Course Overview

• Updated syllabus will be available online
  • SUBJECT TO CHANGE! Always consult the online syllabus!
    • I will inform you in advance about major changes to the syllabus
    • All details will be posted on Canvas announcements as well


Course Expectations

Attendance and Engagement: 20%
Midterm Assignment: 30%
Presentation: 10%
Final Exam: 40%

Readings and Videos:
—Readings from Merges & Duffy are always required
—Assignments should be completed before class
—Readings may be supplemented with videos, podcasts, and other content

Midterm Patent Drafting Assignment: (30%)
—“Invent” a solution to one of three problems and draft a patent
—Focus on the patent document (including, but not limited to, the abstract, background/prior art, claims, description, and drawings as needed)
—You will not be graded on the quality of your artwork, the real-world functionality of your invention, nor on whether your invention is likely to survive scrutiny by the U.S. Patent and Trademark Office
—You must draft this de novo and cannot copy an existing patent!
—Due date TBD, more information to come
—Over 10 million examples on USPTO and Google Patents!
Course Expectations

"Shark Tank" Presentation: (10%)
—You will each present your midterm "invention" to the class as if you were pitching it to the "sharks" on the ABC television show Shark Tank
—I Presentation date TBD
—More information to come

Course Expectations

Final Exam:
—Take-home open book essay exam
—To be scheduled at your convenience during the exam period
—During finals week, you will access the exam on the day and time you choose
—Your written responses will be due within 24 hours

Plus/Delta

Plus: What Went Well
— Speaking back & forth over the zoom went much more smoothly than I expected.
— The audio was clear and the powerpoint slide was direct
— The audio from the presentation went okay
— The technology worked well
— Audio was good! I also appreciated the intermission.
— The incorporation of a break
— Noting what we're going to focus on throughout the course
— Going over what a patent is, the rationale behind it, the economics behind it (I think these are not as obvious as in other types of law so good idea to spend time on these) I also thought the video on economics and spending time on the supply/demand curves and how monopolies impact that were good.

Delta: What Could Go Better
— Some of the slides were repetitive and this seemed to influence the flow of the class.
— Some of the class was redundant (the recaps from was originally class 1)
— Looping in the casebook reading into the discussion
— The screen was pretty high up. It would be slightly better on my neck if your zoom box was positioned at the bottom of the projection instead of at the top.
Thanks!

Delta: What Could Go Better
— The format of the class lends itself well to a zoom format and would be better if it could be done via zoom in totality with all of the students involved. the classroom/zoom format is a bit counterproductive in my opinion.
— I don't understand why we can't all just zoom and what the benefit of us being in the classroom is - we can more easily collaborate without masks over zoom and would have clearer audio and video. I don't know why the ABA rules would allow for a remote professor and in person students over all remote students. I do not want to move to a smaller classroom without the ability to distance.
Message from NUSL Administration

“This past year, we allowed students to attend many of their courses remotely. We were able to do so because we were operating under a variance with respect to distance education that permitted remote teaching and remote attendance for public health reasons. Remote participation helped address health concerns of students and faculty in an environment in which vaccines were not readily available and also helped ensure that we could adhere to classroom capacity limits. This fall semester, while we continue to operate under a variance that gives us greater flexibility for distance education if public health needs require it, we have returned to in-person learning in our traditional curriculum. For this class, we are implementing a model that attempts to replicate students’ traditional on-ground experience as closely as possible by leveraging our newly installed classroom technologies and bringing students together to interact in a law school classroom, just as they would if the professor were physically present.”


Background

• In 1976, Bonito, “a Florida corporation,” began selling 5VBR hull.
• In 1983, Florida enacted law barring “direct molding” to copy vessel parts for sale.
• In 1984, Bonito sued Thunder Craft, “a Tennessee corporation.”

J. O’Connor’s opinion for the Court

• Constitution and Patent Act “have embodied a careful balance between”
  • “promoting innovation,” and
  • permitting competitive “imitation and refinement.”
• Patent reflects “a carefully crafted bargain”:
  • inventor’s disclosure of novel, nonobvious, and useful invention;
  • government’s grant of time-limited “right to exclude.”

Multifactored analysis supports conclusion that Florida law is preempted.

• Subject matter
• Purpose
• Nature of protection
• Term of protection
• Requirements for protection
What are the Elements of a Patent Document?

