

EXHIBIT 5

Practising Law Institute
Faber on Mechanics of Patent Claim Drafting

John D. Kaufmann and Robert C. Faber

Copyright (c) 2010 by the Practising Law Institute

Current through Release 2, November 2009

Appendix

***D-1 Appendix D Glossary and Index of Patent Terms**

A/AN--(1) In a claim, the indefinite article A or AN connotes “one or more.” (2) Also, the indefinite article A or AN is used as modifier of an ELEMENT the first time the ELEMENT is set forth (*i.e.*, introduced) in a claim. *See* THE. (3:8, 3:11) [FN1]

ABSTRACT--A brief summary of the disclosure of a U.S. patent, now printed on the cover page.

AGGREGATION--(1) A lack of structural and/or functional cooperation between the various parts of an assembly; the opposite of COMBINATION. A non-cooperating assembly of parts (strictly speaking, NON-STATUTORY subject matter)--an inherent defect in a structure, qua structure, which no claim, however well drafted, can cure. (2) A COMBINATION claimed without sufficient particularity and definiteness, so that the ELEMENTS of the claim, *as claimed*, do not cooperate. A structure is not necessarily an AGGREGATION solely because all of its ELEMENTS, either in fact or as claimed, do not function simultaneously (as in a typewriter). Recent cases cast doubt on the propriety of this ground of REJECTION. *See* M.P.E.P. § 706.03(i). (3:24, 8:6, 8:7)

***D-2 ALL ELEMENTS RULE--**An accused device infringes a CLAIM only if it includes all ELEMENTS of the CLAIM, either literally or under the DOCTRINE OF EQUIVALENTS.

ALTERNATIVE EXPRESSION--The alternative setting forth in a claim of two ELEMENTS, either (and both) of which perform the same FUNCTION in the claim, instead of a single ELEMENT to perform the FUNCTION. For example: “a spring *or* piston-cylinder for moving the member.” Usually, there is a GENERIC word covering the ALTERNATIVE ELEMENTS, in the case of the example “means for biasing,” which should be used in the claim. ALTERNATIVE EXPRESSIONS *may* render a claim INDEFINITE. In some cases, ALTERNATIVE EXPRESSIONS are permissible, if the claim is not rendered INDEFINITE thereby. For example, “one *or* more arms” (but note the connotation of A and AN). The primary use of alternative elements is in MARKUSH groupings. *See* M.P.E.P. § 706.03(d). (3:8, 3:11, 3:16, 4:7, 6:2, 6:9)

AMENDMENT--A change made in or to a patent application in response to (and hopefully to avoid) a REJECTION or OBJECTION by the EXAMINER. An AMENDMENT is part of a RESPONSE and may affect claims, the DESCRIPTION or the drawings. (2:9)

ANALOGOUS ART--A REFERENCE or some PRIOR ART directed to the same necessary FUNCTION or

utility as is the subject matter set forth in a claim, either the entire claim or particular elements thereof, even though the environment differs. For example, a brick cutter shown in a REFERENCE may be ANALOGOUS ART with respect to a claimed dough cutter. *See* M.P.E.P. § 904.01(c).

ANTECEDENT/ANTECEDENT BASIS--A claim must be consistent with the SPECIFICATION and with itself. That is, ELEMENTS recited in the claim must find ANTECEDENT BASIS in the DESCRIPTION and within the claim, if earlier recited therein. Therefore: (1) Support for; the quality of an ELEMENT which is set forth in (and supported by) the DESCRIPTION and which is then POSITIVELY recited in a claim. (2) A POSITIVELY recited, claimed ELEMENT to which later reference is made in the same (or in a DEPENDENT) claim. Absent an ANTECEDENT in the disclosure and/or claims as originally filed, a claim will be NEW MATTER. (3:2, 3:3, 3:6, 3:7, 3:8, 3:11, 3:22, 3:24, 3:25, 4:1, 8:9, 8:11)

ANTICIPATED--*See* FULLY MET.

APPARATUS--(1) An adjective meaning mechanical or MACHINE-like. (2) A noun meaning a MACHINE or DEVICE, including an *D-3 electrical circuit, having cooperating parts and a "rule of operation" to accomplish a useful RESULT, usually some act or operation on an ARTICLE or WORKPIECE. Sometimes contrasted with an ARTICLE OF MANUFACTURE or a PRODUCT. (chapter 3; 2:9, 2:11, 2:12, 4:2, 4:3, 4:5, 4:6, 4:7, 5:1)

APPARATUS LIMITATIONS IN METHOD CLAIMS--(4:6)

APPARATUS, METHOD FUNCTION OF--(4:5)

APPEAL--A review by a next higher tribunal, such as a review by the BOARD OF PATENT APPEALS AND INTERFERENCES of a decision of a patent EXAMINER, or a review by the CAFC of a decision of the USPTO or a district court decision relating to a patent infringement claim.

APPLICANT--In the United States, the individual person(s) who made the INVENTION and in whose name the application is filed, not the ASSIGNEE or owner or the invention or the employer of the APPLICANT.

ARBITRARY NAMES--(6:3)

ART--(1) A METHOD or PROCESS (pre-1952 usage). (2) Today, a field of technology, as in 35 U.S.C. § 103. *See* 35 U.S.C. § 100(b). (4:1)

ARTICLE--A WORKPIECE. Distinguish from ARTICLE OF MANUFACTURE. (3:1, 3:1.1, 3:2)

ARTICLE OF MANUFACTURE--One of the STATUTORY CLASSES of UTILITY PATENT. Broadly, any product made by man and having industrial utility. Similar to an APPARATUS or MACHINE, but usually having no moving parts or "rule of operation." The same as a MANUFACTURE. It is often difficult to tell whether a DEVICE is a MACHINE or an ARTICLE OF MANUFACTURE, but this difficulty is immaterial. (chapter 5; 1:3, 4:7, 5:1, 5:3, 6:2, 6:6, 6:8, 8:2, 8:4, 8:6, 8:7)

ARTICLE OF MANUFACTURE, OBVIOUS METHOD OF MAKING--(4:4)

ASSIGNMENT/ASSIGNOR/ASSIGNEE--A transaction or document transferring the rights in a patent application or a patent is an ASSIGNMENT; the person transferring the rights is the ASSIGNOR, and the person

to whom the transfer is made is the ASSIGNEE.

***D-4 BEST MODE**--The manner of practicing in the INVENTION preferred by the inventor at the time of the INVENTION and/or at the time of application filing; applies to individual ELEMENTS within a CLAIM and to the entire CLAIM.

