

PATENT LAW SYLLABUS – FALL 2015

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Office Hours: Tuesdays, 10:00am-noon, 2:00-3:00pm, also available by appointment

Casebook and Other Required Texts: The casebook is Nard, *The Law of Patents, Third Edition* (Aspen 2013). The casebook supplement (referred to in Course Reading List as Nard Supp.) has been posted to TWEN. Other supplemental readings will be posted to TWEN as indicated in the readings. The casebook contains the relevant patent statutes. The casebook website (<http://law.case.edu/lawofpatents/>) also contains supplemental information including patent statutes and regulations as well as many of the patents referenced in the assigned cases and may be accessed during class if you bring your laptop. For this reason, I have not required any statutory supplement.

Objectives: To examine the policy issues underlying the patent system; to develop a framework for analyzing the patentability of an invention; to understand the process of patent infringement; and to explore defenses to and remedies for a patent infringement action.

Grading: Seventy percent (70%) of the final course grade will be based on the final examination. Twenty percent (20%) of the grade will be based on assignments (see below). Ten percent (10%) of the grade will be based on attendance, class preparation and participation. Feel free to check with me via email (jcj@law.msu.edu) throughout the semester as to your participation point progress.

Attendance and Preparation: Attendance: Attendance is essential for developing the legal analytical skills that will be tested on the final exam (and is required by the ABA). I will take daily attendance either informally – that is, you will have an assigned seat and I will notice when it is empty – or by passing a roster to be signed; consistent *unexcused* absences or tardiness will be considered a failure to prepare for class and may result in negative participation points. If for some good reason you are forced to miss more than four classes, you are required to see me outside of class or you will not be allowed to take the final exam. I will not contact you after you have missed 4 classes; it is your responsibility to keep up with the number of missed classes. Preparation: You should be prepared to answer questions when I call on you in class. There is no penalty for being nervous or failing to have the correct answer as long as you are prepared and can discuss the reading for the day when asked. Because I understand that other commitments may *occasionally* interfere with class preparation and I would rather that you come to class unprepared rather than skip, you may be excused from class participation with no grade effect TWICE during the semester by signing the Do Not Call List before the beginning of class.

Participation: You will need ten (10) participation points in order to receive full credit for participation, i.e., each point is one percent of your final grade. Participation points may be gathered in a number of ways. Being prepared when called on will gain you a participation point; lack of preparation or unexcused absences will lose one point (see above). Second, I will ask for volunteers to answer questions in class. You may acquire one participation point per class period. In addition, there may be out-of-class opportunities such as attendance at patent related events, discussion participation on the

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TWEN message board and posting patent related current news clippings with summaries of the major issues.

Class Assignments: There will be ten (10) required assignments and one optional assignment throughout the course of the semester. The assignments mirror questions that will appear on the final exam. If you complete all eleven (11) assignments, you will have essentially completed two practice exams. Each assignment should be uploaded to the appropriate TWEN Dropbox folder before the beginning of the class for which it is due.

Examination: The final examination format will be take-home, open book and will likely consist of a mixture of short answer and essay questions. We may not cover all assigned readings in class; however, unless I state otherwise, all assigned readings are likely to appear on the exam.

Office Hours & Availability: I would love the chance to get to know each of you personally. Please come by my office during office hours should you have questions about the course, law school, the job search, etc. Alternatively, you may also make an appointment to meet with me at other times or just drop by my office if I have the door open. Finally, feel free to email me if that works best for you.

Reading Assignments: A course outline is below. The course readings for the semester follow. If a class must be cancelled, we will schedule a makeup class and proceed through the assignments in order. In the course readings, page numbers reference the Nard book unless otherwise noted. Excerpts notated as TWEN refer to supplementary material posted on TWEN.

- I. Introduction to Patent Procedures, Architecture and Claims
- II. Claim Interpretation
- III. Disclosure Requirements
 - A. Enablement
 - B. Written Description, Definite Claims, Best Mode
- IV. Patentable Subject Matter
- V. Utility
- VI. Novelty & Statutory Bars
 - A. Anticipation
 - B. Pre-AIA Section 102
 - C. Post AIA Section 102
- VII. Non-Obviousness
 - A. Graham Test
 - B. Secondary Factors
 - C. PHOSITA
- VIII. Infringement
 - A. Direct – Literal & Doctrine of Equivalents
 - B. Indirect Infringement
 - C. Geographical Limitations
- IX. Defenses
- X. Remedies

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Course Readings

- For all readings assigned, you should also read the related patent statutes which can be found beginning at page 975 in the casebook or on the casebook website.
- The related patents may also be valuable in understanding the case, but are not assigned readings.
- Submit assignments on the date listed by the beginning of class by uploading to the TWEN Dropbox.

