

Patent Law
Professor Merges
Fall 2011
Syllabus

Slides on the New (2011) Patent Act

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/11590.htm>). I also require that you use a statutory supplement, such as Merges et al., IP in the New Technological Age, Case and Statutory Supplement (2011) (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

8/25

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

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Patentable Subject Matter: Stat. Supp. 35 USC § 101; In re Bilski, M&D 79-107.

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101 (cont'd): Chakrabarty, Laws of Nature, etc.: M&D 67-79; Natural Substances, M&D 106-110; Association for Molecular Pathology (Myriad), Course website.

9/6

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

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

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

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Definiteness and Best Mode: Orthokinetics, M&D 337-341; Notes on Standard Oil, Ambiguous Language, Functional Language and Functional Claiming, 341-350; Chemcast and Note, 358-365.

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Introduction to Novelty: Intro and Robertson, M&D 367-380; Stat. Supp. 35 USC § 102; In re Klopfenstein and Note, 415-422. Introduction to “First to File”: Basic Concepts and Prior Art Categories (material to be distributed).

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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.

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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; Note on Rule 131, 491-492; Stat. Supp. § 102(g).

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Statutory Bars I and Presumption of Validity: Intro, 517-519; 527-529; Egbert, Moleculon, Metallizing Engineering, M&D 530-544; i4i Ltd., book supp.

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On Sale Bar and Experimental Use: Pfaff, 544-558; City of Elizabeth, M&D 562-569; Lough, 569-577.

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

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****No Class****

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.

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

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§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.

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

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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.

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

11/3

Joint and Divided Infringement, BMC Resources v. Paymentech & Notes, M&D 847-852; updates from recent cases (to be supplied).

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Indirect Infringement: Intro and CR Bard, M&D 914-915; M&D 923-931; GlobalTech Appliances, Inc. v. SEB, book supplement.

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

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

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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.

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Defenses: Prosecution Delay Laches and Inequitable Conduct: Symbol Technologies, M&D 1109-1112; 1137-1146; Therasense, book supp.

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

11/29

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

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Review Session