

Modern Patent Litigation

Modern Patent Litigation

Cases, Comments, and Notes

Fourth Edition

Paul M. Janicke

PROFESSOR OF LAW

UNIVERSITY OF HOUSTON LAW CENTER



CAROLINA ACADEMIC PRESS

Durham, North Carolina

Copyright © 2017
Paul M. Janicke
All Rights Reserved

e-ISBN: 978-1-53100-231-2

Carolina Academic Press, LLC
700 Kent Street
Durham, North Carolina 27701
Telephone (919) 489-7486
Fax (919) 493-5668
www.cap-press.com

Contents

Table of Principal Cases	xiii
Preface to the Fourth Edition	xvii
Chapter 1 · Patentee’s Remedies	3
A. Permanent Injunction	3
<i>eBay Inc. v. MercExchange, L.L.C.</i> 547 U.S. 388 (2006)	4
<i>MercExchange, L.L.C. v. eBay, Inc.</i> 500 F. Supp. 2d 556 (2007)	8
<i>W.L. Gore & Assocs. v. Garlock, Inc.</i> 842 F.2d 1275 (1988)	15
<i>Amstar Corp. v. Envirotech Corp.</i> 823 F.2d 1538 (1987)	18
<i>i4i Limited Partnership v. Microsoft Corporation</i> 598 F.3d 831 (2010), <i>aff’d</i> , 131 S.Ct. 2238 (2011)	20
B. Preliminary Injunction	26
<i>Roper Corp. v. Litton Sys. Inc.</i> 757 F.2d 1266 (1985)	26
<i>Illinois Tool Works v. Grip Pak, Inc.</i> 906 F.2d 679 (1990)	32
C. Contempt Remedy for Violating Injunction	35
<i>Tivo Inc. v. Echostar Corp.</i> 646 F.3d 869 (2011)	36
<i>Additive Controls & Measurement Systems, Inc. v. Flowdata, Inc.</i> 96 F.3d 1390 (1996)	44
D. Lost Profits Damages	51
<i>King Instrument Corp. v. Otari Corp.</i> 767 F.2d 853 (1985), <i>cert. denied</i> , 475 U.S. 1016 (1986)	51
<i>Juicy Whip, Inc. v. Orange Bang, Inc.</i> 382 F.3d 1367 (2005)	54
<i>BIC Leisure Prods. v. Windsurfing Intl., Inc.</i> 1 F.3d 1214 (1993)	57
E. Reasonable Royalty Damages	63
<i>Georgia-Pacific Corp. v. United States Plywood Corp.</i> 318 F. Supp. 1116 (1970), <i>modified</i> , 446 F. 2d 295 (2d Cir.), <i>cert. denied</i> , 404 U.S. 870 (1971)	64
<i>Fromson v. Western Litho-Plate & Supply Co.</i> 853 F.2d 1568 (1988)	66

