Index

Abate, T. 713
Abbott, and Thailand 694
Abbott, A.F. 150
Abboud, L. 656
AB Hassle v. Canada 480
AB Hassle v. Rhoxalpharma Inc. 480
Abramowicz, M. 39, 41, 57, 67
A.C. Aukerman Co. v. R.L. Chaides Constr. Co. 12
access problems 40
Access to Knowledge (A2K), proposed treaty 704–6
Accuscan, Inc. v. Xerox Corp. 12
Acontius, Jacobus 102
Acts of Union (1706, 1707), UK 103
Adams, J.N. 388, 400
Adelman, M.J. 388
Adler, M.D. 30
Aero Products International Inc. and Chaffee v. Intex Recreation Corp, Quality Trading Inc., and Wal-Mart Stores Inc. 148
Aerotel and Macrossan 326, 333, 344, 345, 346, 347
African Intellectual Property Organization 136, 159
agency capture 31–2, 42, 49
Agreement on Trade Related Aspects of Intellectual Property Rights see TRIPS
AIDS 689–90, 691, 696
Air Supply Plans 331
Alappat, In re 48
Alberti 116
Alchian, A.A. 7, 8, 26
Alexander, J.I. 40
Allen & Hanburys v. Generics 504, 511, 517
Allen, J. 697
Allen’s Patent No. 513 (1729) 110
Allen, V.J. 392
Allied Tube & Conduit Corp. v. Indian Head 735
all or nothing rule 593–4
Al-Site Corp. v. VSI Int’l, Inc. 448
Alza Corp. v. Mylan Labs., Inc. 415
‘ambush’ behaviour 730–31
American Braided Wire Co. v. Thomson 477
American College of Medical Genetics 718
American Home Products v. Novartis 454
American Law Institute 638–41
analogous art test 421, 422
Andean Trade Preference Act 698
Anderson, T. 697
Anderson, T.L. 7, 8, 9, 24, 25, 48
Anheuser-Busch Inc. v. Portugal 148
animals, new varieties 515
Anti-blocking system 328, 347
‘anticommons’ 15–16, 71
anticompetitive activities 151
antitrust law 54, 729, 730, 748, 749, 751
extraterritorial reach 616
and spare parts 497–9
appeal procedure, European Patent Office 224–45
An Appeal to the Public on the Rights of Using Oil-cement or Composition for Stucco 117
Approved Drug Products with Therapeutic Equivalence Evaluations (Orange Book) 651–2
Argand 124
Argentina 372, 670
Arizona v. Maricopa County Med. Society 741
Arkwright cases 118, 119, 120
Arrow Information Paradox 4–5, 35
Arrow, K.J. 5, 14, 91
Asahi Glass Co. v. Pentech Pharmaceuticals, Inc. 661
Asano patent 418, 419
Aspen Skiing Co. v. Aspen Highlands
Skiing Corp. 729
Assessment of the Difficulty of
Dismounting 330
Association des Ouvriers en Instruments
de Precision v. Beyrard 513
Astron Clinica Limited and others 333, 347
Asundi, J. 63
AT&T Corp. v. Microsoft Corp. 615, 616, 618, 619
Atlas Glass Co. v. Simonds Mfg. Co. 390
Atofina v. Great Lakes Chemical
Corporation 313
Attaran, A. 560
Austin, G.W. 617
Australia
infringement 482
Patents Act (1990), on indirect
infringement 472–3
Austria, contributory patent infringement
469, 470
authorized generics 656–60
as a litigation settlement mechanism
659
Automated Sales Control 342
Res. 733
Aventis Pharma Deutschland GmbH v.
Lupin, Ltd. 424, 425–6
Averley, G. 105
Ayres, I. 6, 12, 20, 44
‘bad’ patents 247–8, 252, 260, 732
Baechtold, P. 154
Bainbridge, D. 481
Baker-Bauman v. Walker, No.3 627
Baker Petrolite Corp. v. Canwell Enviro-
Industries Ltd. 481
Ball, G.G. 249, 252
Ball Spine decision 456, 457
Balto, D.A. 657
Banait, N. 658
‘Banks Committee’ 361
Bahdehle, H. 217
bargain effect 27–8
bargaining process 9–10
Bargaining Under Rules Versus
Standards 20
Bar-Gill, O. 4
Barton, J.H. 712
Barzel, Y. 7, 40, 71
B.A.T. Cigaretten-Fabriken, GmbH v.
E.C. Commission 505
Bate, R. 683
Bates v. Coe 394, 400, 403
Battersby, G.J. 45
Baumol, W.J. 69, 745
Bayer, AG v. EC Commission 511
Bayh-Dole Act, USA 523, 528, 544
government license defense 545–8
beacon effect 27–8, 42, 63
Becker, G.S. 31
Bedell, D. 45
behavioralism 13–15
Behrendt, K.E. 651
Bell Atlantic Network Services v. Covad
Communications Group, Inc. 290
Bently, L. 480
Benyaminia, A. 466, 467, 476, 478, 481, 485
Berne Convention (1886) 145
Berne Convention (1971) 145, 618, 619
Bernstein, J.I. 36
Bernstein, L. 61, 62
Besen, S.M. 35, 37
Bessen, J. 15
Betts v. Wilmott 474, 518
Bevan, D. 152
Bibliography of Eighteenth Century
Legal Literature 105
BIC Leisure Prods. v. Windsurfing Int’l
Inc 595
‘Big Pharma’ 59
Billings 118
Binger, B.R. 26
Biography of the Common Law 121
biomedical research tools 553–4
‘bio-piracy’ 143–4
biotechnology 10–11, 59
diagnostic genetics 712–14
EC Directive 465, 515, 516
 genetic engineering 531–2
patent pools in 714–16
holdout problem 719–20
and standard setting 712–21
patents 516
‘reach-through’ claims 465
research tools 535
and US law 363
Bircot’s case 111
Blackberry, patent litigation 5, 18–19,
48, 614–15
Blackmer v. United States 616
Blonder-Tongue Labs., Inc., v. Univ. of
Illinois 48, 628, 729
BMC Resources Inc. v. PaymenteCH LP
486
Board of Trade of the City of Chicago v.
Dow Jones & Co., Inc. 497
Bodenhausen, G. 365, 366, 367
Boehm, K. 126
Bolar exemptions 536, 670
Bonito Boats Inc. v. Thunder Craft
Boats, Inc. 136
Boosey & Hawkes Music Publishers,
Ltd. v. Walt Disney Co. 622
Bosies v. Benedict 403
Boulton & Watt v. Bull 111, 118, 121,
122
Boulton & Watt v. Hornblower 111, 117
The Boundaries of Private Property 16
Bovill v. Moore (1816) 106
Bramah, J. 104, 114, 117
Brandi-Dohrn, M. 464
Brand’s Patent No. 996 (1771) 117
Brazil 685–6
  compulsory licensing 559–60,
689–90
Brenner, In re 363, 377
Brenner v. Manson 363, 372, 377
Bristol-Myers Squibb Co. v. FH
Faulding & Co. Ltd. 472
Bristol-Myers Squibb Co. v. Paranova
SA 509
British Intellectual Property Office 344,
347
British Leyland Motor Corp. Ltd v.
Armstrong Patents Co. Ltd. 492
British Library 105
British Mutoscope and Biograph Co. Ltd
v. Homer 473
The British Patent System 361
British United Shoe Manufacturers v.
Collier 477
Broadcom Corp. v. Qualcomm Inc. 745,
746, 748, 749, 756
Brooke Group Ltd. v. Brown
&Williamson Tobacco Corp. 749
Brussels Convention 624
Buchanan, J.M. 32, 33, 36, 61
Budapest Treaty 158
Buller, J. 117, 118
Bundy, S.M. 661
Bureth, A. 28
Burk, D.L. 4, 646
business methods 339, 755
Byrom, R.W. 587
Calbresi, G. 5, 24
Calculations, Trust, and Economic
Organization 13
The Calculus of Consent 32
California Motor Transport Co. v.
Trucking Unlimited 753
Calvert, R.L. 63
Canada 388
  Generic Medicines case 685
  infringement 478–9, 480, 481, 482,
616
  pharmaceutical products 562
Canada – Patent Protection of
Pharmaceutical Products 685,
700
Canada – Term of Patent Protection
678
Canon 352, 353
Cantwell, J. 141
Capitalism, Socialism, and Democracy
43
Cardizem CD Antitrust Litigation, In re
663
Caribbean Basin Economic Recovery
Act 698
Carlson, In re 390
Carnaval, C.C. 151
Carpmael 104
Carpmael’s Patent Cases 117
Carter Prods., Inc. v. Colgate-
Palmolive Co. 390
‘case or controversy’ interpretation 626
Case of Monopolies 102
Cass, R.A. 691
Catnic Components Ltd. v. Hill & Smith
Ltd. 453
Caulfield, T. 12
CBS Songs v. Amstrad Consumer
Electronics 467, 486
cement patents see Liardet v. Johnson
(1778)
commercialization theory 42, 53–8
and control 55–6
coordination function 54, 55, 60–61
distinction between ex ante and ex post 56–7
inclusiveness 57
and property rights 55
and the software industry 59
Committee of Patentees (1785) 120, 124
common rules, at international level 158, 159, 160
‘commons’ 61
Commonwealth Scientific & Industrial Research Organisation v. Buffalo Technology Inc. 571, 574, 577, 578
Community Design Regulation 493
Community Enforcement of Informal Contracts 62
Community Patent Convention (1975) 511
The Community v. Arthur Bell and Sons, Ltd. 505
companies’ growth, and innovation 69–70
company size 69, 79
Compco Corp. v. Day-Brite Lighting Inc. 136
compensation, for infringement see infringement damages
competition 76
dynamic 71
and positive patent law 59
competition law
and patents, Europe 512–14
and spare parts 494–7
competitive advantage 68
compulsory licensing 139, 523, 747–8
allowed under TRIPS 560–64
Brazil 559–60
and eBay case 573–5
Europe 512
India 685
primer on 559–60
and TRIPS 558–64, 685–95
Commission v. United Kingdom, Re 517
Computer Associates Intern, Inc. v. Altai, Inc. 613

