

LAW-795AP-001: Advanced Topics in Patent Law; Or, the Art of the *Amicus* Brief

Charles Duan
Spring 2024

Last updated January 5, 2024

Meetings: Wednesdays, 1:00–2:50 PM.
Room: TBD.
Prerequisites: None.
Credit hours: 2.
Email: cduan@wcl.american.edu
Web: <https://www.cduan.com>
Office: Yuma 327
Office Hours: Mondays and Wednesdays, 11:00-12:00.

Abstract

In this course, we will review recent Supreme Court cases on patent law, through the lens of *amicus curiae* briefs filed in these cases. Topics will include administrative law of patents, patents and antitrust, litigation procedure, and so on. By reading briefs and preparing short bench-memo reflection papers akin to how judicial clerks might review *amicus* briefs, we will also learn about what makes for effective *amicus* advocacy in patent law and other areas. The final project for the course will be to write your own hypothetical *amicus* brief in a pending case.

About This Course

Professor Paul Ohm at Georgetown describes his course Computer Programming for Lawyers as “an argument in the form of a course.” This seminar is my argument in the form of a course.

On the surface, this is a course about recent Supreme Court patent cases. We will explore the theories, tensions, arguments, and policies that have shaped the modern patent system over the last decade or so. The topics to be covered will include the administrative law of patents, litigation procedure, substantive patentability, the patent–antitrust boundary, and more. These cases are important and useful for anyone planning on practicing patent law in any capacity.

The argument of the course, however, is that we can learn not just from the traditional law school fare of judicial opinions and law review commentary, but from a unique type of document: *amicus curiae* briefs. These third-party “friend of the court” briefs are expected to present the court with novel and useful information beyond the parties’ legal arguments. When done well, *amicus* briefs can shed light on unintended consequences or unexpected policy connections, enriching one’s understanding of a case beyond the four corners of the doctrines.

These *amicus* briefs will let us go “behind the scenes” to learn about the stakeholders, interests, and concerns that underlie patent cases. Along the way, we will also learn about what good *amicus* advocacy looks like—and how it differs from direct litigant advocacy. We will learn what makes an *amicus* brief effective, and how litigants can craft effective *amicus* briefing strategies.

Who Am I?

I am a former patent attorney who spent about ten years working at public interest organizations on patent policy. During that time, I filed around seventy *amicus* briefs on behalf of nonprofit organizations, law professors, library groups, former government officials, software companies, and once a group of cosplayers. These briefs have been cited in the Supreme Court, several federal appellate and district courts, and a variety of other media. In the 2016 Term, I was the sixth winningest *amicus* counsel in the Supreme Court [↗](#).

Who Are You?

This course has no prerequisites. No patent law background is required. In fact, I'd welcome non-patent students in this course. A key question we will tackle in the seminar is how one goes about explaining a body of law as technical as patents, to a Supreme Court with no specific patent law knowledge.

I would envision at least the following categories of students being interested in this seminar:

- Students intending to practice patent law, who want to know about cutting-edge issues.
- Students interested in administrative law, antitrust law, or other fields adjacent to patents. Most of the cases we will study in this course are not “patent” cases per se, but cases about other doctrines where patents just happen to be involved.
- Students interested in Supreme Court or appellate advocacy. *Amicus* practice is a major part of these practices—plenty of the briefs we will read in this seminar were written by top Supreme Court practitioners.
- Students interested in public interest advocacy. Learning how to write an *amicus* brief that attracts attention and persuades judges is an invaluable skill for advancing policy.

How This Course Works

This course is not structured like a normal seminar, where I provide cases and articles for you to read. In many of these patent cases, dozens of *amicus* briefs are filed. These briefs are optional reading for the courts, and a judge (or more likely, a judicial clerk) is not going to give every filed brief a complete and detailed review. Part of the goal of this course is to learn how to find briefs that stand out from the pack—and how to make your own briefs stand out.

Daily Assignments

For each day with a case listed in the schedule, your assignment is:

- **Read two briefs in detail.** You should be prepared to discuss these briefs in class. The two briefs should not both support the same side or position.
- **Skim four more briefs** so you have a general sense of their arguments.
- **Prepare a “bench memo”** summarizing the briefs you reviewed. For the briefs you read in detail, write a summary of about one paragraph (3-4 sentences) for each one. For the briefs you skimmed, write a one-sentence summary of each.

