

Patent Law

Prof. Roger Ford
August 29, 2016
Class 1: Introduction

Today's agenda

- Administrative notes
- Intro to the patent system
- Mechanics and institutions of the patent system
- Architecture of the patent document

Administrative notes

Administrative notes

- Class meetings
- Make-up classes
- Reading assignments
- Grading
- Patent cases and technology

Intro to the patent system

Intro to the patent system

→ 35 U.S.C. § 101:

- “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

Intro to the patent system

- Limited property rights
 - Negative rights: right to exclude
 - Positive rights: right to sell/license
 - No positive right to practice

Intro to the patent system

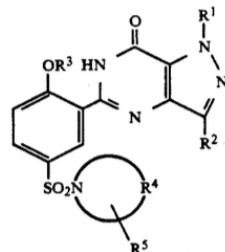
- Group question:
 - What are some reasons a patent holder would not have the right to practice her invention?

Sildenafil citrate

Claim 1 of U.S.
patent 5,250,534

We claim:

1. A compound of the formula:



wherein

R¹ is H, C₁-C₃ alkyl, C₃-C₅ cycloalkyl or C₁-C₃ perfluoroalkyl;

R² is H, C₁-C₆ alkyl optionally substituted by OH, C₁-C₃ alkoxy or C₃-C₆ cycloalkyl, or C₁-C₃ perfluoroalkyl;

R³ is C₁-C₆ alkyl, C₃-C₆ alkenyl, C₃-C₆ alkynyl, C₃-C₇ cycloalkyl, C₁-C₆ perfluoroalkyl or (C₃-C₆ cycloalkyl)C₁-C₆ alkyl;

R⁴ taken together with the nitrogen atom to which it is attached completes a 4-N-(R⁶)-piperazinyl group;

R⁵ is H, C₁-C₄ alkyl, C₁-C₃ alkoxy, NR⁷R⁸, or CONR⁷R⁸;

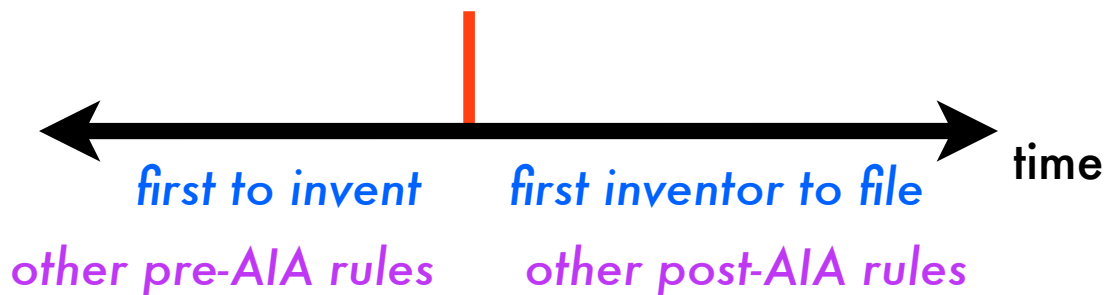
R⁶ is H, C₁-C₆ alkyl, (C₁-C₃ alkoxy) C₂-C₆ alkyl hydroxy C₂-C₆ alkyl, (R⁷R⁸N)C₂-C₆ alkyl, (R⁷R⁸NCO)C₁-C₆ alkyl, CONR⁷R⁸, CSNR⁷R⁸ or C(NH)NR⁷R⁸;

R⁷ and R⁸ are each independently H, C₁-C₄ alkyl, (C₁-C₃ alkoxy)C₂-C₄ alkyl or hydroxy C₂-C₄ alkyl; and

pharmaceutically acceptable salts thereof.

Intro to the patent system

March 16, 2013



Intro to the patent system

→ Group questions:

- What are the advantages and disadvantages of a first-to-invent system?
- What are the advantages and disadvantages of a first-to-file system?
- Why do you think the US switched?

Intro to the patent system

→ U.S. Constitution:

- [Congress has the power] “To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and inventions.”

Intro to the patent system

→ What does the inventor get?

Intro to the patent system

→ What does the inventor get?

- Monopoly profits / exclusivity
 - * *Ex ante* incentive to invent
 - * *Ex post* incentive to develop

→ What does society get?

Intro to the patent system

→ What does the inventor get?

- Monopoly profits / exclusivity
 - * *Ex ante* incentive to invent
 - * *Ex post* incentive to develop

→ What does society get?

- Public disclosure → knowledge can be used by others

Intro to the patent system

→ What's the downside of patents?

Intro to the patent system

→ What's the downside of patents?

- Monopoly pricing
 - * Goods become more expensive
 - * Output falls

Intro to the patent system

→ What's the downside of patents?

- Monopoly pricing
 - * Goods become more expensive
 - * Output falls

→ Balancing the tradeoff

- Limited patent term
- Limited patent rights?

