## Table of Contents

About the Contributors .............................................................. vii

Table of Chapters ........................................................................ xvii

## Chapter 1  Substantive Issues of a Patent Case

*Laurence H. Pretty*

§ 1:1 Introduction ........................................................................ 1-3

§ 1:1.1 Generally ........................................................................ 1-3

§ 1:1.2 The 1952 and 2011 Patent Acts ...................................... 1-4

§ 1:2 Elements of a Patent Owner’s Case ...................................... 1-4

§ 1:2.1 Title and Right to Sue ..................................................... 1-4

[A] Establishing Chain of Title .............................................. 1-4

[B] Right of Exclusive Licensee to Sue .................................. 1-6

§ 1:2.2 Proof of Infringement ..................................................... 1-7

[A] Burden of Proof ............................................................... 1-7

[B] Acts of Infringement ......................................................... 1-7

[B][1] Direct Infringement Within the United States ................. 1-7

[B][2] Infringement with Extraterritorial Component ............. 1-7

[B][3] Induced Infringement ....................................................... 1-9

[B][4] Contributory Infringement ............................................. 1-11

[B][5] Other Acts of Infringement ........................................... 1-12

[B][6] Joint Infringement of a Method Claim ......................... 1-12

[C] Infringement of a Utility Patent ........................................ 1-12

[C][1] Literal Infringement of a Patent Claim ......................... 1-12

[C][2] Claim Construction and *Markman* Proceedings .......... 1-13

[C][3] Claims Containing a Means-Plus-Function Element ..... 1-14

[C][4] Application of the Claim to the Accused Product or Process ................................................................. 1-15

[C][5] Infringement Under the Doctrine of Equivalents ........... 1-16

[D] Infringement of a Design Patent ....................................... 1-18

[E] Infringement of a Plant Patent .......................................... 1-20

(Pat. Litigation, Rel. #6, 4/15) xxii
§ 1:2.3 Validity of the Patent ................................................ 1-21
  [A] Presumed Validity of Each Patent Claim ............. 1-21
  [B] Burden of Proof in Attacking Validity and 
      Enforceability .............................................. 1-22
  [C] Right to an Earlier Effective Filing Date ....... 1-24
§ 1:2.4 Remedies .................................................................. 1-26
§ 1:3 Defenses of Accused Infringer .......................................... 1-27
§ 1:3.1 License and Assignment Defenses ......................... 1-27
  [A] Licensee Estoppel Abrogation and 
      Exceptions ...................................................... 1-27
  [B] Implied License .............................................. 1-28
§ 1:3.2 Noninfringement Defenses ...................................... 1-29
  [A] No Literal Infringement .................................. 1-29
  [B] Limitations on the Doctrine of Equivalents .... 1-29
  [B][1] Prosecution History Estoppel .................. 1-29
  [B][2] Prior Art As Limitation .......................... 1-31
  [B][3] Disclosed But Unclaimed Embodiments ..... 1-31
  [C] Functionality Defense to Design Patent 
      Infringement .................................................. 1-32
  [D] Repair Versus Reconstruction .......................... 1-32
  [E] ANDA ........................................................... 1-33
  [F] Prior Commercial Use Defense 
      (Patents Subject to the 2011 Act) ................... 1-33
§ 1:3.3 Defenses Against Patent Validity ......................... 1-34
  [A] Expiration for Nonpayment of Maintenance 
      Fees ............................................................. 1-34
  [B] Collateral Estoppel by Prior Adjudication 
      of Invalidity .................................................. 1-35
  [C] Lack of Novelty over the Prior Art 
      Under Section 102 ......................................... 1-35
  [C][1] The 1952 and 2011 Acts Differ in the 
        Prior Art Applicable to Applications 
        Filed Before and After March 16, 2013 .... 1-36
  [D] Prior Art Under the 1952 Act ......................... 1-37
  [D][1] Sections 102[a] and [b] ............................... 1-37
  [D][2] Section 102[e] ........................................... 1-43
  [D][3] Section 102[g] ........................................... 1-43
  [E] Prior Art Under the 2011 Act ......................... 1-45
  [E][1] Changes Expanding Prior Art ...................... 1-46
  [E][2] One-Year Grace Period re Disclosures 
        from the Inventor ..................................... 1-47
  [E][3] Derivation Proceedings Created; 
        Interferences Eliminated ......................... 1-47
  [E][4] Subsections of Sections 102 and 104 
        Dropped by the 2011 Act ............................. 1-48
Table of Contents

[E][5] Tax Strategies Deemed Insufficient to Differentiate from the Prior Art............... 1-48
[E][6] Best Mode Still Required but No Longer an Invalidity Defense........... 1-49
[F] Obviousness (§ 103)........................................ 1-49
[F][1] *Graham v. Deere* and *KSR* Analyses........... 1-49
[F][2] Objective Evidence re Obviousness........... 1-52
[G] Misnamed Inventorship.............................. 1-54
[H] Inadequately Disclosed or Claimed (§ 112) .... 1-54
[H][1] Enablement......................................... 1-55
[H][2] Best Mode.......................................... 1-56
[H][3] Written Description ......................... 1-57
[H][4] Indefinitely Claimed......................... 1-57
[I] Abandonment .................................. 1-58
[J] Double Patenting.................................. 1-58
[K] Nonstatutory Subject Matter or Inoperativeness ....................................... 1-59

§ 1:3.4 Defenses of Patent Unenforceability .................. 1-63
[A] Inequitable Conduct Before the PTO.................. 1-64
[A][1] Inequitable Conduct Generally................ 1-64
[A][2] Materiality.................................. 1-65
[A][3] Intent to Deceive................................ 1-67
[A][4] Consequences of Inequitable Conduct ...... 1-68
[B] Laches and Equitable Estoppel .................. 1-69
[B][1] In Litigation................................... 1-69
[B][2] Laches in Patent Prosecution................. 1-70
[C] Patent Misuse.................................. 1-71
[C][1] Tying Unpatented Supplies.................. 1-71
[C][2] Compulsory Package Licensing............ 1-72
[C][3] Price Fixing, Field of Use, Territorial, and Post-Sale Restrictions........ 1-73

§ 1:3.5 Patent Exhaustion..................................... 1-74
§ 1:4 Immunity of States................................... 1-76
§ 1:5 Claims Against a Patent Owner..................... 1-76
§ 1:5.1 Challenges to Patent Liability, Inventorship, or Validity...................... 1-76
[A] For Declaratory Judgment....................... 1-76
[B] To Reform Inventorship Under 35
   U.S.C. § 256..................................... 1-77
[C] Challenging Validity by PTO
   Reexamination ................................ 1-77

