

University of Victoria
PATENT LAW 366
 Manson/Ferance

Syllabus and Reading List

SEPTEMBER – DECEMBER 2009

FRIDAY: 10AM-12PM

Students are expected to review cases prior to each class. Although students are expected to carefully (except when indicated otherwise) review all the readings and materials referred to below, the examination will only cover materials discussed in class.

Evaluation: 100% final examination.

Course website: <http://www.law.uvic.ca/manson/366/index.html>

Date	Subject	Readings / Materials	Lecturer
Sept 11	Introduction	PowerPoint Presentation on IP & Patents	MDM
Sept 18	Claim Construction; Infringement; Remedies	Handout <i>Whirlpool Corp. v. Camco Inc.</i> (2000), 9 C.P.R. (4 th) 129, 2000 SCC 67. <i>Free World Trust v. Électro Santé Inc.</i> (2000), 9 C.P.R. (4 th) 168, [2000] S.C.J. No. 67, 2 S.C.R. 1024. <i>Monsanto Canada Inc. v. Schmeiser</i> (2004), 31 C.P.R. (4 th) 161, [2004] S.C.J. No. 29, 1 S.C.R. 902. <i>Patent Act</i> : sections 8, 32, 42, 43 to 48.5, 53 to 63	MDM
Sept 25	Exercise on Infringement	Handouts	MDM
Oct 2	Validity: Historical	Handout <i>Patent Act</i> , s. 2 (“invention”), s. 27(4), s.27(8).	SJF

Date	Subject	Readings / Materials	Lecturer
	Background; Statutory Subject-Matter Part I	<p>H. G. Fox, <i>Canadian Patent Law and Practice</i> (4th ed.) (Toronto: Carswell, 1969) at 15-16.</p> <p><i>Lawson v. Commissioner of Patents</i> (1970), 62 C.P.R. 101 (Ex. Ct.).</p> <p><i>Tennessee Eastman Co. v. Commissioner of Patents</i> (1972), 8 C.P.R. (2d) 202, [1974] S.C.R. 111, 33 D.L.R. (3d) 459 (S.C.C.).</p>	
Oct 9	Validity: Statutory Subject-Matter Part II	<p><i>Shell Oil Co. v. Commissioner of Patents</i> (1982), 67 C.P.R. (2d) 1 (S.C.C.).</p> <p><i>Progressive Games v. Commissioner of Patents</i> (1999), 3 C.P.R. (4th) 517, [1999] F.C.J. No. 1623 (F.C.T.D.).</p> <p><i>Progressive Games v. Commissioner of Patents</i> (2000), 9 C.P.R. (4th) 479, [2000] F.C.J. No. 1829 (F.C.A.).</p> <p><i>Harvard College v. Canada (Commissioner of Patents)</i> (2002), 21 C.P.R. (4th) 417, [2002] S.C.J. No. 77, 4 S.C.R. 45, 219 D.L.R. (4th) 577 (S.C.C.) [Majority Opinion Only (Dissent Optional)].</p> <p><i>Monsanto Canada Inc. v. Schmeiser</i> (2004), 31 C.P.R. (4th) 161, [2004] S.C.J. No. 29, 1 S.C.R. 902, 239 D.L.R. (4th) 271 (S.C.C.) [Majority Opinion Only (Dissent Optional)].</p> <p><i>Merrell Dow Pharmaceuticals Inc. v. H.N. Norton & Co. Ltd.</i>, [1996] R.P.C. 76 (H.L.) [Page 88 only].</p>	SJF
Oct 16	Validity: Novelty & Obviousness	<p><i>Canwell Enviro-Industries Ltd. v. Baker Petrolite Corp.</i> (2002), 17 C.P.R. (4th) 478, 2002 FCA 158 (F.C.A.).</p> <p><i>Sanofi-Synthelabo Canada Inc. v. Apotex Inc.</i> (2008), 69 C.P.R. (4th) 251 (S.C.C.).</p> <p><i>Whirlpool Corp. v. Camco Inc.</i> (2000), 9 C.P.R. (4th) 129, [2000] S.C.J. No. 68, 2 S.C.R. 1067, 194 D.L.R. (4th) 193, 2000 SCC 67 (S.C.C.).</p> <p><i>Patent Act</i>: sections 28.2 and 28.3; briefly consider sections 27-28.4, 43(2), 53 and 58</p>	MDM
Oct 23	Utility/ Sufficiency of	<p><i>Patent Act</i>, s. 2 (“invention”), s.27(3), s.27(4).</p> <p><i>Minerals Separation North American Corp. v. Noranda</i></p>	SJF

