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SIXTEENTH ANNUAL FALL LECTURE

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PATENTLY NONOBVIOUS:

THE IMPACT OF HINDSIGHT BIAS ON PATENT DECISIONS



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THURSDAY, OCTOBER 22, 2009

The Houston Club

811 Rusk Avenue, Houston, Texas

Reception 5:30 p.m. - Lecture 6:15 p.m.

One Hour of CLE Credit

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PATENTLY NONOBVIOUS: THE IMPACT OF HINDSIGHT BIAS ON PATENT DECISIONS

What is the effect of hindsight knowledge of an invention on evaluating the invention's nonobviousness? Though concern over the hindsight effect has been noted for some time and was central to the Supreme Court's *KSR v. Teleflex* decision, experiments reveal that the hindsight bias distorts nonobviousness decisions far more than has been appreciated, and that the jurisprudence developed around nonobviousness decisions fails to properly account for the bias. The hindsight bias also appears to impact a wider array of patent doctrine than previously recognized, including enablement, claim construction, and the doctrine of equivalents.



Gregory N. Mandel is Professor of Law at Temple Law School. He specializes in intellectual property law and the interface among technology, science, and the law, with a particular focus on patent, biotechnology, and nanotechnology law. Professor Mandel's article, *Another Missed Opportunity*, was selected as one of the top patent articles of 2008. He served on an American Bar Association task force which briefed the Environmental Protection Agency on arising nanotechnology issues and is the recipient of a Fulbright Senior Specialist grant to teach U.S. intellectual property law to foreign law students. He is a frequent speaker on intellectual property and technology law issues and has presented his work internationally at over thirty law schools, as well as for the United Nations, Second Circuit, Environmental Protection Agency, and American Bar Association. He has consulted with senators and representatives, administrative agencies, and private entities concerning technology legislation and how society should handle new technologies and technological risk. His experimental studies have been cited in several briefs filed with the U.S. Supreme Court.

Professor Mandel received his undergraduate degree in physics and astronomy from Wesleyan University and worked on NASA's Hubble Space Telescope prior to attending law school. He received his J.D. from Stanford, where he was Co-Editor-in-Chief of the Stanford Environmental Law Journal. Before entering academia, he practiced law with Skadden, Arps, Slate, Meagher & Flom LLP, clerked for Judge Jerome Farris, U.S. Court of Appeals for the Ninth Circuit, and interned with Chief Judge Anthony J. Scirica, U.S. Court of Appeals for the Third Circuit. Professor Mandel was Associate Dean for Research & Scholarship and Professor of Law at Albany Law School prior to joining Temple. He currently teaches patent law, advanced patent law, and property.



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