

PATENT LAW I (284-002)
GMU SCHOOL OF LAW
COURSE SYLLABUS
INSTRUCTOR: STEPHEN G. KUNIN
(PHILIPPE SIGNORE: SUBSTITUTE)
FALL 2009

ADMINISTRATIVE

Classes will be held on Tuesdays from 8:00 pm to 9:50 pm in Room 224, with a short break around 9:00 pm. The final exam will be held Saturday, December 7 at 6 pm.

The Exam

There will be an 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. The open-book exam will include multiple-choice. The exam will include material covered in class that is not included in the textbook, so attendance at class is essential to perform adequately on the final exam. Attendance will be taken at each class. Students are expected to read assigned materials prior to class. Students in teams of three will be assigned specific cases to report out in class.

Textbooks: Cases and Materials on Patent Law, 3d ed. (Martin J. Adelman, et al.), Thomson Reuters/West (2009) ISBN 978-0-314-19082-6. Unfair Competition, Trademark, Copyright and Patent, Selected. Goldstein and Kitch's Selected Statutes and International Agreements on Unfair Competition, Trademark, Copyright and Patent, 2009 ed. By: Foundation Press. ISBN-13: 9781599415178. You can reach instructor Stephen Kunin at SKunin@Oblon.com or 703-412-6011 and instructor Philippe Signore at psignore@oblon.com or 703-413-3000. The detailed syllabus is set forth below, subject to revision and additional materials to be handed out in class.

EXPECTATIONS

Your grade may be adjusted upward or downward based on class participation. Unexcused repeated absences will lead to a downward adjustment. It is not just the quantity of participation but the professor's 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.

Being able to concisely articulate a position is essential to good lawyering; accordingly, I will assign cases to teams of three students for report out at the next class. You are expected to have done the reading and prepare any assigned problems for each class.

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:

Adelman, Rader, and Klancnik's Patent Law in a Nutshell (Nutshell Series)

A succinct description of the fundamentals of U.S. patent law.

ISBN-13: 9780314256508

THERE IS NO CLASS OCTOBER 13; THE SCHOOL OBSERVES MONDAY CLASSES ON TUESDAY, OCTOBER 13.

Reading Assignments

August 25 (Class #1)

Topics: Introduction: origins of the patent system; forms of patent protection; nature and function of the patent system and other forms of IP protection.

Text: 1-57

Statute: 35 U.S.C. §§ 111, 122, 154.

Also read: The Vessel Design Protection Act (P.L. 105-303)

(<http://www.copyright.gov/title17/92chap13.html>) and *Eldred v. Ashcroft*

(<http://www.supremecourtus.gov/opinions/02pdf/01-618.pdf>) *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*; *E.I. duPont de Nemours & Co. v. Christopher*

September 1 (Class #2)

Topics: Patentable subject matter; natural substances and living things; plant patents.

Text: 58-75

Statute: 35 U.S.C. § 101.

Read: *Diamond v. Chakrabarty* and *Labcorp. v. Metabolite*

(<http://www.supremecourtus.gov/opinions/05pdf/04-607.pdf>)

September 8 (Class #3)

Topics: Patentable subject matter (continued); software inventions; business methods; medical procedures; sports methods.

Text: 76-122

Statute: 35 U.S.C. § 287(c). Read *Gottschalk v. Benson*; *Diamond v. Diehr* and *In re Bilski*

Also read: "Business Method Patents: Are There Any Limits?" 2 J. Marshall Rev. Intell. Prop. Law 30 (2002), available at <http://www.jmls.edu/ripl/vol2/issuel/wright.pdf>

September 15 (Class #4)

Topics: Utility; disclosure; enablement.

Text: 123-154.

Statute: 35 U.S.C. § 112. Read *Lowell v. Lewis*; *Juicy Whip v. Orange Bang* and *Brenner v. Manson*

Also read: *In re Fisher* (<http://fedcir.gov/opinions/04-1465.pdf>)

September 22 (Class #5)

Topics: Enablement (continued); written description; definiteness; best mode.

