

Intellectual Property Law and Engineering – Spring 2025

CHEN 4630 & CHEN 5630 (1 credit hour)

Tuesdays, 7:00–7:50 PM — Jennie Smoly Caruthers Biotech Bldg., Room A104

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CANVAS Page: <https://canvas.colorado.edu/courses/112469>

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A. Overview

Engineering is a dynamic and exciting field of work that naturally involves work in mathematics, physics, chemistry, and other basic sciences. But engineering is more than just knowledge of mathematical relationships and chemical formulae. Engineering inherently involves problem solving, and problem solving is the seed of innovation that can, and often does, blossom into discovery and invention. This class will provide students with a basic understanding of the laws that surround the protection of ideas, discoveries, and inventions, including the intellectual property law principles that surround patents, trade secrets, copyrights, and trademarks.

B. Materials

Required textbook: ***NONE***

*Reading, Cases and Statutes:* To be provided by the Professor

C. Grading

Grades will be based on class attendance and performance on homework, news emails, a presentation, and a final exam / paper, as provided below.

Class Attendance:	150 points
Homework:	105 points
News Emails:	40 points
Presentation:	50 points (15 for pre-meeting / 35 for presentation)
<u>Final Exam / Paper:</u>	<u>75 points</u>
<b>TOTAL:</b>	<b>420 points</b>

i. Class Attendance (150 points)

10 points are awarded for each class attended. No attendance points (*i.e.*, zero, nada, nothing, nil) are awarded if a class is missed. Homework and news emails remain due even if a class is missed.

*Underlying Philosophy:* Woody Allen is credited with saying “80 percent of life is showing-up,” and I happen to agree. Whether that is showing-up for class, your graduation ceremony, a wedding, a funeral, a birthday party, etc., there are just some things that are better done in person, and learning a complicated subject like IP law happens to be one of them. Thus, the emphasis on attendance.

*Late enrollment exception:* Students enrolling after either class 1 or 2 can make-up the normal attendance points for missing the first 1–2 classes by writing a 1–2 page essay about their favorite inventor(s) -- 1 page per class missed.

*Conflicting Evening Exams:* In recent years, some students have had conflicting evening examinations. Regular class attendance points will be credited if you have a conflicting evening examination (send me an email in advance of the exam with evidence showing the exam schedule and your enrollment).

ii. Homework (105 points)

There are eight homework assignments. The assignments will generally consist of a few short answer questions based on the assigned reading. Homework is due as shown in the class schedule, below, and at the beginning of class the day it is due. Homework turned in after the beginning of class but within 3 days of the class in which it was due will receive 50% of the total possible points. Homework turned in after this 3-day grace period will receive a grade of zero (0).

iii. News Emails (40 points)

From Feb. 18 – Mar. 18, there will be group presentations (described in further detail below). The week of your presentation, you are not required to send a news email as you will be working-on/finalizing your presentation. Every other week from Feb. 18 – Mar. 18, you are required to email me and the teaching assistant, prior to class, one recent news article (must be within the last 12 months) about an IP issue (patent, trademark, trade secret or copyright), with both the IP issue and the outcome summarized in the body of the email. Thus, each student will send four news emails. Each news email is worth up to 10 points. Preferably, the submitted news emails will be business related (e.g., how a patent, copyright, trademark or trade secret happening affected business/commerce).

- Definition of news for purposes of this class: “material reported in a reputable newspaper, news periodical, or internet website containing accurate, verified information/facts, preferably with minimal opinion and speculation”

Each news email should preferably cite two sources -- a primary source and a secondary source to ensure it is actually “news” and not some far-fetched opinion / inaccurate accounting. Also, a different primary news source must be used for each news email assignment (i.e., four different primary sources will be used, one for each news email). Some reputable sources of news include any of the main national news sources (ABC, CBS, CNN, FOX, NBC), well-known periodicals (Time, Newsweek, The Economist, The Atlantic), and large newspapers (Wall Street Journal, New York Times, LA Times, Washington Post, BBC, Chicago Tribune, etc.), among others. Some reputable sources of legal news include Patently-O, IPLaw360, The Daily Business Review, The American Lawyer, Bloomberg, ABA Journal, The National Law Review and Reuters. Like homework, news emails turned in after the beginning of class but within 3 days of the class in which it was due will receive 50% of the total possible points. News emails turned in after this 3-day grace period will receive a grade of zero (0).

