

UNDERSTANDING PATENT LAW

LEXISNEXIS LAW SCHOOL ADVISORY BOARD

William Araiza

Professor of Law
Brooklyn Law School

Ruth Colker

Distinguished University Professor & Heck-Faust Memorial Chair in Constitutional Law
Ohio State University Moritz College of Law

Olympia Duhart

Associate Professor of Law
Nova Southeastern University Shepard Broad Law School

Samuel Estreicher

Dwight D. Opperman Professor of Law
Director, Center for Labor and Employment Law
NYU School of Law

David Gamage

Assistant Professor of Law
UC Berkeley School of Law

Joan Heminway

College of Law Distinguished Professor of Law
University of Tennessee College of Law

Edward Imwinkelried

Edward L. Barrett, Jr. Professor of Law
UC Davis School of Law

Paul Marcus

Haynes Professor of Law
William and Mary Law School

Melissa Weresh

Director of Legal Writing and Professor of Law
Drake University Law School

Understanding Patent Law

Amy L. Landers

Professor of Law

University of the Pacific, McGeorge School of Law

Print ISBN: 978-0-7698-5276-8

eBook ISBN: 978-0-3271-8118-7

This publication is designed to provide accurate and authoritative information in regard to the subject matter covered. It is sold with the understanding that the publisher is not engaged in rendering legal, accounting, or other professional services. If legal advice or other expert assistance is required, the services of a competent professional should be sought.

LexisNexis, the knowledge burst logo, and Michie are trademarks of Reed Elsevier Properties, Inc., used under license. Matthew Bender is a registered trademark of Matthew Bender Properties Inc.

Copyright © 2012 Matthew Bender & Company, Inc., a member of LexisNexis.

No copyright is claimed in the text of statutes, regulations, and excerpts from court opinions quoted within this work. Permission to copy material exceeding fair use, 17 U.S.C. § 107, may be licensed for a fee of 25¢ per copy from the Copyright Clearance Center, 222 Rosewood Drive, Danvers, Mass. 01923, telephone (978) 750-8400.

Library of Congress Cataloging-in-Publication Data

Landers, Amy L.
Understanding patent law / Amy L. Landers.
p. cm.
Includes bibliographical references and index.
ISBN 978-0-7698-5276-8 (softbound)
1. Patent laws and legislation--United States. I. Title.
KF3114.L36 2012
346.7304'86--dc23
2012024160

NOTE TO USERS: To ensure that you are using the latest materials available in this area, please be sure to periodically check the LexisNexis Law School web site for downloadable updates and supplements at www.lexisnexis.com/lawschool.

Editorial Offices
121 Chanlon Rd., New Providence, NJ 07974 (908) 464-6800
201 Mission St., San Francisco, CA 94105-1831 (415) 908-3200
www.lexisnexis.com

MATTHEW  BENDER

Preface

Patent law is an important, fascinating, and rapidly changing field. Built on an incentive structure, this area of the law is intended to encourage the development of new solutions. The topic can be provocative. For those interested in a system developed to create the future, the study of patent law can be eminently rewarding.

Over the past few years since the first edition was published, there have been numerous substantive changes in the law. Both the U.S. Supreme Court and the Court of Appeals for the Federal Circuit have issued several key decisions. In enacting the America Invents Act of 2011, the U.S. Congress has passed some of the most significant changes in patent law in the past sixty years. The U.S. Patent & Trademark Office has been active in implementing these changes, and instituting other changes to improve the field. This book incorporates these modifications. Where the former law has continued relevance, both the old and new versions are presented.

For those who are new to patent law, a word of advice: Patience. Even if you have prior legal experience, the terminology, history, and science described in the major cases can be new and complicated. The rules and statutes present intellectual challenges. This book is intended to provide a roadmap for your exploration of the law and theory, and to explain the more difficult areas of the law and the science. This should enable you to more fully understand this intriguing field.

Frequent Citations and Abbreviations

“The 1952 Patent Act” refers to all amendments to 35 U.S.C. that were enacted in 1952 including the former version of 35 U.S.C § 102.

The “AIA” refers to the America Invents Act of 2011, enacted at 35 U.S.C.

“House report” is the document titled AMERICA INVENTS ACT, H.R. Rep. No. 112-98 (2011).

“MANUAL OF PATENT EXAMINING PROCEDURE” is the United States Patent and Trademark Office, MANUAL OF PATENT EXAMINING PROCEDURE. This document is available at <http://www.uspto.gov/web/offices/pac/mpep/index.htm>, and in many law libraries.

“Patent Act” is the statute set forth in 35 U.S.C.

“TRIPS” is the Agreement on Trade-Related Aspects of Intellectual Property Rights, administered by the World Trade Organization. A copy is available at http://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm.

“U.S. PTO” used throughout refers to the United States Patent and Trademark Office.

Statutory citations refer to those under Title 35, U.S. Code unless otherwise specified.

Citations to the Code of Federal Regulations refer to those under Title 37 unless otherwise specified.

