

LAW-688-001: Patent Law

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About This Course

This is an introductory course to patent law, the area of law that provides exclusive rights over inventions and technology. The course will address the theoretical backdrop of patent law, cover the major doctrines of patent validity, infringement, and remedies, provide a window into the practical activities of patent attorneys, and consider key questions in modern patent policy.

A bit about me: I am a former patent attorney who worked primarily in computer software technologies, as both a litigator and a patent prosecutor. For the last ten years, I have been at nonprofit organizations working in intellectual property policy. In this capacity, I have written *amicus curiae* briefs in key patent and copyright cases, commented on legislation, and studied the potential effects of changes to intellectual property law.

Who Should Take This Course?

This course has no prerequisites. It is intended for students who intend for patent law to be a substantial part of their career or who otherwise have a strong interest in intellectual property or technology law.

In particular, **there is no technical background requirement for this course.** While there are scientific prerequisites for obtaining registration to practice before the U.S. Patent and Trademark Office, many people have gone on to success-

ful careers in patent law regardless of their college degree. All that is required, both for this course and generally, is an appetite for diving deep into complex problems of technology and invention.

Learning Outcomes

Students who complete this course will gain practice in:

- Characterizing the major doctrines of patent law and performing legal analysis based on them.
- Reading the contents of patent documents.
- Following the general outline of patent litigation.
- Understanding theories and policies behind patent law, and applying these to legal questions and policy debates.
- Explaining patent law and new technologies to others unfamiliar with the field.

Course Logistics

Meetings: Mondays and Wednesdays, 10:30–11:50 AM.
Room: Yuma 402.
Prerequisites: None.
Credit hours: 3.

Contact Info

Email: cduan@wcl.american.edu
Web: <https://www.cduan.com>
Office: Yuma 327
Office Hours: Tuesdays 11:00 AM–12:00 PM.

I am happy to meet in person or virtually; just send me an email to set up a time. I will also try to set up regular office hours.

Course Materials

The main textbook for this course is Jonathan S. Masur & Lisa Larrimore Ouellette, *Patent Law: Cases, Problems, and Materials* (3d ed. 2023). The book is available for free electronic download [↗](#); that website also contains links for purchasing the book.

I have frequently supplemented the textbook with cases and other readings. These will be available on Canvas. They are also all freely available and hopefully easy to find online. Note that page numbers for assigned cases refer to the PDF files on Canvas, not the reporter pages.

Occasionally I have also assigned statutes to read. You can access statutes online at the Legal Information Institute [↗](#).

If you would like a study aid, you have many options in the library or online, but an excellent and free option is Congressional Research Service Report R46525, *Patent Law: A Handbook for Congress* (2020) [↗](#).

Course Policies

Attendance and Participation

I expect that all students will attend class regularly, complete the assigned readings and any assigned practice questions, arrive to class promptly and be prepared to participate in the class discussion when called upon. If you are unprepared to participate in the class discussion, please let me know in advance of class (either via email the day before or in-person before class begins).

If you face particular challenges that make attendance difficult, contact the Office of Student Affairs.

Classes will be recorded, but the recordings will only be made available to individual students with excused absences. Please let me know in advance if you will be absent, so that I am aware and can send you the recording. If I do, keep in mind that the recordings are for personal use and should not be retained or shared with others.

Grading and Evaluation

Your grade will primarily be based on the results of a final examination. It will be a scheduled, three-hour final examination at the end of the semester. The examination will consist of two hours of essay questions and one hour of written short-answer questions (though it is up to you how you allocate your time).

The examination will be “open materials/closed Internet,” meaning that students may use any materials they bring with them (including digital materials) but access to the Internet during the examination is prohibited.

I may adjust grades up or down by one step (e.g., B+ to A– or B) based on your preparation for and participation in class. Good participation demonstrates engagement with the subject matter of the course and contributes to your fellow students’ learning. Discussions via email, participation in group in-class exercises, and conversations during office hours will all be considered part of class participation.

