ACKNOWLEDGEMENTS

The publisher acknowledges and thanks the following for their learned assistance throughout the preparation of this book:

ANAND AND ANAND
ANDERSON MŌRI & TOMOTSUNE
BAKER MCKENZIE
BOULT WADE TENNANT LLP
BRISTOWS LLP
CLIFFORD CHANCE
DEEP & FAR ATTORNEYS-AT-LAW
GATTAI, MINOLI, AGOSTINELLI & PARTNERS
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TAYLOR WESSING NV
VIEIRA DE ALMEIDA
WILLIAM FRY
WILMER CUTLER PICKERING HALÉ AND DORR LLP
WINSTON & STRAWN LLP
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Although patent litigators should always be mindful that patent litigation has, with some
justification, been called the ‘pathology of the patent system’, not so much as a criticism, but
more in recognition of how remarkably little patent litigation there is in fact when seen in
relation to the ever increasing number of patents in force at any one time, patent litigation is
also the anvil on which patent law is forged. This is because the ‘black letter’ law of patents
tends to be terse by comparison to most other areas of law, and it is only with experience of
how courts and tribunals interpret such law and apply it that one can start to appreciate its
true scope and effect. This, in part, explains how such similarly expressed statutory provisions
as one finds in different patent laws can sometimes result in such different outcomes in
different jurisdictions – disparities that are all the more evident when they concern the same
product or process, and patents that, though in different jurisdictions, are all members of the
same family, and are all intended to protect the same invention. As it becomes increasingly
common for patent disputes to proceed in multiple jurisdictions these differences in outcome
become ever more apparent.

Such disparities are not only a consequence of differing substantive laws, or differences in
interpretation of similarly expressed laws. They can also be a consequence of the considerable
procedural differences between jurisdictions, the nature of which is outlined in this Review.
However, the Review does not only summarise patent litigation procedures. The respective
contributors to it, as leading practitioners in each of their jurisdictions, also focus on recent
developments in substantive patent law as demonstrated by the most important recent court
decisions in their respective jurisdictions, meaning that this Review also provides insight into
the current controversies that affect patent law generally.

For those of us in Europe, the past year has seen little progress towards the entry into
force of the long-heralded Unified Patent Court Agreement, which is the subject of a chapter
in this Review. Its ratification by the UK earlier in 2018 leaves the pending challenge before
the Federal German Constitutional Court to the consistency of the Agreement with the
German Constitution as the only current impediment to its entry into force. But a new
impediment now looms with the imminent withdrawal of the UK from the EU as from
29 March 2019, because the Agreement as drafted does not envisage participation by
non-EU Member States, an issue that might more readily be addressed were the Agreement
to be already in force before such withdrawal occurs. This raises the prospect, unless the
German challenge is rejected in the very near future, of having to amend the Agreement
before it can enter into force to take account of the UK withdrawal from the EU; either to
reflect its exclusion from the Agreement or, as the UK government has urged, to provide for its inclusion, a course that, however, it is not at all clear would be compatible with the case law of the European Court of Justice, irrespective of any treaty language.

Trevor Cook
Wilmer Cutler Pickering Hale and Dorr LLP
New York
August 2018
Chapter 24

UNITED STATES

Thomas L Jarvis and Cyrus T Frelinghuysen, Judge Randall R Rader and Benjamin Christoff

I OVERVIEW

The United States has a highly developed system of patent litigation, largely because of its historic investments in the research and development of technology, coupled with its large and profitable market for products produced both domestically and abroad. US patents are granted based on applications that are examined by the US Patent and Trademark Office (PTO). Those patents can be enforced in the US district courts or at the US International Trade Commission if the infringing products are imported and the patent is used by a domestic industry. All US patents are subject to potential post-grant validity challenges at the PTO. While the volume of patent litigation has varied over time, the need to protect the investments that are necessary to develop new technologies and the profits that are available to competitors suggests that US patent litigation will continue to command significant attention.

II TYPES OF PATENTS

Three types of patents may be obtained in the United States: utility, design and plant.2 The PTO is responsible for reviewing patent applications and granting patents. Utility patents make up approximately half of the patent applications received and patents granted by the PTO.3 The grant of a utility patent provides a patentee with the nationwide right to exclude others from making, using, offering for sale, selling or importing any patented invention. The scope of those rights is set forth in one or more patent claims that define the boundary of patent protection and that are the basis for determining patent validity and infringement.

The process of preparing and filing a patent application with the PTO is referred to as patent ‘prosecution’. An applicant may file either a provisional or non-provisional application. A provisional application need only contain a specification and a drawing but no claims, and does not get examined substantively by the PTO.4 Instead, the provisional application acts as

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1 Thomas L Jarvis and Cyrus T Frelinghuysen are attorneys at Winston & Strawn LLP and Judge Randall R Rader and Benjamin Christoff are partners at the Rader Group PPLC.
a kind of placeholder for an applicant who wants to provide evidence of conception no later than the date of the application. An applicant must then file a non-provisional application containing claims within a year.

Examiners at the PTO review patent applications to determine whether the statutory requirements for patentability are satisfied. These include three basic requirements. First, the claimed invention must fall within the statutory subject matter, which covers ‘any ... process, machine, manufacture, or composition of matter, or any new and useful improvement thereof’. In contrast, ‘[l]aws of nature, natural phenomena, and abstract ideas are not patentable.’ Second, the invention must be new (novel), meaning the invention was not disclosed to the public either in a printed publication or in any other form prior to the filing date of the claimed invention. Third, the invention must be ‘non-obvious’. An invention may be determined to be ‘obvious’ when a ‘person having ordinary skill in the art’, in other words, someone who is skilled in the general field of the claimed invention, would have been able routinely to come up with the claimed invention based on then-available technology and information.

III PROCEDURE IN PATENT ENFORCEMENT AND INVALIDITY ACTIONS

The Federal Rules of Civil Procedure, procedural decisional law and any local or judge-specific rules govern civil litigation proceedings, including patent infringement actions. Proceedings in a patent infringement action can be divided into seven phases: due diligence investigations, pleadings, discovery, patent claim interpretation, summary judgment motions, trials and post-trial proceedings.

Due diligence

The due diligence phase includes review of the client’s patent portfolio to identify patents that appear to be infringed by products that are identified in the market, preparation of infringement claim charts to track the correspondence of each element of the patent claim to features in the apparently infringing products, investigation of defendants to determine the appropriate court for the litigation and estimating the likely monetary awards and injunctive relief that should be awarded. With that information, one may prepare a basic business case for proceeding with litigation.

Selection of patents for litigation should reflect the likely interpretation that will be accorded to each element of the claims, the opportunity to obtain information demonstrating that the accused products meet each of those limitations and optionally an investigation of whether those patents are susceptible to invalidity challenges.

