



Patent Resources Group

Federal Circuit Patent Law (2007-2009) Course Syllabus

- I. NOVELTY AND LOSS OF RIGHT TO A PATENT**
 - A. Anticipation
 - 1. Expert Reports and Citation to Prior Art
 - 2. Claim Construction
 - 3. Anticipation Shown Through Inherency
 - 4. Anticipation by a Parent Patent – Chain of Disclosures “Broken” by Narrow Incorporation by Reference Clause
 - 5. A Reference May Anticipate Even Though Relevant Properties Were Not Appreciated
 - 6. Uncertainty Over How Prior Art Operates May Preclude Summary Judgment of Invalidity
 - 7. Anticipation – Product-by-Process Claims
 - 8. Genus-Species
 - 9. A Prior Art Reference Must be “Enabling” to Anticipate
 - 10. Interpreting a Reference
 - B. Loss of Rights – §102(b)
 - 1. Patented or Described in a Printed Publication
 - 2. Antedating a Reference
 - 3. “On Sale”
 - 4. “In Public Use”
 - C. §102(g) – Prior Invention
 - 1. Six-Month Delay Between Reduction to Practice and Commercialization/Filing Application Does Not Constitute Suppression or Concealment
 - 2. A Party Asserting “Prior Invention” Must Provide a Clear and Convincing Showing of a Prior Actual Reduction to Practice Including That the Prior Invention Worked for Its Intended Purpose
- II. CLAIM CONSTRUCTION**
 - A. Claim Construction
 - 1. General Principles
 - 2. Reference to Intrinsic Evidence
 - 3. Reliance on Expert Testimony, Technical Literature and Other Extrinsic Evidence
 - 4. The Doctrine of Claim Differentiation
 - 5. Means-Plus-Function Claims
 - 6. Preambles and Transitional Phrases
 - 7. Pre-Filing Investigation
- III. 35 USC §112 AND §101 ISSUES IN THE FEDERAL CIRCUIT**
 - A. Section 101
 - 1. Statutory Subject Matter
 - 2. Practical Utility Issues Under Section 101
 - B. Section 112, Second Paragraph
 - 1. The Degree of Specificity Required for “Definiteness”



Patent Resources Group

Federal Circuit Patent Law (2007-2009) Course Syllabus

2. Cases Directed to “The Subject Matter Which the Applicant Regards as His Invention”
3. The Interplay of Section 112, Second Paragraph, and Other Paragraphs of Section 112
- C. Section 112, First Paragraph
 1. The Written Description Requirement
 2. The Enablement Requirement
 3. The Best Mode Requirement
- IV. OBVIOUSNESS/NON-OBVIOUSNESS**
 - A. Presumption of Validity: Burden of Proof
 1. In the Courts
 2. In the PTO
 - B. Appellate Review
 1. PTO Review
 2. Court Review
 - C. The Obviousness/Non-Obviousness Analysis
 1. The Obviousness/Non-Obviousness Analysis Post-*KSR*
 2. Review of Jury Instructions Given Pre-*KSR*
 3. Claim Construction
 4. A *Prima Facie* Case
 5. Reason or Motivation for Combination
 6. Negating/Rebutting a *Prima Facie* Case of Obviousness
 - D. The *Graham* Findings
 1. Objective Considerations
 2. Level of Ordinary Skill in the Art
- V. INVENTORSHIP**
 - A. Inventorship Law
 1. Background
 2. Conception
 3. Actual Reduction to Practice
 4. Derivation
 - B. Joint Inventorship
 1. Background
 2. Joint Inventorship Is Determined by a Three-Part Procedure
 3. Minimum Degree of Collaboration or Concerted Efforts to Support Joint Inventorship Defined
 4. “Rule of Reason Analysis” Is Used to Determine Sufficiency of Corroboration Evidence in Joint Inventorship Disputes
 - C. Correction of Inventorship
- VI. SELECTED CROSSOVER CASES**
 - A. Arbitration
 1. Unless an Arbitration Clearly Delegates Issues for Arbitration to the Arbitrator, Arbitrability Issues Are Decided by the Court



