

# Syllabus for Patent Law II

Law 292  
Spring 2022  
2 Credits

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## I. COURSE MATERIALS.

Robert Patrick Merges & John Fitzgerald Duffy, *Patent Law and Policy: Cases and Materials* (7th ed. 2017).

- The 8th edition (2021) is also acceptable. Page numbers are based on the 7th edition.

Additional cases and materials will be posted on Blackboard.

Copy of Title 35 of the U.S. Code.

## II. LEARNING OUTCOMES.

By the end of the course, students should have an understanding of the doctrinal principles of patent law and the policy considerations that underlie this body of law. Additionally, students should learn general skills on how to read and analyze cases and other legal materials, to identify and respond to legal problems, to make legal arguments, and to apply legal rules to facts.

## III. OFFICE HOURS.

Office hours are Tuesdays from 4-6pm. Due to the pandemic office hours will be on Zoom until further notice. Please email me to set up a Zoom link. I am also happy to meet on Zoom at other times if that is more convenient.

## IV. GRADES.

Your grade will be based on the final exam, which is graded blindly. The knowledge from Patent Law I is integrated into this class, and will be part of the final exam. Additional details regarding the exam will be determined later in the semester based on conditions at the time. The current plan is for grades to be awarded on the standard law school curve.

## V. COVID-19

The current plan is for the class to be taught in-person. However, the situation is extremely uncertain and there is at least the possibility that we may have to change to online class. We may also use online class for snow days. You should have the proper equipment (webcam, internet) for that possibility. If online class is necessary we will use the following Zoom link: <https://gmu.zoom.us/j/4624306081>.

For in-person class, face masks are required for all students, even if you are fully vaccinated and boosted. You must wear your mask so that it fully covers your nose and mouth, and you should keep your mask on at all times indoors, even when you are speaking in class. If you have an exemption from the vaccination requirement, you must comply with the masking requirement and additionally maintain distance from others.

If you are experiencing symptoms of Covid-19 or any other respiratory illness, please do not come to class until you fully recover. Even if you are vaccinated. Even if you test negative for Covid-19. Not only is there the possibility of a breakthrough infection or a false negative test, there is the possibility of some other illness such as influenza or the common cold that you should not want to transmit to your classmates.

## **VI. ASSIGNMENTS**

Generally, we will cover one topic per class. These assignments are subject to change depending on our progress in class. The page references after the case citation are to the pages in the casebook. The assigned pages include both the excerpted cases and the casebook authors' notes about them. I recommend reading the notes, even though we will focus mainly on the cases in class.

Please ensure that you read the materials from Blackboard for class. These are as important as the casebook materials.

Finally, you should obtain a copy of the patent statute, Title 35 of the U.S. Code, including the provisions that existed before the enactment of the America Invents Act. You should be regularly consulting the statute for relevant provisions (usually, but not always, expressly mentioned in cases or the casebook) when preparing for class.

### **1. Infringement I: The Basic Framework**

Merges and Duffy 706-712, 645-663

*Winans v. Denmead*, 56 U.S. 330 (1854)

*Merrill v. Yeomans*, 94 U.S. 568 (1877)

*Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)

Blackboard

*Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Lourie, J., dissenting)

### **2. Infringement II: Claim Construction and Patent Scope**

Blackboard

*Retractable Techs. Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296 (Fed. Cir. 2011)

*Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898 (Fed. Cir. 2004)

*SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870 (Fed. Cir. 2004)

### **3. Infringement III: Interaction with Other Doctrines**

Blackboard

*Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371 (Fed. Cir. 2007)

*O'Reilly v. Morse*, 56 U.S. 62 (1854)

Merges & Duffy 730-736

*Westinghouse v. Boyden Power Brake Co.*, 170 U.S. 537 (1898)

### **4. Infringement IV: The Doctrine of Equivalent**

Blackboard

*Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997)

Merges & Duffy 713-725

*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002)

### **5. Infringement V: Secondary Infringement**

Blackboard

*MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005)

Merges & Duffy 756-782

*Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476 (1964)

*Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754 (2011)

*Commil USA, LLC v. Cisco Systems, Inc.*, 575 U.S. 632 (2015)

### **6. Infringement VI: Joint and Divided Infringement**

Blackboard

*Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301 (Fed. Cir. 2012) (en banc)

*Intellectual Ventures I LLC v. Motorola Mobility LLC*, 870 F.3d 1320 (Fed. Cir. 2017)

Merges & Duffy 687-694

*Limelight Networks, Inc. v. Akamai Techs., Inc.*, 572 U.S. 915 (2014)

*You should read the cases in chronological order (i.e. the Federal Circuit's Akamai decision, the Supreme Court's decision, and then Intellectual Ventures).*

### **7. Inventorship and Ownership**

Merges & Duffy 1003-1011, 1046-1061

*Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223 (Fed. Cir. 1994)  
*United States v. Dubilier Condenser Corp.*, 289 U.S. 178 (1933)

Blackboard

*Stanford University v. Roche Molecular Sys.*, 583 F.3d 832 (Fed. Cir. 2009)

## **8. Defenses I: Inequitable Conduct; Misuse**

Merges & Duffy 978-992, 1099-1117

*Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011)  
*Ill. Tool Works Inc. v. Indep. Ink, Inc.*, 547 U.S. 28 (2006)

Blackboard

*Precision Instrument Mfg. Co. v. Automotive Co.*, 324 U.S. 806 (1945)

## **9. Defenses II: Experimental Use; Exhaustion**

Merges & Duffy 743-750, 1145-1158

*Madey v. Duke University*, 307 F.3d 1351 (Fed. Cir. 2002)  
*Quanta Computer, Inc. v. LG Elec., Inc.*, 128 S. Ct. 2109 (2008)

Blackboard

*Impression Products v. Lexmark Int'l, Inc.*, 137 S.Ct. 1523 (2017)

## **10. Damages I**

Merges & Duffy 840-851

*Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538 (Fed. Cir. 1995) (en banc)

Blackboard

*Panduit Corp. v. Stahlin Bros. Fibre Works*, 575 F.2d 1152 (6th Cir. 1978)  
*Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543 (Fed. Cir. 1997)  
*Monsanto Co. v. McFarling*, 488 F.3d 973 (Fed. Cir. 2007)

## **11. Damages II**

Merges & Duffy 817-835

*Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301 (Fed. Cir. 2009)

Blackboard

*Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286 (Fed. Cir. 2014)

*Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 136 S. Ct. 1923 (2016)

## **12. Injunctions**

Merges & Duffy 791-807

*EBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006)

*Please read the two concurring opinions.*

Blackboard

*Paice LLC v. Toyota Motor Corp.*, 504 F.3d 1293 (Fed. Cir. 2007)

## **13. Post-Grant Procedures**

Blackboard

*Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159 (1938)

Mark A. Lemley & Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U. L. REV. 63 (2004)

Merges & Duffy 931-933, 944-950

Please read notes 1-3 on pp. 944-45 (You do not need to read the *Cuozzo* case—it simply holds that the AIA review procedures are constitutional—but you should appreciate the procedures’ ongoing implications).