

**UNIVERSITY SENATE ROUTING LOG**

**Proposal Title:** Approval of Patent Law as a Permanent Course  
**Name/email/phone for proposal contact:** Michael P. Healy/healym@email.uky.edu/ 859-257-3636

**Instruction:** To facilitate the processing of this proposal please identify the groups or individuals reviewing the proposal, identify a contact person for each entry, provide the consequences of the review (specifically, approval, rejection, no decision and vote outcome, if any) and please attach a copy of any report or memorandum developed with comments on this proposal.

<b>Reviewed by: (Chairs, Directors, Faculty Groups, Faculty Councils, Committees, etc)</b>	<b>Contact person Name (phone/email)</b>	<b>Consequences of Review:</b>	<b>Date of Proposal Review</b>	<b>Review Summary Attached? (yes or no)</b>
College of Law Curriculum Committee	Michael P. Healy 257-3636 healym@email.uky.edu	Approval of Course	March 2, 2007	No
College of Law Faculty	Michael P. Healy 257-3636 healym@email.uky.edu	Approval of Course	April 12, 2007	Faculty Meeting Minutes Attached

## APPLICATION FOR NEW COURSE

1. Submitted by College of Law Date September 21, 2007

Department/Division offering course Law

2. Proposed designation and Bulletin description of this course

a. Prefix and Number LAW 934 b. Title\* Patent Law

\*NOTE: If the title is longer than 24 characters (including spaces), write  
A sensible title (not exceeding 24 characters) for use on transcripts \_\_\_\_\_

c. Lecture/Discussion hours per week 2 or 3 d. Laboratory hours per week NA

e. Studio hours per week NA f. Credits 2 or 3

g. Course description

The course in patent law covers aspects of patent procurement with particular attention directed to the statutory requirements faced by an applicant including considerations of patent eligibility of the subject matter and its utility, novelty and nonobviousness; the specification and claims including disclosure requirements of the written description, such as enablement and best mode; post-grant procedures of reissue, reexamination, and disclaimer; patent enforcement and affirmative defenses against a charge of infringement; remedies; and international prosecution and patenting.

h. Prerequisites (if any)

None

i. May be repeated to a maximum of NA (if applicable)

4. To be cross-listed as

NA

Prefix and Number

Signature, Chairman, cross-listing department

5. Effective Date Fall 2008 (semester and year)

6. Course to be offered  Fall  Spring  Summer

7. Will the course be offered each year? Yes  No   
(Explain if not annually)

We expect that we will offer this course every other year because a relatively small number of students wish to take this course.

8. Why is this course needed?

This course fills a basic need in the College of Law's curriculum. The course has been offered as an experimental course and the course is of special interest to a small number of students. The course will supplement the College's other offerings in the intellectual property area – an area of the law that has become increasingly important with the growth of technology.

9. a. By whom will the course be taught? Adjunct faculty (currently Sam Smith) unless a permanent hire is made in this area.

b. Are facilities for teaching the course now available?  
If not, what plans have been made for providing them?

X Yes  No

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## APPLICATION FOR NEW COURSE

10. What enrollment may be reasonably anticipated? Approximately 10 students.

11. Will this course serve students in the Department primarily?  Yes  No

Will it be of service to a significant number of students outside the Department?  
If so, explain.  Yes  No

The course may be of some interest to students in the College of Engineering.

Will the course serve as a University Studies Program course?  Yes  No

If yes, under what Area? \_\_\_\_\_

12. Check the category most applicable to this course

traditional; offered in corresponding departments elsewhere;

relatively new, now being widely established

not yet to be found in many (or any) other universities

13. Is this course applicable to the requirements for at least one degree or certificate at the University of Kentucky?  Yes  No

14. Is this course part of a proposed new program:  
If yes, which?  Yes  No

15. Will adding this course change the degree requirements in one or more programs?  
If yes, explain the change(s) below (NOTE - If "yes," a program change form must also be submitted.)  Yes  No

16. Attach a list of the major teaching objectives of the proposed course and outline and/or reference list to be used.  
See attached syllabus.

18. If the course is 400G or 500 level, include syllabi or course statement showing differentiation for undergraduate and graduate students in assignments, grading criteria, and grading scales.  Check here if 400G-500.

