Contact Information:  (Please use emails below rather than GMU email)

Professor Shubin
shubin@mwzb.com  703-812-5306

Professor Heaney
Heaney@mwzb.com  703-812-5308

Office Hours:  By appointment upon mutual agreement with students.

Class Prerequisites:  Students are to have completed Patent Law I and II.  The course is a survey course of legal concepts learned in basic patent law classes, but with particular focus on areas that are unique to, or especially problematic in, the chemical/biotech arts, with the majority of readings and examples drawn from legal decisions in those arts.  While a background in chemistry, biochemistry or biology is desirable, many prior students have not had a scientific background, and the professors will explain to the extent practical any necessary concepts during class.

Course Readings:  There is no text for this course, but instead students are assigned on a weekly basis readings selected from relevant case law and materials published by the United States Patent and Trademark Office, as set forth on the following pages.  Students are expected to have completed the readings prior to each class.  It assumed that students have access to assigned case law readings, and to the USPTO website.  The professors will provide paper copies of assigned cases on request from students who do not have such access.

Grading:  Grading is based upon a final exam at the conclusion of the course.  The exam will be a take home, open book, open notes exam (consultation with other persons is prohibited).  The exam will be available in the records office at the beginning of the exam period (Monday, April 25), and due not later than the end of the exam period (Tuesday, May 10).  Students will be restricted as to the number of days the exam can be retained.

Class Participation:  Class attendance is critically important, as the majority of instruction is based on discussion and lecture during the class period.  Class participation in discussions may, at the discretion of the professors, be used as an increment adjustment of the final grade.
GEORGE MASON UNIVERSITY SCHOOL OF LAW
CHEMICAL PATENT PRACTICE
SPRING 2016
Professors Shubin & Heaney

Reading Assignments:

January 12  Introduction/Inventorship

*Streck Inc. v. Research & Diagnostics Systems Inc.*, 659 F.3d 1186 (Fed. Cir. 2012)
*Hitzmann v. Rutter*, 58 U.S.P.Q. 2d 1161 (Fed. Cir. 2001)

January 19  Inventorship

*Applegate v. Scherer*, 332 F.2d 571, 141 USPQ 796 (CCPA 1964)

January 26  Double-Patenting/Restriction

*In re Basell Poliolefine Italia S.P.A.*, 547 F.3d 1371, 89 USPQ2d 1030 (Fed. Cir. 2009)
*Boehringer Ingelheim GmbH v. Barr Laboratories, Inc.*, 592 F.3d 1340, 93 U.S.P.Q.2d 1417 (Fed. Cir. 2010)
Markush Claims


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


February 2  Utility (101)


PTO “Revised Interim Utility Guidelines” 66 FR 1092-1099 (available on the PTO website)

*In re Bilski*, 545 F.3d 943, 88 U.S.P.Q. 2d 1385 (Fed. Cir. 2008)


PTO Examiner Training Materials: “Personalized Medicine”(Given out in class)

February 9  Product-by-Process Claims


*SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 74 USPQ2d 1398 (Fed. Cir. 2005)

Process Claims


Jepson Claims

_In re Ehrreich_, 200 U.S.P.Q. 504 (C.C.P.A. 1979)
_In re Fout_, 213 USPQ 532 (CCPA 1982)

Preambles


Transition Phrases

_Ex parte Davis and Tuukkanen_, 80 U.S.P.Q. 448 (P.O.B.A. 1949)

February 16 112, Second Paragraph, Indefiniteness

_In re Swinehart_, 169 U.S.P.Q. 226 (C.C.P.A. 1971)
_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


February 23 112, First Paragraph, Enablement

_In re Marzocchi_, 169 U.S.P.Q. 367 (C.C.P.A. 1971) – a close reading
_In re Angstadt_, 190 U.S.P.Q. 214 (C.C.P.A. 1976)
_In re Wands_, 8 U.S.P.Q.2d 1400 (Fed. Cir. 1988)
_In re Vaeck_, 20 U.S.P.Q. 1438 (Fed. Cir. 1991)
March 1  112, First Paragraph, Written Description

In re Wertheim et al., 191 U.S.P.Q. 90 (C.C.P.A. 1976)
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)
Purdue Pharma v. Faulding, 56 U.S.P.Q. 2d 1481 (Fed. Cir. 2000)
Chiron v. Genentech, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1325-26
(Fed. Cir. 2004)

PTO “Written Description Training Materials” (Revision 1: 3/25/08)
(available on the PTO website)

Written Description: incorporation by reference
Cir. 2002)

March 8  NO CLASS (Spring Break)

March 15  Written Description (or not?)

Regents of University of California v. Eli Lilly, 119 F.3d 1559, 43
U.S.P.Q. 2d 1398 (Fed. Cir. 1997)
(Fed. Cir. 2004)
Chiron Corp. v. Genentech Inc., 363 F.3d 1247, 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
2004)
In re Alonso, 545 F.3d 1015, 88 U.S.P.Q.2d 1849 (Fed. Cir. 2008)
Ariad v. Lilly, 560 F.3d 1366, 90 U.S.P.Q.2d 1549 (Fed. Cir. 2009)

March 22  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)
Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 3 USPQ 2d 1737
(Fed. Cir.), cert. denied, 484 U.S. 954 (1987)
Dana Corp. v. IPC Ltd. Partnership, 8 U.S.P.Q. 2d 1692 (Fed. Cir. 1988)

The “America Invents Act” – Wither 35 USC §102?


March 29  Anticipation

Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990)
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)
In re Cruciferous Sprout Litigation, 64 U.S.P.Q. 2d 1202 (Fed. Cir. 2002)

April 5  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 (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 U.S.P.Q. 2d 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. Lupin, Ltd., 82 U.S.P.Q. 2d 1852 (Fed. Cir. 2007)
In re Kubin, 561 F.3d 1351, 90 USPQ2d 1417 (Fed. Cir. 2009)
Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex: Federal Register /Vol. 75, No. 169 /Wednesday, September 1, 2010 (Also available on the PTO website.)

April 12  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)
In re Ochiai, 37 U.S.P.Q. 2d 1127 (Fed. Cir. 1995)
April 19
Overview of Biotech Issues: What’s left after Myriad?
(Guest Lecture)

Questions
Review