(Pat. Litigation, Rel. #6, 4/15) xxiii
§ 1:5.2 Claims for Damages Caused by Abuse of Patent Rights ............................................................ 1-78
[A] Unfair Competition Basis ............................................. 1-78
[B] Antitrust Violation Basis .............................................. 1-78
[B][1] Fraud on the PTO .............................................. 1-78
[B][2] After an “Objectively Baseless” Prior Suit ... 1-79
[B][3] Reverse Payment Settlement .................................. 1-80
[C] Standards-Setting Issues ............................................ 1-81

Chapter 2 Investigation Needed Before Bringing Suit

John M. Skenyon

§ 2:1 From Suspicion of Infringement to Adequate Investigation ........................................................................... 2-2

[A] Claim Construction .................................................. 2-10
[B] Comparing the Construed Claims with the Accused Product or Process .................................................. 2-16
[C] Other Areas to Investigate ........................................ 2-23
[D] Nonpracticing Entities ............................................... 2-24

§ 2:1.2 Pre-Suit Opinion Letter ............................................. 2-26

§ 2:1.3 Risk of Laches After the Duty to Inquire Arises .... 2-27

§ 2:2 Forming a Strategy to Achieve the Business Objective .... 2-28

§ 2:2.1 Is Injunction or Licensing the Goal? ......................... 2-28

§ 2:2.2 How Extensive Are Damages So Far and How Extensive Might They Become? ................................. 2-29

§ 2:2.3 Does Management Have the Fortitude for a Long Haul? ................................................................. 2-30

§ 2:2.4 Should the Patent Owner Move for a Preliminary Injunction? ................................................................. 2-31

§ 2:3 Selection of Litigation Team and Experts ..................... 2-34

§ 2:3.1 Pre-Suit Investigation Team ..................................... 2-34

§ 2:3.2 Fee Arrangements .................................................. 2-35

§ 2:3.3 Selecting Experts .................................................... 2-37

§ 2:4 Patent Owner’s Pre-Suit Search for Weaknesses in Its Case ........................................................................... 2-39

§ 2:4.1 Title and Right to Sue Problems .............................. 2-40

§ 2:4.2 Maintenance Fees .................................................. 2-44

§ 2:4.3 Marking and Notice Problems .................................. 2-45

§ 2:4.4 On Sale and Public Use Problems .......................... 2-48
[A] Patents Filed Before March 16, 2013 ......................... 2-48
[B] Patents Filed After March 16, 2013 .......................... 2-49

§ 2:4.5 Inequitable Conduct Problems .............................. 2-49

§ 2:4.6 Conferring with Likely Witnesses ......................... 2-50
Table of Contents

§ 2:4.7 Documents .............................................................. 2-51
  [A] Locating Important Documents .............................. 2-51
  [B] Spoliation Problems ............................................ 2-52
§ 2:4.8 Purging Misuse Problems ......................................... 2-53
§ 2:4.9 Whether Derivation Is an Issue ............................... 2-54
§ 2:5 Whether the Patent Position Should Be Strengthened
  Before Suit .................................................................. 2-54
  § 2:5.1 Ex Parte Reexamination ........................................... 2-54
  § 2:5.2 Reissue ..................................................................... 2-56
  § 2:5.3 Supplemental Examination Under AIA ............... 2-57
  § 2:5.4 Continuation Practice .............................................. 2-58
§ 2:6 Contacting the Infringer or Its Customers
  Before Filing Suit .......................................................... 2-59
  § 2:6.1 Reasons for Notice ................................................... 2-59
  § 2:6.2 The Risks of Giving Notice ..................................... 2-60
§ 2:7 Patent Owner’s Choices .............................................. 2-60
  § 2:7.1 Choice of Defendants .............................................. 2-60
  § 2:7.2 Choice of Venue ..................................................... 2-61
  [A] Joinder of Unrelated Defendants in
      One Venue Narrowed by AIA ....................................... 2-63
  § 2:7.3 Choice of Jury or Bench Trial .................................. 2-64
§ 2:8 Defendant’s Choices .................................................. 2-64
  § 2:8.1 Meeting the Requirements of Rule 11 of the
         Federal Rules of Civil Procedure .............................. 2-65
  § 2:8.2 Whether Prior Commercial Use Is Available
         Against Infringement ............................................... 2-66
  § 2:8.3 Preemptive Strike by Declaratory Judgment ............ 2-67
  § 2:8.4 Whether to Attack Validity in Court
         or in the PTO .......................................................... 2-67
  § 2:8.5 Settlement and Defensive Materials .................. 2-68
  § 2:8.6 Is Another Entity Responsible? .......................... 2-69
  § 2:8.7 Design Around ......................................................... 2-69

Chapter 3 Opening Phase

Andrei Iancu and Amir Naini

§ 3:1 Introduction .............................................................. 3-2
§ 3:2 Complaint ............................................................... 3-2
  § 3:2.1 Essentials of the Complaint ................................. 3-2
  § 3:2.2 Pendent State Law Claims ................................. 3-9
  § 3:2.3 Declaratory Judgment Actions .............................. 3-9
§ 3:3 Answer ............................................................... 3-10
  § 3:3.1 Essentials of the Answer ..................................... 3-10
  § 3:3.2 Pleading Inequitable Conduct .............................. 3-11

(Pat. Litigation, Rel. #6, 4/15) XXV
PATENT LITIGATION

§ 3:3.3 Counterclaims .......................................................... 3-14
§ 3:4 Jurisdiction, Venue, and Transfer ..................................... 3-17
§ 3:4.1 Subject Matter Jurisdiction ........................................ 3-17
[A] “Arising Under” Jurisdiction ........................................ 3-17
[B] Pendent Jurisdiction .................................................. 3-19
[C] Declaratory Judgment Jurisdiction .............................. 3-20
§ 3:4.2 Personal Jurisdiction .............................................. 3-22
§ 3:4.3 Venue ................................................................. 3-26
§ 3:4.4 Suits for Patent Infringement Against a Government Entity .................................................. 3-30
§ 3:5 Procedural Motions in the Opening Phase ....................... 3-31
§ 3:5.1 Rule 12(b) and 12(e) Motions .................................. 3-31
§ 3:5.2 Motions re Indispensable Parties ............................. 3-33
§ 3:5.3 Motions to Bifurcate ................................................. 3-34
§ 3:5.4 Transfer Motions .................................................. 3-38
§ 3:5.5 Motion to Recuse .................................................. 3-41
§ 3:5.6 Motions for Expedited Relief/Ex Parte Application ........ 3-42
§ 3:6 Early Meeting of Counsel Under Rule 26 and Local Rules ........................................................................ 3-42
§ 3:7 Protective Orders to Protect Confidential Information ......................................................................................... 3-46
§ 3:8 Early Neutral Evaluation Procedures ............................... 3-51
§ 3:9 Relations with Opposing Counsel ...................................... 3-52

