

Syllabus for Patent Law I

Law 284-001

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I. COURSE MATERIALS.

Robert Patrick Merges and John Fitzgerald Duffy, *Patent Law and Policy: Cases and Materials* (4th ed. 2007).

Supplemental materials packet from library printing office.

II. OFFICE HOURS.

Feel free to drop by any time that you can catch me in my office. In addition, my office hours are 4-6pm on Wednesdays; and you should be able to find me in my office at those times. You can also email me for an appointment.

III. GRADES.

Your grade will be based on the final exam, which is graded blindly. I may adjust the final grade by one-third of a letter, *e.g.*, a B+ would become an A- or B, for class participation.

Final exam. The final exam will include several short answer questions, and one or two essay questions. I will provide more information about the final exam towards the end of the semester.

IV. ELECTRONIC DEVICES

Please remember to turn off your cell phone and other similar devices before class.

V. ASSIGNMENTS

Generally, we will cover one topic per class. These assignments are subject to change depending on our progress in class.

The assigned pages include both the excerpted cases and the casebook authors' notes about them. I recommend reading the notes, but we will focus mainly on the cases in class. Where the notes are particularly important, I have noted this fact.

Please ensure that you read the assigned materials from the Supplement for class.

1. Introduction to Patents

Merges and Duffy

Pages 14-33

Supplement

35 U.S.C. §§ 101, 102(a), 103(a), 112, 271(a)

U.S. Patent No. 6,436,015 (Weight Plate)

Bonito Boats v. Thunder Craft Boats, 489 U.S. 141 (1989)

After class, please read Merges and Duffy pp. 33-35, and draft one claim covering a pencil. Email me the claim (just an email, do not attach a word document) before the next class. We will discuss the claims you drafted in the next class. The quality of your claim will not affect your class participation grade, as long as you submit one.

2. Infringement and Patent Scope

Merges and Duffy

Pages 781-787, 79-98.

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

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

The Telephone Cases, 126 U.S. 1 (1888)

3. Patentable Subject Matter I: Nature and Scientific Principles

Merges and Duffy

Pages 67-78, 113-117

Diamond v. Chakrabarty, 447 U.S. 303 (1980)

Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127 (1948)

4. Patentable Subject Matter II: Abstract Ideas

Merges and Duffy

Pages 130-155

Gottschalk v. Benson, 409 U.S. 63 (1972)

Diamond v. Diehr, 450 U.S. 175 (1981)

Supplement

In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc)

5. Enablement and Permissible Abstraction

Merges and Duffy

Pages 261-272, 321-327

The Incandescent Lamp Patent, 159 U.S. 465 (1895)

Lizardtech v. Earth Resource Mapping, Inc., 424 F.3d 1336 (Fed. Cir. 2005)

Supplement

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

Invitrogen Corp. v. Clontech Labs., Inc., 429 F.3d 1052 (Fed. Cir. 2005)

6. Enablement and Utility

Merges and Duffy

Pages 275-285, 207-212, 214-230

In re Wands, 858 F.2d 731 (Fed. Cir. 1988)

Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364 (Fed. Cir. 1999)

Brenner v. Manson, 383 U.S. 519 (1966).

7. Novelty I: Anticipation Standard

Merges and Duffy

Pages 357-374, 380-393

In re Robertson, 169 F.3d 743 (Fed. Cir. 1999)

In re Seaborg, 328 F.2d 996 (C.C.P.A. 1964)

In re Hafner, 410 F.2d 1403 (C.C.P.A. 1969)

8. Novelty II: Patents and Printed Publications

Merges and Duffy

Pages 393, 402-431, 519-521

Jockmus v. Leviton, 28 F.2d 812 (2d Cir. 1928)

In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004)

Reevs Bros. v. U.S. Laminating Corp., 282 F. Supp. 118 (E.D.N.Y. 1966)

Alexander Milburn co. v. Davis-Bournonville Co., 270 U.S. 390 (1926)

9. Novelty III: Prior Public Knowledge or Use

Merges and Duffy

Pages 393-402, 522-533

Nat'l Tractor Pullers Ass'n v. Watkins, 205 U.S.P.Q. 892 (N.D. Ill. 1980)

Rosaire v. Baroid Sales Division, Nat'l Lead Co., 218 F.2d 72 (5th Cir. 1955)

Egbert v. Lippmann, 104 U.S. 333 (1881)

Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261 (Fed. Cir. 1986)

10. Novelty IV: The On-Sale Bar and Experimental Use

Merges and Duffy

Pages 536-550, 555-562, 579-584

Pfaff v. Wells Elec., 525 U.S. 55 (1998)

City of Elizabeth v. Am. Nicholson Pavement Co., 97 U.S. 126 (1877)

W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983)

11. Novelty V: Competing Inventors.

Merges & Duffy

Pages 438-464, 468-478

Brown v. Barbacid, 276 F.3d 1327 (Fed. Cir. 2002)

Peeler v. Miller, 535 F.2d 647 (C.C.P.A. 1976)

Dow Chem. Co. v. Astro-Valcour, Inc., 267 F.3d 1334 (Fed. Cir. 2001)

Please read note 1 on page 475.

12. Obviousness I

Merges and Duffy

Pages 611-617, 630-653

Graham v. John Deere Co., 383 U.S. 1 (1966)

13. Obviousness II

Merges and Duffy

Pages 663-685

KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007)

Supplement

In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Iron Grip Barbell Co. v. USA Sports, Inc., 392 F.3d 1317 (Fed. Cir. 2004).

Please read the cases in the supplement before reading KSR.

14. Catch-up and Revision

No new reading.