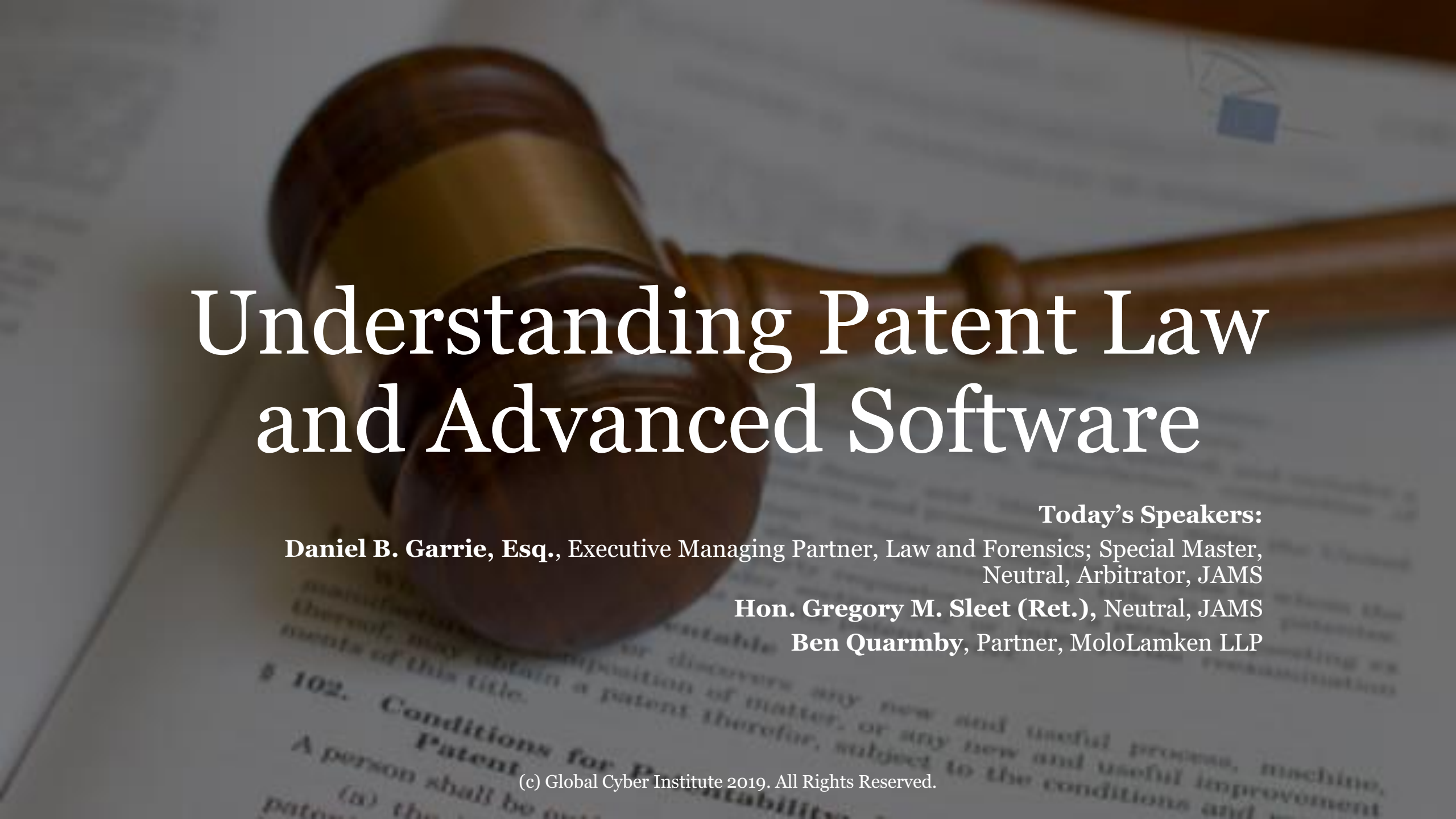


Understanding Patent Law and Advanced Software

Today's Speakers:

Daniel B. Garrie, Esq., Executive Managing Partner, Law and Forensics; Special Master, Neutral, Arbitrator, JAMS

