Patent Law
(LAW-688-001)

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Course Information

Meetings:	Monday & Wednesday, 1:00-2:30 PM
Location:	Y402
Credits:	3
Office hours:	Tuesdays at 1:30-3:30 PM
Prerequisites:	None.
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About This Course

Welcome to Patent Law! The official description of this course is:

> Provides an introduction to issues of legal protection and incentives for technological innovation, focusing on the federal Patent Act, federal court decisions, Patent Office rules, and relevant provisions of international patent law treaties. Specific topics include the history and philosophic underpinnings of American patent law; why people seek patents and the economics of inventive activities; the patent application process; substantive requirements for obtaining patents; how patents are enforced; licensing of patented inventions and antitrust law considerations; and international patent protection.

I didn't write this description, but it's a good one because it reflects many dimensions of patent law. The focus of study will, of course, be the specific doctrines and rules of the Patent Act—what inventions merit patent protection, what one must do to get a patent, and how patents are used in litigation.

But patent law shows up in a broad range of other areas of law and policy—telecommunications, health care, environmental protection, artificial intelligence, competition policy, employment, and tax law, to name a few. That is because technology affects so many things, and patent law is a key legal regime that regulates technology. If you've held a smartphone, taken a prescription drug, or eaten at Taco Bell, you've interacted with the U.S. patent system.

Our goal in this course, then, will also be to place patent law into this larger context. Even if you are not planning on a career in patent law, learning the ways in which this legal system encourages—or impedes—technologies will hopefully add new dimensions to your understanding of law and society.

Who Are You?

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 successful 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

The following are the learning outcomes anticipated for this course, the manner of assessment, and the provided learning experiences.

Outcome 1 You will gain substantive knowledge of U.S. patent law based on statutes, case law, and administrative rules.

- **Assessments**: I will assess progress through in-class assignments and discussion, a graded final examination, and class participation, as explained in further detail in this syllabus.
- **Learning experience**: You will have reading assignments of relevant statutes, case law, and other materials. During each class, we will engage in extensive discussion about the cases and how they relate to core concepts.

Outcome 2 You will practice working with technological concepts, as found in case law, patent documents, and other related materials.

- **Assessments**: I will assess progress through in-class assignments and discussion, a graded final examination, and class participation, as explained in further detail in this syllabus.
- **Learning experience**: You will read technological information in the reading assignments described above. In applying the law to facts during class discussions, we will discuss the nature of these technologies and practice conveying them in ways appropriate to a legal audience.

Outcome 3 You will learn the underlying theories that motivate patent law, and the interaction of patent law and larger societal considerations.

- **Assessments**: I will assess progress on this primarily through class participation. Application of theoretical or policy considerations on the examination will also be acknowledged.
- **Learning experience**: Certain readings and materials during class will discuss the theory of patent law. During class, a portion of the discussions will focus on the ethical, economic, and policy considerations behind legal rules. Several class sessions will focus on specific recent policy debates or considerations involving patent law as well.

Who Am I?

I am a former patent attorney, where my practice focused on computer and communication technologies. Between 2013 and 2022, I worked at nonprofit organizations on patent and technology policy. In this capacity, I write *amicus curiae* briefs in key patent and copyright cases, comment on legislation, have testified in Congress, and have served on advisory boards providing thoughts on how patent and technology policy changes may affect the public interest.

I am happy to meet in person or virtually; just send me an email to set up a time, or come by during the office hours posted above.

Course Logistics

Reporting Attendance

Please record your attendance and absences on the following website:

https://www.cduan.com/attend/?course=LAW-688-001 *link*

This website will also contain the Zoom link for attending virtually, and will provide access to recordings of class if you are absent.

There is no need to email me in advance for absences; just report them, ideally in advance, on this website. You are also permitted to update your attendance record after the fact. For example, if you forgot to sign in during class, you can do so at home using this same website later.

The policy for absences is later in this document.

Books and Materials

Generally, if you need to find materials for this course, check the following places:

- My personal website, https://www.cduan.com/teaching.shtml *link*. This will contain the official version of the syllabus, plus other materials for this course and for prior years.
- Canvas, particularly the Files section for this course.

