintenance fees are required to maintain in force all patents based on applications filed on or after December 12, 1980, except for plant patents based on applications filed on or after August 27, 1982, design patents or reissue patents if the patent being reissued did not require maintenance fees. 37 CFR 1.362(a)-(b). If maintenance fees are not paid, the patent will expire four, eight or twelve years after grant. 37 CFR 1.362(g). Also PATENT ANNUITY.

Mail containing maintenance fee payments should be marked “Box M. Fee.” 37 CFR 1.1(d).

major health or environmental effects test

P: A “test which is reasonably related to the evaluation of the health or environmental effects of a product, which requires at least six months to conduct, and the data from which is submitted to receive permission for commercial marketing or use.” 35 USC 156(f)(3).

making, using or selling

P: Infringing activities that may be excluded by a patentee.

Managing Attorney

T: The attorney in charge of a LAW OFFICE within the PTO.

mandate

CAFC. 37 CFR 1.197(c).

mandatory deposit

C:

Manual of Patent Classification

P:

Manual of Patent Examining Procedure

P: A manual for patent examiners published by the Patent and Trademark Office. It contains the PTO’s interpretation of statute and regulation but does not have the force of law. Abbreviated MPEP.

manufacture

P: Something made by the art of industry or man. 60 F 618. A tangible object, other than a machine or composition of matter, that is man-made and not found in substantially the same form in nature. *Diamond v. Chakrabarty*, 447 US 303 (***). Distinguished from a machine in that a manufacture usually has no moving parts. There is no distinction between a “manufacture” and an “article of manufacture.” *In re Hruby*, 153 USPQ 61.

C: With respect to digital audio recording devices, “to produce or assemble a product in the United States.” 17 USC 1001(8).

manufacturing requirement

P: “A license granting rights to use or sell under a FEDERALLY OWNED INVENTION in the United States shall normally be granted only to a licensee who agrees that any

products embodying the invention or produced through the use of the invention will be manufactured substantially in the United States.” 37 CFR 404.5(a)(2).

C: obsolete ***

manuscript

P: A manuscript may constitute a PRINTED PUBLICATION if it is readily locatable.

C: See UNPUBLISHED WORK.

map

C: One of the types of works protected by the first U.S. copyright act of May 31, 1790. See also book, chart. One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101. A map falls in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS, but cannot be a WORK OF VISUAL ART. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

march-in rights

P: The right of a Federal agency to require a small business firm or non-profit organization, that has acquired title to an invention made by it under a funding agreement with the Government, to license it to a “responsible applicant or applicants, upon terms that are reasonable under the circumstances.” 35 USC 203(1). See also 37 CFR 401.6. A determination under this provision is not subject to the Contract Disputes Act (41 USC 601 et seq.). 35 USC 203(2).

margins

P: In patent applications, the left margin of each page must have a margin of “at least approximately one inch.” The top margin must be “at least approximately 0.75 inch.” 37 CFR 1.52(b). Margins for drawings are specified in 37 CFR 1.71(d), 1.84(b).

mark

T: “The term ‘mark’ includes any trademark, service mark, collective mark, or certification mark.” 15 USC 1127. The Lanham Act thus distinguishes between a mark and a TRADEMARK, the former being registrable on the SUPPLEMENTAL REGISTER. See also DESIGN MARK, LETTER MARK, NUMERAL MARK, WORD MARK.

market

C: See MARKET FOR WORK.

market contraction

P: Reduction in market size resulting from a price increase. A factor in determining LOST PROFITS. 24 USPQ 2d 1321, 1337.

market for work

C: The effect of a use upon the potential market for or value of a copyrighted work is one of the statutory factors to be considered in determining whether the use is a FAIR USE. 17 USC 107.

market power

The power to control or influence a market for particular goods or services.

P: TYING is not PATENT MISUSE unless “the patent owner has market power in the relevant market for the patent or patented product.” 35 USC 271(d)(5).

market research

T: One of the activities indicating effort to use a mark that justifies an extension of time to file a STATEMENT OF USE. 37 CFR 2.89(d)(2).

marking

P: If a patented article is not marked to give NOTICE of the patent, certain remedies for infringement are unavailable to the patentee. 35 USC 287. There is no marking requirement for process patents. *Bandag, Inc. v. Gerrard Tire Co., Inc.*, 704 F.2d 1578. See also FALSE MARKING.

Design patents. [Walker 16:28].

C: 1. See NOTICE OF COPYRIGHT.

2. For notices that must be affixed to data supplied under Government contracts, see generally 48 CFR 52.227. See also LIMITED RIGHTS NOTICE, RESTRICTED RIGHTS NOTICE, SBIR RIGHTS NOTICE.

T: See AFFIXATION, REGISTRATION SYMBOL.

marks registered in the Patent and Trademark Office

T: = REGISTERED MARKS. 15 USC 1127.

Markush claim

P: A particular type of claiming in the alternative in which the inventor names a group of substances from which any may be chosen. For example, “a metal selected from the group consisting of sodium, calcium and potassium.” An exception to the rule against alternative claiming, a Markush claim may only be used to specify a type of material and not a mechanical component. For example, “a fastener selected from the group consisting of a screw, rivet and bolt” would be improper. Named from *Ex parte Markush*, 1925 C.D. 126, 340 O.G. 839. A group defined in this manner is known as a MARKUSH GROUP. “This type of claim is employed when there is no commonly accepted generic expression which is commensurate in scope with the filed which the applicant desires to cover. MPEP 706.03(y). If the components of the group are unrelated, the application may be subject to a requirement of RESTRICTION.

Markush group

P: A set of ***. Normally a Markush group may not name mechanical elements.

“The examiner may require a provisional election of a single species prior to examination “to be given effect in the event that the Markush-type claim should be found not allowable.” MPEP 803.02.

In setting forth a Markush group, “it is improper to use the term ‘comprising’ instead of ‘consisting of’.” MPEP 706.03(y). *Ex parte Dotter*, 12 USPQ 2d 382.

“The materials set forth in the Markush group must ordinarily belong to a recognized physical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property.” MPEP 706.03(y).

See also UNITY OF INVENTION.

mask work

C: A mask work is a “series of related images, however fixed or encoded (A) having or representing the predetermined, three-dimensional pattern of metallic insulating or semiconductor material present or removed from the layers of a SEMICONDUCTOR CHIP PRODUCT; and (B) in which series the relation of the images to one another is that each image has the pattern of the surface of one form of the semiconductor chip product.” 17 USC 901(a)(2).

“The owner of a mask work ... has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the mask work by optical, electronic, or any other means;
- (2) to import or distribute a semiconductor chip product in which the mask work is embodied; and
- (3) to induce or knowingly cause another person to do any of the acts described in paragraphs (1) and (2).” 17 USC 905.

Duration of protection is to the end of the calendar year that includes the tenth anniversary of the date on which the mask work is registered or on which the mask work is first commercially exploited anywhere in the world, whichever comes first. 17 USC 904.

Mask work protection is not available for mask works that are not original or are “STAPLE, commonplace, or familiar in the semiconductor industry, or variations of such designs, combined in a way that, considered as a whole, is not original.” 17 USC 902(b).

See also COMMERCIALY EXPLOIT.

mask work notice

P: A copyright or mask work notice may only appear in a patent document if the required AUTHORIZATION LANGUAGE is included at the beginning of the specification. 37 CFR 1.84(o).

C: “The owner of a mask work ... may affix notice to the mask work, and to masks and semiconductor chip products embodying the mask work, in such manner and location as to give reasonable notice of such protection ... The affixation of such notice is not a condition of protection ... but shall constitute prima facie evidence of notice of protection.” 17 USC 909(a).

“The notice ... shall consist of — (1) the words :mask work, the symbol *M*, or the symbol *** (the letter M in a circle); and (2) the name of the owner or owners of the mask work or an abbreviation by which the name is recognized or is generally known.” 17 USC 909(b).

master

See also SPECIAL MASTER.

masthead

C: “A ‘masthead’ is a body of information appearing in approximately the same location in most issues of a newspaper, magazine, journal, review, or other periodical or serial, typically containing the title of the periodical or serial, information about the staff, periodicity of issues, operation, and subscription and editorial policies of the publication.” 37 CFR 201.20(b)(8).

material

P: Information is material if “there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent.” *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 992, 6 USPQ 2d 1601 (Fed. Cir. 1988).

T: Certification of the material of which goods are made is one of the functions of a CERTIFICATION MARK. 15 USC 1127.

material alteration

T: An alteration is material if the change would require republication if it were made in an application to register. TMEP 1607.02(a). In a trademark application, “amendments may not be made to the DESCRIPTION or DRAWING of the mark if the character of the mark is materially altered.” 37 CFR 2.72(a). A registered mark may be amended if it is not materially altered thereby. 15 USC 1057(c). The new form of mark must create the impression of being essentially the same mark.

material change

P: “A product which is made by a patented process will ... not be considered to be so made after (1) it is materially changed by subsequent processes ...” 35 USC 271(g)?.

material change in position

S: A party who undertakes a material change in position based on a trade secret without constructive knowledge of its secrecy and before receiving notice that it is a secret cannot be prevented from continuing to use the trade secret. Such a party is an INNOCENT USER.

material error

P: “A material error arising through inadvertence or mistake in connection with (1) a PRELIMINARY STATEMENT or (2) drawings or a written description submitted therewith or omitted therefrom, may be corrected by a motion (§1.635) for leave to file a corrected statement. The motion shall be supported by an AFFIDAVIT and shall show that the correction is essential to the ends of justice and shall be accompanied by the corrected statement.” 37 CFR 1.628.

material misrepresentation

P: A required showing to prove INEQUITABLE CONDUCT.

material object

C: A copy of a work is material object in which the work is FIXED. 17 USC 101. “Ownership of a copyright ... is distinct from ownership of any material object in which the work is embodied.” 17 USC 202. Transfer of copyright does not convey property rights in any material object, nor does transfer of ownership of a material object convey copyright. 17 USC 202.

material part

P: One who sells a component of a patented invention that constitutes a “material part of the invention” may be liable as a CONTRIBUTORY INFRINGER. 35 USC 271(c).

mathematical algorithm

P:

mathematical formula

P: Mathematical formulas are not patentable. *Gottschalk v. Benson*, 409 US 63 (1972).

matter

P: See also NEW MATTER, SUBJECT MATTER.

matter of common knowledge

P: See also WELL KNOWN.

matrix

Matrices bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION, MEANS OF MAKING.

means

P: A general term in patent claiming for any structure or device capable of performing a recited function. Example, “means for reducing the diameter thereof,” which could include a die, press or stretching apparatus.

means for clause

P: A clause in a claim that defines an element via its function rather than its structure. Means for clauses are specifically authorized by 35 USC 112: “an element in a claim for a combination may be expressed as a means ... for performing a specified function.” The scope of a means clause includes disclosed structures and their equivalents. *Radio Steel & Mfg. Co. v. MTD Productions, Inc.*, 731 F.2d 840, 221 USPQ 657 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 831 (1984). However, a means clause must use the word “means” or it will not be accorded such a scope. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 19 USPQ 2d 1367 (Fed. Cir. 1991).

means of making

Means of making infringing copies of a mark, including PLATES, MOLDS and MATRICES, may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

means-plus-function claim

P: A claim in which an element is described not by specifying its components but by setting forth the function it performs. “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 USC 112.

To infringe a means-plus-function claim, “an accused device must (1) perform the identical function claimed for the means element, and (2) perform that function using the structure disclosed in the specification or an equivalent structure.” *Intel Corp. v. U. S. Int’l. Trade Comm’n.*, 946 F.2d 821, 841, 20 USPQ 2d 1161 (Fed. Cir. 1991).

mechanical drawing

C: A mechanical drawing illustrating a scientific or technical work is exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(1).

medical device

P: 35 USC 156(d)(2)(A)(ii). See also PATENT TERM EXTENSION.

mental steps doctrine

P: The principle that the patentability of a method cannot be based solely on steps that can be performed by human mental effort, possibly with the benefit of paper, pencil and unlimited time. *In re Abrams*, 89 USPQ 266 (***) . If a computer is claimed for performing the steps, however, the mental steps doctrine will not apply, since the claims will no longer read on human mental activity. *In re Prater and Wei II*, 162 USPQ 541

merchandising item

C: A merchandising item may not constitute a WORK OF VISUAL ART. 17 USC 101.

mere function of machine

P: “In view of the decision of the Court of Customs and Patent Appeals in *In re Tarczy-Hornoch* at 158 USPQ 141 (CCPA 1968), process or method claims are not subject to rejection by Patent and Trademark Office examiners solely on the ground that they define the inherent function of a disclosed machine or apparatus.” MPEP 706.03(r).

mere making

P: [Walker 4:11, 7:17].

merely descriptive

T: A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, use, etc. of the goods or services to which it is applied. *In re MetPath, Inc.*, 223 USPQ 88. “Merely” means “only” or “solely.” TMEP 1207. A mark may be refused registration on the principal register if it “consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them.” 15 USC 1052(e). Permitting on person to appropriate ordinary language to describe goods would be detrimental to others and would not necessarily denote origin. TMEP 1207.

merger

C: See IDEA/EXPRESSION MERGER.

method

C: “Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(b). See also METHOD OF OPERATION.

P: A procedure for accomplishing a result.

S: A “method” may constitute a trade secret under UTSA 1(4).

method claim

P: Also PROCESS CLAIM. *Cf.* APPARATUS CLAIM.

method of doing business

P: “Though seemingly within the category of a process or method, a method of doing business can be rejected as not being within the statutory classes.” MPEP 706.03(a). *In re Wait*, 24 USPQ 88 (1934).

method of operation

C: “In no case does copyright protection ... extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 USC 102(b). The same provision applies to mask works. 17 USC 902(c).

microfiche appendix

P: A microform medium for submitting computer program listings as part of a patent specification. The microfiche must conform to ANSI or NMA standards. 37 CFR 1.96(b). It is available to anyone who orders the file wrapper.

microorganism

P: deposit. MPEP 608.01(p). Budapest Treaty.

military personnel

P: Acts of invention by military personnel domiciled in the United States but serving in a foreign country are considered to have been made in the United States in establishing a date of invention. 35 USC 104.

Miller v. Brass doctrine

P: [Walker 14:27. reissue.

Miller-Tydings Act

P: Walker Appx 49. resale price management.

misappropriation

S: “‘Misappropriation’ means:

(i) acquisition of a trade secret by another by a person who knows or has reason to know that the trade secret was acquired by improper means; or
(ii) disclosure or use of a trade secret of another without express or implied consent by a person who

(A) used improper means to acquire knowledge of the trade secret; or

(B) at the time of disclosure or use, knew or had reason to know that his knowledge of the trade secret was

(I) derived from or through a person who had utilized improper means to acquire it;

(II) acquired under circumstances giving rise to a duty to maintain its secrecy or limit its use; or

(III) derived from or through a person who owed a duty to the person seeking relief to maintain its secrecy or limit its use; or

(C) before a material change of his [or her] position, knew or had reason to know that it was a trade secret and that knowledge of it had been acquired by accident or mistake.” UTSA 1(2).

miscellaneous design

T:

miscellaneous motion

P: In an INTERFERENCE, “[a] party seeking entry of an order relating to any matter other than a matter which may be raised under 1.633 or 1.634 may file a motion requesting entry of the order.” 37 CFR 1.635.

misdescriptive

T: See DECEPTIVELY MISDESCRIPTIVE.

misjoinder

P: The erroneous statement in a patent application that X is an inventor when he is not or that X is not named but is in fact an inventor. If the error was made without “deceptive intent,” then ***

mismarking

P: Use of “patented.”

T: Use of ® when mark is not registered.

misrepresentation

P: See MATERIAL MISREPRESENTATION.

T: It is a defense to TRADEMARK INFRINGEMENT “[t]hat the registered mark is being used, by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used.” 15 USC 1115(b)(3).

misspelling

T: “If the mark consists of a word or words which are misspelled in the mark but nonetheless must be disclaimed, the examining attorney should require disclaimer of the word or words in the correct spelling, provided a disclaimer is otherwise required under Office policy.” EG 91-2.

mistake

P: Mistake. [Walker 21:15].

Mistake in specification. [Walker 10:15].

Mistake as to inventor. [Walker 8:5].

Mistake in disclaimers. [Walker 18:6].

See MATERIAL ERROR.

T: A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 USC 1052(d), 1091(a).

A mistake in a registration is cured by a CERTIFICATE OF CORRECTION. 15 USC 1057(h).

misuse

P: See PATENT MISUSE.

C: See COPYRIGHT MISUSE.

T: See TRADEMARK MISUSE.

mixed question

A question that requires resolution of both a QUESTION OF FACT and a QUESTION OF LAW. Examples:

C: Whether a use is a FAIR USE.

mode of manufacture

T: Certification of the mode of manufacture of goods is one of the functions of a CERTIFICATION MARK. 15 USC 1127.

mode of operation

P: A mode of operation attributed to a reference may result in denial of a patent. 37 CFR 1.132. See also CAPABILITY OF OPERATION.

mode or manner of use

T: A statement of use filed in connection with an intent-to-use application must specify the “mode or manner in which the mark is used on or in connection with” goods or services. 15 USC 1051(d)(1).

model

P: The Commissioner may require the applicant to furnish a model or convenient size to exhibit advantageously the several parts of his invention.” 35 USC 114, 37 CFR 1.92. Models no longer required, except for perpetual motion machines. “If the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.” 35 USC 114, 37 CFR 1.93. Models were formerly required in all cases admitting a model, but now are not admitted unless called for. 37 CFR 1.91. On abandonment or conclusion of the case, they will be returned to the applicant at his expense. 37 CFR 1.94.

C: The Copyright Act of July 8, 1870 extended protection to “models or designs thereof intended to be perfected as works of the fine arts.”. See also STATUTORY. A model falls in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS, but may not be a WORK OF VISUAL ART. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

model designator

T: Numbers intended for use solely as model designators are prima facie merely descriptive. *Eastman Kodak Co. v. Bell & Howell Document Management Prods. Co.*, 26 USPQ 2d 1912, 1916 (Fed. Cir. 1993).

model release

U:

modicum of creative work

C: A “modicum of creative work” is required for copyrightability. *Amsterdam v. Triangle Publication, Inc.*, 189 F.2d 104 (3rd Cir. 1951).

modification

P: modification of decision. *** Request for Board to modify. 37 CFR 1.197(b).

C: The author of a WORK OF VISUAL ART has the right to prevent a modification of it that would be prejudicial to his honor or reputation and, if it is so modified, has the right to prevent his name from being used as its author. 17 USC 106A.

modifications

C: A work consisting of modifications to an existing work may constitute a DERIVATIVE WORK. 17 USC 101.

mold

Molds bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION, MEANS OF MAKING.

monopoly

P:

Monthly Statement of Account

C: A “Monthly Statement of Account is a statement accompanying monthly royalty payments identified in [17 USC 115(c)(3)] and required by that section to be made under the COMPULSORY LICENSE to make and distribute PHONORECORDS of NON-DRAMATIC MUSICAL WORKS.” 37 CFR 201.19(a)(1). Cf. ANNUAL STATEMENT OF ACCOUNT.

Monthly Statement of Account Under Compulsory License for Making and Distributing Phonorecords

C: The required formal identification of a MONTHLY STATEMENT OF ACCOUNT. 37 CFR 201.19(e)(2).

moral rights

C: droit moral, droit de suite, droit voisin

ATTRIBUTION, DISCLOSURE, INTEGRITY, PATERNITY, WITHDRAWAL.

Under the Berne Convention, “the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification to said work, which would be prejudicial to his honor or reputation.”

morals

P: An invention deemed “injurious to public health or morals” may be denied a patent. Such a rejection may be overcome by affidavit. 37 CFR 1.132.

mortgage

P: Mortgages of patents are RECORDABLE. 37 CFR 1.331(b). [Walker 19:32].

C: See TRANSFER OF COPYRIGHT.

T:

motion

P: Interference: MISCELLANEOUS MOTION, MOTION TO CORRECT INVENTORSHIP, PRELIMINARY MOTION. “Motions will be decided by an examiner-in-chief ... An examiner-in-chief may grant or deny any motion or take such other action which will secure the just, speedy, and inexpensive determination of the interference.” 37 CFR 1.640(b).

motion picture

C: “‘Motion pictures’ are audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.” 17 USC 101. Copyright protection was extended to include motion pictures by the Act of August 24, 1912. A type of WORK OF THE PERFORMING ARTS. 37 CFR 202.3(b)(1)(ii). A “motion picture version” of a work may constitute a DERIVATIVE WORK. 17 USC 101. A motion picture may not constitute a WORK OF VISUAL ART. 17 USC 101. See also COUNTERFEIT LABEL, SOUNDTRACK.

“Motion pictures that consist of television transmission programs and that have been published, if at all, only by reason of a license or other grant to a nonprofit institution of the right to make a fixation of such programs directly from a transmission to the public “are exempt from DEPOSIT requirements.” 37 CFR 202.19(c)(12).

“In the case of a motion picture, a copy is ‘complete’ if the reproduction of all of the visual and aural elements comprising the copyrightable subject matter in the work is clean, undamaged, undeteriorated, and free of splices, and if the copy itself and its physical housing are free of any defects that would interfere with the performance of the work or that would cause mechanical, visual, or audible defects or distortions.” 37 CFR 202.19(b)(2)(ii).

motion to call up

P: In CAFC appeals, a motion to incorporate parts of the administrative record below as part of the record on appeal to avoid extensive appendices.

motion to correct inventorship

P: “A party may file a motion to (a) amend its application involved in an INTERFERENCE to correct INVENTORSHIP ... or (b) correct inventorship of its patent involved in an interference.” 37 CFR 1.634. See DILIGENTLY FILED.

MPEP

P: Abbreviation for the MANUAL OF PATENT EXAMINING PROCEDURE.

multimedia

C: See *Multimedia: The Convergence of New Technologies and Traditional Copyright Protection*, 71 Denver U. L. Rev. 635 (1994).

multiple class application

T: An application to register a mark for items classified in more than one class. TMEP 202.01(b). An application may be “filed to register the same mark for goods and/or services comprised in multiple classes, provided that the goods or services are specifically identified.” 37 CFR 2.86(a). A single registration certificate is issued for such marks, but the fee must be paid for each class covered by the registration. 15 USC 1112. See also DIVISION.

“The applicant may not allege use as to certain goods or services and a bona fide intention to use as to other goods or services in the same application, regardless of the number of classes contained therein.” 37 CFR 2.86(c).

multiple dependent claim

P: “A dependent claim which refers to more than one other claim.” 37 CFR 1.75(b). “A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.” 35 USC 112. See also MULTIPLE ON MULTIPLE.

For purposes of computing application fees, a multiple dependent claim is counted as that number of dependent claims in accordance with the number of claims that are referenced therein. 35 USC 41. Multiple dependent claims are not permitted in plant and design patents, which must present only a single claim. 35 USC 162, 35 USC *** (designs).

multiple on multiple

P: A MULTIPLE DEPENDENT CLAIM depending from another multiple dependent claim. Such a claim is not permitted in U.S. practice under 35 USC 112.

multiplication of parts

P: [Walker 22:32].

multiplicity

P: “More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied.” 37 CFR 1.75(b). “An unusual number of claims that is unreasonable in view of the nature and scope of applicant’s invention and the state of the art may afford a basis for rejection on the ground of multiplicity.” MPEP 706.03(1).

multi-product mark

T: A trademark that is used on more than one product. 1990 Bacal 1.3.

municipality

T: A mark may be refused registration on either the principal or the supplemental register if it “consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 USC 1052(b), 1091(a).

Municipalities may register collective and certification marks even if they do not possess an industrial or commercial establishment. 15 USC 1054.

music publisher

C: With respect to DIGITAL AUDIO RECORDING DEVICES, a “person that is authorized to license the reproduction of a particular work in a sound recording.” 17 USC 1001(9).

musical arrangement

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101. It may also constitute a DERIVATIVE WORK. 17 USC 101.

musical composition

C: Musical compositions first received copyright protection in the Act of February 3, 1832.

musical work

C: Includes “any accompanying words.” 17 USC 102(a). A type of WORK OF THE PERFORMING ARTS. 37 CFR 202.3(b)(1)(ii). See also CONDUCTOR’S SCORE, SCORE. A musical work published only as embodied in PHONORECORDS is exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(4).

mutant

P: Plant. 35 USC 161.

mutilation

C: The author of a WORK OF VISUAL ART has the right to prevent a mutilation of it that would be prejudicial to his honor or reputation and, if it is so mutilated, has the right to prevent his name from being used as its author. 17 USC 106A.

T: With respect to a drawing in a trademark application, a term used to indicate that “essential and integral subject matter is missing.” TMEP 807. A registration cannot be obtained for a mutilation of a mark.

name

P: “A patent must be applied for in the name of the actual inventor or inventors. Full names must be stated including the family name and at least one given name without abbreviation together with any other given name or initial. 37 CFR 1.41(a).

T: A “name” may serve as a trademark. 15 USC 1127.

A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises a ... name portrait or signature identifying a particular living individual” except by his written consent,” or identifying “a deceased President of the United States during the life of his widow, except by the written consent of the widow.” 15 USC 1052(c), 1091(a).

T: It is a defense to trademark infringement that “the use of the name, term or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.” 15 USC 1115(b)(4).

International classes have “names.” TMEP 1401.02. *Cf.* TITLE.

named inventor

P: An inventor who is identified in a patent application.

naming

P: “Applicant may be his own LEXICOGRAPHER.” 128 USPQ 117, 119 (***).

narrow claim

P: A claim is narrow if its scope includes only disclosed embodiments. Claim B is narrower than claim A if every element of A is an element of B or, if A and B have the same elements, then some element of B is qualified over the corresponding element of A, but the converse does not hold. Another way of expressing the relationship is to say that A is narrower than B if any device B can be read on, A can also be read on (but not the converse). *Cf.* BROAD CLAIM.

national

C: Published works of nationals of the U.S. or of a foreign nation that is a party to a copyright treaty to which the U.S. is also a party are subject to copyright protection. 17 USC 104(b)(1).

National Aeronautics and Space Administration

P: The Administrator may have patents on aeronautics and space activities issued to him. 42 USC 2457. Abbreviated NASA.

national application

P: A “U.S. national application for a patent which was either filed in the Office under 35 USC 111 or which resulted from an international application after compliance with 35 USC 371.” 37 CFR 1.9(a). See also PATENT APPLICATION.

National Archives

C: “In the case of unpublished works, the Library is entitled ... to select any deposits ... for transfer to the National Archives of the United States or to a Federal records center, as defined in section 2901 of title 44.” 17 USC 704(b).

National Commission on New Technological Uses of Copyrighted Works

C: Abbreviated CONTU.

national emergency

P: A secrecy order issued during a national emergency declared by the President remains in effect for the duration of the national emergency and for a period of six months thereafter. 35 USC 181.

national fee

P: PCT. 35 USC 371(c), 376(a)(4).

National Micrographics Association

P: An organization that promulgates standards for microforms applicable to the MICROFICHE APPENDIX. Abbreviated NMA.

national stage

P: PCT

National Stolen Property Act

18 USC 2314. Used to prosecute theft of trade secrets. Applies to “goods, wares or merchandise.”

national symbol

T: A mark that may disparage or falsely suggest a connection with national symbols or bring them into contempt or disrepute may be refused registration, either on the Principal or the Supplemental Register. 15 USC 1052(a), 1091(a). “A national symbol is subject matter of a unique and personal significance which because of its meaning, appearance and/or sound immediately suggests or refers to the country for which the symbol stands.” TMEP 1202.03(b). National symbols differ from INSIGNIA of nations in that they are not formally adopted.

national treatment

C: The UNIVERSAL COPYRIGHT CONVENTION grants the same protection to works in a country as that country affords to its own nationals for works originating in that country.”

natural person

T: A human being, living or dead, as opposed to a JURISTIC PERSON.

natural zone of expansion

T: The owner of a federally registered mark is entitled to injunctive relief in the market it actually serves plus its natural zone of expansion. *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 121 USPQ 430 (2d Cir. 1959).

naturally occurring article

P: A “thing occurring in nature, which is substantially unaltered, is not a ‘manufacture’ and hence does not constitute PATENTABLE SUBJECT MATTER.” MPEP 706.03(a). *Ex parte Grayson*, 51 USPQ 413.

nature of the copyrighted work

C: One of four statutory factors to be considered in determining whether a use is a FAIR USE.” 17 USC 107.

naval nuclear propulsion

P: The right of a non-profit organization or small business firm to retain title to an invention made under a funding agreement to operate a Government-owned facility primarily dedicated to the Department of Energy’s naval nuclear propulsion program may be restricted under 35 USC 202(a). See also WEAPONS.

Navy

P: See LIAISON OFFICER.

near resemblance

T: An applicant for federal trademark registration must state that no one else “to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.” 15 USC 1051(a)(1)(A).

necessary party

P: The Commissioner is not a necessary party to an interference appeal. 35 USC 146.

negative information

S: Information that a process, method or approach does not work. Negative information may constitute a trade secret under UTSA 1(4) (Commissioners’ Comment).

negative limitation

P: A claim LIMITATION defined by exclusion rather than inclusion, i.e., by specifying what an element does not consist of rather than what it does. Because there may be an unlimited number of things an element may not be, a negative limitation may cause a claim to be unduly broad or INDEFINITE. However, negative limitations are permissible.

“The inclusion of a negative limitation shall not, in itself, be considered a sufficient basis for objection to or rejection of a claim. However, if such a limitation renders the claim unduly broad or indefinite or otherwise results in failure to point out the invention in the manner contemplated by 35 USC 112, an appropriate rejection should be made.” MPEP 706.03(d). It is proper to use a negative limitation at the very POINT OF NOVELTY. 156 USPQ 90. See also HOLE.

negative rules of invention

P: Unless unexpected results are obtained, various conventional transformations and operations on objects do not result in patentable invention. Among these are changing the size of an article, substituting a new material for an existing material and making an apparatus portable. See, e.g., *Sinclair and Carroll Co., Inc. v. Interchemical Corp.*

Examples: [Walker 6:6].

aggregation. [Walker 6:16].

change of degree, form, location, proportion or size

conversion of manual to mechanical operation

duplication of parts

making old devices adjustable, durable, movable or portable

mere exercise of skill expected of one of ordinary skill in the art

new use

omission of parts

reversal of parts

substitution of equivalents

substitution of materials or elements

superior workmanship

unification or multiplication of parts

negative prosecution

P: [Walker 12:50].

negative reserve balance

C: “A ‘negative reserve balance’ comprises the aggregate number of phonorecords, if any, that have been relinquished from possession for purposes of sale accompanied by a privilege of return ... and that have been returned to the COMPULSORY LICENSEE, but because all available PHONORECORD RESERVES have been eliminated, have not been used to reduce a phonorecord reserve” 37 CFR 201.19(a)(7). *** CHECK QUOTE ***

negotiation authority

P: E.g. telephone restriction practice is limited to examiners having negotiation authority.

network station

C: A “television broadcast station that is owned or operated by, or affiliated with, one or more of the television networks in the United States providing nationwide transmissions, and that transmits a substantial part of the programming supplied by such networks for a substantial part of that station’s typical broadcast day.” 17 USC 111(f). For purposes of 35 USC 119, the term also includes “any translator station or

terrestrial satellite station that rebroadcasts all or substantially all of the programming broadcast by a network station.” 35 USC 119(d)(2).

new and useful

P: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor ... ” 35 USC 101.

new animal drug

P: 35 USC 271(e)(1). Defined in the Federal Food Drug and Cosmetic Act. Exception to rule on non-infringement.

new application

T: An application that has not yet received an action by the Examining Attorney. TMEP 401. *Cf.* AMENDED APPLICATION, NEW APPLICATION AWAITING RESPONSE BY APPLICANT, OLD APPLICATION.

new application awaiting response by applicant

T: An application that has received a first official action but for which no first response has been filed by the applicant. TMEP 401.

new drug application

P: An application to the Food and Drug Administration covering a a new drug product. The approval of such new drug application may result in a PATENT TERM RESTORATION. 35 USC 155A(a)(1)(C).

new matter

P: Material not disclosed in a patent application as of its EFFECTIVE FILING DATE. New matter may not be added to an application after it is filed, for to allow it would make filing dates meaningless. “No amendment shall introduce new matter into the disclosure of an application after the filing date of the application.” 35 USC 132, 37 CFR 1.118. A claim reciting elements without support in the original disclosure is rejected on the ground of new matter. MPEP 706.03(a).

new property

P: The discovery of a new property of an old composition does not impart patentability to the composition. *In re Spada*, 15 USPQ 2d 1655.

new use

P: A new use for an old composition does not render the composition itself patentable, but the new use may be patentable as a process. *In re Thuau*, 159 F.2d 379, 57 USPQ 324.. A new use may be patentable if there is any change to the structure of an article of manufacture. *Traitel Marble Co. v. Hungerford Brass & Copper Co.*, 18 F.2d 66. See also DISCOVERED USE DOCTRINE, LABEL CLAIM, TECHNICAL NOVELTY. [Walker 11:9].

newly discovered evidence

T: Newly discovered evidence may be introduced in TTAB proceedings only if it could not have been discovered earlier through the exercise of reasonable diligence. *Rowell Laboratories, Inc. v. Canada Packers, Inc.*, 215 USPQ 523 (TTAB 1982).

news reporting

C: It is not an infringement of copyright to make FAIR USE of a copyrighted work for purposes such as news reporting. 17 USC 107.

newspaper

C: A newspaper may not constitute a WORK OF VISUAL ART. 17 USC 101.

T: An injunction restraining publication of an issue of a newspaper containing infringing matter or violating matter is not available if the result would be to delay dissemination of the issue beyond the regular time for its delivery. 15 USC 1114(2)(C).

next of kin

C: See RENEWAL CLAIMANT.

nexus

P: In inter partes proceedings, obviousness can be rebutted by showing a NEXUS between the merits of the invention and its COMMERCIAL SUCCESS. *Ex parte Remark*, 15 USPQ 2d 1498 (***? 1990). See also SECONDARY CONSIDERATIONS.

NMA

P: = NATIONAL MICROGRAPHICS ASSOCIATION.

no defect reissue

P: [Walker 19:10].

Noerr-Pennington defense

[McC 31.26[4].]

nominal party

P: Exclusive licensee must be joined.

non-analogous art

P: PRIOR ART that is not ANALOGOUS ART and therefore not usable as the basis for a REJECTION.

non-art rejection

P: See FORMAL REJECTION.

noncommercial educational system

C: A “television station that is a noncommercial educational broadcast station as defined in section 397 of title 47.” 17 USC 111(f). *** 47 USC 397.

non-commercial use

P: “In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use or sale of that product.” 35 USC 271(g).

non-competition agreement

U: A contract by which a party agrees not to compete with the business of another. A type of restrictive covenant. Such an agreement is in restraint of trade and enforceability varies widely from state to state. Generally, a non-competition agreement will be enforced if it is (1) reasonable in time and geographic extent and type

of activity prohibited to protect employer's legitimate interests; and (2) not contrary to public policy.

non-competitive goods or services

T:

non-disclosure agreement

S: A contract by which a party agrees not to divulge a trade secret or other confidential information. Also CONFIDENTIALITY AGREEMENT.

non-dramatic literary work

C: One of the four classes of works in which copyright may be claimed, comprising “all published and unpublished nondramatic literary works.” 37 CFR 202.3(b)(1)(i). *** 17 USC 102(a). These works are registered on Form TX.

nonessential component

P: A product is not considered to be “made by a patented process” if “it becomes a trivial and unessential component of another product.” 35 USC 271(g).

non-exclusive license

P:

C: The granting of a non-exclusive license is not a TRANSFER OF COPYRIGHT. A non-exclusive license may be oral.

T:

non-fiction

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i).

non-infringing substitute

P: The question of existence of a non-infringing substitute is a QUESTION OF FACT. 24 USPQ 2d 1321, 1337. See LOST PROFITS.

non-joinder

P: The omission of an inventor's name from a patent application. All inventors must be named, even if they have subsequently disposed of their rights. 35 USC 116.

non-literal element

C: software. 15 USPQ 2d 1577

non-obvious

P:

nonprofit educational purposes

C: Whether a use of copyrighted work is for nonprofit educational purposes is a factor in determining whether it is a FAIR USE. 17 USC 107(1).

nonprofit organization

P: As used in chapter 1 of 37 CFR, “nonprofit organization” means “(1) a university or other institution of higher education located in any country; (2) an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 USC 501(c)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 USC 501(a)); (3) any nonprofit scientific or educational organization qualified

under a nonprofit organization statute of a state of this country (35 USC 201(i)); or (4) any nonprofit organization located in a foreign country which would qualify as a nonprofit organization under paragraphs (e)(2) or (3) of this section if it were located in this country.” 37 CFR 1.9(e).

With respect to a federally funded invention, “nonprofit organization” means “universities and other institutions of higher education or an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 USC 501(c)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 USC 501(a)) or any nonprofit scientific or educational organization qualified under a State nonprofit organization statute.” 35 USC 201(i), 48 CFR 52.227-11(a)(3).

A non-profit organization may be a “contractor” within the meaning of 35 USC 201(c) if it is a party to a funding agreement.

See also SMALL ENTITY.

C: See also MOTION PICTURE.

non-statutory

P: A claim or subject matter that does not fall within one of the categories of patentable subject matter enumerated in the Patent Act, 35 USC 101.

non-statutory time period

P: A period of time, set by the Commissioner and not by statute, within which an applicant or requester may take an action.

nonuse

P: (As showing non-utility) [Walker 5:16]

T:

Northern Regional Research Laboratories

P: An approved DEPOSITORY located at U.S. Department of Agriculture, 1815 N. University Street, Peoria, IL 61604. Abbreviated NRRL.

not in accordance with law

Administrative Procedure Act. ***. See also ARBITRARY, CAPRICIOUS.

notice

P: “Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word “patent” or the abbreviation “pat.,” together with the number of the patent, or where, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice.” 35 USC ***.

Notice of patent suits. The clerk of the district court in which an action involving a patent is brought must notify the PTO of the suit and the decision. 35 USC 290.

Notice of prospective grant of license to a FEDERALLY FUNDED INVENTION. 37 CFR 404.7(b)(1)(i).

C: Notice of termination.

See notice of copyright.

T: “In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the

Commissioner shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights to registration.” 15 USC 1067.

The Commissioner is notified of any appeal to district court from an inter partes decision of the TTAB, 15 USC 1071(b)(2).

It is the duty of the clerks of the federal courts to notify the Commissioner within one month of the filing of any action involving a federally registered mark. 15 USC 1116(c).

The United States attorney must receive “such notice as is reasonable under the circumstances” of an application for seizure under the Trademark Counterfeiting Act, 15 USC 1116(d).

See also NOTICE OF REGISTRATION.

notice of allowability

P: Notification by the PTO that one or more claims of a patent application have been allowed, specifying an issue fee to be paid by the applicant. 35 USC 151.

notice of allowance

P: The informal designation for a NOTICE OF ALLOWABILITY.

T: With respect to an INTENT-TO-USE APPLICATION,
“Unless registration is successfully opposed — ...

(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1(b).” 15 USC 1063(b)(2). See PUBLICATION.

An intent-to-use application “may not be amended during the period between the issuance of the notice of allowance under section 13(b)(2) of the [Lanham] Act and the filing of a statement of use under §2.88, except to delete specified goods and services.” 37 CFR 2.77.

notice of appeal

P: To BPAI from examiner.

To CAFC, notice to Commissioner and three copies to the Clerk of the CAFC. 37 CFR 1.302(a).

T: To TTAB, within period for response to office action. To CAFC or District Court, by written notice of appeal within a period prescribed by the Commissioner, which must be at least 60 days. 15 USC 1071(a)(2).

notice of arbitration award

P: An ARBITRATION award in a patent interference or contract involving a patent is unenforceable until notice of the award is given to the Commissioner. 35 USC 135(d), 294(c); 37 CFR 1.335(c).

Notice of Change of Identity or Signal Carrier Complement

C: See also INITIAL NOTICE OF IDENTITY AND SIGNAL CARRIER COMPLEMENT.

notice of copyright

P: A copyright or mask work notice may only appear in a patent document if the required AUTHORIZATION LANGUAGE is included at the beginning of the specification. 37 CFR 1.84(o).

