

AMERICAN
CASEBOOK
SERIES

CASES AND MATERIALS ON
PATENT LAW

Third Edition



Martin J. Adelman, Randall R. Rader,
John R. Thomas

WEST

CASES AND MATERIALS ON
PATENT LAW
Third Edition

■ ■ ■

By

Martin J. Adelman

*Theodore and James Pedas Family Professor of
Intellectual Property and Technology Law
George Washington University*

Randall R. Rader

*Circuit Judge
United States Court of Appeals for the Federal Circuit
Professorial Lecturer in Law
George Washington University*

John R. Thomas

*Professor of Law
Georgetown University*

AMERICAN CASEBOOK SERIES®

WEST®

A Thomson Reuters business

Thomson Reuters created this publication to provide you with accurate and authoritative information concerning the subject matter covered. However, this publication was not necessarily prepared by persons licensed to practice law in a particular jurisdiction. Thomson Reuters does not render legal or other professional advice, and this publication is not a substitute for the advice of an attorney. If you require legal or other expert advice, you should seek the services of a competent attorney or other professional.

American Casebook Series is a trademark registered in the U.S. Patent and Trademark Office.

© West, a Thomson business, 1998, 2003

© 2009 Thomson Reuters

610 Opperman Drive
St. Paul, MN 55123
1-800-313-9378

Printed in the United States of America

ISBN: 978-0-314-19082-6



TEXT IS PRINTED ON 10% POST
CONSUMER RECYCLED PAPER



Dear West Customer:

West Academic Publishing has changed the look of its American Casebook Series®.

In keeping with our efforts to promote sustainability, we have replaced our former covers with book covers that are more environmentally friendly. Our casebooks will now be covered in a 100% renewable natural fiber. In addition, we have migrated to an ink supplier that favors vegetable-based materials, such as soy.

Using soy inks and natural fibers to print our textbooks reduces VOC emissions. Moreover, our primary paper supplier is certified by the Forest Stewardship Council, which is testament to our commitment to conservation and responsible business management.

The new cover design has migrated from the long-standing brown cover to a contemporary charcoal fabric cover with silver-stamped lettering and black accents. Please know that inside the cover, our books continue to provide the same trusted content that you've come to expect from West.

We've retained the ample margins that you have told us you appreciate in our texts while moving to a new, larger font, improving readability. We hope that you will find these books a pleasing addition to your bookshelf.

Another visible change is that you will no longer see the brand name Thomson West on our print products. With the recent merger of Thomson and Reuters, I am pleased to announce that books published under the West Academic Publishing imprint will once again display the West brand.

It will likely be several years before all of our casebooks are published with the new cover and interior design. We ask for your patience as the new covers are rolled out on new and revised books knowing that behind both the new and old covers, you will find the finest in legal education materials for teaching and learning.

Thank you for your continued patronage of the West brand, which is both rooted in history and forward looking towards future innovations in legal education. We invite you to be a part of our next evolution.

Best regards,

Heidi M. Hellekson
Publisher, West Academic Publishing

WEST'S LAW SCHOOL ADVISORY BOARD

JESSE H. CHOPER
Professor of Law,
University of California, Berkeley

JOSHUA DRESSLER
Professor of Law, Michael E. Moritz College of Law,
The Ohio State University

YALE KAMISAR
Professor of Law, University of San Diego
Professor of Law, University of Michigan

MARY KAY KANE
Professor of Law, Chancellor and Dean Emeritus,
University of California,
Hastings College of the Law

LARRY D. KRAMER
Dean and Professor of Law, Stanford Law School

JONATHAN R. MACEY
Professor of Law, Yale Law School

ARTHUR R. MILLER
University Professor, New York University
Professor of Law Emeritus, Harvard University

GRANT S. NELSON
Professor of Law, Pepperdine University
Professor of Law Emeritus, University of California, Los Angeles

A. BENJAMIN SPENCER
Associate Professor of Law,
Washington & Lee University School of Law

JAMES J. WHITE
Professor of Law, University of Michigan

ACKNOWLEDGMENTS

The authors wish to acknowledge that in the writing of this case-book we have been assisted by many colleagues. Special appreciation is due to individuals who, through classroom use or other contributions, helped improve the book. They are Steve Anzalone, Doug Baldwin, Rebecca Eisenberg, Robert Goldman, Mark Janis, Mike Kaminski, Roberta Morris, Gerald Mossinghoff, Kimberly Pace, John Paul, Kathy White and John Witherspoon. The authors gratefully recognize as well the many students at George Washington University, the United States Patent and Trademark Office Juris Masters Program, the University of Virginia, and Wayne State University who have been subjected to evolving versions of this manuscript. Their suggestions and observations have considerably advanced the efforts reflected in this final version of the book, the culmination of seven years of work on a basic patents text.

The authors also give particular thanks to support shown by their respective institutions, and in particular to their Deans, fellow faculty members and administrators. We gratefully acknowledge support offered by the Max Planck Institute for Foreign and Comparative Patent, Copyright and Competition Law of Munich, Germany, and by Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., of Washington, D.C. Particular thanks is also due to Mr. Toyomaro Yoshida of the Institute of Intellectual Property in Tokyo, Japan, and to Dr. Paul Tauchner and his colleagues at Vossius & Partner of Munich, Germany.

Any omissions and errors that remain are, of course, the responsibility of the authors. Readers should also note that this project has been a team effort of four very independent members of the patent community, with portions presenting a strongly held view of one author that is not necessarily shared by the others. Although no single author agrees with all of the points made in this book, we felt compelled to include different points of view in order to offer a complete academic presentation.

*

TABLE OF CASES

The principal cases are in bold type. Cases cited or discussed in the text are roman type. References are to pages. Cases cited in principal cases and within other quoted materials are not included.

