

## Patent Law – Spring 2025

Tuesdays & Thursdays, 1:15 – 2:40PM	<b>Room:</b> Holland Hall 283/284	Professor <a href="#">Derek Bambauer</a>
<b>Course:</b> LAW 6573 <b>Class:</b> 26425	<b>Credits:</b> 3	<b>Office Hours:</b> Wednesdays 11:00AM – 1:00PM and by appointment

**Last updated:** 2 January 2025

### **Table of Contents**

- [Contact Information](#)
- [Logistics](#)
- [Policies](#)
- [Grading](#)
- [Course Objectives](#)
- [Syllabus](#)

### **Course Description**

Welcome to Patent Law! In this course, we will study the legal protections for inventions available under the U.S. Patent Act. We will follow a life cycle approach to studying patents, beginning with patentability requirements, then the rights conferred once a patent is granted, followed by conduct that infringes those rights and defenses to infringement, and closing with remedies. The class does not assume any prior exposure to intellectual property or to the technologies that draw upon it.

### **Contact Information**

Professor Bambauer can be reached by e-mail ([bambauer@law.ufl.edu](mailto:bambauer@law.ufl.edu)), by telephone (352.273.0957), or in Holland Hall 326. The best way to reach me is via e-mail; I infrequently check voice mail. If you haven't received a reply to your e-mail within 48 hours, please politely remind me.

Professor Bambauer's office hours are Wednesdays, 11:45AM – 1:00PM; you are welcome (and encouraged!) to stop by.

I am also available by appointment, and am happy to get together over coffee / tea / lunch, in real space or via Zoom, to discuss patent law, jobs in IP, the obvious superiority of the Boston Red Sox (except this year), or anything else of interest. You can also follow me on Twitter/X (mostly retweets) [@dbambauer](#).

**Logistics**

- **Materials** - The required textbook for this class is Sarah Burstein, Sara R. Wasserman Rajec, & Andres Sawicki, [Patent Law: An Open-Access Casebook](#) (v1.1 2022). Any additional materials for this course are linked from this syllabus or posted to the course Canvas site.
- **Course Meeting Times** – The class will meet live on Tuesdays and Thursdays at 1:15PM, in Holland Hall 283/284. These sessions will be recorded automatically. In addition, if you would like me to record a class via Zoom and make it available on Canvas, please send me an e-mail, preferably at least 24 hours in advance of the class. **In addition**, there will be unscheduled assignments, group activities, and asynchronous video lectures. You are responsible for completing these course components by the deadlines indicated.
- **Communication** - I will communicate with the class via e-mail and via the course Canvas site. Please monitor your e-mail account, sign up for the course Canvas site, and check the Canvas site regularly.
- **Assignments** - Please see the syllabus below for reading assignments. You are expected to have read and prepared the materials assigned for each class meeting. Please note carefully the page numbers and instructions; often, you will only need to read part of a case or section.

The syllabus will undoubtedly change; please check Canvas regularly for updates and note the “Last Updated” date at the top of the syllabus. You are responsible for reading the materials closely, and for posing questions about anything you do not understand.

In my experience, the class often runs slightly behind schedule during the first few weeks, since patent law is complex and topics such as novelty are particularly challenging. Please keep up with the reading as scheduled and rest assured that we will get back on schedule.

- **Helpful Resources** – You should not need any additional resources beyond the required materials. However, if you would like more information on patent law, I recommend:
  - Dan Hunter, [Intellectual Property](#) (Oxford University Press 2012).
  - Janice M. Mueller, [Patent Law](#) (7<sup>th</sup> ed. 2024).
  - Treatise: CHISUM ON PATENTS (available on Lexis).
  - U.S. Patent & Trademark Office, [Manual of Patent Examining Procedure](#) – this sets out the rules for patent examination, with extensive discussion of requirements, case law, and examination practice.

- Dennis Crouch & Jason Rantanen, [Patently-O](#) – an excellent blog on patent-related decisions and issues
- Peter Menell et al., PATENT CASE MANAGEMENT JUDICIAL GUIDE (3<sup>rd</sup> ed. 2016) – a litigation treatise distributed to all federal district court judges that is accordingly influential (available in [PDF](#), [paper](#), or [on demand](#))

### **Policies**

- **Attendance** - Regular, punctual attendance is required under the College of Law and American Bar Association rules. You are responsible for ensuring that you are not recorded as absent if you arrive late. If you fail to meet the attendance requirement, you may be dropped from the course. The law school's policy on attendance can be found [here](#).

