

SYLLABUS [File01 on USB drive]

CHISUM PATENT ACADEMY®

Advanced Patent Law Seminar

August 12-14, 2015

Mayflower Park Hotel

Seattle, Washington

Instructors: Donald S. Chisum and Janice M. Mueller

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	Recent Blockbuster Supreme Court and Federal Circuit En Banc Cases	File02 , Donald Chisum, <i>Abstracts of Recent Blockbuster Supreme Court and Federal Circuit Decisions</i> . Abstracted decisions: <ul style="list-style-type: none">• <i>Teva Pharms. USA, Inc. v. Sandoz, Inc.</i>, 135 S. Ct. 831 (2015) (claim construction; standard of appellate review);• <i>B&B Hardware, Inc. v. Hargis Indus., Inc.</i>, 135 S. Ct. 1293 (2015) (preclusive effect of PTO Board decisions in court litigation between parties);• <i>Commil USA, LLC v. Cisco Sys., Inc.</i>, 135 S. Ct. 1920 (2015) (discussed in "Active Inducement" outline);• <i>Kimble v. Marvel Entertainment, LLC</i>, 135 S. Ct. 2401 (2015) (post-expiration royalties; stare decisis; no basis for overruling <i>Brulotte</i> (1964));• <i>SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC</i>, No. 2013–1564, 2014 WL 7460970 (Fed. Cir. Dec. 30, 2014) (<i>en banc</i>),	<i>Passim</i>

		<p><i>vacating</i>, 767 F.3d 1339 (Fed. Cir. 2014) (pending <i>en banc</i> questions: effect of Supreme Court <i>Petrella</i> decision (2014) abolishing laches defense in copyright damage claims on patent infringement damage claims);</p> <ul style="list-style-type: none"> • <i>Halo Elecs., Inc. v. Pulse Elecs., Inc.</i>, 769 F.3d 1371 (Fed. Cir. 2014), <i>rehearing en banc denied</i>, 2015 U.S. App. LEXIS 4696 (Fed. Cir. 2015) (willful infringement; effect of Supreme Court's <i>Highmark</i> and <i>Octane Fitness</i> decisions on "exceptional case" standard for attorney fee awards); • <i>Lexmark Int'l, Inc. v. Impression Prods., Inc.</i>, 785 F.3d 565 (Fed. Cir. 2015) (<i>en banc</i> order) (discussed in "Exhaustion" outline below); • <i>Williamson v. Citrix Online LLC</i> (Fed. Cir. June 16, 2015) (Part II.C.1 <i>en banc</i>) (presumption that phrase not using word "means" is not a Section 112/6 clause; not "heightened"; functional claiming); • <i>In re Cuozzo Speed Techs., LLC</i> (Fed. Cir. July 8, 2015), <i>rehearing en banc denied</i> (Fed. Cir. July 8, 2015) (broadest reasonable interpretation; finality of PTAB IPR initiation decision; restriction on claim amendments). 	
<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>File03, Janice Mueller, PowerPoints on “Patents Claims: Interpretation and Definiteness”;</p> <p>File04, <i>Teva Pharms. USA, Inc. v. Sandoz, Inc.</i>, 135 S. Ct. 831 (Jan. 20, 2015) (patent claim construction standards of review);</p> <p>File05, <i>Teva Pharms. USA, Inc. v. Sandoz, Inc.</i>, 789 F.3d 1335 (Fed. Cir. June 18, 2015) (on remand from S. Ct.);</p> <p>File06, <i>Lighting Ballast Control LLC v. Philips Electronics N. Am. Corp.</i>, 790 F.3d 1329 (Fed. Cir. June 23, 2015) (on remand from S. Ct. GVR order);</p> <p>File07, <i>In re Papst Licensing Digital Camera Patent Litig.</i>, 778 F.3d 1255 (Fed. Cir. 2015) (post-<i>Teva</i> claim construction);</p> <p>File08, <i>Fenner Investments, Ltd. v. Cellco P’shp (dba Verizon Wireless)</i>, 778 F.3d 1320 (Fed. Cir. 2015) (post-<i>Teva</i> claim construction);</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>