BOARD OF PATENT APPEALS AND INTERFERENCES (BPAI)--An internal appeal board within the USPTO which hears appeals from the EXAMINER in patentability decisions and INTERFERENCE awards between competing inventors for priority of INVENTION.

BODY--of a CLAIM. Narrative expository prose following the PREAMBLE and the TRANSITION of a claim and reciting the ELEMENTS of the claimed INVENTION as well as a description of how these ELEMENTS cooperate to make up the operative COMBINATION recited in the PREAMBLE. (2:4, 2:5, 2:7, 2:9, 3:1, 3:1.1, 3:2, 3:29, 4:1, 6:8, 6:10)

BROAD/BROAD CLAIM--Relates to a claim which covers or READS ON a wide range and variety of DEVICES, PROCESSES, etc., because the claim contains only few, or only general, limitations. Sometimes called "wide," especially in British practice. A claim may be so BROAD as to be INDEFINITE (§ 3:25) or to READ ON the PRIOR ART. See NARROW. (2:3, 2:4, 2:5, 2:6, 3:2, 3:3, 3:5, 3:7, 3:25, 3:29, 3:29.20, 3:30, 4:1, 5:2, 6:1, 7:1, 8:5, 8:9, 8:10)

CAFC--Abbreviation for the United States Court of Appeals for the Federal Circuit.

CATALOG--An AGGREGATION (Sense (2)) as claimed. (3:22, 6:8, 8:6)

CCPA--Abbreviation for the United States Court of Customs and Patent Appeals, superseded in 1982 by the CAFC.

CHEMICAL CLAIMS--(chapter 6; 4:7, 6:1, 6:4)

CLAIM--A description of the INVENTION (Sense (2)) protected, located at the end of every patent SPECIFICATION. The protection afforded by a patent is measured by the CLAIMS which are similar to a real property deed in function, *i.e.*, describing metes and bounds.

CLAIM DIFFERENTIATION--Presumption that an INDEPENDENT CLAIM should not be construed as requiring a limitation added by a DEPENDENT CLAIM; or in two INDEPENDENT CLAIMS, construing claims to avoid making other language in another INDEPENDENT CLAIM superfluous.

***D-5 CLASS**--The USPTO has a classification system and every INVENTION is classifiable in a particular CLASS and subclass. Each CLASS and subclass relates to a particular subject area.

CLAUSE--In a CLAIM, the description of an element or elements between separating punctuation, commas, semicolons.

CLOSED-ENDED--See CONSISTING ESSENTIALLY OF and CONSISTING OF. (2:6)

COINED NAME CLAIM--A hybrid type of FINGERPRINT CLAIM in which the COINED NAME is defined and its distinctive properties, structure and METHOD of production are set forth in the DESCRIPTION

(§ 6:5). Such a claim may be proper in the event the COINED NAME was known in the PRIOR ART before the application was filed (which occurs only rarely). (6:4, 6:5, 6:6)

COLON-SEMICOLON FORM--A claim format in which a colon may be inserted after the TRANSITION and semicolons are used between the ELEMENTS. Such a claim format may be used: in the OUTLINE FORM; the SINGLE PARAGRAPH FORM; or in the SUBPARAGRAPH FORM. (2:8)

COMBINATION--(1) An interrelated group of ELEMENTS, structurally and FUNCTIONALLY tied together in a claim to an operative DEVICE to effect some useful FUNCTION or RESULT. Simultaneity of operation of the ELEMENTS is not necessary. *See* AGGREGATION and CATALOG. (2) A complete MACHINE, PROCESS, ARTICLE OF MANUFACTURE, COMPOSITION, etc., as distinguished from a SUBCOMBINATION thereof. (1:1, 2:4, 2:5, 2:6, 2:7, 2:8, 2:9, 2:11, 3:2, 3:3, 3:10, 3:22, 3:23, 3:24, 3:27, 3:29, 3:30, 4:1, 4:3, 4:7, 5:1, 6:1, 6:2, 6:7, 6:8, 6:10, 8:5, 8:6, 8:7, 8:10)

COMPOSITION/COMPOSITION OF MATTER--PRODUCTS wherein the chemical nature of the substances or materials used, rather than the shape or form, is the distinguishing characteristic. A COMPOSITION may be a molecule, COMPOUND, solution, mixture, alloy, atom, etc. Sometimes contrasted with ARTICLE OF MANUFACTURE. (1:3; 2:9, 2:11, 4:6, 4:7, 6:1, 6:3, 6:4, 6:6, 6:7, 6:8)

COMPOUND--Usually, a molecule, per se. *See* COMPOSITION. (6:1, 6:2, 6:4, 6:5)

COMPRISES/COMPRISING--TRANSITION words between the BODY of the claim and the PREAMBLE and within a clause in the body of the claim. The words mean "including the following *D-6 ELEMENTS (in the BODY or the elements following the element preceding that TRANSITION word), but not excluding others." A claim or clause using either word is said to be OPEN-ENDED. Thus, "A COMPOSITION COMPRISING (or WHICH COMPRISES) A, B and C" *requires* the presence of A, B and C, but does *not* exclude other components. Hence, one who produces another COMPOSITION made up of A, B, C and D would INFRINGE. INCLUDES and HAS mean the same thing. (2:5, 3:2, 3:10, 4:1, 6:2, 6:8)

COMPUTER PROGRAMS--(4:10)

CONSISTING ESSENTIALLY OF--A TRANSITION between the PREAMBLE and BODY of a claim and within a clause in the body of the claim. The phrase means "excluding other ELEMENTS of any essential significance to the claimed COMBINATION." More NARROW than COMPRISES, but more BROAD than CONSISTING OF. Hence, one who adds an additional component to the claimed COMBINATION may or may not INFRINGE, depending on whether the additional component substantially alters the properties of the COMPOSITION. For example, where a claim calls for "a tough, impact-resistant COMPOSITION, CONSISTING ESSENTIALLY OF A, B and C," and another adds D to the COMPOSITION, if the addition results in a COMPOSITION which is extremely brittle (*i.e.*, nonimpact-resistant) there is no INFRINGEMENT, because D's properties substantially changed the properties of the COMPOSITION. The line between CONSISTING ESSENTIALLY OF and CONSISTING OF is not clear. Use of either phrase results in what is termed a CLOSED-ENDED CLAIM. (2:6)

CONSISTING OF--A TRANSITION between the PREAMBLE and BODY of a claim and within a clause in the body of the claim. The phrase means "excluding more than traces of other than the recited ingredients." Use of the phrase results in a CLOSED-ENDED claim. Thus, "A COMPOSITION CONSISTING OF A, B and C" *requires* the presence of A, B and C, and only A, B and C. One who produces a COMPOSITION of A, B, C and

D would not INFRINGE. *See* COMPRISES, CONSISTING ESSENTIALLY OF. (2:6, 2:9, 2:11, 6:2)

CONTINUATION--A new but continuing patent application either to continue prosecuting CLAIMS on the same INVENTION as the preceding parent application from which it continues or to prosecute other CLAIMS that do not qualify for a DIVISION. *See also* REQUEST FOR CONTINUED EXAMINATION.