Do not put a great deal of effort into the memo. Do not write more than specified above—the exercise is distilling the key points. If a brief makes multiple points, you don’t have to summarize them all; just pick the ones most interesting to you. You are allowed to copy-paste directly from the briefs; in fact you *should* plagiarize for these memos where you can. The memos do not need to be formatted in any particular way.

- **Please print your bench memos to bring to class.** That way I can look over and sort through them quickly. If you don’t have easy access to printing, let me know and I can help you out.

Which Briefs to Read

On almost every day, more than six briefs have been identified. You only need to read six total, and you should select the ones that seem the most “interesting” to a hypothetical judge in the case. In deciding what is “interesting,” keep in mind that the judge will have already read the party briefs in detail. An “interesting” brief is thus one that goes beyond the doctrinal arguments the parties have already presented.

Spend no more than 5–10 minutes choosing which briefs to read. You will pick up on signals for which briefs are likely to be more interesting. Pay attention to these signals—they will inform how you write your own brief.

On days marked “Free Choice,” you may choose among any of the merits *amicus* briefs filed in the case, to the extent that the time limit above permits, in selecting the six for your memo. These are the briefs usually marked in green or dark green on SCOTUSblog (not the yellow ones).

Note that I personally filed briefs in just about all of these cases. **Do not choose**

my briefs to read or summarize! I'll sometimes be using my own briefs as examples during class.

Writing Assignment

The main project for this course will be a short research paper on a patent law topic of your choosing. Alternately, the project is to write a hypothetical *amicus* brief on an issue in a pending patent case. As you will learn in this course, these are one and the same thing: a good *amicus* brief is also a good research paper.

The length requirement for the paper is 4,500 words, excluding footnotes. If you would like to use this course to satisfy the Upper Level Writing Requirement for an additional credit, please let me know.

The steps for completing this project are as follows:

- Identify a pending case of interest to you. This need not be a Supreme Court case; patent cases in district courts and the Federal Circuit appeals court are fine too. The easiest place to find these cases is to read articles on Law360 [↗](#).
- Come up with a constituency that you would want to represent in an *amicus* brief in this case. This might be, for example, a technology industry, a nonprofit organization, a group of hobbyists, patients with a certain medical condition—the more creative, the better. The important thing is that **this constituency must have a distinct perspective that informs how a court should decide the case.**
- Write a sentence of the form “What [your constituency] wants to say about this case, which the courts and parties have not considered so far, is this: [sentence].” That [sentence] is your thesis.
- Find sources that prove your thesis to be (1) correct, and (2) important enough to be worthy of a court’s attention.
- Prepare a topical outline, in the form of brief-style argument headings. Organize your sources into this outline.
- Write the brief.

Due dates for these steps are given below in the schedule.

What makes for a quality output is (1) an original perspective on the topic that others have not already analyzed, (2) creative and thoughtful use of sources, law review articles, and other materials to support an argument, and (3) clearly drawn connections between the doctrinal issue at stake and the novel perspective.

Assessment

Your grade in this course will be determined as follows:

- 70% Your hypothetical amicus brief/research paper, as described above.
- 10% Your other written work, namely the bench memo assignments. You will receive these points as a matter of course if you put in a good faith effort to preparing them.
- 20% Your class participation, including your presentation at the end of the class. High quality participation involves respectfully listening to your classmates and thoughtfully reflecting on their comments, the readings, and the topics of discussion.

Unexcused absences will count against your class participation grade, and I reserve the right to adjust your grade further in the case of excessive unexcused absences. If you are unable to attend class for good cause, please let me know in advance of class.

Schedule

Please carefully read the instructions on how to complete these reading assignments. **You do not need to read all the assigned materials as explained above.**

“ISO” stands for “in support of.”

January 17—Introduction

Read: Fundamentals of Preparing a United States Supreme Court Amicus Brief, 5 J. Appellate Prac. & Process 523 [↗](#).

Patents Versus Property

January 24—Impression Products v. Lexmark

Background: 44 ABA Preview U.S. Sup. Ct. Cas. issue 6, [↗](#), pages 183–185, “What Is the Scope of” through “manufacturing practices in the modern”.

Optional: *The Amicus Machine*, 102 Va. L. Rev. 1901 (2016) [↗](#).

Choose: Public Citizen ISO Petitioner [↗](#).

- IP Professors ISO Petitioner [↗](#).
- Costco Wholesale ISO Petitioner [↗](#).
- Pharmaceutical Research and Manufacturers of America ISO Respondent [↗](#).
- Nokia ISO Respondent [↗](#).
- American Intellectual Property Law Association ISO Neither Party [↗](#).