Computer implemented method for manufacturing a cable harness 331

Computer Program Product 326, 329, 347

computer programs 145–6, 619

see also software

confidentiality, and patents 144–5

Congress of Vienna 160

Conley, N.L. 404

Conn. Valley Enters., Inc. v. United States 391

Continental Paper Bag Co. v. Eastern Paper Bag Co. 569

contract law 737, 739

contracts 5

contributory infringement see infringement, indirect

control problems 85

Convention on Biological Diversity (CBD) 178

Convention on the Grant of European Patents (1973) 284, 619

‘convention priority right’ 130

Cook, W. 152

Cooper, R.C. 610

coordination 28, 64–5

and patents 71

coordination problems 71

Cooter, R. 20

copyright 8, 35, 47, 103, 136, 145–6, 357

dramatic doctrine of unity 466

infringement 463

and interest groups 46

work-for-hire doctrine 60

copyright law, and spare parts 492

Copyright Term Extension Act 44–5

Cornish, W. 131, 458

Correa, C. 373, 562, 675

Coryton, J. 108

Cotropia, C.A. 559, 656

Council of Europe 367–8, 370, 371

Court of Customs and Patent Appeals (CCPA), USA 363

Crane v. Price 126

Crater Corp. v. Lucent Technologies 544

Croft, T. 658

‘cronie capitalism’ 63

Crony Capitalism and Economic Growth in Latin America 63

Croson, R. 20

Cross, F. 31

‘Crown Right’ doctrine 541, 554


Custodiol I 452

Custodiol II 452

Custom Accessories Inc v. Jeffrey-Allan Industries, Inc. 459

Cutting Blade I 452

Cutting Blade II 452

Daiichi Sankyo Co. v. Apotex, Inc. 429–31

damages see infringement damages

Dam, K.W. 21

Dansk Supermarket, A/S v. Imerco 505

Darcy v. Allen (1602) 102

Dasgupta, P. 7

data protection 702

Data Structure Product 330, 352

Davidoff 474

Davies, S. 103, 104, 107, 108, 109, 110, 119

Davis, M.H. 45

Dawson Chem. Co., v. Rohm & Haas Co. 60

Decca Ltd. v. United States 611

decentralization 74

decision making 13–14, 24, 74

Deckler, In re 410

Deepsouth Packing Co. v. Laitram Corp. 615–16

de facto patent term extension 519

de facto research use exceptions 522

Degenhardt, H.W. 155

de jure research use exceptions 522, 525–41

Dell, In re 748

de-minimus type argument 526, 527

Demsetz, H. 7, 8, 23, 25, 26, 27–8, 55, 59

design law, and spare parts 493

design rights 146

Determinants of Profitability 332, 351

Deutsche Grammophon 503–4, 509
Devaiah, V. 101
Devinsky, P. 467
diagnostic genetics 712–14
  characteristics of patent pools 717
  patent thickets 712, 713
  single nucleotide polymorphism
  (SNP) 712
Diamond v. Chakrabarty 48, 372
Diamond v. Diehr 48
Dinwoodie, G.B. 561, 580, 620
Diplomatic Conference, Hague 164, 165
Directory for Patent Slating 113
disclosure
  first-inventor-to file, proposed
  411–12
  of information and patents 144–5
  of inventions 123, 215, 385
  of origin of genetic resources and
  traditional knowledge 177–8
disclosure obligations 738–41
disclosure rules 42
Disposition Program 327, 350
disputes see patent disputes
Dispute Settlement Understanding
  (DSU) 679
Distillers Co. v. Standard Oil Co. 622
diversification 186–7
Dixit, A.K. 7
Djankov, S. 32, 33
Dobbs, D. 587
Dobson v. Dorman 595
Dock, M.C. 101
Doha Declaration 139, 171, 181, 182,
  183, 564, 581, 676, 687, 689, 691,
  697, 701
Dolland (1766) 104
Dolmans, M. 756
Domeij, B. 93
Do Patents Facilitate Financing in the
Software Industry? 17
dossier access system with machine
  translation 277
Dow Jones & Co. Inc. v. Gutnick 612
draft Community Patent
  Convention/Agreement 467, 469
  on direct infringement 476
  on indirect infringement 471
Draft Patent Harmonization Treaty
  164–70, 173, 179
draft Substantive Patent Law Treaty
  (SPLT) 176–80, 184–5, 633, 698
  balance of interests 177
  claim interpretation 17
disclosure of origin of genetic
  resources and traditional
  knowledge 177–8
  exceptions to patentability 177
  flexibility regarding national policies
  178–9
  Group B+ 180
  ‘industrial applicability’ 376
  patentable subject matter 177
  ‘utility’ 376
dramatic doctrine of unity 466
Dreyfuss, R.C. 561, 580, 634, 637, 638,
  679
Drug Price Term Restoration Act
  (1984), USA see Hatch-Waxman
  Act
Duffy, J.D. 4
Dunkel Draft 165
Dunlop, H. 455
Dunlop Holdings Ltd. v. RAM Golf
  Corp. 397
Duplan Corp. v. Deering Milliken, Inc.
  390
Dutfied, G. 147
dynamic competition 71
dynamic efficiency 19, 20
  and static efficiency 21
Dystar 431–2, 436
Dystar Texilfarben GmbH v. C.H.
  Patrick Co. 415, 431–2, 436
Eastman Kodak Co. v. Image Technical
  Services 726
Eastman Kodak v. American Photo
  Booths 380
eBay, Inc. v. MercExchange, L.L.C. 5,
  557–83, 669, 719–20, 732, 733,
  734, 747, 755
  analysis and application under TRIPS
  572–81
  compliancy with TRIPS 576
doctrinal implications on US patent
  law 568
  failure to commercialize as basis for
  denial of injunction under
  569–72
remedy granted when an injunction is denied pursuant to 572
US Supreme Court decision 564–72
Ebersole, T. 714, 718
economic aspects of patenting, Swedish study 76
Economic Competition and Political Competition 31
economic importance, of patents 70
economics, applied to patents 4–34, 141–3
The Economics of Patents 141
The Economics of Welfare 23
economic theories
about the purpose of patents 34–64
of the patent system 70–76
EC Treaty
Article 30 503, 507, 508–10, 516
Articles 28 and 29 503
Edgeberry v. Stephens (1693) 104
Edgebury v. Stephens (1693) 103, 121
‘Edinburgh’ patent 295–6
Editable Document Form 350
Edwards v. Strazzabosco 399, 404, 405
Eehhood, M.M.M. van 621
‘efficient breach’ 19
efficient market hypothesis 10
Egbert v. Lippmann 391
Eisenberg, R.S. 16, 35, 55, 61, 445, 645
Ekenstam, In re 390
Electronic Financial Transactions 332, 340, 341, 343, 349
Electronic Monetary Transactions 332, 347
Elhauge, E. 21
Eli Lilly & Co. v. Medtronic, Inc. 652
Eli Lilly & Co. v. Zenith Goldline Pharmaceuticals, Inc. 434
elimination, of patents 50
Ellickson, R.C. 9
Elmer, M. 608
embodiments 448
Embex v. Service Engineering 525, 527, 529
EMC Corp. v. Norand Corp. 664
Endless + Hauser, Inc. v. Hawk Measurement Systems Pty. Ltd. 445
Endo, M. 457
enforcement 42, 43, 61–3
characteristics 5–6
private and public 61–3
uncertainty in 20
Engelberg, A. 670
‘Engelgau patent’ 417, 418
enrollment
of specifications 106–9
introduction 110
entitlements 47, 140
entrepreneurship 67, 77
general model of a national system 78
Sweden 85–6, 97–8
Environmental. Designs, Ltd. v. Union Oil Co. 430, 445
Eolas Technologies Inc. v. Microsoft Corp. 611, 615
Epitome on the Laws Relating to Patents 118
Epoline file inspection 277
Epstein, R.A. 15, 16, 28, 42, 43, 45
equivalents, doctrine of 452, 454, 455–6, 458, 731
Erie v. Tompkins 497
Essay on the Law of Patents (1803) 108, 118, 121–3
Essén, E.W. 90
estoppel 740
estoppel-like principle 518
Eurasian Patent Organization 159
Eurek, S.E. 651
Eurim-Pharm Arzneimittel, GmbH v. Beiersdorf, AG 509, 511
Europe 67
antitrust law and spare parts 497–9
biotechnology patents 516
competition laws and patents 512–14
compulsory licensing 512
consolidated litigation 624–5
exhaustion rule 515
‘first-to-file system’ 215–16
free movement of goods 503–5
industrial applicability concept 378–9
national rights and parallel imports 516–17
patenting software-related inventions 325–54

Toshiko Takenaka - 9781848446175
Downloaded from Elgar Online at 04/15/2019 06:33:52AM via free access
patent protection 443
territorial restrictions 513–14
European Commission, Treaty to
Exclusionary Abuses 498
European Community, exhaustion of
patent owners rights 501–18
European Community Innovation Survey
(CIS) 77
European Convention on Human Rights
148
European Court of Human Rights 148,
149
European Court of Justice 503, 517, 625
European Court of Patent Appeals
(proposed) 225
European Law, industrial application in
355
European Parliament, resolution on
proposed software directive 336
European Patent Bulletin 211
European Patent Convention 93, 126,
133, 372–3, 411, 530, 611, 622
Article 14 298
Article 52(1) 372
Article 52(2) 329–30, 331
Article 69 294, 443
Article 70 298
Article 84 294
changes in substantive patent law
214–22
claims to medicinal indications
219–22
‘continued use doctrine’ 300
contracting States 218
exclusions from patentability 326
filing date requirements 192–3
‘industrial application’ 355–6, 372–3
infringement 482
London Agreement 302–3
novelty provisions 384
official languages of 294, 302
priority claim 193–5
prior rights 214–19
revision (2007) 191–2
revisions
governing language and
translation 293–4
regarding computer programs 335
translation issues 293–304, 319
‘authentic text’ 301–2
content assessment 298
‘conversion procedure’ 304
correction of errors 303
provisional protection 300–301
safeguard 298
use of the word ‘term’ 294–5
within Article 69(1) 294
European Patent Court (proposed) 636
European Patent Enforcement
Agreement 608
European Patent Litigation Agreement
(proposed) 636–7
European Patent Office 82, 126, 186
appeal procedure 224–45
aim and effect of filing appeal
226–7
amendments after oral
proceedings 234
appealable decisions 227–9
appeal fee 231
costs 241–2
equal treatment principle 230
inter partes proceedings 230, 231,
234
legal and factual framework
232–6
literature on 244–5
and mergers and acquisitions 230
new claims 233
petition for review 242–4
powers of first instance or remittal
of case 237–8
prima-facie relevance 233–4
procedure for filing appeal 231–2
prohibition principle 231
right to appeal and to be party to
the proceedings 229–31
‘subject of the appeal’ 231
time limits 231–2
timing of decision 236–7
application backlog 273
Board of Appeal 208, 224–5, 226,
241
binding effect of decisions 238–9
composition 228–9
ratio decidendi 238–9
res judicata 224
Rules of Procedure 233, 236, 239
free access
Enlarged Board of Appeal 212, 217, 224, 226, 234
decisions and opinions 239–40
established under EPC 191
examination procedure 202–10
Examing Division 7, 193, 197, 199–214, 235, 236
exclusions 328
grant of a patent 210–12
interlocutory revision 226
and late filing of missing parts 195–8
‘Mastering the Workload’ 273
non-unity and Euro-PCT applications 200–201
novelty requirement 216–19
official languages 297–8
Opposition Divisions 228, 231, 235, 239
oral proceedings 205–10
party disposition principle 226–7
priority provision 386–7
refusal of application 212–14
software-related inventions, current practice 337–9
supplementary search 201
translation of priority document 198–200
European Patent Organization 159
revision of EPC 293–4
European Search Opinion (ESOP) 203–4
European Trademark Acts 494
European Trademark Directive 493, 494
European Union Directive on Enforcement of Intellectual Property 608
Evangelista, E. 659
Evans 130
EWP Corp. v. Reliance Universal Inc. 445
examination, duplication of 273–4
Examination Guidelines for Determining Obviousness, USPTO 435–6
examination procedure, European Patent Office 202–10
examination requirement 126
USA 127
examination results, pilot projects for testing mutual exploitation 274–6
Examiner Exchange Program 284–5
ex ante 56–7
exclusion 42, 57–8, 328, 517
waiver of exclusory right 518
exhaustion
doctrine of 489
of patent owners rights 501–18
European Community 514–15
and unenforceability 502–3
exhaustion rule, Europe 515
‘Expediency of Disclosing the Process of Manufactories’ 121, 123–4
expense
of acquiring patents 137–8
of enforcing the patent 138–9
of preserving the patent 138
experimental, use of term 522
experimental exceptions 525–35
Experimental Results on Bargaining Under Alternative Property Rights Regimes 20
experimental use 464
ex post 56–7
Extended European Search Report (EESR) 203–4, 205
extended novelty requirement, Japan 217–18
externalities 23–6, 36–7
‘fair, reasonable and nondiscriminatory’ (FRAND) requirement 744
fair use 6
Falconer, D. 362
Fama, E. 10
fame 63–4
Faulkner v. Gibbs 599
Fauntleroy v. Lum 629
Faurecia Automotive Seating Canada Ltd. v. Lear Corp. Canada Ltd. 478
Federal Rules of Civil Procedure 47–8
Federal Trade Commission Act 749
Federal Trade Commission and Department of Justice Antitrust Division 48–9
Federal Trade Commission v. Cement Inst. 735
Felder v. Reeth 587
Ferreira, A. 683
Patent law and theory

