
TABLE OF CONTENTS

FOREWORD TO THE FIRST EDITION	III
PREFACE TO THE SEVENTH EDITION.....	VII
ACKNOWLEDGMENTS.....	XI
TABLE OF CASES.....	XXV
TABLE OF AUTHORITIES	XLI
Chapter 1. History, Policy, and the Patent Document.....	1
A. Introduction.....	1
B. History of Patent Law.....	4
1. The Classical Period.....	4
2. European Origins	5
a. The Italian Renaissance	5
b. English Patent Policy and the Statute of Monopolies.....	7
3. The American Experience.....	8
C. Theories of Patent Law.....	16
1. Lockean Labor Theory and Natural Rights.....	17
2. Utilitarian Theory	22
D. Economics of Patent Law	24
1. Patents and the Concept of Monopoly	25
2. Monopoly Microeconomics and Deadweight Loss	27
3. Public Goods and Patent Economics	32
4. Incentive Theories for Patent Law.....	35
a. Incentive to Invent	35
b. Incentive to Disclose.....	37
c. Incentive to Commercialize	38
d. Incentive to Design Around	40
5. Conclusion	40
Chapter 2. Obtaining the Patent Grant	41
A. Introduction.....	41
B. The Patent Application and Issued Patent	42
1. The Written Description	45
a. Background of the Invention	45
b. Summary of the Invention.....	46
c. Drawings and Detailed Description of the Invention	47
d. The Drawings	51
2. The Claims.....	51
a. Composition Claims	54
b. Process Claims.....	55
c. Apparatus Claims.....	55
d. Product-by-Process Claims	56
e. Means-Plus-Function Claims	56
C. Procedures Before the Patent and Trademark Office	57
1. Initial Processing of the Application.....	57

2.	Examination and Prosecution	57
a.	Formalities and Search by the Examiner.....	57
b.	Office Action	58
c.	Applicant's Response.....	58
d.	Reconsideration and Allowance.....	59
e.	Responses to a Final Office Action.....	59
f.	Publication.....	60
g.	Patent Term Calculation	62
h.	Post-Allowance Activity	63
i.	Foreign Priority	63
3.	Appeals to the Courts	64
Chapter 3. Utility and Subject-Matter Eligibility		65
A.	General Introduction	65
B.	Utility Basics.....	66
1.	Theory	66
2.	Forms: Operability, Beneficial Utility, and Practical Utility.....	68
C.	The Modern Doctrine of Practical Utility.....	70
	Brenner v. Manson	71
	Notes	76
	In re Brana	77
	Notes	84
	In re Fisher.....	85
	Notes	95
D.	Subject-Matter Eligibility Basics	97
E.	Medical and Biotechnology-Related Inventions.....	99
	Diamond v. Chakrabarty	99
	Notes	109
	Mayo Collaborative Services v. Prometheus Laboratories, Inc.	112
	Notes	122
	Association for Molecular Pathology v. Myriad Genetics, Inc.	124
	Notes	134
F.	Computer-Related Inventions and Business Methods	136
	Diamond v. Diehr.....	137
	Notes	146
	Bilski v. Kappos	148
	Notes	160
	Alice Corp. v. CLS Bank International	162
	Notes	172
G.	Non-Utility Patents	173
1.	Plant Patents.....	174
2.	The Plant Variety Protection Act of 1970.....	174
3.	Design Patents	175
a.	Application Process	176
b.	Validity.....	176
c.	Infringement.....	176
d.	Remedies.....	177

