

# GEORGE MASON UNIVERSITY SCHOOL OF LAW

## CHEMICAL PATENT PRACTICE SPRING 2009

### January 7      **Inventorship**

*Burroughs Wellcome v. Barr Labs.*, 32 U.S.P.Q.2d 1915 (Fed. Cir. 1994)

*Pannu v. Iolab*, 47 U.S.P.Q.2d 1657 (Fed. Cir. 1998)

*Hess v. ACS*, 41 U.S.P.Q.2d 1782 (Fed. Cir. 1997)

*Fina v. Ewen* 43 U.S.P.Q.2d 1935 (Fed. Cir. 1997)

*Hitzmann v. Rutter*, 58 U.S.P.Q.2d 1161 (Fed. Cir. 2001)

### January 14      **Restriction/Double-Patenting**

*General Foods Corp. v. Studiengesellschaft Kohle GmbH*, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992)

*In re Kaplan et al.*, 229 U.S.P.Q. 678 (Fed. Cir. 1986)

*In re Braat*, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991)

*In re Berg*, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998)

*Eli Lilly & Co. v. Barr Laboratories, Inc.*, 58 U.S.P.Q.2d 1869 (Fed. Cir.2001)

*In re Metoprolol Succinate Patent Litigation (AstraZeneca v. KVPharmaceutical)*, 83 U.S.P.Q.2d 1545 (Fed. Cir. 2007)

*In re Basell Polioefine Italia S.P.A.*, (Fed. Cir. 11/13/08 # 2007-1450)

### **Markush claims**

*In re Harnisch*, 206 U.S.P.Q. 300 (C.C.P.A. 1980)

*Ex parte Hozumi*, 3 U.S.P.Q.2d 1059 (Bd App 1984)

*Abbott Laboratories v. Baxter Pharmaceutical Products, Inc.*, 67 U.S.P.Q.2d 1191 (Fed. Cir. 2003)

*Conoco v. Energy and Environmental Int'l*, 79 U.S.P.Q.2d 1801 (Fed. Cir. 2006)

### January 21      **Utility issues (101)**

*Nelson v. Bowler*, 206 U.S.P.Q. 881 (C.C.P.A. 1980)

*In re Brana*, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995)

*Cross v. Iizuka*, 224 U.S.P.Q. 739 (CCPA 1985)

*In re Fisher*, 76 U.S.P.Q.2d 1225 (Fed. Cir. 2005)

*Metabolite Labs, Inc. v. Lab Corp. of Am.Holdings*,71U.S.P.Q.2d 1081 (Fed. Cir. 2004), *cert. dismissed*, 79 U.S.P.Q.2d 1065 (S.Ct. 2006)

PTO "Revised Interim Utility Guidelines" 66 FR 1092-1099 (available on the PTO Website)

**January 28      Utility**

*In re Bilski*, - F.3d -, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008)  
PTO Examiner Training Materials: “Personalized Medicine”

**February 4      Product-by-process claims**

*Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991)  
*Atlantic Thermoplastics Co., Inc. v. Faytex Corp.*, 23 U.S.P.Q.2d 1481 (Fed. Cir. 1992)  
*Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 35 U.S.P.Q.2d 1801 (Fed. Cir. 1995)

**Process claims**

*Eli Lilly v. American Cyanamid Co.*, 38 U.S.P.Q.2d 1705 (Fed. Cir. 1996)

**Jepson claims**

*In re Ehrreich and Avery*, 200 U.S.P.Q. 504 (C.C.P.A. 1979)

**Preambles**

*Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 9 U.S.P.Q.2d 1962 (Fed. Cir. 1989)  
*Catlina Marketing Int'l Inc. v. Coolsavings.com*, 62 U.S.P.Q.2d 1781 (Fed. Cir. 2002)

**Transition phrases**

*Ex parte Davis and Tuukkanen*, 80 U.S.P.Q. 448 (P.O.B.A. 1949)  
*PPG v. Guardian*, 37 U.S.P.Q.2d 1618 (Fed. Cir. 1996)

**February 11      112, second paragraph**

*In re Swinehart*, 169 U.S.P.Q. 226 (C.C.P.A. 1971)  
*Solomon v. Kimberly Clark*, 55 U.S.P.Q.2d 1279 (Fed. Cir. 2000)  
*Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991)  
*Eiselstein v. Frank*, 34 U.S.P.Q.2d 1467 (Fed. Cir. 1995)  
*Verve v. Crane*, 65 U.S.P.Q. 2d 1051 (Fed. Cir. 2002)

**Sixth Paragraph**

*Masco Corp. v. U.S.*, 64 U.S.P.Q. 2d 1182 (Fed. Cir. 2002)

**February 18      112, first paragraph, enablement**

*In re Marzocchi and Horton*, 169 U.S.P.Q. 367 (C.C.P.A. 1971) -- a close reading  
*In re Angstadt and Griffin*, 190 U.S.P.Q. 214 (C.C.P.A. 1976)  
*Genentech Inc. v. Novo Nordisk*, 42 U.S.P.Q.2d 1001 (Fed. Cir. 1997)  
*Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991)  
*Pharmaceutical Res., Inc. v. Roxane Labs., Inc.*, Slip Op. 2997 WL 3151692 (Fed. Cir. 2007 unpublished)  
*In re Wands*, 8 U.S.P.Q.2d 1400 (Fed. Cir. 1988)  
*In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)  
*Enzo Biochem Inc. v. Calgene Inc.*, 52 U.S.P.Q.2d 1129 (Fed. Cir. 1999)  
*Amgen v. Hoechst*, 65 U.S.P.Q.2d 1385 (Fed. Cir. 2003)  
*In re Alonzo*, (Fed. Cir. 10/30/08)

