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**Fall 2017 Syllabus**  
University of North Carolina School of Law  
Law 286 (3 credit hours)  
TuWTh 3:10-4:05 (Room 3025)

## **PATENT LAW**

### **Description**

This course provides an introduction to essentially all aspects of patent law and practice, including the legal doctrines, public policies, and intellectual perspectives that inform the practices of patent prosecution, counseling, and litigation. You will initially develop an understanding of the form and substance of the patent instrument, with particular attention to the claims that define the substantive scope of the patent grant. You will then study the statutory requirements for obtaining a patent grant, including utility, novelty, nonobviousness, and adequacy of disclosure. You will also learn the procedures, both before and after the patent grant, that are relevant to the acquisition and maintenance of patent rights. Finally, you will examine the law governing patent infringement, including literal infringement and infringement under the doctrine of equivalents, as well as the applicable defenses and remedies.

### **Teaching Approach**

My classroom instruction employs a combination of lecture and Socratic questioning, with the aim of providing the conceptual scaffolding necessary for you to engage the material before inviting you to inform the discussion. My aim in questioning you is to provoke critical thinking, self-directed learning, and a search for the connections between the detailed facts of a case and the deeper principles it illustrates. Eventually, such questioning should become a habit of mind, so that you will independently be able to incorporate legal materials efficiently and critically into your knowledge base and work product.

### **Casebook, Supplement, and Additional Materials**

The casebook is MARTIN J. ADELMAN ET AL., CASES AND MATERIALS ON PATENT LAW (4th ed. 2015), published by West Group, supplemented by other handouts. You should also print out a copy of the Patent Act (including pre-AIA provisions) from the link on the course Web site.

### **Prerequisites**

None. Comfort with reading scientific and technical literature written for a popular audience is helpful.

### **Course Format; Reading; Mock Quizzes**

Lectures and discussion will consume the bulk of our class time. Assigned readings for this class may total as much as 60 pages per week. Plan accordingly and read ahead whenever possible, especially before the Tuesday classes. It is far easier to tackle 60 pages over seven days than over a 48-hour period. You are responsible for reading ahead and being prepared to discuss approximately one unit per class meeting. I will call on

students present at random. If you are unprepared and wish to be spared being called on in class, you may email or speak to me before class and I will do my best to remember not to call on you.

There will be occasional, unannounced, very short mock quizzes, which will be graded by one of your fellow students, but no grades will be reported to me, and there will be no consequences for absences or failures.

### **Class Participation/Response Paper Option**

The class session numbers indicated in the Order of Topics table are approximate; you are assured of “safety” by reading and being prepared to discuss the materials one unit ahead.

If you are unprepared and wish to be spared being cold-called, you may email or speak to me before class and I will do my best to remember not to call on you.

There will be occasional, unannounced, very short mock quizzes, which will be graded by one of your fellow students, but no grades will be reported to me, and there will be no consequences for absences or failures.

Do not use your computer, smart phone, e-reader or similar device in a way likely to distract others. This includes browsing to Web sites unrelated to antitrust law, chat rooms, e-mail, or other uses not related to note-taking for class or viewing of course materials.

### **Grading**

There will be a three-hour open book, open note final examination, which will be graded in accordance with the Law School’s curve for small classes. Past examinations are available via the Law Library Web site and My Carolina Law. Your participation grade will be A+, which will count for between 0% and 20% of your final grade, based on the overall quality of your participation via in-class discussion and/or response papers. (High-quality participation reflects time, effort and study on *your* part, as contrasted with reliance on the efforts of others.) The examination likely will consist of three or four questions, at least one of which will involve some discussion of theoretical and policy issues, and the remainder of an issue-spotting variety similar to the assigned problems.

### **Attendance**

Students should arrive on time. I will take attendance at the beginning of class. If you arrive late, it is your responsibility to ensure that you are marked present by speaking to me before I leave the classroom; an email will **not** suffice, and you should not assume that I have made a note of your late arrival.

Your attendance is subject to the Law School’s attendance policy requiring attendance at 80% of class sessions. The names of students who have accumulated seven or more absences during the semester will be brought to the attention of the Associate Dean for Academic Affairs. You are responsible for managing your absences and ensuring that your total number of absences does not reach this threshold. You may email me in advance regarding excusable absences, but any excused absences will still count toward

the threshold and will be subject to review. Absences, excused or unexcused, below the threshold level will not affect the weighting of your participation grade in any way.

