

# 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* (7th ed. 2017).

- The 8th edition (2021) is supposed to be out in August, but as of this time I have not been able to obtain it. I am assured that it will have all the cases I have assigned, so either the 7th or 8th edition will work. The page numbers in the syllabus are based on the 7th edition.

Supplemental materials on Blackboard.

## II. LEARNING OUTCOMES

By the end of the course, students should have an understanding of the principles of patent law and the structure of the American patent system. Students should achieve proficiency in reading the patent document, analyzing patent claims, and evaluating patent validity. Students should also have an understanding of the moral and economic policy considerations underlying patent law.

## III. OFFICE HOURS.

Office hours are Tuesdays from 4-6pm. You do not need to make an appointment to see me at those times, though you are welcome to send an email ahead of time to let me know to expect you. I realize that many students work during the day and I am happy to meet at other times if you email me for an appointment. Generally, email is a more reliable way to reach me than phone.

Based on current conditions, I plan to hold in-person office hours, with face masks for everyone including vaccinated students and myself. If you prefer to meet remotely, that can be arranged. If you have an exemption from the vaccination requirement, you must both wear a mask and additionally maintain social distance.

## IV. GRADES.

Your grade will be based on the final exam, which is graded blindly. The final exam will be open book. Additional details regarding the exam will be determined later in the semester based on conditions at the time. The current plan is for grades to be awarded on the standard law school curve.

## V. COVID-19 PRECAUTIONS.

The current plan is for the class to be taught in-person. Consistent with university policy, face masks are required for all students, even if you are fully

vaccinated. You must wear your mask so that it fully covers your nose and mouth, and you should keep your mask on at all times indoors, even when you are speaking in class. If you have an exemption from the vaccination requirement, you must comply with the masking requirement and additionally maintain distance from others.

If you are experiencing symptoms of Covid-19 or any other respiratory illness, please do *not* come to class until you fully recover. Even if you are vaccinated. Even if you test negative for Covid-19. Not only is there the possibility of a breakthrough infection or a false negative test, there is the possibility of some other illness such as influenza or the common cold that you should not want to transmit to your classmates.

## **VI. ASSIGNMENTS**

Generally, we will cover one segment 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 Blackboard.

### **1. Introduction to Patents**

Merges and Duffy 19-42, 55-64, 199-200

*Lowell v. Lewis*, 15 Fed. Cas. 1018 (C.C.D. Mass. 1817)

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

Blackboard

U.S. Patent No. 6,436,015 (weight plate)

U.S. Patent No. 5,734,961 (method for transmitting information)

### **2. Novelty I: Anticipation Requirements**

Merges & Duffy 394-407, 415-428

*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. 401-403.*

### **3. Novelty II: Patents and Printed Publications**

Merges & Duffy 327-343, 440-442, 446-450

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

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

#### **4. Novelty III: Prior Use and Sale**

Merges & Duffy 343-356, 361-377, 442-446

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

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

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

#### **5. Novelty IV: Secret Use and Sale; Experimental Use**

Merges & Duffy 356-361

*Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516 (2d Cir. 1946)

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

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

#### **6. Novelty V: Priority Between Competing Applicants**

Merges & Duffy 451-470, 378-394

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

#### **7. Obviousness I**

Merges & Duffy 511-527, 531-551

*Hotchkiss v. Greenwood*, 52 U.S. 248 (1851)

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

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

#### **8. Obviousness II**

Merges & Duffy 569-584, 590-600

*KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007)

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*Stanford University v. Roche Molecular Sys., Inc.*, 563 F.Supp.2d 1016 (N.D. Cal. 2009)

#### **9. Utility and Enablement**

Merges & Duffy 201-206, 209-217, 266-273

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

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

*Janssen Pharmaceutica v. Teva Pharmaceuticals USA Inc.*, 583 F.3d 1317 (Fed. Cir. 2009)

#### **10. Disclosure and Patent Scope**

Merges & Duffy 252-263, 282-289

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

*Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998)

Blackboard

*In re Angstadt*, 537 F.2d 498 (C.C.P.A. 1976)

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

## **11. Patentable Subject Matter I: Nature**

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*Lab Corp. of Am. v. Metabolite Labs., Inc.*, 548 U.S. 124 (2006)

*Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1 (1931)

Merges & Duffy 75-85, 128-143

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

*Ass'n for Molecular Pathology, Inc. v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013)

## **12. Patentable Subject Matter II: Abstract Ideas**

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

*Parker v. Flook*, 437 U.S. 584 (1978)

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

Merges & Duffy 86-95

*Bilski v. Kappos*, 561 U.S. 593 (2010)

## **13. Patentable Subject Matter III: The Modern Landscape**

Merges and Duffy 102-113, 143-165

*Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)

*Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014)