

Syllabus for Patent Law II

Law 292
Spring 2024
2 Credits

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I. COURSE MATERIALS.

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

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.

In-person office hours are Wednesday from 2-4pm. I am also happy to arrange meetings on Zoom at other times if you email me for an appointment. Generally, email is a more reliable way to reach me than phone.

IV. GRADES.

Your grade will be based on the final exam, which is graded blindly. The final exam will be open book, but only paper materials will be allowed. For this reason, you are strongly advised to get a paper version of the casebook. Additional details regarding the exam will be determined later in the semester. The knowledge from Patent Law I is integrated into this class and will be assumed when formulating the final exam.

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 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 619-647, 712-718

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

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

Blackboard

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

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

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)

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

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

Merges & Duffy 737-745

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 718-737

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 759-784

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 691-698

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 1071-1079, 1116-1124

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 1042-1059, 1169-1188

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 746-752, 1217-1234

Madey v. Duke University, 307 F.3d 1351 (Fed. Cir. 2002)

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

Blackboard

Quanta Computer, Inc. v. LG Elec., Inc., 128 S. Ct. 2109 (2008)

10. Damages I

Merges & Duffy 846-858

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 822-841

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 795-811

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

Merges & Duffy 955-965

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)