Table of Contents

Chapter 1	INTRODUCTION TO THE PATENT SYSTEM	1
§ 1.01	THE PATENT RIGHT	1
§ 1.02	HISTORY AND ORIGINS OF THE PATENT RIGHT	2
[A]	Early European Patent Systems	2
[B]	The British Patent System and the Statute of Monopolies	3
§ 1.03	U.S. CONSTITUTIONAL BASIS: ADOPTION OF THE COPYRIGHT AND PATENT CLAUSE	5
[A]	The Patent System and the U.S. Constitution	5
[B]	Congressional Adoption of the Patent System	7
[C]	Current Events: The America Invents Act of 2011	8
§ 1.04	FOUNDATIONS OF MODERN U.S. PATENT LAW	9
[A]	The Legal Foundation of Patent Rights	9
[B]	Patent Rights as an Appropriation Mechanism	11
[C]	Incentives and Patent Law	13
§ 1.05	HOW DOES THE PATENT “RIGHT TO EXCLUDE” OPERATE?	14
§ 1.06	WHAT DOES ONE DO WITH A PATENT?	15
§ 1.07	CONCLUSION	16
Chapter 2	THE U.S. PTO: OBTAINING A PATENT	19
§ 2.01	INTRODUCTION	19
§ 2.02	PATENT APPLICATIONS: PRE-FILING CONSIDERATIONS	21
§ 2.03	THE PATENT APPLICATION	22
[A]	Provisional v. Non-provisional Patent Applications	22
[B]	Non-provisional Utility Patent Applications	23
[C]	Some Details: A Closer Look at a Patent Specification	25
§ 2.04	PATENT PROSECUTION AND INFORMATION SHARING	26
[A]	Patent Application Secrecy and Publication	26
[B]	Communication with the U.S. PTO	27
[C]	International Applications and Work Sharing	28
§ 2.05	EXAMINATION PROCEDURES	28
[A]	Intake and Examination	28
[B]	Final Office Actions	30
[1]	Allowance	30
[2]	Rejection and Appellate Options	30
[C]	Continuation Applications	31
§ 2.06	INTERNATIONAL CONSIDERATIONS AND THE PCT APPLICATION PROCESS	32
§ 2.07	CONCLUSION	34

Table of Contents

Chapter 3	POST-GRANT ADMINISTRATIVE PROCEEDINGS	35
§ 3.01	INTRODUCTION	35
§ 3.02	RE-ISSUE	37
[A]	Background to Reissue Proceedings	37
[B]	Defining “Error” for Purposes of Reissue	38
[C]	Limitations on Reissue	40
[1]	Two Year Limit on Broadening Reissue	40
[2]	The Rule Against Recapture	40
§ 3.03	THE DOCTRINE OF INTERVENING RIGHTS	41
§ 3.04	CERTIFICATE OF CORRECTION	44
§ 3.05	REEXAMINATION	46
[A]	Generally	46
[B]	<i>Ex Parte</i> Reexamination	46
[C]	The Former <i>Inter partes</i> Reexam	48
§ 3.06	POST-GRANT REVIEW	49
§ 3.07	<i>INTER PARTES</i> REVIEW	52
§ 3.08	SUPPLEMENTAL EXAMINATION	53
§ 3.09	DETERMINING INVENTORSHIP	55
§ 3.10	CONCLUSION	56
Chapter 4	CLAIMS	57
§ 4.01	BACKGROUND	57
§ 4.02	WHAT IS A CLAIM LIMITATION?	60
§ 4.03	THE ANATOMY OF A CLAIM	60
[A]	The Preamble	61
[B]	The Transition	61
[C]	The Body of the Claim	62
§ 4.04	TYPES OF CLAIMS	62
[A]	Independent Claims, Dependent Claims and Multiple Dependent Claims	62
[B]	Apparatus Claims	63
[C]	Process and Method Claims	63
[D]	Product-By-Process Claims	64
[E]	Composition Claims	65
[F]	Combination Claims	65
[G]	Means-Plus-Function Claims	65
[H]	Markush Claims	66
[I]	<i>Jepson</i> Claims	67
§ 4.05	CONCLUSION	68

Table of Contents

Chapter 5	PATENT TYPES	69
§ 5.01	INTRODUCTION	69
§ 5.02	UTILITY PATENTS	69
§ 5.03	DESIGN PATENTS	70
§ 5.04	PLANT PATENTS	73
§ 5.05	PLANT VARIETY PROTECTION ACT CERTIFICATE	74
§ 5.06	CONCLUSION	75
Chapter 6	ADJUDICATION OF PATENT DISPUTES WITHIN THE COURT SYSTEM	77
§ 6.01	INTRODUCTION	77
§ 6.02	U.S. DISTRICT COURT ACTIONS	78
[A]	Subject Matter Jurisdiction	78
[B]	Standing to Sue for Infringement	81
[C]	Declaratory Judgment Jurisdiction	81
[D]	Personal Jurisdiction and Venue	82
§ 6.03	THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT	84
[A]	Background	84
[B]	The Jurisdiction of the Federal Circuit	85
§ 6.04	PATENT LITIGATION IN THE INTERNATIONAL TRADE COMMISSION	86
§ 6.05	CONCLUSION	87
Chapter 7	OVERVIEW: THE DISCLOSURE REQUIREMENTS OF § 112	89
§ 7.01	INTRODUCTION	89
§ 7.02	HISTORY AND POLICY OF PATENT DISCLOSURE	90
§ 7.03	ASSESSING THE ADEQUACY OF THE DISCLOSURE REQUIREMENTS	91
§ 7.04	CONCLUSION	92
Chapter 8	ENABLEMENT	93
§ 8.01	INTRODUCTION	93
§ 8.02	THE ENABLEMENT ANALYSIS	94
[A]	Generally	94
[B]	The Historic Perspective: <i>O'Reilly v. Morse</i>	95
[C]	Edison's Light Bulb: <i>Consolidated Electric Light Co. v. McKeesport Light Co.</i>	96
[D]	A Comparison: Bell's Telephone Patent	97
§ 8.03	ENABLEMENT AND CLAIM SCOPE	97

