



Morgan Lewis

IP YEAR IN REVIEW

Andrew Gray

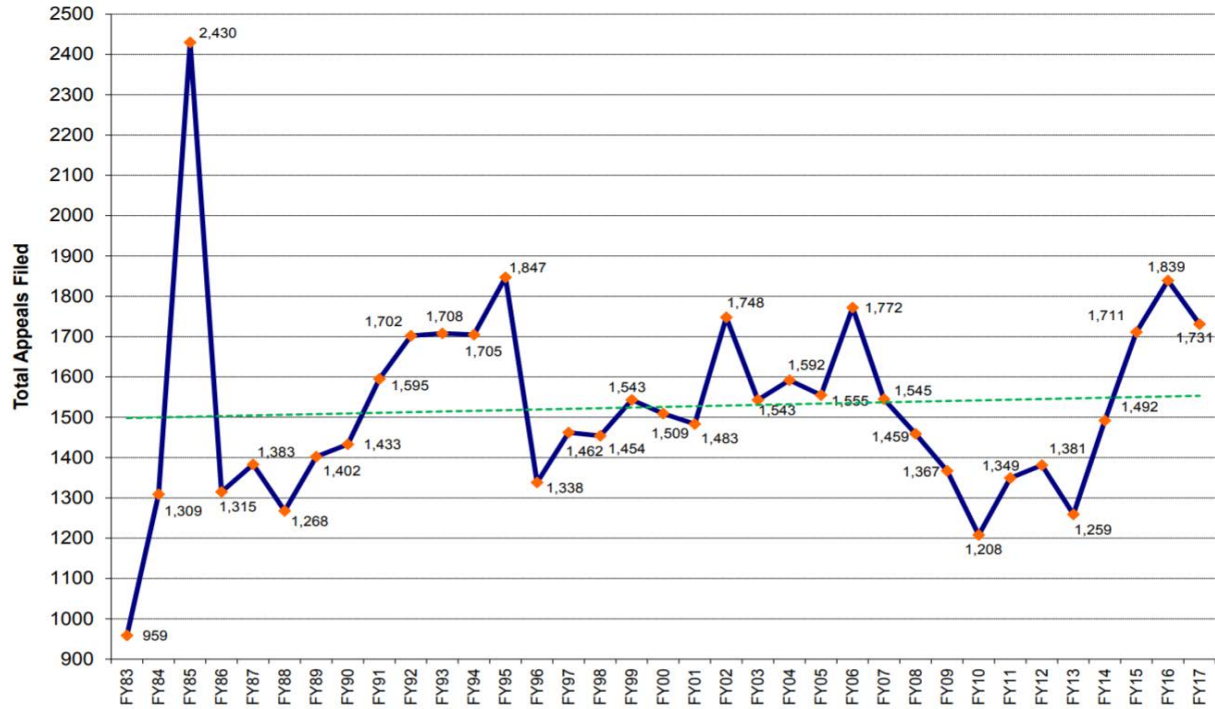
May 10, 2018

The Cases:

- *Oil States Energy Services, LLC v. Greene's Energy Group, LLC* – Julie Goldemberg
- *Impression Products v. Lexmark* – Austin Zuck
- *Aqua Products, Inc. v. Matal* – Karon Fowler
- *Mentor Graphics Corp. v. EVE-USA, Inc.* – Michael Carr
- *Matal v. Tam, Pro Football, and Brunetti* – Scott Tester
- *Energy Heating v. Heat On-The-Fly* – David Bernstein
- *TC Heartland* – Corey Houmand
- *In Re Cray Inc.* – Thom Nolan
- *Patent Eligible Subject Matter* – Matt Walker and Ben Pezzner

2017 FEDERAL CIRCUIT CASELOAD STATISTICS

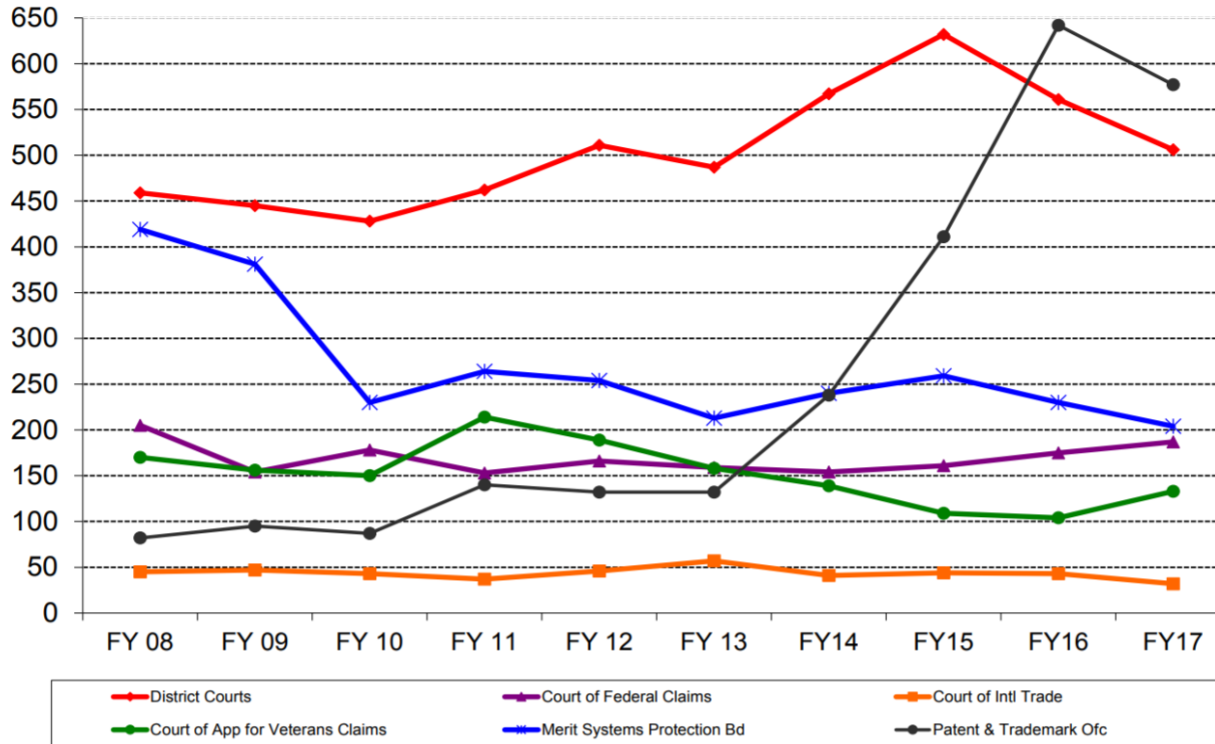
United States Court of Appeals for the Federal Circuit Historical Caseload



Note: Includes reinstated, cross- and consolidated appeals.

