

HARVARD IP CONFERENCE PROBLEM

Relevant U.S. Legal Principles

Generally

In the U.S., the District Court construes the patents claims, and instructs the jury on the law governing infringement and validity. If there are no disputed issues of fact, the District Court also may determine whether or not the patent claims are infringed and valid on summary judgment. If there are disputed issues of fact, as is common, the jury decides these issues after an evidentiary trial. The jury also decides damages, but the District Court decides whether or not to award an injunction. The District Court may decide to impose a mandatory royalty instead of an injunction.

Claim Construction

In construing the patent claims, the District Court considers the language of the claims, the patent specification, and the prosecution history. Claim construction begins with the language of the claims. Claim terms are typically construed according to their ordinary and customary meanings to persons of skill in the art at the time of the invention. However, the claim terms must be read in view of the patent specification for appropriate context. The prosecution history can also inform the meaning of claim terms by demonstrating how the Patent Office and the inventors understood the claimed invention. The claim construction that “stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 1316 (Fed. Cir. 2005); *see also Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996).

Infringement

The patent owner bears the burden of proof on infringement, and must prove infringement by a preponderance of the evidence. To prove infringement, the patent owner must show that the accused infringer made, used, sold, offered for sale, or imported a product that meets all of the limitations of the claim, or performed a method that meets all of the limitations of the claim.

Invalidity/Obviousness

The accused infringer bears the burden of proof on invalidity, and must prove invalidity by clear and convincing evidence (a higher standard). To prove that a patent claim is anticipated, the accused infringer must prove that a prior art reference meets all of the claim limitations. To prove that a patent claim is obvious, the accused infringer must prove that the claimed invention would have been obvious to a person of ordinary skill in the art at the time of the invention.

“Secondary considerations” relevant to the issue of obviousness include whether the invention was commercially successful as a result of the merits of the claimed invention, whether the invention satisfied a long-felt but unresolved need, whether others had tried and failed to make the invention, whether others copied the invention, and whether others praised the invention.

Injunctions

The District Court, rather than the jury, evaluates claims for injunctive relief. The relevant factors are: (1) whether the plaintiff has suffered an irreparable injury; (2) whether money damages are inadequate to compensate for that injury; (3) whether the balance of hardships between the plaintiff and defendant warrants an equitable remedy; and (4) whether the public interest would not be disserved by injunctive relief. *eBay, Inc. v. MercExchange, L.L.C.*, 126 S.Ct. 1837, 1839 (2006).