

OUTLINE

DEDICATION.....	III
TABLE OF CASES	XVII
Chapter 1. Foundations of Patent Law	1
I. Foundations of Patent Law	1
II. Economics (Incentive to Invent)	2
III. History: Antidote to Trade Secrets (Incentive to Disclose)	5
IV. History: Technology Transfer	8
V. Natural Rights (Entitlement Theory)	10
VI. Patents and Public Utility Theory	12
VII. Conclusion	13
Chapter 2. Patent Acquisition	14
I. The United States Patent and Trademark Office	14
A. Examination	14
B. Historical Development	18
C. Organization	25
II. Prosecution Procedures	26
A. Application Types	27
1. Provisional Applications	27
2. Nonprovisional Applications	28
3. Continuing Applications	29
a) Restriction Requirements and Divisionals	31
b) Requests for Continued Examination	33
B. Publication Rule	33
C. Interferences & Derivation Proceedings	34

D. Petition and Appeal Rights	36
III. Post-Grant Procedures	38
A. Certificates of Correction	38
B. Reissue.....	40
1. Error Correction	40
2. Intervening Rights	44
3. Recapture	45
C. Reexamination, Supplemental Examination & Inter Partes Review	46
1. <i>Ex Parte</i> Reexamination	47
2. Supplemental Examination	49
3. <i>Inter Partes</i> Reexamination & <i>Inter Partes</i> Review	49
D. Post-Grant Review.....	51
IV. Conclusion: The World's Most Liberal System.....	51
 Chapter 3. Patent Eligibility.....	53
I. Introduction	53
A. The Constitution & Laws of Nature	54
B. § 101.....	55
II. Processes.....	57
A. Process Versus Product Claims	57
B. Computer-Related Methods	58
C. Business Method Patents.....	64
D. Tax Strategies.....	65
E. Methods of Medical Treatment.....	66
F. Compositions of Matter/Biotechnology	69
III. TRIPS	71
 Chapter 4. Utility	74
I. Introduction	74
A. § 101.....	74
B. Historical Development of the Doctrine	75

II. Three Types of Utility	77
A. Chemistry and Biotechnology	80
B. Biotech Guidelines	83
III. Industrial Application	85
Chapter 5. Anticipation	86
I. Introduction	86
II. Identification of Prior Art Under the U.S.	
First-to- Invent Regime.....	88
A. Novelty Under the First-to-Invent Regime.....	94
B. Secret Prior Art Under the First-to- Invent Regime.....	97
III. Identification of Prior Art Under the U.S.	
First-Inventor-to-File Regime	100
A. Novelty Under the First-Inventor-to- File Regime	101
B. Secret Prior Art Under the First- Inventor-to-File Regime	102
IV. Anticipation	104
A. Each and Every Element.....	104
B. Enablement Requirement	107
C. Inherency.....	108
D. Anticipation vs. Obviousness.....	110
Chapter 6. Statutory Bars	112
I. Introduction	112
II. Public Use Under the First-to-Invent Regime.....	117
A. Definitions	117
B. Activities of the Applicant.....	118
1. Informing	119
2. Noninforming.....	121
3. Secret.....	122
C. Activities of Third Parties	123

1. Informing	124
2. Noninforming.....	125
3. Secret.....	126
III. On Sale Bar Under the First-to-Invent	
Regime.....	127
A. Definitions.....	127
B. Two-Part Test	129
1. Commercial Offer for Sale.....	129
2. Ready for Patenting.....	130
IV. Experimental Use Negation Under the	
First-to-Invent Regime.....	131
A. Exception Versus Negation	131
B. Sales of the Invention	133
V. Patents and Printed Publications.....	135
VI. Other Statutory Bars Under the First-to-	
Invent Regime.....	136
A. Abandonment.....	136
B. Delay.....	138
Chapter 7. Novelty: Prior Invention	140
I. Introduction	140
II. Prior Invention Under First-to-Invent's	
§ 102(a).....	143
A. "Known or Used"	143
B. First-to-Invent's § 102(a) Before the	
Patent and Trademark Office	145
III. Priority Under First-to-Invent's § 102(g)	148
A. § 102(g)	148
B. Statutory Framework.....	150
1. Interferences	151
2. Conception.....	153
3. Reduction to Practice.....	155
4. Diligence.....	159

5. Abandoned, Suppressed, or Concealed	160
6. The Second Paragraph of First-to-Invent's § 102(g)	162
7. Examples	164
IV. Prior Invention Under First-to-Invent's § 102(e) & First-Inventor-to-File's § 102(a)(2)	165
V. Derivation Under First-to-Invent's § 102(f)	167
VI. Derivation Proceedings Under First-Inventor-to-File's § 135	169
VII. Exceptions to First-Inventor-to-File's Novelty Requirement	170
Chapter 8. Nonobviousness	172
I. Introduction	172
II. History of Patent Law's "Crown Jewel"	179
III. Prior Art	183
A. § 102	183
1. Analogous Art	185
2. Joint Research Exception	187
B. Prior Art by Admission	188
IV. The Supreme Court Trilogy	189
V. The Federal Circuit	193
A. Motivation or Suggestion to Combine	194
B. KSR	196
C. Scrutiny of Hindsight	200
D. Objective Criteria (Secondary Considerations)	202
E. Obviousness "Traps"	208
1. Standard of Proof	208
2. Manner of Invention Irrelevant	210
3. Obvious to Try	211
4. Patentability vs. Validity	214
F. Chemistry and Biotechnology	215

