

Table of Contents

Volume 1

PART I. PATENT SYSTEM ORGANIZATION AND PROCESS

CHAPTER 1. HISTORY AND POLICY JUSTIFICATION

I. DEFINITION OF THE TERM “PATENT”

§ 1:1 Generally

II. HISTORICAL ORIGINS OF THE MODERN PATENT GRANT

§ 1:2 Generally

§ 1:3 Early English precedents

§ 1:4 —Royal letters patent prior to 1623

§ 1:5 —Patents for invention prior to 1623

§ 1:6 —The Statute of Monopolies

§ 1:7 —Summary and conclusion

§ 1:8 Developments in the United States

§ 1:9 —Colonial period

§ 1:10 —Constitutional provision

§ 1:11 — —Parallel structure

§ 1:12 — —Underlying purpose

§ 1:13 — —Other issues

§ 1:14 — — —Preemption of State Competition Laws

§ 1:15 — — — —Early History; Relation to Federal Common
Law

§ 1:16 — — — —Developments Post-*Erie Railroad v.*
Tompkins

§ 1:17 — — — —Early History; Relation to Federal Common
Law—*Stiffel Co. v. Sears, Roebuck & Co.*

§ 1:18 — — — — —*Compco Corp. v. Day-Brite Lighting, Inc.*

§ 1:19 — — — — —*Kewanee Oil Co. v. Bicron Corp.*

§ 1:20 — — — — —*Bonito Boats v. Thunder Craft Boats*

§ 1:21 — — — — —Subsequent Developments

§ 1:22 — — — — —Defend Trade Secrets Act of 2016

- § 1:23 — — —Sovereign immunity of the States
- § 1:24 — — —Relation to trademark
- § 1:25 —Constitutional period
- § 1:26 — —Law-making sources in United States Patent Law
- § 1:27 — —Initial statutes and developments up to 1836
- § 1:28 — —Patent Acts of 1836 and 1839
- § 1:29 — —Developments up to 1870
- § 1:30 — —Patent Act of 1870 and related events
- § 1:31 — —Subsequent developments to 1952
- § 1:32 — —Patent Act of 1952
- § 1:33 — —Subsequent developments to 1982
- § 1:34 — —Creation of the Federal Circuit and related
developments
- § 1:35 America Invents Act

III. CURRENT POLICY JUSTIFICATION

- § 1:36 Generally
- § 1:37 Inventions as a form of property
- § 1:38 Natural law
- § 1:39 Economic discretion
- § 1:40 —Social costs of patenting
- § 1:41 — —Impact of single-source control
- § 1:42 — —Decreased supply
- § 1:43 — —Resource scarcity
- § 1:44 — —Decreased rate of future inventive activity
- § 1:45 — —Overall balance
- § 1:46 —Social benefits of patenting
- § 1:47 — —Analogy to bilateral contract: Exchange of control
for disclosure
- § 1:48 — —Analogy to unilateral contract: Incentive to invent
- § 1:49 — —Other economic justifications: Innovation,
prospects, etc
- § 1:50 — — —Incentive to innovate
- § 1:51 — — —Orderly control of economic prospects
- § 1:52 — — —Other rationales

CHAPTER 2. THE PATENT SYSTEM AND THE PATENT AND TRADEMARK OFFICE

I. INTRODUCTION

- § 2:1 Generally

II. CONGRESS' EXERCISE OF ITS CONSTITUTIONAL POWER

- § 2:2 Generally

TABLE OF CONTENTS

- § 2:3 General v. specific acts
- § 2:4 —Special acts
- § 2:5 —General acts
- § 2:6 Judicial versus executive authority over the patent grant
- § 2:7 —Current United States law: Separate delegations
- § 2:8 —General Supremacy of Judiciary
- § 2:9 —Rule of doubt
- § 2:10 —Administrative post-grant proceedings
- § 2:11 —Contrast: European patent systems
- § 2:12 Administration of initial grant
- § 2:13 —General considerations
- § 2:14 —Historical developments in the United States
- § 2:15 — —Act of 1790
- § 2:16 — —Registration under the Act of 1793
- § 2:17 — —Examination under the Act of 1836
- § 2:18 —Subsequent developments

III. THE UNITED STATES PATENT AND TRADEMARK OFFICE

- § 2:19 Generally
- § 2:20 Historical development
- § 2:21 Prelude: The USPTO, administrative law, and the APA
- § 2:22 Internal structures and personnel
- § 2:23 Rule-making activities of the USPTO
- § 2:24 —Rule sources
- § 2:25 — —Codified rules: 37 C.F.R.
- § 2:26 — —Manual of Patent Examining Procedure
- § 2:27 — —Notices
- § 2:28 —Rule making procedures

IV. JUDICIAL REVIEW OF USPTO DECISIONS

- § 2:29 Generally
- § 2:30 Historical overview
- § 2:31 —Acts of 1790 and 1793
- § 2:32 —Act of 1836
- § 2:33 —Judicial review under the Act of 1839
- § 2:34 —Reforms of 1870
- § 2:35 —Required election under the Act of 1927
- § 2:36 —Creation of Court of Customs and Patent Appeals
- § 2:37 —Consolidation in the Federal Circuit
- § 2:38 Current mechanisms
- § 2:39 Standards of review
- § 2:40 —Determinations of fact
- § 2:41 — —Review of facts under the APA generally

- § 2:42 — —Application to review of USPTO
- § 2:43 — —*Dickinson v. Zurko*
- § 2:44 — —Determinations of law
- § 2:45 — —Legal rules under the APA generally
- § 2:46 — — —Procedural versus nonprocedural rules
- § 2:47 — — —Substantive/legislative rules
- § 2:48 — — —Interpretive rules
- § 2:49 — —Application to legal rules of the USPTO
- § 2:50 — — —Substantive/legislative rulemaking authority of
the USPTO
- § 2:51 — — —Interpretive rules of the USPTO

CHAPTER 3. PATENT AND TRADEMARK OFFICE PROCEDURES

I. INTRODUCTION; SCOPE OF CHAPTER

- § 3:1 Generally

II. EXAMINATION OF ORIGINAL APPLICATIONS

A. IN GENERAL

- § 3:2 Generally
- § 3:3 Application papers
- § 3:4 — —Regular applications
- § 3:5 — —Specification
- § 3:6 — —Drawings
- § 3:7 — —Oath or Declaration
- § 3:8 — —Fee
- § 3:9 — —Models and specimens
- § 3:10 — —Biological deposits
- § 3:11 — —Missing parts
- § 3:12 — —Provisional applications
- § 3:13 — —Policy justification
- § 3:14 — —Other aspects
- § 3:15 Examination
- § 3:16 Historical developments
- § 3:17 Relation to validity litigation

B. RESPONSE AND REEXAMINATION

- § 3:18 Generally
- § 3:19 Required content of response
- § 3:20 Amendments
- § 3:21 — —To the disclosure: prohibition against new matter
- § 3:22 — —Policy justification
- § 3:23 — —Analogy to reissue

TABLE OF CONTENTS

§ 3:24	— —Historical developments
§ 3:25	— —Modern developments
§ 3:26	— —Relation to inadequate disclosure
§ 3:27	— —Incorporation by reference
§ 3:28	— —Relation to obviousness
§ 3:29	— —Inherency
§ 3:30	— —Exception for biological deposits
§ 3:31	—To the claims: Doctrine against late claiming
§ 3:32	— —Policy issues
§ 3:33	— —Historical developments of the late claiming doctrine
§ 3:34	— —Supreme Court cases
§ 3:35	— —Subsequent developments
§ 3:36	— —Prosecution laches
§ 3:37	Interviews
§ 3:38	Submissions by third parties

C. MECHANISMS TO ENCOURAGE DILIGENT PROSECUTION

§ 3:39	Generally
§ 3:40	Historical developments and policy issues
§ 3:41	Effect of term calculated from filing date
§ 3:42	Response deadlines
§ 3:43	Final rejection

D. CONTINUATION PRACTICE

§ 3:44	Generally
§ 3:45	Historical origins and policy justification
§ 3:46	Modern law
§ 3:47	—Time limits on filing
§ 3:48	— —Laches, abandonment, and the doctrine against late claiming
§ 3:49	— —Modern law; Co-pendency
§ 3:50	— —Continuation after allowance
§ 3:51	—Cross reference
§ 3:52	—Same subject matter
§ 3:53	— —Rule of adequate disclosure
§ 3:54	— — —Policy issues and historical developments
§ 3:55	— — —Reference to disclosure
§ 3:56	— — —Best mode issues
§ 3:57	— —Additions and deletions
§ 3:58	— — —Deletions
§ 3:59	— — —Additions: Continuations in part
§ 3:60	— —Multiple continuations in sequence; Continuity of disclosure
§ 3:61	—Filing procedures

E. OTHER PROCEDURAL MATTERS

- § 3:62 Internal appeals and petitions
- § 3:63 Issuance
- § 3:64 Secrecy and 18-month publication
- § 3:65 Interferences and derivation proceedings
- § 3:66 Post-issuance proceedings
- § 3:67 Certificates of correction
- § 3:68 Disclaimers

PART II. PATENTABILITY AND VALIDITY

CHAPTER 4. PATENT CLAIMS

I. OVERVIEW

- § 4:1 Introduction; Scope of chapter
- § 4:2 Policy justification and historical development
- § 4:3 —Ascendancy and development of peripheral claiming, 1870–1880
- § 4:4 —Accommodating peripheral claiming, 1880–1952
- § 4:5 —Statutory developments, 1952 – 1982
- § 4:6 —Structural revision of the judiciary, 1982 – present

II. CLAIM THEORY

- § 4:7 Generally

A. CENTRAL VS. PERIPHERAL CLAIMING

- § 4:8 Generally
- § 4:9 —Notice and definitional accuracy
- § 4:10 The mechanics of claim interpretation
- § 4:11 —The identity of the decision maker
- § 4:12 — —Law vs. fact
- § 4:13 — — —Law and fact generally
- § 4:14 — — —Mixed questions of law and fact
- § 4:15 — — —Law and fact in patent claim interpretation
- § 4:16 — — — —*Markman v. Westview Instruments*
- § 4:17 — — — —Underlying questions of fact
- § 4:18 Generally—The mechanics of claim interpretation—
The identity of the decision maker—Law vs. fact—
Law and fact in patent claim interpretation—
Markman v. Westview Instruments—Underlying
questions of fact—*Lighting Ballast Control LLC v.*
Philips Electronics North America Corp.

