

Detailed Table of Contents, Vol. II

About the Author		xxix
Preface		xxxi
Chapter 13	JURISDICTION AND PROCEDURE	1
<hr/>		
<i>Introduction</i>		3
§13.01	U.S. District Courts	3
	[A] Subject Matter Jurisdiction over Patent Cases	3
	[1] Statutory Basis: 28 U.S.C. §1338	3
	[2] “Arising Under” Jurisdiction	4
	[a] “Creation” Test	5
	[b] “Serious Federal Interest” Test	6
	[i] <i>Christianson</i> (U.S. 1988)	6
	[ii] <i>Gunn</i> (U.S. 2013)	7
	[iii] Post- <i>Gunn</i> Federal Circuit Decisions on “Substantial Question” of Patent Law	10
	[B] Personal Jurisdiction	13
	[1] Generally	13
	[2] Specific Personal Jurisdiction	14
	[a] Stream-of-Commerce Theory	15
	[b] Sending Enforcement Letters	18
	[C] Venue	23
	[1] Patent-Specific Statute: 28 U.S.C. §1400(b)	23
	[2] <i>Fourco Glass</i> (U.S. 1957)	24
	[3] <i>V.E. Holding</i> (Fed. Cir. 1990) Greatly Expands Patent Venue	24
	[4] <i>TC Heartland</i> (U.S. 2017) Drastically Narrows Patent Venue	26
	[5] Suing Where Accused Infringer Has “Committed Acts of Infringement” and Has a “Regular and Established Place of Business”	31
	[a] <i>In re Cordis</i> (Fed. Cir. 1985)	31
	[b] Representative Post- <i>TC Heartland</i> (U.S. 2017) District Court Decisions	35
	[c] Post- <i>TC Heartland</i> (U.S. 2017) Federal Circuit Decisions	38
	[i] <i>Cray</i> (2017)	38
	[ii] <i>ZTE</i> (2018)	44
	[d] Waiver or Forfeiture of Improper Venue Defense	44
	[6] Venue for Infringement Actions Against Foreign Corporations	49
	[7] Venue for Patent-Related Actions Not Asserting Infringement	51
	[a] Correction of Inventorship	52
	[b] Declaratory Judgment Actions	52

	[8] Choice of Law and Burden of Proof	53	
	[a] Federal Circuit Law Governs	53	
	[b] Burden of Proof on Plaintiff	54	
	[9] Suing Where Accused Infringer “Resides”	56	
	[D] Pleading Requirements	61	
	[1] Elimination of Form Pleading for Direct Infringement (2015)	61	61
	[2] <i>Bill of Lading</i> (Fed. Cir. 2012)	64	
	[3] Pleading Joint Infringement	71	
	[E] Evidentiary Privileges	71	
	[1] Attorney-Client Privilege	71	
	[2] Patent Agent-Client Privilege	72	
§13.02	U.S. International Trade Commission	76	
§13.03	U.S. Court of Appeals for the Federal Circuit	80	
	[A] Subject Matter-Specific Appellate Jurisdiction	80	
	[B] Critiques of the Federal Circuit	83	
	[C] Standards of Review	84	
	[1] Appeals from Federal District Courts	85	
	[a] Jury Trial	85	
	[b] Bench Trial	88	
	[2] Appeals from the International Trade Commission	89	
	[3] Appeals from the U.S. Patent and Trademark Office	89	
§13.04	U.S. Supreme Court	92	
	[A] Before Formation of the Federal Circuit	92	
	[B] After Formation of the Federal Circuit	93	
§13.05	Standing to Sue for Patent Infringement	97	
	[A] Introduction	97	
	[B] Licensees	97	
	[C] Declaratory Judgment Plaintiffs	100	
	[D] Appeals to Federal Circuit from USPTO	104	
§13.06	Patent Declaratory Judgment Actions	107	
	[A] Introduction	107	
	[B] Pre- <i>MedImmune</i> “Reasonable Apprehension” Test	110	
	[C] <i>MedImmune v. Genentech</i> (U.S. 2007)	111	
	[D] Post- <i>MedImmune</i> Federal Circuit Decisions	114	
	[1] “All the Circumstances” Test	114	
	[2] Decisions Illustrating <i>Lack</i> of Declaratory Judgment Jurisdiction	116	
	[3] Decisions Illustrating <i>Existence</i> of Declaratory Judgment Jurisdiction	121	121
	[4] Covenants Not to Sue	123	
	[E] Burden of Proof	128	
Chapter 14	ANALYTICAL FRAMEWORK FOR PATENT INFRINGEMENT	135	
§14.01	Statutory Basis: 35 U.S.C. §271	136	
§14.02	Direct Versus Indirect Infringement	138	
	[A] Introduction	138	

