

# LAW-688-001: Patent Law

Charles Duan  
Fall 2024

Last updated August 12, 2024

Meetings: Mondays and Wednesdays, 1:00–2:20 PM  
Room: Yuma 115  
Prerequisites: None  
Credit hours: 3  
Email: [cduan@wcl.american.edu](mailto:cduan@wcl.american.edu)  
Web: <https://www.cduan.com>  
Office: Yuma 327  
Office Hours: Tuesdays 10:00 AM–12:00 PM

## About This Course

This is an introductory course to patent law, an area of law that provides exclusive rights over inventions and technology. The course will address the theoretical backdrop of patent law, cover the major doctrines of patent validity, infringement, and remedies, provide a window into the practical activities of patent attorneys, and consider key questions in modern patent policy.

## Who Should Take This Course?

This course has no prerequisites. It is intended for students who intend for patent law to be a substantial part of their career or who otherwise have a strong interest in intellectual property or technology law.

In particular, **there is no technical background requirement for this course.** While there are scientific prerequisites for obtaining registration to practice before the U.S. Patent and Trademark Office, many people have gone on to successful careers in patent law regardless of their college degree. All that is required, both for this course and generally, is an appetite for diving deep into complex problems of technology and invention.

## Learning Outcomes

Students who complete this course will gain practice in:

- Characterizing the major doctrines of patent law and performing legal analysis based on them.
- Reading the contents of patent documents.
- Following the general outline of patent litigation.
- Understanding theories and policies behind patent law, and applying these to legal questions and policy debates.
- Explaining patent law and new technologies to others unfamiliar with the field.

## Who Am I?

I am a former patent attorney who worked primarily in computer software technologies, as both a litigator and a patent prosecutor. Between 2013 and 2022, I worked at nonprofit organizations focusing on intellectual property policy. In this capacity, I have written *amicus curiae* briefs in key patent and copyright cases, commented on legislation, and studied the potential effects of changes to intellectual property law.

I'm happy to meet in person or virtually. Feel free to come by at the office hours listed above, or you can email me to set up another time.

## Course Materials

The main textbook for this course is Jonathan S. Masur & Lisa Larrimore Ouellette, *Patent Law: Cases, Problems, and Materials* (3d ed. 2023). The book is available for free electronic download [↗](#); that website also contains links for purchasing the book.

I have frequently supplemented the textbook with cases and other readings. These will be available on Canvas in a PDF coursepack. They are also all freely available and hopefully easy to find online. Note that page numbers for assigned cases refer to the coursepack, not the original documents.

Occasionally I have also assigned statutes to read. You can access statutes online at the Legal Information Institute [↗](#).

If you would like a study aid, you have many options in the library or online, but an excellent and free option is Congressional Research Service Report R46525, *Patent Law: A Handbook for Congress* (2020) [↗](#).

## Course Policies

In addition to the policies below, please note the Honor Code for the Washington College of Law [↗](#), the Grading and Examination policies of the Registrar [↗](#), and other policies stated in the WCL Catalog [↗](#) and the American University Student Conduct Code [↗](#).

## Attendance and Participation

I expect that all students will attend class regularly, complete the assigned readings and any assigned practice questions, arrive to class promptly and be prepared to participate in the class discussion when called upon. If you are unprepared to participate in the class discussion, please let me know in advance of class (either via email the day before or in-person before class begins).

You may miss up to four class sessions for any reason and without penalty (no need to email me in advance). Any additional absences must be excused for good cause in advance of the class meeting. Further unexcused absences will have a

negative impact on your grade, at my discretion. If you face particular challenges that make attendance difficult, contact the Office of Student Affairs.

Classes will be recorded, but the recordings will only be made available to individual students with excused absences. Please let me know in advance if you will be absent, so that I am aware and can send you the recording. If I do, keep in mind that the recordings are for personal use and should not be retained or shared with others.

## **Grading and Evaluation**

Your grade will primarily be based on the results of a final examination. It will be a scheduled, three-hour final examination at the end of the semester. The examination will be about one hour of multiple choice questions and two hours of essay questions (though it is up to you how you allocate your time).

The examination will be “open materials/closed Internet,” meaning that students may use any materials they bring with them (including digital materials) but access to the Internet during the examination is prohibited.

As a matter of fairness to everyone, I require that any meetings be held or emailed questions be submitted to me at least 72 hours before the exam. (That time is subject to change depending on the date the exam is scheduled.)