TABLE OF CONTENTS

§ 4:19	— — — — — — — — — — <i>Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.</i>
§ 4:20	The mechanics of claim interpretation—The identity of the decision maker—Law vs. fact—Corollary issues
§ 4:21	— — — — — Finality and appellate review
§ 4:22	— — — — — Issue preclusion and <i>Stare Decisis</i>
§ 4:23	— — — — — Judge vs. jury
§ 4:24	— — — — — Verdicts and instructions generally
§ 4:25	— — — — — Application to patent claim interpretation
§ 4:26	— — — — — Example decisions
§ 4:27	— — — — — Target meaning
§ 4:28	— — — — — Author and recipient meanings generally
§ 4:29	— — — — — Example: statutory interpretation
§ 4:30	— — — — — Example: contract interpretation
§ 4:31	— — — — — Application to patent claim interpretation
§ 4:32	— — — — — Patentee’s meaning vs. recipient’s meaning
§ 4:33	— — — — — Patentee’s intended meaning as circumstantial evidence
§ 4:34	— — — — — Hierarchy of sources
§ 4:35	— — — — — Historical development
§ 4:36	— — — — — <i>Vitronics Corp. v. Conceptronic, Inc.</i>
§ 4:37	— — — — — Federal Circuit decisions after <i>Vitronics</i>
§ 4:38	— — — — — <i>Johnson Worldwide v. Zebco</i>
§ 4:39	— — — — — <i>Toro v. White Consol. Industries</i>
§ 4:40	— — — — — <i>Texas Digital Instruments v. Telegenix</i>
§ 4:41	— — — — — <i>Phillips v. AWH</i>
§ 4:42	— — — — — Subsequent developments
§ 4:43	— — — — — Intrinsic and extrinsic sources
§ 4:44	— — — — — Specialized sub-rules
§ 4:45	— — — — — Claims
§ 4:46	— — — — — Specification
§ 4:47	— — — — — Prosecution history
§ 4:48	— — — — — Dictionaries
§ 4:49	— — — — — Expert testimony
§ 4:50	— — — — — <i>Contra Proferentum</i>
§ 4:51	— — — — — Preservation of validity
§ 4:52	— — — — — Criticism of intrinsic and extrinsic categories
§ 4:53	— — — — — Contrast with statutory interpretation
§ 4:54	— — — — — Analogy to contract interpretation
§ 4:55	— — — — — Criticism of contract analogy
§ 4:56	— — — — — Alternative organization
§ 4:57	— — — — — Semantic and pragmatic meanings generally
§ 4:58	— — — — — General example
§ 4:59	— — — — — Illustrative diagram
§ 4:60	— — — — — Application to patent claim interpretation
§ 4:61	— — — — — Illustrative diagram
§ 4:62	— — — — — Recommendation

- § 4:63 —Required process
- § 4:64 —Patentability vs. validity

B. DOMINANCE AND SUBSERVIENCE

- § 4:65 Generally
- § 4:66 Combination and subcombination
- § 4:67 Genus and specie
- § 4:68 Product - method

C. SINGLE-CATEGORY REQUIREMENT AND MULTIPLE-CATEGORY HYBRIDS

- § 4:69 Generally
- § 4:70 Hybrid claim presentations and nonlimiting recitations
- § 4:71 —Indefinite vs. nonlimiting
- § 4:72 —General practice and specific rules
- § 4:73 —Conflict with all-elements rule
- § 4:74 —Patentability determinations
- § 4:75 —Treatment in determination of infringement
- § 4:76 —Products defined by process
- § 4:77 —Starting and ending materials in chemical processes;
1995 Amendments to Section 103(b)
- § 4:78 — —Traditional practice
- § 4:79 — —Hostility to traditional practice
- § 4:80 — —PTO guidelines
- § 4:81 —Hybrid inventions incorporating nonstatutory
elements
- § 4:82 Analysis and commentary
- § 4:83 —Other forms of hybrid claims
- § 4:84 —Hybrid claiming as an impetus to discard anomalies

D. MEANS EXPRESSIONS

- § 4:85 Generally
- § 4:86 Historical development
- § 4:87 —Retention of means expressions after 1870
- § 4:88 —Judicial reaction to means expressions under
peripheral claiming practice
- § 4:89 —Statutory treatment of means expressions in 1952
Patent Act
- § 4:90 —Recent developments
- § 4:91 Boundary with non-means expressions
- § 4:92 Commentary
- § 4:93 Determination of corresponding structure
- § 4:94 Scope of coverage
- § 4:95 PTO practice

III. DEFINITENESS AND NOTICE

- § 4:96 Generally

TABLE OF CONTENTS

IV. REQUIRED FORMAT

- § 4:97 Generally
- § 4:98 Tripartite form of individual claims
- § 4:99 —Body; Diagraming convention
- § 4:100 —Transitional phrase; Open, closed, and partially closed formats
- § 4:101 —Preamble: Jepson-style claims
- § 4:102 Alternative recitations and Markush groupings
- § 4:103 Multiple claims in a single patent
- § 4:104 —Independent and dependent claims
- § 4:105 —Multiply dependent claims

CHAPTER 5. STATUTORY SUBJECT MATTER

I. OVERVIEW

- § 5:1 Introduction; Scope of chapter

II. HISTORICAL DEVELOPMENT AND POLICY JUSTIFICATION

- § 5:2 Generally
- § 5:3 —Policy explanations
- § 5:4 — —Targeting patent incentive to developments in applied technology
- § 5:5 — —Matters of undue social cost

III. PARTICULAR FIELDS OF ACTIVITY

- § 5:6 Generally
- § 5:7 —Static physical configurations
- § 5:8 — —Machines and articles of manufacture
- § 5:9 — —Compositions
- § 5:10 — —Printed matter
- § 5:11 — — —Policy justification
- § 5:12 — — —Exception for functional relationships
- § 5:13 — —Plants
- § 5:14 — — —Arguments for and against utility patents
- § 5:15 — — —*Pioneer Hi-Bred* case
- § 5:16 — —Animals and related biotechnology
- § 5:17 — — —History
- § 5:18 — —*AMP v. Myriad*
- § 5:19 — —Animals and related biotechnology—Policy
- § 5:20 —Processes
- § 5:21 — —Industrial processes generally
- § 5:22 — — —Historical developments

- § 5:23 — — — Impact of peripheral claiming: *Cochran v. Deener*
- § 5:24 — — — Modern developments
- § 5:25 — — — — *Bilski v. Kappos*
- § 5:26 — — — *Mayo v. Prometheus*
- § 5:27 — — — Mathematical formulae, scientific principles, natural phenomena, and end results
- § 5:28 — — — Mental steps
- § 5:29 — — — Policy rationales
- § 5:30 — — — Exception for Ministerial Acts
- § 5:31 — — — Business methods
- § 5:32 — — — Early history
- § 5:33 — — — Modern developments
- § 5:34 — — — *Bilski v. Kappos*
- § 5:35 — — — *CLS v. Alice*
- § 5:36 — — — America Invents Act
- § 5:37 — — — — Tax strategies
- § 5:38 — — — — Expanded post-grant review
- § 5:39 — — — Observations
- § 5:40 — — — — Adapting the requirement of physical transformation
- § 5:41 — — — — Hybrid claiming
- § 5:42 — — — Medical and surgical procedures
- § 5:43 — — — Computer-related inventions
- § 5:44 — — — Policy discussion
- § 5:45 — — — Computer software as an article of manufacture: Printed matter and factual compilations
- § 5:46 — — — Computer software as a process: Physical or other transformation
- § 5:47 — — — Mathematical algorithms
- § 5:48 — — — Mental steps
- § 5:49 — — — Designs

IV. NON-STATUTORY HYBRID INVENTIONS

A. CATEGORIZING INDIVIDUAL INVENTIONS

- § 5:50 Introduction
- § 5:51 — Inventions of a single character versus those claimed as hybrid of statutory and non-statutory elements
- § 5:52 — Summary of existing law regarding hybrid inventions
- § 5:53 — Overview of following sections
- § 5:54 Analyzing claimed inventions as hybrids of statutory and non-statutory elements
- § 5:55 — Refutation of “claimed invention as a whole”
- § 5:56 *[Reserved]*

TABLE OF CONTENTS

§ 5:57	Analyzing claimed inventions as hybrids of statutory and non-statutory elements—Consistency with peripheral claiming and modern claim theory
§ 5:58	—Conclusion
§ 5:59	Nomenclature convention
§ 5:60	Policy objectives
§ 5:61	Inventions claimed as hybrid of statutory and non-statutory elements—Statutory and non-statutory elements combined
§ 5:62	—Current law
§ 5:63	—Outline of remaining sections in group
§ 5:64	<i>[Reserved]</i>
§ 5:65	<i>[Reserved]</i>
§ 5:66	Inventions claimed as hybrid of statutory and non-statutory elements—Policy objectives—Practical importance
§ 5:67	— —Fundamental issue of binary classification
§ 5:68	— —Statutory provision
§ 5:69	— —Overall policy objectives
§ 5:70	— — —Bounding the patent incentive
§ 5:71	— — —Absence of inquiry into prior state of the art
§ 5:72	— — —Proper placement of non-statutory adjudication
§ 5:73	— — —Implementation by detailed rule
§ 5:74	—Historical progression of substantive approaches
§ 5:75	— —Point of novelty
§ 5:76	— —Blue-pencil rule
§ 5:77	— — —Historical development
§ 5:78	— — —Critique
§ 5:79	— — —Requirement that statutory element be “nontrivial”
§ 5:80	— — —Operation of the blue-pencil rule under Sections 102 and 103
§ 5:81	— — —Lack of documentation
§ 5:82	— —Supreme Court decisions
§ 5:83	— — — <i>Parker v. Flook</i>
§ 5:84	— — — <i>Diamond v. Diehr</i>
§ 5:85	—Subsequent developments and current law
§ 5:86	— —Federal Circuit
§ 5:87	— — —Computer-related examples— <i>In re Warmerdam</i>
§ 5:88	— — — <i>State Street Bank</i>
§ 5:89	— — —Significance of apparatus vs. method
§ 5:90	— — —Process requirements and information technologies
§ 5:91	— — —Non-computer related inventions
§ 5:92	— —United States Patent and Trademark Office (USPTO)
§ 5:93	—Impact of hybrid claiming on application of Sections 102 and 103

§ 5:94 — —Commentary

Volume 2

CHAPTER 6. ADEQUATE UTILITY

- § 6:1 Introduction; Scope of chapter
- § 6:2 Historical development and policy justification
- § 6:3 —Advance in the art
- § 6:4 —Use of market forces
- § 6:5 —Deterring unwanted activity
- § 6:6 —Limiting scope of control over future uses
- § 6:7 —Relation between adequate utility and establishing date of invention
- § 6:8 Operability
- § 6:9 —Historical developments
- § 6:10 —Economic justification
- § 6:11 —Corollaries
- § 6:12 —Interactions with restriction on use
- § 6:13 —Proof during prosecution
- § 6:14 —Treatment in litigation
- § 6:15 Public order, morality
- § 6:16 Relation between disclosure and scope of future uses; “Practical utility”
- § 6:17 —*Brenner v. Manson*
- § 6:18 —Common interpretation: Practical utility as fixed standard
- § 6:19 —Alternate interpretation: Practical utility as required correlation between disclosed and potential uses
- § 6:20 Impact of infringing activity