		<p>File09, <i>Pacing Techs., LLC v. Garmin Int'l</i>, 778 F.3d 1021 (Fed. Cir. 2015) (post-<i>Teva</i> claim construction);</p> <p>File010, <i>Nautilus, Inc. v. Biosig Instruments, Inc.</i>, 134 S. Ct. 2120 (2014) (35 U.S.C. §112(b) claim definiteness requirement);</p> <p>File011, <i>Biosig Instruments, Inc. v. Nautilus, Inc.</i>, 783 F.3d 1374 (Fed. Cir. Apr. 27, 2015) (on remand from S. Ct.);</p> <p>File012, <i>Interval Licensing LLC v. AOL, Inc.</i>, 766 F.3d 1364 (Fed. Cir. Sept. 10, 2014) (post-<i>Nautilus</i>, affirming district court’s invalidation of patent claims for indefiniteness);</p> <p>File013, <i>In re Packard</i>, 751 F.3d 1307 (Fed. Cir. 2014) (definiteness standard in USPTO).</p>	
<p>Day 2</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p>	<p>Section 101 Patent Eligible Subject Matter: Federal Circuit Decisions Since Alice</p>	<p>File014, Donald Chisum, <i>Abstracts of Federal Circuit Decisions Concerning Patent Eligible Subject Matter Since Alice</i>. Abstracted decisions:</p> <ul style="list-style-type: none"> ● <i>Digitech Image Techs., LLC v. Electronics for Imaging, Inc.</i>, 758 F.3d 1344 (Fed. Cir. 2014); ● <i>BuySAFE, Inc. v. Google Inc.</i>, 765 F.3d 1350 (Fed. Cir. 2014); ● <i>Ultramercial, Inc. v. Hulu, LLC</i>, 772 F.3d 709 (Fed. Cir. 2014); ● <i>DDR Holdings, LLC v. Hotels.com, L.P.</i>, 773 F.3d 1245 (Fed. Cir. 2014); ● <i>Content Extraction & Transmission LLC v. Wells Fargo Bank</i>, 776 F.3d 1343 (Fed. Cir. 2014); ● <i>OIP Techs., Inc. v. Amazon.com, Inc.</i>, 788 F.3d 1359 (Fed. Cir. 2015); ● <i>Internet Patents Corp. v. Active Network, Inc.</i> (Fed. Cir. June 23, 2015); ● <i>Intellectual Ventures I LLC v. Capital One Bank (USA)</i>, No. 2014–1506, 2015 WL 4068798 (Fed. Cir. July 6, 2015); ● <i>Versata Development Group, Inc. v. SAP America, Inc.</i>, No. 2014–1194, 2015 WL 4113722 (Fed. Cir. July 9, 2015); ● <i>In re BRCA1- & BRCA2- Based Hereditary Cancer Test Patent</i> 	<p>Chapter 7 (“Potentially Patentable Subject Matter (35 U.S.C. §101)”).</p>

		<p><i>Litigation</i>, 774 F.3d 755 (Fed. Cir. 2014);</p> <ul style="list-style-type: none"> • <i>Ariosa Diagnostics, Inc. v. Sequenom, Inc.</i>, 788 F.3d 1371 (Fed. Cir. 2015). 	
<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>File015, Janice Mueller, PowerPoints on <i>Inter Partes</i> Review;</p> <p>File016, <i>Covidien LP v. Ethicon Endo-Surgery, Inc.</i>, Case IPR2013-00209 (PTAB June 9, 2014) (Final Written Decision);</p> <p>File017, Petition for IPR by Covidien (Mar. 25, 2013);</p> <p>File018, Response by Patentee Ethicon (Nov. 19, 2013);</p> <p>File019, Ethicon’s USP 8,317,070 (issued Nov. 27, 2013);</p> <p>File020, <i>In re Cuozzo Speed Techs., LLC</i>, No. 2014-1301, 2015 WL 448667 (Fed. Cir. Feb. 4, 2015) (Dyk, J.) (withdrawn and superseded by July 8 opinion);</p> <p>File021, <i>In re Cuozzo Speed Techs., LLC</i>, No. 2014-1301, 2015 WL 4097949 (Fed. Cir. July 8, 2015) (Dyk, J.) (revised panel opinion) (affirming PTAB’s application of broadest reasonable claim interpretation rule in IPRs; finding no CAFC jurisdiction to review PTAB institution decision);</p> <p>File022, <i>In re Cuozzo Speed Techs., LLC</i>, No. 2014-1301, 2015 WL 4100060 (Fed. Cir. July 8, 2015) (order denying reh’g <i>en banc</i>; concurring opinion by Dyk, J; dissenting opinion by Prost, C.J.; dissenting opinion by Newman, J.);</p> <p>File023, <i>Microsoft Corp. v. Proxyconn, Inc.</i>, 789 F.3d 1292 (Fed. Cir. June 16, 2015) (first reversal of PTAB in an IPR based on erroneous claim construction under “broadest reasonable construction” standard).</p>	<p>Chapter 8[E] (“AIA-Implemented Procedures for Challenging Issued Patents”).</p>