C: Notice “may be placed on publicly distributed copies from which the work can be visually perceived ...” 17 USC 401(a). “If the notice appears on the copies, it shall consist of the following three elements: (1) the symbol © (the letter C in a circle), or the word “Copyright,” or the abbreviation “Copr.”; and (2) the year of first publication of the work; in the case of compilations or derivative works incorporating previously published material, the year date of first publication of the compilation or derivative work is sufficient. The year date may be omitted where a pictorial, graphic or sculptural work, with accompanying text matter, if any, is reproduced in or on greeting cards, postcards, stationery, jewelry, dolls, toys, or any useful articles; and (3) the name of the owner of copyright in the work, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner.” 17 USC 401(b). “The notice shall be affixed to the copies in such manner and location as to give reasonable notice of the claim of copyright.” 17 USC 401(c). For phonorecords of sound recordings, the required notice is of identical form except that the letter P in a circle is used. 17 USC 402(b)(1).

See also LIMITED PUBLICATION RULE, MASK WORK NOTICE.

notice of identity

C: Cable systems *** 17 USC 111(d).

notice of informal patent application

P:

notice of informal patent drawings

P:

notice of infringement

P: To be a willful infringer, a party must have actual or constructive notice of infringement. For the purposes of 35 USC 287, “actual knowledge, or receipt by a person of a written notification, or a combination thereof, of information sufficient to persuade a reasonable person that it is likely that a product was made by a process patented in the United States.”

notice of intent to argue abandonment, suppression or concealment

P: In an INTERFERENCE, “[a] notice shall be filed by a party who intends to argue that an opponent has abandoned, suppressed or concealed an actual reduction to practice (35 U.S.C. 102(g)) ... Unless authorized by an examiner-in-chief, a notice is timely filed with ten (10) days of the close of the testimony-in-chief of the opponent.” 37 CFR 1.632.

notice of intent to publish a statutory invention registration

P: 37 CFR 1.296.

notice of intention

C: To make phonorecords. *** 17 USC 115(b), 37 CFR 201.18(a).

notice of interference

P: “Notice of declaration of an INTERFERENCE will be sent to each party.” 37 CFR 1.611(a). “Notice may be given in the *Official Gazette* that an interference has been declared involving a patent.” 37 CFR 1.611(e). [Walker 13:8]

T: A notice is sent by the PTO that an INTERFERENCE has been instituted. 37 CFR 2.93.

notice of opposition

T: A pleading filed with the TTAB to initiate an opposition proceeding to oppose registration of a published mark. When an opposition is filed, the parties are so informed by the Commissioner. 15 USC 1067. A Notice of opposition “must set forth a short and plain statement showing why the opposer believes it would be damaged by the registration of the opposed mark and state the grounds for opposition.” 37 CFR 2.104. See also REASONABLE CERTAINTY.

notice of prior art

P: 30 days before trial. 35 USC 282.

Notice of Proceeding under 35 USC 32

P: See DISCIPLINARY PROCEEDING.

notice of protection

C: With respect to a mask work, “[h]aving ‘notice of protection’ means having actual knowledge that, or reasonable grounds to believe that, a mask work is protected under this chapter.” 17 USC 901(a)(8). See also INNOCENT PURCHASER, MASK WORK NOTICE.

notice of publication

T: A notice mailed to an applicant indicating the date on which a mark will be published for opposition in the Official Gazette.

notice of references cited

P:

notice of registration

T: A registrant “may give notice that his mark is registered by displaying with the mark the words “Registered in U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” or the letter R enclosed within a circle, thus ®.” 15 USC 1111. See also REGISTRATION SYMBOL. If the registrant fails to give such notice, he may not recover profits or damages for infringement unless the defendant had ACTUAL NOTICE of the registration. 15 USC 1111.

notice of rejection

P When any claim of a patent application is rejected by the examiner, the applicant must be notified and reasons for the rejection given, together with “such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.” 35 USC 132. Notice of rejection are generally referred to as OFFICE ACTIONS.

notice of reliance

T: A document by which one party to an inter partes case before the TTAB identifies those portions of the record or testimony on which it will rely to prove its case. *** CFR.

notice of signal carriage complement

C: Cable systems *** 17 USC 111(d).

notice of stay of regulation of approval

P: 35 USC 155.

notice of termination

C: Termination of transfer. *** 17 USC 203.

Notice to File Missing Parts

P: A form sent to notify the applicant that the application is incomplete. 37 CFR 1.53(d).

novelty

P:

S: Novelty is not required for a valid trade secret. A minority of jurisdictions require novelty. 1990 Epstein 21.

NRRL

P: = NORTHERN REGIONAL RESEARCH LABORATORIES.

number mark

T: = NUMERAL MARK.

numbered

C: A WORK OF VISUAL ART must be signed by the author and consecutively numbered in an edition of 200 or fewer copies. 17 USC 101.

numbering of claims

P: If more than one claim is present, each must be preceded by an Arabic numeral in consecutive ascending order. A claim “retains its original numeral throughout the prosecution of the case.” MPEP 707.07(i).

numeral mark

T: A trademark consisting of a numeral. *Cf.* LETTER MARK, WORD MARK. A mark on the Supplemental Register may consist of a “numeral.” 15 USC 1091(c). A numeral used to distinguish between different goods of the same producer (such as a MODEL NUMBER) does not function as a trademark and is normally unregistrable. See GRADE DESIGNATION.

nunc pro tunc

oath

P: A patent application must be accompanied by an oath by the applicant that he believes himself to be the original and first inventor and stating of what country he is a citizen. 35 USC 115.

DECLARATION in lieu of. 35 USC 25, 37 CFR 1.68. See STRIKE.

An oath or declaration must

- (1) be executed in accordance with 37 CFR 1.66 or 1.68;
- (2) identify the specification to which it is directed;
- (3) identify each inventor, including residence and country of citizenship; and
- (4) state whether the inventor is sole or joint inventor of the invention claimed.

The oath must also state that the individual making it

- (1) has reviewed and understands the contents of the application;
- (2) believes the named inventors to be the original and first inventors of the subject matter; and
- (3) acknowledges the DUTY OF DISCLOSURE. 37 CFR 1.63.

See also SUPPLEMENTAL OATH.

T: Declaration in lieu of oath is provided for in 37 CFR 2.20.

objection

P: A complaint by the examiner that a portion of a patent application is not in proper form required by the Patent Act or Rules of Practice. See INFORMALITY. Cf. REJECTION, which goes to the merits of the invention. MPEP 706.01. “The practical difference between a rejection and an objection is that a rejection, involving the subject matter of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted in, may be reviewed only by way of PETITION to the Commissioner.” MPEP 706.01. See FORMAL REJECTION.

T: In inter partes proceedings, objections to testimony must be renewed in a party’s brief in order to receive consideration by the TTAB. *Harry Fisher Corp. v. Kenneth Knits, Inc.*, 207 USPQ 1019 (TTAB 1980).

objective standard

P: A STANDARD OF INVENTION proposed by Judge Learned Hand in *Safety Car Heating and Lighting Co. v., General Electric Corp.*, 155 F.2d 937 (*** 1946), but later rejected by the Supreme Court in *Jungersen v. Ostby and Barton Co.*, 355 US 560 (1949). It is applied by examining the art before and after applicant’s invention to determine its impact, and takes into consideration the duration and extent of prior unsuccessful efforts to develop the invention.

objective test

P: A test for non-obviousness based on SECONDARY CONSIDERATIONS.

obligation of assignment

P: Subject matter that qualifies as prior art only under 35 USC 102(f) or (g) does not preclude patentability if the subject matter and the claimed invention were owned by the same person or subject to an “obligation of assignment” to the same person. 35 USC 103.

obliteration

T: Removal or concealment of a trademark.

obvious

P:

obvious method

P: “A process may be unpatentable ... even if the product produced therefrom in patentable. *In re Kanter*, 158 USPQ 331 (CCPA 1968), The mere substitution of a new starting material in an otherwise conventional process may well be obvious in the absence of some unobvious result in the process itself.” MPEP 706.03(q).

obvious to try

P: “An ‘obvious-to-try’ situation exists when a general disclosure may pique the scientist’s curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result.” *In re Eli Lilly & Co.*, 14 Q2 1741 (Fed. Cir. 1990). (Demise of old doctrine: *Jones v. Hardy*, 727 F2 1524 (Fed. Cir. 1984). Obvious-to-try is not equated with OBVIOUSNESS.

obviousness

P: “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains.” 35 USC 103. Obviousness is a QUESTION OF LAW. *In re Woodruff*, 919 F.2d 1525, 1577, 16 USPQ 2d 1934 (Fed. Cir. 1990). It is reviewed de novo by the CAFC, but underlying factual determinations are subject to the CLEARLY ERRONEOUS standard. 24 USPQ 2d 1321.

The relevant facts underlying a determination of obviousness are (1) the scope and content of the PRIOR ART; (2) differences between the prior art devices and the claimed invention; (3) the level of ordinary skill in the art; and (4) objective considerations such as COMMERCIAL SUCCESS, LONG-FELT NEED, FAILURE OF OTHERS and copying. *Graham v. John Deere*, 383 US 1. See also ANALOGOUS ART, DURDEN REJECTION, SECONDARY CONSIDERATIONS.

Combining references.

Equivalentents are not necessarily obvious in view of one another. MPEP 706.02.

obviousness-type double patenting

P: A form of DOUBLE PATENTING prohibited because it is “primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. *In re White et al.*, 160 USPQ 417.” MPEP 804. *In re Robeson*, 141 USPQ 485 (CCPA 1964). This test for this type of double patenting has been phrased as “Does any claim in the application define merely an obvious variation disclosed and claimed in the patent?” *In re Vogel*, 164 USPQ 619, 622 (CCPA 1970). A rejection for this form of double patenting can be overcome by a TERMINAL DISCLAIMER. Cf. SAME INVENTION TYPE DOUBLE PATENTING.

occasional request

T: “The Commissioner may waive the payment of any fee for any service or material ... in connection with an occasional request made by a department or agency of the Government ...” 15 USC 1113.

offering for sale

T: It is an infringement of trademark to use in commerce any reproduction of a registered mark in connection with the offering for sale of any goods or services if such use is likely to cause confusion, to cause mistake, or to deceive. 15 USC 1114(1)(A). See also SALE, TRADEMARK INFRINGEMENT.

Office

The PATENT AND TRADEMARK OFFICE.

office action

P:

T: The informal name for an OFFICIAL ACTION. See also PRIORITY ACTION.

office date

P: “The date of receipt of a response to an office action is given by the ‘office date’ stamp which appears on the responding paper.” MPEP 710.01(a).

T: The informal name for an OFFICIAL ACTION.

Office of Enrollment and Discipline

P., T: ***

Office of Federal Procurement Policy

P: An objection by the Secretary of Commerce to a DETERMINATION is sent to the Administrator of the Office of Federal Procurement Policy. 35 USC 202(b)(1)-(2).

officer

An individual legally able to obligate a corporation. *** See also CLERK, CONFIDENTIAL CLERK, PROCURIST, REGISTRAR.

officer or agent of the United States

P: An officer or agent of the United States acting within the scope of his authority and persons acting upon his written instructions or permission are not subject to secrecy order or restrictions on foreign filing under 35 USC 181-186. 35 USC 187.

official action

P:

T: Definition***. An official action is communicated to the applicant through a LETTER OF ACTION. TMEP 1106.

official caption

The CAFC determines the official caption of a case before it.

official certification

C: “An ‘official certification’ is a certification, by the appropriate Government official, that the original of the document is on file in a public office and that the reproduction is a true copy or [sic] the original.” 37 CFR 201.4(a)(3)(ii). Cf. SWORN CERTIFICATION.

Official Gazette

An official publication of the PTO, issued weekly on Tuesdays except in the week after Christmas, including information about patents issued, trademarks published for opposition and administrative matters affecting dealings with the PTO. 35 USC 11. Beginning February 2, 1971, the Gazette has been published in separate volumes for patents and trademarks.

P: The Official Gazette (Patents) contains each
statutory invention registration (37 CFR 1.297(a));
notice of filing on behalf of an omitted inventor (37 CFR 1.47(a));
filing of a reissue application (37 CFR 1.176);
request for reexamination (37 CFR 1.11(c));
reexamination at the initiative of the Commissioner (37 CFR 1.11(c));

notice of disclaimer (37 CFR 1.321).

T: Marks that upon examination appear to be entitled to registration or would be so entitled upon acceptance of a STATEMENT OF USE are published in the Official Gazette for opposition. 15 USC 1062(a).

official notice

P: INTERFERENCE Cf. JUDICIAL NOTICE.

OG

P,T: An abbreviation for the OFFICIAL GAZETTE.

old application

T: = AMENDED APPLICATION. TMEP 402.

old combination

P: A combination recited in a single prior art reference that “discloses broadly a combination of the same elements functionally cooperating in substantially the same manner to produce substantially the same results as that of the claimed combination.” MPEP 706.03(j). “The fact that an applicant has improved one element of a combination which may be per se patentable does not entitle him or her to a claim to the improved element in combination with old elements where the elements perform no new function in the claimed combination.” MPEP 706.03(j).

*** Landis 531. See EXHAUSTED COMBINATION.

Olympic Charter Act

T: The act incorporating the United States Olympic Association, 36 USC 371 et seq. Counterfeiting of a designation made available by reason of section 110 of the Act is a criminal violation of the Trademark Counterfeiting Act of 1984, 18 USC 2320. Consult 15 USC 1116(d). See also COUNTERFEIT MARK.

omission

P: A “material misrepresentation or omission” is a prerequisite to a finding of INEQUITABLE CONDUCT. 24 USPQ 2d 1321, 1336.

omnibus claim

P: A patent claim that merely recites the invention as disclosed but does not define the boundaries thereof. Omnibus claims are not allowable in utility patents because of the requirement of distinct claiming. 35 USC 112. An example of an omnibus claim is “A device substantially as shown and described.” MPEP 706.03(h).

omnibus rejection

P: A rejection that fails to point out any specific grounds. “An omnibus rejection of the claim ‘on the references and for the reasons of record’ is stereotyped and usually not informative and should therefore be avoided.” MPEP 707.907(d).

on appeal

T: The status of a trademark application for which an appeal has been filed. Also APPEALED CASE. TMEP 406.

on or in connection with

T:

on sale

P: [Walker 7:24]

on-sale bar

P: One may not receive a patent for an invention that was “in public use or on sale in this country, more than one year prior to the date of application for the patent in the United States.” 35 USC 102(b). This BAR is statutory and cannot be waived by the PTO. The item offered for sale must be “substantially the same” as the patented invention. *General Electric Co. v. U.S.*, 211 USPQ 867 (Ct. Cl. 1981). Cf. PUBLIC USE BAR, STATUTORY BAR.

The on-sale bar forces the inventor to choose between seeking patent protection promptly following sales activity or taking his chances with his competitors without the benefit of patent protection.” *General Electric Co. v. U.S.*, 654 F.2d 55, 221 USPQ 867 (1981). It encourages early disclosure and prevents extension of the statutory patent term. *Intel Corp. v. U.S. Int’l. Trade Commission*, 946 F.2d 821, 830, 20 USPQ 2d 1161 (Fed. Cir. 1991).

“A single offer to sell is enough to bar patentability whether or not the offer is accepted.” *A B. Chance Co. v. RTE Corp.*, 854 F.2d 1307, 7 USPQ 2d 1881 (Fed. Cir. 1988). The proposal need not disclose the claimed invention.” *RCA Corp. v. Data General Corp.*, 887 F.2d 1056, 12 USPQ 2d 1499 (Fed. Cir. 1989). There is no bar if the customer is participating in testing and development. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ 2d 1746 (Fed. Cir. 1991).

one-time rights

P:

C: The right to publish a work in a single other work.

one-way distinctness

P: The property possessed by two inventions A and B when *either* A can be practiced without B or B can be practiced without A. For example, a “process and apparatus for its practice can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process *as claimed* can be practiced by another materially different apparatus or by hand, or (2) that the apparatus *as claimed* can be used to practice another and materially different process.” MPEP 806.05(e). “In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a RESTRICTION requirement.” MPEP 806.05(e).

open-ended

P: Said of a claim that reads on inventions having elements not listed in the claim, usually introduced by the transitional phrase “comprising.” “Open-ended claims are not inherently improper .. they may be supported if there is an inherent ... upper limit and the specification enables one of skill in the art to approach that limit.” *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F. 2d 1565, 1572 (Fed. Cir. 1991). Cf. CLOSED-ENDED, PARTIALLY CLOSED.

opening brief

P: The brief of a party filed prior to final hearing in an INTERFERENCE. 37 CFR 1.656

operability

P: If a device as disclosed does not perform the function claimed for it, it is said to be “inoperable” and is unpatentable as not being USEFUL. A rejection based on inoperability may be traversed by affidavit. 37 CFR 1.132.

operable range

P: The RANGE of a quantity within which an invention maintains OPERABILITY. Outside such a range, the invention is INOPERABLE and therefore unpatentable. See also PREFERRED RANGE.

operation of law

C: Ownership of a copyright may be transferred “by operation of law.” 17 USC 201(d)(1). See also TRANSFER OF COPYRIGHT.

operator

C: Any “person who, alone or jointly with others:
(A) owns a COIN-OPERATED PHONORECORD PLAYER; or
(B) has the power to make a coin-operated phonorecord player available for placement in an establishment for purposes of public performance; or
(C) has the power to exercise primary control over the selection of the musical works made available for public performance on a coin-operated phonorecord player.” 17 USC 116(e)(2).

With respect to a COIN-OPERATED PHONORECORD PLAYER. 17 USC 116(e)(2).

opinion

See INFRINGEMENT OPINION, ORAL OPINION, PATENTABILITY OPINION, SEARCH OPINION, VALIDITY OPINION.

opposer

T: A party initiating an opposition proceeding to prevent the issuance of a trademark registration. The adverse party is the APPLICANT.

opposition

P: A response to a motion in an interference is termed an “opposition.” 37 CFR 1.638. Cf. REPLY.

T: “Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication ... of the mark sought to be registered.” 15 USC 1063(a). “The opposition must set forth a short and plain statement of the reasons for opposer’s belief that he or she would be damaged by the registration of the opposed mark and state the grounds for opposition.” 37 CFR 2.101. An EXTENSION OF TIME may be obtained. See also EXTRAORDINARY CIRCUMSTANCES. Oppositions are heard by the TTAB and are “sustained” or “dismissed.”

“An opposition may be amended under such conditions as may be prescribed by the Commissioner.” 15 USC 1063(a). When an opposition is filed, notification must be sent to the parties by the Commissioner. 15 USC 1067.

See also NOTICE OF OPPOSITION, WITHDRAWAL.

option

C: A contractual provision granting the right, but not imposing the obligation, to obtain a future right or performance.

oral deposition

P: The principal means of taking testimony in INTERFERENCES. 37 CFR 1.672. Cf. AFFIDAVIT.

oral description

P: [Walker 4:38]

oral hearing

P: 1. In proceedings before the Board or Patent Appeals and Interferences, an oral hearing may be requested. "An appeal decided without an oral hearing will receive the same consideration ... as appeals decided after oral hearing." 37 CFR 1.194. A fee is required. 37 CFR 1.17(g). The appellant receives 20 minutes, the primary examiner 15 minutes. Oral hearing is not granted for petitions except when "considered necessary by the Commissioner." 37 CFR 1.181(c).

2. In the case of amendments to the RULES OF PRACTICE, "[o]ral hearings may be held at the discretion of the Commissioner." 37 CFR 1.352(b).

T: In appeals before the TTAB, a party may request an oral hearing. In an ex parte proceeding, the request must be made within 10 days from the date set for the filing of the reply brief. See also HEARD.

oral license

P: [Walker 20:21]

oral opinion

P: Oral opinions of non-infringement are not favored. 24 USPQ 2d 1321, 1339.

oral work

C: A work consisting of sound only is not copyrightable unless fixed in a tangible medium of expression.

order form

C:

1. Order forms, to the extent they are for recording rather than conveying information, are "not subject to copyright and applications for registration of such works cannot be entertained." 37 CFR 202.1(c).

2. A document used by a library or archives to request a copy or phonorecord from another library or archives. For copies or phonorecords made pursuant to 17 USC 108(d)(2), the order form must bear a WARNING prescribed by the Register of Copyrights.

order of examination

P: "Applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which examination has been advanced pursuant to §1.102." 37 CFR 1.101(a). "Applications which have been acted upon by the examiner, and which have been placed by the applicant in condition of further action by the examiner (amended

application) shall be taken up for action in such order as shall be determined by the Commissioner.” 37 CFR 1.101(b). “Each examiner will give priority to that application in his or her docket, whether amended or new, which has the *oldest effective U.S. filing date* ... The order of examination for each examiner is to give priority to reissue applications, with top priority to those in which litigation has been stayed ... then to those special cases having a fixed 30 day due date, such as examiner’s answers and decisions on motions.” MPEP 708.

order to show cause

P: See SHOW CAUSE ORDER.

ordered

C: See COMMISSIONED. 17 USC 101.

ordinary and accustomed meaning

P: Words in a patent will be given their ordinary and accustomed meaning unless it appears that the inventor used them differently. *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 221 USPQ 473 (Fed. Cir. 1984). See also LEXICOGRAPHER.

ordinary designer

P: The hypothetical person in whose eyes the obviousness of a design patent application is judged. *Cf.* AVERAGE OBSERVER.

ordinary observer test

P: A test for infringement of a design patent: whether an ordinary observer would consider the accused design confusingly similar to the patented design. *Keystone*, 27 USPQ 2d 1297.

C: A test for substantial similarity: “whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.” *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 122, 149 USPQ 800 (2d Cir. 1960). “Whether the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.” *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489, 123 USPQ 154 (2d Cir. 1960).

ordinary skill in the art

A patent may not be obtained if the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. 35 USC 103.

organization

See STRUCTURE, SEQUENCE AND ORGANIZATION.

Organization of American States

C: Published works of the Organization of American States are copyrightable. 17 USC 104(b)(3).

origin

T: The source of goods or services. The purpose of trademarks is to identify origin rather than name the goods or services themselves.

original

P:

C: A work is “original” to an author if it is the product of the independent labor of that author and not copied from another. *Wihtol v. Wells*, (***) 231 F.2d 550 (7th Cir. 1956). A work need not be novel or inventive to be original. Copyright protection “extends only to those components of the work that are original to the creator.” *Rogers v. Koons*, 960 F.2d 301, 307, 22 USPQ 2d 1492 (2d Cir. 1992).

original and first inventor

P: [Walker 3:1]

original claim

P: A claim presented in an application as filed, and not as amended or introduced by amendment. An original claim is its own WRITTEN DESCRIPTION. *In re Kohler*, 204 USPQ 702 (CCPA 1980).

original document

T: “The Patent and Trademark Office will accept and record only an original document, or a legible certified copy of an original.” TMEP 501.05(a).

original jurisdiction

T: “The district and territorial courts of the United States shall have original jurisdiction ... of all actions arising under” the Lanham Act. 15 USC 1121. See also APPELLATE JURISDICTION, JURISDICTION.

original prosecution

P: The first prosecution of an application, as opposed to REEXAMINATION or REISSUE.

original registration

C: required for RENEWAL REGISTRATION except for UCC WORKS. 37 CFR 20217(d).

original work of authorship

C: A work that has been “independently created by an author.” H.R. Rep. No. 1476, 94th Cong., 2d Sess. 51. The only type of work eligible for copyright protection. 17 USC 102(a).

originality

P:

C: The requirement that a work be original to constitute copyrightable subject matter. 17 USC 102(a). A work is original if it is “one man’s alone.” *Bleistein v. Donaldson Lithographing Co.*, 188 US 239 (1903).

ornamental design

P: A design must be ornamental to be patentable. [Walker 16:7]

ornamentation

T: Decorative matter ***. A mark that is purely ornamental will be refused registration. TMEP 1213.02.

other assigned application

P: “[A]ssignment of one of several overlapping applications of the same inventor may give rise to a ground of rejection.” MPEP 706.03(t).

outline form

P: Form of claim in which the elements are labeled with identifying letters, as in an outline. Used for clarity.

overall form

C: The “overall form” of a building is encompassed by the concept of ARCHITECTURAL WORK and is protected by copyright. 17 USC 101.

overall impression

T: In assessing likelihood of confusion, trademarks are to be compared by considering overall impression rather than by examining individual features of the marks. *Taj Mahal Enterprises, Ltd. v. Trump*, 15 USPQ 2d 1641.

overclaiming

P:

overcome

P: A rejection.

overlapping claim

P: [Walker 11:3]

owner

C: Copyright in a work “vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.” 17 USC 201(a). The owner of a copy of a work, as opposed to one to whom a copy has been lent or rented, may display the work publicly without the permission of the copyright owner. 17 USC 109(c).

“The ‘owner’ of a MASK WORK is the person who created the mask work, the legal representative of that person if that person is deceased or under a legal incapacity, or a party to whom all the rights under this chapter of such person or representative are transferred ... except that in the case of a work made within the scope of a person’s employment, the owner is the employer for whom the person created the mask work or a party to whom all the rights under this chapter of the employer are transferred ...” 17 USC 901(a)(6).

T: Only the owner of a trademark may register it. 15 USC 1051.

ownership

P: Ownership “is a question of who owns legal title to subject matter claimed in a patent, patents having the attributes of personal property.” *Sewall v. Walters*, 30 USPQ 2d 1356, 1360 (Fed. Cir. 1994)

T: “To the extent that the right to use the registered mark has become incontestable under section 15, the registration shall be conclusive evidence ... of the registrant’s ownership of the mark.” 15 USC 1115(b).

package

T: A mark on the Supplemental Register may consist of a “package.” 15 USC 1091(c).

It is TRADEMARK INFRINGEMENT to apply a reproduction of a registered mark to a package intended to be used in commerce where such use is likely to cause confusion, or to cause mistake, or to deceive. 15 USC 1114(1)(B). Packages bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

package license

P: A license of a collection of related patents. *Cf.* INTERLOCKING PATENTS.

packaging material

C: Packaging material may not constitute a WORK OF VISUAL ART. 17 USC 101.

T: Whether or not packaging material is acceptable as a trademark specimen depends on whether the goods normally move in commerce in such packaging. For example, bags into which groceries are placed at a cash register identify the store, not the source of the goods. TMEP 808.05.

paid-up license

P: 35 USC 202(4).

painting

C: A painting may be a WORK OF VISUAL ART. 17 USC 101.

page

C: 1. See also 37 CFR 201.20(b)(3). See also FRONT PAGE, BACK PAGE.

2. In computing the number of pages in a RECORDABLE DOCUMENT, “each side of a LEAF bearing textual matter is regarded as a ‘page’.” 37 CFR 201.4(d)(3).

page numbers

P: The pages of a patent application must be numbered consecutively beginning with 1 and the numbers should be located preferably at the bottom center of each page. 37 CFR 1.52(b).

palming off

T: The selling of a good or service of one’s creation under the name or mark of another. *Smith v. Montoro*, 211 USPQ 775 (9th Cir. 1981). A classic form of trademark infringement. Also EXPRESS PASLMIN OFF, PASSING OFF. *Cf.* IMPLIED PALMING OFF, REVERSE PALMING OFF.

Pan-American Copyright Convention

C:

Pan-American Trademark Convention

T: 1910, 1923, 1929.

pantomime

C: One of the categories of COPYRIGHTABLE SUBJECT MATTER. 17 USC 102(a)(4). A type of WORK OF THE PERFORMING ARTS. 37 CFR 202.3(b)(1)(ii).

paper number

P: .

paper patent

P: A patent for an invention that has never been built or practiced. [Walker 4:28]

paper size

P: International applications under the PCT must be on A4 PAPER.

parallel import

T: The unauthorized importation of genuine but trademarked goods. See also GRAY MARKET, IMPORT.

parent application

P: A patent application whose disclosure serves as the basis for a later CONTINUATION, CONTINUATION-IN-PART or DIVISIONAL application. The term 'parent' is applied to an earlier application of an inventor disclosing a given invention. Such invention may or may not be claimed in the first application. MPEP 201.04.

parent claim

P: A claim from which a DEPENDENT CLAIM depends directly. A parent claim itself may be either dependent or independent. Cf. BASE CLAIM, which is always independent.

Paris Convention

P: See CONVENTION APPLICATION, STOCKHOLM REVISION OF THE PARIS CONVENTION. (re utility models)

T: Administered by WIPO.

parody

C: parody not infringement. Parody has been recognized as a form of literary criticism. *Campbell v. Acuff-Rose Music, Inc.*, _____ US _____ (****). See SUBSTANTIALITY. *** Conjure up the original *** Includes SATIRE and BURLESQUE.

T: "Where a party chooses a mark as a parody of an existing mark, the intent ins not necessarily to confuse the public but rather to amuse." *Jordache Enterprises Inc. v. Hogs Wyld Ltd.*, 828 F.2d 1482, 1485, 4 USPQ 2d 1216 (10th Cir. 1987). Paroidy raises first amendment issues.

partially closed

P: Said of a chemical patent claim that excludes elements or ingredients not specifically named, but allows elements that are either present only in trace amounts or that do not interfere with those elements present. A partially closed claim is usually introduced by the transitional phrase "consisting essentially of." Cf. CLOSED-ENDED, OPEN-ENDED, PARTIALLY CLOSED.

partnership

T: A partnership may be an APPLICANT for a trademark registration if the partnership's name and state or country of domicile or organization is given along with the name and citizenship of each general partner. At least one general partner must sign the application.

party

P: In an INTERFERENCE, “[a] ‘party’ is (1) an applicant or patentee involved in the interference or (2) a legal representative or an assignee of an applicant or patentee involved in an interference. Where acts of a party are normally performed by an attorney or agent, ‘party’ may be construed to mean the attorney or agent.” 37 CFR 1.601(l).

passing off

T: = PALMING OFF.

passive carrier

P: *** DEF *** Passive carriers are exempt from copyright liability. 17 USC 111.

past infringement

P: Assignment of cause of action. [Walker 19:17]

patent

P: As used in 35 USC 156, “patent” means a patent issued by the United States Patent and Trademark Office. 35 USC 156(f)(6). The term is often used indiscriminately to mean the rights granted to the patentee, the certificate issues to the patentee (LETTERS PATENT), and the printed copy of the specification and drawings published by the PTO. Rights: 35 USC 154 grant, exclude others. Test: new & useful.

See also DESIGN PATENT, PLANT PATENT, UTILITY PATENT.

Patent Act

P: Title 35, United States Code, relating to patents.

patent agent

P: A person who has been admitted to practice before the PTO. A patent agent is “authorized to represent an applicant” before the PTO. A patent agent cannot render legal advice beyond that involved in prosecuting a patent application. *Cf.* PATENT ATTORNEY, a patent agent who is also an attorney.

Patent and Trademark Office

P: The office within the Department of Commerce established to administer the granting of patents and registration of trademarks. 35 USC 1. “Officers and employees of the Patent and Trademark Office,” during the period of their service and for one year afterward, may not apply for a patent and may not receive a priority date earlier than one year after the termination of their appointment. 35 USC 4.

T: Give address ***.

patent annuity

P: = MAINTENANCE FEE.

patent application

P: In order to receive a filing date, a patent application must include at least the following elements: (1) the specification, including a claim; (2) an oath or declaration; (3) drawings; and (4) the filing fee. 37 CR 1.61.

A patent application should contain the following items in the specified order:

1. Title of the invention. See SHORT TITLE.

2. CROSS-REFERENCE to related applications, if any.
3. Reference to a MICROFICHE APPENDIX, if any.
4. Brief SUMMARY OF THE INVENTION.
5. Brief description of the drawings, if any.
6. Detailed description of the invention.
7. At least one CLAIM.
8. An ABSTRACT OF THE DISCLOSURE.
9. Signed OATH or DECLARATION.
10. DRAWINGS. 37 CFR 1.77.

A CERTIFICATE OF MAILING is ineffective to obtain a filing date for a national or international application. 37 CFR 1.8(a)(2)(i), 1.8(a)(2)(xi). “Papers in an application which has received a filing date ... will not be returned for any purpose whatever.” 37 CFR 1.59. For the confidential status of applications, see CONFIDENTIALITY. See also LANGUAGE.

For different types of patent applications, see CONTINUATION, CONTINUATION-IN-PART, CONVENTION APPLICATION, DIVISIONAL, INTERNATIONAL APPLICATION, NATIONAL APPLICATION, REISSUE.

For clerical and formatting requirements for applications, see LINE NUMBERS, MARGINS, PAGE NUMBERS.

patent applied for

P: = PATENT PENDING.

patent attorney

P: An attorney who has been admitted to practice before the PTO. *Cf.* PATENT AGENT.

Patent Cooperation Treaty

P: Signed by the United States on June 19, 1970, effective in 1978. Treatment of PCT topics is beyond the scope of this book.

Patent Depository Library

P: 35 USC 13.

patent document

P: A document, comprising a patent, patent application, statutory invention registration, industrial design or like document. A patent application that has been identified by number in a published patent document can be furnished to the public. 37 CFR 1.14(a).

patent examiner

P:

patent exhaustion

P: The doctrine that patent rights in a material object are extinguished upon its first sale by the patentee or its licensee. *Bloomer v. Millinger*, 68 US 340 (1864). The owner may resell free of the patent. *U.S. v. Univis Lens Co.*, 316 US 241, 250, 53 USPQ 404, 408 (1942).

patent holder

P:

patent in suit

P: The patent that is involved in the litigation, usually referring to one that is infringed or whose validity is being challenged.

patent infringement

P: “Whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.” 35 USC 271(a). “Whoever actively induces infringement of a patent shall be liable as an infringer.” 35 USC 271(b). “Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.” 35 USC 271(c). “A patentee shall have remedy by civil action for infringement of a patent.” 35 USC 281. Patent infringement is a tort. It is defense to patent infringement that no infringement occurred (NONINFRINGEMENT) or that the patent or patent term extension is invalid.

The test for patent infringement involves two steps: (1) interpreting the claims to determine their proper scope; and (2) determining whether the claims READ ON the accused device.” 24 USPQ 2d 1321.

See also contributory infringement, direct infringement, inducement of infringement, literal infringement, remedies.

patent marking

P: See MARKING.

patent misuse

P: A defense to patent infringement consisting of wrongful use of the patent not necessarily constituting a violation of the antitrust laws. It may consist of attempting to extend the term of the patent beyond the period granted, ***. See 37 USC 271(d): market power. Patent misuse does not invalidate a patent; when the misuse terminates, the patent may be enforced. U.S. Gypsum Cop. v. National Gypsum Co., 352 US 457. The defense of patent misuse is not available merely because the owner

(1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement;

(2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement;

(3) sought to enforce his patent rights against an infringer or contributory infringer.

(4) refused to license or use any rights to the patent;

(5) conditioned the license of any rights to the patent or sale of the patented product on the acquisition of a license to rights in another patent or purchase of separate products unless the patent owner has market power in the relevant market.

[Walker 28:32]

Patent Misuse Reform Act

P: Permits TYING unless the patentee has MARKET POWER in the relevant market. 35 USC 271(d)(4), 271(d)(5) (Public Law 100-73, Nov. 19, 1988). See PATENT MISUSE.

Patent Office

Renamed the PATENT AND TRADEMARK OFFICE.

patent pending

P: An unofficial term denoting that a patent application has been filed. It carries no implication that a patent will issue or that any favorable response has been received from the PTO. False use of the designation is a misdemeanor prohibited by 35 USC 292. Also PATENT APPLIED FOR.

patent term dimiution

P:

patent term extension

P: If a composition of matter or process for using such a composition is subjected to a regulatory review by the Food and Drug Administration leading to a regulation permitting the interstate distribution and sale of such composition and for which there has been a stay of regulation of approval in effect on January 1, 1981, the term of the patent shall be extended by a period equal to the length of the stay. 35 USC 155. See also EXTENSION OF PATENT TERM, PATENT TERM RESTORATION.

Patent Term Extension Act

P: Extends the term of patents for compositions subject to FDA review. 35 USC 155, 156 (Public Law 92-127, Oct. 12, 1983). See PATENT TERM EXTENSION.

“(a) A patent is eligible for extension of the patent term if the patent claims a product as defined in paragraph (b) of this section, either alone or in combination with other ingredients that read on a composition that received permission for commercial marketing or use, or a method of using such a product, or a method of manufacturing such a product ...

(b) The term ‘product’ referred to in paragraph (a) of this section means

(1) The active ingredient of a new human drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(2) The active ingredient of a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug and Cosmetic Act and the Virus-Serum-Toxin Act) that is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(3) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug and Cosmetic Act.” 37 CFR 1.710.

patent term restoration

P: The terms of patents issued for certain new drug products and processes for using them have been lengthened if certain action were taken with respect to the drug product by the Food and Drug Administration. 35 USC 155A. See also EXTENSION OF PATENT TERM, PATENT TERM EXTENSION, PATENT TERM RESTORATION ACT.

Patent Term Restoration Act

P: [Walker V.9, Appx 93]

patentable subject matter

P: Matter for which a patent may be granted. The statutory classes of patentable subject matter are statutorily defined: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain patent therefor, subject to the conditions and requirements of this title.” 35 USC 101. *** (and plants and designs).

Unpatentable subject matter: method of doing business, naturally occurring, printed matter, scientific principle

patentability opinion**patentability report**

P: 1. A report made “where an application properly assigned to one EXAMINING GROUP is found to contain one or more claims *per se* classifiable in one or more other groups, which claims are not divisible *inter se* from the claims which govern classification of the application in the first group, the application may be referred to the other group or groups for a report as to the patentability of certain designated claims.” Abbreviated P.R. MPEP 705.

2. = PATENTABILITY OPINION.

patentability search

P:

patentably distinct

P:

patentee

P: In the Patent Act, “[t]he word ‘patentee’ includes not only the patentee to whom the original patent was issued but also the successors in title to the patentee.” 35 USC 100(d).

paternity

C: The right of an author to be known as the author of a work. One of the MORAL RIGHTS, also known as the right of ATTRIBUTION. The right is recognized in the U.S. for WORKS OF VISUAL ART.

pattern

S: A “pattern for a machine or device” may be a trade secret. Restatement of Torts 757. UTSA 1(4) includes “pattern” in its definition of trade secret.

PCT

P: The PATENT COOPERATION TREATY.

PCT application

P: A patent application made under the PCT. See INTERNATIONAL APPLICATION.

PE

P: = PRIMARY EXAMINER. *Cf.* SPE.

pen and ink drawing

T: = INK DRAWING.

penalty

T: In trademark cases, an award of infringer's profits or increased damages "shall constitute compensation and not a penalty." 15 USC 1117(a).

pending application**pending search**

T: A search performed by the Examining Attorney when an application is in condition for publication, to check for possible conflicts with pending marks. TMEP 1503.01. Also PUB SEARCH.

perceived

C: Copyright protection extends only to works capable of being "perceived, reproduced or otherwise communicated." 17 USC 102(a).

perform

C: "To 'perform' a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible." 17 USC 101. See also PUBLICLY. The exclusive right to perform literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works works publicly is one of the incidents of copyright. 17 USC 106(4).

performance

C: The act in which a work is "performed." One of the exclusive rights of a copyright owner is the right to perform the work publicly. *Cf.* PUBLIC PERFORMANCE.

performing rights society

C: An "association or corporation that licenses the public performance of nondramatic musical works on behalf of the copyright owners, such as the American Society of Composers, Authors and Publishers, Broadcast Music, Inc., and SESAC, Inc." 17 USC 116(e)(3). See also ASCAP, BMI.

perfume

T: "[S]cents or fragrances of products which are known for those features, such as perfumes, colognes or scented household products" are not registrable because they are regarded as descriptive. *In re Celia Clarke*, 17 USPQ 2d 1238 (TTAB 1990). But see SCENT MARK.

period for response

P: "Upon failure of the applicant to prosecute the applicant within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.” 35 USC 133.

“The actual time taken for a response is computed from the date stamped or printed on the office action to the date of receipt by the Office of applicant’s response.” MPEP 710.01(a). See also GOVERNMENT APPLICATION.

T: The period within which a response to an action must be filed, either statutory or set by the PTO. The statutory period is six months. 15 USC 1062(b). The Examining Attorney may neither shorten nor extend the period. TMEP 1109.

periodical

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i). A periodical may not constitute a WORK OF VISUAL ART. 17 USC 101. (By this the statute presumably means to refer to a PERIODICAL ISSUE.)

T: An injunction restraining publication of an issue of a periodical similar to a newspaper or magazine but containing infringing matter or violating matter is not available if the result would be to delay dissemination of the issue beyond the regular time for its delivery. 15 USC 1114(2)(C).

periodical issue

C: An issue of a periodical may constitute a COLLECTIVE WORK if it consists of independent contributions. 17 USC 101. See also PERIODICAL.

peripheral claim

P: A claim that defines the boundaries of an invention. This is the type of claim used in United States patents.

perjury

C: The oath required under 28 USC 1746 ****CHECK is this penalty?***** “I certify under penalty of perjury under the laws of the United States that the foregoing is true and correct.” 17 USC 202.17(***)).

permanent injunction

C: A permanent injunction is usually granted where infringement has been proven, but may be denied if there is no likelihood of future infringement. *Shapiro, Bernstein & Co. v. 4636 S. Vermont Ave., Inc.*, 367 F.2d 236 (9th Cir. 1966).