CHAPTER 7. ADEQUATE DISCLOSURE

I. IN GENERAL

- § 7:1 Introduction and summary

II. ENABLEMENT

- § 7:2 Generally
- § 7:3 —Possession
- § 7:4 —Questions of single-embodiment and breadth distinguished
- § 7:5 —Historical development and policy justification
- § 7:6 —Single-embodiment issues
- § 7:7 — —Claimed configuration
- § 7:8 — — —Statutory basis

TABLE OF CONTENTS

§ 7:9	— — —Case decisions
§ 7:10	— —Method of making
§ 7:11	— — —Biological starting materials
§ 7:12	— — —Trademarks and brand names
§ 7:13	— —How to use
§ 7:14	— — —Relation to adequate utility
§ 7:15	— —Background knowledge
§ 7:16	— — —Target audience
§ 7:17	— — —Private knowledge
§ 7:18	— — —Relation to section 103
§ 7:19	— — —Incorporation by reference
§ 7:20	— —Reasonable vs. undue experimentation
§ 7:21	— —Time frame
§ 7:22	— — —Biological deposits
§ 7:23	—Adequate range of embodiments: Breadth of disclosure vs. breadth of claims
§ 7:24	— —The problem of over-breadth
§ 7:25	— —Existing case law
§ 7:26	— —Critique and alternative explanation

III. SUBJECTIVE APPRECIATION AND THE DESCRIPTION REQUIREMENT

§ 7:27	Generally
§ 7:28	—Policy justification
§ 7:29	— —Assumption as of filing date
§ 7:30	— —Example
§ 7:31	— —Relation to new-matter prohibition
§ 7:32	— —Impact of America Invents Act
§ 7:33	— —Limitation on claim breadth
§ 7:34	—Subjective appreciation distinguished from enablement
§ 7:35	—Ambiguity of “description” requirement
§ 7:36	— —Involved aspects of the enablement requirement
§ 7:37	— —Example cases
§ 7:38	— — <i>Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.</i>
§ 7:39	— —Commentary
§ 7:40	—Typical scenarios
§ 7:41	— —Amended claims
§ 7:42	— — <i>In haec verba</i>
§ 7:43	— —Frame of reference

IV. BEST MODE

§ 7:44	Generally
§ 7:45	—Historical development and policy justification
§ 7:46	— —Confusion and criticism; basic policy objective

- § 7:47 —Well-settled issues
- § 7:48 — —Distinction between best mode and enablement
- § 7:49 — —Two-prong test for occurrence of violation
- § 7:50 — —Trade secrets and reverse engineering
- § 7:51 —Unsettled issues; Failure to discuss objectives
opposing disclosure
- § 7:52 — —Related information, production details, and
commercial embodiments
- § 7:53 — — —Critique
- § 7:54 — —Duty of employer/assignee
- § 7:55 — —Comment and suggestion
- § 7:56 —Time frame; Continuing applications
- § 7:57 —Intent

CHAPTER 8. LACK OF ANTICIPATION

I. OVERVIEW OF SECTION 102

- § 8:1 Generally

II. DERIVATION VS. ORIGINALITY; 102(f)

- § 8:2 Generally
- § 8:3 —Policy justification
- § 8:4 —Definition of “invent”
- § 8:5 —Analogies to par. 102(g) and § 116
- § 8:6 —102(f) “Invent” as conception only
- § 8:7 —Complete vs. substantial prior conception
- § 8:8 —1984 amendments to section 116
- § 8:9 Elements of proof

III. TECHNICAL SUFFICIENCY OF INVALIDATING EVENT

- § 8:10 Generally
- § 8:11 Relation to claimed invention; “All elements” rule
- § 8:12 —Combination/subcombination
- § 8:13 —Genus/specie
- § 8:14 —Effect of non-limiting recitations
- § 8:15 Required presence of enabling knowledge
- § 8:16 —Relation to underlying rationale
- § 8:17 —Incorporation of paragraph 112, par. 1
- § 8:18 —Paragraph 102(a)
- § 8:19 —Paragraph 102(b)—Printed publications
- § 8:20 — —On-sale activity
- § 8:21 — —Prior public use
- § 8:22 —Inoperative disclosures
- § 8:23 “Accidental anticipations” and inherency

TABLE OF CONTENTS

- § 8:24 —Anticipation vs. obviousness
- § 8:25 —Sporadic vs. regular result
- § 8:26 —Policy justifications
- § 8:27 — —Circumstantial proof
- § 8:28 — —Preservation of public domain
- § 8:29 —Potential conflicts
- § 8:30 Incorporation of outside sources
- § 8:31 —Section 103 vs. section 112, par. 1
- § 8:32 —Background knowledge vs. additional elements

IV. TIMING OF EVENT

- § 8:33 Generally

A. PRIORITY

- § 8:34 Generally
- § 8:35 First-to-invent vs. first-to-file
- § 8:36 —Advantages and disadvantages
- § 8:37 Priority, interference priority, and patentability
- § 8:38 —Right to use, right to exclude
- § 8:39 —Illustrations
- § 8:40 —Public domain issues
- § 8:41 —Critique
- § 8:42 —Nomenclature issues
- § 8:43 —Interference priority vs. public invention
 - 1. General Rule of First-to-Invent Priority; 102(g)
 - § 8:44 Generally
 - § 8:45 Mental aspect: Conception
 - § 8:46 —Appreciation
 - § 8:47 —Completeness, relation to claim language
 - § 8:48 — —Generic inventions
 - § 8:49 — —Inherency
 - § 8:50 —Implementing knowledge
 - § 8:51 — —Practical utility
 - § 8:52 — —Unexpected properties
 - § 8:53 — —Offensive vs. defensive invention
 - § 8:54 —Needed experimentation
 - § 8:55 Physical aspect: Reduction-to-practice
 - § 8:56 —Policy rationale
 - § 8:57 —Completeness, relation to claim language
 - § 8:58 —Appreciation
 - § 8:59 —Degree of testing required
 - § 8:60 — —Tripartite analysis
 - § 8:61 — —Unified standard
 - § 8:62 — —Resolution

- § 8:63 Diligence
- § 8:64 —Historical development
- § 8:65 —Modern law
- § 8:66 —Standard of continuity
- § 8:67 —Excuses for inactivity
- § 8:68 Proof issues
- § 8:69 —Standard of proof
- § 8:70 —Corroboration
- § 8:71 — —Traditional justification
- § 8:72 — —Analysis—Quantified probativeness
- § 8:73 — — —Credibility substitute
- § 8:74 — —Rule of reason
- § 8:75 — —USPTO vs. court proceedings
- § 8:76 Basic rule illustrated
- § 8:77 —Basic examples
- § 8:78 —Adequate diligence
- § 8:79 —Race of diligence
- § 8:80 —Genus/specie
- § 8:81 Abandoned, suppressed, concealed
- § 8:82 —Correction for otherwise private acts
- § 8:83 —Historical development
- § 8:84 —Underlying rationales
- § 8:85 — —Classical abandonment
- § 8:86 — —Laches or estoppel
- § 8:87 — —Deliberate secrecy
- § 8:88 —Proof issues
- § 8:89 —Relation to diligence
- § 8:90 Conceptual inconsistencies
- § 8:91 —Constructive reduction to practice
- § 8:92 — —Theoretical justification
- § 8:93 — —Analysis: Justification for issuance of patent
- § 8:94 — — —Prior abandoned applications
- § 8:95 — — —Prior issued patent
- § 8:96 — —Impact on actual reduction to practice
- § 8:97 — —Inconsistencies with patentability
- § 8:98 —Section 104; Inventive activities in foreign countries
- § 8:99 — —History and policy justifications
- § 8:100 — — —Symmetry arguments
- § 8:101 — — —*Bain v. Morse*
- § 8:102 — — —*Electric Storage Battery Co. v. Shimadzu*
- § 8:103 — — —International competitiveness
- § 8:104 — —Foreign activities as evidence of prior invention
- § 8:105 — — —Law prior to 1993
- § 8:106 — — —NAFTA
- § 8:107 — — —GATT/TRIPs

TABLE OF CONTENTS

§ 8:108	— — —Offensive vs. defensive invention
§ 8:109	— — —Discovery presumption
§ 8:110	—Section 119—Priority by foreign filing
§ 8:111	— — —History and policy justifications
§ 8:112	— — —Eligible countries
§ 8:113	— — —Same invention
§ 8:114	— — —Claims
§ 8:115	— — —Disclosure
§ 8:116	— — —Interaction with novelty requirement under 102(b)
§ 8:117	— — —Impact of foreign priority on paragraph 102(e)
§ 8:118	— — —Offensive vs. defensive uses
§ 8:119	— — —Criticisms and counter-arguments
§ 8:120	— — —Historical development
§ 8:121	— — — <i>In re Hilmer</i>
§ 8:122	— — —Current law
§ 8:123	— — —Procedural issues—Computation of 12-month period
§ 8:124	— — —Amended foreign application
§ 8:125	— — —Multiple foreign priority claims
§ 8:126	— — —First and subsequent foreign applications
§ 8:127	—Indeterminate events
§ 8:128	— — —Simultaneous events
§ 8:129	— — —Multiple-party contests
§ 8:130	—Renewed activity; <i>Paulik v. Rizkalla</i>
§ 8:131	Date of invention in Paragraphs 102(a) and (e); Affidavits under Rule 131
§ 8:132	—Basic rule
§ 8:133	—Procedure; Rule 131
§ 8:134	—Anomalies
§ 8:135	— — —Required technical content of showing
§ 8:136	— — —Analogy to obviousness standard under section 103
§ 8:137	—Critique and comment
	2. Paragraph 102(e); Description in a Previously Filed Patent
§ 8:138	Generally
§ 8:139	Historical development and policy justification
§ 8:140	— <i>Alexander Milburn Co. v. Davis-Bournonville Co.</i>
§ 8:141	—Constructive publication
§ 8:142	—Evidence of superior priority
§ 8:143	—Relation to “abandoned, suppressed or concealed”
§ 8:144	—Published applications
§ 8:145	Continuing applications and the requirement of description
§ 8:146	—Discontinued subject matter