iv. Group Presentation (50 points)

From Feb. 18 – Mar. 18, there will be group presentations, where a group of students will present on a specific legal issue, as shown in the below class schedule. Each group will be 2+

students (*depending on final total enrollment*). You can pick your own group members, or I can assign group members. Groups will randomly be assigned a legal case for presentation to the class.

- **Presentation Content:** The presentation should focus on informing the class of the particular holding of the cited case and how it relates to patent law. For instance, if your topic relates to “anticipation,” the legal issues surrounding “anticipation” should be the focus of your presentation. Other legal issues may be discussed, time permitting. The presentations are expected to be about 15 minutes and are worth 35 points.
  - There is no perfect format for the presentations, but presentations are expected to describe how the parties arrived at the deciding court (and which court is the deciding court), the main legal issue of the case, the statute(s) or rule(s) surrounding the case, the facts surrounding the legal issue, and the outcome / rule provided by the case. If the case turns on a particular claim limitation, the claim and the applicable claim limitation(s) should be highlighted in the presentation. As with all good presentations, consider your audience and audience member expectations. (*Note: It is **not** good practice to “divvy up” the slides among group members and then just cram them all together at the end with each person only addressing their own slides. This usually results in a poor presentation and a corresponding poor grade. The best presentations come from group development of a cohesive, organized deck of slides.*)
- **Pre-Meeting:** At least two weekdays (no weekends) prior to your assigned presentation date, you must have a ZOOM meeting with me to review the draft presentation – your group can email me to set-up the meeting. The goal is to review the draft presentation to make sure your team is on track as it relates to the core legal principles and facts of your assigned case. Obviously, you can ask me questions during the meeting. The pre-meeting is worth 15 points and should last 15–20 minutes.

**v. Final Exam / Paper (75 points)**

A short final exam will be administered for undergraduate students and will likely consist of several multiple-choice, short answer and/or matching questions. A short final paper will be required for graduate students.

**D. Anticipated Class Schedule (subject to revision at instructor's discretion)**

<i><b>Date</b></i>	<i><b>Assigned Reading / Activity</b></i>	<i><b>Assignment(s) Due</b></i>
January 14	1. Overview of Intellectual Property: <ul style="list-style-type: none"> <li>• <a href="http://en.wikipedia.org/wiki/Intellectual_property">http://en.wikipedia.org/wiki/Intellectual_property</a></li> <li>• <a href="http://en.wikipedia.org/wiki/Outline_of_intellectual_property">http://en.wikipedia.org/wiki/Outline_of_intellectual_property</a></li> </ul>	NONE