	[B] Direct Infringement Under §271(a)	139
	[1] Making	139
	[2] Using	143
	[a] Generally	143
	[b] Using a Claimed <i>System</i>	146
	[c] Using a Claimed <i>Method</i>	154
	[3] Selling	156
	[4] Offering to Sell	158
	[5] Importing	162
§14.03	Territoriality Aspects of §271(a)	164
	[A] Introduction	164
	[B] Use of Processes or Methods Within the United States	165
	[C] “Beneficial Use” Doctrine	166
	[D] “Sells” Within the United States	170
	[E] “Offer[] to Sell” Within the United States	175
§14.04	Temporal Aspects of §271	179
	[A] Pre-Issuance Acts	179
	[B] Post-Issuance Acts	180
§14.05	Divided Direct Infringement by Multiple Entities	181
	[A] Introduction	181
	[B] <i>Akamai II</i> (Fed. Cir. 2012) (<i>en banc</i>)	184
	[C] <i>Akamai III</i> (U.S. 2014)	188
	[D] <i>Akamai V</i> (Fed. Cir. 2015) (<i>en banc</i>)	190
	[1] “Directs or Controls” Liability	192
	[a] Service Provider-Customer Relationship	193
	[b] Physician-Patient Relationship	194
	[c] “Partnership-Like” Relationship	197
	[2] Joint Enterprise Liability	201
	[3] Subsequent History	202
	[E] Pleading Joint (or “Divided”) Direct Infringement	202
	[1] Illustrative Cases <i>Not</i> Alleging Sufficient Facts for a “Plausible” Claim	202
	[2] Illustrative Cases That <i>Do</i> Allege Sufficient Facts for a “Plausible” Claim	206
§14.06	Indirect Infringement Under §271(b)–(c): Overview	211
	[A] Practicing Less Than Complete Claimed Invention	211
	[B] Intent Required	211
	[C] Historical Background	212
	[D] Direct Infringement as Predicate to Indirect Liability	214
§14.07	Two-Step Analysis for Patent Infringement	215
Chapter 15	PATENT CLAIM INTERPRETATION	217
§15.01	The Central Role of Patent Claims	218
§15.02	Judge Versus Jury as Interpreter	221
	[A] Pre- <i>Markman</i>	221
	[B] <i>Markman v. Westview</i> (U.S. 1996)	221

	[C] <i>Markman</i> Hearings	224	
	[D] Must a District Court <i>Always</i> Expressly Interpret Claim Terms?	226	
§15.03	Evidentiary Hierarchy for Claim Interpretation	234	
	[A] Intrinsic Evidence	235	
	[B] Extrinsic Evidence	235	
	[C] “Contextualist” Versus “Literalist” Approaches	237	
	[D] The <i>En Banc Phillips</i> Decision (Fed. Cir. 2005)	239	
§15.04	Canons of Patent Claim Interpretation	241	
	[A] Perspective: Person Having Ordinary Skill in the Art	242	
	[B] General Rule: Ordinary and Customary Meaning	242	
	[1] Decisions Permitting Only “Stringent” Exceptions to Ordinary Meaning	243	
	[2] Decisions Rejecting “Stringent” Exceptions Rule	251	
	[C] Self-Defined Terms (“Own Lexicographer” Rule)	254	
	[1] Express Redefinition	254	
	[2] Implicit Redefinition	255	
	[D] Interpret Claims in View of the Written Description but Do Not Import a Limitation from the Written Description into the Claims	259	
	[E] Generally Do Not Exclude Preferred Embodiment	260	
	[F] Claim Differentiation Principle	262	
	[1] Definition	262	
	[2] Weight of Presumption	263	
	[G] Generally Do Not Interpret Claims to Preserve Validity	265	
	[H] The Indefinite Article “A” Generally Means One or More	267	
	[I] Timing: Interpret Claim Term Meaning as of Effective Filing Date	269	
§15.05	Disclaimer or Disavowal	277	
	[A] In the Specification	277	
	[B] During Prosecution in the USPTO	281	
	[1] Foundational Case	282	
	[2] Disavowal of Scope Must Be Clear and Unmistakable	284	
	[3] Disclaimer by Statements in USPTO Post-Issuance Reviews	289	
§15.06	Interpreting Preamble Language	292	
	[A] Preamble <i>Not</i> Scope-Limiting	292	
	[B] Preamble <i>Is</i> Scope-Limiting	295	
§15.07	Federal Circuit Review of Claim Interpretation Decisions	297	
	[A] Question of Law, Fact, or Mixed	297	
	[B] <i>De Novo</i> Review Under <i>Cybor (en banc)</i> (1998)	298	
	[C] Criticism of <i>De Novo</i> Standard of Review	300	
	[D] Federal Circuit Revisits <i>Cybor</i> in <i>Lighting Ballast</i> (2014)	303	
	[E] Deference for Fact Finding: <i>Teva</i> (U.S. 2015)	309	
	[F] Federal Circuit’s Application of <i>Teva</i>	316	
	[1] Limited Impact to Date	316	
	[2] Federal Circuit Must Not Consider Extrinsic Evidence in First Instance	318	
	[G] Interlocutory Appeals Rejected	324	
§15.08	Collateral Estoppel Effect of Prior Claim Interpretation Decisions	325	
	[A] Generally	325	