- § 8:147 —Added subject matter; Continuations in part
- § 8:148 —Importance of subject matter claimed in reference
- § 8:149 —Provisional and published applications
- § 8:150 Foreign applications, international agreements, and
In re Hilmer I
- § 8:151 —Potential interpretations of statutory language
- § 8:152 —Conflicting policy arguments
- § 8:153 —*In re Hilmer*
- § 8:154 —Patent cooperation treaty
- § 8:155 —Provisional applications
- 3. Paragraph 102(a); Public Possession Prior to
Patentee's Date of Invention
- § 8:156 Generally
- § 8:157 Historical development and policy justification
- § 8:158 —General absence of policy discussions
- § 8:159 —Public disclosure
- § 8:160 —Evidence of superior priority
- § 8:161 — —Knowledge and circumstantial evidence of prior
knowledge
- § 8:162 — —Status of applicant's own prior work
- § 8:163 —Inconsistencies with paragraph 102(g)
- § 8:164 Public knowledge
- § 8:165 —Example: *In re Borst*
- § 8:166 —Extent of knowledge required
- § 8:167 —Extent of publicness required
- § 8:168 —Abandoned applications
- § 8:169 Circumstantial proof of public knowledge
- § 8:170 —Acceptance of low probabilities
- § 8:171 —Rule-based definiteness
- § 8:172 —Social disutility
- § 8:173 —Printed publication
- § 8:174 — —Historical development
- § 8:175 — —Proof of prior public knowledge
- § 8:176 — — —Effective date of publication
- § 8:177 — — —"Printed"; "Publication"
- § 8:178 —Described in patent
- § 8:179 — —Potential relation to paragraph 102(d)
- § 8:180 — —Relation to printed publications
- § 8:181 — —Secret patents
- § 8:182 —Used
- § 8:183 — —Conflicting authorities
- § 8:184 — —Improper analogies to paragraph 102(b)
- § 8:185 — —Prior use and prior invention
- § 8:186 — —Synthesis of existing authorities
- § 8:187 — — —Individual uses
- § 8:188 — — —Relation to reduction to practice

TABLE OF CONTENTS

- § 8:189 — — —Abandoned and failed experiments
- § 8:190 — — —Secret, noninforming uses
- § 8:191 Geographic limitations
- § 8:192 —Administrative justification
- § 8:193 —Symmetry with local priority
- § 8:194 —“In this country”; Speed of diffusion
- § 8:195 —Historical development
- § 8:196 — —*Shaw v. Cooper*
- § 8:197 — —*Bain v. Morse*
- § 8:198 —Summary

B. PARAGRAPH 102(B)—NOVELTY IN RELATION TO FILING DATE OF APPLICATION

- § 8:199 Generally
- § 8:200 Novelty and priority distinguished
- § 8:201 Historical development and policy justification
- § 8:202 —Patent Act of 1793
- § 8:203 —*Pennock v. Dialogue*, *Shaw v. Cooper*, and the Patent Act of 1836
- § 8:204 —Abandonment
- § 8:205 —Complications
- § 8:206 —The Patent Act of 1870 and *Andrews v. Hovey*
- § 8:207 —Modern authorities
- § 8:208 Absolute novelty v. grace period
- § 8:209 —Acts of 1790, 1793, and 1836: Absolute novelty
- § 8:210 —Act of 1839: Quantified abandonment
- § 8:211 —Post-*Hovey* rationale
- § 8:212 —Patent Act of 1939
- § 8:213 —Modern rationale
- § 8:214 —Current law
- § 8:215 — —Continuing vs. foreign priority applications
- § 8:216 — —Provisional applications
- § 8:217 Prior possession by the public
- § 8:218 —Analogy to paragraph 102(a)
- § 8:219 —Information “known” as of critical date
- § 8:220 —Description in a printed publication
- § 8:221 — —Relationship to paragraph 102(a)
- § 8:222 — —Historical development
- § 8:223 — —Substantive law
- § 8:224 —Patented
- § 8:225 “On sale”; Prefiling commercialization
- § 8:226 —Historical development
- § 8:227 —Modern rationale
- § 8:228 — —Settled issues—Private offers for sale
- § 8:229 — — —Sufficiency of a single offer
- § 8:230 — — —Inherent details

- § 8:231 — — —Sale of patent right
- § 8:232 — — —Unsettled issues—Third-party offers
- § 8:233 — — —Onset of bar—Sufficient technological completion
- § 8:234 — — —*Pfaff v. Wells Electronics*
- § 8:235 — — —“Ready for patenting”
- § 8:236 — — —Initial and improvement inventions
- § 8:237 — — —Sufficient commercialization
- § 8:238 —Commentary
- § 8:239 “In public use”
- § 8:240 —Historical development
- § 8:241 —Withdrawal of material from the public domain
- § 8:242 —Time-wise extension of the applicant’s period of
exclusive control
- § 8:243 — — —*Metallizing Engineering v. Kenyon Bearing*
- § 8:244 — — —Unresolved issues
- § 8:245 —Commentary
- § 8:246 Corroboration and proof requirements
- § 8:247 Experimental use
- § 8:248 —Historical development
- § 8:249 — — —Early cases
- § 8:250 — — —Patent Act of 1839
- § 8:251 — — —*City of Elizabeth v. Nicholson Pavement Co.*
- § 8:252 — — —*Andrews v. Hovey*
- § 8:253 —Modern rationale and law
- § 8:254 — — —Completion of claimed invention
- § 8:255 — — —Inventor’s intent vs. objective circumstances
- § 8:256 — — —Mixed purposes
- § 8:257 — — —Experiments by third parties
- § 8:258 —Difficulties and unsettled issues
- § 8:259 — — —Reduction to practice
- § 8:260 — — —Reliance on exact claim language
- § 8:261 — — —Adequate evidence of experimentation
- § 8:262 —Law vs. fact
- § 8:263 Geographic limitations
- § 8:264 —Historical development
- § 8:265 —Relationship to paragraph 102(a)
- § 8:266 —“On-sale” activities

V. PARAGRAPH 102(C)—ABANDONMENT

- § 8:267 Generally
- § 8:268 Historical development
- § 8:269 —Relation to novelty bar
- § 8:270 —Statutory history
- § 8:271 Modern law
- § 8:272 —Relation to general abandonment
- § 8:273 —Potential issues

TABLE OF CONTENTS

**VI. PARAGRAPH 102(D)—DISPARATE ONSET IN
FOREIGN COUNTRIES**

- § 8:274 Generally
- § 8:275 Policy justification
- § 8:276 Historical development
- § 8:277 Modern law—Relation to period of foreign priority
- § 8:278 —Identical or related applicants
- § 8:279 —Meaning of “patented”
- § 8:280 —Same invention
- § 8:281 National effect

Volume 3

CHAPTER 9. NON-OBVIOUSNESS

I. IN GENERAL

- § 9:1 Introduction and summary
- § 9:2 History
- § 9:3 —*Hotchkiss v. Greenwood*
- § 9:4 —Subsequent developments up to 1952
- § 9:5 —Patent Act of 1952
- § 9:6 —*Graham v. John Deere*
- § 9:7 —Subjectiveness
- § 9:8 Policy justification
- § 9:9 —Existing public domain
- § 9:10 —Patent-driven inventions
- § 9:11 —Other explanations

**II. GRAHAM V. JOHN DEERE AND THE PROCESS
OF DETERMINING OBVIOUSNESS**

- § 9:12 Generally
- § 9:13 *Graham v. John Deere*
- § 9:14 —Compromise for administrative efficiency
- § 9:15 —Historical perspective
- § 9:16 —Patent Act of 1952

A. SCOPE AND CONTENT OF THE PRIOR ART

- § 9:17 Generally
 - 1. Relation to Technological Field; Analogousness
- § 9:18 Generally
- § 9:19 —Inoperative disclosures

2. Timeliness and Other Circumstances; Relation to Paragraphs of Section 102

§ 9:20 Generally

a. “At the Time the Invention Was Made”; Public Knowledge Under 102(A)

§ 9:21 Generally

b. Preservation of Existing Public-Domain; Public Events Under 102(B)

§ 9:22 Generally

§ 9:23 —The law prior to 1952

§ 9:24 —Effect of 1952 Patent Act

§ 9:25 — —*Palmquist*

§ 9:26 — —*Foster*

§ 9:27 —Policy justification

c. Secret Prior Art

§ 9:28 Generally

§ 9:29 —Pipeline justifications

§ 9:30 — —Contents of prior-filed applications under Paragraph 102(e)

§ 9:31 — — —Law prior to 1952

§ 9:32 — — —Patent Act of 1952

§ 9:33 — — — —*Hazeltine Research Inc. v. Brenner*

§ 9:34 — —Prior Inventive Acts under Paragraph 102(g)

§ 9:35 — — —Early law

§ 9:36 — — —*Robbins*

§ 9:37 — — —*Bass*

§ 9:38 — —Contrast with foreign systems

§ 9:39 — —Policy justification

§ 9:40 —Adequacy of applicant's subjective insight

§ 9:41 — —Prior work derived from another under Paragraph 102(f)

§ 9:42 — —Admissions generally

§ 9:43 — —Policy rationale

§ 9:44 —Exceptions for common ownership; 103(c)

§ 9:45 — —Patent law amendments of 1984

§ 9:46 — —Underlying policy

§ 9:47 — —Examples of provision applied

§ 9:48 — —Patent law amendments of 1999 and Paragraph 102(e)

§ 9:49 — —Cooperative Research and Technology Enhancement Act of 2004

TABLE OF CONTENTS

B. DIFFERENCES BETWEEN THE PRIOR ART AND THE CLAIMED INVENTION

§ 9:50 Generally

C. ORDINARILY SKILLED ARTISAN

§ 9:51 Generally

D. SECONDARY CONSIDERATIONS

§ 9:52 Generally

§ 9:53 Treatment in *Graham v. John Deere*

§ 9:54 Early history

§ 9:55 Underlying policy

§ 9:56 —Corollaries

§ 9:57 Types of secondary considerations

§ 9:58 —Long-felt need

§ 9:59 —Simultaneous invention

§ 9:60 —Laudatory statements

§ 9:61 —Copying

§ 9:62 —Commercial success

§ 9:63 — —Underlying rationale

§ 9:64 — — —Consequences

§ 9:65 — — — —Nexus

E. THE DETERMINATION OF OBVIOUSNESS

§ 9:66 Generally

§ 9:67 —Adequate suggestion

§ 9:68 —Obvious to try; Unpredictable arts and optimization

§ 9:69 —Small differences

§ 9:70 —Relation to inherent anticipation

III. STRUCTURES ACCOMPANIED BY PROPERTIES OR USES

§ 9:71 Generally

§ 9:72 —General considerations and explanations

§ 9:73 —Properties of chemical compositions

§ 9:74 — —Historical development

§ 9:75 — —*prima facie*, or structural obviousness

§ 9:76 — —Rebuttal showings

§ 9:77 —Unexpected results

§ 9:78 —Critique; Relation to limits on hybrid claiming

IV. STARTING AND ENDING MATERIALS; BIOTECHNOLOGICAL PROCESSES; PARAGRAPH 103(B)

§ 9:79 Generally

- § 9:80 —Older authorities
- § 9:81 —Federal circuit authorities prior to 1995
- § 9:82 —Biotechnological processes; Section 103(b)
- § 9:83 — —Historical development
- § 9:84 — —Specific statutory provisions
- § 9:85 — —Overall effect
- § 9:86 —Case law developments after 1995
- § 9:87 —Comment: Product and method as a claim construction issue