Patent mechanics and institutions

Patent mechanics and institutions

- Obtaining a patent
 - Patent and Trademark Office (PTO)
- Enforcing patent rights
 - Federal courts

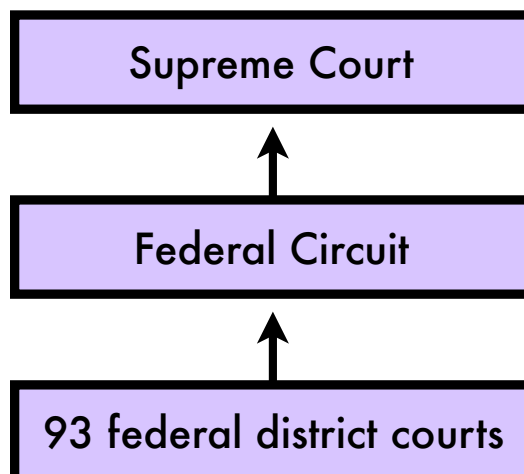
Patent mechanics and institutions

→ PTO

- Examination-based
- Negotiation creates [prosecution history](#)
- Appeals to PTAB and then Federal Circuit
- Or, you can bring a claim in federal district court

Patent mechanics and institutions

→ Courts



Patent mechanics and institutions

- International Trade Commission (ITC)
 - Very popular venue for electronics cases
 - Remedy: blocking imports of accused products
 - Cannot award money damages

Architecture of the patent document

United States Patent [19]
Coffin, Sr.

[11] Patent Number: 5,205,473
[45] Date of Patent: Apr. 27, 1993

[54] RECYCLABLE CORRUGATED BEVERAGE
CONTAINER AND HOLDER

[75] Inventor: David W. Coffin, Sr., Fayetteville,
N.Y.

[73] Assignee: Design By Us Company,
Philadelphia, Pa.

[21] Appl. No.: 854,425

[22] Filed: Mar. 19, 1992

[51] Int. Cl.⁵ B65D 3/28

[52] U.S. Cl. 229/1.5 B; 206/813;
220/441; 220/DIG. 30; 229/1.5 H; 229/DIG.
2; 493/296; 493/907

[58] Field of Search 229/1.5 B, 1.5 H, 4.5,
229/DIG. 2; 220/441, 671, 737-739, DIG. 30;
493/287, 296, 907, 908; 209/8, 47, 215; 206/813

[56] References Cited

U.S. PATENT DOCUMENTS
1,732,322 10/1929 Wilson et al. 220/DIG. 30
1,771,765 7/1930 Benson 229/4.5
2,266,829 12/1941 Sykes 229/1.5 B
2,300,473 11/1942 Winkle 229/4.5
2,501,815 3/1950 Hamm
2,617,549 11/1952 Eager
2,641,402 6/1953 Brown 229/4.5

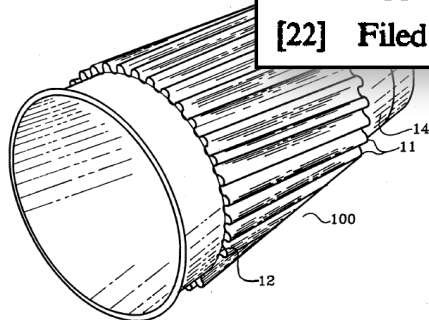
[54] RECYCLABLE CORRUGATED BEVERAGE
CONTAINER AND HOLDER

[75] Inventor: David W. Coffin, Sr., Fayetteville,
N.Y.

[73] Assignee: Design By Us Company,
Philadelphia, Pa.

[21] Appl. No.: 854,425

[22] Filed: Mar. 19, 1992



United States Patent [19]
Coffin, Sr.

[11] Patent Number: 5,205,473
[45] Date of Patent: Apr. 27, 1993

[54] RECYCLABLE CORRUGATED BEVERAGE
CONTAINER AND HOLDER

[75] Inventor: David W. Coffin, Sr., Fayetteville,
N.Y.

[73] Assignee: Design By Us Company,
Philadelphia, Pa.

[21] Appl. No.: 854,425

[22] Filed: Mar. 19, 1992

[51] Int. Cl.⁵ B65D 3/28

[52] U.S. Cl. 229/1.5 B; 206/813;
220/441; 220/DIG. 30; 229/1.5 H; 229/DIG.
2; 493/296; 493/907

[58] Field of Search 229/1.5 B, 1.5 H, 4.5,
229/DIG. 2; 220/441, 671, 737-739, DIG. 30;
493/287, 296, 907, 908; 209/8, 47, 215; 206/813

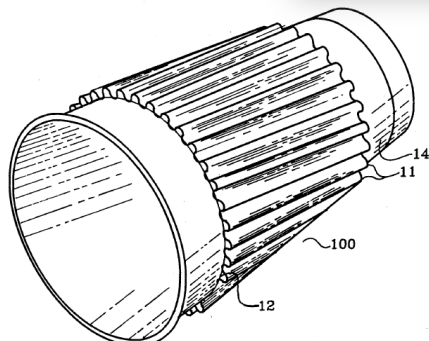
[56] References Cited

U.S. PATENT DOCUMENTS
1,732,322 10/1929 Wilson et al. 220/DIG. 30
1,771,765 7/1930 Benson 229/4.5
2,266,829 12/1941 Sykes 229/1.5 B
2,300,473 11/1942 Winkle 229/4.5
2,501,815 3/1950 Hamm
2,617,549 11/1952 Eager
2,641,402 6/1953 Brown 229/4.5

[51] Int. Cl.⁵ B65D 3/28

[52] U.S. Cl. 229/1.5 B; 206/813;
220/441; 220/DIG. 30; 229/1.5 H; 229/DIG.
2; 493/296; 493/907

[58] Field of Search 229/1.5 B, 1.5 H, 4.5,
229/DIG. 2; 220/441, 671, 737-739, DIG. 30;
493/287, 296, 907, 908; 209/8, 47, 215; 206/813



Next time

→ Claim drafting