[1] Elements	325	
[2] Relevant Supreme Court Decisions	328	
[B] Does Earlier Decision by Federal District Court Necessarily Bind USPTO?		330
[1] Pre-2018 Federal Circuit Decisions	330	
[2] Impact of 2018 USPTO Claim Interpretation Standard Rule Change		332
[C] Effect of Earlier Decision by Federal Circuit	333	
[D] Same Term in Related but Not Identical Patents	336	
[E] Administrative Agency Preclusion Applied to Federal District Courts		339
[1] <i>B&B Hardware</i> (U.S. 2015)	339	
[2] Potential PTAB Preclusion in Federal District Courts?	347	

Chapter 16 COMPARING THE PROPERLY INTERPRETED CLAIMS TO THE ACCUSED DEVICE 351

§16.01	Introduction	353
§16.02	Literal Infringement	353
§16.03	Infringement Under the Doctrine of Equivalents	355
[A]	Historical Background and Policy Underpinnings	355
[B]	Tension with the Notice Function of Claims	356
[C]	All-Limitations Rule	357
[1]	Defining a “Limitation”	357
[2]	Federal Circuit Examples	359
[D]	The Fact Question of Equivalence	360
[1]	Function/Way/Result Test	360
[a]	Generally	360
[b]	Adequate Expert Testimony	361
[c]	Inadequate Expert Testimony	363
[d]	Determination of “Function” Not Limited to Intrinsic Evidence	366
[2]	Insubstantial Differences Test	368
[3]	Obviousness as a Test of Equivalency?	369
[4]	Known Interchangeability	371
[E]	After-Arising Technology	374
§16.04	Reverse Doctrine of Equivalents	378
§16.05	Legal Limitations on the Doctrine of Equivalents	380
[A]	Overview	380
[B]	Prosecution History Estoppel	383
[1]	Definition	383
[2]	Scope of Estoppel	385
[3]	Presumption of Estoppel Under <i>Warner-Jenkinson</i> (U.S. 1997)	386
[4]	The <i>Festo</i> Decisions	388
[a]	Federal Circuit’s Complete Bar Rule of <i>Festo I</i> (2000)	389
[b]	Supreme Court’s Presumptive Bar Rule of <i>Festo II</i> (2002)	391
[c]	Federal Circuit’s Remand Decision in <i>Festo III</i> (2003)	393
[5]	Applying the <i>Festo</i> Rebuttal Criteria	396
[a]	Mere Tangentialness	396
[b]	Unforeseeability	404

	[iii] <i>Commil II</i> (Fed. Cir. 2013) (<i>en banc</i>)	476
	[2] Supreme Court Decisions	478
	[a] “Willful Blindness” Standard: <i>Global-Tech</i> (U.S. 2011)	478
	[b] Good Faith Belief of Invalidity Rejected as Defense: <i>Commil III</i> (U.S. 2015)	479
	[3] Federal Circuit Application of <i>Global-Tech</i> and <i>Commil III</i>	484
	[D] Rejection of Inducing Liability for Divided Infringement	486
	[1] Introduction	486
	[2] <i>Akamai II</i> (Fed. Cir. 2012) (<i>en banc</i>)	486
	[3] <i>Akamai III</i> (U.S. 2014)	492
	[E] Pleading Inducing Infringement	494
§17.03	Contributory Infringement Under §271(c)	499
	[A] Acts	501
	[1] Supply Component	502
	[2] Supply Material or Apparatus	504
	[3] Repair Versus Reconstruction	505
	[B] Non-Staple Article or Commodity of Commerce	506
	[C] Intent Standard for Contributory Infringement	509
	[D] Pleading Contributory Infringement	511
	[E] Relationship to Patent Misuse	513
Chapter 18 SPECIALIZED CATEGORIES OF INFRINGEMENT		515
<hr/>		
	<i>Introduction</i>	516
§18.01	Drug Marketing Application Filings Under 35 U.S.C. §271(e)	516
	[A] Introduction	516
	[B] Technical Infringement Under §271(e)(2)	516
	[1] Paragraph IV Certifications	518
	[2] Automatic Stay	518
	[C] Safe Harbor Under §271(e)(1)	519
	[1] <i>Merck KgaA v. Integra Lifesciences</i> (U.S. 2005)	520
	[2] Federal Circuit Decisions Post- <i>Merck</i>	521
	[D] Settlements of Hatch-Waxman Litigation	526
§18.02	Component Exports Under 35 U.S.C. §271(f)	535
	[A] <i>Deepsouth Packing v. Laitram</i> (U.S. 1972) and Legislative Response	536
	[B] “Supplying or Causing to Be Supplied”	538
	[C] “Components”	538
	[1] <i>Microsoft v. AT&T</i> (U.S. 2007)	539
	[2] Federal Circuit Decisions Post- <i>AT&T</i>	541
	[D] “Actively Induce the Combination” Under §271(f)(1)	544
	[1] Facts of <i>Promega v. Life Techs</i>	545
	[2] “Self-Inducement” Can Create Liability	547
	[E] “Substantial Portion of the Components” Under §271(f)(1)	550
	[1] Federal Circuit View: Evaluate Qualitatively	551
	[2] Supreme Court Reverses: “Substantial Portion” Must Be Evaluated Quantitatively	