Festo Corp. v. Shoketsu Kabushiki Co. 133
Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki 444, 450
F. Hoffmann-La Roche Ltd. v. Empagran 616, 617, 623
filing
plans and drawings 110–11
of specifications 107–8
filing date, and invention date 400
filing date requirements 166–8, 175–6, 177, 179
late filing 195–6
under the European Patent Convention 192–3
Filling Gaps in Incomplete Contracts 20
Fina Oil & Chem. Co. v. Ewen 664
Finisar Corp. v. DirecTV Group, Inc. 575
Firms, Courts, and Reputation Mechanisms 62
first-inventor-to-file, proposed 406–13
disclosure 411–12
priority 411–13
first-to-file countries, novelty 384–5
first-to-file principle 165, 176–7, 383, 458
Europe 215–16
grace period 385–6
novelty provision 383
priority provisions 383, 386–7
first-to-invent system see under USA
Firth, A. 466
Fischbaum, M. 39
Fisch, J.E. 53
Florence, patent for Brunelleschi’s boat (1421) 360
Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank 549
Fogel, R. 4
Folkes v. Chadd 125
follow-on products 523
foreign patents 611
Fornstein 451
Fox, H.G. 126
framing 14
The Framing of Decisions and the Psychology of Choice 14
France
direct infringement 476
grants of monopolies under the Royal Prerogative 63–4
Patent Law (1791) 127–8
Patent Law (1844) 364
Patent Law (1902) 128
patent system 127–9
spare parts, and competition law 496
free movement of goods 503–5
free rider problem 26, 54
Free Trade Agreements 646, 698, 698–704
bar on parallel imports 703
and data protection 702
limited compulsory licensing 701–2
patentability 699
patent term 699–702
‘freezer program’ business model 11
Freistaat Bayern (Bavaria) v. Eurim-Pharm, GmbH 505
Frew v. Hawkins 551
Friedman, M. 9, 29, 33
Fry Committee (1901) 126
Fujikawa v. Wattanasin 397
Fujitsu Limited’s Application 346
functionality 148
Furubotn, E.G. 29, 30, 32
GAF Building Materials Corp. v. Elk Corp. 664
Gallo, A.A. 259
Gambro Lundia AB v. Baxter Healthcare Corp. 313
game theory 54, 149–50
Gana, R.L. 674
Ganz reference 431
GATT 165
Gebrauchsmuster 129, 146
Genentech, Inc. v. Novo Nordisk 446
General Motors Corp. v. Deves Corp. 589
Generics (UK) Ltd. and Harris Pharmaceuticals Ltd. v. Smith Kline 511, 517
genetic resources 177–8, 181–2
Gentleman, A. 682
George, G. 719
Georgia-Pacific Corp. v. United States Plywood Corp. 565, 600

Toshiko Takenaka - 9781848446175
Downloaded from Elgar Online at 04/15/2019 06:33:52AM
via free access
Geradin, D. 746
Gerber Garment Technology v. Lectra Systems 477
Gerhardsen, T. 683, 691, 694, 697, 706
Germany 191, 330, 331, 470, 624
business schemes 332
core doctrine 327, 332
direct infringement 479
freedom of imitation principle 495
patentability 365
Patent Law (1877) 129, 364–5, 530
patent system 12
‘person having ordinary skill in the art’ (PHOSITA) 451–2
compared to UK, Japan, and USA 458–61
 petty patent 129
‘Red Dove Doctrine’ 327, 328
regulatory review exception 538, 539
research use exception 530, 533–4
software-related inventions
 current practice 339–44
 and mathematical algorithms 343
spare parts 489–90
 and antitrust law 497–9
 and competition law 494–5
‘technical advance’ requirement 365
‘technical progress’ requirement 369
Trademark Act 494
Unfair Competition Act 494–5
Gertner, R. 20
Gervais, D. 165, 373, 688, 692
Gervais, N. 170
Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbaun Beteiligungs KG 625, 631
Gesellschaft zur Verwertung von Leistungsschutzrechten, mbH v. E.C. Commission 505
Gholz, C.L. 404
Gibbs, F.W. 115
Gillette Company/LA-Laboratories 494
Gilson, R.J. 50
Gimeno, L. 463
Glass, In re 446
globalization 173, 286
goals for patent system 3
Godson, R. 108
Goeddel, D.V. 358
Golden Bridge Tech., Inc. v. Nokia, Inc. 735
Golden Rice 715
Gordon, W.J. 22
Gorison, S.M. 49
Gorlin, J. 692
Gottschalk v. Benson 48
Goulds Manufacturing Co. v. Cowing 597
Gould v. Schawlow 400, 405, 406
governance mechanism, patent rights as 72, 75–6
government, role of 36
government-generated standards 751–5
government standards 723–4
Grady, M.F. 40
Graham v. John Deere Co. 415–20, 433, 445
differences between prior art and claims at issue 423–9
PHOSITA 445
prior art 420–23
Granstrand, O. 67, 69, 70, 76, 89, 90, 155
Gray, E. 719
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. 419
Greece 191
Greene, J. 657
Green Fluorescent Protein (GFP) 715
Green v. Broadcasting Corp. of New Zealand 466
Greif, A. 62
Griffith v. Kanamaru 405
Griliches, Z. 70
Griswold v. Connecticut 377
Grody, W.W. 718
Group of Friends of Development 180
‘group think’ 15
growth, and innovation 69
Gruber, S. 464
Guell, D. 67
Guell, R.C. 39
Guinier, L. 31
Gulf Cooperation Council Patent Office 159
Gutterman, A. 70
Gwartney, J.D. 33
Gyromat Corp. v. Champion Spark Plug Company 596

Haber, S. 63
Haddock, D.D. 20, 30, 36, 37
 Hague, Diplomatic Conference 164, 165
 Hague Convention 630–31, 637
 Hahn v. Wong 403, 404
 Halford v. Seed Hawk Inc. 464, 482
 Hall, C.D. 58
 Hall, In re 390
 Hall v. Stern 595
 Hamar v. Playne 118
Handels-og Kontorfunktionsaerrernes Forbund i Danmark v. DanskArbejdsgiverforening, SA 506
Hannay’s Patent (1774) 109
Hardin, G. 26
harmonization of patent law 64, 95, 159, 163, 172, 173, 180, 184–5
and practices 284–6
and World Intellectual Property Organization (WIPO) 285
harpsichord and piano patents 111
abbreviated new drug applications 650–51
certifications for Orange Book-listed patents 651–2, 665, 668
controversies surrounding 655–67
authorized generics 656–60
defamatory judgement actions 663–7
extension of 670–72
generic marketing exclusivity 654–5
innovator marketing exclusivities 654
new chemical entity 654
New Drug Applications 650, 651
overview 647–55
patent enforcement proceedings 652–3
patent term extension 653–4
reverse payment settlements 660–63
and Roche Products, Inc. v. Bolar Pharmaceuticals 647–50
statutory experimental use exception 650
Haworth, L. 463
Haworth, P. 463
Hayek, F.A. von 62, 248
Hayne v. Malby 123
Heinzl, M. 18
Helfer, L. 675, 679
Helfgott, S. 217
Heller, M.A. 15, 16, 26
Henry’s Patent No. 601 (1744) 110
Hermann, G. 484
Hesser, T. 90
Hess, J. 659
heuristics 14
Hewlett Packard Co. v. Bausch & Lomb Inc. 420
Hicks, L.L. 560
Higgins, B. 115
Hill, P. 7, 8, 48
Hill-Rom Co. v. Kinetic Concepts, Inc. 317
‘Hilmer Doctrine’ 179, 219, 284, 409–10
Hilmer, In re 396
Hilli, AG v. E.C. Commission 505, 515
Hindmarsh, W. 361
Hirai, Y. 586
Hirscheifler, J. 35
Hitachi 331, 337
Hodgkinson & Corby Ltd. v. Wards Mobility Ltd. 497
Hoescht Celanese Corp. v. BP Chemicals Ltd. 481
Hoffman, E. 26
Hoffman-La Roche v. Harris Pharmaceuticals 477
Holbein, J.R. 560
Holdsworth 105
Hookway, J. 694
Hornblower v. Boulton (1799) 110, 118, 121, 521
Hornickel, J. 217
Hoskins 102
Hubbard, T. 706
Hughes, J. 3
Hulme, E.W. 103, 104, 106, 114, 116, 117, 360
human cloning 295–6
human rights 680
Hyatt v. Boone 399
Hybritech Inc. v. Monoclonal Antibodies 405, 446
Hynix Semiconductor v. Rambus Inc. 738
IBM, litigation 51
Icon Health & Fitness, Inc., In re 422
Ideal Instruments, Inc. v. Rivard
   Instruments, Inc. 622
ideas
   intangible technical 154–5
   and patents 143
Ikuyo, T. 586
Illinois Tool Works, Inc. v. Independent
   Ink, Inc. 21, 499, 726
IMA, AG and others v. Windsurfing
   International, Inc. and others 514
Impeller Flow Meter 470, 479, 489
Improved Pension Benefits System 331, 339
Improver Corporation v. Remington
   Consumer Products Ltd. 67, 454
‘incentive-access paradigm’ 35
incentives, patents as 71, 140
incentive-to-disclose theory 72
incentive-to-innovate theory 72
incentive-to-invent theory 72
India 67, 217, 305
   Cancer Patient Aid Association 699
   Cipla case 684
   compulsory licensing 685
   generic drugs 696
   ‘License Raj’ 15–16
   limited patent rights 684
   Novartis case 681–4
   Patents Act (2005) 685
      amendment to 680–84
industrial, definition of 376
industrial applicability, and utility 382
industrial application
   ambiguity of term 378
      in European Law 355
   ‘industrial character’ 368
industrial property 365–6
   and utility 356–7
industry, definition of 376
industry-generated standards 734–51
industry-specific patent law 668–72
industry standards 722–56
   and patent law 731–4
Industry Triilateral, proposal for
   streamlining patent application
      format standards 286
inefficiency, and monopolies 19–20, 21, 22
Information Anxiety 248
information cost advantages, of property
   rules 43
information costs 8, 10, 34
‘information paradox’ 91
infringement 133, 463–6
   as a criminal offence 467
   different actors supply different
      components of patented
      product or raw materials 486
   different actors use different elements
      of patented process 485–6
direct 464
   financing the infringer’s activity 482
   making patented product 476
   manufacture of components of
      patented product/process 480
   offering patented process for
      use/supplying plant to
      operate 481
   offering to supply the means of
      infringement 481
   repairing patented products 481
   selling direct product of patented
      process 482
   selling, offering patented products
      477–8
   stocking a patented product
      476–7
   supplying all components of
      patented product 478
   supplying an item which can only
      be used to infringe 482
   supplying product where there is a
      new use claim 480
   supplying raw materials for
      manufacture of patented
      product 480
   supplying raw materials for
      patented process 481–2
   supplying some components of
      patented product 478–80
      and unity of space 482–4
      and unity of time 474–82
   using patented process 481
   using patented product 478

