

## **LAW 691 – PATENT LITIGATION**

**Andy Halaby**  
**Spring 2015**

Class hours: Tuesdays, 6:00-8:55 p.m.

Office hours: After class and by appointment

### My contact information

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### Course Objective

This is a practical course, drawn on real world litigation experience, addressing key issues in patent litigation. We will cover, at a minimum, pre-litigation issues including pre-filing investigation and identifying proper parties; jurisdiction, venue, and pleadings; disclosure and discovery; privilege issues; experts; dispositive motions, pretrial, and trial; claim construction; infringement and limitations thereon; invalidity; unenforceability; remedies; appeal; and other related proceedings. We will survey applicable provisions of Titles 28 and 35 of the United States Code, including amendments wrought by the America Invents Act of 2011, as well as the Federal Rules of Civil Procedure (“FRCP”). **Reading assignments are, and lectures will be, designed to help students gain an understanding of what the real world practice of law is like. In particular, we will talk about many of the cutting-edge cases that real world patent litigators are talking about, right now.**

Prior completion of, or at least concurrent enrollment in, Civil Procedure is strongly encouraged. Prior completion of, or at least concurrent enrollment in, Evidence and an introductory course addressing patent law is desirable, but not required.

NOTE: If you’ve already taken an introductory patent law course, you will find a bit of the assigned reading duplicative.

## Materials

There is one required book for this course: Kimberly A. Moore, Timothy R. Holbrook, and John F. Murphy, *Patent Litigation and Strategy* (4th ed. 2013), which is abbreviated “CB” in the reading assignments below.

Where cases, rules, statutes, or other materials outside the casebook are assigned, you are responsible for procuring them. Note, though, that I’ve supplied links to most of these cases.

## Assignments

You should complete each week’s assignment, **including Week 1’s assignment**, before that week’s class.

“Read” means to carefully study so as to be prepared to participate in class regarding, and ultimately to be examined on, that material.

“Bkgrd,” if used at all, means to read for background. You won’t be examined on this material unless I specifically tell you otherwise, but you’ll get a lot more out of lecture if you read it.

“Skim”: Our time together is limited; there are aspects of the course’s subject matter that we don’t have time to get into very deeply. The “Skim” material addresses topics that I want you to be aware of, particularly if you plan to practice patent litigation. Perhaps obviously, you won’t be examined on this material.

I may sometimes distribute or post on Blackboard additional materials of interest.

## Attendance and Grading

See the Statement of Student Policies. You will take a final examination of an as-yet-to-be-determined format. Last year’s exam was a short, take home memorandum. This year’s exam may or may not follow that format.

Students sometimes ask whether they can do a research paper instead of the final. You can’t.

Beyond the substantive and procedural subject matter, I want you to learn something about legal reasoning, jurisprudence, and practical application of the law. You should consider these topics, as discussed in class in the context of our subject matter, fair game for the exam.

## Syllabus

<u>Week</u>	<u>Date</u>	<u>Topic</u>	<u>Assignment</u>
1	Jan. 13	<b>I. Course introduction</b>  <b>II. Pre-Litigation and Parties — Who can bring suit?</b> A. Assignment vs. license B. Declaratory judgment actions C. Pre-suit investigations	<u>Read</u> CB 23-52 (to “1”) <u>Skim</u> CB 52 (from “1”)-56 (to <i>Medimmune</i> ) <u>Read</u> CB 56 (from <i>Medimmune</i> )-78 (to <i>EMC</i> ) CB 89 (from “C”)-95 (through “5”)
2	Jan. 20	<b>III. Jurisdiction, Venue, and Pleadings</b> A. The proper court: Where can you bring suit? B. Jurisdiction C. Venue D. Joinder E. Pleadings	<u>Read</u> CB 99-101 (to “A”) <u>Bkgrd</u> CB 101 (from “A”)-109 (to “B”) <u>Read</u> CB 109 (from “B”)-118 (to <i>Genetic</i> ) <u>Skim</u> CB 118 (from <i>Genetic</i> )-129 (to “C”) <u>Read</u> CB 129 (from “C”)-130 <u>Bkgrd</u> CB 131-135 (to “1”) <u>Read</u> CB 135 (from “1”)-151, 157-182 (through <i>Vivid</i> ) <u>Bkgrd</u> CB 182 (from <i>Vivid</i> )-186 <u>Skim</u> CB 187-192

