

PATENT LAW

Fall 2000

2 Credits

Wednesday: Day 2-3:50 Room 224
Evening 6-7:50 Room 221

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Text: Martin Adelman, et.al, *Patent Law* (West 1998).
Robert Merges, *Patent Law & Policy Statutory Supplement* (Michie 1997).
Patent Law Supplement (prepared by Prof Moore)

1. **Course overview; history & origins of the patent system; the nature and function of the patent system; costs and benefits of the patent system, comparison of various forms of intellectual property protection; & federal preemption.**

Reading Assignment

4-9(§1.2), 17 (§1.3)-20, 28-47 (skip footnotes), 639(Notes)-646, 48-51, 73-81.

STAT: The Contents and Term of a Patent -- § 154

2. **Patentable subject matter: computer software & business methods.**

Reading Assignment

83-84 (stop after US Law), 105-122, 134 (*Alappat*)-150 (stop after note 6), *State Street* (Supplement), *Amazon.com*, *Priceline.com*,

STAT: § 101.

3. **Patentable subject matter: patenting life, cloning, medical procedures, & sports moves.**

Reading Assignment

153-156 (skip notes), 157 (Note 3), 163 (Note 3), 104 (Note 4), 178 (Notes & probs)-180.

4. **Utility.**

Reading Assignment

181-202

5. **Novelty §102 — Statutory Bars**

Reading Assignment

203-207, 213 (*Egbert*)-218, 280-283 (*Gore*), 223 (notes)-239, *Pfaff* (Supplement)
STAT: §102(b)

6. **Novelty: Patents & printed publications, known or used by others, abandonment, prior foreign filings, derivation, disclosures in earlier filed applications.**

Reading Assignment

292-296, 303 (§4.6)-311 (do problems), *Nat 'I Tractor Pullers* (Supplement), *Gambro Lundia AB v. Baxter Healthcare Corp.* (Supplement),
STAT: §102(a), (b), (c), (d), (e), (f)

7. **Novelty: interferences, Rule 131, Priority (conception, reduction to practice and diligence), corroboration requirement, abandoned, suppressed & concealed.**

Reading Assignment

319(Note 7)-325, 329 (§5.2[d])--336 (stop after note 3), 339 (§5.2e)--352(Stop after note 2), 360 (*Paulik*)-373, 380-382 (do problems)
STAT:§102(g)

8. **Novelty: foreign priority and prior art effective dates**

Reading Assignment

825-837 (skip notes), Problems (Supplement)
STAT: §104.

Novelty: Anticipation

1. The Identity Requirement: The prior art reference must contain all the claim limitations.
2. The prior art reference must be enabling.
3. The Inherency Doctrine

Reading Assignment

392(Note 5)-396 (skip Notes), 398(§6.2)-404 (skip notes), Be prepared to discuss anticipation problem 405-406.

9. **Obviousness: *Graham v. John Deere Co.*, motivation to combine, teaching away, objective factors, §102/103, analogous arts**

Reading Assignment

417-447(through Note 5), 453-54 (Note 2 only), 456 (Note 4)-467 (top), 550 (note 3), 557 (§8.2)-561 (skip notes), 563-565 (top)
STAT: §103.

- 10 **HYPO**

11. **§112 inadequate disclosure concerns: enablement, written description, best mode.**

Reading Assignment

567-568 (stop at *Gould*), 576-580 (*Atlas*) (skip notes), 601-609 (*Vas Cath*), *Gentry Galleries* (Supplement), 612-620 (through Note 4);
STAT: §112.

12. **Unenforceability: inequitable conduct (intent & materiality).**

Reading Assignment

735-755 (through Note 5).

Rescheduling The last two weeks of class (Nov. 15, Nov. 22) are canceled. These two class are rescheduled for **Saturday, September 30, 2000 from 9:30 a.m.-1:00 p.m. in Room 221** The material covered in this Saturday session will be recorded. If you are unable to attend the class, please listen to the tape as the material covered will be on the exam. Failure to attend this class will not be held against you in assessing your participation grade.

This syllabus is not absolute and may change during the semester. However, we will generally proceed in the order specified above unless I notify you otherwise during class. Students are responsible for knowing what material is required for a given day.

EXPECTATIONS

The Exam

There will be a written examination in this course. The exam will cover the reading materials and the class discussions. I will expect you to demonstrate knowledge of the statutes and common law as well as the policies behind them. Successful performance on the exam will require class attendance.

Class Participation

Class participation and attendance will constitute a percentage of your final grade. It can raise or lower your exam grade by 1-2 grades. For example, if you receive a B on the final exam, participation could raise your grade as high as an A-. A lack of participation, unpreparedness or absences could lower your grade from a B to a C+. It is not just the quantity of participation but the quality of the student*s contribution to the class. Therefore, a student who speaks every class, but does not say anything particularly thoughtful may not get any added points for participation.

Being able to concisely articulate a position is essential to good lawyering; accordingly, I will call on students randomly to ensure equal participation. It is my practice to call on every student every week. You are expected to have done the reading and prepare any assigned problems for each class. This is a class on US Patent Law, not a comparative course; therefore, you may skip notes in the assigned reading which pertain to the patent laws of other countries.

Secondary Materials

Although I do not believe that resort to secondary materials is necessary to master the material in this class, there are a number of excellent sources that could be of assistance to you during practice. I recommend:

1. Chisum, D., *Patents* (Matthew Bender).
This multi-volume treatise is the leading reference source.
2. Landis, J., *The Mechanics of Claim Drafting* (Practicing Law Institute).
This is the leading reference for claim drafting.
3. *Manual of Patent Examining Procedure*.
The PTO*s official manual of procedure for patent examination.
4. Moore, Michel & Lupo, *Patent Litigation and Strategy* (West 1999).
This is a casebook/treatise on patent litigation.

Office Hours

Finally, my office hours are Tuesdays 4-6. I am happy to answer patent law questions during this time. I also respond promptly to e-mail questions and am available by appointment if you cannot come during office hours.