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CHISUM PATENT ACADEMY®

Advanced Patent Law Small Group Seminars
September 29-30 and October 3-4, 2016
Offices of Kaye Scholer LLP
Washington, D.C.

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| Session | Topics | Cases and Materials for Discussion |
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| Day 1 Morning Session 9:00 am – 12:00 pm | Recent Blockbuster Supreme Court and Federal Circuit En Banc Cases | <p>File02, Donald Chisum, <i>Abstracts of Recent Blockbuster Supreme Court and Federal Circuit Decisions</i>. Abstracted decisions:</p> <ul style="list-style-type: none">• <i>Halo Electronics</i>, 136 S. Ct. 1923 (2016) (enhanced damages, willful infringement);• <i>Carnegie Mellon</i>, 807 F.3d 1283 (Fed. Cir. 2015), <i>rehearing en banc, denied in part and held in abeyance in part</i>, 805 F.3d 1382 (Fed. Cir. 2015) (willful infringement, enhanced damages);• <i>Lexmark, Inc.</i>, 816 F.3d 721 (Fed. Cir. 2016) (<i>en banc</i>) (exhaustion);• <i>The Medicines Co. v. Hospira</i>, 827 F.3d 1363 (Fed. Cir. July 11, 2016) (<i>en banc</i>) (on sale, commercial activity) (see also File03 below);• <i>Cuozzo Speed Technologies, LLC v. Lee</i>, 136 S. Ct. 2131 (2016) (<i>inter partes</i> review, appeals, broadest reasonable construction);• <i>In re Aqua Prods., Inc.</i>, No. 2015-1177, 2016 WL 4375651, 118 USPQ2d 1776 (Fed. Cir. Aug. 12, 2016) (order granting reh'g <i>en banc</i>) (burdens of proof and production for IPR motions to amend). <p>File03, Janice Mueller, Powerpoints on On-Sale Bar: <i>The Medicines Co. v. Hospira, Inc.</i>, 827 F.3d 1363 (Fed. Cir. July 11, 2016) (<i>en banc</i>).</p> |

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| <p>Day 1</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p> | <p>Inter Partes Review I: Appellate Review and Broadest Reasonable Construction</p> | <p>File04, Janice Mueller, PowerPoints on <i>Inter Partes</i> Review;</p> <p>File05, Donald Chisum, <i>Thresholds to Inter Partes Review Institution: Federal Circuit Review Before and After Cuozzo</i>. Abstracted Decisions:</p> <ul style="list-style-type: none"> ● <i>SightSound Technologies</i>, 809 F.3d 1307; ● <i>Versatam</i>, 793 F.3d 1306; ● <i>MCM</i>, 812 F.3d 1284; ● <i>Ethicon</i>, 812 F.3d 1023; ● <i>GTNX</i>, 789 F.3d 1309; ● <i>Achates</i>, 803 F.3d 652; ● <i>Synopsys</i>, 814 F.3d 1309; ● <i>Shaw</i>, 817 F.3d 1293, ● <i>Harmonic</i>, 815 F.3d 1356; ● <i>HP</i>, 817 F.3d 1339; ● <i>Wi-Fi One, LLC v. Broadcom Corp.</i>, No. 2015-1944, 2016 WL 4933298 (Fed. Cir. Sept. 16, 2016). <p>File06, Donald Chisum, <i>Broadest Reasonable Construction in Inter Partes Review: Case Examples</i>. Abstracted Decisions:</p> <ul style="list-style-type: none"> ● <i>Straight Path</i>, 806 F.3d 1356; ● <i>PPC Broadband</i>, 815 F.3d 734; ● <i>PPC Broadband</i>, 815 F.3d 747. |
| <p>Day 2</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p> | <p>Inter Partes Review II: Claim Amendments and Procedural Fairness; Obviousness</p> | <p>File07, Donald Chisum, <i>Claim Amendments During Inter Partes Review</i>. Abstracted Decisions:</p> <ul style="list-style-type: none"> ● <i>Proxyconn</i>, 789 F.3d 1292; ● <i>Prolitec</i>, 807 F.3d 1353; ● <i>Synopsys</i>, 814 F.3d 1309; ● <i>Nike</i>, 812 F.3d 1326; ● <i>In re Aqua Prods., Inc.</i>, 823 F.3d 1369 (Fed. Cir. May 25, 2016), <i>vacated and reh’g en banc granted</i>, No. 2015-1177, 2016 WL 3007656, 118 USPQ2d 1776 (Fed. Cir. Aug. 12, 2016). <p>File08, Donald Chisum, <i>Procedural Fairness and Due Process in Inter Partes and Post-Grant Review</i>. Abstracted Decisions:</p> <ul style="list-style-type: none"> ● <i>Belden</i>, 805 F.3d 1064; ● <i>Ariosa Diagnostics</i>, 805 F.3d 1359; |