- AAIPharma Inc. v. Thompson**, 296 F.3d 227 (4th Cir.2002), **925**
- Abbott Laboratories v. Geneva Pharmaceuticals, Inc.**, 182 F.3d 1315 (Fed.Cir.1999), **211**
- Abbott Laboratories v. TorPharm, Inc., 503 F.3d 1372 (Fed.Cir.2007), 849
- A.B. Dick Co. v. Burroughs Corp., 798 F.2d 1392 (Fed.Cir.1986), 584
- Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2nd Cir.1976), 41
- A.C. Aukerman Co. v. R.L. Chaides Const. Co.**, 960 F.2d 1020 (Fed.Cir.1992), 240, **815**, 960
- Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc., 887 F.2d 1070 (Fed.Cir.1989), 477
- Agawam Woolen Co. v. Jordan**, 74 U.S. 583, 19 L.Ed. 177 (1868), **277**
- Aktiebolag v. E.J. Co., 121 F.3d 669 (Fed.Cir.1997), 765
- Alappat, In re, 33 F.3d 1526 (Fed.Cir.1994), 120, 538
- Alexander Milburn Co. v. Davis-Bournonville Co.**, 270 U.S. 390, 46 S.Ct. 324, 70 L.Ed. 651 (1926), **273**
- Al-Site Corp. v. VSI Intern., Inc.**, 174 F.3d 1308 (Fed.Cir.1999), **489**
- American Medical Systems, Inc. v. Medical Engineering Corp., 6 F.3d 1523 (Fed.Cir.1993), 901
- Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200 (Fed.Cir.1991), 248, 516, 767
- Amgen Inc. v. Hoechst Marion Roussel, Inc., 469 F.3d 1039 (Fed.Cir.2006), 673
- Amsted Industries Inc. v. Buckeye Steel Castings Co.**, 24 F.3d 178 (Fed.Cir.1994), **897**
- Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258 (1969), 15
- Andrew Corp. v. Gabriel Electronics, Inc., 847 F.2d 819 (Fed.Cir.1988), 516
- Ansonia Brass & Copper Co. v. Electrical Supply Co., 144 U.S. 11, 12 S.Ct. 601, 36 L.Ed. 327 (1892), 293
- Apotex Inc. v. Wellcome Foundation Ltd. (S.C.C.2002), 402
- Apotex USA, Inc. v. Merck & Co., Inc.**, 254 F.3d 1031 (Fed.Cir.2001), **264**
- Appeal No. 242-47, Ex parte, 1976 WL 20959 (Pat.& Tr. Office Bd.App.1976), 373
- Application of (see name of party)**
- Aristocrat Technologies Australia Pty Ltd. v. International Game Technology**, 521 F.3d 1328 (Fed.Cir.2008), **501**
- Aro Mfg. Co. v. Convertible Top Replacement Co. (Aro II), 377 U.S. 476, 84 S.Ct. 1526, 12 L.Ed.2d 457 (1964), 753
- Aro Mfg. Co. v. Convertible Top Replacement Co. (Aro I), 365 U.S. 336, 81 S.Ct. 599, 5 L.Ed.2d 592 (1961), 753
- Asahi Kasei Kogyo KK's Application, Re, 1991 WL 839550 (HL 1991), 166
- Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573 (Fed.Cir.1996), 713
- Atlantic Thermoplastics Co., Inc. v. Faytex Corp.**, 970 F.2d 834 (Fed.Cir.1992), **479**
- Atlantic Works v. Brady, 107 U.S. 192, 2 S.Ct. 225, 27 L.Ed. 438 (1883), 292
- Atlas Powder Co. v. E.I. du Pont De Nemours & Co.**, 750 F.2d 1569 (Fed.Cir.1984), **398**
- AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352 (Fed.Cir.1999), 87
- Autogiro Co. of America v. United States**, 181 Ct.Cl. 55, 384 F.2d 391 (Ct.Cl.1967), **649**
- Aventis Pharma S.A. v. Amphastar Pharmaceuticals, Inc.**, 525 F.3d 1334 (Fed.Cir.2008), **568**
- Baker Oil Tools, Inc. v. Geo Vann, Inc., 828 F.2d 1558 (Fed.Cir.1987), 199, 207
- Ball Corp. v. United States, 729 F.2d 1429 (Fed.Cir.1984), 619
- Bass, Application of, 59 C.C.P.A. 1342, 474 F.2d 1276 (Cust. & Pat.App.1973), 373
- Baxter Healthcare Corp. v. Spectramed, Inc., 49 F.3d 1575 (Fed.Cir.1995), 673
- Baxter Intern., Inc. v. COBE Laboratories, Inc., 88 F.3d 1054 (Fed.Cir.1996), 215
- Bayer AG v. Schein Pharmaceuticals, Inc., 301 F.3d 1306 (Fed.Cir.2002), 454, 456
- Beatrice Foods Co. v. New England Printing and Lithographing Co., 930 F.2d 1572 (Fed.Cir.1991), 882
- Bedford v. Hunt, 3 F.Cas. 37 (C.C.D.Mass. 1817), 125

- Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615 (Fed. Cir.1995), 468
- Bender v. Hoffmann, 1898 C.D. 262 (1898), 348
- Bergy, Application of**, 596 F.2d 952 (Cust. & Pat.App.1979), 10
- Bernhart, Application of, 57 C.C.P.A. 737, 417 F.2d 1395 (Cust. & Pat.App.1969), 80
- Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563 (Fed.Cir.1996), 25
- BIC Leisure Products, Inc. v. Windsurfing Intern., Inc.**, 1 F.3d 1214 (Fed.Cir.1993), 869
- Bilski, In re**, 545 F.3d 943 (Fed.Cir.2008), 88
- Bolton, Ex parte, 1938 WL 7747 (Pat. & Tr. Office Bd.App.1938), 478
- Bonito Boats, Inc. v. Thunder Craft Boats, Inc.**, 489 U.S. 141, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989), 3
- Borg-Warner Corp. v. Paragon Gear Works, Inc., 355 F.2d 400 (1st Cir.1965), 477
- Bott v. Four Star Corp., 675 F.Supp. 1069 (E.D.Mich.1987), 594
- Boyd v. Schildkraut Giftware Corp., 936 F.2d 76 (2nd Cir.1991), 901
- Braat, In re, 937 F.2d 589 (Fed.Cir.1991), 592, 595
- Brenner v. Manson**, 383 U.S. 519, 86 S.Ct. 1033, 16 L.Ed.2d 69 (1966), 132
- Brigance, In re, 792 F.2d 1103 (Fed.Cir.1986), 198
- Brose v. Sears, Roebuck & Co., 455 F.2d 763 (5th Cir.1972), 901
- Burlington Indus., Inc. v. Quigg, 822 F.2d 1581 (Fed.Cir.1987), 346, 652
- Burlington Industries, Inc. v. Dayco Corp., 849 F.2d 1418 (Fed.Cir.1988), 567
- C. Van der Lely N.V. v. Bamfords Ltd., [1963] RPC 61 (H.L.1962), 697
- Cambridge Products, Ltd. v. Penn Nutrients, Inc., 962 F.2d 1048 (Fed.Cir.1992), 896
- Canter and Geyer, Ex parte, 1946 WL 3078 (Pat. & Tr. Office Bd.App.1946), 478
- Carman Industries, Inc. v. Wahl, 724 F.2d 932 (Fed.Cir.1983), 592
- Catalina Marketing International, Inc. v. Cool-savings.com, Inc.**, 289 F.3d 801 (Fed.Cir.2002), 468
- Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371 (Fed.Cir.2004), 688
- Chemcast Corp. v. Arco Industries Corp.**, 913 F.2d 923 (Fed.Cir.1990), 445
- Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303 (Fed.Cir.1998), 526
- Chore-Time Equipment, Inc. v. Cumberland Corp., 713 F.2d 774 (Fed.Cir.1983), 324
- Christiana v. Rice, [1931] A.C. 770 (1931), 231
- Christianson v. Colt Industries Operating Corp., 822 F.2d 1544 (Fed.Cir.1987), 393
- Christie v. Seybold, 55 F. 69 (6th Cir.1893), 236
- City of (see name of city)**
- Clay, In re**, 966 F.2d 656 (Fed.Cir.1992), 375
- Cole v. Kimberly-Clark Corp., 102 F.3d 524 (Fed.Cir.1996), 500
- Coleman v. Dines, 754 F.2d 353 (Fed.Cir.1985), 240
- Computer Docking Station Corp. v. Dell, Inc.**, 519 F.3d 1366 (Fed.Cir.2008), 690
- Conmar Products Corp. v. Universal Slide Fastener Co., 172 F.2d 150 (2nd Cir.1949), 53
- Consolidated Electric Light Co v. McKeesport Light Co, 159 U.S. 465, 16 S.Ct. 75, 40 L.Ed. 221 (1895), 395
- Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264 (Fed.Cir.1991), 207
- Cook, Application of, 58 C.C.P.A. 1049, 439 F.2d 730 (Cust. & Pat.App.1971), 414
- Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc., 291 F.3d 1317 (Fed.Cir.2002), 430
- Cord v. Smith, 338 F.2d 516 (9th Cir.1964), 714
- Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.**, 868 F.2d 1251 (Fed.Cir.1989), 715
- Costello, In re, 717 F.2d 1346 (Fed.Cir.1983), 248
- C.P.C. v. Nosco Plastics, Inc., 719 F.2d 400 (Fed.Cir.1983), 714
- Crescent Tool Co. v. Kilborn & Bishop Co., 247 F. 299 (2nd Cir.1917), 41
- Crigler v. Salac, 438 So.2d 1375 (Ala.1983), 753
- Crystal Semiconductor Corp. v. TriTech Microelectronics Intern., Inc., 246 F.3d 1336 (Fed. Cir.2001), 874, 875, 902
- Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58 (1941), 14, 293
- Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F.2d 955 (Fed.Cir.1986), 140
- Cybor Corp. v. FAS Technologies, Inc.**, 138 F.3d 1448 (Fed.Cir.1998), 665
- Datamize, LLC v. Plumtree Software, Inc.**, 417 F.3d 1342 (Fed.Cir.2005), 517
- Deepsouth Packing Co. v. Laitram Corp., 406 U.S. 518, 92 S.Ct. 1700, 32 L.Ed.2d 273 (1972), 766
- Deuel, In re**, 51 F.3d 1552 (Fed.Cir.1995), 359
- Dewey & Almy Chemical Co v. Mimex Co, 124 F.2d 986 (2nd Cir.1942), 163
- Diamond v. Chakrabarty**, 447 U.S. 303, 100 S.Ct. 2204, 65 L.Ed.2d 144 (1980), 7, 59
- Diamond v. Diehr**, 450 U.S. 175, 101 S.Ct. 1048, 67 L.Ed.2d 155 (1981), 80
- Diamond Rubber Co. of New York v. Consolidated Rubber Tire Co., 220 U.S. 428, 31 S.Ct. 444, 55 L.Ed. 527 (1911), 397
- Dillon, In re**, 919 F.2d 688 (Fed.Cir.1990), 351
- D.L. Auld Co. v. Chroma Graphics Corp., 714 F.2d 1144 (Fed.Cir.1983), 192
- Doll, Application of, 57 C.C.P.A. 822, 419 F.2d 925 (Cust. & Pat.App.1970), 619
- Dolly, Inc. v. Spalding & Evenflo Companies, Inc., 16 F.3d 394 (Fed.Cir.1994), 713
- Dossel, In re, 115 F.3d 942 (Fed.Cir.1997), 425
- DSU Medical Corp. v. JMS Co., Ltd.**, 471 F.3d 1293 (Fed.Cir.2006), 742
- Dubilier Condenser Corporation, United States v., 289 U.S. 178, 53 S.Ct. 554, 77 L.Ed. 1114 (1933), 43, 828
- Earle v. Sawyer, 8 F.Cas. 254 (C.C.D.Mass. 1825), 292
- Easycase Inc. v. Bryan Lawrence & Co., [1995] F.S.R. 597 (1995), 282

