

## 以判決分析方式來學習美國專利法

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### 摘要

本文提供非受美國訓練的法律學生一種閱讀美國專利法判決的方法，特別針對臺灣學生所設計。美國法律寫作有其風格。如果沒有在美國法學院受過訓練，讀者很難完全掌握判決的內容。因此，有必要提出一個方法以幫助學生分析判決，而使他們能獲得美國專利法的知識。為展現本文所建議的方法，本文先介紹美國法律寫作和美國專利法等概念。接著，就閱讀策略，本文以五個方向討論並舉例佐證。本文所提的方法包括三個步驟。首先，以初步分析各段落第一個句子的方式來重新組織法院判決；其次，確認各段落的主題是關於事實、法律原則、或法律爭點分析；最後，總結法院所適用之法律原則與裁決內容。因為法院判決有特定的文章結構，確認法院所採用的法律原則並非難事，而法律適用時所採用的相關事實內容也能確認。這些相關資訊可做為讀者用來提供法律意見之用。

**關鍵詞：**專利法、法律寫作、巡迴上訴法院、專利英文

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## 1. Introduction

This article is intended to provide a method for non-American-trained law students to analyze American patent law cases/court decisions. Particularly, the method is designed for Taiwanese students with no American legal background. The author began to feel this need when teaching one course related to the American patent law for Taiwanese students who have never studied American law. After witnessing that the students struggled with learning and could not comprehensively understand court decisions, the author started to think about an analytic method which can help students study patent cases. By feeling more comfortable with legal reading, students can gain more knowledge of patent law through constantly reading court decision after graduation.

To study American patent law, students need to learn how to analyze a court decision first, so that they can keep learning the law through reading court decisions regularly. A court decision is not a subject of general English because it involves particular terms in the legal field, particular paragraph structure used to present the reasoning and finding of the court, and grammatical preference used to express rules and holdings. So, it is better to consider a court decision as a subject within the domain of English for Specific Purposes (“ESP”).

ESP is defined by Day & Krzanowski (2011) as “teaching and learning the specific skills and language needed by particular learners for a particular purpose” (p. 5). Bruce (2002) characterizes ESP as a “theme-based” approach to teach language which uses “content topics or texts as vehicles for the conventional teaching of specialized vocabulary or high frequency language forms” (p. 322). Regarding English for Law, Candlin et al. (2002) has cautioned that “[l]aw, unfortunately, is not as universal a discipline as, say, business or science and does not travel as well across national, cultural and legal boundaries” (p. 302). That is, English for law in the American context can be very different from that in the British or New Zealand context. An ESP teacher without any legal training cannot offer a comprehensive program to students unless she joins with a legal specialist to co-teach the students (Northcott & Brown, 2006).

While plain English is now adopted in legal writing (Hartig & Lu, 2014), the American legal writing has its own style. A court’s decision is written in response to arguments presented by the parties at dispute (Moore & Binder, 2010). Six common arguments made include goal arguments, consequence arguments, principle arguments, arguments by analogy, arguments from precedent, and inference arguments. Knowing these six arguments helps analyze the context of a court’s decision.

“Goal arguments” request a court to opine for purposes of legislative intents (Moore & Binder, 2010). “Consequence arguments” are an alternative to “goal arguments,” and aim at persuading a court not to make a decision which is contrary to legislative intents. “Principle arguments” request a court to follow a certain legal rule suggested by the party who brings principle arguments. “Arguments by analogy” are more factually-oriented, and focus on the common features between the present case and prior court decision. “Arguments from precedent” highlight the legal consequence of a prior case which shares many common features with the present case, so as to urge the court to follow the prior case. Lastly, “inference arguments” are another factually-specific argument which focuses on what can be inferred from circumstantial evidence of the case. Although a court is not obligated to respond to all arguments each party has made, it will frame its conclusion based on what the parties have disputed about. This is because the court should answer the legal question brought by the parties (Wendel, 2009).

To further elaborate the thoughts of a court, a court’s decision usually comprises (1) facts related to the dispute, (2) historic or procedural information of litigation, (3) legal issues to be resolved, (4) applicable rules to resolve the legal issues, (5) holdings which are answers to the legal issues, and (6) reasoning which shows why the court reach these holdings (McKinney, 2005). However, there is no official guideline for writing a judicial decision (Lebovits, Curtin, & Solomon, 2008).