	<i>Crystal Semiconductor Corp. v. TriTech Microelectronics Int'l., Inc.</i>	72
	246 F.3d 1336 (2001)	
	<i>Harris Corp. v. Ericsson Inc.</i>	73
	417 F.3d 1241 (2005)	
	<i>Interactive Pictures Corp. v. Infinite Pictures, Inc.</i>	76
	274 F.3d 1371 (2001)	
	<i>Studiengesellschaft Kohle, m.b.H. v. Dart Indus.</i>	78
	862 F.2d 1564 (1988)	
	<i>Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.</i>	80
	576 F.3d 1348 (2009)	
	<i>i4i Limited Partnership v. Microsoft Corp.</i>	88
	598 F.3d 831 (2010)	
	<i>Uniloc USA, Inc. v. Microsoft Corp.</i>	93
	632 F.3d 1292 (2011)	
F.	Enhancement: Willfulness; Counsel Opinions	101
	<i>Knorr-Bremse Systeme Fuer Nutzfahrzeuge Gmbh v. Dana Corp.</i>	101
	383 F.3d 1337 (2004)	
	<i>Halo Electronics, Inc. v. Pulse Electronics, Inc.,</i>	
	<i>Stryker Corp. v. Zimmer, Inc.</i>	108
	136 S. Ct. 1923 (2016)	
	<i>Ortho Pharm. Corp. v. Smith</i>	112
	959 F.2d 936 (1992)	
	<i>Read Corp. v. Portec, Inc.</i>	113
	970 F.2d 816 (1992)	
G.	Prejudgment Interest	116
	<i>Nickson Indus. v. Rol Mfg. Co.</i>	116
	847 F.2d 795 (1988)	
	<i>Beatrice Foods Co. v. New England Printing & Litho. Co.</i>	118
	923 F.2d 1576 (1991)	
H.	Attorney Fees	119
	<i>Modine Mfg. Co. v. Allen Group</i>	119
	917 F.2d 538 (1990), <i>cert. denied</i> , 500 U.S. 918 (1991)	
Chapter 2 · Accused Infringer's Remedies		121
A.	Declaratory Judgment	121
	<i>Int'l. Med. Prosthetics Research Assocs. v. Gore Enterprise Holdings</i>	121
	787 F.2d 572 (1986)	
	<i>MedImmune, Inc. v. Genentech, Inc.</i>	126
	549 U.S. 118 (2007)	
	<i>Creative Compounds, LLC v. Starmark Labs</i>	133
	651 F.3d 1303 (2011)	
	<i>Powertech Technology Inc. v. Tessera, Inc.</i>	137
	660 F.3d 1301 (2011, as corrected Jan. 10, 2012)	
B.	Attorney Fees	142
	<i>Eltech Sys. Corp. v. PPG Indus.</i>	142
	903 F.2d 805 (1990)	
	<i>Octane Fitness, LLC v. Icon Health & Fitness, Inc.</i>	148
	134 S.Ct. 1749 (2014)	
C.	Indemnification	151

D.	Wrongful Injunction Action	151
	<i>Transonic Systems, Inc. v. Non-Invasive Medical Technologies Corp.</i>	
	75 Fed. Appx. 765 (2003)	152
	<i>Nintendo of America, Inc. v. Lewis Galoob Toys, Inc.</i>	
	16 F.3d 1032 (1994)	153
E.	Misuse Defense and Antitrust Action	158
	<i>Berlenbach v. Anderson & Thompson Ski Co.</i>	
	329 F.2d 782 (1964), <i>cert. denied</i> , 379 U.S. 830 (1964)	159
	<i>Princo Corp. v. U.S. Int’l. Trade Comm’n. and</i>	
	<i>U.S. Philips Corporation, Intervenor</i>	
	616 F.3d 1318 (2010)	161
	<i>Zenith Radio Corp. v. Hazeltine Research, Inc.</i>	
	395 U.S. 100 (1969)	172
	<i>In re Independent Service Organizations Antitrust Litigation</i>	
	203 F.3d 1322 (2000)	178
	Chapter 3 · Jurisdiction and Venue	185
A.	Basics of Jurisdiction under Section 1338(a)	186
	<i>Consolidated Kinetics Corp. v. Marshall, Neil & Pauley, Inc.</i>	
	11 Wash. App. 173 (1974)	186
	<i>Christianson v. Colt Industries Operating Corp.</i>	
	486 U.S. 800 (1988)	190
	<i>Gunn v. Minton</i>	
	133 S. Ct. 1059 (2013)	195
	<i>Medtronic, Inc., Petitioner v. Mirowski Family Ventures, LLC</i>	
	134 S.Ct. 843 (2014)	201
B.	Infringement by U.S. or Its Contractors, or by States	204
	<i>TVI Energy Corp. v. Blane</i>	
	806 F.2d 1057 (1986)	204
	<i>Florida Prepaid Postsecondary Education Expense Board v.</i>	
	<i>College Savings Bank</i>	
	527 U.S. 627 (1999)	207
C.	The Limits of Supplemental Patent Jurisdiction	214
	<i>Verdegaal Bros. v. Union Oil Co.</i>	
	750 F.2d 947 (1984)	214
D.	Jurisdiction Over Persons: General and Special Minimum Contracts	218
	<i>Beverly Hills Fan Company v. Royal Sovereign Corp.</i>	
	21 F.3d 1558 (1994)	219
	<i>3D Systems, Inc. v. Aarotech Laboratories, Inc.</i>	
	160 F.3d 1373 (1998)	227
E.	Patent Venue: Defendant’s Residence	232
	<i>VE Holding Corp. v. Johnson Gas Appliance Co.</i>	
	917 F.2d 1574 (1990), <i>cert. denied</i> , 499 U.S. 922 (1990)	233
F.	Convenience Transfer	234
	<i>In re TS Tech USA Corp.</i>	
	551 F.3d 1315 (2008)	234
	<i>In re Telular Corporation, Petitioner</i>	
	319 Fed. Appx. 909 (2009)	238