- eBay Inc. v. MercExchange, L.L.C.**, 547 U.S. 388, 126 S.Ct. 1837, 164 L.Ed.2d 641 (2006), **835**
- Edgeberry v. Stephens, English Patent Cases 8 (King's Bench 1691), 282
- Egbert v. Lippmann**, 104 U.S. 333, 26 L.Ed. 755 (1881), **183**
- E.I. duPont deNemours & Co. v. Christopher**, 431 F.2d 1012 (5th Cir.1970), **48**
- Electric Storage Battery Co. v. Shimadzu**, 307 U.S. 5, 307 U.S. 613, 307 U.S. 616, 59 S.Ct. 675, 83 L.Ed. 1071 (1939), **210**
- Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048 (Fed.Cir.1994), 689
- Eli Lilly and Co. v. Medtronic, Inc., 496 U.S. 661, 110 S.Ct. 2683, 110 L.Ed.2d 605 (1990), 918
- Elizabeth, City of v. American Nicholson Pavement Co.**, 97 U.S. 126, 24 L.Ed. 1000 (1877), **193**, 208
- EMI Group North America, Inc. v. Cypress Semiconductor Corp., 268 F.3d 1342 (Fed. Cir.2001), 177
- Energizer Holdings, Inc. v. ITC, 2008 WL 1791980 (Fed.Cir.2008), 444
- Engelhard Industries, Inc. v. Research Instrumental Corp., 324 F.2d 347 (9th Cir.1963), 54
- Environmental Designs, Ltd. v. Union Oil Co. of California, 713 F.2d 693 (Fed.Cir.1983), 307
- Envirotech Corp. v. Westech Engineering Inc., 904 F.2d 1571 (Fed.Cir.1990), 206
- Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362 (Fed.Cir.1999), 408
- Enzo Biochem, Inc. v. Gen-Probe Inc.**, 323 F.3d 956 (Fed.Cir.2002), **437**
- Esai Co. Ltd. v. Dr. Reddy's, 2008 WL 279 1884 (2008), 357
- Ethicon, Inc. v. United States Surgical Corp.**, 135 F.3d 1456 (Fed.Cir.1998), **544**
- EWP Corp. v. Reliance Universal Inc., 755 F.2d 898 (Fed.Cir.1985), 346
- Ex parte (see name of party)**
- Exxon Research and Engineering Co. v. United States, 265 F.3d 1371 (Fed.Cir.2001), 526
- EZ Dock v. Schafer Systems, Inc., 276 F.3d 1347 (Fed.Cir.2002), 208
- Ferag AG v. Quipp, Inc., 45 F.3d 1562 (Fed.Cir. 1995), 207
- Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.**, 535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed.2d 944 (2002), **721**
- Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 172 F.3d 1361 (Fed.Cir. 1999), 720
- Finch v. Hughes Aircraft Co., 926 F.2d 1574 (Fed.Cir.1991), 896
- Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323 (Fed.Cir.2008), 841
- Fisher, In re**, 421 F.3d 1365 (Fed.Cir.2005), **140**
- FMC Corp. v. Up-Right, Inc., 816 F.Supp. 1455 (N.D.Cal.1993), 766
- Foster, Application of**, 52 C.C.P.A. 1808, 343 F.2d 980 (Cust. & Pat.App.1965), **370**
- Fressola, Ex parte**, 27 U.S.P.Q.2d 1608 (Bd.Pat. App. & Interf.1993), **460**
- Fromson v. Western Litho Plate and Supply Co., 853 F.2d 1568 (Fed.Cir.1988), 878
- Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573 (Fed.Cir.1997), 281
- Gechter v. Davidson, 116 F.3d 1454 (Fed.Cir. 1997), 538
- Genentech, Inc. v. Novo Nordisk A/S, 108 F.3d 1361 (Fed.Cir.1997), 394
- General Elec. Co., United States v., 82 F.Supp. 753 (D.N.J.1949), 901
- General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272 (Fed.Cir.1992), 594
- General Tire and Rubber Co. v. Firestone Tyre and Rubber Co. Ltd., [1975] 2 All E.R. 173 (1975), 855
- Gentry Gallery, Inc. v. Berklene Corp.**, 134 F.3d 1473 (Fed.Cir.1998), **426**, 444
- Georgia-Pacific Corp. v. United States Plywood Corp.**, 318 F.Supp. 1116 (S.D.N.Y. 1970), **876**
- Gerber Garment Technology v. Lectra Systems, [1995] R.P.C. 383 (Pat.Ct.1995), 867, 880
- Gillman v. Stern**, 114 F.2d 28 (2nd Cir.1940), **227**
- Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043 (Fed.Cir.1995), 453
- Goodman, In re, 11 F.3d 1046 (Fed.Cir.1993), 595
- Gordon, In re, 733 F.2d 900 (Fed.Cir.1984), 477
- Gosteli, In re**, 872 F.2d 1008 (Fed.Cir.1989), 16, **628**
- Gottschalk v. Benson**, 409 U.S. 63, 93 S.Ct. 253, 34 L.Ed.2d 273 (1972), **77**
- Gould, In re, 673 F.2d 1385 (Cust. & Pat.App. 1982), 257
- Gould v. Control Laser Corp., 866 F.2d 1391 (Fed.Cir.1989), 393
- Gould v. Control Laser Corp., 705 F.2d 1340 (Fed.Cir.1983), 257
- Gould v. General Photonics Corp., 534 F.Supp. 399 (N.D.Cal.1982), 256
- Gould v. Hellwarth**, 472 F.2d 1383 (Cust. & Pat.App.1973), 257, **387**
- Gould v. Quigg, 822 F.2d 1074 (Fed.Cir.1987), 257
- Gould v. Schawlow**, 53 C.C.P.A. 1403, 363 F.2d 908 (Cust. & Pat.App.1966), **249**
- Graff, In re, 111 F.3d 874 (Fed.Cir.1997), 618, 619
- Graham v. John Deere Co. of Kansas City**, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), 292, **298**
- Grain Processing Corp. v. American Maize-Products Co., 185 F.3d 1341 (Fed.Cir.1999), 875
- Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902 (Fed.Cir.1988), 198
- Graver Tank & Mfg. Co. v. Linde Air Products Co.**, 339 U.S. 605, 70 S.Ct. 854, 94 L.Ed. 1097 (1950), **698**
- Great Atlantic & Pac. Tea Co. v. Supermarket Equipment Corp.**, 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162 (1950), 14, **294**