United States Court of Appeals for the Federal Circuit

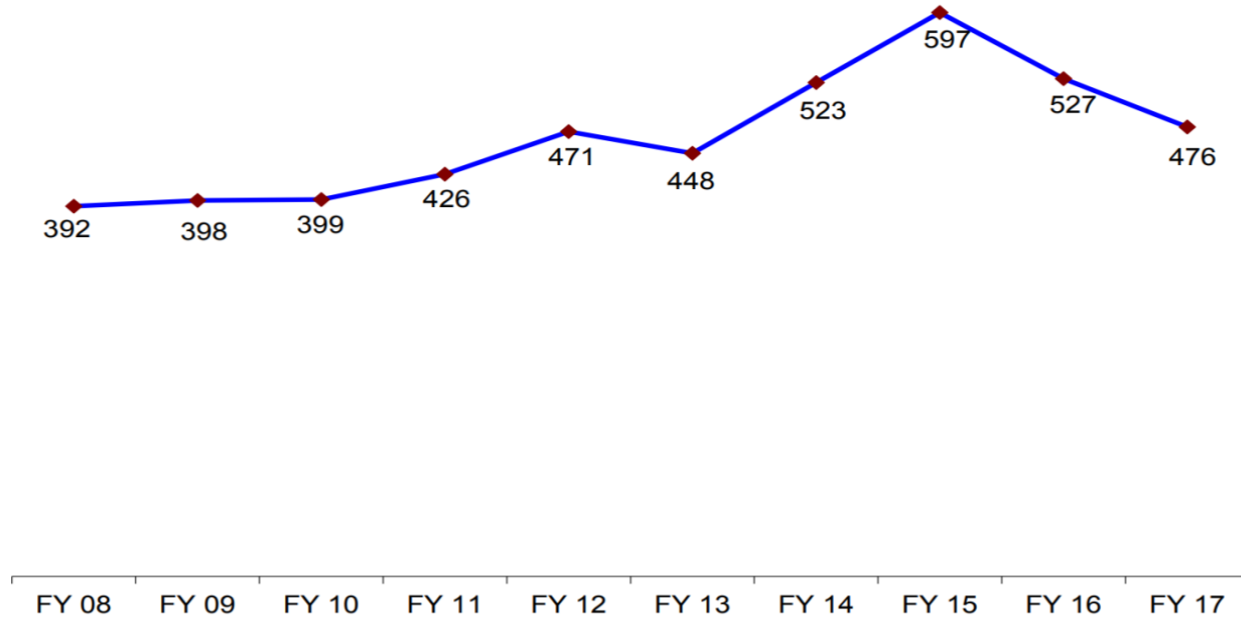
Appeals Filed in Major Origins



Notes: Includes reinstated, cross-, and consolidated appeals.

United States Court of Appeals for the Federal Circuit

Filings of Patent Infringement Appeals from the U.S. District Courts



Note: Includes reinstated, cross- and consolidated appeals.

United States Court of Appeals for the Federal Circuit

Median Time to Disposition in Cases Terminated After Hearing or Submission¹

Docketing Date² to Disposition Date, in Months

	<u>FY 08</u>	<u>FY 09</u>	<u>FY 10</u>	<u>FY 11</u>	<u>FY 12</u>	<u>FY 13</u>	<u>FY 14</u>	<u>FY 15</u>	<u>FY 16</u>	<u>FY 17</u>	Overall Median per Origin
District Court	11.0	11.0	11.0	11.2	11.8	11.8	12.0	12.0	13.0	13.0	11.8
Court of Federal Claims	9.2	10.3	10.0	10.6	9.9	10.4	10.0	10.0	9.0	9.0	10.0
Court of International Trade	12.4	11.5	11.0	12.2	12.6	12.4	13.0	12.0	13.0	15.0	12.4
Court of Appeals Veterans Claims	8.0	9.3	9.3	6.0	8.6	11.2	10.0	7.0	7.5	6.0	8.3
Board of Contract Appeals	9.6	11.9	8.8	10.0	11.5	13.3	16.0	10.0	10.0	9.0	10.0
Department of Veterans Affairs	4.8	18.9	n/a	19.4	15.7	n/a	n/a	16.0	13.0	17.0	16.0
Department of Justice	n/a	8.9	8.9	n/a	n/a	9.7	12.0	5.9	12.0	13.0	9.7
International Trade Commission	14.4	14.4	14.8	14.6	16.1	13.7	16.0	13.0	17.0	13.0	14.5
Merit Systems Protection Board	5.8	6.5	6.1	6.1	6.4	7.4	6.0	6.5	7.0	6.0	6.3
Office of Compliance	19.0	n/a	13.0	15.0	n/a	n/a	n/a	n/a	n/a	n/a	15.0
Patent and Trademark Office	8.9	9.3	8.2	11.2	11.7	10.1	10.0	11.0	11.0	13.0	10.6
Government Accountability Office	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a	11.0	n/a	11.0
Overall Median per Fiscal Year	9.4	10.7	9.7	11.2	11.7	11.2	12.0	10.5	11.0	13.0	

¹ Excludes cross and consolidated appeals, writs, and OPM petitions

² Calculated from Date of Docketing or Date of Reinstatement, whichever is later

SUPREME COURT

*OIL STATES ENERGY SERVICES, LLC V.
GREENE'S ENERGY GROUP, LLC*

THE IPR CONSTITUTIONALITY CHALLENGE

JULIE GOLDEMBERG
CASE NO. 16-712, 2018 WL 1914662
(U.S. APR. 24, 2018)

IPR History

- IPRs introduced via the AIA for cheaper means to challenge patents.
- PTAB proceeding is adversarial: discovery, motions, depositions, hearing.
- PTAB issues “final written decision,” appealable to the Federal Circuit.
- IPR proceedings are POPULAR.
 - 80% of IPR filings are for patents in co-pending district court litigation.
 - If IPRs are filed early, district courts tend to stay parallel proceedings.
 - Accused infringers who prevail in front of the PTAB can negate the infringement claims in the co-pending district court proceedings.

Oil States Background

- Oil States Energy Services owned a patent covering ways to protect wellhead equipment.
- Oil States filed an infringement suit against competitor Greene's Energy Group.
- Greene's then petitioned the PTAB to institute IPR, and the PTAB found claims anticipated.
- Oil States appealed to the Federal Circuit.
- The Federal Circuit summarily affirmed the PTAB without issuing an opinion (Rule 36).
- Oil States filed a petition for writ of certiorari, presenting the same constitutional challenges that the Supreme Court *previously declined to take up*.

Oil States' Constitutional Challenges

- IPRs violate separation of powers: exercise of the “judicial power” by an agency.
 - Patent validity disputes traditionally tried in courts.
 - PTAB adjudicates the competing interests of private parties.
 - Agency can only adjudicate if case involves a public, and not a private, right.

Public right when the claims (i) are by or against the government, (ii) have been historically resolved exclusively outside the judicial branch, or (iii) are resolved in a non–Article III tribunal because their location there is “essential to a limited regulatory objective . . . integrally related to particular federal government action.”

- Seventh Amendment requires that “the right of trial by jury shall be preserved” for most “suits at common law.”

Supreme Court Upholds Constitutionality of IPRs 7-2

- Patents are public rights: Granting a patent involves a matter “arising between the government and others.”
 - IPR is a second look at an earlier grant.
- Patent validity decided in 18th-century English courts of law, but no violation of the “general” principle that “Congress may not withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law.”
- No “looks like [litigation] test.”
- When Congress properly assigns something to a non-Article III tribunal, “the Seventh Amendment poses no independent bar.”

Takeaways

- *Inter partes* review is here to stay.
 - Look for PTO to continue tweaking the mechanics under new Director Iancu.
- Patents may be public rights, but this holding is narrow.
 - Court explicitly states it did not address whether patents are not property for purposes of the Due Process Clause or the Takings Clause.
- Court leaves door open for other constitutional challenges to PTO procedures.
 - Retroactive application of *inter partes* review to patents issued prior to the AIA.
 - Panel stacking.

SUPREME COURT

*IMPRESSION PRODUCTS V.
LEXMARK INTERNATIONAL*

PATENT EXHAUSTION AND SALES ABROAD

AUSTIN ZUCK

Case No. 15-1189 (U.S. May 30, 2017)

Plaintiff - Lexmark International, Inc.



- **Products at Issue:**

- Lexmark Toner Cartridges
- Sold in U.S. and internationally

- **Two Purchase Options**

1. "Regular" - Full Price; No Restrictions
2. "Return Program" - 20% Less; Post-Sale Restrictions to return to Lexmark & not refill

Defendant – Impression Products, Inc.

“Remanufacturer”



Acquire

- Acquire Used/Empty Cartridges
 - Regular and Return Program cartridges
 - Acquire from U.S. or International buyer

Refill

- Refill Cartridges
 - For Return Program cartridges – Refill & replace microchip that prevents re-use

Resell

- Resell Cartridges
 - Regardless of location of initial authorized sale, resell in U.S.

Patent Exhaustion – First Sale in U.S.

First: Toner Cartridges Sold in U.S.