Toshiko Takenaka - 9781848446175
Downloaded from Elgar Online at 04/15/2019 06:33:52AM
via free access
importing direct product of patented process into territory 484
importing patent process into territory 483–4
indirect 464, 465–7, 468–9
draft Community Patent Convention 471
eamples of different bases for 469
USA 473
literal 463
non-literal 463
offering patented process for use 484
‘parasitic’ damages 464
and price erosion 477
research as 519
and unity of action, dispersed liability 484–5
and unity of space 482–4
USA 251, 450–51
using patent process in the patent territory 483
infringement damages 44
‘but for’ test 585
‘foreseeability’ test 585
USA and Japan 584–608
inherent patentability 380, 381
Initiative for Enhanced US–Japan Cooperation on IPR Protection and Enforcement 278
injunctions 57–8
Innova/Pure Water, Inc. v. Safari Water Filtration Sys. 444, 446
innovation 67, 70
general model of national system 78
and growth 69
over time 21
and R&D tax credits or deductions 74
innovation-activity model 67
Innovation Without Patents 147
Institutions and Credible Commitment 30
intangible property 154
integrated circuits, layout designs 172
Integra v. Merck 540, 554
Intellectual Asset Management 141
intellectual property 12, 66
Japan 67, 456
positive law intellectual property regimes 60
and public choice problems 48
Sweden 88
and utility 356–7
Intellectual Property Digital Library (IPDL) 277
Intellectual Property in the New Technological Age 154
Intellectual Property Owners Association 52
intellectual property rights 35, 66, 74–5
see also TRIPS Agreement
intellectual property tools, extension of patent protection through 492–7
Intercom system 330
interest groups 31–2
and copyright 46
interference proceedings 403–4, 410
Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklaw (IGC) 178
interlocutory revision 226
International Association for the Protection of Intellectual Property 614
‘international dispensing authority’ 158
international framework 160
International Haplotype Mapping Project 712
internationalization, of patenting 83
International News Service v. Associated Press 497
international norm setting 173–84
International Patent Bureau 136
International Patent Classification (IPC) 140, 159
international patent law 154–5
International Preliminary Examination Authority 162
International Preliminary Examination 130
International Preliminary Examination Authority 162
International Searching Authority 162, 175, 200
Internet 17, 260, 386
domain names 629
Internet Corporation for Assigned
Names and Numbers 629
inutility 362
invention/diffusion process 71
inventions 67
disclosure of 123
early 102, 106
and industrial applicability 380
novelty test 104
patented invention, as a research tool
521
and TRIPS 677
and utility 380
inventive step (non-obviousness)
requirement 89–90, 126
and computers 331
and software-related inventions 334, 340
inventors 411
and piracy 107
investment, generic strategies 67–8
‘invisible colleges’ 248
Irino, Y. 602
ISA France Sarl and M. Visser’s
Industrie & Handelsonderneming-
VIHO, BV v. Tipp-EX Vertieb,
GmbH & Co. KG 505
Israel 465–6
Italy
Merck case 150
research use exception 539
ITP SA v. Coflexip Stena Offshore Ltd.
148
Jack, A. 690
Jaffe, A.B. 67
Janis, M.D. 671
Japan 50–51, 67, 76, 480
Advance Industrial Property Network
(AIPN) 277
comparative assessment of patent
invalidation procedures 266
compensation, for infringement,
comparison with USA
584–608
damages awarded compared to USA
585
dossier access system with machine
translation 277
extended novelty requirement 217–18
impact of 1998 revision 606–8
infringement damages
after 1968 revision 600–606
disclosure of per-unit net
profits 608
guarantee of minimum
compensation 605–6
industry 607
lost profits 601, 602–5
policy change 600–602
reasonable royalty 505, 601–2
all or nothing rule 593–4
lost profits 590–97
Panduit test 606
patent law policy 588–9
pre-1998 practice 590–600
reasonable royalty 597–600
Institute of Intellectual Property 607
intellectual property 67, 456
Intellectual Property Association 606
intellectual property system 584
Kilby decision 265
lost profits, after 1968 amendment
602–4
Ministry of Economy, Trade and
Industry (METI) 278, 584
novelty definition 384–5
novelty provisions 384
patent invalidation procedures
categories of actions 268
comparison of court decisions 269
patent invalidation processes in
courts 265–9
Patent Law
on indirect infringement 471–2
revision on infringement damages
585
‘person having ordinary skill in the
art’ (PHOSITA) 455–7
compared to Germany, UK, and
USA 458–61
research use exception 531, 534–5, 540
tort law 585
and patent policies 586–9
translation issues 314–17, 318
grammatical problems 316
Japanese Patent Office (JPO) 186, 271
applications backlog 272–3, 584
cost of invalidation trial 267
duration of invalidation trial 267
Industrial Property Right Committee 601
JP-First (JP-Fast Information Release strategy) 284
patent invalidation processes 265–9
PCT system 276
post-grant opposition system 262
’Strategic Program’ 273
Jaspen, B. 694
Jazz Photo Corp. v. International Trade Commission 491
Jessop’s case 111
Johns Hopkins University v. CellPro Inc. 446
Johnson & Johnson Assoc., Inc. v. R.E. Serv. Co. Inc. 450
Johnson, J. 112–13
see also Liardet v. Johnson
Johnson, J.A. 535
Johnson Worldwide Assocs. v. Zebco Corp. 448
Joint Department of Justice-Federal Trade Commission Antitrust Enforcement and Intellectual Property Rights Report 727
joint incentive, patents as 72
Jolls, C. 13
Jones v. Ford Motor Credit Co. 626
Joos, U. 245
Jordan, G.E. 670
J.P. Stevens & Co., Inc. v. Lex Tex, Inc. 728
judges 33–4
Juicy Whip v. Orange Bang 359
Julian-Arnold, G. 559, 573
Jungersen v. Ostby & Barton Co. 49
JVW Enterprises, Inc. v. Interact Accessories, Inc. 447
Kahneman, D. 14
Kahn, In re 421
Kalman v. PCL Packaging (UK) Ltd. 478
Kamien, M.I. 658
Kandel, E. 62
Kaplow, L. 20, 43
Karjala, D.S. 45
Kaufman Co, Inc. v. Lautech, Inc. 593
Kazim, A. 690
keiretsu strategy 3, 50–51, 53
Keizer v. Bradley 397
Kelman, M. 28
Kendall v. Winsor 394
Kensall, F. 105, 112, 114
Kesan, J.P. 247, 249, 252, 259
Kewanee Oil Co. v. Bicron Corp. 136
Khan, B.Z. 364
Khwanthomb, A. 687
Kilby decision 265
Kimberly-Clark Corp. v. Johnson & Johnson 444
King Instruments Corp. v. Otari Corp. 593, 599
Kingsdown Med. Consultants Ltd. v. Hollister Inc. 728
Kingsley, J.L. 364
Kingston, W. 105
Kirin-Amgen Inc. and others v. Hoechst Marion Roussel Limited and others 133, 453, 454, 457, 458, 460
Kirin-Amgen Inc. v. TransKaryotic Therapies Inc. (No.2) 482
Kitch, E. 40, 41, 43, 55, 71
Klemperer, P. 6, 12
Klink, J. 486
Knight, A. 358
knowledge technical 248
tradiional knowledge and patents 143–4, 177, 181–2
Koike, Y. 606
Korea 176
regulatory review exception 538
research use exception 530, 531, 534–5, 540
Korean Intellectual Property Office (KIPO) 186, 277, 280
Korea (South) 287
Korobkin, R. 13, 20
Kraus, J. 5
Kremer, M. 37, 39
KSR Int’l Co. v. Teleflex, Inc. 415–20, 435–6, 437–8, 670, 671, 731
and PHOSITA 446
prior art 420–23
secondary considerations 433–4
‘kudos’ 61
Kuhluk, B.N. 16
laches 12, 732
lack of inventive step 126
*Lacrois Durarib SA v. Kikform (UK) Ltd.* 478
Ladas, S. 365
*Lam Inc. v. Johns-Manville Corp.* 595
*Lampu Corp. v. American Power Products, Inc.* 309
Landes, W.M. 75
‘land-grab’ approach 7
Lanham (Trademark) Act (1946), USA 53, 617
*Lapides v. Board of Regents of the University System of Georgia* 550
La Porta, R. 32
*Larson v. U.S.* 543
Laster, D. 524
late filing
of missing parts 195–8
and the European Patent Office 195–8
Lave, J.M. 651, 661
Law and Economics 4
Law of Patents 118
*Law and Practice of Letters Patent* 118
Leal, D.R. 9
*Least Cost Telephone Connection* 342
legal protection, international 157
*LEGO* cases 495
Lehman, B. 273
Lemley, M.A. 4, 54, 55, 56, 154, 399, 646, 722, 734, 735, 737, 738, 739, 741, 743, 744, 747
*Lenzig AG’s European Patent (UK)* 148
Leonard, D.B.G. 714
Lerner, J. 67
*Levi Strauss & Co. v. Costco Wholesale UK Ltd.* 474, 506
*Levi Strauss & Co. v. Tesco Store Ltd.* 474, 506
Lévy, R. 28
Levy, S. 656
liability rule 6, 12–13, 43–4
Liardet, J. 111–12, 117
biography 112
cements, relative merits 114–16
declaration in case against Johnson 114
enrollment of specification 112
filing of bill against Johnson 113
patent for cement 111–12
reassignation of patent 112
*Liardet v. Adam* 112, 115
*Liardet v. Johnson* (1778) 104, 105, 106, 111–19, 122, 124, 125
cements, relative merits 114–16
record of case 116–19
‘License Raj’ 15–16, 50
licensing, compulsory see compulsory licensing
Lichtman, D.G. 39
Liebowitz, S.J. 60
life-expectancy, of patents 137
Lim, A.S.Y. 465
Limiting Patentees’ Market Power without Reducing Innovation Incentives 6
Lindholm, A. 69
Linux 63, 64
Litman, J. 46
litterae patentes 139–40
Llewellyn, D. 131
*Logic Verification* 330, 352
Lombe’s Patent No. 422 (1718) 109
London Agreement 302–3
Long, C. 4
Lopatka, J.E. 661
Lopez-De-Silanes, F. 32
LoPucki, L.M. 4
*Los Angeles News Service v. Reuters Television Int’l (USA) Ltd.* 618
*Lough v. Brunswick Corp.* 401–2
Loury, G.C. 7
Love, J. 706
*Lowell v. Lewis* 362, 377
Lowenfeld, A.F. 679
Lunney, G. 35, 38
Lunney, G.S. Jr. 22
*Lutzker v. Plet* 398, 405
*McBee v. Delica Co.* 618
McChesney, F.S. 32
*McDonald v. Graham* 477
Macedo, R.B. 399, 404
Macey, J.R. 28
*McGill, Inc. v. John Sink Co.* 459
machine translation 277
Machlup, F. 70
MacInnis, L. 697
MacLennan v. Gilbert Technology Inc. 463
McNollgast 28
Macrossan 326, 345, 347, 348
Madey v. Duke 456, 525, 527–8, 529–30, 532, 544–7, 705
Madrid Agreement Concerning the International Registration of Marks 626
Magill 498, 512, 516
Mahurkar v. Impra, Inc. 393, 394
Mailing Campaign 332
Mandelbrot, B. 10
Mann, R.J. 17
Mansfield, E. 70, 74, 91
Mansfield’s Court Notebooks 105, 114, 125
Manville Sales Corp. v. Paramount Systems, Inc. 544, 595
Margolis, S.E. 60
market entry, and patents 58–9
market failure 29
market-generated standards 724–31
patent capture 733
market power 22, 60, 726
markets
thick and thin 10–11
transaction costs 61
Markets and Hierarchies 13
Markman v. Westview Instruments 253, 256, 459
Marsh-McBirney, Inc. v. Montedoro-Whitney Corp. 595
Mars, Inc. v. Kabushiki Nippon Conlux 622, 623, 626, 632
Maryland Casualty Co. v. Pacific Coal & Oil Co. 665
Masui, K. 590
Mathias 103
Matsumoto, N. 457
Matsushita Elec. Indus. Co. v. Zenith Radio Corp. 18, 749
May, C. 160, 360
Mazzoleni, R. 70
Medical Research and Development, proposed treaty 706–7
Medicare Prescription Drug, Improvement, and Modernization Act (2003) 664