CHAPTER 10. INVENTORSHIP

I. IN GENERAL

- § 10:1 Introduction; Scope of chapter
- § 10:2 History and policy justification
- § 10:3 —Critique of economic justification
- § 10:4 —Analogy to general law of property

II. RULE OF PROPER INVENTORSHIP

- § 10:5 Rule of proper inventorship
- § 10:6 —Comparison to copyright
- § 10:7 —Corollary rules
- § 10:8 —Perfection of patent rights by assignee
- § 10:9 —General observations

III. DEFINITION OF “INVENTOR”

- § 10:10 Definition of “inventor”
- § 10:11 —Partial analogy to first-to-invent priority
- § 10:12 — —Critique
- § 10:13 —Business entities and employed inventors
- § 10:14 — —Historical development
- § 10:15 — —Conflicts with modern collaborative research
- § 10:16 — —Contrast with copyright
- § 10:17 — —Critique
- § 10:18 — —Recent legislative adjustments

IV. JOINT INVENTORSHIP

- § 10:19 Joint inventorship
- § 10:20 —Joint invention and proper inventorship
- § 10:21 — —Joint inventors and joint applicants distinguished
- § 10:22 — —Structure of discussion in following sections
- § 10:23 —Joint invention defined
- § 10:24 — —General evaluation of area

TABLE OF CONTENTS

§ 10:25	— — Prior limits on correcting inventorship
§ 10:26	— — Basic rule of joint inventorship
§ 10:27	— — — Effect of 1984 amendments
§ 10:28	— — — Examples of basic rule applied
§ 10:29	— — Inventive contribution versus suggestion
§ 10:30	— — — Specific tests identified and critiqued
§ 10:31	— — — Complete or definite conception
§ 10:32	— — — Materiality
§ 10:33	— — — Excess over state of the art
§ 10:34	— — — Consent
§ 10:35	— Joint applicants; Cooperating inventors and the 1984 amendments to Section 116
§ 10:36	— — Application by joint inventors
§ 10:37	— — Joint applications by cooperating inventors
§ 10:38	— — Historical background
§ 10:39	— — — Conflict between the all-claims rule and modern group research
§ 10:40	— — — Legislative purpose of the 1984 amendments
§ 10:41	— — Current interpretation of the 1984 amendments
§ 10:42	— Joint inventors and the meaning of “another”
§ 10:43	— — Sole inventors
§ 10:44	— — Joint inventors
§ 10:45	— — Effect of 1984 amendments
§ 10:46	— — Examples of current rule applied
§ 10:47	— Rights and obligations of joint inventors
§ 10:48	— — Early history
§ 10:49	— — Initial analogy to tenancy in common
§ 10:50	— — Later modifications
§ 10:51	— — Modern rule and rationale
§ 10:52	— — Effective abandonment
§ 10:53	— — Contrast with copyright law

V. CORRECTION OF INVENTORSHIP

§ 10:54	Correction of inventorship
§ 10:55	— Historical development and policy justification
§ 10:56	— — Pre-1952 law
§ 10:57	— — Patent Act of 1952
§ 10:58	— — 1982 amendments
§ 10:59	— — Policy justification
§ 10:60	— Error without deceptive intent
§ 10:61	— Consent
§ 10:62	— Diligence
§ 10:63	— Sole-to-sole conversions
§ 10:64	— — Patent Act of 1952
§ 10:65	— — 1982 amendments

- § 10:66 — —Common vs. non-common assignment; Conflicts
with other limits
- § 10:67 — — —First inventorship
- § 10:68 — — —Lack of novelty

PART III. INFRINGEMENT

CHAPTER 11. TEMPORAL SCOPE

I. OVERVIEW

- § 11:1 Infringement generally
- § 11:2 —Qualities of the patent right
- § 11:3 — —Temporal scope
- § 11:4 — —Geographic scope
- § 11:5 — —Technological scope
- § 11:6 — —Adequate commerciality
- § 11:7 —Structure of following chapters
- § 11:8 Introduction to temporal scope
- § 11:9 History and policy justification
- § 11:10 —Early US law
- § 11:11 —Intermediate period: 17 years from issuance
- § 11:12 —Modern changes
- § 11:13 — —Patent term restoration
- § 11:14 — —20 years from filing
- § 11:15 — —Convoyed changes
- § 11:16 —Policy
- § 11:17 — —Natural right
- § 11:18 — —Economic justifications

II. ONSET AT ISSUANCE AND FILING

- § 11:19 Generally
- § 11:20 Policy and history
- § 11:21 Basic 20-year patent term; applications filed on or
after June 8, 1995
- § 11:22 —Claims of benefit under Sections 120 and 121
- § 11:23 —Claims of foreign and domestic priority
- § 11:24 —Claims to prior PCT applications
- § 11:25 Term restoration
- § 11:26 —1994 provisions; applications filed on or after June
8, 1995
- § 11:27 —1999 provisions; applications filed on or after May
29, 2000
- § 11:28 — —Limitations
- § 11:29 — —Procedures and appeals
- § 11:30 — —Effective date

TABLE OF CONTENTS

- § 11:31 Provisional rights and 18-month publication
- § 11:32 —Policy justification
- § 11:33 —Requirement of published application
- § 11:34 —Limitations
- § 11:35 —Effective date
- § 11:36 —Commentary: general impact of patent value
- § 11:37 Transitional provisions; applications filed before June 8, 1995

III. BEGINNING AND ENDING OF THE TERM

- § 11:38 Beginning of the term
- § 11:39 Ending of the term

IV. PATENT TERM EXTENSIONS UNDER SECTION 156

- § 11:40 Generally
- § 11:41 History and policy justification
- § 11:42 Basic extension
- § 11:43 Application for extension
- § 11:44 Interim extensions
- § 11:45 Special issues
- § 11:46 —Identity of drug product
- § 11:47 — —Salts and esters
- § 11:48 — —Pro-drugs and metabolites
- § 11:49 — —Combinations and subcombinations

CHAPTER 12. GEOGRAPHIC SCOPE

I. OVERVIEW

- § 12:1 Generally
- § 12:2 Historical development
- § 12:3 —Early decisions and statutes
- § 12:4 —*Brown v. Duchesne, Gardiner v. Howe*
- § 12:5 —Patent Act of 1870 and subsequent decisions
- § 12:6 —Patent Act of 1952 and subsequent developments
- § 12:7 — —*Deepsouth Packing Co. v. Laitram Corp.* and Section 271(f)
- § 12:8 — —Section 271(g)
- § 12:9 — —Outer space and Section 105
- § 12:10 Policy justification

II. ENCOMPASSED TERRITORY

- § 12:11 Generally
- § 12:12 Territories and controlled spaces

- § 12:13 Registered vessels
- § 12:14 Outer space

III. SITUS OF ACCUSED ACTIVITY

- § 12:15 Generally
- § 12:16 Making
- § 12:17 Using
- § 12:18 Sale
- § 12:19 Offer for sale
- § 12:20 —Situs of offer
- § 12:21 —Requirement of domestic sale

IV. CROSS-BORDER TRANSACTIONS

- § 12:22 Generally

A. OUTGOING TRANSACTIONS

- § 12:23 Generally
- § 12:24 Export of claimed embodiments
- § 12:25 Export of apparatus to perform claimed process
- § 12:26 Inducing and contributing to foreign practice of invention; Section 271(f)
- § 12:27 Early cases
- § 12:28 *Deepsouth Packing Co. v. Laitram Corp.*
- § 12:29 Section 271(f); Patent Law Amendments Act of 1984
- § 12:30 Inducing and contributing to foreign practice of invention; Section 271(f)—Special issues
- § 12:31 — — *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*
- § 12:32 — — —Commentary

B. INCOMING TRANSACTIONS

- § 12:33 Generally
- § 12:34 Products produced with patented materials
- § 12:35 Products made by patented apparatus
- § 12:36 Products made by patented process; Section 271(g)
- § 12:37 —History
- § 12:38 —Section 271(g); Process Patents Amendment Act of 1988
- § 12:39 — —The meaning of “product”
- § 12:40 — —Products “made by” process
- § 12:41 —Special issues
- § 12:42 — —Domestic application
- § 12:43 — —Relation to issue date of asserted patent
- § 12:44 —Presumption as to making

TABLE OF CONTENTS

- § 12:45 Foreign inducement of infringing acts inside the
United States

V. TRANSITORY EMBODIMENTS

- § 12:46 Generally

Volume 4

**CHAPTER 13. TECHNOLOGICAL SCOPE—
DIRECT**

I. OVERVIEW

- § 13:1 Generally

II. HISTORY AND POLICY JUSTIFICATION

- § 13:2 Generally

A. EARLY HISTORY

- § 13:3 Generally

B. THE IMPACT OF CLAIM THEORY

- § 13:4 Generally
§ 13:5 Central claiming and technological scope
§ 13:6 —*Winans v. Denmead*
§ 13:7 —Criticisms
§ 13:8 Technological scope and peripheral claiming

**C. EQUIVALENTS UNDER PERIPHERAL
CLAIMING**

- § 13:9 Generally
§ 13:10 Developments to 1950
§ 13:11 —Descriptions by learned hand
§ 13:12 *Graver Tank & Mfg. Co. v. Linde Air Products Co.*
§ 13:13 Developments in the Federal Circuit to 1994
§ 13:14 *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.,
Inc.*
§ 13:15 —Initial Federal Circuit decision
§ 13:16 — —Majority opinion
§ 13:17 — —Dissenting opinions
§ 13:18 —Decision of the supreme court
§ 13:19 — —Effect of 1952 Patent Act
§ 13:20 — —Equity vs. law