I may adjust grades up or down by one step (e.g., B+ to A- or B) based on your preparation for and participation in class. Good participation demonstrates engagement with the subject matter of the course and contributes to your fellow students’ learning. Discussions via email, participation in group in-class exercises, and conversations during office hours will all be considered part of class participation.

If you would like sample exams, you can take a look at my website [↗](#). Professor Michael Risch at Villanova also posts his Patent Law exams online [↗](#).

## **Schedule**

Although I hope to keep to this schedule as much as possible, it is subject to change depending on the pace of the class and external events such as important

judicial decisions or guest speakers. If there are any updates, a revised syllabus will be posted.

In particular, the classes and readings under “Special Topics” are subject to change depending on outside developments. And if there is a topic or item that you would like to see covered on those days, feel free to suggest it to me.

## **Introduction**

### **August 26—Theory of Patents**

- Read:* *Bonito Boats v. Thunder Craft*, 489 U.S. 141 (1989), coursepack pages 1–10.
- *Graham v. Deere*, 383 U.S. 1 (1966), coursepack pages 11–15, “After a lapse of 15” through “of the 1793 Patent Act.”
  - Textbook, pages 33–42, Ch. I.1.E–I.1.F.

### **August 28—How to Read a Patent**

- Read:* Textbook, pages 10–32, Ch. I.1–I.1.D.
- (Optional) Peter S. Menell et al., *Patent Claim Construction*, 25 BERKELEY TECH. L.J. 711 (2010), coursepack pages 22–28, “Table B: Common Terms Construed” through “1142, 1147–48 (Fed. Cir. 2004).”
- Prepare:* Find U.S. Patent 6,368,227 and read through it.
- Have a copy of the Menell article available for class.

**September 2—NO CLASS:** Labor Day

## **Requirements of Patentability**

### **September 4—Introduction to Novelty**

- Read:* Textbook, pages 47–49, Ch. II.2.
- Textbook, pages 116–132, Ch. II.2.C.

### **September 9—Novelty: Types of Prior Art**

- Read:* Textbook, pages 61–64, Ch. II.2.B1.1.
- Textbook, pages 70–75, Ch. II.2.B2 through *Netscape Communications v. Konrad*, 295 F.3d 1315 (Fed. Cir. 2002).
  - Textbook, pages 82–96, Ch. II.2.B2.3 through *W.L. Gore & Associates v. Garlock*, 721 F.2d 1540 (Fed. Cir. 1983).

**September 11—Novelty: Timing**

*Read:* Textbook, pages 49–60, Ch. II.2.A. You can skip the parts about pre-AIA §102.

- Textbook, pages 64–66, Ch. II.2.B1.2.
- Textbook, pages 103–105, Ch. II.2.B2.5.
- America Invents Act First Inventor to File: USPTO Training Slides, coursepack pages 29–57.
- (Optional) Textbook, pages 105–116, Ch. II.2.B3. Read if you want to see how complicated the law used to be.

*Prepare:* Try to create two flowcharts for applying §102, one for when the prior art reference is a patent and one for when the prior art reference is not a patent. Use the examples on the USPTO slides to test your understanding and the correctness of your flowcharts.

**September 16—Obviousness: The Law**

*Read:* *Graham v. Deere*, 383 U.S. 1 (1966), coursepack pages 15–20, “The difficulty of formulating conditions” through “before reaching the Patent Office.”.

- Textbook, pages 133–151, Ch. II.3–II.3.A.

**September 18—Obviousness: Secondary Considerations**

*Read:* Textbook, pages 152–167, Ch. II.3.B.

- *Procter & Gamble v. Teva*, 566 F.3d 989 (Fed. Cir. 2009), coursepack pages 58–64.

**September 23—Patentable Subject Matter: Software**

*Read:* Textbook, pages 252–254, Ch. II.6.

- Textbook, pages 286–308, Ch. II.6.B through “are ineligible under § 101.”. Skip USPTO Guidance.
- Textbook, pages 312–314, “Practice Problems: Abstract Ideas Consider” through “F.3d 1253 (Fed. Cir. 2017).”.

**September 25—Patentable Subject Matter: Biotechnology**

*Read:* Textbook, pages 254–274, Ch. II.6.A.

- Textbook, pages 284–286, “Practice Problems: Laws of Nature” through “F.3d 1319 (Fed. Cir. 2020).”.

### **September 30—Enablement**

*Read:* Textbook, pages 168–170, Ch. II.4.

- Textbook, pages 180–205, Ch. II.4.B. You can skim or skip the *Incandescent Lamp Patent* case. You do need to know the case, but the description in *Amgen v. Sanofi* is enough.