The main textbook for this course is Jonathan S. Masur & Lisa Larrimore Ouellette, *Patent Law: Cases, Problems, and Materials* (5th ed. 2026). The book is available for free electronic download *link*; that website also contains links for purchasing the book.

I have frequently supplemented the textbook with cases and other readings. These will be available in the Files section of Canvas, in a PDF coursepack.

Occasionally I have also assigned statutes to read. You can access statutes online at the Legal Information Institute *link*.

If you would like a study aid or reference materials, you have many options in the library or online. Here are some free ones:

- Congressional Research Service Report R46525, *Patent Law: A Handbook for Congress* (2020) *link*. An excellent and free short overview.
- *Manual of Patent Examining Procedure*, chapter 2100, *link*. Covers the requirements for patentability.
- Peter S. Menell et al., *Patent Case Management Judicial Guide* (3d ed. 2016), *link*. Covers patent litigation in extensive detail.

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 my website and announced on Canvas.

Introduction

August 24—Theory of Patents

Read: Supplementary Materials, pages 1–19, Ch. 1.

— Masur & Ouellette, pages 33–41, Ch. I.1.E–I.1.F.

August 26—How to Read a Patent

Read: M&O, pages 10–32, Ch. I.1–I.1.D.

— Supp., pages 19–25, Ch. 2.

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

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

Requirements of Patentability

August 31—Introduction to Novelty

Read: M&O, pages 46–48, Ch. II.2.

— M&O, pages 117–133, Ch. II.2.C.

September 2—Novelty: Types of Prior Art

Read: M&O, pages 60–64, Ch. II.2.B1.1.

— M&O, pages 70–74, Ch. II.2.B2 through Netscape Communications v. Konrad, 295 F.3d 1315 (Fed. Cir. 2002).

— M&O, pages 82–96, Ch. II.2.B2.3 through W.L. Gore & Associates v. Garlock, 721 F.2d 1540 (Fed. Cir. 1983).

September 7—**NO CLASS**: Labor Day

September 9—Novelty: Timing

Read: M&O, pages 49–60, Ch. II.2.A. You can skip the parts about pre-AIA §102.

— M&O, pages 64–65, Ch. II.2.B1.2.

— M&O, pages 102–104, Ch. II.2.B2.5.

— Supp., pages 25–45, Ch. 3.

Optional: M&O, pages 105–116, Ch. II.2.B3. Read if you want to see how complicated the law used to be.

Read: Try to create two flowcharts for applying §102, one for when the prior art reference is a patent and one for when the prior art reference is not a patent. Use the examples on the USPTO slides to test your understanding and the correctness of your flowcharts.

September 14—Obviousness: The Law

Read: Supp., pages 45–52, Ch. 4.1. You must read this case.

— M&O, pages 134–152, Ch. II.3–II.3.A. If you do the optional reading below, you do not need to read this.

Optional: Supp., pages 45–81, Ch. 4. The remainder of the chapter is an alternate presentation of the obviousness doctrine that I wrote for this year. Since it is experimental, it is an optional alternative.

September 16—Obviousness: Secondary Considerations

Read: M&O, pages 153–168, Ch. II.3.B.

— Supp., pages 81–89, Ch. 5.

Read: We will do the problems in the Notes and Questions section of the supplement in class.

September 21—Patentable Subject Matter: Software

Read: M&O, pages 246–248, Ch. II.6.

— M&O, pages 281–303, Ch. II.6.B through "are ineligible under § 101.". Skip USPTO Guidance.

— M&O, pages 306–309, Practice Problems: Abstract Ideas.

September 23—**NO CLASS**: Outside Patent Event

September 28—Patentable Subject Matter: Biotechnology

Read: M&O, pages 248–268, Ch. II.6.A.

— M&O, pages 278–281, "Practice Problems: Laws of Nature" through "F.3d 1285 (Fed. Cir. 2020).".

September 30—Enablement

Optional: Supp., pages 89–97, Ch. 6. This may be helpful if you're not familiar with the chemistry concepts in the cases.

Read: M&O, pages 169–171, Ch. II.4.

— M&O, pages 181–199, Ch. II.4.B.

