

DONALD SHELBY CHISUM

ADDRESS

Donald S. Chisum
<http://www.chisum.com>

EDUCATION

A.B. 1966 Stanford University — Phi Beta Kappa, Philosophy
LL.B. 1968 Stanford University — Order of the Coif, Top 5% of class

BAR AFFILIATIONS

United States Supreme Court
United States Court of Appeals for the Ninth Circuit
United States Court of Appeals for the Federal Circuit
California — Inactive
Washington — Inactive

EMPLOYMENT

1997-2006 Professor of Law, Santa Clara University
1990-2005 Of Counsel, Morrison & Foerster LLP — Palo Alto and San Francisco, California
1974-1996 Professor of Law, University of Washington
1984 Visiting Professor, Cardozo Law School, Yeshiva University — New York, New York
1981-1983 Associate Dean, University of Washington School of Law
1972-1974 Associate Professor of Law, University of Washington
1969-1972 Assistant Professor of Law, University of Washington
1968-1969 Law Clerk, Judge Shirley M. Hufstedler, United States Court of Appeals for the Ninth Circuit
1967 Summer Associate, Cravath, Swaine & Moore — New York, New York
1966 Research Assistant, Professor Herbert Packer, Stanford Law School

PUBLICATIONS — INTELLECTUAL PROPERTY

Chisum, Chisum on Patents (37 vol., LexisNexis Matthew Bender, 1978-).

Chisum, Patent Law Digest (LexisNexis Matthew Bender, 1991-).1

Chisum, Patent Law Digest, 25th Federal Circuit Anniversary Edition (LexisNexis Matthew Bender, 2008.)

Chisum, Elements of United States Patent Law, Second Edition (dual language edition, translation into Japanese by Prof. Toshiko Takenaka and Prof. Nobuo Monya) (Yushodo Press Co., Ltd. Tokyo, 2000.)

Chisum & Nard, Schwartz, Newman & Kieff, Principles of Patent Law. (Foundation Press).

Chisum & Jacobs, World Intellectual Property Guidebook, United States (Matthew Bender, 1992).

Chisum, Elements of United States Patent Law (dual language edition, translation into Japanese by Prof. Nobuo Monya) (Yushodo Co., Ltd., Tokyo, 1987).

Chisum, Intellectual Property (Matthew Bender Casebook, 1980).

Amicus Curiae Brief for Celltech Group plc. (joint author) on prosecution history estoppel in support of petitioner, United States Supreme Court, *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., a/k/a SMC Corporation and SMC Pneumatics, Inc.*, August, 2001.

Amicus Curiae Brief for Chiron Corporation (joint author) on prosecution history estoppel in support of petitioner, United States Supreme Court, *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., a/k/a SMC Corporation and SMC Pneumatics, Inc.*, August, 2001.

Amicus Curiae Brief for the American Intellectual Property Law Association on State Immunity from Federal Court Damage Suits for Patent Infringement, Court of Appeals for the Federal Circuit, *Chew v. State of California*, June, 1989.

Amicus Curiae Brief for the American Intellectual Property Law Association (joint author) on Whether Actual Reduction to Practice is Necessary to Invoke the “On Sale” Provision of 35 U.S.C. Section 102, Supreme Court of the United States, *UMC Electronics v. The United States of America*, October, 1987.

Amicus Curiae Brief for the American Intellectual Property Law Association on the Degree to which the Obviousness Determination is one of Fact, Court of Appeals for the Federal Circuit, *Panduit v. Dennison*, July, 1986.

Amicus Curiae Brief for the American Patent Law Association on the Constitutional Status of Trade Secrets as Property, United States Supreme Court, *Ruckelshaus v. Monsanto Company*, January, 1984.

Patenting Intangible Methods: Revisiting Benson (1972) after Bilski (2010), 27 Santa Clara Computer & High Technology Law Journal 445 (2011).

Weeds and Seeds in the Supreme Court’s Business Method Patents Decision: New Directions for Regulating Patent Scope, 15 Lewis & Clark Law Review 11 (2011).

“Written Description of the Invention: Ariad (2010) and the Overlooked Invention Priority Principle,” 2010 Patently-O Patent L.J. 72.

Chapter: “Lost in Translation”: *The Legal Impact of Patent Translation Errors on Claim Scope*, (with Farmer), Patent Law and Theory: A Handbook of Contemporary Research, Toshiko Takenaka, (Edward Elgar Publishing Limited 2009). (Chinese Translation: Intellectual Property Publishing House 2013).

“Lost in Translation”: *The Legal Impact of Patent Translation Errors on Claim Scope*, (with Farmer), Japan Institute of Invention and Innovation (2006).

Reforming Patent Law Reform, 4 J. Marshall Rev. Intell. Prop. L 336 (2005).

The Supreme Court and Patent Law: Does Shallow Reasoning Lead to Thin Law? 3 Marquette Intellectual Property Law Review 1 (1999).

The Scope Of Protection For Patents After The Supreme Court’s Warner-Jenkinson Decision: The Fair Protection — Certainty Conundrum, 14 Santa Clara Computer & High Tech. L.J. 1 (1998).

Developments on the “Written Description” and “Enablement” Requirements, Claim Interpretation, and the Doctrine of Equivalents, Bijblad bij De Industriële Eigendom, The Netherlands, (1998).

Agricultural Biotechnology and the Law: Patents, Plant Patents, Plant Variety Certificates, and the Rise of Intellectual Property Rights in Biological Subject Matter, (with Stuart), Chapter: Agricultural Biotechnology, Arie Altman, (1998).

Introduction to the United States First-to-Invent System, 4 Nordic Intellectual Property Law Review 521 (1993).

Comment on Plesner, "Better Right to an Invention," 4 Nordic Intellectual Property Law Review 576 (1993).

Introduction to Symposium on International Patent Law Harmonization, 26 The John Marshall Law Review 437 (1993).

Patent Law Developments in the United States Court of Appeals for the Federal Circuit During 1991, 41 The American University Law Review 3 (1992).

The Diamond Scientific Decision, Comments by Professor Donald Chisum, 8 Computer Law Reporter 187 (1988).

Review Essay: The Patentability of Computer Software: An International Guide to the Protection of Computer-Related Inventions (W.A. Hanneman), 3 Yearbook of Law Computers and Technology 229 (1987).

Patent Law and the Presumption of Moral Regularity: A Critical Review of Recent Federal Circuit Decisions on Inequitable Conduct and Willful Infringement, 69 Journal of the Patent and Trademark Office Society 27 (1987).

Comment: Anticipation, Enablement and Obviousness: An Eternal Golden Braid, 15 American Intellectual Property Law Association Quarterly Journal 57 (1987).

The Patentability of Algorithms, 47 University of Pittsburgh Law Review 959 (1986). Received the Gerald Rose Memorial Award, John Marshall Law School, Chicago, Illinois, February 1987.

The Recision Remedy for Franchise Regulation Violations, 5 Franchise Law Journal 1 (1985) (with McTigue).

Remedies for Patent Infringement, 13 American Intellectual Property Law Association Quarterly Journal 380 (1985).