medicinal indications
claims to 219–22
first and second medicinal use 221
Merck KGaA v. Integra Lifesciences 1, Ltd. 536–8, 705
Merck & Co., Inc. v. Primecrown, Ltd. 508, 511
Merck & Co., Inc. v. Sterphan, BV and Exler 508, 511
Merck & Co. v. Teva Pharmaceuticals USA Inc. 290, 627
Mergers, R.P. 4, 5, 38, 43, 56, 154
Merrell Dow Pharmaceuticals v. HN Norton & Co. Ltd. 480
Merrill Lynch’s Application 328–9, 333, 344, 345
Merrill, S.A. 67, 89, 90
Merrill, T.W. 31, 58
Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co. 391
Meters v. Metropolitan Gas 477
Michel, S. 150
Microsoft 498
Microsoft, standardization 725
Microsoft Corp. v. AT & T Corp. 611
Microsoft Corp. v. United States 729
Mikazuki, A. 591
Miles Labs., Inc. v. Shandon, Inc. 423
Millar v. Taylor (1769) 110
Miller, J.C. 746
Miller, J.S. 655
Mimura, R. 604
mining rights 92
missing parts, late filing of 195–8
Mitchell v. Havley 489
Miyamoto, T. 154
Mobil 480
novelty 126, 357, 358, 381–2, 732
comparison of European, USA and
Japanese systems 388
EPC definition 384
in first-to-file countries 384–6
first-to-invent system, USA 388–97
Japan
definition 384–5
provisions 384
US, definition 406–7
novelty provision, first-to-file principle
383
novelty requirement
European Patent Office 216–19
translation issues 298
novelty test, inventions 104
Novo Industries, L.P. v. Micro Molds
Corp. 311
Nozick, R. 29
NTP, Inc. v. Research in Motion, Ltd. 5,
612, 614–15, 616
Obuchi, T. 455
obviousness 126
O’Connor, S.M. 464, 532, 546
Oda, In re 310
Oddi, A.S. 35
Odu, O. 510
OECD 610
Oetiker, In re 420, 421
Offering Interactive Help 332
Office of First Filing (OFF) 275, 278,
282
Officer van Justitie v. Adiaan de Peijper
508
Office of Second Filing (OSF) 275, 278,
282
Oldham v. Langmead 123
Ollier, P. 684
Omegaflex Inc. v. Parker-Hannifin Corp.
427–8
Onco-mouse case 515
On the Complex Economics of Patent
Scope 56
Ono Pharmaceuticals Co., Ltd. v. Kyoto
Pharmaceutical Industries, Ltd.
535
Ono, S. 271
‘open innovation’ 68
Open Source movement 335, 336
open source software 63–4
opposition systems 260–70
Opting out of the Legal System 61
Optional Law 44
Orange book 651–2, 668
Ordover, J.A. 76
O’Reilly v. Morse 520
Organisation Africaine de la Propriété
Intellectuelle 159
origins and early use, of patents 101–3
O’Rourke, M.A. 6
Ottman v. Stanray Corp. 622
Oskarsson, C. 69
Otsuka Pharmaceutical Co. Ltd. v. Towa
Yakuhin K.K. 535
Outterson, K. 646
Ozaki, H. 456
Page Keeton, W. 586
Pagenberg, J. 458
Paice LLC v. Toyota Motor Corp. 570,
572, 575, 577, 578
PAIR (public web service) 277
Palvix compulsory license 691
Panduit Corp. v. Stahlin Bros. Fibre
Works, Inc. 565, 594, 600
Panduit Test 595, 602, 603, 606
Paper Converting Machine Co. v.
Magna-Graphics Corp. 592
‘paperless patent office’ 271, 272
parallel imports 697–8
‘parasitic’ damages 464
Parchomovsky, G. 4
Paredes, T.A. 13, 14, 15, 29, 63
Parikh, S. 15
Paris Accord 705
Paris Convention 129–30, 139, 146, 155,
157, 160–61, 357, 365–7
Article 1(3), definition of ‘industry’
367
Article 1 143, 366
Article 2 157, 623
Article 4, right of priority 158
final Protocol 366
‘industrial property’ 365–6, 367
priority 395–6
Paris-Route 275, 281
Park, J. 465
participation theories 468, 470
Partition Tree 343
party disposition principle 226–7
‘passing off’, UK 496–7
patentability, meaning of word 132
Germany 365
inherent 380, 381
Strasbourg Convention (Agreement) 368–9
and translation 199
TRIPS 373–6
patentability criteria, Sweden 88–9
patent application test 49
patent application backlog 272–3
patent auctions 150
patent capture 755–6
Patent Co-operation Treaty 82, 130, 136, 158, 161–3, 170, 194, 611
expansion of international search system 175
harmonization 163
objectives and structure 162
on patentability 371–2
patent application 304–7
correction of errors 306
obvious error principle 306
reform 174–6, 185–6
simplification and streamlining of system 175
time limit modification 175
translation issues 304–7
Written Opinion of the International Searching Authority 203
patent disputes
American Law Institute Project 638–41
arbitration 629–30
consolidation of worldwide claims 520–29
in a global economy 610–42
inaccuracy 629
litigant-mediated approaches, private agreements 629–33
litigant-mediated approaches 614–33
extraterritorial application of local law 614–20
prescriptive authority 617
resolution mechanisms 630–31
state mediated approaches 633–41
coordinated adjudication 635–41
dep harmonization 633–5
USA 252–8, 614–20
validity determination 629
patent/growth spiral 77, 81
patent infringement see infringement
patenting competence 86–7
Patenting Practices Within the Upper-Rhine Biovalley Network 28
patent law
and industry standards 731–4
utility in 357–9
Patent Law Amendment Act (1852) 126
Patent Law and Rent Dissipation 40
Patent Law Treaty 158, 164–70, 191
patent litigation, level of 142–3
patent misuse 750–51
Patent Office 82, 126
practice, software-related inventions 350–53
Patent Office Library 140
patent owners’ rights, exhaustion, European Community 501–18
patent policy issues, country specific 94–5
patent pools
attempted pools 716
in biotechnology 714–16
blocking patents 716
competing patents 716
complementary patents 716
in consumer electronics 717–18
humanitarian pools 715
one-shop pools 715
preemptive pools 715–16
Patent Prosecution Highway (PPH) pilot program 278–81
patent protection
Europe 443
through other tools of intellectual property 492–7
patent reform 47
USA 67
patent rights
and disclosures, as a governance mechanism 75–6
and monopoly power 58
as negative rights 135
strategic strengths 133–4
vulnerability 135
waiver of 505–7
patents
growth of roles 139–41
length of term 136–7
life-expectancy 137
as a national or regional right 136
origins and early use 101–3
strategic weaknesses 134–9
Patents Act (1883) 106, 126
Patents Act (1902) 126
Patents Act (1952) 47, 53
Section 271 60
Patents Act (1977) 126
Section 30 501
Section 39(3) 146
Section 42(3) 145
Section 70 152
Patents Versus Ex Post Rewards 28
patent system
advantages and drawbacks 68, 246–7
and economic growth 69
economic theories 70–76
spread of 127–31
as a two stage bargain 246
UK, development in the eighteenth
century 103–25
USA 16–17, 127
‘patent thicket’ 15, 17
in biotechnology 712
‘patent trolls’ 17–18, 152–3, 577
Patry, W. 45
Paulik v. Rizkalla 394
Pavlovich v. Superior Court 612
Payne, J.W. 14
Peets, L. 139
Penin, J. 28
Pennington Seed, Inc. v. University of
Arkansas et al. 551, 552
Pennoek v. Dialogue 388, 389, 391, 401
Peppenhausen v. Falke 526
Perfect 10 v. Visa Int’l Service Assoc.
467
Perfecting Patent Prizes 39
The Perils of Posnerian Pragmatism 28
The Permit Power Meets the
Constitution 15
‘permit thickets’ 15, 50
‘person having ordinary skill in the art’
(PHOSITA) 443–4
in assessment of extent of protection
446–51
comparison of UK, Japan, Germany
and USA 458–61
Germany 451–2
and Graham v. John Deere Co. 445
Japan 455–7
and KSR Int’l Co. v. Teleflex, Inc.
446
UK 453–5
USA 444–51
‘person skilled in the art’ (PSITA),
definition 446
Peters, F.E. 92
petty patents 129, 146, 357
Pfaff v. Wells Elecs. Inc. 392
pharmaceutical patents
sui generis regime 645–72
and system closure 669–70
see also Hatch-Waxman Act
pharmaceutical sector 134, 135, 171,
183–4, 515
authorized generics 656–60
Canada 562
Pharmon, BV v. Hoeschst, AG 506, 517
Phillips case 308, 312
Phillips, J. 101, 102, 110, 149, 150, 359,
466
Phillips v. AWH Corp. 444, 447, 448–9,
459, 461
‘baffle’, meaning of term 448–50
‘philosophical inquiry’ 529
Phytheron Int’l, SA v. Jean Bourbon, SA
509
Picard v. United Aircraft Corp. 51
Pigou, A.C. 23, 25
Pila, J. 361, 368
Pioneer Electronics Capital Inc. v.
Warner Music Manufacturing
484
pioneer patents 520, 521, 523
and secrecy 524
Piper Aircraft Co. v. Reyno 621
piracy 107, 110, 124
Pitcairn v. United States 527
Pitz, J. 484
plans and drawings, filing 110–11
plants and animals, patentability 181
Plastic Pipe 452
Plavix case 686, 691, 693
Plenius patent (1745) 108
Polanyi, M. 13
The Political Economy of Innovation 105
Porter, B. 660
positive law intellectual property regimes 60
positive patent law, and competition 59
Posner, R.A. 4, 13, 19, 22, 30, 75, 661
power of patents 134, 151–3
Prager, F. 360
Prantl (Criminal Proceedings against) 505
Pratt, J.W. 14
‘predicate act’ approach 615
Prepaid Telephone Calls 340, 343–4
prescriptive authority 617
Pressed Prism Glass Co. v. Continuous Glass Prism Co. 595
pre-standard acquisitions 733
price discrimination, and patents 59–60
Price v. Symsek 398, 404
Primos Inc. v. Hunter’s Specialities Inc. 133
Princetown Biochemicals, Inc. v. Beckman Coulter Inc. 420
priority art 47, 185, 247–8, 249, 308, 346
application pending as 385
compared to claims at issue 423–9
definition 384, 385
geographical limitations 408
scope and content, Graham and KSR cases 420–23
priority art effect 179, 180
priority
first-inventor to file, proposed 411–13
USA, definition 406–7
priority claim, under the European Patent Convention 193–5
priority document, translation 198–200
priority provision, first-to-file principle 383, 386–7
prior rights, European Patent Convention 214–19
The Private Production of Public Goods 59
private sector, pursuit of public goods 668–9
Privatizing the Commons 7
product life-cycle model 67
Professional Real Estate Investors v. Columbia Pictures Indus. 753
‘pro-patent side’ 43
property
intangible 154
patents as 148–9
property approach, governance perspective 71–5
property rights 23, 25, 34, 41, 65
and commercialization theory 55
Demsetz on 26–7
and monopoly power 58
patents as 3, 5, 42
and rent dissipation 7–8
The Property Rights Paradigm 26
property rules 5–6
information cost advantages 43
prospect theory 40–41, 54, 71, 73
protection see patent protection
protracted pendency 272–3
public choice problems 28–34, 44–50, 53
and intellectual property 48
public goods 26, 34
private sector pursuit of 668–9
public health, and patent rights 673–711
Pucke’s Patent (1718) 108
Pugh, T. 657, 658
purpose of patents, competing economic theories 34–64
quality, of patents 174, 247
R&D 76, 81, 82, 83
and experimental exceptions 525–35
research use exception 525–35, 555
Sweden 88
Rachlinski, J.J. 14
Radiant Burners, Inc. v. Peoples Gas Light & Coke Co. 735
Radio controlled clocks 484
Radio Steel and Mfg. Co. v. MTD Products, Inc. 596, 599
Radio Telefis Eireann v. E.C. Commission 512
Rai, A.K. 55, 61
Rambus Inc. v. Infineon Technologies AG 737, 756
Rambus, In re 729, 739, 749
Raskind, L.J. 35, 37
Rath, In re 625
Rationality as Process and Product of Thought

