



# Course program and reading list

Semester 1 Year 2022

**School:** Harry Radzyner Law School LL.B.

## Workshop in Patent and Licensing Law

**Lecturer:**

Adv. Mark Cohen [mark.cohen@post.runi.ac.il](mailto:mark.cohen@post.runi.ac.il)

---

<b>Course No.:</b>	<b>Course Type :</b>	<b>Weekly Hours :</b>	<b>Credit:</b>
10065	Elective	2	2

<b>Course Requirements :</b>	<b>Group Code :</b>	<b>Language:</b>
Final Paper	221100650	English

**Prerequisites**

**Prerequisite:**

4 - Legal English Advanced 2 **OR** 10061 - Legal English Advanced for - Honors Program

**Students who took one of the courses listed below will not be allowed to register to the course Workshop in Patent and Licensing Law (10065):**

- 1893 - Topics In Corporate Governance
  - 1895 - Criminal Proceeding - Workshop
- 

 Course Description

Patent Law

Course Description

**October 10, 2021 – January 7, 2022**

**Lecturer-Mark S. Cohen**

**Overview:**

This course is an introduction to patent law, and the existing statutes, rules, regulations, and court decisions. We will explore and apply patent law and current issues. This class will be an introductory mix so you will get a good grounding of the fundamental patent law, policy and practice. My starting point will be US patent law but in parallel I will discuss both Israel and European patent law. Students will be required to apply written and oral skills in view of the applicable patent law.

Course Hours Sunday: 15:45pm -17:15pm

Room: L203

I am readily available, so if you do not understand a concept or have a question, please email me at [mcohen@pearlcohen.com](mailto:mcohen@pearlcohen.com).

**Course will cover:**

- - Theory and Policy Objectives
  - Patent Prosecution
  - Patent Validity
  - Patent Enforcement
  - Licensing
  - Opinion / Due Diligence / IP Law as related to Licensing Agreement & Employment Agreement & Government Grants US / Israel

**Format of Class:**

1. On the syllabus are the topics of patent law we will cover and a number of cases relevant to the respective topics area
  1. I have uploaded US patent US 9,162,262 and its Prosecution History File Wrapper which I will be using throughout each class
2. At the start of each class, a student will brief a selected case regarding the

respective topic of the class.

**How you are graded:**

1. Final Exam - 50%- Take Home
2. Take Home Assignment (3x)-30%
3. Class Brief- 10%.
4. Attendance – 10% (10 classes)

**How to prepare for the course:**

There is no book required. I will be uploading my power point presentations, cases, and additional reading material to my web site for all of the classes.

**SYLLABUS**

**Class 1:** Introduction to Patent Law

**Class 2/3:** Claims  
Disclosure Requirements  
Enablement  
Written Description  
Inventorship

*In re Wright*, 999 F.2d 1557 (Fed. Cir. 1993)

*Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991)

*Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336.

*Regents v. Eli Lilly & Co.*, 119 F.3d 1559 (Fed. Cir. 1997)

**Additional reading:**

*Mastermine Software, Inc. v. Microsoft Corp.*, No. 2016-2465, 2017 U.S. 21479 (Fed. Cir. 2017)

*Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456 (Fed. Cir. 1998)

*Burroughs Wellcome Co. v. Barr Labs., Inc* 40 F.3d 1223.

*Falana v. Kent State Univ.* 669 F.3d 1349.

*Chou v. Univ. of Chi. & Arch Dev. Corp* 254 F.3d 1347

*Stern v. Trs. of Columbia Univ.* 434 F.3d 1375.

*Fiers v Revel*, 984 F.2d 1164 (Fed. Cir. 1993)

*Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473.

*Wyeth & Cordis Corp. v. Abbott Labs.*, 720 F.3d 1380.

*ScriptPro, LLC v. Innovation Assocs.*, 762 F.3d 1355.

*Young Dental Mfg. Co. v. Q3 Special Prods.*, 112 F.3d 1137.

*Sonix Technology v Publications International*, 844 F.3d 1370 (Fed. Cir. 2017)

*Amgen Inc. v. Sanofi*, 872 F.3d 1367 (Fed. Cir. 2017)

**Class 4:** Patent Eligibility –Utility (35 U.S. Code § 101)

*Gottschalk v. Benson*, 409 U.S. 63, 93 S.Ct. 253, 34 L.Ed.2d 273 (1972)

*Diamond v. Diehr*, 450 U.S. 175, 101 S.Ct. 1048, 67 L.Ed.2d 155 (1981)

*Diamond v. Chakrabarty*, 447 U.S. 303, 100 S.Ct 2204, 65 L.Ed.2d 144 (1980)

*Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013).