***D-7 CONTINUATION-IN-PART (CIP)**--A new but continuing patent application filed to add new matter to a preceding parent application, which therefore continues only in part.

CONTRIBUTORY INFRINGEMENT/CONTRIBUTORY INFRINGER--INFRINGEMENT arising when one (the CONTRIBUTORY INFRINGER) sells a component of a patented INVENTION, or a material or APPARATUS for use in practicing a patented PROCESS, knowing the same to be especially made and adapted for use in an INFRINGEMENT of such patent, unless what is sold is a staple article of commerce suitable for substantial non-infringing use. 35 U.S.C. § 271(c).

COUNT--A claim defining the INVENTION the priority of which is being contested in an INTERFERENCE.

DEPENDENT CLAIM--A claim which refers back to and further restricts (*i.e.*, makes more NARROW) a single preceding claim (the PARENT CLAIM), which may itself be a DEPENDENT CLAIM. The DEPENDENT CLAIM either modifies an ELEMENT in the PARENT CLAIM or adds another ELEMENT to the PARENT CLAIM, or both. 35 U.S.C. § 112, Rule 75(c). (2:3, 2:9, 2:11, 3:11, 3:14, 4:1, 4:6, 4:7, 6:8, 6:9, 7:1, 8:10)

DESCRIPTION--Often referred to as WRITTEN DESCRIPTION or "detailed DESCRIPTION." The SPECIFICATION of a patent or patent application is made up of drawings, a DESCRIPTION and claims. The DESCRIPTION describes the structure, composition, cooperation, function, embodiments, etc., of the INVENTION in a quite detailed, technical fashion and provides ANTECEDENT basis for the terms of the claims which define the INVENTION. (3:3, 3:6, 3:13, 5:4, 6:3)

DESIGN CLAIM--(5:1)

DEVICE--(1) A generalized word meaning "thing" or "item." (2) A MACHINE or APPARATUS. (3:1, 3:1.1, 3:2)

DIVISION--A patent application having the same disclosure as the preceding parent application, containing CLAIMS either from the parent or based on the disclosure in the parent, which cover an INVENTION that the EXAMINER of the parent had restricted out of the parent in a RESTRICTION REQUIREMENT and which CLAIMS had not been elected by the APPLICANT for PROSECUTION in the parent.

***D-8 DOCTRINE OF EQUIVALENTS**--A legal tenet holding that where a DEVICE, etc., accused of INFRINGING a claim does not include each and every ELEMENT of the CLAIM in *haec verba*, it will still INFRINGE the claim if it includes for every ELEMENT thereof either such ELEMENT or the EQUIVALENT of ELEMENTS not precisely present. *See* FILE WRAPPER ESTOPPEL. (3:29)

DOUBLE INCLUSION--Setting forth in a claim precisely the same ELEMENT twice as two different ELEMENTS, usually under twelve different names. (2:9, 2:11, 3:11, 3:29, 3:29.20)

DRAWINGS, REFERENCE TO IN CLAIMS--(6:6)

DUPLICATE CLAIM--A redundant CLAIM. A CLAIM that does not “differ substantially” from another claim in the same patent or patent application. *See* Rule 75(b), M.P.E.P. § 706.03(k). (7:1, 8:2)

ELECTION--In response to a RESTRICTION REQUIREMENT, an APPLICANT selects one INVENTION and claims thereon for PROSECUTION in the present application.

ELECTRICAL CIRCUIT CLAIMS--(3:30)

ELECTRICAL METHODS--(4:8)

ELEMENTS--(1) In CLAIM terminology, those things which together constitute the claimed INVENTION. In APPARATUS and ARTICLE OF MANUFACTURE claims, the ELEMENTS are the main structural parts; in METHOD claims, the ELEMENTS are steps or acts, usually GERUND phrases and clauses; in COMPOSITION claims, the ELEMENTS are chemicals or molecules. (2:5, 2:6, 2:7, 2:8, 2:9, 2:11, 3:1, 3:1.1, 3:3, 3:6, 3:7, 3:11, 3:12, 3:13, 3:14, 3:16, 3:17, 3:18, 3:21, 3:22, 3:23, 3:24, 3:29, 3:30, 4:1, 4:2, 4:3, 4:6, 5:1, 6:1, 6:8, 6:10, 7:1, 8:5, 8:8, 8:10). (2) The respective parts of an assembly.

ELEMENTS, FEATURES OF--(3:17)

ELEMENTS, NAMING OF--(3:7)

ELEMENTS, NUMBER OF--(3:11)

ELEMENTS, ORDER OF--(3:21, 4:3)

ELEMENTS, PARTS OF--(3:17)

***D-9 ELEMENTS, STRUCTURAL CONNECTION OF**--(3:23)

ELEMENTS, TYING TOGETHER--(3:22)

EMBODIMENT--A particular variant or example of an INVENTION disclosed in the SPECIFICATION and perhaps claimed. The SPECIFICATION may disclose one or more EMBODIMENTS.

EQUIVALENT--An ELEMENT or group of ELEMENTS that either is not substantially different from, is interchangeable with, or that performs substantially the same FUNCTIONS in substantially the same manner to produce substantially the same RESULT as an ELEMENT, group of ELEMENTS or INVENTION set forth in a claim. *See* DOCTRINE OF EQUIVALENTS. (3:29.12, 4:5, 6:6)

EUROPEAN-TYPE CLAIM--A claim format, similar to a JEPSON claim format, and common in European patents. The format followed is usually: “A (name of the DEVICE and its FUNCTION) of the type having (recitation of the PRIOR ART, usually that found in a *single* REFERENCE) characterized in that (recitation of the improvement in the claim BODY).” (6:8)

EXAMINATION/EXAMINER--The EXAMINER, a USPTO employee, studies in detail patent applications to determine if the applicant is entitled to a patent under the STATUTE. Such study is called the EXAMINATION. (1:1, 2:2, 8:8)

EXHAUSTED COMBINATION--*See* OLD COMBINATION. (8:5)

EXTRINSIC EVIDENCE--Evidence useful for interpreting a claim element or a claim and that is not INTRINSIC EVIDENCE; includes dictionaries, encyclopedias, and learned texts; statements (and testimony) of experts and of persons skilled in the relevant art.

