

**Patent Law**  
**Professor Merges**  
**Fall 2012**  
**Syllabus**

Our casebook is Merges & Duffy, Patent Law and Policy (5th ed. 2011 – referred to as “M&D” in the following syllabus). A supplement to the casebook (referred to as “Book Supp.”) will also be used; I will email this to you near the beginning of the semester. It will also be posted on the course web page ([http://www.law.berkeley.edu/institutes/bclt/students\\_courses.html](http://www.law.berkeley.edu/institutes/bclt/students_courses.html)). I also require that you use a statutory supplement, such as Merges et al., IP in the New Technological Age, Case and Statutory Supplement (2012) (referred to as “Stat. Supp.”).

We meet Tuesday and Thursday, 11:20-12:35 in room 140. I will have regular office hours, Mondays 2:00-3:15, or you can arrange an appointment. My office is in room 438, North Addition; phone 643-6199; email [rmerges@law.berkeley.edu](mailto:rmerges@law.berkeley.edu). Email is by far the best way to contact me.

**Date & Assignment**

**8/23**

Historical Introduction M&D 1-13; Introduction to the patent document, pp. 13-26; Introduction to Claims & Patent System: M&D 26-66.

**8/28**

Patentable Subject Matter: Stat. Supp. 35 USC § 101; Chakrabarty, Laws of Nature, etc.: M&D 67-79; In re Bilski, M&D 79-107.

**8/30**

101 (cont'd) Natural Substances: Mayo v. Prometheus, Book Supp., p. 1; M&D 106-110; Association for Molecular Pathology (Myriad), Book Supp., p. 15.

**9/4**

Utility: Branan, M&D 234-243; Ex parte Fisher, M&D 244-256.

**9/6**

Enablement and Written Description: Intro and Incandescent Lamp, M&D 261-276; Janssen v. Teva, M&D, 287-296; Stat Supp. 35 USC § 112.

**9/11**

Intro. and Gentry Gallery, M&D 302-312; Ariad v. Eli Lilly, M&D 316-336.

**9/13: No class**

**9/18: No class**

**9/20**

Definiteness and Functional Claiming: Orthokinetics, M&D 337-341; Notes on Standard Oil, Ambiguous Language, Functional Language and Functional Claiming, 341-350.

**9/25**

Introduction to Novelty: Intro and Robertson, M&D 367-380; Stat. Supp. 35 USC § 102; In re Klopfenstein and Note, 415-422. Introduction to the AIA and “First to File”: Basic Concepts and Prior Art Categories, Book Supp., pp. 30-35.

**9/27**

Novelty II, 102(e) and (f): Note on Novelty and the Economics of Search, M&D 427-431; §102(e): Alexander Milburn, 432-438; §102(f): Campbell, M&D 441-448; Note on the AIA Derivation Procedure, Book Supp., p. 43.

**10/2**

Priority, §102(g)(1) & (2): Intro., Brown v. Barbacid, M&D 448-465; Peeler and Notes on Abandoned, etc., M&D 465-472; Dow, 477-487.

**10/4**

Statutory Bars I: Intro, 517-519; 527-529; Egbert, Moleculon, Metallizing Engineering, M&D 530-544; Pfaff, 544-558.

### **10/9**

Experimental Use, AIA Grace Period: City of Elizabeth, M&D 562-569; Lough, 569-577; Book Supp., pp. 35-43.

### **10/11**

Third Party Activity: Baxter, WL Gore, M&D 577-591; International Considerations, 593-596; Summary & Problems, 596-600.

### **10/13**

Nonobviousness: Intro, Hotchkiss, Historical Note, M&D 619-633; Graham, M&D 638-653 [stop reading Graham opinion before discussion of *Cook* case]; US v. Adams, 661-670.

### **10/16**

Suggestion Test: Intro (“Subtests”) and KSR v. Teleflex, M&D 670-692; Obviousness after KSR & In re Kubin, M&D 692-706.

### **10/18**

§102/103 Prior Art and Analogous Arts: Intro and Hazeltine, M&D 747-751; Note, Economic Rationale, M&D 760-761; Oddzon, M&D 761-767; Intro & Clay M&D 780-788; Note on Nonobviousness and the AIA, Book Supp., p. 44.

### **10/25**

Claims I: Intro and Merrill, M&D 797-804; Intro and Phillips, M&D 804-821; Note on Canons, 821-829.

### **10/30**

Claims II: Intro and Wright Co. v. Paulhan, M&D 829-834; Note on Purposive Claim Construction, 834-837; Intro and Markman, M&D 852-865.

### **11/1**

Claims III: Doctrine of Equivalents and Prosecution History Estoppel: Festo, M&D 871-888.

### **11/6**

Joint and Divided Infringement, BMC Resources v. Paymentech & Notes, M&D 847-852; additional recent Federal Circuit cases to be discussed in class.

### **11/8: No Class**

### **11/13**

Indirect Infringement and Prior User Rights: Intro and CR Bard, M&D 914-915; M&D 923-931; Note on Global-Tech Appliances, Inc. v. SEB, Inc., 131 S.Ct. 2060 (2011), Book Supp., p. 55; Note on the AIA's Prior Commercial Use defense, Book Supp., p. 44.

### **11/15**

Injunctions: Intro, eBay, Notes, Additional Notes, M&D, 941-955; Amazon.com, 956-966.

### **11/20**

Damages: Lucent, M&D 966-986; Grain Processing, and Note M&D 1002-1017.

### **11/27**

Willful Infringement, Reissue and Reexamination: In re Seagate Technology, M&D 1027-1037; Intro to Reissues and , M&D 1080-1081; Mentor Corp., M&D 1086-1088; Intro to Reexamination and Rodime and Notes, Note on Inter Partes Reexamination, M&D 1099-1107.

**11/22: No Class – Happy Thanksgiving!**

**11/29**

Defenses: Prosecution Delay Laches and Inequitable Conduct: Symbol Technologies, M&D 1109-1112; 1137-1146; Therasense, Book Supp., p. 56.

**Makeup – To be scheduled**

Coinvention and Ownership: Burroughs-Wellcome; Ethicon, M&D 1147-1155; 1169-1189; Stanford v. Roche, book supp.

**TBA**

Review Session