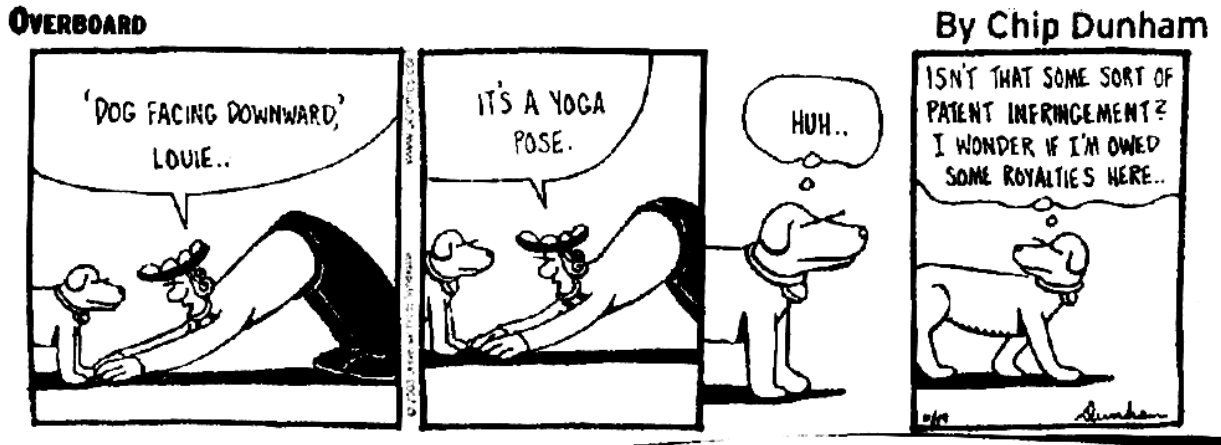


Patent Law



This course surveys the fundamentals of patent law, covering its basic legal rules and policies. The first half of the course will focus on the legal requirements for patenting technological innovations, such as utility, disclosure, enablement, novelty, and nonobviousness, and the prohibitions against public use, sale and abandonment. It will also address what inventions and discoveries can be secured as property rights under the Patent Act, including recent hot-button issues, such as computer software, biotechnology and business methods. The second half of the course will review patent litigation, including claim interpretation, the doctrine of equivalents, and remedies, as well as the legal and policy issues arising from the Patent Trial and Appeal Board, an administrative tribunal created in 2011 to cancel issued patents. Although patent cases can arise from complicated scientific discoveries or technologies, the legal rules or policies rarely depend on understanding the underlying science or technology. Accordingly, students with non-technical backgrounds are encouraged to take this course, especially given that patents and other intellectual property assets are increasingly important to commercial clients the world over.

LOGISTICS

1. Class Schedule

The class meets on Mondays and Wednesdays, 9:50am – 11:50am.

2. Attendance and Class Preparation

Students are responsible for complying with Scalia Law's regulations regarding attendance. The regulations are on the law school's web site, and students should read them before their first

classes. To ensure compliance, I will take attendance. If you are tardy, it will be counted as an absence unless you tell me to mark you as present before I leave the classroom at the end of class. Two tardies will equal one absence.

3. Grade

Your grade is based primarily on the final exam.

Since class discussion is important to the learning process, I do take class participation into account in the grading process, raising grades for consistent, high-quality participation in class discussion or lowering grades for chronic lack of preparation or unprofessional conduct. Given the administrative restraints on grade changes, classroom participation only makes a difference on the margin.

4. Final Exam

The final exam will consist of essay and short-answer questions.

The exam is open book, but this does not mean that you should bring everything written under the sun on patent law. Understanding how one prepares for intensive and discrete events, such as licensing negotiations, depositions in lawsuits, and actual trials, is as much a part of good lawyering as is learning the substantive law. If you want to bring five commercial outlines and a variety of canned summaries to the final exam, then I will not impede your desire to drown yourself (and your grade) under a mountain of superfluous materials.