October 5—Written Description

Read: M&O, pages 200–224, Ch. II.4.C.

October 7—Utility, Inventorship, Double Patenting

Read: M&O, pages 171–181, Ch. II.4.A.

— M&O, pages 310–328, Ch. II.7.

Infringement and Remedies

October 12—Claim Construction and Literal Infringement

Read: M&O, pages 329–347, Ch. III–III.8. Ignore paragraphs 5 and 6 of *Phillips*; we will discuss means-plus-function claims later.

— M&O, pages 348–353, Ch. III.9–III.9.A.

— Supp., pages 97–105, Ch. 7.

October 14—Infringement by Doctrine of Equivalents

Read: Supp., pages 105–113, Ch. 8.

— M&O, pages 353–371, Ch. III.9.B.

October 19—Definiteness and Functional Claiming

Read: M&O, pages 225–233, Nautilus v. Biosig Instruments, 572 U.S. 898 (2014).

— M&O, pages 237–238, Ch. II.5.B.

— Supp., pages 113–127, Ch. 9.

October 21—Indirect and Divided Infringement

Read: M&O, pages 372–389, Ch. III.10 through "rise to liability in Global-Tech.". Skip the note on *Commil v. Cisco*.

— M&O, pages 393–394, Ch. III.11.A. Skip the Supreme Court *Akamai v. Limelight* case.

— M&O, pages 397–402, Akamai Techs. v. Limelight Networks, 797 F.3d 1020 (Fed. Cir. 2015) (en banc) through Practice Problems: Divided Infringement.

October 26—Limitations and Defenses

Read: M&O, pages 402–407, Ch. III.11.B.

— M&O, pages 420–444, Ch. III.12. Read the Exhaustion and Inequitable Conduct sections, but skim the rest; you mostly just need to know that they exist.

October 28—Injunctions and Reasonable Royalties

Read: M&O, page 445, Ch. IV.

— M&O, pages 446–458, Ch. IV.13. Skim the discussion questions.

— M&O, pages 485–502, Ch. IV.15. Skim the discussion questions.

November 2—Lost Profits

Read: M&O, pages 459–484, Ch. IV.14.

November 4—Additional Damages; Patent Procedure
Read: M&O, pages 503–515, Ch. IV.16.A.
— M&O, pages 518–532, Ch. V.17.

Special Topics

November 9—Information and Communication Technologies
Read: M&O, pages 585–588, Ch. V.20.E.3.
— Supp., pages 127–145, Ch. 10.
Optional: M&O, pages 533–541, Ch. V.18.

November 11—Design Patents
Read: M&O, pages 549–555, Ch. V.19.B.
— Supp., pages 145–167, Ch. 11.

November 16—Pharmaceuticals and Health Care
Read: Supp., pages 167–185, Ch. 12. Focus primarily on the generic drug sections, less on biosimilars.

November 18—Patents and Equity
Read: We will have as a guest speaker Professor Shweta Kumar of the University of Kentucky, J. David Rosenberg College of Law.

November 23—Artificial Intelligence
Read: Supp., pages 185–205, Ch. 13.
Read: Make a list of all the patent doctrines we've learned about in this class. For as many doctrines as you can, think of a hypothetical situation in which AI challenges what you've learned about that doctrine.

Course Policies

In addition to the policies below, please note the Honor Code for the Washington College of Law, the Grading and Examination policies of the Registrar, and other policies stated in the WCL Catalog *link* and the American University Student Conduct Code *link*.

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 pre-

pared to participate in the class discussion when called upon. To be prepared for class means that you have read the assignment and have made an effort to think through the materials and any problems or questions in the notes (though no outside research is necessary or encouraged).

Attendance The manner of recording your attendance is given above in this document. On any day when class is held, your attendance status is one of the following:

- Present: you are physically in class that day and indicated this on the attendance form (including if you forgot to fill in the form and entered your presence later).
- Excused absence: you attended by Zoom, or you entered an explanation in the attendance form that justifies your absence. There is no limit on excused absences.
- Unexcused absence: you neither entered your presence on the attendance form nor entered a sufficient explanation on that form. You are permitted **up to four unexcused absences** without penalty. Further unexcused absences will have a negative impact on your grade, at my discretion. If you face particular challenges that make attendance difficult, contact the Office of Student Affairs.