- **Lexmark**
 1. Regular: No cause of action
 - No post-sale restrictions
 - Authorized sale exhausts Lexmark's patent rights
 2. Return Program: Infringement
 - Post-sale restrictions reserved
 - Lexmark's patent rights
 - Authorized sale did not exhaust patent rights
- **Impression Products**
 - Authorized sale exhausts patent rights for both cartridges



Patent Exhaustion – First Sale Abroad



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Cartridges Sold Internationally

- **Lexmark**
 - Regular and Return Program: No Exhaustion
 - International sales do not exhaust U.S. Patent Rights
 - Lexmark never authorized importation
- **Impression Products**
 - Authorized sale anywhere exhausts patent rights for both cartridges

Procedural History

35 U.S.C. § 154(a)(1)

A Patentee has the right “to **exclude others** from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States.”



District Court:

- Granted Impression’s motion to dismiss as to Return Program cartridges sold in U.S.
 - A cartridge sold in the U.S., even with post-sale restrictions, exhausts patentee’s patent rights.
- Denied Impression’s motion to dismiss as to all cartridges sold abroad.
 - A cartridge initially sold abroad does not exhaust patent rights.

Lexmark Int’l, Inc. v. Ink Techs. Printer Supplies, LLC, 9 F. Supp. 3d 830 (S.D. Ohio 2014)



Federal Circuit:

- Agreed with Lexmark on both issues
 - A legal post-sale restriction can reserve patentee’s patent rights.
 - A cartridge initially sold abroad does not exhaust U.S. patent rights because rights are territorial.

Lexmark Int’l, Inc. v. Impression Prod., Inc., 816 F.3d 721 (Fed. Cir. 2016)

Supreme Court Opinion

“[A] patentee’s decision to sell a product **exhausts all of its patent rights** in that item, regardless of any restrictions the patentee purports to impose or the location of the sale.”

Held: Lexmark exhausted its patent rights in the Regular and Return Program cartridges the moment it sold them, whether internationally or in the U.S.

- Post-sale restrictions are enforceable through contract law against the initial buyer, but cannot limit patent rights
- Relied on *Kirtsaeng v. John Wiley & Sons* (2013), holding that copyright owner loses right to restrict purchaser’s freedom after authorized sale under ‘first sale doctrine’
 - “[D]ifferentiating the patent exhaustion and copyright first sale doctrines would make little theoretical or practical sense: The two share a ‘strong similarity...and identity of purpose.’”

Takeaways

- An authorized sale anywhere in the world exhausts U.S. patent rights
- Post-sale restrictions can be enforced through contract law
 - Potential issues with privity with resellers; state law venue for contract disputes
- Pre-sale License restrictions can still preserve rights
 - Condition use on certain license terms – e.g., Software licenses
 - Distinction between “License” and “Sale” could be hard to establish
- Be cautious when pricing and selling internationally
 - Selling large quantities at very low prices may lead to re-sale in United States

FEDERAL CIRCUIT

AQUA PRODUCTS, INC. V. MATAL

THE BURDEN OF PERSUASION IN IPR PROCEEDINGS.

KARON FOWLER
872 F.3d 1290 (Fed. Cir. 2017)

En Banc Review

Issue 1: May the PTO require the patent owner to bear the burden of persuasion/production regarding patentability?

Issue 2: When the petitioner does not challenge the patentability of proposed amended claims or the Board finds the challenge inadequate, may the Board raise a patentability challenge sua sponte?



En Banc Decision

872 F.3d 1290 (Fed. Cir. 2017)

Issue 1: The Board cannot place the burden of establishing patentability of amended claims on the patent owner in IPR proceedings. Rather, the petitioner must establish that any proposed amended claims are not patentable.

Issue 2: Because the record did not present this precise issue, the Court declined to address the second issue. But the Court held that the Board must base a patentability determination on the entire record before it instead of merely on the face of the motion to amend claims.

Precedential Weight

The only legal conclusions that support and define the judgement of the court are that:

- 1. the PTO has not adopted a rule placing the burden of persuasion with respect to the patentability of amended claims on the patent owner that is entitled to deference; and**
- 2. in the absence of anything that might be entitled to deference, the PTO may not place that burden on the patentee.**

“All the rest of our cognitions, whatever label we have placed on them, are just that—cognitions.”

Takeaways

The Board will no longer place the burden of persuasion on the patent owner to prove patentability of any proposed substitute claims.

Petitioner:

- Ask for Sur-Reply if Patent Owner files a motion to amend.
- Petitioners should plan ahead in their petitions for potential motion to amend.

Patent Owner:

- Consider filing a motion to amend, after which the burden of persuasion will be placed on the Petitioner to prove unpatentability.
- Note, however, that the success rate of motions may not significantly change.

FEDERAL CIRCUIT

*MENTOR GRAPHICS CORP. V. EVE-
USA, INC.*

LOST PROFITS DAMAGES: HOW MUCH IS AT STAKE?

MICHAEL CARR
872 F.3d 1290 (Fed. Cir. 2017)

Patent Damages: Background

- **35 U.S.C. § 284:** “On finding for the claimant the court shall award the claimant damages adequate to **compensate** for the infringement, but **in no event less than a reasonable royalty** for the use made of the invention by the infringer”
- **Reasonable Royalty**
 - Reasonable royalty based upon an **established royalty**, if there is one, or if not upon a **hypothetical royalty** resulting from arm’s length negotiations between a willing licensor and a willing licensee. *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1078 (Fed. Cir. 1983)
 - The minimum amount of damages. Usually a smaller than lost profits.
- **Lost Profits**
 - Place the patentee in the same position had there been no infringement.
 - Not easy to prove.
 - *Panduit* test: Non-exclusive method to establish entitlement to lost profits. *Panduit Corp. v. Stahl Bros. Fibre Works*, 575 F.2d 1152 (6th Cir. 1978)
 1. **demand** for the patented product;
 2. **absence** of acceptable non-infringing alternatives;
 3. **manufacturing** and marketing **capability** to exploit the demand; and
 4. the amount of **profit** patentee would have made.

Patent Damages: Apportionment

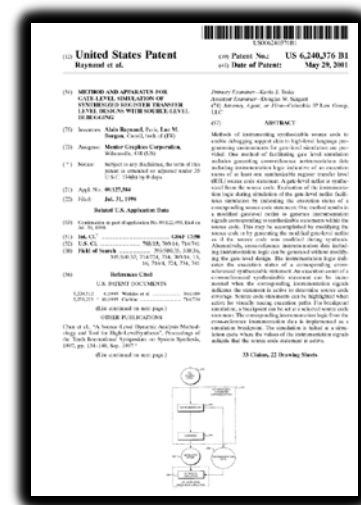
- *Garretson v. Clark*, 111 U.S. 120 (1884):
 - “[t]he patentee ... must in every case give evidence tending to **separate** or **apportion** the defendant’s profits and the patentee’s damages between the **patented feature** and the **unpatented features**.”
 - Patent damages must be based upon revenue or profits **attributed** to **patented feature**.
- **Lost profits**: Apportionment required?

Mentor Graphics Corp. v. EVE-USA, Inc. (D. Or.)

• Mentor: Velocite



Synopsys: ZeBu (EVE is a subsidiary)



• US Patent 6,240,376: emulators for debugging source code

• Undisputed Facts:

1. Many valuable features but Intel would not have purchased the Synopsys emulator system without the two patented features
2. No other alternatives available
3. But for infringement by Synopsys, Mentor would have made sales to Intel

• **Jury Verdict:** \$36 million lost profits

Mentor Graphics Corp. v. EVE-USA, Inc.