- § 13:21 — —Factual equivalency
- § 13:22 — —All-elements rule
- § 13:23 — —Prosecution history estoppel
- § 13:24 — —Time frame
- § 13:25 — —Concurring opinion
- § 13:26 —Federal Circuit decision on remand
- § 13:27 *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*
- § 13:28 —Early procedural history
- § 13:29 —Facts
- § 13:30 —Federal Circuit 3-judge decision on remand
- § 13:31 —Federal Circuit *en banc* decision
- § 13:32 — —Majority opinion
- § 13:33 — —Concurrences and dissents
- § 13:34 —Supreme court opinion
- § 13:35 —Federal Circuit decision on second remand
- § 13:36 — —Majority opinion
- § 13:37 — —Concurrences and dissents
- § 13:38 *Johnson & Johnston v. R.E. Service Co.*
- § 13:39 Subsequent developments

D. POLICY JUSTIFICATION

- § 13:40 Introduction
- § 13:41 General Principles
- § 13:42 Role of claims and claim theory

III. TECHNOLOGICAL SCOPE UNDER PERIPHERAL CLAIMING

A. OVERVIEW

- § 13:43 Generally

B. LITERAL INFRINGEMENT

- § 13:44 Generally
- § 13:45 History and policy justification
- § 13:46 Relation to claim interpretation
- § 13:47 “All-elements” rule
- § 13:48 —Methods
- § 13:49 —Additional elements or functions
- § 13:50 —Alternative species
- § 13:51 Reverse doctrine of equivalents

C. DOCTRINE OF EQUIVALENTS

1. Overview

- § 13:52 Generally

TABLE OF CONTENTS

2. Policy justification

- § 13:53 Generally
- § 13:54 Notice vs. definitional accuracy
- § 13:55 Language issues
- § 13:56 —Later-discovered technology
- § 13:57 —Context and inadvertent mistakes
- § 13:58 — —Non-patent example
- § 13:59 — —Patent example: *International Rectifier Corp. v. Ixys Corp.*
- § 13:60 —Infringement by equivalents as a reaction
- § 13:61 Law vs. equity
- § 13:62 Relation to reissue

3. Factual equivalency

- § 13:63 Generally
- § 13:64 History and policy justification
- § 13:65 Formulation of test
- § 13:66 —Function, way, result
- § 13:67 —Insubstantial differences
- § 13:68 —Commentary and synthesis
- § 13:69 — —Inventive concept
- § 13:70 — —*Sanitary Refrigerator Co. v. Winters*
- § 13:71 — —*Claude Neon Lights v. E. Machlett & Son.*
- § 13:72 — —Illustrative diagram
- § 13:73 Element-by-element inquiry
- § 13:74 Pioneer inventions vs. improvements
- § 13:75 Known interchangeability
- § 13:76 —Time frame

4. Legal defenses

- § 13:77 Generally
- § 13:78 Graphical illustration
- § 13:79 Prior art
- § 13:80 —History and policy justification
- § 13:81 —Obvious variations
- § 13:82 — —*Wilson Sporting Goods*
- § 13:83 —Hypothetical claim
- § 13:84 —Burdens of proof
- § 13:85 —Required relation to patent claim
- § 13:86 —Other issues of patentability
- § 13:87 Patentee's conduct
- § 13:88 —Policy justification
- § 13:89 — —Abandonment and classical estoppel
- § 13:90 — —Analogy to novelty requirement
- § 13:91 — —Judicial estoppel
- § 13:92 —Disclosure dedication

- § 13:93 — —Historical development
- § 13:94 — —Early Federal Circuit decisions
- § 13:95 — — —*Maxwell v. J. Baker, Inc.*
- § 13:96 — — —*YBM Magnex, Inc. v. USITC*
- § 13:97 — — —*Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.*
- § 13:98 — —Definition of “claimed”
- § 13:99 — —Definition of “disclosed”
- § 13:100 — —Dedication via other activities
- § 13:101 — —Prosecution history estoppel
- § 13:102 — —History and policy justification
- § 13:103 — —Estopping events
- § 13:104 — — —Cancellations and substitutions
- § 13:105 — — —Arguments
- § 13:106 — — —Narrowing of related claims and applications
- § 13:107 — — —Formal rejections and restrictions
- § 13:108 — — —Insufficient disclosure rejections
- § 13:109 — —Extent of estoppel
- § 13:110 — — —Underlying purpose
- § 13:111 — — —*Festo*
- § 13:112 — — —Subsequent decisions
- § 13:113 All-elements rule

IV. CENTRAL CLAIMING AND MEANS EXPRESSIONS

- § 13:114 Generally

CHAPTER 14. ADEQUATE COMMERCIALITY

- § 14:1 Generally
- § 14:2 — —Historical development
- § 14:3 — —Early United States statutes
- § 14:4 — —Patent Acts of 1836 and 1870
- § 14:5 — —Patent Act of 1952
- § 14:6 — —Regulated inventions and the Hatch-Waxman Act
- § 14:7 — — —1984 Hatch-Waxman Act
- § 14:8 — — —Subsequent developments to 2003
- § 14:9 — — —2003 Amendments
- § 14:10 — —GATT/TRIPs and offers for sale
- § 14:11 — —Policy justifications
- § 14:12 — —Commercial exclusivity
- § 14:13 — —Rule-based implementation
- § 14:14 — —Definition without reference to intent
- § 14:15 — — —Comparison to copyright

TABLE OF CONTENTS

§ 14:16	— — —Intent as circumstantial evidence
§ 14:17	— — —Contrast with indirect infringement
§ 14:18	Acts of infringement
§ 14:19	—Making
§ 14:20	— —Basic definition
§ 14:21	— — —Radio Corporation of America v. Andrea
§ 14:22	— — —Deepsouth Packing Co. v. Laitram Corp.
§ 14:23	— — — —Holding
§ 14:24	— — —Deepsouth Packing Co. v. Laitram Corp— Effect of subsequent enactment of section 271(f)
§ 14:25	— — —Developments after 1982
§ 14:26	— — — —Paper Converting Machine Co. v. Magna- Graphics Corp.
§ 14:27	— — — —Subsequent developments
§ 14:28	— —Inapplicability to method inventions
§ 14:29	— —Questions of capacity for use
§ 14:30	— — —Modifications required before use
§ 14:31	— — —Capacity for additional uses
§ 14:32	—Using
§ 14:33	— —Basic definition
§ 14:34	— —Use of method inventions
§ 14:35	— — —Contrast with making and selling; offers to use
§ 14:36	— — —Serial performance by different persons
§ 14:37	— —Use of claimed structure for alternative purpose
§ 14:38	—Selling
§ 14:39	— —Basic definition
§ 14:40	— —Delivery
§ 14:41	— —Sale vs. license
§ 14:42	— —Transfer of embodiments vs. intellectual property rights
§ 14:43	— —Inapplicability to method inventions
§ 14:44	— —Relation to offers for sale
§ 14:45	—Offers for sale
§ 14:46	— —Historical development
§ 14:47	— —Basic definition
§ 14:48	— —Section 271(i); date of offered sale
§ 14:49	— —Application to methods; offers to use
§ 14:50	Experimental, noncommercial and de minimis activities
§ 14:51	—Experimental uses generally
§ 14:52	— —Early history
§ 14:53	— —Policy justification
§ 14:54	— —Pre-Federal Circuit developments
§ 14:55	— —Developments in the court of claims
§ 14:56	— —Developments in the Federal Circuit
§ 14:57	— — —Experimental use for regulatory approval

- § 14:58 — — —Use of genomic material
- § 14:59 — — —Recent developments
- § 14:60 —Regulated inventions and the Hatch-Waxman Act
- § 14:61 — — —Historical development
- § 14:62 — — —Early history
- § 14:63 — — —Roche Prod. Inc. v. Bolar Pharmaceutical Co.,
Inc.
- § 14:64 — — —Initial Hatch-Waxman Act
- § 14:65 — — —Eli Lilly and Co. v. Medtronic, Inc.
- § 14:66 — — —1988 and 2003 statutory amendments
- § 14:67 — — —Merck KGaA v. Integra Lifesciences I, Ltd.
- § 14:68 — — —271(e)(1)—Safe harbor
- § 14:69 — — —Application to medical devices
- § 14:70 — — — —Eli Lilly and Co. v. Medtronic, Inc.
- § 14:71 — — —Class I and II medical devices
- § 14:72 — — —Reasonably related uses
- § 14:73 — — — —Merck KGaA v. Integra Lifesciences I, Ltd.
- § 14:74 — — — —Subsequent developments
- § 14:75 — — —271(e)(2)—Technical infringement
- § 14:76 — — —Statutory mechanics
- § 14:77 — — —Special issues
- § 14:78 — — — —Limitations on remedies
- § 14:79 — — — —Relation to induced infringement
- § 14:80 — — — —Availability of declaratory judgment action

Volume 5

CHAPTER 15. INDIRECT INFRINGEMENT

- § 15:1 Generally
- § 15:2 Historical development
- § 15:3 —Early history
- § 15:4 —Blake v. Smith, Wallace v. Holmes, and the onset of
indirect infringement
- § 15:5 —License restrictions, unpatented supplies, and
Henry v. A.B. Dick
- § 15:6 —Judicial reaction and the development of patent
misuse
- § 15:7 — —Motion Picture Patents Co. v. Universal Film
Mfg. Co.
- § 15:8 — —Carbice Corporation of America v. American
Patents Development Corporation
- § 15:9 — —Mercoid Corp. v. Mid-Continent Inv. Co.
- § 15:10 —1952 Patent Act; paragraphs 271(b), (c), (d)
- § 15:11 —Aro Mfg. Co. v. Convertible Top Replacement Co.
- § 15:12 —Dawson Chemical Co. v. Rohm and Haas Co.
- § 15:13 —1988 Patent Misuse Reform Act

TABLE OF CONTENTS

- § 15:14 Policy justification
- § 15:15 Inducing infringement; section 271(b)
- § 15:16 —Proof of direct infringement
- § 15:17 —Required relation to direct infringer
- § 15:18 — —Sale of materials suited to dual use
- § 15:19 — —Inducement by officers and directors
- § 15:20 —Required knowledge and intent
- § 15:21 Contributory infringement; section 271(c)
- § 15:22 —Proof of direct infringement
- § 15:23 —Staple vs. nonstaple article of commerce
- § 15:24 —Required knowledge and intent

PART IV. POSTISSUANCE PROCEEDINGS

CHAPTER 16. REISSUE AND REEXAMINATION

I. IN GENERAL

- § 16:1 Generally

II. HISTORICAL DEVELOPMENT

A. IN GENERAL

- § 16:2 Generally

B. REISSUE

- § 16:3 Generally
- § 16:4 Prestatutory history
- § 16:5 —*Grant v. Raymond*
- § 16:6 Early statutory history
- § 16:7 —Patent Act of July 3, 1832
- § 16:8 —Patent Act of 1836
- § 16:9 —Patent Act of 1870
- § 16:10 Developments up to 1882: dealing with broadening
reissues
- § 16:11 —The problem of broadening
- § 16:12 — —Mistaken reliance
- § 16:13 — —Inclusion of later inventions
- § 16:14 — —Speculation
- § 16:15 — —Example: Woodworth patents
- § 16:16 — —Example: *Hoffheins v. Brand*
- § 16:17 —Reactive measures
- § 16:18 — —Patent Act of 1836; outright ban on broadening

