

SYLLABUS – FALL 2021

Patent Office Litigation LAW 306-001 Fall 2021

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COURSE SCHEDULE/MEETING TIMES/TYPE:

This course will meet on Mondays from 8:10 pm – 10:10 pm.

OFFICE HOURS/AVAILABILITY TO STUDENTS OUTSIDE CLASS MEETING TIMES:

By appointment.

REQUIRED [& OPTIONAL] TEXTS:

- The required readings in this class will consist primarily of cases from the U.S. Supreme Court, Federal Circuit Court of Appeals, federal district courts, and Patent Trial and Appeal Board. We will send you copies of the required cases (often edited for length) in advance of each class.
- **Recommended Textbook: None**
- **PTAB Strategies and Insights Newsletter:** PDF and Article List on TWEN (updated monthly)
- **Other Sources:**
 - Rules of Practice: 37 C.F.R. Part 42
<https://www.uspto.gov/sites/default/files/documents/tmlaw.pdf>
 - AIA Statute 35 U.S.C. §§ 311–319 (IPR); §§ 321–329 (PGR); §§ 302–307 (Reexam): <https://www.govinfo.gov/app/details/USCODE-2012-title35/USCODE-2012-title35-partIII-chap31-sec311/context>
 - PTAB: <http://www.uspto.gov/ip/boards/bpai/index.jsp>
 - PTAB E2E general: <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/patent-trial-and-appeal-board-end.html>
 - PTAB E2E search for a case: <https://ptab.uspto.gov/#/login>
 - Office Patent Trial Guide (Plus 2018 and 2019 Updates): <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice->

- [guide-november-2019](#)
- Derivation Proceedings: http://www.uspto.gov/aia_implementation/2012-22204-derivation-proceedings.pdf
- Interferences: <https://www.uspto.gov/patents-application-process/appealing-patent-decisions/interference/interferences>
- USPTO AIA FAQs: http://www.uspto.gov/aia_implementation/faq.jsp
- Representative PTAB Orders, Decision, and Notices: http://www.uspto.gov/ip/boards/bpai/representative_orders_and_opinions.jsp
- POP, Precedential and Informative Decisions: <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions>

COURSE OVERVIEW/DESCRIPTION:

- All post-grant proceedings will be covered: reissue, reexamination, inter partes review, post grant review, derivation, and interference.
- The Leahy-Smith America Invents Act (AIA) shifted the battleground of certain patent challenges from district court to the USPTO by creating new, more powerful, fast-track, litigation-like review proceedings, including post-grant review and *inter partes* review.

LEARNING OUTCOMES:

- This course will cover practical aspects of how patent office litigation proceedings are used on their own and in conjunction with district court and ITC litigation to achieve client aims.
- The course also explores the interface between the proceedings and the district courts, the USITC, and the Federal Circuit.
- The course will include small writing assignments and class participation to provide practical implementation of the statute, rules, and procedures for petitions, preliminary response, patent owner response, motion to amend, petitioner reply, patent owner sur reply, deposition, Board calls, and Board oral hearing.

BASIS OF EVALUATION & ASSESSMENTS

- There will be frequent opportunities for student input and consideration of how to counsel clients on available patent office litigation options and limitations. Practical strategies and case studies will be used.
- Patent Law I and II are recommended but not required for this course.
- Final Examination 90%; Class Participation and Assignments: 10%

INSTRUCTOR EXPECTATIONS & COURSE RULES/STRUCTURE:

- We expect all students will be prepared to discuss the general subject matter, if not the exact facts and law of the assigned cases, during each class.
- All students will respect all other students' comments and answers.

- All written assignments will be due before class starts. The assignments should be emailed to both professors.
- As the class will be small we expect each student to be on call to at least participate generally.
- Students must use their MasonLive email account to receive important University information, including communications related to this class. If approved by the student, we will respond to messages sent from or send messages to a non-Mason email address.

