Syllabus for Patent Law I

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I. COURSE MATERIALS.


Supplemental materials have been uploaded onto TWEN (The West Education Network). You should download the Word document (due to a technical glitch, the html version does not display properly in many cases).

You will need a copy of Title 35 of the U.S. Code, which can be obtained from many online sources. Please be aware that Title 35 was significantly amended in 2011. I will put the new version on TWEN, but you will need the old version as well.

II. OFFICE HOURS.

My office hours are 4-6pm on Thursdays. You can also email me for an appointment. Generally, email is a more reliable way to reach me than phone.

III. GRADES.

Your grade will be based on the final exam, which is graded blindly. The final exam will be open book. It will include several multiple choice or short answer questions, and one or two essay questions.

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. Quality and quantity are both considered in assessing class participation. In general, voluntary participation is given more credit than induced participation when making this assessment.

IV. ELECTRONIC DEVICES

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

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

V. ATTENDANCE

A sign-in sheet will be distributed at the start of class. Please initial the sign-in sheet during the class. If you forget to sign in during the class, you will be marked as absent for that class. You cannot sign in after the class has finished.

The ABA has a rule—over which I have no control—that a student who misses more than 20% of classes is ineligible to sit of the exam. Please make sure you do not violate this rule, as the penalty is severe.
VI. ASSIGNMENTS

Generally, we will cover one topic per class. If we fall behind, we will carry over material to the next class. The assignments are also subject to change depending on our progress.

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 supplemental materials on TWEN.

1. Introduction to Patents
Merges and Duffy 13-35, 48-54, 216-217


*You may be called upon in class to perform the claim drafting exercise.*

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U.S. Patent No. 6,436,015 (weight plate)
U.S. Patent No. 5,734,961 (method for transmitting information)
*Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1 (1931)

2. Patentable Subject Matter I
Merges and Duffy 159-170, 68-78, 170-181

*Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948)
*Parke-Davis & Co. v. H.K. Mulford & Co.*, 189 F. 95 (S.D.N.Y. 1911)

3. Patentable Subject Matter II
Merges and Duffy 108-127, 79-88

*O’Reilly v. Morse*, 56 U.S. 62 (1854)
*The Telephone Cases*, 126 U.S. 1 (1888)

*You may skip the concurring opinions in Bilski.*

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4. Novelty I: Anticipation Requirements
Merges and Duffy 367-384, 391-397
   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)

Please read note 6 on pp. 378-380.

5. Novelty II: Patents and Printed Publications
Merges and Duffy 403-404, 413-441, 527-529
   Jockmus v. Leviton, 28 F.2d 812 (2d Cir. 1928)
   In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004)
   Alexander Milburn co. v. Davis-Bournonville Co., 270 U.S. 390 (1926)

6. Novelty III: Prior Knowledge and Use
Merges and Duffy 403-412, 529-541
   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)

7. Novelty IV: The On-Sale Bar; Experimental Use
Merges and Duffy 544-558, 586-591, 562-569
   W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983)

8. Novelty V: First-to-Invent
Merges & Duffy 449-473, 475-487
   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)

9. Novelty VI: First-to-File
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   New Patent Act, § 102
10. Obviousness I
Merges and Duffy 619-661, 668-670
    *Hotchkiss v. Greenwood*, 52 U.S. 248 (1851)

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

11. Obviousness II
Merges and Duffy 673-692, 699-706

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12. Utility and Enablement
Merges and Duffy 218-233, 212-216, 277-287
    *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364 (Fed. Cir. 1999)
    *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988)

13. Disclosure and Infringement Scope
Merges and Duffy 261-276, 302-312
    *The Incandescent Lamp Patent Case*, 159 U.S. 465 (1895)
    *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998)

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    *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052 (Fed. Cir. 2005)
    *Automotive Techs. Int’l, Inc. v. BMW*, 501 F.3d 1274 (Fed. Cir. 2007)

14. Catch-up and Revision
No new reading.