- § 16:19 — — — Impact of central claiming; *Carver v. Braintree*
- § 16:20 — — — Disagreement over statutory interpretation
- § 16:21 — — — Broadening reissues allowed; *Battin v. Taggart*
- § 16:22 — — — Insistence on same invention
- § 16:23 — — — *Goodyear v. Day*
- § 16:24 — — — *Giant Powder Co. v. California Powder Works*
- § 16:25 — — — Inadvertence, accident, or mistake
- § 16:26 — — — General claiming requirements
- § 16:27 — — — *O'Reilly v. Morse*
- § 16:28 — — — *Burr v. Duryee*
- § 16:29 — — — *Carlton v. Bokee*
- § 16:30 — — — Prohibition against new matter
- § 16:31 — — — Earliest Patent Office practices
- § 16:32 — — — Patent Office rules
- § 16:33 — — — Initial use of parol evidence
- § 16:34 — — — Later prohibition of parol evidence
- § 16:35 — — — Judicial reactions
- § 16:36 — — — Patent Act of 1870
- § 16:37 — — — Later court decisions
- § 16:38 — — — Overall effect; reduction in frequency of reissue
- § 16:39 — — — Models as a lingering problem
- § 16:40 — — — Imposition of time limit
- § 16:41 — — — Early calls for reform
- § 16:42 — — — *Miller v. Bridgeport Brass Co.*
- § 16:43 — — — — Factual setting
- § 16:44 — — — — Supreme Court decision
- § 16:45 — — — — Subsequent acceptance
- § 16:46 — — — — Effect on reissue practice
- § 16:47 — — — — Developments 1882–1952
- § 16:48 — — — — Effect of reissue on existing causes of action
- § 16:49 — — — — Patent Act of 1928
- § 16:50 — — — — Rule against recapture
- § 16:51 — — — — Intervening rights
- § 16:52 — — — — Pre-1882: no defense
- § 16:53 — — — — 1882–1915: invalidity
- § 16:54 — — — — 1915–1952: rise of personal defense
- § 16:55 — — — — Early cases
- § 16:56 — — — — *Sontag Chain Stores Co. Limited v. National Nut Co. of California*
- § 16:57 — — — — Patent Act of 1952
- § 16:58 — — — — Section 251
- § 16:59 — — — — Section 252
- § 16:60 — — — — Section 253
- § 16:61 — — — — Subsequent amendments

TABLE OF CONTENTS

C. REEXAMINATION

- § 16:62 Generally
- § 16:63 Early developments
- § 16:64 “No-defect” reissue practice under the Dann amendments
- § 16:65 Patent Act of 1980
- § 16:66 Inter partes reexamination under the 1999 amendments
- § 16:67 2002 Amendments
- § 16:68 Subsequent developments

III. POLICY JUSTIFICATION

- § 16:69 Generally
- § 16:70 Reissue
- § 16:71 Reexamination

IV. REISSUE

A. IN GENERAL

- § 16:72 Generally

B. REQUIREMENTS FOR ELIGIBILITY

- § 16:73 Generally
- § 16:74 Defect
- § 16:75 —Claims
- § 16:76 — —Narrowing changes
- § 16:77 — —Broadening changes
- § 16:78 — — —Definition of broadening
- § 16:79 — — —Two-year time limit
- § 16:80 — —Changes to improve definiteness
- § 16:81 —Disclosure and the prohibition of new matter
- § 16:82 —Assertions of priority under section 119
- § 16:83 —Assertions of continuation status under section 120
- § 16:84 —Changes in inventorship
- § 16:85 Mechanisms to prevent expanded prosecution
- § 16:86 —Same invention
- § 16:87 — —Early history
- § 16:88 — —Court decisions prior to 1952
- § 16:89 — — —*Parker & Whipple Co. v. Yale Clock Co.*
- § 16:90 — — —*U.S. Industrial Chemicals v. Carbide & Carbon Chemicals Corporation*
- § 16:91 — —Patent Act of 1952
- § 16:92 — —Court decisions to 1982
- § 16:93 — —Federal Circuit decisions

- § 16:94 — — — *In re Hounsfielde*
- § 16:95 — — — *In re Weiler*
- § 16:96 — — — *In re Amos*
- § 16:97 — — — Analysis and recommendation
- § 16:98 — — — Lack of deceptive intent
- § 16:99 — — — Error
- § 16:100 — — — Historical development
- § 16:101 — — — Early statutory provisions
- § 16:102 — — — 1846–1884; *Stimpson v. West Chester R Co.*
- § 16:103 — — — 1884–1952; *Mahn v. Harwood*
- § 16:104 — — — 1952 Patent Act
- § 16:105 — — — General definition
- § 16:106 — — — Nonelected subject matter
- § 16:107 — — — Rule against recapture
- § 16:108 — — — Reissue oath

C. LIMITATIONS ON REMEDIES

- § 16:109 — — — Generally
- § 16:110 — — — Time span
- § 16:111 — — — Treatment of original rights
- § 16:112 — — — Newly added rights
- § 16:113 — — — Starting date of new rights
- § 16:114 — — — Expiration date of new rights
- § 16:115 — — — Intervening rights
- § 16:116 — — — Historical development
- § 16:117 — — — Calculation on date of reissue grant
- § 16:118 — — — Application to narrowing claims
- § 16:119 — — — Implied license as to existing embodiments
- § 16:120 — — — Potential license to continue other utilization

V. REEXAMINATION

- § 16:121 — — — Generally
- § 16:122 — — — Overview of reexamination procedures
- § 16:123 — — — Ex parte procedures
- § 16:124 — — — Inter partes procedures
- § 16:125 — — — Constitutional questions
- § 16:126 — — — Court review, jury trials, and retroactivity
- § 16:127 — — — Due process and estoppel
- § 16:128 — — — Substantial new question of patentability
- § 16:129 — — — “Substantial”
- § 16:130 — — — “New”
- § 16:131 — — — Stays of parallel proceedings
- § 16:132 — — — Scope of reexamination
- § 16:133 — — — Effect of reexamination
- § 16:134 — — — Intervening rights

TABLE OF CONTENTS

- § 16:135 —Estoppel of unsuccessful third-party requester in
inter partes reexamination

Volume 6

PART V. DEFENSES

**CHAPTER 17. DEFENSES GENERALLY—
NONINFRINGEMENT AND INVALIDITY**

- § 17:1 Generally
§ 17:2 Relation of current statute to general pleading theory
§ 17:3 —Prior statutes generally
§ 17:4 —Patent infringement actions and pleading theory
generally
§ 17:5 — —Defenses in pleading theory generally
§ 17:6 — — —Negation vs. avoidance
§ 17:7 — — —Common-law pleading practices
§ 17:8 — — —Modern federal code pleading
§ 17:9 —Application to patent statute
§ 17:10 — —Defenses in prior statutes
§ 17:11 — —Section 282
§ 17:12 — —Status of pleading under current statute
§ 17:13 — — —Notice of prior art
§ 17:14 Noninfringement
§ 17:15 Invalidity
§ 17:16 —Presumption of validity
§ 17:17 — —Burdens of proof
§ 17:18 — —Standard of proof
§ 17:19 —Mootness and order of resolution
§ 17:20 — —General considerations
§ 17:21 — —Early developments
§ 17:22 — — —Supreme Court decisions
§ 17:23 — — —Subsequent lower-court decisions to 1982
§ 17:24 — —*Cardinal Chemical Co. v. Morton International,
Inc.*
§ 17:25 Subsequent developments
§ 17:26 Mootness and order of resolution—Issue preclusion
§ 17:27 Invalidity—Issue preclusion—Traditional rule
§ 17:28 Mootness and order of resolution—Issue preclusion—
*Blonder-Tongue Laboratories, Inc. v. University of
Illinois Foundation*
§ 17:29 — — —Facts
§ 17:30 — — —Holding
§ 17:31 —Full and fair opportunity to litigate
§ 17:32 —Subsequent developments

- § 17:33 Invalidity—Estoppel by transfer of ownership
- § 17:34 — — —Licensee estoppel
- § 17:35 — — —Early history
- § 17:36 — — —*Lear, Inc. v. Adkins*
- § 17:37 — — — —Holding
- § 17:38 — — — —Modern rule
- § 17:39 — — — —Recovery of royalties paid
- § 17:40 — — — —Escrow and breach
- § 17:41 — — —Prior consent decrees and settlements
- § 17:42 — —Assignee estoppel
- § 17:43 — —Assignor estoppel

CHAPTER 18. MISUSE

- § 18:1 Generally
- § 18:2 Historical development
- § 18:3 —Initial period: onset to 1913
- § 18:4 — —Indirect infringement
- § 18:5 — — —Initial recognition; *Wallace v. Holmes*
- § 18:6 — — —Limitations; *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*
- § 18:7 — —The proliferation of restrictive licensing
- § 18:8 — —Indirect infringement—Patent rights as property
- § 18:9 — — —Restrictive covenants in patented inventions
- § 18:10 — — —*Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*
- § 18:11 — — —*Henry v. A.B. Dick Co.*
- § 18:12 —Judicial reaction: 1913 to 1952
- § 18:13 — —*Bauer & Cie v. O'Donnell*
- § 18:14 — —*Motion Picture Patents Co. v. Universal Film Mfg. Co.*
- § 18:15 — —*Carbice Corporation of America v. American Patents Development Corporation*
- § 18:16 — —*Mercoide Corp. v. Mid-Continent Inv. Co.*
- § 18:17 —Statutory regulation; 1952 to present
- § 18:18 — —1952 Patent Act; paragraphs 271(b), (c), (d)
- § 18:19 — —Supreme Court decisions to 1982
- § 18:20 — — —*Zenith Radio Corp. v. Hazeltine Research, Inc.*
- § 18:21 — — —*Dawson Chemical Co. v. Rohm and Haas Co.*
- § 18:22 — —Federal Circuit decisions to 1988
- § 18:23 — —1988 Patent Misuse Reform Act
- § 18:24 — —Subsequent Federal Circuit decisions
- § 18:25 Policy justification
- § 18:26 Specific acts of misuse
- § 18:27 —Refusal of patent owner to participate in the market
- § 18:28 — —Suppression
- § 18:29 — —Refusal to license