G. Conflicting Actions: Which Goes Forward?	241
<i>Kahn v. GMC</i>	
889 F.2d 1078 (1989)	241
<i>In re Google Inc.</i>	
2014 U.S. App. LEXIS 19596 (Fed. Cir. 2014)	246
H. Impact of the America Invents Act of 2011	248
Chapter 4 · Parties to Patent Suits	251
A. Necessary Parties Plaintiff	251
<i>Waterman v. Mackenzie</i>	
138 U.S. 252 (1891)	251
<i>Independent Wireless Tel. Co. v. RCA</i>	
269 U.S. 459 (1926)	253
<i>McNeilab, Inc. v. Scandipharm, Inc.</i>	
95 F.3d 1164 (1996)	260
<i>WiAV Solutions LLC v. Motorola, Inc.</i>	
631 F.3d 1257 (2010)	265
<i>Alfred E. Mann Foundation v. Cochlear Corp.</i>	
604 F.3d 1354 (2010)	271
B. Permissible Parties Defendant	277
<i>Orthokinetics Inc. v. Safety Travel Chairs, Inc.</i>	
806 F.2d 1565 (1986)	278
C. Joinder of Non-Cooperating Defendants	279
Chapter 5 · Problems in Determining Patent Scope	281
<i>Graver Tank & Mfg. Co. v. Linde Air Products Co.</i>	
339 U.S. 605 (1950)	281
<i>Vitronics Corp. v. Conceptronic, Inc.</i>	
90 F.3d 1576 (1996)	282
<i>Phillips v. AWH Corp.</i>	
15 F.3d 1303 (2005), <i>cert. denied</i> , 126 S. Ct. 1332 (2006)	289
<i>Net MoneyIN, Inc. v. Verisign, Inc.</i>	
545 F.3d 1359 (2008)	299
<i>Allvoice Computing PLC v. Nuance Communications, Inc.</i>	
504 F.3d 1236 (2007)	304
Chapter 6 · Special Problems of Patent Infringement	311
<i>Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.</i>	
576 F.3d 1348 (2009), <i>cert. denied</i> ,	
130 S.Ct. 1088 (2010)	311
<i>Intermedics, Inc. v. Ventritex Co.</i>	
1993 U.S. App. LEXIS 3620 (1993)	317
<i>Merck KGaA v. Integra Lifesciences I, Ltd.</i>	
545 U.S. 193 (2005)	322
<i>Global-Tech Appliances, Inc. v. SEB S. A.</i>	
131 S. Ct. 2060 (2011)	328
<i>i4i Limited Partnership v. Microsoft Corp.</i>	
598 F.3d 891 (2010), <i>aff'd. on other grounds</i> ,	
131 S.Ct. 2238 (2011)	335