Table of Contents

§ 8.04	UNDUE EXPERIMENTATION	100
[A]	The Modern Foundation of Undue Experimentation: The <i>Wands</i> Factors	100
§ 8.05	ENABLEMENT, PRIORITY AND TIMING	103
[A]	The Relevant State of the Art	103
[B]	Enablement and Priority	103
[C]	Enablement and Patent Enforcement	104
§ 8.06	ENABLEMENT AND UTILITY	105
§ 8.07	A BRIEF NOTE: SOME ECONOMIC CONSIDERATIONS	107
§ 8.08	CONCLUSION	108
 Chapter 9 WRITTEN DESCRIPTION		109
§ 9.01	INTRODUCTION	109
§ 9.02	GENERAL PRINCIPLES	110
§ 9.03	<i>ARIAD</i> : THE CURRENT LEGAL STANDARD	111
§ 9.04	APPLICATION OF THE POSSESSION TEST	114
[A]	Amendments During Prosecution	114
[B]	Benefit Of An Earlier Filing Date	116
[C]	Biological and Chemical Subject Matter	118
§ 9.05	COMPARISON: WRITTEN DESCRIPTION AND ENABLEMENT	120
§ 9.06	CONCLUSION	122
 Chapter 10 DEFINITENESS		123
§ 10.01	INTRODUCTION	123
§ 10.02	“PARTICULARLY POINT OUT AND DISTINCTLY CLAIM”	124
[A]	General Rules	124
[B]	Differing Definiteness Standards: Patent Applications v. Issued Patents	125
[C]	Assessing Whether a Claim is Definite	125
[D]	Indefiniteness and Means Plus Function Claims	126
[E]	Terms of Degree	127
[F]	Remedy: Should an Indefinite Claim Be Invalidated?	128
§ 10.03	“APPLICANT REGARDS:” THE INVENTOR’S DEFINITION	129
§ 10.04	CONCLUSION	131
 Chapter 11 BEST MODE		133
§ 11.01	OVERVIEW	133
§ 11.02	THE BEST MODE STANDARD	134
§ 11.03	APPLICATION OF THE BEST MODE STANDARD	135
[A]	First Prong: The Inventor’s Subjective Intent	136

Table of Contents

[B]	Second Prong: Objective Examination of the Patent Disclosure	137
§ 11.04	IMPACT OF A BEST MODE VIOLATION	140
§ 11.05	CONCLUSION	141
Chapter 12	OVERVIEW OF § 102: NOVELTY, STATUTORY BARS AND DERIVATION	143
§ 12.01	INTRODUCTION	143
§ 12.02	TERMINOLOGY RELEVANT TO A § 102 ANALYSIS	144
§ 12.03	THE PRE-AIA VERSION OF SECTION 102	145
[A]	The Structure of the Former Version of § 102	145
[B]	The Historic Underpinnings of the Pre-AIA Statute	147
§ 12.04	NOVELTY AND THE AMERICA INVENTS ACT	149
§ 12.05	SECTION 102’s “STRICT IDENTITY” REQUIREMENT	153
§ 12.06	INHERENCY	156
[A]	Defining Inherency	156
[B]	Accidental Inherency and Knowledge of an Inherent Property	158
[C]	Inherency and “New Use” Patents	160
§ 12.07	THE AIA: TAX STRATEGIES	162
§ 12.08	CONCLUSION	163
Chapter 13	PUBLIC KNOWLEDGE AND USE AS PRIOR ART	165
§ 13.01	INTRODUCTION	165
§ 13.02	TERRITORIALITY RESTRICTIONS: “KNOWN” OR “USED”	166
§ 13.03	PRIOR KNOWLEDGE	167
[A]	Prior Knowledge Must Be “Publicly Known”	167
[B]	Knowledge Must Be Enabling	168
§ 13.04	PRIOR USE	169
[A]	What is a “Public Use”?	169
[B]	Private vs. Public Uses	172
§ 13.05	THE EXPERIMENTAL USE EXCEPTION	174
§ 13.06	PROVING PRIOR KNOWLEDGE AND USE	175
§ 13.07	CONCLUSION	178
Chapter 14	PATENTS AND PRINTED PUBLICATIONS	179
§ 14.01	INTRODUCTION	179
§ 14.02	PRINTED PUBLICATIONS	181
[A]	Background: What is a “Printed Publication” under § 102?	181
[B]	“Printed Publications” and Public Accessibility	184
[1]	Development of the “Public Accessibility” Standard	185
[2]	The Current Standard: <i>In re Klopfenstein</i>	186