FIGURE--An individual, numbered drawing in a patent.

FILE WRAPPER--The official file of the USPTO relating to the EXAMINATION of a patent application. It includes the application as filed, all formal papers and all correspondence (OFFICE ACTIONS, RESPONSES, and the like) preceding the issuance of (or denial of) a patent. Often called PROSECUTION HISTORY. Sometimes called "file history."

***D-10 FILE WRAPPER ESTOPPEL**--If a patent applicant, whose claims are REJECTED (or sometimes OBJECTED to), NARROWS those claims (as by adding limiting language thereto or by making arguments interpreting the claim language in a restrictive manner) and thereafter obtains allowance of the formerly rejected claims, he may be strictly limited by the additional language or arguments, and will not be entitled to any EQUIVALENTS with respect thereto. Often called PROSECUTION HISTORY ESTOPPEL. *See* INFRINGE and DOCTRINE OF EQUIVALENTS.

FINGERPRINT CLAIM--A claim defining a chemical COMPOSITION in terms of its properties, such as X-ray diffraction, solubility, melting point, phase diagram, spectrum, etc., often as shown in the drawing. The use of such a claim is limited to emergency situations wherein the differences between the INVENTION and the PRIOR ART cannot be explained or described (and claimed) in the traditional terms of physical or chemical structure. Such a claim must, nevertheless, distinctly claim the INVENTION. (6:4, 6:5, 6:6)

FORM/FORMAT OF CLAIMS IN GENERAL--(chapter 2; 2:8).

FORMAL REJECTION--A REJECTION (OBJECTION) made by the EXAMINER to the form, as opposed to the substance (novelty and/or unobviousness), of a claim. A NON-ART REJECTION. (chapter 10; 7:1, 8:9)

FULLY MET--A phrase used to REJECT a claim which is completely anticipated by or shown in a single REFERENCE. This type of REJECTION is properly posited on 35 U.S.C. § 102, not on 35 U.S.C. § 103.

FUNCTION/FUNCTIONAL CLAUSE/LIMITATION--Describing an ELEMENT in terms of what it does, as opposed to what it is (i.e., its structure). *See* § 3:21. At times a FUNCTIONAL LIMITATION may be expressed negatively, that is, by what the ELEMENT does not do. (3:24, 3:25, 3:27, 3:29, 5:1, 6:1, 8:5, 8:9)

FUNCTIONAL ORDER--A logical ordering of the ELEMENTS of a claim which begins with the ELEMENT which first contacts the WORKPIECE. *See* STRUCTURAL ORDER. (3:21)

GAZETTE--*See* OG/OFFICIAL GAZETTE.

GENERIC/GENUS--A GENUS is a class BROADER than, or including, more than one SPECIES. "Primate" is a GENUS with respect to *D-11 "man" and "ape" which are SPECIES thereof. A GENERIC claim includes within its SCOPE two or more disclosed embodiments (SPECIES). Such a claim must cover or READ ON what is comprehended in each of the SPECIES. *See* M.P.E.P. § 806.02(d) and (e). (3:2, 3:7, 3:16, 3:29, 4:1, 5:1, 6:1, 6:2, 6:3, 6:9)

GERUND--A verbal noun expressing the action of the verb in a generalized manner; a verbal noun, ending in

“-ing” and performing the function of a substantive, often taking the case phrase construction, and at the same time showing the verbal features of tense and voice, taking adverbial modifiers, and governing objects. Usually, GERUNDS are the first words of METHOD steps, the basic ELEMENTS of a METHOD claim. (4:1)

HAS/HAVING--TRANSITION words between the PREAMBLE and the BODY of a claim. Mean the same as COMPRISES/COMPRISING. (2:5, 6:8)

HOLE--Absence of material. HOLES, unlike most ELEMENTS, should usually be claimed INFERENTIALLY (Sense (1)), as “a lever having a hole.” (3:17, 3:18, 3:29)

IMPROVEMENT CLAIM--(6:8)

IN ORDER TO--*See* WHEREBY. Often used in a manner different from WHEREBY in a MEANS-plus-FUNCTION clause, as: “means for rotating the wheel IN ORDER TO reciprocate the arm. . . .” Usually, “IN ORDER TO reciprocate the arm” will be considered as a STRUCTURAL/FUNCTIONAL limitation and may fall under 35 U.S.C. § 112, ¶ 6. (3:25, 3:29)

INCLUDES/INCLUDING--TRANSITION words between the PREAMBLE and BODY of a claim. Mean the same as COMPRISES/COMPRISING. (2:5, 6:8)

INCOMPLETE--Quality of a claim which omits essential ELEMENTS or cooperative relationships. *See* M.P.E.P. § 706.03(f). (6:10, 8:8, 8:9, 8:10)

INDEFINITE--(1) Lack of proper ANTECEDENT. (2) The quality of a claim which fails to accurately define the limits or boundaries of the INVENTION for any reason. (3) Not meeting the requirements of 35 U.S.C. § 112 to particularly point out and distinctly claim the INVENTION. (3:5, 3:14, 3:16, 3:17, 3:29, 4:1, 6:2, 8:8)

***D-12 INDEPENDENT CLAIM--**A claim that contains a complete description of the subject matter, without reference to any other claim. (*See* DEPENDENT CLAIM.) (2:9)

INDIRECT LIMITATION--Example: First reciting “a gear” and then reciting “said plastic gear” in a claim, where the same gear is meant in both instances. “Plastic” is an INDIRECT LIMITATION rendering the claim INDEFINITE. *See* ANTECEDENT, INFERENTIAL and POSITIVE, and M.P.E.P. § 706.03(d). (3:14)

INFERENTIAL--(1) In reference to the form of claims as such, an INFERENTIAL claim is one wherein a new ELEMENT is introduced in the middle of a clause which introduces and describes another ELEMENT. *See* § 3:3. (2) The term is also used to refer to the setting forth of an ELEMENT (or a limitation or feature thereof) in a claim not found in the DESCRIPTION, or an ELEMENT (or limitation of an ELEMENT) set forth definitely in the claim (“the arm”) where not set forth earlier in the claim. *See* INDIRECT LIMITATION and §§ 3:6, 3:14 and 8:8. (3) APPARATUS limitations are usually brought into METHOD claims INFERENTIALLY in the sense of meaning (1). (3:3, 3:6, 3:14, 4:6, 8:5, 8:9)

INFORMATION DISCLOSURE STATEMENT (IDS)--A statement filed in the USPTO during prosecution of a patent application to inform an EXAMINER of prior ART and other information material to the patentability of the INVENTION.