5 Enacted in 2011, the America Invents Act (AIA) had several significant impacts on US patent laws, including shifting the United States from a ‘first-to-invent’ system to a ‘first-inventor-to-file’ system. Under the first-to-invent system, an inventor could obtain a patent upon a showing that he or she was the first to conceive of the claimed invention and reduce it to practice. In contrast, under the AIA’s first-inventor-to-file-system, the person who first discloses an invention, namely, through the filing of a provisional or non-provisional application, will be granted a patent, even if someone else were to have previously conceived of the invention.


Identification of products that are likely to be found to infringe those patents may be possible from simple examination of the product, or might require sophisticated reverse engineering. The preparation of infringement claim charts is a systematic means of evaluating infringement. The claim chart documents the basis for later infringement allegations and satisfies rules in some courts that require the chart as part of a complaint.

US district courts hold original and exclusive jurisdiction over actions arising under the Patent Act. There are 89 judicial districts spread across the 50 states, with a total of 94 districts including the territories of the United States. Until recently, patent infringement actions were routinely filed in the judicial district believed to be most favourable to the patent owner’s interests (often the Eastern District of Texas). However, starting in May 2017, patent venue (the proper district for a case) has been changed to benefit defendants. The US Supreme Court narrowly interpreted the first prong of the patent venue statute – which allows suit wherever a corporate defendant ‘resides’ – by interpreting a corporation’s residence to mean its state of incorporation rather than wherever it distributes products. Soon thereafter the US Court of Appeals for the Federal Circuit narrowly interpreted the other prong – which allows venue wherever the defendant has committed acts of infringement and has a regular and established place of business – so that the presence of remote employees, without more, does not confer the status of a ‘regular and established place of business’. The restriction of the venue laws has dramatically reduced the number of patent infringement cases filed in the Eastern District of Texas, preferred by patent owners, and increased the number filed in Delaware, New York and Illinois, where many companies are incorporated or headquartered. For example, in the first quarter of 2017, the last quarter before the Supreme Court’s decision, 129 patent cases were filed in Delaware, but that number grew to an average of 216 cases for each of the following three quarters. In 2018, Delaware is on track to surpass the Eastern District of Texas as the top district for the filing of patent cases.

**ii Pleadings**

Patent litigations are initiated by the filing of a complaint. Historically, patent infringement complaints were only required to provide a short and plain statement of the claim, showing that the pleader is entitled to relief – the model form only required an allegation of jurisdiction, that the plaintiff owns the patent, that the defendant has been infringing the patent ‘by making, selling and using [the device] embodying the patent’, that the plaintiff has given the defendant notice of its infringement and a demand for an injunction or monetary damages. However, from 1 December 2015, those simple rules were revised in favour of more detailed pleadings. While the new standards continue to evolve, a common interpretation of the new rules requires that the complaint contain an identification of representative claims from each patent, some description of the patented functionality, identification of the accused products

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10 28 U.S.C. § 1331. Except for ancillary issues such as breach of contract claims arising from the sale of a patent, as a general matter state courts do not have jurisdiction to enforce patents.
12 In re Cray Inc., 871 F.3d 1355, 1366 (Fed. Cir. 2017).
14 DocketNavigator Analytics, 2017 Most Active Courts (showing 467 cases filed in Delaware and 289 filed in the Eastern District of Texas as of July 2018).
15 McZeal v. Sprint Nextel Corp., 501 F.3d 1354, 1357 (Fed. Cir. 2007); see also Fed. R. Civ. P. 8(a)(2) and 84, and Form 18.

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and a description of corresponding functionality in such products.\textsuperscript{16} A few courts require more, such as alleging element-by-element that the patent claims are used in the accused products.\textsuperscript{17} When a court finds that a complaint lacks sufficient detail, there are generally opportunities for amending or submitting a wholly new complaint with additional details. The patent owner must file the complaint with the appropriate court and serve a copy of the complaint upon the defendants. A defendant served with a complaint must respond within 21 days (plus any extensions of time).\textsuperscript{18} If the complaint is defective due to lack of jurisdiction, failure to state a recognised claim, failure to name all necessary parties, or other reasons, the defendant may file a motion to dismiss.\textsuperscript{19} Absent a motion to dismiss, the defendant must file an answer to the complaint. Answers are issue-by-issue admissions, denials, or denials based on lack of information.\textsuperscript{20} Failure to deny any allegation in the complaint, except for the amount of damages, can constitute an admission of that allegation.\textsuperscript{21} Answers must also include any affirmative defences, which are reasons why the defendant should not be subject to any claim for relief even if the allegations in the complaint are proven true. Common affirmative defences include unreasonably delayed claims, defendant’s licence under the patent, past payment or resolution of the dispute in a prior litigation. Any affirmative defences that are not included in the answer may be found waived.\textsuperscript{22} In some courts, the complainant must respond to the affirmative defences. Failure to respond to a complaint in a timely manner can result in a default judgment where the court rules in favour of the plaintiff without further proceedings.\textsuperscript{23} However, in many instances, the courts have exercised discretion to permit late responses in order to avoid a default. Depending upon the complexity of the issues, the court may allow submission of later discovered information that was not available when the original complaint or answer were filed, or even allow amendments to the complaint and answer later in the litigation.

iii Discovery

The discovery phase of US civil litigations involves the exchange of information between the parties and, if necessary, obtaining information from third parties, that might later be used as evidence at trial. After service of the complaint is completed, the parties must prepare a proposed discovery plan for submission to the court.\textsuperscript{24} Within 14 days after the discovery plan, all parties must make initial disclosures (without awaiting discovery requests) that identify the names and contact information for likely witnesses, copies of documents upon which the party will use to support its claims or defences, a calculation of damages and any insurance agreements.\textsuperscript{25} In most circumstances, the court will hold a scheduling

\textsuperscript{16} See, for example, \textit{Uniloc USA Inc. v. Aoyagi Inc.}, No. 6:15-cv-1168, slip op. at 7 2016 WL 7042236 at *5 (E.D. Tex. 13 May 2016).


\textsuperscript{18} See Fed. R. Civ. P. 12(a)(1)(A). The defendant’s waiver of service can extend the time to 60 days and a foreign defendant may be entitled to 90 days to respond.


\textsuperscript{20} See Fed. R. Civ. P. 8(b)(1)-(5).

\textsuperscript{21} See Fed. R. Civ. P. 8(b)(6).

\textsuperscript{22} See Fed. R. Civ. P. 12(b). (h).

\textsuperscript{23} See Fed. R. Civ. P. 55(a).

\textsuperscript{24} See Fed. R. Civ. P. 26(f).