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| | | <ul style="list-style-type: none"> ● <i>Straight Path</i>, 806 F.3d 1356; ● <i>SightSound Technologies</i>, 809 F.3d 1307; ● <i>Redline Detection</i>, 811 F.3d 435; ● <i>Nike</i>, 812 F.3d 1326; ● <i>Dell</i>, 818 F.3d 1293; ● <i>Intelligent Bio-Systems</i>, 821 F.3d 1359; ● <i>SAS Institute</i>, No. 2015-1346, 2016 WL 3213103, 119 USPQ2d 1031; ● <i>Genzyme Therapeutic</i>, No. 2015–1720, 2016 WL 3254734, 119 USPQ2d 1022; ● <i>In re Magnum Oil Tools Int'l, Ltd.</i>, No. 2015-1300, 2016 WL 3974202 (Fed. Cir. July 25, 2016). <p>File09, Donald Chisum, <i>Cases on Obviousness: Comparing Inter Partes Review and District Court Litigation</i>. Abstracted Decisions:</p> <ul style="list-style-type: none"> ● <i>Circuit Check</i>, 795 F.3d 1331; ● <i>Allergan</i>, 796 F.3d 1293; ● <i>Belden</i>, 805 F.3d 1064; ● <i>MCM Portfolio</i>, 812 F.3d 1284; ● <i>SightSound Technologies</i>, 809 F.3d 1307; ● <i>Merck & Cie v. Gnosis</i>, 808 F.3d 829; ● <i>Redline Detection</i>, 811 F.3d 435; ● <i>Ethicon Endo-Surgery, Inc. v. Covidien</i>, 812 F.3d 1023; ● <i>TriVascular</i>, 812 F.3d 1056; ● <i>Shaw Industries</i>, 817 F.3d 1293; ● <i>Pride Mobility</i>, 818 F.3d 1307; ● <i>Intelligent Bio-Systems</i>, 821 F.3d 1359. |
| <p>Day 2</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p> | <p><i>Patent-Eligible Subject Matter: 2016 Federal Circuit Cases</i></p> | <p>File010, Donald Chisum, <i>Patent Eligible Subject Matter: 2016 Federal Circuit Cases</i>. Abstracted Decisions:</p> <ul style="list-style-type: none"> ● <i>Mortgage Grader</i>, 811 F.3d 1314; ● <i>Smith</i>, 815 F.3d 816; ● <i>Enfish</i>, 822 F.3d 1327; ● <i>TLI Comm.</i>, 823 F.3d 607; ● <i>Bascom</i>, 827 F.3d 1341; ● <i>Elec. Power Grp., LLC v. Alstom S.A.</i>, No. 2015-1778, 2016 WL 4073318 (Fed. Cir. Aug. 1, 2016); ● <i>McRO, Inc. v. Bandai Namco Games Am. Inc.</i>, No. 2015-1080, 2016 WL 4896481 (Fed. Cir. Sept. 13, 2016). |