		554	
	[F] Territoriality Issues in §271(f) Damage Awards	559	
§18.03	Importation Under 35 U.S.C. §271(g)	560	
	[A] Process Patent Amendments Act of 1988	560	
	[B] Product Made by a Patented Process	561	
	[C] “Materially Changed” Product	564	
Chapter 19	DEFENSES TO PATENT INFRINGEMENT	569	
§19.01	Introduction	571	
§19.02	Noninfringement	573	
§19.03	Absence of Liability for Infringement	573	
	[A] License	574	
	[1] Express License	575	
	[2] Implied License	576	
	[B] Prior User Rights	582	
	[1] Pre-America Invents Act of 2011	582	
	[2] Post-America Invents Act of 2011	584	
	[C] Experimental/Research Use	585	
	[D] Expiration of Damages Limitation Period of 35 U.S.C. §286	589	
	[E] Laches and Equitable Estoppel in Initiating Patent Infringement Litigation	590	
	[1] Introduction	590	
	[a] <i>Aukerman</i> (Fed. Cir. 1992) (<i>en banc</i>)	592	
	[b] <i>Petrella</i> (U.S. 2014)	594	
	[c] <i>SCA Hygiene I</i> (Fed. Cir. 2014)	595	
	[d] <i>SCA Hygiene II</i> (Fed. Cir. 2015) (<i>en banc</i>)	597	
	[e] Supreme Court Eviscerates Patent Laches Defense in <i>SCA Hygiene III</i> (U.S. 2017)	600	
	[2] Laches Framework	604	
	[a] Elements	604	
	[i] Unreasonable Delay by Patentee	605	
	[ii] Material Prejudice to Accused Infringer	608	
	[b] “Should Have Known”	609	
	[3] Equitable Estoppel	610	
	[a] Introduction	610	
	[b] Elements	611	
	[c] Privity	613	
	[d] Misleading Communication	614	
	[e] Reasonable Reliance	615	
	[f] Relationship Between Patent Claims, Misleading Conduct, and Reliance Thereon	615	
	[F] State Sovereign Immunity	621	
	[G] Temporary Presence Exemption	624	
	[H] Patent Exhaustion	626	
	[1] Generally	626	

	[2] Unconditional Sale of Patented Product	627	
	[3] Conditioned Sale of Patented Product	629	
	[a] Federal Circuit Position	629	
	[i] <i>Mallinckrodt</i> (Fed. Cir. 1992)	629	
	[ii] <i>Lexmark Int'l</i> (Fed. Cir. 2016) (<i>en banc</i>)	631	
	[b] Supreme Court Reversal: <i>Impression Prods., Inc. v. Lexmark Int'l</i> (2017)	634	
	[4] Application to Method Claims: <i>Quanta</i> (U.S. 2008)	640	
	[5] Self-Replicating Technology	643	
	[I] Lack of Standing to Sue	645	
§19.04	Unenforceability	647	
	[A] Introduction	647	
	[B] Inequitable Conduct	649	
	[1] Acts or Omissions	650	
	[2] Materiality	656	
	[a] Materiality Standards Pre- <i>Therasense</i> (Fed. Cir. 2011) (<i>en banc</i>)	656	
	[b] Materiality Standard Post- <i>Therasense</i> (Fed. Cir. 2011) (<i>en banc</i>)	659	
	[i] “But For” Test	661	
	[a] No Allowance if USPTO Had Been Aware of Undisclosed Information	661	
	[b] Nondisclosure of Inconsistent Statements or Positions	663	
	[c] Nondisclosure of Prior Art	664	
	[d] Nondisclosure of Corroborating Evidence	669	
	[ii] “Affirmative Egregious Misconduct” Exception	672	
	[iii] Cumulative Information	676	
	[3] Intent to Deceive	676	
	[a] Generally	676	
	[b] Inferring Intent	677	
	[i] Generally	677	
	[ii] Adverse Inference of Intent to Deceive USPTO as Sanction for Litigation Misconduct	678	
	[c] Clear and Convincing Evidence Lacking	683	
	[d] Clear and Convincing Evidence Present	687	
	[e] “Gross Negligence” Insufficient	690	
	[f] Knowledge of Materiality Alone Insufficient	691	
	[g] Intentionally Selective or Partial Withholding	693	
	[h] Unreasonable Explanation for Withholding	696	
	[4] Independence of Materiality and Intent Inquiries	697	
	[5] Overall Equitable Balancing	698	
	[6] Burden of Proof and Standard of Review	700	
	[7] Pleading Inequitable Conduct with Particularity	701	
	[8] Curing Inequitable Conduct	705	
	[a] Federal Circuit Decisions	705	
	[9] Impact on Related Patents	708	
	[C] Patent Misuse	710	