S: Some authorities consider a permanent injunction inappropriate in trade secret cases, since if the secret were to become public, defendant would still be enjoined from making use of it.

permanently parted with possession

C: “A compulsory licensee shall be considered to have ‘permanently parted with possession’ of a phonorecord made under the license (i) in the case of phonorecords relinquished from possession for purposes other than sale, at the time at which the compulsory licensee actually first part with possession; (ii) in the case of phonorecords relinquished from possession for purposes of sale without a privilege of returning unsold phonorecords for credit or exchange, at the time at which the compulsory licensee actually first parts with possession; (iii) *******” [continue from 37 CFR 201.19(a)(5).

permission

C: A license to use all or a portion of a copyrighted work. Whether permission was sought is a factor considered in determining whether a use is a fair use. *Marcus*, 695 F.2d 1171, 217 USPQ 691.

perpetual motion

P: Model required. [Walker 5:14.] Claims involving perpetual motion will be rejected on the grounds of no UTILITY. MPEP 706.03(p).

person

T: The term ‘person’ and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person.” 15 USC 1127. “Person” does not include fictitious characters. TMEP 1202.03(a).

person having ordinary skill in the art

P: “A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 USC 103. Cf. PERSON SKILLED IN THE ART.

person skilled in the art

P: The specification of a patent application must “enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use” the invention. 35 USC 112. Cf. PERSON HAVING ORDINARY SKILL IN THE ART.

persona

T: A party’s personality. ***

personal knowledge

P: When a rejection is based on facts within the personal knowledge of an employee of the PTO (rather than those that appear in a printed reference), the applicant may call for an affidavit of such employee. 37 CFR 1.107(b), MPEP 706.02(a).

Declaration which attests “on a personal knowledge basis ... to the previous timely mailing.” 37 CFR 1.8(b).

personal liability

C: A corporate officer may be jointly and severally liable with the corporation for copyright infringement where the officer was the dominant influence in the corporation and determined the policies which resulted in infringement. *Sailor Music v. Mai Kai of Concord, Inc.*, 640 F.Supp. 629, 230 USPQ 860 (D. N.H. 1986). A corporate officer may be vicariously liable if he or she has the right and ability to supervise the infringing activity and also has a direct financial interest in such activity. *Gershwin Publishing Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 170 USPQ 182 (2d Cir. 1971).

personal name mark

T:

personal property

C: The ownership of a copyright may pass as personal property by intestate succession. 17 USC 201(d)(1).

persuasion, burden of

P: Interference. [Walker 13:20]

pertain to copyright

C: "A document shall be considered to 'pertain to copyright' if it has a direct or indirect relationship to the existence, scope, duration, or identification of a copyright, or to the ownership, division, allocation, licensing, transfer, or exercise of rights under a copyright." 37 CFR 201.4(a)(2).

petition

See PETITION TO THE COMMISSIONER.

Petitions are "granted" or "dismissed."

P:

In INTERFERENCE. 37 CFR 1.644.

T: 1. See PETITION TO CANCEL.

2. See PETITION TO THE COMMISSIONER.

petition to cancel

T: "A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged by the registration of the mark on the principal register ..." 15 USC 1064. The petition must be filed within five years from the date of registration of the mark or at any time if

- 1) the mark becomes the GENERIC name for the goods or services, or a portion thereof;
 - 2) the mark is abandoned (see ABANDONMENT);
 - 3) the registration was obtained fraudulently;
 - 4) the mark contravenes the provisions of 15 USC 1052(a)-(c), relating to IMMORAL and disparaging marks;
 - 5) the mark is being used to misrepresent the goods or services;
 - 6) the mark is a certification mark and the registrant does not control the use of such mark, engages in production of goods to which the mark is applied, permits the use of the mark for purposes other than to certify, or discriminately refuses to certify the goods of any person who maintains the standards the mark certifies. 15 USC 1064.
- When a petition to cancel is filed, notice must be sent to the parties by the Commissioner. 15 USC 1067. The petition results in an inter partes proceeding before the TTAB. A CERTIFICATE OF MAILING is ineffective to establish a filing date for a petition to cancel.

petition to make application special

P: A petition to the Commissioner to accelerate the examination of an application. It may be made (1) at the request of a head of a government department; (2) because of the age or health of the applicant; or (3) when the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources. 37 CFR 1.102. *** Other reasons: search *** Rule 181

T: An applicant who wishes an application advanced out of the normal order of examination may petition the Commissioner stating why special action is requested. TMEP 1102.04. It is an extraordinary remedy restricted to cases in which “particular and very special circumstances exist,” for example, actual or threatened infringement, threat of pending litigation, and the need for a registration to obtain a foreign registration.

petition to the Commissioner

P: Any action or requirement of any examiner during ex parte prosecution that is not subject to appeal to the Board or a court is reviewable by the Commissioner upon petition. It may be required that there have been a proper request for reconsideration. 37 CFR 1.181.

Access to application. 37 CFR 1.14.

Access to assignment record. 37 CFR 1.12

Access to interference settlement agreement. 37 CFR 1.666(b).

Accord filing date. 37 CFR 1.60, 1.62.

Amendment after payment of issue fee. 37 CFR 1.312.

Appeal from refusal to admit amendment. 37 CFR 1.127.

Appeal from refusal to publish statutory invention registration. 37 CFR 1.295(a).

Change scope of license. 37 CFR 5.15.

Color drawing. MPEP 608.02(p).

Consider Information Disclosure Statement. 37 CFR 1.97(d).

Correct inventorship. 37 CFR 1.48.

Correct inventorship after issuance. 37 CFR 1.324.

Decision on question not specifically provided for. 37 CFR 1.182.

Defer issuance of patent. 37 CFR 1.314

Divisional reissue to issue separately. 37 CFR 1.177.

Expedite handling of foreign filing license. 37 CFR 5.12, 5.13, 5.14.

Filing by other than all inventors (suspend rules). 37 CFR 1.183.

Institute public use proceeding. 37 CFR 1.292.

Interference. 37 CFR 1.644(e).

Late filing of interference settlement agreement. 37 CFR 1.666(c).

Make application special. 37 CFR 1.102.

Patent to issue to assignee, assignment recorded late. 37 CFR 1.337.

Process application filed with specification in a non-English language. 37 CFR 1.52(d).

Reconsideration of a decision on petition in interference. 37 CFR 1.644(f).

Reconsideration of a decision on petition refusing to accept delayed payment of maintenance fee in expired patent. 37 CFR 1.378(e).

Request publication of statutory invention registration prior to mailing of first examiner’s action. 37 CFR 1.104.

Retroactive license. 37 CFR 5.25.

Review decision refusing to accept maintenance fee filed prior to expiration of patent. 37 CFR 1.377.

Review requirement for restriction. 37 CFR 1.144.

Review statement by primary examiner that appeal is not in proper form. 37 CFR 1.193(a).

Revive abandoned application. 37 CFR 1.137(a), 1.137(b).

Revive unavoidably abandoned application under 35 USC 111, 133, 364 or 371.

Strike application from files for violation of 37 CFR 1.56, relating to oaths.

Submission of foreign priority papers after issue fee is paid. 37 CFR 1.55(a).

Suspend action in application. 37 CFR 1.103.

Unintentionally delayed payment of issue fee. 35 USC 151.

Withdraw application from issue. 37 CFR 1.313.

Withdraw statutory invention registration after receipt of notice of intent to publish. 37 CFR 1.296.

Withdrawal. 37 CFR 1.313.

T: "Petition may be taken to the Commissioner: (1) From any repeated of final formal requirement of the examiner in the ex parte prosecution of an application if permitted by 2.63(b); (2) in any case for which [the Lanham Act or CFR] specifies that the matter is to be determined directly or reviewed by the Commissioner; (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances; (4) in any case not specifically defined and provided for by this part of Title 37 of the Code of Federal regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension nor waiver of any requirement of the rules not being a requirement of the Act of 1946." 37 CFR 2.146(a). "A timely petition to the Commissioner ... is a response which avoids abandonment of the application." 37 CFR 2.65(a). "A formal requirement which is the subject of a petition decided by the Commissioner may not subsequently be the subject of an appeal to the TTAB." 37 CFR 2.63(b).

Allow indexing of an assignment. TMEP 501.11.

Change a holding of abandonment. TMEP 1112.04.

Establish that LOST SPECIMEN was submitted.

Interference. 15 USC 1066, TMEP 1206.03(a).

Make application special. TMEP 1102.04.

Post-registrations matters, such as refusal to accept affidavits.

Record a document not deemed recordable by the Assignment Division. TMEP 503.01.

Refusal by the TTAB to initiate an opposition.

Reopen prosecution after decision on appeal. TMEP 1115.06, 1502.05.

Restore jurisdiction over an application to the Examining Attorney.

Reverse a decision of the mail room or Application Section denying an application a filing date.

Review an action by the Examining Attorney during prosecution.

Review refusal of an affidavit of continued use. TMEP 1603.13.

Review interlocutory orders of the TTAB.

Revive an application after abandonment for unavoidable delay. TMEP 1112.05(a).

See also STAY.

petitioner

T: One who brings a petition. In an inter partes proceeding, the adverse party is known as the RESPONDENT.

phantom count

P: In an interference, “[w]hen a COUNT is broader in scope than all claims which correspond to the count, the count is a ‘phantom count’. A phantom count is not patentable to any party.” 37 CFR 1.601(f).

PHOSITA

P: An acronym for the hypothetical “person having ordinary skill in the art.”

phonogram

C: = SOUND RECORDING.

phonorecord

C: A material object “in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term ‘phonorecords’ includes the material object in which the sounds are first fixed.” 17 USC 101. Phonorecords are not “copies.” See also COUNTERFEIT LABEL.

Literary, dramatic, and musical works published only as embodied in phonorecords are exempt from DEPOSIT requirements. 37 CFR 202.19(c)(4). See also SPOKEN WORD RECORDING.

phonorecord reserve

C: “A ‘phonorecord reserve’ comprises the number of phonorecords, if any, that have been RELINQUISHED FROM POSSESSION for purposes of sale in a given month accompanied by a privilege of return ... and that have not been considered VOLUNTARILY DISTRIBUTED during the month in which the compulsory licensee actually first parted with their possession.” 37 CFR 201.19(a)(6). See also LAPSED RESERVE, NEGATIVE RESERVE BALANCE.

photograph

C: “Photographs and the negatives thereof” first received copyright protection by the Act of March 3, 1865. The constitutionality of photographic copyright was upheld in *Burrow-Giles* *** (1884). Photographs fall in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

The subject of a photograph is not a JOINT AUTHOR of the photograph.

phrase

T: A mark on the Supplemental Register may consist of a “phrase.” 15 USC 1091(c).

pictorial, graphic and sculptural works

C: Works that “include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned ...” 17 USC 101. Copyrightable. 17 USC 102(a).

pictorial illustration

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101.

pictorial work

C: See PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 102(a).

picture claim

P: A narrow claim that substantially lists all of the described components of an invention and their interconnection, without broad language. “The mere fact that a claim recites in detail all of the features of an invention (i.e. is a ‘picture claim’) is never, in itself, justification for allowance of such claim.” MPEP 706. A picture claim protects the patentee against direct copyists, but little more. *Cf.* FOOTPRINT CLAIM.

picture postcard

C: The year date may be omitted from the copyright notice on a pictorial, graphic or sculptural work as reproduced on a postcard. 17 USC 401(b)(2). Picture postcards exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(2).

pioneer invention

P: An invention that is a major advance in its field or one that is not an outgrowth of prior art. A pioneer invention is entitled to a broad range of equivalents, not because it is entitled to special treatment under the law, but because many equivalents can be found that do not encroach on the prior art.

Piracy and Counterfeiting Act of 1982

C: 18 USC 2318, 2319. Makes criminal violations of 17 USC 506.

piracy

P: Within a list of perils in an insurance contract, “piracy” has been held to include patent infringement. *Acqua Queen Mfg. Inc. v. Charter Oak Fire Ins.*, (name***) 26 USPQ 2d 1940, 1942 (C.D. Cal. 1993).

C: See also RENEWAL AFFIDAVIT FOR A U.C.C. WORK. 37 CFR 202.17(d)(2)(i)(A).

place of first publication

C: See also RENEWAL AFFIDAVIT FOR A U.C.C. WORK. 37 CFR 202.17(d)(2)(i)(A).

plain error

P: In an INTERFERENCE, plain error can be corrected even if action was taken that would normally constitute waiver. “Nothing in this section precludes taking notice of plain errors affecting substantial rights although they were not brought to the attention of an examiner-in-chief or the Board.” 37 CFR 1.685(e).

plans

C: “Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(b). But see ARCHITECTURAL WORK.

plant patent

P: “Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found

seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor ..." 35 USC 161. Plant patents were first allowed in 1930. Plant applications are excused from the requirements of 35 USC 112 provided that the description is "as complete as is reasonably possible." 35 USC 162. Only one claim is permitted but PRINCIPAL DISTINGUISHING CHARACTERISTICS may be claimed. A plant patent confers the "right to exclude others from asexually reproducing the plant or selling or using the plant so produced." 35 USC 163. The same rules apply to plant patent applications as to those for other inventions or discoveries except 37 CFR 1.162-1.167, which are unique to plant patent applications. 37 CFR 1.161. The oath must state that the applicant has asexually reproduced the plant. 37 CFR 1.162. Where the plant is a newly found plant the applicant must state that it was found in a cultivated area. 37 CFR 1.162. Plant patent applications are also sent to the Department of Agriculture. 37 CFR 1.167.

Plant Variety Protection Act

P: 7 USC 2321 *et seq.* With respect to federally funded inventions, "invention" includes "any novel variety of plant which is or may be patentable under the Plant Variety Protection Act." 35 USC 201(d). Abbreviated PVPA.

plate

T: A printing plate. Plates bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION, MEANS OF MAKING.

play

C: See DRAMATIC WORK. To "play" a work constitutes a PERFORMANCE of the work. 17 USC 101.

pleading

plot

C:

plurality

P: A term in patent claim drafting meaning "more than one."

poetry

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i).

point of novelty

P:

Design patent infringement. Two-prong test (1) similarity; and (2) similarity at points of novelty. Test not used for validity, but only infringement. Litton ***. *Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984).

pool

P: A common licensing of patent rights among companies, which creates a "pool" of rights. See also ***.

portrait

T: A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises a ... portrait ... identifying a particular living individual” except by his written consent,” or identifying “a deceased President of the United States during the life of his widow, except by the written consent of the widow.” 15 USC 1052(c), 1091(a).

position of notice

C: 17 USC 401(c), 402(c).

positive rules of invention

P: General principles to the effect that accomplishing certain results yields a patentable invention. *Cf.* NEGATIVE RULES OF INVENTION. See also SECONDARY CONSIDERATIONS. Performing conventional operations that cause disproportionate, unexpected, surprising or unusual results.

Prior art is NON-ANALOGOUS ART.

Prior art TEACHES AWAY from the invention.

Results obtained are substantially superior to those previously achieved.

CRITICAL LIMITATIONS are required to achieve the result.

Results are synergistic.

positively

P: An element of a claim is recited “positively” when it is claimed directly as opposed to inferentially.

possession

P: See CABLE SYSTEM, UNITED STATES. *Cf.* INSULAR POSSESSION.

post-employment non-competition agreement

U:

post office box

C: A post office box is insufficient for an address of a COMPULSORY LICENSEE. 37 CFR 201.19(e)(2).

post-solution activity

P: [computer program claims]

postcard

C: The year date may be omitted from the copyright notice on a pictorial, graphic or sculptural work as reproduced on a postcard. 17 USC 401(b)(2). Picture postcards exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(2).

poster

C: A poster cannot be a WORK OF VISUAL ART. 17 USC 101.

post-expiration royalty

P: [Walker 28:23]

posthumous work

C: For renewal copyright purposes, a work that was unpublished on the date of death of the author and with respect to which no copyright assignment or other contract for exploitation of the work occurred during the author's lifetime." 37 CFR 202.7(6).

Post-Registration Section

T:

post-seizure hearing

See SEIZURE HEARING.

power of attorney

P:

T: A power is not necessary for an attorney to represent a party in trademark cases. TMEP 602.01.

P.R.

P: = PATENTABILITY REPORT.

practical application

P: With respect to a federally funded invention, "practical application" means "to manufacture in the case of a composition or product, to practice in the case of a process or method, or to operate in the case of a machine or system; and in, each case, under such conditions as to establish that the invention is being utilized and that its benefits are to the extent permitted by law or Government regulations available to the public on reasonable terms." 35 USC 201(f), 37 CFR 401.2(e), 37 CFR 404.3(d), 48 CFR 52.227(11)(a)(4).

practice

P: An invention

T: A person "practices" before the PTO when he represents others in connection with trademark matters. TMEP 607.

preamble

P: A preamble is "an introductory or first phrase of a claim." *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 228 USPQ 90 (Fed. Cir. 1985). It defining the subject of the claim. The words of the preamble are limiting to the extent they give "life and meaning" to the claim. The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventor actually invented and intended to encompass by the claim. *Corning Glass Works v. Sumitomo Electric USA*, 868 F.2d 1251, 1257, 9 USPQ 2d 1962 (Fed. Cir. 1989). *** Statements in the preamble are not to be ignored in determining patentability. 156 Q 90.

predatory intent

T: 15 USPQ2 11631***,

predecessor in title

T: In a TRADEMARK APPLICATION, a “DATE OF FIRST USE may be asserted with a statement that such first use was by the predecessor in title or by the RELATED COMPANY as the case may be.” 37 CFR 2.38(a).

preemption

The principle that an adjudicatory body has no authority to decide a question because that authority has been reserved expressly or implicitly to a different body.

28 USC *** district ct exclusive jurisd. in pat and copyright cases.

P: The Patent Act, 35 USC ***, preempts ***.

C: The Copyright Act, 17 USC 101-810, preempts “on and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 ... Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.” 17 USC 301(c). *** includes (4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102(a)(8). To determine whether a cause of action is preempted, :the work at issue must be within the subject matter of copyright. Second, the rights granted by the state law must be equivalent to the rights protected by the Copyright Law. When the rights defined by the state law would be infringed by an act which, in and of itself, would infringe one of the rights protected by the Copyright Act, the state law is preempted. There is no preemption when a violation of the state law requires acts other than those protected by copyright.” *Kregos v. Associated Press*, 3 F.3rd 656 (2d Cir. 1993)

See EXTRA ELEMENT TEST.

T: The Lanham Act, 15 USC 1051-1127, does not pre-empt state legislation in the field of trademarks.

preexisting material

C: Copyright in a compilation or derivative work containing preexisting material “does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.” 17 USC 103(b).

preferred embodiment

P: [Walker 10:10]

preferred range

P: The RANGE of a quantity in the PREFERRED EMBODIMENT. See also OPERABLE RANGE.

prejudgment interest

P: Interest awarded for a period prior to the awarding of a judgment. Prejudgment interest may be assessed in patent case without a showing that the case is exceptional. *General Motors Corp. v. Devex Corp.*, 461 US 684 (***).

C: Prejudgment interest for infringement is not provided for by statute, but has been awarded by courts. *Kleier Advertising, Inc. v. Premier Pontiac, Inc.*, 921 F.2d 1036 (10th Cir. 1990).

T: For a wrongful seizure under a SEIZURE ORDER, “[t]he court in its discretion may award prejudgment interest on relief recovered ... at an annual interest rate established

under section 6621 of the Internal Revenue Code of 1954.” 15 USC 1116(d)(11). Such interest may also be awarded in trademark counterfeiting cases “commencing on the date of the service of the claimant’s pleadings.” 15 USC 1117(b). Prejudgment interest under 15 USC 1117(a) is at the court’s discretion. *Ohio-Sealy Mattress Mfg. Corp. v. Sealy Inc.*, 776 F.2d 646 (7th Cir. 1985).

preliminary amendment

P: An amendment to an application submitted before the first office action. 37 CFR 1.115; MPEP 714.09. [Walker 12:38]

To conform claims of foreign application to U.S. practice.

In divisional: to point out differences between inventions in divisional and parent.

preliminary examination fee

P: PCT. 35 USC 362(b), 376(a)(5).

preliminary injunction

The purpose of a preliminary injunction is to preserve the status quo pending trial on the merits. 15 USPQ 2d 1613. *** standards for issuance. Likelihood of success on the merits, irreparable harm, balance of hardships, not contrary to public interest. 874 F.2d 709. (1) reasonable probability of eventual success in the litigation; (2) movant will be irreparably injured *pendente lite* if relief is not granted. Additional factors: (3) possibility of hardship to other interested persons from grant or denial; (4) public interest. *Instant Air Freight*, 882 F.2d 797. Sound discretion of trial court. The grant or denial of a preliminary injunction is immediately appealable as a matter of right. See INTERLOCUTORY APPEAL. See also SUFFICIENTLY SERIOUS QUESTIONS GOING TO THE MERITS.

P: The plaintiff must make a “clear showing” of a “reasonable” likelihood of success on the merits both as to validity and infringement. *Atlas Powder Co. v. Ireco Chemicals*, 723 F.2d 1230, 227 USPQ 289 (Fed. Cir. 1985). On appeal, the grant of a preliminary injunction can be reversed if the trial court abused its discretion, committed an error of law or seriously misjudged the evidence underlying findings of fact. *Nutrition 21 v. U.S.*, 18 USPQ 2d 1347 (Fed. Cir. 1991).

preliminary motion

P: In an interference, a part may file the following preliminary motions:

“(a) A motion for judgment on the ground that an opponent’s claim corresponding to a count is not patentable to the opponent ...

(b) A motion for judgment on the ground that there is no interference-in-fact...

(c) A motion to redefine the interfering subject matter by (1) adding or substituting a count, (2) amending an application claim corresponding to a count or adding a claim in the moving party’s application to be designated to correspond to a count, (3) designating an application or patent claim to correspond to a count, (4) designating an application or patent claim as not corresponding to a count, or (5) requiring an opponent who is an applicant to add a claim and to designate the claim to correspond to a count ...

(d) A motion to substitute a different application owned by a party for an application involved in an interference ...

(e) A motion to declare an additional interference (1) between an additional application not involved in the interference and owned by a party and an opponent's application or patent involved in the interference or (2) when an interference involves three or more parties, between less than all applications and any patent involved in the interference ...

(f) A motion to be accorded the benefit of the filing date of an earlier application

...

(g) A motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier application ...

(h) When a patent is involved in an interference and the patentee has on file or files an application for reissue ..., a motion to add the application for reissue to the interference ...

(i) When a motion is filed under paragraph (a), (b) or (g) of this section, an opponent, in addition to opposing the motion, may file a motion to redefine the interfering subject matter ... or a motion to substitute a different application ...

(j) When a motion is filed under paragraph (c)(1) of this section an opponent, in addition to opposing the motion, may file a motion for benefit under paragraph (f) of this section as to the count to be added or substituted.” 37 CFR 1.633.

preliminary statement

P: Interference. [Walker 13:9] “A party’s preliminary statement must identify the inventor who made the invention defined by each COUNT and must state on behalf of the inventor the facts required by paragraph (a) of §§1.623, 1.624, and 1.625 as may be appropriate ... The preliminary statement shall state whether the invention was made in the United States or abroad.” 37 CFR 1.622. For additional requirements for a preliminary statement, see 37 CFR 1.623-627. See SEALED ENVELOPE. See also DOUBT, EVIDENCE, MATERIAL ERROR.

premature

T: An action is premature if it is taken before it is legally permissible. For example, a refusal may not be made final in a first official action. If this is done, the refusal is said to be “premature.”

pre-patent conduct

P: The actions of an infringer prior to the issuance of a patent. Pre-patent conduct may be taken into account in regard to WILLFULNESS. 24 USPQ 2d 1321, 1340.

preponderance of the evidence

P: A standard of proof ***.

Proving direct infringement. *Lemelson v. U.S.*, 752 F.2d 1538, 224 USPQ 526 (Fed. Cir. 1985).

pre-sales activity

T: [McC 16.04]

presentation

P: A claim is presented when it first appears in an application, either originally or by amendment (in which case it is a ‘later presentation’).

preservation

C: Making or distributing a copy or phonorecord of an unpublished work in facsimile form by a library or archives for purposes of preservation or security is not an infringement of copyright if the work is currently in the collections of the library or archives. 17 USC 108(b).

President

C: The President of the United States, by proclamation, may find that a foreign nation extends copyright protection to U.S. nationals or domiciliaries and may extend copyright protection in the United States to nationals and domiciliaries and works first published in that nation. 17 USC 104(b)(5).

“Whenever the President finds that a foreign nation extends to MASK WORKS of owners who are nationals or domiciliaries of the United States protection (A) on substantially the same basis as that on which the foreign nation extends protection to mask works of its own nationals and domiciliaries and mask works first commercially exploited in that nation ... the President may by proclamation extend protection ... to mask works (i) of owners who are, on the date on which the mask works are registered ... or the date on which the mask works are first commercially exploited anywhere in the world, whichever occurs first, nationals, domiciliaries or sovereign authorities of that nation.” 17 USC 902(a).

T: The widow of a deceased President of the United States, during her lifetime, must consent before a registration will issue for a mark consisting of or comprising a name, portrait or signature identifying the deceased President. 15 USC 1052(c), 1091(a).

presumption

P: In infringement of a process by importation, sale or use of a product made by the process, if the court finds

- (1) substantial likelihood that the product was made by the patented process; and
- (2) the plaintiff has made a reasonable effort to determine that the product was made by the process but is unable to do so;

then the product shall be presumed to have been made by the process and the burden is on the defendant to establish that it was not so made. 35 USC 295.

It is presumed that the invention of an issued patent is operative. [Walker 5:17]

In an INTERFERENCE, “[a] rebuttable presumption shall exist that, as to each COUNT, the inventors made their invention in the chronological order of the earlier of their filing dates or effective filing dates.” 37 CFR 1.657.

presumption of validity

P: An issued U.S. patent is presumed valid. 35 USC 282. Each claim is presumed valid independently even if it is dependent on an invalid claim. “A patent is born valid and remains valid until a challenger proves it was stillborn or had birth defects.” *Roper Corp. v. Litton Systems, Inc.*, 757 F.2d 1266 (Fed. Cir. 1985).

C: *** statutory presumption of validity. 17 USC ***

prevailing party

C: *** Attorney’s fees. A defendant who offers judgment before trial and wins on the issue of actual damages is the “prevailing party.”

price erosion

P: *** basis for damages for infringement. 24 USPQ 2d 1321.

prima facie

P: obviousness

T: descriptiveness

prima facie evidence

C: If the copyright to a work is registered within five years after first publication of the work, the registration certificate is prima facie evidence of the facts stated therein. 17 USC 410(c). A renewal registration certificate 17 USC 304.

T: “Acknowledgment shall be prima facie evidence of the execution of an assignment and when recorded in the Patent and Trademark Office the record shall be prima facie evidence of execution” 15 USC 1060.

“Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein ... ” 15 USC 1115(a).

primarily geographically deceptively misdescriptive

T: If a mark is primarily descriptive of geographical source but the goods or services are not from that source, the mark is primarily geographically deceptively misdescriptive. TMEP 1208.05. A mark may be refused registration on the principal register if it “consists of a mark which, ... (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them.” 15 USC 1052(e). See also PRIMARILY GEOGRAPHICALLY DESCRIPTIVE.

primarily geographically descriptive

T: If the geographical significance of a mark is so clear that it would be likely to be assumed to relate to the origin of any goods or services, the mark is primarily geographically descriptive. TMEP 1208.01. A mark may be refused registration on the principal register if it “consists of a mark which, ... (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them.” 15 USC 1052(e). A mark is primarily geographically descriptive if (1) the mark is the name of a place known generally to the public; and (2) the public would make a goods/place association. Streets names can be primarily geographically descriptive. *In re Gale Hayman Inc.*, 15 USPQ 2d 1478 (TTAB 1990). If the geographic term names a place that is remote or obscure to the American consumer, it is not primarily geographically misdescriptive. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ 2d 1450 (Fed. Cir. 1987). See also PRIMARILY GEOGRAPHICALLY DECEPTIVELY MISDESCRIPTIVE.

primarily merely a surname

T: A mark may be refused registration on the principal register if it “consists of a mark which, ... (3) is primarily merely a surname.” 15 USC 1052(e). Even if a mark is a

surname, it may not be primarily so, e.g., if the mark has other meanings. TMEP 1209. It is the examiner's burden to show that a mark is primarily merely a surname. A rare name can be primarily merely a surname, *In re Rebo High Definition Studio*, 15 USPQ 2d 1314 (TTAB 1990). Adding Mr., Mrs. or other title or an initial before the surname does not eliminate its surname significance. *In re Piquet*, 5 USPQ 2d 1367 (TTAB 1987).

primary examiner

P: Final rejections must be signed by a primary examiner. A final REQUIREMENTS FOR RESTRICTION must be signed by a primary examiner. MPEP 803.01. Abbreviated PE.

primary invention

P: [Walker 21:8]

primary jurisdiction

*** Interaction between courts and administrative agencies. When to stay proceedings.

primary meaning

T: The original meaning of a trademark, as the name of the goods or services. *Cf.* SECONDARY MEANING.

primary network station

C: A "network station that broadcasts or rebroadcasts the basic programming service of a particular national network." 17 USC 119(d)(3).

primary patent

P: [Walker 22:41]

primary purpose

T: Is primary purpose to package or to serve as a trademark?

primary reference

P: *Cf.* SECONDARY REFERENCE.

primary significance test

T: principal distinguishing characteristics. "To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 US 844, 214 USPQ 1 (1982).

primary transmission

C: A "transmission made to the public by the transmitting facility whose signals are being received and further transmitted by the secondary transmission service, regardless of where or when the performance or display was first transmitted." 17 USC 111(f), 17 USC 119(d)(4).

principal distinguishing characteristics

P: Properties of an asexually reproduced plant that may be claimed in a PLANT PATENT. Rule 164

Principal Register

T: “The term ‘principal register’ refers to the register provided for by section 1052 to 1072 of this title.” 15 USC 1127. “All applications will be treated as seeking registration on the Principal Register unless otherwise stated in the application.” 37 CFR 2.46. “An application for registration on the Principal Register under section 1(a) or section 44 may be changed to an application for registration on the Supplemental register and vice versa.” 27 CFR 2.75(a). “An intent-to-use application may be so amended only after submission of a statement of use or amendment to allege use.” 37 CFR 2.75(b). Cf. SUPPLEMENTAL REGISTER.

Discuss prima facie effect, etc. ***

Principle test

U: For tie-in. [McC 31.33[4]d]

principle

C: By statute, a principle embodied in a work is not copyrightable. “In no case does copyright protection ... extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 USC 102(b). The principle is analogous for MASK WORKS.

print

C: One of the types of works protected by the Copyright Act of April 29, 1802. See also design, engraving, etching. Prints fall in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 101. A type of WORK OF VISUAL ART. 37 CFR 202.3(b)(1)(iii). A print may be a WORK OF THE VISUAL ARTS. 17 USC 101.

T: An item of printed matter. It is TRADEMARK INFRINGEMENT to apply a reproduction of a registered mark to a print intended to be used in commerce where such use is likely to cause confusion, or to cause mistake, or to deceive. 15 USC 1114(1)(B). Prints bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

printed matter

P: Printed matter does not constitute patentable subject matter. *In re Gulack*, 703 F.2d 1381. “[A] mere arrangement of printed matter though seemingly a ‘manufacture’ is rejected as not being within one of the statutory classes.” MPEP 706.03(a). Printed matter by itself is unpatentable but may be claimed as part of a combination. *In re Miller*, 164 USPQ 46.

printed publication

P: A person is not entitled to a patent if ‘the invention was ... described in a printed publication in this or a foreign country, before the invention thereof by the applicant.’ 35 USC 102(a). See also BAR, MAGAZINE, STATUTORY BAR.

printer

T: See INNOCENT INFRINGER, INNOCENT VIOLATOR.

prior art

P: All knowledge, including patents and publications, relating to a claimed invention. “‘Prior art’ is the existing body of technical knowledge against which the patentability

of an invention is judged.” MPEP 706.02. An inventor is conclusively presumed to be familiar with all prior art. *Brenner v. Ladd*, 247 F.Supp. 51. “The prior art primarily comprises REFERENCES that are within the field of the inventor’s endeavor.” *Heidelberger Durkmaschinen v. Hantscho Commercial Prods.*, 30 USPQ 2d 1377, 1379 (Fed. Cir. 1994). See also ANALOGOUS ART, MATTER OF COMMON KNOWLEDGE, CONVENTIONAL, PERSONAL KNOWLEDGE, WELL KNOWN.

prior invention

P: A defense to patent infringement in which the challenger shows that the patentee was not the original inventor. Prior invention must be shown by clear and convincing evidence. *Pentech Int’l. v. Hayduchok*, 18 Q2 1337 (S.D. N.Y. 1990).

prior registration

T: “Prior registration of the same or similar marks owned by the applicant should be identified in the application.” 37 CFR 2.36. ** Discuss citation of prior registrations in support of application. See also REFERENCE.

prior use

T: It is a defense to trademark infringement that “the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant’s prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 7(c), (B) the registration of the mark under this Act if the application for registration is filed before the effective date of the Trademark Revision Act of 1988, or (C) publication of the registered mark under section 1062 of this title: *Provided, however*, That this defense or defect shall apply only for the area in which such continuous prior use is proved.” 15 USC 1115(b)(5).

It is a defense to trademark infringement that “the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under section 1062(c) of this title of the registered mark of the registrant, and not abandoned, *Provided, however*, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant’s mark.” 15 USC 1115(b)(6).

priority

P: The first inventor to conceive has priority provided that he has been diligent from a time immediately preceding conception by the earliest junior inventor.

See also FOREIGN PRIORITY, PRIORITY OF INVENTION.

priority action

T: Notice of an INFORMALITY requiring a written response by applicant. It is so called because the application will receive priority if a response is received within two months. Such an action is permissible only for a REQUIREMENT, not for a statutory REFUSAL. TMEP 1111.03.

priority date

P: For PCT applications, the priority date is defined in PCT Art. 2(xi). 37 CFR 1.401(f).

priority of invention

P: “In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive but last to reduce to practice, from a time prior to conception by the other.” 35 USC 102(g). “Inventor testimony regarding priority of invention must be supported by some type of corroborating evidence.” *Mergenthaler v. Scudder*, 11 App. DC 264 (1897). For the effect of priority of invention on DOUBLE PATENTING rejections, see MPEP 804.07.

priority papers

P: 37 CFR 1.55.

privacy

U: The right of a person to be free from unwanted publicity.

private deposit

P: See DEPOSIT.

private home viewing

C: The viewing for private use in a household by means of a satellite reception equipment which is operated by an individual in that household and which serves only such household, of a secondary transmission delivered by a satellite carrier of a primary transmission of a television station licensed by the Federal Communications Commission. 17 USC 119(d)(5).

private study

C: It is not an infringement of copyright for a library or archives to make a copy or phonorecord of certain works from its collection at the request of another library or archive provided, inter alia, that the library or archives had no notice that the copy or phonorecord would be used for any purpose other than “private study, scholarship or research.” 17 USC 108(d)(1).

privity

P: 1. An invention subject to a secrecy order is held abandoned if the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, publishes, discloses or files for a patent in a foreign country. 35 USC 182.

2. “Privity, like the doctrine of ASSIGNOR ESTOPPEL itself, is determined upon a balance of the equities ... If an inventor assigns his invention to his employer company A and leaves to join company B, whether company B is in privity with and thus bound by the doctrine will depend on the equities dictated by the relationship between the inventor and company B in light of the act of infringement.” *Shamrock Technologies, Inc. v. Medical Sterilization, Inc.*, 903 F.2d 789, 14 USPQ 2d 1728 (Fed. Cir. 1990).

T: It is a defense to TRADEMARK INFRINGEMENT “[t]hat the registered mark is being used, by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used.” 15 USC 1115(b)(3).

pro confesso injunction

P: [Walker 25:27]

pro se applicant

P: An applicant who is not represented by an attorney or PATENT AGENT. “When, during the examination of a pro se case, it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, the examiner shall draft one or more claims for the applicant.” MPEP 707.07(j).

T: One who represents himself before the PTO. The Office is solicitous of such applicants and provides them with additional help and guidance.

procedure

C: Procedures are not copyrightable. “In no case does copyright protection ... extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 USC 102(b). A similar provision applies to MASK WORKS. 17 USC 902(c).

proceeding

An administrative ***.

process

P: A “mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing. *Cochrane v. Deener*, 94 US 780 (***). As used in the Patent Act, “process” means “process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter or material. 35 USC 100(b).

See also NON-COMMERCIAL USE, NONESSENTIAL COMPONENT.

C: The term “process” includes one now known or later developed. 17 USC 101. Processes are not copyrightable. “In no case does copyright protection ... extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 USC 102(b).

S: A “process” may constitute a trade secret. UTSA 1(4).

process claim

P: Also METHOD CLAIM. *Cf.* APPARATUS CLAIM.

process patent

P: “A product which is made by a patented process will ... not be considered to be so made after — (1) it is materially changed by subsequent processes; or (2) it becomes a trivial and nonessential component of another product.” 35 USC 271(g).

Process Patent Amendment Act of 1988

P: 35 USC 271(g) (Public Law 1000-418, Sec. 9003, 1002 Stat. 1583-4, Aug. 23, 1988).

processing and retention fee

P: The fee required to prevent disposal by the PTO of an application that has been accorded a filing date but is incomplete and thus cannot be examined. 37 CFR 1.53(d).

procurist

T: In certain countries, corporate officer. TMEP 803.11

produce

P: “The term ‘produce,’ when used in relation to SPECIAL NUCLEAR MATERIAL, means (1) to manufacture, make, produce, or refine special nuclear material; (2) to separate special nuclear material from other substances in which such material may be contained; or (2) to make or to produce new special nuclear material.” 42 USC 2014.

product

P: An ARTICLE OF MANUFACTURE or COMPOSITION.

A term used in 35 USC 156 to mean “(A) A drug product. (B) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.” 35 USC 156(f)(1).

product-by-process claim

P: “An article may be claimed by a process of making it provided it is definite.” MPEP 706.03(e), *In re Pilkington*, 162 USPQ 145. A product defined by the process by which it can be made is nevertheless a PRODUCT CLAIM. MPEP 806.05(f); *In re Bridgford*, 149 USPQ 55 (CCPA 1966). Therefore, the resulting product must be new to be patentable. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

product claim

P: A claim directed to a PRODUCT.

product disparagement

T: Added to Lanham Act by TLRA, 1988.

product mark

T: A trademark used in connection with a specific commodity, as opposed to a house mark, which is used on multiple goods of the same producer. TMEP 804.02.

product of nature

P: Products of nature, that is, naturally occurring substances, are not patentable.

productive use

C: A use that “result[s] in some added benefit to the public beyond that produced by the first author’s work.” *Sony*, 464 U.S. 417, 478. A subfactor in evaluating the PURPOSE AND CHARACTER of a work for FAIR USE purposes.

professional model product

C: An “audio recording device that is designed, manufactured, marketed, and intended for use by recording professionals in the ordinary course of a lawful business, in accordance with such requirements as the Secretary of Commerce shall establish by regulation.” 17 USC 1001(10).

profits

P: See also LOST PROFITS, SEPARATION OF PROFITS.

C: Liability for profits from infringement is several only. *MCA, Inc. v. Wilson*, 677 F.2d 180 (2d Cir. 1981). See SEVERAL LIABILITY.