<i>Date</i>	<i>Assigned Reading / Activity</i>	<i>Assignment(s) Due</i>
	<ul style="list-style-type: none"> <li><a href="https://www.mentalfloss.com/article/52444/27-celebrity-patent-holders">https://www.mentalfloss.com/article/52444/27-celebrity-patent-holders</a></li> </ul> 2. Howard Rockman's Top 10 list of IP protection (provided)	
January 21	1. Overview of Patents (skim): <ul style="list-style-type: none"> <li><a href="http://en.wikipedia.org/wiki/Patent">http://en.wikipedia.org/wiki/Patent</a></li> <li><a href="http://en.wikipedia.org/wiki/United_States_patent_law">http://en.wikipedia.org/wiki/United_States_patent_law</a></li> <li><a href="http://en.wikipedia.org/wiki/Design_patents">http://en.wikipedia.org/wiki/Design_patents</a></li> </ul> 2. U.S. Patent Nos. 5,126,156 and 5,975,893 (skim both) 3. The Patenting Process (skim): <ul style="list-style-type: none"> <li><a href="https://www.uspto.gov/patents/basics/patent-process-overview#step1">https://www.uspto.gov/patents/basics/patent-process-overview#step1</a></li> <li><a href="https://www.waltmire.com/2017/01/06/patent-application-process-flow-chart/">https://www.waltmire.com/2017/01/06/patent-application-process-flow-chart/</a></li> </ul>	Homework 1
January 28	1. Patent Industrial Utility – 35 U.S.C. 101 (skim) 2. Case: <u>Diamond v. Chakrabarty</u> , 447 U.S. 303 (p. 2–9) ( <i>read</i> ) <ul style="list-style-type: none"> <li>U.S. Patent No. 4,259,444 (claims 1, 7, and 11)</li> </ul> 3. Case: <u>Myriad</u> , 133 S. Ct. 2107 (p. 4–22) ( <i>read</i> ) <ul style="list-style-type: none"> <li>U.S. Patent No. 5,747,282 (claims 1 and 2)</li> </ul>	Homework 2
February 4	1. Patent Novelty – 35 U.S.C. 102 (skim) 2. Case: <u>Pfaff v. Wells</u> , 525 U.S. 55 ( <i>read</i> ) 3. Article: Dippin Dots – what went wrong? <b>Assigning of Feb.– Mar. group presentations</b>	Homework 3
February 11	1. Patent Obviousness – 35 U.S.C. 103 (skim) 2. Case: <u>KSR v. Teleflex</u> , 550 US 398, pp. 8–31 ( <i>read</i> ) 3. Written description, enablement and best mode – 35 U.S.C. 112 (skim) 4. Claim charts – matching-up the prior art to the claims <ul style="list-style-type: none"> <li><a href="https://en.wikipedia.org/wiki/Claim_chart">https://en.wikipedia.org/wiki/Claim_chart</a></li> </ul>	Homework 4
<p align="center"><b>February 18 to March 18 – IP in the news and presentations</b></p> <p><i>Patent Documents:</i> Google patents can be used to locate the applicable patent(s) cited in the below cases: <a href="https://patents.google.com/">https://patents.google.com/</a></p>		

<i>Date</i>	<i>Assigned Reading / Activity</i>	<i>Assignment(s) Due</i>
February 18	Presentation 1 – Anticipation (Group 1) <ul style="list-style-type: none"> <li>• 35 U.S.C. 102</li> <li>• <i>Case: Titanium Metals v. Banner</i>, 778 F.2d 775               <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?case=2590194147014741898">https://scholar.google.com/scholar_case?case=2590194147014741898</a></li> </ul> </li> </ul> Presentation 2 – Anticipation (Group 2) <ul style="list-style-type: none"> <li>• 35 U.S.C. 102</li> <li>• <i>Case: Minerva Surgical v. Hologic, Inc.</i>, 59 F.4th 1371               <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?case=7296500211746738951">https://scholar.google.com/scholar_case?case=7296500211746738951</a></li> </ul> </li> </ul>	Homework 5 <i>for everyone</i> & News Email due for Groups 3–11
February 25	Presentation 3 – Written Description Requirement (Group 3) <ul style="list-style-type: none"> <li>• 35 U.S.C. 112</li> <li>• <i>Case: AbbVie v. Janssen</i>, 759 F.3d 1285               <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?&amp;case=6167472654931691868">https://scholar.google.com/scholar_case?&amp;case=6167472654931691868</a></li> </ul> </li> </ul> Presentation 4 – Right of Priority (Group 4) <ul style="list-style-type: none"> <li>• 35 U.S.C. 120, 121</li> <li>• <i>Case: Anascape v. Nintendo</i>, 601 F.3d 1333               <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?&amp;case=9144676124644681679">https://scholar.google.com/scholar_case?&amp;case=9144676124644681679</a></li> </ul> </li> </ul>	News Email due for Groups 1–2 and 5–11
March 4	Presentation 5 – Enablement (Group 5) <ul style="list-style-type: none"> <li>• 35 U.S.C. 112</li> <li>• <i>Case: Alcon v. Barr</i>, 745 F. 3d 1180               <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?&amp;case=6743074355785325244">https://scholar.google.com/scholar_case?&amp;case=6743074355785325244</a></li> </ul> </li> </ul> Presentation 6 – Claim Construction (Group 6) <ul style="list-style-type: none"> <li>• <i>Case: Phillips v. AWH</i>, 415 F. 3d 1303               <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?&amp;case=2207195741320793153">https://scholar.google.com/scholar_case?&amp;case=2207195741320793153</a></li> </ul> </li> </ul> Presentation 7 – Inventorship (Group 7) <ul style="list-style-type: none"> <li>• 35 U.S.C. 116 and 256</li> <li>• <i>Case: Univ. of Pitt v. Hedrick</i>, 573 F.3d 1290               <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?&amp;case=15040603369713624295">https://scholar.google.com/scholar_case?&amp;case=15040603369713624295</a></li> </ul> </li> </ul>	News Email due for Groups 1–4 and 8–11
March 11	Presentation 8 – Obviousness (Group 8) <ul style="list-style-type: none"> <li>• 35 U.S.C. 103</li> <li>• <i>Case: Wyers v. Master Lock Co.</i>, 616 F.3d 1231               <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?case=12214126920180829054">https://scholar.google.com/scholar_case?case=12214126920180829054</a></li> </ul> </li> </ul> Presentation 9 – Obviousness (Group 9)	News Email due for Groups 1–7 and 10–11