	[1] Generally	710	
	[2] Historical Development	712	
	[a] Tying	712	
	[b] Post-Patent Expiration Royalties	714	
	[3] Not Synonymous with Antitrust Liability	722	
	[4] Statutory Limitations on Patent Misuse: §271(d)	725	
	[D] Prosecution History Laches	729	
	[E] Unclean Hands Based on Misconduct Independent of Inequitable Conduct in Patent Procurement	732	
§19.05	Invalidity	738	
	[A] Burden of Proof	738	
	[1] Generally	738	
	[2] <i>Microsoft v. i4i</i> (U.S. 2011) Confirms “Clear and Convincing Evidence” Burden of Proof	741	
	[B] Collateral Estoppel Effect of Invalidity Adjudication	742	
	[C] Statutory Grounds for Invalidity	743	
	[D] Limits on Accused Infringer’s Standing to Assert Invalidity	744	
	[1] Licensee Repudiation	744	
	[2] Assignor Estoppel	745	
§19.06	Antitrust Counterclaims in Patent Cases	750	
	[A] Generally	750	
	[B] Market Power	751	
	[C] Anticompetitive Conduct	755	
	[1] <i>Walker Process</i> Fraud	756	
	[2] Sham Patent Litigation	759	
	[3] Refusals to Deal	761	

Chapter 20 REMEDIES FOR PATENT INFRINGEMENT 765

§20.01	Introduction	768	
§20.02	Injunctions	769	
	[A] Statutory Basis: 35 U.S.C. §283	769	
	[B] Permanent Injunctions	771	
	[1] Generally	771	
	[2] Federal Circuit Decisions Before <i>eBay v. MercExchange</i> (U.S. 2006)	771	771
	[3] The <i>eBay v. MercExchange</i> (U.S. 2006) Standard	772	
	[4] Appellate Standard of Review	775	
	[5] Factor (1): Irreparable Harm	775	
	[a] Generally	775	
	[b] Causal Nexus Requirement	782	
	[i] <i>Apple III</i> (Fed. Cir. 2013)	783	
	[ii] <i>Apple IV</i> (Fed. Cir. 2015)	787	
	[c] Standard Essential Patents/FRAND Licensing	794	
	[6] Factor (2): Inadequate Remedies at Law	798	
	[7] Factor (3): Balance of Hardships	800	

	[8] Factor (4): Public Interest	803	
	[9] Contempt Proceedings for Violation of Permanent Injunction		805
	[C] Preliminary Injunctions	808	
	[1] Generally	808	
	[2] Preliminary Injunction Factors	809	
	[3] Appellate Standard of Review	810	
	[4] Choice of Law	811	
	[5] Procedural Considerations	812	
	[6] Factor (1): Patentee Likely to Succeed on the Merits	812	
	[7] Factor (2): Patentee Likely to Suffer Irreparable Harm	817	
	[a] Generally	817	
	[b] Causal Nexus Requirement	818	
	[c] Disproving Irreparable Harm	825	
	[8] Factor (3): Balance of the Equities Tips in Patentee's Favor		826
	[9] Factor (4): Injunction Is in the Public Interest	828	
§20.03	Ongoing Royalties for Future Infringements	829	
	[A] Generally	829	
	[B] Illustrative Decisions	830	
	[C] Criticism of Ongoing Royalty Awards	832	
§20.04	Damages for Past Infringements	834	
	[A] Statutory Basis: 35 U.S.C. §284	834	
	[B] Compensatory Damages	835	
	[1] Lost Profits	836	
	[a] The <i>Panduit</i> Analysis	836	
	[i] Demand for the Patented Product	837	
	[ii] Absence of Acceptable Noninfringing Substitutes	838	
	[iii] Manufacturing and Marketing Capability	841	
	[iv] Amount of Profit	841	
	[b] Federal Circuit Expansion of Lost Profits Justification	842	
	[c] Price Erosion Damages	843	
	[d] Territoriality Issues	844	
	[i] Generally	844	
	[ii] <i>WesternGeco</i> (U.S. 2018)	845	
	[2] Apportionment, Entire Market Value Rule, and Conveyed Sales		851
	[a] Conveyed/Accessory Sales	851	
	[b] Entire Market Value Rule Versus Apportionment	853	
	[i] Apportionment in Lost Profits Damages	855	
	[ii] Apportionment in Reasonable Royalty Damages	861	
	[3] Established Royalty	866	
	[4] Reasonable Royalty	868	
	[a] Hypothetical Negotiation	869	
	[b] Date for Hypothetical Negotiation	871	
	[c] Analytical Approach	873	
	[d] Rejected 25% Rule of Thumb	874	

