Patent Law II

This course builds upon the patentability requirements that students learn in Patent Law I, and thus students will learn the basic legal rules and policies governing how patented innovation is licensed, asserted in court, and how it is treated under the antitrust laws. Subjects covered include the nature and function of claims, claim construction, direct infringement, and the doctrine of equivalents infringement. The course will then cover the defenses to patent infringement lawsuits, including laches, exhaustion, experimental use, and inequitable conduct. The class will also study the new doctrines and institutions created by the America Invents Act of 2011 (AIA), including the new prior user right and the new post-issuance review programs, such as post-grant review and inter partes review. The balance of the class will cover the commercialization of patented innovation in the marketplace, studying the doctrines of assignment, licensee estoppel, and the seemingly vexing relationship between patent law and antitrust law. Although patent cases often involve complicated scientific discoveries or technologies, the essential legal principles or policies rarely depend on understanding the underlying science or technology. Accordingly, students with non-technical backgrounds are encouraged to take this course, particularly given that intellectual property assets, such as patents, are increasingly important to commercial clients the world over.

LOGISTICS

1. Attendance and Class Preparation

Students are responsible for complying with GMU’s regulations regarding attendance. The regulations are on the law school’s web site, and students should read them before their first classes. To ensure compliance, I will take attendance. If you are tardy, it will be counted as an
absence unless you tell me to mark you as present before I leave the classroom at the end of class. Two tardies will equal one absence.

2. Grade

Your grade is based primarily on the final exam.

Since class discussion is important to the learning process, I do take class participation into account in the grading process, raising grades for consistent, high-quality participation in class discussion or lowering grades for chronic lack of preparation or unprofessional conduct. At a minimum, classroom participation is used to make decisions on the margins.

3. Final Exam

The final exam will consist of essay and short-answer questions.

The exam is open book, but this does not mean that you should bring everything written under the sun on patent law. Understanding how one prepares for intensive and discrete events, such as patent licensing negotiations, depositions in patent infringement actions, and actual trials, is as much a part of good lawyering as is learning the substantive law. If you want to bring five commercial outlines and a variety of canned summaries to the final exam, then I will not impede your desire to drown yourself (and your grade) under a mountain of superfluous materials.

With that warning in mind, the best way to succeed in this course is to keep up with the assignments and take good notes. When studying for the final exam, I recommend preparing an outline that is detailed and comprehensive. Using your outline, you should also prepare a checklist that lays out the steps you will go through and the issues you will address in answering potential problems on the exam. You will use the checklist as your principal reference guide during the exam, and the more comprehensive outline will serve only as a back-up in case you forget something or need more information. Feel free to use commercial outlines or canned case summaries to fill in holes in your notes—speaking with me though is always the best policy—but it is the preparation of the outline and checklist that constitutes proper studying for a final exam. If you paid attention in class and prepared your own outline and checklist, you should do great on the exam.

Students may either handwrite or type their exam; I have no preference for either format.

4. Technology Issues

TWEN

Students are required to register for the class TWEN site. (For those who may not have used TWEN yet, go to lawschool.westlaw.com, click on the TWEN tab at the top of the page and follow the instructions.) I will post announcements, updates to the syllabus, and supplemental class materials to the TWEN site. If you do not register with your current email address, you risk
not receiving class notices, changes to the syllabus, etc. “I forgot to register at TWEN” is never a valid excuse for not being prepared for class.

**Computers in the Classroom**

Students may use computers or handheld devices for taking notes. I will not be using TWEN or the Internet during class, and thus there is no reason for any student to connect to the school’s network. Please leave Ethernet cables at home and disable all wireless network (wi-fi) cards.

If I discover a student surfing the net during class, the link will be disconnected. Depending on the recidivism of the offending student, I reserve the right to ban the student from using a computer in class for the rest of the term. The same applies to playing games or using computers for any purpose other than note-taking, such as, but not limited to, instant messaging, using Facebook, reading or posting to blogs, planning your next vacation. Such extraneous computer activities ensure that you will do worse in this course than you expect, and they are also unprofessional because they are disruptive to your fellow classmates sitting around you.

**Web-Based Resources for Patent Law**

- U.S. Court of Appeals for the Federal Circuit: [www.fedcir.gov](http://www.fedcir.gov)
- Listing of several online patent databases: [www-sul.stanford.edu/depts/swain/patent/patdbases.html](http://www-sul.stanford.edu/depts/swain/patent/patdbases.html)
- Federal Circuit Bar Association: [www.fedcirbar.org](http://www.fedcirbar.org)
- World Intellectual Property Organization: [www.wipo.int](http://www.wipo.int)
- American Intellectual Property Association: [www.aipla.org](http://www.aipla.org)
5. Office Hours

Although I have “official” office hours, I have an open door policy and I am in my office regularly throughout the workweek. (If the door is closed, please knock and let me know that you are there.) Please feel free to stop by whenever you’d like or make an appointment.

My office hours are: Wednesday, 3:00 – 5:00pm, or by appointment (emailing is usually best).

6. Miscellany

Students are not permitted to record lectures without first obtaining my permission to do so.

I RESERVE THE RIGHT TO CHANGE THE SYLLABUS AND ANYTHING ELSE DISCUSSED HEREIN, except those policies pertaining to attendance and grades, which will be set in stone as of the first day of class.

READINGS


CLASS SCHEDULE

Students are responsible for all class readings, regardless of whether we discuss them in class. (A series of different page ranges, separated by a comma, come from whatever source is designated at the start of the series.) Materials not in the casebook will be posted on TWEN. I reserve the right not to cover some material in the readings in order to stay on schedule, and, as a reminder, you will be responsible for all of the readings listed in the syllabus that we do not cover in class.

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<th>Class</th>
<th>Topic</th>
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<td>Introduction to Patent Law II</td>
<td>M&amp;D 13-33, 749-756, 795-806</td>
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<td>Direct Infringement: Claim Interpretation</td>
<td>Phillips v. AWH (Fed. Cir. 2005) - Judge Mayer Dissent [TWEN]</td>
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<td>Thorner v. Sony Computer (Fed. Cir. 2012) [TWEN]</td>
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|   | Doctrine of Equivalents | M&D 807-830  
*Deere & Co. v. Bush Hog* (Fed. Cir. 2012) [TWEN] |
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| 4 | Indirect Infringement  
“Foreign” Infringement | M&D 858-888 |
| 5 | Defenses:  
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AIA Prior User Right  
Exhaustion | M&D 842-858, 1198-1211  
| 6 | Defenses (cont.):  
Inequitable Conduct  
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Alternative Legal Defensive Mechanisms:  
PTO Post-Issuance Review Proceedings | M&D 1056-1068, 1070-1079  
M&D 1039-1056, 1068-1070 |
| 7 | Law & Fact Questions  
Attorney Fees | M&D 985-1005, 1013-1020  
M&D 984 |
| 8 | Remedies: Damages – Reasonable Royalties | *Panduit Corp. v. Stahlin Bros.* (6th Cir. 1968) [TWEN]  
M&D 915-932 |
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