- **Synopsys Argument:** 2-step process for calculating lost profits.
 1. **All profits** it lost as a result of the infringement.
 2. **Further apportion** lost profits to determine what amount attributable to patent.
- The allegedly **infringing features** were just **two features** of emulators that consist of **thousands** of hardware and software **features**.
 - Why should Mentor get **all profits** for the lost sales instead of the **value attributable** to its patented features?
- *Ericsson, Inc. v. D-Link Sys., Inc.*, 773 F.3d 1201, 1226 (Fed. Cir. 2014)
 - “**apportionment** is required **even for non-royalty forms of damages**” (quoting *Garretson v. Clark*, 111 U.S. 120, 121 (1884)).

How much is at stake?



All Profit



*Profit
Attributed to
Patent???*



Mentor Graphics Corp. v. EVE-USA, Inc. 851 F.3d 1285 (Fed. Cir. 2017)

2017 Fed. Cir. Panel Opinion (Moore, J.):

- Apportionment **required** for lost profits damages.
 - “**apportionment** is an important component of damages law generally, and we believe it is **necessary** in **both reasonable royalty** and **lost profits** analysis.”
- *Panduit* test accomplishes apportionment.
 - “*Panduit*’s requirement that patentees prove **demand for the product as a whole** and the **absence of non-infringing alternatives** ties lost profit damages to specific claim limitations and ensures that **damages** are **commensurate** with the **value** of the **patented features**.”
 - “When the *Panduit* factors are met, they incorporate into their very **analysis** the **value** properly **attributed** to the **patented feature**.”

Mentor Graphics Corp. v. EVE-USA, Inc. 851 F.3d 1285 (Fed. Cir. 2017) *En Banc* Petition Denied

- Petition denied (Stoll, J.):
 - **Apportionment required** even for “non-royalty forms of damages”
 - **Narrow facts** of this case:
 - “Intel would **not have purchased** the [infringing] Synopsys emulator system **without** the two **patented features** and that there were **no** other **alternatives** available”
 - “the patented features were what *imbued* the **combined features** that made up the emulator with **marketable value.**”
 - “Under these circumstances, **further apportionment is unnecessary.**”
 - “the panel determined that **because** the *Panduit* **factors** are **satisfied**, the damages award properly **accounted** for **apportionment**. I do **not** read the panel’s decision to apply broadly to **all lost profits** analyses.”

Mentor Graphics Corp. v. EVE-USA, Inc. 851 F.3d 1285
(Fed. Cir. 2017) *En Banc* Petition Denied

- Dissent (Dyk, J.):
- Although Mentor would have made sales instead of Synopsys, “more than **but-for causation** is required for **apportionment**.”
 - “The **claimed damages** must be apportioned between **patented** and **unpatented features**.”

Takeaways

- **Apportionment required** in reasonable royalty and lost profits
- Apportionment may be accomplished by satisfying *Panduit* factors
- Lost profits under *Panduit* are not easy to prove (esp. factors 1 and 2)
 1. demand for the patented product as a whole;
 2. absence of acceptable non-infringing alternatives;
- **IF** customer would not have purchased accused product without infringing feature **AND** no available non-infringing alternatives, **THEN**, patentee is entitled to **ALL** its lost profits
 - This is so even if product had **many valuable** patented features.
- **Lost Profits Relatively Rare: PwC 2017 Patent Litigation Study**
 - For patentees that were **eligible** to obtain lost profits (No NPEs), from 2007 to 2016:
 - **61%** damages form of reasonable royalties
 - **21%** form of lost profits
 - **19%** included both lost profits and reasonable royalties

SUPREME COURT, FEDERAL CIRCUIT, AND FOURTH CIRCUIT

TRADEMARK DISPARAGEMENT

MATAL V. TAM 137 S.C.T. 1744 (U.S. 2017)
(THE "SLANTS" CASE)

PRO-FOOTBALL V. BLACKHORSE 709 F. APP'X 182 (4TH CIR
2018)
(THE "REDSKINS" CASE)

IN RE BRUNETTI 877 F.3D 1330 (FED. CIR. 2017)
(THE "FUCTION" CASE)

SCOTT TESTER

Disparaging, Vulgar, and “Immoral” Trademarks



Matal v. Tam Background

- Simon Tam formed *The Slants* in 2006 to “reclaim” Asian stereotypes.
- Tam applied to register “The Slants”
 - Denied by Examiner (twice), TTAB, Federal Circuit
 - The term “Slants” disparages Asians.
 - Reversed by Federal Circuit *en banc* (2015)
 - The bar on registration of “disparaging” marks in 15 U.S.C. § 2(a) violates the First Amendment.
- Supreme Court granted PTO’s (Lee’s) request for cert (2016).

Pro-Football v. Blackhorse Background

- Formed as the Boston Braves in 1932.
- Renamed the Redskins when they relocated to DC in 1937.
 - Complaints about the name were first reported as early as the 1940's-50's.
 - Owner stated "Redskins" was chosen to honor Native American coaches and players
- TTAB canceled Redskin's trademarks (*Harjo v. Pro-Football*, 1999)
 - Reversed by DC District Court (2003 & 2008)
 - Laches bars termination of trademarks known about for decades
- TTAB canceled Redskin's trademarks (*Blackhorse v. Pro-Football*, 2014)
 - AIA's change of venue for TMs from DC to Fed or 4th Circuits permits refiling
 - Laches does ***not*** apply to disparagement of a *class* of people
 - Upheld by USDC Ed. Va. (2015).
- Pro-Football appealed to 4th Circuit.

In Re Brunetti Background

- Erik Brunetti began selling clothing under the FUCT brand in 1990.
 - Friends U Can't Trust
 - Clothing generally took anti-government and anti-religious slants.
 - Frequently displays images deemed by some to be immoral or vulgar.
- In 2011, applications were filed for the use of FUCT in clothing.
 - Denied by Examiner, TTAB
 - Determined to be a “phonetic twin” of fucked, “one of the most offensive English words.”
- Brunetti appealed to the Federal Circuit.

Trademarks and First Amendment Issues

- Government speech?
 - PTO argued mark registration is government speech, as the government must issue the registration.
 - Applicants argued registration is private speech, as the applicants choose which marks to register.
- Viewpoint Neutral?
 - *Slants*: PTO argued that rejection of disparaging remarks is viewpoint-neutral, despite rejecting only marks it finds “refer to a group in a negative way,” while allowing “positive” marks.
 - *Brunetti*: PTO argued that, unlike disparaging remarks, which have a positive v. negative viewpoint, vulgar marks are viewpoint-neutral.
- Commercial speech?
 - Question saved for another day.

Tam at the Supreme Court

- “Slants” is disparaging to Asians.
 - Tam’s examples of allowed trademarks arguably disparaging to others in the past were insufficient to overcome the clear meaning of the statute.
- Trademarks are private speech
 - Marks are submitted by the applicants and the government is paid to register them.
 - The government cannot “edit” or modify the marks; rather the government must either accept the registration request or not.
- Section 2(a)’s ban on disparaging remarks is “facially unconstitutional.”
 - Viewpoint discriminatory.
 - Rejection of only “disparaging” (as opposed to “uplifting”) marks is the very “essence of viewpoint discrimination.”
 - Held to fail both strict scrutiny and the lower *Central Hudson* standard of “a substantial interest... narrowly drawn” used for commercial speech.

Brunetti at the Federal Circuit

- FUCT is vulgar (“and therefore scandalous”)
 - When read aloud, “fuct” sounds like “sounds like “the past tense of the verb ‘fuck,’ a vulgar word, and is therefore scandalous.”
 - Confirmed by Urban Dictionary.
 - Federal Circuit confirmed reliance on this “website to which anyone can anonymously submit declarations” and held “the Board reasonably focused on the highest rated definition.”
- Section 2(a)'s bar on vulgar and immoral remarks is unconstitutional.
 - “Immoral and scandalous” bar is not limited to “material which deals with sex.”
 - All “obscene marks would be scandalous,” but “not all scandalous or immoral marks are obscene.”
 - Does not matter whether it is viewpoint-discriminatory.
 - Not the Court's place to re-write statutes to make them constitutional.

