

SYLLABUS/TIMED AGENDA [File01 on USB drive]

**CHISUM PATENT ACADEMY®**

**Advanced Patent Law Small Group Seminar**

**February 21-22, 2019**

**Offices of Bracewell LLP**

**Houston, Texas**

**Instructors: Donald S. Chisum and Janice M. Mueller**

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Session	Topics	Cases and Materials for Discussion
<b>Day 1</b>  <b>Morning Session</b>  <b>9:00 am – 12:00 pm</b>	<b><i>Recent Blockbuster Supreme Court and Federal Circuit En Banc Cases</i></b>	<b>File02</b> , Donald Chisum, <i>Powerpoints on Blockbusters: Recent Supreme Court and Federal Circuit En Banc Decisions; Pending Cases:</i>  <b>Supreme Court Decisions:</b> <ul style="list-style-type: none"><li>• <i>SAS Inst. Inc. v. Iancu</i>, 138 S. Ct. 1348 (April 24, 2018) (Gorsuch, J.) (rejecting USPTO “partial institution” practice and holding that PTAB cannot institute IPR on less than all challenged patent claims);</li><li>• <i>Oil States Energy Services, LLC v. Greene’s Energy Group, LLC</i>, 138 S. Ct. 1365 (April 24, 2018) (Thomas, J.) (AIA-implemented post-grant review procedures do not violate Article III or Seventh Amendment of U.S. Constitution; patents are “public franchises”);</li><li>• <i>WesternGeco LLC v. ION Geophysical Corp.</i>, 138 S. Ct. 2129 (June 22, 2018) (Thomas, J.) (holding that foreign lost profits damages are available for export infringement under 35 U.S.C. §271(f));</li><li>• <i>Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc.</i>, 139 S. Ct. 628 (Jan. 22, 2019) (Thomas, J.) (holding that under 35 U.S.C. §102(b) (AIA version), the on-sale bar to patentability may be triggered by a sale in which the purchaser is required to keep the details of the invention confidential).</li></ul>

		<p><b>Federal Circuit <i>En Banc</i> Decisions:</b></p> <ul style="list-style-type: none"> <li>● <i>Wi-Fi One, LLC v. Broadcom Corp.</i>, 878 F.3d 1364 (Fed. Cir. Jan. 8, 2018) (<i>en banc</i>) (Reyna, J.) (PTAB’s §315 IPR time bar determinations are reviewable by Federal Circuit, overruling held that time-bar determinations were not exempt from judicial review, overruling <i>Achates Reference Publishing, Inc. v. Apple Inc.</i>, 803 F.3d 652 (Fed. Cir. 2015));</li> <li>● <i>Nantkwest, Inc. v. Iancu</i>, 898 F.3d 1177 (July 27, 2018) (<i>en banc</i>) (Stoll, J.) (holding that 35 U.S.C. §145’s “[a]ll the expenses of the proceedings shall be paid by the applicant” provision does <i>not</i> permit USPTO to collect attorney fees from §145 plaintiff, win or lose);</li> <li>● <i>Click-To-Call Techs., LP v. Ingenio, Inc., YellowPages.com, LLC</i>, 899 F.3d 1321, 1328 n.3 (Fed. Cir. Aug. 16, 2018) (holding as <i>en banc</i> court in footnote 3 of panel decision that 35 U.S.C. § 315(b)’s time bar <i>does</i> bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice).</li> </ul> <p><b>Federal Circuit <i>En Banc</i> Rehearing Denials:</b></p> <ul style="list-style-type: none"> <li>● <i>Berkheimer v. HP Inc.</i>, 890 F.3d 1369 (Fed. Cir. 2018) (<i>en banc</i> denial) (holding that in <i>Alice</i> step two inquiry for patent eligibility, to the extent it is at issue in a case, whether a claim element or combination is “well-understood, routine, and conventional” is a question of fact).</li> </ul>
<p><b>Day 1</b></p> <p><b>Afternoon Session</b></p> <p><b>1:00 pm – 4:00 pm</b></p>	<p><b>“Printed Publication: Prior Art/“Public Accessibility” Decisions</b></p>	<p><b>File03</b>, Janice Mueller, <i>PowerPoints on Printed Publication Prior Art—What Counts as Publicly Accessible?</i> 2018 Federal Circuit cases analyzed:</p> <ul style="list-style-type: none"> <li>● <i>Medtronic, Inc. v. Barry</i>, 891 F.3d 1368 (Fed. Cir. June 11, 2018) (Chen, J.) (video demonstration and related slide presentation to spinal surgeons at industry meetings and conferences);</li> <li>● <i>Jazz Pharm., Inc. v. Amneal Pharm., LLC</i>, 895 F.3d 1347 (Fed. Cir. July 13, 2018) (Lourie, J.) (FDA Advisory Committee Art materials, published on FDA’s website and referenced in Federal Register prior to advisory committee meeting);</li> <li>● <i>In re Power Integrations, Inc.</i>, 899 F.3d 1316 (Fed. Cir. Aug. 16, 2018) (Bryson, J.) (denying petition for writ of mandamus to PTAB; refusing to consider on merits Board’s non-institution decision that certain documents were not prior art);</li> <li>● <i>Nobel Biocare Servs. AG v. Intradent USA, Inc.</i>, 903 F.3d 1365 (Fed. Cir. Sept. 13, 2018) (Lourie, J.) (catalog distributed at dental industry trade show);</li> <li>● <i>GoPro, Inc. v. Contour IP Holding LLC</i>, 908 F.3d 690 (Fed. Cir. Nov. 1, 2018) (Reyna, J.) (catalog distributed at annual dealer trade show focused on action sports, which had</li> </ul>