Recordings Classes will be recorded to the extent possible, 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.

Participation I will call on students based on a random list. The purpose of randomized cold-calling is to make sure that everyone has the opportunity to practice speaking and reasoning about the materials. Participation in class is not just important for meeting the learning outcomes of this course and understanding the materials; it is essential practice for the lawyering skills of thinking on the fly, organizing thoughts, and communicating effectively. My goal is always to engage your minds and ensure that the classroom is a welcoming space for thoughtful discussion. To the extent that there are things I can do to improve along these lines, I'd certainly welcome your feedback.

Grading and Evaluation

Your grade will primarily be based on the results of a final examination. It will be a scheduled 3-hour final examination at the end of the semester. The examination will consist of a combination of essay questions and written short-answer questions.

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.

As a matter of fairness to everyone, I require that any meetings be held or emailed questions be submitted to me at least 48 hours before the exam. (That time is subject to change depending on the date the exam is scheduled.)

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.

If you would like sample exams, you can take a look at my website *link*. Professor Michael Risch at Villanova also posts his Patent Law exams online *link*.

Artificial Intelligence and Other Assistance

The following quotation is the official policy of this course with respect to generative AI; the rest is just for you to think about.

> The use of generative AI programs is permitted for completing any written take-home assignments in this course. While AI is a powerful tool, it should not be used as a substitute for independent studying and work; further, there are inherent risks and potential ethical violations when using AI. As such, students must affirm that they have verified the authenticity and attest to the accuracy of the AI output upon submission of their work. Failure to do so could result in a lower grade on the respective assignment and potentially constitute an Honor Code violation.
>
> Please attach the following certification to any work to which more than one non-quoted sentence was initially generated by AI or any other source: "I certify that any language drafted by generative artificial intelligence, including quotations, citations, paraphrased

> assertions, and legal analysis, has been checked by me for accuracy, using, for example, print reporters or traditional legal databases. I understand I will be held responsible for the contents thereof according to applicable rules of the course syllabus and WCL Honor Code, regardless of whether generative artificial intelligence drafted any portion of this submission."

I'm generally permissive about what tools you use to produce writing. I study technology, after all, and have used computer programs to assist my writing for years. You'll have these tools available in your work, and lawyers have been using automation to speed up their workflow ever since the invention of the printing press.

That said, I would be cautious about over-relying on AI at this early stage in your legal career, for three reasons.

Writing is practice. You can't get good at the piano by listening to recordings; you have to move your fingers to learn. In the same way, if you want to be a great communicator of legal arguments—that is, a lawyer—you can't just sit back and listen to what ChatGPT says; you need to do the skill of communicating, over and over again, faster and faster. Law school writing is the slow practice of argument: Today you spend an hour every day writing IRAC paragraphs in the comfort of your home, so that tomorrow you can spin out IRAC paragraphs with your voice in seconds before an adversarial court. AI can help you write something right now, but it can't build your memory bank of turns of phrase and sentence structures that will serve you for the rest of your career.

Skepticism is your job. It is the very role of lawyers to challenge purported claims of the law, and to do so by digging deep into sources of authority. If opposing counsel puts forward a legal rule under which your client loses, you wouldn't just blindly trust it—you'd scrutinize all of the cases and laws cited, and research the counterarguments. So should you blindly trust AI in the same way? Instead, use generated statements the same way you would use any other slick-sounding but probably biased source of opinion (which, by the way, includes *lots* of third-party legal sources): a helpful starting point, but something to be verified.

Where we're going, we don't need AI. Practice these skills of constructing arguments and skeptical research enough, and faster than you expect you'll discover what top lawyers know already—legal writing and reasoning are not that

hard once you've done them enough, and AI isn't much of a speed help. That might be hard for you to believe today. But remember when you were learning to add and complained that you could just use a calculator? How fast can you solve 5 + 7 now?

Right now, writing feels like a slog, and it's hard to see why you need to do it when this shiny new tool can. But put in the work, and soon enough you'll produce arguments as easily as ChatGPT—and yours will be better.