

Detailed Table of Contents

BOARD OF CONTRIBUTORS	v
PREFACE TO THE THIRD EDITION.....	ix
FOREWORD	xi
AMERICAN COLLEGE OF TRIAL LAWYERS’ STATEMENT OF PURPOSE.....	xiii
SUMMARY TABLE OF CONTENTS	xv
CHAPTER 1 THE PIZZA BOX CASE: ANATOMY OF A CASE FOR PATENT NOVICES.....	1
I. Introduction	1
II. The Patent.....	2
A. Patent Terms.....	3
B. Inter Partes and Post-Grant Review of the PTO...	5
C. Pleadings and Motions.....	6
D. Discovery.....	6
E. Claim Construction.....	7
1. Plaintiff Vitale’s Claim Construction Arguments.....	8
2. Defendant PizzaBoxCo’s Argument	15
F. Summary Judgment Motions.....	20
G. Trial.....	20
H. Reproduction of Vitale Patent.....	21

CHAPTER 2 THE AMERICA INVENTS ACT AND ITS IMPACT ON PATENT LITIGATION 25

- I. Introduction 25
- II. New Proceedings at the PTO and Their Effect on Civil Actions 26
- III. The (Modified) First-to-File Rule 26
- IV. Changes to Section 102(b) Prior Art 27
- V. Changes to Defenses in Patent Litigation..... 28
 - A. “Best Mode” Defense Is Abolished..... 29
 - B. Inequitable Conduct and Supplemental Examination 29
 - C. The More Robust Prior-Commercial-Use Defense 30
- VI. Miscellaneous Changes: Joinder and False Marking..... 30

CHAPTER 3 THE COMPLAINT 33

- I. Pleading Infringement..... 33
 - A. Direct Infringement..... 35
 - B. Induced Infringement 35
 - C. Contributory Infringement 36
 - D. Infringement of Drug Patents 37
 - E. Infringement for Supplying Components for Assembly into a Patented Product Outside of the United States..... 38
 - F. Infringement by a Product Made Outside the United States of a U.S. Patent Covering a Process..... 39
 - G. Willfulness..... 39
- II. Pleading Damages and Other Remedies 40
 - A. Compensatory Damages 40
 - B. Enhanced Damages..... 40
 - C. Injunctions..... 41
 - D. Attorneys’ Fees 41

CHAPTER 4 MOTIONS TO DISMISS, TO TRANSFER, TO STRIKE 43

- I. Motion to Dismiss..... 44
 - A. Lack of Subject-Matter Jurisdiction—Fed. R. Civ. P. 12(b) (1) 44

B. Failure to Join a Necessary Party—Fed. R. Civ. P. 12(b) (7), 19	47
C. Lack of Personal Jurisdiction—Fed. R. Civ. P. 12(b) (2)	48
1. Personal Jurisdiction Generally	48
2. Standard for Personal Jurisdiction Under Federal Circuit Law.....	48
3. Exercise of Jurisdiction Based on Extraterritorial Conduct.....	50
D. Improper Venue—Fed. R. Civ. P. 12(b) (3)	50
E. Motion to Dismiss for Failure to State a Claim Upon Which Relief May Be Granted—Fed. R. Civ. P. 12(b) (6)	51
II. Motion to Strike.....	51
A. Inequitable Conduct.....	51
1. Standard	51
2. Timing	53
III. Motion to Transfer	53
 CHAPTER 5 ANSWER AND COUNTERCLAIMS	 57
I. Introduction	58
II. Affirmative Defenses.....	58
A. Noninfringement	58
B. Invalidity of the Patent.....	59
1. Section 101	59
2. Section 102.....	60
a. For Those Patents Having an Effective Filing Date Prior to March 16, 2013.....	60
b. For Those Patents Having an Effective Filing Date on or After March 16, 2013....	61
3. Section 103.....	62
4. Section 112.....	62
5. Other Matters Relating to an Invalidity Defense	63
C. Inequitable Conduct in Obtaining the Patent	63
D. License or Implied License	64
E. Limitations on Damages	65
F. Equitable Defenses: Laches and Estoppel	66
1. Laches.....	66
2. Equitable Estoppel.....	67
G. Patent Misuse.....	68