Without being trained in an American law school, a person cannot analyze court decisions correctly. It is needed to develop a method to help non-American-trained lawyers analyze the cases, because some of them may need the knowledge related to the American patent law so as to provide to their clients sound opinions. Particularly in Taiwan, the method is desired because Taiwanese companies may have troubles about patent infringement in their American market.

For elaborating the proposed, analytic method, this article begins with a background introduction about the American patent law and court system. Then, this article proposes a three-step method to efficiently analyze a patent law decision. Five aspects of the proposed method are explained in details with examples. The first aspect relates to the step-one discussion, while the other four aspects relate to the step-two discussion. The proposed approach is patent-law-specific. Different from the traditional case reading guidance which focuses on helping students extract common law doctrine from cases, this article points out the uniqueness of patent law cases.

## **2. Overview of the American Patent Law and Federal Judicial System**

### **2.1 American patent law**

The American patent law is very important for supporting the economy of the United States, because the law creates a strong system for promoting and protecting innovations. As long as a patent application meets the requirements of patentability, a patent is consequently granted to the applicant. After the grant of the patent, the right owner has a right to exclude others from making, using, offering to sell, selling, or importing her patented invention. A patent right is an exclusive right, but not a right to use the patented invention (Chisum, Nard, Schwartz, Newman, & Kieff, 2004; Tu, 2014).

A patent is a document that defines the scope of patent rights. The document contains two main parts: specification and drawings. The specification includes description and claims. The specification describes the invention. The drawings help understand the invention visually. The claims define the range of the patent protection (United States Patent and Trademark Office [USPTO], 2010).

To get a patent, an invention has to pass the patentability examination. First, the application for an invention has to meet the full disclosure requirements: “enablement,” “written description,” “best mode,” and “definiteness” (Chisum et al., 2004; Tu, 2014). “Enablement” means that an application has to disclose enough information to let a person of ordinary skill in the art of the invention make and use the invention. “Written description” requires the application to show the inventor possesses the invention. “Best mode” requires the inventor to disclose the best example of the invention. “Definiteness” requires the applicant to define in the claims the scope of the invention unambiguously.

Second, an invention has to be “novel.” Whether an invention meets “novelty” depends on prior arts which are usually a document. To say an invention is not novel, all elements of a claim of the invention must be found in one single prior art (Chisum et al., 2004; Tu, 2014). Besides, such prior art document must enable a person of ordinary skill in the art to accomplish the claim. When such enablement is found, the prior art document anticipates the invention. The term used for describing “not novel” is “anticipation”.

Third, an invention has to be “non-obvious” in views of a person of ordinary skill in the art. If an invention is “obvious,” it is not patentable. To reach a conclusion of “obviousness,” generally at least two prior art references are used by a challenger. These prior art references have to disclose all elements of a claim, but any single reference does not need to include every element of the claim (Chisum et al., 2004; Tu, 2014). If a person of ordinary skill in the art would have thought a way to combine

different elements in the prior art references to create the invention, the invention is considered obvious.

Fourth, an invention must be “useful.” The invention has to function for its intended purposes so as to meet the “utility” requirement (Chisum et al., 2004; Tu, 2014).

Fifth, an invention must be a patentable subject matter, such as processes, machines, manufactures, or compositions of matter. “Laws of nature,” “physical phenomena,” and “abstract ideas” are not patentable (Chisum et al., 2004; Tu, 2014).

The determination of patentability or infringement relies on “claim construction” or “claim interpretation” (Chisum et al., 2004; Tu, 2014). A claim defines the scope of patent rights, and is construed according to the specification, drawings and claims. These three tools for claim construction are called “intrinsic evidence.” “Extrinsic evidence,” such as expert testimony, inventor testimony, dictionary definitions, and citations to learned treatises could also be used under a court’s permission.

If an accused product falls within the scope of a claim, the product infringes the patent right related to the claim. Two common types of infringement include direct infringement and indirect infringement. “Direct infringement” means that an infringer himself performs the infringing act. “Literal infringement” and “Infringement under the doctrine of equivalents” are within the category of “direct infringement.” “Literal infringement” means that an accused product has every element of the claim. “Infringement under the doctrine of equivalents” means that an accused product does not have at least one element of the claim, but it still constitutes infringement because at least one feature of the accused product is functionally similar to the missing element (Chisum et al., 2004; Tu, 2014).

