that are disclosed in the publication. Rejections under 35 USC §102 are called rejections for "anticipation." They are also called 102-rejections.

Patent examiners cite 35 USC §103, when the examiner finds two or more publications, where the combination of these publications (when taken together) disclose every aspect of the claim. In other words, rejections under 35 USC §103 are imposed where there is a one-to-one correspondence between every element in the claim (every phrase in the claim), and elements found in the combination of the two or more publications. Rejections under 35 USC §103 are called rejections for obviousness.

Examiners cite 35 USC §112 when the examiner believes the claim to be non-enabled. In other words, when an examiner believes that a typical skilled artisan would not be able to make and use the invention, as claimed, the examiner imposes a rejection under 35 USC §112.

Now, let us turn our attention to sources of law that are found in published courtroom opinions. Patent opinions from the Federal Circuit and from the U.S. district courts can be found on LEXIS NEXIS®, Westlaw®, and on Google Scholar®. Patent opinions from the European courts can be found at www.epo.org.

A few examples of holdings in the case law from the Federal Circuit are as follows. The case law holding that only working examples (and not prophetic examples) can be written the past tense can be found in *Hoffmann-LaRoche, Inc. v. Promega Corp.* (34). Case law holding that inventors must submit publications to the Patent Office that are relevant to the claims, during the time when a patent application is in the prosecution phase, includes *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.* (35). If the inventors prefer to keep these publications to themselves, and if the inventors hope that the patent examiner will never find them on her own, the result can be harsh, adverse consequences to the company. The requirement to submit these publications has been reviewed (36).

Case law holding that people who only supply "common knowledge" must not be named as inventors includes *Hess v. Advanced Cardiovascular Sys., Inc.* (37). Case law holding that rejections for anticipation must be based on a one-to-one correspondence between what is found in a prior art publication, and all of the elements in one particular claim, include *Verdegaal Bros. v. Union Oil Co. of California* (38). This courtroom opinion held that, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

[34] Hoffmann-LaRoche, Inc. v. Promega Corp., 323 F.3d 1354 (Fed. Cir. 2003).
[35] Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc. 326 F.3d 1226 (Fed. Cir. 2003).
[36] Brody T. Duty to Disclose: Dayco Products v. Total Containment. *The John Marshall Law School Review of Intellectual Property Law*. 2008;7:325–375.
[37] Hess v. Advanced Cardiovascular Sys., Inc., 106 F.3d 976, 980-81 (Fed. Cir. 1997).
[38] Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628 (Fed. Cir. 1987).