T: In trademark cases, “defendant’s profits” may be recovered as damages. “In assessing profits the plaintiff shall be required to prove defendant’s sales only; defendant must prove all elements of cost or deduction claimed. ... If the court shall

find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find just ...” 15 USC 1117(a).

project

T: commercial impression ***.

prolixity

P: “Claims are rejected as prolix when they contain long recitations of unimportant details which hide or obscure the invention.” MPEP 706.03(g). The prohibition derives from *Ex parte Iagan*, 1911 C.D. 10, 162 O.G. 538. Amendment may be required to correct “unnecessary prolixity.” 37 CFR 1.117.

promotional material

C: Promotional material may not constitute a WORK OF VISUAL ART. 17 USC 101.

proof of authority

P: If the inventor is dead, insane or legally incapacitated, proof of the power or authority of the legal representative must be recorded in the PTO before a patent will be granted. 37 CFR 1.44.

proper means

S: “Proper means” of acquiring a trade secret include

1. Discovery by independent invention;
2. Discovery by reverse engineering;
3. Discovery under a license from the owner;
4. Observation of the item in public use or on public display;
5. Obtaining the trade secret from published literature.” UTSA, 14 ULA 403 (1985 & Suppl. 1990). *Cf.* IMPROPER MEANS.

proportionality

C: A test to determine whether use of a copyrighted work is a FAIR USE, which requires an examination of “the amount and substantiality of the portion used in relation to the copyrighted work as a whole.” 17 USC 107(3).

proportions

P: [Walker 22:28]

proposed

T: A designation used for papers submitted in connection with an application that have not yet been formally ENTERED and thus do not yet have any effect. TMPEP 710.03.

proposed count

P: “An applicant may seek to have an INTERFERENCE declared with an application by (1) Suggesting a proposed COUNT and presenting at least one claim corresponding to the proposed count ...” 37 CFR 1.604(a).

prosecution

P: Prosecution may be conducted by the assignee to the exclusion of the inventor. 37 CFR 1.32.

T:

prosecution history

P:

prosecution history estoppel

P: The principle that a patentee, once having narrowed his claims during the prosecution of a patent to overcome a substantive rejection, cannot assert the doctrine of equivalents to recover what has been surrendered. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (**). Formerly known as FILE WRAPPER ESTOPPEL, a term derived from the jacket or “file wrapper” in which the papers associated with an application are kept. The principle applies to arguments submitted to obtain the patent, *Coleco Indus. Inc. v. U.S. Int’l. Trade Comm’n.*, 573 F.2d 1247, 197 USPQ 472 (CCPA 1978) and to claim amendments made to overcome prior art, *Prodyne Enterprises Inc. v. Julie Pomerantz, Inc.*, 743 F.2d 15881, 223 USPQ 477 (Fed. Cir. 1984).

prospective manufacture

P: “An application may be made special on the ground of prospective manufacture” if the applicant alleges that he possesses sufficient presently available capital and facilities to manufacture the invention in quantity but will not unless certain that the patent will be granted and obligates himself to manufacture the invention in the United States immediately upon allowance of claims or issuance of the patent.” MPEP 708.02.

protected expression

C: See EXTRINSIC TEST, INTRINSIC TEST.

protest

P: A member of the public may protest against a pending application. 37 CFR 1.291. Receipt of the protest will be acknowledged but the PTO will not engage in further communication with the protester. 37 CFR 1.291(c). [Walker 14:1]

T: See LETTER OF OBJECTION. TMEP 1503.03.

protective order

An order of court to protect a party or person from whom discovery is sought from “annoyance, embarrassment, oppression, or undue burden or expense, including ... (7) that a trade secret or other confidential research, development, or commercial information not be disclosed or disclosed only in a designated way.” FRCP 26(c).

T: In connection with a SEIZURE ORDER, “[t]he court shall enter an appropriate protective order with respect to discovery by the applicant of any records that have been seized.” 15 USC 1116(d)(7).

provisional application

P:

provisional double patenting rejection

P: “When two or more pending applications of (1) the same INVENTIVE ENTITY, (2) the same assignee, or (3) having at least one common inventor, contain CONFLICTING CLAIMS which are not PATENTABLY DISTINCT, a ‘provisional’ double patenting rejection ... should be made in each application. Such a rejection is ‘provisional’ since the conflicting claims are not, as yet, patented.” MPEP 804.

provisional election

P: In responding to a requirement for restriction, the applicant, though he disagrees with the requirement and requests reconsideration, “must indicate a provisional election of one invention for prosecution.” 37 CFR 1.143, MPEP 803.02.

provisional rejection

P: See PROVISIONAL DOUBLE PATENTING REJECTION.

provoke

P: To “provoke” an INTERFERENCE is to initiate an interference. 37 CFR 1.607(c).

pseudonymous work

C: A “work on the copies or phonorecords of which the author is identified under a fictitious name.” 17 USC 101. A contract to create a pseudonymous work is inconsistent with the moral right of ATTRIBUTION, which entitles an author to credit for his creation.

PTO

The PATENT AND TRADEMARK OFFICE.

pub search

T: = PENDING SEARCH.

public display

C:

public domain

Available for use by anyone.

C: “Title 17, United States Code, does not provide copyright protection for any work that is in the public domain in the United States.” Berne Convention Implementation Act, Sec. 12.

public domain computer software

C: Software “which has been publicly distributed with an explicit disclaimer of copyright protection by the copyright owner.” 37 CFR 201.26(b)(3). Such software may be so designated in a DOCUMENT PERTAINING TO COMPUTER SHAREWARE. 37 CFR 201.26(d). A copy may be donated to the Gift Section of the Copyright Office for the benefit of the Machine-Readable Collections Reading Room. 37 CFR 201.26(g).

Public Health Service Act

P: 35 USC 156(f)(2)(A). See also PATENT TERM EXTENSION.

public inspection

P: Many foreign countries open patent application for public inspection during the application process. No earlier filing date may be claimed under 35 USC 119 on a patent that has been opened for public inspection.

public interest

In some circuits, a PRELIMINARY INJUNCTION will not issue if it would be adverse to the public interest. *Lundgrin v. Claytor*, 619 F.2d 61 (***)

T: Seizure under 15 USC 1116(d) may be denied if “public interest in a potential prosecution so requires.”

public library

P: The Commissioner may supply printed copies of patents to public libraries. 35 USC 13.

public performance

C: A performance that occurs “at a place open to the public or at any place where a substantial number of persons outside of a normal circle of family and its social acquaintances is gathered.” 17 USC 101.

public place

C: The copyright in an architectural work that has been constructed is not infringed by the making, distribution or public display of pictorial representations of the work, if the building in which the work is embodied is “located in or ordinarily visible from a public place.” 17 USC 120(a). See also PUBLIC PERFORMANCE.

Public Place Clause

C: The first clause of the definition of “publicly” in 17 USC 101, providing that a work is performed or displayed “at a place open to the public or at any place where a substantial number of persons outside of a normal circle of family and its social acquaintances is gathered.” Cf. TRANSMISSION CLAUSE.

public policy

P: An invention whose only use is against public policy will be rejected as not having UTILITY. MPEP 706.03(p).

public use

P: “Any use of an invention by a person other than the inventor who was under no limitation, restriction or obligation of secrecy to the inventor.” *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976 (Fed. Cir. 1983). Nonsecret, nonexperimental or commercial use of the invention prior to the CRITICAL DATE. *Sauquoit*, 419 US 1057. Public use of an invention more than one year prior to the filing of a U.S. patent application bars patentability. 35 USC 102(b). To invalidate a patent on the ground of public use, a party must show such use by CLEAR AND CONVINCING EVIDENCE. *T.P. Labs*, 724 F.2d 965. See PUBLIC-USE BAR, PUBLIC USE PROCEEDING. Cf. EXPERIMENTAL USE.

public-use bar

P: One may not receive a patent for an invention that was “in public use or on sale in this country, more than one year prior to the date of application for the patent in the United States.” 35 USC 102(b). This BAR is statutory and cannot be waived by the PTO. Cf. ON-SALE BAR, STATUTORY BAR.

public use proceeding

P: An administrative proceeding in the PTO to determine whether an invention claimed in an application was in public use or on sale so as to constitute a STATUTORY BAR to the issuance of a patent. If a petitioner makes a “prima facie showing that the invention claimed in an application believed to be on file had been in public use or on

sale more than one year before the filing of an application, the Commissioner may hold a hearing to determine whether a public use proceeding should be instituted.” 37 CFR 1.292(a). The petitioner will be heard. *Cf.* PROTEST, in which the protester is not heard. The petitioner must pay a sizable fee to initiate such a proceeding. 37 CFR 1.17(j). “The outcome of a public use proceeding may also be the basis of a rejection.” MPEP 706.03(u).

public work

C: Works first published outside the United States and registered under 17 USC 408 after publication in the United States but before a DEMAND FOR DEPOSIT is made under 17 USC 407(d) are exempt from DEPOSIT requirements. 37 CFR 202.19(c)(10)(ii).

publication

P:

1. See PRINTED PUBLICATION.
2. “The publication under the [PCT] treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication.” 35 USC 374.

C: The “distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or public display of a work does not of itself constitute publication.” 17 USC 101.

T: 1. If it appears that a mark is entitled to registration or would be so entitled upon acceptance of a STATEMENT OF USE, “the Commissioner shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office ...” 15 USC 1062(a). The purpose of publication is to permit a party that believes it would be damaged by the registration to file a notice of opposition. 15 USC 1063. If the mark is not successfully opposed, a CERTIFICATE OF REGISTRATION will be issued, except for an INTENT-TO-USE APPLICATION, in which case a NOTICE OF ALLOWANCE will be issued. 15 USC 1063(b)(2). Upon registration, notice of the registration is published in the Gazette. 15 USC 1063(b)(1).

Among pending applications, the one with the earliest effective filing date has priority for publication. 37 CFR 2.83.

Marks registered on the Supplemental Register are not subject to opposition but are published on registration. 15 USC 1092.

2. In a civil action appealing from a decision of the TTAB, “summons against adverse parties residing in foreign countries may be served by publication.” 15 USC 1071(b)(4).

Publication and Issue Section

T: The PTO section that processes applications that have been passed to publication. TMEP 303.02.

publication doctrine

P: The doctrine that copyright in a work is lost upon first publication unless copyright notice has been affixed to copies of the work. For works published prior to January 1, 1978, copyright is irrevocably lost. For works published on or after January 1, 1978

but before March 1, 1989, copyright can be saved by the escape provision of 17 USC 405(a). For works published on or after March 1, 1989, the publication doctrine has been made inapplicable by the Berne Convention Implementation Act, which made notice optional. See also LIMITED PUBLICATION RULE.

publicity

See RIGHT OF PUBLICITY.

publicly

C: “To perform or display a work ‘publicly’ means (1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of family and its social acquaintances is gathered; or (2) to transmit or otherwise communicate a performance or display of the work to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.” 17 USC 101.

published

T: The status of a trademark application that has been approved for publication in the Official Gazette for opposition. Also IN PUBLICATION. TMEP 407.

published work

C: A published work is subject to copyright protection if “(1) on the date of first publication, one or more of the authors is a national or domiciliary of the United States, or is a national, domiciliary, or sovereign authority of a foreign nation that is a party to a copyright treaty to which the United States is also a party, or is a stateless person, wherever that person may be domiciled; or (2) the work is first published in the United States or in a foreign nation that, on the date of publication, is a party to the Universal Copyright Convention; or (3) the work is first published by the United Nations or any of its specialized agencies, or by the Organization of American States; or (4) the work is a Berne Convention work; or (5) the work comes within the scope of a Presidential proclamation. Whenever the President finds that a particular foreign nation extends, to works by authors who are nationals or domiciliaries of the United States or to works that are first published in the United States ... the President may by proclamation extend protection under this title ...” 17 USC 104(b).

Puerto Rico

C: For purposes of the Copyright Act, the Puerto Rico is a STATE. 17 USC 101.

pull effect

P: In computing lost profits due to infringement, the power of a patented product to cause sales of related unpatented products, known as the “pull effect,” may be taken in to account. *TWM Mfg. Co. v. Dura Corp.*, 789 F.2d 895 (Fed. Cir. 1986).

punitive damages

Damages awarded to punish the wrongdoer rather than to compensate the victim.

C: Punitive damages are not available for copyright infringement. *Kelly v. L.L. Cool J.*, 145 F.R.D. 32 (S.D.N.Y. 1992).

S: Punitive damages may be awarded in trade secret cases. *Clark v. Bunker*, 453 F.2d 1006.

purchaser

T: See also RECORDATION.

purchaser motivation

T: The reason a consumer chooses particular product. “Purchaser motivation shall not be a test for determining abandonment.” 15 USC 1127.

purpose and character

C: The “purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purpose” is one of four statutory factors in determining whether the use is a FAIR USE. 17 USC 107 Three subfactors are used in evaluating purpose and character: (1) whether the use was PRODUCTIVE; (2) whether the use was commercial; and (3) whether the alleged infringer’s conduct was proper. 792 F.Supp. 132.

PVPA

P: Abbreviation for the PLANT VARIETY PROTECTION ACT, 7 USC 2321 *et seq.*

quality

T: Certification of the quality of goods and services is one of the functions of a CERTIFICATION MARK. 15 USC 1127.

quality control

T: “One of the most valuable and important protections afforded by the Lanham Act is the right to control the quality of the goods manufactured and sold under the holder’s trademark.” *El Greco Leather Prod. Co., Inc. v. Shoe Work, Inc.*, 806 F.2d 392, 395, 1 USPQ 2d 1016 (2d Cir. 1986), *cert. denied*, 484 US 817 (1987). “[T]he most corrosive and irreparable harm attributable to trademark infringement is the inability of the victim to control the nature and quality of the defendant’s goods.” *Ideal Industries v. Gardner Binder, Inc.*, 612 F.2d 1018, 1026, 20 USPQ 2d 177 (7th Cir. 1979), *cert. denied*, 477 US 924, 206 USPQ 804 (1980).

quasi de novo

T: Appellate review in which new evidence may be introduced but new issues not raised below may not be addressed. This form of review is employed in appeals from decisions of PTO on appeal to the District Courts under 35 USC 145 and 15 USC 1071(b). The findings of the PTO will be upheld unless the court is of the “thorough conviction” that a different result is required. By contrast, in reviewing matters of fact, the CAFC applies the CLEARLY ERRONEOUS standard. *** Citation for District court.

question of fact

A decision on a question of fact can be overturned on appeal only if it is “clearly erroneous.”

P: amount of damages

anticipation. *Chester v. Miller*, 906 F.2d 1574, 15 USPQ 2d 1333 (Fed. Cir. 1990).

diligence. *Bell Telephone Laboratories, Inc. v. Hughes Aircraft Co.*, 564 F.2d 654, 195 USPQ 695 (3rd Cir. 1977), *cert. denied*, 197 USPQ 448 (1978).

equivalence. *Graver*, 39 US 605.

existence of non-infringing substitute.

identity of invention. *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985). [Walker 4:54]

utility. *Newman v. Quigg*, 877 F.2d 1575, 11 USPQ 2d 1340 (Fed. Cir. 1989).

Whether a case is exceptional.

Whether direct infringement has occurred.

Whether a reference is ANALOGOUS ART.

Whether a NON-INFRINGEMENT SUBSTITUTE exists. 24 USPQ 2d 1321, 1337.

willfulness of infringement.

T: Genericness.

Distinctiveness. TMEP 1211.02.

Acquired distinctiveness. *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

Functionality. *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1506, 4 USPQ 2d 1877 (9th Cir. 1987).

Likelihood of confusion.

question of law

A question of law may be reviewed *de novo* by an appellate court.

P: Validity,

claim construction. *Moeller v. Ionetics, Inc.*, 794 F.2d 653.

claim definiteness. *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 20 USPQ 2d 1094 (Fed. Cir. 1991).

conception

enablement

inventorship

obviousness: *In re Woodruff*, 919 F.2d 1525, 1577, 16 USPQ 2d 1934 (Fed. Cir. 1990);
In re Kulling, 897 F.2d 1147.

reduction to practice. *DSL Dynamic Sciences Ltd. v. Union Switch & Signal, Inc.*, 928 F.2d 1122, 18 USPQ 2d 1152 (Fed. Cir. 1991).

validity

T: Subject matter jurisdiction.

qui tam

Action. 35 USC 292.

®

T: The REGISTRATION SYMBOL, used in Costa Rica, Denmark, Guatemala, Luxembourg, the Netherlands and the United States to indicate a registered trademark. TMEP 902. One statutory form of the NOTICE OF REGISTRATION of a trademark. 15 USC 1111.

Racketeer Influenced and Corrupt Organization Act

S: A statute, 18 USC 1961-68, prohibiting persons from investing in, maintaining an interest in or participating in an enterprise through a pattern of racketeering activity that affects interstate commerce. The act may be enforced both through criminal indictment

and private civil action. Theft of trade secrets is encompassed by “racketeering activity.” Abbreviated RICO.

racketeering activity

S: Illegal activities as defined in the RICO statute, 18 USC 1961-68, including mail fraud, 18 USC 1341, wire fraud, 18 USC 1343, violations of the National Stolen Property Act, 18 USC 2314 and 18 USC 2315. Racketeering activity can include the theft of trade secrets.

range

P: A claim limitation of the form “from __ to __,” where the blanks stand for numbers. When a claim covers several compositions (for example, by reciting a range), a prior art reference disclosing one of the compositions anticipates the claim. *Titanium Metals v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See also OPERABLE RANGE, PREFERRED RANGE.

read on

P: A claim “reads on” a specification or device if every element of the claim can literally be found as described therein. “Each and every limitation recited in the claim must be present in the accused structure” for LITERAL INFRINGEMENT to be found. *Builders Concrete, Inc. v. Bremerton Concrete Prods. Co.*, 757 F.2d 255, 225 USPQ 240 (Fed. Cir. 1985). “The structures of the accused device [must] do the same work in substantially the same way, and accomplish substantially the same result as those of the patented device.” *Autogiro Co. of America v. U.S.*, 384 F.2d 399, 155 USPQ 697 (Ct. Cl. 1967).

reasonable certainty

T: A NOTICE OF OPPOSITION must identify the OPPOSER “with reasonable certainty.” 37 CFR 2.102(***)..

reasonable effort

P: Before a plaintiff is entitled to the PRESUMPTION that a product was made by a patented process, he must make reasonable effort to so determine. 35 USC 295. Cf. DILIGENT EFFORT.

reasonable notice

C: A notice of copyright “shall be affixed to the copies in such manner and location as to give reasonable notice of the claim of copyright.” 17 USC 401(c).

T: The United States attorney must receive “such notice as is reasonable under the circumstances” of an application for seizure under the Trademark Counterfeiting Act, 15 USC 1116(d).

reasonable royalty

P: “Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.” 35 USC 284. See WILLING LICENSOR-WILLING LICENSEE RULE.

C: 17 USC 405(b). January 1, 1978 - March 1, 1989. Nimmer 14.02.

T: [McC 30.27]

S: A reasonable royalty may be awarded to a party whose trade secret is misappropriated if no other measure of damages is possible. *Structural Dynamics Research Corp. v. Engineering Mechanics Research Corp.*, 401 F.Supp. 1102 (***).

reasonable time

T: A telegraphic amendment will be accepted as timely filed if a written confirmation is received within a “reasonable time.” TMEP 710.03(c).

reasonably prudent person

P: See WILLFUL INFRINGEMENT.

reasons

P: If the record of a prosecution does not make clear the reasons for allowance, the examiner may set forth his reasoning in an office action or separate communication. The applicant may also file a statement. 37 CFR 1.109.

rebuttal

P: Before Board. ***

T: Before TTAB. ***

recapture

P: One cannot recover by REISSUE claims that were voluntarily limited or cancelled during prosecution.

T: The recovery of rights in a trademark that has become generic.

receipt

P: The date of recording of an assignment is “the date of receipt of the assignment at the office in proper form and accompanied by the fee set forth in §1.21(h).” 37 CFR 1.302.

C: “The Register of Copyrights shall, when requested by the depositor and upon payment of the fee prescribed by section 708, issue a receipt for the deposit.” 17 USC 407(b).

Receiving Office

P: A “national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.” 35 USC 351(f).

receptacle

T: It is TRADEMARK INFRINGEMENT to apply a reproduction of a registered mark to a receptacle intended to be used in commerce where such use is likely to cause confusion, or to cause mistake, or to deceive. 15 USC 1114(1)(B). Receptacles bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

reciprocal rights

P: foreign countries. [Walker 9:7]

recite

P: To set forth explicitly in a claim.

C: Reciting a work constitutes a PERFORMANCE of the work. 17 USC 101.

T: To list goods in an IDENTIFICATION OF GOODS. See also RECITATION.

recitation

T: An IDENTIFICATION OF GOODS in a trademark application.

recognize

C: A compulsory licensee “shall be considered to ‘recognize’ revenue from the sale of a phonorecord when sales revenue would be recognized in accordance with the generally accepted accounting principles as expressed by the American Institute of Certified Public Accountants or the Financial Accounting Standards Board, whichever would cause sales revenue to be recognized first.” 37 CFR 201.19(a)(5).

recombinant DNA

P: 35 USC 271(e). Patents for methods of manufacturing products that primarily use recombinant DNA technology and have been subject to regulatory review may be eligible for EXTENSION OF PATENT TERM. 35 USC 156(a)(5)(B), 156(f)(2)(B). Applications relating to the safety of research in the field of recombinant DNA will be made SPECIAL. MPEP 708.02. See also PETITION TO MAKE SPECIAL.

recombinant RNA

P: 35 USC 156(f)(2)(B), 271(e).

reconditioning

P, T: See REPAIR.

reconsideration

P: Upon petition to the Commissioner, “it may be required that there have been a proper request for reconsideration.” 37 CFR 1.181(c).

A request for reconsideration of a Board decision must be made within one month of such decision. 37 CFR 1.197(b).

“After response by applicant or patent owner, the application or patent under reexamination will be reconsidered and again examined.” 37 CFR 1.112.

Reconsideration by the Commissioner of an action taken by a former Commissioner is limited by the principles governing the granting of new trials. 37 CFR 1.184.

T: “After response by the applicant, the application will be reexamined or reconsidered. If registration is again refused or any formal requirement is repeated, but the examiner’s action is not stated to be final, the applicant may respond again.” 37 CFR 2.63(a).

Reconsideration of a refusal or requirement is sought by means of a REQUEST. A request for reconsideration is not a proper reply to a final action. TMEP 1110.

TTAB: motions, judgments.

The examining attorney may request reconsideration of decision of the TTAB “only if the Board reverses the attorney’s decision as to all issues and determined that the mark must be published for opposition or that the registration must issue.” EG 1-92. See *In re Ferrero S.p.A.*, ____ USPQ 2d ____ (TTAB 1992).

reconstruction

P: “Reconstruction of a patented entity, comprised of unpatented elements, is limited to such a true reconstruction of the entity as to in fact make a whole new article ... Mere

replacement of individual unpatented parts, one at a time, whether of the same part repeatedly or different parts successively, is no more than the lawful right of the owner to REPAIR his property.” *Aro Mfg. Co. v. Convertible Top Replacement Co., Inc.*, 365 US 336, 346, 128 USPQ 354 (1961).file, including ***. Making evidence of record.

record

T: file, including ***. Making evidence of record.

In a civil action appealing from a decision of the TTAB or the Commissioner, the PTO record may be “admitted on motion of any party.” 15 USC 1071(b)(3).

record on appeal

P: [Walker 17:57]

T: On appeal to TTAB, record must be complete.

records

T: “In the case of a civil action arising under section 32(1)(a) of this Act (15 USC 1114) or section 110 [of the Olympic Charter Act] with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order ... providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.” 15 USC 1116(d)(1)(A).

recordable document

C: “Any transfer of copyright ownership (including any instrument of conveyance, or note or memorandum of the transfer), or any other document pertaining to a copyright, may be recorded in the Copyright Office.” 37 CFR 201.4(c). The transfer must be accompanied by a fee and must bear a SIGNATURE, and be COMPLETE and LEGIBLE. See RECORDATION.

T: The PTO maintains a liberal policy on the type of instruments that may be recorded, but will accept only original documents or certified copies of original documents. TMEP 501.05(a).

recordation

P: 35 USC 261, 37 CFR 1.331. The date of recording of an assignment is “the date of receipt of the assignment at the office in proper form and accompanied by the fee set forth in §1.21(h).” 37 CFR 1.302. “No instrument will be recorded which is not in the English language and which does not amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title of the patent or invention to which it relates, and which does not identify the patent or application to which it relates, except as ordered by the Commissioner.” 37 CFR 1.331(b).

C: 17 USC 205. All documents relating to a copyright may be recorded. Recordation of transfers was formerly required for the transferee to bring a lawsuit, but this was repealed by the BCIA.

T: “An assignment shall be void as against any subsequent purchaser for a valuable consideration without notice, unless it is recorded in the Patent and Trademark Office within three months after the date thereof or prior to such subsequent purchase.” 15 USC 1060. TMEP 502. recordable: licenses, security interests.

recording

C: See SOUND RECORDING.

Rectanus

T: See TEA ROSE-RECTANUS DOCTRINE.

reduction to practice

P: invention.

Actual: physical construction of apparatus, making composition.

Constructive: filing application.

“This issue of reduction to practice is a question of law ...” *DSL Dynamic Sciences Ltd. v. Union Switch & Signal, Inc.*, 928 F.2d 1122, 18 USPQ 2d 1152 (Fed. Cir. 1991).

Cf. CONCEPTION.

reel and frame

P,T: The method used by the PTO to index recorded documents, which are stored on reels of microfilm. TMEP 501.04. *Cf.* LIBER AND PAGE.

reexamination

P: A PTO proceeding in which the validity of an unexpired patent is reconsidered in light of prior art. 35 USC 302. The Commissioner or any person may institute the reexamination of a patent. 35 USC 304. Such a person is known as a “requester.” 37 CFR 1.501. Reexamination proceedings are conducted with “special dispatch.” 35 USC 305. A patent may be amended prior to or during reexamination. 37 CFR 1.115.

“Requests for reexamination should be additionally marked “Box Reexam’.” 37 CFR 1.1(c). Reexamination has been available since 1980. See also INTERVENING RIGHTS. *Cf.* ORIGINAL PROSECUTION.

T: See RECONSIDERATION.

reference

P: A citation of an item of PRIOR ART. Requirement of a reference for 102. References may be combined to show that an invention is obvious provided that the prior art suggests combining them. *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547 (***). The examiner must cite the “best reference at his command.” 37 CFR 1.106(b), 1.107. A reference must be taken in its entirety, including those portions which TEACH AWAY from the claimed invention. *Bausch & Lomb, Inc. v. Barnes-Hind Hydrocurve, Inc.*, 230 USPQ 416, 420 (Fed. Cir. 1986). See also ANALOGOUS ART, AUXILIARY REFERENCE, BASIC REFERENCE, COMBINING REFERENCES, PRIMARY REFERENCE, SECONDARY REFERENCE.

T: A citation of a registered mark as grounds for refusing an application for registration. See also KNOWN MARK.

Reference and Bibliography Section

C: A section of the Copyright Office that receives searches copyright registrations and recordations. 37 CFR 201.1(d).

reference numerals

P: Numbers designating elements of a patent drawing. Reference numerals that refer to the drawings may also be used in the claims. MPEP 608.01(m)**.*.

reference work

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i).

refund

P: “The Commissioner may refund any fee paid by mistake or any amount paid in excess of that required. 35 USC 42(d). Fees paid to the CAFC are not refundable. Fed. Cir. Rule 52.

C: “The Register may ... refund any sum paid by mistake or in excess of the fee required by this section.” 17 USC 708(c).

refusal

P: 1. If an inventor refuses to execute a patent application, his assignee, one to whom he had a duty to assign or “one who shows sufficient proprietary interest in the matter” may file a patent application in his behalf. 35 USC 118. “If a JOINT INVENTOR refuses to join in an international application which designates the United States of America or cannot be found or reached after diligent effort, the international application which designates the United States of America may be filed by the other inventor on behalf of himself or herself and the omitted inventor.” 37 CFR 1.425.

2. Failure of the PTO to allow a patent claim is a REJECTION, not a refusal.

An amendment that is not ADMITTED is said to be “refused.” 37 CFR 1.116(a).

T: Denial of a application for registration of a trademark. Cf. REJECTION, the term used for the denial of a patent. Refusals are “affirmed” or “reversed” on appeal. See REQUIREMENT.***

Statement of use. 15 USC 1051(d)(3). Affidavit of continued use. 15 USC 1058(c). Renewal. 15 USC 1059(b). Cf. ACCEPTANCE.

Reg. U.S. Pat. & Tm. Off.

T: One statutory form of the NOTICE OF REGISTRATION of a trademark. 15 USC 1111.

regional origin

T: Certification of regional origin is one of the functions of a CERTIFICATION MARK. 15 USC 1127. A certification mark that indicates regional origin may be registered notwithstanding the prohibition against marks that are PRIMARILY GEOGRAPHICALLY DESCRIPTIVE. 15 USC 1052(e).

register

C:

1. To obtain a COPYRIGHT REGISTRATION.

2. The REGISTER OF COPYRIGHTS.

T: to obtain a registration.

One of the two lists of marks maintained by the PTO. The physical register consists of copies of the registration certificates on file in the Trademark Search Library. TMEP 202.02(a). See PRINCIPAL REGISTER, SUPPLEMENTAL REGISTER.

Register of Copyrights

C: “All administrative functions and duties under this title ... are the responsibility of the Register of Copyrights as director of the Copyright Office of the Library of Congress.” 17 USC 701(a). The Register is appointed by the Librarian of Congress and has rulemaking authority, subject to the approval of the Librarian of Congress. 17

USC 702. The Register of Copyrights must make an annual report to the Librarian of Congress. 17 USC 701(c). See REGULATIONS.

Register of Government Interests in Patents

P: The register, established by Executive Order 9424 (3 CFR 1943-1948 Comp.), requiring the executive agencies of the Government to forward to the Commissioner for recording “all licenses, assignments, or other interests of the Government in or under patents or applications for patents.” 37 CFR 7.1. See also ABBREVIATED COPY, SECRET REGISTER.

registered agent

P, T: An patent agent admitted to practice before the PTO.

registered attorney

P, T: An attorney admitted to practice before the PTO.

Registered in United States Patent and Trademark Office

T: One statutory form of the NOTICE OF REGISTRATION of a trademark. 15 USC 1111.

registered mark

T: “The term ‘registered mark’ means a mark registered in the United States Patent and Trademark Office under [the Lanham Act] or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase ‘marks registered in the Patent and Trademark Office’ means registered marks.” 15 USC 1127. See REGISTRATION.

registered trademark

T: A trademark for which a registration has been granted by the PTO.

registrant

T: The record owner of a trademark registration. The term “registrant” embraces “the legal representatives, predecessors, successors and assigns of such applicant or registrant.” 15 USC 1127.

registrar

A type of British CORPORATE OFFICER. TMEP 803.11.

registration

P: See STATUTORY INVENTION REGISTRATION.

C: Registration of a work (or refusal of registration by the Register of Copyrights) is a prerequisite to filing an action for copyright infringement unless the infringed work is a Berne Convention work and the COUNTRY OF ORIGIN is not the United States. 17 USC 411.

T: Principal Register, Supplemental Register.*** Registration does not expand the rights of the registrant to use or enforce the mark, but provides procedural and evidentiary advantages. “Registration of a mark on the principal register ... shall be constructive notice of the registrant’s ownership thereof.” 15 USC 1072. This provision eliminates the defense of INNOCENT INFRINGEMENT. Upon registration, notice of the registration is published in the Gazette. 15 USC 1063(b)(1).

Registration of a trademark is not dispositive of the registrant's right to use the mark. See *Dominion Bankshares v. Devon Holding Co., Inc.*, 690 F.Supp. 338, 347, 6 USPQ 2d 1855 (E.D. Pa. 1988).

"In any action involving a registered mark the court may determine the right to registration" and may order cancellations, restores cancelled marks "and otherwise rectify the register." 15 USC 1119.

Procuring a registration by a "false or fraudulent declaration or representation" gives rise to a civil action by "any person injured thereby." 15 USC 1120.

registration certificate

C:

T: See CERTIFICATE OF REGISTRATION.

registration notice

C:

T: The following phrases and symbols may be used to indicate that a mark has been federally registered: "Reg. U.S. Pat. & Tm. Off.," Registered in U.S. Patent and Trademark Office," "®." 15 USC 1111. It is improper to use a registration notice prior to registration although there is no penalty other than possible refusal of registration *** deceptive intent. TMEP 902.03. See also NOTICE.

registration number

C:

T:

registration certificate

T: See CERTIFICATE OF REGISTRATION.

registration symbol

T: ®

regrading

P: Of PTO exam. 37 CFR 10.7(c).

regular and established place of business

P: See VENUE. [Walker 23:8].

regular time

T: An injunction restraining publication of an issue of newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter is not available if the result would be to delay dissemination of the communication beyond the regular time for its transmission. 15 USC 1114(2)(C).

regulations

P: The Commissioner of Patents and Trademarks may promulgate regulations, not inconsistent with law, that have the force of statute. 35 USC 6 *** check. When capitalized, "Regulations" means the Regulations under the Patent Cooperation Treaty. 35 USC 351(b).

C: "The Register of Copyrights is authorized to establish regulations not inconsistent with law for the administration of the functions and duties made the responsibility of

the Register under this title. All regulations established by the Register under this title are subject to the approval of the Librarian of Congress.” 17 USC 702.

T: “The Commissioner shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.” 15 USC 1123.

regulatory review

P: Review by the Food and Drug Administration under the Federal Food, Drug and Cosmetic Act. The term of a patent for a composition of matter or method of using such composition may be extended if the composition has been the subject of regulatory review. 35 USC 155, 155A, and 156.

regulatory review period

P: 35 USC 156(g).

rehearing

P: “The BPAI has sole authority to grant rehearings.” 35 USC 7. Also [Walker 12:57]

reinstatement

P: To practice before the PTO.

reissue

P: An issued patent that is erroneous in some respect can be corrected upon the filing of a reissue application. 35 USC 251. The statute forbids “enlarging the scope of claims of the original patent.” The bases for granting a reissue patent are (1) the claims were too narrow or too broad; (2) the disclosure contained inaccuracies; (3) the applicant failed to claim or incorrectly claimed foreign priority; and (4) failed to make reference to or incorrectly made reference to a prior copending application. MPEP 1402. The term of the reissue patent is coextensive with that of the original patent. An application for reissue must be accompanied by a certified copy of an abstract of title or an order for a title report. 37 CFR 1.171.

For “inequitable conduct during prosecution of the original application, reissue is not available to obtain new claims and therefore rehabilitate the patent.” *Hewlett Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556, 11 USPQ 2d 1750 (Fed. Cir. 1989).

See also INTERVENING RIGHTS, RECAPTURE, WRITTEN ASSENT. *Cf.* ORIGINAL PROSECUTION.

reissue oath

P: 37 CFR 1.172(a). Requirements 37 CFR 1.175.

rejection

P: Failure of the PTO to allow one or more claims of a patent application based on the merits of the invention. “The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a ‘rejection’.” MPEP 706.01. “When a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of the rejection fully and clearly stated, and the word ‘reject’ should be used.” MPEP 707.07(d). The corresponding term in trademark prosecution is REFUSAL. *Cf.* OBJECTION.

aggregation

correspondence of claim and disclosure
disclaimer
double patenting
duplicate claims
improper Markush group
incomplete
method of doing business
multiplicity
naturally occurring article
new matter
nonstatutory subject matter
obvious method
old combination
omnibus claim
other assigned application. MPEP 706.03(t).
printed matter
proximity
res judicata. MPEP 706.03(w)
scientific principle
statutory bar
undue breadth
utility

T: “Rejection” is not used in reference to trademark applications. The proper word is REFUSAL. TMEP 1106.02(c).

rejoinder

P: Reconsideration of a claim once joined in the same application but which was made the subject of a REQUIREMENT FOR RESTRICTION and for which the grounds of such restriction are no longer present in the case. See EVIDENCE CLAIM.

related application

P: ***

T: Applications are “related” to one another if they are for “the same or closely related marks.” TMEP 710.05.

related company

T: “The term ‘related company’ means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.” 15 USC 1127. Use of a mark by a related company inures to the benefit of the registrant or applicant for registration. 15 USC 1055. An application may be based solely on use of a mark by a related company if applicant controls the nature and quality of the goods and services with which the mark is used. 37 CFR 2.38, TMEP 202.03(b). See also PREDECESSOR IN TITLE.

related goods or services

T: Likely to be connected in minds of prospective purchasers. Relationship: used together, same channels of trade.

related inventions

P: Inventions that are not independent. MPEP 808.02. Related inventions may nonetheless be the subject of restriction if they are (1) in separate classifications; (2) have separate status in the art of classified together; or (3) in different FIELDS OF SEARCH. MPEP 808.02.

remand

P: Prior to entry of a decision on appeal to the Board, the Commissioner may remand the application to the examiner. 37 CFR 1.191(e)***. The Board may also remand a case to the examiner for further consideration. 37 CFR 1.196(a).

T: The Board may remand an application to the Examining Attorney. TMEP 1106.07(a). The Examining Attorney may request remand during appeal. TMEP 1502.02. (1507.07****)

remake

C: A form of motion picture DERIVATIVE WORK in which the new work consists of the same story and characters as the original.

remarks

P,T: Comments in a RESPONSE explaining the applicant's position to the examiner.

remedies

P:
C:
T:

removal

P: Of reference.

T: The deletion of a portion of a trademark drawing containing matter that is not part of the mark sought to be registered. TMEP 807.13(a), 904.05. The name of the goods is that matter that most frequently must be removed from drawings.

render

C: To "render" a work constitutes a PERFORMANCE of the work. 17 USC 101.

renewal

P: Of application. [Walker 7:8]

C: The fee for a renewal application is provided in 17 USC 708(a)(2). Copyright Renewal Act of 1992.

T: At any time within six months before the expiration of a registration or within three months following expiration, the registration may be renewed for an additional period of ten years if accompanied by a verified statement that the mark is still in use in commerce or an explanation for nonuse. 15 USC 1059(a). b A certificate of mailing is ineffective to establish a filing date for a renewal. 37 CFR 1.8(a)(2)(v).

Renewal Affidavit for a U.C.C. Work

C: A renewal registration may be obtained for a work in which U.S. copyright subsists by virtue of 17 USC 9**(c) even though no original registration was obtained provided that the application for renewal registration is accompanied by a Renewal Affidavit for a UCC Work. 37 CFR 202.17(d)(2).

renewal claimant

C: ***. 217 USC 304(a), 37 CFR 201.5(b)(iv), 202.17(f).

renewal registration

C: ***. 17 USC 304. Copyright in works created before January 1, 1978 by applying for renewal between the 27th and 28th years after registration. *** CHECK *** See also RENEWAL AFFIDAVIT FOR A UCC WORK.

rental

C: Distribution of copies or phonorecords by rental to the public is a PUBLICATION. 17 USC 101.

reopen

P: The Commissioner may reopen a case already decided by the Board, but only for “consideration of matters not already adjudicated.” 37 CFR 1.198.

T: An application “which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6.” 37 CFR 2.142(g).

repeal

P: patent repeal. [Walker 25:18, 8:12]

repair

P: Parts of a broken or worn out patented article may be replaced without infringement. Cf. RECONSTRUCTION, RESTORATION. See also CONTRIBUTORY INFRINGEMENT. [Walker 22:4]

T: A trademark may be retained on a product that has been repaired, recondition and resold if it is clearly indicated to the consumer that the product has been used and reconditions. *Champion Spark Plug Co. v. Sonders*, 331 US 125, 73 USPQ 133 (1947).

replacement

P: Contributory infringement. [Walker 22:9]

C: Making a copy or phonorecord of an published work by a library or archives for the purpose of replacement of a copy that is damaged, deteriorating, lost, or stolen is not an infringement of copyright if an unused replacement cannot be obtained at a fair price.” 17 USC 108(c).

reply

P: A response to an official action is referred to as a “reply” at 37 CFR 1.111(a). A reply must be in writing and must be a bona fide attempt to advance the case. 37 CFR 1.111(b). See also RESPONSE.

A response to an OPPOSITION to a motion in an INTERFERENCE is a “reply.” 37 CFR 1.638.

reply brief

P: In an appeal to the Board, the applicant may file a reply brief within one month in response to the examiner’s brief, but it must be directed only to “such new points of argument as may be raised in the examiner’s answer.” 37 CFR 1.193(b).

T:

report

T: An injunction in a trademark case “may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction ... a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction.” 15 USC 1116 (a).

report forms

C: Report forms, to the extent they are for recording rather than conveying information, are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

representative claim

P: A claim designated by the parties to interference litigation whose validity will be taken to represent that of all other claims in suit. *Miles*, 27 USPQ 2d 1123.

reproduced

C: Copyright protection extends only to works capable of being “perceived, reproduced or otherwise communicated.” 17 USC 102(a).

reproduction

C: The exclusive right to reproduce a copyrighted work in copies or phonorecords is one of the incidents of copyright. 17 USC 106(1).

> See ART REPRODUCTION, COPY.

> “The Register of Copyrights is authorized ... to make a facsimile reproduction of all or any part of the material deposited under section 408.” 17 USC 704(c).