**February 25      112, first paragraph, written description**

*In re Wertheim et al.*, 191 U.S.P.Q. 90 (C.C.P.A. 1976)  
*In re Johnson*, 194 U.S.P.Q. 187 (C.C.P.A. 1977)  
*Ex parte Grasselli*, 231 U.S.P.Q. 394 (Bd. App 1986)  
*In re Grasselli*, 138 F.2d 453 (unpublished) (Fed. Cir. 1984)  
*In re Driscoll*, 195 U.S.P.Q. 434 (C.C.P.A. 1977)  
*Fujikawa v. Wattanasin*, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996)  
*Union Oil v. Atlantic Richfield*, 54 U.S.P.Q.2d 1227 (Fed Cir. 2000)  
*Purdue Pharma v. Faulding*, 56 U.S.P.Q.2d 1481 (Fed. Cir. 2000)  
PTO " Written Description Training Materials" (Revision 1: 3/25/08) (available on the PTO Website)

**written description:** incorporation by reference

*Southern Clay Products v. United Catalysts*, 64 U.S.P.Q. 2d 1606 (Fed. Cir. 2002)

**March 4            Written description**

*Regents of University of California v. Eli Lilly*, 119 F.3d 1559, 43 U.S.P.Q. 2d., 1398 (Fed. Cir. 1997)  
*Enzo Biochem v. Gen-Probe Inc.*, 63 U.S.P.Q. 1609 (Fed. Cir. 2002)  
*Moba v. Diamond*, 66 U.S.P.Q.2d 1429 (Fed. Cir. 2003)  
*University of Rochester v. G.D. Searle and Co., Inc.*, 69 U.S.P.Q.2d 1886 (Fed.Cir. 2004)  
*Chiron Corp. v. Genentech Inc.*, 70 U.S.P.Q.2d 1321 (Fed. Cir. 2004)  
*Metabolite Labs, Inc. v. Lab Corp. of Am.Holdings* 71 U.S.P.Q.2d 1081 (Fed. Cir. 2004), *cert. dismissed*, 79 U.S.P.Q.2d 1065 (S.Ct. 2006)  
*Univ. of Rochester v. G.D. Searle & Co.*, 71 U.S.P.Q.2d 1545 (Fed. Cir. 2004)

**March 11          NO CLASS**

**March 18**            **112, first paragraph, best mode**

*Bayer v. Schein Pharmaceuticals*, 64 U.S.P.Q. 2d 1001 (Fed. Cir. 2002)  
*Chemcast Corp. v. Arco Industries Corp.*, 16 U.S.P.Q.2d 1033 (Fed. Cir. 1990)  
*Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991)  
*Dana Corp. v. IPC Ltd. Partnership*, 8 U.S.P.Q.2d 1692 (Fed. Cir. 1988).  
*Randomex Inc. v Scopus Corp*, 7 U.S.P.Q.2d 1050 (Fed. Cir. 1988)  
*Wahl Instruments v. Acvious*, 21 U.S.P.Q.2d 1123 (Fed. Cir. 1991)

**March 25**            **Anticipation**

*In re Donohue*, 226 U.S.P.Q. 619 (Fed. Cir. 1985)  
*In re Schoenwald*, 22 U.S.P.Q.2d 1671 (Fed. Cir. 1992)  
*In re Petering*, 133 U.S.P.Q. 275 (C.C.P.A. 1962)  
*In re Ruschig*, 145 U.S.P.Q. 274 (C.C.P.A. 1965)  
*Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 73 (Fed. Cir. 1985)  
*Atlas v. Ireco*, 51 U.S.P.Q.2d 1943 (Fed. Cir. 1999)  
*In re Cruciferous Sprout Litigation*, 64 U.S.P.Q.2d 1202 (Fed. Cir. 2002)  
*Schering v. Geneva.*, 67 U.S.P.Q. 2d 1664 (Fed. Cir. 2003)

**April 1**              **Obviousness**

(Although not specifically assigned, this topic assumes familiarity with the Supreme Court's decision in *KSR Int'l Co. V. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (US 2007))  
*In re Grabiak*, 226 U.S.P.Q. 870 (Fed. Cir. 1985)  
*In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992)  
*In re Lalu*, 223 U.S.P.Q. 1257 (Fed. Cir. 1984)  
*In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994)  
*Daiichi Sankyo Co., Ltd. v. Apotex, Inc.*, 84 U.S.P.Q.2d 1285 (Fed. Cir. 2007)  
*Takeda Chemical Ind., Ltd. v. Alphapharm Pty., Ltd.*, 84 U.S.P.Q.2d 1197 (Fed. Cir. 2007)  
*Aventis Pharma Deutschland GmbH v. Lupine, Ltd.*, 82 U.S.P.Q.2d 1852 (Fed. Cir. 2007)  
*Pfizer, Inc. v. Apotex, Inc.*, 82 U.S.P.Q.2d 1321 (Fed. Cir. 2007)  
PTO "Examination Guidelines for Determining Obviousness Under 35 USC §103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" :  
72(195) FR 57526 (10/10/07) (Also available on the PTO website)

**April 8**              **TBA**

**April 15            Obviousness**

*\* Rule 132 Declarations*

*In re Soni*, 34 U.S.P.Q.2d 1684 (Fed. Cir. 1995)

*In re Chupp*, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987)

*In re Zenitz*, 142 U.S.P.Q 158 (C.C.P.A. 1964)

*In re Davies*, 177 U.S.P.Q. 381 (C.C.P.A. 1973)

*\* "Analogous" Process*

*In re Ochiai*, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995)

*Sanofi-Synthelabo v. Apotex Inc.*, (Fed. Cir. 12/12/08)