If you face special circumstances that require you to arrive late, leave early, or miss class sessions, please contact me so we can discuss how best to manage the situation. In particular, if you face an extended absence, contact me so I can help you stay current on the material.

- If you feel sick or may have been in contact with someone who is infectious, please stay home and contact me so you can participate by Zoom. Except for seeking medical care, avoid contact with others and do not travel.
- Please notify me if you will miss a scheduled course component. All course sessions are recorded so that you can access material that you miss, or review course content.
- **Professionalism** - Please be professional while attending class and while participating in assignments outside class (for example, blog discussions and e-mail exchanges). This includes treating other students and faculty courteously, being prepared for class, ensuring that you do not distract other students, and engaging the material as best you are able. In particular, I ask that you try to curb electronic distractions: turn cellular phones **off** whenever possible, avoid playing computer games, and do not use communication tools such as instant messaging or e-mail during class time. In return, I commit to treat you with respect and professionalism, including by beginning and ending class on time.
- **Blogging / Podcasting** - You are welcome to blog and podcast about class discussions and assignments, with this proviso: you may not identify any of your classmates by name (for example, “Jane Doe said that everything in this class is infringement”) without that person's permission. This policy seeks to ensure frank, enthusiastic discussion in class without concern that an inadvertent error may be preserved forever by Google.
- **Special Circumstances** - If you face special circumstances that could affect your participation in class or your ability to prepare adequately (such as a life event, a disability, repetitive strain injury (RSI), or stage fright), please contact me. There are

resources at the College of Law and beyond that we can enlist to assist you. Law school can be a stressful experience; I (along with the rest of the faculty and administration) am here to help you manage its challenges. This applies outside of class as well: if you need help or are facing a problem, please reach out. There are a lot of resources here to assist you. In particular, I would like you to be aware of:

- [Wellness at UF Law](#)
  - [U Matter, We Care](#) – contact at <umatter@ufl.edu> or 352.392.1575 (24 hours)
  - [Counseling and Wellness Center](#) – <UFLawCares@law.ufl.edu> or 352.392.1575
  - [Student Health Care Center](#) – 352.392.1161 (24 hours)
  - [University of Florida Shands Emergency Room / Trauma Center](#) – 352.733.0111; the ER is at 1515 SW Archer Road, Gainesville, FL 32608.
- **Out-of-Class Requirements** – American Bar Association Standard 310 requires devoting 2 hours of preparation outside (before) class for each hour of classroom instruction. This class has approximately three hours of classroom instruction per week; thus, you should spend roughly six hours per week outside class reading the assigned materials, preparing practice problems, formulating questions, and so forth.
  - **Feedback:** At several points during the course, I will ask you for feedback in writing / electronically about how the course is progressing and how it can be improved. This feedback is anonymous, and it is extremely important to me. It is also a **required component** of the class. I will read and carefully consider everything that the class shares with me; then, I will summarize it at the start of the next session and also describe how I will respond based upon it.
  - **College of Law Standard Syllabus Policies** - Information about other College of Law policies, including compliance with the University Honor Code, Grading, Accommodations, Class Recordings, and Course Evaluations can be found at this link: <https://ufl.instructure.com/courses/427635/files/74674656?wrap=1>.

### **Grading**

Your grade for the class will be based upon **4 components**: class feedback, seven quizzes, a midterm examination, and the final examination.

Deadlines are vitally important to patent lawyers. Failing to meet a deadline can mean that your client will be treated as having abandoned a patent application (thereby forfeiting any rights to the claimed invention), or as having waived objections or counterarguments in litigation. I may grant deadline extensions for these evaluations in my discretion, on a case by case basis, **if you ask for the extension in advance**. Late assignments will be penalized or will receive no credit **at my discretion**.

- **Feedback (5% total grade)** – At one or more points during the semester, I will ask you to submit feedback about the course via written response, Canvas post, or e-mail message. I use this feedback to adjust the course during the semester and to improve it

year to year. **You earn points simply for submitting feedback – you will not be evaluated in any way based upon the content of the feedback.** (That's the point of asking for candid input!)