Takeaways

- PTO must register (and cannot cancel) disparaging marks.
 - Simon Tam got his long-awaited registered mark.
 - Registered November 14, 2017, eight years after he first applied.
 - Pro-Football keeps its trademark registrations.
 - Without expressing opinion (or allowing for oral argument), the 4th Circuit instructed the district court to reverse the TTAB's cancellation of the many Redskins marks.
 - Brunetti will get his registration.
 - Already put "fuct[®]" on his clothes.
- Congress *could* pass a new ban on "obscene" marks.
 - May be held by Federal Circuit to be viewpoint discriminatory.
- Citations to the Urban Dictionary may be okay.

FEDERAL CIRCUIT

ENERGY HEATING V. HEAT ON-THE-FLY

INEQUITABLE CONDUCT AND ATTORNEYS FEES

DAVID BERNSTEIN

Case No. 16-1559 (Fed. Cir. May 4, 2018)

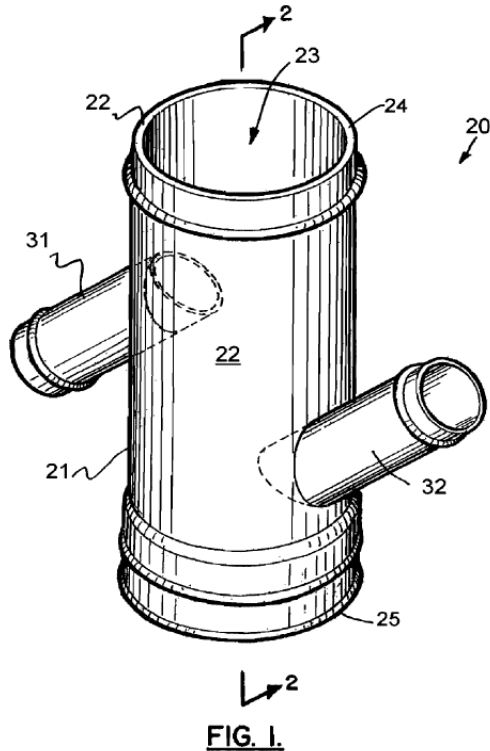
Losing Big

- Patentee and declaratory judgment defendant Heat On-The-Fly (HOTF) tried to enforce their patent relating to heating water on demand during hydraulic fracturing (“fracing”)
- The result? Heat On-The-Fly:
 - Lost its patent;
 - Had a jury verdict award against them for tortious interference; and
 - Is heading back to District Court on the issue of Attorney’s Fees.
- What happened?

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- The result? Heat On-The-Fly:
 - Lost its patent;
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 - Is heading back to District Court on the issue of Attorney’s Fees.
- What happened?

Heating Water On-demand for Fracing



- In fracing, heated water is mixed with fracing chemicals (called “proppants”).
- The proppant holds open the fractures and provides porosity to allow hydrocarbons to flow out the formation
- Prior art used large “frac tanks,” typically heated up the night before.
- Claim 1 of HOTF’s ‘993 patent is a method that uses “a transportable heating apparatus” and “a mixer.” (Shown left).

On-sale Activity

- HOTF filed for, and obtained, U.S. Patent No. 8,171,993 ('933 patent)
- The earliest provisional application was filed September 18, 2009.
- Thus, the critical date for the on-sale bar under pre-AIA 102 was September 18, 2008.
- Prior to September 18, 2008, starting as early as October 2006, HOTF performed at least 61 frac jobs using the claim method and collected over \$1.8 million dollars from the pre-critical heat-on-the-fly services.
- These on-sale activities were not disclosed to the USPTO during prosecution of the '933 patent.

Energy Heating, LLC v. Heat On-The-Fly, LLC, No. 2016-1559, 2018 WL 2072122, at *1-2 (Fed. Cir. May 4, 2018).

Inequitable Conduct

- Inequitable conduct is an equitable defense to patent infringement alleging that the applicant breached his or her duty of candor during patent prosecution.
- A finding of “fraud,” “inequitable conduct,” or violation of duty of disclosure with respect to any claim in an application or patent, renders all the claims thereof unpatentable or invalid. See *Therasense Inc. v. Becton Dickinson and Co.*, 649 F.3d 1276, 1288 (Fed. Cir. 2011).

Inequitable Conduct Standard

- To prevail on inequitable conduct, the accused infringer must prove by clear and convincing evidence that
 - The applicant knew of the reference or prior commercial sale;
 - **The applicant knew that it was material;**
 - **Made a deliberate decision to withhold it (i.e., intended to deceive).**

Therasense Inc. v. Becton Dickinson and Co., 649 F.3d 1276, 1290 (Fed. Cir. 2011).

Materiality of On-sale Activity

- On-sale activity triggers the statutory bar under 102 if the invention was both:
 - The subject of a commercial sale or offer for sale (using principles of contract law); and
 - Was “ready for patenting”

Pfaff v. Wells Elecs., Inc., 525 U.S. 67 (1998)

- A prior commercial sale will not serve as a bar if it was a bona fide experiment to:
 - Test the *claimed* features; or
 - Determine if the invention would work for its intended purpose

Clock Spring, L.P. v. Wrapmaster, Inc., 560 F.3d 1317 (Fed. Cir. 2009).

Experimental Use as the flip side of “Ready for Patenting”

- “In other words, an invention may not be ready for patenting if the claimed features or overall workability are being tested.” *Clock Spring*, 560 F.3d at 1327.
- HOTF’s founder, Mr. Hefley, testified that the 61 pre-critical sales were intended to experiment on the following issues:
 - To heat water at the same rate that the water was being pumped downhole;
 - To get a thirty degree rise in temperature; and
 - To achieve those results consistently. *Energy Heating, LLC*, 2018 WL 2072122, at *6 (Fed. Cir. May 4, 2018)
- “None of these purported experimental criteria are reflected in the claims of the patent.” *Id.*

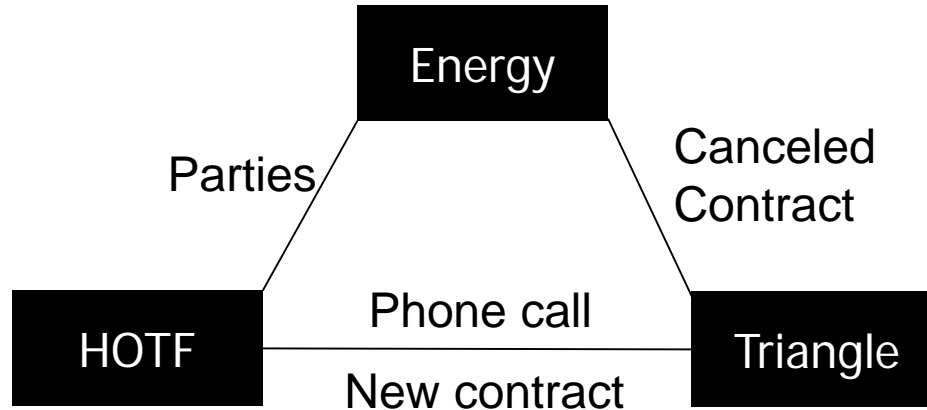
Intent to Deceive the PTO

- “[S]pecific intent to deceive must be ‘the single most reasonable inference able to be drawn from the evidence.’ ” *Energy Heating, LLC.*, 2018 WL 2072122, at *6.
- “Mr. Hefley knew that the patent process required that he file his application within one year of the first offer for sale or public use. It is undisputed that Mr. Hefley’s business partner had discussed the on-sale bar requirement with him.” *Id.* at *4.
- HOTF’s patent attorney “would have testified that Mr. Hefley told him about the 61 frac jobs, but that Mr. Nehbass decided they were all experimental uses that did not need to be disclosed.” *Id.* at *7
- However, HOTF had asserted attorney-client privilege with respect to the patent attorney, and his testimony was properly excluded. *Id.*

Inequitable Conduct Affirmed

Tortious Interference

- “State tort claims based on enforcing a patent, including for tortious interference, are preempted by federal patent laws, unless the claimant can show that the patent holder acted in bad faith.” *Energy Heating, LLC*, 2018 WL 2072122, at *8.