Hon. Gregory M. Sleet (Ret.), Neutral, JAMS

Ben Quarmby, Partner, MoloLamken LLP

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Agenda

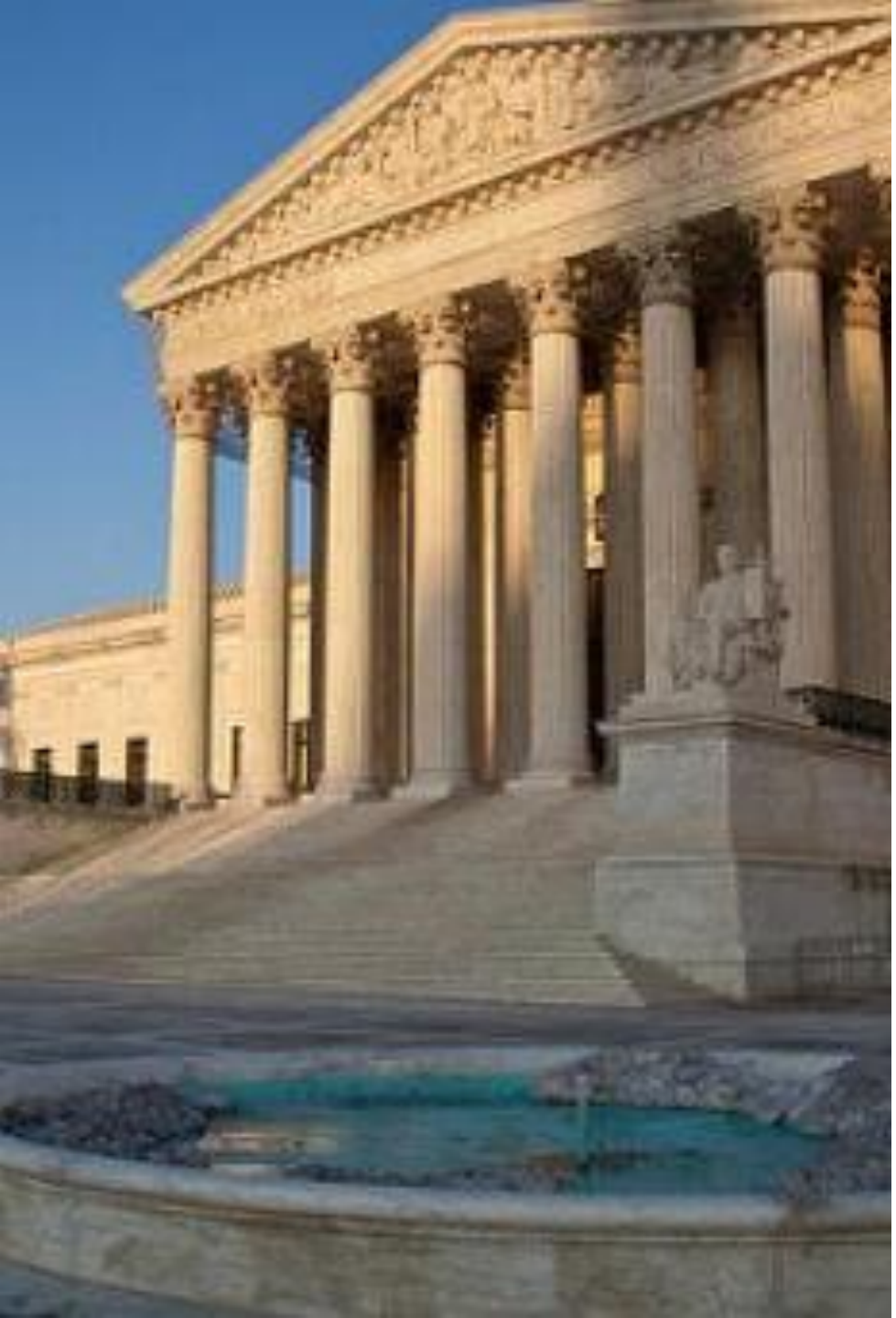
1. Understanding Patents
2. Case Law
3. Infringement and Copyright
4. Questions?