- **Subject Quizzes (21%)** - You are expected to prepare for class by reading the assigned materials and, more importantly, thinking about how they fit together and how they relate to the overall arc of the course. After completing a set of course modules, you will be asked to respond to a short, multiple-choice quiz (typically 5-7 questions) on Canvas that will help you gauge your understanding of the material. You will have **15 minutes** to complete the quiz. Each quiz will be available for a period of **7 days**; you must submit your answer within those seven days. In total, your quiz scores will count for **21%** of your final grade.
- **Midterm Examination (21%)** - The midterm examination will cover the material on patentability. It will consist of a **90-minute test** that you can download and take **at a point of your choosing** during exam period (December 1-14, 2023). I will post instructions for the final exam to the course Canvas site well in advance of the test - **read them carefully**. You can use your notes, the textbook, and any other resource available to you to respond to the problem. You may not copy pre-prepared material into your exam answer. It goes without saying that your exam must consist of your own work; you may not accept assistance from anyone or provide aid to other students during the examination. (Collaborative preparation in studying for the exam is permitted, and encouraged, to the degree you find it helpful.)
- **Final Examination (53%)** - The largest single component of your grade will be the final examination. It will consist of an **8-hour test** that you can download and take **at a point of your choosing** during exam period (April 25 – May 8, 2025). I will post instructions for the final exam to the course Canvas site well in advance of the test - **read them carefully**. You can use your notes, the textbook, and any other resource available to you to respond to the problem. You may not copy pre-prepared material into your exam answer. It goes without saying that your exam must consist of your own work; you may not accept assistance from anyone or provide aid to other students during the examination. (Collaborative preparation in studying for the exam is permitted, and encouraged, to the degree you find it helpful.)

### Course Objectives

This class is designed to enable you to:

- Understand the theoretical rationales for granting exclusive legal entitlements over inventions, and for limiting those grants
- Explain why a claimed invention is or is not eligible for protection under the U.S. Patent Act and related regulations and case law
- Analyze and apply:
  - The five statutory criteria for eligibility for protection, and how these differ before and after the enactment of the America Invents Act in 2011
  - Rights granted to the patentee / patent owner
  - Elements in a claim for infringement of those rights under both literal infringement and the doctrine of equivalents

- Applicable defenses to infringement
- Remedies available in a successful infringement suit
- Procedural requirements for obtaining protection and litigating infringement
- Understand the mechanisms and procedures for applying for a patent, prosecuting a patent, and litigating alleged infringement of a patent

## **Syllabus**

Page numbers refer to the textbook unless otherwise indicated. “MPEP” indicates a citation to the [Manual of Patent Examining Procedure](#) published by the U.S. Patent and Trademark Office. Statutory references are to Title 35 of the U.S. Code, which codifies patent law.

Some modules will be covered asynchronously: you will watch a recorded lecture on the material at a time of your choosing. These modules are marked as “**ASYNC**” in the list of assignments below.

**Note:** We will be working with **two** versions of the Patent Act, the version established by the 1952 Act and in effect through March 15, 2013 (the “Old” or “1952” Act), and the version instantiated by the America Invents Act that principally took effect March 16, 2013 (“AIA”). **Please look carefully** to make sure you read the correct version of the statute. (I recommend downloading [this version of the Patent Act](#), which includes both pre- and post-AIA provisions.)

This syllabus will change as we move through the course; I anticipate that I will reduce, but not increase, the reading as we assess our pace over the semester.

<b>Module and Topics</b>	<b>Date</b>	<b>Assigned Reading</b>
<b>Introduction:</b> Course Overview, Theoretical Rationales, and Other Intellectual Property Systems	14 January 2025	17-27, 28-43; William W. Fisher III, <a href="#">Theories of Intellectual Property</a> , in NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY (Stephen Munzer, ed., 2001) (read pages 1-8); “Life of a Patent” diagram (Canvas).
<b>Introduction:</b> Reading a Patent	16 January	Find and read Patent No. 5,443,036; 43-48.
<b>Patentability</b>		
<b>Subject Matter:</b> Categories, Natural Phenomena & Laws	21 January	35 U.S.C. § <a href="#">101</a> ; 75-78; Ass’n for Molecular Pathology v. Myriad Genetics, 569 U.S. 576 (2013) (excerpts, on Canvas); Mayo Collab.



