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CHISUM PATENT ACADEMY®

Advanced Patent Law Seminar

March 10-11, 2016

21C Museum Hotel

Cincinnati, Ohio

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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>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) (active inducement; belief in invalidity: not defense);• <i>Kimble v. Marvel Entertainment, LLC</i>, 135 S. Ct. 2401 (2015) (post-expiration royalties; stare decisis; no basis for overruling <i>Brulotte</i> (U.S. 1964));• <i>In re Cuozzo Speed Techs., LLC</i>, 793 F.3d 1268 (Fed. Cir. 2015), <i>revising prior panel opinion</i>, 778 F.3d 1271 (Fed. Cir., 2015), <i>reh'g en banc denied</i>, 2015 U.S. App. LEXIS 11716 (Fed. Cir. 2015), <i>cert. granted sub nom.</i> <i>Cuozzo Speed Techs., LLC v. Lee</i>, No. 15-446, 2016 WL 205946 (U.S. Jan. 15, 2016) (discussed in "Inter Partes Review" outline and session);• <i>Halo Elecs., Inc. v. Pulse Elecs., Inc.</i>, 769 F.3d 1371 (Fed. Cir. 2014), <i>cert. granted</i>, 136 S. Ct. 356 (Oct. 19, 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>Stryker Corp. v. Zimmer Inc.</i>, 774 F.3d 1349 (Fed. Cir. 2014), <i>revised opinion on rehearing</i>, 782

		<p>F.3d 649 (Fed. Cir. 2015), <i>cert. granted</i>, 136 S. Ct. 356 (Oct. 19, 2015);</p> <ul style="list-style-type: none"> ● <i>Carnegie Mellon University v. Marvell Tech. Group, Ltd.</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, 2015 U.S. App. LEXIS 20233 (Fed. Cir., Nov. 17, 2015) (willful infringement, enhanced damages); ● <i>Williamson v. Citrix Online LLC</i>, 792 F.3d 1339 (Fed. Cir. 2015) (Part II.C.1 <i>en banc</i>) (means plus function clauses); ● <i>SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC</i>, 807 F.3d 1311 (Fed. Cir. 2015) (<i>en banc</i>) (survival of patent laches defense despite Supreme Court’s 2014 <i>Petrella</i> copyright decision); ● <i>Akamai Techs., Inc. v. Limelight Networks, Inc.</i>, ., 797 F.3d 1020 (Fed. Cir. 2015) (<i>en banc</i>) (expanding “directs or controls” standard for direct divided infringement liability); ● <i>Suprema, Inc. v. Mentalix Inc.</i>, 796 F.3d 1338 (Fed. Cir. 2015) (<i>en banc</i>); ● <i>Ariosa Diagnostics, Inc. v. Sequenom, Inc.</i>, 788 F.3d 1371 (Fed. Cir. 2015), <i>rehearing en banc denied</i>, 809 F.3d 1282 (Dec. 2, 2015) (LOURIE & Moore, concurring; DYK, concurring in denial of en banc rehearing; NEWMAN, dissenting) (Section 101 exclusion of natural phenomenon); ● <i>Medicines Company v. Hospira, Inc.</i>, 791 F.3d 1368 (Fed. Cir. 2015), <i>vacated & rehearing en banc granted</i>, 805 F.3d 1357 (Nov. 13, 2015) (on sale bar; supplier exception; sale of “services”); ● <i>Lexmark Int’l, Inc. v. Impression Prods., Inc.</i>, Nos. 2014-1617, 2014-1619, 2016 U.S. App. LEXIS 2452 (Fed. Cir. Feb. 12, 2016) (<i>en banc</i>) (discussed in "Exhaustion" outline and session).
<p>Day 1</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p>	<p><i>Inter Partes Review I: Case Study, Claim Interpretation and Amendment, Burdens of Proof, Procedural Traps</i></p>	<p>File03, Janice Mueller, PowerPoints on <i>Inter Partes</i> Review;</p> <p>File04, <i>Covidien LP v. Ethicon Endo-Surgery, Inc.</i>, Case IPR2013-00209 (PTAB June 9, 2014) (Final Written Decision);</p> <p>File05, <i>Ethicon Endo-Surgery, Inc. v. Covidien LP</i>, No. 2014-1771, 2016 WL 145576 (Fed. Cir. Jan. 13, 2016) (affirming PTAB decision finding Ethicon’s claims unpatentable as obvious);</p> <p>File06, Petition for IPR by Covidien (Mar. 25, 2013);</p> <p>File07, Response by Patentee Ethicon (Nov. 19, 2013);</p> <p>File08, <i>In re Cuozzo Speed Techs., LLC</i>, No. 2014-1301, 2015 WL 448667 (Fed. Cir. Feb. 4, 2015)</p>