\textsuperscript{25} See Fed. R. Civ. P. 26(a)(1).
conference within 90 days of service of the complaint and as soon as practicable the court will issue a scheduling order that limits the time to join other parties, amend the pleadings, complete discovery and file motions. The period for conducting discovery varies widely, but in complex patent infringement cases, fact discovery may last for about a year and expert discovery for an additional six months. Fact discovery includes the exchange of documents and inspection of equipment, interrogatories (written answers to questions from the opposing party), and depositions (out-of-court sworn oral testimony of a witness that is transcribed by a court reporter for possible later use at trial). Expert discovery includes the exchange of written reports disclosing all facts and opinions that an expert witness intends to rely upon at trial, followed by deposition of the experts. Discovery is often the most expensive phase of patent litigation. Parties may move for a protective order limiting discovery requests that are irrelevant or where the burden or expense of producing the evidence outweighs its likely benefit. Parties also sometimes agree to forego certain types of discovery owing to expense.

iv Patent claim interpretation
In 1996, the Supreme Court held in Markman v. Westview that the interpretation of patent claims is a legal issue for judges to decide and does not require jury consideration. Many judges now conduct Markman hearings early in the procedural schedule. Following the US Court of Appeals for the Federal Circuit’s guidance, trial courts consider the evidence of proper claim interpretation in the following order of importance: first, the intrinsic evidence, including the claims, specification and the prosecution history and, then (optionally), extrinsic sources such as dictionaries and expert testimony. Based on the hearing, the judge may issue an order construing (interpreting) the patent claims at issue. The resolution of patent claim interpretation disputes relatively early in the proceedings often provides a basis for settlement or summary motions regarding infringement or validity issues.

v Summary judgment motions
Any party may file a motion for summary judgment on issues where the facts are not in dispute and the judge can resolve the issue as a matter of law. After issuance of a Markman claim interpretation, infringement and invalidity issues may be ripe for summary motions. The success rates for summary motions are highly variable depending on the district. In 2017, patent owners obtained summary judgment 27 per cent of the time, while motions against patent owners were granted 25 per cent of the time. Since July 2014, 36 per cent of motions

27 See Fed. R. Civ. P. 34.
for summary judgment of invalidity for lack of patentability under 35 U.S.C. Section 101 have been successful in light of the Supreme Court’s 2014 *Alice* ruling that ‘abstract ideas’ are not patentable.\(^{35}\)

**vi Trial**

Although about 4,600 patent infringement complaints were filed in 2017, typically only about 3 per cent of those complaints culminate in a trial.\(^{36}\) Many cases are settled, some are resolved by summary judgment and others are withdrawn owing to lack of interest or litigation resources.

The median time to trial for patent cases in the US district courts is about 30 months.\(^{37}\) While some courts like the Eastern District of Virginia routinely proceed to trial in 12 months, most courts are slower and many individual cases are delayed (stayed) pending inter partes review (IPR) of the validity of the patent at the PTO. Courts vary widely in the rate at which they exercise their discretion to stay patent litigations pending an IPR; however, some studies indicate that up to 70–80 per cent of patent cases with a co-pending IPR validity challenge are stayed pending completion of the IPR proceeding.\(^{38}\)

Plaintiffs and defendants have a constitutionally guaranteed right to a jury trial, but upon agreement of both, a judge can decide in lieu of a jury. While a well-educated and experienced judge might more easily comprehend the complex technology at issue in many patent cases, about 80 per cent of patent infringement cases that go to trial are tried to a jury, probably because plaintiffs have generally obtained higher success rates and larger monetary damages before juries instead of judges.\(^{39}\)

Trials are formal hearings where witness testimony, documents and physical evidence are examined to resolve disputed issues of fact. The jury is then instructed by the judge on the applicable law in order to reach a verdict on the issues – typically, whether the patent is infringed by the accused device, whether the patent is valid and the appropriate monetary damages. Counsel for the parties play an active role in presenting evidence, including questioning the witnesses. Trials typically begin with counsel providing opening statements to foreshadow the evidence that will be presented, followed by testimony from fact and expert witnesses and typically ending with counsel providing a closing argument on how the evidence should be interpreted. The average duration of patent infringement trials is eight days.\(^{40}\)

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\(^{36}\) DocketNavigator Analytics, New Patent Cases and Trials (2008–2018). For example, in 2017, 4,548 cases were initiated, but there were just 122 trials during the same time frame (2.7 per cent).


Post-trial proceedings

Jury verdicts can be challenged by motions for judgment as a matter of law (JMOL). Those motions ask the judge to consider whether the evidentiary record is sufficient to support the verdict of the jury. And if a defendant made a pre-verdict JMOL motion on damages, then that motion can be reasserted after the verdict.\(^{41}\) JMOL motions are often coupled with motions for a new trial and can result in significant reductions in damage liability.

The complexity of the technology and legal issues has led many judges and judicial districts to adopt special procedural rules for patent litigations – rules that are often further tailored for the special circumstances of individual cases.

IV SUBSTANTIVE LAW

i Infringement

A patent holder can bring an action for ‘direct’ infringement against anyone who makes, uses, offers to sell, sells or imports into the United States a patented invention or a product that is made by a patented process.\(^{42}\) Absent special circumstances, liability for infringement attaches to companies found to have engaged in the specified prohibited acts, not their specific employees, officers or directors.

A patent holder may also bring a claim for ‘indirect’ infringement against anyone who actively induces or contributes to direct infringement, as long as there is a showing of direct infringement.\(^{43}\) Liability for inducement attaches when a party knows about a patent and actively takes actions that encourage others to infringe the patent, knowing that such actions constitute inducement.\(^{44}\) A defendant’s good faith belief in a patent’s invalidity is not a defence against a claim of induced infringement.\(^{45}\) Liability for contributory infringement attaches when a party sells, offers to sell or imports into the United States a component of a patented invention that constitutes a material part of the invention rather than a commodity-type article suitable for substantial non-infringing uses, knowing that the component was made or adapted for use in an infringing manner.\(^{46}\) In addition, a party may be liable for infringement if it exports for assembly abroad all or substantially all of the components of a patented invention,\(^{47}\) or if it exports for assembly abroad a component of a patented invention that constitutes a material part of the invention rather than a commodity-type article suitable for substantial non-infringing uses, knowing that the component will be combined outside the United States in an infringing manner.\(^{48}\) A patent holder has the burden of proving infringement by a preponderance of the evidence.\(^{49}\) The determination as to patent infringement is a two-step process.\(^{50}\) First, a court construes the claims of the patent,
namely, the court determines what the claims mean. Claim interpretation is a question of law for the court to rule upon. Second, the accused product or process is compared to the properly-construed claims. This step is a question of fact and therefore usually determined by a jury. Infringement will be found when an accused product or process includes every element (‘limitation’) of a claim. ‘Literal infringement’ exists when each and every element in a claim ‘reads on’, or is found in, an accused product or process.

