

SYLLABUS/TIMED AGENDA [File01 on USB drive]

CHISUM PATENT ACADEMY®

Advanced Patent Law Small Group Seminar

March 5-6, 2018

Offices of Bracewell LLP

Houston, Texas

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Session	Topics	Cases and Materials for Discussion
Day 1 Morning Session 9:00 am – 12:00 pm	Recent Blockbuster Supreme Court and Federal Circuit En Banc Cases	File02 , Donald Chisum, <i>Powerpoints on Blockbusters: Recent Supreme Court and Federal Circuit En Banc Decisions; Pending Cases:</i> Supreme Court Decisions: <ul style="list-style-type: none">• <i>TC Heartland LLC v. Kraft Food Brands Grp. LLC</i>, 137 S. Ct. 1514 (May 22, 2017) (venue);• <i>Impression Prods., Inc. v. Lexmark Int'l, Inc.</i>, 137 S. Ct. 1523 (May 30, 2017) (conditional sales; international exhaustion); Certiorari Grants: <ul style="list-style-type: none">• <i>SAS Inst. Inc. v. Lee</i>, 137 S. Ct. 2160 (May 22, 2017) (granting <i>certiorari</i> to consider whether PTAB can institute IPR on less than all challenged claims);• <i>Oil States Energy Services, LLC v. Greene's Energy Group, LLC</i>, 137 S. Ct. 2239 (June 12, 2017) (granting <i>certiorari</i> to review Constitutionality of AIA-implemented post-grant review procedures);• <i>WesternGeco LLC v. ION Geophysical Corp.</i>, 138 S. Ct. 734 (Jan. 12, 2018) (granting <i>certiorari</i> to determine whether foreign lost profits damages are available for export infringement under 35 U.S.C. §271(f)).

		<p>Federal Circuit <i>En Banc</i> Decisions:</p> <ul style="list-style-type: none"> • <i>Aqua Prods., Inc. v. Matal</i>, 872 F.3d 1290 (Fed. Cir. Oct. 4, 2017) (<i>en banc</i>) (burdens of proof and production in IPR motions to amend claims) (also discussed in IPR session below); • <i>Wi-Fi One, LLC v. Broadcom Corp.</i>, 878 F.3d 1364 (Fed. Cir. Jan. 8, 2018) (<i>en banc</i>) (PTAB’s §315 IPR time bar determinations <i>are</i> reviewable by Federal Circuit). <p>Federal Circuit <i>En Banc</i> Rehearing Grants:</p> <ul style="list-style-type: none"> • <i>Nantkwest, Inc. v. Matal</i>, 869 F.3d 1327 (Fed. Cir. Aug. 31, 2017) (order granting sua sponte <i>en banc</i> consideration and vacating panel decision, <i>Nantkwest, Inc. v. Matal</i>, 860 F.3d 1352 (Fed. Cir. June 23, 2017) (Prost, C.J.) (holding USPTO was entitled to its attorney fees as part of Section 145’s “[a]ll the expenses of the proceedings shall be paid by the applicant” mandate)).
<p>Day 1</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p>	<p>“Exceptional” Cases and Attorney Fee Awards post-Octane/Highmark (U.S. 2014)</p>	<p>File03, Janice Mueller, <i>Powerpoints on Exceptional Case and Attorney Fee Awards under Section 285, Post-Octane/Highmark</i>. Recent cases analyzed:</p> <p>2017 Defendant-Favorable Decisions:</p> <ul style="list-style-type: none"> • <i>Inventor Holdings, LLC v. Bed Bath & Beyond</i>, 876 F.3d 1372 (Fed. Cir. Dec. 8, 2017) (Chen, J.) (affirming District of Delaware’s award of attorney fees to defendant as of date Supreme Court issued <i>Alice</i> §101 decision); • <i>Nova Chems. Corp. (Canada) v. Dow Chem. Co.</i>, 856 F.3d 12012 (Fed. Cir. May 11, 2017) (Prost, C.J.) (affirming District of Delaware’s award to defendant of \$2.5 million in attorney fees); • <i>Bayer CropScience AG v. Dow AgroSciences LLC</i>, 851 F.3d 1302 (Fed. Cir. Mar. 17, 2017) (Stoll, J.) (affirming District of Delaware’s award of attorney fees to defendant); • <i>AdjustaCam, LLC v. Newegg, Inc.</i>, 861 F.3d 1353 (Fed. Cir. July 5, 2017) (Reyna, J.) (reversing E.D. Tex. (Gilstrap, J.)’s denial of defendant’s motion for attorney fees); • <i>Rothschild Connected Devices Innovations, LLC v. Guardian Protection Servs., Inc.</i>, 858 F.3d 1383 (Fed. Cir. June 5, 2017) (Wallach, J.) (reversing E.D. Tex. (Payne, M.J.)’s denial of defendant’s s request for attorney fees); • <i>Romag Fasteners, Inc. v. Fossil, Inc.</i>, 866 F.3d 1330 (Fed. Cir. Aug. 9, 2017) (Dyk, J.) (vacating District of Connecticut’s grant of attorney fees to patentee based on district court’s “several errors” and remanding case for consideration of attorney fees under Patent Act (as well as Lanham Act) “under the correct standard”).