(Dyk, J.) (withdrawn and superseded by July 8 opinion);

File09, *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268 (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);

File010, *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1297 (Fed. Cir. July 8, 2015) (order denying reh'g *en banc*; concurring opinion by Dyk, J.; dissenting opinion by Prost, C.J.; dissenting opinion by Newman, J.);

File011, *Cuozzo Speed Techs., LLC v. Lee*, No. 15-446, 2016 WL 205946 (U.S. Jan. 15, 2016) (order granting *certiorari*);

File012, *Microsoft Corp. v. Proxyconn, Inc.*, 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);

File013, *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, No. 2015-1214, 2015 WL 5166366 (Fed. Cir. Sept. 4, 2015) (affirming PTAB determination that petitioner had *not* carried burden of showing challenged claims unpatentable as anticipated under 35 U.S.C. §102(e) (2006); burdens of production and persuasion in IPRs);

File014, *Nike, Inc. v. Adidas AG*, No. 2014-1719, 2016 WL 537609 (Fed. Cir. Feb. 11, 2016) (Vacating PTAB's obviousness determination in IPR; discussing patentee's burden to show patentability of proposed substitute claims; Board's obligation to consider secondary considerations evidence);

File015, Donald S. Chisum, *Abstracts of Recent Federal Circuit Cases on Inter Partes Review*. Abstracted decisions include those cited above plus:

- *Prolitec, Inc. v. ScentAir Technologies, Inc.*, 807 F.3d 1353 (Fed. Cir. 2015) (amendment; burden to show patentability over prior art cited in original prosecution);
- *Synopsys Inc. v. Mentor Graphics Corp.*, 2016 U.S. App. LEXIS 2250 (Fed. Cir. 2016) (institution on fewer than all claims);
- *Convolve, Inc. v. Compaq Computer Corp.*, 2016 U.S. App. LEXIS 2266 (Fed. Cir. 2016) (intervening rights; claim amendment)

<p>Day 2</p> <p>Morning Session</p> <p>9:00 am – 12:00 pm</p>	<p><i>Inter Partes Review II: Obviousness—Comparing IPR with District Court Litigation</i></p>	<p>File016, Donald Chisum, <i>Abstracts of Federal Circuit Decisions Concerning Obviousness in IPRs and Federal District Court</i>. Abstracted decisions:</p> <ul style="list-style-type: none"> ● <i>Circuit Check Inc. v. QXQ Inc.</i>, 795 F.3d 1331 (Fed. Cir. 2015); ● <i>Allergan, Inc. v. Sandoz Inc.</i>, 796 F.3d 1293 (Fed. Cir. 2015); ● <i>Belden Inc. v. Berk-Tek LLC</i>, 805 F.3d 1064 (Fed. Cir. 2015); ● <i>Straight Path IP Group, Inc. v. Sipnet EU S.R.O.</i>, 806 F.3d 1356 (Fed. Cir. 2015) (remand; claim construction error); ● <i>MCM Portfolio LLC v. Hewlett-Packard Co.</i>, 2015 U.S. App. LEXIS 20848 (Fed. Cir. 2015); ● <i>SightSound Techs., LLC v. Apple Inc.</i>, 809 F.3d 1307 (Fed. Cir. 2015); ● <i>Merck & Cie v. Gnosis S.p.A.</i>, 808 F.3d 829 (Fed. Cir. 2015) (first IPR invalidating pharma patent); ● <i>Redline Detection, LLC v. Star Envirotech, Inc.</i>, 2015 U.S. App. LEXIS 22897 (Fed. Cir. 2015).
<p>Day 2</p> <p>Afternoon Session</p> <p>1:00 pm – 4:00 pm</p>	<p><i>“Exhaustion”</i></p>	<p>File017, Donald Chisum, <i>Recent Supreme Court and Federal Circuit Cases on Exhaustion Defense to Infringement</i>. Abstracted decisions:</p> <ul style="list-style-type: none"> ● <i>Quanta Computer, Inc. v. LG Electronics, Inc.</i>, 553 U.S. 617 (2008); ● <i>Kirtsaeng v. John Wiley & Sons, Inc.</i>, 133 S. Ct. 1351 (2013); ● <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>, Nos. 2014-1617, 2014-1619, 2016 U.S. App. LEXIS 2452 (Feb. 12, 2016) (<i>en banc</i>) (exhaustion, sales outside the United States, sales conditioned on single use restriction).