<i>Date</i>	<i>Assigned Reading / Activity</i>	<i>Assignment(s) Due</i>
	<ul style="list-style-type: none"> <li>35 U.S.C. 103</li> <li>Case: <u>Daiichi Sankyo v. Matrix Labs</u>, 619 F.3d 1436 <ul style="list-style-type: none"> <li><a href="https://scholar.google.com/scholar_case?case=15320749939134835262">https://scholar.google.com/scholar_case?case=15320749939134835262</a></li> </ul> </li> </ul> <p><i>GET CHEMICAL COMPOUNDS FROM PDF VERSION</i></p>	
March 18	<p>Presentation 10 – Doctrine of Equivalents (Group 10)</p> <ul style="list-style-type: none"> <li>Case: <u>Festo</u>, 535 U.S. 722 <ul style="list-style-type: none"> <li><a href="https://scholar.google.com/scholar_case?&amp;case=8250508786110786578">https://scholar.google.com/scholar_case?&amp;case=8250508786110786578</a></li> </ul> </li> </ul> <p>Presentation 11 – The Duty of Disclosure (Group 11)</p> <ul style="list-style-type: none"> <li>37 C.F.R. 1.56</li> <li>Case: <u>Intellect Wireless v. HTC</u>, 732 F. 3d 1339 <ul style="list-style-type: none"> <li><a href="https://scholar.google.com/scholar_case?&amp;case=16202068478177031764">https://scholar.google.com/scholar_case?&amp;case=16202068478177031764</a></li> </ul> </li> </ul>	News Email due for Groups 1–9
March 25	<b><i>Spring Break – No Class</i></b>	None
April 1	<ol style="list-style-type: none"> <li>Foreign patent filing – Right of Priority (handout provided)</li> <li>Design patents <ul style="list-style-type: none"> <li><a href="http://en.wikipedia.org/wiki/Design_patents">http://en.wikipedia.org/wiki/Design_patents</a> (skim)</li> <li>35 U.S.C. 171–173 (skim)</li> <li>Case: <u>Seaway v. Walgreens</u>, 589 F.3d 1233 (<i>read</i>) <ul style="list-style-type: none"> <li><a href="https://scholar.google.com/scholar_case?case=4165315684411405227">https://scholar.google.com/scholar_case?case=4165315684411405227</a></li> <li>U.S. Patent No. D529263</li> </ul> </li> <li>Forbes Article: "The Surprise Leader in Design Patents"</li> </ul> </li> </ol>	Nothing Due
April 8	<ol style="list-style-type: none"> <li>Trade Secrets <ul style="list-style-type: none"> <li><a href="http://en.wikipedia.org/wiki/Trade_secret">http://en.wikipedia.org/wiki/Trade_secret</a> (skim)</li> <li><a href="https://www.forbes.com/2010/02/19/protecting-trade-secrets-leadership-managing-halligan-haas.html">https://www.forbes.com/2010/02/19/protecting-trade-secrets-leadership-managing-halligan-haas.html</a> (<i>read</i>)</li> <li><a href="https://en.wikipedia.org/wiki/Defend_Trade_Secrets_Act">https://en.wikipedia.org/wiki/Defend_Trade_Secrets_Act</a> (skim)</li> <li>CRS 7–74–102 et seq. (skim)</li> <li>18 USC §§ 1836 and 1839 (skim)</li> <li>Coca-Cola trade secret theft – articles (<i>read</i>)</li> </ul> </li> </ol>	Homework 6

