

HOFSTRA-FALL 2015-PATENT LAW 2921
PROF. JOSEPH J. RICHETTI

Class Time And Location

Tuesdays, 8:10 am to 10 am
ROOM: KUSHN 0242

Contact

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Class Textbook And Supplement

Textbook: Patent Law And Policy: Cases And Materials, Sixth Edition
Supplement:
http://www.lexisnexis.com/store/images/Supplements/3090_2014S_Student.pdf

Assignments

Unless otherwise provided, all reading assignments below by default refer to the chapters from textbook; reading assignments from the supplement are indicated as "Supp., pp. __ - __." All reading assignments below include the sections and/or cases and their subsequent notes. Cases or handouts that are designated as optional may be referenced during class, but are not required reading.

#1 8/25/15

1. GENERAL DISCUSSION OF INTELLECTUAL PROPERTY: WHAT IS A PATENT
 - A. **General Overview - Read pp. 13-16, 24-26, 49-55, 59-64**
 - B. **Sample Patent - Read pp. 17-23**

#2 9/1/15

1. STATUTORY SUBJECT MATTER
 - A. **Chakrabarty – pp. 69-81**
 - B. **Diehr – pp. 133-147**
 - C. **Alice – Supp., pp. 1-13**
 - D. **Myriad – Supp., pp. 13-23**

E. *Optional Reading:*

- a. **USPTO July 2015 Update on Subject Matter Eligibility:**
<http://www.gpo.gov/fdsys/pkg/FR-2015-07-30/pdf/2015-18628.pdf>

2. INVENTORSHIP

- A. Intro – pp. 1081-1082**
 - a. **Burroughs Wellcome – pp. 1082-1088**
- B. Judicial Correction of Inventorship – pg. 1089**
- C. Joint inventors**
 - a. **Ethicon – pp. 1095-1111**

3. UTILITY

- A. Intro – pp. 209-214**
- B. Beneficial Utility**
 - a. **Juicy Whip – pp. 216-220**
- C. Practical and Specific Utility**
 - a. **Brana – pp. 232-241**

#3 9/8/15

1. DISCLOSURE – ENABLEMENT

- A. Intro – pp. 262-264**
- B. Enablement/Patent Breadth and Undue Experimentation**
 - a. **Incandescent Lamp – pp. 264-267**
- C. Enablement/Temporal Considerations – pp. 284 - 287**

2. DISCLOSURE – WRITTEN DESCRIPTION

- A. Intro – pp. 289-292**
- B. Gentry – pp. 292-298**
- C. Limits on Breadth – pp. 298-302**
- D. Ariad – pp. 302-316**

3. DISCLOSURE - DEFINITENESS

- A. Intro – pp. 316**
- B. Nautilus – Supp., pp. 23-32**
- C. Notes on pp. 319-327**

9/15/15 – HOLIDAY (ROSH HASHANAH) – NO CLASS

#4 9/22/15 – NOTE MORNING CLASSES STILL MEET

1. NOVELTY

- A. Intro – pp. 337-345
- B. Identity Requirement
 - a. Robertson – pp. 345-354
- C. Accidental/Unknown Anticipation
 - a. Seaborg – pp. 354-358
 - b. Schering – pp. 358-365
- D. 102(a)
 - a. Intro – pp. 337-378
 - b. “Known by Others”
 - i. National Tractor – pp. 378-382
 - c. “Used by Others”
 - i. Rosaire – pp. 383-387
 - d. Patents and Printed Publications
 - i. Klopfenstein – pp. 387-396