INFRINGE/INFRINGEMENT/INFRINGER--An INFRINGER INFRINGES a claim by making, using or selling in the United States that which is set forth in the claim without the authority of the patent owner. *See* 35

U.S.C. § 271 and DOCTRINE OF EQUIVALENTS. Normally, the DEVICE, etc., accused of being an INFRINGEMENT must contain each and every ELEMENT of the claim. (1:2, 2:9, 2:11, 3:3, 3:29, 3:30, 6:4, 6:5, 6:7, 7:1)

INOPERATIVE--Incapable of performing an intended purpose. INOPERATIVENESS may reside in an INVENTION, *qua* INVENTION, or as claimed. *See* AGGREGATION.

INTERFERENCE--A proceeding in the USPTO to determine among (a) one or more patent applicants and one or more patentees, or (b) two or more applicants, claiming the same INVENTION, which of the parties was the first inventor. The claim defining the contested INVENTION is called a COUNT. (3:26)

***D-13 INTRINSIC EVIDENCE**--Evidence useful for interpreting a CLAIM ELEMENT or a CLAIM, including the SPECIFICATION and drawings of the patent (or application) and the PROSECUTION HISTORY; does not include dictionaries, encyclopedias, and learned treatises, or statements of experts or persons skilled in the ART or evidence requiring authentication, credibility determination or questionable hearsay.

INTRODUCTION/INTRODUCTORY PHRASE--"I (or we) claim" or "What is claimed is." Each claim is the direct object of a SINGLE SENTENCE beginning with an INTRODUCTORY PHRASE, which appears only once, before the first claim. (2:1, 2:2, 3:1)

INVENTION--(1) As a legally significant act, the summation of conception and reduction to practice, actual or constructive. (2) Also, the thing or DEVICE invented and claimed in a patent or patent application. (3) Sometimes used (misused?) as meaning unobvious as in "what is the invention?"; meaning, what is the novel and unobvious feature(s) defined in the claim. *See* 35 U.S.C. § 103. (1:3, 2:9, 2:11, 3:3, 3:6, 3:29, 4:4, 6:1, 6:5, 6:9, 7:1, 8:5, 8:6, 8:9, 8:10)

JEPSON CLAIM--A claim format for an improvement-type INVENTION wherein the old ELEMENTS are set forth in the PREAMBLE of the claim and the new or modified ELEMENTS (or new or modified COMBINATIONS thereof) are set forth in the BODY of the claim. Similar to a EUROPEAN-TYPE CLAIM. From a Patent Office decision involving an inventor named Jepson. (3:29, 6:8, 8:5)

LABEL CLAIM--A type of NEW USE CLAIM wherein a statement of the intended use of a COMPOSITION is set forth in the PREAMBLE as a PREAMBLE LIMITATION and is relied on for novelty and/or unobviousness. (6:7)

LARGE ENTITY--An ASSIGNEE or LICENSEE business concern with more than 500 employees, not an eleemosynary institution.

LAUDATORY STATEMENTS--Words such as "novel" or "efficiently" or "long wearing" which are generally not permitted in UTILITY claims. *See* § 2:7. Sometimes called SURPLUSAGE. Permitted in plant patent claims. (2:7, 5:1, 5:4)

LICENSE--Permission granted by the patent owner to a licensee to make, use, or sell a PRODUCT or perform a METHOD which would otherwise infringe a CLAIM of a patent.

***D-14 LITERAL INFRINGEMENT**--The accused device or METHOD satisfies every word in a CLAIM ELEMENT, and as to an entire CLAIM, every word therein.

MACHINE--One of the STATUTORY CLASSES of UTILITY PATENT. Often called "APPARATUS." A DEVICE usually having moving parts and a "rule of operation." Often contrasted with ARTICLE OF MANUFACTURE. (chapter 3; 1:3, 3:1, 3:2, 3:3, 5:1, 6:8, 8:6, 8:9)

MAINTENANCE FEE--MAINTENANCE FEES are payable to the USPTO now at intervals of 3.5, 7.5, and 11.5 years from the date of issuance of the patent.

MANUAL--See M.P.E.P.

MANUFACTURE--An ARTICLE OF MANUFACTURE. (1:3, 3:2, 8:6, 8:7)

MARKUSH CLAIM--A claim using special language as a permissible ALTERNATIVE EXPRESSION for a group of materials, articles, or steps operable therein. Used most in chemical claims but useful in mechanical, electrical, method and other types of claims. A contrived GENERIC expression where no true GENERIC expression exists. Example: "a metal selected from the group CONSISTING OF copper, silver and gold." Technically, but permissibly, violates the rule against ALTERNATIVE EXPRESSIONS. From a case, *Ex parte Markush*. (3:13, 6:1, 6:2)

MEANS--A generalized and very BROAD word used to describe, in appropriate situations, an ELEMENT of a claim. See sixth paragraph of 35 U.S.C. § 112. Properly phrased as "means for (performing a specified function)." (2:9, 2:11, 3:7, 3:12, 3:14, 3:16, 3:18, 3:23, 3:29, 3:30, 4:1, 5:1, 6:1, 6:2, 6:9)

MENTAL STEPS--(4:8, 8:7)

METHOD--A procedure for transforming or reducing an ARTICLE, WORKPIECE or chemical substance to a different state or thing. METHOD, PROCESS and ART mean the same thing. METHOD is more common in mechanical and electrical claims; PROCESS is more common in chemical claims; ART today is more commonly used to mean "field of technology." (chapter 4; 2:9, 2:11, 4:1, 4:3, 4:4, 4:5, 4:8, 4:10, 6:4, 6:6, 6:7, 6:8)

***D-15 METHOD CLAIMS, APPARATUS LIMITATIONS IN**--(4:6)

METHOD, ELECTRICAL--(4:8)

METHOD AS FUNCTION OF APPARATUS--(4:5)

METHOD OF MAKING AN ARTICLE OF MANUFACTURE, OBVIOUS--(4:4)

M.P.E.P.--The Manual of Patent Examining Procedure, a looseleaf booklet published by the Government Printing Office and available from the Superintendent of Documents, Box 1533, Washington, D.C. 20013 and on-line. It is the EXAMINERS' "bible." (2:2) (See Appendix C3 for selected sections.)