T: It is an infringement of trademark to use in commerce any reproduction of a registered mark without the consent of the registrant, if such use is likely to confuse, or to cause mistake, or to deceive. 15 USC 1114(1)(A). Infringing reproductions of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

reproduction rights organization

C: An organization that administers and licenses photocopying rights, *e.g.*, the COPYRIGHT CLEARANCE CENTER.

republiation

T: An amendment after publication or registration that substantially alters the mark or the description of goods may require republication of the mark in the Official Gazette. 15 USC 1057(h).

request

P: 1. The action by an applicant to have his specification and drawings published as a statutory invention registration is called a “request.” 37 CFR 1.294(a). See also REQUESTER.

When “capitalized, means that element of the international application described in PCT Rules 3 and 4.” 37 CFR 1.401(d). A Request is a required component of an INTERNATIONAL APPLICATION. 37 CFR 1.431(a).

2. The parties to an interference settlement agreement may request that the filed “copy will be kept separate from the file of the interference, and made available only to

Government agencies on written request, or to any person upon petition accompanied by the fee set forth in §1.17(i)(1) and on a showing of good cause.” 37 CFR .666(b).

T: reconsideration.

request for disclosure

P: “A written request made to a person engaged in the manufacture of a product to identify all process patents owned by or licensed to that person, as of the time of the request, that the person then reasonably believes could be asserted to be infringed under section 271(g) of that product were imported into, or sold or used in, the United States by an unauthorized person.” 35 USC 287(b)(4)(A). *** FURTHER LIMITATIONS.

request for jurisdiction

T: Upon publication of a mark for opposition, the jurisdiction of the Examining Attorney over the application ceases. If it is necessary to issue a refusal or make a requirement after publication, the Examining Attorney must request jurisdiction from the Commissioner or, during an appeal, from the TTAB. TMEP 1503.02(a).

request for reconsideration

T: “During the period between a final action and expiration of the time for filing an appeal, the applicant may request the examiner to reconsider the final action ... Amendments accompanying requests for reconsideration after final action will be entered if they comply with the rules of practice in trademark cases and the Act of 1946.” 37 CFR 2.64(b).

request for reexamination

P: [Walker 15:2] See REEXAMINATION. See also REQUESTER.

request to divide

T: See DIVISION.

requester, requestor

P: One who seeks REEXAMINATION of a patent. 37 CFR 1.501.

requirement

T: A statement by the Examining Attorney in an official action requiring the applicant to correct a matter of form. *Cf.* REFUSAL.

requirement for division

P: = REQUIREMENT FOR RESTRICTION. 37 CFR 1.142(a).

requirement for restriction

P: A requirement that an applicant “elect that invention to which his claim shall be restricted.” 37 CFR 1.142. See RESTRICTION.

requirement for restriction or election

P: See ELECTION, RESTRICTION.

reregistration

T: “Trademark registered under the Act of 1881, the Act of 1905 or the Act of 1920 may be reregistered ... but a new complete application for registration must be filed ...

and such application will be subject to examination and other proceedings in the same manner as other applications.” 37 CFR 2.158.

res judicata

P: 1. A judgment of invalidity of a patent is *res judicata*, but a judgment of validity is not.

2. “Res Judicata may constitute a proper ground for rejection ... It should be applied only when the earlier decision was a decision of the BPAI or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision.” MPEP 706.03(w).

T: A refusal to register based on prior adjudication by the TTAB or a reviewing court is *res judicata*. TMEP 1103.05.

resale price control

U: [McC 31.31]

resale rights

C: The right of an artist to participate in the profit from future transfers of a work. See also DROIT DE SUITE. *** CA

research

C: It is not an infringement of copyright to make FAIR USE of a copyrighted work for purposes such as research. 17 USC 107. It is not an infringement of copyright for a library or archives to make a copy or phonorecord of certain works from its collection at the request of another library or archive provided, *inter alia*, that the library or archives had no notice that the copy or phonorecord would be used for any purpose other than “private study, scholarship or research.” 17 USC 108(d)(1).

reservation of rights

P: *Cf.* GRANT-BACK.

reserve

C: See PHONORECORD RESERVE.

response

P: A reply to an official action is referred to as a “response” at 37 CFR 1.112. See also INSUFFICIENT RESPONSE, REPLY.

T: A reply by the applicant to an official action. See also ABANDONMENT, SUBSTANTIALLY COMPLETE RESPONSE.

respondent

The adverse party to a petition is known as the PETITIONER.

reservation

P: A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.” 37 CFR 1.79.

restoration

P: 1. See also REPAIR.

2. See PATENT TERM RESTORATION.

T: See REPAIR.

restraint of trade

U: [McC 31.27]

restricted computer software

In the context of Government procurement, “computer software developed at private expense and that is a trade secret; is commercial or financial and is confidential or privileged; or is published copyrighted computer software; including minor modifications of such computer software.” 48 CFR 52.227-14(a). See RESTRICTED RIGHTS NOTICE. *Cf.* LIMITED RIGHTS DATA.

restricted rights

The “rights of the Government in restricted computer software, as set forth in a Restricted Rights Notice or subparagraph (g)(3) if included in this clause, or as otherwise may be provided in a collateral agreement incorporated in and made part of this contract, including minor modifications of such computer software.” 48 CFR 52.227-14(a). *Cf.* LIMITED RIGHTS.

Restricted Rights Notice

A legend ***

“(a) This computer software is submitted with restricted rights under Government Contract No. _____ (and subcontract _____, if appropriate). It may not be used, reproduced, or disclosed by the Government except as provided in paragraph (b) of this Notice or as otherwise expressly stated in the contract.

(b) This computer software may be —

(1) Used or copied for use in or with the computer or computers for which it was acquired, including use at any Government installation to which such computer or computers may be transferred;

(2) Used or copied for use in a backup computer if any computer for which it was acquired is inoperative;

(3) Reproduced for safekeeping (archives) or backup purposes;

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(c) Notwithstanding the foregoing, if this computer software is published copyrighted computer software, it is licensed to the Government, without disclosure prohibitions, with the minimum rights set forth in paragraph (b) of this clause.

(d) Any other rights or limitations regarding the use, duplication, or disclosure of this computer software are to be expressly stated in, or incorporated in, the contract.

(e) This Notice shall be marked on any reproduction of this computer software, in whole or in part.” 48 CFR 52.227-14(g)(3)(i)(a).

restriction

P: The selection by applicant of fewer than all claims for further prosecution. “[I]f two or more distinct inventions are claimed in one application, ... the Commissioner

may require restriction.” 35 USC 121. “Restriction ... includes that practice of requiring an ELECTION between distinct inventions, or example, election between COMBINATION and SUBCOMBINATION, and the practice relating to an election between INDEPENDENT INVENTIONS, for example, and ELECTION OF SPECIES.” MPEP 802.02. The applicant will be required to choose a single GROUP of claims for examination. “[T]he examiner shall require the applicant in his response to that action to elect that invention to which his claim should be restricted, the official action be called a requirement for restriction.” 37 CFR 1.142(a). The non-elected claims may be made the subject of a DIVISIONAL APPLICATION. The requirement may be withdrawn or overruled. See also PROVISIONAL ELECTION. A final requirement for restriction, if traversed, is appealable (***) CHECK Comm’r?). MPEP 821. If after an official action the applicant presents claims drawn to an invention distinct from that previously claimed, restriction will be required. 37 CFR 1.145. See also CONSONANCE, DIVISION, INDEPENDENT AND DISTINCT INVENTIONS, ONE-WAY DISTINCTNESS, REQUIREMENT FOR DIVISION, THREE-WAY REQUIREMENT FOR RESTRICTION, TWO-WAY DISTINCTNESS.

Restriction is proper only if (1) the inventions are distinct and have separate utility; and (2) examining the application would otherwise be a serious burden on the examiner. MPEP 803.

T: 1. narrowing of description of goods.

2. A partial cancellation of a registration through removal of goods or services listed in the registration. Restriction under 15 USC 1068** is an equitable remedy. *Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ 2d 1589, 1593 (TTAB 1992).

restrictive covenant

U: A contractual promise not to engage in a certain activity. Most frequently a NON-COMPETITION AGREEMENT, or post-employment restrictive covenant.

result

P: The desired object of an invention. See also FUNCTION / WAY / RESULT.

retail sale

P: “In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use of sale of that product.” 35 USC 271(g).

retention

C: “Deposits not selected by the Library under subsection (b), or identifying portions or reproductions of them, shall be retained under the control of the Copyright Office ... for the longest period considered practicable and desirable by the Register of Copyrights.” 17 USC 704(d). After the retention period, copies may be destroyed, except that unpublished works may be destroyed only if a facsimile reproduction has been retained. 17 USC 704(d). “The depositor of copies, phonorecords, or identifying material under section 408, or the copyright owner of record, may request retention, under the control of the Copyright Office, of one or more of such articles for the full term of copyright in the work.” 17 USC 704(e).

retroactive license

P: Foreign filing. 37 CFR 5.25.

return of application

P: [Walker 12:3]

reversal of parts

P: [Walker 6:49, 22:55]

reverse doctrine of equivalents

P: The principle that “an accused article may avoid infringement even if it is within the literal terms of the claim, if it is so far changed in principle from a patented article that it performs the same or similar function in a substantially different way.” *Scripps Clinic & Research Foundation v. Genentech*, 929 F.2d 1565, 1581 (Fed. Cir. 1991). Cf. DOCTRINE OF EQUIVALENTS.

reverse engineering

C: Copying for reverse engineering is permissible to understand the ideas contained in a computer program. *Atari Games Corp. v. Nintendo of America, Inc.*, 975 F.2d 832 (Fed. Cir. 1992).

S: The process of discovering the method of operation or structure of a product by studying the product itself. Reverse engineering is a PROPER MEANS of learning a trade secret if the product was properly obtained. See also REVERSE ENGINEERING INJUNCTION.

reverse engineering injunction

S: [McC Dict.]

reverse likelihood of confusion

T: Reverse LIKELIHOOD OF CONFUSION occurs when person dealing with the SENIOR USER of a mark believe they are dealing with the JUNIOR USER, for example, because of the latter’s extensive advertising.

reverse palming off

T: The practice in which a person removes or obliterates the original trademark of another, without authorization, and resells the goods under his own mark. *Smith v. Manturo* ***, 15 USPQ 2d 1350. That is, instead of palming off one’s own goods as those of another, one sells another’s goods as one’s own. This is also known as EXPRESS REVERSE PALMING OFF. Reverse palming off is prohibited by section 43(a) of the Lanham Act. *Roho Inc. v. Marquis*, 902 F.2d 356, 15 USPQ 2d 1057 (5th Cir., 1990). Cf. IMPLIED REVERSE PALMING OFF, in which the goods of another are sold unmarked. *Shaw v. Lindheim*, 15 USPQ 2d 1525 (9th Cir. 1990).

revival

P: “An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable.” 37 CFR 1.137(a). A TERMINAL DISCLAIMER for a period equal to the period of abandonment will be required. 37 CFR 1.137(c).

T: “An application ABANDONED for failure to timely respond, or for failure to timely file a STATEMENT OF USE may be revived as a pending application if it is shown to the

satisfaction of the Commissioner that the delay was unavoidable.” 37 CFR 2.66(a). See UNAVOIDABLE DELAY.

revocation

P: The Atomic Energy Act, 42 USC 2181(a-b), provides for the revocation of patents issued for inventions solely useful in the utilization of ATOMIC ENERGY in nuclear weapons.

T: Of power of attorney on notification to the Commissioner. 37 CFR 2.19(a).

ribbon

P: “When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed ...” 37 CFR 1.66(b).

RICO

The Racketeer Influenced and Corrupt Organization Act, 18 USC 1961-68.

right of enforcement

P: The right to bring an action for patent infringement. Both the patent owner and the exclusive licensee are necessary parties in an infringement suit. *Independent Wireless Telegraph Co. v. Radio Corp. of America*, 269 US 459 (1926). A Federal agency may grant the right of enforcement of a Federally owned patent to its licensee. 35 USC 207(a)(2).

right to exclude others

P: The grant of a patent is the “right to exclude others from making, using or selling the invention throughout the United States and, if the invention is a process, of the right to exclude others from using or selling throughout the United States, or importing into the United States, products made by that process ...” 35 USC 154.

right of publicity

U: “The right of an individual, especially a public figure or a celebrity, to control the commercial value and exploitation of his name and picture or likeness and to prevent others from unfairly appropriating this value for commercial benefit.” *Estate of Presley v. Russen*, 513 F.Supp. 1339, 211 USPQ 415 (D. N.J. 1981). The principle was recognized by the Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 US 562, 205 USPQ 741 (1977). “All that is required is that the name clearly identify the wronged person.” *Hirsch v. S.C. Johnson & Son, Inc.*, 280 NW2d 129, 205 USPQ 920 (Wis. 1971).

ROM

C: An abbreviation for “read-only memory.” A ROM may be a SEMICONDUCTOR CHIP PRODUCT. Cf. CD-ROM.

RO/US

P: United States Receiving Office.

RRO

C: An abbreviation for REPRODUCTION RIGHTS ORGANIZATION.

royalty

.

rule

Following is a list of name “rules” referred to elsewhere in this book: affirmative rule of invention, all claims rule, all elements rule, all limitations rule, anti-dissection rule, negative rule of invention, rule of addition, rule of doubt, rule of exactness, rule of omission, rule of reason, visibility rule.

rule of addition

P: A rule of claim interpretation that a claim having a transitional phrase of “comprising” can be literally infringed by a structure having additional elements beyond those enumerated in the claim. *Cf.* RULE OF EXACTNESS, RULE OF OMISSION.

rule of doubt

C: A principle under which the Copyright Office registers a copyright in a work even though the Register is unable to determine whether the work constitutes copyrightable subject matter.

rule of exactness

P: A rule of claim interpretation that a claim having a transitional phrase of “consisting of” is only literally infringed by a structure having precisely those elements enumerated in the claim. *Cf.* RULE OF ADDITION, RULE OF OMISSION.

rule of omission

P: A rule of claim interpretation that a claim reciting elements is not literally infringed by a structure that omits one or more of the elements. Also ALL ELEMENTS RULE. *Cf.* RULE OF ADDITION, RULE OF EXACTNESS.

rule of operation

P: Related to moving parts. Machine has rule of operation; article of manufacture does not.

rule of reason

P: Interference. [Walker 13:14]

U: Antitrust. [McC 31.32]

Rule 116 amendment

P: An amendment submitted after a FINAL REJECTION. Such an amendment is not entered as of right, and entry may be refused by the examiner. To avoid ABANDONMENT, a NOTICE OF APPEAL must be filed.

Rule 131 affidavit

P:

rulers

C: Rulers containing no original authorship are not subject to copyright. 37 CFR 202.1(d).

rulemaking

T: “The Commissioner shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.” 15 USC 1123.

Rules of Practice

P: 37 CFR Part 1.

T: 37 CFR Part 2.

SA 1-2 Form for Statement of Account

C: “‘Short Form’ for use by cable systems whose semiannual gross receipts for secondary transmission total less than \$292,000.” 37 CFR 201.17(d)(2)(i).

SA 3 Form for Statement of Account

C: “‘Long Form’ for use by cable systems whose semiannual gross receipts for secondary transmission total \$292,000 or more.” 37 CFR 201.17(d)(2)(i).

safety requirement

P: [Walker 10:23]

said

P: A reference word used in claims to denote an element that has already been defined, *e.g.*, “wherein said coating is applied by ion deposition.”

sale

P: Making using or selling ***. See also ON SALE, RETAIL SALE.

C: Distribution of copies or phonorecords by sale to the public is a PUBLICATION. 17 USC 101.

T: It is an infringement of trademark to use in commerce any reproduction of a registered mark in connection with the sale of any goods or services if such use is likely to cause confusion, to cause mistake, or to deceive. 15 USC 1114(1)(A).

same invention type double patenting

P: A form of double patenting forbidden by 35 USC 101, which allows an inventor to obtain “a patent,” which is interpreted as meaning only one patent. MPEP 804. “A good test, and probably the only objective test, for ‘same invention’ is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention.” *In re Vogel*, 164 USPQ 619 (CCPA 1970). Claims to different STATUTORY CLASSES cannot define the same invention. *Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co.*, 228 USPQ 837 (Fed. Cir. 1987). See also DOUBLE PATENTING, TERMINAL DISCLAIMER. Cf. OBVIOUSNESS TYPE DOUBLE PATENTING.

same inventor

P: [Walker 9:59]

same patentable invention

P: “Invention ‘A’ is the ‘same patentable invention’ as an invention ‘B’ when invention ‘A’ is the same as (35 USC 102) or is obvious (35 USC 103) in view of invention ‘B’ assuming invention ‘B’ is prior art with respect to invention ‘A’.” 37 CFR 1.601(n). Cf. SEPARATE PATENTABLE INVENTION.

satellite carrier

C: An “entity that uses the facilities of a satellite or satellite service licensed by the Federal Communications Commission to establish and operate a channel of communications for point-to-multipoint distribution of television station signals, and that owns or leases a capacity or service on a satellite in order to provide such point-to-multipoint distribution, except to the extent that such entity provides such distribution pursuant to tariff under the Communications Act of 1934, other than for private home viewing.” 17 USC 119(d)(6).

satire

C: Satire is treated as PARODY.

SBIR rights

The “rights in SBIR data as set forth in the SBIR Rights Notice of paragraph (d) of this clause.” 48 CFR 52.227-20(a).

SBIR Rights Notice

A legend *** “These SBIR data are furnished with SBIR rights under Government Contract No. _____ (and subcontract _____, if appropriate). For a period of 2 years after acceptance of all items to be delivered under this contract, the Government agrees to use these data for Government purposes only, and they shall not be disclosed outside the Government (including disclosure for procurement purposes) during such period without permission of the Contractor, except that, subject to the foregoing use and disclosure prohibitions, such data may be disclosed for use by support Contractors. After the aforesaid 2-year period the Government has a royalty-free license to use, and to authorize others to use on its behalf these data for Government purposes, but is relieved of all disclosure prohibitions and assumes no liability for unauthorized use of these data by third parties. This notice shall be affixed to any reproductions of these data, in whole or in part. 48 CFR 52.227-20(d).

scale of abstraction

C: Test for evaluating . 15 USPQ 2d 1577.

scandalous

T: A mark is scandalous if its meaning or association would be shocking to the sense of truth, decency or propriety, disgraceful, or offensive to moral feelings. TMEP 1201.01. A mark that comprises scandalous matter may be refused registration, either on the Principal or the Supplemental Register. 15 USC 1052(a), 1091(a).

scène à faire

C: A scene that flows naturally from a basic plot premise. “Incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.” *Atari v. North American Philips Consumer Electronics*, 672 F.2d 607, 616, 214 USPQ 33, 41 (7th Cir. 1982). Scènes à faire are not copyrightable since they are regarded as IDEAS.

scent mark

T: A trademark consisting of an odor. *In re Celia Clarke*, 17 USPQ 2d 1238 (TTAB 1990). Also FRAGRANCE MARK. See also PERFUME.

schedules

C: Schedules of sporting events containing no original authorship are not subject to copyright. 37 CFR 202.1(d).

scholarship

C: It is not an infringement of copyright to make FAIR USE of a copyrighted work for purposes such as scholarship. 17 USC 107. It is not an infringement of copyright for a library or archives to make a copy or phonorecord of certain works from its collection at the request of another library or archive provided, inter alia, that the library or archives had no notice that the copy or phonorecord would be used for any purpose other than “private study, scholarship or research.” 17 USC 108(d)(1).

scientific principle

P: “A scientific principle, divorced from any tangible structure, can be rejected as not within the STATUTORY CLASSES.” MPEP 706.03(a); *O’Reilly v. Morse*, 15 How. 62.

scientific work

C: A scientific work is factual and receives less protection than do non-scientific works. “[T]he scientific nature of the plaintiff’s work will weigh in favor of the copier whose purposes are similarly scientific.” *Loew’s*, 131 F.Supp. 165, 175.

scope

P: Scope of claim

T: Scope of goods, scope of registration

scope of employment

P: Generally inventive.

C: Work made for hire. 17 USC 101.

scope of review

Administrative Procedures Act, 5 USC 706. Standards: arbitrary or capricious or an abuse of discretion or otherwise not in accordance with law.

Clearly erroneous.

P: Of Board of Patent Appeals and Interferences.

Of Commissioner.

Of District Court.

C: Of Register of Copyrights.

T: Of Trademark Trial and Appeal Board.

Of Commissioner.

score

C: “If the only publication of copies in the United States took place by the rental, lease, or lending of a full score and parts, a full score is a ‘complete’ copy. 37 CFR 202.19(b)(2)(i).

scorecards

C: Scorecards, to the extent they are for recording rather than conveying information, are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(c).

SCPA

C: The SEMICONDUCTOR CHIP PROTECTION ACT.

screen display

C: 15 USPQ 2d 1577

sculptural work

C: Sculptural works, then known as “statutory,” first received copyright protection in the Act of July 8, 1870. See PICTORIAL, GRAPHIC AND SCULPTURAL WORKS. 17 USC 102(a). A sculpture may be a WORK OF VISUAL ART. 17 USC 101. See also THREE-DIMENSIONAL SCULPTURAL WORK.

seal

The Patent and Trademark Office is authorized to keep “a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.” 35 USC 2.

P: An oath taken before a foreign official is not effective unless the official has an official seal. 35 USC 115.

C: “The Register of Copyrights shall adopt a seal to be used on and after January 1, 1978, to authenticate all certified documents issued by the Copyright Office.” 17 USC 701(b).

seal order

T: A court order directing the clerk to keep the file of the case, and possibly the docketing statement, confidential. A seizure order “shall be sealed until the person against whom the order is directed has an opportunity to contest such order.” 15 USC 1116(d)(7).

sealed envelope

P: “The PRELIMINARY STATEMENT and copies of any drawing or written description shall be filed in a sealed envelope bearing only the name of the party filing the statement and the STYLE and number of the interference.” 37 CFR 1.627(a). “A preliminary statement may be opened only at the direction of an examiner-in-chief.” 37 CFR 1.627(b).

search

P: infringement search, patentability search, state-of-the-art search. ***

C: “Upon request and payment of the fee specified in section 708, the Copyright Office shall make a search of its public records, indexes, and deposits.” 17 USC 705(c). The fee is ten dollars per hour or fraction. 17 USC 708(a)(10).

T:

search clause

T: If no conflicting marks are found by the Examining Attorney in examining a trademark application, the first official action should so inform the applicant by inclusion of a sentence known as the “search clause.” TMEP 1105.01.

search fee

P: 35 USC 361(d), 376(1)(2). PCT

search opinion**search report**

T:

Sears-Compco doctrine

T: The principle, derived from the two cases *Sears, Roebuck & Co. v. Stiffel Co.*, 376 US 225, 140 USPQ 524 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 US 234, 140 USPQ 528 (1964). ***

seasonable notice

“Seasonable notice” is defined in U.C.C. Section 1-204 as “at or within the time agreed or if no time is agreed at or within a reasonable time.” See VOUCHING IN.

second interference

P: “A second INTERFERENCE between the same parties will not be declared upon an application not involved in an earlier interference for an invention defined by a count of the earlier interference.” 37 CFR 1.665. See also COLLATERAL ESTOPPEL.

second serial rights

C: The right to publish a work that has already been published by another.

secondary considerations

P: Objective evidence of non-obviousness not related to the invention itself, hence termed “secondary.” Examples are COMMERCIAL SUCCESS, an unsatisfied LONG-FELT NEED for the invention, FAILURE OF OTHERS who have tried to solve the problem, COPYING by others, synergism and UNEXPECTED RESULTS. *In re Kulling*, 897 F.2d 1147. “[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art is not.” 218 USPQ 871, 879. “Secondary considerations have probative value only when the decision maker determines that there is a nexus between the claimed invention and the considerations.” *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). See also AFFIRMATIVE RULE OF INVENTION, SKEPTICISM.

secondary invention

P: [Walker 21:8, 22:41]

secondary meaning

T: The association in the mind of consumers between a trademark and the source of goods or services in connection with which the mark is used. If the original or primary meaning of the mark has been replaced by an indication of origin in one producer, the mark has acquired secondary meaning. TMEP 1211. “To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 US 844, 214 USPQ 1 (1982). (This is the PRIMARY SIGNIFICANCE TEST.)

Secondary meaning is presumed in cases of intentional copying. *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 450, 228 USPQ 705 (4th Cir. 1986).

secondary meaning mark

T: A trademark that is not INHERENTLY DISTINCTIVE but has achieved SECONDARY MEANING through promotion and use. [McC 16.12]

secondary reference

P: *Cf.* PRIMARY REFERENCE.

secondary transmission

C: The “further transmitting of a primary transmission simultaneously with the primary transmission, or nonsimultaneously with the primary transmission if by a ‘cable system’ not located in whole or in part within the boundary of the forty-eight contiguous States, Hawaii, or Puerto Rico ...” 17 USC 111(f), 17 USC 119(d)(7).

secrecy

P: Patent applications are maintained in secrecy. 35 USC ***. “No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto ...” 37 CFR 1.14(a).

The grant of a patent may be withheld for periods of up to one year and the application maintained in secret if the national security so requires. 35 USC 181. The Commissioner, having made a determination that the grant of a patent would be detrimental to the national security, issues a SECRECY ORDER. Disclosure or filing for a foreign patent on an invention subject to a secrecy order by the inventor, his successors, assigns, or legal representatives or anyone in privity with him or them, without the consent of the Commissioner, is an abandonment of the invention. 35 USC 182. The penalty for violation of a secrecy order is a fine of up to \$10,000 and imprisonment for not more than two years, or both. 35 USC 186.

T: See SEAL ORDER.

S: A requirement to find a trade secret.

secrecy order

P: An order by the Commissioner by the authority of 35 USC 181 that a patent application be kept secret and that no patent may be granted while such order remains in effect. The granting of secrecy order is appealable to the Secretary of Commerce. See, generally, 37 CFR 5.1 *et seq.*

secret matter

P: Failure to reveal secret matter in testimony before the PTO may not be punished by contempt except upon appropriate order of the court issuing the subpoena. 35 USC 24.

secret register

P: At the request of the government department or agency submitting an instrument evidencing a government interest in a patent for recording on the REGISTER OF GOVERNMENT INTERESTS IN PATENTS may request that the instrument be placed on a secret register. Thereafter, no info ***.

secret use

P: [Walker 4:9, 4:14]

Secretary of Agriculture

P: The Secretary of Agriculture may determine the period by which a patent term is to be extended under 35 USC 156(g).

The Secretary of Agriculture may be directed by the President to assist the Commissioner in the examination of plant patents by furnishing information and performing research. 35 USC 164.

The Secretary of Agriculture may acquire patent applications and patents in order to carry out his duties. 7 USC 178(g).

Secretary of Commerce

P: The Secretary of Commerce may promulgate regulations under which any federally owned invention (except one owned by the Tennessee Valley Authority) may be licensed on a nonexclusive, partially exclusive or exclusive basis. 35 USC 208. See also PROFESSIONAL MODEL PRODUCT.

Secretary of Health and Human Services

P: The Secretary of Health and Human Services may determine the period by which a patent term is to be extended under 35 USC 156(g).

Section 8 affidavit

T: = AFFIDAVIT OF CONTINUED USE. A registered mark will be cancelled at the end of the sixth year of registration unless such an affidavit is filed within one year next preceding the expiration of such sixth year. 15 USC 1058(a). Called "Section 8" because the affidavit is provided for in Section 8 of the Lanham Act. A CERTIFICATE OF MAILING is ineffective to secure a filing date for a Section 8 affidavit. See also COMBINED AFFIDAVIT.

Section 15 affidavit

T: See AFFIDAVIT OF INCONTESTABILITY. 15 USC 1065(3). Called "Section 15" because the affidavit is provided for in Section 15 of the Lanham Act. A CERTIFICATE OF MAILING is ineffective to secure a filing date for a Section 8 affidavit. See also COMBINED AFFIDAVIT.

Section 43(a) claim

T: A claim for infringement of a trademark that is not federally registered.

Section 44 registration

T: A registration under Section 44 of the Lanham Act (15 USC ***) whose basis for filing is a foreign registration.

Section 2(f) registration

T: A registration of a mark not originally entitled to registration but which has become distinctive of or has acquired a secondary meaning for applicant's goods or services. TMEP 202.03(d).

security

C: Making or distributing a copy or phonorecord of an unpublished work in facsimile form by a library or archives for purposes of preservation or security is not an infringement of copyright if the work is currently in the collections of the library or archives. 17 USC 108(b).

T: in order to obtain a SEIZURE ORDER, security must be posted “for the payment of damages as any person may be entitled to recover as a result of a wrongful seizure or wrongful attempted seizure.” 15 USC 1116(d).

security interest

P: See also MORTGAGE.

C:

T:

seedlings

P: [Walker 17:9; 35 USC 161]

seizure

C: The government may not seize a copyright except under Title 11 USC (bankruptcy). 17 USC 201(e). See INVOLUNTARY TRANSFER.

T: “In the case of a civil action arising under section 32(1)(a) of this Act (15 USC 1114) or section 110 [of the Olympic Charter Act] with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order ... providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.” 15 USC 1116(d)(1)(A). See SEIZURE HEARING, SEIZURE ORDER.

The United States attorney must receive “such notice as is reasonable under the circumstances” of an application for seizure under the Trademark Counterfeiting Act, 15 USC 1116(d).

seizure hearing

C: After execution of a WRIT OF SEIZURE, the defendant may request a hearing to determine the propriety of the seizure. Rule 9, Rules of Practice As Amended, 17 USCA Foll. §501.

T: The hearing, to be held not less than 10 nor more than 15 days after issuance of a SEIZURE ORDER, to examine the propriety of any seizure under 15 USC 1116(d).

seizure order

T: 15 USC 1116(d). Affidavit or verified complaint required. Security required. See also SEIZURE HEARING, UNITED STATES ATTORNEY.

semiconductor chip product

C: “A ‘semiconductor chip product’ is the final or intermediate form of any product —
(A) having two or more layers of metallic, insulating, or semiconductor material, deposited or otherwise placed on, or etched away or otherwise removed from, a piece of semiconductor material in accordance with a predetermined pattern; and
(B) intended to perform electronic circuitry functions.” 17 USC 901(a)(1).

“An ‘infringing semiconductor chip product’ is a semiconductor chip product which is made, imported, or distributed in violation of the exclusive rights of the owner of a MASK WORK ...” 17 USC 901(a)(9).

Semiconductor Chip Protection Act

C: 17 USC 901. See also MASK WORK, SEMICONDUCTOR CHIP PRODUCT.

senior party

P: In an INTERFERENCE, a ‘senior party’ is “the party with the earliest effective filing date as to all COUNTS, or, if there is no party with the earliest effective filing date as to all counts, the party with the earliest filing date.” 37 CFR 1.601(m). Cf. JUNIOR PARTY.

senior user

T: The first one to use a mark on or in connection with a category of goods or services. Cf. JUNIOR USER.

separate paper

T: A REQUEST FOR DIVISION “should be made in a separate paper.” 37 CFR 2.87(c).

separate patentable invention

P: “Invention ‘A’ is a ‘separate patentable invention’ with respect to invention ‘B’ when invention ‘A’ is new (35 USC 102) and non-obvious (35 USC 103) in view of invention ‘B’ assuming invention ‘B’ is prior art with respect to invention ‘A’.” 37 CFR 1.601(n). Cf. SAME PATENTABLE INVENTION.

separateness test

U: For TIE-IN. [McC 21.22[4][a]]

separation of profits

P: [Walker 27:32]

sequence

C: 1. The hallmark of an audiovisual work, such as a motion picture, and a TRANSMISSION PROGRAM, is that its images are in sequence. 2. The ordering of lines of a computer program. See STRUCTURE, SEQUENCE AND ORGANIZATION. 3. *** DNA sequences? See SEQUENCE DATA.

sequence data

P: A representation of nucleotide and amino acid sequence information specifying the linear order of amino acids in a polypeptide or protein chain or of nucleotides in a polynucleotide strand.

sequel

C: Sequels are “subsequent stories embodying the same characters” as the original work. *Goodis v. United Artists Television, Inc.*, 425 F.2d 397, 406, 165 USPQ 3, 9 (2d Cir. 1970).

serial

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i).

Serial Copy Management System

C: 17 USC 1002.

serial copying

C: The “duplication in a digital format of a copyrighted musical work or SOUND RECORDING from a digital reproduction of a DIGITAL MUSIC RECORDING.” 17 USC 1001(11).

serial number

P: A six-digit code used as a suffix in the APPLICATION NUMBER of a patent application. “Any application for a patent received in the Patent and Trademark Office will be assigned a serial number for identification purposes.” 37 CFR 1.52(a).

T: Applications are given a serial number as received. 37 CFR 2.23.

serial rights

C: The right to publish a work in a periodical. See FIRST NORTH AMERICAN SERIAL RIGHTS, ONE-TIME RIGHTS, SECOND SERIAL RIGHTS.

series code

P: A two-digit code used as a prefix for the APPLICATION NUMBER of a patent application.

sermon

C: Sermons, when published individually, are exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(3).

service

C: For an ADVANCE NOTICE OF POTENTIAL INFRINGEMENT, service may be made personally, by first-class mail or telegram. The date of service is the date on which the notice is actually received. 37 CFR 201.22(e).

T: 1. The performance of some activity on the order of or for the benefit of others than the applicant and not merely incident to the sale of goods or of the performance of another service. TMEP 1301.01. See also SERVICE MARK.

2. An applicant not domiciled in the United States must designate in writing “the name and address of some person resident in the United States who may receive notices or process in proceedings affecting the mark.” 15 USC 1051(e).

service mark

T: “A service mark is a mark used in the sale or advertising of services of a person to identify his services and distinguish them from the services of others.” *** “The term ‘service mark’ means any word, name, symbol, or device, or any combination thereof

—
(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.” 15 USC 1127.

Service marks are used for intangible activities which are performed by one person for a person or persons other than himself, for pay or otherwise. TMEP 102. The

rights arising from registration of service marks are the legal equivalent of those arising from registration of trademarks. “Subject to the provisions relating to the registration of trademarks, service marks shall be registrable, in the same manner and with the same effect as trademarks and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks.’ 15 USC 1053.

Applications for service mark registration contain the same elements as trademark applications “but shall be modified to relate to services instead of to goods wherever necessary.” 37 CFR 2.43.

SESAC

C: A PERFORMING RIGHTS SOCIETY, formerly known as the Society of European Stage Authors & Composers.

settlement agreement

Courts may retain jurisdiction to enforce settlement agreements in cases that were once properly before them. *Halderman v. Penhurst Street School and Hospital*, 901 F.2d 311, 317 (3rd Cir. ***), *cert. denied*, *** (1990).

P: In interference. 37 CFR 1.666(c). Access on petition to Commissioner. 37 CFR 1.666(b).

several liability

Liability of joint tortfeasors in which each is responsible only for his own acts. *Cf.* JOINT AND SEVERAL LIABILITY.

C: See PROFITS.

shareware

C: See COMPUTER SHAREWARE.

shift

P: The claiming by applicant of another invention after an ELECTION is once made and action given on the elected subject matter. “The general policy of the Office is not to permit the applicant to shift.” MPEP 819. Some forms of shifting are permissible. MPEP 820.

shoe

A drawer in which prior art, principally printed patents, are stored at the PTO for convenience of examiners.

shop right

P: A nonexclusive, royalty-free license in an invention granted by law to the employer of an inventor who uses the employer’s property to make the invention. ***CASE. *Dubilier*.

C: There is no analog of the patent shop right in copyright law.

short phrase

C: “Words and short phrases such as names, titles and slogans” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

short title

P: “Every patent shall contain a short title of the invention ...” 35 USC 153, 37 CFR 1.72. See also TITLE.

T: A brief designation for the name of an INTERNATIONAL CLASS. TMEP 1401.02(b).

shortened statutory time period

P: A time period for response set by the PTO to be shorter than that allowed by statute, but not less than 30 days. 35 USC 133. Abbreviated SSP. The applicant may obtain an extension up to the statutorily permitted limit upon payment of a fee.

Time	Response for Which Time is Allowed
30 days	Requirement for RESTRICTION or ELECTION OF SPECIES.
2 months	Winning party in a terminated interference to reply to an unanswered office action
	<i>Ex parte Quayle</i> . When application is in condition for allowance except as to matters of form.
	MULTIPLICITY rejection.
	New ground of rejection in an examiner’s answer on appeal.
3 months	Respond to any office action on the merits.

show cause order

P: An order directing a party to an INTERFERENCE to demonstrate why summary judgment should not be entered. 37 CFR 1.617(b), 1.640(d)

show-how

S: *Cf.* KNOW-HOW.

showing

T: 15 USC 1091.

shrink-wrap license

C:

sight

The area of a paper lying within the margins. 37 CFR 1.84(b).

sign

T: It is TRADEMARK INFRINGEMENT to apply a reproduction of a registered mark to a sign intended to be used in commerce where such use is likely to cause confusion, or to cause mistake, or to deceive. 15 USC 1114(1)(B). Signs bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

signature

P: The following documents must be signed: amendment, application, disclosure document, express abandonment.

C: To be recordable, a document “must bear the actual signature or signatures of the person or persons who executed it.” 37 CFR 201.4(c)(1). A legible copy or facsimile

is acceptable if it accompanied by a SWORN CERTIFICATION or an OFFICIAL CERTIFICATION that the copy is a true copy of the original.

The signature on an ADVANCE NOTICE OF POTENTIAL INFRINGEMENT must be “an actual handwritten signature of an individual,” but the requirement is waived if the notice is initially served “in the form of a telegram or similar communication.” 37 CFR 201.22(d).

T: A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises a ... signature ... identifying a particular living individual” except by his written consent,” or identifying “a deceased President of the United States during the life of his widow, except by the written consent of the widow.” 15 USC 1052(c), 1091(a).

signed

P: An appeal to the Board must be signed. 37 CFR 1.191(b).

C: A WORK OF VISUAL ART must be signed by the author and consecutively numbered in an edition of 200 or fewer copies. 17 USC 101.

signed print

C: A “fine print which has been signed by the artist’s own hand, and not by any mechanical means of reproduction, after it has been printed.” *** NY Artist’s Law.

similarity

C: See SUBSTANTIAL SIMILARITY.

T: A factor in determining whether there is likelihood of confusion between two marks. *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ 2d 1264 (1st Cir. 1987). “Similarity is determined on the basis of the total effect of the designation, rather than a comparison of individual features.” *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 486, 212 USPQ 2d 246 (1st Cir. 1981). See CONFUSINGLY SIMILAR.

simulation

T: A likeness so close that it would create the impression of being the same as the current form. TMEP 1203. A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 USC 1052(b), 1091(a).

simultaneously published

C: For purposes of the Berne Convention, works are “simultaneously published” if their dates of publication are within 30 days of one another. 17 USC 101.

single anonymous source

T: An anonymous source believed by a consumer to be the only provider of particular goods or services. “Secondary meaning can exist if the public links the product to a single source, even if that source is anonymous.” *Sunbeam Corp. v. Equity Industries Corp.*, 635 F.Supp. 625, 629, 229 USPQ 865 (E.D. Va. 1986), *aff’d*, 811 F.2d 1505, 1 USPQ 2d 1752 (4th Cir. 1987).

single application

T: = SINGLE-CLASS APPLICATION.

single-class application

T: A trademark application in which all identified goods or services fall within a single INTERNATIONAL CLASS. TMEP 202.01(a).

single-leaf work

C: A “work published in copies consisting of a single leaf, including copies on which the work is printed or otherwise reproduced on either one side or on both sides of the leaf, and also folders which, without cutting or tearing the copies, can be opened out to form a single leaf.” 37 CFR 201.20(b)(9).

single mark

T: = UNITARY MARK.

single means claim

P: Impermissible claim not to a combination in means-plus-function form. Such a claim violates 35 USC 112 in that the claim is broader than the means disclosed.

single presentation test

T: For likelihood of confusion. Does consumer, knowing of mark A, associate its owner when mark B is presented? *Sterling Drug, Inc. v. Lincoln Laboratories, Inc.*, 322 F.2d 968 (7th Cir. 1963)

single sentence rule

P: The requirement that each claim of a patent be the direct object of a single English sentence. MPEP 601.01(m).

single species claim

P: A claim “restricted to a single disclosed embodiment.” MPEP 806.04(e). See SPECIES. Cf. GENERIC CLAIM.

single unit of publication

C: See SINGLE WORK.

single work

C: “In the case of published works: All copyrightable elements that are otherwise recognizable as self-contained works, that are included in a single unit of publication, and in which the copyright claimant is the same.” 37 CFR 202.3(b)(3)(A). “In the case of unpublished works: all copyrightable elements that are otherwise recognizable as self-contained works, and are combined in a single unpublished “collection.” 37 CFR 202.3(b)(3)(B). See COLLECTION.