Chapter 4 Discovery and Privilege

Brian E. Ferguson

§ 4:1 Introduction ............................................................... 4-4
§ 4:1.1 Purpose of This Chapter ........................................... 4-4
§ 4:1.2 Source of Discovery Rules ......................................... 4-4
§ 4:2 General Objectives of Discovery in Patent Cases ............ 4-4
§ 4:2.1 In General .............................................................. 4-4
§ 4:2.2 Discovery Objectives for a Patentee ........................ 4-5
§ 4:2.3 Discovery Objectives for an Accused Infringer ......... 4-8
§ 4:3 Scope of Discovery ...................................................... 4-10
§ 4:4 Mandatory Disclosures ................................................ 4-11
§ 4:4.1 In General .............................................................. 4-11
§ 4:4.2 Initial Conference of Counsel and Report Thereon—Rule 26(f) ......................................................... 4-11
[A] In General .............................................................. 4-11
[B] Subject of Conference ................................................ 4-12
[C] Report on Proposed Discovery Plan .............................. 4-13
[D] Patent Infringement Cases ........................................... 4-13

xxvi
| § 4:4.3 | Initial Disclosures—Rule 26(a)(1) | 4-15 |
| A | In General | 4-15 |
| B | Subject of Disclosure | 4-15 |
| C | Duty of Supplementation | 4-16 |
| D | Initial Disclosures in Patent Infringement Cases | 4-16 |
| § 4:4.4 | Disclosure of Expert Testimony—Rule 26(a)(2) | 4-18 |
| A | In General | 4-18 |
| B | Subject of Disclosure | 4-18 |
| C | Expert Disclosures in Patent Cases | 4-19 |
| § 4:4.5 | Pretrial Disclosures and Objections Thereto—Rule 26(a)(3) | 4-23 |
| A | In General | 4-23 |
| B | Subject of Disclosure | 4-23 |
| C | Subject of the Objections | 4-24 |
| § 4:4.6 | Notice of Prior Art Used in Defense | 4-24 |
| § 4:5 | Requests for Production of Documents and Things and Inspection—Rule 34 | 4-25 |
| § 4:5.1 | Requests for Production | 4-25 |
| § 4:5.2 | Responses to Requests for Production | 4-26 |
| § 4:5.3 | Duty of Supplementation of Responses to Requests for Production | 4-27 |
| A | Requests for Production in Patent Cases | 4-28 |
| § 4:6 | Interrogatories | 4-28 |
| § 4:6.1 | In General | 4-28 |
| § 4:6.2 | Scope of Interrogatories | 4-28 |
| § 4:6.3 | Scope of Interrogatories in an Infringement Case | 4-29 |
| § 4:6.4 | Interrogatory Responses | 4-31 |
| § 4:6.5 | Duty of Supplementation of Interrogatory Responses | 4-32 |
| § 4:7 | Requests for Admissions | 4-33 |
| § 4:7.1 | Procedure for Requests | 4-33 |
| § 4:7.2 | Procedure for Responses | 4-33 |
| § 4:7.3 | Content of Responses | 4-34 |
| § 4:7.4 | Effect of Admissions | 4-34 |
| § 4:7.5 | Duty of Supplementation of Responses | 4-34 |
| § 4:7.6 | Use of Requests for Admissions in Patent Infringement Cases | 4-35 |
| § 4:8 | Depositions | 4-35 |
| § 4:8.1 | Purpose and Advantages | 4-35 |
| A | Pre-Deposition Planning | 4-36 |
| B | Deposition Tactics and Pointers | 4-37 |
| C | Preparing a Witness to Give a Deposition | 4-38 |
| D | Waiver Problems Associated with Use of Documents in Witness Preparation | 4-39 |
PATENT LITIGATION

[E] Defending Depositions and Typical Objections ........................................ 4-41
[F] Rule 31—Depositions upon Written Questions ........................................ 4-42
[G] Place of Deposition ........................................................................ 4-42

§ 4:8.2 Video Depositions ........................................................................ 4-43
§ 4:8.3 Subject Matter of Depositions by Type of Witness and Deposition .......... 4-43
[A] Deposing Rule 30(b)(6) Witnesses .................................................. 4-43
[B] Deposing Fact Witnesses .................................................................. 4-45
[C] Topics Covered by Patentee in Depositions ....................................... 4-46
[D] Topics Covered by Accused Infringer in Depositions ......................... 4-47

§ 4:8.4 Deposing Expert Witnesses ....................................................... 4-50
[A] Expert Witnesses and Required Expert Reports .................................. 4-50
[B] Tips for Deposing Experts ................................................................ 4-51
[C] Time of Taking ............................................................................... 4-52

§ 4:8.5 Restrictions on Depositions ....................................................... 4-52
[A] Total Number of Depositions ......................................................... 4-52
[B] Number of Depositions of a Single Person ........................................ 4-52
[C] Schedule and Duration .................................................................... 4-53
[D] Judge on the Case or in the Discovery Locale ..................................... 4-53

§ 4:8.6 Instructions Not to Answer/Allowable Testimony ......................... 4-53
[A] Questions Regarding Legal Opinion or Conclusion ............................ 4-54
[B] Questions Regarding Interpretation of Claims ..................................... 4-55

§ 4:8.7 Dealing with Abuse or Obstruction ............................................ 4-57
§ 4:8.8 Compelling Appearance/Testimony ............................................ 4-59
[A] Compelling the Witness to Appear .................................................. 4-59
[B] Compelling Answers at a Deposition ................................................. 4-60

§ 4:9 Rule 45 Subpoenas to Nonparties .................................................. 4-61
§ 4:9.1 Subpoenas in General ................................................................. 4-61
§ 4:9.2 Subpoenas in Patent Infringement Cases ...................................... 4-62
§ 4:9.3 Response to Subpoenas ............................................................... 4-62