Text: 386-430

Statute: 35 U.S.C. §§ 112, 120, 132. Read *Gould v. Hellwarth*; *Atlas Powder v. du Pont*; *Pharma v. Roxane*; *Vas-Cath-Mahurkar*; *Gentry Gallery v. Berklene*

Also read: <http://www.law.northwestern.edu/journals/njtip/v3/n2/1/>; *LizardTech, Inc. v. Earth Resource Mapping, Inc.* (<http://www.fedcir.gov/opinions/05-1062.pdf>) and *Liebel-Flarsheim v. Medrad* at <http://ipo.informz.net/ipo/data/images/courtcases/liebel-flarsheim.pdf>.

September 29 (Class #6)

Topics: Written Description and Best mode

Text: 431-458

Statute: 35 U.S.C. § 112. Read *UC v. Eli Lilly*; *Enzo Biochem v. Gen-Probe* and *Chemcast v. Arco*

October 6 (Class #7)

Topics: Novelty; section 102(a); section 102(e).

Text: 155-179, 225-232 and 273-276. Read *Titanium v. Banner*; *Schering v. Geneva*; *Woodcock v. Parker*; *Gillman v. Stern and Milburn v. Davis-Bournonville*

Also read: *Scherin Co. v. Geneva Pharm*, 339 F.3d 1373 (Fed. Cir. 2003).

Also read: *Cooper Cameron Corp. v. Kvaerner Oilfield Prods.*, 291 F.3d 1317 (Fed. Cir. 2002); *Bruckelmyer v. Ground Heaters, Inc.* (<http://www.fedcir.gov/opinions/05-1412o.pdf>) and *In re Omeprazole. Patent Litigation* at

<http://www.ipo.org/AM/TemplateRedirect.cfm?template=/CM/ContentDisplay.cfm&ContentID=14948>

October 13 – No Class

October 20 (Class #8)

Topics: Section 102(f); section 102(g).

Text: 233-272; 277-281. Read *Oka v. Youssefye*; *Scott v. Finney*; *Gould v. Schawlow*; *Woodland Trust v. Flowertree*; *Apotex v. Merck* and *Agawam v. Jordan*

October 27 (Class #9)

Topics: Section 102(g) (continued); diligence; reduction to practice; foreign priority; Hilmer doctrine; Patent Cooperation Treaty (PCT). Statutory bars; section 102(b); public use; on-sale bar; experimental use doctrine.

Text: 624-648. 180-219. Read *In re Gosteli*; *In re Hilmer*; begin reading cases for November 3.

Statute: 35 U.S.C. §§ 104; 119.

November 3 (Class #10)

Topics: Statutory bars; section 102(b); public use; on-sale bar; experimental use doctrine.

Text: 180-219. Read *Egbert v. Lippmann*; *Metallizing Engineering v. Kenyon Bearing*; *City of Elizabeth v. American Nicholson*; *Pfaff v. Wells*; *Electric Storage v. Shimadzu*; *Abbott Labs v. Geneva*; *Gore v. Garlock*

Also read: *In re Elsner* (<http://www.fedcir.gov/opinions/03-1569.doc>) and *Electromotive Division of General Motors Corp. v. Transportation Systems Division of General Electric Co.*, ___ F.3d ___ (Fed. Cir. 2005) (<http://caselaw.findlaw.com/data2/circs/fed/041412p.pdf>)

November 10 (Class #11)

Topics: Absolute novelty in foreign countries; section 102(c); section 102(d); nonobviousness.

Text: 220-224; 286-298. Read *Hotchkiss v. Greenwood and A&P v. Supermarket*

Statute: 35 U.S.C. § 103.

November 17 (Class #12)

Topics: Nonobviousness (continued).

Text: 298-347. Read *Graham v. John Deere*; *KSR v. Teleflex*; *In re Translogic*; *Ormco v. Align*

November 24 (Class #13)

Topics: Nonobviousness (continued); secondary factors of nonobviousness.

Text: 348-385. Read *In re Papesch*; *In re Dillon*; *In re Kubin*

www.cafc.uscourts.gov/opinions/08-1184.pdf ; *In re Foster and In re Clay*

December 1 (Class #14)

Topics: Claims.

Text: 459-529. Read *Ex parte Fressola*; *Catalina Marketing v. Coolsavings*; *Atlantic Thermoplastics v. Faytex*; *Al-Site v. VSI*; *Aristocrat v. International Game*; *Orthokinetics v. Safety Travel and Datamize v. Plumtree*

December 7 - Tuesday

Final exam: Tuesday, December 7 at 6 pm.