Tortious Interference Affirmed

- “We have reviewed the record and find substantial evidence to support the jury's finding of bad faith. Energy presented sufficient evidence to allow a reasonable fact finder to conclude that HOTF, the patent holder, acted in bad faith, and therefore its claim for tortious interference falls within the bad-faith exception to preemption. We therefore affirm.” *Energy Heating, LLC*, 2018 WL 2072122, at *8.

Takeaways

- Disclose all colorable on-sale activities, even if you determine that they fall within an exception to the on-sale bar.
- The consequences of a failure to disclose on-sale activities can be worse than losing the patent.

SUPREME COURT

TC HEARTLAND LLC

PATENT VENUE (AND THE FATE OF THE E.D. TEXAS)

COREY HOUMAND
Case No. 16-341 (U.S. May 22, 2017)

Underlying Facts

- TC Heartland LLC:
 - Is a limited liability company under Indiana law and headquartered in Indiana.
 - Was sued for patent infringement in Delaware.
 - Maintains no business presence in Delaware.
- The District of Delaware denied TC Heartland's motion to transfer venue.
- The Federal Circuit denied TC Heartland's petition for mandamus.

The Patent Venue Statute

- 28 U.S.C. § 1400(b) provides:

§ 1400. Patents and copyrights, mask works, and designs.

(b) Any civil action for patent infringement may be brought in the judicial district **where the defendant resides,** or where the defendant has committed acts of infringement and has a regular and established place of business.

The *TC Heartland* Decision

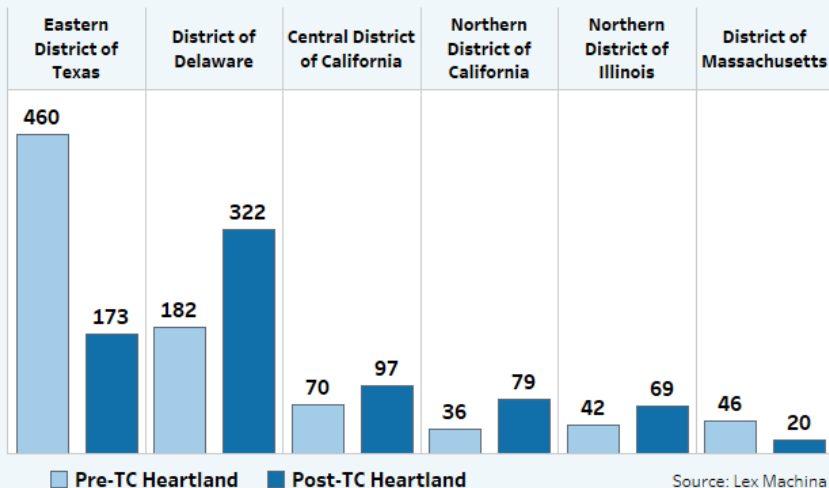
The U.S. Supreme Court held that, for purposes of § 1400(b), **a domestic corporation “resides” only in its State of incorporation** for purposes of the patent venue statute.

TC Heartland LLC v. Kraft Foods Group Brands LLC, 137 S. Ct. 1514 (2017).

TC Heartland's Impact

TC Heartland Reshapes The Patent Map

In the nearly four months since the U.S. Supreme Court's TC Heartland decision set new rules on where patent suits can be filed, far fewer cases have been filed in the Eastern District of Texas, while Delaware, California and Illinois have seen considerably more compared with the four-month period prior to TC Heartland.



- Delaware and the E.D. Tex. have traded places.
- Delaware: 322 cases filed in the three months since *TC Heartland*, compared with 182 cases in the preceding three months.
- E.D. Tex.: A 60% drop in patent infringement filings.

Comparison of Leading Judicial Districts

District	Patent Holder Success Rate	Median Years to Trial	Median Damages
E.D. Texas	54%	2.2	\$9.9 million
Delaware	41%	2.1	\$16.2 million
N.D. Texas	47%	2.4	\$4.8 million
New Jersey	38%	2.7	\$16.2 million
E.D. Virginia	29%	1.0	\$32.7 million
N.D. Calif.	27%	2.6	\$5.4 million
C.D. Calif.	26%	2.3	\$3.1 million

Resolving Lingerin Questions

- “Unincorporated associations, such as limited liability companies, are generally treated like corporations for purposes of venue, whereby the ‘residence’ is the association’s principle place of business.”

Maxchief Investments Ltd. v. Plastic Dev. Group, LLC, 2017 WL 3479504 (E.D. Tenn. 2017)
(transferring LLC defendant).

- “[S]uits against aliens are outside the scope of venue laws.”

Brunette Machine Works, Ltd. v. Kokum Indus., Inc., 406 U.S. 706, 711 (1972).

- Plaintiffs must establish that venue is proper against each defendant.

Takeaways

- Under the Supreme Court's holding, patent suits against domestic corporations may now be filed only:
 - In a defendant corporation's state of incorporation; or
 - Where the defendant corporation "has committed acts of infringement *and* has a regular and established place of business."
- Some new filings in N.D. Cal., many in D. Del. E.D. Tex still seems to be busy.

FEDERAL CIRCUIT

IN RE CRAY INC.

"REGULAR AND ESTABLISHED" POST-TC HEARTLAND

THOM NOLAN
CASE NO. 2017-129
(SEP. 21, 2017)

Raytheon Co. v. Cray, Inc. (E. District of Tex.)

- In a suit for patent infringement, Cray moved to transfer from E.D. Texas to W.D. Wisconsin.
- Judge Rodney Gilstrap held that Cray's employment of a work-from-home employee in the district constituted a "regular and established place of business."
- The Judge also announced a four factor test for future cases:
 - 1. Physical presence in the district.
 - 2. The defendant's representations.
 - 3. Benefits received by the defendant in the district.
 - 4. Targeted transactions with the district.

In Re Cray: The Federal Circuit Creates Its Own Test

As discussed in greater detail below, our analysis of the case law and statute reveal three general requirements relevant to the inquiry: **(1) there must be a physical place in the district**; **(2) it must be a regular and established place of business**; and **(3) it must be the place of the defendant**. If any statutory requirement is not satisfied, venue is improper under § 1400(b).

- Applying this test, the Federal Circuit reversed the District Court's decision.

Applying the Federal Circuit's Test

Cray's Contacts With E.D. Texas

Physical Place?

- Two homes of Cray's employees were within E.D. Texas.

Regular & Established?

- Those employees regularly conducted business from their homes

Of The Defendant?

- The fact that Cray allowed its employees to work from home is insufficient.
- Cray did not own, lease, or rent any portion of their employees' homes in E.D. Texas.
- There was no evidence that the employees' location in the Eastern District of Texas was material to Cray in any way.

VENUE = IMPROPER

Takeaways: Choosing and Challenging Venue

- Considerations for Plaintiffs:
 - The safest venue choice is the target's forum of incorporation
 - Some courts may be willing to consider the presence of related or subsidiary entities for purposes of venue.
- Considerations for Defendants:
 - Venue is unlikely to be proper if only remote work employees are employed in the district.