Copyright, Computer Programs and the Apple Cases: A Compromise Solution, 9 European Intellectual Property Review 231 (1983).

Prior Invention and Patentability, 63 Journal of the Patent and Trademark Office Society 397 (1981).

Foreign Activity: Its Effect on Patentability under United States Law, 11 International Review of Industrial Property & Copyright Law 26 (1980).

Book Review: Patent and Know-How Licensing in Japan and the United States, 10 Law in Japan 152 (1977).

Sources of Prior Art in Patent Law, 52 Washington Law Review 1 (1976).

"Afterthoughts" and Undisclosed Advantages as Evidence of Patentability: From Salt Dredges to Polystyrenes, 57 Journal of the Patent and Trademark Office Society 437 (1975).

State Regulation of Franchising: The Washington Experience, 48 Washington Law Review 291 (1973).

The Allocation of Jurisdiction Between State and Federal Courts in Patent Litigation, 46 Washington Law Review 633 (1971), 1972 Patent Law Review 103.

PUBLICATIONS — OTHER

The Tensions of Judicial Federalism (review of Redish, Federal Jurisdiction), 33 Stanford Law Review 1161 (1981).

Legal Assistance for Indigent Inmates, Washington State Bar News, April 1975, at 9 (with Young).

Book Review: Cases & Materials on Corporate Finance (Brudney & Chirelstein), 86 Harvard Law Review 1103 (1973).
In Defense of Modern Habeas Corpus for State Prisoners, 21 DePaul Law Review 682 (1972).

Book Review: The Wall Street Jungle, 46 Washington Law Review 847 (1971).

Book Review: Up the Organization, 45 Washington Law Review 871 (1970).

Napalm, Proxy Proposals and the SEC, 12 Arizona Law Review 463 (1970).

Student Comment: *Nonissuer Transactions under the California Corporate Securities Act of 1968*, 21 Stanford Law Review 152 (1968).

Student Comment: *A Reconstruction of Taxation's Blockage Doctrine*, 20 Stanford Law Review 336 (1968).

Student Note: *Constitutional Right to Engage an Out-of-State Attorney*, 19 Stanford Law Review (1967).

SUBJECTS TAUGHT

Patents, Copyrights, Trademarks
Intellectual Property
Civil Procedure
Computers and the Law
Federal Jurisdiction
Corporations
Corporate Finance
Securities Regulation
Legal Problems of Prisoners

OTHER ACTIVITIES AND HONORS

Co-Founder, Chisum Patent Academy, 2009-.

Professorship, Inez Mabie Professor of Law, Santa Clara University School of Law, 2001-2006.

Professorship, Phil and Bobbie Sanfilippo Chair, Santa Clara University, 1998-2001.

Director, Santa Clara University School of Law Summer Law Study Abroad Munich Germany Program 1998-2006.

Director, Center for Advanced Study and Research on Intellectual Property, 1987-1996.

Visiting Professor, School of Law, Queensland University of Technology, Brisbane, Australia, 2002.

Visiting Professor, Max Planck Institute for Patent, Copyright and Competition Law, Munich, Germany, 1979.

Editor, American Intellectual Property Law Association Quarterly Journal, 1986-1994.

Founder & Co-Editor, The Prison Law Reporter (ABA Young Lawyers Section, 1971-74).

Editor 1966-67, Book Review Editor 1967-68, Stanford Law Review.

Member, Executive Committee, International Association for the Advancement of Teaching and Research in Intellectual Property, 1995-1999.

Member, Advisory Board, Santa Clara University Institute of International and Comparative Law, 1998-2006.

Member, Board of Directors, American Intellectual Property Law Association, 1989-1992.

Member, Advisory Editorial Board to the Court of Appeals for the Federal Circuit Newsletter, 1986-1992.

Chairman, Association of American Law Schools, Intellectual Property Law Section, 1987-1988.

Recipient of the Katz-Kiley Fellowship presented by the University of Houston Law Center, Houston, Texas, November 2, 1995.

Recipient of the Jefferson Medal Award presented by the New Jersey Patent Law Association, May 12, 1989.

Recipient of the Gerald Rose Memorial Award for "The Patentability of Algorithms," 47 U. Pitt. L. Rev. 959, presented by The John Marshall Law School, Chicago, Illinois, February 1987.

Biebel & French Distinguished Visiting Scholar in Law and Technology, University of Dayton School of Law, Dayton, Ohio, September 15-16, 1992.

Testified before the House Subcommittee on Courts, Intellectual Property and the Administration of Justice on the Transgenic Animal Patent Reform Act, September 13, 1989.

Conferee, The Law, Science and Technology Frontier Conference, Arizona State University College of Law, Tempe, Arizona, February 13-14, 1989.

Honoree, The Los Angeles Daily Journal and California Law Business, "100 Most Influential Attorneys in California," September 13, 1999.

Exam Board for Registration to Practice before the Patent & Trademark Office 1987-1992.

Panelist, "*Bilski v. Kappos*," Chicago-Kent College of Law, Chicago, Illinois, September 30, 2010.

Panelist, "Claim Scope and Disclosure," Indiana University School of Law, Bloomington, Indiana, September 23, 2010.

Panelist, "The Future of Industrial Design Protection in the United States, Europe, and Beyond," University of Pittsburgh School of Law, Pittsburgh, Pennsylvania, February 26, 2009.

Panelist, "Supreme Court Shows Interest in IP Cases: *MercExchange v. ebay* and *Labcorp v. Chiron*," High Tech Law Institute, Santa Clara University School of Law and Silicone Valley Intellectual Property Law Association, April 28, 2006.

Panelist, "Comparing European and United States patent law: equivalents, estoppel, inequitable conduct and other current issues," Training Course, Boehmert & Boehmert, Munich, Germany, July 6, 2005.

Panelist, "Constitutionalizing Patents," Technology and the Law Symposium, University of Pittsburgh School of Law, Pittsburgh, Pennsylvania, March 18, 2005.

Panelist, "The Non-Obviousness and Inherency Doctrines," Law, Science & Technology Conference, Stanford Law School, Palo Alto, California, March 11, 2005.

Panelist, "Federal Circuit Decision Making; Predictable or Unpredictable?" Annual Meeting, American Intellectual Property Law Association, Washington, D.C., October 14, 2004.

Panelist, "Patent Roundtable," U.S. District Court, Northern District of California, Palo Alto, California, January 29, 2004 and February 10, 2004.

Panelist, "The First 15 Years: An Objective Review," First Bench and Bar Conference, Federal Circuit Bar Association, St. Thomas, U.S. Virgin Islands, April 26, 1998.

Panelist, "Claim Construction: The Current Law of Liability," Summer Conference, American Bar Association Intellectual Property Law Section, San Diego, California, June 26, 1997.

Panelist, "Intellectual Property and the Use of Technology in the Courtroom," CLE Program sponsored by The Federal Circuit Bar Association, San Francisco, California, January 28, 1997.

Panelist, "Extraterritorial Application of U.S. Intellectual Property Law," Symposium at the University of Virginia School of Law, Charlottesville, Virginia, January 25, 1997.