### **October 2—Written Description**

*Read:* Textbook, pages 205–230, Ch. II.4.C.

### **October 7—Utility, Inventorship, Double Patenting**

*Read:* Textbook, pages 170–180, Ch. II.4.A.

- Textbook, pages 315–331, Ch. II.7.

## **Infringement and Remedies**

### **October 9—Claim Construction and Literal Infringement**

*Read:* Textbook, pages 332–349, Ch. III–III.8. Ignore paragraphs 5 and 6 of *Phillips*; we will discuss means-plus-function claims later.

- Textbook, pages 350–355, Ch. III.9–III.9.A.
- *Simo Holdings v. Hong Kong uCloudLink*, 983 F.3d 1367 (Fed. Cir. 2021), coursepack pages 65–70.

### **October 14—NO CLASS: Fall Break**

### **October 16—Infringement by Doctrine of Equivalents**

*Read:* *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), coursepack pages 71–75.

- Textbook, pages 355–373, Ch. III.9.B.

### **October 21—Definiteness and Functional Claiming**

*Read:* Textbook, pages 231–239, *Nautilus v. Biosig Instruments*, 572 U.S. 898 (2014).

- Textbook, pages 242–243, Ch. II.5.B.
- *Williamson v. Citrix Online*, 792 F.3d 1339 (Fed. Cir. 2015), coursepack pages 76–89.

### **October 23—Indirect and Divided Infringement**

*Read:* Textbook, pages 374–392, Ch. III.10.

- Textbook, pages 393–402, Ch. III.11.A.

### **October 28—Limitations and Defenses**

- Read:* Textbook, pages 402–407, Ch. III.11.B.  
– Textbook, pages 420–442, Ch. III.12.

### **October 30—Injunctions and Reasonable Royalties**

- Read:* Textbook, page 443, Ch. IV.  
– Textbook, pages 444–455, Ch. IV.13. Skim the discussion questions.  
– Textbook, pages 482–499, Ch. IV.15. Skim the discussion questions.

### **November 4—Lost Profits**

- Read:* Textbook, pages 456–481, Ch. IV.14.

### **November 6—Additional Damages; Patent Procedure**

- Read:* Textbook, pages 500–514, Ch. IV.16.  
– Textbook, pages 515–529, Ch. V.17.  
*Prepare:* Review 35 U.S.C. § 311-319. How does the statute match the textbook’s description of inter partes review?

## **Special Topics**

### **November 11—Design Patents**

- Read:* Textbook, pages 544–550, Ch. V.19.B. Disregard the paragraph on nonobviousness; it is incorrect in view of *LKQ*.  
– *Best Lock v. Ilco Unican*, 94 F.3d 1563 (Fed. Cir. 1996), coursepack pages 90–97.  
– *LKQ Corp. v. GM Global Technology*, 102 F.4th 1280 (Fed. Cir. 2024), coursepack pages 98–109.

### **November 13—International Patent Law**

- Read:* Textbook, pages 552–580, Ch. V.20–V.20.E.2.

### **November 18—Pharmaceuticals**

- Read:* Kevin J. Hickey et al., *Drug Pricing and Intellectual Property Law: A Legal Overview for the 116th Congress* (2019), coursepack pages 111–134, “Types of Pharmaceutical Patents” through “Overview for the 116th Congress”. Skip the footnotes, and focus primarily on the generic drug sections, less on biosimilars.  
*Prepare:* Skim 21 U.S.C. § 355(j). You do not need to understand it, but appreciate its complexity, and see if you can connect the CRS report analysis to the statutory language.



### **November 20—Information and Communication Technologies**

*Read:* Textbook, pages 580–583, Ch. V.20.E.3.

- Brian T. Yeh, *Availability of Injunctive Relief for Standard-Essential Patent Holders* (2012), coursepack pages 136–152, “IT Industry Products and Patents” through “appropriate in cases involving SEPs.”
- (Optional) Textbook, pages 530–537, Ch. V.18.

### **November 25—Artificial Intelligence**

*Read:* *Thaler v. Vidal*, 43 F.4th 1207 (Fed. Cir. 2022), coursepack pages 153–158.

- USPTO, *Request for Comments Regarding the Impact of the Proliferation of Artificial Intelligence*, coursepack pages 159–166.

*Prepare:* Make a list of all the patent doctrines we’ve learned about in this class.

For as many doctrines as you can, think of a hypothetical situation in which AI challenges what you’ve learned about that doctrine.

### **November 26—Review**