ATTENDANCE: Regular and punctual attendance are required to earn academic credit. Attendance requirements for academic credit will follow the policies set forth in Academic Regulation 4-1. Should a student anticipate the possibility of missing a substantial number of class sessions (e.g. a serious illness), please immediately contact the Assistant Dean, Student Academic Affairs.

We will take attendance at the beginning of each class.

CLASS RECORDINGS PROHIBITED: Pursuant to Academic Regulation 4-2.2, no portion of a class session or an examination may be preserved by means of a recording device such as an audio recording device or camera. Any exceptions to this policy must be expressly permitted in writing by one of us.

COVID HEALTH & SAFETY REQUIREMENTS: Please refer to the most up-to-date University policies, available here: https://www.law.gmu.edu/covid_19.

COURSE ASSIGNMENTS/SCHEDULE:

The syllabus will likely change throughout the semester as new case law develops and new rules or guidance issue from the PTO. In order to keep the amount of reading manageable, we will often send edited versions of the assigned cases via e-mail. You can expect to receive these at least a week in advance of the class for which they are assigned.

We will not go through every assigned reading each week, but you will be responsible for the readings on the final examination.

Finally, some weeks there will be a short writing assignment. We do not expect more than 2–3 pages and so these should not take too much time to prepare.

Week 1: August 23, 2021

- Core Topic: Overview of Proceedings, Claim Construction, Burdens, Stays, Parallel Proceedings – Race to Finality
- Reading Assignments:
 - *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016)
 - *Thryv Inc. v. Click-to-Call Technologies, LP*, 140 S. Ct. 1367 (2020)
 - *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021)

- *Pers. Audio, LLC v. CBS Corp.*, 946 F.3d 1348 (Fed. Cir. 2020)
- *ePlus, Inc. v. Lawson Software, Inc.*, 789 F.3d 1349, *rehearing denied*, 790 F.3d 1307 (Fed. Cir. 2015)
- *CyWee Grp. Ltd. v. Samsung Elecs. Co.*, 2019 WL 11023976 (E.D. Tex. Feb. 14, 2019) (Bryson, J.)

Week 2: August 30, 2021

- Core Topic: Constitutional Basis and Challenges; Administrative Procedure Act Part I
- Reading Assignments
 - *Oil States Energy Servs., LLC v. Greene’s Energy Group, LLC*, 138 S. Ct. 1365 (2018)
 - *United States v. Arthrex*, 141 S. Ct. 1970 (2021)
 - USPTO implementation of an interim Director review process following Arthrex, <https://www.uspto.gov/patents/patent-trial-and-appeal-board/procedures/uspto-implementation-interim-director-review>
 - Other Constitutional Issues – May 2020 PTAB Strategies and Insights <https://www.sterneckessler.com/news-insights/publications/supreme-court-decided-and-pending-constitutional-challenges>
 - *Arthrex* – One Month Later – July 2021 PTAB Strategies and Insights
 - *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364 (Fed. Cir. 2016)
 - *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015)

September 6, 2020: No Class (Labor Day)

Week 3: September 13, 2021

- Core Topic: Who can file petition; Searching, Prior Art, Experts, Librarians, Petition, Multiple Petitions per Patent, Protective Orders- Motions to Seal
- Reading Assignments:
 - Patent Office Litigation (“POL”) Chapters 3, 4 (available on Westlaw)
 - **Who can file**
 - *Return Mail, Inc. v. United States Postal Serv.*, 139 S.Ct. 1853 (2019)
 - *Regents of the Univ. of Minn. v. LSI Corporation*, 926 F.3d 1327 (Fed. Cir. 2019)
 - *Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals Inc.*, 896 F.3d 1322 (Fed. Cir. 2018)
 - *Athena Automation Ltd. v. Husky Injection Molding Sys. Ltd.* (§ II.A), Case IPR2013-00290, Paper 18 (Oct. 25, 2013)
 - **Case in Chief**
 - *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd*, 821 F.3d 1359 (Fed. Cir. 2016)
 - *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, (Fed. Cir. 2017)