On the other hand, “indirect infringement” means that an infringer makes others infringe a patent, and it includes “inducement of infringement” and “contributory infringement.” “Inducement of infringement” means that an infringer intentionally causes direct infringement, while “contributory infringement” means that an infringer assists others to perform direct infringement (Chisum et al., 2004; Tu, 2014).

## **2.2 Basic American federal civil procedure overview**

Before reading patent law cases, readers must learn some concepts about the American federal civil procedure to understand the cases.

The federal court system has district courts, appellate courts, and the Supreme Court (Nedzel, 2008). All federal district courts have exclusive, original jurisdiction over cases arising from the patent law. The United States Court of Appeals for the Federal Circuit (“Federal Circuit”) reviews patent-law-related appeals from district

courts (Chisum et al., 2004). The Supreme Court of the United States hears appeals from the Federal Circuit when it wants to resolve a critical legal issue (Nedzel, 2008).

The issues surrounding the American patent law can be divided into a “question of law” and “question of fact” (Rai, 2003). A question of law is decided by a judge while, on demand of one party, a question of fact is decided by jury (Christie, 1992). There may be a third category as a mixed question of law and fact. “Obviousness” is one example, and three factual inquiries will be done before a legal conclusion of “obviousness” (Chisum et al., 2004).

A question of fact can be decided by jury or a judge. When jury is a fact-finder, it is called “jury trial.” When a judge is a fact-finder, it is called “bench trial” (Tindell, 2009). In the federal civil procedure, parties have no right to jury trial. Instead, each party has to demand jury trial. Otherwise, facts will be tried by a judge (Mauet, 2008).

During litigation, each party could file a motion to request the court to rule on a procedural issue based on the Federal Rules of Civil Procedure. In patent litigation, three common procedural tools include rule 12 motions, rule 56 motions, and motions for judgment as a matter of law (“JMOL”). The rule 12 motions are usually about whether a district court has personal jurisdiction over the defendant. The rule 56 motions ask a court to conclude the case without jury trial. Lastly, the JMOL motions request a judge to make a judgment after the jury heard all evidence or to change the jury’s deliberation.

### **3. Analyzing Court Decisions**

#### **3.1 Method in general**

“Subject,” “verb,” and “legal issue” are three basic elements for analyzing a court decision. A court decision contains different voices from the plaintiff, defendant, challenged district court, Federal Circuit, Supreme Court, and any court other than these three courts. “Subject” in a sentence is usually a key to identify the different voices. “Verb” in the same sentence can reflect what the Federal Circuit wants to express about the “subject,” such as holding, rejection, agreeing, stating, arguing, and responding. Finally, “legal issue” helps group different sentences into different sets associated with different legal issues, so that each set could provide meaningful information to the reader.

The analytic method comprises three steps, by which a reader could collect necessary information. First, re-organize a court decision by briefly analyzing the first sentence of each paragraph. Second, identify whether a paragraph is about facts, legal doctrines, or legal issue analysis. Third, summarize the legal rules applied and rulings made.

To explain the three-step method. This article uses as examples seventeen patent law cases published as precedents by the Federal Circuit from April to July in 2011. The Appendix shows the selected case names. The cases are chosen because they are written by different judges. So, we can see the different styles.

### **3.2 Step one: Re-organize a court decision**

#### **3.2.1 Basic formality of a court decision**

A court decision begins by the name of the Federal Circuit that is followed by parties' names. For example, the front page of *Creative Compounds, LLC. v. Starmark Laboratories* (2011) shows that Creative Compounds, LLC. is the plaintiff and appellant, while Starmark Laboratories is the defendant and appellee.

The structure of a court decision can be divided into several sections in series including the introduction, background, discussion, and conclusion. The introduction section provides a short overview about the legal conclusions of both the district court and Federal Circuit. The background section can be divided into three subsections: patented technology, infringer's technology, and the procedural history in the district court. The discussion section comprises six parts: the standard of review, plaintiff's arguments, defendant's arguments, district court's findings or rulings, applicable, statutory or case law, and Federal Circuit's rulings. The standard of review is usually the beginning paragraph of each discussion section. Finally, the conclusion section is usually a short paragraph stating whether the Federal Circuit affirms, remands, vacates, or reverses the district court's decision.

#### **3.2.2 The first paragraph of a court decision**

The first paragraph in each court decision is usually the introduction section, and its content is very similar throughout the selected cases. The writing pattern is usually like this. Plaintiff (or Defendant) appeals the district court's decision. Because Plaintiff or Defendant failed to do something, or the district court erred in something, this court (Federal Circuit) affirms, remands, vacates, or reverses.