Rato, M. 746
Rav-Bariah v. Havshush 465–6
Rawls, J. 29
‘reasonable and nondiscriminatory’ (RAND) requirement 744–6

Reckitt & Coleman Products Ltd v. Borden Inc. 496
Record Carrier 333
Red Dove case 327
‘Red Dove Doctrine’ 327, 328
Redgrave v. Boston Symphony Orchestra, Inc. 640
Reed, K.L. 662

Reeves Bros., Inc. v. U.S. Laminating Corp. 390
regional agreements 159
registration of interests 149
The Regulation of Entry 32
regulatory review exception 536–41, 538
European Union 538
Germany 538, 539
Korea 538
UK 538
Reich, A. 675
Reichman, J.H. 561, 679
Reilly, ex parte (1790) 109
Reimer, E. 369

rent dissipation 6–7, 32, 34, 38, 40, 54
and property rights 7–8
‘rent dissipation theory’ 40–41
repair, interpretation of term 500
replacement parts see spare parts
Report of the Select Committee on Patents (1851) 126

research
exception, for research use 521, 522
as infringement 519
private, non-commercial 531
research use exception 521, 522, 554–6
biomedical research tools 553–4
de facto, USA 541–53, 554
de jure 525–41
de-minimus type argument 526, 527
Germany 530
Italy 539
Japan 531
regulatory review exceptions 536–41

USA 536–8
strategic aspects 523–5
UK 530–33
USA 525
‘residual claimant’ 7
res judicata 224
Resnick, D.B. 714
rewards 58
cost of 39–40
as the goal of patents 35–9
Rexnord Corp. v. Laitram Corp. 448
Rhenalu v. Alcoa, Inc. 433
Richardson v. Suzuki Motor Co. 565
Rich, G.S. 53
Richie, J. 658
Richman, B.D. 62
Richter, R. 29, 30, 32
Ricketson, S. 361
right of priority 158
Riley, J. 35
risk aversion 14
Rite-Hite Corp. v. Kelley Co. Inc. 589,
591, 598
Robbins Co. v. Lawrence Mfg. Co. 393
Robinson, C.K. 52
Robinson, D.A. 652
Robinson, F.J.G. 105, 124
Robinson, J. 22
392
Roche Nederland BV v. Primus 625, 627
Roche Products, Inc. v. Bolar Pharmaceuticals 525, 526–7, 529,
536
and the Hatch-Waxman Act 647–50
Roemer v. Simon 597
Roe, M.J. 50
‘root copy’ approach 615
Rotocrop International Ltd. v.
Genbourne Ltd. 478
Roussel-Uclaf SA v. Hockley International Ltd. 474
Royal Swedish Academy of Engineering Sciences 70
royalties 733, 734
royalty-free licenses 743–4, 747
Ruiz v. A.B. Chance Co. 433
Russia 702
R. v. Arkwright 122
R v. Eley 125

Toshiko Takenaka - 9781848446175
Downloaded from Elgar Online at 04/15/2019 06:33:52AM
via free access
Index  781