Panelist, "Global Substantive Patent Harmonization: Can it Be Achieved without Consensus on Philosophical Foundations?" Seminar Series at the Max Planck Institute, Munich, Germany, September 20, 1995.

Panelist, "Disclosure Standards and Patent Claim Scope: the United States 'Enablement', 'Invention Description' and 'Best Mode' Requirements - Comparison with Approaches in Europe and Japan," Seminar Series at the Max Planck Institute, Munich, Germany, September 19, 1995.

Panelist, "Recent United States Patent Law Reforms: Do They Comply with the 'Letter' and 'Spirit' of the TRIPs Standards for Patents?" Seminar Series at the Max Planck Institute, Munich, Germany, September 18, 1995.

Panelist, Intellectual Property Law Section Fall Meeting, New York State Bar Association, Bolton Landing, New York, October 2, 1992.

Panelist, Trade Related Aspects of Intellectual Property, Symposium sponsored by Vanderbilt University, Nashville, Tennessee, March 23-24, 1989. Remarks published at 22 Vanderbilt Journal of Transnational Law 341 (1989).

SPEECHES

"Patent Law Yesterday, Today and Tomorrow: Confessions of a Treatise Author," The Pauline Newman IP American Inn of Court, Alexandria, Virginia, March 19, 2013.

"Recent Developments in Patent Law," Thirteenth Annual Richard C. Sughrue Symposium on Intellectual Property Law and Policy, University of Akron, School of Law, Akron, Ohio, March 21, 2011.

"The Top Ten Patent Cases of 2009," Silicon Valley Intellectual Property Law Association, Santa Clara, California, March 25, 2010.

"Recent Developments in Patent Law From A Treatise Author's Perspective," LexisNexis Seminar, Chicago, Illinois, November 5, 2009; Commentary at Zuhn, Donald. "Patent Docs." *Biotech & Pharma Patent Law & News Blog*. 18 11 2009. Web. 5 Feb 2010.

"Recent Developments in Patent Law: Permanent Injunctions, Definiteness, Patentable Subject Matter, and Willful Infringement," LexisNexis Seminar, Seattle, Washington, July 21, 2009.

"The Federal Circuit after Twenty-Five Years," LexisNexis Seminar, Harvard Club, New York, New York, February 13, 2008.

"Heavy Hands on Hard Clay: The Supreme Court as an Instrument of Patent Law Reform," Second Annual Distinguished Lecture in Intellectual Property, University of Pittsburgh School of Law, Pittsburgh, Pennsylvania, March 28, 2007.

"Heavy Hands on Hard Clay: The Supreme Court as an Instrument of Patent Law Reform," Seventh Annual Center for Intellectual Property Law and Information Technology Symposium, DePaul University College of Law, Chicago, Illinois, March 15, 2007.

- “Lost in Translation: The Legal Impact of Patent Translation Errors on Claim Scope; Comparing U.S., European and Japanese Law,” International Association for the Advancement of Teaching and Research in Intellectual Property, Parma, Italy, September 4, 2006.
- “Substantive U.S. Patent Law,” Workshop on U.S. Intellectual Property Law, Humboldt University Berlin, June 17, 2005, Berlin, Germany
- “Reforming Patent Law Reform,” Judges’ Dinner, Pittsburgh Intellectual Property Law Association, Pittsburgh, Pennsylvania, April 27, 2005.
- “Patents System Review,” Board of Directors Meeting, Interamerican Association of Industrial Property, Santo Domingo, Dominican Republic, November 15, 2004.
- “Transnational Impact of United States Patent Law,” Berlin Chapter, German Association for the Protection of Industrial Property and Copyright Law, Berlin, Germany, June 28, 2004.
- “Patent Law Year in Review,” Los Angeles Intellectual Property Law Association, La Jolla, California, June 7, 2003.
- “Recent Developments in Patent Law,” Stanford Law and Technology Association, Palo Alto, California, January 30, 2003.
- “Scope and License of Patent Law. Practical Examples,” Queensland Department of Justice, Brisbane, Australia, September 25, 2002.
- “Patent Law: Two Centuries of Challenges for the Judiciary,” Boston Patent Law Association, Boston, Massachusetts, May 3, 2002.
- “Top Ten Intellectual Property Cases of the Federal Circuit 1982-2002,” Twentieth Anniversary Judicial Conference of the Court of Appeals for the Federal Circuit, Washington, D.C., April 8, 2002, **published at 217 F.R.D. 548.**
- “Recent Federal Circuit Decisions on Claim Interpretation,” Silicon Valley Intellectual Property Law Association, Santa Clara, California, November 15, 2001.
- “Emerging Trends and Future Prospects for the Patent System in the U. S. and Abroad,” San Diego Intellectual Property Law Association, San Diego, California, September 25, 2001.
- “The Patent System in 2001: The Best of Times or The Worst of Times?” The 2nd Annual Honorable Howard T. Markey Distinguished Lecture, John Marshall Law School, Chicago, Illinois, April 3, 2001.
- “Recent Developments in Patent Law (Other Than “Festo”!),” Silicon Valley Intellectual Property Association, Palo Alto, California, March 27, 2001.
- “35 USC §112, 6th Paragraph,” Stanford Law School Executive Education, Palo Alto, California, April 11, 2000.
- “Introduction to the ‘Written Description’ Requirement: An Historical and Public Policy Perspective,” American Bar Association Section of Intellectual Property Law, 15th Annual CLE Program, Washington D.C., April 3, 2000.
- “Recent Supreme Court and Federal Circuit Decisions on Patent Law: A Late 1999 Summer Refresher,” Silicon Valley Intellectual Property Law Association, San Jose, California, September 16, 1999.
- “Major Developments in Patent Law,” Morrison & Foerster Seminar, Osaka, Japan, June 2, 1999 and Tokyo, Japan, June 3, 1999.
- “Some Recent Developments and Pending Issues in Patent Law,” San Francisco Bay Area Intellectual Property Inn of Court and Santa Clara University School of Law Joint Meeting, Santa Clara, California, April 21, 1999.

"Patenting Business Methods after *State Street Bank*," Seminar, Santa Clara University High Tech Law Program, Santa Clara, California, March 26, 1999.

"The Supreme Court and Patent Law: Does Shallow Reasoning Lead to Thin Law?" The Second Annual Helen Wilson Nies Memorial Lecture, Marquette University Law School, Milwaukee, Wisconsin, March 16, 1999.

"Implications of the *State Street* Decision and its Impact on Business Processes," Winter Meeting Licensing Executives Society U. S. A. and Canada, Napa, California, March 13, 1999.

"Update on Patent Law," 23rd Annual Intellectual Property Institute, Intellectual Property Section of the State Bar of California, San Jose, California, November 7, 1998.

"Ownership Rights in Patents: Perils of Joint Ownership," San Francisco Bay Area Chapter Licensing Executives Society, Foster City, California, September 17, 1998.

"Territoriality in Intellectual Property: Lessons from Patent Law," 3rd LAWASIA Intellectual Property Conference & 10th Annual California International Law Weekend, San Francisco, California, July 30, 1998.