III. Counterclaims.....	69
A. Antitrust Counterclaims.....	69
B. Unfair Competition Claims.....	70
C. Tortious Interference Claims.....	71
D. Declaratory Judgment of Noninfringement, Invalidity, or Unenforceability.....	71
CHAPTER 6 PRELIMINARY INJUNCTION MOTIONS.....	73
I. Introduction.....	73
II. Likelihood of Success on the Merits.....	74
A. Infringement.....	74
B. Invalidity.....	75
III. Irreparable Harm.....	75
IV. Balance of Hardships.....	76
V. Public Interest.....	77
CHAPTER 7 THE CASE-MANAGEMENT CONFERENCE.....	79
I. Introduction.....	79
A. Conference Checklist.....	80
B. Local Rules.....	83
CHAPTER 8 DISCOVERY ISSUES UNIQUE TO PATENT CASES.....	87
I. Introduction.....	87
II. Scheduling Considerations.....	88
III. Disclosure of Infringement and Invalidity Contentions and Claim Construction Issues.....	88
A. Patentee’s Infringement Contentions.....	89
B. Accused Infringer’s Invalidity Contentions.....	89
C. Parties’ Contentions Regarding Contested Claim Interpretation Issues.....	90
IV. Relevance and Limits of Discovery.....	91
V. Attorney-Client Privilege and Waiver Issues.....	91
A. Questions of What Qualifies as Privileged.....	92
B. Waiver—Its Scope and Effect.....	92
C. The Timing Issue.....	92
VI. Summary of the Discovery Order and Timing Suggested by Patent Rules.....	93

CHAPTER 9	CLAIM CONSTRUCTION—THE <i>MARKMAN</i> HEARING	95
	I. General Principles	96
	II. Key Elements in Claim Construction	96
	A. Claims	96
	1. Independent vs. Dependent Claims	97
	2. Means-Plus-Function or Step-Plus-Function Claims	97
	B. Intrinsic Evidence	98
	C. Extrinsic Evidence	98
	III. Timing of Claim Construction	99
	IV. Issues to Consider During a Claim Construction Hearing	99
	V. Evidence to Consider When Construing Patent Claim Terms.....	100
	A. Use of Intrinsic Evidence in Construing Claim Terms.....	100
	B. Use of Extrinsic Evidence in Construing Claim Terms.....	101
	VI. Appeal of a Claim Construction Ruling.....	102
CHAPTER 10	SUMMARY JUDGMENT MOTIONS	103
	I. Applying the Summary Judgment Standard to Burdens of Proof in Patent Litigation.....	104
	A. Summary Judgment of Infringement/Noninfringement	105
	B. Summary Judgment of Validity/Invalidity.....	107
	C. Summary Judgment of Unenforceability.....	112
	II. Timing of Summary Judgment Motions	113
	A. Where Not All Claims Have Been Construed.....	114
	B. After All Claims Have Been Construed Through a Formal <i>Markman</i> Hearing.....	115
	C. Combining <i>Markman</i> and Summary Judgment....	115
	III. Evidence to Support or Oppose Summary Judgment.....	117
	A. Expert Evidence Supporting Summary Judgment	117
	B. Expert Evidence Opposing Summary Judgment	118
	IV. Appealability of Partial Summary Judgment	119

CHAPTER 11 PRETRIAL ISSUES AND MOTIONS IN LIMINE 121

- I. Introduction 122
- II. Separation of Issues for Trial 122
 - A. Inequitable Conduct From Case in Chief 123
 - B. Willfulness From Liability..... 123
 - C. Liability From Damages 124
 - D. Infringement From Invalidity..... 125
 - E. Antitrust From Patent Issues 125
- III. Time Limits at Trial..... 127
- IV. Motions in Limine 127
 - A. Inventor Testimony 127
 - B. *Daubert* and Expert Testimony 128
 - 1. Limitations Relating to Inadequate Disclosure, Untimely Disclosure, or Lack of Disclosure..... 129
 - 2. Limitations on Expert Testimony on Willfulness 129
 - 3. Limitations on Expert Testimony Regarding PTO Procedures..... 130
 - C. Comparison of Accused Product With Embodiments of Patent 131
 - D. Commercial Success of the Patented Invention... 131
 - E. Finding of Validity of Same Patent in Other Litigation 132
 - F. Reference to Reissue or Reexamination Proceedings 132
 - G. Use of the Word “Monopoly” 133
 - H. Evidence of Foreign Patents and Proceedings..... 133
 - I. Evidence Related to Decisions for the Court 134

CHAPTER 12 THE USE OF SPECIAL MASTERS, COURT APPOINTED EXPERT WITNESSES, AND TECHNICAL ADVISORS TO AID THE COURT IN PATENT LITIGATION..... 135

- I. Introduction 135
- II. Special Masters 136
- III. Court-Appointed Experts Under Rule 706..... 138
- IV. Technical Advisors..... 140
- V. Conclusion 142

