SYLLABUS



## 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
Wednesday, February 22, 2012 Morning Session 9:00 am – 12:00 pm	America Invents Act of 2011 (Part I): First Inventor to File; Inventor's Oath; Assignee Filing; Prior User Rights	N/A	Donald S. Chisum, <i>Analysis and Impact of the</i> <i>America Invents Act of 2011:</i> <i>Discussion and Cross-References</i> , §§ 1-5.

Wednesday, February 22, 2012 Afternoon	Patent-Eligible Subject Matter	Chapter 7 ("Potentially Patentable Subject Matter").	<i>Bilski v. Kappos</i> , 130 S. Ct. 3218 (2010) (intangible processes and business methods); <i>Research Corp. Techs., Inc. v. Microsoft Corp.</i> , 627 F.3d 859 (Fed. Cir. 2010) (narrow
Session			interpretation of <i>Bilski</i> and "abstract ideas");
1:00 pm – 4:00 pm			Prometheus Lab., Inc. v. Mayo Collaborative Serv., 628 F.3d 1347 (Fed. Cir. 2010) (medical diagnostic methods), cert. granted, 131 S. Ct. 3027 (June 20, 2011);
			<i>CyberSource Corp. v. Retail Decisions</i> , 654 F.3d 1366 (Fed. Cir. 2011);
			<i>Ultramercial v. Hulu</i> , 657 F.3d 1323 (Fed. Cir. 2011);
			<i>Dealertrack, Inc. v. Huber</i> , F.3d, 2012 WL 164439 (Fed. Cir. Jan. 20, 2012);
			Donald S. Chisum, <i>Analysis and Impact of the</i> <i>America Invents Act of 2011:</i> <i>Discussion and Cross-References</i> , §§ 14 (tax strategies), 18 (transitional program for business method patents), 33 (human organism patents).

Thursday, February 23, 2012 Morning Session 9:00 am – 12:00 pm	America Invents Act of 2011 (Part II):Post-Grant ReviewInter Partes ReviewThird-Party SubmissionsSupplemental ExaminationBest ModeMarkingAdvice of CounselJurisdiction and Procedural Matters	N/A	Donald S. Chisum, Analysis and Impact of the America Invents Act of 2011: Discussion and Cross-References, §§ 6-33.
Thursday, February 23, 2012 Afternoon Session 1:00 pm – 4:00 pm	Non-Obviousness in the Post- <i>KSR</i> Era	Chapter 5 ("The Nonobviousness Requirement of 35 U.S.C. § 103").	KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007) (modern restatement on nonobviousness); <i>Transocean Offshore Deepwater Drilling, Inc. v.</i> <i>Maersk Contractors USA, Inc.</i> , 617 F.3d 1296 (Fed. Cir. 2010); <i>In re Kao</i> , 639 F.3d 1057 (Fed. Cir. 2011) ( <i>prima facie</i> case; nexus requirement for

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

Friday, February 24, 2012 Afternoon Session 1:00 pm – 4:00 pm	1) Patent Claim Interpretation: The Ongoing Schism (two hours)	Pp. 331-349	<ul> <li>Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc);</li> <li>Arlington Indus., Inc. v. Bridgeport Fittings, Inc., 632 F.3d 1246 (Fed. Cir. 2011);</li> <li>Retractable Techs., Inc. v. Becton, Dickinson and Co., 653 F.3d 1296 (Fed. Cir. 2011) (panel opinion);</li> <li>Id., 659 F.3d 1369 (Fed. Cir. 2011) (denying petition for rehearing en banc; dissenting opinions by Moore, J., and O'Malley, J.).</li> </ul>
	2) Attorney Ethics (one hour) Duty of Candor to USPTO; Inequitable Conduct Defense post- <i>Therasense</i>	Pp. 431-442.	<i>Therasense, Inc. v. Becton, Dickinson and Co.,</i> 649 F.3d 1276 (Fed. Cir. 2011) ( <i>en banc</i> ) (inequitable conduct); <i>Powell v. Home Depot U.S.A., Inc.,</i> 663 F.3d 1221 (Fed. Cir. 2011) (failure to update Petition to Make Special not "affirmative egregious misconduct").