R v. Else (1785) 106, 120
Ryco Inc v. Ag-Bag Corp. 597
Ryco Manufacturing Co. v. Nu-Star, Inc. 445
Sabaf v. MFI Furniture Centres 484
Sage Products Inc. v. Devon Industries, Inc. 450
Samuelson, P.A. 10, 22, 722
Sandburg, B. 17, 577
Sandisk Corp. v. ST Microelectronics, Inc. 732
Sandvik Aktiebolag v. E.J. Co. 491
Sarnoff, J.D. 539
Sasse, In re 403
Scaltech, Inc. v. Retec/Tetra, L.L.C. 392
Schaumann, N. 46
Schechter, F. 101
Scherer, F.M. 70, 71
Schildkraut, M.G. 662
Schmeltzer, J. 36
Schumpeter, J.A. 43
Schwarcz, S.L. 62
SciMed Life Sys. v. Advanced Cardiovascular Sys. 448
Scotchmer, S. 67
Scott Johnston, J. 20
Scott Kieff, F. 3, 4
Scott v. Finney 399
search, duplication of 273–4
Search of Faulty Character Strings 328, 331, 339, 352
search results, pilot projects for testing mutual exploitation 274–6
Sears, Roebuck & Co. v. Stiffel Co. 136
secret prior art 410–11
Self-Service Delivery of Chip Cards 342
Sell, S. 160
Semiconductor Chip Protection Act (1984) 669
semiconductor chips 669
semiconductor devices 331, 688
Semiconductor Energy Laboratory Co., Ltd. v. Samsung Electronics Co., Ltd. 313
Semoto, K. 604
Sen, A.K. 29
Service, R.F. 712
service sector 174
Severn & King v. Imperial Insurance Co. 125
Sewell, B. 6
Shapiro, C. 15
Sharma, A. 18
Shavell, S. 7, 37, 38, 39, 43
Sheldon v. Metro-Goldwyn Pictures, Corp. 615
Shell Oil Co. v. Amoco Corp. 664
Shering Corp. v. Amgen, Inc. 447
Sherman Act 730, 749
Sherman, B. 480
Shibuya, T. 604, 606
Shinozuka, T. 585
Shleifer, A. 32
Shrivastave, B. 684
Simmenthal v. S.A. Import 517
Simon, H.A. 13, 14
Simon, J.H.M. 716
Simpson, A.W.B. 24
Singapore, contributory patent infringement 469
Singer, M. 385, 454
Singer, R. 385
size, of companies 69
Sjölander, S. 69
skills, level of ordinary skill in the pertinent art 429–33, 731
Slovic, P. 14
small inventors 404–5
small and medium-sized firms (SMFs), Sweden 79, 88, 98
Small, W. 124
Smith, A. 8
Smith, H.E. 41, 43, 64
Smith, J.W. 118
Smith Kline & French Laboratories Ltd. v. RD Harbottle (Mercantile) Ltd. 476
SmithKline Diagnostics, Inc. v. Helena Laboratories Corp. 590, 595, 596
social costs 249, 258, 270
socialization effect 9
social utility 356, 357
Société Anonyme des Manufactures de Glaces v. Tilghman’s Patent Sand Blast Co. 474
Society of Composers, Authors & Music Publishers of Canada v. Canadian Ass’n of Internet Providers 613
SodaStream 494
software 81, 260, 611–14
counter programs 326
infringements 465
legal provisions and development of
case law 325–35
reverse-engineering 611
‘technical effect’ 619
software-related inventions
business methods 339
comparison of EPO, German and UK
systems 348–50
current practice 337–50
EPO 337–9
data carriers 330
definition of technical features 334
Germany, current practice 339–44
human interference in 330
insufficient instruction in claim 334
and inventive step (non-obviousness)
requirement 334, 338, 342, 343
liberalization of approach 329
and mathematical algorithms 343
non-technical features 339
patentability 330
patenting in Europe 325–54
Patent Office practice 350–53
control data 352–3
data handling 352
dialog methods 353
operation of a computer 351
post-computer process activities
350–51
pre-computer process activities
350–51
user interface 353
political developments 335–7
program product claims 330
and revised EPC 335
technical features 337–8
UK 333
current court practice 344–8
four step test 345–6
SOHEI 339
Solomonic Bargaining 20
Soup Recipe 327
South Africa
contributory patent infringement 469
Medicines and Related Substances
Control Act (1997) 564
Southwest Software, Inc. v. Harlequin
Inc. 311
spare parts
and antitrust law 497–9
USA 499
and competition law 494–7
France 496
and copyright law 492
and design law 493
Germany 489–90
antitrust law 497–9
competition law 494–5
scope of patent protection for 488–92
and trademark law 493–4
UK 490
competition law 496–7
USA 490–91
specifications 122
enrollment of 106–110
failure to enroll 110
filing 107–8
specific subject matter of patents,
Europe 510–12
Spectrum Int’l. v. Sterilite Corp. 448
Spectrum Sports v. McQuillan 730
Speech Analysis Device 331, 332
Spence, A.M. 31
Spence, D.B. 31
Sperry Gyroscope Co. v. Arma
Engineering Co. 544
Stac Elecs. v. Microsoft Corp. 615
Standard Format Proposal 286
Standard Oil Co. v. Am. Cyanide Co.
445
standards 172–3
government-generated 751–5
information deficiency/overload
problem 752–3
industry-generated 734–51
market-generated 724–31
network effects 725, 735
sunk costs 725, 735
standard setting organizations (SSO)
723, 735, 736–7, 740, 748
abuse of decision making process 735
collusion 750
‘compliant implementation’ 743
‘essential to compliance’ undertaking
742
‘fair, reasonable and
nondiscriminatory’(FRAND) requirement 744
non-assertion/licensing undertaking 741–3
participant duties 737–9
‘reasonable and nondiscriminatory’(RAND) requirement 744–6
shortcomings 739–40
Standing Committee on the Law of Patents 176
Staniszski, P. 134
stART Licensing 715
State Industries, Inc. v. Mor-Flo Industries, Inc. 596
State Intellectual Property Office of China (SIPO) 186
State Papers Domestic (1710) 107
static efficiency, and dynamic efficiency 21
Statute of Monopolies (1623–4) 102, 103
statutory bars, USA 388
Stauder, D. 454
Stearns, M.L. 28
Steele v. Bulova Watch Co. 617, 618
Steinbrook, R. 672
Stevens v. Tamai 307
Stigler, G.J. 8, 24, 31
Stiglitz, J.E. 7
Strandberg, K. 554
Strasbourg Convention (Agreement) 140, 159, 361
‘industrial applicability’ 371
patentability 368–9
strategic strengths, of patents 133–4
strategic weaknesses, patents 134–9
Straus, J. 385
Stubblebine, W.C. 36
Sturtevant’s Patent 107
subject-matter, of patent protection 145–6
Substantive Patent Law Treaty (proposed) see draft Substantive Patent Law Treaty
sui generis 48
sui generis regime, of pharmaceutical patents 645–72
Sullivan, K.M. 31
Sun, H. 582
sunk costs 725, 735
surgical, therapeutic and diagnostic methods (STD methods) 93–4
Suthersanen, U. 147
Swanson, D.G. 745
Sweden 70, 306–7
control problems 85
entrepreneurship 85–6
general model of national system of innovation and entrepreneurship 78
intellectual property 88
patentability criteria 88–9
patenting competence 86–7, 100
patenting decline 82–4
patents, innovations and growth 79, 81–2
R&D 88
raising of the inventive step (non-obviousness) requirement 89–90
small and medium-sized enterprises (SMEs) 79, 88, 98
study on economic aspects of patenting 76
analytical framework and design 77–9
empirical results 79–84
methodological design 80–81
patent/growth spiral 77
policy recommendations 84–94, 97–100
technical character requirement 90–93
Swedish Patent Office 70, 83, 98–9
Symmetric Tragedies 61
Symmons, C.R. 382
A Systems Approach to Corporate Governance Reform 63
Szalewski, S.J. 496
Takabayashi, R. 457, 604, 606
Takeda Chemical Industries, Ltd. v. Alphaharm Pty. Ltd. 434, 436–7, 438
Takenaka, T. 67, 133, 383, 407, 454, 458, 460, 585, 634
Takeshita, M. 591
Takeuchi, A. 586
Talley, E. 20
Tamoxifen Citrate Antitrust Litigation, *In re* 663
tamura, Y. 589, 604
Tanaka, H. 586
Tap Pharmaceutical Products, Inc. v. Owl Pharmaceuticals, L.L.C. 311
taxes 74
taylor, K. 395
‘teaching-suggestion-motivation’ (TSM) test 415, 416, 418, 419, 421, 424, 436
Teague patent 422
Tec Air Inc. v. Denso Mfg. Michigan Inc. 392
technical effects 329, 330, 331, 619
technical knowledge 248
technical subject matter 329
‘technification’ 92
technology 325–6
defining 370
*Technology and Culture* 125
technology exploitation 67–8, 71
technology-specific considerations, non-obviousness 438
technology transfer mechanism, patent as 139
Tegic Communications Corp. v. Board of Regents of the University of Texas System 550
Tellex Inc. v. KSR Int’l Co. 419
term, of patents 136–7
terms of art 355
territorial restrictions 513–14, 611, 612–14
Teva Pharmaceutical Industries, Ltd. v. Crawford 660
Teva Pharmaceutical USA, Inc. v. Novartis Pharmaceuticals Corp. 665–6, 667
Teva Pharmaceutical USA, Inc. v. Pfizer, Inc. 665
Thailand
Abbott 694
compulsory licensing 685–6, 689, 690–91, 693–5
Thesis, *In re* 393
The Theory of Economic Relations 31
Thetford Corp. and another v. Fiamma, SpA and others 515, 517
Thomas, J.R. 380, 615, 620
Thomas, R.P. 62
Thomas v. Jones 119
Thompson v. Australian Capital Television Pty Ltd. 486
three unities concept 466–7
Tirole, J. 22
‘tollbooth’ problem 32–3
‘Tooke Committee’ 361
tort law 737
Japan 585, 586–9
Toshiko, T. 50
*Toward a Theory of Property Rights I* 23, 25, 26
*Toward a Theory of Property Rights II* 23, 25, 27
Toyama, T. 590
trade 9
Trademark Law Treaty 166
Trademark Regulations, European Community 511
trademarks 8, 53, 60, 101, 103
European trade mark law 474
and patent law 147–8
trademark law, and spare parts 493–4
and TRIPs 136
UK 501
The Tragedy of the Anticommons 15, 26
The Tragedy of the Commons 26–7
*A Transactional View of Property Rights* 5
transaction costs 8, 10, 29–30, 34, 39, 260
business models 11
of exchanges 60–61
of infringer and owner 11–12
of patents in biotechnology research 10–11
zero 25
transactions
benefits of 8–10
over patents 16–17
and specialization 9
translation
costs of 302, 318
cultural and grammatical subtleties 290–91
‘Edinburgh’ patent 295–6
Europe 293–304
and interpretation 290
meaning of term 290
and the Patent Cooperation Treaty
304–7
patent translation errors 288–318
safeguards 292
translation issues
Japan 314–17
USA 307–14
treaties 156–9
_Treatise on the Law of Patents_ (Collier) 118
_Treatise on the Law of Patents_ (Hindmarsh) 118
_A Treatise on the Law relating to Patent Privileges for the Sole Use of Inventions_ 361
‘treaty’, definition of word 156
Treaty on Intellectual Property in Respect of Integrated Circuits 172
Treaty of Rome 502
Treaty to Exclusionary Abuses,
European Commission 498
_Trice Prods. Corp. v. Delman, Corp._ 390
Trilateral cooperation 271–87
Memorandum of Understanding 272
Trilateral Meeting for Workload Reduction of Offices and Associated Costs 272
Trilateral Offices 271
cooperation in patent practice 272
Examiner Exchange program 284–5
historical background 271–2
new legal system 281
New Route proposal 281–3
Paris-route 275
Patent Prosecution Highway (PPH) pilot program 278–81
pillar one: dossier access system with machine translation 277, 279
pillar two: framework to address timing issues for enhancing sharing and utilization 277–84
pillar three: harmonization of patent laws and practices 284–6
pillar projects for testing mutual exploitation of search and examination results 274–6
timing issue 275–6
Standard Formal Proposal 286
Strategic handling of applications for rapid examination (SHARE) 283–4
tri-way proposal 283
TRIPS 130–31, 138, 139, 165, 166, 170–73, 610, 619, 671
access to medicines in developing countries 182–3
Annex 184
Article 3.1 157
Article 7 155
Article 8 179, 581
Article 9 145
Article 27(1) 143, 148
Article 27.3(b) 181
Article 28 560
Article 29bis 181–2
Article 30 576–9
substantive-based exception 561–2
Article 31 576, 686–7, 690
procedural-based exception 562–4
Article 41 623
Article 44 579–81
Article 71.1 181
background 674–98
compulsory licensing 558–64, 685–95
‘national emergency’ 686, 689–90, 691–2
as a non-existent option 693–4
parallel imports 697–8
permissible subject matter 687–9
prior negotiations 690–91
public-non-commercial use 692–3
Thailand 685–6, 689, 690–91, 693–5
coverage 171
data protection 678–9
and developing countries 675, 696–7
direct infringements under 464
as a dispute settlement system 171–2
 eBay
analysis and application under 572–81
compliancy of 576
enforcement 679–80
enforcement procedures 171
exceptions from patent rights 678
geographical coverage 171
and harmonization 172
‘mailbox’ provision 684–5
origins 674–6
overview 676–9
patentability 373–6, 675, 680–84
of plants and animals 181
patentable subject matter 677
patent rights
‘limited exception’ 684–5
scope 677–8
public health issues 676
review 180–82
standards for patent use 172–3, 463–4, 676
and trademarks 136
and utility 355, 378
wording of drafts 373–5
TRIPS-plus agreements see free trade agreements
tri-way proposal, Trilateral Offices 283
Tronzo v. Biomet, Inc. 309
Tubular Rivet and Stud Cuko. v. O’Brien 482
Tulloch, G. 32
Turner v. Winter (1787) 104, 117, 118, 122, 123
Tversky, A. 14
Twentieth Century Fox Film Corp. v. iCraveTV 612
Two Identities/COMVIK 337, 338, 351
Two Pesos, Inc. v. Taco Cabana, Inc. 493
Tyrer, L. 377
Ubel, F.A. 410
UK
Acts of Union (1706, 1707) 103
chooses 501
‘Crown Right’ doctrine 541
development of patent system in the eighteenth century 103–26
expense of procedure 124–5
traditional account 105–14
transfer from Council to courts 105–6
doctrine of inutility 361
early patent system 102–3
law of patents (1800) 120–25
‘passing off’ 496–7
Patents Act (1977) 126, 146, 152, 361, 501, 505, 530
‘person having ordinary skill in the art’ (PHOSITA) 453–5
compared to Germany, Japan, and USA 458–61
reform of patent system 125–7
regulatory review exception 538
research use exception 530–33
software-related inventions 333
spare parts
and competition law 496–7
protection for 490
Statute of Monopolies (1623) 148, 359, 360–61
UK Intellectual Property Office (UKIPO) 280
Ulen, T. 20
Ullrich, H. 359, 365
UMC Elecs. Co v. United States 392
uncertainty, in enforcement 20
Understahl, B. 657, 658
Union Carbide Chemicals v. BP Chemicals Ltd. 481
Union Oil Co. of California, In re 748
United Horse-Shoe & Nail Co. v. John Stewart & Co. 477
United Kingdom Patent Law 361
United Mine Workers v. Pennington 753
United Nations Treaty Collection 156
United States v. Aluminum Co. of America 725
United States v. Container Corp. of America 735
United States v. Grinnell Corp. 726
United States v. United Shoe Mach. Corp. 726
United Wire v. Screen Repair Services (Scotland) Ltd. 476, 490
unity
of action 466
dramatic doctrine of 466
of space 466
territorial dimension 482–4
of time, and direct infringement 474–82
**Update Art, Inc. v. Modiin Publ’g, Ltd.**
615, 616, 618
USA 136

