

**SYLLABUS AND CLASS PLAN FOR
PATENT REMEDIES & DEFENSES
SPRING 2013
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Required materials: Casebook, P. Janicke, *Modern Patent Litigation* (Carolina Academic Press, 3rd ed. 2012 – publisher will make e-version available); copy of the patent statute, 35 USC. (The pre-AIA version is acceptable for purposes of this course, although the revised version made a few changes to patent litigation and defenses.)

Recommended text: For those who feel the need for an additional book in text form, I suggest H. Schwartz, *Patent Law and Practice*, 7th edition, published by BNA. It is available online from Amazon.com [\$175].

General: The course is designed to highlight in depth the principal substantive law issues, and a few jurisdictional and procedural ones – that are most commonly encountered in patent litigation today, ones that do not arise in Patent Office practice and that are not covered seriously in any basic patent law course. This course will follow my casebook, *Modern Patent Litigation*. We will treat the cases rather thoroughly, and as a result will on average cover only six cases per class session. We will construct and discuss several variant fact patterns of some of the cases.

You will also need to bring the patent statute to each class.

The content of the course, and the approximate dates for coverage of the various parts, are as follows:

Chapter 1: Patentee's Remedies

A. Permanent Injunction

eBay v. MercExchange, (S. Ct.)

eBay v. MercExchange (on remand to E.D. Va.)

W. L. Gore & Assocs. v. Garlock, Inc., 842 F. 2d 1275 (Fed. Cir. 1988)

Amstar Corp. v. Envirotech Corp., 823 F. 2d 1538 (Fed. Cir. 1987)

i4i (Fed. Cir.) [excerpt]

B. Preliminary Injunction

Roper Corp. v. Litton Sys., 757 F. 2d 1266 (Fed. Cir. 1985)

Illinois Tool Works v. Grip-Pak, Inc., 906 F. 2d 679 (Fed. Cir. 1990)

C. Contempt Remedy for Violating Injunction

TiVo v. EchoStar (Fed. Cir. 2011)

Additive Controls & measurement Sys. Inc. v. Flowdata Inc. (Fed. Cir. 1996)

D. Damages: Lost Profits

King Instr. Corp. v. Otari Corp., 767 F. 2d 853 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1016 (1986)

Juicy Whip Inc. v. Orange Bang, Inc. (Fed. Cir. 2005)

BIC Leisure Prods. v. Windsurfing Int'l., Inc., F. 3d 1214 (Fed. Cir. 1993)

E. Reasonable Royalty

Georgia-Pacific Corp. v. United States Plywood Corp., 318 F. Supp. 1116 (S.D.N.Y. 1978), *modified*, 446 F. 2d 295 (2d Cir.), *cert. denied*, 404 U.S. 870 (1971)

Fromson v. Western Litho Plate & Supply Co., 853 F. 2d 1568 (Fed. Cir. 1988)

Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l., Inc., 246 F. 3d 1336 (Fed. Cir. 2001).

Harris Corp. v. Ericsson Inc. (Fed. Cir. 2005)

Interactive Pictures v. Infinite Pictures (Fed. Cir. 2001)

SGS Kohle v. Dart Indus. (Fed. Cir. 1988)

Cardiac Pacemakers

i4i (Fed. Cir. 2010) [excerpt]

F. Enhancement: Willfulness; Counsel Opinions

Knorr-Bremse Systeme Fuer Nutzfahreuge GmbH v. Dana Corp.

In re Seagate (en banc Fed Cir 2007)

Ortho Pharm. Corp. v. Smith, 959 F. 2d 936 (Fed. Cir. 1992)

Read Corp. v. Portec, Inc., 970 F. 2d 816 (Fed. Cir. 1992) [Part II]

G. Interest

Nickson Indus. v. Rol Mfg. Co., 847 F. 2d 795 (Fed. Cir. 1988)

Beatrice Foods Co. v. New England Printing & Litho. Co., 923 F. 2d 1576 (Fed. Cir. 1991)

H. Attorney Fees

Modine Mfg. Co. v. Allen Group, 917 F. 2d 538 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 918 (1991)

Chapter 2. Accused Infringer's Remedies

A. Declaratory judgment

Int'l Med. Prosthetics Res. Assocs. v. Gore Enterprise Holdings, 787 F. 2d 572 (Fed. Cir. 1986)