With that warning in mind, the best way to succeed in this course is to keep up with the assignments and take good notes. When studying for the final exam, I recommend preparing an outline that is detailed and comprehensive. Using your outline, you should also prepare a checklist that lays out the steps you will go through and the issues you will address in answering potential problems on the exam, e.g., patentability (e.g., § 103 requirements—(1) the scope and content of the prior art, (2) differences between prior art and the claim, (3) the PHOSITA, etc.). You will use the checklist as your principal reference guide during the exam, and the more comprehensive outline will serve only as a back-up in case you forget something or need more information. Feel free to use commercial outlines or canned case summaries to fill in holes in your notes—speaking with me though is always the best policy—but it is the *preparation* of the outline and checklist that constitutes proper studying for a final exam. If you paid attention in class and prepared your own outline and checklist, you should do great on the exam.

Students may either handwrite or type their exam; I have no preference for either format.

5. Technology Issues

TWEN

Students are required to register for the class TWEN site. (For those who may not have used TWEN yet, go to lawschool.westlaw.com, click on the TWEN tab at the top of the page and

follow the instructions.) I will post announcements, updates to the syllabus, and supplemental class materials to the TWEN site. If you do not register with your current email address, you risk not receiving class notices, changes to the syllabus, etc. “I forgot to register at TWEN” is never a valid excuse for not being prepared for class.

Web-Based Resources for Patent Law

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| U.S. Patent & Trademark Office | www.uspto.gov |
| U.S. Court of Appeals for the Federal Circuit | www.fedcir.gov |
| PTO website for patents | www.uspto.gov/main/patents.htm |
| PTO searchable database for patents | www.uspto.gov/patft/index.html |
| Patent Act (red-lined with AIA changes) | www.bitlaw.com/source/35usc/35usc.pdf |
| Patent Act, U.S.C. Title 35 (searchable) | www4.law.cornell.edu/uscode/35/ |
| Patent Act, U.S.C. Title 35 (single document) | www.uspto.gov/web/offices/pac/mpep/consolidated_laws.pdf |
| C.F.R. Title 37 - Patents, Copyrights and Trademarks (searchable) | cfr.law.cornell.edu/cfr/cfr.php?title=37 |
| C.F.R. Title 37 - Patents, Copyrights and Trademarks (single document) | www.uspto.gov/web/offices/pac/mpep/consolidated_rules.pdf |
| Federal Circuit Bar Association | www.fedcirbar.org |
| World Intellectual Property Organization | www.wipo.int |
| American Intellectual Property Association | www.aipla.org |

6. Office Hours

I will hold office hours right after class on Mondays and Wednesdays from Noon – 1pm or by appointment (in person or Zoom).

7. Learning Outcomes

The goal of this course is to provide students with the basic rules of patent law, as well as a working knowledge of the policies that gave rise to these legal rules and which affect their continuing application today. Ultimately, students will learn the analytical skills to interpret and understand legal materials, such as court decisions and statutes, and to apply legal rules and policies derived from these legal materials in resolving problems that arise in the administration of the patent system.

8. Miscellany

Students are not permitted to record classes without first obtaining my permission to do so.

I RESERVE THE RIGHT TO CHANGE THE SYLLABUS AND ANYTHING ELSE DISCUSSED HEREIN, except those policies pertaining to attendance and grades, which will be set in stone as of the first day of class.

READINGS

The required text is Merges & Duffy, *Patent Law & Policy: Cases and Materials* (8th ed. 2021) [“M&D”].

There are additional required readings provided on TWEN (downloadable in PDF format).