- *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324 (Fed. Cir. 2019)
- *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 (Oct. 2, 2020)
- **Printed Publication**
 - *Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018-01039 (PTAB Dec. 20, 2019) (Designated: Dec. 20, 2019) (Paper 29)
- **Incorporation by Reference Improper**
 - *Cisco Sys., Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454, Paper 12 (Aug. 29, 2014)
- **Protective Order —Motion to Seal**
 - *Argentum Pharm. LLC v. Alcon Research, Ltd.*, Case IPR2017-01053, Paper 27 (Jan. 19, 2018)

Week 4: September 20, 2021

- Core Topic: Patent Owner Preliminary Response, Real Party in Interest, Privy, Statutory Bar challenges, Discretionary Denial (325 and 314)
- **Assignment # 1 Due** (Petition)
- Reading Assignments:
 - 35 U.S.C. §§ 313, 314, 315, 325
 - Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019, pp. 49–52
 - **Statutory Bars of 315(a) and 315(b)**
 - *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 (Oct. 2, 2020)
 - *Infiltrator Water Techs., LLC, v. Presby Patent Trust*, Case IPR2018-00224, Paper 18 (Oct. 1, 2018)
 - *GoPro, Inc. v. 360Heros, Inc.*, Case IPR2018-01754, Paper 38 (Aug. 23, 2019)
 - *Proppant Express Investments, LLC v. Oren Techs., LLC*, Case IPR2017-01917, Paper 86 (Feb. 13, 2019)
 - *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, Case IPR2017-00651, Paper 152 (Jan. 24, 2019)
 - **Discretionary Denial – 314(a), 325(d) - *Becton / General Plastic Factors***
 - *Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 (Mar. 20, 2020)
 - *Becton, Dickinson & Co. v. B. Braun Melsungen AG* (§ III.C.5, first paragraph), Case IPR2017-01586, Paper 8 (Dec. 15, 2017)
 - *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, Case IPR2019-01469, Paper 6 (Feb. 13, 2020)
 - *Oticon Medical AB v. Cochlear Limited* (§ II.B and II.C), Case IPR2019-00975, Paper 15 (Oct. 16, 2019)
 - *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha* (§ II.B.4.i), Case IPR2016-01357 et al., Paper 19 (Sept. 6, 2017)

Week 5: September 27, 2021

- Core Topic: Board Decisions, Joinder, Trial Strategy, Board Calls, Rehearing
- **Assignment # 2 Due** (Patent Owner Preliminary Response)
- Reading Assignment:
 - POL Chapter 8
 - *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018)
 - **Rehearing**
 - *Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, Case IPR2018-00816, Paper 19 (Jan. 8, 2019)
 - **Joinder – Section 315(c)**
 - *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha* (§ II.B.4.i), Case IPR2016-01357 et al., Paper 19 (Sept. 6, 2017)
 - *Apple Inc. v. Uniloc 2017 LLC*, Case IPR2020-00019, Paper 15 (Oct. 28, 2020) [AIA 314(a), 315(c), denying institution and joinder motion – analysis of General Plastic factors based on follow-on copycat petition]
 - *Proppant v Oren*, IPR2018-00914, Paper 38 (P.T.A.B. March 13, 2019)

Week 6: October 4, 2021

- Core Topic: Patent Owner Response, Depositions, Mandatory and Additional Discovery, Motion to Amend
- **Assignment # 3 Due** (Board Decision; Read Expert Declarations)
- Reading Assignment:
 - POL Chapter 7
 - *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26 (June 11, 2013) [additional discovery factors]
 - *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, Case CBM2013-00005, Paper 32 (May 29, 2013) [additional discovery factors]
 - *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (Motion to Amend)
 - *Nike v Adidas*, 955 F.3d 45 (Fed. Cir. 2020)
 - *Uniloc 2017 LLC, v. Hulu, LLC et al.*, Case No. 2019-1686 (Fed. Cir. July 22, 2020) (101 review of motion to amend)
 - *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, Case IPR2018-00600, Paper 67
 - *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-00948, Paper 34 (Jan. 18, 2019) [AIA § 316(d), grounds that can be raised against substitute claims]
 - *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, 01130, Paper 15 (Feb. 25, 2019) [AIA § 316(d), requirements and burden]
 - *Focal Therapeutics, Inc. v. SenoRx, Inc.*, Case IPR IPR2014-0011, Paper 19 (July, 2014) [deposition conduct]

