

Patent Law
Professor Merges
Fall 2010
Syllabus

Our casebook is Merges & Duffy, Patent Law and Policy (4th ed. 2007 – 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). I also require that you use a statutory supplement, such as Merges et al., IP in the New Technological Age, Case and Statutory Supplement (2010) (referred to as “Stat. Supp.”).

We meet Tuesday and Thursday, 11:20-12:35 in room 170. I will have regular office hours, Tuesdays 1:30-2:40, or you can arrange an appointment. My office is in room 438, North Addition; phone 643-6199; email rmerges@law.berkeley.edu. Email is by far the best way to contact me.

Date & Assignment

8/17

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

8/19

Patentable Subject Matter: Stat. Supp. 35 USC § 101; In re Bilski, Book Supp.

8/24

101 (cont'd): Chakrabarty, Laws of Nature, etc.: M&D 67-78; Natural Substances, M&D 106-110; Association for Molecular Genetics (Myriad), & Notes, Book Supp.

8/26

Utility: Brana, M&D 230-240; Ex parte Fisher, M&D 240-256.

8/31

Enablement and Written Description: Intro and Incandescent Lamp, M&D 261-272; Janssen v. Teva, Book Supp.; Stat Supp. 35 USC § 112.

9/2

Gentry Gallery, M&D 299-309; Additional Notes on Written Description; Ariad v. Eli Lilly, Book Supp.

9/7

Written Description II: Rochester v. Searle, 314-320; LizardTech v. Earth Resource Mapping, Inc., 321-327

9/9

Definiteness and Best Mode: Orthokinetics, M&D 327-332; Note on Standard Oil, 332-337; Note on Functional Language, 337-340; Chemcast, 348-356.

9/14

Introduction to Novelty: Intro and Robertson, M&D 357-370; Stat. Supp. 35 USC § 102; In re Hafner and Notes, 380-387; Intro, 393; In re Klopfenstein, 405-413.

9/16

Novelty II, 102(e) and (f): Note on Novelty and the Economics of Search, M&D 417-421; §102(e): Alexander Milburn, 421-431; §102(f): Campbell, M&D 431-438.

9/20 – 9/24

***** No Class – Fall Break *****

9/28

Priority, §102(g)(1) & (2): Intro., Brown v. Barbacid, M&D 438-456; Peeler, M&D 456-464; Dow, 468-478; Note on Rule 131, 481-483; Stat. Supp. § 102(g).

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Statutory Bars I: Intro and Pennock, Egbert, Moleculon, Metallizing Engineering, M&D 509-536.

10/5

On Sale Bar and Experimental Use: Pfaff, 536-550; City of Elizabeth, M&D 555-562; Lough, 562-570.

10/7

Third Party Activity: Baxter, WL Gore, M&D 570-584; International Considerations, 586-589; Summary & Problems, 589-593.

10/12

Nonobviousness: Intro, Hotchkiss, Historical Note, Graham, M&D 611-645 [stop reading Graham opinion before discussion of *Cook* case]; US v. Adams, 653-662.

10/14

Suggestion Test: Intro (“Subtests”) and KSR v. Teleflex, 665-685; Obviousness after KSR & In re Kubin, Book Supp.

10/19

§102/103 Prior Art and Analogous Arts: Intro and Hazeltine, 730-734; Note, Economic Rationale, 743-744; Oddzon, M&D 745-750; Intro & Clay M&D 764-773.

10/21

Claims I: Intro and Merrill, 781-787; Intro and Phillips, 787-804; Note on Canons, 804-812.

10/26

Claims II: Intro and Wright Co. v. Paulhan, M&D 820-826; Note on Purposive Claim Construction, 826-829; Intro and Markman, 829-839; Phillips (Part II), 845-849.

10/28

Claims III: Doctrine of Equivalents: Warner-Jenkinson, M&D 856-867; Prosecution History Estoppel: Festo, 867-88.

11/2

Joint and Divided Infringement, BMC Resources v. Paymentech & Notes, Book Supp.; other recent infringement/claim construction case (look for email update).

11/4

Indirect Infringement and Foreign Activity: Intro and Aro, CR Bard, M&D 908-923; Intro, Brown, and Microsoft v. AT&T, 923-931.

11/9

Injunctions: Intro, eBay, Notes, z4, Additional Notes, M&D, 933-956; Amazon.com, 956-967.

11/11

****No Class – Veteran’s Day****

11/16

Damages: Panduit, M&D 969-985; Grain Processing, and Note M&D 1000-1019; Note, Entire Market Value Rule, 1025-1029; Lucent v. Gateway & Notes, Book Supp.

11/18

Willful Infringement, Reissue and Reexamination: In re Seagate Technology, Book Supp.; Intro to Reissues, M&D 1073; Intro to Reexamination and Rodime and Notes, Note on Inter Partes Reexamination, M&D 1092.

11/23

Defenses: Prosecution Delay Laches and Inequitable Conduct: Symbol Technologies, M&D 1130-1140 ; Briefs in Therasense v. Becton-Dickinson (pending Federal Circuit en banc case – look for email updates).

11/25

**** No Class – Happy Thanksgiving ****

11/30

Coinvention and Ownership: Burroughs-Wellcome; Stark, Eli Lilly, Ethicon, M&D
1142-1180.

Makeup - TBA

Exhaustion and First Sale: Quanta v. LG Electronics, Book Supp.

Date TBA

Review Session