MULTIPLE DEPENDENT CLAIM--A DEPENDENT CLAIM which is DEPENDENT upon more than one other, preceding CLAIM or is dependent upon another MULTIPLE DEPENDENT CLAIM. (2:11)

MULTIPLICITY--A word connoting an indefinite number, two or more; usually a fairly large number. Often thought of as being greater than a PLURALITY. (3:11)

NARROW/NARROW CLAIM--A NARROW CLAIM covers or READS ON a restricted SCOPE of DEVICES, PROCESSES, etc., because it contains either many, or quite specific, limitations. A NARROW

CLAIM is usually entitled only to a NARROW range of EQUIVALENTS. *See* BROAD CLAIM, OLD COMBINATION, PICTURE CLAIM (Sense (2)) and PROLIX. (2:3, 3:2, 3:3, 4:1, 5:2, 6:1, 7:1, 8:9, 8:10)

NEGATIVE LIMITATION--A claim limitation telling what an ELEMENT is not, instead of what it is; or what it does not do, instead of what it does. (3:5, 5:1)

NEW MATTER--A term of art in patent law meaning any matter not "fairly" disclosed within the "four corners" (entire SPECIFICATION, DRAWINGS or CLAIMS) of a patent application as filed. NEW MATTER may not be introduced into an application after it is filed. An ANTECEDENT for any element added to a claim after filing must be found in the original disclosure, or the claim will be, or be based upon, NEW MATTER. (6:3, 8:11)

***D-16 NEW USE CLAIM**--A claim to a METHOD involving some NEW USE of an old material or COMPOSITION, such as the killing of insects by spraying with DDT, DDT being sold for *other* purposes. Traditionally (and under 35 U.S.C. § 100(b)), such a NEW USE may be claimed only in METHOD terminology, and the test of patentability is the novelty and unobviousness of the METHOD. *See* PREAMBLE LIMITATIONS; LABEL CLAIM. (2:4, 4:7, 5:1, 6:1, 6:7, 6:10, 8:5)

NON-ART REJECTION--A REJECTION of a CLAIM based, not on PRIOR ART (*i.e.*, not on 35 U.S.C. §§ 102 and/or 103), and may be based on the form of the CLAIM. *See* FORMAL REJECTION and chapter 10. Includes REJECTIONS due to: NON-STATUTORY subject matter (35 U.S.C. § 101), METHOD functional of APPARATUS (§ 4:5), improper NEW USE (§ 8:6) and PRINTED MATTER limitations (§ 8:7), and other bases covered in chapter 10. (chapter 10; 4:10, 8:5)

NON-STATUTORY--(1) Quality of the subject matter of a purported INVENTION which is not patentable under 35 U.S.C. § 101, either by the precise terms thereof, or by case-law interpretation. *See* §§ 1:3 and 8:6. (2) Also used as a ground for REJECTION of a claim to an INVENTION where the claim is inherently defective, as an OMNIBUS CLAIM (§ 1:2), the claim sets forth a RESULT only (§ 3:25) or the claim depends solely on printed matter for patentability (§ 8:7). *See* FORMAL REJECTION and NON-ART REJECTION. (1:2, 1:3, 3:22, 4:10, 8:6, 8:7)

NOVELTY--As provided in Section 102 of the STATUTE, an INVENTION is novel if it has not been patented, or described in a publication or in public use or on sale by others, either before being invented by the inventor or more than one year before a patent application.

NUMBERING OF CLAIMS--(2:3)

NUMERALS, REFERENCE, IN CLAIMS--(3:13)

OBJECTION--A criticism by an EXAMINER to the form of a claim, as opposed to its substance. *See* NON-ART REJECTION and REJECTION. (3:5, 3:25)

OBVIOUSNESS--As provided in Section 103 of the STATUTE, an INVENTION must not have been obvious to a person having ordinary skill in the ART to which the INVENTION pertains.

***D-17 OFFICE ACTION**--A communication from an EXAMINER to the APPLICANT after examination of the application.

OFFICIAL GAZETTE/OG--A weekly publication of the USPTO, giving abstracts of and other information on all patents granted that week, as well as other information relating to patent and trademark practice. Now split into two volumes, one for Patents, one for Trademarks. (3:5). It is available on-line and on DVDs.

OLD COMBINATION--Quality of a claim which recites an overall COMBINATION (including a SUB-COMBINATION) wherein the INVENTION resides in the SUBCOMBINATION which does not cooperate in some new and unobvious manner with the remainder of the COMBINATION. Sometimes called EXHAUSTED COMBINATION or OVERCLAIMING. A ground for REJECTION. (6:8, 6:10, 8:5, 8:8)

OMNIBUS CLAIM--A claim in formal terms, such as "My INVENTION substantially as shown and described." Not permitted in Utility patents under 35 U.S.C. § 112. This form of claim is used in design patents, and in modified form in plant patents. (1:2, 5:3, 5:4, 6:4, 6:6)

OPEN-ENDED--See COMPRISES.

OPERATIONAL EXPRESSIONS--(3:24)

ORDER OF CLAIMS--(2:3, 6:7)

OUTLINE FORMAT--A claim format in which each ELEMENT is introduced in its own SUBPARAGRAPH which may be identified by a parenthesized number or letter. See § 2:8. (2:8, 4:3)

OVERCLAIMING--See OLD COMBINATION. (3:22, 8:5)

PARENT CLAIM--A main claim from which a DEPENDENT CLAIM depends. The parent claim may itself be INDEPENDENT or dependent. (2:9, 2:11, 3:14, 6:8)

PATENT--A grant by the Patent and Trademark Office giving the owner thereof the right to prevent others from making, using, or selling an INVENTION and therefore the right to give others permission.

PATENT AGENT--A person who is licensed to prosecute patent applications in the USPTO, and not usually an attorney member of the bar.

***D-18 PATENT ATTORNEY**--An attorney member of the bar who has been licensed to prosecute patent applications in the USPTO.

PENDING/PATENT PENDING--An application for a patent is PENDING if it is an unissued, unabandoned application.

PERIPHERAL CLAIM--The type of claim used in the United States. It defines the outer boundaries of the INVENTION. All that is within those boundaries (including all the claimed ELEMENTS and their EQUIVALENTS) will be READ ON by the claim; all that is outside the boundaries is not READ ON by the claim. See DOCTRINE OF EQUIVALENTS. (1:2)

PICTURE CLAIM--A claim reciting all significant structure disclosed in the description, omitting only "nuts and bolts." Thus, a very NARROW claim. (6:7, 7:1)

PLANT PATENT CLAIM--(5:4)

PLURALITY--An indefinite number, two or more. *See* MULTIPLICITY. (3:11)

POSITIVE/POSITIVELY--(1) The opposite of INFERENTIAL. A POSITIVE recitation of an ELEMENT means that the ELEMENT is introduced and fully described in a clause of a claim in which no other ELEMENT is introduced (except for a HOLE). *See* §§ 3:3, 3:6, 3:14, 4:2, 4:6, 8:9. (2) The opposite of NEGATIVE. *See* NEGATIVE LIMITATION. (3:3, 3:5, 3:17, 3:29, 4:1, 6:8, 8:5)

PQ--*See* USPQ.

