

**DESIGN PATENT LAW AND PROSECUTION
FALL 2009**

Instructors:

James D. Hamilton Tel: (703) 412-6220 E-Mail: jhamilton@oblon.com

Michael E. McCabe Tel: (703) 412-6443 E-Mail: mmccabe@oblon.com

Class Hours/Days of the Week: 8:00 – 8:50 PM Mondays*

*(Class hours may be changed to 8:00 – 9:40 PM on a biweekly basis upon approval by the law school and by a voice vote of the students in attendance on August 24, 2009. If biweekly classes are approved, subsequent classes will be rescheduled to meet on September 14, September 28, October 13, October 26, November 9 and November 23, 2009 to cover assignments for weeks 3-5, 6-8, 8-9, 10-11, 12-13, and 14, respectively)

Classroom: 224

Recommended Textbooks: Manual of Patent Examining Procedure (MPEP) –Chapter 1500 (Design Patents);

Chapter 1500 of the MPEP is available on-line at:
<http://vwww.uspto.gov/web/offices/pac/mpep/documents/1500.htm>

ASSIGNMENTS:

Weeks 1 – 2 (Weeks of August 24 and August 31, 2009 – note that no class will be held on Labor Day – September 7, 2009. Students should be prepared to complete all assigned readings for weeks 1-2 for the class held on August 24, 2009)

Discussion Topics: (1) Introduction; (2) Statutory Subject Matter; (3) Actual Reduction of Practice; (4) Specification (5) Novelty; (6) Non-Obviousness; (7) Public Use; and (8) MPEP assigned reading.

Reading Assignment: Textbook: pgs. 1500-1 to 1500-11- Statutes and Rules Applicable; Definition of Design; and Elements of a Design Application and the decisions listed below:

Application of Hruby, 54 CCPA 1196, 373 F.2d 997, 153 USPQ 61 (Fed. Cir. 1967).

Fitzgerald v. Arbib, 268 F.2d 763, 122 USPQ 530 (Fed. Cir. 1959).

Racing Strollers, Inc. v. Tri Industries, Inc., 878 F.2d 1418, 11 USPQ2d 1300 (Fed. Cir. 1989)

Ex Parte Reiner, 142 USPQ 283 (Bd. of Pat. App. & Inter. 1964).

Application of Bartlett et al., 49 CCPA 969, 300 F.2d 942, 133 USPQ 204 (CCPA 1962).

Sidewinder Marine, Inc. v. Starbuck-Kustom Boats and Products, Inc., 597 F.2d 201, 202 USPQ 356 (10th Cir. 1979).

In re Nalbandian, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

In re Mann, 861 F.2d 581, 8 USPQ2d 2030 (Fed. Cir. 1988).

In re Zahn, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

In re Daniels, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998).

Class Handouts: None

Weeks 3 -5 (Weeks of September 14 and 21, 2009):

Discussion Topics: (1) Examination of Design Applications; (2) Statutory Subject Matter for Designs; (3) Computer-Generated Icons; (4) Design Comprising Multiple Articles or Multiple Parts Embodied in a Single Article; (5) Lack of Ornamentality; (6) Novelty; and (7) Non-Obviousness.

Reading Assignment: MPEP pgs. 1500-11 to 1500-35. and the decisions listed below as referenced in the MPEP:

Ex parte Donaldson, 26 USPQ2d 1250 (Bd. Pat. App. & Int. 1992).

Ex parte Strijland, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992).

In re Oeticker, 997 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Ex parte Gibson, 20 USPQ 249 (Bd. App. 1933).

L.A. Gear Inc. v. Thorn McAn Shoe Co., 988 F.2d 1117, 25 USPQ2d 1913 (Fed. Cir. 1993).

Avia Group International Inc. v. L.A. Gear California Inc., 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988).

In re Webb, 916 F.2d 1553, 16 USPQ2d 1433, (Fed. Cir. 1990).

In re Carletti, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964).

In re Bartlett, 300 F.2d 942, 133 USPQ 204 (CCPA 1962).

In re Nalbandian, 661 F.2d, 1214, 211 USPQ 782, (CCPA 1981).

In re Glavas, 230 F.2d 447, 109 USPQ 50 (CCPA 1956).

Seiko Epson v. Nu-Kote International Inc., 190 F.3d 1360, 52 USPQ2d 1011 (Fed. Cir. 1999)

Class Handouts: None

Weeks 6 – 7 (Weeks of September 28 and October 5):

Discussion Topics: (1) Considerations under 35 U.S.C. §112; (2) Restriction; (3) Traversal of Restriction Requirement

Reading Assignment: MPEP pgs. 1500-35 to 1500-49 and the decisions listed below referenced in the MPEP:

Ex parte Kohler, 1905 C.D. 192, 116 O.G. 1185 (Comm'r Pat. 1905).