Schedule

Although I hope to keep to this schedule as much as possible, it is subject to change depending on the pace of the class and external events such as important judicial decisions or guest speakers. If there are any updates, a revised syllabus will be posted on Canvas.

Introduction

August 28—Theory of Patents

- Read:* *Bonito Boats v. Thunder Craft*, 489 U.S. 141 (1989), coursepack pages 1–10, entire text.
- *Graham v. Deere*, 383 U.S. 1 (1966), coursepack pages 11–15, “After a lapse of 15” through “of the 1793 Patent Act.”
 - Textbook, pages 33–42, Ch. I.1.E–I.1.F.

August 30—How to Read a Patent

Read: Textbook, pages 10–32, Ch. I.1–I.1.D.

- (Optional) Peter S. Menell et al., Patent Claim Construction, 25 Berkeley Tech. L.J. 711 (2010), coursepack pages 22–28, “Table B: Common Terms Construed” through “1142, 1147–48 (Fed. Cir. 2004).”

Prepare: Find U.S. Patent 6,368,227 and read through it.

- Have a copy of the Menell article available for class.

September 4—NO CLASS: Labor Day

Requirements of Patentability

September 6—Introduction to Novelty

Read: Textbook, pages 47–49, Ch. II.2.

- Textbook, pages 116–132, Ch. II.2.C.

September 11—Novelty: Types of Prior Art

Read: Textbook, pages 61–64, Ch. II.2.B1.1.

- Textbook, pages 70–75, Ch. II.2.B2 through *Netscape Communications v. Konrad*, 295 F.3d 1315 (Fed. Cir. 2002).
- Textbook, pages 82–96, Ch. II.2.B2.3 through *W.L. Gore & Associates v. Garlock*, 721 F.2d 1540 (Fed. Cir. 1983).

September 13—Novelty: Timing

Read: Textbook, pages 49–60, Ch. II.2.A.

- Textbook, pages 64–66, Ch. II.2.B1.2.
- Textbook, pages 103–105, Ch. II.2.B2.5.
- America Invents Act First Inventor to File: USPTO Training Slides, coursepack pages 29–57, entire text.
- (Optional) Textbook, pages 105–116, Ch. II.2.B3. Read if you want to see how complicated the law used to be.

Prepare: Study 35 U.S.C. § 102 carefully. Use the examples on the USPTO slides to test your understanding.

September 18—Obviousness: The Law

Read: *Graham v. Deere*, 383 U.S. 1 (1966), coursepack pages 15–20, “The difficulty of formulating conditions” through “before reaching the Patent Office.”

- Textbook, pages 133–151, Ch. II.3–II.3.A.

September 20—Obviousness: Secondary Considerations

Read: Textbook, pages 152–167, Ch. II.3.B.

- Procter & Gamble v. Teva, 566 F.3d 989 (Fed. Cir. 2009), coursepack pages 58–64, entire text.

September 25—Enablement

Read: Textbook, pages 168–172, Ch. II.4–II.4.A. Skip the Janssen case.

- Textbook, pages 187–205, Amgen v. Sanofi, 143 S. Ct. 1243 (2023) through “F.3d 1377 (Fed. Cir. 2012).”.

September 27—Written Description

Read: Textbook, pages 205–230, Ch. II.4.C.

October 2—Definiteness and Functional Claims

Read: Textbook, pages 231–242, Ch. II.5–II.5.A.

- Williamson v. Citrix Online, 792 F.3d 1339 (Fed. Cir. 2015), coursepack pages 65–78, entire text.
- Textbook, page 246, “Practice Problem: Does § 112(f)” through “knife blade means for cutting”.

October 4—Patentable Subject Matter: Software

Read: Textbook, pages 252–254, Ch. II.6.