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Understanding Patents

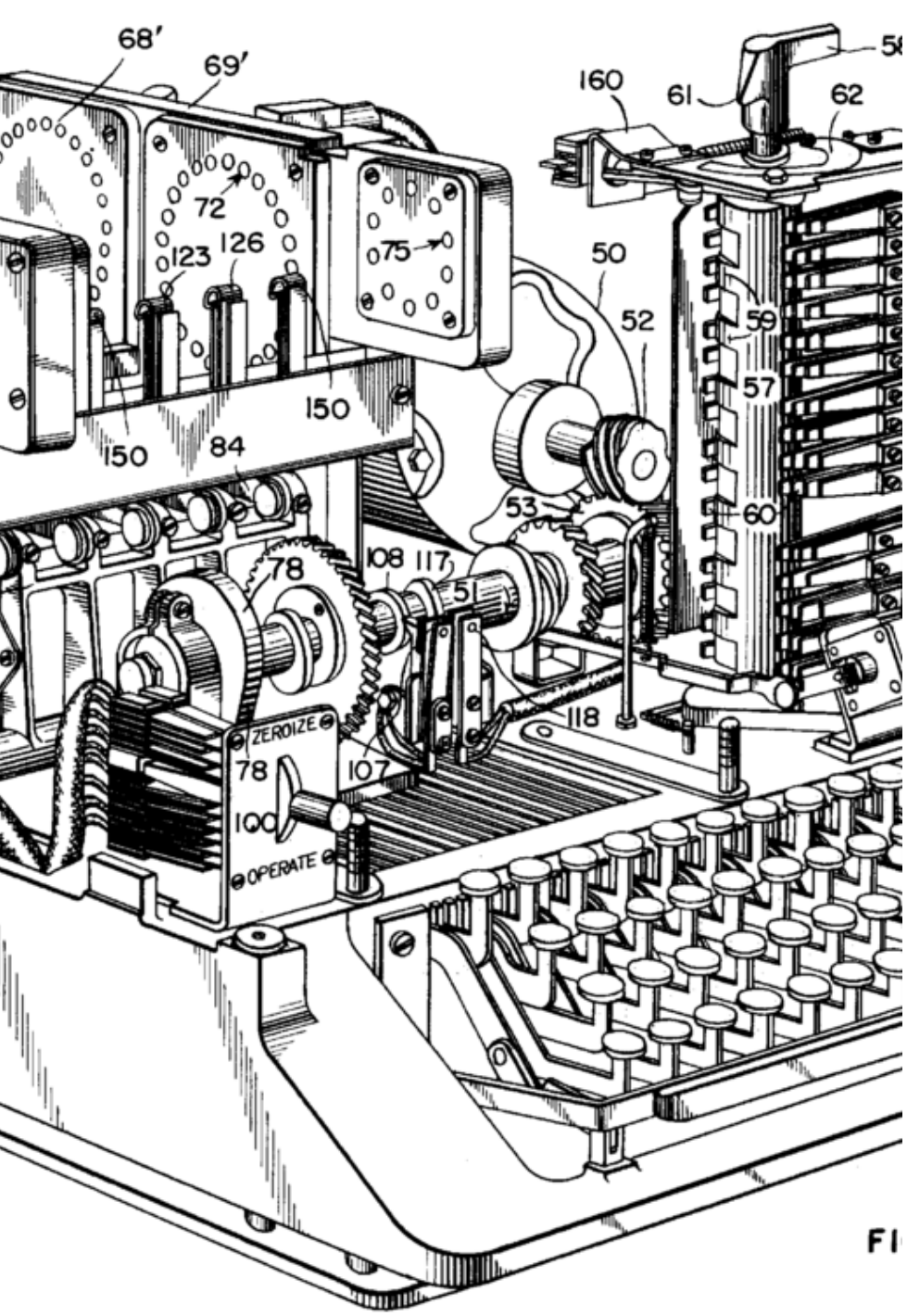
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The Changing Landscape