19. Within the Department, who should be contacted for further information about the proposed course?

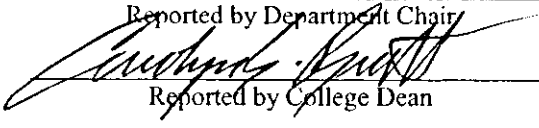
Name

Michael P. Healy, Associate Dean for Academic Affairs

Phone Extension 257-3636

## APPLICATION FOR NEW COURSE

### Signatures of Approval:

Not Applicable	Not Applicable
Date of Approval by Department Faculty	Reported by Department Chair
April 12, 2007	
Date of Approval by College Faculty	Reported by College Dean
*Date of Approval by Undergraduate Council	Reported by Undergraduate Council Chair
*Date of Approval by Graduate Council	Reported by Graduate Council Chair
*Date of Approval by Health Care Colleges Council (HCCC)	Reported by HCCC Chair
*Date of Approval by Senate Council	Reported by Senate Council Office
*Date of Approval by University Senate	Reported by Senate Council Office

\*If applicable, as provided by the Rules of the University Senate

**UNIVERSITY OF KENTUCKY  
COLLEGE OF LAW**

**MINUTES OF FACULTY MEETING  
April 12, 2007**

Attending: Dean Vestal; Associate Deans Bakert and Healy; Professors Ausness, H. Davis, M. Davis, Dennis, Fortune, Frost, Gaetke, Graham, Huberfeld, Kightlinger, Lawson, K. Moore, Price, Ringhand, and Welling; Curriculum Committee Student Representative L. Middleton.

- 1) The faculty undertook consideration of and action regarding proposals by the Curriculum Committee, including the following:
  - a) Approval of Permanent Courses
    - i) Immigration Law – Passed
    - ii) International Trade Law – Passed
    - iii) Internet Law – Passed
    - iv) Medical Liability – Passed
    - v) Patent Law – Passed
    - vi) Race, Racism, and the Criminal Law – Passed
  - b) Amendments to *Kentucky Law Journal* Constitution (see attached)
    - i) Business Manager elected by out-going board members – Passed
    - ii) Journal Membership/Writing Competition Process – Passed
  - c) Addition of Course Prerequisite (Capital Punishment) or Instructor Approval for Capital Punishment Seminar – Passed
  - d) Fall 2007 Enrollment in Non-Law Course (GWS 595) by Rising 3L Mindy Calisti – Passed
  - e) Amendment of Faculty Average Grade Rule (see attached) – Passed  
The new rule will be effective as of Fall 2007, and Dean Vestal committed to conduct a data review in Fall 2008 to determine the effect of the rule change on academic status.

2) The meeting was adjourned.

Respectfully Submitted,

Andrea L. Dennis  
Secretary

**PATENT LAW**  
**900 – 003**

**Syllabus**

**Spring 2007**

Instructor: Samuel B. Smith, Jr.  
Telephone: (H) 859-231-3862  
E-mail: [Smithjr1364@aol.com](mailto:Smithjr1364@aol.com)

Office: Room (To be determined)  
Office Hours: Following class, each Tuesday and Friday. If a period of consultation is required at another time, let me know to set up a time at our mutual conveniences.

**COURSE MATERIALS**

*Text:* “Cases and Materials on Patent Law,” Second Edition, West Group, Martin J. Adelman et al, 2003

*Supplemental Materials* (on reserve in the law library)

Title 35, United States Code  
Title 37, Code of Federal Regulations  
Manual of Patent Examining Procedure (MPEP) (5<sup>th</sup> Revision, November 2006).

Materials are also available at the United States Patent and Trademark Office website at: <http://www.uspto.gov/> under the heading “Patents”

Think about the purchase a copy of Title 35, United States Code, should the Final Examination, or a possible quiz be of the closed book variety.

**ADMINISTRATIVE NOTES**

*Attendance* – It is hoped that each student will make a commitment to attend class on a regular basis, and arrive at each scheduled class they attend in a timely fashion.

With regard to attendance, the College of Law, Faculty Rule IV. B sets out policy that I intend to follow. Briefly, the Faculty Rule permits a number of absences without consequence, and identifies the number of absences that disqualify the student from taking the final examination.

**The number of absences (including both excused and unexcused) from the classroom that will trigger disqualification is 7.**



Each student should let me know whether some extraordinary circumstances arises, and/or extra help is needed.