Table of Contents

§ 14.03	PRIOR PATENTS	188
§ 14.04	CONCLUSION	190
Chapter 15	PRIOR SALES AND OFFERS FOR SALE	191
§ 15.01	INTRODUCTION	191
§ 15.02	ON-SALE AND THE “READY FOR PATENTING” STANDARD	193
[A]	Introduction	193
[B]	The U.S. Supreme Court’s <i>Pfaff v. Wells Electronics, Inc.</i>	194
[C]	Applying the Pfaff “Ready for Patenting” Standard	196
§ 15.03	DEFINING AN “OFFER FOR SALE” OR “SALE”	197
§ 15.04	LICENSES AND ON-SALE ACTIVITY	199
§ 15.05	CONCLUSION	200
Chapter 16	ABANDONMENT AND THE PRE-AIA 35 U.S.C.	
	§ 102(c)	203
§ 16.01	INTRODUCTION	203
§ 16.02	HISTORIC BACKGROUND OF ABANDONMENT	204
§ 16.03	PATENTEE DELAY	205
§ 16.04	ABANDONED INVENTION v. ABANDONED APPLICATION	206
§ 16.05	DISCLOSED BUT UNCLAIMED SUBJECT MATTER	206
§ 16.06	CONCLUSION	207
Chapter 17	PRIOR PATENTS	209
§ 17.01	INTRODUCTION	209
§ 17.02	OPERATION OF THE PRE-AIA 35 U.S.C. § 102(d)	210
§ 17.03	IDENTIFYING PRIOR ART THAT IS “PATENTED”	211
§ 17.04	CLAIM SCOPE AND VALIDITY OF THE FOREIGN PATENT	212
§ 17.05	WHEN IS A FOREIGN INVENTION “PATENTED?”	214
§ 17.06	DISTINCTION BETWEEN § 102(d) AND THE “PATENTED” PROVISIONS OF §§ 102(a) & (b)	215
§ 17.07	CONCLUSION	215
Chapter 18	EARLIER FILED PATENTS AND APPLICATIONS ...	217
§ 18.01	INTRODUCTION	217
§ 18.02	U.S. PATENT APPLICATIONS	218
[A]	Origins of U.S. Patents as Prior Art	218
[B]	<i>In re Hilmer</i> : Prior U.S. Patents and Foreign Filings	221
§ 18.03	PATENT APPLICATIONS FILED UNDER THE PATENT COOPERATION TREATY	224
§ 18.04	PUBLISHED PATENT APPLICATIONS	225

Table of Contents

§ 18.05	CONCLUSION	225
<hr/>		
Chapter 19	DERIVATION AND INVENTORSHIP	227
<hr/>		
§ 19.01	INTRODUCTION	227
§ 19.02	INVENTORSHIP	228
[A]	Who is an Inventor under the Patent Act?	228
[B]	Joint Inventors and Ownership	230
[C]	Filing a Patent Application: The Inventor’s Oath	231
§ 19.03	WHAT IS “DERIVATION”?	231
[A]	The Legal Standard for Derivation	231
[B]	Application of § 102(f)’s Two-Prong Test	232
§ 19.04	DERIVATION ACTIONS UNDER THE AIA	234
§ 19.05	CORRECTION OF INVENTORSHIP	235
§ 19.06	CONCLUSION	236
<hr/>		
Chapter 20	THE FIRST TO INVENT SYSTEM	237
<hr/>		
§ 20.01	INTRODUCTION	238
§ 20.02	STRUCTURE AND OPERATION	239
§ 20.03	CONCEPTION AND REDUCTION TO PRACTICE	240
[A]	Conception	240
[1]	Complete Conception	241
[2]	Conception: Inventor Recognition and Appreciation of the Invention	242
[3]	Utility is Not Required to Establish Conception	243
[4]	Conception’s Corroboration Requirement	243
[B]	Reduction to Practice	244
[1]	Actual Reduction to Practice	244
[2]	Reduction to Practice: All Elements Requirement	244
[3]	Reduction to Practice: Demonstrating that the Invention Works for Its Intended Purpose	245
[4]	Inventor’s Appreciation and Recognition of the Invention’s Utility	246
[5]	Constructive Reduction to Practice	247
[C]	Simultaneous Conception and Reduction to Practice	248
§ 20.04	PRIORITY RULES UNDER § 102(g)	249
[A]	General Rule: The First to Reduce to Practice Has Priority	249
[B]	Diligence and the First to Conceive	249
§ 20.05	“ABANDONED, SUPPRESSED OR CONCEALED”	252
[A]	Overview of the Doctrine and Policy	252
[B]	Intentional Abandonment, Suppression or Concealment	252
[C]	Patentee Delay and an Inference of Abandonment, Suppression or Concealment	253