#5 9/29/15

1. NOVELTY

- A. 102(e)
 - a. Intro – pp. 405, 407-413
- B. 102(f)
 - a. Campbell – pp. 415-422
- C. Derivation Proceedings Under the AIA – pp. 422-424
- D. Section 102(g): The Basic Rules of Priority
 - a. Intro – pp. 424-427
 - b. Brown – pp. 427-441
- E. Conception – pp. 441-442
- F. Abandonment – pp. 442-450
- G. *Optional Reading:*
 - a. 102(e) Problems – pp. 413-414
 - b. Prior Art Uses of § 102(g)
 - i. Dow – pp. 454 -464
 - c. Establishing A Date Of Invention: Rule 131
 - i. Moore – pp. 467-473

#6 10/6/15

1. NOVELTY – STATUTORY BARS

- A. Intro – pp. 493 -497

- B. Pennock – pp. 497-505
- C. 102(b)
 - a. Intro – pp. 505-508
 - b. Public Use
 - i. Eggbert – pp. 508-513
 - ii. Moleculon – pp. 513-519
 - c. On Sale
 - i. Pfaff – pp. 522-529
 - d. Disclosures in AIA – pp. 540-543
 - e. Experimental Use
 - i. City of Elizabeth – pp. 543-550
 - ii. Lough – pp. 550-558
 - f. Third Party Statutory Bars
 - i. Baxter – pp. 558-567
 - ii. W.L. Gore – pp. 567-572

#7 10/13/15

- 1. NONOBVIOUSNESS
 - A. Intro – pp. 605-611
 - B. Graham – pp. 624-645, 650-652
 - C. Subtests of Non-obviousness – pp. 653-655
 - D. KSR – pp. 655-670
 - E. Scope and Content of Prior Art
 - a. Winslow – pp. 708-715
 - F. Nonanalogous Art
 - a. Clay – pp. 739-747

#8 10/20/15

- 1. CLAIM INTERPRETATION/INFRINGEMENT UNDER 271(A)
 - A. Intro – pp. 749-750
 - B. Claim Interpretation
 - a. Phillips – pp. 756-771
 - b. Canons of Claim Interpretation – pp. 771-779
 - c. Equivalents and Means-Plus-Function Claims
 - i. Wright – pp. 779-784
 - d. Procedural Aspect of Claim Construction
 - i. Markman – pp. 795 -806
 - C. Joint/Divided Infringement
 - a. Akamai – Supp., pp. 33-39

D. *Optional Reading:*

b. Teva v. Sandoz:

http://www.supremecourt.gov/opinions/14pdf/13-854_o7jp.pdf

c. En Banc Akamai Decision (8/13/15)

<http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/9-1372.Opinion.8-11-2015.1.PDF>

#9 10/27/15

1. INFRINGEMENT - DOCTRINE OF EQUIVALENTS

A. Winans – pp. 807 - 813

B. Festo – pp. 813 – 830

#10 11/3/15

1. INDIRECT INFRINGEMENT UNDER 271(B) AND (C)

A. Intro – pp. 858-859

B. Aro – pp. 859-866

C. Bard – pp. 867-872

D. Global Tech – pp. 873-880

E. Foreign Activity

a. Brown – pp. 880-883

b. Microsoft – pp. 883-888

F. *Optional Reading:*

a. Commil v. Cisco:

http://www.supremecourt.gov/opinions/14pdf/13-896_l53m.pdf

b. DSU Medical:

<http://www.cafc.uscourts.gov/images/stories/opinions-orders/04-1620.pdf>

c. ACCO v. ABA Locks and Belkin:

[http://www.finnegan.com/files/Publication/47505264-743a-4610-a135-](http://www.finnegan.com/files/Publication/47505264-743a-4610-a135-2fa6e0f2fc48/Presentation/PublicationAttachment/702f5bc9-f631-4c7f-9936-37755ef43042/06-1570%2009-12-2007.pdf)

[2fa6e0f2fc48/Presentation/PublicationAttachment/702f5bc9-f631-4c7f-9936-37755ef43042/06-1570%2009-12-2007.pdf](http://www.finnegan.com/files/Publication/47505264-743a-4610-a135-2fa6e0f2fc48/Presentation/PublicationAttachment/702f5bc9-f631-4c7f-9936-37755ef43042/06-1570%2009-12-2007.pdf)