PREAMBLE--The initial part of a claim, the purpose of which is to name or define the thing being claimed. Often the environment in which the claimed thing will be used is set forth, as well as the WORKPIECE. *See* NEW USE CLAIM. (2:4, 2:5, 2:7, 2:9, 2:11, 3:1, 3:2, 3:3, 3:24, 3:29, 4:1, 6:1, 6:7, 6:8, 6:10)

PREAMBLE LIMITATION--Descriptive statement in a PREAMBLE such as those related to the field of use, environment, etc. Possibly helpful in distinguishing a claim over PRIOR ART. *See* NEW USE CLAIM. (3:2, 4:10, 6:7, 6:10, 8:5)

***D-19 PREFERRED EMBODIMENT**--Examples or variations of an INVENTION may be disclosed in the SPECIFICATION. One or more of these may be considered preferred by the inventor.

PRINTED MATTER--*See* NON-ART REJECTION, NON-STATUTORY. (4:9, 8:7)

PRIOR ART--All subject matter (patents, publications, etc.) bearing on the novelty and unobviousness of a claimed INVENTION pursuant, *inter alia*, to 35 U.S.C. §§ 102 and 103.

PRIORITY--A patent application may have an effective filing date earlier than its actual filing date under U.S. law, based on a PROVISIONAL APPLICATION, or on a prior application of which the present application is a continuing application, or by treaty, such as the Paris Convention and the Patent Cooperation Treaty on a non-U.S. application disclosing the invention.

PROCESS--One of the STATUTORY CLASSES of UTILITY PATENT. *See* METHOD. (chapter 4; 1:3, 2:3, 4:1, 5:3, 6:3, 6:5)

PROCESS, CHEMICAL--(4:7)

PRODUCT--Synonymous with ARTICLE OF MANUFACTURE and COMPOSITION. (2:3, 6:1)

PRODUCT-BY-PROCESS--A type of claim defining a PRODUCT in terms of the PROCESS by which it is made. Generally used when the PRODUCT cannot be defined in more traditional terms. This type of claim covers the PRODUCT *only* when made by the specified PROCESS. Novelty and unobviousness must reside in the PRODUCT and not merely in the PROCESS. *See* M.P.E.P. § 706.03(e). (2:9, 2:11, 3:25, 4:8, 5:1, 5:2, 6:3, 6:7)

PROLIX--Quality of a claim which is “too complete” in that it sets forth long recitations of unimportant details which hide or obscure the INVENTION. *See* M.P.E.P. § 706.03(g). (8:10)

PROSECUTION--Following the filing of an application and before issuance of the patent, the actions of the EXAMINER and of the APPLICANT and his representative before the USPTO are prosecution.

***D-20 PROSECUTION HISTORY**--*See* FILE WRAPPER.

PROSECUTION HISTORY ESTOPPEL--*See* FILE WRAPPER ESTOPPEL.

PROVISIONAL APPLICATION--A patent application, often less thorough than a complete UTILITY PATENT application, which establishes the date of filing of an application on the INVENTION in the United States, serves as a basis for a claim for PRIORITY for the U.S. application and other country applications, and has a one-year term during which a regular application should be filed.

PUNCTUATION OF CLAIMS--(2:8)

READ ON--To encompass, comprehend or give support to; to be within the terms of. If a claim READS ON a device accused of being an INFRINGEMENT thereof, the DEVICE does INFRINGE. If a claim READS ON a REFERENCE (or, *vice versa*) the claim is either unpatentable or invalid. A claim must READ ON the DESCRIPTION of the patent or application to which it is appended for the ELEMENTS of the claim to find ANTECEDENT basis therein. (3:6, 8:9)

REEXAMINATION--Any party may request that an issued patent be reexamined, typically based upon prior ART which the requestor shows was not properly considered during the examination of the application for the patent.

REFERENCE--*See* PRIOR ART. Whether a REFERENCE is available as PRIOR ART depends on 35 U.S.C. §§ 102 and 103 and case-law interpretations thereof. PRIOR ART REFERENCES may be relied on by the EXAMINER or an accused INFRINGER to attack a claim.

REFERENCE NUMERALS IN CLAIMS--(3:13)

REJECTION--Disallowance of a claim by an EXAMINER because of its substance (lack of novelty; obvious). *See* OBJECTION and PRIOR ART. (3:5, 3:25, 4:5, 8:6, 8:8, 8:9, 8:10)

REQUEST FOR CONTINUED EXAMINATION (RCE)--Following a final OFFICE ACTION, to enable further examination of the same application, an RCE may be filed along with a fee, effectively refiling the same application.

***D-21 RESPONSE--**An applicant's answer to an OFFICE ACTION. Attempts to meet REJECTIONS of and OBJECTIONS to claims either by AMENDMENT, or argument, or both.

RESTRICTION REQUIREMENT--Where the EXAMINER concludes that an application contains claims directed to more than one INVENTION, he may require the applicant to elect one INVENTION and to restrict his claims to such elected INVENTION. (6:9, 6:10)

RESULT--What the INVENTION is intended to accomplish. Claims setting forth only RESULTS are objectionable as too BROAD. (3:25, 3:26, 3:29, 4:1)

SAID--THE. Used in claims to refer back to a claim element previously introduced. Preferable to use THE. "THE SAID" is a redundancy to be avoided. (3:14)

SCOPE--Breadth; the limits of the boundaries of a PERIPHERAL CLAIM. *See* BROAD and NARROW. (chapter 8; 2:3, 2:4, 2:9, 2:11, 3:3, 3:7, 3:13, 3:17, 3:29, 5:4, 6:1, 7:1, 8:4, 8:9, 8:10)

SCOPE OF CLAIMS, VARYING--(chapter 8)

SINGLE ELEMENT CLAIM--A rare type of claim not to a COMBINATION but to one ELEMENT. Permissible if not a SINGLE MEANS CLAIM. (2:7)

SINGLE MEANS CLAIM--An impermissible claim not to a COMBINATION and having only one ELEMENT which is expressed in the form of "MEANS plus function." *See* 35 U.S.C. § 112. (3:29, 4:1, 4:3, 4:7, 6:8)

SINGLE PARAGRAPH FORM--A claim format in which the ELEMENTS are not identified by indentation, letters or numerals, but are set off by commas. *See* COLON-SEMICOLON FORM, OUTLINE FORM, SUB-PARAGRAPH FORM. (2:8, 3:1)

SINGLE SENTENCE RULE--In the United States, a claim must be a single sentence. *See* INTRODUCTION. (2:2, 2:7, 3:18)

SMALL ENTITY--Individuals, not-for-profit entities, and eleemosynary institutions, and ASSIGNEES or licensees of the APPLICANT with fewer than 500 employees, are deemed SMALL ENTITIES and may pay reduced official fees.

