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 is 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, and due not later than the end of the exam period. 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.
Reading Assignments:

January 7  Introduction/Inventorship

*Streck Inc. v. Research & Diagnostics Systems Inc.*, 665 F.3d 1269 (Fed. Cir. 2012)  
*Hitzmann v. Rutter*, 58 U.S.P.Q. 2d 1161 (Fed. Cir. 2001)

January 14  Inventorship

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

January 21  Restriction/Double-Patenting

*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

_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)

January 28 Utility (101)

_In re Brana_, 34 U.S.P.Q. 2d 1436 (Fed. Cir. 1995)
_In re Fisher_, 76 U.S.P.Q. 2d 1225 (Fed. Cir. 2005)
_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 4 Product-by-Process Claims

_Atlantic Thermoplastics Co., Inc. v. Faytex Corp._, 23 U.S.P.Q. 2d 1481 (Fed. Cir. 1992)
_SmithKline Beecham Corp. v. Apotex Corp._, 403 F.3d 1331, 74 USPQ2d 1398 (Fed. Cir. 2005)
_Abbott Labs. v. Sandoz Inc._, 566 F.3d 1282, 90 U.S.P.Q.2d 1769 (Fed. Cir. 2009)
Process Claims


**Jepson Claims**

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

**Preambles**


**Transition Phrases**

*Ex parte Davis and Tuukkanen*, 80 U.S.P.Q. 448 (P.O.B.A. 1949)

**February 11 112, Second Paragraph, Indefiniteness**

*Eiselstein v. Frank*, 34 U.S.P.Q. 2d 1467 (Fed. Cir. 1995)

**Sixth Paragraph**


**February 18 112, First Paragraph, Enablement**

*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)
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 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

March 4 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 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)
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 25 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 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 (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 8 Obviousness
*Rule 132 Declarations
In re Soni, 34 U.S.P.Q. 2d 1684 (Fed. Cir. 1995)
April 17  Overview of Biotech Issues: What’s left after Myriad?  
   (Guest Lecture)  
   Association for Molecular Pathology v. Myriad Genetics, 569 US - , -  
   USPQ – (2013)  

Questions  
Review