Substantive Patentability

January 31—Alice v. CLS Bank

Background: *Previewing CLS Bank v. Alice*, Patent Progress (Feb. 7, 2013) [↗](#).

Optional: *Narratives of Gene Patenting*, 43 Fla. St. U. L. Rev. 1133 [↗](#). At least read the table on page 1193.

Choose: Paul R. Michel ISO Neither Party [↗](#).

- IEEE-USA ISO Neither Party [↗](#).
- Advanced Biological Laboratories ISO Petitioner [↗](#).
- American Civil Liberties Union ISO Respondents [↗](#).
- Microsoft ISO Affirmance [↗](#).
- Electronic Frontier Foundation ISO Respondents [↗](#).

February 7—Amgen v. Sanofi

Background: Court to decide how specific a patent disclosure must be, SCOTUS-blog (Mar. 23, 2023) [↗](#).

Optional: *The Trouble with Amicus Facts*, 100 Va. L. Rev. 1757 [↗](#).

Choose: American Chemical Society ISO Petitioners [↗](#).

- National Association of Patent Practitioners ISO Petitioners [↗](#).
- Nature’s Fynd ISO Petitioners [↗](#).
- High Tech Inventors Alliance ISO Neither Party [↗](#).
- Alliance of U.S. Startups and Inventors for Jobs ISO Petitioner [↗](#).
- Fresenius Kabi ISO Respondents [↗](#).
- Small and Medium Biotechnology Companies ISO Respondents [↗](#).
- Unified Patents ISO Respondents [↗](#).
- Sir Gregory Paul Winter ISO Respondents [↗](#).

Patents and Antitrust

February 14—Kimble v. Marvel

Background: 42 ABA Preview U.S. Sup. Ct. Cas. issue 6, [↗](#), pages 238–241, “Your Friendly Neighborhood Patent License:” through “these two bodies of law.”

Choose: University of Massachusetts Biologic Laboratories ISO Petitioners [↗](#).

- Intellectual Property Owners Association ISO Petitioners [↗](#).
- Memorial Sloan Kettering Cancer Center ISO Petitioners [↗](#).
- New York Intellectual Property Law Association ISO Petitioners [↗](#).
- Robin Feldman ISO Neither Party [↗](#).
- American Intellectual Property Law Association ISO Neither Party [↗](#).
- Licensing Executives Society ISO Neither Party [↗](#).
- William Mitchell College of Law Intellectual Property Institute ISO Respondent [↗](#).
- Washington Legal Foundation ISO Respondent [↗](#).

February 21—FTC v. Actavis

Background: *Justices to Look at Deals by Generic and Branded Drug Makers*, N.Y. Times (Mar. 24, 2013) [↗](#).

Free Choice: SCOTUSBlog Docket [↗](#).

Prepare: Due date: Email me your proposed thesis statement, a section heading outline, and an initial list of sources and authorities.

Litigation and Patent Assertion Entities

February 28—Commil v. Cisco

Background: 42 ABA Preview U.S. Sup. Ct. Cas. issue 6, [↗](#), pages 228–230, “Is a Good-Faith Belief That” through “where cost calculations are paramount.”

Free Choice: SCOTUSblog Docket [↗](#).

March 6—Samsung v. Apple

Background: *Argument preview: Justices to consider \$400 million verdict for Samsung’s infringement of the design of Apple’s iPhone*, SCOTUSblog (Oct. 4, 2016) [↗](#).

Free Choice: SCOTUSblog Docket [↗](#).

March 13—NO CLASS: Spring Break

March 20—TC Heartland v. Kraft Foods

Background: 44 ABA Preview U.S. Sup. Ct. Cas. issue 6, [↗](#), pages 165–168, “Is 28 U.S.C. § 1400(b)” through “Court over the past decade.”

Free Choice: SCOTUSblog Docket [↗](#).

Prepare: Due date: First draft of your brief.

Patents and Administrative Law

March 27—Oil States v. Greene’s Energy

Background: *Patent Law: A Primer and Overview of Emerging Issues* (Congressional Research Service 2017) [↗](#), pages 38–40, Viability of Inter Partes Review Proceedings.

Free Choice: SCOTUSblog Docket [↗](#).

April 3—United States v. Arthrex

Background: *Supreme Court to Consider Whether Patent Judges’ Appointments Are Constitutional* (Congressional Research Service, 2021) [↗](#).

Free Choice: SCOTUSblog Docket [↗](#).

Student Presentations

April 10—Day 1

April 17—Day 2

April 28—Final Papers Due