D-22 SO THAT--See* IN ORDER TO and WHEREBY. (3:25, 3:27, 3:29)

SPECIES--A SPECIES is a member of a GENUS. A SPECIES is one of the two or more alternative and mutually exclusive embodiments of an INVENTION. The different SPECIES may be structures, steps, COMPOUNDS, chemicals, etc. *See* GENERIC/GENUS. (2:9, 3:7, 3:16, 4:1, 6:4, 6:7, 6:9)

SPECIFICATION--The drawings, DESCRIPTION and claims of a patent application or patent. *See* NEW MATTER. (1:1, 3:3, 3:6, 3:7, 3:24, 3:28.10, 3:28.11, 4:1, 4:10, 5:1, 6:3, 6:4, 6:5, 7:1, 8:5)

STATUTE--Title 35 of the United States Code (35 U.S.C.). (chapter 1; 1:1)

STATUTORY CLASSES--The main categories or "pigeonholes" into which a technical subject must fit in order to be potentially patentable. These categories are set forth in 35 U.S.C. §§ 101, 161 and 171 as interpreted by the case-law, and include PROCESS, MACHINE, MANUFACTURE, COMPOSITION OF MATTER, designs and plants. (1:3, 2:2)

STEP--A generalized word used in appropriate situations as an ELEMENT of a METHOD CLAIM. Used in step-plus-function or step-for-performing-a-function claim ELEMENT. *See* sixth paragraph of 35 U.S.C. § 112. (3:29)

STRUCTURAL CONNECTION--(3:23)

STRUCTURAL ORDER--A logical ordering of the ELEMENTS of a claim which begins with a base, power source or input and proceeds structurally to an ultimate ELEMENT or output. *See* FUNCTIONAL ORDER. (3:21)

SUBCOMBINATION--An ELEMENT or group of ELEMENTS that forms a part of a primary COMBINATION. If a SUBCOMBINATION has utility by itself, it may be claimed separately from the COMBINATION. (6:10, 8:5, 8:8)

SUBCOMBINATION FORMAT--A claim format for a SUBCOMBINATION: "In a (name of COMBINATION) for (COMBINATION'S FUNCTION), an X and a Y," where X, Y is the claimed SUBCOMBINATION. An exception to the "rule" that a TRANSITION should be between the PREAMBLE and BODY of a claim. (6:10)

***D-23 SUBPARAGRAPH FORM**--A claim format in which each ELEMENT is introduced and defined in its own indented subparagraph. *See* COLON-SEMICOLON FORM, OUTLINE FORM, SINGLE PARAGRAPH FORM. (2:8, 3:1, 3:3, 4:3)

SUPPORT FOR CLAIMS IN SPECIFICATION AND DRAWINGS--*See* ANTECEDENT. (3:6, 3:14)

SURPLUSAGE--*See* LAUDATORY STATEMENTS. (2:7)

TABULAR FORM--Same as SUBPARAGRAPH FORM. (2:8)

THE--The definite article THE is used to refer to an ELEMENT which has been introduced earlier in a claim. Alternatively SAID may be used, meaning the same thing. (2:9, 3:14)

THEREBY--*See* WHEREBY. (3:25, 3:26)

TRADEMARKED MATERIALS--(6:3)

TRANSITION/TRANSITIONAL PHRASE--Language between the PREAMBLE and BODY of a claim. May affect the SCOPE of the claim. *See* COMPRISES, CONSISTING OF, CONSISTING ESSENTIALLY OF, INCLUDES, HAS. (2:5, 2:6, 2:7, 3:1, 6:10)

ULTIMATE SPECIES--A SPECIES which cannot be further divided into other SPECIES. Example: Silver is an ultimate species of the genus "conductive metals." (6:9)

UNBASED COMPARATIVE--An adjective, such as "thick," "heavy," "small," etc., used in a claim wherein no basis for the use thereof (*i.e.*, thicker, heavier, smaller than what?) is set forth. The remedy is to provide a basis or relation for comparison, such as "said second member being thicker than said first member." Many words, such as resilient, flexible, etc., while, strictly speaking, UNBASED, are usually accepted without question. An UNBASED COMPARATIVE is a ground for REJECTION or OBJECTION, because its use may render a claim INDEFINITE. (3:16)

UNDUE MULTIPLICITY--Presentation of too many claims in view of the nature and SCOPE of the INVENTION. *See* Rule 75(b), M.P.E.P. § 706.03(1). (2:9, 2:11, 6:2, 6:5, 7:1, 8:4)

USEFUL/UTILITY--An INVENTION must be USEFUL, and have some definable use. An INVENTION that is without use, or that is scientifically impossible, lacks UTILITY.

***D-24 USPQ**--The *United States Patent Quarterly*, a case reporter published quarterly and advance sheets in a magazine published weekly by BNA, Inc., and covering cases on patents, trademarks, copyrights, intellectual property, etc., from any forum.

USPTO--The United States Patent and Trademark Office, which handles the filing, prosecution, and grant of U.S. patents.

UTILITY PATENT--Patents defining INVENTIONS having industrial utility (METHOD, APPARATUS, ARTICLE OF MANUFACTURE, COMPOSITION OF MATTER) as distinguished from design patents (§ 5:3) and plant patents (§ 5:4). (1:2, 6:2)

VAGUE--*See* INDEFINITE. (3:16, 8:9)

VARYING SCOPE OF CLAIMS--(chapter 8)

WHEREBY--When properly used in a claim, a word introducing a clause describing the FUNCTION or operation necessarily following from previously recited structure, whether a whole claim or an ELEMENT thereof. The phrase traditionally means "it necessarily follows from the foregoing that." Such a WHEREBY clause is improper when it is used to *imply* structural or cooperational relationships which are not positively recited in the claim. (3:25, 3:26, 3:27, 4:1)

WORKPIECE--The thing or ARTICLE operated on, altered, changed or reduced by a claimed APPARATUS or METHOD. It should be introduced in the PREAMBLE of the claim, and/or introduced INFERENTIALLY in the BODY of the claim. (3:1, 3:2, 3:3, 3:21, 3:24, 4:1, 4:2)

WRITTEN DESCRIPTION--*See* DESCRIPTION.

[FN1]. References are to sections of the book where the term is used expressly or implicitly; **boldface numerals** indicate sections where the term is defined or discussed in detail. UPPER CASE designates terms defined in the glossary.

PLIREF-PATCLAIM App. D

END OF DOCUMENT