

Antonin Scalia Law School
George Mason University
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Patent Remedies Seminar

This seminar studies examines the legal doctrines and theoretical principles comprising remedies for infringement of patents. The seminar will study both legal and equitable remedies: damages (lost profits and reasonable royalties) and injunctions (preliminary and permanent). It will also study related remedies doctrines, such as enhanced damages, and attorney fees. Among these legal topics, the seminar will address “hot topics” in patent remedies, such as the remedies available to owners of standard essential patents committed to FRAND licensing, patent holdup, and patent trolls. The purpose of this seminar is to gain a better understanding of the theoretical, policy, and economic justifications for patent remedies doctrines. Remedies are not only the primary reason why a patent owner pursues an infringement claim in court, they are also the legal framework that defines the incentives (or disincentives) in commercial negotiations that comprise patent licensing.

LOGISTICS

1. Class Schedule

The class meets on Monday, 1:50pm – 3:50pm.

2. Course Prerequisites

As an advanced-level seminar in patent law, classroom discussion and the final exam presuppose that students know the fundamental doctrines, institutions, and policies in patent law. Thus, Patent Law is a prerequisite for this seminar. The Intellectual Property Law course may suffice as a prerequisite, but students who have taken only this survey course should confirm with Professor Mossoff if they covered a sufficient amount of patent law and the patent system. Otherwise, these students will be at a disadvantage relative to their classmates in both classroom discussion and on the final exam. The Remedies course is not a prerequisite for this course, but students should plan to enroll in it, as remedies doctrines are fundamental to the legal system and thus essential to know in any area of legal practice; it is also a very good course in preparing students for the bar exam.

3. Attendance and Class Preparation

Students are responsible for complying with Scalia Law’s regulations regarding attendance. The regulations are on the law school’s web site, and students should read them before their first classes. To ensure compliance, I will take attendance. If you are tardy, it will be counted as an absence unless you tell me to mark you as present before I leave the classroom at the end of class. Two tardies will equal one absence.

4. Grade

Grades will be based on a final exam.

Class participation is accounted for in the grading process, raising grades for consistent, high-quality participation in class discussion or lowering grades for chronic lack of preparation or unprofessional conduct. Given the law school's administrative restraints on grade changes, classroom participation results in only a one-third increase or decrease in a grade.

The exam will be comprised of essay questions and short-answer questions, although the exact format is yet to be determined.

5. TWEN

Students are required to register for the class TWEN site. The weekly reading assignments will be posted to TWEN, and I will also post announcements, updates to the syllabus, and supplemental class materials to the TWEN site. If you do not register with your current email address, you risk not receiving class notices, changes to the syllabus, etc.

6. Office Hours

I will hold office hours after class on Mondays, from 4:00 – 5:00pm, or by appointment (Zoom or in person).



7. Learning Outcomes

The goal of this seminar is to provide students with a working knowledge of the law, theories, and policies of patent remedies. The legal rules derive from policies and theories, which continue to inform and guide their application by courts. Thus, understanding these fundamental concepts and principles makes it possible for students to better analyze and apply statutes and court decisions.

8. Miscellany

Students do not have permission to record class lectures. If there is a particular reason to do so, such as missing class for a medical or family emergency, please speak with me.

CLASS TEXTS

There is no coursebook. All assigned readings are available on TWEN in pdf format.

CLASS TOPICS AND ASSIGNMENTS

CLASS	TOPIC	READING ASSIGNMENT
1	Introduction to Patent Remedies	<p>35 U.S.C. §§ 283 - 285</p> <p>DOUGLAS LAYCOCK & RICHARD L. HASEN, MODERN AMERICAN REMEDIES 1-8 (5th ed., 2019)</p> <p>James Ryan, <i>A Short History of Patent Remedies</i>, 6 CYBARIS 150 (Summer 2015)</p>
2	Lost Profits	<p><i>Panduit Corp. v. Stahl Bros. Fibre Works, Inc.</i>, 575 F.2d 1152 (6th Cir. 1978) – lost profits analysis on pp. 1154-57</p> <p><i>Rite-Hite Corp. v. Kelley Co.</i>, 56 F.3d 1538 (Fed. Cir. 1995) (en banc) – all opinions on lost profits</p> <p><i>Crystal Semiconductor Corp. v. TriTech Microelectronics Int'l</i>, 246 F.3d 1336 (Fed. Cir. 2001) – lost profits analysis</p>
3	Reasonable Royalties	<p><i>Panduit Corp. v. Stahl Bros. Fibre Works, Inc.</i>, 575 F.2d 1152 (6th Cir. 1978) – reasonable royalty analysis pp. 1157-64</p> <p><i>Georgia-Pacific Factors</i></p> <p><i>Dowagiac Mfg. Co. v Minnesota Moline Plow Co.</i>, 235 U.S. 641 (1915)</p> <p><i>Uniloc USA v. Microsoft Corp.</i>, 632 F.3d 1292 (Fed. Cir. 2011)</p> <p><i>Paice L.L.C. v. Toyota Motor Corp.</i>, 504 F.3d 1293 (Fed. Cir. 2014)</p>