TABLE OF CONTENTS

- § 18:30 — —Excessive royalties
- § 18:31 — —Discriminatory royalties
- § 18:32 —Restrictions on licensee's freedom of action
- § 18:33 — —Territorial limitations
- § 18:34 — —Industry or commercial field limitations;
prohibited customers
- § 18:35 — —Resale restraints; price fixing
- § 18:36 — —Covenant not to deal in competing goods
- § 18:37 —Actions required of licensee
- § 18:38 — —Royalty based on unpatented subject matter
- § 18:39 — —Grant-back clauses
- § 18:40 — —Post-expiration royalties
- § 18:41 — —Tying arrangements

CHAPTER 19. DEFENSES: EXPRESS AND IMPLIED LICENSES; EXHAUSTION

- § 19:1 Generally
- § 19:2 Historical development
- § 19:3 —Express licenses
- § 19:4 —Early implied licenses
- § 19:5 — —License to use, based on purchase
- § 19:6 — —License from recovered infringements
- § 19:7 —Subsequent developments
- § 19:8 — —Imposition of implied license in other
circumstances
- § 19:9 — —Effect of express limitations by patent owner
- § 19:10 — — —Initial recognition
- § 19:11 — — —Early expansion
- § 19:12 — — —Framing the dispute; *Keppell v. Bailey*
- § 19:13 — — —Early indecision
- § 19:14 — — —The ascendancy of property
- § 19:15 — — — —*Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*
- § 19:16 — — — —*Henry v. A.B. Dick Co.*
- § 19:17 — — —Reaction: Restrictions on the division of title
- § 19:18 — — — —*Miles Medical Co. v. John D. Park & Sons Co.*
- § 19:19 — — — —*Bauer & Cie v. O'Donnell*
- § 19:20 — — — —Supreme Court decisions in 1917
- § 19:21 — — — —Subsequent developments
- § 19:22 — — — —Contractual powers limited
- § 19:23 — — — —Extent of limit addressed
- § 19:24 —Federal Circuit decisions
- § 19:25 —Subsequent Supreme Court decisions
- § 19:26 — —*Leegin Creative Leather Products, Inc. v. PSKS, Inc.*

- § 19:27 — — *Quanta Computer, Inc. v. LG Electronics, Inc.*
- § 19:28 *Bowman v. Monsanto Co.*
- § 19:29 Policy Justification
- § 19:30 —Express versus implied
- § 19:31 —Implied in fact versus implied in law
- § 19:32 —Prohibition Against Restraints on Chattel; Freedom of Contract
- § 19:33 —Actions in patent versus actions in contract
- § 19:34 —Exhaustion and implied-in-law licenses compared
- § 19:35 Express licenses
- § 19:36 Implied licenses
- § 19:37 —Licenses implied in fact
- § 19:38 —Licenses implied in law
- § 19:39 — —First sale doctrine
- § 19:40 — — —“Unrestricted” sales; Effect of contract limitation
- § 19:41 — — —“Embodiments” and range of patents subject to doctrine
- § 19:42 — —Involuntary sales
- § 19:43 — —Repair versus reconstruction
- § 19:44 — —Recovered infringements
- § 19:45 — —Parallel importation and international sales

CHAPTER 20. DEFENSES: SECTION 287(C); MEDICAL AND DIAGNOSTIC PROCEDURES

- § 20:1 Generally
- § 20:2 Historical development
- § 20:3 —Patenting medical technology generally
- § 20:4 —Specific prior examples
- § 20:5 — —*Pallin v. Singer*
- § 20:6 —Proposed responses
- § 20:7 — —H.R. 1127
- § 20:8 — —S. 1334
- § 20:9 — —H.R. 3814
- § 20:10 — —S. 2105
- § 20:11 — —H.R. 3610 and H.R. 4278
- § 20:12 —Public Law 104-208
- § 20:13 —Subsequent developments
- § 20:14 Policy justification
- § 20:15 Basic rule
- § 20:16 Definitions
- § 20:17 —Affected subject matter: medical activity
- § 20:18 —Immunized persons
- § 20:19 — —Medical practitioner
- § 20:20 — —Related health-care entity
- § 20:21 Exceptions

TABLE OF CONTENTS

§ 20:22 Effective date

**CHAPTER 21. DEFENSES: SECTION 286;
SIX-YEAR LIMITATION**

- § 21:1 Generally
- § 21:2 Historical development
- § 21:3 —Early cases
- § 21:4 —Patent Act of 1870
- § 21:5 —Revised Statutes of 1874
- § 21:6 —*Campbell v. City of Haverhill*
- § 21:7 —Patent Act of 1897
- § 21:8 —Subsequent cases to 1952
- § 21:9 — —*Peters v. Hanger*
- § 21:10 — —*Pollen v. Ford Instrument Co*
- § 21:11 —Patent Act of 1952
- § 21:12 —Court decisions since 1982
- § 21:13 — —*Standard Oil Co. v. Nippon Shokubai Kagaku Kogyo Co.*
- § 21:14 — —*Stucki Co. v. Buckeye Steel Castings Co.*
- § 21:15 — —*Hughes Aircraft Co. v. National Semiconductor Corp.*
- § 21:16 Policy justification
- § 21:17 Basic rule
- § 21:18 Subsidiary Issues
- § 21:19 —Burden of proof
- § 21:20 —Burden of pleading
- § 21:21 —Accrual
- § 21:22 — —Indirect infringers
- § 21:23 —Tolling
- § 21:24 — —Effect of contractual agreements

**CHAPTER 22. DEFENSES: SECTION 273;
PRIOR INVENTOR, PRIOR-USER RIGHTS**

- § 22:1 Generally
- § 22:2 Historical development
- § 22:3 —Prior-user rights generally
- § 22:4 — —Correction to first-to-file
- § 22:5 — —Protectionism
- § 22:6 — —Shelter for trade-secret user
- § 22:7 —Prior-user rights internationally
- § 22:8 — —Prior-user rights and the Paris Convention
- § 22:9 — — —Original 1883 text
- § 22:10 — — —Subsequent amendments
- § 22:11 — —Prior-user rights and GATT/TRIPs
- § 22:12 — —Prior-user rights and the Patent Law Treaty
- § 22:13 —Prior-user rights in United States

- § 22:14 — —Proposed legislation, 1992–1997
- § 22:15 — —American Inventors Protection Act 1999 and the
prior-inventor defense
- § 22:16 — —Case law decisions
- § 22:17 Policy justification
- § 22:18 Basic rule
- § 22:19 Definitions
- § 22:20 —Limitation to business methods
- § 22:21 —Commercial use
- § 22:22 — —Use by non-profit entity
- § 22:23 —Effective filing date
- § 22:24 Scope of defense
- § 22:25 —Limitation to particular uses
- § 22:26 —Extension by exhaustion

CHAPTER 23. DEFENSES: LACHES

- § 23:1 Generally
- § 23:2 Scope of chapter; Forms of laches distinguished
- § 23:3 Historical development
- § 23:4 Law vs. Equity generally
- § 23:5 Historical development—Law vs. Equity generally—
Laches vs. Statutes of Limitation
- § 23:6 —Application to actions for patent infringement
- § 23:7 — —Early period
- § 23:8 — —*Campbell v. City of Haverhill*
- § 23:9 — —Section 6, Patent Act of 1897
- § 23:10 — —Court decisions, 1895—1915
- § 23:11 — —Judiciary Act of 1915
- § 23:12 — —Patent Act of 1946
- § 23:13 —Patent Act of 1952
- § 23:14 —Application to actions for patent infringement—
Federal Circuit decisions
- § 23:15 — — —*Cornetta v. U.S.*
- § 23:16 — — —*Aukerman v. Chaides*
- § 23:17 — — — —Facts
- § 23:18 — — — —Initial panel decision
- § 23:19 — — — —*En banc* decision
- § 23:20 — — — —Subsequent decisions
- § 23:21 Policy justification
- § 23:22 General rule
- § 23:23 Special issues
- § 23:24 —Unreasonable delay
- § 23:25 — —Onset of period
- § 23:26 — — —*Wanlass v. General Elec. Co.*
- § 23:27 — — —*Wanlass v. Fedders*
- § 23:28 — — —Subsequent decisions

TABLE OF CONTENTS

§ 23:29	— —Excuses
§ 23:30	— — —Other litigation
§ 23:31	— — —Insecure title
§ 23:32	— — —Ongoing license negotiations
§ 23:33	— — —Poverty
§ 23:34	— — —Lack of counsel
§ 23:35	— — —Prior minimal infringement
§ 23:36	—Prejudice to defendant
§ 23:37	— —Economic prejudice
§ 23:38	—Unreasonable delay—Evidentiary prejudice
§ 23:39	—Burdens of pleading and proof
§ 23:40	—Six-year presumption
§ 23:41	—Defendant's unclean hands
§ 23:42	—Effect on remedies
§ 23:43	Developments in the Supreme Court
§ 23:44	— <i>Petrella v. Metro-Goldwyn-Mayer, Inc.</i>
§ 23:45	— <i>SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC.</i>

CHAPTER 24. DEFENSES: ESTOPPEL

§ 24:1	Generally
§ 24:2	Scope of chapter
§ 24:3	Estoppel generally
§ 24:4	—Basic definition
§ 24:5	—Early categories of estoppels; estoppels <i>in pais</i>
§ 24:6	—Development of estoppel by conduct and equitable estoppel
§ 24:7	—Elements of equitable estoppel
§ 24:8	Historical development of estoppels as defense to patent infringement
§ 24:9	Historical development of estoppel as defense to patent infringement—Early law; <i>Wyeth v. Stone</i>
§ 24:10	—Example court decisions to 1982
§ 24:11	— — <i>Dwight & Lloyd Sintering Co. v. Greenawalt</i>
§ 24:12	— — <i>Continental Coatings Corporation v. Metco, Inc.</i>
§ 24:13	— — <i>Advanced Hydraulics, Inc. v. Otis Elevator Co</i>
§ 24:14	— —Summary
§ 24:15	—Federal Circuit developments
§ 24:16	— —Early decisions
§ 24:17	— — <i>A.C. Aukerman Co. v. R.L. Chaides Const. Co.</i>
§ 24:18	— —Subsequent developments
§ 24:19	Policy justification
§ 24:20	—In general
§ 24:21	—Estoppel vs. laches
§ 24:22	—Estoppel vs. fraud
§ 24:23	Basic rule

- § 24:24 Specific issues
- § 24:25 —Communication from patent owner
- § 24:26 — —Threat, silence, and delay
- § 24:27 — —Other litigation
- § 24:28 —Reliance
- § 24:29 —Material prejudice
- § 24:30 —Proof issues
- § 24:31 —Unclean hands
- § 24:32 —Impact on remedies

Volume 7

Table of Laws and Rules

Table of Cases

Index