SIR

P: = STATUTORY INVENTION REGISTRATION.

site specific genetic information

P: 35 USC 271(e).

site specific genetic manipulation

P: Inventions that are not primarily manufactured using site specific genetic manipulation techniques may be eligible for PATENT TERM EXTENSION.

skepticism

P: “Initial skepticism as to the merits of an invention by experts at the patentee’s two major competitors followed by the experts’ copying the patented feature support sins nonobviousness.” *Hughes Tool Co. v. Dresser Industries, Inc.*, 816 F.2d 1549, 2 USPQ 2d 1396 (Fed. Cir. 1987). See also SECONDARY CONSIDERATIONS.

skilled in the art

P: Quote 35 USC 103. *** Test for obviousness.

skilled mechanic test

P: An obsolete standard of patentability under the 1836 Patent Act, superseded by statute in 1952. It involved examining whether “the improvement is the work of the skillful mechanic, not that of the inventor.” *Hotchkiss v. Greenwood*, 52 US 248 (1851).

slogan

C: “Words and short phrases such as names, titles and slogans” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

T: A mark on the Supplemental Register may consist of a “slogan.” 15 USC 1091(c). Slogans are registrable as trademarks. *Roux Laboratories, Inc. v. Clairol, Inc.*, 427 F.2d 823, 166 Q 34.

Small Business Administration

P: A DETERMINATION is sent to the Chief Counsel for Advocacy. 35 USC 202(b)(1).

small business concern

An entity as defined in section 3 of the Small Business Act. 35 USC 41(h)(1). For the purposes of chapter 1 of 37 CFR, a business concern as defined by the Small Business Administration in 13 CFR 121.12.

small business firm

P: Any business concern

(1) whose number of employees, including those of affiliates, does not exceed 500 persons; and

(2) which has not assigned, granted, conveyed or licensed, and is under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who could not be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or nonprofit organization under this section. 13 CFR 121.12(a).

As used in Chapter 38 of the Patent Act, a “small business concern as defined in section 2 of Public Law 85-536 (15 USC 632) and implementing regulations of the Administrator of the Small Business Administration.” 35 USC 201(h). The same definition is used in the FAR at 48 CFR 52.227-11(a)(5) adds, “For the purpose of this clause, the size standards for small business concerns involved in Government

procurement and subcontracting at 13 CFR 121.3-8 and 13 CFR 121.3-12, respectively, will be used.” 48 CFR 52.227-11(a)(5). A small business firm may be a “contractor” within the meaning of 35 USC 201(c) if it is a party to a funding agreement.

small entity

P: An “INDEPENDENT INVENTOR, a SMALL BUSINESS CONCERN or a NON-PROFIT ORGANIZATION.” 37 CFR 1.9(f). A small entity is entitled to reduced filing fees.

Smithsonian Institution

P: See GOVERNMENT AGENCY.

snapshot claim

P: A claim to an INTERMEDIATE produced during a process. Intermediates may be claimed if the final product is useful. Snapshot claims affords additional protection for a process invention. Not to be confused with a PICTURE CLAIM.

Société de la Propriété Artistique, des Dessins et Modèles

C: A French organization that collects amounts due under the DROIT DE SUITE and distributes payments to artists. Abbreviated S.P.A.D.E.M.

soft drink

U: Statutory exemption for soft drink distribution from non-price vertical restraints. [McC 31.32[3]]

software

P: 35 USC 101.

C: See also WARNING OF COPYRIGHT FOR SOFTWARE RENTAL.

Solicitor

P,T: Litigation papers required to be served on the Solicitor of the PTO should be hand-delivered to the Office of the Solicitor or mailed to Office of the Solicitor, P.O. Box 15667, Arlington, Virginia 22215. “All other communications to the Solicitor should be addressed to: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.” 37 CFR 1.1(g).

sound business practice

T: See INJUNCTION.

sound mark

T: A trademark that identifies and distinguishes services through audio rather than visual means. TMEP 1301.07(a).

sound recording

C: A work that results “from the fixation of a series of musical, spoken or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes or other phonorecords, in which they are embodied.” 17 USC 101. Also PHONOGRAM. Copyright protection was extended to include sound recordings by the Act of October 15, 1971, now 17 USC 102(a). A sound recording may constitute a DERIVATIVE WORK. 17 USC 101. One of the four classes of works in which copyright may be claimed, comprising “all published and unpublished sound recordings fixed on and

after February 15, 1972.”. 37 CFR 202.3(b)(1)(iv). These works are registered on Form SR. “In the case of sound recordings, a ‘complete’ phonorecord includes the phonorecord, together with any printed or other visually perceptible material published with such phonorecord ...” 37 CFR 202.19(b)(2). There are no exclusive performance rights in sound recordings. 17 USC 114.

soundtrack

C: “Works published only as embodied in a soundtrack that is an integral part of a MOTION PICTURE” are exempt from DEPOSIT requirements. 37 CFR 202.19(c)(11).

source code

P: Patent specification.

C: Copyrightable. Submission requirements.

source designator

T:

source material

“The term ‘source material’ means (1) uranium, thorium or any other material which is determined by the Commission pursuant to the provisions of section 2091 of this title to be source material; or (2) ores containing one or more of the foregoing materials, in such concentration as the Commission may by regulation determine from time to time.” 42 USC 2014(z) (the Atomic Energy Act). The term is used in the definition of SPECIAL NUCLEAR MATERIAL.

sovereign immunity

P: 28 USC 1498(a)

C: 28 USC 1498(b) waives sovereign immunity of the U.S. in copyright cases. Quote***. The Copyright Act abrogates sovereign immunity of the states under the 11th Amendment in copyright actions. *Pennsylvania v. Union Gas Co.*, 109 S.Ct. 2273, 2281 (1989).

S.P.A.D.E.M.

C: Abbreviation for Société de la Propriété Artistique, des Dessins et Modèles.

SPE

P: = SUPERVISING PRIMARY EXAMINER.

special

P: Prospective manufacture.

Actual infringement. *** REQUIREMENT *** A declaration that there is an infringing device or product actually on the market or method in use, a “rigid comparison of the alleged infringing device, product or method with the claims of the application has been made,” some of the claims are unquestionably infringed, a “careful and thorough search of the prior art has been made and he believes all of the claims in the application to be allowable.” MPEP 708.02.

FIVE-YEAR CASE. MPEP 707.02(a).

Superconductivity. MPEP 708.02.

“Applications for reissue, remanded by an appellate tribunal, interfering applications, applications ready for allowance, in condition for final rejection, five-year cases, reexamination proceedings.” MPEP 708.01.

“An application for patent that has once been made special and advanced out of turn for examination by reason of a ruling made in that particular case (by the Commissioner or Assistant Commissioner) will continue to be special throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any, to the BPAI; and any interference ...” MPEP 708.01.

A “reissue application is special and remains so even if applicant does not make a prompt response.” MPEP 706.03(x).

“The Patent and Trademark Office will accord ‘special’ status to all patent applications for inventions which materially enhance the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements — air, water, and soil.” MPEP 708.02.

T: Said of an application that is to be examined out of the normal order or processing. See PETITION TO MAKE APPLICATION SPECIAL.

special care

P: “Where a patent claim rests largely on a combination of elements in the prior art, ‘it must be scrutinized with special care’.” *Pentech Int’l. v. Hayduchok*, 18 USPQ 2d 1337 (S.D. N.Y. 1990).

special circumstances

T: Excusable nonuse requires special circumstances. 203 Q 712 (Comm’r. Pats. and Trademarks 1979).

special dispatch

P: REEXAMINATION proceedings are conducted by the PTO “with special dispatch.” 35 USC 305. “When an applicant seeks an INTERFERENCE with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the PTO.” 37 CFR 1.607(b).

special form drawing

T: = INK DRAWING. TMEP 807.

special master

P:

special nuclear material

P: “The term ‘special nuclear material’ means (1) plutonium, uranium enriched in the isotope 233 or in the isotope 235, and any other material which the Commission, pursuant to the provisions of section 2071 of this title, determines to be special nuclear material, but does not include source material; or (2) any material artificially enriched by any of the foregoing, but does not include source material.” 42 USC 2014(aa) (the Atomic Energy Act). The term is used to define those inventions that may not be patented under the Act.

A CERTIFICATE OF MAILING is ineffective to establish a filing date for purposes of statements under 42 USC 2182, 2457(c), relating to special nuclear material. 37 CFR 1.8(a)(2)(x).

special relationship

S: A relationship, such as employer-employee, corporation-director, client-attorney, that gives rise to a duty of non-disclosure even in the absence of an explicit agreement.

special relief

C: An applicant for copyright may be exempted from the DEPOSIT requirements of 17 USC *** by requesting “special relief” from the Register of Copyrights. 37 CFR 202.20(d).

special service handling

T: In connection with renewal. 37 CFR 2.6(s)***.

special setting

P: A change in the usual order of presenting a case at trial. In infringement actions, the party claiming infringement is usually the plaintiff and bears the burden of proof. In a suit for declaratory judgment after an asserted claim of infringement, the party claiming infringement is the defendant, who may present first upon a motion for special setting.

species

P: A species is a disclosed embodiment of an invention. MPEP 806.04(e). “[M]ore than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species.” 37 CFR 1.141. A species anticipates a claim for a genus. *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971), *Chester v. Miller*, 906 F.2d 1574, 15 USPQ 2d 1333 (Fed. Cir. 1990). RESTRICTION may be required in an application that claims species that are PATENTABLY DISTINCT and in which no GENERIC CLAIM is allowable. See ELECTION OF SPECIES, GENUS, ULTIMATE SPECIES.

species claim

P: A claim to one or more embodiments of a GENUS. To be the subject of RESTRICTION, species claims must be mutually exclusive, that is, one claim must recite “limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first.” MPEP 806.04(f). See also SINGLE SPECIES CLAIM.

specification

P: Description and drawings of the invention, including any background. “The specification shall contain a WRITTEN DESCRIPTION of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or, with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 USC 112.

specify

T: To mention or name in an explicit manner. TMEP 804.01. The Trademark Act requires an applicant for registration to specify “the goods or serviced in connection with which the mark is used.” 15 USC 1051(a).

specimen

P: “If the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.” 35 USC 114. A plant specimen may be required. 37 CFR 1.166. See also INSPECTION.

T: An applicant for federal trademark registration must submit “such number of specimens or facsimiles of the mark as used as may be required by the Commissioner.” 15 USC 1051(a)(1)(C). An application “must include three specimens of the mark as used on or in connection with the goods in commerce. The specimens shall be duplicates of the labels, tags or containers bearing the trademark, or the displays associated with the goods and bearing the trademark (or if the nature of the goods makes use of such specimens impracticable then on documents associated with the goods or their sale) ...” 37 CFR 2.56. The specimen may consist of a sample of materials used for labeling the goods in trade or photos of the labeled goods in the trade channel. TMEP 808. One specimen must be submitted in order to receive a filing date. TMEP 909.01. The specimen must conform to Office size requirements. See BULKY SPECIMEN. See also FACSIMILE, SUBSTITUTE SPECIMEN.

spectrum of distinctiveness

T: Generic, descriptive, suggestive, arbitrary (fanciful), coined. ***

speculation or conjecture

T: A mark is suggestive if “speculation or conjecture” is required to understand it. *In re Gould Paper Corp.*, 5 USPQ 2d 1110 (***).

speech

C: Speeches, when published individually, are exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(3).

split

C: An agreement to partition a market by distributing motion pictures only to certain theatres. [McC Dict.].

spoken word recording

C: A “SOUND RECORDING in which are fixed only a series of spoken words, except that the spoken words may be accompanied by incidental music or other sounds.” 17 USC 1001(5)(c).

sponsorship

T: use of a mark may imply sponsorship. See also AFFILIATION, ENDORSEMENT.

sport

P: plant protection. 35 USC 161.

spurious designation

T: See COUNTERFEIT MARK.

spurring

P: Being motivated to file a patent application by the apprehension that another has invented or patented the same invention. The second inventor who has spurred the first may be deemed the de jure inventor. *Mason v. Hepburn*, 13 App. D.C. 86 (D.C. Cir. 1898).

SSO

C: = STRUCTURE, SEQUENCE AND ORGANIZATION.

SSP

P: = SHORTENED STATUTORY PERIOD.

stamping

T: Stamping is an acceptable manner of affixing a trademark to goods. TMEP 808.04(b).

stand

P: A patent or claim of a patent is said to “stand” if it is upheld after appeal. 37 CFR 1.192(c)(5). *Cf.* FALL.

standard

C: A printmaking term that describes the first impression of a print to achieve the artistic goals and quality requirements of the artist and the publisher.

standard of invention

P: The level of ingenuity required of an invention for it to rise to the level of patentability. The current standard is non-obviousness. Earlier higher standards were rejected by the statutory provision that patentability “shall not be negated by the manner in which the invention was made.” 35 USC 103. See FLASH OF CREATIVE GENIUS, OBJECTIVE STANDARD.

standard of proof

P: infringement — preponderance

standard of review

The conditions that must be found before an appellate court will reverse the decision of a lower court or administrative body.

Abuse of discretion

Clearly erroneous

Error of law

Seriously misjudged evidence underlying findings of fact

T: Standards of review on petitions: ABUSE OF DISCRETION, CLEAR ERROR, CORRECTNESS, ERROR OR ENTITLEMENT, EXTRAORDINARY CIRCUMSTANCES.

standing

T: To oppose: damage.***

U: Antitrust. [McC 31.30]

standstill agreement

T: An agreement whereby the parties are bound not to expand their activities in a particular arena, such as the goods to which a trademark is applied or the geographical area in which a trademark is used.

staple

P: One who sells a COMPONENT of a patented invention, if such component is not a “staple article,” may be liable as a CONTRIBUTORY INFRINGER. 35 USC 271(c).

C: Protection for MASK WORKS is not available for works that are “staple, commonplace or familiar in the semiconductor industry, or variations of such designs, combined in a way that, considered as a whole, is not original.” 17 USC 902(b)(2).

state

C: State “includes the District of Columbia and the Commonwealth of Puerto Rico, and any territories to which this title is made applicable by an Act of Congress.” 17 USC 101.

T: A mark may be refused registration on either the Principal or the Supplemental Register if it “consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 USC 1052(b), 1091(a).

States may register collective and certification marks even if they do not possess an industrial or commercial establishment. 15 USC 1054.

“No State or other jurisdiction of the United States or any political subdivision thereof may require alteration of a [federally] registered mark.” 15 USC 1121.

state-of-the-art search

P:

state registration

T: *Cf.* FEDERAL REGISTRATION.

stateless person

C: Published works of stateless persons are subject to U.S. copyright protection. 17 USC 104(b)(1).

statement commenting on reasons

P: If the examiner sets forth reasons for allowance, the applicant may file a statement of his own. Failure to file such a statement does not imply agreement with the examiner’s reasons. 37 CFR 1.109.

statement of account

C: Cable systems *** 17 USC 111(d). A statement of account must contain “a certification of the capacity of the person signing.” 37 CFR 201.17(e)(14)(iii)(D). See also ANNUAL STATEMENT OF ACCOUNT, CS/SA-3, MONTHLY STATEMENT OF ACCOUNT, SALR, SA-3.

statement of compliance

T: A statement in response to an inquiry by the Examining Attorney prompted by specimens raising a question whether use on which the application is based is lawful.

The statement must allege that the use was lawful on the date of application. TMEP 901.03(b). See COMPLIANCE WITH STATUTE.

statement of nonuse

T: A certificate of mailing is not effective to establish a filing date for a statement of nonuse. *Cf.* STATEMENT OF USE.

statement of use

T: After notice of allowance of an intent-to-use application. “In an intent-to-use application, a statement of use ... must be filed within six months after issuance of a notice of allowance under section 13(b)(2) of the Act, or within an extension of time granted under §2.89. A statement of use that is filed prior to issuance of a notice of allowance is premature, will not be considered, and will be returned to the applicant.” 37 CFR 2.88(a). If an intent-to-use applicant “fails to timely file a statement of use under §2.88, the application shall be deemed to be abandoned. 37 CFR 2.65(c). See also ABANDONMENT, REVIVAL.

A CERTIFICATE OF MAILING is ineffective to establish a filing date either for a statement of use or a request for extension of time.

6 mos. statement of use 15 USC 1051(d)(1).

Extensions: 6-month period. First GOOD CAUSE extension: file 6-12 months after Notice of Allowance; second extension: file 12-18 months; third extension, file 18-24 months; fourth extension: file 24-30 months; final extension: 30-36 months.. On good cause for up to a total of 24 months.

Efforts to use a mark justify extensions of time. These include performing MARKET RESEARCH, “production of services, research and development, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval.” 37 CFR 2.89(d)(2).

On acceptance of the statement of use, a registration will be issued. *Cf.* STATEMENT OF NONUSE.

statement relating to the death of an author

C: *** 17 USC 302(d).

statement revealing the identity of an author

C: *** 17 USC 302(c).

stationery

C: The year date may be omitted from the copyright notice on a pictorial, graphic or sculptural work as reproduced on stationery. 17 USC 401(b)(2). Stationery is exempt from the DEPOSIT requirement of 17 USC 407(a). 37 CFR 202.19(c)(2).

status

P: abandoned, after final

T: status of trademark applications. ABANDONED, ALLOWED, AWAITING RESPONSE, IN ISSUE, IN PUBLICATION, ON APPEAL, PUBLISHED, SUSPENDED, UNDER REFUSAL, UNDER SUSPENSION.

Status of registrations: INCONTESTABLE.

status inquiry

T: An inquiry as to the status of a trademark application. TMEP 411. (Diligence? ***) See also TRADEMARK STATUS LINE.

status of amendments

P: A required section of applicant's appeal brief to the Board, indicating the status of each claim, that is, whether it is pending or cancelled, and identifying the claims appealed.

status of claims

P: A required section of applicant's appeal brief to the Board, indicating the status of any amendments filed subsequent to final rejection, that is, whether or not they were ENTERED. 37 CFR 1.192(c)(2).

status quo

Last uncontested status. *** Temporary restraining order.

Statute of Anne

C:

statute of limitations

In intellectual property cases, statutes of limitations restrict the time period for which past damages can be recovered.

P: Six years from the infringement. 35 USC 286. In applying the statute of limitations to infringement by the government, the period taken by the government to deny a claim for compensation is not counted. 35 USC 286.

C: Three years from ***. 17 USC 507.

T: No limitation of actions is stated in the Lanham Act. "Whenever a federal statute contains no statute of limitations, as is the case with the Lanham Act, a court should look to the 'most appropriate or the 'most analogous' statute of limitations in the law of the forum state." *Wilson v. Garcia*, 471 US 261, 268 (1985). Because infringement is a continuing wrong, it gives rise to a claim for relief as long as the infringement persists. *Menendez v. Holt*, 128 US 514 (1888); *James Burrough, Ltd. v. Sign of Beekeeper Inc.*, 572 F.2d 574, 197 USPQ 277 (7th Cir. 1978).

S: Under the Uniform Trade Secrets Act, three years from the time the owner of the trade secret discovers, or should have discovered, the misappropriation. UTSA, 14 ULA 416.

Statute of Monopolies

P:

statutory

C: An antique term for SCULPTURAL WORK.

statutory bar

P: A condition that by statute forbids the issuance of a patent. The seven statutory bars under 35 USC 102 are that the invention was:

(a) known or used by others in this country or patented or described in a printed publication in this or a foreign country, before the invention by the applicant;

(b) patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application in the United States;

(c) abandoned;

(d) patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States;

(e) described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of Section 371(c) of the Patent Act (relating to the National Stage of PCT applications) before the invention by applicant;

(f) was not invented by the applicant; or

(g) made in this country by another who had not abandoned, suppressed or concealed it.

statutory class

P: One of the four categories of patentable subject matter enumerated by statute: PROCESS, MACHINE, MANUFACTURE or COMPOSITION OF MATTER. 35 USC 101. A claim should be directed to only one statutory class of invention. *Ex parte Lyell*, 17 USPQ 2d 1548 (BPAI 1990).

statutory copyright

C:

statutory damages

C: ***QUOTE 17 USC 504. "In any action under this title, other than an action instituted under section 411(b), no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for —

(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or

(2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work." 17 USC 412.

Factors to be considered in setting damages include: (1) expenses saved by use of the infringing material; (2) revenue lost by the copyright owner; (3) unjust enrichment of the infringer; (d) state of mind of the infringer; and (e) deterrent effect. *Schmidt v. Holy Cross Cemetery, Inc.*, 840 F.Supp. 829 (D. Kan. 1993). However, the court has unfettered discretion to award statutory damages within the prescribed range. See also WILLFUL INFRINGEMENT.

statutory disclaimer

P: The patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term of the patent granted or to be granted. 35 USC 253, 37 CFR 1.321(a). Also TERMINAL DISCLAIMER. [Walker 12:68, 18:3]

“The filing of a statutory disclaimer under 35 USC 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference.” 37 CFR 1.662(c).

statutory invention certificate

P: Evidence issued by the PTO of a STATUTORY INVENTION REGISTRATION.

statutory invention registration

P: A defensive registration having all the attributes of a patent under Title 35, USC except those specified in section 183 (relating to compensation) and 271 through 289 (relating to infringement), that is, the registration acts as prior art but creates no enforceable patent rights. An invention for which a statutory invention certificate is issued is not a “patented invention” under section 292. 35 USC 157. Statutory invention applications are subject to the requirements of 35 USC 112 and will not be published if an interference is declared unless the applicant is determined to have priority. 35 USC 157. During the pendency of a patent application, the applicant may waive rights to a patent and have the specification and drawings published as a statutory invention registration. *** created 1985.

stay

T: “The mere filing of a petition to the Commissioner will not act as a stay in any appeal or inter partes proceeding that is pending before the TTAB nor stay the period for replying to an office action in an application except when a stay is specifically requested and is granted or when §§2.63(b) and 2.65 are applicable to an ex parte application.” 37 CFR 2.146(g).

step

P: An element of a process claim is a “step” in the process, expressed as a gerund, as in “rotating said lever into a horizontal orientation.”

stippling

T: A method of indicating color on a black and white trademark drawing. See also LINING.

stipulation

T: An extension of time to oppose may be based on a stipulation by the parties. 37 CFR 2.012(c). See also CONSENT.

Stockholm Revision of the Paris Convention

P: Applicants for a U.S. patent may claim an earlier filing date based on an application for an inventor’s certificate in a foreign country if the applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of foreign filing. 35 USC 119.

stolen copy

C: It is not an infringement of copyright for a library or archives to make a facsimile copy or phonorecord of a published work to replace a stolen copy if after reasonable effort it determines that an unused replacement cannot be purchased at a fair price. 17 USC 108(c).

store receiver

C: A “single receiving apparatus of a kind commonly used in private homes.” Communication of a transmission by public reception on such a device is not an infringement of copyright. 17 USC 110(5). See also AIKEN EXEMPTION.

streamlined continuation

P: [Walker 9:9]

strength

T: The DISTINCTIVENESS of a trademark; its “tendency to identify the goods sold under the mark as emanating from a particular, although a possibly anonymous, source.” The origin-indicating quality of the mark in the eyes of the public. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1131, 202 USPQ 81 (2d Cir. 1979). “Factors useful in determining a trademark’s relative strength include the length of time a mark has been used and the plaintiff’s relative renown in its field; the strength of the mark in plaintiff’s field of business, especially by looking at the number of similar registered marks; and the plaintiff’s actions in promoting its mark.” *Tanel Corp. v. Reebok Int’l, Ltd.*, 774 F.Supp. 49, 55, 16 USPQ 2d 2034 (D. Mass. 1990). See also SPECTRUM OF DISTINCTIVENESS.

strike

P: An application may be stricken from the files if

- (1) the oath or declaration is signed in blank;
 - (2) the oath or declaration is signed without review thereof by the person making the oath or declaration;
 - (3) the oath or declaration is signed without review of the specification; or
 - (4) the application is altered after signing of the oath or declaration. 37 CFR 1.56(c).
- “Any member of the public may seek to have an application stricken from the files pursuant to paragraph (***) of this section by filing a timely petition ...” 37 CFR 1.56(e).

strong mark

T: *Cf.* WEAK MARK.

structural limitation

P: [Walker 11:11]

structure

P:

structure, sequence and organization

C: Elements of a computer program that are not literally present in its SOURCE CODE. Used in test for infringement. *Whelan Associates, Inc. v. Jaslow Dental Lab.*, 797 F.2d 1202, 230 USPQ 481 (3rd Cir. 1986). See also LOOK AND FEEL.

style

P: The “style” of an INTERFERENCE is its name, *e.g.*, *Jones v. Smith*. 37 CFR 1.627(a)..

style mark

T: A mark that designates a particular style of a product. 1990 Bacal 1.3. A style mark is not registrable if it serves only to distinguish among goods of the same producer. *Cf.* GRADE MARK.

stylized

T: A mark is stylized if it is written in a particular typeface or with special capitalization or other graphic effect. For example, “EverBrite” is stylized; “EVERBRITE” is not.

subclass

P:

subcombination

P: An element or group of elements of a combination that has separate utility. A subcombination thus has fewer elements than its parent combination. While a subcombination may be the subject of claims not drawn to the parent combination, RESTRICTION may be required if the subcombination has utility in other combinations. A subcombination is not generic to the different subcombinations in which it is used. MPEP 806.04(c).

subelement

P:

subject invention

P: With respect to federally funded inventions, “subject invention” means “any invention of the contractor conceived or first actually reduced to practice in the performance of work under a funding agreement: Provided, That in the case of a variety of plant, the date of determination (as defined in section 41(d) of the Plant Variety Protection Act (7 USC 2401(d)) must also occur during the period of contract performance.” 35 USC 201(e), 37 CFR 401.2(d), 48 CFR 52.227-11(a)(6).

subject matter

P:

C:

subject matter jurisdiction

T: Subject matter jurisdiction is a QUESTION OF LAW. *Reebok Int’l. Ltd., v. Marnatech Enterprises, Inc.*, 970 F.2d 552, 23 USPQ 2d 1377 (9th Cir. 1992).

subjective eyeball test

T: The degree of visual similarity between two products — a test for TRADE DRESS infringement. *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1 USPQ 2d 1161 (11th Cir. 1986), *cert. denied*, 481 US 1041 (1987).

subjective standard of invention

P: See Miller p. 74.

subliminal confusion

T: Confusion that causes “the consumer to identify the properties and reputation of one product with those of another, although he can identify the particular manufacturer of

each.” *Ortho Pharmaceutical Corp. v. American Cyanamid Co.*, 361 F.Supp. 1032, 179 USPQ 649 (D. N.J. 1973).

subpoena

P,T: Testimony in a contested case in the PTO may be taken by subpoena issued by the clerk of the United States court for the district in which the testimony is sought. 35 USC 24.

subscriber

C: An “individual who receives a secondary transmission service for private home viewing by means of a secondary transmission from a satellite carrier and pays a fee for the service, directly or indirectly, to the satellite carrier or to a distributor.” 17 USC 119(d)(8).

subsequent process

P: A product made by a patented process is not an infringement if it is “materially changed by a subsequent process.” 35 USC 271(g).

subservient

P: A patent claim B is “subservient” to another claim A if it is **NARROWER** than A, in which case A is said to be the **DOMINANT** claim.

subsidiary rights

C: Rights to a work other than the right to copy and distribute, including abridgment, adaptation, dramatization, screenplay, serialization, syndication, translation.

subsist

C:

substantial identity

P: [Walker 4:4]

substantial likelihood

P: Rebuttable presumption of infringement if process patentee can show a “substantial likelihood” or infringement and, after reasonable efforts, cannot discover the actual process used by a foreign manufacturer. 35 USC 271(g).

substantial noninfringing use

P: One who sells a material component or part of a patented invention “knowing that it is especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.” 35 USC 271(c).

substantial preparation

P: Court may protect substantial preparation begun after expiration of grace period for paying maintenance fee but before acceptance of late payment. 35 USC 41(c)(2).

substantial similarity

C: An element of the judicial test for copyright infringement. *Eisenschimi v Fawcett*, 246 F.2d 598 (***) . The test is not statutory. There is substantial similarity where “the **ORDINARY OBSERVER**, unless he set out to detect the disparities, would be disposed to

overlook them, and regard their aesthetic appeal as the same.” *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489, 124 USPQ 154 (2d Cir. 1960). The similarity must be found in that portion of the plaintiff’s work that is protected. *Levine v. McDonald’s Corp.*, 735 F.Supp. 92 (S.D.N.Y. 1990).

substantiality

C: An inquiry to decide whether a parody of a work is an infringement. The test is whether the parody does more than necessary to “recall or conjure up” the original. *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541 (2d Cir. 1964), *cert. denied*, 379 US 822 (1964).

A factor to be considered in determining whether use of a copyrighted work is a FAIR USE, which requires an examination of “the amount and substantiality of the portion used in relation to the copyrighted work as a whole.” 17 USC 107(3).

substantially

P: The word “substantially” serves to broaden a claim by covering structures and quantities that are not exactly as described.

substantially as described

P: [Walker 21:33]

substantially complete response

T: A RESPONSE that inadvertently omits consideration of some matter or compliance with some REQUIREMENT. 37 CFR 2.65(b). See ABANDONMENT.

substantially embraced

P: When a claim is presented for matter originally shown or described in a patent application but not “substantially embraced” in the statement of invention or claims originally presented, a SUPPLEMENTAL DECLARATION is required. 37 CFR 1.67.

substantially exact

T: “[T]he drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods.” 37 CFR 2.51(a).

substantially exclusive and continuous use

T: “The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.” 15 USC 1052(f). See DISTINCTIVENESS, SECTION 2(F) REGISTRATION.

substantially indistinguishable

T: “A counterfeit mark is ... a spurious designation that is identical with, or substantially indistinguishable from a designation as to which the remedies of this Act are made available by reason of section 110 of the [Olympic Charter Act].” 15 USC 1116(d)(1)(B).

A higher standard than CONFUSINGLY SIMILAR, also used in the definition of a COUNTERFEIT MARK under the Trademark Counterfeiting Act of 1984, 18 USC 2320(a).

substantially involved

P: An individual who is “substantially involved in the preparation or prosecution of the application and who is associated with the inventor” has a DUTY OF CANDOR toward the PTO. 37 CFR 1.56(a).

substantially the same subject matter

P: interference

substitute

P: See NON-INFRINGEMENT SUBSTITUTE.

substitute specification

P: “If the number or nature of the amendments shall render it difficult to consider the case ... the examiner may require the entire specification ... to be rewritten.” It must be accompanied by a statement that the substitute specification includes no NEW MATTER. 37 CFR 1.125.

substitute specimen

T: Applicant may submit substitute SPECIMENS of the mark as used on or in connection with the goods, or in the sale or advertising of the services.” 37 CFR 2.59(a). Any substitute specimen must be supported by affidavit or declaration attesting to use at least as early as the FILING DATE. TMEP 808.03.

substitution

T: It is TRADEMARK INFRINGEMENT for a retailer to substitute, even passively, different goods when goods of a specific source are requested. *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 216 USPQ 579 (9th Cir. 1982).

substitution of equivalents

P: [Walker 14:19]

substitution of materials

P: [Walker 6:41]

successor

T: See also INTENT-TO-USE APPLICATION.

such as

C: In the Copyright Act, 17 USC 101 *et seq.*, the use of the phrase “such as” is illustrative and not limiting.

sufficient amount

P: The “sufficient amount” recitation “is not a distinguishing LIMITATION of the claims, unless that amount is different from the prior art and critical to the use of the claimed composition. *In re Dillon*, 919 F.2d 688, 16 USPQ 2d 1897 (Fed. Cir. 1990) (in banc).

sufficient cause

P: A standard for granting certain extensions of time. 37 CFR 1.13(b).

T: 37 CFR 2.144.

sufficiently serious questions going to the merits

A Second Circuit standard for granting a preliminary injunction: possible irreparable harm plus either probability of success on the merits or sufficiently serious questions going to the merits to make them a fair ground for litigation and a balance of hardships tipping decidedly in favor of granting the injunction. *Consumers Union of US v. General Signal Corp.*, 221 USPQ 400 (2d Cir. 1983).

suggestion

P: Part of a standard for OBVIOUSNESS. “Whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Dow*, 837 F.2d 469, 473 (***)

suggestion of claim

P: “The examiner may suggest that the applicant present a claim in a application for the purpose of an INTERFERENCE with another application or patent.” 37 CFR 1.605(a).

suggestion to combine

P: “When a patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination” for the invention to be considered obvious. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ 2d 1321, 1323 (Fed. Cir. 1990), *cert. denied*, 498 US 920 (1990). “As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor.” *In re Beattie*, 974 F.2d 1309, 24 USPQ 2d 1040 (Fed. Cir. 1992).

suggestive mark

T: A mark is suggestive if it “suggests, rather than describes, some particular characteristic of the goods or services to which it applies and requires the consumer to exercise imagination in order to draw a conclusion as to the nature of goods and services.” *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 217 USPQ 988 (5th Cir. 1983). A mark that “connotes something about the product” with which it is associated. 15 USPQ 2d 1613. A mark is suggestive if “it requires imagination, thought or perception to reach a conclusion as to the nature” of the goods or services. *Stix Products, Inc. v. United States Merchants and Mfrs., Inc.*, 160 USPQ 777 (***) “If the means of arriving at the descriptive significance is incongruous, circuitous, or by language which is not normal for the circumstances, the mark may be considered suggestive.” Suggestive marks are registrable on the Principal Register. TMEP 1207.

summary judgment

P: interference. 37 CFR 1.617.

summary of the invention

P: A required element of the SPECIFICATION of a patent application. “A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description.” 27 CFR 1.73.

A required section of applicant's appeal brief to the Board is a "statement of invention." 37 CFR 1.192(c)(3).

summons

T: In a civil action appealing from a decision of the TTAB, "summons against adverse parties residing in foreign countries may be served by publication." 15 USC 1071(b)(4).

superconductivity materials

P: The PTO will accord SPECIAL status to patent applications for inventions involving superconductivity materials. MPEP 708.02.

superstation

C: A television station whose programs are carried outside its local broadcast area by cable providers. A "television broadcast station, other than a network station, licensed by the Federal Communications Commission that is secondarily transmitted by a satellite carrier." 17 USC 119(d)(9).

supervising primary examiner

P: "The supervising primary examiners are expected to personally check on the pendency of every application which is up for the third or subsequent OFFICIAL ACTION with a view to finally concluding its prosecution. Any case that has been pending five years should be carefully studied by the supervising primary examiner and every effort made to terminate its prosecution. In order to accomplish thus result, the case is to be considered 'special' by the examiner." MPEP 707.02(a). Abbreviated SPE.

supervisory examining attorney

T:

supervisory power

T: Of Commissioner. [McC 21.03[3]]

supplemental declaration

P:

supplemental examiner's answer

P: In an application under appeal, a new rejection based on fraud or violation of duty of disclosure constitutes a supplemental examiner's answer. 37 CFR 1.193(c).

supplemental jurisdiction

P: The power of a federal court to address state claims arising from the same transaction or occurrence that gave rise to the federal claim. *Rolex Watch USA Inc. v. Bulova Watch Co., Inc.*, 26 USPQ 2d 1951, 1954 (E.D.N.Y. 1993). See 28 USC 1367.

supplemental oath

P: A separate oath must be filed (1) when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented; or (2) when an oath or declaration submitted after filing the specification improperly refers to an amendment which includes new matter. 37 CFR 1.67.

Supplemental Register

T: The “term ‘supplemental register’ refers to the register provided for by section 1091 to 1096 of this title.” 15 USC 1127. It is a continuation of the register provided for in the BUENOS AIRES CONVENTION. TMEP 202.02(b). Rights of Supplemental v. Principal. *** See also PRINCIPAL REGISTER, SUPPLEMENTAL REGISTRATION.

Marks not registrable on Principal, but capable of functioning as a TM. Buenos Aires? ***

“All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register ... except those declared to be unregistrable under subsections (a)-(d) of Section 1052 ..., which are in lawful use in commerce by the owner thereof ... may be registered on the supplemental register.” 15 USC 1092.

“For the purposes of registration on the supplemental register, a mark may consist of any trade-mark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, or device or any combination of any of the foregoing but such mark must be capable of distinguishing the applicant’s goods or services.”

“Marks for the supplemental register shall not be published for or be subject to opposition.” 15 USC 1092. Such marks are subject to cancellation.

“The certificates of registration for marks registered on the supplemental register shall be conspicuously different from certificates issued for marks registered on the principal register.” 15 USC 1093.

The provisions of the Lanham Act “shall govern so far as applicable applications for registration and registrations on the supplemental register as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 1(b) [intent to use], 2(e) [merely descriptive, primarily geographically descriptive, surname], 2(f) [five years’ use], 7(b) [prima facie effect], 7(c) [constructive use], 12(a) [publication for opposition], 13 to 18, inclusive, [opposition, cancellation, incontestability, interference, inter partes proceedings, concurrent use], 22 [constructive notice], 33 [evidence of exclusive right to use] and 42 [importation forbidden].” 15 USC 1094. Marks on the Supplemental Register are not subject to INTERFERENCE. 37 CFR 2.91(b).

A mark on the Supplemental Register may also be registered on the Principal Register. 15 USC 1095. “Registration of a mark on the supplemental register shall not constitute an admission that the mark has not acquired distinctiveness.” 15 USC 1095. “An application for registration on the Principal Register under section 1(a) or section 44 may be changed to an application for registration on the Supplemental register and vice versa.” 27 CFR 2.75(a). “An intent-to-use application may be so amended only after submission of a statement of use or amendment to allege use.” 37 CFR 2.75(b). Cf. PRINCIPAL REGISTER.

Registration on the Supplemental Register may not be used to stop importation of infringing goods. 15 USC 1096.

supplemental registration

T: A registration on the SUPPLEMENTAL REGISTER.

supplemental search fee

P: PCT. 35 USC 376(a)(3). See 37 CFR 1.445(a)(2).

supplementary application

P: An application to the Food and Drug Administration covering a facility for production of a new drug product. The approval of such supplementary application may result in a PATENT TERM RESTORATION. 35 USC 155A(a)(1)(D).

supplementary registration

C: “A ‘supplementary registration’ means a registration made upon application under section 408(d) of Title 17 of the United States Code ... and the provisions of this section.” 37 CFR 201.5(a)(1)(ii). It is one made to “correct an error in a copyright registration or to amplify the information given in a registration. ... The information contained in a supplementary registration augments but does not supersede that contained in the earlier registration.” 17 USC 408(d).

supplementary work

C: A “work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes.” 17 USC 101.

support

P: *** must find support in specification for every element and limitation in claim unless implicit.

suppression

P: One may not obtain a patent if, “before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, suppressed or concealed it.” 35 USC 102(g). Hiding, failure to apply for a patent. ***

Supremacy clause

:Const. Art. IV, Clause 2

surcharge

P: PCT

surname

T: A mark may be refused registration on the principal register if it “consists of a mark which, ... (3) is PRIMARILY MERELY A SURNAME.” 15 USC 1052(e). “The principal reason is that all person bearing a certain surname should have an equal opportunity to utilize the surname as a distinguishing mark.” TMEP 1209.

A mark on the Supplemental Register may consist of a “surname.” 15 USC 1091(c).

surrender

P: An application for a reissue must be accompanied by an offer to surrender the original patent. 37 CFR 1.178.

claim. 35 USC 251 ??***

T: A trademark registration may be surrendered for cancellation voluntarily. 15 USC 1057(e). Classes 37 CFR 2.172.

surreply

T: The TTAB discourages surreplies. *Data National Corp. v. BellSouth Corp.*, *** Q2 ***.

survey

T: Requirements.

surviving spouse

C: See WIDOW, WIDOWER.

suspension

Of proceedings.

A person, agent or representative who is shown to be “incompetent, disreputable, or guilty of gross misconduct” by be suspended or excluded from practice before the PTO. 35 USC 32.

P: Of action on application. “Suspension of action by the office will be granted for GOOD AND SUFFICIENT CAUSE and for a reasonable time specified upon petition by the applicant ... Action will not be suspended when a response to an office action is required.” 37 CFR 1.103(a). Suspension of action on an application may be the subject of a PETITION. 37 CFR 1.103.

When an INTERFERENCE is declared, ex parte prosecution of an application involved in the interference is suspended.” 37 CFR 1.615(a).