***Conduct of the Course*** – The hope always is to conduct each class with some amount of dialogue with the students. Accordingly, I will call on students randomly, and solicit comments from volunteers. I expect that each student attending class will have read the assigned materials carefully and will be prepared to discuss them in class. I also expect that each student will bring the casebook and whatever supplemental materials as needed to each class attended.

***Assignments*** – All reading assignments, unless otherwise identified, are in the Adelman et al text. Any written assignments and/or response to a quiz or exercise assigned for completion out – of – classroom **must** be submitted on the date scheduled for completion.

The ***Notes*** within the text are useful and contain helpful information. They, also, are part of respective assignments. Students need not dwell on the notes but check them out, and bring up your questions in class on matters that are unclear.

***Tape Recording*** – Recording of class sessions, if carried out, should be carried out only on written request and express permission.

***Grading*** -- At this time, I intend that the grade for the course will be determined by the individual grade point achieved on the final examination. Whatever the number of points available within the several parts of the final examination the grade point achieved will be located to a representative numeric value along a 100 point scale.

It is expected that the grades will locate to a multiple points along the 100 point scale, and one (1) of the grade(s) will represents a top grade, and another grade(s) will represent a bottom grade. I intend to grade each student on a curve and the student(s) with the top grade will be awarded an “A”, possibly an “A+” if the grade is significantly better than the average of all other grades.

The remaining grades will be determined according to their relationship to the upper grade(s). It is expected that the average of the grades will locate to a spread of grade points for second and third year students.

Subject to grading guidelines of the College of Law, University of Kentucky, I may adjust upwardly the grade achieved by any student on his/her final examination for good response to any out – of – class assignment, and for substantial and thoughtful contributions to our class discussions

Conversely, within the guidelines of the College of Law, I may adjust downwardly the

grade achieved by any student on his/her final examination based upon situations of persistent unexcused absence, lack of preparation, and/or tardiness.

## SCHEDULE OF TOPICS & ASSIGNMENTS

**1. Tuesday, January 9** – Introduction and overview of the course.

**2. Friday, January 12** – Chapter One, INTRODUCTION, pages 1 – 26 (through § 1.4), and the following cases:

BONITO BOATS, INC. V. THUNDER CRAFT BOATS, INC.  
IN RE BERGY

pages 43 – 56, from § 1.6[d], and the following cases:

E. I. DUPONT DENEMOURS & COMPANY V. CHRISTOPHER  
ROCKWELL GRAPHIC SYSTEMS, INC. V. DEV INDUSTRIES, INC.  
925 F.2d 174, 17 USPQ2d 1780 (7<sup>th</sup> Cir. 1991)

Look at and think about the “Trade Secret Exercise.” We will go over the exercise in class.

**3. Tuesday, January 16** – Chapter Two, PATENT ELIGIBILITY, pages 57 – 100, stopping at § 2.2, and the following cases:

GOTTSCHALK V. BENSON  
DIAMOND V. DIEHR  
ARRHYTHMIA RESEARCH TECHNOLOGY, INC. V. CORAZONIX CORP.  
STATE STREET BANK V. SIGNATURE FINANCIAL GROUP, INC.

**4. Friday, January 19**, Chapter Two, PATENT ELIGIBILITY, page 100, from § 2.2, through page 119, to § 2.3, pages 131 – 132, and the following cases:

DIAMOND, COMM. OF PATENTS V. CHAKRABARTY  
J.F.M. AG SUPPLY, INC. V. PIONEER III-BRED INTERNATIONAL, INC.

Look at and think about the “Statutory Subject Matter Exercise.” We will go over the exercise in class.

Chapter Three, UTILITY, pages 133 – 158, and the following cases:

LOWELL V. LEWIS  
JUICY WHIP, INC. V. ORANGE BANG, INC.  
BRENNER, COMMISSIONER OF PATENTS V. MANSON  
IN RE BRANA

Look at and think about the “Utility Exercise.” We will go over the exercise in class.

**5. Tuesday, January 23**, Chapter Four, ANTICIPATION, pages 159 – 178, and the following cases:

TITANIUM METALS CORP. OF AMERICA V. BANNER  
CONTINENTAL CAN CO. V. MONSANTO CO.

Look at and think about the “Anticipation Exercise.” We will go over the exercise in class.