Class	Topic	Assignment
Class 1	Introduction I: What is Patent; How to Obtain Patent Rights	1. Nard, pages 1-6, 16-29, 31-49.
Class 2	Introduction II: How to Search for Patent Information; How to Read a Patent	1. We will be discussing US patent number 5,205,473 in class. Find the patent, skim it (noting all the various sections), and bring it to class. Hint: US Patent and Trademark Office has at least two search engines for patents. Google also has a patent search engine. 2. The patent assigned covers an insulated cup holder of the type seen at coffee houses across the United States (Starbucks, Biggbys, etc.). Stop by a coffee shop and pick one up. Bring it to class with you. We will discuss how to determine if your cup holder would infringe the patent.
Class 3	Claim Interpretation	1. Assignment #1 – Patent Research, Due to TWEN Dropbox 2. Nard 59-78 3. Nard Supp. 32-45 4. Obtain Milk Flavoring Straw in Class
Class 4	Enablement	1. Assignment #2 – Claim Construction, Due to TWEN Dropbox 2. 91, 96-108, 114-125 (ignore notes related to Morse as we didn't read that case)
Class 5	Written Description; Best Mode; Definiteness	1. Nard 125-142 2. Nard Supp. 1-11
Class 6	Patentable Subject Matter I: Biotechnology	1. Assignment #3 – Section 112, Due to TWEN Dropbox 2. Nard 165-202
Class 7	Patentable Subject Matter II: Method Patents and Software	1. Nard Supp. 11-32
Class 8	Utility	1. Nard 240-262
Class 9	Assignment Review	1. Assignment #4 – Utility 2. Prepare Presentation as Assigned
Class 10	Pre-AIA Novelty & Statutory Bar I:	1. Nard 263-281, 310-318

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	Anticipation, Date of Invention, 102(a), “known or used by others” and “printed publication”	
Class 11	Pre-AIA Novelty & Statutory Bar II: 102(e), 102(b) “on-sale bar”	1. Nard 437-457
Class 12	Pre-AIA Novelty & Statutory Bar III: 102(b), “public use” and experimental use	1. Nard 457-467, 482-499
Class 13	Pre-AIA Novelty & Statutory Bar III: Pre-AIA Problem Set	1. Assignment #5 – Pre-AIA Problem Set, Due to TWEN Dropbox
Class 14	AIA Reforms I: Novelty & Statutory Bar; Priority, Post-AIA Problem Set	1. Nard 281-285, 323-324
Class 15	AIA Reforms II: Post-AIA Problem Set Continued	1. Assignment #6 – Post-AIA Problem Set, Due to TWEN Dropbox
Class 16	Non-Obviousness I: History and the Graham Test	1. Nard 347-372
Class 17	Non-Obviousness II: Applications of the Graham Test	1. Nard 372-405
Class 18	Non-Obviousness III: Secondary Considerations, Analogous Prior Art and PHOSITA	1. Nard 408-436
Class 19	Enforcing Patent Rights – Direct Infringement I: Intro, and Literal Infringement	1. Assignment #7 – Non-Obviousness, Due to TWEN Dropbox 2. Nard 501-507, 517-523
Class 20	Enforcing Patent Rights – Direct Infringement II: Doctrine of Equivalents	1. Nard 523-524, 526-547
Class 21	Enforcing Patent Rights – Direct Infringement III: Limitations to DOE	1. Nard 547-560, 562-570, 581-587
Class 22	Enforcing Patent Rights – Indirect Infringement	1. Assignment #8 – Direct Infringement, Due to TWEN Dropbox 2. Nard 603-613 3. Nard Supp. 46-54
Class 23	Other Issues with Infringement: Infringement of Means Plus Function Claims	1. Nard 622-630
Class 24	Defenses to Patent Infringement I: Patent Exhaustion; Repair v. Reconstruction; Limitations to Patent Exhaustion	1. Assignment #9 – Indirect Infringement, Due to TWEN Dropbox 2. Nard 663-676, 699-720
Class 25	Defenses to Patent Infringement II: Challenging Patent Validity	1. Assignment #10 – Repair v. Reconstruction, Due to TWEN Dropbox 2. Nard 729-758
Class 26	Defenses to Patent Infringement III:	1. Nard 799-810, 810-817

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	Inequitable Conduct; Experimental Use	
Class 27	Remedies for Patent Infringement	1. TBD
Class 28	Wrap Up and Review	1. Assignment #11 – Overview, Due to TWEN Dropbox (optional but may replace any previous Assignment) 2. Prepare Presentation as Assigned
Final Exam Week	Final Exam – Take Home	Self-Scheduled – May be completed during the exam period; completed exams to be emailed to registrar at exam@law.msu.edu unless directed otherwise in exam instructions.