CLASS SCHEDULE

Students are responsible for all class readings, regardless of whether we discuss them in class. (A series of different page ranges, separated by a comma, come from whatever source is designated at the start of the series.) Materials not in the casebook are posted on TWEN. If a reading is designated as “skim,” you just need to read it, and there’s no need to take scrupulous notes or otherwise be prepared to answer questions about it. I reserve the right not to cover some material in the readings in order to stay on schedule, and, as a reminder, you are responsible for all of the readings listed in the syllabus that we do not cover in class.

| Class | Topic | Reading Assignments |
|--------------|---|--|
| 1 | Introduction to Patent Law: History, Institutions, and Policy | M&D 3-69 “Theories of Patent Law” [TWEN] “Charts and Graphs on Patent System” [TWEN] |
| 2 | Novelty (AIA) | M&D 79-88, 164-194 |
| 3 | Novelty (AIA) | M&D 88-113 |
| 4 | Novelty (AIA) | M&D 114-149 |
| 5 | Novelty (AIA and pre-AIA) | M&D 150-164, 201-225 <i>Campbell v. Spectrum Automation Inc.</i> (6th Cir. 1975) [TWEN] |

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| 6 | Novelty (pre-AIA) | M&D 225-254, 266-268 |
| 7 | Utility | M&D 269-278, 286-319 |
| 8 | Nonobviousness | M&D 325-376 |
| 9 | Nonobviousness | M&D 438-451 PHOSITA (M&D 6th edition, p. 698) [TWEN] <i>In re Dembiczak</i> (Fed. Cir. 1999) [TWEN] |
| 10 | Nonobviousness | M&D 384-404, 424-438, 411-418 |
| 11 | Enablement | M&D 453-485 |
| 12 | Written Description Definite Claims Best Mode | M&D 491-540 |
| 13 | Patentable Subject Matter (laws of nature & physical phenomena) | M&D 541-548, 558-584 |
| 14 | Patentable Subject Matter (abstract ideas) | M&D 548-558, 584-609 |
| 15 | Direct Infringement: Claim Interpretation | M&D 619-630, 698-711 35 U.S.C. § 271(a) [google on internet or read it on Westlaw] <i>Phillips v. AWH</i> (Fed. Cir. 2005) - Judge Mayer Dissent [TWEN] |

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| 16 | Direct Infringement: Claim Interpretation | M&D 630-691 |
| 17 | Doctrine of Equivalents | M&D 711-737 <i>Deere & Co. v. Bush Hog</i> (Fed. Cir. 2012) [TWEN] |
| 18 | Joint & Divided Infringement Indirect Infringement “Foreign” Infringement | M&D 691-698, 759-794 |
| 19 | Litigation Defenses: Experimental Use AIA Prior User Right Exhaustion | M&D 745-752, 758-759, 1217-1234, 120-122 (Note 6) |
| 20 | Litigation Defenses: Assignor Estoppel Inequitable Conduct Laches | M&D 1042-1057, 1059-1067 <i>Minerva Surgical v. Hologic</i> (S. Ct. 2021) [TWEN] <i>SCA Hygiene v. First Quality Baby Prods.</i> (S. Ct. 2017) [TWEN] |
| 21 | Law & Fact Questions | M&D 919-935, 947-955 <i>Dennison Mfg. Co. v. Panduit Corp.</i> (S. Ct. 1986) and <i>Panduit Corp. v. Dennison Mfg. Co.</i> (Fed. Cir. 1987) [TWEN] <i>Teva Pharmaceuticals v. Sandoz</i> (S. Ct. 2015) [TWEN] |

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|----|---|--|
| 22 | PTAB: Post-Issuance Review of Patents | M&D 955-971, 1057-1059 Justice Gorsuch Dissent in <i>Oil States v. Greene's Energy</i> [TWEN] |
| 23 | PTAB: Administrative Law and Institutional Issues | M&D 971-998, 1000-1010, 1019-1028 |
| 24 | Remedies: Damages – Reasonable Royalties | M&D 795 (§ 284), 841-846 <i>Panduit Corp. v. Stahl Bros.</i> (6th Cir. 1968) [TWEN] <i>Ericsson v. D-Link</i> (Fed. Cir. 2014) [TWEN] – read only portion on damages, pp. 1-8, 36-57 |
| 25 | Remedies: Damages – Lost Profits | M&D 846-874, 880 (Note 4) - 885 |
| 26 | Remedies: Injunctions | M&D 795 (§ 283), 795-822 |