Chapter 4. Novelty	179
A. Introduction.....	179
B. Novelty Theory.....	180
C. Anticipation Analysis.....	181
1. Identity Requirement and Inherent Anticipation.....	181
<i>Prima Tek II, L.L.C. v. Polypap, S.A.R.L.</i>	182
Notes	186
<i>Allergan, Inc. v. Apotex, Inc.</i>	190
Notes	195
2. Enablement Requirement for Anticipation	197
<i>In re Paulsen</i>	198
Notes	200
D. Basics of Novelty Under AIA § 102.....	201
1. Filing Dates and Applicability of AIA § 102.....	202
2. Prior Art Basics Under AIA § 102(a)	205
3. AIA § 102(b) Exceptions.....	207
4. Questions and Answers	211
E. Basics of Pre-AIA Novelty and Loss of Right.....	214
1. The Basic Layout of Pre-AIA § 102	214
2. Pre-Invention Novelty Under Pre-AIA § 102	218
3. Statutory Bars Under Pre-AIA § 102.....	221
4. Nond derivation in Pre-AIA § 102.....	222
5. Distinctions Between Pre-AIA and AIA § 102	222
6. Summary Chart for Pre-AIA § 102	223
7. Questions and Answers	225
F. Categories of Prior Art Material	227
1. Printed Publication	227
<i>In re Cronyn</i>	228
Notes	231
<i>In re Klopfenstein</i>	232
Notes	239
<i>SRI International, Inc. v. Internet Security Systems, Inc.</i>	240
Note	253
2. Patented Matter	254
3. Backdated U.S. Patents and Patent Applications	255
<i>Alexander Milburn Co. v. Davis-Bournonville Co.</i>	255
Notes	257
4. Public Use, Knowledge, or Availability	258
a. Matter in “Public Use” or “Known or Used by Others”	259
<i>Egbert v. Lippmann</i>	259
Notes	263
<i>Delano Farms Co. v. California Table Grape Commission</i>	263
Note	270
<i>Rosaire v. Baroid Sales Division</i>	271
Notes	274
b. Experimental Use.....	275
<i>City of Elizabeth v. American Nicholson Pavement Co.</i>	276
Notes	280

Lough v. Brunswick Corp.	282
Notes	289
c. Inventor Use v. Third-Party Use.....	290
Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.....	291
Notes	292
Baxter International, Inc. v. COBE Laboratories, Inc.	293
Notes	299
5. Sale or Offer for Sale.....	301
Pfaff v. Wells Electronics, Inc.....	301
Notes	308
Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.....	313
Notes	322
6. Derivation.....	324
Gambro Lundia AB v. Baxter Healthcare Corp.....	324
Notes	329
7. Making in the U.S. and Foreign Activity Under Pre-AIA § 102	329
a. Matter “Made in this Country by Another Inventor”	330
Fleming v. Escort Inc.	330
Notes	336
b. Foreign Activity and Prior Art Under Pre-AIA § 102(e) and § 102(g)	341
In re Hilmer (Hilmer I)	342
In re Hilmer (Hilmer II).....	348
Notes	351
G. Priority, Invention, and Invention Date.....	352
1. Basic Law on Determining an Invention Date.....	353
Mahurkar v. C.R. Bard, Inc.....	353
Notes	357
2. Conception	361
Fiers v. Revel.....	361
Note.....	365
Burroughs Wellcome Co. v. Barr Laboratories, Inc.	366
Note.....	378
3. Reduction to Practice	379
DSL Dynamic Sciences Ltd. v. Union Switch & Signal, Inc.	379
Notes	383
4. Abandonment, Suppression, and Concealment	385
Fujikawa v. Wattanasin	385
Notes	394
Chapter 5. Nonobviousness	397
A. Introduction.....	397
1. Section 103 of the Patent Act	398
2. History of the Nonobviousness Requirement	400
B. Basics of Nonobviousness Analysis	403
1. The <i>Graham</i> Factors.....	403
<i>Graham</i> v. John Deere Co.	403

Notes	425
United States v. Adams	428
Notes	435
2. Identification of a “Reason to Combine”	436
KSR International Co. v. Teleflex Inc.	436
Notes	449
3. “Unpredictable” Versus “Predictable” Arts	451
In re Kubin	452
Notes	462
C. The Scope of the Prior Art	463
1. Analogous Versus Nonanalogous Art	463
In re Clay	463
In re Paulsen	466
Notes	468
2. Pre-AIA “Secret Prior Art” and § 103	470
a. Pre-AIA § 102(g) “Secret Prior Art” as § 103 Prior Art.....	470
In re Bass	471
Notes	481
b. Pre-AIA § 102(f) Prior Art as § 103 Prior Art.....	484
OddzOn Products, Inc. v. Just Toys, Inc.	484
Notes	489
D. The Content of the Prior Art and Comparison to the Claimed Invention.....	489
Callaway Golf Co. v. Acushnet Co.	490
Fresenius USA, Inc. v. Baxter International Inc.	498
Notes	504
E. Section 103’s Ordinary Artisan	508
1. Who Is the “Person Having Ordinary Skill in the Art”?	508
2. What Level of Skill Is “Ordinary”?	510
3. What Is the Breadth of the Hypothetical Person’s Knowledge?.....	511
4. How Does Common Sense Enter the Analysis?	511
Perfect Web Technologies, Inc. v. InfoUSA, Inc.	512
Notes	520
F. Secondary Considerations	520
1. Problems of Proof and Relative Weight	522
Apple Inc. v. Samsung Electronics Co.	522
Notes	542
2. Prominent Forms of Secondary Considerations.....	544
a. Commercial Success	544
b. Long-Felt Need and Failure of Others.....	547
c. Copying	548
d. Licensing or Acquiescence	549
e. Unexpected Results.....	550
In re Soni.....	551
Notes	562
Chapter 6. Disclosure Requirements	565
A. Introduction.....	565