Week 7: October 12, 2021

- Core Topic: Secondary Considerations
- **Assignment # 4 Due** (Deposition Questions for Petitioner Expert)
- Reading Assignment:
 - POL Chapter 7
 - **Secondary Considerations / Obviousness Analysis**
 - *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317 (Fed. Cir. 2016)
 - *Shenzhen Liown Elecs. Co., Ltd.*, 2017 WL 500153 (Feb. 6, 2017)
 - *Activision Blizzard, Inc.*, Case IPR2015-01996, Paper 101 (Mar. 29, 2017)
 - *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, Paper 33 (Jan. 24, 2020)
 - *Ex parte Quist*, Appeal No. 2008-001183 (June 2, 2010)
 - *Ex parte Jellá*, Appeal No. 2008-1619 (Nov. 3, 2008)

Week 8: October 18, 2021

- Core Topic: Estoppels – Prosecution, District Court, Related Proceedings; Petitioner Reply; Post Grant Reviews
- **Assignment # 5 Due** (Patent Owner Response; Motion to Amend)
- Reading Assignment:
 - Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019, pp. 73–75
 - 35 U.S.C. § 315
 - POL Chapter 11
 - *Facebook, Inc. v. Skky, LLC* (§ II.B.2), Case CBM2016-00091, Paper 12 (Sept. 28, 2017)
 - *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016)
 - *Westlake Servs., LLC v. Credit Acceptance Corp.*, Case CBM2014-00176, Paper 28 (May 14, 2015)

Week 9: October 25, 2021

- Core Topic: AIA-Proofing Patents, Reissues, Supplemental Examination, Ex Parte Examination – Overview
- **Assignment # 6 Due** (Petitioner Reply; Opposition to Motion to Amend)
- Reading Assignment:
 - POL Chapters 8, 16, 26
 - *Ex parte Wellerdieck*, 2007-1119 (May 4, 2007) [term]
 - *Ex parte Adams*, 2007-0441 (March 14, 2007) [changes to indefinite claims]
 - *Ex parte Kraus*, 2005-0841 (Sept. 21, 2006) [recapture]

Week 10: November 1, 2021

- Core Topic: Objections, Supplemental Evidence, Supplemental Information, Motions Practice: Exclude/Opposition to Motion to Exclude

- **Assignment # 7 Due** (Patent Owner Sur Reply)
- Reading Assignment:
 - *Mylan Pharmaceuticals Inc. v. Horizon Pharma USA, Inc.*, IPR2018-00272, Paper 35 (PTAB Mar. 28, 2019) (Motion to Terminate):
 - *Argentum Pharm. LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 (PTAB Jan. 19, 2018) (informative) (Motion to Seal)
 - *Nuna Baby Essentials, Inc. et al. v. Britax Child Safety, Inc.*, IPR2018-01683, Paper 11 (PTAB Dec. 18, 2018) (Motion to Excuse Late Filing)
 - *Samsung Electronics Co. v. Immersion Corporation*, IPR2018-01468, Paper 10 (PTAB Feb 20, 2019): [Petition-Excused]
 - *Olympus America Inc. v. Perfect Surgical Techniques, Inc.*, IPR2014-00233, Paper 56 (PTAB June 8, 2015): [Stipulated Due Dates-Not Excused]