Chapter Six, NOVELTY: PRIOR INVENTION, pages 248 – 255, to § 6.2, and the following cases:

WOODCOCK V. PARKER  
GILLMAN V. STERN

**6. Friday, January 26** – Chapter Five, STATUTORY BARS, pages 179 to § 5.1[c], page 211, and the following cases:

EGBERT V. LIPPMANN  
METALLIZING ENGIN. CO. V. KENYON BEARING & AUTO PARTS  
CITY OF ELIZABETH V. AMERICAN NICHOLSON PAVING CO.  
LOUGH (I) V. BRUNSWICK CORPORATION  
LOUGH (II) V. BRUNSWICK CORPORATION

**7. Tuesday, January 30** – Chapter Five, STATUTORY BARS, page 211, from § 5.1[c], to page 230, § 5.3, and the following cases:

PFAFF V. WELLS ELECTRONICS, INC.  
ELECTRIC STORAGE BATTERY CO. V. SHIMADZU  
ABBOTT LABORATORIES V. GENEVA PHARMACEUTICALS, INC.  
W. L. GORE & ASSOCIATES V. GARLOCK, INC.

**8. Friday, February 2** – Chapter Five, STATUTORY BARS, page 230, from § 5.3, to page 247, and the following cases:

IN RE CARLSON  
IN RE HALL  
EX PARTE THOMPSON  
STATUTORY BAR EXERCISE (Written answer to be turned in)

Chapter Six, NOVELTY: PRIOR INVENTION, page 255, from § 6.2, through page 260, stopping at § 6.2[c]

**9. Tuesday, February 6** – Chapter Six, NOVELTY: PRIOR INVENTION, page 260, § 6.2[c], to § 6.3, page 287, and the following cases:

OKA V. YOUSSEFYEH  
SCOTT V. FINNEY  
GOULD V. SCHAWLOW  
WOODLAND TRUST V. FLOWERTREE NURSERY, INC.

**10. Friday, February 9** – Chapter Six, NOVELTY: PRIOR INVENTION, page 287, § 6.3, through page 307, and the following cases:

APOTEX USA, INC. V. MERCK & CO., INC.  
ALEXANDER MILBURN CO. V. DAVIS-BOURNONVILLE CO.  
AGAWAM WOOLEN CO. V. JORDAN  
NOVELTY EXERCISE (Written answer to be turned in)

**11. Tuesday, February 13** – Review of 35 U.S.C. § 102 and Chapter Seven, NONOBVIOUSNESS, pages 308 – 336 (stopping at “United States v. Adams”), and the following cases:

HOTCHKISS V. GREENWOOD  
GREAT A. & P. TEA COMPANY V. SUPERMARKET EQUIPMENT CORP.  
THE TRILOGY INCLUDING:

GRAHAM V. JOHN DEERE CO.  
CALMAR, INC. V. COOK CHEMICAL CO.  
COLGATE-PALMOLIVE CO. V. COOK CHEMICAL CO.

Note: the structures of the patents which are the subjects of controversy in Graham, Calmar, and Cook are illustrated on pages 343 and 344.

**12. Friday, February 16** – Chapter Seven, NONOBVIOUSNESS, pages 336 – 371, to § 7.2[d], and the following cases:

UNITED STATES V. ADAMS  
IN RE ROUFFET  
HYBRITECH INC. V. MONOCLONAL ANTIBODIES, INC.

**13. Tuesday, February 20** – Chapter Seven, NONOBVIOUSNESS, pages 372 – 410, and the following cases:

WINDSURFING INTERNATIONAL, INC. V. TABUR MARINE, LTD  
IN RE PAPESCII  
IN RE DILLON  
YAMANOUCHI PHARMA., CO. LTD. V. DANBURY PHARMACAL, INC.  
IN RE DUELL

Look at and think about the “Nonobviousness Exercise.” We will go over the exercise in class.