- Greenberg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580 (Fed.Cir.1996), 499
- Grose, Application of, 592 F.2d 1161 (Cust. & Pat.App.1979), 357
- Hahn v. Wong, 892 F.2d 1028 (Fed.Cir.1989), 234, 264
- Halliburton Co. v. Schlumberger Technology Corp., 925 F.2d 1435 (Fed.Cir.1991), 585
- Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1, 67 S.Ct. 6, 91 L.Ed. 3 (1946), 488
- Hanson v. Alpine Valley Ski Area, Inc., 718 F.2d 1075 (Fed.Cir.1983), 901
- Harries v. Air King Products Co., 183 F.2d 158 (2nd Cir.1950), 14, 293
- Hass, In re, 31 C.C.P.A. 895, 141 F.2d 122 (Cust. & Pat.App.1944), 348
- Hazeltine Research, Inc. v. Brenner, 382 U.S. 252, 86 S.Ct. 335, 15 L.Ed.2d 304 (1965), 373
- Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co., 77 F. 288 (6th Cir. 1896), 792
- Hebert v. Lisle Corp., 99 F.3d 1109 (Fed.Cir. 1996), 868
- Hedgewick v. Akers, 497 F.2d 905 (Cust. & Pat.App.1974), 282
- Heicklen, Ex parte, 1989 WL 274434 (Bd.Pat. App. & Interf.1989), 125
- Hensley Equipment Co. v. Esco Corp., 383 F.2d 252 (5th Cir.1967), 14
- Henze, Application of, 37 C.C.P.A. 1009, 181 F.2d 196 (Cust. & Pat.App.1950), 348
- Hewlett-Packard Co. v. Bausch & Lomb, Inc.**, 882 F.2d 1556 (Fed.Cir.1989), 584, **609**
- High Frequency Products, Inc. v. Wynn's Climate Systems, Inc., 91 F.3d 167 (Fed.Cir. 1996), 901
- Hilmer, Application of, 57 C.C.P.A. 985, 424 F.2d 1108 (Cust. & Pat.App.1970), 644
- Hilmer, Application of**, 53 C.C.P.A. 1288, 359 F.2d 859 (Cust. & Pat.App.1966), **634**
- Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc., 114 F.3d 1161 (Fed.Cir.1997), 712
- Hoeksema, Application of, 55 C.C.P.A. 1493, 399 F.2d 269 (Cust. & Pat.App.1968), 357
- Hogan, Application of, 559 F.2d 595 (Cust. & Pat.App.1977), 499
- Hollister v. Benedict & Burnham Mfg. Co., 113 U.S. 59, 5 S.Ct. 717, 28 L.Ed. 901 (1885), 293
- Holmwood v. Sugavanam, 948 F.2d 1236 (Fed. Cir.1991), 264
- Honeywell Intern. Inc. v. Hamilton Sundstrand Corp., 370 F.3d 1131 (Fed.Cir.2004), 730
- Hoover Group, Inc. v. Custom Metalcraft, Inc., 84 F.3d 1408 (Fed.Cir.1996), 752
- Hormone Research Foundation, Inc. v. Genentech, Inc., 904 F.2d 1558 (Fed.Cir.1990), 478
- Horton v. Stevens, 1988 WL 252359 (Bd.Pat. App. & Interf.1988), 263
- Hotchkiss v. Greenwood**, 52 U.S. 248, 11 How. 248, 13 L.Ed. 683 (1850), **289**
- Hyatt, In re, 708 F.2d 712 (Fed.Cir.1983), 488
- Imazio Nursery, Inc. v. Dania Greenhouses, 69 F.3d 1560 (Fed.Cir.1995), 26
- Innogenetics, N.V. v. Abbott Laboratories, 512 F.3d 1363 (Fed.Cir.2008), 841
- In re (see name of party)**
- International Visual Corp. v. Crown Metal Mfg. Co., Inc., 991 F.2d 768 (Fed.Cir.1993), 741
- Interspiro USA, Inc. v. Figgie Intern. Inc., 18 F.3d 927 (Fed.Cir.1994), 896
- Jamesbury Corp. v. Litton Indus. Products, Inc., 839 F.2d 1544 (Fed.Cir.1988), 820
- Jazz Photo Corp. v. International Trade Com'n**, 264 F.3d 1094 (Fed.Cir.2001), **754**
- J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Intern., Inc., 534 U.S. 124, 122 S.Ct. 593, 151 L.Ed.2d 508 (2001), 26, 67
- Johnson, In re, 747 F.2d 1456 (Fed.Cir.1984), 348
- Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.**, 285 F.3d 1046 (Fed.Cir. 2002), **731**
- Joy Technologies, Inc. v. Flakt, Inc., 6 F.3d 770 (Fed.Cir.1993), 752
- Juicy Whip, Inc. v. Orange Bang, Inc.**, 185 F.3d 1364 (Fed.Cir.1999), **126**
- Jungersen v. Ostby & Barton Co., 335 U.S. 560, 69 S.Ct. 269, 93 L.Ed. 235 (1949), 14, 293
- Kalm, Application of, 54 C.C.P.A. 1466, 378 F.2d 959 (Cust. & Pat.App.1967), 164
- Kathawala, In re, 9 F.3d 942 (Fed.Cir.1993), 222
- Kaufman Co., Inc. v. Lantech, Inc., 926 F.2d 1136 (Fed.Cir.1991), 855
- KCJ Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351 (Fed.Cir.2000), 689, 730
- Kendall v. Winsor, 62 U.S. 322, 21 How. 322, 16 L.Ed. 165 (1858), 220
- Kennedy v. Hazelton, 128 U.S. 667, 9 S.Ct. 202, 32 L.Ed. 576 (1888), 544
- Kewanee Oil Co. v. Bicon Corp., 416 U.S. 470, 94 S.Ct. 1879, 40 L.Ed.2d 315 (1974), 55
- Key Mfg. Group, Inc. v. Microdot, Inc., 925 F.2d 1444 (Fed.Cir.1991), 741
- Key Pharmaceuticals v. Hercon Laboratories Corp., 161 F.3d 709 (Fed.Cir.1998), 680
- King Instrument Corp. v. Otari Corp., 767 F.2d 853 (Fed.Cir.1985), 248
- King Instruments Corp. v. Perego, 65 F.3d 941 (Fed.Cir.1995), 868
- Kingsdown Medical Consultants, Ltd. v. Hollister Inc.**, 863 F.2d 867 (Fed.Cir.1988), **558**
- Kirin-Amgen Inc. and Others v. Hoechst Marion Roussel Limited and Others**, [2004] UKHL 46, [2002] EWCA 1096 (2004), **768**
- Knight v. Baltimore & O.R. Co., 14 F.Cas. 758 (C.C.D.Md.1840), 292
- Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337 (Fed. Cir.2004), 884
- KSR Intern. Co. v. Teleflex Inc.**, 550 U.S. 398, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007), **308**
- Kubin, Ex parte, 83 U.S.P.Q.2d 1410 (Bd.Pat. App. & Int'f.2007), 368
- Laboratory Corp. of America Holdings v. Chiron Corp., 384 F.3d 1326 (Fed.Cir.2004), 849

- Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.**, 548 U.S. 124, 126 S.Ct. 2921, 165 L.Ed.2d 399 (2006), **69**
- LaBounty Mfg., Inc. v. United States Intern. Trade Com'n**, 958 F.2d 1066 (Fed.Cir.1992), 198
- Lacotte v. Thomas**, 758 F.2d 611 (Fed.Cir.1985), 264
- Laitram Corp. v. Rexnord, Inc.**, 939 F.2d 1533 (Fed.Cir.1991), 499
- Lalu, In re**, 747 F.2d 703 (Fed.Cir.1984), 350
- Lam, Inc. v. Johns-Manville Corp.**, 718 F.2d 1056 (Fed.Cir.1983), 855
- Lantech, Inc. v. Keip Mach. Co.**, 32 F.3d 542 (Fed.Cir.1994), 673
- L.E.A. Dynatech, Inc. v. Allina**, 49 F.3d 1527 (Fed.Cir.1995), 896
- Lee, In re**, 277 F.3d 1338 (Fed.Cir.2002), 324
- Lee v. Runge**, 404 U.S. 887, 92 S.Ct. 197, 30 L.Ed.2d 169 (1971), 292
- Leinoff v. Louis Milona & Sons, Inc.**, 726 F.2d 734 (Fed.Cir.1984), 346
- Levi Strauss & Co. v. Golden Trade, S.r.L.**, 1995 WL 710822 (S.D.N.Y.1995), 230
- Liebel-Flarsheim Co. v. Medrad, Inc.**, 481 F.3d 1371 (Fed.Cir.2007), 414
- LizardTech, Inc. v. Earth Resource Mapping, Inc.**, 424 F.3d 1336 (Fed.Cir.2005), 444
- LNP Engineering Plastics, Inc. v. Miller Waste Mills, Inc.**, 275 F.3d 1347 (Fed.Cir.2001), 526
- Longi, In re**, 759 F.2d 887 (Fed.Cir.1985), 594
- Lorenz v. Colgate-Palmolive-Peet Co.**, 167 F.2d 423 (3rd Cir.1948), 215
- Lowell v. Lewis**, 15 F.Cas. 1018 (C.C.D.Mass. 1817), **124**
- Lundak, In re**, 773 F.2d 1216 (Fed.Cir.1985), 396
- Maday v. Duke University**, 307 F.3d 1351 (Fed.Cir.2002), **799**
- Mahurkar v. C.R. Bard, Inc.**, 79 F.3d 1572 (Fed.Cir.1996), 425, 876, 879, 896
- Mahurkar Patent Litigation, Matter of**, 831 F.Supp. 1354 (N.D.Ill.1993), 425
- Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc.**, 793 F.2d 1279 (Fed.Cir.1986), 475
- Manville Sales Corp. v. Paramount Systems, Inc.**, 917 F.2d 544 (Fed.Cir.1990), 199
- Markman v. Westview Instruments, Inc.**, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), **654**
- Markman v. Westview Instruments, Inc.**, 52 F.3d 967 (Fed.Cir.1995), 430, 466
- Masco Corp. v. United States**, 303 F.3d 1316 (Fed.Cir.2002), 509
- Matter of (see name of party)**
- Maxwell v. J. Baker, Inc.**, 86 F.3d 1098 (Fed.Cir.1996), 733, 880
- McClain v. Ortmyer**, 141 U.S. 419, 12 S.Ct. 76, 35 L.Ed. 800 (1891), 293
- McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576 (Fed.Cir.1993), **824**
- MedImmune, Inc. v. Genentech, Inc.**, 549 U.S. 118, 127 S.Ct. 764, 166 L.Ed.2d 604 (2007), **938**
- Medtronic, Inc. v. Cardiac Pacemakers, Inc.**, 721 F.2d 1563 (Fed.Cir.1983), 324
- Mendenhall v. Astec Industries, Inc.**, 1988 WL 188449 (E.D.Tenn.1988), 257
- Mentor Corp. v. Coloplast, Inc.**, 998 F.2d 992 (Fed.Cir.1993), 619
- Merck & Co., Inc. v. Kessler**, 80 F.3d 1543 (Fed.Cir.1996), 541
- Merck KGaA v. Integra Lifesciences I, Ltd.**, 545 U.S. 193, 125 S.Ct. 2372, 162 L.Ed.2d 160 (2005), **907**
- Merrell Dow Pharmaceuticals Inc. v. HN Norton & Co. Ltd.**, 1995 WL 1081850 (HL 1995), 177
- Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.**, 153 F.2d 516 (2nd Cir.1946), **188**
- Metoprolol Succinate Patent Litigation, In re**, 494 F.3d 1011 (Fed.Cir.2007), **596**
- Micro Chemical, Inc. v. Great Plains Chemical Co., Inc.**, 103 F.3d 1538 (Fed.Cir.1997), 206
- Miles Laboratories, Inc. v. Shandon Inc.**, 997 F.2d 870 (Fed.Cir.1993), 516
- Minnesota Min. and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.**, 976 F.2d 1559 (Fed.Cir.1992), 306
- Mlot-Fijalkowski, In re**, 676 F.2d 666 (Cust. & Pat.App.1982), 379
- Moleculon Research Corp. v. CBS, Inc.**, 793 F.2d 1261 (Fed.Cir.1986), 188, 207
- Molins PLC v. Textron, Inc.**, 48 F.3d 1172 (Fed.Cir.1995), 584
- Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH**, 139 F.3d 877 (Fed.Cir.1998), 347
- Moore U.S.A., Inc. v. Standard Register Co.**, 229 F.3d 1091 (Fed.Cir.2000), 713
- Morton Salt Co. v. G.S. Suppiger Co.**, 314 U.S. 488, 62 S.Ct. 402, 86 L.Ed. 363 (1942), 792
- Motion Picture Patents Co. v. Universal Film Mfg. Co.**, 243 U.S. 502, 37 S.Ct. 416, 61 L.Ed. 871 (1917), 792
- Motorola, Inc. v. Interdigital Technology Corp.**, 121 F.3d 1461 (Fed.Cir.1997), 308
- Mueller Brass Co. v. Reading Industries, Inc.**, 352 F.Supp. 1357 (E.D.Pa.1972), 557
- Mylan Pharmaceuticals, Inc. v. Thompson**, 268 F.3d 1323 (Fed.Cir.2001), **918**
- Mylan Pharmaceuticals, Inc. v. United States Food And Drug Admin.**, 454 F.3d 270 (4th Cir.2006), **961**
- Nalbandian, In re**, 661 F.2d 1214 (Cust. & Pat.App.1981), 25
- National Tractor Builders Ass'n v. Watkins**, 1980 WL 30369 (N.D.Ill.1980), 230
- Nazomi Communications, Inc. v. Arm Holdings, PLC**, 403 F.3d 1364 (Fed.Cir.2005), 687
- Nelson v. Bowler**, 626 F.2d 853 (Cust. & Pat.App.1980), 145
- Newell Companies, Inc. v. Kenney Mfg. Co.**, 864 F.2d 757 (Fed.Cir.1988), 16, 584
- New England Braiding Co., Inc. v. A.W. Chesterton Co.**, 970 F.2d 878 (Fed.Cir.1992), 281
- Newman v. Quigg**, 877 F.2d 1575 (Fed.Cir.1989), 125
- Nickson Industries, Inc. v. Rol Mfg. Co., Ltd.**, 847 F.2d 795 (Fed.Cir.1988), 876
- Nobell, Inc. v. Sharper Image Corp.**, 950 F.2d 732 (Fed.Cir.1991), 477