In re Salmon, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983).

In re Daniels, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998).

In re Berkman, 642 F.2d 427, 209 USPQ 45 (CCPA 1981).

In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Ex parte Appeal No. 315-40, 152 USPQ 71 (Bd. App. 1965).

In re Rubinfeld, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

In re Platner, 155 USPQ 222 (Comm'r Pat. 1967).

Keystone Retaining Wall Systems, Inc. v. Westrock Inc., 997 F.2d 1444, 27 USPQ2d 1297 (Fed. Cir. 1993).

Bloomcraft of Pittsburgh v. Ladd, 144 USPQ 562 (D.D.C. 1965).

Class Handouts: None

Weeks 8 – 9 (Weeks of October 12 and 19, 2009) (Monday, October 12 (Columbus Day) class to be held on Tuesday October 13, 2009):

Discussion Topics: (1) Double Patenting; (2) Priority Under 35 U.S.C. §119(a)-(d); (3) Benefit Under 35 U.S.C. §120 (3) Expedited Examination; (4) Allowance and Term of Design Patent; (5) Reissue of a Design Patent; (6) Reexamination; (7) Protest; (8) Relationship Between Design Patent, Copyright and Trademark.

Reading Assignment: MPEP pgs. 1500-50 to 1500-62 and the decisions listed below referenced in the MPEP:

Anchor Hocking Corp. v. Eyelet Specialty Co., 377 F. Supp 98, 183 USPQ 87 (D. Del. 1974).

In re Zickendraht, 319 F.2d 225, 138 USPQ 22 (CCPA 1963).

In re Dembiczak, 175 F.3d 994, 50 USPQ2d 614 (Fed. Cir. 1999).

In re Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973).

In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995).

In re Yardley, 493 F.2d 1389, 181 USPQ 331 (CCPA 1974).

In re Mogen David Wine Corp., 328 F.2d 925, 140 USPQ 575 (CCPA 1964).

Class Handouts: None

Weeks 10 -11 (Weeks of October 26 and November 2, 2009):

Discussion Topics: Design Patent Litigation - Infringement; Ordinary Observer Requirement.

Reading Assignment:

35 U.S.C. § 271.

Gorham v. White, 81 U.S. 511 (1872).

Elmer v. ICC Fabricating Inc., 67 F.3d 1571, 36 USPQ2d 1417 (Fed. Cir. 1995).

OddzOn Products v. Just Toys, 122 F.3d 1396 (Fed. Cir. 1997).

Contessa Food Products v. Conagra, 282 F.3d 1370 (Fed. Cir. 2002).

Arminak and Assoc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314 (Fed.Cir. 2007).

Class Handouts: None

Weeks 12 – 13 (Weeks of November 9 and 16, 2009):

Discussion Topics: Design Patent Litigation - Point of Novelty Requirement; Claim Interpretation; Willful Infringement

Reading Assignment:

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 88 USPQ2d 1658 (Fed. Cir. 2008).

Unidynamics Corp. v. Automated Products International, Ltd., 157 F.3d 1311 (Fed. Cir. 1998).

L.A. Gear, Inc. v. Tom McAn Shoe Co., 988 F.2d 1117 (Fed Cir. 1993).

Hupp v. Siroflex of America, 122 F.3d 1456 (Fed. Cir. 1997).

Read v. Portec, 970 F.2d 816 (Fed. Cir. 1992).

In re Seagate Tech., LLC, 497 F.3d 1360 (Fed. Cir. 2007) (en banc).

Class Handouts: None

Weeks 14-15 (November 23 and 30, 2009):

Discussion Topics: Design Patent Litigation - Invalidity; Inequitable Conduct; Remedies

Reading Assignment:

35 U.S.C. §101, 102, 103, 112, 284 and 289

Braun Inc. v. Dynamics Corp. of America, 975 F.2d 815 (Fed. Cir. 1992).

Catalina Lighting Inc. v. Lamps Plus, Inc., 295 F.3d 1277 (Fed. Cir. 2002).

Nike Inc. v. Wal-Mart Stores, 46 USPQ2d 1001 (Fed. Cir. 1998).

The Read Corp. v. Portec, 970 F.2d 816 (Fed. Cir. 1992).

KSR v. Teleflex, 127 S.Ct. 1727 (2007).

Titan Tire Corp. v. Case New Holland, Inc., 566 F.3d 1372 (Fed. Cir. 2009).

Class Handouts: None

Final Exam – Saturday, December 5, 2009 (Noon)