

# Syllabus for Patent Law I

Patent Law I (284-001)  
Fall 2007  
2 Credits

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1. **Course schedule.** Class meets in room 332 on Fridays from 10:00am to 11:50am with a 10 minute break in the middle. The first class is Friday August 24. There is no class on Friday November 23. The last class is Friday November 30. The final exam is Saturday December 15 at noon.

2. **Course materials.** Required: Robert Merges and John Duffy, Patent Law and Policy: Cases and Materials 4<sup>th</sup> ed. (LexisNexis, August 2007). The fourth edition will not arrive at the GMU bookstore until mid August 2007.

Additional materials may be posted on TWEN as the semester proceeds.

The Patent Act (35 US Code), Patent Rules (37 CFR) and Manual of Patent Examining Procedure (MPEP) are available at:

<http://www.uspto.gov/web/offices/pac/mpep/index.htm>

3. **Office visiting hours.** My normal office visiting hours are Wednesdays 2:00-4:00pm. You need not give me advance notice that you're stopping by during those hours. If you cannot come by then, feel free to contact me to schedule an appointment.

#### 4. **Policy on electronic devices and recording.**

Please remember to turn off your cell phone before class.

I encourage you to take notes on a laptop, but do not use it or any other electronic device for purposes unrelated to class (*e.g.*, games, surfing the internet, email, instant messaging). If you absolutely must attend to your messages (*e.g.*, your wife is about to go into labor), please let me know before class.

Please do not record a lecture unless you: (a) cannot attend the lecture, *and* (b) let me know before the lecture that you intend to have someone in the class record it for you.

5. **Grades.** Your grade will be based on the final exam, which is graded blindly. However, superb class participation will boost your

final grade by one-third of a letter, *e.g.*, a B+ would become an A-. Poor class participation will pull down your grade by one-third of a letter.

*Final exam.* The final exam will include multiple choice and true-false questions and may include short answer and/or one or two short-to-medium length essay questions. I will provide more information about the question breakdown towards the end of the semester.

You will have 2.5 to 3 hours to complete the final. I prefer that you type your answers to essay and short-answer questions on your laptop. But if you have very legible handwriting, you may write your answers in a Bluebook.

*Class participation.* Superb class participation has more to do with advancing the particular question under discussion than with making points, albeit clever, that distract. Poor class participation includes poor citizenship (*e.g.*, being disruptive or rude), being unprepared or absent when called upon (especially more than once), coming into class late on multiple occasions, or playing around on a computer or other electronic device during class.

*Note the University's attendance policy: a student cannot earn credit for a course if that student misses more than two clock hours for each credit hour assigned to the course. This course is worth 2 credit hours. Therefore, you cannot miss more than two classes and still earn credit.*

**6. Secondary materials.** Although resort to secondary materials is not necessary to master the subject matter in this course, there are a number of excellent sources that could assist you both now and in the future. These include:

- Alan Durham, *Patent Law Essentials: A Concise Guide*, 2<sup>nd</sup> Edition (Praeger 2004). A model of clarity and concision.
- D. Robert Faber, *Landis on Mechanics of Patent Claim Drafting*, 5th Edition (Practising Law Institute 2005). This is the leading guide to drafting U.S. patent claims.
- Janice Mueller, *An Introduction to Patent Law*, 2nd Edition (Aspen 2006). A very clear and useful small encyclopedia of patent law.
- David Pressman, *Patent It Yourself*, 12<sup>th</sup> Edition (Nolo 2006). Useful for beginners because it assumes no knowledge on the part of the reader.
- Irwin Aisenberg, *Modern Patent Law Precedent: Dictionary of Key Terms and Concepts*, 7<sup>th</sup> Edition (Thomson/West 2005). When I was in practice, I found this book invaluable. It provides

the quickest way to find case language on a particular point of law.

7. *Assignments.* Assignments are subject to change based on the pace of the course.

Class/Topic	Assignment	Coverage
1. Introduction to patents and claim drafting	Merges & Duffy: 1-35, 48-66	Historical overview; architecture of the patent document; claim drafting exercise (pencil); application and enforcement processes; and globalization
2. Claim drafting	Merges & Duffy: 35-48	Claim drafting exercise (cup holder).
3. Patentable subject matter I	Merges & Duffy: 65-92, 98-106	<i>Diamond v. Chakrabarty</i> ; <i>O'Reilly v. Morse</i> ; <i>Lab-Corp v. Metabolite</i> .
4. Patentable subject matter II	Merges & Duffy: 130-31, 139-41, 154-65, 175-81; 195-200.	Software; business methods; <i>State Street</i> .
5. Patentable subject matter III, and utility	Merges & Duffy: 200-205, 207-08, 212-18, 238-40, 253-56	Patents on social and legal technologies; <i>Lowell v. Lewis</i> and Justice Story's theory of the utility requirement; <i>Juicy Whip</i> and the modern approach to the utility requirement; and the PTO Utility Guidelines.
6. Enablement and written description	Merges & Duffy: 257-75, 290, 295-309, 313-14	<i>The Incandescent Lamp Patent</i> ; <i>Fisher</i> ; the relationship between enablement and patent breadth; <i>Vas-Cath v. Mahurkar</i> ; continuing application practice and the "new matter" prohibition; <i>Gentry Gallery</i> .
7. Definite claims and best mode	Merges & Duffy: 327-37, 346-56	<i>Orthokinetics</i> , <i>Standard Oil v. American Cyanamid</i> ; functional claim language; <i>Chemcast</i> and "hidden" best modes; the <i>Transco</i> rule for best mode disclosures in

		continuing applications.
8. Novelty I: anticipation analysis	Merges & Duffy: 357-74, 380-81, 386-93	<i>Robertson; Seaborg</i> ; the “every element” rule; accidental anticipation; the enforcement difficulties associated with “new use” patents.
9. Novelty II: 102(a) and 102(e)	Merges & Duffy: 393-413, 417-31	The public knowledge standard, printed publications and “patented” prior art; economics of search; <i>Milburn</i> ; “secret” prior art; derivation; corroboration.
10. Novelty III: 102(f) and 102(g)	Merges & Duffy: 431-56, 462-66	The basic priority rules; <i>Campbell v. Spectrum; Brown v. Barbacid</i> , the <i>Paulik v. Rizkalla</i> rule; trade secrets as suppressed invention.
11. Novelty IV: finer points of 102(g), rule 131 practice, and international issues	Merges & Duffy: 475, 478-83, 488-89, 494-96, 503-07	Proving a date of invention; swearing behind a reference; territorial restrictions on proving invention; obtaining patents in multiple countries.
12. Novelty V: introduction to 102(b) and public use	Merges & Duffy: 509-111, 517-19 (notes 1 and 4), 519-33	Policies underlying the statutory bars; critical dates and “grace” periods; <i>Egbert v. Lippmann</i> and “hidden” public uses; <i>Moleculon</i> , confidentiality and the limits of private uses.
13. Novelty VI: 102(b) on-sale bar, and third party activity	Merges & Duffy: 536-50; 555-58, 560-62 (notes 4 and 7), 570-79	The on-sale bar, <i>Pfaff</i> , and the “ready for patenting” standard; experimental use exception; third-party activity as a statutory bar; <i>Baxter</i> .
14. Obviousness	Merges & Duffy: 611-17; 630-53, 663-65, 700-16	The function of nonobviousness; the <i>Selden</i> controversy; <i>Graham; Hybritech v. Monoclonal Antibodies</i> and the objective indicia of obviousness.