<u>Week</u>	<u>Date</u>	<u>Topic</u>	<u>Assignment</u>
3	Jan. 27	<p><b>IV. Disclosure, Discovery, and Privilege</b></p> <p>A. Scope of discovery  B. Discovery mechanisms  C. Discovery planning  D. Opposing discovery</p> <p><b>V. Experts</b></p> <p>A. Inventors  B. Selection of experts  C. Types of experts  D. Expert discovery  E. Role of expert testimony</p>	<p><u>Read</u>  CB 193-212 (through “b”)</p> <p><u>Bkgrd</u>  CB 212 (from “b”)-222 (to “3”)</p> <p><u>Read</u>  CB 222 (from “3”)-227</p> <p><u>Skim</u>  United States District Court, District of Arizona  Local Rules of Civil Procedure 33.1, 36.1, 37.1</p> <p><u>Read</u>  CB 228-245 (to <i>Deutsche Bank</i>)</p> <p><u>Skim</u>  CB 245-266</p> <p><u>Read</u>  CB 267-289</p> <p><u>Skim</u>  CB 290-292</p>
4	Feb. 3	<p><b>VI. Dispositive Motions, Pretrial, and Trial</b></p> <p>A. Summary judgment  B. Motions in limine  C. Bifurcation, trifurcation, and order of trial  D. Final pretrial conference</p> <p><b>VII. Claim Construction</b></p> <p>A. Who construes/matter of law</p>	<p><u>Read</u>  CB 293-310 (to <i>Elf</i>)  CB 312 (from “D”)-355 (to “B”)</p> <p><u>Skim</u>  CB 355 (from “B”)-356 (to “C”)</p>

<u>Week</u>	<u>Date</u>	<u>Topic</u>	<u>Assignment</u>
5	Feb. 10	<b>VII. Claim Construction (cont'd)</b> B. Canons of claim interpretation  <b>VIII. Infringement</b> A. Literal B. Equivalents	<u>Read</u> CB 356 (from “C”)-393 (to “Problems”) CB 405-423 (to “C”)
6	Feb. 17	<b>VIII. Infringement (cont'd)</b> C. Acts constituting infringement D. Means-plus-function claims	<u>Read</u> CB 423 (from “C”)-434 (to <i>Centillion</i> ) <u>Bkgrd</u> CB 434 (from <i>Centillion</i> )-443 (to “2”) <u>Read</u> CB 443 (from “2”)-452 (to <i>Akamai</i> ) <a href="#"><i>Limelight Networks v. Akamai Techs.</i></a> , No. 12-786 (U.S. June 2, 2014) CB 459 (from “Notes”)-464 (to “3”) <u>Skim</u> CB 464 (from “3”)-529 (to “6”) <u>Read</u> CB 531 (from “D”)-541 (to <i>Noah</i> ) <u>Skim</u> CB 541 (from <i>Noah</i> ) to 546 (to “Notes”) <u>Read</u> CB 546 (from “Notes”)-552 (to <i>Epcon</i> ) <u>Bkgrd</u> CB 552 (from <i>Epcon</i> )-553 (to “Problems”)

<u>Week</u>	<u>Date</u>	<u>Topic</u>	<u>Assignment</u>
7	Feb. 24	<b>IX. Limitations on Infringement</b> A. All Elements/Limitations Rule B. Prosecution history estoppel C. Practicing the prior art D. Disclosure in specification dedicated to public if not claimed E. All Advantages Rule F. Prior user rights	<u>Read</u> CB 555-594 (to “C”) <u>Skim</u> CB 594 (from “C”)-606 (to “D”) <u>Read</u> CB 606 (from “D”)-624 (to “G”)

