

Syllabus for Patent Law II

Law 292-002

Spring 2009

2 Credits

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I. COURSE SCHEDULE.

Class meets in room 221 on Mondays from 6:00pm to 7:50pm. There is no class on January 19, 2009; class will meet on Wednesday, April 22, 2009.

II. COURSE MATERIALS.

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

Supplemental materials packet with additional cases.

III. OFFICE HOURS.

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

IV. 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 multiple choice or short answer questions, and one or two essay questions. The knowledge from Patent Law I is integrated into this class, and will be part of the final exam. I will provide more information about the final exam towards the end of the semester.

I strongly prefer that you type your answers. If you have a good reason (*e.g.* your laptop died or you don't have one), you may write your answers in a bluebook.

Class participation. Good class participation has more to do quality than quantity—it is better to be insightful when you speak than to speak often. Poor class participation includes failing to submit drafting exercises, being unprepared when called upon, coming into class late, or playing around on a computer or other electronic device during class. Missing class is considered poor participation.

The University's attendance policy states that 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. Please refrain from skipping class too often.

V. ELECTRONIC DEVICES

Please remember to turn off your cell phone before class.

Those who wish to their laptops to take notes may do so. Please refrain from surfing the internet, email, instant messaging, etc. during class.

VI. 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. These are as important as the casebook materials.

1. Infringement I: The Basic Framework

Merges and Duffy

Pages 781-787, 829-839

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

Markman v. Westview Instruments, 817 U.S. 370 (1996)

Supplement

35 U.S.C. §§ 154, 271

SafeTCare Mfg., Inc. v. Tele-Made, Inc., 497 F.3d 1262 (Fed. Cir. 2007)

2. Infringement II: Claim Construction

Merges and Duffy

Pages 787-820

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005)

Unique Concepts, Inc. v. Brown, 939 F.2d 1558 (Fed. Cir. 1991)

Supplement

Honeywell Int'l v. Univ. Avionics Sys. Corp., 493 F.3d 1358 (Fed. Cir. 2007)

Helmsderfer v. Bobrick Washroom Equip., Inc., 527 F.3d 1379 (Fed. Cir. 2008)

3. Infringement III: The Problem of Scope

Merges and Duffy

Pages 325-327, 804

Lizardtech, Inc. v. Earth Resource Mapping, Inc. (Fed. Cir. 2006) (Rader, J., dissenting) (refresh from Patent Law I)

Please read note 5 at page 804.

Supplement

SuperGuide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870 (Fed. Cir. 2004)

Plant Genetic Systems, N.V. v. DeKalb Genetics Corp., 315 F.3d 1335 (Fed. Cir. 2003)

4. Infringement IV: The Doctrine of Equivalents

Merges and Duffy

Pages 856-881

Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17 (1997)

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002)

5. Infringement V: Inducement and Contributory Infringement

Merges and Duffy

Pages 907-916

Aro Mfg. Co. v. Convertible Top Co., 377 U.S. 476 (1964)

Supplement

Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd., 545 U.S. 913 (2005)

DSU Med. Corp. v. JMS Co., 471 F.3d 1293 (Fed. Cir. 2006)

6. Infringement VI: Foreign Infringement

Merges and Duffy

Pages 926-931

Microsoft Corp. v. AT&T Corp., 2007 U.S. Lexis 4744 (2007)

Please read note 4 on page 930. We will discuss *NTP v. RIM* in class.

Supplement

35 U.S.C. § 271(f) & (g)

Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co., 425 F.3d 1366 (Fed. Cir. 2005), *rehearing denied*, 434 F.3d 1357 (Fed. Cir. 2006)

7. Inequitable Conduct

Merges and Duffy

Pages 1103-1105, 1121-1130

Kingsdown Med. Consultants v. Hollister, Inc., 863 F.2d 867 (Fed. Cir. 1988)

Supplement

Ferring B.V. v. Barr Labs., Inc., 437 F.3d 1181 (Fed. Cir. 2006)

Innogenetics, N.V. v. Abbott Labs., 512 F.3d 1363 (Fed. Cir. 2008)

8. Other Defenses

Merges and Duffy

Pages 895-902, 1243-1268

Madey v. Duke University, 307 F.3d 1351 (Fed. Cir. 2002)

Illinois Tool Works Inc. v. Independent Ink, Inc., 547 U.S. 28 (2006)

Brulotte v. Thys Co., 379 U.S. 29 (1964)

9. Inventorship and Ownership

Merges & Duffy

Pages 1141-1148, 1184-1200

Burroughs Wellcome Co. v. Barr Labs., Inc., 40 F.3d 1223 (Fed. Cir. 1994)

Filmtec Corp. v. Allied-Signal Inc., 939 F.2d 1568 (Fed. Cir. 1991)

United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933)

10. Remedies I: Damages

Merges and Duffy

Pages 985-1000

Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538 (Fed. Cir. 1995)

Supplement

Fonar Corp. v. Gen. Elec. Co., 107 F.3d 1543 (Fed. Cir. 1997)

In re Seagate Tech., LLC, 497 F.3d 1360 (Fed.Cir.2007)

11. Remedies II: Injunctions

Merges and Duffy

Pages 933-956

EBay Inc. v. MercExchange, L.L.C., 126 S. Ct. 1837 (2006)

z4 Techs., Inc. v. Microsoft Corp., 434 F. Supp. 2d 437 (E.D. Tex. 2006)

Supplement

Paice LLC v. Toyota Motor Corp., 504 F.3d 1293 (Fed. Cir. 2007)

Please make sure to read the two concurring opinions in EBay.

12. Continuation Practice and Post-Issuance Proceedings

Please download from Lexis, Westlaw, or SSRN

Mark A. Lemley and Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U.L. Rev. 63 (2004)

Supplement

35 U.S.C. §§ 112, 120, 251-252, 301-307, 311-318.

13. Licensing and Enforcement

Merges and Duffy

Pages 1284-1299

Lear, Inc. v. Adkins, 395 U.S. 653 (1969)

Medimmune, Inc. v. Genentech, Inc., 127 S. Ct. 764 (2006)

Supplement

Quanta Computer, Inc. v. LG Elec., Inc., 128 S. Ct. 2109 (2008)

14. Catch-up and Revision

No new reading.