Shell Oil Co. v. Amoco Corp., 970 F. 2d 885 (Fed. Cir. 1992)

Medimmune v. Genentech (S. Ct. 2007)

B. Attorney fees

Eltech Sys. Corp. v. PPG Indus., 903 F. 2d 805 (Fed. Cir. 1990)

C. Indemnification

D. Wrongful injunction action

Transonic Sys. Inc. v. Noninvasive Med. Techs. Corp. (Fed. Cir. 2003)

Nintendo of Amer. v. Lewis Galoob Toys (9th Cir. 1994)

E. Misuse Defense; Antitrust Action

Berlenbach v. Anderson & Thompson Ski Co., 329 F. 2d 782 (9th Cir.), *cert. denied*, 379 U.S. 830 (1964)

Princo Corp. v. USITC (Fed. Cir. 2010)

Zenith Radio Corp. v. Hazeltine Research, Inc., 395 U.S. 100 (1969)

In re Independent Service Organizations, 203 F. 3d 1322 (Fed. Cir. 2000), *cert. denied*, 531 U.S. 1143 (2001).

Chapter 3: Jurisdiction and Venue

A. Basics of jurisdiction where cases “arise under” § 1338(a)

Consolidated Kinetics v. Marshall, Neil & Pauley, Inc., 521 P. 2d 1209 (Wash. App. 1974)

Christianson v. Colt Indus., (S. Ct. 1988)

Air Measurement v. Akin Gump (Fed. Cir. 2007)

Haase v. Abraham Watkins (E.D. Tex. 2010)

B. Claims of infringement by U.S. or its contractors; *claims against states*

TVI Energy Corp. v. Blane, 806 F. 2d 1057 (Fed. Cir. 1986)

Florida Prepaid Educ. v. College Savings Bank (S. Ct. 1996)

C. The limits of supplemental jurisdiction

Verdegaal

D. Jurisdiction over persons: General and Special
Minimum Contacts

Beverly Hills Fan Co. v. Royal Sovereign Corp., 21 F. 3d 1558 (Fed. Cir. 1994)

3D Systems, Inc. v. Aarotech Labs. Inc., 160 F. 3d 1373 (Fed. Cir. 1998).

E. Venue: Residence of Defendant

VE Holding Corp. v. Johnson Gas Appliance Co., 917 F. 2d 1574 (Fed Cir.), *cert. denied*, 499 U.

F. Convenience Transfers

In re TS Tech (Fed. Cir. 2008)

In re Telular (Fed. Cir. 2009)

G. Conflicting actions

Kahn v. GMC, 889 F. 2d 1078 (Fed. Cir. 1989)

Deprenyl Animal Health, Inc. v. University of Toronto Innov. Found., 297 F.3d 1343 (Fed. Cir. 2002)

Chapter 4: Parties and Pleadings

A. Necessary Parties Plaintiff

Waterman v. Mackenzie, 138 U.S. 252 (1891)

Independent Wireless Tel. Co. v. RCA, 269 U.S. 459 (1926)

McNeilab, Inc. v. Scandipharm, Inc., 1996 U.S. App. LEXIS 19073 (Fed. Cir. 1996)

WIAV

Mann

B. Possible Parties Defendant

Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F. 2d 1565 (Fed. Cir. 1986)

Bear_Creek

BMC

Chapter 5: Problems in Determining Patent Scope

Excerpt from *Graver Tank*

Vitronics

Phillips v. AWH

Net Moneyin

Allvoice

New Chapter 6: Special Problems Regarding Patent Infringement

Cardiac Pacemakers (Fed. Cir. 2010)

Intermedics v. Ventritex (Fed. Cir. 1993)

Merck v. Integra (S.Ct. 2005)

i4i [excerpt]

SEB

Chapter 7: Estoppels

A. To deny validity: Assignor estoppel

Shamrock Techs. v. Medical Sterilization, Inc., 903 F. 2d 789 (Fed. Cir. 1990)

B. To deny infringement: Marking estoppel

Boyd v. Schildkraut (2d Cir. 1991)

Slip Track (Fed. Cir. 2004)

C. To assert infringement: Prosecution history
estoppel

Festo – S.Ct.

