

PATENT INFRINGEMENT LAW 288

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Administrative

Classes will be held Wednesdays, for the first half of the semester, from 6:00 PM to 7:50 PM in room 412, with a short break around 7:00 PM. The first class will be on August 24, 2005 and the last class of instruction will be on October 5, 2005.

The final exam will be given on Wednesday, October 19, 2005 at 6:00 PM in room 412. The final exam will be open book. Expect a significant portion of the final exam to center around some version of the question, "Does it infringe?" The exam will include material covered in class that is not included in the text for the course, so attendance at class is essential to perform adequately on the final exam.

Students are expected to read assigned materials prior to class. Each week, 3 or 4 cases will be assigned to "volunteers" for presentation to the class. All students are encouraged to read the cases prior to class. Class participation will count and can raise or lower your grade by one step (if you earn a B+ on the final exam, your grade for the course can range from A- to B). It is not just the quantity of participation but the professors' assessment of 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.

Text: Infringement Concepts, Dale S. Lazar. Copies of this 250 page paper can be purchased in the copy center. A copy will also be distributed electronically if the Law School's network is up to the task. If you do not receive a copy electronically, contact Dale Lazar by email at the address above and I will send it to you directly.

Reading Assignments

August 24

Text: Claim Construction through Use of Extrinsic Evidence, pages 1 – 77.

Cases:

_____ **Markman v. Westview Instruments, Inc.**, 517 US 370, 116 S.Ct. 1384, 38 USPQ 2nd 1461 (1996) and the earlier Fed. Cir. decision, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995).

_____ **Wang Laboratories, Inc. v. America Online, Inc.**, 197 F.3d 1377, 53 USPQ2d 1161 (Fed. Cir. 1999).

_____ **Phillips v. AWH Corp.**, 363 F.3d 1207, 70 USPQ2d 1417 (Fed. Cir. 2004) and the en banc decision at 2005 U.S. App. Lexis 13954, 75 USPQ2d 1321 (Fed. Cir. 2005).

August 31

Text: Claim Construction from Claim Preambles through Old Combination and Patent Misuse, pages 77 – 93 and 217 through 228

Cases:

_____ **Catalina Marketing Int'l v. Coolsavings.com**, 289 F.3d 801, 62 USPQ2d 1781 (Fed. Cir. 2002)

_____ **Scripps Clinic v. Genentech, Inc.**, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991)

_____ **Atlantic Thermoplastics Co. v. Faytex Corp.**, 970 F.2d 834, 23 USPQ2d 1481 (Fed. Cir. 1992) and 974 F.2d 1279, 23 USPQ2d 1801 (Fed. Cir. 1992)

September 7

Text: Claim Construction – Means Plus Function and Functional Language, pages 93 through 131

Cases:

_____ **Cardiac Pacemakers Inc. v. St. Jude Medical Inc.**, 296 F.3d 1106, 63 USPQ2d 1725 (Fed. Cir. 2002)

_____ **Cole v. Kimberly Clark Corp.**, 102 F.3d 524, 41 USPQ2d 1001 (Fed. Cir. 1996)

_____ **O.I. Corp. v. Dekmar Co., Inc.**, 115 F.3d 1576, 42 USPQ2d 1777 (Fed. Cir. 1997)

_____ **In re Caldwell**, 138 USPQ 243 (CCPA 1963)

September 14

Text: Literal Infringement and Doctrine of Equivalents, pages 132 through 159

Cases:

_____ **Warner-Jenkinson v. Hilton Davis Chemical Co.**, 117 S. Ct. 1040, 41 USPQ2d 1865 (1997) (Doctrine of Equivalents Portion) and Fed. Cir. decision at 62 F. 3d 1512, 35 USPQ2d 1641 (Fed. Cir. 1995)

_____ **Conroy v. Reebok**, 14 F.3d 1303, 46 USPQ2d 1373 (Fed. Cir. 1994)

_____ **Johnson & Johnston Associates v. R.E. Service Co., Inc.**, 285 F.3d 1046, 62 USPQ2d 1225 (Fed. Cir. 2002)

September 21

Text: Doctrine of Equivalents and Prosecution History Estoppel, pages 160 through 176

Cases:

_____ **Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.**, 145 F.3d 1303, 46 USPQ2d 1752 (Fed. Cir. 1998)

_____ **WMS Gaming Inc. v. International Game Technology**, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999)

_____ **Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.**, 122 S. Ct. 1831, 62 USPQ2d 1705 (2002), including the subsequent Federal Circuit decision at 344 F.3d 1359, 68 USPQ2d 1321 (Fed. Cir. 2003)

September 28

Text: Prosecution History Estoppel and Reverse Doctrine of Equivalents, pages 176 through 187

Cases:

_____ **Honeywell International v. Hamilton Sundstrand**, 370 F.3d 1130 (Fed. Cir. 2004)

_____ **Haynes International v. Jessop Steel Co.**, 8 F.3d 1573, 28 USPQ2d 1653 (Fed. Cir. 1993)

_____ **SRI Int'l v. Matsushita Elec. Corp.**, 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985)

October 5

Text: Acts of Infringement, pages 187 through 217

Cases:

_____ **Husky Injection Molding Systems Ltd. v. R & D Tool & Engineering Co.**, 291 F.3d 780, 62 USPQ2d 1834 (Fed. Cir. 2002)

_____ **Aro Manufacturing Co. v. Convertible Top Replacement Co.**, 377 U.S. 476, 141 USPQ 681 (1964)

_____ **Water Technologies v. Calco, Ltd.**, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988)

_____ **Manville Sales Corp. v. Paramount Systems, Inc.** 917 F.2d 544, 16 USPQ2d 1587 (Fed. Cir. 1990)

_____ **Paper Converting Machine Co. v. Magna-Graphics**, 745 F.2d 11, 223 USPQ 591 (Fed. Cir. 1984)

Final Exam: October 19