- America Invents Act
- U.S. Supreme Court

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Patentability

- Four eligible categories:
  - Process
  - Machine
  - Manufacture
  - Composition of Matter
    - 35 U.S.C. § 101

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Patentability

- Three judicial exceptions:
  - Natural Phenomena
  - Laws of Nature
  - Abstract Ideas

    Ass'n. for Mol. Path. v. Myriad Genetics, Inc., 133 S.Ct. 2107, 2116 (2013)

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United States Supreme Court on Patentability

- *Bilski v. Kappos*
- *Mayo v. Prometheus*
- *Mol. Pat. v. Myriad*

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Case Law

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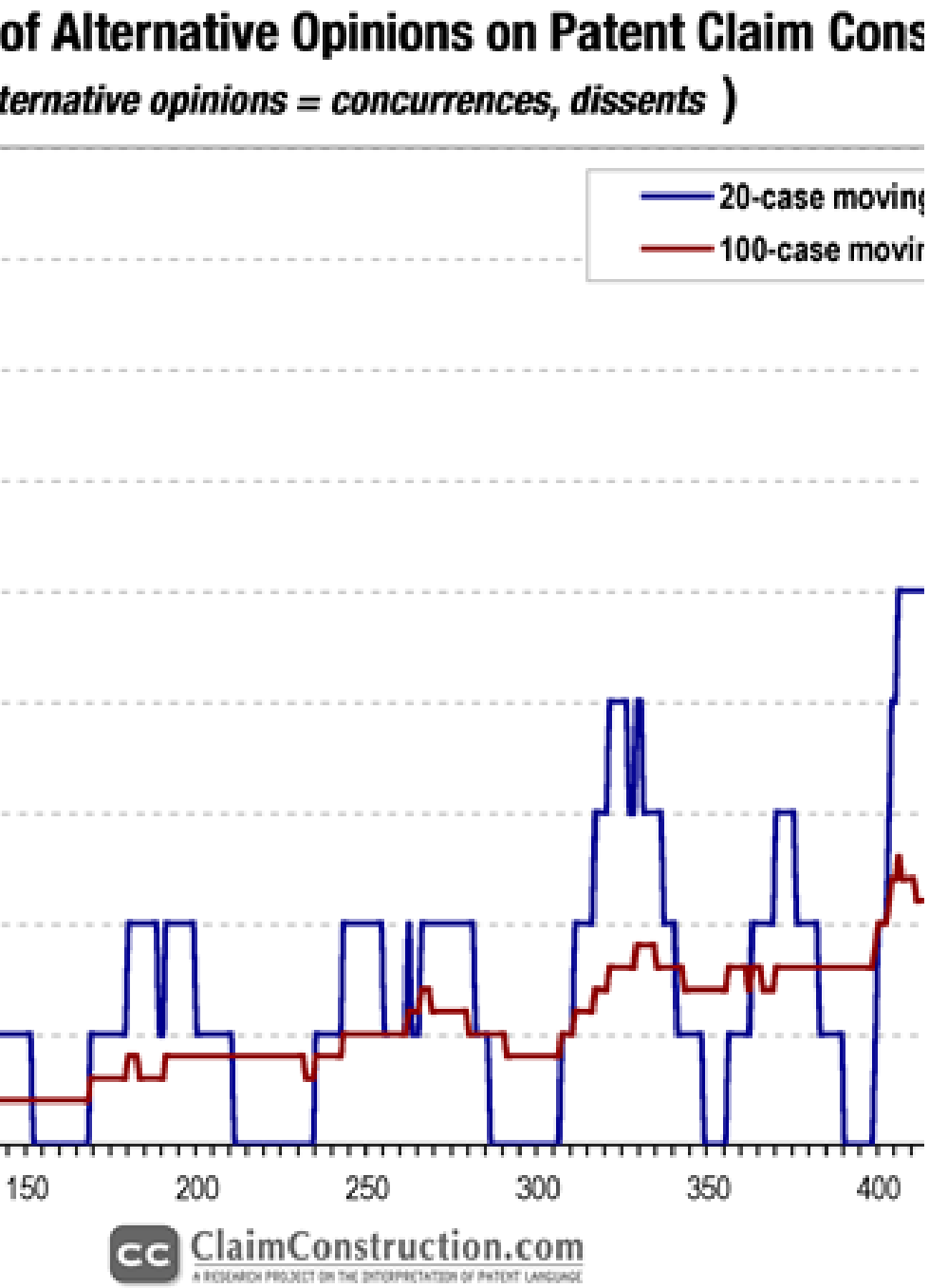


Patents – *Alice v. CLS Bank*

[M]ere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea "while adding the words 'apply it'" is not enough for patent eligibility.