**14. Friday, February 23** – Chapter Eight, PRIOR ART FOR NONOBVIOUSNESS, pages 411 – 437, and the following cases:

IN RE STRYKER  
IN RE FOSTER  
HAZELTINE RESEARCH, INC. V. BRENNER  
ODDZON PRODUCTS, INC. V. JUST TOYS, INC.  
IN RE CLAY  
IN RE WINSLOW  
PRIOR ART FOR NONOBVIOUSNESS EXERCISE (Written answer to be turned in)

**15. Tuesday, February 27** – REVIEW OF TITLE 35, SECTIONS 101, 102 AND 103

**16. Friday, March 2** – Chapter Nine, THE PATENT SPECIFICATION: OBJECTIVE DISCLOSURE, pages 438 – 462 (to the American Home Products case), and the following cases:

GOULD V. HELLWARTH  
ATLAS POWDER CO. V. E. I. DUPONT DENEMOURS & CO.  
IN RE WRIGHT

page 470, from § 9.2, to page 481, stopping at § 9.3, and the following case:

VAS-CATH INC. V. MAHURKAR

Chapter Ten, THE PATENT SPECIFICATION: BEST MODE, pages 497 – 507 (to the Bayer AG case), and the following case:

CHEMCAST CORP. V. ARCO INDUSTRIES CORP.

**17. Tuesday, March 6** – Chapter Eleven, CLAIMS, pages 525 – 565 (stopping at the Al-Site Corp. case), and the following cases:

EX PARTE FRESSOLA  
CATALINA MARKETING INTER. V. COOLSAVINGS.COM, INC.  
ATLANTIC THERMOPLASTICS CO. INC. V. FAYTEX CORP.  
IN RE DONALDSON

**18. Friday, March 10** – Chapter Eleven, CLAIMS, pages 565 – 593, and the following cases:

AL-SITE CORP. V. VSI INTERNATIONAL, INC.  
IN RE FOUT  
ORTHIOKINETICS, INC. V. SAFETY TRAVEL CHAIRS, INC.

Look at and think about the “Claim Drafting Exercise.” See what you are able to do. We will go over the exercise in class.

**SPRING BREAK, MARCH 11 - 17: NO ASSIGNMENTS**

**19. Tuesday, March 20** – Chapter Twelve, PROSECUTION, pages 594 – 648, stopping at § 12.4, and the following cases:

TRANSCO PRODUCTS INC. V. PERFORMANCE CONTRACTING, INC.  
ETHICON, INC. V. UNITED STATES SURGICAL CORP.  
HESS V ADVANCED CARDIOVASCULAR SYSTEMS, INC.  
KINGSDOWN MEDICAL CONSULTANTS, LTD. V. HOLLISTER INC.  
MOLINS PLC V. TEXTRON, INC.

**20. Friday, March 23** – Chapter Twelve, PROSECUTION, page 648, from § 12.4, through page 673, and the following cases:

IN RE VOGEL  
ELI LILLY AND COMPANY V. BARR LABORATORIES, INC.

Look at and think about the “Prosecution Exercise.” We will go over the exercise in class.

Chapter Thirteen, POST GRANT PROCEDURES, pages 674 – 698, and the following cases:

HEWLITT-PACKARD CO. V. BAUSCH & LOMB INC.  
IN RE RECREATIVE TECHNOLOGIES CORP.

Look at and think about the “Post – Grant Procedure Exercise.” We will go over the exercise in class.

**21. Tuesday, March 27** – Chapter Fourteen, INTERNATIONAL PROSECUTION, pages 699 – 703 (stopping at the In re Gosteli case), and page 713, from § 14.2, through page 733, to § 14.3, and the following cases:

IN RE HILMER (HILMER I)  
IN RE HILMER (HILMER II)  
IN RE DECKLER

**22. Friday, March 30** – Chapter Fifteen, INFRINGEMENT, pages 744 – 776, to § 15.2, and the following cases:

AUTOGIRO CO. OF AMERICA V. UNITED STATES  
MARKMAN V. WESTVIEW INSTRUMENTS, INC.  
CCS FITNESS, INC. V. BRUNSWICK CORPORATION  
CATALINA MARKETING INT’L, INC, V, COOLSAVINGS.COM, INC.  
(Reconsider from March 6)  
INTERACTIVE GIFT EXP, INC. V. COMPUSERVE, INC.

**23. Tuesday, April 3** – Chapter Fifteen, INFRINGEMENT, page 776, from § 15.2, – 807, to § 15.3[b], and the following cases:

GRAVER TANK V. LINDE AIR PRODUCTS CO.  
WARNER-JENKINSON COMPANY V. HILTON DAVIS CHEMICAL CO.  
CORNING GLASS WORKS V. SUMITOMO ELECTRIC USA, INC.