- North American Vaccine, Inc. v. American Cyanamid Co., 7 F.3d 1571 (Fed.Cir.1993), 689
- Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931 (Fed.Cir.1990), 346
- OddzOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396 (Fed.Cir.1997), 373
- Oei v. Citibank, N.A., 957 F.Supp. 492 (S.D.N.Y.1997), 87
- Oetiker, In re, 977 F.2d 1443 (Fed.Cir.1992), 347
- O'Farrell, In re, 853 F.2d 894 (Fed.Cir.1988), 346, 356, 368
- Oka v. Youssefyeh**, 849 F.2d 581 (Fed.Cir.1988), 237
- Open-End Spinning Machine (Offenend-spinnmaschine), Case No. X ZR 26/87 (1989), 881
- O'Reilly v. Morse, 56 U.S. 62, 15 How. 62, 14 L.Ed. 601 (1853), 414, 487
- Ormco Corp. v. Align Technology, Inc.**, 463 F.3d 1299 (Fed.Cir.2006), 335
- Orthokinetics, Inc. v. Safety Travel Chairs, Inc.**, 806 F.2d 1565 (Fed.Cir.1986), 511, 752
- Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc., 520 F.3d 1358 (Fed.Cir.2008), 334, 344
- Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc., 707 F.2d 1376 (Fed.Cir.1983), 584
- Paice LLC v. Toyota Motor Corp., 504 F.3d 1293 (Fed.Cir.2007), 842
- Palmquist, Application of, 51 C.C.P.A. 839, 319 F.2d 547 (Cust. & Pat.App.1963), 370
- Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082 (Fed.Cir.1985), 346
- Panduit Corp. v. Stahlin Bros. Fibre Works, Inc.**, 575 F.2d 1152 (6th Cir.1978), 849
- Papesch, Application of**, 50 C.C.P.A. 1084, 315 F.2d 381 (Cust. & Pat.App.1963), 349
- Paragon Podiatry Laboratory, Inc. v. KLM Laboratories, Inc., 984 F.2d 1182 (Fed.Cir.1993), 567
- Paulik v. Rizkalla, 760 F.2d 1270 (Fed.Cir.1985), 272
- Paulsen, In re, 30 F.3d 1475 (Fed.Cir.1994), 379
- Pennock v. Dialogue, 27 U.S. 1, 7 L.Ed. 327 (1829), 182
- Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931 (Fed.Cir.1987), 715
- Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309 (Fed.Cir.1985), 345, 346
- Perrigo, In re, 18 C.C.P.A. 1323, 48 F.2d 965 (Cust. & Pat.App.1931), 125
- Petersen Mfg. Co., Inc. v. Central Purchasing, Inc., 740 F.2d 1541 (Fed.Cir.1984), 714
- Pfaff v. Wells Electronics, Inc.**, 525 U.S. 55, 119 S.Ct. 304, 142 L.Ed.2d 261 (1998), 200
- Pfeiffer, In re, 243 F.3d 565 (Fed.Cir.2000), 510
- Pharmaceutical Resources, Inc. v. Roxane Laboratories, Inc.**, 2007 WL 3151692 (Fed.Cir.2007), 409
- Pharmacia & Upjohn Co. v. Mylan Pharmaceuticals, Inc., 170 F.3d 1373 (Fed.Cir.1999), 509
- Phillips v. AWH Corp.**, 415 F.3d 1303 (Fed.Cir.2005), 674
- Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298 (Fed.Cir.1999), 689
- Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2nd Cir.1961), 41
- Prater, Application of, 56 C.C.P.A. 1381, 415 F.2d 1393 (Cust. & Pat.App.1969), 80
- Price v. Symsek, 988 F.2d 1187 (Fed.Cir.1993), 282
- Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc., 75 F.3d 1568 (Fed.Cir.1996), 308
- Proveris Scientific Corp. v. Innovasystems, Inc., 536 F.3d 1256 (Fed.Cir.2008), 917
- Quad Environmental Technologies v. Union Sanitary District, 946 F.2d 870 (Fed.Cir.1991), 594
- Randomex, Inc. v. Scopus Corp., 849 F.2d 585 (Fed.Cir.1988), 451
- Rasmussen, In re, 650 F.2d 1212 (Cust. & Pat.App.1981), 415
- Read Corp. v. Portec, Inc., 970 F.2d 816 (Fed.Cir.1992), 883
- Reading & Bates Const. Co. v. Baker Energy Resources Corp., 748 F.2d 645 (Fed.Cir.1984), 510
- Recreative Technologies Corp., In re, 83 F.3d 1394 (Fed.Cir.1996), 531
- Reeves Instrument Corp. v. Beckman Instruments, Inc., 444 F.2d 263 (9th Cir.1971), 15
- Refac Intern., Ltd. v. Lotus Development Corp., 81 F.3d 1576 (Fed.Cir.1996), 585
- Regents of the University of California v. Eli Lilly & Co.**, 119 F.3d 1559 (Fed.Cir.1997), 431
- Regimbal v. Scymansky, 444 F.2d 333 (9th Cir.1971), 15
- Religious Technology Center v. Wollersheim, 796 F.2d 1076 (9th Cir.1986), 47
- Rite-Hite Corp. v. Kelley Co., Inc.**, 56 F.3d 1538 (Fed.Cir.1995), 856
- Roanwell Corp. v. Plantronics, Inc., 429 U.S. 1004, 97 S.Ct. 538, 50 L.Ed.2d 617 (1976), 292
- Robotic Vision Systems, Inc. v. View Engineering, Inc., 249 F.3d 1307 (Fed.Cir.2001), 207
- Roche Products, Inc. v. Bolar Pharmaceutical Co., Inc.**, 733 F.2d 858 (Fed.Cir.1984), 792, 905, 906
- Rockwell Graphic Systems, Inc. v. DEV Industries, Inc., 925 F.2d 174 (7th Cir.1991), 44, 46
- Rohm & Haas Co. v. Crystal Chemical Co., 722 F.2d 1556 (Fed.Cir.1983), 584
- Rosemount, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540 (Fed.Cir.1984), 516
- Sage Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420 (Fed.Cir.1997), 701, 731
- Sage Products, Inc. v. Devon Industries, Inc., 880 F.Supp. 718 (C.D.Cal.1994), 379
- Sakraida v. Ag Pro, Inc., 425 U.S. 273, 96 S.Ct. 1532, 47 L.Ed.2d 784 (1976), 15
- SanDisk Corp. v. STMicroelectronics, Inc., 480 F.3d 1372 (Fed.Cir.2007), 945
- Sanofi-Synthelabo v. Apotex, Inc.**, 470 F.3d 1368 (Fed.Cir.2006), 842