FEDERAL CIRCUIT

*PATENTABLE SUBJECT MATTER
TODAY*

*THE CASES AND THE USPTO'S INTERPRETATION OF
THEM*

BEN PEZZNER
MATT WALKER

SECTION 1

FEDERAL CIRCUIT DECISIONS

How 2016 ended - Electric Power Group

- Broad abstract idea of “collecting information, analyzing it, and displaying certain results of the collection and analysis”
- Held that providing a “humanly comprehensible” amount of information is not sufficient to transform otherwise-abstract processes
- Led to a rash of Section 101 rejections by the Patent Office for software-related patent applications
- Some opportunities to distinguish:
 - Claim a new source or type of information, or new techniques for analyzing it

2017 By the Numbers



- 22 Federal Circuit decisions citing to *Alice* and determining whether claims are subject matter eligible
 - 21 involved software
 - 19 held that the claims were ineligible
 - 11 cited to *Electric Power Group*

Abstract Ideas



Financial

- *paying for a remote purchase at a local retailer*
- *paying for transit with a bank card*
- *processing an application for financing a purchase*
- *financial risk assessment*
- *billing insurance companies*
- *conditioning and controlling access to data based on payment*
- *providing a vehicle valuation through the collection and use of vehicle information*

Abstract Ideas

Data Manipulation

- *identifying/characterizing files based on selection criteria*
- *routing information*
- *communicating information about a mail object*
- *relaying mailing address data*
- *encoding and decoding image data*
- *collecting, organizing, and displaying information*
- *collecting, displaying, and manipulating data*
- *receiving, authenticating, and publishing data*
- *creating/using an index to search for and retrieve data*
- *remotely accessing user specific information*
- *providing restricted access to resources*
- *calculating and comparing regions in space*

Visual Memory v. NVIDIA



- Claims directed to "an improved computer memory system" having a programmable cache based on the processor type
- Configuring the memory system based on the type of processor connected to the memory system is an improvement in computer technology
- The specification explains that multiple benefits flow from the patent's improved memory system

Thales Visionix Inc v. US

- Claims directed to use of inertial sensors in a non-conventional manner to measure the relative position and orientation of a moving object on a moving reference frame
- The claims reduce errors / eliminate many “complications” inherent in previous solutions for determining position and orientation of an object on a moving platform
- The application of physics can create an improved technique for measuring movement of an object on a moving platform.
- A new and useful technique for using sensors to more efficiently track an object on a moving platform is patent eligible

Trading Technologies International Inc. v. CQG Inc.

- Claims directed to electronic trading of stocks, bonds, futures, options and similar products
- Require a specific, structured graphical user interface paired with a prescribed functionality
- Addresses and resolves a specifically identified problem in the prior state of the art
- Specific technologic modifications to solve a problem or improve the functioning of a known system generally produce patent-eligible subject matter
- Abstraction is avoided or overcome when a proposed new application or computer-implemented function is not simply the generalized use of a computer as a tool to conduct a known or obvious process, but instead is an improvement to the capability of the system as a whole.

Finjan Inc. v. Blue Coat Systems Inc.

- The claims directed to providing computer security by scanning a downloadable and attaching the results of that scan to the downloadable itself in the form of a “security profile.”
- Employs a new kind of file that enables a computer security system to do things it could not do before
- The claims recite specific steps—generating a security profile that identifies suspicious code and linking it to a downloadable—that accomplish the desired result

Core Wireless v. LG

- The claims directed to an improved user interface for computing devices
- Claimed limitations disclose a specific manner of displaying a limited set of information to the user, rather than using conventional user interface methods to display a generic index on a computer
- The specification confirms that these claims disclose an improved user interface for electronic devices
- The disclosed invention improves the efficiency of using the electronic device by bringing together “a limited list of common functions and commonly accessed stored data”

Takeaways

- Avoid identifying a problem without providing a technical solution
 - *For example: A method for remotely accessing data of varying types comprising ... using code to access the data*
- Avoid arguing that the claims do not preempt the abstract idea and/or are limited to a particular field
- Explain in the specification how the claimed invention provides benefits over conventional systems (i.e., a technical solution to a technical problem)
- Emphasize new sources or types of information, or new techniques for analyzing it

SECTION 2

USPTO INTERPRETATION AND GUIDANCE

Sources of Examiner Guidance

1) MPEP 2106

- 2106.04: Alice Step 1 (2A)
- 2106.05: Alice Step 2 (2B)
- 2106.07: OA Requirements

2) USPTO SME Page: Examination guidance: Memos, Training slides

3) USPTO SME Page: Chart of subject matter eligibility court decisions

MPEP 2106.05(a)-(h) (Alice Step 2)

Ineligible

- (a) No Improvements to Computer/Technology →
RecogniCorp v. Nintendo, Return Mail v. US Postal, Credit Acceptance v. Westlake, Cleveland Clinic v. True Health
- (d) Well-Understood, Routine, Conventional →
Cleveland Clinic v. True Health (determine biomarker level)
Return Mail v. US Postal (decoding undeliverable mail data)
- (f) Mere Instructions to “Apply it” →
Intellectual Ventures v. Capital One
Intellectual Ventures v. Erie
- (g) Insignificant Extra-Solution Activity
Intellectual Ventures v. Erie (use of well-known XML tags to form an index)
- (h) Field of Use
Intellectual Ventures v. Erie (limiting to use with XML tags)

Eligible/Remanded

- (a) Improvements to Computer/Technology
Visual Memory v. NVIDIA, Thales v. US, Trading Techs v. COG
- (d) Unconventional
Berkheimer v. HP (see USPTO Memo), Aatrix Software v. Green Shades Software, Exergen v. Kaz
- (f) More than “Applying it”
Thales v. US
- (b) Particular Machine
- (c) Particular Transformation
- (e) Other Meaningful Limitations

Berkheimer Memo (USPTO SME page)

Berkheimer v. HP, Inc. (CAFC, 2018)

- Digitally processing and archiving files in a digital asset management system
- “Eliminates redundant storage of common text and graphical elements, which improves system operating efficiency and reduces costs” (CAFC citing the spec)
- Issue on summary judgment: whether claims are “well-understood, routine, conventional” in context of 101 eligibility
- Holding: Claims 4-7 directed to improvements; whether those improvements are well-understood, routine, conventional = a question of fact

Berkheimer Memo (USPTO SME page)

USPTO Memo:

No More Hand-Waving Conventionality!



Berkheimer Memo (USPTO SME page)

Memo: Claim elements are not well-understood/routine/conventional (WRC) unless examiner expressly cites to:

1) Express statement in the Applicant's specification

Statement must describe element as being WRC

2) Court decision discussed in MPEP 2106.05(d)(II)

Claim elements must closely match those in the list (narrow list)

3) Publication that discusses the state of the art

Must describe the state of the art + WRC nature (can't just cite to a random patent)

4) Examiner's personal knowledge (official notice)

If Applicant objects, Examiner must provide (1)-(3) above to support rejection

Berkheimer Memo (USPTO SME page)

Memo: Claim elements are not well-understood/routine/conventional (WRC) unless examiner expressly cites to:

1) Express statement in the Applicant's specification

Examiner training: look for written description shortcuts ("so well known it satisfies 112a")

2) Court decision discussed in MPEP 2106.05(d)(II)

List will likely grow with subsequent MPEP revisions

3) Publication that discusses the state of the art

Examiner training: look through IDS references for discussions of "the state of the art"

4) Examiner's personal knowledge (official notice)

Same rules as 103 Official notice: challenge it (or you have agreed)

Chart of Court Decisions (USPTO SME web page)

- More up to date than MPEP 2106
- Facts reduced to 10 words or less
- Holding reduced to 1 word
- Examiners are not encouraged (or trained) to analyze