Of rules. Any requirement of the regulations not a requirement of statute may be suspended or waived by the Commissioner. 37 CFR 1.183.

T: “Action by the PTO may be suspended for a reasonable time for GOOD AND SUFFICIENT CAUSE.” 37 CFR 2.67.

Suspending of action which is due to be taken by the Examining Attorney does not extend the applicant’s time. *** TMEP 1108.

Action on an application is suspended where there is likelihood of confusion between applicant’s mark and a mark that is the subject of an application with an earlier filing date. 37 CFR 2.83.

Awaiting foreign registration.

During the time that the action of the Examining Attorney is formally delayed beyond the time such action would have been due in normal order, the application is referred to as being “suspended” or being “under suspension.” TMEP 405. See also STATUS.

sustain

To uphold.

T: An opposition, if successful, is said to be “sustained.” *Cf.* DISMISS.

swear back, swear behind

P: v. prior invention

v. prior patent

*** See also CARRY BACK.

sweat of the brow

C: The idea that a work should be protectible merely because substantial effort was required to create it, and to allow copying by others deprives the author of the fruit of his labor. The concept was explicitly put to rest in *Feist Publications, Inc. v. Rural*

Telephone Service Co. Inc., 499 US 340 (1991), in which the Supreme Court ruled that originality is a constitutional requirement for copyright protection.

sworn

P: With respect to an interference, “[s]worn’ means sworn or affirmed.” 37 CFR 1.601(o).

sworn certification

C: “A ‘sworn certification’ is an affidavit under the official seal of any officer authorized to administer oaths within the United States, or if the original is located outside of the United States, under the official seal of any diplomatic or consular officer of the United States or a person authorized to administer oaths whose authority is proved by the certificate of such an officer, or a statement in accordance with section 1746 of Title 28 of the United States Code.” 37 CFR 201.4(a)(3)(i). Cf. OFFICIAL CERTIFICATION.

symbol

C: “Familiar symbols and designs” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

T: A “symbol” may serve as a trademark. 15 USC 1127.

synchronization rights

C: The right to use a copyrighted musical work as part of the SOUNDTRACK of a MOTION PICTURE.

syndex

C: = SYNDICATED EXCLUSIVITY.

syndicated exclusivity

C: The right, granted under FCC rules, to prohibit a cable TV station from transmitting a program to which a broadcaster has exclusive rights in its broadcast area, effective January 1, 1990. See *United Video Inc. v. FCC*, 890 F.2d 1173, 12 USPQ 2d 1964 (D.C. Cir. 1989). Abbreviated SYNDEX.

syndication

C: The distribution of a series of works on a regular basis to consuming markets, such as publishers, television stations and newspapers.

synergism

P: An obsolete test to determine whether a combination is obvious. If the elements do not cooperate to produce a synergistic result, that is, that do no more than would be expected from their individual functions, the invention was regarded as obvious. “A requirement for synergism or a synergistic effect is nowhere found in the statute, 35 USC. When present, for example in a chemical case, synergism may point toward nonobviousness, but its absence has no place in evaluating the evidence on obviousness.” *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

Unexpected synergism is a SECONDARY CONSIDERATION in determining non-obviousness. See SYNERGISTIC RESULTS.

Demise of doctrine for combination patents: *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

synergistic results

P: [Walker 6:36, 11:15, 12:11]

system

C: Systems are not copyrightable apart from their expression. “In no case does copyright protection ... extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 USC 102(b). Likewise for MASK WORKS. 17 USC 902(c). “Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(b).

systematic instructional activities

C: A literary, pictorial or graphic work is an INSTRUCTIONAL TEXT if it is prepared for publication and with the purpose of use in “systematic instructional activities.” 17 USC 101.

t.a

T: An abbreviation for “trading as,” a designator for a FICTITIOUS NAME. TMEP 802.02. An ASSUMED NAME DESIGNATION.

table

P: “The description portion of the specification may contain tables; claims may contain tables either if necessary to conform to 35 USC 112 or if otherwise found to be desirable.” 37 CFR 1.58(a). All tables and chemical formulas must be suitable for camera copy. 37 CFR 1.58(b).

C: One of the works that may be a SUPPLEMENTARY WORK. 17 USC 101.

tacking

T: USE not rising to the level of trademark use may be tacked onto later trademark use to obtain an earlier date of first use. [McC 16.04]

tangible

S: A trade secret need not exist in tangible form to be protectible. 484 US 19. *Carpenter v. US*. Some state criminal theft of trade secret statutes require asportation of a tangible article.

tangible medium of expression

C: See FIXED. 17 USC 101.

tape measure

C: Tape measures containing no original authorship are not copyrightable. 37 CFR 202.1(d).

Tea Rose-Rectanus doctrine

T: Protects junior user who adopted a mark in good faith from suit by a geographically remote senior user.

teach

P: *Cf.* CLAIM, DISCLOSE, SUGGEST, TEACH AWAY.

teach away

P: The prior art is said to “teach away” from an invention if it suggests that the invention would not work. *** Probably not obvious. *General Battery Corp. v. Gould, Inc.*, 545 F.Supp. 731 (D. Del. 1982).

teaching

C: It is not an infringement of copyright to make FAIR USE of a copyrighted work for purposes such as teaching. 17 USC 107.

technical data

In the context of Government procurement, “data (other than computer software) which are of a scientific or technical nature.” 48 CFR 52.227-14(a). See also LIMITED RIGHTS DATA.

technical drawing

C: A technical drawing falls in the category of PICTORIAL, GRAPHIC AND SCULPTURAL WORKS, but may not be a WORK OF VISUAL ART. 17 USC 101. A type of WORK OF THE VISUAL ARTS. 37 CFR 202.3(b)(1)(iii).

technical novelty

P: The doctrine that a new use for an old article of manufacture may be patentable if any structural change is made to the article. *Traitel Marble Co. v. Hungerford Brass & Copper Co.*, 18 F.2d 66 (***).

technique

S: A “technique” may constitute a trade secret under UTSA 1(4).

telegraphic amendment

T: An amendment submitted by wire and thus incapable of being signed. It will be ENTERED if followed by a properly signed amendment within a “reasonable time.” TMEP 710.03(c).

telephone interview

T: An interview conducted by means of a telephone conversation. TMEP 1107.

telephone practice

P: When an examiner issues a rejection on the ground of multiplicity, the practice is to call the applicant’s attorney. MPEP 706.03(1). [Walker 12:46, 12:41]. See also TELEPHONE RESTRICTION PRACTICE.

telephone restriction practice

P: The practice of the PTO in seeking ELECTION of a group of claims by telephoning the attorney of record. It is streamlined since a REQUIREMENT FOR RESTRICTION is normally not accompanied by an ACTION ON THE MERITS. See also TELEPHONE PRACTICE. MPEP 812.01.

telescoped word

T: A word consisting of two or more words run together, the last letter of each being the same as the first letter of the next, which are contracted to a single letter. For example, the words “WONDER” and “ROCK” can be used to form the UNITARY EXPRESSION “WONDERROCK” and the telescoped word “WONDEROCK.”.

temporary presence

P: It is not an infringement of a patent to use an invention on any vessel, aircraft or vehicle entering the U.S. temporarily or accidentally if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the U.S., if the country of origin of the vessel, aircraft or vehicle affords similar privileges to foreign craft. 35 USC 272.

temporary restraining order

Preserve status quo ***. Abbreviated TRO. Requirements:

tenancy in common**Tennessee Valley Authority**

P: Contractors of the Tennessee Valley Authority are exempt from the federal funding provisions of 35 USC 210 *et seq.*, relating to federal rights in inventions.

term

P: The term of a utility or plant patent is seventeen years. 35 USC 154. The term of a design patent is fourteen years. 35 USC 173. See also PATENT TERM EXTENSION, PATENT TERM RESTORATION.

C: (1) For works created on or after January 1, 1978: life of the author plus fifty years. 17 USC 302. For anonymous works, pseudonymous works and works made for hire, 75 years after publication or 100 years after creation, whichever is earlier. 17 USC 302(c).

(2) For works created but not published or copyrighted before January 1, 1978: life of the author plus 50 years.

(3) For works copyrighted before January 1, 1978: up to 75 years ***.

For the rights of attribution and integrity, the term is the life of the author.

For MASK WORKS, the end of the calendar year including the 10th anniversary of the date on which the mask work is registered or on which it is first commercially exploited anywhere in the world, whichever comes first. 17 USC 904.

T: Ten years from registration, renewable for ten-year periods. 15 USC 1058(a), 1059(a). The period was formerly 20 years. See RENEWAL.

terminal disclaimer

P: Quote 35 USC 253. The surrender of a period of a patent term subsequent to a certain date. In the case of revival of an unintentionally abandoned application, if the petition to revive is not received within six months of the date of abandonment, the applicant must disclaim that terminal part of the term equal to the period of abandonment. 37 CFR 1.137(c). Likewise, delay in paying the issue fee requires a terminal disclaimer. 37 CFR 1.316(d). It may be used to overcome an OBVIOUSNESS TYPE DOUBLE PATENTING rejection. 37 CFR 1.78(d), 1.321(b). A terminal disclaimer is “ineffective for the ‘same invention’ type double patenting situation where it is

attempted to twice claim the same invention.” MPEP 803.02. Terminal disclaimer of separate claims is not permitted. MPEP 1490. Also statutory disclaimer.

***COMMON OWNERSHIP?

termination of proceedings

P: A file wrapper continuation must be filed before payment of the issue fee, abandonment or termination of proceedings on prior application. 37 CFR 1.62(a). Dismissal of appeal, failure to file a timely appeal from Board action. 37 CFR 1.197(c). Termination of action on appeal is a termination of proceedings.

termination of transfer

C: Procedures 17 USC 203(a)(4), 17 USC 304(c)(4). The right to terminate cannot be waived. 17 USC 203(a)(5).

Transfers made before January 1, 1978.

Transfers made on or after January 1, 1978. 17 USC 203.

A work made for hire is not a transfer. Notice of termination required.

territorial assignment

T: An assignment purporting to transfer rights in a trademark registration for less than the entire United States. TMEP 502.

territorial commerce

T: *** TMEP 806.05.

territorial court

T: “The district and territorial courts of the United States shall have original jurisdiction ... of all actions arising under” the Lanham Act. 15 USC 1121.

territoriality

T: The effect of the trademark laws is territorial. See also GRAY MARKET. Cf. EXTRATERRITORIALITY.

territory

C: For purposes of the Copyright Act, the “organized territories under the jurisdiction of the United States Government” are STATES. 17 USC 101. A nonsimultaneous transmission by a cable system within a territory is considered a SECONDARY TRANSMISSION. 17 USC 111(f).

T: License.

test

P: The result of tests and experiments may be included in a specification. “The results of tests and examples should not normally be questioned by the examiner unless there is reasonable basis for questioning the results. If the examiner questions the results, the appropriate claims should be rejected as being based on an insufficient disclosure under 35 USC 112, first paragraph. MPEP 707.07(1); *In re Borkowski et al.*, 164 USPQ 642 (CCPA 1970).

C: One of the nine statutory classes of WORKS MADE FOR HIRE. 17 USC 101. Tests and answer material for tests when published separately from other literary works are exempt from the DEPOSIT requirement. 37 CFR 202.19(c)(8). See also ANSWER MATERIAL FOR A TEST.

ordinary observer test
separateness test
time and place test

testimony

P: In an INTERFERENCE, testimony from “another interference, proceeding, or action involving the same parties: may be used. 37 CFR 1.683.

testimony in chief

P:

testimony period

P: A period of time allowed for taking testimony. ***

T: A period of time allowed for taking testimony. ***

textbook

C: A type of NON-DRAMATIC LITERARY WORK. 37 CFR 202.3(b)(1)(i).

thing

P: With respect to affidavits of witnesses, “[a] party shall not be entitled to rely on any thing mentioned in the affidavit unless the opponent is given reasonable access to the thing. A thing is something other than a document. 37 CFR 1.672(b).

third-party registration

T: A trademark registration owned by someone other than the parties to a case or proceeding. The existence of third-party registrations may be used to show that a mark is WEAK. *In re Melville Corp.*, 18 USPQ 2d 1386 (TTAB 1991).

thorough conviction

T: An evidentiary standard. See COLLATERAL ESTOPPEL.

three-dimensional mark

T: Three-dimensional marks are those which, when in use, have depth as well as height and breadth. TMEP 1301.08. “In an application to register a mark with three-dimensional features, the drawing shall depict the mark in perspective in a single rendering.” 37 CFR 2.51(d).

three-dimensional sculptural work

C: Exempt from DEPOSIT requirements. 37 CFR 202.19(c)(6).

three-way requirement for restriction

P: Product, process of making, process of use. A three-way requirement for restriction can only be made if the process of making the product is distinct from the product. 37 CFR 1.141(b). “Where claims to all three categories, product, process of making, and process of use, are included in a NATIONAL APPLICATION, a three-way requirement for restriction can only be made where the process of making is distinct from the product.” 37 CFR 1.141(b).

tie-in

P: See also TYING. [McC Dict.]

C: BLOCK BOOKING, BUNDLING of hardware and software.

T:

U: [McC 31.33]

tie-out

P: An agreement in which a party agrees not to make, use or sell goods competitive with a patented article. Possible PATENT MISUSE.

time

P: An application must be prosecuted within six months of any action, or such shorter period, not less than 30 days, as fixed by the Commissioner, or the application will be abandoned, except for UNAVOIDABLE DELAY. 35 USC 133. The following table indicates the time limit for taking various actions in patent matters.

TIME	ACTION	CITE
Promptly	Notify the Board of any litigation related to any patent or application involved in an INTERFERENCE.	37 CFR 1.660(d)
60 min.	Each party's oral argument at a final hearing on an interference.	37 CFR 1.654(a)
3 days	Serve notice of deposition in INTERFERENCE prior to oral conference, if served by Express Mail.	37 CFR 1.673(b)
10 days	Serve notice of deposition in INTERFERENCE prior to oral conference, if not served by Express Mail.	37 CFR 1.673(b)
10 days	To file notice of intent to argue abandonment, suppression or concealment after close of opponent's testimony-in-chief.	37 CFR 1.632
10 days	To notify the Board after receiving notice of a request for reexamination of a patent involved in an interference.	37 CFR 1.660(a)
10 days	To notify the Board of a REISSUE application filed by a patentee for a patent involved in an INTERFERENCE.	37 CFR 1.660(b).
10 days	To notify the Board of a notice of protest filed against an application involved in an INTERFERENCE.	37 CFR 1.660(c)
10 days	Demand jury trial on an issue, "after service of the last pleading directed to such issue."	FRCP Rule 38
14 days	To request reconsideration of a decision on a motion in an interference.	37 CFR 1.640(c)
14 days	Reply to a request for reconsideration of a FINAL DECISION in an INTERFERENCE, after service of the notice of request.	37 CFR 1.658(b)
15 days	Reply after service of opposition to a motion in an INTERFERENCE.	37 CFR 1.638(b)
15 days	To show good cause why judgment in an INTERFERENCE should not be entered for failure to take testimony.	37 CFR 1.652
15 days	To file a written objection to a notice offering the official record in an INTERFERENCE.	37 CFR 1.682(c)
15 days	To file a written objection to the admissibility of an answer to an interrogatory in an INTERFERENCE.	37 CFR 1.688(a)
20 days	To request reconsideration of a decision to publish a BPIA decision.	37 CFR 1.14(d)
20 days	To notify the Board of any and all right, title and interest in any application or patent involved or relied upon in an INTERFERENCE	37 CFR 1.602(b)
20 days	To file preliminary motion under 1.633(i) or (j) after service of the preliminary motion.	37 CFR 1.633(b)
20 days	To file an OPPOSITION to a motion in an INTERFERENCE.	37 CFR 1.638(a)

20 days	To respond to a SHOW CAUSE ORDER in an INTERFERENCE.	37 CFR 1.640(e)
20 days	File INTERFERENCE arbitration award.	37 CFR 1.690(c)
20 days	File agreement to arbitrate interference after execution of the agreement.	37 CFR 1.690(a)
30 days	Request to BPAI to reconsider or modify a decision.	37 CFR 1.197(b), 1.658(b)
30 days	File notice of prior art relied on to show invalidity, before trial.	35 USC 282
30 days	Specify date for selection of arbitrators after execution of the agreement to arbitrate an interference.	37 CFR 1.690(a)
1 month	To amend to present a claim suggested by the examiner to provoke an interference.	37 CFR 1.605(a)
1 month	Request for reconsideration of a FINAL DECISION in an INTERFERENCE.	37 CFR 1.658(b)
60 days	Interference.	35 USC 146
2 months	Petition to the Commissioner on action complained of.	37 CFR 1.181(f)
2 months	Appeal to CAFC or filing of civil action	37 CFR 1.304
6 months	File INTERFERENCE SETTLEMENT AGREEMENT after termination of INTERFERENCE, on PETITION TO THE COMMISSIONER.	37 CFR 1.666(c)
12 months	Statutory bar for patent in foreign country: more than 12 months before filing US application.	
1 year	Statutory bar for printed publication, public use, on-sale	

With respect to late payment of maintenance fees, see GRACE PERIOD. See also NON-STATUTORY TIME PERIOD, SHORTENED STATUTORY TIME PERIOD.

T:

TIME	ACTION	CITE
10 min.	Examiner's time to argue at oral hearing before TTAB	
20 min.	Appellant's time to argue at oral hearing before TTAB, including rebuttal	
7 days	For seizure after issuance of a seizure order	15 USC 1116(d)(5)(C))
10 days	Request for oral hearing in TTAB appeal, after date reply brief is due.	
10 days	Demand jury trial on an issue, "after service of the last pleading directed to such issue."	FRCP Rule 38
15 days	Petition from denial of a request for extension of time to oppose.	37 CFR 2.146(e)(1)
20 days	File reply brief after mailing of examiner's brief on appeal to TTAB	
20 days	Election to appeal to district court after appeal to CAFC.	
30 days	File notice of opposition, after publication of mark in Official Gazette.	
30 days	File civil action after filing notice of election under 15 USC 1071.	
30 days	Request to TTAB for reconsideration of decision on motion.	37 CFR 2.127(b)
30 days	Petition from an interlocutory order of the TTAB.	37 CFR 2.146(e)(2)
1 month	Petition from refusal to grant extension of time to file a STATEMENT OF USE.	37 CFR 2.89(g)

1 month	Request to TTAB for reconsideration of judgment.	37 CFR 2.129(c)
8 weeks	Domestic applicant to file application after execution of declaration.	EG 1-92
60 days	Petition on any matter not specifically provided for.	37 CFR 2.146(d)
60 days	Appellant's brief due after filing notice of appeal to TTAB.	
60 days	Examiner's brief due after service of appellant's brief.	
60 days	File notice of appeal from decision of the TTAB.	15 USC 1071(a)(2)
60 days	Commence civil action after decision of the TTAB.	15 USC 1071(b)(1)
12 weeks	Foreign applicant to file application after execution of declaration.	EG 1-92
6 months	Respond to office action unless delay is unavoidable.	
6 months	Reconsideration of refusal to accept Section 8 affidavit.	37 CFR 2.165
6 months	Petition from refusal of renewal application, from date of mailing of action	37 CFR 2.184
6 months	Petition from refusal to correct or amend records or accept disclaimer.	37 CFR 2.176
5 years	File petition to cancel a registration	

time and place test

T: (Junior user) [McC 16.12].

time cards

C: Time cards, to the extent they are for recording rather than conveying information, are "not subject to copyright and applications for registration of such works cannot be entertained." 37 CFR 202.1(c).

time limit action

P: An action in which the examiner requires the application to respond on or before a specified date under the authority of 35 USC 6. MPEP 710.02.

title

P: The specification must contain a title. "The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application." 37 CFR 1.72. Also SHORT TITLE.

A non-profit organization or small business firm that makes an invention under a funding agreement with the Government may elect to retain title to the invention, with certain exceptions. 35 USC 202(a).

C: For protectibility of titles, see TITLES.

In computing the fee for recording a document, the number of "titles" referenced in the document is relevant. "The term 'title' generally denotes 'appellation' or 'denomination' rather than 'registration,' 'work' or 'copyright'." 37 CFR 201.4(d)(2).

T: Prior U.S. class names were referred to as "titles." TMEP 1401.02. Cf. NAME. For protectibility of titles, see TITLES.

title card

T: A card or other display identifying live entertainment. TMEP 1301.09. Used in reference to a DISPLAY associated with services.

title mark

T: A trademark applied as the title for a periodic publication. TMEP 804.02(a). The names of continuing radio or television programs are title marks. TMEP 1301.09. Titles will not serve as trademarks unless more than one presentation or story is involved.

title page

C: “A ‘title page’ is a PAGE, or two consecutive pages, facing each other, appearing at or near the front of the copies of a work published in BOOK FORM, on which the complete title if the work is prominently stated and on which the name of the author or authors, the name of the publisher, the place of publication, or some combination of them, are given.” 37 CFR 201.20(b)(5).

title report

P: A title report on a patent may be ordered from the PTO. 37 CFR 1.19(b)(6).

titles

C: “Words and short phrases such as names, titles and slogans” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a). Titles of serial publications may be trademarked.

T: A title of a continuing publication may be registered as a SERVICE MARK. 15 USC 1127. See TITLE MARK. A title of a single book is merely descriptive of that book and is unregistrable. *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (CCPA 1958).

TLRA

Trademark Law Revision Act.

TMEP

Abbreviation for the TRADEMARK EXAMINING OPERATION.

TMEP

Abbreviation for the TRADEMARK MANUAL OF EXAMINING PROCEDURE.

token use

T: Not enough for Section 8 affidavit after TLRA.

tort

Patent, copyright and trademark infringements are species of torts.

total concept and feel

C: See CONCEPT AND FEEL.

total effect

T: Similarity of trademarks “is determined on the basis of the total effect of the designation, rather than a comparison of individual features.” *Boston Athletic Ass’n. v. Sullivan*, 867 F.2d 22, 9 USPQ 2d 1690 (1st Cir. 1989). See also CONFUSING SIMILARITY.

toys

C: The year date may be omitted from the copyright notice on a pictorial, graphic or sculptural work as reproduced on toys. 17 USC 401(b)(2).

trade dress

T, U: The “image and overall appearance of a product.” It embodies “that arrangement of identifying characteristics or decorations connected with a product, whether by packaging or otherwise, intended to make the source of the product distinguishable from another and to promote its sale.” *Ferrari*, 944 F.2d 1235, 1238, 20 USPQ 2d 1001 (6th Cir. 1991), *cert. denied*, *** (1992). It may include such features as size, shape, color, texture and graphics. *Stormy Clime, Ltd. v. Pro Group, Inc.*, 809 F.2d 971, 1 USPQ 2d 2026 (2d Cir. 1987). Inherently distinctive trade dress is protectible even if it has not acquired secondary meaning. *Two Pesos, Inc.*, 112 S.Ct. 2753, 2760, 23 USPQ 2d 1091 (1992). Trade dress that is FUNCTIONAL is not protectible as a trademark.

trade dress infringement

T: Required elements ***.

trade name

T: “The terms ‘trade name’ and ‘commercial name’ mean any name used by a person to identify his or her business or vocation.” 15 USC 1127. Trade names include “individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturalists, and others to identify their businesses, vocations or occupations, the names or titles lawfully adopted and used by persons, firms, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.” TMEP 1210. Trade names per se are not registrable as trademarks. TMEP 1210. However, common law protection is available under section 43(a) of the Lanham Act.

trade secret

S: “A trade secret may consist of any formula, pattern, device or compilation of information which is used in one’s business and which gives him an opportunity to obtain an advantage over competitors who do not know or use it. It may be a formula for a chemical compound, a process of manufacturing, treating or preserving materials, a pattern for a machine or other device, or a list of customers.” Restatement of Torts 757. About half the states follow the Restatement definition; the others follow the Uniform Trade Secrets Act definition: “‘trade secret’ means information, including a formula, pattern, compilation, device, method, technique or process, that: (i) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.” UTSA 1(4).

Factors to be considered under the Restatement:

1. Extent to which the information is known outside of his business.
2. Extent to which it is known by employees and others in his business.
3. Extent of measures taken to guard secrecy.

4. Value of the information to him or his competitors.
5. Amount of effort and money expended to develop the information.
6. Ease or difficulty with which the information could be properly acquired or duplicated by others.

A trade secret is not immune to discovery by legitimate means:

1. Independent invention.
2. Reverse engineering.
3. Observation of product in public use.
4. Discovery by publicly available data.

Kewanee Oil Co. v. Bicron Corp., 416 US 470, 474, 181 USPQ 673, 676 (1974).

trademark

P: Use of trademark in a patent application.

T: “The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof —

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 USC 1127. Trademarks are used on goods, that is, physical commodities. TMEP 101. A mark for services is called a SERVICE MARK.

Trademarks “foster competition and the maintenance of quality by securing to the producer the benefits of a good reputation.” *Park 'N Fly v. Dollar Park and Fly, Inc.*, 469 US 189 (***) .

See also CERTIFICATION MARK, COLLECTIVE MARK, COLLECTIVE MEMBERSHIP MARK, DERIVATIVE MARK, DESIGN MARK, FRAGRANCE MARK, GRADE MARK, HOUSE MARK, INGREDIENT MARK, LETTER MARK, MULTI-PRODUCT MARK, NUMERAL MARK, PRODUCT MARK, SCENT MARK, SERVICE MARK, SINGLE MARK, SOUND MARK, STYLE MARK, THREE-DIMENSIONAL MARK, TITLE MARK, UNION LABEL, UNITARY MARK, WORD MARK.

Trademark Act

T: The LANHAM ACT, 15 USC 1051-1127, inclusive.

trademark application

T: A certificate of mailing is ineffective to establish a filing date for a trademark application. 37 CFR 1.8(a)(2)(ii). See also EXAMINATION, LANGUAGE. A trademark application must contain the following elements:

1. Name of applicant.
2. Citizenship of applicant.
3. Domicile and post office address.
4. In a section 1(a) application, a statement of use. In a section 1(b) application, a statement that the applicant has a bona fide intention to use the mark.
5. Goods or services on or in connection with which the mark is used or applicant has a bona fide intention to use.
6. Class of goods or services according to the official classification.

7. In a section 1(a) application, the date of first use as a trademark and the date of first use in commerce, specifying the nature of such commerce.
8. In a section 44(e) application, a certification of the trademark office of applicant's country of origin showing that the mark has been registered in such country.
9. Foreign priority information, if applicable.
10. More or intended mode of use.
11. Description of mark. 37 CFR 2.35
12. Identification of prior registrations. 37 CFR 2.36.
13. Authorization of a qualified person to represent applicant. 37 CFR 2.37.

trademark attorney

T:

Trademark Counterfeiting Act of 1984

T: Civil provisions: 15 USC 1116(d). Criminal provisions: "Whoever intentionally traffics or attempts to traffic in goods or services and knowingly uses a counterfeit mark on or in connection with such goods or services shall, if an individual, be fined not more than \$250,000 or imprisoned not more than five years, or both, and, if a person other than an individual, be fined not more than \$1,000,000. 18 USC 2320. The penalties are increased for a second offense.

Trademark Examining Operation

T: Abbreviated TMEQ.

trademark infringement

T: "(1) Any person who shall, without the consent of the registrant —

(A) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(B) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive;

shall be liable in a civil action by the registrant ..." 15 USC 1114.

"When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, or a violation of Section 43(a) shall have been established : the plaintiff shall be entitled ... subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the cost of the action ... The court in exceptional cases may award reasonable attorney fees to the prevailing party." 15 USC 1117.

Trademark infringement is a tort.

Trademark Law Revision Act

T: P.L. 100-667, effective November 16, 1989. Abbreviated TLRA. It is a defense to trademark infringement that "the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been

continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 7(c), (B) the registration of the mark under this Act if the application for registration is filed before the effective date of the Trademark Revision Act of 1988, or (C) publication of the registered mark under section 1062 of this title: *Provided, however*, That this defense or defect shall apply only for the area in which such continuous prior use is proved.” 15 USC 1115(b)(5).

Trademark Legal Administrator

T: A staff member of the Assistant Commissioner for Trademarks responsible for drafting PETITION decisions.

Trademark Manual of Examining Procedure

T: A publication issued by the PTO as a guide for trademark examining attorneys. Abbreviated TMEP. The Trademark Manual of Examining Procedure does not have the force of law, but represents the PTO’s opinion of what the law is. *In re Martin’s Famous Pastry Shoppe, Inc.*, 221 USPQ 364. *Cf.* TRADEMARK RULES OF PRACTICE.

trademark misuse

T:

trademark registration

T: Term: 10 years.

Trademark Rules of Practice

T: Regulations having the force of law promulgated by the Commissioner and codified at 37 CFR Part 2. Waiver [McC 21.05[4].]
Cf. TRADEMARK MANUAL OF EXAMINING PROCEDURE.

Trademark Status Line

T: A telephone number at the PTO, 703-305-8747, from which information about the status of registered marks and applications for registration may be obtained.

Trademark Trial and Appeal Board

T: “The Trademark Trial and Appeal Board shall include the Commissioner, the Deputy Commissioner, the Assistant Commissioners, and members, appointed by the Commissioner. Employees of the Patent and Trademark Office and other persons, all of whom shall be competent in trademark law, shall be eligible for appointment as members. Each case shall be heard by at least three members of the Board, the members hearing such a case to be designated by the Commissioner.” 15 USC 1067. The TTAB hears interferences, oppositions, concurrent use applications and petitions to cancel. 15 USC 1067. It also hears appeals from the decisions of examiners. 15 USC 1070. *** Appeal, Testimony, Rules ***

trademark use

T:

trademark-type use

T:

traffic

C: Within the meaning of the piracy statute, 18 USC 2318, “the term ‘traffic’ means to transport, transfer or otherwise dispose of, to another, as consideration for anything of value or to make or obtain control of with intent to so transport, transfer or dispose of ...” Trafficking in COUNTERFEIT LABELS is punishable by a fine of \$250,000 or not more than five years in prison, or both. 18 USC 2318(a).

T: As used in the Trademark Counterfeiting Act of 1984, “the term ‘traffic’ means transport, transfer, or otherwise dispose of, to another, as consideration for anything of value, or make or obtain control of with intent to so transport, transfer, or dispose of.” 18 USC 2320(d)(2).

transcript

P: In an INTERFERENCE, “a certified transcript filed in the PTO may be inspected by any party.” 37 CFR 1.679.

transfer

C: 1. To be enforceable, a transfer of rights in copyright must be in writing an signed by the conveyor. 17 USC 204(a).

2. “In the case of unpublished works, the Library is entitled ... to select any deposits ... for transfer to the National Archives of the United States or to a Federal records center, as defined in section 2901 of title 44.” 17 USC 704(b).

transfer of copyright

C: “A ‘transfer of copyright ownership’ is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.” 17 USC 101. A transfer of ownership of copies or phonorecords to the public is a PUBLICATION. 17 USC 101. See also EXPRESS TRANSFER, INVOLUNTARY TRANSFER, TERMINATION OF TRANSFER.

transfer of drawing

T: A procedure in which a drawing from an abandoned application is physically moved by the PTO for use in a new application. 37 CFR 2.26; TMEP 807.15.

transfer price

C: The “transfer price” of a DIGITAL AUDIO RECORDING DEVICE or a DIGITAL AUDIO RECORDING MEDIUM is defined in 17 USC 1001(12).

transgenic

P: Genetically transformed, usually by introduction of a gene from an animal other than parent at an early stage of development.

transitional phrase

P: Language separating the PREAMBLE from the BODY of a claim. COMPRISING, CONSISTING ESSENTIALLY OF, CONSISTING OF.

transitional provisions

C: e.g. 17 USC 914.

transitory

C: A work that can only be “perceived, reproduced or otherwise communicated” for a period of transitory duration is not “fixed.” 17 USC 101. It is thus is not the subject of copyright. 17 USC 102(a).

transitory compound

P: [Walker 5:8].

translation

P: The Commissioner may require a translation of a foreign application used a basis for an earlier filing date. 35 USC 119. See LANGUAGE.

C: A translation is one of the nine statutory classes of WORKS MADE FOR HIRE. 17 USC 101. It may also constitute a DERIVATIVE WORK. 17 USC 101. The right to make translations is one of the basic rights of an author under the Berne Convention.

2. “Where due to an incorrect translation the scope of a patent granted on an international application designating the United States, which was not originally filed in the English language, exceeds the scope of the international application in its original language, a court of competent jurisdiction may retroactively limit the scope of the patent.” 35 USC 375(b).

T: If a trademark consists of one or more foreign words, a translation is required so registrability can be determined. TMEP 906. Section 44 applications must include a translation of the foreign certificate of registration. TMEP 1008.

translator station

C: “A ‘translator station’ is, with respect to programs both originally transmitted and retransmitted by it, a primary transmitter for the purposes of this section.” 37 CFR 201.17(b)(7).

transmission

C: See also PRIMARY TRANSMISSION, SECONDARY TRANSMISSION.

Transmission Clause

C: The second clause of the definition of “publicly” in 17 USC 101, providing that a work is performed or displayed publicly if it is transmitted to the public. *Cf.* PUBLIC PLACE CLAUSE.

transmission program

C: “A body of material, that, as an aggregate, has been produced for the sole purpose of transmission to the public in a sequence and as a unit.” 17 USC 101, 37 CFR 202.22(a)(3).

transmit

C: Of a performance or display, “to communicate it by any device or process whereby images or sounds are received beyond the place from which they are sent.” 17 USC 101.

transmittal

P: The sending of an INTERNATIONAL APPLICATION to the INTERNATIONAL BUREAU by a RECEIVING OFFICE. 37 CFR 1.461.

transmittal fee

P: PCT 35 USC 361(d), 376(a)(1).

transposition of parts

P: [Walker 22:28].

traverse

P: To disagree in response to a REJECTION or REQUIREMENT. “A traverse of a requirement to restrict is a statement of the reasons upon which the applicant relies for his conclusion that the requirement is in error.” MPEP 818. Certain requirement must be traversed or objection to them is waived. After an initial traverse, the PTO should reconsider the matter traversed. MPEP 821.01.

Treasury of the United States

C: “All fees received under this section shall be deposited by the Register of Copyrights in the Treasury of the United States.” 17 USC 708(c).

treaties**treaty**

P: Within the patent statute, “treaty” refers to the Patent Cooperation Treaty done at Washington on June 19, 1970. 35 USC 351(a).

treble damages

P: “When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.” 35 USC 284.

T: “In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount.” 15 USC 1117(a). ** counterfeiting statute 15 USC 1117(b). Se also ATTORNEY’S FEES.

trial

P: In construing the Federal Rules of Evidence in an INTERFERENCE, trial means interference. 37 CFR 1.671(c)(4).

trial court

P: In construing the Federal Rules of Evidence in an INTERFERENCE, trial court means examiner-in-chief or Board as may be appropriate. 37 CFR 1.671(c)(1).

trial or hearing

P: In construing Federal Rules of Evidence 803(24) and 804(5) in an INTERFERENCE, trial or hearing means the taking of testimony by oral deposition. 37 CFR 1.671(c)(7).

trial proof

C: In printmaking, a PROOF that differs from those of the published edition. Abbreviated TP.

Tribunal

C: The COPYRIGHT ROYALTY TRIBUNAL. 37 CFR 301.1

trier of fact

P: In construing the Federal Rules of Evidence in an INTERFERENCE, trier of fact means examiner-in-chief or Board as may be appropriate. 37 CFR 1.671(c)(1).

trivial component

C: A product is not considered to be “made by a patented process” if it “becomes a trivial and nonessential component of another product.” 35 USC 271(g).

TRO

Abbreviation for the TEMPORARY RESTRAINING ORDER.

true copy

P: The applicant may omit signing the oath or declaration in a continuation or divisional application if a true copy of the prior complete application is filed. 37 CFR 1.60(b).

TTAB

T: The TRADEMARK TRIAL AND APPEAL BOARD.

tuber

P: Not patentable. 35 USC 161.

TVA

= TENNESSEE VALLEY AUTHORITY.

24 hour box

T: A set of boxes in the PTO holding copies of pending applications for interested parties to examine. TMEP 302.01***.

two-way distinctness

P: “In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.” MPEP 806.05(c). It must be shown that (1) the combination “does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (2) the subcombination can be shown to have utility either by itself or in other and different relations.” MPEP 806.05(c). See DISTINCT. *Cf.* ONE-WAY DISTINCTNESS.

tying

P: Antitrust. 35 USC 271. Tying is PATENT MISUSE only if the owner of the patent has MARKET POWER in the relevant market.

type of application

T: Refers to the form of an application for registration. combined or multiple class application, Principal Register, single or single class application, Supplemental Register. TMEP 201.

type of mark

T: certification mark, collective mark, service mark, trademark. TMEP 201.

typed drawing

T: A drawing that merely presents a mark using typewritten capital letters, most commonly used for WORD MARKS not written in STYLIZED fashion. TMEP 807. “If

the application is for the registration of only a word, letter or numeral, or any combination thereof, not depicted in special form, the drawing may be the mark typed in capital letters on paper.” 37 CFR 2.51(e). “A typed drawing may be used if it is not desired to show any special characteristic, such as design, style of lettering, color, diacritical marks or unusual forms of punctuation. TMEP 807.07. The only acceptable special symbols in a typed drawing are:

, ! ' : /) & # * = . ? " - ; (% \$ @ + [] TMEP 807.09, EG 1-92.

A typed drawing will not be accepted where the mark includes a design element that is essential to its commercial impression. *In re Dartmouth Marketing Co.*, 154 USPQ 557 (TTAB 1967). Cf. INK DRAWING, SPECIAL FORM DRAWING.

typeface design

C: Typefaces are not copyrightable as typefaces. 37 CFR 202.1(e). Computer programs to produce type images are copyrightable.

typographic ornamentation

C: “Mere variations of typographic ornamentation, lettering or coloring” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

typographical error

P: Correction. [Walker 12:65].

UCC

Uniform Commercial Code

C: = UNIVERSAL COPYRIGHT CONVENTION.

UCC work

C:

UDAP

Unfair deceptive acts and practices, prohibited in some states by LITTLE FTC acts.

ULA

Uniform laws.

ultimate consumer

T: The final purchaser of a product, not including any distributors or middlemen; generally, a member of the public rather than a member of the relevant industry.

ultimate species

P: A SPECIES that cannot be further divided into other species and thus cannot serve as a genus, such as particular molecules.

unaccepted

T: Papers or materials so defective that they cannot be accorded a FILING DATE. TMEP 410. Also INFORMAL.

unauthorized representation

A person not recognized to practice before the PTO who holds himself out to be so recognized, may be fined not more than \$1,000 for each offense. 35 USC 33.

unavoidable delay

P: An application must be prosecuted within six months of any action, or such shorter period, not less than 30 days, as fixed by the Commissioner, or the application will be abandoned, “unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.” 35 USC 133. At the international stage of a PCT application, the Commissioner may excuse a failure to act within the time prescribed, upon a showing of unavoidable delay. 35 USC 364(b). With respect to late payment of maintenance fees, see GRACE PERIOD. The Commissioner may accept a maintenance fee after the patent has expired if there has been unavoidable delay. 37 CFR 1.378(a). See also 37 CFR 1.155(b). See also REVIVAL. Cf. UNINTENTIONAL DELAY.