- Scaltech, Inc. v. Retec/Tetra, L.L.C., 156 F.3d 1193 (Fed.Cir.1998), 206
- Schering Corp. v. Geneva Pharmaceuticals**, 339 F.3d 1373 (Fed.Cir.2003), 166
- Schoenwald, In re, 964 F.2d 1122 (Fed.Cir.1992), 165
- SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337 (Fed.Cir.2001), 681
- Scott v. Finney**, 34 F.3d 1058 (Fed.Cir.1994), 198, 242
- Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565 (Fed.Cir.1991), 478
- Seagate Technology, LLC, In re**, 497 F.3d 1360 (Fed.Cir.2007), 884
- Seal-Flex, Inc. v. Athletic Track and Court Const., 172 F.3d 836 (Fed.Cir.1999), 508
- Searles, Application of, 57 C.C.P.A. 912, 422 F.2d 431 (Cust. & Pat.App.1970), 537
- Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818 (Fed.Cir.1984), 516
- Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566 (Fed.Cir.1996), 752
- Senza-Gel Corp. v. Seiffhart, 803 F.2d 661 (Fed.Cir.1986), 814
- Sewall v. Walters, 21 F.3d 411 (Fed.Cir.1994), 282
- Shearing v. Iolab Corp., 975 F.2d 1541 (Fed.Cir.1992), 452
- Shellmar Products Co. v. Allen-Qualley Co., 87 F.2d 104 (7th Cir.1936), 53
- Smith, In re, 714 F.2d 1127 (Fed.Cir.1983), 200
- Smith, Application of, 59 C.C.P.A. 1025, 458 F.2d 1389 (Cust. & Pat.App.1972), 425
- Smith v. Dravo Corp., 203 F.2d 369 (7th Cir.1953), 47
- Smith v. Goodyear Dental Vulcanite Co., 93 U.S. 486, 23 L.Ed. 952 (1876), 292
- Smith Intern., Inc. v. Hughes Tool Co., 718 F.2d 1573 (Fed.Cir.1983), 835
- SmithKline Beecham Corp. v. Apotex Corp., 439 F.3d 1312 (Fed.Cir.2006), 486
- SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 926 F.2d 1161 (Fed.Cir.1991), 878
- Sneed, In re, 710 F.2d 1544 (Fed.Cir.1983), 346
- South Corp. v. United States, 690 F.2d 1368 (Fed.Cir.1982), 16
- Speas, In re, 2008 WL 1009000 (Fed.Cir.2008), 125
- Specialty Composites v. Cabot Corp., 845 F.2d 981 (Fed.Cir.1988), 345, 346
- Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524 (Fed.Cir.1987), 448
- SRI Intern. v. Matsushita Elec. Corp. of America, 775 F.2d 1107 (Fed.Cir.1985), 688
- Standard Oil Co. (Indiana) v. Montedison, S.p.A., 494 F.Supp. 370 (D.Del.1980), 477
- State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368 (Fed.Cir.1998), 86, 831
- Straussler v. United States, 168 Ct.Cl. 852, 339 F.2d 670 (Ct.Cl.1964), 163
- Streamfeeder, LLC v. Sure-Feed Systems, Inc., 175 F.3d 974 (Fed.Cir.1999), 741
- Sun Studs, Inc. v. ATA Equipment Leasing, Inc., 872 F.2d 978 (Fed.Cir.1989), 878
- Symbol Technologies, Inc. v. Lemelson Medical, 277 F.3d 1361 (Fed.Cir.2002), 594
- Syntex (U.S.A.) Inc. v. Paragon Optical Inc., 1987 WL 124333 (D.Ariz.1987), 347
- Tafas v. Dudas, 541 F.Supp.2d 805 (E.D.Va.2008), 537
- Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd., 492 F.3d 1350 (Fed.Cir.2007), 356, 368
- T.D. Williamson, Inc. v. Laymon, 723 F.Supp. 587 (N.D.Okla.1989), 766
- Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353 (Fed.Cir.1999), 206
- Teva Pharmaceuticals USA, Inc. v. Novartis Pharmaceuticals Corp.**, 482 F.3d 1330 (Fed.Cir.2007), 946
- Teva Pharmaceuticals USA, Inc. v. Pfizer, Inc., 395 F.3d 1324 (Fed.Cir.2005), 938
- Texas Instruments Inc. v. United States Intern. Trade Com'n, 988 F.2d 1165 (Fed.Cir.1993), 526
- Theis, Application of, 610 F.2d 786 (Cust. & Pat.App.1979), 198
- Thurber Corp. v. Fairchild Motor Corp., 269 F.2d 841 (5th Cir.1959), 293
- Timely Products Corp. v. Arron, 523 F.2d 288 (2nd Cir.1975), 206
- Titanium Metals Corp. of America v. Banner**, 778 F.2d 775 (Fed.Cir.1985), 157
- TP Laboratories, Inc. v. Professional Positioners, Inc., 724 F.2d 965 (Fed.Cir.1984), 198
- Transco Products Inc. v. Performance Contracting, Inc.**, 38 F.3d 551 (Fed.Cir.1994), 455, 534
- Translogic Technology, Inc., In re**, 504 F.3d 1249 (Fed.Cir.2007), 327
- Travis v. Baker, 30 C.C.P.A. 1271, 137 F.2d 109 (Cust. & Pat.App.1943), 241
- Tropix, Inc. v. Lumigen, Inc., 825 F.Supp. 7 (D.Mass.1993), 486
- Trustees of Columbia University v. Roche Diagnostics GmbH, 2000 Markman 1867981, 126 F.Supp.2d 16 (D.Mass.2000), 486
- Truswal Systems Corp. v. Hydro-Air Engineering, Inc., 813 F.2d 1207 (Fed.Cir.1987), 347
- Tsubakimoto Seiko Co. Ltd. v. THK K.K.**, Case No. 1994(o) 1083 (1998), 784
- UMC Electronics Co. v. United States, 816 F.2d 647 (Fed.Cir.1987), 206
- Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989 (Fed.Cir.2000), 430
- Unisplay, S.A. v. American Electronic Sign Co., Inc., 69 F.3d 512 (Fed.Cir.1995), 878
- United States v. — (see opposing party)**
- United States Steel Corp. v. Phillips Petroleum Co., 865 F.2d 1247 (Fed.Cir.1989), 476
- Upjohn Co. v. Kessler, 938 F.Supp. 439 (W.D.Mich.1996), 922
- USM Corp. v. SPS Technologies, Inc.**, 694 F.2d 505 (7th Cir.1982), 808
- Vaeck, In re, 947 F.2d 488 (Fed.Cir.1991), 306
- Van Ornum, In re, 686 F.2d 937 (Cust. & Pat.App.1982), 593
- Vas-Cath Inc. v. Mahurkar**, 935 F.2d 1555 (Fed.Cir.1991), 416
- Vickers v. Sidell, 7 R.P.C. 292 (1890), 293

- Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed.Cir.1996), 689
- Vogel, Application of**, 57 C.C.P.A. 920, 422 F.2d 438 (Cust. & Pat.App.1970), **588**
- Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.**, 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997), **702**
- Westphal, Ex parte, 1992 WL 494866 (Bd.Pat. App. & Interf.1992), 425
- Wilson Sporting Goods Co. v. David Geoffrey & Associates**, 904 F.2d 677 (Fed.Cir.1990), **740**
- Windsurfing Intern. Inc. v. AMF, Inc., 782 F.2d 995 (Fed.Cir.1986), 814
- W.L. Gore & Associates, Inc. v. Garlock, Inc.**, 721 F.2d 1540 (Fed.Cir.1983), **216**, 517, 831
- Woodcock v. Parker**, 30 F.Cas. 491 (C.C.D.Mass.1813), **226**
- Woodland Trust v. Flowertree Nursery, Inc.**, 148 F.3d 1368 (Fed.Cir.1998), **257**
- Wright, In re**, 999 F.2d 1557 (Fed.Cir.1993), **402**
- Wright, In re, 848 F.2d 1216 (Fed.Cir.1988), 352
- Yale Lock Mfg. Co. v. Sargent, 117 U.S. 536, 6 S.Ct. 934, 29 L.Ed. 954 (1886), 874
- YBM Magnex, Inc. v. International Trade Com'n, 145 F.3d 1317 (Fed.Cir.1998), 733
- York Products, Inc. v. Central Tractor Farm & Family Center, 99 F.3d 1568 (Fed.Cir.1996), 499
- Zenith Laboratories, Inc. v. Bristol-Myers Squibb Co., 19 F.3d 1418 (Fed.Cir.1994), 674
- Zletz, In re, 893 F.2d 319 (Fed.Cir.1989), 232, 652

CASES AND MATERIALS ON
PATENT LAW
Third Edition

*

SUMMARY OF CONTENTS

	Page
ACKNOWLEDGMENTS	iii
TABLE OF CASES	xv
Chapter One. Introduction	1
1.1 Overview of This Casebook	1
1.2 Foundations of the United States Patent System	3
1.3 Origins of the Patent System	8
1.4 Forms of Patent Protection	19
1.5 The Nature and Function of the Patent System	27
1.6 Other Forms of Intellectual Property Protection	40
Chapter Two. Patent Eligibility	58
2.1. Biotechnology and Products of Nature	59
2.2. Computer-Related Inventions and Methods of Doing Business	76
Chapter Three. Utility	123
3.1 General Principles	124
3.2 The Utility Requirement in Chemistry and Biotechnology	132
3.3 The Utility Requirement at the Federal Circuit	140
Chapter Four. Anticipation	155
Chapter Five. Statutory Bars	180
5.1 Applicant Activities § 102(b)	183
5.2 Third Party Activities § 102(b)	209
5.3 Abandonment § 102(c)	220
5.4 Delayed United States Filing § 102(d)	221
Chapter Six. Novelty: Prior Invention	225
6.1 Prior Invention Under § 102(a)	226
6.2 The Elements of “Invention” Under § 102(g)	233
6.3 Patent Award to the Second Inventor	264
6.4 Disclosure in United States Patent Applications—§ 102(e)	273
6.5 Derivation—Theft From a Prior Inventor—§ 102(f)	277
6.6 A Note on First-to-File Versus First-to-Invent	282
Chapter Seven. Nonobviousness	286
7.1 The Historical Standard of Invention	289
7.2 The Modern Standard of Nonobviousness	298
7.3 Obviousness in Chemistry and Biotechnology	348
7.4 Prior Art for Obviousness	369
Chapter Eight. The Patent Specification	386
8.1 Enablement	387
8.2 “Written Description”—Proscription on New Matter	415

	Page
8.3 “Written Description”—Proscription Applied to Claims Without Priority Issues.....	431
8.4 Best Mode	445
Chapter Nine. Claims	459
9.1 United States Peripheral Claiming Technique.....	460
9.2 Patent Claim Format	467
9.3 Claim Definiteness.....	511
Chapter Ten. Prosecution	530
10.1 Overview of Patent Prosecution	531
10.2 Inventorship	544
10.3 Inequitable Conduct	558
10.4 Double Patenting	587
10.5 Post-Grant Procedures.....	608
10.6 International Prosecution	624
Chapter Eleven. Infringement	649
11.1 Literal Infringement.....	654
11.2 The Doctrine of Equivalents or Non-Textual Infringement	697
11.3 Limitations on the Doctrine of Equivalents	714
11.4 Indirect Infringement.....	742
11.5 Infringement Analyses Overseas	767
Chapter Twelve. Additional Defenses	791
12.1 Experimental Use	792
12.2 Misuse.....	808
12.3 Laches and Estoppel.....	815
12.4 Shop Rights	824
12.5 The First Inventor Defense.....	830
Chapter Thirteen. Remedies	834
13.1 Injunctions	835
13.2 Damages.....	849
13.3 Enhanced Damages and Attorney Fees	882
13.4 Marking	896
Chapter Fourteen. The Hatch-Waxman Act	905
14.1 The Bolar Exemption	906
14.2 ANDA Litigation	918
14.3 The Orange Book	924
14.4 Declaratory Judgment Jurisdiction.....	937
14.5 Authorized Generics	961
14.6 Exercises	968
INDEX	971