In addition to literal infringement, infringement under the ‘doctrine of equivalents’ exists even if one or more of the claim limitations are not literally present in the accused product or process, as long as the equivalents of those limitations are present. In other words, to find infringement under the doctrine of equivalents, any differences between the claimed invention and the accused product must be insubstantial. A determination of infringement under the doctrine of equivalents is subject to two major limitations. First, ‘prosecution history estoppel’ limits the range of equivalents available to a patent holder by preventing recapture of subject matter that the patent holder surrendered through narrowing amendments during prosecution of the patent. Second, under the ‘all elements’ rule, the doctrine of equivalents does not apply if applying the doctrine would vitiate an entire claim limitation.

ii Invalidity and other defences

There are multiple defences available to a party accused of infringement. The most commonly-raised defences include non-infringement, invalidity and unenforceability.

Non-infringement

With respect to non-infringement, an accused infringer may argue that a patent holder has failed to establish infringement either literally or under the doctrine of equivalents. As the burden of proof rests with the patent holder, an accused infringer may defeat a claim of infringement by showing that an accused product or process fails to meet just a single limitation of a claim.

Invalidity

The validity of a patent may be challenged on multiple grounds, including but not limited to the grounds described below, and a defendant bears the burden of proving invalidity by clear and convincing evidence. First, an accused infringer may take the position that a patent is

51 id.
52 id.
53 id.
54 Allen Eng’g v. Bartell Indus., 299 F.3d 1336, 1345 (Fed. Cir. 2002).
55 See Allen Eng’g v. Bartell Indus., 299 F.3d 1336, 1345 (Fed. Cir. 2002).
56 VirnetX, Inc. v. Cisco Sys., 767 F.3d 1308, 1322 (Fed. Cir. 2014).
57 Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 493 F.3d 1368, 1377 (Fed. Cir. 2007) (citation omitted).
59 Microsoft Corp. v. i4i Ltd. P’ship, 564 U.S. 91, 95 (2011). The ‘clear and convincing’ standard is a higher standard of proof than the ‘preponderance of the evidence’ standard necessary to prove infringement and has been described by the US Supreme Court as a ‘heavy burden.’ See id. at 104.
directed to ineligible subject matter, in other words, laws of nature, natural phenomena and abstract ideas. The US Supreme Court has articulated a two-step framework for determining patent eligibility:

- determine whether the claims are directed to one of the aforementioned patent-ineligible concepts; and
- if so, consider the elements of the claims – both individually and as ordered combinations – to assess whether the additional elements transform the nature of the claims into a patent-eligible application of the concept.60

Second, a patent may be found invalid for failure to satisfy what is known as the ‘utility requirement’. In short, the utility requirement demands that an invention actually work as claimed. For example, an invention that is ‘inoperative’, in the sense that it does not operate to produce the results claimed, is not a ‘useful’ invention for the purposes of meeting the utility requirement.61

Third, an accused infringer may argue that an invention lacks ‘novelty’, meaning it is anticipated by the prior art. ‘Prior art’ refers to any information or other evidence that was publicly known prior to a certain date.62 Prior art references may include, for example, patents, patent applications, books, articles, advertisements or even pre-existing products. A patent is anticipated when a single prior art reference describes every limitation of the claimed invention.63

Fourth, a patent may be rendered invalid as being ‘obvious’. This means a particular invention would have been obvious to a person of ordinary skill in the art64 at the time of the invention. For example, an invention may be obvious if someone working in the relevant technical field could have routinely and easily come up with the invention by combining certain prior art references. The obviousness analysis entails several basic factual inquiries:

- determining the scope and content of the prior art;
- ascertaining the differences between the prior art and the claims at issue; and
- evaluating the level of ordinary skill in the pertinent art.65

In addition, the obviousness analysis must take into account secondary evidence that supports a finding that an invention is not obvious. Such evidence includes whether:

- the invention was commercially successful or widely licensed;
- there was a long-felt but unresolved need for the invention;
- others failed to come up with the invention; and
- the invention yielded unexpected results.

Fifth, under the ‘written description’ and ‘enablement’ requirements, a patent may be found invalid if it lacks a description of the invention sufficient to enable one of ordinary skill in

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62 After the passage of the AIA, any information or evidence disclosed before an inventor files a patent application will be considered prior art.
63 Net MoneyIN Inc. v. VeriSign Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008).
64 The phrase ‘person of ordinary skill in the art’ refers to a hypothetical person who is presumed to have an average level of skill in the relevant technical field at the time of the invention.
the art to make and use the invention.\textsuperscript{66} A patent’s specification must describe the invention in full, clear, concise and exact terms.\textsuperscript{67} The written description requirement is met where there is sufficient information in the specification to show that the inventor possessed the invention at the time of the original filing.\textsuperscript{68} The enablement requirement is met where one skilled in the art, having read the patent’s specification, could practise the invention without undue experimentation.\textsuperscript{69}

Sixth, a patent may be found invalid to the extent the claims are not ‘definite’. A patent specification must conclude with claims particularly pointing out and distinctly claiming the subject matter of the claimed invention.\textsuperscript{70} If the scope of a claim, when read in light of the specification and prosecution history, is not clear to a person of ordinary skill in the art, it may be found indefinite.\textsuperscript{71}

\textbf{Unenforceability}

Even when a defendant cannot prove invalidity, a patent may nonetheless be found unenforceable for a variety of reasons, including inequitable conduct or patent misuse. Inequitable conduct occurs when an inventor breaches the duty of candour and good faith owed to the PTO while applying for a patent. For example, either a misstatement or misrepresentation to the PTO can lead to a finding of inequitable conduct, if it was material in nature and done with an intent to deceive.\textsuperscript{72} Inequitable conduct can render all claims of a patent unenforceable.

A patent may also be found unenforceable owing to misuse. Misuse occurs when a patent holder attempts to impermissibly broaden the physical or temporal scope of the patent grant in a way that has anticompetitive effects.\textsuperscript{73} For example, in the licensing context, one common form of misuse is when a patentee requires the purchase of an unpatented product as a condition for obtaining a licence to the patent.\textsuperscript{74} Another type of misuse would be charging royalties for a patent after the patent has expired. Misuse renders the patent unenforceable during the period of the misuse.

Particular unenforceability issues arise in the context of standard-essential patents (SEPs). First a brief overview of SEPs may be appropriate. In recent decades international corporations have increasingly collaborated in standardising technologies to achieve interoperability of products. (One simple example is the standardised USB ports included in various manufacturers’ computers.) The companies that participate in standard-setting attend meetings hosted by standard-setting organisations (SSOs), where they propose and vet technological solutions. The agreed-upon result is often a long technical standard that specifies the requirements for each component of a complex technology. Before participating, companies must often sign an agreement with the SSO, which obligates them to disclose any patents relevant to the standard and to license them to implementers on fair, reasonable

\textsuperscript{66} See 35 U.S.C. § 112(a).