### **Rescheduled Classes**

I will also not be available to teach on **Thursday, November 2** or **Tuesday, November 7**. We will need to meet for makeup classes at our regular time (10:55-11:50) on **two** of the following dates (all Fridays): September 15, September 22, September 29, and October 6. A Doodle poll will be circulated soon to ascertain overall class preferences; excused absences will be granted per the regular attendance policy.

### **Honor Code**

The Honor Code is in effect in this class and all others at the University. I am committed to treating Honor Code violations seriously and encourage all students to become familiar with its terms set out at <http://instrument.unc.edu>. If you have questions, it is your responsibility to ask me about the Code's application. All exams, written work and other projects must be submitted with a statement that you have complied with the requirements of the Honor Code in all aspects of the submitted work.

### **Office Hours**

Room 5079, (919) 962-4116. Tuesdays and Thursdays, 1:30-2:30; other times if my door is open; and by appointment. At other times, email is preferred. Please do not rely on voicemail for time-sensitive matters.

### **Show and Tell Assignment (Class 3)**

Find a household object, preferably one that you can bring to class, that is marked with a U.S. Patent number. (*Optional:* For more on the significance of marking, read pages 927–35 of your casebook.) Then visit the U.S. Patent Office Web site ([www.uspto.gov](http://www.uspto.gov)) and print out the full text of the patent document. (You can also use [google.com/patents](http://google.com/patents), but do familiarize yourself with the USPTO site.) Be prepared to discuss the object and the document with your practice group.

### **Order of Topics**

The principal cases are listed for your convenience; however, you are also responsible for all material on the pages listed, whether or not it is covered in class. **Minor revisions to this syllabus are likely; they will be announced in class and posted on the class Web site.**

### ***Invitation to the Course***

- |   |  |                    |             |                     |
|---|--|--------------------|-------------|---------------------|
| 1 | Legal Foundations of the Patent System | 1.1–1.3[b], 1.4[a] | 1–17, 20–30 | Bonito Boats, Bergy |
|---|--|--------------------|-------------|---------------------|

### ***Is the Patent Bargain a Good Deal for the American Public?***

- |   |  |             |       |  |
|---|--|-------------|-------|--|
| 2 | Rationales for the Patent System; Patent Valuation | 1.4[a], 1.5 | 33–47 |  |
| 3 | Show and Tell Exercise                             |             |       |  |

***The Inventor's Part of the Bargain: A Legally Complete Patent Application [§ 112]***

4-5	Claims	9.1-9.2	475-496	Fressola, Catalina
6	Claim Drafting Exercise			
7-8	Enablement	8.1	395-426	Gould v. Hellwarth, Atlas Powder, Wright, Pharmaceutical Resources
9-10	Written Description	8.2	426-60	Vas-Cath, Ariad
11	Best Mode	8.3	461-75	Chemcast

***Timing of the Patent Application: Anticipation and Novelty [§ 102]***

12-13	Anticipation	4	169-92	Titanium Metals, Schering
14-15	Public Use	5.2[a]	193-209	Egbert, Metallizing
16	“On Sale”; “Otherwise Available to the Public”	5.2[b-c]	209-30	Pfaff, Lister
17	Disclosure in Applications; The Grace Period	5.2[d], 5.3	230-45	Milburn, City of Elizabeth
18	Prior Invention	6.1-6.2	245-55	Woodcock, Gillman
19-21	The Elements of Invention; Other First-to-Invent Provisions	6.3-6.4	255-92	Oka, Scott, Gould, Apotex

***Nonobviousness [§ 103]***

22-24	Nonobviousness	7.1, 7.3	293-96, 305-59	Graham, KSR, Translogic, Transocean
25	Nonobviousness Exercise			
26-27	Analogous Arts	7.5	380-95, Handout	Innovention, Deuel

***Patentable Subject Matter and Utility [§ 101]***

28-29	Patentable Subject Matter: Biotechnology	2.1	67-104	Chakrabarty, Mayo, Myriad
30-31	Patentable Subject Matter: Information Technology	2.2	104-32, handout	Bilski, Alice, Nuijten
32	Utility: General Principles	3.1	133-43	Lowell, Juicy Whip

***Infringement [§ 271]***

33-35	Claim Construction; Literal Infringement	11.1- 11.2	643-93, 739- 40, 763-70	Autogiro, Markman, Cybor, Phillips, Limelight
36-39	The Doctrine of Equivalents (time permitting)	11.3- 11.4	693-728	Graver Tank, Warner-Jenkinson, Corning, Festo