Festo [Judge Saris decision on remand]

Festo [Fed Cir affirmance on remand]

Intervet (Fed Cir 2010)

D. To sue: Equitable estoppel and laches

A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F. 2d 1020 (Fed. Cir. 1992)

Meyers v. Asics Corp., 974 F. 2d 1304 (Fed. Cir. 1992)

Cancer Research (Fed. Cir. 2010)

E. To Deny License

Wang Labs., Inc. v. Mitsubishi Electronics America, Inc., 103 F. 3d 1571 (Fed. Cir.), *cert. denied*, 1997 U.S. LEXIS 4726 (1997)

Chapter 8: Defenses

A. Defenses Only As Provided By Statute

Aristocrat v. Int'l Game (Fed. Cir. 2008)

B. License

Anton Bauer

C. Exhaustion

Intel Corp. v. U.S. Int'l. Trade Comm'n., 946 F. 2d 821 (Fed. Cir. 1991)

Unidisco, Inc. v. Schattner, 824 F. 2d 965 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1042 (1988)

D. Inequitable conduct

Kingsdown Med. Consultants, Ltd. v. Hollister, Inc., 863 F. 2d 867 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1067 (1989)

Medtronic v. Boston Sci. (E.D. Tex. 2008)

Therasense

Exergen v. Wal-Mart

E. Improperly broadened reissue/reexamination

Quantum Corp. v. Rodime, PLC, 65 F. 3d 1577 (Fed. Cir. 1995)

F. Intervening rights

Westvaco Corp. v. Int'l. Paper Co., 991 F. 2d 735 (Fed. Cir. 1993)

G. Inherent Anticipation

King_Pharm

H. Failure to mark and mismarking

Amer. Med. Sys. v. Medical Engg. Corp., 6 F. 3d 1523 (Fed. Cir. 1993), *cert. denied*, 511 U.S. 1070 (1994)

I. Time limitation on damages

Standard Oil Co. v. Nippon Shokubai KK Co., 754 F. 2d 345 (Fed. Cir. 1985)

Chapter 9: Discovery Matters

A. Privileged communications

Amer. Standard, Inc. v. Pfizer, Inc., 828 F. 2d 734 (Fed. Cir. 1987)

Quantum Corp. v. Tandon Corp., 940 F. 2d 642 (Fed. Cir. 1991)

In re Spalding Sports (Fed. Cir. 2000)

GFI v. Franklin Corp. (Fed. Cir. 2001)

B. "Work product"

Rule 26, Fed. R. Civ. P. [VERIFY UP TO DATE]

In re Pioneer Hi-Bred Int'l (Fed. Cir. 2001)

C. Spoliation of Evidence

Micron_v_Rambus

C. Relevance issues

D. Other discovery and fee-award issues

Nilssen v. Osram Sylvania Inc. (Fed. Cir. 2008)

Chapter 10: Trial and Judgment

A. Summary judgment

Palumbo v. Don Joy Co., 762 F. 2d 969 (Fed. Cir. 1985)

Ryko Mfg. Co. v. Nu-Star, Inc., 950 F. 2d 714 (Fed. Cir. 1991)

B. Separate trials

In re Innotron Diagnostics, 800 F. 2d 1077 (Fed. Cir. 1986)

C. Jury's role

Markman v. Westview Instr., Inc., 517 U.S. 370 (1996)

Listing of jury issues as of 2011

D. Entry of partial judgment; finality

396. Rule 54, Fed. R. Civ. P

396. 28 U.S.C. §§ 1292

E. Dismissals and consent judgments

Hartley v. Mentor Corp., 869 F. 2d 1469 (Fed. Cir. 1989)

Foster v. Hallco Mfg. Co., 947 F. 2d 469 (Fed. Cir. 1991)

F. Issue preclusion

In re Freeman (Fed. Cir. 1995)

Del-Mar Avionics, Inc. v. Quinton Instr. Co., 836 F. 2d 1320 (Fed. Cir. 1987)

CLASS PREPARATION

I will randomly call upon you in class. I will have the discretion to raise or lower any student's final grade by one grade level. This aspect of your grade is obviously not anonymous.

QUIZZES

Students seem to like the idea of two quizzes during the semester, counting in the aggregate for 10% of the final grade. These will have to be multiple-choice questions, due to practical time constraints. We will discuss the advisability of these during the first class.