B.	Enablement	566
1.	Historical and Policy Underpinnings.....	567
	O'Reilly v. Morse	567
	Notes	574
2.	State of the Art at Time of Filing, Undue Experimentation, and Claim Scope.....	580
	In re Glass	580
	Notes	584
	In re Hogan.....	589
	Notes	595
C.	Best Mode	599
	Notes	600
D.	Written Description	602
	Vas-Cath Inc. v. Mahurkar	602
	Notes	614
	Fujikawa v. Wattanasin	618
	Notes	622
E.	Definiteness: Particularly Pointing Out and Distinctly Claiming	624
	One-E-Way, Inc. v. International Trade Commission	625
	Notes	637
 Chapter 7. Procedures and Institutions		 641
A.	Introduction.....	641
B.	Overview of Patent Law Institutions	642
C.	Interactions with State Laws and Process	644
1.	State Court Jurisdiction	644
2.	State Laws and Federal Preemption	646
a.	Basics of Preemption.....	646
	Cover v. Hydramatic Packing Co.	646
	Notes	650
b.	Unfair Competition and Trade Secret Law	652
	Bonito Boats, Inc. v. Thunder Craft Boats, Inc.	652
	Notes	663
D.	Interactions Among Federal Players	665
1.	Allocating Work Between Judge and Jury	666
	Markman v. Westview Instruments, Inc. (Markman II).....	666
	Notes	672
2.	Standards of Review	673
	Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.	676
	Notes	689
3.	The Federal Circuit and the Supreme Court	691
a.	Scope of Federal Circuit Jurisdiction.....	691
b.	Supreme Court Review	692
E.	Post-Issuance Procedures.....	693
1.	Correction, Disclaimer, Reissue, and Supplemental Examination	694
a.	Correction	694
b.	Disclaimer.....	695
c.	Supplemental Examination.....	696

d. Reissue	696
i. Underlying Policies of Reissue	697
Topliff v. Topliff	698
Notes.....	700
ii. Correctable Errors and the Recapture Rule	701
In re Youman	702
Notes.....	712
iii. Intervening Rights	712
Seattle Box Co. v. Industrial Crating & Packing, Inc. (Seattle Box I)	713
Seattle Box Co. v. Industrial Crating & Packing Inc. (Seattle Box II).....	718
Notes.....	724
2. Ex Parte Reexamination and Inter Partes Review	725
Notes	726
3. Post-Grant and Covered Business Method Review	728
4. Supplemental Examination.....	729
Chapter 8. Claim Construction and Infringement.....	731
A. Introduction.....	731
B. Claim Construction	734
1. Interpretive Approaches and Evidentiary Sources.....	737
Vitronics Corp. v. Conceptronic, Inc.	739
Notes	747
2. Claim Construction in Action	755
Acumed LLC v. Stryker Corp.	756
Notes	769
C. The Doctrine of Equivalents and Prosecution History Estoppel	770
1. The Doctrine of Equivalents	770
a. Introduction	770
b. History of the Doctrine of Equivalents	772
c. The Doctrine After Creation of the Federal Circuit	775
Warner-Jenkinson Co. v. Hilton Davis Chemical Co.	776
Notes	787
d. Applying the Doctrine of Equivalents.....	796
Brilliant Instruments, Inc. v. Guidetech, LLC.....	796
Notes	803
2. Prosecution History Estoppel.....	804
Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co....	806
Notes	816
D. Infringement of Means Plus Function Claims—35 U.S.C. § 112(f)	821
Al-Site Corp. v. VSI International, Inc.	822
Notes	830
E. Direct Infringement	833
F. Indirect Infringement	835
1. Active Inducement	835
Hewlett-Packard Co. v. Bausch & Lomb, Inc.	835
Notes	840