*Mayo Collaborative Services v. Prometheus Laboratories, Inc.* 132 S. Ct. 1289 (2012)

*Bilski v. Kappos*, 130 S.Ct 3218 (2010)

*Alice Corp. Pty Ltd v CS Bank International*, 134 S. Ct. 2347 (2014)

*Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984)

*Enfish LLC v. Microsoft Corp.*, case number 15-1244

*Bascom Global Internet Services Inc. v. AT&T Mobility LLC et al.*, case number 15-1763

*In McRO Inc. v. Bandai Namco Games America Inc. et al.*, case number 15-1080

*Cleveland Clinic Found. v. True Health Diagnostics LLC*, 859 F.3d 1352 (2017) (Fed. Cir. 2017)

*Two-Way Media Ltd v. Comcast Cable Communs., LLC*, Nos. 2016-2531, 2016-2532, 2017 U.S. App. LEXIS 21706 (Fed. Cir. Nov. 1, 2017)

*Aatrix Software, Inc. v Green Shades Software, Inc.*, 2017-1452, 2018 WL 843288 (Fed. Cir. Feb.14, 2018)

**Additional reading:**

*Digitech Image Techs., LLC v. Electronics for Imaging, Inc.*758 F.3d 1344

*In re Roslin Inst. (Edinburgh)* 750 F.3d 1333.

*Brenner v. Manson*, 383 U.S. 519, 86 S.Ct. 1033, 16 L.Ed.2d 69 (1966)

*Lowell v. Lewis*, 15 F.Cas. 1018 (C.C.D. Mass. 1817)

*In re Brana*, 51 F.3d 1560 (Fed. Cir. 1995)

*In re Swartz*, 232 F.3d 862.

*Juicy Whip, Inc. v. Orange Bang, Inc.*, 382 F.3d 1367.

*In re Fisher*,421 F.3d 1365.

*Rapid Litigation Management v Cellzdirect Inc.*, 827 F.3d 1042 (Fed. Cir. 2016)

*Berkheimer v. HP Inc.*, 881F.3d 1360 (Fed. Cir. 2018)

*Vanda Pharmaceuticals Inc. v. West-Ward Pharmaceuticals*, 887 F.3d 1117 (Fed. Cir. 2018)

**Class 5:** Novelty (35 USC 102)

*Titanium Metals Corp. of Amer. v. Banner*, 778 F.2d 775 (Fed.Cir. 1985)

*Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991)

*Atlas Powder Co. v. IRECO Inc* 190 F.3d 1342.

*In re Moore* 58 C.C.P.A. 1340.

*In re Robertson* 169 F.3d 743.

*In re Seaborg* 51 C.C.P.A. 1109.

*In re Hafner* 56 C.C.P.A. 1424.

*In re Ruschig* 343 F.2d 965 (CCPA 1965)

*In re Donohue*, 776 F.2d 531 (Fed. Cir. 1985)

*Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 851 F.3d 1270 (2017) (Fed. Cir. 2017)

**Class 6:** Loss of Rights (Statutory Bars) and Deadlines

Diligence

Public Use

Prior Disclosure

Prior Invention

Third Party Activities

*Egbert v. Lippmann*, 104 U.S. 333, 26 L.Ed. 755 (1881)

*Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516 (2d Cir. 1946)

*Electric Storage Battery Co. v. Shimadzu*, 307 U.S. 5, 307 U.S. 613, 307 U.S. 616, 59 S.Ct. 675, 83 L.Ed. 1071 (1939)

*Woodcock v Parker*, 30 F.Cas. 491 (C.C.D.Mass. 1813)

*Gould v. Schawlow*, 363 F.2d 908 (CCPA 1966)

*Pfaff v Wells Electronics, Inc.*, 525 U.S. 55, 119 S.Ct. 304, 142 L.Ed.2d 261 (1998)

*Helsinn Healthcare SA v. Teva Pharmaceuticals USA Inc.* (2019)

**Public Use**

*Moleculon Research Corp. v. CBS, Inc.* 872 F.2d 407

*EZ Dock v Schafer Sys. Inc.*, 276 F.3d 1347 (Fed. Cir. 2002)

**On Sale**

*Abbott Lab. v. Geneva Pharms., Inc.* 182 F.3d 1315.

*Plumtree Software, Inc. v. Datamize, LLC* 473 F.3d 1152.

*The Medicines Co v Hospira. Fed Cir en banc July 11, 2016.*

**Experimental Use**

*Elizabeth v. American Nicholson Pavement Co.* 1878 U.S. No. 203

*Electromotive Div. of GMC v. Transp. Sys. Div. of GE* 417 F.3d 1203

### **Diligence**

*Brown v. Barbacid* 436 F.3d 1376.

*Fujikawa v. Wattanasin* 93 F.3d 1559.

### **Printed Publication**

*In re Klopfenstein*, 380 F.3d 1345.