"Recent U. S. Patent Law Developments," European Patent Office, The Hague, Netherlands, March 19, 1998.

"The Scope of Protection in Patent Litigation," Dutch Group AIPPI, Amsterdam, Netherlands, March 18, 1998.

"Post Hilton-Davis: Importance of Prosecution History," Seminar, Santa Clara University School of Law High Tech Program, Santa Clara, California, January 28, 1998.

"The Patent and Trademark Office and the Public Interest," Seminar, Santa Clara University School of Law High Tech Program, Santa Clara, California, January 27, 1998.

"Recent Developments on Patent Disclosure Requirements," Peninsula Intellectual Property Law Association, San Jose, California, September 24, 1997.

"The Scope of Protection for Patents in the U.S. after *Warner-Jenkinson*," Seminar, Offices of the Bundesverband der Deutschen Industrie e.v., Cologne, Germany, June 13, 1997.

"The Scope of Protection for Patents in the U.S. after *Warner-Jenkinson*," Seminar, Federation of Swedish Industries, Stockholm, Sweden, June 11, 1997.

"The Scope of Protection for Patents in the U.S. after *Warner-Jenkinson*," Seminar, LES Switzerland, Zurich, Switzerland, June 10, 1997.

"The Scope of Protection for Patents in the U.S. after *Warner-Jenkinson*," Seminar, Dutch Group AIPPI, Utrecht, Netherlands, June 9, 1997.

"*Warner-Jenkinson* Decision," Seminar, Japan LES, Osaka, Japan, May 15, 1997.

"Recent Developments in Patent Law," Annual Seminar, San Francisco Intellectual Property Law Association, Wailea, Maui, Hawaii, May 9, 1997.

"Recent Federal Circuit Patent Cases," Spring Seminar, Orange County Patent Law Association and San Diego Intellectual Property Law Association, Borrego Springs, California, April 19, 1997.

"Patents—The Year in Review," 21st Annual Intellectual Property Institute, State Bar of California, San Jose, California, November 2, 1996.

"Judge Helen Nies and Patent Law," Peninsula Intellectual Property Law Association, Santa Clara, California, September 26, 1996.

"How Should Japanese Enterprises Survive in the Battlefield of Patent Disputes—American Perspective," International Symposium, Kyushu University, Fukuoka, Japan, September 13, 1996.

"Best Mode and Inequitable Conduct in U.S. Patent Law," Hitachi Corp. Legal and Patent Departments, Tokyo, Japan, September 10, 1996.

"The Doctrine of Equivalents and the Supreme Court's *Hilton-Davis* Chemical Decision," Tokyo District Court and Tokyo High Court, Tokyo, Japan, September 10, 1996.

"Doctrine of Equivalents," Institute for Intellectual Property (IIP), Tokyo, Japan, September 9, 1996.

"Best Mode and Inequitable Conduct," Seminar sponsored by Morrison & Foerster, Tokyo, Japan, September 9, 1996.

"Patent Law 'Trends' and Fundamentals: Case Studies on Obviousness, Claim Interpretation and Process Patent Protection," AIPPI Japan Group, Gotemba, Japan, September 7, 1996.

"The Federal Circuit and Judicial Review of Patent Office Decisions," Korean Patent Attorneys Association, Seoul, Korea, September 4, 1996.

"Selected Topics on U.S. Patent Law and Practice," Korean Industrial Property Office, Seoul, Korea, September 3, 1996.

"Patent Litigation and Jury Trials in the United States: Are Foreign Companies Unfairly Disadvantaged?" Graduate Intellectual Property Law Program, Yonsei University, Seoul, Korea, September 3, 1996.

"Patent Litigation and Jury Trials in the U.S.: Are Foreign Companies Unfairly Disadvantaged?" Judicial Research and Training Institute, Seoul, Korea, September 2, 1996.

"Case Studies on Patent Law: Obviousness, Claim Interpretation and Process Patent Protection," National Bureau of Standards, Ministry of Economic Affairs, Taipei, Taiwan, August 31, 1996.

"Patent Litigation and Jury Trials in the United States: Are Foreign Companies Unfairly Disadvantaged?" Law Department, National Taiwan University, Taipei, Taiwan, August 30, 1996.

"Case Studies on Patent: Obviousness, Claim Interpretation, and Process Patent Protection, Industrial Technology Research Institute, Chutung, Hsinchu, Taiwan, August 30, 1996.

"Patent Year in Review," Spring Seminar, Los Angeles Intellectual Property Law Association, Palm Desert, California, May 5, 1996.

"Patent Update," 1996 Annual Meeting, San Francisco Intellectual Property Law Association, Santa Cruz, California, April 27, 1996.

"A Tale of Two Cases: Sense and Nonsense in United States Patent Litigation," Japanese Institute of International Business Law, Inc., Tokyo, Japan, January 10, 1996.

"Intellectual Property Rights Enforcement in the United States: Juries, National Values, and International Economic Norms," Celebration for Osamu Takura, Tokyo, Japan, January 8, 1996.

"Allocation of Decisional Responsibility between Judge and Jury in Patent Trials," Second Annual Katz-Kiley Lecture, University of Houston Law Center, Houston, Texas, November 2, 1995.

- “Recent Developments in Patent Law,” 1995 Annual Meeting, American Intellectual Property Law Association, Washington, D.C., October 28, 1995.
- “1995 Patent Law Developments: An *En Banc* Year for the Federal Circuit: Infringement, Equivalents, Damages,” “Patent Litigation and Jury Trials after *Markman* and *Hilton-Davis*,” “Best Mode and Inequitable Conduct,”
- “Comparative Law - Patent Enforcement Globally,” Seminar sponsored by E.I. du Pont de Nemours and Company, Wilmington, Delaware, October 23, 1995.
- “Recent Developments in Intellectual Property Law,” Intellectual Property Law Section State Bar of Arizona, Tempe, Arizona, October 21, 1995
- “Patents - The Year in Review,” 20th Annual Intellectual Property Law Institute, State Bar of California, Pasadena, California, October 21, 1995.
- “The U. S. Patent System at a Major Crossroads - Or Not?” Licensing Executive Society, Paris, France, September 13, 1995, International Chamber of Commerce, London, United Kingdom, September 11, 1995.
- “The Scope for Intellectual Property Protection of Biotechnology,” 1995 Annual Meeting International Association for the Advancement of Teaching and Research in Intellectual Property, Seattle, Washington, July 20, 1995.
- “Patenting of Living Organisms, in Particular Human Genes,” 36th World Congress of the International Association for the Protection of Industrial Property, Montreal, Canada, June 27, 1995.
- “The Implications of *In re Deuel*,” Bay Area Bioscience Center, Millbrae, California, April 18, 1995.
- “What’s Driving IP Cases in the 1990’s?” Association of Business Trial Lawyers, Northern California, San Francisco, California, April 11, 1995.
- “GATT - The Details of the Patent Law Changes,” Washington State Patent Law Association, Seattle, Washington, January 12, 1995.
- “Introduction to the United States First-to-Invent System,” Japan Group AIPPI, Tokyo, Japan, November 17, 1994.
- “Implications of the 1994 GATT/TRIPS Agreement for World-Wide Harmonization of Intellectual Property Rights,” Seminar Sponsored by Tokio Marine and Fire Insurance Company, Limited, Tokyo, Japan, November 15, 1994.
- “Recent Developments in Intellectual Property Law and Practice,” 1994 Annual Meeting, American Intellectual Property Law Association, Washington D.C., October 29, 1994.
- “Patent Law Developments: Best Mode Concealment, Fraud, Willful Infringement and Other Bad Things,” “The Language of Obviousness: The ‘Suggestion’ Test and ‘Obvious-to-Try Ban,’” “Scope of Protection: The ‘New Basics’ of Enablement, Claim Interpretation, and Equivalency,” Seminar sponsored by E.I. du Pont de Nemours and Company, Wilmington, Delaware, October 24, 1994.
- “The Future of Intellectual Property Protection for Biotechnology,” 28th Annual Meeting, Society of Research Administrators, Seattle, Washington, October 17, 1994.
- “U.S. Patent Law: The Year in Review,” 19th Annual Intellectual Property Law Institute, State Bar of California, Rancho Mirage, California, October 15, 1994.
- “Determining Inventorship: When Was the Invention Made - and by Whom?” American Intellectual Property Law Association 1994 Chemical/Biotechnical Patent Law Practice Course, Cambridge, Massachusetts, September 23, 1994, Seattle, Washington, November 4, 1994.