		<p>2017 Patentee-Favorable Decisions:</p> <ul style="list-style-type: none"> ● <i>Checkpoint Sys., Inc. v. All-Tag Security S.A.</i>, 858 F.3d 1371, 1376-1377 (Fed. Cir. June 5, 2017) (Newman, J.) (reversing Eastern District of Pennsylvania’s award of approximately \$10.3 million in attorney fees, costs, and interest to defendant; record showed patentee’s charge of infringement “was reasonable and the litigation was not brought in bad faith or with abusive tactics.”); ● <i>Univ. of Utah v. Max-Planck-Gesellschaft zur Foerderung der Wissenschaften e.V.</i>, 851 F.3d 1317 (Fed. Cir. Mar. 23, 2017) (Reyna, J.) (affirming District of Massachusetts’ denial of attorney fees to defendant in §256 inventorship action; case was not “exceptional” and district court did not abuse its discretion in denying fee-shifting). <p>2017 Other Decisions Relating to Attorney Fees:</p> <ul style="list-style-type: none"> ● <i>Nantkwest, Inc. v. Matal</i>, 869 F.3d 1327 (Fed. Cir. Aug. 31, 2017) (ordering sua sponte consideration <i>en banc</i> and vacating panel decision reported at 860 F.3d 1352 (Fed. Cir. June 23, 2017) (Prost, C.J.) (panel majority holding USPTO entitled to its attorney fees under the “[a]ll the expenses of the proceedings shall be paid by the applicant” mandate of 35 U.S.C. §145, whether or not USPTO prevailed)); ● <i>AIA America, Inc. v. Avid Radiopharmaceuticals</i>, 866 F.3d 1369 (Fed. Cir. Aug. 10, 2017) (Hughes, J.) (applying the two-part test of <i>Tull v. United States</i>, 481 U.S. 412, 417-418 (1987) to hold that requests for attorney fees under 35 U.S.C. §285, despite seeking monetary relief, are equitable rather than legal, and thus they do not invoke the Seventh Amendment right to a jury trial).
<p>Day 2</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p>	<p>Claim Definiteness; Anticipation.</p>	<p>File04, Donald Chisum, <i>Powerpoints on Claim Definiteness</i>. Cases analyzed:</p> <ul style="list-style-type: none"> ● <i>Sonix Technology Co., Ltd. v. Publications International, Ltd.</i>, 844 F.3d 1370 (Fed. Cir. 2017); ● <i>Eli Lilly & Co. v. Teva Parenteral Medicines, Inc.</i>, 845 F.3d 1357 (Fed. Cir. 2017); ● <i>Tinnus Enterprises, LLC. v. Telebrands Corp.</i>, 846 F.3d 1190 (Fed. Cir. 2017); ● <i>Mentor Graphics Corp. v. EVA-USA, Inc.</i>, 851 F.3d 1275 (Fed. Cir. 2017); ● <i>Mylan Institutional LLC v. Aurobindo Pharma Ltd.</i>, 857 F.3d 858 (Fed. Cir. 2017); ● <i>One-E-Way, Inc. v. U.S. Int’l Trade Comm’n</i>, 859 F.3d 1059 (Fed. Cir. 2017); ● <i>Mastermine Software, Inc. v. Microsoft Corp.</i>, 874 F.3d 1307 (Fed. Cir. 2017); ● <i>BASF Corp. v. Johnson Matthey Inc.</i>, 875 F.3d 1360 (Fed. Cir. 2017); ● <i>Presidio Components, Inc. v. American Technical Ceramics Corp.</i>, 875 F.3d 1369 (Fed. Cir. 2017).