Patent Resources Group

Federal Circuit Patent Law (2007-2009) Course Syllabus

2. Defendants' Attempt to Escape the Eastern District of Texas by Arbitration Fails
 - B. Attorney Discipline
 - C. Case or Controversy
 1. Determining the Existence of a Case or Controversy
 2. Discretionary Rulings
 3. Burden Shifting?
 - D. Contempt
 - E. Double Patenting
 1. Background
 2. Same Invention-Type Double Patenting
 3. Obviousness-Type Double Patenting
 4. The Effect of 35 U.S.C. § 121 on Double Patenting
 - F. Eleventh Amendment
 - G. PTO Fee Diversion
 - H. Local Rules for Patent Cases
 - I. Subject Matter Jurisdiction to Hear Foreign Patent Claims
 - J. Preemption
 - K. A Patent Attorney's Life is a Hard Life Indeed
 - L. Patent Attorney Malpractice
 - M. Protective Orders
 - N. District Court Judge Removed From Case
- VII. LITERAL, INDUCED, AND CONTRIBUTORY INFRINGEMENT**
- A. Literal Infringement
 1. General Substantive Principles
 2. General Procedural Principles
 3. The Reverse Doctrine of Equivalents
 4. *De Minimis* Exceptions
 5. Experimental Use
 6. §271(e)(1) Exceptions
 7. §271(e)(2)(A) Infringement
 8. §271(a) Offers for Sale and §271(f) Sales of Component Parts
 9. Temporary Presence in the United States
 - B. Inducement
 1. An Accused Infringer's Intent to Infringe Under §271(f) May Be Proven by Circumstantial Evidence
 2. To Establish Inducement to Infringe, a Patentee Must Prove That the Alleged Inducer Had Knowledge of the Infringing Acts
 3. Inducement to Infringe Requires That the Alleged Infringer Possess Knowledge of the Patent and the Specific Intent to Encourage Another's Infringement
 4. Personal Liability of a Corporate Officer for Inducing Infringement Requires Personal Culpability



Patent Resources Group

Federal Circuit Patent Law (2007-2009) Course Syllabus

5. Because Liability for Inducement Requires Proof of Direct Infringement, to Prove Inducement a Patentee Must Show Either Actual Instances of Direct Infringement or that the Accused Product or Device Can Be Used Only in an Infringing Manner
 - C. Contributory Infringement
 1. Where a Patentee Elects to Sell Only One Element of a Patented Combination and Places No Restrictions on Such Sale, Purchasers of Such Element Acquire an Implied License to Purchase and Use the Other Elements of the Combination
 2. Acts Constituting Contributory Infringement Must Occur Within the United States
 3. Liability for Contributory Infringement Does Not Extend to the Sale of a Service
 - D. Repair/Reconstruction
 - E. Process Patents Amendment Act
- VIII. THE DOCTRINE OF EQUIVALENTS AND PROSECUTION HISTORY ESTOPPEL**
- A. Doctrine of Equivalents
 1. Background
 2. Pre-*Hilton Davis/Warner Jenkinson*
 3. *Hilton Davis/Warner-Jenkinson* - the Federal Circuit and the Supreme Court
 4. The Doctrine After *Warner-Jenkinson*
 5. §112, ¶6 Equivalency and Its Relation to the Doctrine of Equivalents
 - B. Prosecution History Estoppel
 1. Background - the Now-Discarded *Hughes Aircraft* Flexible Approach to Estoppel
 2. The *Warner-Jenkinson* Presumption
 3. *Festo* - the Creation of the Foreseeability Approach to Estoppel
 4. Acts That Create a Presumption of Estoppel
 5. Rebuttal of the *Festo* Presumption of Estoppel
- IX. LEGAL ETHICS AND INEQUITABLE CONDUCT**
- A. Inequitable Conduct in the Federal Circuit
 1. Burden of Proof: Balancing Materiality and Intent
 2. Materiality
 3. Intent
 - B. Pleading Inequitable Conduct