\textsuperscript{68} Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1320 (Fed. Cir. 2003).

\textsuperscript{69} Streck, Inc. v. Research & Diagnostic Sys., Inc., 665 F.3d 1269, 1288 (Fed. Cir. 2012). Various factors must be considered when determining whether a disclosure requires undue experimentation. See id.

\textsuperscript{70} See 35 U.S.C. § 112(b).


\textsuperscript{72} Therasense, Inc. v. Becton, Dickinson & Co., 649 F.3d 1276, 1290 (Fed. Cir. 2011)

\textsuperscript{73} Princo Corp. v. U.S. Int’l Trade Commission, 616 F.3d 1318, 1321 (Fed. Cir. 2010).

\textsuperscript{74} See id.
and non-discriminatory (FRAND) terms. After all, one factor in choosing the best technical solution to adopt into the standard may be whether additional patent royalties would be required for practicing the solution. If so, the participating companies may prefer to adopt another technology that is free to use.

Against this backdrop, a new body of unenforceability case law has emerged owing to increased SEP litigation. Generally speaking, failure to comply with a SSO’s policies regarding the disclosure of relevant patents or the licensing of SEPs on FRAND terms may prevent a patent owner from enforcing its patents. For example, in a noteworthy decision from 2008, the Federal Circuit upheld a finding that Qualcomm breached its duty to disclose certain patents to a SSO, which rendered those patents unenforceable against any standard-compliant products.75 In a more recent case, the Federal Circuit provided clarification regarding implied waiver owing to a breach of a duty to disclose information to a SSO.76 Nokia was the original assignee of the patent-at-issue, which it did not disclose at the time Nokia’s technical proposal was not adopted by the SSO. Nokia ended up disclosing the patent to the SSO four years later. The district court rejected the argument that Nokia had waived its right to enforce the patent by breaching its obligation to disclose the patent to the SSO. On appeal, the Federal Circuit did not find the patent unenforceable but remanded the case to the district court for further proceedings, explaining that implied waiver may render a patent unenforceable when a patentee’s conduct results in an unfair benefit or is so egregious as to justify unenforceability. This case underscores the need for companies that actively participate in SSO activities to be wary of the potential negative consequences of failing to meet the obligations imposed by the SSO’s policies.

**Additional defences**

Additional defences that may be raised to counter a claim of infringement include licence, patent exhaustion and equitable estoppel. An accused infringer may rely on an express or implied licence to practise the patented invention. When an express licence defence is involved, there is typically a licence agreement that exists between the parties that must be interpreted. In contrast, an implied licence may arise in certain unique circumstances when the grant of a licence can be inferred.77 For example, when a patent holder sells a patented product, the sale carries with it an implied licence to engage in conduct that would otherwise constitute infringement.78

A concept closely related to this form of implied licence is what is known as ‘patent exhaustion’. Under the doctrine of patent exhaustion, the authorised sale of a patented product gives the buyer, or any subsequent purchaser, a right to use or resell that product.79 In 2017, the Supreme Court found that patent exhaustion applies even with respect to foreign sales.80

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75 See *Qualcomm Inc. v. Broadcom Corp.*, 548 F.3d 1004, 1027 (Fed. Cir. 2008).
77 *Monsanto Co. v. Scruggs*, 459 F.3d 1328, 1336 (Fed. Cir. 2006).
Finally, the defence of equitable estoppel is available to accused infringers. To prevail on an estoppel defence, there must be a showing that the patent holder’s misleading statement or conduct led the alleged infringer to reasonably infer that the patent holder did not intend to enforce its patent.81

V FINAL REMEDIES FOR INFRINGEMENT

There are two remedies for infringement: monetary damages and injunctive relief.

Monetary damages

The Patent Act provides for the award of damages ‘adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use of the invention made by the infringer’.82 The courts have recognised multiple grounds for calculating the appropriate compensation, but lost profits and reasonable royalties are the two most common grounds. Lost profits typically results in larger damage awards and may be available if the patent owner can establish that, but for the infringement, it would have made the infringer’s sales.83 Proof of lost profits often includes evidence:

a that the patented invention was in demand;
b that no non-infringing substitutes were available;
c that the patent owner was capable of fulfilling the demand; and
d of the profits the patent owner would have received.84

If lost profits cannot be established, then the courts can award reasonable royalties. Reasonable royalties are most often determined by the rate a reasonable and willing patent owner and a reasonable and willing licensee would have hypothetically negotiated at the time the infringement began. Courts consider many factors in the hypothetical negotiation, including:

a royalties paid by other licensees of the infringed or similar patents;
b nature and scope of the licence;
c whether the patent owner previously sought enforcement or licence of its patents;
d whether the parties are competitors;
e possibility of convoyed sales;
f remaining term of the patent;
g profitability of products covered by the patent;
h advantages of the patent product over alternative products; and
i the portion of profits that derive from patented components of a commercial product.85

81 Hynix Semiconductor Inc. v. Rambus Inc., 645 F.3d 1336, 1347 (Fed. Cir. 2011).
84 Mentor Graphics Corp. v. EVE-USA, Inc., 851 F.3d 1275 (Fed. Cir. 2017).
**Injunctive relief**

Injunctive relief may be available under 35 U.S.C. Section 283, which provides that:

> [t]he several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

Until about a decade ago, injunctions were routinely granted to most prevailing patent owners upon request. However, the Supreme Court’s 2006 *eBay, Inc v. MercExchange* decision restricted the issuance of injunctive relief to patent owners that satisfied the traditional equitable test that:

- **a** absent an injunction, irreparable injury will occur;
- **b** monetary damages are inadequate to compensate for that injury;
- **c** the balance of hardships between the patent owner and the infringer favour injunctive relief; and
- **d** the public interest does not preclude an injunction.86

Following the *eBay* decision, trial courts have rarely granted permanent injunctions to patent assertion entities (only 16 per cent of the time), but have awarded permanent injunctions to all other patentees, including practising entities and universities, at a rate of about 80 per cent.87

**Standard-essential patent remedies**

SEPs raise unique remedies issues. Because technical standards are international (unlike the patent laws), foreign countries’ various policies of setting royalties for use of standard-essential patents can influence US damages awards. Determining a reasonable royalty under US patent law often involves looking to comparable licence agreements – and in some cases, the most comparable licences may be those reached under a foreign country’s SEP licensing regime. The Japan Patent Office (JPO), for example, recently issued guidelines for setting fair and reasonable royalties for use of SEPs.88 Commentators have observed that the JPO has engaged in a praiseworthy effort to balance the interests of patent owners and standard implementers,89 but balance is not necessarily the norm throughout the world.