	[e] Rejected Nash Bargaining Solution	875	
§20.05	Enhanced Damages and Willful Infringement	879	
	[A] Statutory Basis: 35 U.S.C. §284	879	
	[B] Enhancement Based on Willfulness	879	
	[1] Generally	879	
	[2] <i>Read Factors</i> for Enhancement	882	
	[C] Willfulness Pre- <i>Seagate</i> (2007)	885	
	[1] Duty of Due Care	885	
	[2] Adverse Inference	885	
	[D] The <i>Seagate</i> Standard: Objective Recklessness	888	
	[1] Objective Recklessness	888	
	[2] <i>Seagate's</i> Two-Part Standard for Willfulness	889	
	[a] Objective Recklessness Prong: High Likelihood of Infringement	890	
	[b] Subjective Prong: Infringer Knew or Should Have Known of Risk	892	
	[3] Scope of Waiver	893	
	[E] Judge Versus Jury and Standard of Review	893	
	[1] Jury Question	893	
	[2] Appellate Standard of Review	894	
	[a] <i>Bard Peripheral</i> (Fed. Cir. 2012)	894	
	[b] <i>Halo</i> (U.S. 2016)	895	
	[F] America Invents Act of 2011 Codification	897	
	[G] Supreme Court Rewrites Law of Willfulness (<i>Halo</i> 2016)	899	
	[1] <i>Halo v. Pulse</i> (Fed. Cir. 2014)	901	
	[2] <i>Stryker v. Zimmer</i> (Fed. Cir. 2015)	905	
	[3] <i>Halo v. Pulse</i> (U.S. 2016)	907	
	[4] Post- <i>Halo</i> Federal Circuit Decisions on Willfulness	912	
	[a] <i>WBIP v. Kohler</i> (Fed. Cir. 2016)	913	
	[b] <i>Halo v. Pulse</i> (Fed. Cir. 2016)	915	
	[c] <i>Stryker v. Zimmer</i> (Fed. Cir. 2016)	916	
	[d] <i>Arctic Cat v. Bombardier</i> (Fed. Cir. 2017)	918	
§20.06	Attorney Fees in Exceptional Cases	920	
	[A] Statutory Basis: 35 U.S.C. §285	920	
	[B] Discretionary with District Court	922	
	[C] Categories of “Exceptional” Cases	924	
	[1] Attorney Fees Imposed Against Patentees: <i>Octane Fitness</i>	928	
	[a] <i>Octane Fitness I</i> (Fed. Cir. 2012)	929	
	[b] <i>Octane Fitness II</i> (U.S. 2014)	931	
	[2] Attorney Fees Imposed Against Infringers	934	
	[3] Federal Circuit Attorney Fee Decisions After Supreme Court’s Decisions in <i>Octane Fitness III</i> / <i>Highmark III</i>	936	
	[D] Burden of Proof	955	
	[E] Standard of Review	956	
	[1] <i>Highmark I</i> (Fed. Cir. 2012)	956	
	[2] <i>Highmark II</i> (Fed. Cir. 2012) (<i>en banc</i>)	958	
	[3] <i>Highmark III</i> (U.S. 2014)	961	

	[F] Prevailing Party	962	
	[G] Reasonable Attorney Fees	965	
	[H] No Attorney Fee-Shifting to USPTO in Civil Actions Under 35 U.S.C. §145	967	967
§20.07	Rule 11 Sanctions	972	
§20.08	Prejudgment Interest	976	
§20.09	Costs	978	
§20.10	Patent Marking	980	
	[A] Statutory Basis: 35 U.S.C. §287	980	
	[B] Notice	981	
	[C] Marking Patented Articles Versus Methods	983	
	[D] “Patent Pending” Designations	983	
	[E] False Marking	984	
	[1] Statutory Basis: 35 U.S.C. §292	984	
	[2] America Invents Act of 2011 Elimination of <i>Qui Tam</i> Actions	985	985
	[F] Burdens of Proof and Production When Patentee Assertedly Failed to Mark	986	986
§20.11	Provisional Compensation Remedy	988	
	[A] Statutory Basis: 35 U.S.C. §154(d)	988	
	[B] “Substantially Identical” Inventions	988	
	[C] Actual Notice	989	
	[D] Statute of Limitations	991	
	[E] Decisions	991	
§20.12	Time Limitation on Damages Recovery	992	
	[A] Statutory Basis: 35 U.S.C. §286	992	
	[B] Six Year Pre-Filing Period	993	
	[C] Claims Against the U.S. Government	993	

Chapter 21 CORRECTING PATENTS IN THE USPTO (REISSUE AND REEXAMINATION) 995

§21.01	Introduction	996
§21.02	Certificates of Correction	996
	[A] USPTO at Fault	997
	[B] Applicant at Fault	998
	[C] No Change in Claim Scope Permitted	998
	[D] Effect of Certificate	998
§21.03	Reissue	999
	[A] Overview	999
	[B] Historical Development	1000
	[C] Statutory Basis: 35 U.S.C. §251	1001
	[1] “Inoperative or Invalid”	1002
	[2] Timing	1003
	[3] New Matter Prohibition	1003
	[4] “Invention Disclosed in the Original Patent”	1005
	[D] Broadening Reissues	1012
	[1] Two-Year Time Bar	1012
	[2] What Constitutes Broadening	1012

	[3] Claim-by-Claim Analysis Required	1015
	[E] Reissue Error	1016
	[F] The Recapture Rule	1021
	[G] Effect of Reissue: Intervening Rights	1023
	[1] Generally	1023
	[2] Statutory Basis	1025
	[3] Absolute Intervening Rights	1025
	[4] Equitable Intervening Rights	1025
	[H] Strategic Considerations for Reissue	1027
§21.04	Disclaimer Under 35 U.S.C. §253	1028
	[A] Disclaimer of Invalid Claims	1028
	[B] Terminal Disclaimers	1029
	[1] Generally	1029
	[2] Unauthorized Filing of Terminal Disclaimers	1029
§21.05	Reexamination	1035
	[A] Overview	1035
	[B] <i>Ex Parte</i> Reexamination	1037
	[1] Who Can Request	1037
	[2] Statutory Grounds for Reexamination	1038
	[3] Substantial New Question of Patentability	1039
	[4] Legislative Changes in Response to <i>Portola</i>	1040
	[C] <i>Inter Partes</i> Reexamination (Pre-America Invents Act of 2011)	1041
	[D] Intervening Rights in Reexamination	1044
§21.06	Reexamination Compared to Reissue	1048