		<p>File05, Donald Chisum, <i>Powerpoints on Anticipation</i>. Cases analyzed:</p> <ul style="list-style-type: none"> ● <i>In re Petering</i>, 301 F.2d 676 (C.C.P.A. 1962); ● <i>Perricone v. Medicis Pharm. Corp.</i>, 432 F.3d 1368 (Fed. Cir. 2005); ● <i>Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.</i>, 471 F.3d 1369, 1375 (Fed. Cir. 2006); ● <i>Net MoneyIN, Inc. v. VeriSign, Inc.</i>, 545 F.3d 1359, 1371 (Fed. Cir. 2008); ● <i>Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC</i>, 683 F.3d 1356 (Fed. Cir. 2012); ● <i>Kennametal, Inc. v. Ingersoll Cutting Tool Co.</i>, 780 F.3d 1376 (Fed. Cir. 2015); ● <i>Blue Calypso, LLC v. Groupon, Inc.</i>, 815 F.3d 1331 (Fed. Cir. 2016); ● <i>Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co., Ltd.</i>, 851 F.3d 1270 (Fed. Cir. 2017).
<p>Day 2 Afternoon Session 1:00 pm – 4:00 pm</p>	<p>Patent-Eligible Subject Matter: 2017-2018 Federal Circuit Cases</p>	<p>File06, Donald Chisum, <i>Powerpoints on Section 101: Is there a Common Theme in Decisions Finding Claims Patent-Eligible?</i></p> <p>Selected 2017-2018 Cases:</p> <ul style="list-style-type: none"> ● <i>Enfish, LLC v. Microsoft Corp.</i>, 822 F.3d 1327 (Fed. Cir. 2016); ● <i>Thales Visionix Inc. v. United States</i>, 850 F.3d 1315 (Fed. Cir. 2017); ● <i>Visual Memory LLC v. NVIDIA Corp.</i>, 867 F.3d 1253 (Fed. Cir. 2017); ● <i>Finjan, Inc. v. Blue Coat Sys., Inc.</i>, 879 F.3d 1299 (Fed. Cir. January 10, 2018); ● <i>Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.</i>, 880 F.3d 1356 (Fed. Cir. Jan. 25, 2018); ● <i>Berkheimer v. HP, Inc.</i>, 881 F.3d 1360 (Fed. Cir. Feb. 8, 2018) (fact questions in step 2 of Alice analysis precluded summary judgment of 101 invalidity); ● <i>Aatrix Software, Inc. v. Green Shades Software, Inc.</i>, -- F.3d --, 2018 WL 843288 (Fed. Cir. Feb. 14, 2018) (vacating R12(b)(6) dismissal; district court can dismiss on pleadings only if no factual allegations prevent resolving eligibility as legal question). <p>File07: Representative Claims for Section 101 Cases.</p>