

Patent Law

Fall 2008, 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 did very well (and got A's) without a science degree last year.

Class Days and Office Hours

Class will meet Mondays and Wednesdays from 10:00-11:15. We will not meet on 9/1.

My office hours are 11:15-12:00 and 1:00-1:45 on Mondays and Wednesdays, 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 at michael.risch@mail.wvu.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 used by Professor Olson in his 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

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+Fall+2008>

You can access the page via the course's TWEN 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 PRS devices ("clickers") during the course. Please see Keith Walton in the Library or Room 225 to obtain and register your clicker.

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 (copy attached) 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 (copy attached) for more discussion.

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 final exam will be an eight hour take home final with a word limit, though you can finish it in less time. The exam will be an open book, open note exam, but you may not confer with any other person about the exam.

Reading Assignments

Unless otherwise noted, all section references are to the Patent Act, 35 U.S.C. §101 *et seq.*

1. *Introduction to Patents and Claims*, *Kewanee v. Bicron* (separate handout, available on TWEN page); 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. 222-238, 240-250
4. *Enablement I*, pp. 257-272 ; §112
5. *Enablement II*, pp. 273-284, 286-293, 295-297 (start at note a)
6. *Written Description*, pp. 299-320; §§120, 132
7. *Definiteness*, pp. 328-340
8. *Best Mode*, pp. 340-356 (top of page)
9. *Novelty I*, pp. 357-370, 380-387; §§100, 102
10. *Novelty II*, pp. 393-417, 421-428 (long assignment - please read all cases. We will do exercises in class about these cases - I won't be asking about any particular case in class)
11. *Novelty III*, pp. 431-453
12. *Novelty IV*, pp. 456-464, 468-478, 370-380; §104
13. *Statutory Bars I*, pp. 509-511, 517-518 (note 1), 519-536; §102(b)
14. *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
15. *Statutory Bars III*, pp.570-578 (note 5), 579 (note 7)-584, 589; §102(c)
16. *Obviousness I*, pp. 611-623, 630 (top)-653, 661 (notes 4 and 5); §103 (long, but only 2 cases)
17. *Obviousness II*, pp. 663-685, 692-695, 711-712 (note 1)
18. *Obviousness III*, pp. 724-732, 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)
19. *Subject Matter I*, pp. 67-77(note 2), 79-89 (note 5), 98-105 (no notes); §§100 and 101
20. *Subject Matter II*, pp. 106-110 (note1), 111-112 (notes 4, 5), 113 (no notes)-117, 141-150, 156-164
21. *Infringement I*, pp. 781-785 (no notes), 788 (Phillips)-812; §271 (787-788 are recommended if you plan to practice patent law)
22. *Infringement II*, pp. 812-826, 839 (notes 1, 2), 845-846
23. *Equivalents*, pp. 849-853, 854 (note 2)-855 (note 3), 856-880 (note 5)
24. *Indirect Infringement*, pp.907-921 (note 3), 926 (note 2)-931; §271
25. *Defenses I*, pp. 882-891, 895-902, 1130-1137 (note 1), 1138 (note 4)-1140
26. *Defenses II*, pp. 1102-1108, 1110-1120 (note 8), 1121-1128; §287
27. *Defenses III*, pp. 1239-1253, 1256-1257 (notes 3-5), 1262-1265, 1291-1298
28. *Remedies*, pp. 933-939 (note 1), 969-979 (note 2), 985-997 (note 2); §§283-284

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.

Social Justice Statement

West Virginia University is committed to social justice. I concur with that commitment and expect to maintain a positive learning environment based upon open communication, mutual respect, and non-discrimination. Our University does not discriminate on the basis of race, sex, age, disability, veterans status, religion, sexual orientation, color or national origin. Any suggestions as to how to further such a positive and open environment in this class will be appreciated and given serious consideration.

If you are a person with a disability and anticipate needing any type of accommodation in order to participate in this class, please advise me and make appropriate arrangements with the Office of Disability Services (293-6700).