<u>Week</u>	<u>Date</u>	<u>Topic</u>	<u>Assignment</u>
8	Mar. 3	<p><b>IX. Limitations on Infringement (cont'd)</b> G. License/exhaustion</p> <p><b>X. Invalidity</b> A. Overcoming the presumption of validity B. Identifying prior art C. Patentable subject matter and utility D. Anticipation—§ 102</p>	<p><u>Read</u> CB 624 (from “G”)-635 (to “Problems”) CB 639-643 (to “Eligible Subject Matter”))</p> <p><u>Skim</u> CB 643 (from “Eligibility Subject Matter”)-649 (to “D”)</p> <p><u>Read</u> <a href="#"><i>DDR Holdings v. Hotels.com</i></a>, No. 2013-1505 (Fed. Cir. Dec. 5, 2014) (Parts I and II.B only; skim dissent). CB 649 (from “D”)-651 (to “Patentee’s Rebuttal Evidence . . . .”)</p> <p><u>Skim</u> CB 651 (from “Patentee’s Rebuttal Evidence . . . .”)-653 (to “2”)</p> <p><u>Read</u> CB 653 (from “2”)-659 CB 661 (from Note 1)-663 (through Note 5)</p> <p><u>Skim</u> CB 663 (“Patentee’s Rebuttal Evidence . . . .”)</p> <p><u>Read</u> CB 663 (from “3”)-688 (to “4”)</p> <p><u>Skim</u> CB 688 (from “4”)-691 (to “8”)</p>
9	Mar. 17	<p><b>X. Invalidity (cont'd)</b> AIA and the shift to first-to-file</p> <p>E. Obviousness—§ 103 F. Inadequate specification—§ 112</p>	<p><u>Read</u> CB 691-727 (to “Problems”) CB 729 (from “F”)-740 (to <i>Ariad</i>)</p> <p><u>Skim</u> CB 740 (from <i>Ariad</i>) to 757 (to “Notes”)</p> <p><u>Read</u> CB 757 (from “Notes”)-759</p>

<u>Week</u>	<u>Date</u>	<u>Topic</u>	<u>Assignment</u>
10	Mar. 24	<b>X. Invalidity (cont'd)</b>  <b>XI. Unenforceability</b> A. Inequitable conduct B. Misuse C. Laches and equitable estoppel	<u>Read</u> CB 760 (1st ¶ under “3” only) <a href="#">Nautilus v. Biosig Instrs.</a> , No. 13-3369 (U.S. June 2, 2014) CB 771-772 (to “1”) <u>Skim</u> CB 772 (from “1”)-781 (to “Notes”) <u>Read</u> CB 781 (from “Notes”)-802 (to <i>Princo</i> ) <u>Bkgrd</u> CB 802 (from <i>Princo</i> )-817 <u>Read</u> CB 818-820 (to “C”) <u>Skim</u> CB 820 (from “C”)-831 (to “D”) <u>Read</u> CB 831 (from “D”)-849 (to “7”) <u>Skim</u> <a href="#">Petrella v. Metro-Goldwyn-Mayer</a> , No. 12-1315 (U.S. May 19, 2014) <a href="#">D. Chisum post</a> , PatentlyO, Jan. 2, 2015.
11	Mar. 31	<b>XII. Remedies</b> A. Injunctions B. Damages	<u>Read</u> CB 867-889 (through “Notes”) <u>Skim</u> CB 889 (from “Notes”)-929 (to “Problems”) <u>Read</u> CB 931-959 (to “B”)

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12	Apr. 7	<b>XII. Remedies (cont'd)</b>  C. Enhanced monetary awards D. Marking	<u>Read</u> CB 959 (from “B”)-996 <u>Skim</u> CB 997-1009 (to <i>Beckman</i> ) <u>Read</u> <a href="#"><i>Octane Fitness v. ICON Health &amp; Fitness</i></a> , No. 12-1184 (U.S. Apr. 29, 2014) <a href="#"><i>Highmark v. Allcare Health Mgmt.</i></a> , No. 12-1163 (U.S. Apr. 29, 2014) <u>Skim</u> CB 1014 (from “Notes”)-1016 <u>Read</u> CB 1020 (from “D”)-1031 (to “Notes”) <u>Skim</u> CB 1031 (from “Notes”)-1035 (to “Problems”)
13	Apr. 14	<b>XIII. Post-Issuance Proceedings at the PTO</b> A. <i>Ex parte</i> reexamination B. <i>Inter partes</i> review C. Post-grant review D. Claim construction E. Strategic considerations	<u>Read</u> CB 1111-1149 (to “F”) <u>Skim</u> CB 1149 (from “F”)-1153 <i>Fresenius USA v. Baxter Int’l</i> , 721 F.3d 1330 (Fed. Cir. 2013), including dissent.