

AGENDA/SYLLABUS [File01 on USB drive]

CHISUM PATENT ACADEMY®

Advanced Patent Law Seminar March 5-6, 2015 21C Museum Hotel, Cincinnati, Ohio

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Session	Topics	Cases and Materials for Discussion	Background Reading in Mueller, <i>Patent Law, Fourth Edition</i> (Aspen 2013)
Day 1 Morning Session 9:00 am – 12:00 pm	<i>Recent Blockbuster Supreme Court and Federal Circuit Cases</i>	File02 , Donald Chisum, <i>Abstracts of 2014-2015 Supreme Court Patent Cases</i> . Abstracted decisions: <ul style="list-style-type: none">• <i>Teva Pharm. USA, Inc. v. Sandoz, Inc.</i>, 135 S. Ct. 831 (Jan. 20, 2015) (claim construction standards of review);• <i>Medtronic, Inc. v. Mirowski Family Ventures, LLC</i>, 134 S. Ct. 843 (2014) (burden of proof in licensee DJ suits);• <i>Octane Fitness, LLC v. ICON Health & Fitness, Inc.</i>, 134 S. Ct. 1749 (2014) (exceptional case standard for attorney fee awards in patent cases);• <i>Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.</i>, 134 S. Ct. 1744 (2014) (standard for reviewing district court exceptional case determinations; abuse of discretion);• <i>Petrella v. Metro-Goldwyn-Mayer, Inc.</i>, 134 S. Ct. 1962 (2014) (laches in copyright infringement cases);	Chapter 7 (“Potentially Patentable Subject Matter”); Chapter 9 (“Patent Infringement”); Chapter 11 (“Remedies for Patent Infringement”).

- *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014) (repudiation of lenient Federal Circuit claim definiteness standard);
- *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111 (2014) (divided infringement; no inducement absent direct infringement);
- *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) (computer-implemented inventions as patent eligible subject matter).

File03, Donald Chisum, *Abstracts of Selected Critical 2014-2015 Federal Circuit En Banc and Panel Decisions*. Abstracted decisions:

- *Lighting Ballast Control LLC v. Philips Elecs. N. Am. Corp.*, 744 F.3d 1272 (Fed. Cir. 2014) (*en banc*) (no change from *de novo* standard of review of claim construction; stare decisis);
- *Digitech Image Techs., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014) (“device profile”; abstract idea under *Alice*);
- *BuySAFE, Inc. v. Google Inc.*, 765 F.3d 1350 (Fed. Cir. 2014) (guaranteeing on line transaction performance; abstract idea under *Alice*);
- *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014) (distributing copyrighted content over the Internet; abstract idea under *Alice*);
- *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) (generating a composite web page: not abstract idea under *Alice*);
- *In re BRCA1- & BRCA2- Based Hereditary Cancer Test Patent Litigation*, 774 F.3d 755 (Fed. Cir. 2014) (comparing genes to detect mutation; abstract idea under *Alice*);
- *Content Extraction & Transmission LLC v. Wells Fargo Bank*, 2014 U.S. App. LEXIS 24258 (Fed. Cir. 2014) (extracting data from hard copy documents; abstract idea under *Alice*);
- *Commil USA, LLC v. Cisco Sys., Inc.*, 720 F.3d 1361 (Fed. Cir. June 25, 2013), *cert. granted*, 135 S. Ct. 752 (Dec. 5, 2014) (inducement; good faith belief in invalidity; discussed in outline at File 011);
- *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 769 F.3d 1371 (Fed. Cir. 2014) (willful infringement);
- *SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC*,

		<p>767 F.3d 1339 (Fed. Cir. 2014), <i>vacated and rehearing en banc granted</i>, 2014 U.S. App. LEXIS 24697 (Dec. 30, 2014) (<i>en banc</i>) (laches defense to damages);</p> <ul style="list-style-type: none"> • <i>Bristol-Myers Squibb Co. v. Teva Pharmaceuticals USA, Inc.</i>, 752 F.3d 967 (Fed. Cir. 2014), <i>rehearing & rehearing en banc denied</i>, 2014 U.S. App. LEXIS 20062 (Fed. Cir. 2014) (Newman, Lourie, Reyna & Taranto dissenting) (obviousness: post-filing date evidence not described in patent specification). 	
<p>Day 1</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p>	<p><i>Patent Claims: Construction, Standard of Review, and Definiteness Requirement</i></p>	<p>File04, Janice Mueller, PowerPoints on “Patents Claims: Interpretation and Definiteness”;</p> <p>File05, <i>Teva Pharms. USA, Inc. v. Sandoz, Inc.</i>, 135 S. Ct. 831 (Jan. 20, 2015) (patent claim construction standards of review);</p> <p>File06, <i>In re Papst Licensing Digital Camera Patent Litig.</i>, No. 2014-1110, 2015 WL 408127 (Fed. Cir. Feb. 2, 2015) (post-<i>Teva</i> claim construction);</p> <p>File07, <i>Fenner Investments, Ltd. v. Cellco P’shp</i>, No. 2013-1640, 2015 WL 570730 (Fed. Cir. Feb. 12, 2015) (post-<i>Teva</i> claim construction);</p> <p>File08, <i>Pacing Techs., LLC v. Garmin Int’l</i>, 2015 WL 668828 (Fed. Cir. Feb. 18, 2015) (post-<i>Teva</i> claim construction);</p> <p>File09, <i>Nautilus, Inc. v. Biosig Instruments, Inc.</i>, 134 S. Ct. 2120 (2014) (35 U.S.C. §112(b) claim definiteness requirement);</p> <p>File010, <i>In re Packard</i>, 751 F.3d 1307 (Fed. Cir. 2014) (definiteness standard in USPTO);</p> <p>File011, <i>Lighting Ballast Control LLC v. Philips Elecs. N.A. Corp.</i>, 744 F.3d 1272 (Fed. Cir. 2014) (<i>en banc</i>) (reaffirming <i>de novo</i> standard of review for claim construction), <i>cert. granted, judgment vacated sub nom. Lighting Ballast Control LLC v. Universal Lighting Techs., Inc.</i>, No. 13-1536, 2015 WL 303220 (U.S. Jan. 26, 2015) (vacating and remanding</p>	<p>Chapter 2[B] (“Patent Claims: Claim Definiteness Requirement (35 U.S.C. §112(b))”);</p> <p>Chapter 9[B] (“Patent Infringement: Step One: Patent Claim Interpretation”).</p>

