
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. There will be a special section created for patent licensing cases, using the “pitfall approach,” i.e., studying cases where different drafting of the license would have changed the result or avoided the litigation. The remainder of the 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.

Major Assignments/Exams

There will be three for-credit quizzes spaced during the semester. Each will be pre-announced and will be in multiple-choice format. The final exam will count for 85% of the final grade if the quiz scores at 15% pull the total upward; if the final alone is higher, the quiz scores will not count.

Required Reading

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

Chapter 1: Patentee's Remedies

A. Permanent Injunction
eBay v. MercExchange, (S. Ct.)

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


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


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

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


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]

Uniloc USA v. Microsoft (Fed. Cir. 2011)

F. Enhancement: Willfulness; Counsel Opinions

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

Halo Electronics v. Pulse Electronics (S. Ct. 2016)

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


H. Attorney Fees


Chapter 1A: Patent licensing to avoid litigation

(In process of creation.)

Chapter 2. Accused Infringer's Remedies

A. Declaratory judgment


Medimmune v. Genentech (S. Ct. 2007)

Creative Compounds v. Starmark Labs (Fed. Cir 2011)

Powertech Technology v. Tessera Inc. (Fed. Cir. 2012)

B. Attorney fees

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

Octane Fitness v. Icon Health (S. Ct. 2014)
C. Indemnification

D. Wrongful injunction action


   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)


   In re Independent Service Organizations, 203 F. 3d 1322 (Fed. Cir. 2000), cert.

Chapter 3: Jurisdiction and Venue

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

   App. 1974)


   Gunn v. Minton (S.Ct. 2013) [suppl. cases]

   Medtronic v. Mirowski Family Ventures (S. Ct. 2014)
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)


C. The limits of supplemental jurisdiction

*Verdegaal Bros. v. Union Oil* (Fed. Cir. 1984)

D. Jurisdiction over persons: General and Special

Minimum Contacts

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


E. Venue: Residence of Defendant

*VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F. 2d 1574 (Fed Cir.), *cert. denied*, 499 U.S. 922 (1990)

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)
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)


WIAV Solutions v. Motorola (Fed Cir 2010)

Mann Foundation v. Cochlear Corp. (Fed. Cir. 2010)

B. Possible Parties Defendant

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

Chapter 5: Problems in Determining Patent Scope

Excerpt from Graver Tank

Vitronics

Phillips v. AWH

Net Moneyin
Chapter 6: Special Problems Regarding Patent Infringement

Cardiac Pacemakers (Fed. Cir. 2010)

Intermedics v. Ventritex (Fed. Cir. 1993)

Merck v. Integra (S.Ct. 2005)

Global Tech v. SEB (S. Ct. 2011)

i4i [excerpt]

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

Frolow v. Wilson (Fed. Cir. 2013) [suppl. cases]

C. To assert infringement: Prosecution history estoppel

Townsend v. Hitec (Fed. Cir. 1987)

Festo v. Shoketsu (S.Ct. 2002)
Festo [Judge Saris decision on remand]

Festo [Fed Cir affirmance of Saris decision]

Intervet (Fed Cir 2010)

D. To sue: Equitable estoppel and laches


E. To Deny Existence of License


Chapter 8: Defenses

A. Defenses Only As Provided By Statute

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

B. License

Anton Bauer v. PAG (Fed. Cir. 2003)

C. Exhaustion


Keurig (Fed. Cir. 2013) [suppl. cases]

D. Inequitable conduct


Therasense v. Becton (Fed. Cir. 2011)

Exergen v. Wal-Mart (Fed. Cir. 2009)

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. Prior Invention

Thomson v. Quixote (Fed. Cir. 1999)

H. Inherent Anticipation

King Pharm v. Eon (Fed. Cir. 2010)

H. Failure to mark and mismarking

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)

    In re Seagate (Fed. Cir. 2007)

    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.

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

C. Spoliation of Evidence

    Micron v. Rambus (Fed. Cir. 2011)

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)


B. Separate trials

_In re Innotron Diagnostics, _800 F. 2d 1077 (Fed. Cir. 1986)

C. Jury's role


Listing of jury issues as of 2011

D. Entry of partial judgment; finality

Rule 54, Fed. R. Civ. P

28 U.S.C. § 1292

E. Dismissals and consent judgments

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

F. Issue preclusion

Baxter (Fed. Cir. en banc 2012) [suppl. cases]


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.

UH SERVICE

Counseling and Psychological Services (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 (www.uh.edu/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 “Let’s Talk” program, a drop-in consultation service at convenient locations and hours around campus. http://www.uh.edu/caps/outreach/lets-talk/