Table of Contents

[D]	Patentee’s Resumed Activity Negating a Finding of Abandonment, Suppression or Concealment	254
§ 20.06	CONCLUSION	255
Chapter 21	NONOBVIOUSNESS	257
§ 21.01	INTRODUCTION	257
§ 21.02	THE ORIGINS OF THE NONOBVIOUSNESS REQUIREMENT	259
[A]	Patentability Standards Prior to the Enactment of § 103	259
[B]	Origins of the Secondary Considerations of Nonobviousness	261
[C]	The Former “Flash of Creative Genius” Standard	261
§ 21.03	NONOBVIOUSNESS ANALYTIC FRAMEFORK: <i>GRAHAM</i> v. <i>JOHN DEERE</i>	263
§ 21.04	HOW IS PRIOR ART USED UNDER § 103?	265
§ 21.05	BACKGROUND: COMBINING MULTIPLE REFERENCES	266
§ 21.06	CURRENT LAW: <i>KSR INT’L CO. v. TELEFLEX INC.</i>	268
§ 21.07	OBVIOUS TO TRY: <i>IN RE KUBIN</i>	272
§ 21.08	DETERMINING THE SCOPE AND CONTENT OF THE PRIOR ART	273
[A]	What is “Prior Art” Under § 103?	273
[B]	A Reference Must Constitute Analogous Art	276
§ 21.09	SECONDARY CONSIDERATIONS OF NONOBVIOUSNESS	278
§ 21.10	NONOBVIOUSNESS AND COMBINATION CLAIMS	281
§ 21.11	CONCLUSION	282
Chapter 22	UTILITY	283
§ 22.01	INTRODUCTION	283
§ 22.02	OPERABLE UTILITY	285
§ 22.03	SPECIFIC OR PRACTICAL UTILITY	286
[A]	The Historical Context for the Modern Utility Standard	286
[B]	U.S. Supreme Court Sets § 101’s Utility Standard: <i>Brenner v. Manson</i>	288
[C]	Subsequent Development of the <i>Brenner</i> Utility Standard	289
§ 22.04	MORAL UTILITY	292
§ 22.05	SOME ECONOMIC CONSIDERATIONS RELATING TO THE UTILITY REQUIREMENT	294
§ 22.06	CONCLUSION	295
Chapter 23	STATUTORY SUBJECT MATTER	297
§ 23.01	INTRODUCTION	297
§ 23.02	PRODUCTS OF NATURE	298
[A]	History: Products of Nature and Natural Phenomenon	299
[B]	Products Made from Living Things: <i>Parke-Davis & Co. v. H.K. Mulford</i>	

Table of Contents

	<i>Co.</i>	300
[C]	Products of Nature v. Living Things: The Supreme Court’s <i>Diamond v. Chakrabarty</i>	301
[D]	Claims Derived from Nature: <i>Mayo v. Prometheus</i>	303
[E]	Emerging Issues: The <i>Myriad</i> Case	305
§ 23.03	ABSTRACT SUBJECT MATTER, BUSINESS METHODS AND SOFTWARE	307
[A]	Introduction	307
[B]	<i>Gottschalk v. Benson</i>	308
[C]	<i>Parker v. Flook</i>	309
[D]	<i>Diamond v. Diehr</i>	310
[E]	Patentable Subject Matter at the Federal Circuit	311
[F]	The Federal Circuit’s Restrictive Approach	313
§ 23.04	THE SUPREME COURT’S <i>BILSKI</i> OPINION	314
[A]	<i>Bilski</i> and the Prohibition on Abstract Subject Matter	314
[B]	<i>Bilski</i> ’s Progeny	316
§ 23.05	CONCLUSION	317
Chapter 24	PROCEDURES FOR CLAIM CONSTRUCTION	319
§ 24.01	INTRODUCTION	319
§ 24.02	COMPARISON: CLAIM INTERPRETATION AT THE U.S. PATENT & TRADEMARK OFFICE AND IN THE COURTS	321
§ 24.03	CLAIM INTERPRETATION IN THE COURTS	322
[A]	Former Law: Claim Construction Procedures	322
[B]	Current Law: <i>Markman v. Westview Instruments, Inc.</i>	323
[1]	<i>Markman</i> ’s Aftermath	325
§ 24.04	IMPLEMENTING <i>MARKMAN</i>	326
§ 24.05	CLAIM CONSTRUCTION AND THE ACCUSED DEVICE	328
§ 24.06	CONCLUSION	329
Chapter 25	HOW TO INTERPRET PATENT CLAIM TERMS	331
§ 25.01	INTRODUCTION	331
§ 25.02	HISTORY: FORMER APPROACHES TO CLAIM CONSTRUCTION	332
§ 25.03	THE CURRENT APPROACH: THE FEDERAL CIRCUIT’S EN BANC DECISION IN <i>PHILLIPS v. AWH CORP</i>	334
[A]	The <i>Phillips</i> Claim Construction Methodology	334
[B]	Application of the <i>Phillips</i> Claim Construction Methodology	338
§ 25.04	A CLOSER LOOK AT THE INTERACTION OF THE SPECIFICATION AND CLAIM TERMS	338
[A]	Putting a Claim Construction Analysis Together	338
[B]	The Patentee as Lexicographer: <i>SciMed</i>	340