<i>Date</i>	<i>Assigned Reading / Activity</i>	<i>Assignment(s) Due</i>
April 15	1. Copyrights <ul style="list-style-type: none"> <li>• <a href="https://copyrightalliance.org/ca_faq_post/difference-copyright-patent-trademark/">https://copyrightalliance.org/ca_faq_post/difference-copyright-patent-trademark/</a> (<i>read</i>)</li> <li>• <a href="http://en.wikipedia.org/wiki/Copyright_law_of_the_United_States">http://en.wikipedia.org/wiki/Copyright_law_of_the_United_States</a> (skim)</li> <li>• Case: <i>Fourth Estate Public Corp v. Wall-Street. com, LLC</i>, 139 S. Ct. 881 (2019) (<i>read</i>) <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?case=4728796451311095418">https://scholar.google.com/scholar_case?case=4728796451311095418</a></li> </ul> </li> <li>• Statutes: 17 USC 102, 412 and 504</li> <li>• <a href="http://en.wikipedia.org/wiki/Statutory_damages_for_copyright_infringement">http://en.wikipedia.org/wiki/Statutory_damages_for_copyright_infringement</a> (<i>read</i>)</li> </ul>	Homework 7
April 22	1. Trade and Service Marks <ul style="list-style-type: none"> <li>• <a href="http://en.wikipedia.org/wiki/Trademark">http://en.wikipedia.org/wiki/Trademark</a> (skim)</li> <li>• <a href="http://en.wikipedia.org/wiki/Service_mark">http://en.wikipedia.org/wiki/Service_mark</a> (skim)</li> <li>• <a href="http://en.wikipedia.org/wiki/Trademark_distinctiveness">http://en.wikipedia.org/wiki/Trademark_distinctiveness</a> (<i>read</i>)</li> <li>• <a href="https://www.uspto.gov/learning-and-resources/trademark-faqs">https://www.uspto.gov/learning-and-resources/trademark-faqs</a> (skim)</li> <li>• Becoming generic: <i>King-Seeley v. Aladdin</i>, 321 F.2d 577 (<i>read</i>) <ul style="list-style-type: none"> <li>◦ <a href="https://scholar.google.com/scholar_case?case=326773422967317335&amp;">https://scholar.google.com/scholar_case?case=326773422967317335&amp;</a></li> </ul> </li> </ul>	Homework 8
April 29	Make-up class / potential panel with former student attorneys, engineers, business leaders, etc.	N/A

#### E. Academic Ethics

Any discovered act of academic dishonesty by a student in this course will be reported to the Boulder Campus Honor Code Council. Additionally, the course instructor will report the incident to the Academic Ethics Committee of the Department of Chemical and Biological Engineering. This Committee will recommend to the instructor whether a sanction should be applied to the student. Typical sanctions may range from a zero on an assignment in question to an F in the course. Whether or not the student has admitted the act, in light of the preponderance of the evidence, may factor into the recommendation of the Committee.

END