

**SYLLABUS FOR
PATENT REMEDIES & DEFENSES
COURSE 6393 SEC 20598
SPRING 2026**

PROF. JANICKE

Required materials: Casebook, P. Janicke, *Modern Patent Litigation* (Carolina Academic Press, 4th ed. 2016 – e-book).

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 e-book 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.

Major Assignments/Exams

There will be three not-for-credit quizzes spaced during the semester. Each will be pre-announced and will be in multiple-choice format. The final exam in multiple-choice format will count for 100% of the final grade.

Course Objectives and Learning Objectives

By the end of this course, you will be able to:

- understand and identify overarching patent litigation statutes, principles and caselaw;
- identify and consider ethical and professional questions raised by the course materials;
- articulate and express a well-informed opinion regarding patent infringement suits; and
- develop skills in legal analysis, reasoning, research; problem-solving; and written and oral communication related to patent litigation.

Required Reading

The content of the course will track the content of the e-casebook:

Chapter 1: Patentee's Remedies

- A. Permanent Injunction
- B. Preliminary Injunction
- C. Contempt Remedy for Violating Injunction
- D. Damages: Lost Profits
- E. Reasonable Royalty
- F. Enhancement: Willfulness; Counsel Opinions
- G. Interest
- H. Attorney Fees

Chapter 2. Accused Infringer's Remedies

- A. Declaratory judgment
- B. Attorney fees
- C. Indemnification
- D. Wrongful injunction action

E. Misuse Defense; Antitrust Action

Chapter 3: Jurisdiction and Venue

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

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

C. The limits of supplemental jurisdiction

D. Jurisdiction over persons: General and Special
Minimum Contacts

E. Venue: Residence of Defendant

F. Convenience Transfer

G. Conflicting actions

Chapter 4: Parties and Pleadings

A. Necessary Parties Plaintiff

B. Possible Parties Defendant

Chapter 5: Problems in Determining Patent Scope

Chapter 6: Special Problems Regarding Patent Infringement

Chapter 7: Estoppels

- A. To deny validity: Assignor estoppel
- B. To deny infringement: Marking estoppel
- C. To assert infringement: Prosecution history estoppel
- D. To sue: Equitable estoppel and laches
- E. To Deny Existence of License

Chapter 8: Defenses

- A. Defenses Only As Provided By Statute
- B. License
- C. Exhaustion
- D. Inequitable conduct
- E. Improperly broadened reissue/reexamination
- F. Intervening rights
- G. Prior Invention
- H. Inherent Anticipation
- H. Failure to mark and mismarking

I. Time limitation on damages

Chapter 9: Discovery Matters

A. Privileged communications

B. "Work product"

C. Spoliation of Evidence

C. Relevance issues

D. Other discovery and fee-award issues

Chapter 10: Trial and Judgment

A. Summary judgment

B. Separate trials

C. Jury's role

D. Entry of partial judgment; finality

E. Dismissals and consent judgments

F. Issue preclusion

CLASS PREPARATION

I will call upon you in class recite the cases. 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.

COUNSELING AND PSYCHOLOGICAL SERVICES

Counseling and Psychological Services "Let's Talk" program("CAPS") can help students who are having difficulties managing stress, adjusting to the demands of a professional program, or feeling sad and hopeless. You can reach CAPS by calling 713-743-5454 during and after business hours for routine appointments or if you or someone you know is in crisis. No appointment is necessary for the , a drop-in consultation service at convenient locations and hours around campus.

The Texas Lawyers' Assistance Program ("TLAP") also supports law students who are dealing with stress, anxiety, depression, substance abuse, and other mental health problems. You can reach TLAP at any time at 1-800-343-8527. TLAP's website includes a page with links to sources about mental health that are of interest to law students: <https://www.tlaphelps.org/law-students>.

ANTI-DISCRIMINATION AND SEXUAL MISCONDUCT POLICIES

UHLC and the University of Houston are committed to maintaining and strengthening an educational, working, and living environment where students, faculty, staff, and visitors are free from discrimination and sexual misconduct. If you have experienced an incident of discrimination or sexual misconduct, a confidential reporting process is available to you. For more information, please refer to the University System's Anti-Discrimination Policy SAM 01.D.07 Sexual Misconduct Policy SAM 01.D.08and .

Please be aware that under the sexual misconduct policy, SAM 01.D.08, faculty and other University employees are required to report to the University any information received regarding sexual misconduct as defined in the policy. Due to this reporting requirement, faculty members and other employees are not a confidential resource. The reporting obligations under the sexual misconduct policy extends to alleged conduct by University employees and students.