Chapter 7 · Estoppels	343
A. To Deny Validity: Assignor Estoppel	344
<i>Shamrock Techs. v. Medical Sterilization, Inc.</i>	
903 F.2d 789 (1990)	344
B. To Deny Infringement: Can There Be Marking Estoppel?	347
<i>Frolow v. Wilson Sporting Goods Co.</i>	
710 F.3d 1303 (2013)	347
C. To Assert Infringement: Prosecution History Estoppel	349
<i>Townsend Engrg. Co. v. Hitec Co.</i>	
829 F.2d 1086 (1987)	349
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.</i>	
535 U.S. 722 (2002)	355
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.</i>	
<i>a/k/a SMC Corp.</i>	
2005 U.S. Dist. LEXIS 11621 (2005)	363
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.,</i>	
<i>(also known as SMC Corp.)</i>	
493 F.3d 1368 (Fed. Cir. 2007), <i>cert. denied</i> ,	
553 U.S. 1093 (2008)	371
<i>Intervet Inc. v. Merial Limited</i>	
617 F.3d 1282 (2010)	380
D. To Sue: Equitable Estoppel and Laches	384
A. <i>C. Aukerman Co. v. R. L. Chaides Constr. Co.</i>	
960 F.2d 1020 (1992)	384
<i>Meyers v. Asics Corp.</i>	
974 F.2d 1304 (1992)	393
<i>Cancer Research Technology Limited v. Barr Laboratories, Inc.</i>	
625 F.3d 724 (2010)	399
E. Estoppel to Deny Existence of a License	405
<i>Wang Laboratories, Inc. v. Mitsubishi Electronics America, Inc.</i>	
103 F.3d 1571 (1997), <i>cert. denied</i> , 522 U.S. 818 (1997)	405
Chapter 8 · Defenses	415
A. Defenses Are Limited by Statute	416
<i>Aristocrat Technologies Australia Pty. Ltd. v. International</i>	
<i>Game Technology</i>	
543 F.3d 657 (2008)	416
B. License	421
<i>Anton/Bauer, Inc. v. PAG, Ltd.</i>	
329 F.3d 1343 (2003)	422
C. Exhaustion of the Patent Right	431
<i>Intel Corp. v. ULSI System Technology, Inc.</i>	
995 F.2d 1566 (1993)	432
<i>Unidisco, Inc. v. Schattner</i>	
824 F.2d 965 (1987), <i>cert. denied</i> , 484 U.S. 1042 (1988)	437
<i>Keurig, Inc. v. Sturm Foods, Inc.</i>	
732 F.3d 1370 (2013)	438
D. Inequitable Conduct	442
<i>Kingsdown Med. Consultants, Ltd. v. Hollister Inc.</i>	
863 F.2d 867 (1989), <i>cert. denied</i> , 490 U.S. 1067 (1989)	442