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	Specification	<p><i>Mines Ltd.</i> (1952), 15 C.P.R. 133 (P.C.).</p> <p><i>Procter & Gamble Co. v. Bristol-Myers Canada Ltd.</i> (1978), 39 C.P.R. (2d) 145 at 145-150 and 158-161 (F.C.T.D.); affd. 42 C.P.R. (2d) 33, 24 N.R. 342 (F.C.A.); leave to appeal to S.C.C. refused 42 C.P.R. (2d) 33 [Pages 145-150 and 158-161 C.P.R. of trial decision only].</p> <p><i>Amfac Foods Inc. v. Irving Pulp & Paper, Ltd.</i> (1986), 12 C.P.R. (3d) 193 (F.C.A.).</p> <p><i>Apotex Inc. v. Wellcome Foundation Ltd.</i> (2002), 21 C.P.R. (4th) 499 at 499-502, 505-511 and 519-535, [2002] S.C.J. No. 78, 4 S.C.R. 153, 219 D.L.R. (4th) 660, 21 C.P.R. (4th) 499, 2002 SCC 77 (S.C.C.) [Paragraphs 1-22 and 48-93 only].</p>	
Oct 30	Exercise on Validity	Handouts	SJF
Nov 6	<p>Specialized Fields of Patent Protection</p> <p>a) Biotech & Pharmaceutical Patents</p> <p style="text-align: center;"><u>and</u></p> <p>b) Computer-Related Inventions</p>	<p><i>Apotex Inc. v. Wellcome Foundation Ltd.</i> (2002), 21 C.P.R. (4th) 499, [2002] S.C.J. No. 78, 4 S.C.R. 153, 219 D.L.R. (4th) 660, 2002 SCC 77 (S.C.C.) [Paragraphs 1-22 and 48-93 only].</p> <p><i>Harvard College v. Canada (Commissioner of Patents)</i> (2002), 21 C.P.R. (4th) 417, [2002] S.C.J. No. 77, 4 S.C.R. 45, 219 D.L.R. (4th) 577, 2002 SCC 76 (S.C.C.) [Paragraphs 118-127, 153-166, 184-187, 197-206 only].</p> <p><i>Monsanto Canada Inc. v. Schmeiser</i> (2004), 31 C.P.R. (4th) 161, [2004] S.C.J. No. 29, 1 S.C.R. 902, 239 D.L.R. (4th) 271 (S.C.C.) [Paragraphs 1-97].</p> <p><i>Schlumberger Canada v. Commissioner of Patents</i> (1981), 56 C.P.R. (2d) 204, [1982] 1 F.C. 845 (F.C.A.).</p> <p>CIPO Practice Notice, "Office Practice Regarding Signals", C.P.O.R., Vol. 135, No. 33, Aug. 14, 2007, p.10</p>	MDM

Date	Subject	Readings / Materials	Lecturer
Nov 13	U.S. Practice	<p>Subject Matter: <i>In re Bilski</i>, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008), <i>certiorari</i> granted June 1, 2009 (SCOTUS).</p> <p>Claim Construction: <i>Phillips v. AWH Corporation</i>, 2005 U.S. App. LEXIS 13954, 75 USPQ2d (BNA) 1321 (Fed. Cir. 2005) (en banc). [Majority Opinion only]</p> <p>Doctrine of Equivalence/Prosecution History Estoppel: <i>Festo Corp. v. Shoketsu Kinzoku Kogyokabushiki Co.</i>, 535 U.S. 722, 234 F.3d. 558 (U.S.S.C. 2002).</p> <p>Inequitable Conduct: <i>Purdue Pharma L.P. v. Endo Pharmaceuticals Inc.</i>, 438 F.3d 1123, 77 USPQ2d 1767 (Fed. Cir. 2006).</p> <p>Obviousness: <i>Teleflex, Inc. v. KSR Int'l Co.</i>, 2005 U.S. App. LEXIS 176, 119 Fed.Appx. 282 (Fed. Cir. 2005), <i>cert. granted</i> 126 S. Ct. 2965 (2006).</p>	SJF
Nov 20	Summary	[Recap of materials from previous lectures; Q&A regarding the final exam.]	MDM and SJF
Nov 27	Commercializing Inventions & Patent Licenses	<p>Handout: Patent License Checklist</p> <p><i>Patent Act</i>, s. 50, 53, 54, 55, 55.01, 55.2, 56, 57, 59, 60.</p>	KFM
Tues Dec 8 at 9 am	Final Exam		