

PATENT REMEDIES & DEFENSES – SPRING 2024

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Office Hours: Via Zoom appointment
Class Meeting Time and Location: MW 1:00-2:30, Room TBD

INTRODUCTION

Course Description: 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 in a basic patent law course. This course will follow my casebook, *Modern Patent Litigation (4th Ed., eBook)*. 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.

DESCRIPTION AND REQUIREMENTS

Prerequisites: None. Patent Law would be helpful but is not required.

Required Texts:

Paul M. Janicke, *Modern Patent Litigation* 4th Ed. (Carolina Academic Press) - eBook

Course Grading:

There will be three pre-announced quizzes spaced through the semester. The grade for the course will be based 15% on the quizzes and 85% on the final exam, OR on the final exam alone, *whichever formula is higher*. In other words, the quiz scores may help your grade in the course, but they cannot harm your grade.

Learning Objectives:

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 in a basic patent law course. The course will follow my casebook, *Modern Patent Litigation*, with some distributed update cases.. We will treat all 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.

Learning Outcomes:

Completion of the course will equip students to practice in the patent law field, in three areas. The first is work done in law firms handling patent litigation. The issues treated in this course are the ones most often seen in U.S. district court patent cases. The second area is for those practicing patent prosecution, handling to foresee issues that may arise in PTO proceedings or in later litigation of the patents they are procuring. The third aspect is for students destined to practice law in corporate

employment positions. Having a competent grasp of the likely issues and outcomes in patent enforcement will be beneficial for such attorneys.

COURSE ASSIGNMENTS
(pages refer to the assigned casebook, *Modern Patent Litigation, 4th ed.*)

	<u>Pages</u>
Chapter 1 · Patentee's Remedies	3
A. Permanent Injunction	
B. Preliminary Injunction	
C. Contempt Remedy for Violating Injunction	
D. Lost Profits Damages	
E. Reasonable Royalty Damages	
F. Enhancement: Willfulness; Counsel Opinions	
G. Prejudgment Interest	
H. Attorney Fees	
Chapter 2 · Accused Infringer's Remedies	121
A. Declaratory Judgment	
B. Attorney Fees	
C. Indemnification	
D. Wrongful Injunction Action	
E. Misuse Defense and Antitrust Action	
Chapter 3 · Jurisdiction and Venue	185
A. Basics of Jurisdiction under Section 1338(a)	
B. Infringement by U.S. or Its Contractors, or by States	

C. The Limits of Supplemental Patent Jurisdiction	
D. Jurisdiction Over Persons: General and Special Minimum Contracts	
E. Patent Venue: Defendant’s Residence	
F. Convenience Transfer	
G. Conflicting Actions: Which Goes Forward?	
H. Impact of the America Invents Act of 2011	
Chapter 4 · Parties to Patent Suits	251
A. Necessary Parties Plaintiff	
B. Permissible Parties Defendant	
C. Joinder of Non-Cooperating Defendants	
Chapter 5 · Problems in Determining Patent Scope	281
Chapter 6 · Special Problems of Patent Infringement	311
Chapter 7 · Estoppels	343
A. To Deny Validity: Assignor Estoppel	
B. To Deny Infringement: Can There Be Marking Estoppel?	
C. To Assert Infringement: Prosecution History Estoppel	
D. To Sue: Equitable Estoppel and Laches	
E. Estoppel to Deny Existence of a License	
Chapter 8 · Defenses	415
A. Defenses Are Limited by Statute	
B. License	
C. Exhaustion of the Patent Right	

- D. Inequitable Conduct
- E. Improperly Broadened Reissue or Reexamination
- F. Intervening Rights
- G. Prior Invention
- H. Inherent Anticipation
- I. Failure to Mark Goods
- J. Time Limitation on Damages

Chapter 9 · Discovery Matters 509

- A. Privilege for Communications
- B. “Work Product”
- C. Relevance Issues

Chapter 10 · Judgments 563

- A. Summary Judgment
- B. Separate Trials
- C. Jury’s Role
- D. Partial Judgments
- E. Effect of Consent Judgments
- F. Issue Preclusion—Different Design

Mental Health and Wellness Resources

The University of Houston has a number of resources to support students' mental health and overall wellness, including CoogsCARE and the UH Go App. UH Counseling and Psychological Services (CAPS) offers 24/7 mental health support for all students, addressing various concerns like stress, college adjustment and sadness. CAPS provides individual and couples counseling, group therapy, workshops and connections to other support services on and off-campus. For assistance visit uh.edu/caps, call 713-743-5454, or visit a Let's Talk location in-person or virtually. Let's Talk are daily, informal confidential consultations with CAPS therapists where no appointment or paperwork is needed.

The Student Health Center offers a Psychiatry Clinic for enrolled UH students. Call 713-743-5149 during clinic hours, Monday through Friday 8 a.m. - 4:30 p.m. to schedule an appointment. The A.D. Bruce Religion Center offers spiritual support and a variety of programs centered on well-being.

Need Support Now? - If you or someone you know is struggling or in crisis, help is available. Call CAPS crisis support 24/7 at 713-743-5454, or the National Suicide and Crisis Lifeline: call or text 988, or chat 988lifeline.org.

Title IX/Sexual Misconduct

Per the UHS Sexual Misconduct Policy, your instructor is a "responsible employee" for reporting purposes under Title IX regulations and state law and must report incidents of sexual misconduct (sexual harassment, non-consensual sexual contact, sexual assault, sexual exploitation, sexual intimidation, intimate partner violence, or stalking) about which they become aware to the Title IX office. Please know there are places on campus where you can make a report in confidence. You can find more information about resources on the Title IX website at <https://uh.edu/equal-opportunity/title-ix-sexual-misconduct/resources/>.

Reasonable Academic Adjustments/Auxiliary Aids

The University of Houston is committed to providing an academic environment and educational programs that are accessible for its students. Any student with a disability who is experiencing

barriers to learning, assessment or participation is encouraged to contact the Justin Dart, Jr. Student Accessibility Center (Dart Center) to learn more about academic accommodations and support that may be available to them. Students seeking academic accommodations will need to register with the Dart Center as soon as possible to ensure timely implementation of approved accommodations. Please contact the Dart Center by visiting the website: <https://uh.edu/accessibility/> calling (713) 743-5400, or emailing jdcenter@Central.UH.EDU.

Resources for Online Learning

The University of Houston is committed to student success and provides information to optimize the online learning experience through our Power-On website (<https://uh.edu/power-on/learning/>). Please visit this website for a comprehensive set of resources, tools, and tips, including: obtaining access to the internet, AccessUH, Blackboard, and Canvas; using your smartphone as a webcam; and downloading Microsoft Office 365 at no cost. For questions or assistance contact UHOnline@uh.edu.

Honor Code

The UHLC Honor Code applies to all aspects of this course. You are responsible for knowing all Honor Code provisions and for complying with the Honor Code. Please inquire if you have any questions regarding how the Honor Code's provisions apply to specific activities or situations related to this course. Your continuing enrollment in this course is deemed to be a pledge by you under the Honor Code to comply with the Honor Code in relation to this course and to comply with the instructions in the course syllabus.