§ 4:10 Self-Help Discovery ................................................................. 4-63
§ 4:11 Limitations on Discovery ............................................................. 4-65
§ 4:11.1 Burdensome Discovery ............................................................. 4-65
§ 4:11.2 Claims of Privilege or Protection of Trial Preparation Materials ........... 4-66
[A] In General .................................................................................... 4-66
§ 4:11.3 Trial Preparation Materials in General .................... 4-67
§ 4:11.4 Discovery of Nontestifying Experts ..................... 4-67
[A] Documents/Information Generated During Prosecution .... 4-67
§ 4:11.5 Invention Disclosures ........................................... 4-70
[A] Opinions of Counsel to Rebut Charge of Willful Infringement 4-70
§ 4:12 Motions for Protective Order............................................ 4-76
§ 4:12.1 Grounds for a Protective Order.............................. 4-76
§ 4:12.2 Procedure for Moving for a Protective Order .......... 4-77
§ 4:12.3 Stipulated Protective Order Regarding Confidential Information 4-77
§ 4:13 Discovery Motion Practice and Sanctions ..................... 4-80
§ 4:13.1 Rule 37 Motion to Compel...................................... 4-80
[A] Prior to a Motion to Compel ........................................ 4-80
[B] Filing a Motion to Compel .......................................... 4-80
[C] Delay or Failure to File Motion to Compel ..................... 4-81
[D] Opposing a Motion to Compel ..................................... 4-82
[E] Recovery of Attorneys’ Fees and Costs ......................... 4-83
[F] Failure to Comply with an Order to Compel .................. 4-83
§ 4:13.2 Sanctions Available Without a Discovery Order ........ 4-85
§ 4:13.3 Failure to Provide Electronically Stored Information ............. 4-85
§ 4:13.4 Spoliation of Evidence ........................................... 4-86
§ 4:13.5 Rule 26(g) Motions.................................................. 4-88
§ 4:13.6 Miscellaneous Other Discovery Motions .................... 4-89
[A] Extensions of Time .................................................... 4-89
[B] Motion to Be Relieved of Admissions .......................... 4-90
§ 4:13.7 Appeals from Discovery Orders ............................... 4-91

Chapter 5 Attorney-Client Privilege and Work Product Immunity
Karen A. Jacobs, Megan E. Dellinger, and Eleanor G. Tennyson

§ 5:1 Introduction ........................................................................ 5-2
§ 5:2 Attorney-Client Privilege ................................................. 5-3
§ 5:2.1 Defining the Privilege ................................................... 5-3
§ 5:2.2 Resolving Disputes ...................................................... 5-4
§ 5:2.3 Attorney-Client Privilege Issues Typical in Patent Litigation .............................................. 5-5
[A] Who Qualifies As an Attorney? ................................. 5-5
(Pat. Litigation, Rel. #6, 4/15)
[A][2] Patent Agents Registered to Practice Before the PTO ..................... 5-6
[A][3][a] Courts Extending the Privilege to Communications with Foreign Nonattorney Patent Agents .................................. 5-9
[A][3][b] The U.K. As an Example ........................................ 5-13
[A][3][c] Courts Denying the Privilege to Communications with Foreign Patent Agents ................................................... 5-14
[B] What Types of Communications Are Protected? .................................................. 5-15
[B][1] Prosecution Documents.............................................. 5-15
[B][1][a] The Jack Winter Line of Cases ................................ 5-16
[B][1][b] The Knogo Line of Cases ....................................... 5-17
[B][1][c] More Recent Federal Circuit Law .............................. 5-19
[B][2] Opinion Letters................................................. 5-21
[B][3] Licensing and Settlement Documents .......................... 5-23
[C] Who Qualifies As a Client? ............................ 5-24

§ 5:2.4 Joint Defense Privilege ........................................... 5-26

§ 5:3 Attorney Work Product Immunity .................................. 5-30
§ 5:3.1 Defining the Immunity.................................................. 5-30
§ 5:3.2 Resolving Disputes .................................................. 5-32
§ 5:3.3 The Immunity in Patent Litigation ............................. 5-33
§ 5:3.4 “Anticipation of Litigation” ..................................... 5-33
§ 5:3.5 Typical Documents in Patent Litigation ........................ 5-35
[A] Opinion Letters ...................................................... 5-35
[B] Patent Prosecution Documents .................................. 5-37
[D] Pre-Suit Investigations ............................................. 5-39
[E] Licensing and Settlement .......................................... 5-40
[F] Party or Party Representative ..................................... 5-40

§ 5:4 Waiver of Attorney-Client Privilege .................................. 5-41
§ 5:4.1 Generally ......................................................... 5-41
§ 5:4.2 Inadvertent Waiver ................................................. 5-43
§ 5:4.3 Intentional Waiver ................................................. 5-49
[A] Willful Infringement; Inducement of Infringement ..................... 5-49
[B] Inequitable Conduct .................................................. 5-57
[C] Estoppel ............................................................... 5-59

§ 5:4.4 Timing and Scope of Intentional Waiver ........................ 5-60
§ 5:4.5 Waiver Resulting from Corporate Transactions ................. 5-61

§ 5:5 Waiver of Work Product Immunity .................................. 5-67
Table of Contents

§ 5:5.1 Generally................................................................. 5-67
§ 5:5.2 Inadvertent Waiver................................................... 5-67
§ 5:5.3 Intentional Waiver ................................................... 5-69
  [A] Willful Infringement ............................................. 5-69
  [B] Disclosing Work Product to Experts ....................... 5-72
§ 5:6 Piercing the Attorney-Client Privilege and
  Work Product Immunity ............................................. 5-74
§ 5:7 Conclusion ....................................................................... 5-75

Chapter 6 Organization, Vendor Support, and Cost Control

Timothy J. Malloy, Stephen F. Sherry, and
Kirk A. Vander Leest

§ 6:1 Developing a Central Organizational Framework for
  the Case........................................................................ 6-2
§ 6:2 Organizing a Trial Team............................................. 6-9
  § 6:2.1 Team Leaders ..................................................... 6-9
  § 6:2.2 Other Lawyers .................................................. 6-11
  § 6:2.3 Local Counsel .................................................. 6-11
  § 6:2.4 In-House Counsel ............................................. 6-12
  § 6:2.5 Temporary Personnel ......................................... 6-12
  § 6:2.6 Turnover............................................................ 6-13
§ 6:3 Document Organization and Retrieval............................ 6-13
  § 6:3.1 Electronic Case Management and Filing ............... 6-14
  § 6:3.2 Micro Versus Macro Document Management ......... 6-14
  § 6:3.3 Indexing Categories ........................................... 6-15
  § 6:3.4 Control Numbers and Copying ............................. 6-16
  § 6:3.5 Imaging Systems .............................................. 6-18
  § 6:3.6 Considerations Regarding Electronic Discovery ....... 6-19
§ 6:4 Organizing Deposition Materials .................................... 6-22
  § 6:4.1 Planning.............................................................. 6-22
  § 6:4.2 Taking the Deposition, Indexing, and Digesting........ 6-23
  § 6:4.3 Videotaping Depositions ..................................... 6-24
  § 6:4.4 Using Deposition Testimony ................................. 6-26
§ 6:5 Using Database Systems............................................. 6-26
§ 6:6 Obtaining Patent Materials ........................................ 6-29
§ 6:7 Obtaining a Claim Construction Ruling ....................... 6-31
§ 6:8 Creating Demonstrative Exhibits and Videos ............... 6-32
§ 6:9 Jury Consultants ...................................................... 6-35
§ 6:10 Other Litigation Support Vendors .............................. 6-38
  § 6:10.1 Copying Services ............................................. 6-38
  § 6:10.2 Graphics Services .......................................... 6-39
  § 6:10.3 Services for the Electronic Courtroom ................. 6-40
§ 6:11 Budgeting and Cost Control....................................... 6-42
Chapter 7  Nondiscovery Motions and Court-Initiated Procedures