Patent Resources Group

Federal Circuit Patent Law (2007-2009) Course Syllabus

1. Inequitable Conduct Must Be Pled With Particularity: Federal Circuit Will Apply Its Own Law in Deciding Whether Pleadings Are Adequate: Whether District Court Properly Denied Leave to Amend Is Decided Under Otherwise Applicable Regional Circuit Law: District Court Did Not Abuse Its Discretion in Denying Leave to Amend First Sought Three Years After the Close of Discovery
 - C. Appeal
 1. District Court's Finding That a Patent Was Unenforceable Because of Inequitable Conduct by the Prosecuting Attorney Does Not Give Prosecuting Attorney a Right of Appeal: Absent a Court's Invocation of Its Authority to Punish Persons Before It for Misconduct, Actions by the Court Such as Making Adverse Findings as Language in a Court Opinion Regarding the Conduct of a Third Party Do Not Give Nonparties the Right to Appeal Either From the Ultimate Judgment in the Case or From the Particular Court Statement or Finding That They Find Objectionable
 - D. Right to a Jury Trial
 1. District Court Retains Discretion to Conduct a Bench Trial on the Equitable Issue of Unenforceability in the Same Case Where Invalidity Is Tried to a Jury
 - E. Alleged Fraud Based Solely on Patentee's Failure to Disclose Pre-Critical Date Sales Will Not Suffice to Infer Intent for *Walker Process*-Type Antitrust Claim – in the Case of an Omission, There Must Be Evidence of Intent Separable From the Simple Fact of the Omission
- X. THE RELIEF AVAILABLE TO THE PREVAILING PARTY IN PATENT LITIGATION**
- A. Compensatory Money Damages for Infringement of a Utility Patent Under 35 USC §284
 1. Damages Based on Lost Profits
 2. Damages Based on a Reasonable Royalty
 3. *Daubert* Damages Issues in the Federal Circuit
 - B. Damages Issues in Design Patent Cases
 - C. Damages for U.S. Government Secrecy Orders
 - D. Interest and Costs
 1. Prejudgment Interest
 2. Postjudgment Interest
 3. Awards of Costs
 - E. Limitations on Damages
 1. Marking and Notice Under 35 USC §287
 2. Double Recovery of Damages
 - F. Joint and Several Liability Issues
 - G. Money Awards by the Court
 1. Increased Damages Under 35 USC §284 for Willful Infringement
 2. Awards of Reasonable Attorney Fees Under 35 USC §285



Patent Resources Group

Federal Circuit Patent Law (2007-2009) Course Syllabus

- H. Injunctive Relief
 - 1. Injunctions in General/Procedural Aspects
 - 2. Injunctions Against Patent Owners
 - 3. Preliminary Injunctions
 - 4. Permanent Injunctions
 - 5. Contempt
- I. Laches
- XI. CORRECTION OF PATENTS**
 - A. The Error Requirement for a Reissue Patent
 - 1. Errors in an Original Patent That Are Correctable by Reissue
 - 2. The Recapture Estoppel Rule
 - B. Establishing the Basis for a Reexamination
 - 1. A Formal Request for Reexamination Is Required
 - 2. The Portola Doctrine Applies Only in the Patent and Trademark Office
 - C. Issues Related to Claim Scope in a Reissue Patent
 - 1. No Change in Scope
 - 2. Broadened Reissue Claim Scope and Disclaimers
 - 3. Narrowed Claim Scope
 - 4. Claim Construction Issues in Reissue
 - D. Issues Related to Claim Scope Following Reexamination
 - 1. No Change in Claim Scope
 - 2. Broadened Claim Scope
 - 3. Narrowed Claim Scope
 - 4. Claim Construction Issues in Reexamination Prosecution
 - 5. Non-Final Reexamination Proceedings Cannot Moot a District Court's Invalidity Judgment on Original Claims
 - E. Issues Related to Certificates of Correction
 - 1. Certificate of Correction Under 35 U.S.C. §254 (PTO Mistake)
 - 2. Certificate of Correction Under 35 U.S.C. §255 (Applicant's Mistake)
 - F. Limited Authority for District Courts to Correct Claims
- XII. ASSIGNMENT AND LICENSE ISSUES**
 - A. Standing to Sue for Patent Infringement
 - 1. The Patentee or Its Assignee May Sue in Its Own Name
 - 2. The Exclusive Licensee of a Patent, Having All Substantial Rights, May Sue Without Joining the Licensor
 - 3. A Non-Exclusive Licensee Does Not Have Standing to Sue for Patent Infringement
 - 4. Assignment of the Right to Sue for Past Damages Must Be in Writing at the Time the Infringement Claim Is Filed
 - 5. Patent Law Trumps Bankruptcy Law When the Issue Is Standing to Sue for Patent Infringement



Patent Resources Group

Federal Circuit Patent Law (2007-2009) Course Syllabus

6. The Issue of Standing to Appeal Is Controlled by Different Rules Than Is the Issue of Standing to Sue in District Court
7. An “Exclusive Enterprise License” Fails to Confer Standing
- B. License as a Defense
 1. Unrestricted Sale of an Unpatented Component of Patented Combination Is Not a Grant of Implied License That Will Defeat a Claim of Contributory Infringement
 2. Implied License Rule Clarified and Applied to Interesting Fact Pattern
- C. Co-Ownership as a Defense
- D. Common License and Assignment Terms
 1. A Litigation Royalty Is Not a Settlement Royalty
 2. Covenant Not to Sue Is Transferable
- E. Employer’s Ownership Rights
- F. Estoppel