American Inventors Protection Act (1999) 410
analogous art test 421, 422
Bayh-Dole Act 523, 528, 544
government license defense 545–8
biotechnology 363
Board of Examiners 108
challenges to patent’s validity 249, 259
compensation, for infringement, comparison with Japan 584–608
consolidated litigation 621–3
court invalidation 249
copyright infringement 468, 469
Copyright Remedy Clarification Act (CRCA) 459
costs of patent litigation 251, 259–60
Court of Customs and Patent Appeals (CCPA) 363
court invalidation 249
eyearly Patent Acts 362
eyearly patent system 108
eBay
doctrinal implications on patent law 568
failure to commercialize as basis for denial of injunction under 569–72
examination requirement 127
extension of term 137
extraterritorial application of local law 614–20
‘federal question’ jurisdiction 621–2
Federal Trade Commission 655
first-inventor to file, proposed 406–13
‘being patented’, definition 408
condition for revision 412–13
disclosure 411–12
novelty 407–10
priority 411–13
first-to-invent system 215, 219, 383, 387, 458
abandonment 393–4, 398, 408
completeness of inventions 392–3
complexity 389
concealment 398
discrepancy between statutory language and practice 399–406
experimental-use exception 391
foreign-originated inventions 395
grace period 388–9, 400–402, 412
interference 403–4
novelty 388–97, 400–402
printed publications, definition 393
prior art 396–7, 408
priority 395–7, 397–9
priority provision 402–6
‘public use or on sale’, interpretation of 391, 392, 394, 407, 408
sale bar 392–3
subject matter, interpretation of 391
suppression 398
foreign-filed patents 309, 394–5
and foreign patents 390
and harmonization 165
Hilmer doctrine 179, 219, 284, 409–10
infringement 251
definition of 536
indirect 473
remedies under patent law 565–6
infringement damages compared to Japanese pre-1998 practice 590–600
entire-market-value rule 597
lost profits 590–97
patent law policy 589
inter partes reexamination procedure 250–51
Lanham (Trademark) Act 617
Manual of Patent Examining Procedure 313
Markman hearing 312
misappropriation doctrine 497
non-obviousness 414
Panduit Test 595, 602, 603, 606
Patent Act (1793), novelty provision 389
Patent Act (1839) 401

Toshiko Takenaka - 9781848446175
Downloaded from Elgar Online at 04/15/2019 06:33:52AM
via free access
patent disputes 252–8
empirical studies 252–8
cases adjudicated on merits 253
expenditure, by type of ruling 256–7
expenditure differences across outcomes 255–6
expenditure in patent cases 254, 254–5
infringement and invalidity rulings 253–4
invalidity rulings 257–8
patent law
compliance with TRIPS 378–9
in utility 355, 359
Patent and Plant Variety Protection Remedy Clarification Act (PRCA) 459
patent protection 443
patent reform 67
patent system 16–17, 45, 127
‘person having ordinary skill in the art’ (PHOSITA) 444–51
compared to Germany, UK, and Japan 458–61
prior art, definition 388, 390
priority disputes 307
private agreements 633
‘pro-patent policy’ 584
recalibration of patent bargain 731
research use exception 525–7, 540–41
de facto 541–53
regulatory review exceptions 536–8
Section 1498: government use clause 541–5
state sovereign immunity 548–53
secret prior art 410–11
spare parts
and antitrust law 499
protection 490–91, 497
statutory bars 388, 393
‘teaching-suggestion-motivation’ (TSM) test 415, 416, 418, 419
tort, and patent policies 586–9
translation errors
certificate of correction 310
correction 309–11
during prosecution 309–10
judicial correction 311–12
‘new matter’ standard 310
‘reissue’ of patents 310
translation issues 307–14, 318
duty of candour and disclosure 312
interpretation disputes 311–12
‘United States English’ 309
utility 363
standards 363
see also Hatch-Waxman Act
US Department of Commerce (DOC) 278
The Use of Knowledge in Society 248
US Patent and Trademark Office (PTO) 84, 127, 186, 246–9, 272, 279
administrative reform 260
analogous art 421
application backlog 273
Examination Guidelines for Determining Obviousness 435–6
opposition system proposed 260–64
fee schedule 264
post-grant systems 263–4
pre-grant systems 262–3
reexamination 249–50
reform of 258–65
‘The 21st Century Strategic Plan’ 273
U.S. v. Palmer 542
US–Australia free trade agreement 700
US–Chile free trade agreement 700
US–Korea free trade agreement 699
US–Oman free trade agreement 699, 700
US–Panama Trade Promotion Agreement 699
US–Peru free trade agreement 700
utilitarian law 3
utility 379–81
in the age of revolution 362–4
definition and meaning of 376–7
historical origins 359–65
and industrial applicability 382
and industrial and intellectual property 356–7
place in patent law 357–9
and TRIPS 355, 378, 379
USA 355, 359, 363
utility model 140–41, 357
validity, of patent rights 135
Valley Drug Co. v. Geneva
Pharmaceuticals, Inc. 663
Vandoren, P. 183
Van Eekhauta, J.C. 183
Van Horn, C.E. 410
Vanity Fair Mills, Inc. v. T. Eaton Co. 618
van Pottelsberghe, B. 67
van Ypersele, T. 7, 37, 38, 39
Varian, H.R. 23
Vas-Cath, Inc. v. Curators of the
University of Missouri et al. 550
Velcro, SA v. Aplix 514
Venetian Republic
Statute of 1474 359
utility requirement 360
Verizon Communications Inc. v. Law
Offices of Curtis V. Trinko, LLP 499, 727, 729
Verkey, E. 143
vicarious liability 467
Vicom 328, 345, 348–9
Vienna Convention on the Law of
Treaties 156, 376, 679
View from the Bench 61
Voda v. Cordis Corp. 622, 626, 632
Volvo, AB v. Erik Veng (UK) Ltd. 517
voting preferences 29–31
Wadlow, C. 358, 380
waiver of patent rights 505–7
Walker Process Equip., Inc. v. Food
Mach. & Chem. Corp 728
Wallace and Tireman Co. v. Syracuse 595
Wallis, J.J. 8
Walsh, J.P. 12, 61
Wang Labs. v. Mitsubishi Elecs. Am.,
Inc. 12
Warner-Jenkinson Co. v. Hilton Davis
Chem. Co. 443, 444, 447, 451,
458, 461, 462, 731
Warner-Lambert v. Apotex 480
Watal, J. 170, 687, 688, 689, 692
Watson, M.S. 718
Watt, J. 120, 121
Waxman, H. 682
weak patents 50, 51–2
Wealth and Welfare 23
Webster 104, 118
Webster’s Patent Cases 117
Wegner, H.C. 583
Weingartner, S.T. 151
Weingast, R. 15
Weinstock Netanel, N. 55
Wells Fargo & Co. v. Wells Fargo
Express Co. 618
Wendell Holmes, O. Jr. 19
Westbrook, J.L. 641
Westinghouse v. New York Air Brake Co. 597
Weston, A. 120
Wheaton, J.J. 650
Whitman, D.J. 392
Whittemore v. Cutter 521, 525
Whobrey, W. 645
Wieczurek, R. 396
Williamson, O.E. 4, 13–14
Windsurfing International Inc. v. AMF
Inc. 729
Windsurfing International Inc. v. EC
Commission 514
Windsurfing International v. Trilantic 478
Winship 105
WIPO Intellectual Property Handbook 160
WIPO Patent Report 154
W.L. Gore & Assocs. v. Garlock, Inc. 391
Wolff, S. 28
World Health Organization (WHO) 707
biological standards 719
World Intellectual Property Organization
(WIPO) 130, 156, 610
Collection of Laws for Electronic
Access 468
digital access service 186
and harmonization of patent law 285,
633–4
‘Reduced package’ proposal 285
World Trade Organization 130–31, 171,
673–4
Dispute Settlement Understanding
(DSU) 679
Worrell, C. 659
‘worthiness’ 8
Yahoo! Inc. v. La Ligue Contre Le Racisme et L’Antisemitsme 612
Yale Lock Co. v. Sargent 595
Yingping, J. 358
Yoo, C.S. 21
Yoon, Y.J. 61
Young, Ex Parte 550, 551, 552

Young, M. 139
Young v. New Haven Advocate 612
Yukio, N. 621

Zamiska, N. 694
Zang, I. 658
Zino Davidoff SA v. A&G Imports Ltd. 474, 506