Chapter 22 CHALLENGING PATENTS IN THE USPTO (AIA-IMPLEMENTED PROCEDURES) 1051

§22.01	Introduction	1053
§22.02	<i>Inter Partes</i> Review	1055
	[A] Introduction	1055
	[1] 2012 Implementation	1055
	[2] Statistical Information	1056
	[3] Timing and Procedure	1058
	[B] Scope	1059
	[C] Institution	1060
	[1] “Reasonable Likelihood” of Prevailing Standard	1060
	[2] Claim Interpretation for Institution Decision	1061
	[3] Non-Appealability of Institution Decision	1063
	[a] Statutory Basis	1063
	[b] <i>In re Cuozzo</i> (Fed. Cir. 2015)	1064
	[c] <i>Cuozzo v. Lee</i> (U.S. 2016)	1066
	[d] Post- <i>Cuozzo</i> Federal Circuit Decisions on Non-Appealability of PTAB Institution Determinations	1071
	[i] Are §315 Time Bar Determinations Appealable to Federal Circuit?	1072

[iii]	Assignor Estoppel Not a Bar to Seeking IPR	1074	
[D]	Estoppel Effect	1078	
[E]	Timing Issues	1079	
[1]	Time Bars to Filing an IPR in the USPTO	1079	
[a]	Prior Declaratory Judgment Action Challenging Validity [35 U.S.C. §315(a)]	1079	
[b]	Prior Infringement Action by Patentee Against IPR Petitioner, Its Privy, or Real Party in Interest [35 U.S.C. §315(b)]	1079	
[i]	Judicial Non-Reviewability of PTAB §315(b) Time-Bar Determinations	1080	
[a]	<i>Achates</i> (Fed. Cir. 2015)	1080	
[b]	<i>Wi-Fi One I</i> (Fed. Cir. 2016)	1081	
[c]	<i>Wi-Fi One II</i> (Fed. Cir. 2018) (<i>en banc</i>)	1085	
[d]	<i>Thryv</i> (U.S. 2020)	1089	
[iii]	Meaning of “Privy” in 35 U.S.C. §315(b)	1094	
[2]	Stays of Parallel District Court Litigation When IPRs Have Been Filed	1098	
[a]	Automatic Stay	1098	
[b]	Discretionary Stay	1098	
[F]	Broadest Reasonable Construction Rule for IPRs	1103	
[1]	Propriety of BRC	1103	
[a]	Generally	1103	
[b]	<i>In re Cuozzo</i> (Fed. Cir. 2015)	1104	
[c]	<i>Cuozzo v. Lee</i> (U.S. 2016)	1109	
[2]	Limits on BRC	1115	
[3]	2018 Repeal of BRC Standard for AIA-Implemented Post-Issuance Proceedings	1123	
[G]	Motions to Amend Claims	1124	
[1]	Legal Framework	1126	
[2]	Prior Art Not Relied on to Institute	1127	
[3]	Prior Art in Original Prosecution	1130	
[4]	Burden of Proof for Substitute Claims: <i>In re Aqua Products</i> (Fed. Cir. 2017) (<i>en banc</i>)	1133	
[a]	Introduction	1133	
[b]	<i>Aqua Prods.</i> (Fed. Cir. 2016) (Vacated Panel Decision)	1134	
[c]	Grant of Rehearing <i>En Banc</i> in <i>Aqua Prods.</i>	1135	
[d]	<i>En Banc</i> Decision in <i>Aqua Prods. v. Matal</i> (Fed. Cir. Oct. 2017)	1137	
[i]	Opinion of Judge O’Malley	1138	
[ii]	Opinion of Judge Taranto	1148	
[iii]	Opinion of Judge Reyna	1150	
[iv]	Opinion of Judge Moore	1152	
[v]	Opinion of Judge Hughes	1152	
[e]	Post- <i>Aqua Products</i> Federal Circuit Decisions	1153	
[5]	Federal Circuit Standard of Review	1155	
[H]	Burdens of Proof	1159	
[1]	Generally	1159	