Further, while there is no *per se* rule against awarding injunctions for infringement of SEPs, courts are often hesitant to do so. As an initial matter, if the patent owner agreed to license on FRAND terms, then the patent owner could be deemed as waiving its argument that remedies at law (i.e., money damages) are inadequate to compensate for the infringement (as required for an injunction). A patent owner’s best chance of securing an injunction generally arises where the implementer has unreasonably delayed negotiations or unilaterally

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refused to accept a reasonable licence offer. 90 However, in the ITC, where injunctive relief is the only remedy available, FRAND obligations are generally examined in the public interest context after a violation has been found. 91

VI OTHER TYPES OF PATENT PROCEEDINGS

Section 337 investigations at the US International Trade Commission

The US International Trade Commission (ITC) is authorised to exclude from importation into the United States articles that infringe a US patent that protects a domestic industry (19 U.S.C. Section 337). Although Section 337 is technically a government investigation, patent owners and importers largely drive the proceedings. The adoption of free trade policies, the relocation of manufacturing industries into Asia and the dominance of globally traded products has increased the number and importance of patent infringement cases at the ITC. Although sometimes criticised as a tool of protectionist trade policies, about one-third of all Section 337 complaints are filed by non-US based companies. 92

Jurisdiction

The ITC has jurisdiction over parties that sell for importation into the United States, import or sell after importation into the United States (collectively, ‘importers’). 93 Like US district courts, the ITC can exercise personal jurisdiction over persons and companies that have at least some minimal level of contact with the United States, or that appear and defend in a Section 337 investigation. However, in addition, the ITC also has in rem jurisdiction over all products imported into the United States. 94 In order to attain economies of scale, most industries depend on the large and lucrative markets available in the United States and therefore are subject to Section 337 investigations.

To establish a violation of Section 337, a patent owner must establish by a preponderance of the evidence that (1) a valid and enforceable US patent is infringed (2) by products imported into the United States and (3) that there are significant investments in a US domestic industry that exploits the patent. 95

Patent infringement

With a few exceptions, the ITC generally applies the same patent law as the US district courts. Because Section 337 applies to the ‘importation... of articles that infringe’, direct infringement is determined as of the moment of importation. Thus, at the ITC there is typically no direct infringement of method claims and claims covering systems that are not

90 See Apple Inc. v. Motorola, Inc., 757 F.3d 1286, 1332 (Fed. Cir. 2014).
95 19 U.S.C. § 1337(a)(1)(B) and § 1337(a)(2)-(d).
assembled until after importation – however, an importer of those articles can be found to be indirectly infringing by contributing to or inducing a direct infringement by its customers. Liability for contributory infringement arises when an importer:

Offers to sell or sell ... a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practising a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use. 96

Liability for induced infringement arises when an importer ‘induces infringement of a patent’, 97 which the courts have interpreted as requiring both knowledge (or at least no wilful blindness) of the asserted patent and that its actions would lead another to directly infringe the patent. 98 This ‘infringing at the moment of importation’ test has had a substantial impact in the electronics industries where patents are often directed to methods of operation and components are often imported for assembly into infringing systems within the United States.

Importation

The Section 337 importation requirement is met when at least one unit of the allegedly infringing product is imported into the United States. The ITC takes an expansive view to find importation in each of the following circumstances:

a foreign manufacturers that sell products to trading companies with knowledge that the trading company would import the product into the United States; 99

b foreign manufacturers accepting purchase orders for delivery and installation of the product in the United States; 100

c foreign manufacturers that ship to the United States disk drives that include magnetic disk components that had earlier been made by an infringing process in the United States; 101 and

d importation of a single unit for use at a trade show. 102

Domestic industry

Section 337 requires (1) significant investments in plant, equipment, labour and capital; or (2) substantial investments in research, development, engineering or operating a licensing business, that exploit at least one claim of each asserted patent. 103 Complainants must establish both the economic prong of domestic industry (the amount of the investment, considered in the context of the industry) and the technical prong (practice of the patent by either the complainant or its licensees). Historically, investments sufficient to manufacture in the United States

100 Certain Variable Speed Wind Turbines, Inv. No. 337-TA-376, Order No. 11 (19 October 1995).
States a product that practises a patent is deemed a ‘significant’ investment. As investments in research, development, engineering or licensing may not result in a product, those investments must have a nexus to the claims of the asserted patent. Complainants may rely upon their own investments, as well as the investments of their corporate affiliates, investments made by their licensees under the patent and investments made by their contractors.

Section 337 procedures

Section 337 investigations are governed by the ITC’s Rules of Practice and Procedure. Owners of US patents file with the ITC a complaint containing detailed allegations of the facts that, if later proven true, would constitute a violation of Section 337 and typically support those allegations with voluminous exhibits. The ITC institutes an investigation in nearly all cases and issues a notice of investigation defining the investigation’s scope ‘in such plain language as to make explicit what accused products or category of accused products’ will be investigated.

The procedures in Section 337 investigations are similar to those in district court patent infringement cases in several ways: Section 337 provides the full gamut of discovery tools; motions are available to resolve discovery disputes; motions for summary disposition are available (although less frequently granted than in district court); and formal trials are held. However, there are important procedural differences. Section 337 patent infringement investigations are typically completed in about 16 months, whereas comparable cases in the district courts average about 30 months. Section 337 investigations often involve extensive foreign discovery, complex technology (about 70 per cent of the cases involve the electronics industry), voluminous briefs and written testimony and high demand trials that are compressed into very short time periods. While only about 3 per cent of district court patent infringement cases proceed to trial, about 40 per cent of Section 337 investigations proceed to trial. The ITC’s dedicated administrative law judges preside over discovery and a trial and they issue an initial determination (ID) on all issues that bear on whether the importers have violated Section 337 – all within about 12 months. The ITC commissioners then take over the case for the final four months during which they can review and modify the findings in the ID and then rule on remedy, bonding and public interest issues.

105 Certain Liquid Crystal Display Devices and Products Containing the Same, Inv. No. 337-TA-631, Order No. 18 (23 Sept. 2008).
110 See 19 C.F.R. § 210.10(b)(1).
113 See 19 C.F.R. § 210.18.
Section 337 investigations can be terminated based on withdrawal of the complaint, settlement, dispositive decisions on motions for summary determination, or a final determination on the merits by the ITC. Of the investigations that went to a final determination during the period 2011–Q1 of 2018, complainants won in about 56 per cent of those cases.\textsuperscript{117} When a complainant wins, unless contrary to the public interest, the ITC must issue an exclusion order that directs US Customs and Border Protection to stop further importations of infringing products.\textsuperscript{118} If the importers who were found in violation have commercially significant inventories of infringing products, the ITC has the discretion to also issue a cease-and-desist order prohibiting certain enumerated commercial activities involving that inventory.\textsuperscript{119}

Section 337 remedial orders are immediately effective, but subject to a 60-day review period during which the president can disapprove the remedy for policy reasons.\textsuperscript{120} During that period, importations can continue if the importers post a bond that is ultimately forfeited to the complainant unless the President disapproves the orders or the decision is reversed on appeal.\textsuperscript{121} Losing parties in Section 337 investigations can appeal for modification of the decision by the Court of Appeals for the Federal Circuit.\textsuperscript{122} In the event an importer is found to violate a cease and desist order, the ITC is authorised to impose civil penalties in the amount of US$100,000 per violation day or alternatively up to twice the domestic value of the products.\textsuperscript{123}

\textbf{ii \hspace{1em} Inter partes review at the US Patent and Trademark Office}\textsuperscript{124}

An IPR is a proceeding before the Patent Trial and Appeal Board (PTAB), a branch of the PTO that is authorised to review the validity of a patent.\textsuperscript{125} Any US patent that was issued on or after 16 September 2012 is eligible for IPR.

