

Syllabus for Patent Law I

Law 284-001

Fall 2022

2 Credits

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I. COURSE MATERIALS.

Robert Patrick Merges and John Fitzgerald Duffy, Patent Law and Policy: Cases and Materials (8th ed. 2021).

Supplemental materials on Blackboard.

II. LEARNING OUTCOMES

By the end of the course, students should have an understanding of the principles of patent law and the structure of the American patent system. Students should achieve proficiency in reading the patent document, analyzing patent claims, and evaluating patent validity. Students should also have an understanding of the moral and economic policy considerations underlying patent law.

III. OFFICE HOURS.

Office hours are Wednesday from 4-6pm. You do not need to make an appointment to see me at those times, though you are welcome to send an email ahead of time to let me know to expect you. I realize that many students work during the day and I am happy to meet at other times if you email me for an appointment. Generally, email is a more reliable way to reach me than phone.

Based on current conditions, I plan to hold in-person office hours, with face masks for everyone. If you prefer to meet remotely, that can be arranged.

IV. GRADES.

Your grade will be based on the final exam, which is graded blindly. The final exam will be open book. Additional details regarding the exam will be determined later in the semester.

V. REMOTE TEACHING.

This class will be conducted remotely via Zoom. You will need a computer with a good internet connection, a camera, and a microphone. To facilitate interaction, please keep your camera on at all times while class is in session, even if you are not speaking, though you may use a virtual background if you wish to keep your surroundings private. You should mute your microphone unless you are speaking.

All classes for this course will be recorded this semester. If you become medically incapacitated and unable to attend class, recordings of the classes that you are unable to attend will be made available for you to watch later. Because class involves a great deal of question-and-answer interaction, watching a static

recording is generally inferior to participating live. In order to encourage everyone to participate live to the maximum extent possible, recordings will only be made available to students who are medically prevented from participating live; the recordings are intended to be a last-resort backup, not a convenient alternative to attending class when scheduled. For the same reasons, please do not make your own recordings or distribute any recordings to which you have been given access.

VI. ASSIGNMENTS

Generally, we will cover one segment per class. If we fall behind, we will carry over material to the next class. The assignments are also subject to change depending on our progress.

The assigned pages include both the excerpted cases and the casebook authors' notes about them. I recommend reading the notes, but we will focus mainly on the cases in class. Where the notes are particularly important, I have noted this fact.

Please ensure that you read the supplemental materials on Blackboard.

1. Introduction to Patents

Merges and Duffy 20-44, 58-67, 276-277

Lowell v. Lewis, 15 Fed. Cas. 1018 (C.C.D. Mass. 1817)

You may be called upon in class to perform the claim drafting exercise.

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U.S. Patent No. 6,436,015 (weight plate)

U.S. Patent No. 5,734,961 (method for transmitting information)

2. Novelty I: Anticipation Requirements

Merges & Duffy 79-85, 164-178, 187-194

In re Robertson, 169 F.3d 743 (Fed. Cir. 1999)

In re Seaborg, 328 F.2d 996 (C.C.P.A. 1964)

In re Hafner, 410 F.2d 1403 (C.C.P.A. 1969)

Please read note 6 on pp. 172-174.

3. Novelty II: Patents and Printed Publications

Merges & Duffy 85-88, 133-149, 215-221

In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004)

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Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390 (1926)

4. Novelty III: Prior Use and Sale

Merges & Duffy 114-127, 88-104

Egbert v. Lippmann, 104 U.S. 333 (1881)

Moleculon Res. Corp. v. CBS, Inc., 793 F.2d 1261 (Fed. Cir. 1986)
Pfaff v. Wells Elec., 525 U.S. 55 (1998)

5. Novelty IV: Secret Use and Sale; Experimental Use

Merges & Duffy 127-131, 104-113

Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516 (2d Cir. 1946)

Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc., 139 S. Ct. 628 (2019)

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W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983)

City of Elizabeth v. Am. Nicholson Pavement Co., 97 U.S. 126 (1877)

6. Novelty V: Priority Between Competing Applicants

Merges & Duffy 146-164, 225-247

Brown v. Barbacid, 276 F.3d 1327 (Fed. Cir. 2002)

7. Obviousness I

Merges & Duffy 325-368

Hotchkiss v. Greenwood, 52 U.S. 248 (1851)

Graham v. John Deere Co., 383 U.S. 1 (1966)

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In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

8. Obviousness II

Merges & Duffy 384-404, 424-438

KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398 (2007)

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Stanford University v. Roche Molecular Sys., Inc., 563 F.Supp.2d 1016 (N.D. Cal. 2009)

9. Utility and Enablement

Merges & Duffy 269-276, 278-283, 286-295, 478-485

Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364 (Fed. Cir. 1999)

Brenner v. Manson, 383 U.S. 519 (1966)

Janssen Pharmaceutica v. Teva Pharmaceuticals USA Inc., 583 F.3d 1317 (Fed. Cir. 2009)

10. Disclosure and Patent Scope

Merges & Duffy 453-478, 491-501

The Incandescent Lamp Patent Case, 159 U.S. 465 (1895)

Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473 (Fed. Cir. 1998)

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In re Angstadt, 537 F.2d 498 (C.C.P.A. 1976)

Automotive Techs. Int'l, Inc. v. BMW, 501 F.3d 1274 (Fed. Cir. 2007)

11. Patentable Subject Matter I: Nature

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Lab Corp. of Am. v. Metabolite Labs., Inc., 548 U.S. 124 (2006)

Am. Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1 (1931)

Merges & Duffy 541-548, 571-584

Diamond v. Chakrabarty, 447 U.S. 303 (1980)

Ass'n for Molecular Pathology, Inc. v. Myriad Genetics, Inc., 133 S. Ct. 2107 (2013)

12. Patentable Subject Matter II: Abstract Ideas

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Gottschalk v. Benson, 409 U.S. 63 (1972)

Parker v. Flook, 437 U.S. 584 (1978)

Diamond v. Diehr, 450 U.S. 175 (1981)

Merges & Duffy 548-558

Bilski v. Kappos, 561 U.S. 593 (2010)

13. Patentable Subject Matter III: The Modern Landscape

Merges and Duffy 558-571, 584-602

Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66 (2012)

Alice Corp. v. CLS Bank Int'l, 573 U.S. 208 (2014)

Please read note 2 on pp. 595-599.