CHAPTER 13 TRIAL	143
I. Introduction	143
II. Pretrial Order	144
III. Selecting the Jury.....	144
IV. Use of Jury Notebooks.....	145
V. Opening Statements and Burdens of Proof, Preliminary Jury Instructions.....	146
VI. Presentation of the Evidence	148
A. Infringement	149
B. Validity	150
C. Inequitable Conduct and Other Counterclaims....	150
D. Damages.....	151
VII. Closing Arguments.....	152
VIII. Instructions to the Jury	152
CHAPTER 14 POST-TRIAL PROCEEDINGS.....	155
I. Motions for Judgment as a Matter of Law and a New Trial.....	155
II. Inequitable Conduct	156
III. Damages.....	159
A. Supplemental Damages	159
B. Prejudgment Interest.....	160
C. Enhancing Damages—35 U.S.C. §284.....	162
D. Attorneys’ Fees—35 U.S.C. §285	163
IV. Injunctions.....	164
A. Permanent Injunctions.....	164
B. Contempt.....	166
CHAPTER 15 AIA TRIAL PROCEEDINGS BEFORE PATENT OFFICE	169
I. Introduction	170
II. Unique Features of AIA Trials	171
III. Petitioner Estoppel in AIA Trials.....	175
A. Different Petitioner Estoppel Rules in IPR, CBM and PGR	175
B. No Petitioner Estoppel for Invalidity Ground Denied Institution.....	177
IV. Interactions between PTAB Proceedings and Civil Actions	177
A. District Court Actions May Bar IPR Petitions.....	178

B. Claim Construction Interplays between PTAB and District Courts	179
C. Stay of Civil Litigation	181
1. Timing of Stay Request.....	181
2. Impacts of Institution Decisions to Stay Requests	183
D. Estoppel on Other Parties to Litigation.....	183
E. Impact to Litigation by Pending AIA Trials.....	184
F. Litigation Impacts of AIA Trials	184
1. Scope of AIA Trial Estoppel Effects in District Courts.....	184
2. Intervening Rights Triggered by Claim Amendments in AIA Trials	185
G. Admissibility of AIA Trial Records in Litigation	186
 CHAPTER 16 SPECIAL CONSIDERATIONS IN HATCH-WAXMAN LITIGATION	 189
I. Introduction	190
II. The Basic Framework of Hatch-Waxman Litigation	190
III. Subject Matter and Personal Jurisdiction in Hatch-Waxman Cases	192
IV. Special Case Management Issues Arising in Hatch-Waxman Cases	194
A. Timing and Order of Disclosure and Evidence.....	194
B. Trial	196
C. Bench Trial vs. Jury Trial.....	196
V. Substantive Patent Issues Arising in Hatch-Waxman Litigation.....	199
A. Validity	199
B. Infringement	201
VI. Settlements in Hatch-Waxman Litigation.....	201
 CHAPTER 17 THE APPEAL	 203
I. Federal Circuit Jurisdiction.....	204
A. Cases “Arising Under the Patent Laws”	204
1. Implication of Federal Patent Law	205
2. Patent Law Defense Does Not “Arise Under”	206

3.	Effect of Dismissal.....	207
4.	Mootness	207
B.	Jurisdiction Over Other Claims Brought With Patent Claim	207
1.	Supplemental Jurisdiction—28..... U.S.C. §1367.....	207
2.	Supplemental Jurisdiction Over Foreign Patent Claims	208
3.	Unfair Competition Claims—28 U.S.C. §1338(b)	209
4.	Patent Infringement Counterclaims.....	210
5.	Patent Declaratory Judgment Claims	210
6.	No Jurisdiction Over Ownership or Licensing Disputes.....	211
7.	Transfer of Appeals to Regional Circuit.....	211
C.	Finality Requirement	212
1.	Final Decision Rule.....	212
2.	Final but for an Accounting—28 U.S.C. §1292(c) (2)	212
3.	Final but for an Award of Attorneys’ Fees or Costs.....	212
4.	Rule 54(b) Certification	212
5.	Injunctions and Stay Orders	213
6.	Certified Questions.....	213
II.	Standards of Review.....	214
III.	Governing Law.....	216
IV.	Remand.....	216
CHAPTER 18 TRIAL OF A PATENT CASE IN CANADA		219
I.	Overview.....	219
II.	The Canadian Patent System	221
III.	The Canadian Court System	222
IV.	Anatomy of a Patent Case for Novices	223
V.	Pleadings.....	225
A.	Statement of Claim	225
B.	Defense (and Counterclaim)	227
VI.	Interlocutory Motions Respecting Pleadings.....	228
VII.	Preliminary Injunctions	229
VIII.	Case Management	229
IX.	Severing of Issues.....	230
X.	Discovery	230

XI. Pre-Trial Issues	232
XII. The Trial.....	233
XIII. Judgment and Post-Trial Matters.....	234
XIV. Appeals.....	235
XV. NOC Proceedings	236
TABLE OF CASES	239
INDEX	257