**24. Friday, April 6** – Chapter Fifteen, INFRINGEMENT, pages 807, § 15.3[b], through page 833, and the following cases:

FESTO CORP. V SHOKETSU KINZOKU...CO. LTD. (FESTO VIII)  
FESTO CORP. V. SHOKETSU KINZOKU...CO. LTD. (FESTO IX)

344 F.3d 1359, 68 USPQ2d 1321 (Fed. Cir. 2003)

FESTO CORP. V. SHOKETSU KINZOKU...CO. LTD (FESTO X)  
2005 WL 1398528 (D. Mass)

FESTO CORP. V. SHOKETSU KINZOKU...CO. LTD (FESTO XI)  
2006 WL 47695 (D. Mass)

JOHNSON & JOHNSTON ASSOCIATES INC. V. R.E. SERVICE CO., INC.

**25. Tuesday, April 10** – Chapter Fifteen, INFRINGEMENT, page 834, § 15.3[c], through page 875, to § 15.7, and the following cases:

WILSON SPORTING GOODS CO. V. DAVID GEOFFREY & ASSOCIATES  
TATE ACCESS FLOORS, INC. V. INTERFACE ARCHITECT. RES., INC.  
INTERMEDICS, INC. V. VENTRITEX, CO., INC.  
HEWLETT-PACKARD CO. V. BAUSCH & LOMB INC.  
JAZZ PHOTO CORP. V. UNITED STATES INT'L TRADE COMM.

**26. Friday, April 13** – Chapter Fifteen, INFRINGEMENT, pages 875, from § 15.7 to page 883, stopping at § 15.8, and the following case:

ELI LILLY & CO. V. AMERICAN CYANAMID CO.

Chapter Sixteen, ADDITIONAL DEFENSES, pages 910 – 929, and the following cases:

C. AUKERMAN CO. V. R. L. CHAIDES CONSTRUCTION CO.  
MCELMURRY V. ARKANSAS POWER & LIGHT CO.  
ADDITIONAL DEFENSE EXERCISE (Written answer to be turned in)

Chapter Seventeen, REMEDIES, pages 930 – 941, to § 17.2, and the following case:

H.H. ROBERTSON, CO. V UNITED STEEL DECK, INC.

**27. Tuesday, April 17** – Chapter Seventeen, REMEDIES, page 941, from § 17.2, through page 966, stopping at § 17.2[c], and the following cases:

PANDUIT CORP. V. STAHLIN BROS. FIBRE WORKS, INC.  
RITE-HITE CORP. V. KELLEY CO.  
BIC LEISURE PRODUCTS, INC. V. WINDSURFING INT'L, INC.

pages 974, from § 17.2[d], to page 978, stopping at § 17.2[e], and the following case:

GEORGIA-PACIFIC CORP. V. UNITED STATES PLYWOOD CORP.



**28. Friday, April 20** – Chapter Seventeen, REMEDIES, page 980, from § 17.3, to page 997, stopping at the “Remedies Exercise,” and the following cases:

READ CORP. V. PORTEC, INC.

AMSTED INDUSTRIES INC. V. BUCKEYE STEEL CASTINGS CO.

Chapter Eighteen, PATENT ENFORCEMENT, pages 1000 – 1024, stopping at § 18.4, and the following cases:

FILMTEC CORPORATION V. ALLIED-SIGNAL, INC.

WATERMAN V. MACKENZIE

BEVERLY HILLS FAN CO. V. ROYAL SOVEREIGN CORP.

## ADDENDUM

In supplement to the "Administrative Notes" set out in the Syllabus, the Patent Law course is directed to both the administrative and judicial aspects of this subject matter, all of which falls within a larger body of law oftentimes referred to as Intellectual Property Law. While it is possible during classroom discussions to touch on other subject matter within the larger field, such as Trademarks, Unfair Competition, Copyrights, and so forth, you will not be responsible for, or tested on, any subject matter not assigned.

Students taking the Patent Law course have in the past been permitted to reschedule the final examination under circumstances set out in University Senate Rule 5.2.4.6. I intend to follow my previous policy, and will endeavor to reschedule the final examination to a mutually convenient date subject to receipt of a written request no later than April 7, 2006.

Finally, every student is advised during the final examination, class work, quizzes, and other assignments that they are bound by the Honor Code promulgated by the University of Kentucky, College of Law.