Gary M. Hoffman, Charles W. Saber, and Dipu A. Doshi

§ 7:1 Introduction ....................................................................... 7-2
§ 7:2 Markman Proceedings for Claim Interpretation................. 7-3
  § 7:2.1 Markman in General .................................................... 7-3
  § 7:2.2 When a Markman Determination Is Necessary ........ 7-6
  § 7:2.3 Procedural Contexts in Which Claim Interpretation Arises ................................................. 7-8
  § 7:2.4 Evidence Considered in Determining Claim Construction......................................................... 7-11
  § 7:2.5 Manner in Which Courts Construe Claims ............ 7-13
  § 7:2.6 Role of Witnesses ......................................................... 7-29
  § 7:2.7 Use of Court-Appointed Experts .............................. 7-31
  § 7:2.8 Necessity of a Hearing to Decide Claim Construction........................................................................... 7-32
  § 7:2.9 Timing of Markman Hearings ................................. 7-33
  § 7:2.10 Timing Established by Local Rules .......................... 7-36
  § 7:2.11 Appeal of Claim Construction Decisions ................ 7-40
§ 7:3 Summary Judgment Motions ........................................... 7-42
  § 7:3.1 Introduction............................................................. 7-42
  § 7:3.2 Summary Judgment Motions by the Patentee ......... 7-44
  § 7:3.3 Summary Judgment for the Accused Infringer......... 7-45
  § 7:3.4 Procedural Aspects of Motions for Summary Judgment......................................................................... 7-47
§ 7:4 Nondiscovery Procedural Motions.................................... 7-49
  § 7:4.1 Introduction............................................................. 7-49
  § 7:4.2 Motion for Separate Trials (Bifurcation)................... 7-50
  § 7:4.3 Motion for Appointment of a Special Master ........ 7-52
  § 7:4.4 Motions for Leave to Amend ................................... 7-53
§ 7:5 Pretrial and Scheduling Conferences ................................ 7-55
  § 7:5.1 Initial Scheduling Order............................................. 7-55
§ 7:6 Court-Initiated Settlement Procedures............................ 7-57
  § 7:6.1 Alternative Dispute Resolution Programs
       Used by Federal District Courts........................................... 7-57
  § 7:6.2 Court-Initiated ADR Programs in Patent Cases ...... 7-59

Chapter 8  Witnesses Special to a Patent Case

Mark T. Banner, Christopher J. Renk, and Ted L. Field

§ 8:1 Introduction ....................................................................... 8-2
§ 8:2 The Inventor ...................................................................... 8-4
  § 8:2.1 The Patent Owner’s Approach to the Inventor ..... 8-4

xxxii
[A] The Inventor’s Role in a Patent Owner’s Case ......................................................... 8-5
[B] Inventor Problems and Overcoming Them ............................................................. 8-8
§ 8:2.2 The Defendant’s Approach to the Inventor .............................................. 8-13
§ 8:2.3 The Hostile Inventor ......................................................................................... 8-17
§ 8:3 Expert Witnesses ............................................................................................... 8-18
§ 8:3.1 Qualifying Experts at Trial and Presenting Their Opinions ................................ 8-20
§ 8:3.2 Technical Expert .............................................................................................. 8-32
§ 8:3.3 Patent Law Expert ......................................................................................... 8-41
§ 8:3.4 Damages Expert .............................................................................................. 8-47
§ 8:3.5 Deposition of Experts ...................................................................................... 8-51
§ 8:3.6 Non-Testifying Experts .................................................................................. 8-51
§ 8:4 Fact Witnesses .................................................................................................. 8-54
§ 8:4.1 Designers of Accused Infringing Products .................................................. 8-54
§ 8:4.2 Nonparty Invalidity Witness ........................................................................... 8-56
§ 8:4.3 Witness Regarding Inequitable Conduct Before the PTO ................................ 8-59
§ 8:4.4 The Willfulness Witness ................................................................................. 8-62

Chapter 9 Damages and Attorney Fees

Laurence H. Pretty

§ 9:1 Statutory Basis .................................................................................................. 9-3
§ 9:1.1 Damages on U.S. Sales of Components Used Overseas in a Process Patented in the United States ................................................................................................. 9-3
§ 9:1.2 Damages Base and Exclusions ..................................................................... 9-4
§ 9:2 Determination of Liability Period ...................................................................... 9-5
§ 9:2.1 Start and End of Patent Term ........................................................................ 9-5
§ 9:2.2 Start and End of Infringement ...................................................................... 9-5
§ 9:2.3 Six-Year Pre-Complaint Limitation ................................................................ 9-7
§ 9:2.4 Limitations Imposed by the Patent Marking Statute ........................................ 9-7
§ 9:3 Tests for Entitlement to a Lost Profit Measure of Damages ................................ 9-8
§ 9:3.1 Requirement for Causation Generally ......................................................... 9-8
§ 9:3.2 Panduit Test for Lost Profits ......................................................................... 9-10
[A] Demand for Patented Product .......................................................................... 9-10
[B] Absence of Acceptable Noninfringing Substitute .............................................. 9-11
[C] Capacity .............................................................................................................. 9-13
[D] Quantum of Lost Profits .................................................................................... 9-14
§ 9:3.3 Alternatives to Panduit Test .......................................................................... 9-14

(Pat. Litigation, Rel. #6, 4/15) xxxiii
§ 9:3.4 Lost Profits or Infringers’ Profits on a Design Patent

§ 9:4 Calculation of Amount of Lost Profits

§ 9:4.1 Profits on the Patented Product Lost to the Infringing Products

§ 9:4.2 Profits on Unpatented Products Sold by the Patentee Lost to Infringing Products

§ 9:4.3 Profits on Ancillary Products Meeting the Entire Market Value Test

§ 9:4.4 Profits Lost Due to Price Erosion Damages

§ 9:5 Reasonable-Royalty Measure of Recovery

§ 9:5.1 Reasonable Royalty Based on Hypothetical Pre-Infringement Negotiations

§ 9:5.2 Reasonable Royalty Based on a Fraction of the Patentee’s Lost Profits

§ 9:5.3 Reasonable Royalty Based on a Fraction of Infringer’s Anticipated Profit

§ 9:5.4 Reasonable Royalty Limited by the Differential Cost of Using an Alternative Noninfringing Technology

