

This is your Release #1 (October 2014)

Patent Claim Construction and *Markman* Hearings

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This first release to *Patent Claim Construction and Markman Hearings* updates your guide with the many new Supreme Court, Federal Circuit and lower courts decisions that have been issued since this volume was published as well as providing additional practice coverage on selected topics. This revised version reflects the most current guidance for this important patent practice area.

Examples of the new coverage included with this release are:

- New coverage of recently issued patent-related U.S. Supreme Court decisions:
 - In *Limelight Networks, Inc. v. Akamai Technologies, Inc.*, the Court reversed the Federal Circuit and held that there can be no inducement to infringe unless there is direct infringement. See § 2:2.1[A]4, **Joint Infringement**.
 - In *Nautilus v. Biosig*, the Supreme Court provided a new standard to determine whether a patent is invalid for indefiniteness, ruling that the existing Federal Circuit standard was “too strict.” See § 2:4.1[A]1, **Indefiniteness**.
 - In *Alice Corporation Pty. Ltd. v. CLS Bank International*, the Court provided additional guidance on when, and if, business methods are patent eligible under section 101. See § 2:4.2, **Section 101, Patent-Eligible Subject Matter**.
- New subsections adding expanded coverage of patent-eligible subject matter in the following areas. See § 2:4.2 [A] **Biotechnology**; [B] **Software and Computers**; and [C] **Business Methods**.
- Additional coverage of the claim preclusion area including a discussion of the *Kessler* Doctrine as a separate doctrine from claim or issue preclusion. See § 3:5 **Claim Preclusion (Res Judicata)** and § 3:6 **Kessler Doctrine**.
- The local rules for *thirteen* additional federal courts have been added to chapter 5, including the rules for the District of Maryland [§ 5:9], Eastern District of Missouri [§ 5:12], District of Nevada [§ 5:13], the Eastern, Northern and Southern Districts of New York [§§ 5:16–18], and the Western District of Tennessee [§ 5:25].

(continued on reverse)

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- Two new appendixes provide additional practice help: a sample “**Stipulated Patent Case Protective Order**” (Appendix I) and a sample “**Joint Claim Construction Table**” (Appendix J).

The **Table of Authorities** and the **Index** have also been updated.

FILING INSTRUCTIONS

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REMOVE OLD PAGES NUMBERED:

- Title page to 6-44
- 10-1 to 10-9
- T-1 to I-32

INSERT NEW PAGES NUMBERED:

- Title page to 6-45
- 10-1 to 10-11
- App. I-1 to I-28

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