	<i>Medtronic Vascular, Inc. v. Boston Scientific Corp.</i> 2008 U.S. Dist. LEXIS 67819 (2008)	449
	<i>Therasense, Inc. v. Becton, Dickinson & Co.</i> 649 F.3d 1276 (2011)	456
	<i>Exergen, Inc. v. Wal-Mart Stores, Inc.</i> 575 F.3d 1312 (2009)	469
E.	Improperly Broadened Reissue or Reexamination <i>Quantum Corp. v. Rodime, PLC</i> 65 F.3d 1577 (1995)	476
F.	Intervening Rights <i>Westvaco Corp. v. International Paper Co.</i> 991 F.2d 735 (1993)	481
G.	Prior Invention <i>Thomson S.A. v. Quixote Corp.</i> 166 F.3d 1172 (1999)	487
H.	Inherent Anticipation <i>King Pharmaceuticals, Inc. v. Eon Labs, Inc.</i> 616 F.3d 1267 (2010)	492
I.	Failure to Mark Goods <i>American Med. Sys. v. Medical Eng'g Corp.</i> 6 F.3d 1523 (1993)	498
J.	Time Limitation on Damages <i>Standard Oil Co. v. Nippon Shokubai Kagaku Kogyo Co.</i> 754 F.2d 345 (1985)	504
Chapter 9	· Discovery Matters	509
A.	Privilege for Communications <i>American Standard, Inc. v. Pfizer Inc.</i> 828 F.2d 734 (1987)	510
	<i>In re Seagate Technology, LLC, Petitioner</i> 497 F.3d 1360 (2007), <i>cert. denied</i> , 552 U.S. 1230 (2008)	525
	<i>Quantum Corp. v. Tandon Corp.</i> 940 F.2d 642 (1991)	527
	<i>In re Spalding Sports Worldwide, Inc.</i> 203 F.3d 800 (2000)	530
	<i>GFI, Inc. v. Franklin Corp.</i> 265 F.3d 1268 (2001), <i>cert. denied</i> , 537 U.S. 1046 (2002)	536
B.	“Work Product” Rule 26, Fed. R. Civ. P.	537
	<i>In re Pioneer Hi-Bred International, Inc.</i> 238 F.3d 1370 (2001)	538
C.	Relevance Issues	543
	<i>Micron Technology, Inc. v. Rambus Inc.</i> 645 F.3d 1311 (2011)	544
	<i>Nilssen v. Osram Sylvania, Inc.</i> 528 F.3d 1352 (2008)	558
Chapter 10	· Judgments	563
A.	Summary Judgment <i>Palumbo v. Don-Joy Co.</i> 762 F.2d 969 (1985)	564

	<i>Ryko Manufacturing Co. v. Nu-Star, Inc.</i>	
	950 F.2d 714 (1991)	571
B.	Separate Trials	577
	<i>In re Innotron Diagnostics</i>	
	800 F.2d 1077 (1986)	577
C.	Jury's Role	583
	<i>Markman v. Westview Instruments, Inc.</i>	
	517 U.S. 370 (1996)	583
	A List of Patent Litigation Issues Decided by the Judge and Ones Decided by the Jury	593
D.	Partial Judgments	594
	Rule 54, Fed. R. Civ. P.	594
	28 USCS §§ 1292, 1295	595
E.	Effect of Consent Judgments	596
	<i>Hartley v. Mentor Corp. v. American Hospital Supply Corp.</i>	
	869 F.2d 1469 (1989)	596
	<i>Foster v. Hallco Manufacturing Co.</i>	
	947 F.2d 469 (1991)	600
	<i>In re Baxter International, Inc.</i>	
	678 F.3d 1357 (2012)	608
F.	Issue Preclusion—Different Design	613
	<i>Del-Mar Avionics, Inc. v. Quinton Instrument Co.</i>	
	836 F.2d 1320 (1987)	613
	Index	617