	[2] Institution Decision Does Not Shift Burdens	1163	
	[I] Constitutionality	1166	
	[1] Federal Circuit View	1166	
	[2] Supreme Court Sustains Constitutionality of IPR in <i>Oil States v. Greene’s Energy</i> (2018)	1169	
	[J] Board Must Institute or Not Institute Review of <i>All</i> Patent Claims Challenged in IPR Petition (<i>SAS Institute</i> (U.S. 2018))	1176	
	[1] Federal Circuit View: Partial Institution Permitted	1177	
	[2] Supreme Court View: Partial Institution Not Permitted	1178	
	[K] No Tribal Sovereign Immunity in <i>Inter Partes</i> Review	1182	
§22.03	Post-Grant Review	1185	
	[A] Introduction	1185	
	[B] Effective Date	1187	
	[C] Nine-Month Window	1188	
	[D] Scope	1189	
	[E] Standard to Grant Review	1189	
	[F] Automatic Stay and Estoppel Effect	1190	
§22.04	Transitional Program for Covered Business Method Patents	1190	
	[A] Introduction	1190	
	[1] Generally	1190	
	[2] Federal Circuit’s Interpretation of “Covered Business Method Patent”	1192	
	[B] USPTO First TPCBM Final Decision	1196	
	[C] Discretionary Stay	1202	
Chapter 23	DESIGN PATENTS	1211	
<hr/>			
§23.01	Introduction	1211	
§23.02	Requirements for Design Patentability	1214	
	[A] Primarily Ornamental	1214	
	[B] Novelty	1216	
	[C] Nonobviousness	1217	
	[1] Designer of Ordinary Skill Perspective	1218	
	[2] Two-Step Analysis for Combining Design Prior Art	1219	
	[3] Secondary Considerations	1224	
§23.03	Enforcement of Design Patents	1226	
	[A] “Ordinary Observer” Test of <i>Gorham v. White</i> (U.S. 1871)	1226	
	[B] Discarded “Point of Novelty” Component	1226	
	[C] Modern Standard: <i>Egyptian Goddess</i> (Fed. Cir. 2008) (<i>en banc</i>)	1227	
	[D] Illustrative Decisions After <i>Egyptian Goddess</i>	1229	
	[E] Doctrine of Equivalents and Prosecution History Estoppel	1233	
§23.04	Remedies for Infringement of Design Patents	1243	
	[A] Statutory Basis: 35 U.S.C. §289	1243	
	[B] Apportionment of Infringer’s Profits for Multicomponent Products: <i>Samsung v. Apple</i> (U.S. 2016)	1246	
	[C] Requirement to Elect §284 or §289	1252	

[D] No Enhancement for Willful Infringement Under §289	1253
--	------

Chapter 24	PLANT PATENTS	1255
-------------------	----------------------	-------------

§24.01	Introduction	1255
§24.02	Historical Development	1256
	[A] Plant Patent Act of 1930	1256
	[B] 1954 Amendments	1259
	[C] Plant Variety Protection Act of 1970	1260
§24.03	Requirements for Plant Patent Protection	1262
	[A] Governing Statutes	1262
	[B] Asexual Reproduction	1264
	[C] Variety	1265
	[D] Distinct and New	1266
	[E] Cultivated	1269
	[F] Nonobvious	1272
§24.04	Enforcement of Plant Patents	1273
§24.05	Utility Patent Protection for Plants	1277

Chapter 25	INTERNATIONAL PATENTING ISSUES	1279
-------------------	---------------------------------------	-------------

§25.01	Introduction	1280
	[A] Territorial Scope of Patents	1280
	[B] Obtaining Foreign Patent Protection Prior to the Paris Convention	1281
§25.02	The Paris Convention	1285
	[A] Introduction	1285
	[B] National Treatment	1286
	[C] Right of Priority	1287
	[D] U.S. Implementation of the Paris Right of Priority: 35 U.S.C. §119	1289
	[E] The <i>Hilmer</i> Rule (Pre-America Invents Act of 2011)	1292
	[F] Limitations of the Paris Convention	1295
§25.03	The Patent Cooperation Treaty	1295
	[A] Introduction	1295
	[B] International Application Processing	1296
	[C] National Phase	1297
§25.04	The World Trade Organization's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)	1298
	[A] Introduction	1298
	[B] Dispute Settlement Procedures	1299
	[C] Substantive Minimum Levels of Protection	1300
	[D] Limitations on Compulsory Licensing	1301
§25.05	Patent Harmonization Issues	1303
	[A] Procedural Harmonization	1303
	[B] Substantive Harmonization	1304
	[1] First-to-File Versus First-to-Invent	1304

	[2] Prior User Rights	1307
	[3] Absolute Versus Qualified Novelty: Grace Period	1308
§25.06	Industrial Applicability Requirement of Foreign Patent Systems	1310
	[A] Definition of Industrial Applicability	1310
	[B] Morality/Public Policy Component	1310
§25.07	Gray Market Patented Goods	1311
	[A] Domestic Exhaustion	1312
	[B] Regional (European Community-Wide) Exhaustion	1312
	[C] International Exhaustion	1313
	[1] Generally	1313
	[2] Federal Circuit Rejection of International Exhaustion	1314
	[3] <i>Lexmark Int'l</i> (Fed. Cir. 2016) (<i>en banc</i>)	1316
	[4] Supreme Court Adopts International Exhaustion of U.S. Patent Rights in <i>Impression Prods.</i> (2017)	1320
§25.08	Enforcement of Foreign Patents in U.S. Courts	1326
§25.09	Patent Protection in Europe	1329
	[A] Routes to Obtain Patent Protection	1329
	[B] Routes to Enforce Patents	1330
	[1] Unitary Patent System	1331
	[2] Unified Patent Court	1332
Glossary	1335	
Table of Cases		1347
Table of Authorities		1463
Table of Statutes		1489
Index		1509