### **Third Party Activities**

*Baxter Int'l, Inc. v. Cobe Labs., Inc.* 88 F.3d 1054

*Evans Cooling Sys. v. GMC* 125 F.3d 1448

**Class 7:** Obviousness/Inventive Step (35 USC 103)

*Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966)

*KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007)

### **Additional reading:**

*In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998)

*Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367  
(Fed. Cir. 1986)

*In re Vogel*, 422 F.2d 438 (CCPA 1970)

*Perfect Web Techs., Inc. v. InfoUSA, Inc.* 587 F.3d 1324.

*P&G v. Teva Pharms. USA, Inc.* 566 F.3d 989.

*Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling United States, Inc.*, 699 F.3d 1340.

*In re Winslow* 53 C.C.P.A. 1574.

*In re Kubin* 561 F.3d 1351.

*Arkie Lures, Inc. v. Gene Larew Tackle, Inc.* 119 F.3d 953

*BMS v Teva*, 752 F.3d 967 (Fed. Cir. 2014)

*Meiresonne v. Google, Inc.*, 849 F.3d 1379 (2017) (Fed. Cir. 2017)

*E.I. DuPont de Nemours v. Synvina C.V.*, 904 F.3d 996 (Fed. Cir. 2018)

**Class 8:** Inequitable Conduct/Ethics Rules

Duty of Disclosure

Post Grant Issues

Term

### ***Inequitable conduct***

*Therasense, Inc. v. Becton, Dickinson & Co.* 649 F.3d 1276.

*Ohio Willow v Alps South*, Fed. Cir. February 19, 2016.

### ***Claim Interpretation***

*Phillips v. AWH Corp.* 415 F.3d 1303.

### ***Additional reading:***

*Am. Calcar, Inc. v. Am. Honda Motor Co.* 768 F.3d 1185.

*Critikon Inc. v. Becton Dickinson Vascular*, 120 F.3d 1253, (Fed Cir. 1997)

*Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867 (Fed. Cir. 1988)

*Molins PLC v. Textron, Inc.*, 48 F.3d 1172 (Fed. Cir. 1995)

*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556 (Fed. Cir. 1989)

**Class 9:** Invalidity

Reexamination

European Opposition

IPR



*In re Recreative Technologies Corp.*, 83 F.3d 1394 (Fed. Cir. 1996)

*In re Swanson* 540 F.3d 1368.

**Class 10:** Enforcement

- Literal Infringement
- The Doctrine of Equivalents
- Prosecution History Estoppel
- Claim Interpretation
- Safe Harbor

*Markman v. Westview Instruments Inc.*, 517 U.S. 370, 116 S.Ct.1384, 134 L.Ed.2d 577 (1996)

*Graver Tank & Mfg. Co. v. Linde*, 339 U.S. 605, 70 S.Ct. 854, 94 L.Ed. 1097 (1950)

*Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S.17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997)

*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed.2d 944 (2002)

*Johnson & Johnston Associates Inc. v. R.E. Service Co., inc.*, 285 F.3d 1046 (Fed. Cir. 2002)

*In Life Technologies Corp. et al. v. Promega Corp. et al*, case number 14-1538

*SCA Hygiene Products Aktiebolag et al. v. First Quality Baby Products, LLC, et al.*, (2016)

**Additional reading:**

**Doctrine of Equivalents**

*Cybor Corp. v. Fas Techs.* 138 F.3d 1448

*Lighting Ballast Control LLC v. Philips Elecs. North Am. Corp.* 744 F.3d 1272 (en banc)

*Perkin Elmer v Westinghouse*, 822 F.2d 1528 (Fed. Cir. 1987)

**Reverse Doctrine of Equivalents**

*Westinghouse v. Boyden Power Brake Co.* 170 U.S. 537.

### **Induced Infringement**

*Akamai v. Limelight*

**Class 11:** Licensing Patents/Negotiations  
Assignments  
Employment Agreements  
Government Grants (Bayh-Dole Act and Office of Chief Scientist)

**Class 12:** Due-Diligence for Merges & Acquisitions/Public offering  
IP language and sections in SEC filings and capital raising documents

---



### Course Goals

This course is an introduction to patent law, and the existing statutes, rules, regulations, and court decisions. We will explore and apply patent law and current issues. This class will be an introductory mix so you will get a good grounding of the fundamental patent law, policy and practice. My starting point will be US patent law but in parallel I will discuss both Israel and European patent law. Students will be required to apply written and oral skills in view of the applicable patent law.

---



### Grading

**How you are graded:**

1. Final Exam - 50%- Take Home
  2. Take Home Assignment (3x)-30%
  3. Class Brief- 10%.
  4. Attendance – 10% (10 classes)
- 



### Reading List

There is no book required. I will be uploading my power point presentations, cases, and additional reading material to my web site for all of the classes