- “Patents and Trademarks: The Year in Review,” Twelfth Annual Federal Circuit Judicial Conference, United States Court of Appeals for the Federal Circuit, Washington D.C., June 16, 1994, **published at 159 F.R.D. 59.**
- “Proprietary Rights in Genetic Resources, Private or Public?” The Hebrew University of Jerusalem, The Otto Warburg Center for Agricultural Biotechnology, Rehovot, Israel, March 20, 1994.
- “Scope of Protection of United States Patents: The In Banc *Hilton Davis Chemical* and *Pall Corporation* Cases,” Licensing Executives Society, Deutsche Landesgruppe e.V., Munich, Germany, March 16, 1994.
- “Recent Developments in Intellectual Property Law,” 38th Annual Conference on Developments in Intellectual Property Law, John Marshall Law School, Chicago, Illinois, February 25, 1994.
- “Major Trends in U.S. Patent Law on Patent Claim Scope and Claim Interpretation,” Kyoto Comparative Law Center, Kyoto, Japan, November 12, 1993.
- “Patentability of Software-Related Inventions,” Fourth International Symposium on Legal Protection of Computer Software, Software Information Center, Tokyo, Japan, November 10, 1993.
- “U.S. Patent Law: The Year in Review,” 18th Annual Intellectual Property Law Institute, State Bar of California, Carmel, California, November 5, 1993.
- “Patent Law Developments: A Sampler,” “Remedies for Patent Infringement,” “Doctrine of Equivalents and Prosecution History Estoppel: A 1993 Update,” “The ‘One World’ of Patents: Relation Between U.S. and Corresponding Foreign Patents During Prosecution, Licensing, and Enforcement,” “Megatrends in Patent Law: Ownership and Inventorship Problems: Will ‘Conceptions’ and ‘Reductions to Practice’ Live on After the Death of ‘First to Invent’ Priority?” Seminar sponsored by E.I. du Pont de Nemours and Company, Wilmington, Delaware, October 25, 1993.
- “Introduction to the First-to-Invent System,” Finnish National Group of AIPPI, Helsinki, Finland, September 29, 1993.
- “Conception, Constructive Reduction to Practice and Ownership; First to Invent Concepts in a First to File World,” Peninsula Intellectual Property Law Association, Palo Alto, California, September 22, 1993.
- “Intellectual Property Rights in an International Context,” International Commercial Law Seminar, University of Washington, School of Law, Seattle, Washington, August 20, 1993.
- “Current Developments in Patent Law,” 1993 Annual Meeting, Texas State Bar, Fort Worth, Texas, June 19, 1993.
- “Recent Developments in Patent Law,” 1993 Spring Seminar, Los Angeles Intellectual Property Law Association, Carlsbad, California, June 12, 1993.
- “Software Patents,” 10th Anniversary Pacific Rim Computer Law Institute, Seattle, Washington, June 4, 1993.
- “Recent Developments in Patent Law,” 1993 Spring Seminar, San Francisco Patent and Trademark Law Association, Monterey, California, May 8, 1993.
- “Developments in Patent Law,” 37th Annual Conference on Developments in Intellectual Property Law, John Marshall Law School, Chicago, Illinois, February 26, 1993.
- “Current Developments in Patent Law,” Practising Law Institute California MCLE Marathon Weekend, San Francisco, California, January 16, 1993 and Los Angeles, California, January 9, 1993.
- “Patent Law Developments,” 17th Annual Intellectual Property Law Institute, Intellectual Property Section, State Bar of California, Santa Barbara, California, November 6, 1992.

“Recent Patent Law Developments: Design Patents for Icons, Product-By-Process Claims, and The Advisory Commission's Reform Recommendations,” “Patent Claim Interpretation: A Primer and Some Examples,” “Willful Patent Infringement and The ‘Advice of Counsel’ Defense,” “Inequitable Conduct: A 1992 Update,” “Overcoming Obviousness Rejections in Chemical (And Other) Cases,” “Laches And Estoppel: Is there a Life After Aukerman?”, Seminar sponsored by E.I. du Pont de Nemours and Company Wilmington, Delaware, October 12, 1992.

“Recent Developments in Patent Law,” 1992 Annual Meeting, American Intellectual Property Law Association, September 18, 1992.

“Developments on Patent Infringement, Defenses, and Remedies, July 1, 1991 - June 30, 1992,” 1992 Patent, Copyright & Trademark Section, American Bar Association Annual Meeting, San Francisco, California, August 12, 1992.

“Recent Developments in Patent Law,” 1991 Annual Meeting, Texas State Bar, Houston, Texas, June 22, 1991.

“The Year in Review: Patent and Trademark Related Decisions of the Court of Appeals for the Federal Circuit,” The Ninth Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit, Washington, D.C., May 9, 1991, published at 140 F.R.D. 57.

“1990 Patent Law Developments: Patentability and Infringement Issues,” 1991 Spring Seminar, San Francisco Patent and Trademark Law Association, Napa Valley, California, May 4, 1991.

“Duty of Candor and Inequitable Conduct: An Historical Overview and Analysis of Two Recent Cases,” Seminar sponsored by Yushodo Co., Ltd., Tokyo, Japan, April 25, 1991.

“Basic Concepts of United States Patent Law & Practice,” Seminar sponsored by Yushodo Co., Ltd., Tokyo, Japan, April 24, 1991.

“International Patent Law Harmonization: Impact on Patent Infringement Litigation,” Harmonization of Trade and Investment Practices in the Asia-Pacific Regions, Inter-Pacific Bar Association, Tokyo, Japan, April 23, 1991.