Week 11: November 8, 2021

- Core Topic: Oral Argument, Demonstratives, Live Testimony, Settlement, Adverse Judgement, Reissue
- Reading Assignment:
 - Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019, pp. 81–90
 - <https://www.uspto.gov/sites/default/files/documents/LEAPOralArgumentsPracticumFINALv2.pdf>
 - *DTN, LLC v. Farms Technology, LLC*, Case IPR2018-01412, Paper 21 (June 14, 2019)
 - *Kokusai Electric Corporation v. ASM IP Holding B.V.*, Case IPR2018-01151, Paper 38 (Aug. 20, 2019)
 - *DePuy Synthes Prods., Inc. v. Medidea, L.L.C.*, Case IPR2018-00315, Paper 29 (Jan. 23, 2019)
 - *K-40 Elecs., LLC v. Escort, Inc.*, Case IPR2013-00203, Paper 34 (May 21, 2014)
 - *Curt G. Joa, Inc. v. Fameccanica.data S.P.A.*, Case IPR2016-00906, Paper 61 (June 20, 2017)

Week 12: November 15, 2021

- Core Topic: Appeals; Administrative Procedure Act Part II
- Reading Assignments:
 - **Standing to Appeal**
 - *AVX Corp. v. Presidio Components*, 923 F.3d 1357 (Fed. Cir. 2019)
 - *DuPont v. Synvina*, 904 F.3d 996 (Fed. Cir. 2018)
 - *Mylan Pharm. Inc. v. Research Corp. Techs., Inc.*, 914 F.3d 1366 (Fed. Cir. 2019)
 - *Momenta Pharm., Inc. v. Bristol-Myers Squibb Co.*, 915 F.3d 764 (Fed. Cir. 2019)
 - **Reverse v. Remand**

- *In re Van Os*, 844 F.3d 1359 (Fed. Cir. 2017)
- *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034 (Fed. Cir. 2017)
- *In re Hodges*, 882 F.3d 1107 (Fed. Cir. Feb. 12, 2018)
- *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992)
- **Appealable Issues**
 - *Thryv, Inc v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020)
 - *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018)
 - Petition for Certiorari, *Apple v. Optis*,
https://www.supremecourt.gov/DocketPDF/21/21-118/184962/20210726172741631_21-xxxx%20-%20Apple%20Inc.%20v.%20Optis%20Cellular%20Technology%20LLC%20-%20cert.%20petition%20with%20appendix.pdf

Week 13: November 22, 2021

- Team Oral Arguments
- Discuss Final Exam

ADDITIONAL SCHOOL POLICIES AND RESOURCES:

ACADEMIC INTEGRITY: It is expected that students adhere to the Antonin Scalia Law School Honor Code. The Honor Code prohibits lying, cheating, or stealing. This includes a student obligation to never represent the work of another as their own, and to never provide or accept unauthorized assistance on any school related assignment. The Honor Code is available here: <https://sls.gmu.edu/honor/>.

ACADEMIC REGULATIONS - [Click Here](#)

CLASSROOM ACCOMMODATIONS: Disability Services at George Mason University is committed to providing equitable access to learning opportunities for all students by upholding laws that ensure equal treatment of people with disabilities. If you are seeking accommodations for this class, please visit <http://ds.gmu.edu/> for detailed information about the Disabilities Registration Process. Faculty may not receive or respond to requests for an accommodation. All requests must be handled by the office of Disability Services. You may contact Disability Services directly via email at ods@gmu.edu or phone at (703) 993-2474. If you have any questions about how in-class or testing accommodations are implemented at the law school, please contact the Assistant Dean, Student Academic Affairs for more information.

EXAM CONFLICTS:

In accordance with AR 4-4.1, excuses and requests for permission not to sit for an examination when scheduled must be presented, with appropriate documentation, to the Assistant Dean, Student Academic Affairs. Except in emergencies, such requests should be presented no later than two weeks before the date of the examination.

UNIVERSITY LIFE: University Life provides student support resources such as Counseling and Psychological Services (<https://caps.gmu.edu>), Student Health Services (<https://shs.gmu.edu>), and the Student Support and Advocacy Center (<https://ssac.gmu.edu>). For more information about University Life on the Arlington Campus, please visit: <https://ularlington.gmu.edu/>