T: A reply to a refusal to register must be made within six months “unless it be shown to the satisfaction of the Commissioner that the delay in responding was unavoidable, whereupon such time may be extended.” 15 USC 1052(b). “Unavoidable” means that reasonable steps had been taken or precautionary systems were in operation which were designed to avoid the circumstances which caused the delay, but the delay occurred despite such precautions. Diligence is required in prosecution so there is no delay in filing a PETITION to revive. TMEP 1112.05(b).

unbased comparative

P: A adjective of degree for which no basis of comparison has been recited. For example, “a large valve.” A claim containing an unbased comparative may be rejected as INDEFINITE.

unclean hands

P:

C:

T: [McC 31.24].

unconscious infringement

C: Infringement in which the infringer has no memory of the original but had actual access to it. “Yet unconscious infringement is quite as much as deliberate.” *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54, 28 USPQ 330, 336 (2d Cir. 1936).

uncopyrightable

C: Not constituting COPYRIGHTABLE SUBJECT MATTER, e.g., blank forms, typeface designs.

uncultivated state

P: Plant unpatentable. 35 USC 161.

under refusal

T: The status of a pending trademark application containing an unanswered official action. TMEP 404. Also AWAITING RESPONSE.

under suspension

T: The status of a trademark application whose time for action by the Examining Attorney is delayed beyond the time it would have been due in the normal course. TMEP 405. See also SUSPENSION.

underline

P: Material to be inserted by amendment is to be indicated by underlining. Underline is used in the specification of a reissue. 37 CFR 1.173.

undue breadth

P: A claim is rejected on the ground of undue breadth when (1) the claim covers prior art; (2) the claim covers subject matter not part of the invention; or (3) the claim covers technology not within the enabling disclosure. “A single means claim, i.e. where a means recitation does not appear in combination with another recited element or means, is subject to an undue breadth rejection under 35 USC 112, first paragraph.” MPEP 706.03(z); *In re Hyatt*, 218 USPQ 195 (Fed. Cir. 1983). “In applications directed to inventions in arts where results are predictable, broad claims may properly be supported by the disclosure of a single species ... However, in applications directed to inventions in arts where results are unpredictable, the disclosure of a single species usually does not provide an adequate basis to support generic claims.” MPEP 706.03(z). This is because in arts such as chemistry it is not obvious from the disclosure of one species what other species will work.

undue experimentation

P: A DISCLOSURE is enabling if under its TEACHING “a person skilled in the art could make and use the invention without undue experimentation.” 182 USPQ 298.

undue multiplicity

P: Claims in a patent may not be “unduly multiplied.” 37 CFR 1.75(b). See MULTIPLICITY.

unexpected properties

P: See SECONDARY CONSIDERATIONS.

unexpected results

P: See SECONDARY CONSIDERATIONS. See *U.S. v. Adams*, 383 US 38, 148 USPQ 479 (1966).

unexpired patent

P:

unfair competition

T: One of the purposes of the Lanham Act is to protect persons engaged in commerce within the control of Congress against unfair competition.” 15 USC 1127.

unification of parts

P: [Walker 22:32].

Uniform Commercial Code

P:

Uniform Deceptive Trade Practices Act

U:

Uniform Trade Secrets Act

S: A model statute promulgated by the National Commissioners on Uniform State Laws. Versions of the Uniform Trade Secrets Act have been enacted in the following jurisdictions: Alabama, Alaska, California, Colorado, Connecticut, Delaware, District of Columbia, Florida, Hawaii, Illinois, Indiana, Kansas, Louisiana, Maine, Maryland, Minnesota, Montana, Nevada, New Hampshire, New Mexico, North Dakota, Oklahoma, Oregon, Rhode Island, South Dakota, Utah, Virginia, Washington, West Virginia, Wisconsin. Abbreviated UTSA.

unintended result

P: [Walker 4:9].

unintentional delay

P: “An application unintentionally abandoned for failure to prosecute ... may be revived as a pending application if the delay was unintentional.” 37 CFR 1.137(b). An unintentionally delayed payment of a patent maintenance fee may be accepted upon petition to the Commissioner. See also TERMINAL DISCLAIMER. Cf. UNAVOIDABLE DELAY.

unintentionally abandoned application

P: An unintentionally abandoned application for a patent may be revived upon petition to the Commissioner. 37 CFR 1.137(a).

unintroduced result

P: [Walker 4:9].

union

T: Certification that goods have been made or services are being provided by a union is one function of a CERTIFICATION MARK. 15 USC 1127. Membership in a union, association or other organization is denoted by a COLLECTIVE MARK. See also UNION LABEL.

union label

T: A certification mark owned by a labor union and used to certify that the goods to which it is applied were produced by members of the union. TMEP 1305.06.

unique product

T: A product that comprises its own GENUS. A mark used in connection with a unique product may be registered, notwithstanding the fact that the mark names the product. 15 USC 1127.

unique service

T: A service that comprises its own GENUS. A mark used in connection with a unique service may be registered, notwithstanding the fact that the mark names the service. 15 USC 1127.

unit of publication

C:

unit publication doctrine

C: Where a work is published as separate physical elements that are sold together as a grouping, COPYRIGHT NOTICE on one is sufficient as to all.

unitary expression

T: An expression written as a single word in a mark, e.g. "SCREENWIPE." A unitary expression, if disclaimed, must be disclaimed as a whole. *American Speech Language-Hearing Ass'n. v. National Hearing Aid Society*, 224 USPQ 798, 804 (TTAB 1984). See also COMPOUND WORD, TELESCOPED WORD.

unitary mark

T: A composite mark claimed as a whole. Also SINGLE MARK.

United Nations

C: Published works of the United Nations are copyrightable. 17 USC 104(b)(3).

United States

P: As used in the Patent Act, "United States" means "the United States of America, its territories and possessions." 35 USC 100(c), 37 CFR 1.601(p).

C: The "United States," when used in a geographical sense, comprises the several States, the District of Columbia and the Commonwealth of Puerto Rico, and the organized territories under the jurisdiction of the United States Government." 17 USC 101. A work first published in the United States is copyrightable. 17 USC 104(b)(2).

T: "The United States includes and embraces all territory which is under its jurisdiction and control." 15 USC 1127.

A mark may be refused registration on either the Principal or the Supplemental register if it "consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof." 15 USC 1052(b), 1091(a).

United States attorney

T: A registrant may not apply for a SEIZURE ORDER "unless the applicant has given such notice of the application as is reasonable under the circumstances to the United States attorney for the judicial district in which such order is sought." The U.S. attorney may participate in the proceedings "if such proceedings may affect evidence of an offense against the United States." 15 USC 1116(d)(2).

United States Claims Court

P: An inventor whose invention is subject to a secrecy order and who is dissatisfied with the compensation offered to him may bring suit in the United States Claims Court or the United States District Court for the district in which the claimant resides. 35 USC 183.

Determinations by a Federal agency to exercise MARCH-IN RIGHTS is reviewable by the United States Claims Court. 35 USC 203(2).

*** 35 USC 282.

United States Designated Office

P: PCT. Abbreviated DO/US.

United States District Court

P: An inventor whose invention is subject to a secrecy order and who is dissatisfied with the compensation offered to him may bring suit in the United States Claims Court or the United States District Court for the district in which the claimant resides. 35 USC 183.

T: Appeals. ***

United States Elected Office

P: PCT. Abbreviated EO/US.

United States Government work

C: A work of the United States Government is not subject to copyright protection, but the United States may hold title to works by assignment or bequest. 17 USC 105. A similar provision applies to MASK WORKS. 17 USC 903(d).

United States International Preliminary Examining Authority

P: PCT. Abbreviated IPEA/US.

United States International Searching Authority

P: PCT. Abbreviated ISA/US.

United States Magistrate

P: In construing the Federal Rules of Evidence in an INTERFERENCE, U.S. Magistrate means examiner-in-chief or Board as may be appropriate. 37 CFR 1.671(c)(1).

United States marshal

An officer charged with enforcement of orders of federal courts. *** See statute authorizing marshals.

T: A SEIZURE ORDER is carried out by a United States marshal. 15 USC 1116(d)(9).

United States Patents Quarterly

Abbreviated USPQ, or, in this dictionary, as just Q.

United States Receiving Office

P: PCT. “Only residents or nationals of the United States of America may file INTERNATIONAL APPLICATIONS in the United States Receiving Office.” 37 CFR 1.421(a). Abbreviated RO/US.

United States Trademark Association

T: Abbreviated USTA.

unity of invention

P: PCT. 35 USC 372(b)(2). 37 CFR 1.475(a). The components of a MARKUSH GROUP exhibit unity of invention if they “(1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.” MPEP 803.02. “The INTERNATIONAL APPLICATION shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (‘requirement of unity of invention’).” PCT Rule 13.1. In the U.S., a claim may not contain more than one distinct invention. 37 CFR 1.141.

Universal Copyright Convention

C: A work first published in a foreign nation that is a party to the Universal Copyright Convention is copyrightable. 17 USC 104(b)(2). Reciprocity. Notice : “Copyright” or ©, year, name of author.

University-Government Inventions Act

P: Allows certain non-profit organizations and small business concerns to retain title to federally funded inventions. 35 USC 200 *et seq.* (Public Law 96-512, Dec. 12, 1980; amended by Public Law 98-620, Nov. 8, 1984).

unjust enrichment

S: A party whose trade secret has been misappropriated may recover the misappropriator’s unjust enrichment. UTSA 3(a).

unlawful use

C: Copyright protection for material in a compilation or derivative work “does not extend to any part of the work in which such material has been used unlawfully.” 17 USC 103(a).

unlimited rights

In the context of Government procurement, “the right of the Government to use, disclose, reproduce, prepare derivative works, distribute copies to the public, and perform publicly and display publicly, in any manner and for any purpose, and to have or permit others to do so.” 48 CFR 52.227-14(a). *Cf.* LIMITED RIGHTS.

unpatentable

P:

unpredictability

P: If the claimed result of a process is unpredictable because the claim is so broad as to cover poorly understood organisms or compounds, rejection is proper. *In re Vaeck*, 20 USPQ 2d 1438 (Fed. Cir. 1991).

unpublished decision

T: Citation of “unpublished” or “digest” decisions is not allowed and will be ignored, unless the citation is used to assert “claim preclusion, issue preclusion, judicial estoppel or law of the case or the like.” EG 1-92.

unpublished work

C: A work is unpublished if it is not PUBLISHED. Copyright in unpublished works may be protected without regard to the nationality or domicile of the author. 17 USC 104(a). Unpublished works receive greater protection than published works. “[T]he author’s right to control the first public appearance of his expression weighs against ... use of the work before its release.” *Harper*, 471 US 539, 564.

See also REPRODUCTION, TRANSFER.

Works first published outside the U.S. registered under 17 USC 408 before publication in the U.S. are exempt from DEPOSIT requirements. 37 CFR 202.19(c)(10)(i).

unrecognized result

P: [Walker 4:9].

unregistered mark

T: A trademark that is not the subject of a current federal registration.

unregistrable

T: Said of a trademark for which a registration cannot be obtained.

unserved household

C: A household is “unserved” with respect to a particular television network if it (A) cannot receive through the use of a conventional outdoor rooftop receiving antenna, an over-the-air signal of grade B intensity (as defined by the Federal Communications Commission) of a primary network stations affiliated with that network, and (B) has not, within 90 days before the date on which that household subscribes, either initially or on renewal, to receive secondary transmissions by a satellite carrier of a network station affiliated with that network, subscribed to a cable system that provides the signal of a primary network station affiliated with that network.” 17 USC 119(d)(9).

unstable compound

P: [Walker 5:8].

until public disclosure injunction

S: A injunction against use or disclosure of a trade secret until it has been disclosed publicly. *Conmar Products Corp. v. Universal Slide Fastener Co.*, 172 F2 150.

UPOV Convention

P: Plant [Walker 17:25].

U.S. class

T:

U.S. Magistrate

See UNITED STATES MAGISTRATE.

use

P:

T: A mark is “used” when goods bearing the mark are first sold or transported or a service in connection to which the mark is applied is rendered. TMEP 806.01. In a trademark application, except an intent-to-use application, use must be alleged, even if the application is based on Section 44. See also ADD-ON USE, ANALOGOUS USE, BAD FAITH USE, BONA FIDE USE, CONTINUOUS PRIOR USE, CONTINUOUS USE, DE MINIMIS, EXCLUSIVE USE, PRE-SALES ACTIVITY, PRIOR USE, SUBSTANTIALLY EXCLUSIVE AND CONTINUOUS USE, TACKING.

use in commerce

T: “The term “use in commerce” means bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce —

(1) on goods when —

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods

makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and
 (2) on services when it is used or displayed in the sale or advertising of services or advertising of services and the services are rendered in commerce, or the services are rendered in more than one state or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.” For purposes of the foregoing, “commerce” means all commerce which may lawfully be regulated by Congress. 15 USC 1127.

Use in commerce need not be alleged in a Section 44 application. TMEP 1005.01. See also COMPLIANCE WITH STATUTE.

useful

P:

useful article

C: An “article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article’.” 17 USC 101. Only those aspects of the appearance of a useful article that are separable from its utilitarian function are subject to copyright. *** QUOTE 17 USC 113.

The year date may be omitted from the copyright notice on a pictorial, graphic or sculptural work as reproduced on a useful article. 17 USC 401(b)(2).

useful arts

Const. Art. I, Sec. 8, Cl. 8.

user interface

C: The set of displays and input/output mechanisms by which a user interacts with a computer. User interfaces are the subject of copyright. ***, 886 F.2d 1173, 12 USPQ 2d 1566.

USPQ

= UNITED STATES PATENTS QUARTERLY.

USTA

= UNITED STATES TRADEMARK ASSOCIATION.

utilitarian

T: *Cf.* FUNCTIONAL.

utilitarian function

C: An article having an “intrinsic utilitarian function” is a USEFUL ARTICLE. 17 USC 101.

utilitarian functionality

T:

utility

P: The requirement of 35 USC 101 that an invention must be “useful” to be entitled to patent. For rejections for lack of utility, see fraudulent, frivolous, inoperable, perpetual

motion. A rejection based on lack of utility can be TRAVERSED by AFFIDAVIT. 37 CFR 1.132. It is the examiner's burden to produce evidence supporting a rejection for lack of utility. *In re Langer*, 183 USPQ 288 (CCPA 1974).

"Utility under 35 USC 101 is a QUESTION OF FACT." *Newman v. Quigg*, 877 F.2d 1575, 11 USPQ 2d 1340 (Fed. Cir. 1989).

C: Utility is not a prerequisite to copyrightability.

utility model

P: 35 USC 184. Not U.S. Movable three-dimensional art of a definite shape. Short protest. See also PARIS CONVENTION.

utility patent

Cf. DESIGN PATENT, PLANT PATENT.

UTSA

S: The Uniform Trade Secrets Act.

vacate

T: A filing date erroneously accorded by the PTO may be "vacated." TMEP 708.01. See also CANCELLATION.

vague and indefinite

P: One must be able to determine what a patent claim covers and what it does not cover. 35 USC 112 requires that application must contain one or more claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." A claim that does not meet this standard may be rejected as "vague and indefinite."

validity

P: Patents are presumed valid. Validity is a QUESTION OF LAW. Clear and convincing evidence. "In determining validity, a claim must be construed to uphold its validity if possible." *Lewman Marine Inc. v. Barient Inc.*, 827 F.2d 744, 3 USPQ 2d 1766 (Fed. Cir. 1987). See also WARRANTY OF VALIDITY.

Design patents are also presumed valid. 35 USC 282; *Roper Corp. v. Litton Systems, Inc.*, 757 F.2d 1266, 225 USPQ 345 (Fed. Cir. 1985).

T: "Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark ..." 15 USC 1115(a). "To the extent that the right to use the registered mark has become incontestable under section 15, the registration shall be conclusive evidence of the validity of the registered mark ..." 15 USC 1115(b).

validity opinion

P:

valuable consideration

T: See also RECORDATION.

valuable service

Agents, attorneys and other persons representing applicants before the PTO must be qualified to render “valuable service” to such applicants. 35 USC 31.

value

C: The effect of a use on the value of a copyrighted work is evaluated in determining whether the use is fair. 17 USC 107.

S: To constitute a trade secret, information must have value to its owner. *Reinforced Molding Corp. v. General Electric Co.*, 592 F.Supp. 1083 (***)

variation

C: “Mere variations of typographic ornamentation, lettering or coloring” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

vehicle

P: See TEMPORARY PRESENCE.

venue

P: “Any civil action for patent infringement may be brought in the judicial district where the defendant resides or where the defendant has committed acts of infringement and has a REGULAR AND ESTABLISHED PLACE OF BUSINESS.” 28 USC 1400(b).

The patent venue statute, 28 USC 1400(b), has been held to have been modified by the 1988 amendments. A corporate defendant resides in any judicial district in which it is doing business. *VG Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1576, 6 USPQ 2d 1614 (Fed. Cir. 1990).

C: Under 28 USC 1400(a), an action for infringement of copyright and mask works may be brought where “defendant or his agent resides or may be found.”

T: 1. There is no specific federal venue statute for trademark actions.

2. The place of signing a verification. TMEP 803.01(a).

verification

C: See also SERIAL COPYING. 17 USC 1002(b).

T: A statement attesting to the truth of facts set forth in a document. TMEP 803.01. A trademark application must be verified by the applicant or by a member of the firm or an officer of the corporation or association applying. 15 USC 1051(a)(1)(A). “A verification or declaration, which is signed by a person having COLOR OF AUTHORITY to sign, is acceptable for the purpose of determining the timely filing of the paper.” 37 CFR 2.72(c).

Statement of use. 15 USC 1051(d)(1). See ACKNOWLEDGMENT.

verified complaint

A complaint whose averments of fact are accompanied by a DECLARATION.

T: A verified complaint or affidavit is required when applying for a SEIZURE ORDER. 15 USC 1116(d).

verified statement

T: A VERIFICATION. 37 CFR 2.76(b).

version

C: Each version of a work is a separate work for purposes of copyright. 17 USC 101.

vertical restraint

T: [McC 31.32].

vessel

P: See TEMPORARY PRESENCE.

Veterans of World War II

P: patent term extension. [Walker Appx 49].

veterinary biological product

P: A veterinary biological product subject to regulatory review may be eligible for a PATENT TERM EXTENSION. 35 USC 156(a)(5)(C).

271(e)(1). Exception to the rule that it is not infringement to use invention for submission of drug information. Defined in Federal Food, Drug and Cosmetic Act.

vicarious liability

C: Test.

A corporate officer may be vicariously liable for copyright infringement if the officer (1) has a financial stake in the activity; and (2) has the ability and right to supervise the activity causing infringement. *Fermata*, 712 F.Supp. 1257.

violating matter

T: As used in Section 32 of the Trademark Act, 15 USC 1114, “the term ‘violating matter’ means matter that is the subject of a violation under section 43(a).” See INJUNCTION, TRADEMARK INFRINGEMENT.

violator

T: As used in Section 32 of the Trademark Act, 15 USC 1114, “the term ‘violator’ means a person who violates section 43(a).” See INJUNCTION, TRADEMARK INFRINGEMENT.

Virgin Islands

T: See 48 USC 1405(q), 1574(c), 1643.

Virus-Serum-Toxin Act

P: The statute 21 USC 151-158. 35 USC 156(d)(2)(A)(i), 35 USC 156(f)(2)(B). See PATENT TERM EXTENSION.

visibility rule

P: [Walker 16:14].

visual art

C: See WORK OF VISUAL ART.

visual art multiple

C: Includes “prints, photographs (positive or negative) and similar art objects produce in more than one copy and sold, offered for sale or consigned in, into or from this state for an amount in excess of one hundred dollars, exclusive of any frame.” *** NY Artist’s Law.

Visual Artists Rights Act of 1990

C: A portion of the Copyright Act defining a WORK OF VISUAL ART and providing for the moral rights of ATTRIBUTION and INTEGRITY.

Visual Arts Registry

C: A registry in the Copyright Office, maintained pursuant to 17 USC 113(d)(3), of information concerning works of visual art incorporated in or made part of a building. See also VISUAL ARTS REGISTRY STATEMENT.

Visual Arts Registry Statement

C: The statement provided by 17 USC 113(d)(3) by which visual artists, owners of buildings and their duly authorized representatives may record their interests in WORKS OF VISUAL ART to “establish a public record of information relevant to an artist’s integrity right to prevent destruction or injury to works of visual art incorporated in or made part of a building.” 37 CFR 201.25(a).

void

T: A trademark application is “void” if the applicant did not have a right to apply on the assigned filing date. TMEP 705.02.

voluntarily distributed

C: A “PHONORECORD is considered ‘voluntarily distributed’ if the compulsory licensee has voluntarily and PERMANENTLY PARTED WITH POSSESSION of the phonorecord.” 37 CFR 201.19(a)(5).

voluntary arbitration

See ARBITRATION.

voluntary disclaimer

T: “An applicant may voluntarily disclaim a component of a mark sought to be registered.” 15 USC 1056(a).

vouching in

“(3) Where a tender has been accepted

- (a) the buyer must within a reasonable time after he discovers or should have discovered any breach notify the seller of breach or be barred from any remedy; and
- (b) if the claim is one for infringement or the like (subsection (3) of Section 2-312) and the buyer is sued as a result of such a breach he must so notify the seller within a reasonable time after he receives notice of the litigation or be barred from any remedy over for liability established by the litigation.”

“(5) Where the buyer is sued for breach of a warranty or other obligation for which his seller is answerable over

- (a) he may give his seller written notice of the litigation. If the notice states that the seller may come in and defend and that if the seller does not do so he will be bound in any action against him by his buyer by any determination of fact common to the two litigations,

then unless the seller after reasonable receipt of the notice does come in and defend he is so bound.” UCC 2-607

waiver

P: The inventor waives a right to a patent by causing publication of a statutory invention registration. 37 CFR 1.106(e).

T: Of rules. 37 CFR 2.146(a)(5) and 2.148 permit the Commissioner to waive any provision of the Rules of Practice which (1) is not a provision of statute; (2) is required by justice; and (3) injures no other party.

waiver of secrecy

P: Filing a FILE WRAPPER CONTINUATION is construed as a waiver of secrecy by the applicant under 35 USC 122*** to the extent that any member of the public who is entitled to access either the prior application or any continuing *** application must be given access to the file wrapper. 37 CFR 1.62(f).

Walker Process counterclaim

P: An antitrust counterclaim arising out of institution of a patent infringement action based on a patent fraudulently obtained, as in *Walker Process Equipment, Inc. v. Food Machine Chem. Co.*, 382 US 172, 147 USPQ 404 (1965).

war

P: A secrecy order issued while the United States is at war remains in effect for the duration of hostilities and for a period of one year following cessation of hostilities. 35 USC 181.

warehousing

T: The practice of obtaining rights to trademarks that one is not actually using.

warning

C: A library or archives ordering copies or phonorecords from another library or archives under 17 USC 108(d)(2) must include on its ORDER FORM a warning prescribed by the Register of Copyrights. The warning must also be displayed “prominently, at the place where orders are accepted.”

Warning of Copyright for Software Rental

C: A notice under 17 USC 109(b)(2)(4) that is required to be “affixed to the packaging that contains the computer program which is lent by a nonprofit LIBRARY for nonprofit purposes.” 37 CFR 201.24(a). The notice must be in the verbatim form published in CFR and “shall be printed in such manner as to be clearly legible, comprehensible, and readily apparent to a casual user of the computer program.” 37 CFR 201.24(c).

warranty

warranty of non-infringement

In sales under the Uniform Commercial Code, “Unless otherwise agreed a seller who is a merchant regularly dealing in goods of the kind warrants that the goods shall be delivered free of the rightful claim of any third person by way of infringement or the like ...” UCC 2-312(3).

P:
C:
T:

warranty of uniqueness

C: The number of a limited edition print, for example, “32/100,” constitutes a warranty that there is only one print numbered 32 and that only 100 prints were pulled.

warranty of validity

P: implied [Walker 19:24].

watch service

T: An organization that provides “watches” for trademark applications and registrations that may conflict with the mark being watched. See also CLIPPING SERVICE.

weak mark

T: “A mark is relatively weak if it is suggestive and when it is one of only a few terms which communicates a particular impression.” *Taj Mahal Enterprises, Ltd. v. Trump*, 15 USPQ 2d 1641. See also THIRD-PARTY REGISTRATION. Cf. STRONG MARK.

weapons

P: The right of a non-profit organization or small business firm to retain title to an invention made under a funding agreement to operate a Government-owned facility primarily dedicated to the Department of Energy’s weapons propulsion program may be restricted under 35 USC 202(a). See also NAVAL NUCLEAR PROPULSION.

well known

P: “Things believed to be known to those skilled in the art are often asserted by the examiner to be ‘well known’ or ‘matters of common knowledge’ ... If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient to so state.” MPEP 706.02(a).

whereby clause

P: A statement in a claim of a function of an apparatus or a result of a process. Such clauses are acceptable where they describe a result that necessarily follows from the claimed structure. “Whereby” itself does not define any structure and cannot serve to distinguish. MPEP 706.103(c). See FUNCTIONAL. [Walker 11:11].

White doctrine

P: See EX PARTE WHITE DOCTRINE.

widow, widower

C: An “author’s ‘widow’ or ‘widower’ is the author’s surviving spouse under the laws of the author’s domicile at the time of his or her death, whether or not the spouse has later remarried.” 17 USC 101. See also RENEWAL CLAIMANT.

T: The widow of a deceased President of the United States, during her lifetime, must consent before a registration will issue for a mark consisting of or comprising a name, portrait or signature identifying the deceased President. 15 USC 1052(c), 1091(a).

will

C: Ownership of copyright may be bequeathed by will. 17 USC 201(d)(1).

willful and malicious

S: If misappropriation of a trade secret has been “willful and malicious,” exemplary damages up to twice the amount of the original award may be assessed. UTSA 3(b).

willful infringement

P: Knowledge of the patent plus failure to obtain an opinion of counsel as to non-infringement or validity. *Avia Group Int’l. Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557. The standard for willful infringement is whether “under all the circumstances, a REASONABLY PRUDENT PERSON would conduct himself with any confidence that a court might hold the patent invalid or not infringed.” 24 USPQ 2d 1231, 1339. Willful infringement must be shown by CLEAR AND CONVINCING EVIDENCE. *E. I. DuPont de Nemours v. Phillips Petroleum Co.*, 849 F.2d 1430.

When infringement is shown to be willful, the court may treble any damages. *Rosemont, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 221 USPQ 1 (Fed. Cir. 1984). Willful infringement may make a case EXCEPTIONAL under 35 USC 285 and entitle the plaintiff to attorney’s fees. *Bott v. Four Star Corp.*, 807 F.2d 1567, 1 USPQ 2d 1210 (Fed. Cir. 1986).

C: Infringement is willful if defendant had no reasonable basis for believing its conduct was legal, had actual knowledge or acted in reckless disregard of the copyright owner’s rights. *Fallaci v. New Gazette Literary Corp.*, 568 F.Supp. 1172 (S.D.N.Y. 1983). If infringement is willful, STATUTORY DAMAGES up to \$100,000 may be recovered for each work infringed. 17 USC 504(c)(1). Infringement must be willful to constitute CRIMINAL INFRINGEMENT.

T: Willful infringement can be used to show LIKELIHOOD OF CONFUSION. Willful infringement may make a case EXCEPTIONAL for purposes of awarding attorney’s fees. Infringement must be willful to entitle the plaintiff to an accounting for profits.

willing licensor-willing licensee rule

P: A principle for determining a REASONABLE ROYALTY to be awarded a patentee as damages for infringement. The royalty is calculated to be the amount a willing licensor and willing licensee would reach at a time just before commencement of the infringement. *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F.Supp. 1116 (***)

Wilson Tariff Act

P: [Walker 28:7].

WIPO

The World Intellectual Property Organization.

withdrawal

P: A requirement for a statutory invention registration may be withdrawn prior to date of notice of intent to publish. 37 CFR 1.296.

An application may be withdrawn from issue after allowance upon petition by the applicant for “good and sufficient reasons why withdrawal is necessary.” 37 CFR 1.313(a). When the issue fee has been paid, no withdrawal except (1) mistake by PTO; or (2) violation of the duty of disclosure or illegality in application; or (3) unpatentability of one or more claims; or (4) an interference. 37 CFR 1.313(b).

A claim is withdrawn when it is present in a group not elected by the applicant. *Cf.* CANCELLATION.

A rejection may be withdrawn by the examiner. MPEP 706.07(d).

In an INTERFERENCE, “[no] attorney or agent of record may withdraw as attorney or agent of record except with the approval of an examiner-in-chief and after reasonable notice to the party on whose behalf the attorney or agent has appeared.” 37 CFR 1.613(d).

C: The MORAL RIGHT, not recognized in the U.S., to remove, modify or disavow a work after publication.

T: 1. “An application may be expressly abandoned by filing in the PTO a written statement of abandonment or withdrawal of the application ...” 37 CFR 2.68. See also EXPRESS ABANDONMENT.

2. “An individual authorized to represent an applicant or party on a trademark case may withdraw upon application to and approval by the Commissioner. 37 CFR 2.19(b). On cases before the TTAB, proceedings will be suspended for a reasonable time to permit a party to obtain new counsel.

Withdrawal from appeal. TMEP 1502.03.

within the scope of employment

C: See WORK MADE FOR HIRE.

without notice

T: See also RECORDATION.

word

C: “Words and short phrases such as names, titles and slogans” are “not subject to copyright and applications for registration of such works cannot be entertained.” 37 CFR 202.1(a).

T: A “word” may serve as a trademark. 15 USC 1127. See WORD MARK.

word mark

T: A trademark consisting of words only, without graphics. TMEP 807.09. *Cf.* DESIGN MARK, LETTER MARK, NUMERAL MARK.

work

C: A “work” usually refers to a WORK OF AUTHORSHIP. See also VERSION.

work for hire

C: An informal phrase for WORK MADE FOR HIRE.

work made for hire

C: (1) A “work prepared by an employee within the scope of his or her employment; or (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.” 17 USC 101. A work made for hire cannot constitute a WORK OF VISUAL ART. 17 USC 101. The author of a work made for hire is the “employer or other person for whom the work was

prepared” “unless the parties have expressly agreed otherwise in a written instrument signed by them.” 17 USC 201(b).

The duration of copyright in a work made for hire is 75 years from first publication or 100 years from creation, whichever expires first. 17 USC 302(c).

Renewal rights, 17 USC 304(a); importation 17 USC 601(b)(1).

work of authorship

C: A work including a LITERARY WORK, MUSICAL WORK, DRAMATIC WORK, PANTOMIME, CHOREOGRAPHIC WORK, PICTORIAL WORK, GRAPHIC WORK, SCULPTURAL WORK, MOTION PICTURE, other AUDIOVISUAL WORK, or a SOUND RECORDING. 17 USC 101.

work of the fine arts

C: One of the types of works protected by Copyright Act of July 8, 1870. See also STATUTORY.

work of the performing arts

C: One of the four classes of works in which copyright may be claimed, comprising “all published and unpublished works prepared for the purpose of being performed directly before an audience or indirectly by means of a device or process.”. 37 CFR 202.3(b)(1)(ii). These works are registered on Form PA.

work of the United States Government

C: A “work prepared by an officer or employee of the United States Government as part of that person’s official duties.” 17 USC 101.

work of the visual arts

C: One of the four classes of works in which copyright may be claimed, comprising “all published and unpublished pictorial, graphic and sculptural works.” 37 CFR 202.3(b)(1)(iii). These works are registered on Form VA. *Cf.* WORK OF VISUAL ART.

work of visual art

C: A ‘work of visual art’ is — (1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculpture of two hundred or fewer that are consecutively numbered and bear the signature or other identifying mark of the author; or (2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include — (A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication; (ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container; (B) any work made for hire; or (C) any work not subject to copyright protection under this title.” 17 USC 101. Works of visual art are protected by the rights of ATTRIBUTION and INTEGRITY. 17 USC 106A. *Cf.* WORK OF THE VISUAL ARTS.

workpiece

P:

World Intellectual Property Organization

An agency of the United Nations that administers the Berne Convention. Abbreviated WIPO.

wrapper

T: It is TRADEMARK INFRINGEMENT to apply a reproduction of a registered mark to a wrapper intended to be used in commerce where such use is likely to cause confusion, or to cause mistake, or to deceive. 15 USC 1114(1)(B). Wrappers bearing an infringement of a mark may be ordered destroyed by the court. 15 USC 1118. See also DESTRUCTION.

writ of mandamus

P:

writ of prohibition

P:

writ of seizure

C: An ex parte order issued by a U.S. district court directing the U.S. marshal to seize infringing materials. The Rules of the Supreme Court permit this procedure in copyright cases upon filing an affidavit and bond. *Duchess Music Corp. v. Stern*, 458 F.2d 1305 (9th Cir. 1972); Rules of Practice as Amended, 17 USCA Foll. §501. See also POST-SEIZURE HEARING.

writer

C: With respect to DIGITAL AUDIO RECORDING MEDIA, a writer is “the composer or lyricist of a particular musical work.” 17 USC 1001(13).

writing

P: an instrument in writing is required to transfer an interest in a patent. Agreements between parties to an interference. 35 USC 135(c).

“All business with the Patent and Trademark Office should be transacted in writing.” 37 CFR 1.2.

C: A tangible form of intellectual expression. Congress has the power to grant, for limited times, exclusive rights to “writings and discoveries.” Const. Art I, Sec. 8, Cl. 8.

T: An instrument in writing is required to assign a trademark. 15 USC 1060.

written agreement

C: Required to have work made for hire, transfer of ownership.

written assent

P: The “written assent” of all assignees must accompany a reissue application. 37 CFR 1.172(a).

written authority

P: For member of public to access a patent application. 37 CFR 1.14(e).

written description

P: “The specification shall contain a WRITTEN DESCRIPTION of the invention ...” 35 USC 112.

written description test

P: *Hoechst Celanese Corp. v. BP Chemicals Ltd.*, 47 PCTJ (BNA) 447 (S.D. Tex. No. G-92-499).

written instrument

C: A “written instrument” signed by the parties is required to designate a WORK MADE FOR HIRE. 17 USC 101.

year date

C: A date consisting only of a specific year. For example, the date in a notice of copyright need only give the year of first publication. The “year in which the creation of this work was completed” in an application for registration, means “the latest year in which the creation of any copyrightable element was completed.” 37 CFR 202.3(b)(3)(B)(ii).

Parties to the Berne Convention

Argentina
Australia
Austria
Bahamas
Barbados
Belgium
Benin
Brazil
Bulgaria
Burkina Faso
Cameroon
Canada
Central African Republic
Chad
Chile
Colombia
Congo
Costa Rica
Côte D'Ivoire
Cyprus
Czechoslovakia
Denmark
Egypt
Fiji
Finland
France
Gabon
Germany
Greece
Guinea
Holy See
Hungary
Iceland
India
Ireland
Israel
Italy
Japan
Lebanon
Liberia
Libya
Liechtenstein
Luxembourg

Madagascar
Mali
Malta
Mauritania
Mexico
Monaco
Morocco
Netherlands
New Zealand
Niger
Norway
Pakistan
Peru
Philippines
Poland
Portugal
Romania
Rwanda
Senegal
South Africa
Spain
Sri Lanka
Suriname
Sweden
Switzerland
Thailand
Togo
Trinidad and Tobago
Tunisia
Turkey
United Kingdom
United States of America
Uruguay
Venezuela
Yugoslavia
Zaire
Zimbabwe

Foreign Juristic Entities

A.G.

(Ger.) = Aktiengesellschaft

Aktiengesellschaft

(Ger.) Joint stock company. The officers are usually identified as Manager or Director. Abbreviated A.G.

C.C.C.

(Brit.) = CWMNI & CYFINGEDIG CYHOEDDUS.

Cwmni & Cyfingedig Cyhoeddus

(Brit.) = Welsh equivalent of a PUBLIC LIMITED COMPANY.

Firma

(Ger.) Company.

G.m.b.H.

(Ger.) = GESELLSCHAFT MIT BESCHRANKTER HAFTUNG.

Gesellschaft mit beschränkter Haftung

(Ger.) A joint stock company with limited liability. The officers are usually designated as Manager. Abbreviated G.M.B.H.

K.G.

(Ger.) = KOMMANDITGESELLSCHAFT.

Kommanditgesellschaft

(Ger.) A partnership that survives even though the partners might change. Abbreviated K.G.

O.H.G.

(Ger.) = OFFENE HANDELSGESELLSCHAFT.

Offene Handelsgesellschaft

(Ger.) A type of German partnership. Abbreviated O.H.G.

P.l.c.

(Brit.) = PUBLIC LIMITED COMPANY.

Public limited company

(Brit.) Abbreviated P.L.C.

s.a.

(Fr.) = SOCIÉTÉ ANONYME.

(Sp.) = SOCIEDAD ANONIMA.

s.a.r.l.

(Fr.) = SOCIÉTÉ À RESPONSABILITÉ LIMITÉE.

(Ital.) = SOCIETÀ A RESPONSABILITÀ LIMITATA.

Sociedad anonima

(Sp.) Joint stock company similar to an American corporation.

Sociedad de responsabilidad limitada

(Sp.) Limited liability joint stock company.

Sociedad regular colectiva

(Sp.) Regular collective company similar to an American partnership.

Società a responsabilità limitata

(Ital.) Equivalent of a joint stock company. Abbreviated S.A.R.L.

Società cooperative

(Ital.) A cooperative society.

Società in nome collettivo

(Ital.) A general partnership whose members have unlimited liability.

Società per azioni

(Ital.) Analogous to an American corporation.

Società semplice

(Ital.) A simple partnership whose existence need not be made public.

Société à responsabilité limitée

(Fr.) A limited liability company similar to small, closely-held American corporation. Abbreviated S.A.R.L.

Société anonyme

(Fr.) A joint stock company similar to an American corporation. Abbreviated S.A.

Société en commandité par actions

(Fr.) A special partnership by shares. Logically between a société en commandité simple and a société anonyme.

Société en commandité simple

(Fr.) A special partnership similar to an American limited partnership.

Société en nom collectif

(Fr.) A general partnership having unlimited liability.

s.p.a.

(Ital.) = SOCIETÀ PER AZIONI.

Stiftung

(Ger.) A foundation governed by a Board of Management. Two of the members must be a Mandatory and Deputy Mandatory.

Significant Dates

March 3, 1881	15 USC 1052, 1062, 1064, 1115, 1127.
February 20, 1905	15 USC 1052, 1062, 1065, 1067, 1115, 1127.
August 20, 1910	17 USC 1091.
June 15, 1916	36 USC 27.
March 19, 1920	15 USC 1091, 15 USC 1095, 1096, 1126, 1127.
June 20, 1936	22 USC 248.
July 5, 1947	15 USC 1052.
September 21, 1950	15 USC 1116
February 15, 1972	Copyright protection for SOUND RECORDINGS effective. 17 USC 115, 17 USC 301.
April 15, 1976	17 USC 801.
December 31, 1976	17 USC 304.
December 31, 1977	17 USC 118(b)(4), 17 USC 304.
January 1, 1978	Effective date of Copyright Act, 17 USC 101 <i>et seq.</i> 17 USC 203, 301, 304, 701.
January 3, 1978	17 USC 114.
January 1, 1980	17 USC 804.
January 3, 1980	17 USC 118(e)
December 1, 1981	37 CFR 201.20 regulations for copyright notice became effective.
January 1, 1982	21 USC 355(c)(3)(D)(i).
June 30, 1982	17 USC 118(c).
December 31, 1982	17 USC 118.
July 1, 1983	17 USC 913.
September 24, 1984	21 USC 355(c)(3)(D)(i)
July 1, 1985	17 USC 913.
January 1, 1986	17 USC 912.
March 1, 1989	Effective date of BERNE CONVENTION IMPLEMENTATION ACT.
November 16, 1989	Reduction in trademark registration duration to 10 years from 20.
July 1, 1991	17 USC 119(c).
December 31, 1992	17 USC 119(c)
July 1, 1994	17 USC 914(f).
December 31, 1994	17 USC 119(c).
June 8, 1995	Effective date of GATT amendments creating patent term of 20 years from filing.
July 1, 1995	17 USC 914.
January 1, 1996	
December 31, 2002	17 USC 303.
December 31, 2027	17 USC 303.
February 15, 2047	Federal and state protection ends for pre-1972 SOUND RECORDINGS. 17 USC 301(c).

Topics

In re Pleuddemann, 910 F.2d 823 (Fed. Cir. 1990).

Allen's Trademark Digest

Oct 10, 1990

Bacal et al., Trademark Administration: A Guide for Paralegals, Administrators and Attorneys, New York: USTA (1990)

Crawford, Ted. Legal Guide for the Visual Artist. New York: Madison Square Press (1977)

Dunner. CAFC: Practice and Procedure.

Epstein, Michael A. Modern Intellectual Property.

Henn, Harry G. Copyright Law: A Practitioner's Guide — Summary of the Berne Convention Implementation Act of 1988. PLI G7-1012 (1989).

HTLJ High Technology Law Journal.

Missing

35 USC 202.

Completed

15 USC 1051-1123, 1127

17 USC 101-107,***, 201-202, 701-705, 1001-1002

35 USC -> 291, 351-364, 372-376.

42 USC 2014

37 CFR 1.1-1.198, 1.248-1.456.

37 CFR 1.601-1.710, 1.801.

37 CFR 2.1-2.98, 2.153-2.158.

37 CFR 7

37 CFR 201.4-201.8, 201.17(a)-(e), 201.19, 201.22, 202.1

37 CFR 202.17-18, 202.19(b)(2)-(c)(4), 202.20-26

37 CFR 401.1-401.2

37 CFR 501-501.10

MPEP 700-710.02(b), 711

800 ALL

TMEP

Epstein, Modern Intellectual Property 1-370 (unfinished).