Case Name	Decision Type	Citation	Decision Date	Patent(s) or App. No(s)	Title or General Subject Matter	Claim Type	Exception Type	Judicial Conclusion	Classification (USPC & CPC)
<i>Voter Verified, Inc. v. Election Systems & Software LLC</i>	Precedential	__ F.3d __ (Fed Cir. 2018) CAFC Appeal No. 2017-1930	4/20/2018	RE40,449	Method for self-verified voting	Method, System	Abstract Idea	Ineligible	235/386 G07C 13/00
<i>Vanda Pharmaceuticals Inc. v. West-Ward Pharmaceuticals Int'l Ltd.</i>	Precedential	__ F.3d __ (Fed Cir. 2018) CAFC Appeal No. 2016-2707, 2016-2708	4/13/2018	8,586,610	Treating schizophrenia patients with iloperidone	Method	Law of Nature	Eligible	514/320 C07D 405/12
<i>Maxon LLC v. Funai Corp.</i>	Non- precedential with opinion	__ Fed. Appx. __ (Fed Cir. 2018) CAFC Appeal No. 2017-2139	4/9/2018	8,989,160 7,489,671 7,486,649 7,171,194	Managing services to an audio-video device in a personal network	Method, Device	Abstract Idea	Ineligible	370/338 H04W 84/12 455/418 H04W 8/245
<i>In re Bhagat</i>	Non- precedential with opinion	__ Fed. Appx. __ (Fed Cir. 2018) CAFC Appeal No. 2016-2525	3/16/2018	12/426,034	Lipid-containing compositions and methods of use thereof	Method, Product	Natural Phenomenon	Ineligible	514/183 A61K 31/20
<i>Intellectual Ventures I LLC, v. Symantec Corp.</i>	Non- precedential with opinion	__ Fed. Appx. __ (Fed Cir. 2018) CAFC Appeal No. 2017-1814; 2017-1858	3/15/2018	5,537,533	Method of remote mirroring of digital data from a primary server to a remote server	Method	Abstract Idea	Ineligible Claims 25 and 33	714/511 H05K 999/99
<i>Exergen Corp. v. Kaz USA, Inc.</i>	Non- precedential with opinion	__ Fed. Appx. __ (Fed Cir. 2018) CAFC Appeal No. 2016-2315, 2016-2341	3/8/2018	7,787,938 6,292,685	Temporal artery temperature detector	Method, Device	Law of Nature	Eligible '938: 17, 24, 33, 39, 40, 46, 49, 60 and 66 '685: 7, 14, and 24	600/474 G01J 5/04
<i>Automated Tracking Solutions, LLC v. The Coca-Cola Co.</i>	Non- precedential with opinion	__ Fed. Appx. __ (Fed Cir. 2018) CAFC Appeal No. 2017-1494	2/16/2018	8,896,449 8,842,013 7,834,766 7,551,089	Method for tracking objects and people using RFID	Method, System	Abstract Idea	Ineligible	340/572.4 G06K 7/0008

Chart of Court Decisions (USPTO SME web page)

Example: Two-Way Media v. Comcast (CAFC, 2017)

- USPTO Chart: “A scalable architecture for IP Multicasting” = “Ineligible”
- However, CAFC:
 - “While the specification may describe an innovative ‘scalable architecture,’ claim 1 does not.”
 - The concepts themselves look eligible, but the claims are ineligible because they did not reflect the innovations discussed in the spec

Takeaways

- Consult newly revised MPEP 2106.04/05/07 when formulating 101 responses
- Ensure 101 rejections follow guidance on USPTO SME page (especially Berkheimer memo)
- Compare examiner's source of case law knowledge (the chart) with missing nuance from the actual opinion

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Morgan Lewis



Biography



Andrew J. Gray IV

Silicon Valley

T +1.650.843.7575

andrew.gray@morganlewis.com

Serving as the leader of Morgan Lewis's semiconductor practice, Andrew J. Gray IV concentrates his practice on intellectual property (IP) litigation and prosecution and on strategic IP counseling. Andrew advises both established companies and startups on computer and Internet law issues, financing and transactional matters that involve technology firms, and the sale and licensing of technology. He represents clients in patent, trademark, copyright, and trade secret cases before state and federal trial and appellate courts throughout the United States, and before the US International Trade Commission.

Biography



David Bernstein counsels clients in intellectual property and, in particular, focuses on patent prosecution. He has drafted and prosecuted patent applications in a variety of technological fields in signal processing, circuit design, semiconductor devices, memory architecture, and GPS navigation. Additional areas of his work include computer science and other fields of engineering.

David Bernstein

Silicon Valley

T +1.650.843.7838

david.p.bernstein@morganlewis.com

Biography



Michael F. Carr

Silicon Valley

T +1.650.843.7568

michael.carr@morganlewis.com

Michael F. Carr represents clients in patent, copyright, trade dress, and trade secret misappropriation actions. With a focus on patent litigation, he also partners with clients in antitrust and complex commercial cases. When it comes to preventative practice, Michael counsels clients on prelitigation strategy and intellectual property (IP) licensing issues. He has worked with clients in the smartphone, optoelectronic transceiver, video-on-demand (VOD) technology, video game hardware, satellite communications, semiconductor manufacturing, and image sensor technology industries.

Biography



Karon N. Fowler

Silicon Valley

T +1.650.843.7265

karon.fowler@morganlewis.com

Karon N. Fowler represents clients in intellectual property disputes involving patents, trademarks, copyrights, and trade secrets. Karon has had bench and jury trial experience throughout the United States, including before the US International Trade Commission. She has also contributed to post-grant proceedings before the US Patent and Trademark Office. Karon's experience spans a case's lifecycle from the time of filing, at trial, and through appeal.

Biography



Julie S. Goldemberg

Philadelphia

T +1.215.963.5095

julie.goldemberg@morganlewis.com

Julie S. Goldemberg represents clients in patent, trademark, trade secret, and other intellectual property matters. Building on her background in electrical engineering, she has experience litigating traditional patent infringement cases and Hatch-Waxman cases in US federal district courts at all stages from the time of filing the complaint to the completion of all appeals. Prior to joining the firm, Julie clerked for Chief Judge Sharon Prost of the US Court of Appeals for the Federal Circuit.

Biography



Thomas Y. Nolan

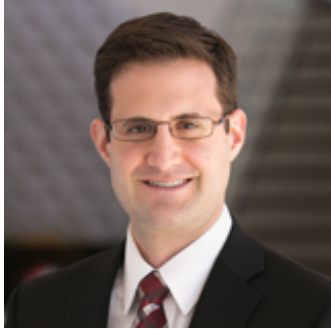
Silicon Valley

T +1.650.843.7283

thomas.nolan@morganlewis.com

Thomas Y. Nolan handles intellectual property matters, including patent disputes in federal courts and administrative agencies, as well as trademark prosecution. He also assists clients in responding to data breaches and other data security incidents. While in law school, Thomas worked with the Samuelson Law, Technology and Public Policy clinic to research and advise clients on the evidentiary implications of police use of body-worn cameras.

Biography



Benjamin H. Pezzner

Silicon Valley

T +1.650.843.7584

benjamin.pezzner@morganlewis.com

Benjamin H. Pezzner brings a diverse background in patents to his intellectual property (IP) practice, including experience as a patent examiner, an electrical design engineer, and an inventor. This background enables Benjamin to bring a unique combination of perspectives to a practice that includes counseling clients on patent strategy and prosecution in a variety of computer hardware and software fields.

Biography



W. Scott Tester

Silicon Valley

T +1.650.843.7532

scott.testers@morganlewis.com

With an educational and professional background in electrical and computer engineering, litigator W. Scott Tester concentrates his practice on patent disputes involving the electrical and mechanical arts, as well as other related Intellectual Property (IP) matters. Prior to attending law school, Scott worked as a senior design engineer with a major telecommunications firm, where he specialized in telecommunications, network management, and security. He holds a BS degree in electrical and computer engineering from North Carolina State University.

Biography



Matthew M. Walker

Silicon Valley

T +1.650.843.7857

matthew.walker@morganlewis.com

Matthew M. Walker brings a diverse technical background to his legal practice, including degrees in physics and electrical engineering as well as experience as both a design engineer and a process engineer. This background enables Matthew to bring depth and perspective to a practice that includes counseling clients on patent strategy and prosecution in a variety of technical fields. He works with cutting-edge innovations in computer hardware and software, semiconductor chip design, and biomedical devices.

Biography



Austin L. Zuck

Silicon Valley

T +1.650.843.7266

austin.zuck@morganlewis.com

Austin Zuck focuses his practice on litigation involving patents, trademarks, copyrights, trade secrets, and related intellectual property matters. His practice also includes assisting clients with trials before the Patent Trial and Appeal Board (PTAB), including inter partes review proceedings. While in law school, Austin worked with the Entrepreneurs Law Clinic to advise new clients on intellectual property strategy.

Our Global Reach

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