- *Alice Corp. Pty. Ltd. v. CLS Bank Int'l.*, 134 S.Ct. 2347, 2358 (2014) (emphasis added)

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Patents – Claim Construction

- *Markman v. Westview*
  - Not for a jury but exclusively for the court to determine
  - Even when construction has evidentiary underpinnings
- *Cybor v. FAS Techs.*
  - Reviewed *de novo* on appeal
  - Even when construction relates to fact-based questions

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Patents – *Teva v. Sandoz*

[This case] requires us to determine what standard the Court of Appeals should use when it reviews a trial judge's resolution of an underlying factual dispute. . . . **We hold that the appellate court must apply a 'clear error,' not a *de novo*, standard of review**.

- *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015) (emphasis added)

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Patents – Attorney Fees

A "court in **exceptional** cases may award reasonable attorney fees to the prevailing party."

- 35 U.S.C. § 285 (emphasis added)

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Patents – *Brooks v. Dutailier*

Exceptional case

Material inappropriate conduct

OR

Objectively baseless

AND

Brought in subjective bad faith

Brooks Furniture Mfg., Inc. v. Dutailier Int'l Inc., 393 F.3d 1378 (Fed. Cir. 2005)

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Patents – *Octane Fitness*

Exceptional case is one that stands because of:

Substantive Strength of Litigating Position

OR

Unreasonable Manner of Litigation

Octane Fitness, LLC v. Icon Health & Fitness, Inc., 134 S.Ct. 1749 (2014)

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Infringement and Copyright

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Patents – Joint & Induced Infringement

Whoever actively induces infringement of a patent shall be liable as an infringer.

- 35 U.S.C. § 271(b)

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Patents – Joint & Induced Infringement

[I]n this case, performance of all the claimed steps cannot be attributed to a single person, so direct infringement never occurred. Limelight cannot be liable for inducing infringement that never came to pass.

- *Limelight Networks, Inc. v. Akamai Techs.*, 134 S.Ct. 2111, 2118 (2014)

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Patents – *Global-Tech Appliances*

- For induced infringement, need to show inducer knew:
  - Of Patent In Question
  - Induced Acts Infringed
    - *Global-Tech Appliances, Inc. v. SEB S. A.*, 563 U. S. 754 (2011)

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Patents – *Commil v. Cisco*

The question the Court confronts today concerns whether a defendant's belief regarding patent validity is a defense to a claim of induced infringement. **It is not**. The scienter element for induced infringement concerns infringement; that is a different issue than validity.

- *Commil USA, LLC v. Cisco Sys.*, 135 S.Ct. 1920, 1928 (2015) (emphasis added)