Table of Principal Cases

- 3D Systems, Inc. v. Aarotech Laboratories, Inc., 160 F.3d 1373 (1998), 227
- A. C. Aukerman Co. v. R. L. Chaides Constr. Co., 960 F.2d 1020 (1992), 384
- Additive Controls & Measurement Systems, Inc. v. Flowdata, Inc., 96 F.3d 1390 (1996), 44
- Alfred E. Mann Foundation v. Cochlear Corp., 604 F.3d 1354 (2010), 271
- Allvoice Computing PLC v. Nuance Communications, Inc., 504 F.3d 1236 (2007), 304
- American Med. Sys. v. Medical Eng'g Corp., 6 F.3d 1523 (1993), 498
- American Standard, Inc. v. Pfizer Inc., 828 F.2d 734 (1987), 510
- Amstar Corp. v. Envirotech Corp., 823 F.2d 1538 (1987), 18
- Anton/Bauer, Inc. v. PAG, Ltd., 329 F.3d 1343 (2003), 422
- Aristocrat Technologies Australia Pty. Ltd. v. International , Game Technology, 543 F.3d 657 (2008), 416
- Beatrice Foods Co. v. New England Printing & Litho. Co., 923 F.2d 1576 (1991), 118
- Berlenbach v. Anderson & Thompson Ski Co., 329 F.2d 782 (1964), *cert. denied*, 379 U.S. 830 (1964), 159
- Beverly Hills Fan Company v. Royal Sovereign Corp., 21 F.3d 1558 (1994), 219
- BIC Leisure Prods. v. Windsurfing Intl., Inc., 1 F.3d 1214 (1993), 57
- Cancer Research Technology Limited v. Barr Laboratories, Inc., 625 F.3d 724 (2010), 399
- Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc., 576 F.3d 1348 (2009), 80
- Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc., 576 F.3d 1348 (2009), *cert. denied*, 130 S.Ct. 1088 (2010), 311
- Christianson v. Colt Industries Operating Corp., 486 U.S. 800 (1988), 190
- Consolidated Kinetics Corp. v. Marshall, Neil & Pauley, Inc., 11 Wash. App. 173 (1974), 186
- Creative Compounds, LLC v. Starmark Labs, 651 F.3d 1303 (2011), 133
- Crystal Semiconductor Corp. v. TriTech Microelectronics Int'l, Inc., 246 F.3d 1336 (2001), 72
- Del-Mar Avionics, Inc. v. Quinton Instrument Co., 836 F.2d 1320 (1987), 613
- eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388 (2006), 4
- Eltech Sys. Corp. v. PPG Indus., 903 F.2d 805 (1990), 142
- Exergen, Inc. v. Wal-Mart Stores, Inc., 575 F.3d 1312 (2009), 469
- Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002), 355
- Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd. , a/k/a SMC Corp., 2005 U.S. Dist. LEXIS 11621 (2005), 363
- Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd. (also known as SMC Corp.), 493 F.3d 1368 (Fed. Cir. 2007), *cert. denied*, 553 U.S. 1093 (2008), 371

- Florida Prepaid Postsecondary Education Expense Board v. , College Savings Bank, 527 U.S. 627 (1999), 207
- Foster v. Hallco Manufacturing Co., 947 F.2d 469 (1991), 600
- Frolow v. Wilson Sporting Goods Co., 710 F.3d 1303 (2013), 347
- Fromson v. Western Litho-Plate & Supply Co., 853 F.2d 1568 (1988), 66
- Georgia-Pacific Corp. v. United States Plywood Corp., 318 F. Supp. 1116 (1970), *modified*, 446 F. 2d 295 (2d Cir.), *cert. denied*, 404 U.S. 870 (1971), 64