		<p>approximately 150 vendors and more than 1,000 attendees, including actual and potential dealers, retailers, and customers of portable point-of-view video cameras);</p> <ul style="list-style-type: none"> <li>• <i>Acceleration Bay, LLC v. Activision Blizzard Inc.</i>, 908 F.3d 765 (Fed. Cir. Nov. 6, 2018) (Moore, J.) (technical article/report had been uploaded to website as of critical date, but not indexed or searchable in a meaningful way).</li> </ul>
<p><b>Day 2</b></p> <p><b>Morning Session</b></p> <p><b>9:00 am – 12:00 pm</b></p>	<p><b>Patent Enforcement &amp; Defenses in Litigation.</b></p>	<p><b>File04</b>, Donald Chisum, <i>PowerPoints on Patent Enforcement Topics</i>. Cases analyzed:</p> <ul style="list-style-type: none"> <li>• <i>Vanda Pharms. Inc. v. West-Ward Pharms. Int'l Ltd.</i>, 887 F.3d 1117 (Fed. Cir. 2018) (active inducement of method claims);</li> <li>• <i>Texas Advanced Optoelectronic Solutions., Inc. v. Renesas Elecs. Am., Inc.</i>, 888 F.3d 1322 (Fed. Cir. 2018) (infringement of method and apparatus claims, extraterritorial sales, intersection of patents and trade secret protection and the jury trial right);</li> <li>• <i>SimpleAir, Inc. v. Google LLC</i>, 884 F.3d 1160 (Fed. Cir. 2018) (claim preclusion (res judicata));</li> <li>• <i>Arcelormittal Atlantique et Lorraine v. AK Steel Corp.</i>, 908 F.3d 1267 (Fed. Cir. Nov. 14, 2018) (issue preclusion (collateral estoppel));</li> <li>• <i>Gust, Inc. v. AlphaCap Ventures, LLC</i>, 905 F.3d 1321 (Fed. Cir. 2018) (unreasonable continuation of litigation; fees awards against law firm).</li> </ul>
<p><b>Day 2</b></p> <p><b>Afternoon Session</b></p> <p><b>1:00 pm – 4:00 pm</b></p>	<p><b>Section 101 Patent-Eligible Subject Matter:</b></p> <p><b>2018 Federal Circuit Cases</b></p>	<p><b>File05</b>, Donald Chisum, <i>PowerPoints on Section 101: Is there a Common Theme in Decisions Finding Claims Patent-Eligible?</i> Selected 2018 Cases:</p> <ul style="list-style-type: none"> <li>• <i>Vanda Pharms. Inc. v. West-Ward Pharms. Int'l Ltd.</i>, 887 F.3d 1117 (Fed. Cir. 2018);</li> <li>• <i>Roche Molecular Sys., Inc. v. Cepheid</i>, 905 F.3d 1363 (Fed. Cir. 2018);</li> <li>• <i>Aatrix Software, Inc. v. Green Shades Software, Inc.</i>, 890 F.3d 1354 (Fed. Cir. 2018) (en banc) (MOORE, Dyk, O'Malley, Taranto &amp; Stoll, concurring in denial of rehearing en banc; LOURIE &amp; Newman, concurring in denial of rehearing en banc; REYNA, dissenting from denial of rehearing en banc);</li> <li>• <i>SAP Am., Inc. v. InvestPic, LLC</i>, 898 F.3d 1161 (Fed. Cir. 2018);</li> <li>• <i>Data Engine Techs. LLC v. Google LLC</i>, 906 F.3d 999 (Fed. Cir. 2018);</li> <li>• <i>Ancora Techs., Inc. v. HTC America, Inc.</i>, 908 F.3d 1343 (Fed. Cir. 2018).</li> </ul> <p><b>File06:</b> Representative Claims for Section 101 Cases.</p>