

## **Patent Law**

Spring 2011, Prof. Michael Risch

### **Prerequisites**

There are no prerequisites for this class. You do not need a science degree, nor do you need to be interested in taking the Patent Bar to enjoy or learn in this class. You do, however, have to be willing to learn about new areas of technology (simplified). Many students have done very well (and received A's) without a science degree.

### **Class Days and Office Hours**

Class will meet Tuesdays and Thursdays from 1:40-2:30.

My office hours are 9:30-11:00 on Tuesdays, plus any other time that we might schedule in advance. Additionally, if I am in my office with the door open, please feel free to come in and talk.

You may contact me anytime at [risch@law.villanova.edu](mailto:risch@law.villanova.edu)

### **Class Goals**

I have five goals for this class:

#### *Primary*

1. You should understand and be able to apply U.S. patent law principles

#### *Secondary*

2. You should understand some of the reasoning behind U.S. patent laws
3. You should understand how some of the patent rules affect other rules
4. You should understand how changing some of the patent laws will affect the system

#### *Synthesis:*

5. You should be able to express your understanding both in writing and in discussion

### **Books and Materials**

Unless otherwise noted, all page numbers refer to Merges & Duffy, **4th** edition.

You will also need a statutory supplement. I have ordered the supplement that comes with Merges, Menell & Lemley (the same supplement we used in the Intellectual Property Class) but you may use any other patent statutory supplement - even the patent statute directly from the U.S. Patent & Trademark Office, located at [http://www.uspto.gov/web/offices/pac/mpep/consolidated\\_laws.pdf](http://www.uspto.gov/web/offices/pac/mpep/consolidated_laws.pdf)

If you use the Merges, Menell & Lemley supplement, I highly recommend that you read the introductions to computers and biotechnology.

The course website is:

<http://www.casesofinterest.com/tiki/tiki-index.php?page=Patent+Law+Spring+2011>

You can access the page via the course's Blackboard page as well. The course page includes this syllabus and associated information, and may contain additional materials in the future.

Finally, we will be using clicker devices during the course. You can get these from the Copy and Distribution Center if you do not have one already. You must register your clicker serial number so that I can keep track of your attendance and participation. Use this site to register your clicker (you can click on it directly from the CasesofInterest.com website):

[http://www.casesofinterest.com/tiki/tiki-view\\_tracker.php?trackerId=9#content2](http://www.casesofinterest.com/tiki/tiki-view_tracker.php?trackerId=9#content2)

### **Writing Requirement**

A total of four percent (4%) of your grade will be from short written case briefs. Please see the "Writing Requirement" web page at the CasesofInterest.com website for more discussion.

### **Class Participation**

Three percent (3%) of your grade will be based on class participation, with an emphasis on quality over quantity. Short class exercises may be assigned, and they are mandatory but not graded; instead, they will be included in your class participation grade. Please see the "Class Participation" web page at the CasesofInterest.com website for more discussion.

### **Grade Bumps**

The 7% associated with the writing requirement and class participation are used to consider raising or lowering your grade pursuant to Law School policy. Note, however, that the default is a grade decrease if you do not complete the writing requirement or participation.

### **Attendance**

Your attendance and participation in class is required, and is critical to your learning the material in the assigned readings. Class attendance will not be graded *per se*, but excessive absences may lead to reduction in grades. See the "Class Participation and Policy" document for more information.

### **Final Exam**

Ninety-three percent (93%) of your grade will be the final exam. The form of the final exam is to be decided. The exam will be an open book, open note exam, but you may not confer with any other person about the exam.

## Reading Assignments

Readings for each class session are below, with each number signifying one class period. Unless otherwise noted, all section references are to the Patent Act, 35 U.S.C. §101 *et seq.* There are many “skim” readings, which are primarily cases covered in IP Survey. I include them here to refresh your recollection and understanding of those cases. Further, you will note that some days are heavy reading, followed by some days of light reading; we will likely have many lessons that carry over half-way through the next class, though you should always read for the next class.