- GFI, Inc. v. Franklin Corp., 265 F.3d 1268 (2001), *cert. denied*, 537 U.S. 1046 (2002), 536
- Global-Tech Appliances, Inc. v. SEB S. A., 131 S. Ct. 2060 (2011), 328
- Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605 (1950), 281
- Gunn v. Minton, 133 S. Ct. 1059 (2013), 195
- Halo Electronics, Inc. v. Pulse Electronics, Inc., Stryker Corp. v. Zimmer, Inc., 136 S. Ct. 1923 (2016), 108
- Harris Corp. v. Ericsson Inc., 417 F.3d 1241 (2005), 73
- Hartley v. Mentor Corp. v. American Hospital Supply Corp., 869 F.2d 1469 (1989), 596
- i4i Limited Partnership v. Microsoft Corp., 598 F.3d 831 (2010), 88
- i4i Limited Partnership v. Microsoft Corp., 598 F.3d 891 (2010), *aff'd. on other grounds*, 131 S.Ct. 2238 (2011), 335
- i4i Limited Partnership v. Microsoft Corporation, 598 F.3d 831 (2010), *aff'd*, 131 S.Ct. 2238 (2011), 20
- Illinois Tool Works v. Grip Pak, Inc., 906 F.2d 679 (1990), 32
- In re Baxter International, Inc., 678 F.3d 1357 (2012), 608
- In re Google Inc., 2014 U.S. App. LEXIS 19596 (Fed. Cir. 2014), 246
- In re Independent Service Organizations Antitrust Litigation, 203 F.3d 1322 (2000), 178
- In re Innotron Diagnostics, 800 F.2d 1077 (1986), 577
- In re Pioneer Hi-Bred International, Inc., 238 F.3d 1370 (2001), 538
- In re Seagate Technology, LLC, Petitioner, 497 F.3d 1360 (2007), *cert. denied*, 552 U.S. 1230 (2008), 525
- In re Spalding Sports Worldwide, Inc., 203 F.3d 800 (2000), 530
- In re Telular Corporation, Petitioner, 319 Fed. Appx. 909 (2009), 238
- In re TS Tech USA Corp., 551 F.3d 1315 (2008), 234
- Independent Wireless Tel. Co. v. RCA, 269 U.S. 459 (1926), 253
- Int'l. Med. Prosthetics Research Assocs. v. Gore Enterprise Holdings, 787 F.2d 572 (1986), 121
- Intel Corp. v. ULSI System Technology, Inc., 995 F.2d 1566 (1993), 432
- Interactive Pictures Corp. v. Infinite Pictures, Inc., 274 F.3d 1371 (2001), 76
- Intermedics, Inc. v. Ventritex Co., 1993 U.S. App. LEXIS 3620 (1993), 317
- Intervet Inc. v. Merial Limited, 617 F.3d 1282 (2010), 380
- Juicy Whip, Inc. v. Orange Bang, Inc., 382 F.3d 1367 (2005), 54
- Kahn v. GMC, 889 F.2d 1078 (1989), 241
- Keurig, Inc. v. Sturm Foods, Inc., 732 F.3d 1370 (2013), 438
- King Instrument Corp. v. Otari Corp., 767 F.2d 853 (1985), *cert. denied*, 475 U.S. 1016 (1986), 51
- King Pharmaceuticals, Inc. v. Eon Labs, Inc., 616 F.3d 1267 (2010), 492
- Kingsdown Med. Consultants, Ltd. v. Hollister Inc., 863 F.2d 867 (1989), *cert. denied*, 490 U.S. 1067 (1989), 442
- Knorr-Bremse Systeme Fuer Nutzfahrzeuge Gmbh v. Dana Corp., 383 F.3d 1337 (2004), 101
- Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996), 583
- McNeilab, Inc. v. Scandipharm, Inc., 95 F.3d 1164 (1996), 260
- MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118 (2007), 126

