

SYLLABUS

CHISUM PATENT ACADEMY®

Intensive Patent Law Training Seminar
February 22-24, 2012
New York, NY

Instructors: Donald S. Chisum and Janice M. Mueller

Session	Topics	Background Reading in Mueller, <i>Patent Law, Third Edition</i> (Aspen 2009)	Materials/Representative Cases for Discussion
<p>Wednesday, February 22, 2012</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p>	<p>America Invents Act of 2011 (Part I):</p> <ul style="list-style-type: none">First Inventor to File;Inventor's Oath;Assignee Filing;Prior User Rights	<p>N/A</p>	<p>Donald S. Chisum, <i>Analysis and Impact of the America Invents Act of 2011: Discussion and Cross-References</i>, §§ 1-5.</p>

<p>Wednesday, February 22, 2012</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p>	<p>Patent-Eligible Subject Matter</p>	<p>Chapter 7 (“Potentially Patentable Subject Matter”).</p>	<p><i>Bilski v. Kappos</i>, 130 S. Ct. 3218 (2010) (intangible processes and business methods);</p> <p><i>Research Corp. Techs., Inc. v. Microsoft Corp.</i>, 627 F.3d 859 (Fed. Cir. 2010) (narrow interpretation of <i>Bilski</i> and “abstract ideas”);</p> <p><i>Prometheus Lab., Inc. v. Mayo Collaborative Serv.</i>, 628 F.3d 1347 (Fed. Cir. 2010) (medical diagnostic methods), <i>cert. granted</i>, 131 S. Ct. 3027 (June 20, 2011);</p> <p><i>CyberSource Corp. v. Retail Decisions</i>, 654 F.3d 1366 (Fed. Cir. 2011);</p> <p><i>Ultramercial v. Hulu</i>, 657 F.3d 1323 (Fed. Cir. 2011);</p> <p><i>Dealertrack, Inc. v. Huber</i>, ___ F.3d ___, 2012 WL 164439 (Fed. Cir. Jan. 20, 2012);</p> <p>Donald S. Chisum, <i>Analysis and Impact of the America Invents Act of 2011: Discussion and Cross-References</i>, §§ 14 (tax strategies), 18 (transitional program for business method patents), 33 (human organism patents).</p>
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<p>Thursday, February 23, 2012</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p>	<p>America Invents Act of 2011 (Part II):</p> <p>Post-Grant Review</p> <p><i>Inter Partes</i> Review</p> <p>Third-Party Submissions</p> <p>Supplemental Examination</p> <p>Best Mode</p> <p>Marking</p> <p>Advice of Counsel</p> <p>Jurisdiction and Procedural Matters</p>	<p>N/A</p>	<p>Donald S. Chisum, <i>Analysis and Impact of the America Invents Act of 2011: Discussion and Cross-References</i>, §§ 6-33.</p>
<p>Thursday, February 23, 2012</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p>	<p>Non-Obviousness in the Post- KSR Era</p>	<p>Chapter 5 (“The Nonobviousness Requirement of 35 U.S.C. § 103”).</p>	<p><i>KSR Int’l Co. v. Teleflex Inc.</i>, 550 U.S. 398 (2007) (modern restatement on nonobviousness);</p> <p><i>Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.</i>, 617 F.3d 1296 (Fed. Cir. 2010);</p> <p><i>In re Kao</i>, 639 F.3d 1057 (Fed. Cir. 2011) (<i>prima facie</i> case; nexus requirement for</p>

			<p>secondary considerations evidence);</p> <p><i>In re Klein</i>, 647 F.3d 1343 (Fed. Cir. 2011) (analogous art);</p> <p><i>Genetics Inst. v. Novartis Vaccines</i>, 655 F.3d 1291 (Fed. Cir. 2011);</p> <p><i>Innovention Toys, LLC v. MGA Entertainment, Inc.</i>, 637 F.2d 1314 (Fed. Cir. 2011).</p>
<p>Friday, February 24, 2012</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p>	<p>Anatomy of a Patent Case: <i>i4i v. Microsoft</i></p> <p>Claim interpretation</p> <p>Anticipation (on sale bar)</p> <p>Direct and Indirect Infringement</p> <p>Willful Infringement</p> <p>Damages</p> <p>Permanent Injunction</p> <p>Burden of Proof to Invalidate</p>	<p>Chapter 9 (“Patent Enforcement);</p> <p>Chapter 10 (“Defenses”);</p> <p>Chapter 11 (“Remedies”).</p>	<p><i>I4i Ltd. P’ship v. Microsoft Corp.</i>, 598 F.3d 831 (Fed. Cir. 2010), <i>aff’d sub nom. Microsoft Corp. v. i4i Ltd. P’ship</i>, 131 S. Ct. 2238 (June 9, 2011).</p>