2. WILLFUL INFRINGEMENT

A. Seagate – pp. 973-982

#11 11/10/15

1. INEQUITABLE CONDUCT

- A. **Intro – pp. 1056-1059**
 - B. **Therasense – pp. 1059-1068**
2. LACHES/EQUITABLE ESTOPPEL
- A. **Symbol – pp. 1070-1079**
 - B. **Control Beyond Patent Scope/Tying Agreements**
 - a. **Illinois Tool – 1176-1193**
3. EXHAUSTION/FIRST SALE DOCTRINE
- A. **Quanta – pp. 1198-1208**
 - B. **Optional Reading:**
 - a. **Monsanto – Supp., pp. 60-66**
 - b. **Kimble v. Marvell:**
http://www.supremecourt.gov/opinions/14pdf/13-720_jiel.pdf

#12 11/17/15

1. REMEDIES - MONEY DAMAGES/INJUNCTION
- A. **Injunctions – pg. 889**
 - B. **Preliminary Injunctions**
 - a. **eBay – pp. 890-904**
 - C. **Reasonable Royalties**
 - a. **Lucent – pp. 915 -933**
 - D. **Lost Profits**
 - a. **Rite Hite – pp. 933-948**
 - E. **Non-infringing Substitutes**
 - a. **Grain – pp. 948-963**
 - F. **Optional Reading:**
 - a. **Octane – Supp., pp. 40-46**
2. PATENT MARKING
- A. **Intro – pp. 982-984**

#13 11/24/15

1. REEXAMINATION/REISSUE
- A. **Intro – pp. 1040-1042**
 - B. **Rodime – pp. 1042-1046**

2. POST GRANT REVIEW AND INTER PARTES REVIEW

A. Intro – pp. 1046-1053

#14 12/1/15

LAST CLASS - REVIEW FOR FINAL AND HOT TOPICS

Attendance & Lateness

You are expected to arrive on time and prepared for each class.

Moreover, the rules of the New York State Court of Appeals and the American Bar Association require law students to be in good and regular attendance in the courses for which they are registered. To comply with these rules, you must attend at least 85% of the regularly-scheduled classes in this course. Thus, you may miss no more than two classes in this two-credit class.

I will provide dated sign-in sheets for each regularly-scheduled class. Your signature (or lack thereof) on these sheets shall presumptively determine your attendance at (or absence from) any given class. Each student is individually responsible for signing the attendance sheet in. Falsification of sign-in sheets (by, for example, signing another student's name) is a violation of the Code of Academic Conduct.

If you exceed the permitted absences by not attending class, or by failing to sign in, you will be administratively withdrawn from the course. Any such withdrawal may have serious ramifications for your financial aid, academic standing, and date of graduation. If you are excessively absent from several classes, you may face additional sanctions, including but not limited to denial of certification of good and regular attendance to the New York State Board of Law Examiners, or other state bar examiners.

The Office of Student Affairs has authority to excuse class absences for religious reasons and in cases of truly compelling hardship. If you wish to claim a particular absence as excused, and thus not counted against your maximum number of allowable absences, you must take that issue up with the Office of Student Affairs.

Grading

Your final grade shall be based upon a final examination. The final examination will be closed-note and closed-book, however, you will be provided with portions of selected patent statutes. The exam will consist of several essay questions totaling 100 points. It will be graded anonymously.

You will earn a letter grade for the course (from "A" to "F") that corresponds to your score on the final exam given the parameters set by the Law School's mandatory grading curve. I reserve the right to increase your letter grade by one increment (e.g., from a "B" to a "B+") on account of your in-class performance throughout the semester.

Email and Office Hours

If you have any questions or concerns, please contact me using my phone and email provided above. If you would like to meet to discuss anything in person, please let me know and we can arrange to meet before, or after class.