Table of Contents

§ 25.05	CLAIM CONSTRUCTION AND VALIDITY	341
§ 25.06	CANONS OF CLAIM CONSTRUCTION	342
[A]	The Doctrine of Claim Differentiation	342
[B]	Construction of Terms in the Preamble	342
[C]	Additional Canons of Claim Construction	344
§ 25.07	CONCLUSION	345
<hr/>		
Chapter 26	AN INTRODUCTION TO PATENT INFRINGEMENT .	347
<hr/>		
§ 26.01	INTRODUCTION	347
§ 26.02	VIOLATION OF THE PROVISIONAL RIGHT	348
§ 26.03	OVERVIEW OF INFRINGEMENT THEORIES	349
[A]	Direct and Indirect Infringement	349
[B]	Literal Infringement and Infringement under the Doctrine of Equivalents	350
§ 26.04	CONCLUSION	351
<hr/>		
Chapter 27	DIRECT INFRINGEMENT	353
<hr/>		
§ 27.01	INTRODUCTION	353
§ 27.02	TYPES OF CLAIMS AND DIRECT INFRINGEMENT	354
[A]	Product, Device and Apparatus Claims	354
[B]	Process and Method Claims	356
§ 27.03	ACTS THAT CONSTITUTE INFRINGEMENT UNDER § 271(a)	358
[A]	“Makes”	358
[B]	“Uses”	359
[C]	“Offers to Sell”	360
[D]	“Sells”	361
[E]	“Imports into the U.S.”	362
§ 27.04	MULTIPLE INFRINGERS: DIVIDED INFRINGEMENT	362
§ 27.05	CONCLUSION	364
<hr/>		
Chapter 28	PRIOR USE RIGHTS	365
<hr/>		
§ 28.01	INTRODUCTION	365
§ 28.02	IMPLEMENTING THE PRIOR USE RIGHTS UNDER THE AIA	366
[A]	Prior Law	366
[B]	Prior use Rights Under the AIA	367
[1]	Subject Matter Scope	367
[2]	Who is a Prior User?	368
[3]	Effect of the Defense	369
[4]	The University Exclusion	369
§ 28.03	CONCLUSION	369

Table of Contents

Chapter 29	INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS	371
§ 29.01	INTRODUCTION	371
§ 29.02	<i>WINANS v. DENMEAD</i> : THE HISTORIC FOUNDATIONS OF THE DOCTRINE OF EQUIVALENTS	373
§ 29.03	THE DEVELOPMENT OF THE CURRENT DOCTRINE OF EQUIVALENTS: <i>GRAVER TANK & MFG. CO. v. LINDE AIR PRODUCTS CO</i>	375
§ 29.04	THE U.S. SUPREME COURT’S REFINEMENT OF THE DOCTRINE OF EQUIVALENTS: <i>WARNER-JENKINSON CO. v. HILTON DAVIS CHEMICAL CO</i>	376
[A]	Factual Background of the <i>Warner-Jenkinson</i> Opinion	376
[B]	<i>Warner-Jenkinson’s</i> Affirmation of the Doctrine of Equivalents	377
[C]	<i>Warner-Jenkinson</i> and the Principle Prosecution History Estoppel	378
[D]	The Doctrine of Equivalents and After-Arising Technology	379
§ 29.05	TESTS FOR INFRINGEMENT IN A POST- <i>WARNER-JENKINSON</i> ERA	380
§ 29.06	PUTTING THE DOCTRINE TOGETHER: AN EXAMPLE OF THE APPLICATION OF THE <i>WARNER-JENKINSON</i> STANDARD	383
§ 29.07	THE REVERSE DOCTRINE OF EQUIVALENTS	384
§ 29.08	CONCLUSION	385
Chapter 30	RESTRICTIONS ON THE DOCTRINE OF EQUIVALENTS	387
§ 30.01	INTRODUCTION	387
§ 30.02	PROSECUTION HISTORY ESTOPPEL: THE <i>FESTO</i> CASES	388
[A]	Overview of the Doctrine of Prosecution History Estoppel	388
[B]	<i>Festo</i> : The Ground Rules of Prosecution History Estoppel	389
[C]	<i>Festo</i> : The Federal Circuit’s Refinement	392
[D]	Putting the <i>Festo</i> Analysis Together: Application of the Doctrine of Prosecution History Estoppel	393
§ 30.03	ADDITIONAL RESTRICTION ON THE DOCTRINE OF EQUIVALENTS: AN EQUIVALENT CANNOT ENCOMPASS THE PRIOR ART	394
§ 30.04	THE PUBLIC DEDICATION RULE	395
§ 30.05	THE DOCTRINE OF EQUIVALENTS CANNOT VITIATE AN ENTIRE CLAIM ELEMENT	396
§ 30.06	CONCLUSION	397
Chapter 31	CLAIM CONSTRUCTION OF MEAN PLUS FUNCTION CLAIM TERMS	399
§ 31.01	INTRODUCTION	399
§ 31.02	IDENTIFYING A “MEANS PLUS FUNCTION” CLAIM TERM	401