§ 9:5.5 Reasonable Royalty Based on a Flat Fee or Milestone Payments

§ 9:5.6 Georgia-Pacific Factors

§ 9:5.7 Blended Damages Award of Lost Profits and Reasonable Royalty Based on Market Share

§ 9:5.8 Liquidated Damages Against Violating Licensee

§ 9:5.9 Compelled Royalty for a Winning Patentee After Denial of a Permanent Injunction

§ 9:5.10 Reasonable Royalty, Entire Market Value, and Surveys

§ 9:6 Proving the Amount of Damages

§ 9:6.1 Foundational Fact Evidence of Damages

[A] Sales and Marketing Fact Witnesses

[B] Adverse Witnesses Employed by the Infringer

[C] Licensing Witnesses

[D] Capacity Witnesses

§ 9:6.2 Use of a Damages Expert

[A] Selection of a Damages Expert

[B] Expert’s Team

[C] Protection of Attorney Work Product

[D] Procedural Issues re Damages Evidence

§ 9:6.3 Damages for Post-Verdict Sales

§ 9:7 Effect of Bifurcation on Trial of Damages

§ 9:8 Demonstrative Exhibits
§ 9:9 Prejudgment Interest ........................................................ 9-37
§ 9:10 Increased Damages ....................................................... 9-38
§ 9:10.1 Willfulness and Who Determines It ........................ 9-38
§ 9:10.2 Willfulness = Objective Recklessness ...................... 9-39
§ 9:10.3 Judicial Discretion on Enhancement ....................... 9-41
§ 9:10.4 Privilege and Disqualification ............................... 9-42
§ 9:10.5 Requirements for Opinion Adequacy ....................... 9-44
[A] Competence and Comprehensiveness ...... 9-45
[B] Timeliness .......................................................... 9-46
§ 9:11 Award of Attorney Fees ............................................ 9-47
§ 9:12 False Marking ................................................................ 9-49
§ 9:12.1 Under 1952 Act ....................................................... 9-49
§ 9:12.2 Under 2011 Act ....................................................... 9-51

Chapter 10 Injunctions

John F. Sweeney

§ 10:1 Introduction ..................................................................... 10-2
§ 10:1.1 Types of Injunctions ..................................................... 10-2
§ 10:1.2 Statutory Basis for Injunctive Relief ............................ 10-4
§ 10:2 Historical Origins of Injunctive Relief ............................ 10-9
§ 10:3 Injunctive Relief in Patent Law Prior to the Federal Circuit ......................................................... 10-11
§ 10:4 Preliminary Injunctions.................................................. 10-11
§ 10:4.1 Preliminary Injunction Hearing .................................... 10-13
§ 10:4.2 Likelihood of Success on the Merits ....................... 10-14
§ 10:4.3 Irreparable Harm .................................................... 10-18
§ 10:4.4 Balance of Hardships Between the Parties .......... 10-21
§ 10:4.5 Public Interest ....................................................... 10-22
§ 10:4.6 Posting of Bond ..................................................... 10-23
§ 10:4.7 Standard of Review ................................................ 10-24
§ 10:5 Persons Bound by Injunction ......................................... 10-26
§ 10:6 Permanent Injunctions ................................................... 10-28
§ 10:6.1 Public Interest Implications ....................................... 10-31
§ 10:6.2 Scope of Injunctive Relief ......................................... 10-32
§ 10:7 Enforcement of Injunctions ......................................... 10-34
§ 10:8 Unclean Hands .............................................................. 10-36
§ 10:9 Laches, Acquiescence, and Delay .............................. 10-38
§ 10:10 Relation of Injunctive Relief to Jury Trial .................. 10-38
§ 10:10.1 Injunctive Relief and Assertion of Invalidity and Noninfringement ........................................ 10-38
§ 10:10.2 Injunctive Relief and Damages ............................... 10-42
§ 10:11 Tactical Considerations Concerning Applications for Preliminary Injunctive Relief ....................... 10-44
Chapter 11  Pretrial Proceedings

Don W. Martens and John B. Sganga, Jr.

§ 11:1  Introduction ................................................................. 11-2
§ 11:2  Establish the Theme of Your Case ............................... 11-3
  § 11:2.1  Theme of Patent Owner’s Case ................................. 11-3
  § 11:2.2  Theme of Accused Infringer’s Case ............................ 11-4
  § 11:2.3  Building on the Theme ........................................... 11-4
§ 11:3  Pretrial Conference and Associated Filings .................... 11-5
  § 11:3.1  Exhibit Lists and Objections .................................. 11-5
  § 11:3.2  Witness List ........................................................... 11-7
  § 11:3.3  Designations of Deposition Testimony ..................... 11-9
  § 11:3.4  Memorandum of Contentions of Fact and Law ............ 11-11
  § 11:3.5  Joint Pretrial Order ................................................ 11-12
  § 11:3.6  Pretrial Conference ............................................... 11-13
  § 11:3.7  Trial Brief ............................................................ 11-13
  § 11:3.8  Filings Unique to the Bench Trial ............................ 11-14
§ 11:4  Additional Filings and Hearings for Jury Trials ............... 11-15
  § 11:4.1  Jury Instructions .................................................... 11-15
  § 11:4.2  Verdict Form and Special Interrogatories ................ 11-16
  § 11:4.3  Voir Dire Questions ............................................... 11-17
§ 11:5  Section 282 Notice of Prior Art ................................... 11-17
§ 11:6  Motions in Limine and Bench Briefs ............................. 11-18
§ 11:7  Other Motions, or Stipulations, Related to Trial Conduct ............................................... 11-19
  § 11:7.1  Set Order of Proofs ............................................... 11-19
  § 11:7.2  Sequestering Witnesses ......................................... 11-20
  § 11:7.3  Protective Order Regarding Confidential Documents ............................................... 11-20
  § 11:7.4  Permit and Regulate Use of Electronic Presentation Media ............................................... 11-21
§ 11:8  Logistical Arrangements with the Court ....................... 11-22
  § 11:8.1  Viewing the Courtroom ......................................... 11-22
  § 11:8.2  Equipment and File Setup in the Courtroom ............. 11-23
  § 11:8.3  Exhibit Tagging .................................................... 11-23
  § 11:8.4  Ascertaining Exhibit Procedures Required by Judge ............................................... 11-23
  § 11:8.5  Arrangements for Daily Transcripts ........................ 11-23
Table of Contents