“Developments in Patent Law,” 35th Annual Conference on Developments in Intellectual Property Law, The John Marshall Law School, Chicago, Illinois, February 22, 1991.

“International Patent Law Harmonization: Will the United States First-To-Invent System Survive?” Pacific Northwest Intellectual Property Forum, University of Victoria, Victoria, B.C., February 10, 1991.

“Intellectual Property Protection in the Next Decade: Developing Approaches to New Technologies,” American Bar Association Section of International Law and Practice Annual Fall Meeting, San Jose, California, December 7, 1990.

“Recent Developments in Patent Law,” 1990 Annual Meeting, California State Bar, Santa Barbara, California, November 2, 1990.

“The Obviousness Standard of Patentability: The Role of Unexpected New Properties”, “ ‘Putting Your Best Foot Forward’ The Best Mode Patent Disclosure Requirement: History, Policy, Interpretation and International Harmonization Aspects,” Seminar sponsored by E.I. du Pont de Nemours and Company, Wilmington, Delaware, October 15, 1990.

“Recent Developments In Patent Law,” 1990 Annual Meeting, American Intellectual Property Law Association, Washington, D.C., October 1990.

“Duty of Disclosure and Inequitable Conduct: Recent Federal Circuit Decisions,” 1990 Basic Computer and Electronic Practice Seminar, American Intellectual Property Law Association, Chicago, Illinois, September 14, 1990 and San Francisco, California, October 5, 1990.

- “The Year in Review: The Patent and Trademark Decisions of the Court of Appeals for the Federal Circuit,” The Eighth Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit, Washington, D.C., May 31, 1990, published at 133 F.R.D. 245.
- “Recent Developments in Patent Law,” Los Angeles Patent Law Association 1990 Spring Seminar, Indian Wells, California, May 13, 1990.
- “Recent Developments in Patent Law,” The San Francisco Patent and Trademark Law Association 1990 Annual Spring Seminar, Pebble Beach, California, May 5, 1990.
- “Recent Developments: Federal Circuit Decisions on the ‘On Sale’ Bar,” Intellectual Property Law 1990, State Bar of Texas, Intellectual Property Law Annual Institute, Austin, Texas, March 3, 1990.
- “Recent Developments in Patent Law,” 34th Annual Intellectual Property Law Conference, John Marshall Law School, Chicago, Illinois, February 23, 1990.
- “Recent Developments in Patent Law,” American Intellectual Property Law Association Annual Meeting, Arlington, Virginia, October 21, 1989.
- “Selected Issues in Patent Law,” Seminar Sponsored by E.I. du Pont de Nemours and Company, Wilmington, Delaware, October 17, 1989.
- “Survey of International Patent Protection,” Patent Protection for Computer Software Institute Sponsored by Prentice Hall Law & Business, San Francisco, California, September 25, 1989.
- “Recent Developments in Patent Law,” Intellectual Property Law Seminar, Cleveland Patent Law Association, Akron, Ohio, September 23, 1989.
- “The Year in Review: The Patent and Trademark Decisions of the Court of Appeals for the Federal Circuit,” The Seventh Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit, Washington, D.C., May 24, 1989, published at 128 F.R.D. 409.
- “Of Mice and Men: 199 Years of American Patent Law,” 39th Annual Jefferson Medal Award Presentation, Florham Park, New Jersey, May 12, 1989.
- “Recent Developments in Patent Law,” Los Angeles Patent Law Association Annual Meeting, Palm Springs, California, May 6, 1989.
- “Patent Law Harmonization: National Initiatives Likely to be Added for Implementation in the United States,” American Intellectual Property Law Association Spring Stated Meeting, Los Angeles, California, May 2, 1989.
- “Recent Legislative Developments in United States Patent, Trademark and Copyright Law,” Sponsored by the Max-Planck Institute for Patent, Copyright and Unfair Competition Law and the German Association for the Protection of Industrial Property and Copyright Law, at the European Patent Office, Munich, West Germany, April 27, 1989.
- “Recent Developments in Patent Law,” San Francisco Patent and Trademark Law Association Annual Meeting, Yosemite, California, April 1, 1989.
- “Developments Affecting Patentability and Infringement Issues,” 33rd Annual Intellectual Property Law Conference, John Marshall Law School, Chicago, Illinois, February 24, 1989.
- “Patents and Inventions: New Life Forms,” Conference on “Who Owns Knowledge?” University of Victoria, Victoria, British Columbia, Canada, February 11, 1989.

- “The Doctrine of Equivalents in Patent Law: Some Historical and Policy Perspectives on the Federal Circuit's *Pennwalt* Decision,” Rochester Patent Law Association Annual Meeting, Rochester, New York, November 4, 1988.
- “Recent Developments in Patent Law,” American Intellectual Property Law Association Annual Meeting, Arlington, Virginia, October 21, 1988.
- “Selected Issues in Patent Law,” Seminar sponsored by E.I. du Pont de Nemours and Company, Wilmington, Delaware, September 16, 1988.
- “Recent Developments in Patent Law,” 14th Annual Intellectual Property Law Workshop presented by The Institute of Continuing Legal Education and the Patent, Trademark and Copyright Law Section, State Bar of Michigan, Mackinac Island, Michigan, July 29, 1988.
- “Patent Protection for Software and Technology,” and “International Patent Protection Schemes for New Technologies: Worldwide Harmonization,” Fifth Annual Computer Law Institute, Seattle, Washington, June 3, 1988.
- “Major Court and Board of Appeals Decisions on Patent Protection for Biotechnology,” Prentice Hall Law & Business Fourth Annual Biotechnology Law Institute, San Francisco, California, June 2, 1988.
- “Recent Developments in Patent Law, 1987-1988,” San Francisco Patent and Trademark Law Association 1988 Annual Meeting, Lake Tahoe, Nevada, May 30, 1988.
- “The Doctrine of Equivalents in Patent Law: Some Historical and Policy Perspectives on the Federal Circuit's *Pennwalt* Decision,” Los Angeles Patent Law Association, La Costa, California, May 15, 1988.
- “Recent Developments in Patent Law,” 32nd Annual Intellectual Property Law Conference, John Marshall Law School, Chicago, Illinois, February 18, 1988.
- “Inequitable Conduct: Has the Federal Circuit Sensed the Groundswell of Concern?” Association of Corporate Patent Counsel, San Diego, California, January 25, 1988.
- “What Does Harmonization Mean: A Panel Discussion” Moderator, American Intellectual Property Law Association Annual Meeting, Washington, D.C., October 23, 1987.
- “International Harmonization of Patent Law,” Continuing Legal Education Lecture Series, United States Patent and Trademark Office, October 21, 1987.
- “Selected Issues in Patent Law,” Seminar sponsored by E.I. du Pont de Nemours and Company, Wilmington, Delaware, September 16, 1987.
- “Recent Developments in Patent Law,” 13th Annual Intellectual Property Law Workshop presented by The Institute of Continuing Legal Education and the Patent, Trademark and Copyright Law Section, State Bar of Michigan, Boyne Highlands, Michigan, July 24, 1987.
- “Recent Developments in Remedies for Patent Infringement,” Seminar presented by the Indiana Continuing Legal Education Forum and Patent, Trademark & Copyright Section of the Indiana State Bar Association, Indianapolis, Indiana, June 26, 1987.
- “Recent Decisions by the Federal Circuit on Inequitable Conduct,” Seminar presented by the Patent, Trademark and Copyright Law Sections of the Virginia State Bar, District of Columbia Bar and the Bar Association of the District of Columbia, Arlington, Virginia, June 4, 1987.
- “The Year in Review: The Patent and Trademark Decisions of the Court of Appeals for the Federal Circuit,” The Fifth Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit, Washington, D.C., May 8, 1987, published at 119 F.R.D. 45.