		Servs. v. Prometheus Labs., 566 U.S. 66 (2012) (excerpts, on Canvas).
<i>Subject Matter</i> : Abstract Ideas	23 January	79-94; skim 115-132; 151-158.
<i>Utility</i>	28 January	35 U.S.C. § 101; 159-61; 162-65; 165-170; 176-183.
<b>Quiz 1: Subject Matter</b>	Available 29 January through 3 February	
<i>Novelty</i> : Introduction, Anticipation, AIA Basics	30 January	<a href="#">35 U.S.C. §§ 102(a), 102(b), 102(d)</a> ; 243-252; 256-262; 252-56; 282-93.
<i>Novelty</i> : AIA – Printed Publications, Public Use, & On Sale	4 February	<a href="#">In re Klopfenstein</a> , 380 F.3d 1345 (Fed. Cir. 2004); 268-282.
<i>Novelty</i> : AIA – Otherwise Available to the Public	6 February	Finish remaining material
<i>Novelty</i> : Pre-AIA Anticipation, Statutory Bars, & Priority	11 February	Pre-AIA <a href="#">35 U.S.C. § 102</a> ; 293-96; review <a href="#">Egbert v. Lippmann</a> , 104 U.S. 333 (1881) (including dissenting opinion), <a href="#">Rosaire v. Baroid Sales Div., Nat'l Lead Co.</a> , 218 F.2d 72 (5 <sup>th</sup> Cir. 1955); <a href="#">Griffith v. Kanamaru</a> , 816 F.2d 624 (Fed. Cir. 1987)
<b>Quiz 2: AIA Novelty / Priority</b>	Available 12 February through 17 February	
<i>Non-Obviousness</i> : Introduction	13 February	<a href="#">35 U.S.C. § 103</a> ; 297 (first paragraph); 305-316
<i>Non-Obviousness</i> : Modern Approach, Motivation to Combine, & Secondary Factors	18 February	318-341
<b>Quiz 3: Non-Obviousness</b>	Available 19 February through 24 February	
<i>Disclosure</i> : Policy, Enablement	20 February	<a href="#">35 U.S.C. § 112</a> ; 185-204
<i>Disclosure</i> : Written Description, Definiteness, Best Mode	22 February	204-206 (top); 208-225; 226 (bottom paragraph); 234-241

<b>Quiz 4: Non-Obviousness &amp; Disclosure</b>	Available 23 February through 3 March	
<b>Midterm</b>	Available 4 March through 11 March	
<b>Infringement</b>		
Claim Construction	27 February	363-376; 392-407 (top)
<i>Infringement</i> : Introduction, Claim Construction, Literal Infringement	4 March	<a href="#">35 U.S.C. §§ 271(a)</a> , <a href="#">282(a)</a> ; 413-417
<i>Infringement</i> : Doctrine of Equivalents	6 March	417-424; 424-32
<i>Infringement</i> : Contributory Infringement, Inducement	11 March	<a href="#">35 U.S.C. §§ 271(c)</a> ; <a href="#">35 U.S.C. §§ 271(b)</a> ; 432-446
<i>Infringement</i> : Divided Infringement, Extraterritorial Infringement, Government Infringement	13 March	<a href="#">35 U.S.C. §§ 271(f)</a> ; 446-50; 452-463
<b>Quiz 5: Infringement</b>	Available 4 March through 11 March	
<b>Defenses</b>		
<i>Defenses</i> : Inequitable Conduct	25 March	<a href="#">MPEP § 2001</a> (37 C.F.R. § 1.56); 465-474
<i>Defenses</i> : Laches, Experimental Use; Prior User Rights	27 March	474-80; 487-491; 491-492
<i>Defenses</i> : Exhaustion	1 April	492-502
<b>Quiz 6: Defenses</b>	Available 4 April through 8 April	
<b>Remedies</b>		
<i>Remedies</i> : Injunctions & Damages: Lost Profits	3 April	<a href="#">35 U.S.C. § 283</a> ; 35 U.S.C. §§ <a href="#">284</a> ; 667-71; 672-678.
<i>Remedies</i> : Damages: Reasonable Royalty, Willful Infringement, Fees	8 April	35 U.S.C. § <a href="#">285</a> ; 678-693; 698-708
<b>Quiz 7: Remedies</b>	Available 10 April through 14 April	



<b>Procedural Issues in Litigation</b>		
<i>Procedure: Post-Issuance Review</i>	10 April	619-628; 628-632; 637-648
<b>Course Review</b>	12 April	
<b>Exam</b>	25 April – 8 May	