

Patent Law – Fall 2023

Wednesdays & Fridays, 9:00 – 10:25AM	Room: Holland Hall 345	Professor Derek Bambauer
Course: LAW 6573 Class: 14113	Credits: 3	Office Hours: Wednesdays 10:45AM – 12:45PM and by appointment

Last updated: 10 August 2023

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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 (derekbambauer@law.ufl.edu), by telephone (352.273.0600), or in Holland Hall 326. The best way to reach me is via e-mail; I infrequently check voice mail.

Professor Bambauer's office hours are Wednesdays, 10:45AM – 12:45PM; 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 (mostly retweets) [@dbambauer](#).

Logistics

- **Materials** - The required textbook for this class is Jonathan S. Masur & Lisa Larrimore Ouellette, [Patent Law: Cases, Problems, and Materials](#) (3rd ed. 2023). 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 Wednesdays and Fridays at 9:00AM, in Holland Hall 345. 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](#) (6th ed. 2020).
 - 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 (3rd 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 **3 components**: class feedback, seven quizzes, 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, D2L 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 (28%)** - 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 **28%** of your final grade.
- **Final Examination (67%)** - 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 (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.)

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.

Module and Topics	Date	Assigned Reading
Introduction: Course Overview, Theoretical Rationales, and Other Intellectual Property Systems	23 August 2023	1-22 (stop at part C), 33-42; William W. Fisher III, Theories of Intellectual Property , 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); 539-44
Introduction: Reading a Patent	25 August	Find and read Patent No. 5,443,036; read pages 23 (start at #2) – 25 (#9) and apply to the ‘036 patent; 25-31; complete exercises on 31
Patentability		
<i>Subject Matter:</i> Categories, Natural Phenomena & Laws	30 August	35 U.S.C. § 101; 252-74
<i>Subject Matter:</i> Abstract Ideas	1 September	274-301, 308-14
<i>Utility</i>	6 September	35 U.S.C. § 101; 168-72, 178-80; Brenner v. Manson , 383 U.S. 519 (1966) (please read the introduction and Part II of the majority opinion—or, pages 520-22, 528-36).
Quiz 1: Subject Matter	Available 8 September	

	through 15 September	
<i>Novelty</i> : Introduction, Anticipation, AIA Basics	8 September	35 U.S.C. §§ 102(a), 102(b), 102(d) ; 55 (graphic), 59-60, 47-54, 56-57 (stop at third full paragraph), 58-59 (#1-7), 116-22
<i>Novelty</i> : AIA – Printed Publications & Patents	13 September	60-70; In re Klopfenstein , 380 F.3d 1345 (Fed. Cir. 2004)
<i>Novelty</i> : AIA – Public Use, On Sale	15 September	70-89; City of Elizabeth v. Am. Nicholson Pavement Co. , 97 U.S. 126 (1877 (please read 127-130, 133-37))
<i>Novelty</i> : Secret Prior Art, Grace Period, Inherency	20 September	89-96, 99-103, 103-105, 127-31
Quiz 2: AIA Novelty / Priority	Available 21 September through 28 September	
<i>Novelty</i> : Pre-AIA Anticipation & Statutory Bars	22 September	Pre-AIA 35 U.S.C. § 102 ; review 47-top of 50, 54-55, 58, 59-60, 64-67; 58-59 (#8), 105-06, 111-16; Egbert v. Lippmann , 104 U.S. 333 (1881) (including dissenting opinion), Rosaire v. Baroid Sales Div., Nat'l Lead Co. , 218 F.2d 72 (5 th Cir. 1955)
<i>Novelty</i> : Pre-AIA Priority	27 September	107-10; Griffith v. Kanamaru , 816 F.2d 624 (Fed. Cir. 1987)
Quiz 3: Pre-AIA Novelty / Priority	Available 29 September through 5 October	
<i>Non-Obviousness</i> : Introduction	29 September	35 U.S.C. § 103 ; 133-36; Graham v. John Deere , 383 U.S. 1, 3-4, 11-26 (1966) (Introduction, Parts I(a), III-VI.A)
<i>Non-Obviousness</i> : Motivation to Combine & Secondary Factors	4 October	136-49, 152-65
<i>Disclosure</i> : Policy, Enablement	11 October	35 U.S.C. § 112 ; 168-170, 180-205

<i>Disclosure: Written Description, Definiteness, Best Mode</i>	13 October	205, 210-30, 231-39
Quiz 4: Disclosure	Available 14 October through 21 October	
<i>Inventorship</i>	18 October	315-331
Infringement		
<i>Infringement: Introduction, Claim Construction, Literal Infringement</i>	20 October	35 U.S.C. §§ 271(a), 282(a) ; 332-34, <i>skim</i> 335-49; 350-52; Larami Corp. v. Amron , 27 U.S.P.Q.2d 1280 (E.D. Pa. 1993)
<i>Infringement: Doctrine of Equivalents</i>	25 October	355-59; <i>Warner-Jenkinson Co. v. Hilton Davis Chemical Co.</i> , 520 U.S. 17 (1997) (Canvas); <i>skim</i> 359-67; 367-74
<i>Infringement: Contributory Infringement, Inducement</i>	27 October	35 U.S.C. §§ 271(c) ; 374-81; 35 U.S.C. §§ 271(b) ; 381-92; Global-Tech Appliances v. SEB S.A. , 563 U.S. 754 (2011)
<i>Infringement: Divided Infringement, Extraterritorial Infringement, Government Infringement</i>	1 November	35 U.S.C. §§ 271(f) ; 393-402, 402-07, 407-12; <i>skim</i> 412-18; 419
Quiz 5: Infringement	Available 2 November through 9 November	
Defenses		
<i>Defenses: Invalidity & Non-infringement; Exhaustion</i>	3 November	35 U.S.C. § 112 ; 420-22; 422-33
<i>Defenses: Inequitable Conduct</i>	8 November	MPEP § 2001 (37 C.F.R. § 1.56); 433-36; Therasense v. Benton, Dickinson & Co. , 649 F.3d 1276, 1279-85, 1287-96 (Fed. Cir. 2011)
<i>Defenses: Misuse, Prior User Rights, Experimental Use, Laches, Assignor Estoppel</i>	(ASYNC)	35 U.S.C. §§ 271(d), 282(b) ; 436-41; 536-37
Quiz 6: Defenses	Available 9 November through 16 November	
Remedies		

<i>Remedies: Injunctions & Damages: Lost Profits</i>	15 November	35 U.S.C. § 283 ; 443-54; 35 U.S.C. §§ 284 ; 456-58, 460-69, 478-80
<i>Remedies: Damages: Reasonable Royalty, Willful Infringement, Fees</i>	17 November	35 U.S.C. § 285 ; 482-99; 500-11; 512-14
Quiz 7: Remedies	Available 18 November through 25 November	
Procedural Issues in Litigation		
<i>Procedure: Jurisdiction, Standing, Venue, Local Rules, Post-Issuance Review, ITC Proceedings</i>	21 November	515-21; <i>skim</i> 522-25; 526-27
Reading Period	27-30 November	
Exam	1-14 December	