- “Recent Developments in Patent Law,” San Francisco Patent and Trademark Law Association, 19th Annual Seminar, Maui, Hawaii, May 5, 1987.
- “The Patent-Related Decisions and the Trademark-Related Decisions of the Court of Appeals for the Federal Circuit,” Federal Circuit Bar Association, Intellectual Property Breakout Session, Phoenix, Arizona, April 27, 1987.
- “Recent Developments in Patent Law,” 1987 Spring Seminar, Orange County Patent Law Association, Rancho Santa Fe, California, April 11, 1987.
- “Recent Developments in Patent Law,” 31st Annual Intellectual Property Law Conference, John Marshall Law School, Chicago, Illinois, February 19, 1987.
- “Deliberate and Willful Infringement of Intellectual Property Rights,” State Bar of Texas, Professional Development Program in Intellectual Property Law, San Antonio, Texas, February 14, 1987.
- “Patent Law and the Presumption of Moral Regularity: A Critical Review of Recent Federal Circuit Decisions on Inequitable Conduct and Willful Infringement,” Meeting of the Patent, Trademark and Copyright Section of the Bar Association of Metropolitan St. Louis, St. Louis, Missouri, October 21, 1986.
- “Recent Developments in Patent Law,” American Intellectual Property Law Association Annual Meeting, Arlington, Virginia, October 9, 1986, published in Selected Legal Papers, Vol. 4 No. 2 at 1 (AIPLA 1986).
- “The Patentability Requirement of Nonobviousness: ‘Secondary’ Considerations,” “Inequitable Conduct in Patent Procurement: A Problem and Some Recent Cases,” “Claim Interpretation and Prosecution History Estoppel: Recent Decisions of the Court of Appeals for the Federal Circuit,” Seminar sponsored by E.I. du Pont de Nemours and Company, Wilmington, Delaware, September 25, 1986.
- “Recent Developments in Patent Law,” 12th Annual Intellectual Property Law Workshop, Michigan Institute of Continuing Legal Education, Grand Traverse, Michigan, July 18, 1986.
- “Strategies for Protecting Intellectual Properties,” Panel Discussion, Society of University Patent Administrators, Seattle, Washington, June 25, 1986.
- “Semi-Conductor Chip Protection Act: Who is Filing on What; Countries with Reciprocal Laws,” Pacific Rim Computer Law Institute, Seattle, Washington, June 26, 1986.
- “International Protection of Intellectual Property,” Colloquium sponsored by the University of Washington Law, Science and Technology Society, Seattle, Washington, May 22, 1986.
- “Two Big Events in Patent Law,” San Francisco Patent & Trademark Law Association 18th Annual Seminar, Pebble Beach, California, May 10, 1986.
- “Recent Developments in Patent Law,” Joint Seminar of the Washington State Patent Law Association and Oregon Patent Law Association, Union, Washington, April 12, 1986.
- Panel Discussion: “Tensions in Government Policy: Patents, Antitrust, Taxes, and New Technologies,” Stanford Law and Technology Association, Stanford, California, April 11, 1986.
- “The Patentability of Algorithms,” The Future of Software Protection Symposium at the University of Pittsburgh School of Law, Pittsburgh, Pennsylvania, April 4, 1986.
- “Recent Developments in Patent Law,” 30th Annual Intellectual Property Law Conference, John Marshall Law School, Chicago, Illinois, February 20, 1986.

- “Five Major Trends in Patent Law,” United States Patent and Trademark Office, Patent Academy, Washington, D.C., January 30, 1986.
- “Computers and the Law,” Industrial Technology Research Institute, Hsinchu, Taiwan, Republic of China, November 14, 1985.
- “The Semiconductor Chip Protection Act of 1984,” National Taiwan University, College of Law, Department of Law, Taipei, Taiwan, Republic of China, November 12, 1985.
- “The Semiconductor Chip Protection Act of 1984,” Yotsuya, Tokyo, Japan, November 7, 1985.
- “Prior Art and the Patent Law Amendments Act of 1984,” Japan Group AIPPI, Tokyo, Japan, November 6, 1985.
- “Recent Developments in Patent Law,” Michigan Institute of Continuing Education, Mackinac Island, Michigan, August 2, 1985.
- “The Semiconductor Chip Protection Act,” Washington State Bar Association, Pacific Rim Computer Law Institute, Seattle, Washington, June 20, 1985.
- “The Year in Review: The Patent and Trademark Decisions of the Court of Appeals for the Federal Circuit,” The Third Annual Judicial Conference of the Court of Appeals for the Federal Circuit, Washington, D.C., May 17, 1985, published at 108 F.R.D. 465.
- “Recent Developments in Patent Law,” 29th Annual Conference on Intellectual Property Law, John Marshall Law School, Chicago, Illinois, February 21, 1985.
- “Functionality and the Problem of Election of Copyright, Patent, Trademark and Trade Secret Protection: Implications for Practice, Scholarship and Teaching,” Annual Meeting, Association of American Law Schools, Section on Intellectual Property, Washington, D.C., January 6, 1985.
- “Recent Developments in Patent Law,” American Intellectual Property Law Association, Annual Convention, Arlington, Virginia, October 26, 1984.
- “Recent Developments in Intellectual Property Law: Patents,” Annual Meeting, State Bar of California, Patent, Trademark and Copyright Section, Carmel, California, September 21, 1984.
- “The Year in Review: The Patent and Trademark Decisions of the Court of Appeals for the Federal Circuit,” The Second Annual Judicial Conference of the Court of Appeals for the Federal Circuit, Washington, D.C., April 26, 1984, published at 104 F.R.D. 207.
- “Advice of Counsel on Patent Matters - Impact on the Measure of Damages in Patent Litigation,” Peninsula Patent Law Association, Palo Alto, California, April 19, 1984.
- “Recent Developments in Patent Law,” 28th Annual Conference on Intellectual Property Law, John Marshall Law School, Chicago, Illinois, February 23-24, 1984.
- “Definition of a ‘Franchise’ and Other Coverage Problems under State and Federal Franchise Regulation Schemes,” University of Washington Continuing Legal Education Program, Seattle, Washington, November 12, 1983.
- “A Review of the Early Patent Decisions of the Federal Circuit,” Joint Seminar of the Washington State Patent Law Association and Oregon Patent Law Association, Port Ludlow, Washington, June 3, 1983.
- “Copyrightability of Computer Software,” Copyright Law Society of Japan, April 6, 1983.