Anyone other than the owner of a patent may petition the PTAB to institute an IPR.\textsuperscript{126} During the first two years that IPRs were available, about 80 per cent of IPR petitions were directed to patents in pending litigations.\textsuperscript{127} IPR petitions are subject to detailed requirements, including: the identification of all real parties in interest; identification with particularity of

\begin{itemize}
\item \textsuperscript{117} US International Trade Commission, Section 337 Statistics: Number Cases in Which Violation Is Found/ Yr, available at https://www.usitc.gov/intellectual_property/337_statistics_number_cases_which_violation.htm (updated 13 April 2018).
\item \textsuperscript{118} 19 U.S.C. § 1337(d).
\item \textsuperscript{119} 19 U.S.C. § 1337(f).
\item \textsuperscript{120} 19 U.S.C. § 1337(j). Presidential review is now delegated to the US Trade Representative.
\item \textsuperscript{121} 19 U.S.C. § 1337(j)(3).
\item \textsuperscript{122} 19 U.S.C. § 1337(c).
\item \textsuperscript{123} 19 U.S.C. § 1337(f)(2).
\item \textsuperscript{124} The AIA was signed into law on 16 September 2011. The AIA created three types of post-grant review proceedings: \textit{inter partes} review (discussed herein) and the less commonly used post-grant review and covered business method review, each of which became effective 16 September 2012.
\item \textsuperscript{125} 35 U.S.C. §§ 311-319.
\item \textsuperscript{126} 35 U.S.C. § 311(a); 37 C.F.R. § 42.101.
\item \textsuperscript{127} El-Gamel, Samuel, Siddoway, The New Battlefield: One Year of Inter Partes Review Under the America Invents Act, 42-1 \textit{AIPLA Quarterly Journal}, 39, 55 (2014).
\end{itemize}
each patent claim challenged; the proper interpretation of the claim; and the legal grounds and evidence supporting the challenge. Patent owners have the option of responding to the petition prior to the PTAB’s determination of whether to institute an IPR.

The PTAB will institute an IPR no later than six months after filing of the petition if there is a ‘reasonable likelihood that the petitioner will prevail’ with respect to at least one of the challenged patent claims. IPR proceedings are called trials, but have limited procedures for discovery and submission of testimony and are often decided on written submissions without an in-person hearing. The PTAB must issue a final written decision no more than 12 months after institution of an IPR.

IPRs have had two significant impacts on patent litigation:

a) many district courts (but not the ITC) often stay infringement proceedings on patents that are undergoing IPR until the conclusion of the IPR proceeding; and

b) IPRs that proceed to a final written decision invalidate all claims at issue in about 64 per cent of the cases, some of the claims in about 16 per cent of the cases and none of the claims in about 19 per cent of the cases.

In May 2018, the PTO under new leadership proposed changing the PTAB’s claim interpretation standard from ‘broadest reasonable interpretation’ to match the standard used by district courts, which seeks to ascertain a skilled artisan’s understanding of the claim language in dispute. The rule change is not expected to significantly impact the PTAB’s patent invalidation rate, but rather is designed to prevent patent challengers from strategically arguing for a narrow interpretation in district court to avoid infringement while also arguing for a different, broader interpretation before the PTAB.

VII APPEAL

All appeals of patent-related claims fall within the exclusive jurisdiction of the US Court of Appeals for the Federal Circuit, located in Washington, DC. The Federal Circuit was created to ensure there exists a nationwide uniform authority for patent law. The Federal Circuit takes appeals from decisions of various courts and agencies, including district court patent cases, PTAB decisions and final determinations of the ITC. For district court cases, the losing party must file a notice of appeal with the district court within 30 days after the court has entered judgment. For PTAB proceedings, a notice of appeal must be filed with the PTO no later than 63 days after the PTAB’s final decision. Finally, for ITC investigations, a losing party must file an appeal with the Federal Circuit no later than 60 days after the ITC’s final determination.

128 35 U.S.C. § 312(a); 37 C.F.R. § 42.104.
130 35 U.S.C. § 314(b); 37 C.F.R. § 1.923.
131 See 37 C.F.R. §§ 42.51-74.
135 37 C.F.R. § 90.3.
After an appeal is docketed with the Federal Circuit, the parties submit a series of briefs setting forth their arguments why the lower decision should be affirmed or reversed. Generally speaking, the Federal Circuit will only review materials already in the record below and will not consider new evidence. After briefing is completed, oral arguments are often held before a panel of three Federal Circuit judges. The panel will issue an opinion, although no opinion may be provided when the panel determines to affirm a district court judgment. The disposition of appeals to the Federal Circuit from the time of docketing an appeal to a decision typically requires a year – and has been rising from 10.5 months in 2015 to 13 months in 2018.\textsuperscript{137} In terms of outcomes, for the 12-month period ending 30 September 2017, the Federal Circuit reversed district court judgments for just 11 per cent of the time – that figure was 14 per cent for the ITC and 12 per cent for the PTO.\textsuperscript{138} Since the creation of the PTAB in 2011 caused an influx of new cases for the Federal Circuit, the court has increasingly issued summary affirmances with no opinion, whose frequency controversially rose as high as 49 per cent in Q4 2016 and moderated somewhat to 37 per cent for 2017.\textsuperscript{139} The most common issue on appeal is claim interpretation, both because of its importance to the outcome in most cases and because the Federal Circuit rarely defers to the lower court’s decision on the issue. In the vast majority of instances, the Federal Circuit’s decision will resolve a case, unless a losing party decides to seek review by the Supreme Court, which only rarely grants requests for review.\textsuperscript{140} The cost of an appeal can range from tens of thousands of dollars up to US$1 million, depending on the complexity of the issues.

\section*{VIII THE YEAR IN REVIEW}

Historically, the Supreme Court rarely reviewed patent cases, leaving it to the Federal Circuit to guide the direction of patent law. Yet in recent years, the Supreme Court has been granting review of more cases and has generally narrowed the scope of protection available under the patent laws. During the past year, the Supreme Court ruled on the following three patent cases.