<p>Day 3</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p>	<p>Method and System Claims: Active Inducement</p>	<p>File024, Donald Chisum, <i>Method and System Claims: Active Inducement</i>. Abstracted decisions:</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); ● <i>DSU Med. Corp. v. JMS Co., Ltd.</i>, 471 F.3d 1293 (Fed. Cir. 2006) (<i>en banc</i> as to "Section III.b": En Banc "Resolution of Conflicting Precedent"; Required intent: induce specific acts? Or additionally to cause an infringement?); ● <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 Sys., Inc.</i>, 135 S. Ct. 1920 (2015) (good faith belief in invalidity not a defense); ● <i>Limelight Networks, Inc. v. Akamai Techs., Inc.</i>, 134 S. Ct. 2111 (2014) (divided infringement; no inducement absent direct infringement); ● <i>Akamai Techs., Inc. v. Limelight Networks, Inc.</i>, 786 F.3d 899 (Fed. Cir. 2015) (on remand; no "joint tortfeasor" theory for determining direct infringement of method claim performed by two actors; only agency, contract or joint enterprise theories); ● <i>Advanced Software Design Corp. v. Fiserv, Inc.</i>, 641 F.3d 1368 (Fed. Cir. 2011) (steps by single actor; steps recited in preamble: only "claim environment"); ● <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 Comm., Inc. v. Nokia Corp.</i>, 739 F.3d 1339 (Fed. Cir. 2014) (hardware and software required to carry out claimed functions of apparatus (CPU); no infringement by accused device with hardware capacity but lacking software for carrying out function); ● <i>Ericsson, Inc. v. D-Link Sys., Inc.</i>, 773 F.3d 1201 (Fed. Cir. 2014) (system claims with "capabilities", not active or enabled software; method claims; actual performance; active inducement). 	<p>Chapter 9[E] ("Aspects of Infringement Beyond 35 U.S.C. §271(a)").</p>
--	---	---	---

<p>Day 3</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p>	<p><i>Patent Exhaustion</i></p>	<p>File025, Donald Chisum, <i>Abstracts of Patent Exhaustion Cases</i>. Abstracted decisions:</p> <ul style="list-style-type: none"> ● <i>Quanta Computer, Inc. v. LG Elecs., Inc.</i>, 553 U.S. 617 (2008); ● <i>Bowman v. Monsanto Co.</i>, 133 S. Ct. 1761 (2013); ● <i>Keurig, Inc. v. Sturm Foods, Inc.</i>, 732 F.3d 1370 (Fed. Cir. 2013); ● <i>Lifescan Scotland, Ltd. v. Shasta Techs., LLC</i>, 734 F.3d 1361 (Fed. Cir. 2013); ● <i>Helferich Patent Licensing, LLC v. New York Times Co.</i>, 778 F.3d 1293 (Fed. Cir. Feb. 10, 2015); ● <i>Lexmark Int’l, Inc. v. Impression Prods., Inc.</i>, 785 F.3d 565 (Fed. Cir. 2015) (<i>en banc</i> order); ● <i>Mallinckrodt, Inc. v. Medipart, Inc.</i>, 976 F.2d 700 (Fed. Cir. 1992); ● <i>Kendall Co. v. Progressive Med. Tech., Inc.</i>, 85 F.3d 1570 (Fed. Cir. 1996); ● <i>Princo Corp. v. U.S. Int’l Trade Comm’n</i>, 616 F.3d 1318 (Fed. Cir. 2010) (<i>en banc</i>); ● <i>Jazz Photo Corp. v. International Trade Comm’n</i>, 264 F.3d 1094 (Fed. Cir. 2001); ● <i>Kirtsaeng v. John Wiley & Sons, Inc.</i>, 133 S. Ct. 1351 (2013); ● <i>Lexmark Int’l, Inc. v. Static Control Components Inc.</i>, 134 S. Ct. 1377 (2014). 	<p>Chapter 10[C][8] (“Patent Exhaustion”).</p>
---	--	--	--