“Recent Developments in United States Patent Law,” Ohtemachie Keidanren Convention Hall, Tokyo, Japan, April 6, 1983; Korean Patent Office, April 15, 1983.

“Revival of the United States Patent System,” Institute of International Business Law, Tokyo, Japan, April 4-5, 1983; Osaka, Japan; Korea Traders Association, Seoul, Korea, April 13, 1983.

“Introduction to Computers: History, Terminology, and Effect on the Law Office,” Computer Seminar for Legal Secretaries and Paralegals, Seattle, Washington, March 12, 1983.

“Recent Developments in Patent Law,” 27th Annual Conference on Intellectual Property Law, John Marshall Law School, Chicago, Illinois, February 17-18, 1983.

“Patent Protection for Computer-Related Inventions,” University of Washington Continuing Legal Education Program, Seattle, Washington, February 12, 1983.

EXPERT TESTIMONY

Estate of Paxton v. Commissioner of Internal Revenue, United States, United States Tax Court, T. C. Memo. 1982-464 (construction of patent claims, relation of one patent as improvement of another patent).

Franklyn v. Guilford Packing Co., United States District Court, Western District of Washington, Civil No. C75-215S, Findings and Conclusions entered May 5, 1981 (construction of patent claims, application of nonobviousness standard to prior art patents).

Microcomputer Sys. Corp. v. Digital Equip. Corp., United States District Court, Northern District of California, Civil Action No. C79 0072 RHS, Trial: February 1982 (construction of patent claims, standard of clarity of claims, use of undisclosed advantages to support patentability, disclosure of best mode, on sale statutory bar and experimental use exception).

In re Certain CT Scanner and Gamma Camera Medical Diagnostic Imaging Apparatus, U.S. International Trade Commission; Trial Testimony: December 27, 1982 (construction of claims, infringement, prior use as prior art, date of conception and reduction to practice).

Allen Archery, Inc. v. Browning Mfg. Co., United States District Court, District of Utah; Trial Testimony: January 15, 1985 (definiteness and support for claim language, patenting procedures).

American Hospital Supply v. Extracorporeal Medical Specialties, Inc., United States District Court, Central District of California; Jury Trial; Trial Testimony: February 7, 1985 (construction of claims, infringement, protested reissue proceedings).

Coherent Radiation v. Spectra-Physics, United States District Court, Northern District of California; Jury Trial; Trial Testimony: February 19, 1985 (abandonment, suppression and concealment, prior invention, reduction to practice).

Applied Cardiac Electrophysiology v. Cardiac Pacemakers, Inc., United States District Court, Central District of California; Jury Trial; Trial Testimony: April 12, 1985 (abandonment of an invention, abandonment of a patent application, inequitable conduct).

In re Certain Double-Sided Floppy Disk Drives and Components Thereof, U.S. International Trade Commission, Inv. No. 337-TA-215; Trial Testimony: August 26, 1985 (prosecution history estoppel, doctrine of equivalents, scope of Jepson claims).

Mainland Industries, Inc. v. Standal's Patents, Ltd., United States District Court, District of Oregon; Jury Trial; Trial Testimony: September 19, 1985 (prosecution history estoppel, divisional applications, inequitable conduct).

Verdegaal Brothers, Inc. v. Standard Oil Company of California, United States District Court, Eastern District of California; Jury Trial; Trial Testimony: January 9, 1986 (prosecution history, scope of examiner's interference search).

Weldon P. Taquino v. Teledyne Monarch Rubber, United States District Court, Western District of Louisiana; Trial Testimony: June 13 and 23, 1986 (obviousness, literal infringement, doctrine of equivalents).

NAPP Systems (USA), Inc. v. BASF Akteingesellschaft, United States District Court, Southern District of California; Jury Trial; Trial Testimony: October 28, 1986 (prosecution history estoppel, construction of claims, Rule 132 declarations, duty of candor, new matter in amendment of specification).

BenchCraft, Inc. et al. v. Broyhill Furniture Industries, Inc., United States District Court, Northern District of Mississippi; Trial Testimony: October 6 and 16, 1987 (design patents, inequitable conduct).

National Gypsum Company v. Steel Systems International, Inc. and William Knorr, United States District Court, District of Oregon; Jury Trial; Trial Testimony: January 14, 1988 (prosecution history, claim construction, presumption of validity, interference procedures, copying of claims for interference purposes).

Ronald P. Jensen, M.D. v. Iolab Corporation, et al., United States District Court, Central District of California; Trial Testimony: March 4, 1988 (doctrine of equivalents, prosecution history estoppel, obviousness).

Dr. Jerre M. Freeman v. Minnesota Mining and Manufacturing Company, United States District Court, District of Delaware; Trial Testimony: March 15, 1988 (reissue, recapture, claim interpretation, operability, anticipation, obviousness).

Paramount Packaging Corporation v. Cello Bag Co., Inc., United States District Court, Western District of Washington; Trial Testimony: August 22 & 25, 1988 (doctrine of equivalents, claim interpretation, on sale bar, prosecution history estoppel, inequitable conduct).

Rohm and Haas Company v. Mobil Oil Corporation, United States District Court, District of Delaware; Trial Testimony: October 27, 1988 (double patenting, terminal disclaimers).

Minnesota Mining & Manufacturing Co. v. Quest Medical, Inc., United States District Court, Northern District of Texas; Trial Testimony: December 8 & 9, 1988 (claim interpretation, prosecution history estoppel, means plus function limitations, doctrine of equivalents).

Hesston Corporation v. Don L. Sloop and Massey-Ferguson, Inc., United States District Court, District of Kansas; Trial Testimony: October 11, 1989 (continuation applications, description requirement, support for claims).

Genentech v. The Wellcome Foundation, United States District Court, District of Delaware; Jury Trial; Trial Testimony: April 3, 1990 (prosecution history, inequitable conduct, best mode).

Black and Decker v. The Hoover Company, United States District Court, District of Connecticut, Trial Testimony: October 1, 1990 (claim interpretation, anticipation).

General Foods Corporation v. Studiengesellschaft Kohle mbH, United States District Court Southern District of New York, Trial Testimony: May 20 & 21, 1991 (double patenting).

Golden Valley Microwave Foods v. Weaver Popcorn Company, United States District Court Northern District of Indiana, Trial Testimony: February 3, 1992 (inequitable conduct).

United States Surgical Corp. v. Ethicon Endo Surgery and Johnson & Johnson, United States District Court, District of Connecticut, Trial Testimony: June 30, 1995 (inventorship correction, inequitable conduct).

Powertex Inc. v. Internal Revenue Service, United States Tax Court, Trial Testimony: February 25, 1997 (patent ownership, shop rights).

The Wellcome Foundation, Glaxo Group Ltd and SmithKline Beecham Corporation v. Abbott Biotechnology Ltd and Abbott Laboratories, UK High Court of Justice, Chancery Division, Patents Court, Trial Testimony: May 1 & 5, 2009 (reissue, continuation applications, claim construction and prosecution disclaimer).

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