§ 11:9 Preparing Witnesses for Trial................................................. 11-24
§ 11:10 Preparation of Internal Documentation.............................. 11-25
  § 11:10.1 Opening Statement and Closing Argument................... 11-25
  § 11:10.2 Direct Testimony Outlines........................................... 11-25
  § 11:10.3 Cross-Examination Testimony Outlines........................ 11-25
§ 11:11 Logistical Arrangements for the Trial Team....................... 11-26
  § 11:11.1 Setting Up a “War Room” for Trial.............................. 11-26
  § 11:11.2 Staffing and Accommodations................................. 11-27
  § 11:11.3 Assigning Clear Lines of Responsibility.................... 11-27
  § 11:11.4 Trial Subpoenas and Witness Fees............................ 11-27
  § 11:11.5 Role of Local Counsel.............................................. 11-27
  § 11:11.6 Scheduling Witnesses............................................. 11-28
  § 11:11.7 Arranging Local Copying and Local Litigation Graphics Support.............................................................. 11-28
  § 11:11.8 Arranging for Visible Presence of Corporate Representatives at Trial.................................................. 11-28

Chapter 12 Trial

David W. Beehler, Munir R. Meghjee, and David A. Prange

§ 12:1 Planning the Order of Presentation of Evidence.................. 12-3
  § 12:1.1 Patent Owner’s Case.................................................. 12-3
  § 12:1.2 Accused Infringer’s Case.......................................... 12-4
§ 12:2 Jury Matters ..................................................................... 12-6
  § 12:2.1 Juror Profile, Information, and Voir Dire..................... 12-6
  § 12:2.2 Use of Jury Consultants............................................. 12-8
§ 12:3 Trial Team ...................................................................... 12-10
  § 12:3.1 Organize a Core Group That Knows the Case Intimately.... 12-10
  § 12:3.2 Project a Professional Attitude................................. 12-10
§ 12:4 Use of Electronic Courtroom Technology......................... 12-11
  § 12:4.1 Document Control and Display.................................. 12-11
  § 12:4.2 Computer Graphics.................................................... 12-12
    [A] Persuasive Value.................................................. 12-12
    [B] Animations......................................................... 12-13
    [C] Cost.................................................................. 12-14
    [D] Admissibility................................................... 12-15
  § 12:4.3 Other Visual Aids..................................................... 12-17
  § 12:4.4 Real-Time Court Reporting..................................... 12-18
§ 12:5 Opening Statements.......................................................... 12-18
  § 12:5.1 For the Patent Owner.................................................. 12-19
    [B] Disbelief............................................................... 12-20

(Pat. Litigation, Rel. #6, 4/15)   xxxvii
PATENT LITIGATION

[C] Problem Solved/Tutorial ................................ 12-20
[D] How to Read a Patent ....................................... 12-20
[E] Presumption of Validity .................................... 12-20
[F] Prior Art ........................................................ 12-20
[G] Experts .......................................................... 12-21

§ 12:5.2 For the Accused Infringer ........................................ 12-21

§ 12:6 Testimony ........................................................................ 12-22

§ 12:6.1 Presentation of Live Witnesses on Direct .................... 12-22
[A] Generally .......................................................... 12-22
[B] Witness Order .................................................... 12-23
[C] Credibility and Appearance Factors .............................. 12-23
[D] Use of Adverse Witnesses for Your Own Case .................... 12-23

§ 12:6.2 Presentation of Testimony by Deposition, Including Use of Video Presentation ........ 12-26

§ 12:6.3 Expert Witnesses at Trial ........................................ 12-27
[B] Technical and Fact Experts ...................................... 12-29
[C] Legal Experts ...................................................... 12-29
[D] Damages Experts .................................................. 12-30

§ 12:6.4 Cross-Examination and Impeachment ...................... 12-31

§ 12:6.5 Making Objections ............................................... 12-32

§ 12:6.6 Offers of Proof ...................................................... 12-34

§ 12:7 Admission of Other Evidence and Use of Demonstrative Aids ........................................ 12-35

§ 12:7.1 Factual Exhibits .................................................. 12-35

§ 12:7.2 Summaries ......................................................... 12-37

§ 12:7.3 Demonstrative Exhibits ........................................ 12-38

§ 12:7.4 Written Discovery Responses and Pretrial Statement Facts ........................................ 12-38

§ 12:8 Proof of Special Issues ............................................. 12-38

§ 12:8.1 Issues to Be Decided by the Court ......................... 12-39
[A] Equitable Estoppel and Inequitable Conduct ...................... 12-39
[B] Injunctive Relief .................................................... 12-39
[C] Enhanced Damages ............................................... 12-39
[D] Prejudgment and Post-Judgment Interest ....................... 12-40
[E] Attorneys’ Fees ..................................................... 12-41
[F] Section 112 Definiteness and Enablement ...................... 12-41

§ 12:8.2 Issues to Be Decided by the Jury .............................. 12-41
[A] Infringement ......................................................... 12-41
[B] Novelty ............................................................. 12-42
[C] Nonobviousness .................................................... 12-42
[D] Section 112 Best Mode ............................................ 12-42

xxxviii
Table of Contents

[E] Section 112 Written Description.......................... 12-42
[F] Damages .......................................................... 12-43
[G] Willfulness ...................................................... 12-43

§ 12:9 Motions During Trial ........................................ 12-43
§ 12:9.1 Evidence Motions and Bench Briefs ................. 12-43
§ 12:9.2 Motions in Bench Trials .............................. 12-44
§ 12:9.3 Rule 50[a] Motion for Judgment As a Matter of Law [JMOL] ................................................. 12-45

§ 12:10 Closing Arguments ........................................ 12-47
§ 12:11 Post-Trial Motions ......................................... 12-47
§ 12:11.1 Rule 50[b] Motion for Judgment As a Matter of Law ...................................................... 12-47
§ 12:11.2 Motions for New Trial .................................. 12-50
§ 12:11.3 Injunctions, Interest, Enhanced Damages, and Attorneys’ Fees .................................. 12-52
§ 12:11.4 Rule 52 Amendments to the Findings .......... 12-52
§ 12:11.5 Rule 60 Proceedings for Relief from Judgment ... 12-53
§ 12:11.6 Stays of Execution ..................................... 12-58
§ 12:12 Judgment ................................................... 12-59