2. Contributory Infringement.....	843
C.R. Bard, Inc. v. Advanced Cardiovascular Systems, Inc.....	843
Notes	845
G. Geographic Scope of the Patent Grant and Foreign Activity.....	848
1. Foreign Activity and Export Control—§ 271(f)	849
2. Foreign Activity and Import Control—§ 271(g)	851
Eli Lilly & Co. v. American Cyanamid Co.....	852
Notes	859
H. The Patent Term	861
1. The Default Patent Term	861
2. Patent Term Extensions	862
3. Enforcement Around the Patent Term’s Edges?	865
Chapter 9. Defenses and Limitations	867
A. Introduction.....	867
B. Inequitable Conduct	868
Therasense, Inc. v. Becton, Dickinson & Co.	869
Notes	889
C. Misuse and § 271(d)	892
Dawson Chemical Co. v. Rohm & Haas Co.	893
Notes	913
D. Antitrust	914
Nobelpharma AB v. Implant Innovations, Inc.	915
Notes	925
E. Exhaustion, Implied License, and Repair/Reconstruction	929
1. The Doctrine of Implied License	929
2. The Doctrine of Patent Exhaustion	931
Impression Products, Inc. v. Lexmark International, Inc.	931
Notes	940
3. The Doctrine of Repair/Reconstruction	944
Husky Injection Molding Systems Ltd. v. R & D Tool & Engineering Co.	944
Notes	950
F. Further Limitations on Contracting.....	953
1. The Licensee’s Right to Challenge the Validity of a Patent	953
Lear, Inc. v. Adkins	953
Notes	960
2. Post-Expiration Royalties and Restraints.....	963
Kimble v. Marvel Entertainment, LLC	963
Notes	974
G. Inventorship and Ownership	977
Ethicon, Inc. v. United States Surgical Corp.	978
Notes	993
H. Prior Use Defense—35 U.S.C. § 273.....	998
1. AIA § 273	999
2. Pre-AIA § 273	1000
I. Experimental Use	1001
Madey v. Duke University.....	1002
Notes	1007

J. Governmental Immunity	1009
1. Federal Government—28 U.S.C. § 1498.....	1009
2. State Government—11th Amendment and § 271(h)	1010
Chapter 10. Remedies.....	1013
A. Introduction.....	1013
B. Remedies That Compensate for Past Infringement: Money Damages and Interest	1013
1. Money Damages	1014
a. An Overview of Money Damages.....	1015
b. Lost Profits	1016
i. What Would the Infringer's Customers Have Done?	1016
BIC Leisure Products, Inc. v. Windsurfing International, Inc.....	1016
Notes.....	1021
ii. What Would the Patent Owner Have Done?	1023
Crystal Semiconductor Corporation v. TriTech Microelectronics International, Inc.	1024
Notes.....	1029
iii. What Else Would the Infringer Have Done?	1030
Grain Processing Corp. v. American Maize-Products Co.	1030
Notes.....	1037
c. Reasonable Royalty	1039
Lucent Technologies, Inc. v. Gateway, Inc.	1041
Notes	1055
d. Limitations on Awarding Money Damages	1058
i. Foreseeability.....	1058
Rite-Hite Corp. v. Kelley Co., Inc.	1058
Notes.....	1066
ii. The Entire Market Value Rule	1067
LaserDynamics, Inc. v. Quanta Computer, Inc.	1068
Notes.....	1074
iii. The Six-Year Rule—35 U.S.C. § 286	1076
iv. No Laches for Patent Infringement Damages	1076
v. The Marking or Notice Requirement—35 U.S.C. § 287(a)	1077
John L. Rie, Inc. v. Shelly Bros., Inc.	1078
Notes.....	1079
2. Compensation for Delayed Payment—Interest.....	1081
a. History of Prejudgment Interest	1081
b. Calculating Prejudgment Interest	1082
i. The Principal Amount.....	1082
ii. Selecting the Rate.....	1083
iii. Accrual Method.....	1084

C. Remedies That Prevent or Deter Future Infringement	1084
1. Injunctions.....	1085
a. Permanent Injunctions	1086
eBay Inc. v. MercExchange, LLC	1087
Notes	1091
Paice LLC v. Toyota Motor Corp.	1096
Note	1100
b. Preliminary Injunctions.....	1100
Sanofi-Synthelabo v. Apotex, Inc.	1102
Notes	1112
i. Who Cannot Be Enjoined.....	1114
ii. Stay of Injunction Pending Appeal.....	1115
Polaroid Corp. v. Eastman Kodak Co.	1116
Notes.....	1118
TiVo, Inc. v. EchoStar Communications Corp.	1119
Note	1120
2. Enhanced Damages.....	1120
Halo Electronics, Inc. v. Pulse Electronics, Inc.	1121
Notes	1129
3. Attorney Fees	1131
a. The Exceptional-Case Requirement.....	1132
b. The Reasonable-Fee Requirement	1133
c. The Prevailing-Party Requirement.....	1134
d. The Court's Discretion	1135
e. Vexatious and Bad Faith Litigation	1135
INDEX	1137