Table of Contents

§ 31.03	EXAMPLE: CLAIM CONSTRUCTION UNDER § 112, ¶ 6	402
§ 31.04	LITERAL INFRINGEMENT ANALYSIS FOR MEANS PLUS FUNCTION CLAIMS	404
[A]	Literal Infringement of Claims Governed by § 112, ¶ 6	405
[B]	Literal Infringement and After-Arising Technologies	407
[C]	Application of the Literal Infringement Standard for Claims Governed by § 112, ¶ 6 Governing Rules: <i>Al-Site Corp. v. VSI Int’l, Inc.</i>	407
§ 31.05	INFRINGEMENT OF A MEANS PLUS FUNCTION CLAIM UNDER THE DOCTRINE OF EQUIVALENTS	408
[A]	Doctrine of Equivalents and Functional Claims	408
[B]	A Comparison of “Equivalent Structure” for § 112, ¶ 6 Limitations: Literal and Doctrine of Equivalents Infringement	410
§ 31.06	CONCLUSION	411
Chapter 32		
	EXPERIMENTAL USE	413
§ 32.01	INTRODUCTION	413
§ 32.02	COMMON LAW EXPERIMENTAL USE	414
[A]	The Origins of Common Law Experimental Use	414
[B]	Current Standards: Common Law Experimental Use	415
§ 32.03	STATUTORY EXPERIMENTAL USE: 35 U.S.C. § 271(e)	418
[A]	The Background and Structure of Statutory Experimental Use	418
[B]	Statutory Experimental Use and the FDA Approval Process	419
[C]	The Supreme Court’s Construction of Statutory Experimental Use: <i>Merck KGaA v. Integra Lifesciences I, Ltd.</i>	420
§ 32.04	CONCLUSION	421
Chapter 33		
	CONTRIBUTORY INFRINGEMENT	423
§ 33.01	INTRODUCTION	423
§ 33.02	POLICY ISSUES RELATING TO CONTRIBUTORY INFRINGEMENT	425
§ 33.03	“A MATERIAL PART OF THE INVENTION”	426
§ 33.04	KNOWLEDGE OF USE FOR INFRINGEMENT	426
§ 33.05	SUBSTANTIAL NONINFRINGEMENT USES	427
§ 33.06	DIRECT INFRINGEMENT	430
§ 33.07	CONCLUSION	431
Chapter 34		
	ACTIVE INDUCEMENT	433
§ 34.01	INTRODUCTION	433
§ 34.02	INTENT TO INDUCE INFRINGEMENT	435
§ 34.03	CONDUCT THAT INDUCES INFRINGEMENT	437
§ 34.04	DIRECT INFRINGEMENT BY ANOTHER	437

Table of Contents

§ 34.05	CONCLUSION	438
Chapter 35	EXTRATERRITORIAL ACTIVITY AND PATENT INFRINGEMENT	439
§ 35.01	INTRODUCTION	440
§ 35.02	SECTION 271(a) AND EXTRATERRITORIAL ACTIVITY	441
[A]	Infringing Uses: <i>NTP, Inc. v. Research in Motion, Ltd.</i>	441
[B]	The Locus of an Infringing Offer to Sell and Infringing Sales	443
[1]	Offers for Sale and Sales Outside the U.S.	443
[2]	Extra-Territorial Activity Directed toward the U.S.	444
§ 35.03	EXPORTING COMPONENTS FROM THE U.S.	444
[A]	“Makes” and Extraterritorial Activity: <i>Deepsouth Packing Co. v. Laitram Corp.</i>	444
[B]	The Enactment of Section 271(f): Closing the <i>Deepsouth</i> Loophole ...	446
[C]	Interpretation of Section 271(f): What is a “Component of a Patented Invention”?	447
[1]	Designs and Plans	448
[2]	Tangible Items and Section 271(f): Software	448
[3]	Method Claims and Section 271(f)	450
§ 35.04	SECTION 271(G) AND THE IMPORTATION OF PRODUCTS INCORPORATING U.S. PATENTED INVENTIONS	451
[A]	The Enactment of Section 271(g)	451
[B]	The Operation of Section 271(g)	452
§ 35.05	INFRINGEMENT ACTIONS BEFORE THE U.S. INTERNATIONAL TRADE COMMISSION	455
[A]	The Jurisdiction of the International Trade Commission	455
[B]	The International Trade Commission Process	455
[C]	Section 271(g) and Patent Infringement in the International Trade Commission	457
§ 35.06	CONCLUSION	458
Chapter 36	INEQUITABLE CONDUCT AND THE DUTY TO DISCLOSE	459
§ 36.01	INTRODUCTION	459
§ 36.02	INEQUITABLE CONDUCT: HISTORY AND POLICY	460
[A]	Origins in Equity	460
[B]	Development of Inequitable Conduct	463
§ 36.03	THE CURRENT STANDARD FOR INEQUITABLE CONDUCT	464
[A]	<i>Therasense</i> : Intent to Deceive	465
[B]	A Closer Examination of the Materiality Standard	466
[C]	Application of the <i>Therasense</i> Standard	466