1. Chemistry.....	215
2. Biotechnology.....	216
VI. Obviousness (Inventive Step) in Foreign Patent Systems.....	217
Chapter 9. Adequate Disclosure	219
I. Introduction	219
II. Enablement.....	222
A. Purpose.....	222
B. Test.....	224
1. At the Time of Filing	224
2. Scope of Disclosure	227
3. Without Undue Experimentation.....	230
C. Relationship to Utility.....	233
III. Written Description	234
A. Purpose.....	234
B. "Possession" of the Claimed Subject Matter.....	237
C. Written Description Unchained.....	239
IV. Best Mode	241
A. Purpose.....	241
B. Two-Part Test	242
1. Inventor's Subjective Belief	242
2. Concealment	244
C. Unnecessary Vestige?.....	247
Chapter 10. Claims	250
I. Introduction	250
A. Central Legal Element of a Patent.....	250
B. Historical Development.....	251
C. § 112.....	253
II. Parts of a Claim.....	256
A. One-Sentence Rule	257
B. Preamble	258

C. Transitional Phrase	259
D. Body	263
E. Independent and Dependent Claims	265
III. Special Claim Formats	267
A. Means-Plus-Function	268
1. § 112, ¶ 6 / § 112(f).....	268
2. Practical Significance	271
3. Equivalents Under § 112 and the Doctrine of Equivalents.....	278
4. International Treatment.....	282
B. Product-by-Process	283
1. Purpose.....	283
2. International Treatment.....	287
C. Jepson.....	288
D. Markush	288
IV. Definiteness	290
A. Test	290
B. Relative Terminology & Words of Approximation	293
Chapter 11. Issues in Patent Acquisition	295
I. Introduction	295
II. Inventorship	296
A. Test for Inventorship	296
B. Consequences of Incorrect Inventorship.....	299
III. Inequitable Conduct	301
A. Purpose	301
B. Test for Inequitable Conduct	305
1. Materiality	307
2. Intent.....	309
C. International Treatment	312
IV. Double Patenting	312
A. Purpose	312
B. Two Types.....	313

1. Same Invention or Statutory	313
2. "Obviousness-Type" or Nonstatutory	315
C. Terminal Disclaimer	318
V. International Prosecution	319
Chapter 12. Claim Construction	320
I. Introduction	320
II. Claim Construction	323
A. Challenges of Claim Construction	324
B. Claim Construction in the Federal Circuit Era: <i>Markman</i>	327
C. Sources of Claim Meaning	336
1. The Claim Language	338
2. The Specification	342
3. The Prosecution History	348
4. Extrinsic Evidence	351
a) Dictionaries, Treatises, and Encyclopedias	353
b) Expert Testimony	355
c) Prior Art References and Scientific Articles	357
D. Guidelines for Claim Construction	358
E. Practical Problems	359
1. Preamble	359
2. Construing Claims in Light of the Specification Versus Impermissibly Importing a Limitation from the Specification	362
3. Construing Claims to the Extent Necessary Versus Construing Claims in Light of the Accused Device	364

4. Evolving Claim Construction.....	365
F. Claim Construction at the Patent Office.....	367
Chapter 13. Infringement	369
I. Introduction	369
II. Literal Infringement	370
III. The Doctrine of Equivalents—Non-textual Infringement.....	372
A. Purpose	372
B. Test(s)	375
C. Limitations	377
1. Prosecution History Estoppel	378
2. All-Elements Rule	381
3. Prior Art	384
4. Public Dedication.....	386
D. Means-Plus-Function Claims	387
E. Reverse Doctrine of Equivalents.....	388
IV. Indirect Infringement	389
A. Inducement of Infringement	390
B. Contributory Infringement	393
V. Territorial Scope	394
A. Exporting Components of a Patented Combination.....	395
B. Importation of Goods Manufactured by a Patented Process.....	398
VI. International Trade Commission.....	399
VII. Exceptions to Infringement.....	403
A. Implied Licenses, First Sale & Exhaustion, and Repair & Reconstruction	404
B. Experimental Use	407
VIII. “Artificial” Infringement Under § 271(e)(2).....	410
IX. Infringement Abroad	413

Chapter 14. Additional Defenses	416
I. Introduction	416
II. Laches and Estoppel	418
A. Laches.....	419
B. Equitable Estoppel	421
C. Prosecution Laches	423
D. Licensee Estoppel	425
E. Assignor Estoppel	428
III. Shop Rights	429
IV. Temporary Presence in the United States	432
V. First Inventor Defense	433
VI. Patent Misuse.....	434
Chapter 15. Remedies	439
II. Injunctions	440
III. Damages	445
A. Lost Profits	446
B. Price Erosion	453
C. Reasonable Royalty	455
D. The Entire Market Value Rule	459
E. Marking	461
IV. Willful Infringement: Enhanced Damages and Attorney Fees	465
V. International Remedies.....	470
Chapter 16. International Patent Law	472
I. Major International Agreements	472
A. Paris Convention	473
B. Patent Cooperation Treaty.....	479
C. Regional Agreements.....	482
1. European Patent Convention and the European Union	482
2. TRIPS and Bilateral Free Trade Agreements	483

OUTLINE

xv

II. International Enforcement 486

INDEX..... 489