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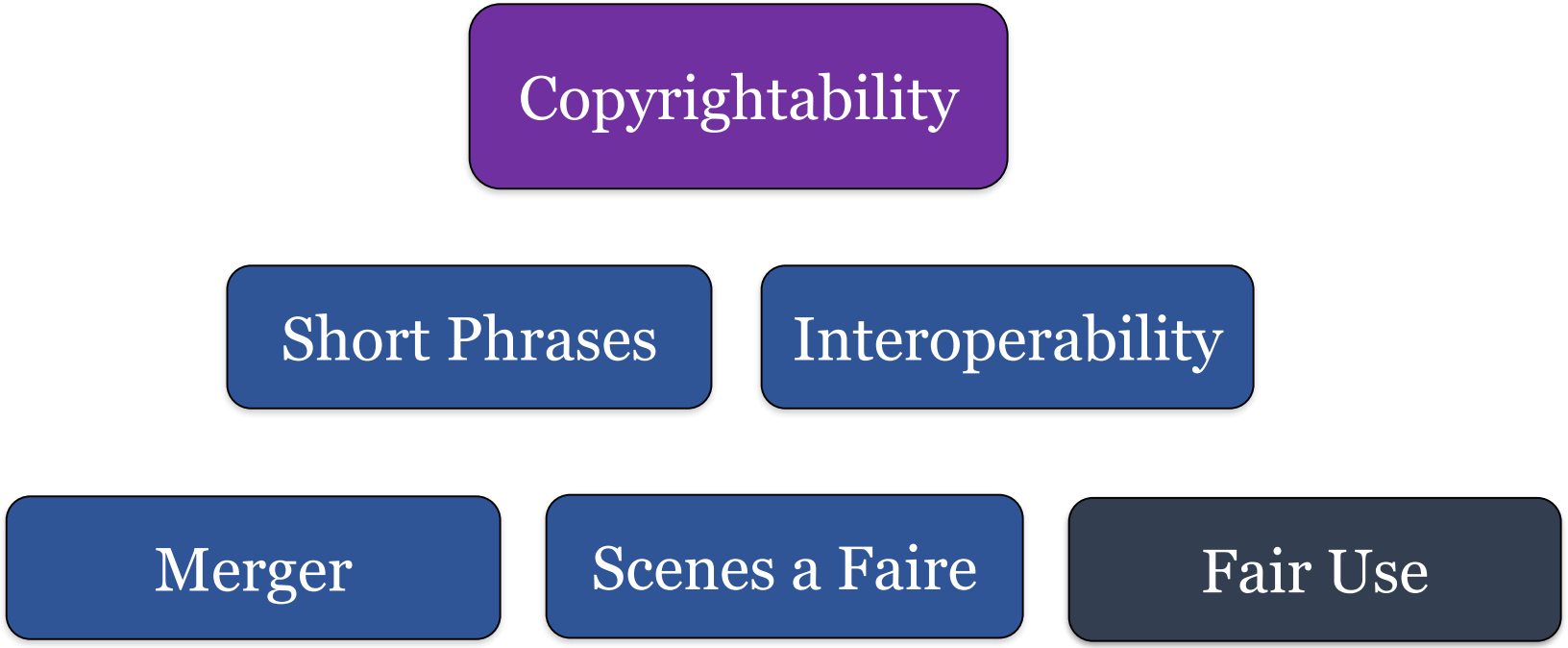


Copyright – *Oracle v. Google*

- Copyright Act protects: "original works of authorship fixed in any tangible medium of expression," including "literary works."
  - 17 U.S.C. § 102(a)
- As literary works, copyright protection extends to computer programs.
  - *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832, 838 (Fed. Cir. 1992)

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Copyright – *Oracle v. Google*



Oracle America, Inc. v. Google, Inc., 750 F.3d 1339 (Fed. Cir. 2014)

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Questions?

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M.A., Computer Science Brandies Uni.
J.D., Rutgers School of Law

Daniel Garrie is an Arbitrator, Forensic Neutral, technical Special Master at JAMS, available in Los Angeles, New York, and Seattle; Executive Managing Partner of Law & Forensics LLC, Head of Computer Forensics and Cyber Security Practice Groups, with locations in the United States, India, and Brazil; and adjunct Professor of Law at Cardozo School of Law. He is also a Partner at Zeichner Ellman & Krause, where he heads their global cyber security practice.

Mr. Garrie has built and sold several Internet security, e-commerce, and search technology startups. Prior to his time at Pulse Advisory, Daniel Garrie was the Worldwide Director of Electronic Discovery & Information Governance at Charles River Associates. He also works as a Strategic Partner for Quorumm Ventures and a Board of Governors member for the Organization of Legal Professionals. He is a nationally recognized educator and lecturer on various topics including computer software, cyber security, e-discovery, forensics, emerging internet and mobile technologies, and cyber warfare. He is the Editor in Chief of the Journal of Law & Cyber Warfare, a fellow at the Ponemon Information Privacy Institute, a distinguished neutral with CPR, and on the editorial board of the Beijing Law Review.