- Medtronic, Inc., Petitioner v. Mirowski Family Ventures, LLC, 134 S.Ct. 843 (2014), 201
- Medtronic Vascular, Inc. v. Boston Scientific Corp., 2008 U.S. Dist. LEXIS 67819 (2008), 449
- MercExchange, L.L.C. v. eBay, Inc., 500 F. Supp. 2d 556 (2007), 8
- Merck KGaA v. Integra Lifesciences I, Ltd., 545 U.S. 193 (2005), 322
- Meyers v. Asics Corp., 974 F.2d 1304 (1992), 393
- Micron Technology, Inc. v. Rambus Inc., 645 F.3d 1311 (2011), 544
- Modine Mfg. Co. v. Allen Group, 917 F.2d 538 (1990), *cert. denied*, 500 U.S. 918 (1991), 119
- Net MoneyIN, Inc. v. Verisign, Inc., 545 F.3d 1359 (2008), 299
- Nickson Indus. v. Rol Mfg. Co., 847 F.2d 795 (1988), 116
- Nilssen v. Osrarn Sylvania, Inc., 528 F.3d 1352 (2008), 558
- Nintendo of America, Inc. v. Lewis Galoob Toys, Inc., 16 F.3d 1032 (1994), 153
- Octane Fitness, LLC v. Icon Health & Fitness, Inc., 134 S.Ct. 1749 (2014), 148
- Ortho Pharm. Corp. v. Smith, 959 F.2d 936 (1992), 112
- Orthokinetics Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565 (1986), 278
- Palumbo v. Don-Joy Co., 762 F.2d 969 (1985), 564
- Phillips v. AWH Corp., 15 F.3d 1303 (2005), *cert. denied*, 126 S. Ct. 1332 (2006), 289
- Powertech Technology Inc. v. Tessera, Inc., 660 F.3d 1301 (2011, as corrected Jan. 10, 2012), 137
- Princo Corp. v. U.S. Int'l. Trade Comm'n. and , U.S. Philips Corporation, Intervenor, 616 F.3d 1318 (2010), 161
- Quantum Corp. v. Rodime, PLC, 65 F.3d 1577 (1995), 476
- Quantum Corp. v. Tandon Corp., 940 F.2d 642 (1991), 527
- Read Corp. v. Portec, Inc., 970 F.2d 816 (1992), 113
- Roper Corp. v. Litton Sys. Inc., 757 F.2d 1266 (1985), 26
- Ryko Manufacturing Co. v. Nu-Star, Inc., 950 F.2d 714 (1991), 571
- Shamrock Techs. v. Medical Sterilization, Inc., 903 F.2d 789 (1990), 344
- Standard Oil Co. v. Nippon Shokubai Kagaku Kogyo Co., 754 F.2d 345 (1985), 504
- Studiengesellschaft Kohle, m.b.H. v. Dart Indus., 862 F.2d 1564 (1988), 78
- Therasense, Inc. v. Becton, Dickinson & Co., 649 F.3d 1276 (2011), 456
- Thomson S.A. v. Quixote Corp., 166 F.3d 1172 (1999), 487
- Tivo Inc. v. Echostar Corp., 646 F.3d 869 (2011), 36
- Townsend Engrg. Co. v. Hitec Co., 829 F.2d 1086 (1987), 349
- Transonic Systems, Inc. v. Non-Invasive Medical Technologies Corp., 75 Fed. Appx. 765 (2003), 152
- TVI Energy Corp. v. Blane, 806 F.2d 1057 (1986), 204
- Unidisco, Inc. v. Schattner, 824 F.2d 965 (1987), *cert. denied*, 484 U.S. 1042 (1988), 437
- Uniloc USA, Inc. v. Microsoft Corp., 632 F.3d 1292 (2011), 93
- VE Holding Corp. v. Johnson Gas Appliance Co., 917 F.2d 1574 (1990), *cert. denied*, 499 U.S. 922 (1990), 233
- Verdegaal Bros. v. Union Oil Co., 750 F.2d 947 (1984), 214
- Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (1996), 282
- W.L. Gore & Assocs. v. Garlock, Inc., 842 F.2d 1275 (1988), 15
- Wang Laboratories, Inc. v. Mitsubishi Electronics America, Inc., 103 F.3d 1571 (1997), *cert. denied*, 522 U.S. 818 (1997), 405
- Waterman v. Mackenzie, 138 U.S. 252 (1891), 251

Westvaco Corp. v. International Paper
Co., 991 F.2d 735 (1993), 481
WiAV Solutions LLC v. Motorola, Inc.,
631 F.3d 1257 (2010), 265

Zenith Radio Corp. v. Hazeltine Re-
search, Inc., 395 U.S. 100 (1969),
172

Preface to the Fourth Edition

In the last few years the Supreme Court has taken an unprecedented interest in U.S. patent law issues. Certiorari has been granted in over a dozen cases in the past four years, leading to a number of significant changes to the rules of law touching patent litigation. This new edition of *Modern Patent Litigation* is the result. New cases have been added, and ones that have become obsolete have been removed.

As in prior editions, I have focused on the issues most commonly encountered in patent cases, except for ones that are normally treated in a basic patent law course, e.g., the defenses of obviousness or lack of novelty. I have liberally cut unrelated portions of the reported cases, generally without ellipses, in order to lessen the burden on the reader. The same is true for internal citations, which have been deleted wherever in my judgment they do not enhance understanding of the point being made by the court.

The book's length is chosen to fit a three-credit law school course. For a two-credit course it is anticipated that the instructor can easily select the topics of most interest.

Paul M. Janicke
University of Houston
September 2016