Table of Contents

§ 36.04	REGULATION OF ATTORNEY CONDUCT BY THE U.S. PATENT & TRADEMARK OFFICE	467
§ 36.05	SUPPLEMENTAL EXAMINATION AND INEQUITABLE CONDUCT	469
§ 36.06	CONCLUSION	469
Chapter 37	PATENT MISUSE	471
§ 37.01	INTRODUCTION	471
§ 37.02	THE ORIGINS OF THE PATENT MISUSE DOCTRINE	472
[A]	Early Common Law Roots	472
[B]	The <i>Mercoid</i> Cases: Patent Misuse and Contributory Infringement . . .	474
§ 37.03	THE 1952 PATENT ACT: <i>DAWSON CHEMICAL v. ROHM & HAAS</i> . .	475
§ 37.04	THE 1988 AMENDMENTS TO THE PATENT ACT: REFUSALS TO LICENSE AND MARKET POWER	476
§ 37.05	INCREASING THE TEMPORAL SCOPE OF A PATENT LICENSE . .	478
§ 37.06	TYING AND PATENT POOLS	480
§ 37.07	CONCLUSION	482
Chapter 38	PATENTS AND ANTITRUST LAW	483
§ 38.01	INTRODUCTION	483
§ 38.02	TYING CLAIMS	485
[A]	Defining the Relevant Terminology: Tying, Per Se Illegality and the Rule of Reason	485
[B]	The Evolving Jurisprudence of Patent Tying Cases	487
§ 38.03	UNILATERAL REFUSALS TO LICENSE A PATENT	489
§ 38.04	SETTLEMENTS AND REVERSE PAYMENTS	492
§ 38.05	PATENT INFRINGEMENT LITIGATION AND THE SHAM EXCEPTION	495
[A]	Background: Anticompetitive Patent Infringement Litigation: <i>Handgards, Inc. v. Ethicon, Inc.</i>	495
[B]	The First Amendment and <i>Noerr-Pennington</i> Immunity	496
[C]	The Sham Exception to <i>Noerr-Pennington</i> Immunity	496
§ 38.06	FRAUDULENT PROCUREMENT OF A PATENT: <i>WALKER PROCESS CLAIMS</i>	498
§ 38.07	CONCLUSION	500
Chapter 39	EXHAUSTION AND THE FIRST SALE DOCTRINE . . .	501
§ 39.01	INTRODUCTION	501
§ 39.02	FIRST SALE AND EXHAUSTION	502
§ 39.03	EXHAUSTION: UNAUTHORIZED AND FOREIGN SALES	505
§ 39.04	POST SALE RESTRICTIONS	505

Table of Contents

§ 39.05	THE DOCTRINE OF REPAIR/RECONSTRUCTION	507
[A]	The Analytic Framework	507
[B]	The Sequential Replacement of Parts	508
§ 39.06	REPLACEMENTS THAT ARE “AKIN TO REPAIR”: <i>HUSKY INJECTION MOLDING SYSTEMS, LTD. v. R & D TOOL ENGINEERING CO</i>	509
§ 39.07	CONCLUSION	510
Chapter 40		
	PROSECUTION LACHES	511
§ 40.01	INTRODUCTION	511
§ 40.02	THE HISTORIC FOUNDATIONS OF PROSECUTION LACHES	514
§ 40.03	THE CURRENT STANDARD	515
[A]	Delay	515
[B]	Prejudice	517
§ 40.04	CONCLUSION	518
Chapter 41		
	REMEDIES FOR PATENT INFRINGEMENT	519
§ 41.01	INTRODUCTION	520
§ 41.02	INJUNCTIVE RELIEF	521
[A]	Permanent Injunctive Relief	521
[1]	Statutory Basis and Former Law	521
[2]	The Current Standard: <i>eBay v. MercExchange</i>	522
[3]	Application of the <i>eBay</i> Standard	523
[5]	Compensation for Ongoing Infringement	525
[B]	Preliminary Injunctions	525
§ 41.03	MONETARY RELIEF: STATUTORY BACKGROUND	526
§ 41.04	MONETARY RELIEF: LOST PROFITS	527
[A]	The <i>Panduit</i> Test: Proof of a Causal Relationship to Infringement	527
[B]	Spotlight on the Second <i>Panduit</i> Factor: Availability of Non-Infringing Alternatives	529
[C]	Lost Profits: Price Erosion	530
[D]	Market Share Calculation of Lost Profits	530
§ 41.05	MONETARY RELIEF: REASONABLE ROYALTY	532
[A]	Established Royalty	532
[B]	The Analytic Approach	533
[C]	The Reasonable Royalty Based on a Hypothetical Negotiation	533
§ 41.06	MONETARY RELIEF: ADDITIONAL CONSIDERATIONS	536
[A]	The Entire Market Value Rule	536
[B]	Patentee Delay and the Ability to Recover Monetary Relief	538
[C]	Actual and Constructive Notice/Marking	539
§ 41.07	WILLFUL INFRINGEMENT AND EXCEPTIONAL CASES	540
§ 41.08	PREJUDGEMENT INTEREST	542

Table of Contents

§ 41.09	CONCLUSION	542
Chapter 42	INTERNATIONAL TREATIES AND THE GLOBALIZATION OF PATENTS	543
§ 42.01	INTRODUCTION	543
§ 42.02	THE PARIS CONVENTION OF 1883	544
§ 42.03	COORDINATION OF PATENT APPLICATION FILING: THE PATENT COOPERATION TREATY AND THE EUROPEAN PATENT CONVENTION	545
§ 42.04	TRIPS: THE WORLD TRADE ORGANIZATION AND THE AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS	546
§ 42.05	CONCLUSION	548
	GLOSSARY	549
	TABLE OF CASES	TC-1
	INDEX	I-1