INID Codes:
- Defined by Standard ST.9 of the World Intellectual Property Organization (WIPO), the United Nations agency responsible for administering over 20 treaties concerning IP
- These numbers will be effectively the same on all US patents

Title, Inventor, and Assignee:
- Title is written by the patent applicant, needs to be sufficiently descriptive
- Examiner can require a title change
- Inventor is prominently displayed, must be an individual and not a corporation
- Leaving off inventors can result in patent invalidation
- Advanced Magnetic Closures, Inc. v. Rome Fasteners Corp., 607 F.3d 817 (Fed. Cir. 2010)
- Patents can be assigned to employers or corporations

US Patent Number and Issue Date:
- Patent practitioners and courts will often refer to patents by the last three digits of the patent number: “the ‘626 patent”
- Implementation of 1994 TRIPs Agreement
- Patents issued prior to June 8, 1995 expire 17 years after the date of issue
- Latest patents under this system expired June 8, 2012 (with some exceptions)
- Term for patents issued after June 8, 1995 is the longer of 17 years from date of issue OR 20 years from date of filing
- Filing to issue: 30-36 months

Application Information:
- Application serial number and filing date
- Under AIA, the patent term runs 20 years after the filing date
- Information concerning earlier filing (priority) dates also listed here
Domestic and International Classifications:
• International system administered by WIPO
• Domestic system administered by PTO
• Bolded: primary classification
Fields of Search:
• Search terms patent examiner uses to identify prior art

References:
• Existing patents that the inventor believes comprises the relevant prior art (with fields of search)

Patent Claims: Often the FOCUS of the Dispute

“To use a colloquial term coined by Judge Rich, ‘the name of the game is the claim.’”


Rules of Claim Construction

35 U.S.C. § 112(f)
“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

Claim Structure
Preamble (e.g., “A razor”)
Transition (e.g., “comprising”)
• “Comprising”
• “Consisting of”
• “Consisting essentially of”
Body (e.g., “a blade.”)

Claim Terminology

Independent Claim
1. A razor comprising a blade.

Dependent Claims
2. The razor of claim 1 further comprising a handle to which the blade is attached.
3. The razor of claim 2 wherein the blade is made of stainless steel.
Claim Terminology

Open Claims: comprising
• If the claim reads, ‘An invention comprising elements A, B, and C,’ traditionally interpreted as ‘elements A, B, and C, and any additional elements’

Closed Claims: consisting of
• If the claim reads, ‘An invention consisting of elements A, B, and C,’ someone selling a variant that also incorporates element D does not infringe your claim

Intermediate: consisting essentially of
• This covers a variant of the invention having element D, but only if element D does not make the variant essentially different from the claimed invention (elements A, B, and C)

Claim Construction and Scope: Which do you Prefer? Why?

1. A razor for shaving facial hair comprising
   • a first blade and
   • a second blade running parallel to the first blade and separated from it by a distance of at least 2 mm.
   -- OR --

1. A razor consisting of
   • a first means for cutting and
   • a second means for cutting running parallel to the first means for cutting and separated from the first means by a distance of about 2 mm.

Claim Drafting Exercise

Your task is to put your self into the “pre-pencil world”

Based on the inventor’s disclosure, draft at least three claims:
• One as broad as possible
• Another to an intermediate range
• A fallback claim

Try to include the “pencil-plus-eraser” combination in at least one claim

How would you draft the first (independent) claim?

I claim:
1. A box comprising upper and lower members which close or open relative to each other to form a covered box, a bottom of said box being formed by said lower member and comprising three laminated layers, a first and outside one of said three laminated layers forming a supporting layer having a first and substantially flat surface on its interior side, a second and intermediate one of said three laminated layers extending over at least a substantial portion of said first flat interior surface, said second layer comprising barrier layer means resistant to at least moisture and being spread across the said first flat interior surface, a third and inside one of said three layers having a second and substantially flat surface on its lower side with a plurality of spaced parallel flutes upstanding on its upper side, said first and second flat surfaces being bonded together in a face to face relationship with said barrier layer means interposed therebetween, said flutes comprising a plurality of upwardly directed ridges defining therebetween upwardly directed open channels, said ridges forming means for supporting an article above the bottoms of said channels, and venting means formed in said box and located in a side wall of said box at the ends of said channels, the dimensions of said box being such that heat from an article resting on said flutes escapes through said ventilation means via said channels.
Claim Drafting Exercise

• Novelty?
• Nonobviousness?
• Claims?

Innovating Based on Prior Art

• Novelty?
• Nonobviousness?
• Claims?

Patent Drafting Assignment

• 3 prompts and instructions/formatting to be shared next week (choose one)
• 30 points, 30% of your grade (grading rubric forthcoming)
• Deadline October 22, 2021 by 6pm! (two extra days)
• 10% (or 3 points) off for each day late
• Focus more on content of patent and less on appearance/production
• I will share examples from last year’s class
• Drawings will be important, but you will not be graded on your artwork
• You will also not be graded on the real-world functionality of your invention, nor on whether your invention is likely to survive scrutiny by the USPTO

Be creative! Invent something you will feel comfortable presenting to the class!

15 Minute Break