		case to Fed. Cir. for further consideration in light of <i>Teva v. Sandoz</i>).	
<p>Day 2</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p>	<p>Issues Concerning Method and System Claims;</p> <p>Exhaustion Defense</p>	<p>File012, Donald Chisum, <i>Method and System Claim Issues; Exhaustion Defense</i>. Abstracted decisions:</p> <p>(1) Method and Systems Claims: Active Inducement</p> <p>(a) Sections 271(b) and (c); Distinguishing Active Inducement from Contributory Infringement</p> <ul style="list-style-type: none"> ● <i>Toshiba Corp. v. Imation Corp.</i>, 681 F.3d 1359 (Fed. Cir. 2012) (contributory infringement and active inducement; substantial non-infringing use). <p>(b) Knowledge and Intent</p> <ul style="list-style-type: none"> ● <i>Global-Tech Appliances, Inc. v. SEB S.A.</i>, 131 S. Ct. 2060 (2011) (knowledge of patent and infringement required for active inducement); ● <i>Commil USA, LLC v. Cisco Systems</i>, 720 F.3d 1361 (Fed. Cir. 2013), <i>rehearing en banc denied</i>, 2013 U.S. App. LEXIS 21713 (Fed. Cir. Oct. 25, 2013) and 2013 U.S. App. LEXIS 21714 (Fed. Cir. Oct. 25, 2013), <i>certiorari granted</i>, 135 S. Ct. 752 (December 5, 2014) (limited to question 1: "Whether the Federal Circuit erred in holding that a defendant's belief that a patent is invalid is a defense to induced infringement under 35 U.S.C. § 271(b)."). <p>(c) The Joint-Distributed Infringement Problem, Claim Drafting Considerations</p> <ul style="list-style-type: none"> ● <i>Limelight Networks, Inc. v. Akamai Technologies, Inc.</i>, 134 S. Ct. 2111 (2014) (divided infringement; no inducement absent direct infringement); ● <i>Advanced Software Design Corp. v. Fiserv, Inc.</i>, 641 F.3d 	<p>Chapter 9[E] ("Aspects of Infringement Beyond 35 U.S.C. §271(a)");</p> <p>Chapter 10[C][8] ("Patent Exhaustion").</p>

		<p>1368 (Fed. Cir. 2011) (steps by single actor; steps recited in preamble: only "claim environment");</p> <ul style="list-style-type: none"> • <i>HTC Corp. v. IPCOM GmbH & Co., KG</i>, 667 F.3d 1270 (Fed. Cir. 2012) (claim to apparatus for use in system with recited steps; not improper hybrid process/product claim); • <i>Nazomi Communs., Inc. v. Nokia Corp.</i>, 739 F.3d 1339 (Fed. Cir. 2014) (hardware with capacity but lacking software); • <i>Ericsson, Inc. v. D-Link Systems, Inc.</i>, 773 F.3d 1201 (Fed. Cir. 2014) (system claims requiring only "capabilities"). <p>(2) Exhaustion</p> <ul style="list-style-type: none"> • <i>Keurig, Inc. v. Sturm Foods, Inc.</i>, 732 F.3d 1370 (Fed. Cir. 2013) (method claims); • <i>Lifescan Scotland, Ltd. v. Shasta Technologies, LLC</i>, 734 F.3d 1361 (Fed. Cir. 2013) (method claims); • <i>Helferich Patent Licensing, LLC v. New York Times Co.</i>, 2015 U.S. App. LEXIS 2047 (Fed. Cir. Feb. 10, 2015) (claims to presumptively separately patentable inventions; "reciprocal enhancement of utility"). 	
<p>Day 2</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p>	<p><i>Inter Partes Review: Overview; Case Study; Fed. Cir. Review of PTAB Decisions</i></p>	<p>File013, Janice Mueller, PowerPoints on <i>Inter Partes</i> Review;</p> <p>File014, <i>Covidien LP v. Ethicon Endo-Surgery, Inc.</i>, Case IPR2013-00209 (PTAB June 9, 2014) (Final Written Decision);</p> <p>File015, Petition for IPR by Covidien (Mar. 25, 2013);</p> <p>File016, Response by Patentee Ethicon (Nov. 19, 2013);</p> <p>File017, Ethicon’s USP 8,317,070 (issued Nov. 27, 2013);</p> <p>File018, <i>In re Cuozzo Speed Techs., LLC</i>, No. 2014-1301, 2015 WL 448667 (Fed. Cir. Feb. 4, 2015) (affirming PTAB’s application of broadest reasonable claim interpretation rule in IPRs; finding no CAFC jurisdiction to review PTAB institution decision).</p>	<p>Chapter 8[E] (“AIA-Implemented Procedures for Challenging Issued Patents”).</p>