Mr. Garrie's scholarship in e-discovery, forensics, and cyber security is frequently cited by the bench and the bar, including: Arrivalstar v. US, US v. Briggs, Coast Professional, Inc. v. US, Genger v. TR Investors, LLC, John B. v. Goetz, and Northruop Grumman Computing Systems, Inc. v. US. Mr. Garrie is also frequently quoted by leading publications including the New York Times, Fortune, Forbes, and the Wall Street Journal on issues relating to cyber security and cyberwarfare.

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JAMS – Neutral
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URL: https://www.jamsadr.com/sleet/

Hon. Gregory M. Sleet (Ret.) joins JAMS after serving 20 years on the bench of the United States District Court for the District of Delaware, including seven years as chief judge. Judge Sleet presided over 6,400 civil cases, including 2,002 patent cases, and wrote more than 1,200 opinions. He presided over 151 trials, including 74 patent trials (40 bench trials and 34 jury trials). Before taking the federal bench in 1998, Judge Sleet acquired varied experience in civil and criminal litigation and corporate legal work. He served as a United States Attorney for the District of Delaware from 1994-1998. He served as in-house counsel in the legal department of Hercules Incorporated (1992–1994) and as deputy attorney general for the State of Delaware (1990–1992). Prior to that, he practiced law in Philadelphia for 14 years, six of those as an assistant public defender with the Defender Association of Philadelphia.

Judge Sleet gained deep experience in a wide range of commercial cases during his tenure on the district court. He is especially known for his expertise in patent litigation, covering a range of industries, including medical devices, biotech/pharmaceuticals, consumer products, computer hardware/electronics, software, industrial/construction and chemicals. He is a sought-after speaker on patent litigation, participating on panels at RPX, the Rocky Mountain Intellectual Property and Technology Institute, the Sedona Conference, the USC Gould School of Law, the New York Intellectual Property Law Association's (NYIPLA) symposium on patent litigation, the Practising Law Institute and many others. Beginning in 2006-2007, Judge Sleet served as an adjunct professor, teaching patent litigation, at Rutgers Law School, Widener University School of Law and, most recently, Duke University School of Law.

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Ben Quarmby's practice focuses on business disputes and intellectual property litigation. He has represented clients as lead counsel in federal and state trial courts, the International Trade Commission, federal courts of appeals, the United States Patent & Trademark Office, and in arbitration.

Mr. Quarmby represents both plaintiffs and defendants in cases around the country. His clients include U.S. corporations, individuals, and family offices, as well as many foreign companies, particularly from Japan and France.

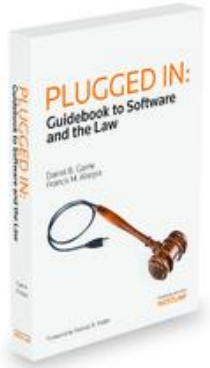
Mr. Quarmby frequently publishes on topics including patent, trademark and trade secret law, the General Data Protection Regulation (GDPR), shareholder appraisal rights, artificial intelligence, social media, and privacy. He is also a frequent speaker on issues such as third-party litigation funding, developments in patent, trademark and copyright law, and international arbitration.

Prior to joining MoloLamken LLP, Mr. Quarmby practiced business and IP litigation with the law firm of Quinn Emanuel Urquhart & Sullivan. He also clerked for the Honorable Garrett E. Brown, Jr., Chief Judge for the District of New Jersey. Mr. Quarmby is fluent in French, and is admitted to the United States Patent and Trademark Office.

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Additional Reading

BOOKS



[Plugged In: Guidebook to Software and the Law]



[Dispute Resolution and e-Discovery]



[Software and the Law: Digital Forensic Investigations and E-Discovery]



[Cyber Warfare: Understanding the Law, Policy and Technology]

ARTICLES



[The Neutral Corner: How to Effectively Use a Technical E-Discovery Neutral]



[White Paper — Client Data: Secure as the Weakest Link]



[What You Need to Know Now (and Ask Your Broker) About Cyber Insurance]

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