\textbf{i Oil States Energy Services LLC v. Greene’s Energy Group LLC\textsuperscript{141}}

In this widely watched case challenging the constitutionality of IPR proceedings, the Supreme Court upheld IPRs as constitutional. After the PTAB invalidated its patents, Oil States argued on appeal that actions to revoke a patent must be tried in a federal district court before a jury rather than in administrative proceedings. The Federal Circuit rejected this argument. The Supreme Court affirmed the Federal Circuit’s judgment, finding that an IPR ‘involves the

\begin{itemize}
\item \textsuperscript{140} After a panel reaches a decision, the losing party may also file a petition for rehearing by the panel or the whole Federal Circuit, but the latter is typically only granted if there is an important issue of patent law that the Federal Circuit decides should be addressed.
\item \textsuperscript{141} \textit{Oil States Energy Services LLC v. Greene’s Energy Group LLC}, 584 U.S. ___ (2018).
\end{itemize}

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same interests as the determination to grant a patent in the first instance’, such that Congress can properly empower the PTO to administer IPRs. The Supreme Court emphasised ‘the narrowness of [its] holding’, remarking that its decision should not be ‘misconstrued as suggesting that patents are not property’ in other legal contexts.

ii **SAS Institute Inc. v. Iancu**

In this decision issued the same day as Oil States, the Supreme Court held that, if an IPR is instituted, the PTAB must decide the patentability of all claims challenged by a petitioner. The Supreme Court found that the PTAB’s practice of reviewing fewer than all challenged patent claims violated the plain language of the America Invents Act, which requires a ‘yes-or-no choice’ as to whether to institute an IPR. As a result of this decision, petitioners may need to be more selective in choosing which claims to challenge, as the PTAB will reach a final decision on all of them, such that the petitioner cannot challenge them again in district court. There is also a greater likelihood that district courts will stay cases pending the PTAB’s final decision, given that the PTAB will now have to issue a decision on every challenged claim.

iii **WesternGeco LLC v. ION Geophysical Corp.**

In its third patent decision of the year, the Supreme Court addressed when a party may recover damages for lost profits outside of the United States. Generally speaking, lost foreign sales are not recoverable for domestic acts of infringement, but this case involved Section 271(f) of the Patent Act, which imposes liability for infringement when a party supplies a patented invention’s components from the United States. The Supreme Court reversed the Federal Circuit’s holding that the patent owner could not recover foreign lost profits caused by patent infringement, finding that, under Section 271(f)(2), the focus is on the act of exporting components from the United States such that damages can include lost foreign profits to fully compensate the patent owner for the infringement.

**IX OUTLOOK**

The United States has a long tradition of research and development of new technologies, large markets with high profit margins and a tradition of rewarding intellectual property rights, all of which results in a great deal of patent litigation. With the shift of manufacturing to Asia, Chinese patent infringement proceedings could emerge as viable additions or alternatives to proceedings in the United States. In 2017, a reported 16,010 patent litigations were filed in China, an increase of nearly 30 per cent from the prior year. According to one study, foreign patent owners are as likely to litigate in China as domestic patent owners, and the patent owner ‘win rate’ in China may be as high as 80 per cent. However, there is an array

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of challenges that face foreign companies involved in patent litigation in China, including strict limits on discovery, low damages awards and the chance that political considerations may influence the outcome of a case.147

The US patent system remains resilient in the face of obstacles. The PTAB’s IPR proceedings have delayed many patent infringement cases in the district courts and have invalidated many patents involved in those litigations. The US Supreme Court’s Oil States decision has resolved the constitutionality of such proceedings for now. It remains to be seen if the number of district court actions will decline significantly as a result. Further, the high cost of thorough discovery in the US may be disproportionate to its benefits and thus could be stifling patent enforcement. Another area where consensus is building in favour of change is patent eligibility under Section 101 of the patent statute, whose ambiguity has visibly harmed innovation in important industries such as medical diagnostics. But history has repeatedly shown that reports of the ‘death’ of patent litigation have been greatly exaggerated.

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Based in the Washington, DC office of Winston & Strawn LLP, Tom Jarvis is the chair of Winston & Strawn’s ITC practice and litigates patent and other unfair competition cases at the US International Trade Commission (ITC). Over the past 30 years, Tom has totalled more than 150 trial days as lead trial counsel in ITC Section 337 cases.

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Tom has a top-tier rating for his ITC representation of an ‘array of technology sector clients’ (Chambers USA), including leading designers and manufacturers of telecommunications equipment, smartphones, microprocessors, digital signal processors, memory devices, networking equipment, semiconductor fabrication processes and packaging, and various operating systems and application software. Chambers USA praises Tom’s ‘excellent track record at the ITC’ and describes him as ‘an expert at the unique procedures of the ITC and very in tune with the mindset within the ITC’.

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Judge Rader was appointed to the United States Court of Appeals for the Federal Circuit in 1990 and served as its Chief Judge from 1 June 2010 until his retirement in 2014. Before joining the Federal Circuit, Judge Rader served as a trial judge on the United States Claims Court (now the US Court of Federal Claims), and as Minority and Majority Chief Counsel to Subcommittees of the US Senate Judiciary Committee.

Since leaving the bench in 2014, Judge Rader has founded the Rader Group, initially focusing on arbitration, mediation, and legal consulting and legal education services. Judge Rader has presided over a major arbitration under ICC rules in Paris; conducted mediations to settle ongoing litigation; joined law faculty at Tsinghua University; conducted full-credit courses at leading law schools in Washington, DC, Seattle, Santa Clara, Bangkok, Seoul, Tokyo, Munich; consulted with major corporations and law firms on IP policy and litigation; and advised foreign governments on international IP standards. He continues to advocate improvements in innovation policy through speaking engagements worldwide, and has led efforts to form the International Arbitration Center in Tokyo (IACT).

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Ben is an experienced patent lawyer who focuses on arbitration, litigation counselling and legal education. Before joining the Rader Group, Ben gained extensive litigation experience at a national trial firm where he handled matters ranging from pre-filing investigation to appeal.

While in law school, Ben completed several judicial internships, including with the Honourable Jimmie V Reyna of the US Court of Appeals for the Federal Circuit, Administrative Law Judge Thomas Pender of the US International Trade Commission, the Honorable Thomas M Rose of the US District Court for the Southern District of Ohio, and the Honorable Herbert L Stern, III of the Civil Division, 2nd Judicial District, Denver County, CO.

Ben frequently speaks on patent law, including as a guest lecturer at the George Washington University Law School. He has also published several articles and is co-author of the book, Patent Law in a Nutshell (3rd ed. 2018).
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