1. *Introduction to Patents and Claims*, *Kewanee v. Bicron* (separate handout, available on Blackboard); pp. 14-35, 49-55; Background pp. 1-13 (not required, but may be helpful)
2. *Utility I*, pp. 207-218 note 1, 220 (note 1 only); §101; U.S. Const., Art. 1, Sec. 8, cl. 8; Required exercise: draft pencil claims as discussed on p. 35, bring to class, and be prepared to discuss
3. *Utility II*, pp. 231-238, skim 222-231, 240-250
4. *Enablement I*, pp. 257-261, 269-275 ; §112, skim 261-269.
5. *Enablement II*, pp. 275-284, 286-293, 295-297 (start at note a)
6. *Written Description*, pp. 299-302, 307-320; §§120, 132, skim 303-307
7. *Definiteness*, pp. 328-340
8. *Best Mode*, pp. 340-356 (top of page)
9. *Novelty I*, pp. 357-360, 370-387; §§100, 102, skim 360-370 (read notes more carefully)
10. *Novelty II*, pp. 393-417 (long assignment - please read all cases – Rosaire was assigned in IP Survey. We will do exercises in class about these cases - I won't be asking about any particular case in class)
11. *Novelty III* 421-428, 431-438
12. *Novelty IV*, pp. 438-453
13. *Novelty V*, pp. 456-464, 468-478; §104
14. *Statutory Bars I*, pp. 509-511, 517-518 (note 1), 519-522, 526-536; §102(b), skim 522-526
15. *Statutory Bars II*, pp. 536-545 (note 4), 548 (note 6)-550 (note 8), 555-567, 569-570 (note 5); 545, note 5 will be covered in class as an exercise, though reading it may be helpful
16. *Statutory Bars III*, pp.570-578 (note 5), 579 (note 7)-584, 589; §102(c)
17. *Obviousness I*, pp. 611-617, 645-653, 661 (notes 4 and 5); §103, skim 630 (top)-645 (note that *Calmar v. Cook chemical* is combined with *Graham* and starts in the middle of 645), skim 653-660 (*Adams case*)
18. *Obviousness II*, pp. 663-665, 680-685, 692-695, 711-712 (note 1), 724-732, skim 665-680
19. *Obviousness III*, pp. 734 (note 4)-740, 745-749 (note 3), 750-759, 764-769 (long assignment - we will cover these cases as a group in class rather than discussing each in detail)
20. *Subject Matter I*, pp. 67-68, 111-112 (notes 4, 5), 113 (no notes)-117; §§100 and 101; skim 68-77 (note 2), 106-110 (note 1)
21. *Subject Matter II*, pp. 79-89 (note 5), *Bilski v. Kappos* (Supreme Court case to be distributed)
22. *Infringement I*, pp. 781-785 (no notes), 801-812; §271 (787-788 are recommended if you plan to practice patent law); skim 788 (*Phillips*)-800
23. *Infringement II*, pp. 812-826, 839 (notes 1, 2), 845-846, 882-891
24. *Equivalents*, pp. 849-853, 854 (note 2)-855 (note 3), 856-867; skim 867-880 (note 5)
25. *Indirect Infringement*, pp. 907-916, 919-921 (note 3), 926 (note 2)-931; §271; skim 916-919
26. *Inequitable Conduct*, pp. 1102-1108, 1110-1120 (note 8), 1121-1128; §287 (readings may change – Federal Circuit is revisiting issue)
27. *Remedies*, pp. 933-939 (note 1), 969-979 (note 2), 985-997 (note 2); §§283-284
28. *Catch-up and review*

Unless otherwise noted or discussed in class, each assignment applies to each class session, even if we haven't finished discussing the last assignment in class. You are, of course, free to read unassigned materials, and those materials may help your understanding of patent law.