Chapter 13 Appeal

Allen M. Sokal, James R. Barney, and J. Derek McCorquindale

§ 13:1 Introduction .................................................. 13-2
§ 13:2 The Federal Circuit in General ......................... 13-3
§ 13:2.1 Origin and Structure of the Court .................... 13-3
§ 13:3 Jurisdictional Considerations: Subject Matter and Timing .................................................. 13-6
§ 13:3.1 When Do You Have a “Patent” Case? .......... 13-6
§ 13:3.2 When May You Approach the Federal Circuit for Relief? ........................................ 13-10
[A] Final Decisions ............................................... 13-10
[B] Complete Resolution of a Severable Part of the Case .................................................. 13-10
[C] Interlocutory Appeals ....................................... 13-11
[D] Collateral Order Doctrine ................................ 13-12
[E] Petitions for Extraordinary Writs ......................... 13-13
§ 13:4.1 Applicable Patent Precedents ......................... 13-15
§ 13:4.2 Nonpatent Substantive Law .......................... 13-16
§ 13:4.3 Applicable Procedural Law .......................... 13-17
§ 13:5 Limitations on Appellate Review................................. 13-18
§ 13:5.1 Scope of Review ....................................................... 13-18
§ 13:5.2 Limitation to Evidence, Argument, and
Objections Advanced in the Trial Court
Record................................................................. 13-23
§ 13:6 Pre-Appeal Actions in the Trial Court............................ 13-24
§ 13:6.1 Supplementation of the Record and
Preservation of Issues............................................... 13-24
§ 13:6.2 Obtaining an Appealable Order ............................. 13-26
§ 13:6.3 Deciding Whether to Appeal at All....................... 13-27
§ 13:6.4 Motion to Stay Injunction or Execution of
Judgment................................................................... 13-28
§ 13:6.5 Filing the Notice of Appeal .................................... 13-30
§ 13:6.6 Consideration of Cross-Appeal .............................. 13-31
§ 13:7.1 Sequence, Content, and Timing of Submissions ... 13-32
§ 13:7.2 Issue Selection ....................................................... 13-35
§ 13:7.3 Practical Considerations in Briefing...................... 13-36
[B] Statement of the Case................................... 13-37
[C] Statement of the Facts .................................. 13-38
[D] Argument ...................................................... 13-39
[E] Summary of Argument ................................. 13-40
[F] Conclusion.................................................... 13-40
[G] Appellee’s Brief.............................................. 13-41
[H] Reply Brief..................................................... 13-41
§ 13:8 Oral Argument ............................................................... 13-42
§ 13:9 Decision ......................................................................... 13-44
§ 13:10 Post-Decision Proceedings .............................................. 13-45
§ 13:11 Conclusion ................................................................. 13-46

Chapter 14 Patent Litigation Other Than District Court
Infringement Actions
Paul D. Tripodi II
§ 14:1 Introduction ................................................................. 14-3
§ 14:2 Litigation Against the U.S. Government for
Compensation for Unauthorized Use of a Patent ............ 14-4
§ 14:2.1 Exclusive Jurisdiction in U.S. Court of
Federal Claims ............................................................... 14-4
§ 14:2.2 Position of Suppliers to the Government.............. 14-6
[A] “By or for the United States” ............................... 14-8
[B] “Authorization or Consent” ................................. 14-11
§ 14:2.3 Substantive Patent Principles and Controlling Precedent.................................................. 14-12
§ 14:2.4 Unavailability of Injunctive Relief and Jury............ 14-14
§ 14:2.5 Procedure ............................................................... 14-15
  [B] Nationwide Jurisdiction ........................................ 14-16
  [C] Commencement of Action in Court of Federal Claims ........................................... 14-16
  [D] Other Provisions of the RCFC That Deviate from the Federal Rules ............ 14-17
  [E] Statute of Limitations ........................................ 14-17
§ 14:2.6 Determination of Amount Awarded ...................... 14-18
  [A] Reasonable Royalty........................................ 14-19
  [A][1] Royalty Compensation Base Calculation...14-20
  [A][2] Reasonable Royalty Rate Determination ...14-20
  [B] Lost Profits.................................................... 14-22
  [C] Percentage of Governmental Cost Savings... 14-23
  [D] Delay Damages ............................................. 14-23
§ 14:2.7 Defenses Special to Court of Claims Cases........... 14-24
  [A] March-In Rights............................................ 14-24
  [B] Exhaustion of Administrative Remedies ...... 14-25
§ 14:2.8 Appeal .................................................................... 14-26
§ 14:3 Federal Civil Actions Arising Under the Patent Laws Other Than for Infringement .......... 14-26
  [B] Interference Proceedings Declared on or After September 16, 2012 ......................14-32
  [C] Derivation Proceedings ...................................... 14-32
§ 14:3.3 Under 35 U.S.C. § 291 Involving Interfering Patents or Derived Patents .................... 14-33
  [A] Interfering Patents Under Pre-AIA
      35 U.S.C. § 291 .................................................. 14-34
  [B] Derived Patents Under Post-AIA
§ 14:3.4 Under 35 U.S.C. § 256 to Correct Joinder of Inventor .................................................. 14-36
  [A] Substantive Requirements .................................. 14-37
  [B] Burden of Proof .............................................. 14-38
  [C] Diligence ....................................................... 14-39
§ 14:4.1 Introduction .............................................................. 14-39
§ 14:4.2 Complaint ................................................................ 14-44
§ 14:4.3 Response ................................................................. 14-47
§ 14:4.4 Protective Order ....................................................... 14-49
§ 14:4.5 Discovery in the ITC ....... ... ... ... ... ... ... ... ... 14-49
§ 14:4.6 ITC Motion Practice .................................................. 14-52
§ 14:4.7 Domestic Industry .................................................... 14-55
[B] Domestic Industry Requirement Has Two Prongs That Must Be Satisfied ..... 14-56
[B][1] Economic Prong ....................................................... 14-57
[B][2] Technical Prong ....................................................... 14-57
[C] Early Determination Pilot Program ....................... 14-60
§ 14:4.8 Hearing ................................................................. 14-60
§ 14:4.9 Conclusion ............................................................. 14-62

Chapter 15 Challenging Validity in the PTO
Under the 2011 America Invents Act
Charles Barquist and Matthew Kreeger
§ 15:1 Introduction .............................................................. 15-3
§ 15:2 Ex Parte Reexamination .................................................. 15-4
§ 15:3 Inter Partes Review ........................................................ 15-5
§ 15:3.1 Generally ................................................................. 15-5
§ 15:3.2 Procedure ................................................................. 15-6
[A] Petition ............................................................... 15-6
[B] Decision ............................................................ 15-9
[C] Appeal ............................................................ 15-12
§ 15:3.3 PTAB Trial Practice Rules ....................................... 15-12
§ 15:3.4 Differences from Prior Law ...................................... 15-13
§ 15:3.5 Effective Date .......................................................... 15-15
§ 15:3.6 Estoppel .............................................................. 15-16
§ 15:3.7 Litigation Stays Pending Inter Partes Review .......... 15-16
§ 15:4 Post-Grant Review ....................................................... 15-17
§ 15:4.1 Generally ................................................................. 15-17
§ 15:4.2 Procedure ................................................................. 15-18
[A] General ............................................................... 15-18
[B] Petition ............................................................... 15-18
[C] Decision ............................................................ 15-22
[D] Appeal ............................................................ 15-24
§ 15:4.3 Estoppel .............................................................. 15-24
§ 15:4.4 Litigation Stays Pending Post-Grant Review ........ 15-25