- Textbook, pages 286–308, Ch. II.6.B through “are ineligible under § 101.”. Skip USPTO Guidance.
- Textbook, pages 312–314, “Practice Problems: Abstract Ideas Consider” through “F.3d 1253 (Fed. Cir. 2017).”.

October 9—Patentable Subject Matter: Biotechnology

Read: Textbook, pages 254–267, Ch. II.6.A through “to fail or fall short?”.

- Vanda v. West-Ward, 887 F.3d 1117 (Fed. Cir. 2018), coursepack pages 79–89, entire text.
- Textbook, pages 284–286, “Practice Problems: Laws of Nature” through “F.3d 1319 (Fed. Cir. 2020).”.
- (Optional) Textbook, pages 311–312, “American Axle and the State” through “without comment in June 2022.”.

October 11—Gene Patents; Other Validity Requirements

Read: Textbook, pages 267–274, *Association for Molecular Pathology v. Myriad Genetics*, 569 U.S. 576 (2013).

– Textbook, pages 315–331, Ch. II.7.

Prepare: We will hopefully have as a guest speaker Professor Jorge Contreras, who recently authored a book on the Myriad case. Come with questions about the history and policy of gene patents.

October 16—NO CLASS: Fall Break

October 18—Review, Catch-Up, and Other Topics

Infringement and Remedies

October 23—Claim Construction

Read: Textbook, pages 332–349, Ch. III–III.8.

– *Simo Holdings v. Hong Kong uCloudLink*, 983 F.3d 1367 (Fed. Cir. 2021), coursepack pages 90–95, entire text.

October 25—Direct Infringement

Read: Textbook, pages 350–373, Ch. III.9.

October 30—Indirect Infringement

Read: Textbook, pages 374–402, Ch. III.10–III.11.A.

November 1—Limitations and Defenses

Read: Textbook, pages 402–407, Ch. III.11.B.

– Textbook, pages 420–442, Ch. III.12.

November 6—Injunctions and Reasonable Royalties

Read: Textbook, page 443, Ch. IV.

– Textbook, pages 444–455, Ch. IV.13. Skim the discussion questions.

– Textbook, pages 482–499, Ch. IV.15. Skim the discussion questions.

November 8—Lost Profits

Read: Textbook, pages 456–481, Ch. IV.14.

November 13—Additional Damages; Patent Procedure

Read: Textbook, pages 500–514, Ch. IV.16.

– Textbook, pages 515–529, Ch. V.17.

Prepare: Review 35 U.S.C. § 311-319. How does the statute match the textbook’s description of inter partes review?

Special Topics

November 15—Design Patents

Read: Textbook, pages 544–550, Ch. V.19.B.

- Best Lock v. Ilco Unican, 94 F.3d 1563 (Fed. Cir. 1996), coursepack pages 96–103, entire text.
- LKQ Corp. v. GM Global Technology, No. 21-2348 (Fed. Cir. Jan. 20, 2023), coursepack pages 104–114, entire text.

November 20—International Patent Law

Read: Textbook, pages 552–580, Ch. V.20–V.20.E.2.

November 22—Pharmaceuticals

Read: Kevin J. Hickey et al., Drug Pricing and Intellectual Property Law: A Legal Overview for the 116th Congress (2019), coursepack pages 116–139, “Types of Pharmaceutical Patents” through “Overview for the 116th Congress”. Skip the footnotes, and focus primarily on the generic drug sections, less on biosimilars.

Prepare: Skim 21 U.S.C. § 355(j). You do not need to understand it, but appreciate its complexity, and see if you can connect the CRS report analysis to the statutory language.

November 27—Information and Communication Technologies

Read: Textbook, pages 580–583, Ch. V.20.E.3.

- Brian T. Yeh, Availability of Injunctive Relief for Standard-Essential Patent Holders (2012), coursepack pages 141–157, “IT Industry Products and Patents” through “appropriate in cases involving SEPs”.
- (Optional) Textbook, pages 530–537, Ch. V.18.

November 29—Catch-Up and Review