4	Legal and Evidentiary Standards for Damages	<p><i>Cornell Univ. v. Hewlett-Packard Co.</i>, 609 F. Supp. 2d 279 (N.D.N.Y. 2009)</p> <p><i>State Industries v. Mor-Flo Industries</i>, 883 F.2d 1573 (Fed. Cir. 1989)</p> <p><i>Virnetx, Inc. v. Cisco Sys., Inc.</i>, 767 F.3d 1308 (Fed. Cir. 2014)</p> <p><i>Omega Pats., LLC v. CalAmp Corp.</i>, 13 F.4th 1361 (Fed. Cir. 2021)</p>
5	Reasonable Royalties: Standard Essential Patents	<p><i>Ericsson, Inc. v. D-Link Sys., Inc.</i>, 773 F.3d 1201 (Fed. Cir. 2014)</p> <p><i>HTC Corp. v. Telefonaktiebolaget LM Ericsson</i>, 407 F. Supp. 3d 631 (E.D. Tex. 2019)</p> <p><i>TCL Comm'n Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson</i>, 943 F.3d 1360 (Fed. Cir. 2019)</p> <p><i>Commonwealth Sci. & Indus. Research Org. v. Cisco Sys., Inc.</i>, 809 F.3d 1295, 1303 (Fed. Cir. 2015)</p>
6	Damages: Theory and Policy	<p>Michael Risch, <i>Unreasonable Royalties</i>, 98 B.U. L. REV. 187 (2018)</p> <p>[more articles TBD]</p>

7	Injunctions (Permanent)	<p><i>Continental Paper Bag Co. v. Eastern Paper Bag Co.</i>, 210 U.S. 405 (1908)</p> <p><i>Polaroid Corp. v. Eastman Kodak Co.</i>, 228 U.S.P.Q. 305, 342-344 (D. Mass. 1985)</p> <p><i>eBay, Inc. v. MercExchange, L.L.C.</i>, 547 U.S. 388 (2006)</p> <p><i>Robert Bosch v. Pylon LLC v. Pylon Mfg. Corp.</i>, 659 F. 3d 1142 (Fed. Cir. 2011)</p> <p><i>BASF Plant Science, LP v Commonwealth Sci. & Indus. Research Org.</i>, 2019 WL 8108116 (E.D. Va. 2019)</p> <p><i>BASF Plant Science, LP v Commonwealth Sci. & Indus. Research Org.</i>, 28 F.4th 1247 (Fed Cir 2022)</p>
8	Preliminary Injunctions	<p>7 Chisum on Patents § 20.04 – Preliminary Injunctions</p> <p><i>Smith Int’l, Inc. v. Hughes Tools Co.</i>, 718 F.2d 1573 (Fed. Cir. 1983)</p> <p><i>Sanofi-Synthelabo v. Apotex</i>, 470 F.3d 1368 (Fed. Cir. 2006)</p> <p><i>Kimberly-Clark v. First Quality Baby Prod.</i>, 660 F. 3d 1293 (Fed Cir. 2011)</p>
9	Injunctions: Standard Essential Patents	<p><i>Apple Inc. v. Motorola, Inc.</i>, 757 F.3d 1286 (Fed. Cir. 2014)</p> <p>USPTO-DOJ Policy Statement on SEP Remedies (Jan. 8, 2013)</p> <p>USPTO-DOJ-NIST Policy Statement on SEP Remedies (Dec. 19, 2019)</p> <p>Adam Mossoff, <i>Patent Injunctions and the FRAND Commitment: A Case Study in the ETSI Intellectual Property Rights Policy</i>, Berkeley Tech. L. J. (forthcoming 2023)</p>

10	Theory and Policy of Injunctions	<p>Mark A. Lemley & Carl Shapiro, <i>Patent Holdup and Royalty Stacking</i>, 85 TEX. L. REV. 1991 (2007)</p> <p>Jorge L. Contreras, <i>Much Ado About Hold-Up</i> 2019 U. ILL. L. REV. 875</p>
11	Theory and Policy of Injunctions (cont.)	<p>Alexander Galetovic & Stephen Haber, <i>The Fallacies of Patent-Holdup Theory</i>, 13 J. COMP. L. & ECON. 1 (2017)</p> <p>[More Articles TBD]</p>
12	Enhanced Damages and Attorney Fees	<p><i>Halo Elecs., Inc. v. Pulse Elecs., Inc.</i>, 579 U.S. 93 (2016)</p> <p><i>Octane Fitness, LLC v. ICON Health & Fitness, Inc.</i>, 572 U.S. 545 (2014)</p> <p><i>Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.</i>, 572 U.S. 559 (2014)</p> <p>David Kappos & Jonathan Barnett, <i>Enhanced Damages Necessary In No-Injunction Patent System</i>, LAW360 (Feb. 2, 2023)</p>
13	Patent Remedies: Theory and Policy	<p>Dirk Auer, Geoffrey A. Manne, Julian Morris, & Kristian Stout, <i>The Deterioration of Appropriate Remedies in Patent Disputes</i>, 21 FED. SOC'Y REV. 158 (2020)</p> <p>Ted Sichelman, <i>Purging Patent Law of "Private Law" Remedies</i>, 92 TEX. L. REV. 517 (2014)</p>