In addition, the first paragraph provides the information of the key issues of the case. For example, in *Duramed Pharmaceuticals, Inc. v. Paddock Laboratories, Inc.* (2011), the Federal Court stated, "Because the district court did not err in holding that prosecution history estoppels bars Duramed's allegations of infringement under the doctrine of equivalents, we affirm" (p. 2). The key legal issue in the case is about the doctrine of equivalents, or more specifically, the prosecution estoppels.

### **3.3 Step two: Identify facts, legal doctrines, or legal issue analysis**

#### **3.3.1 How to find legal issues**

As mentioned above, a court decision talks about legal issues in the introduction section. But, the introduction section cannot provide the information of legal issues in details because of the length of the first paragraph.

A reader could look to the second source for identifying legal issues. It is the background section which informs readers of the claims at dispute, legal issues, and holdings in the district court's decision. For example, in the *Spectralytics, Inc. v. Cordis Corp.* decision, the background section shows that the claim at dispute in front of the Federal Circuit was claim 1 and that the legal issues included validity, infringement, willful infringement, and damages.

“Validity,” “infringement,” or “damages” is a generic term which may still provide little information about what the Federal Circuit had dealt with. A reader could turn to the third source which is the discussion section. Some judges may provide headlines in the discussion section. For instance, the discussion section of the *Retractable Technologies, Inc. v. Becton, Dickinson and Co.* decision can be broken down into:

- A. Standards of Review
- B. Claim Construction
  - 1. Retainer Member
  - 2. Body
  - 3. Exclusion of Devices that Operate by “Cutting”
- C. Infringement
  - 1. 3 mL Integra
  - 2. 1 mL Integra
- D. Exclusion of RTI's Discovery Responses and Letter to the District Court
- E. Invalidity of Claim 25 of the '077 Patent
  - 1. Anticipation
  - 2. Obviousness

Such the expressively, organized structure helps readers locate information useful to them as quickly as possible.

On the other hand, some judges may provide no headline. For example, *Advanced Software Design Corp. v. Fiserv, Inc.* (2011) uses I, II, III, IV, and V to divide the whole decision into five sections (not including the introduction section). Those cases without headlines require a reader to carefully examine all paragraphs, so the reader can figure out which section is the discussion section, a main part of a court decision.

### **3.3.2 How to find law**

When a judge discusses applicable law, she must cite court decisions or statutes in the decision. For example, in *In re Brimonidine Patent Litigation* (2011), the Federal Circuit stated (p. 16):



Where “the problem is known, the possible approaches to solving the problem are known and finite, and the solution is predictable through use of a known option,” a solution that is obvious to try may indeed be obvious. *Abbott Labs. v. Sandoz, Inc.*, 544 F.3d 1341, 1351 (Fed. Cir. 2008), citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

The quotation in *In re Brimonidine Patent Litigation* is directly from *Abbott Labs. v. Sandoz, Inc.* It is a direct citation.

A judge may use indirect citations. The use of indirect citations means that the judge rephrases legal doctrines applied in cited cases. For instance, in *Radio Systems Corp. v. Accession, Inc.* (2011), the Federal Circuit stated (p. 5),

The district court’s exercise of jurisdiction over an out-of-state defendant must be consistent with both the forum state’s long-arm statute and the requirements of due process. *See Avocent Huntsville Corp. v. Aten Int’l Co.*, 552 F.3d 1324, 1329 (Fed. Cir. 2008). Because Tennessee’s long-arm statute is coterminous with due process limitations, *Masada Inv. Corp. v. Allen*, 697 S.W.2d 332, 334 (Tenn. 1985); *see* Tenn. Code Ann. § 20-2-214, the jurisdictional issue in this case turns on whether the court’s exercise of jurisdiction would be consistent with the requirements of due process.

### 3.3.3 How to find parties’ arguments

If a reader has identified parties’ names, it is not difficult to find parties’ arguments. “Allege,” “argue,” “contend,” “claim,” “contest,” “maintain,” and “respond” are common verbs which follow one of the parties’ names.

### 3.3.4 How to find a court’s conclusion

“This court” and “we” are two common subjects that indicate a court’s conclusion. “Find,” “hold,” “affirm,” and “deny” are common verbs to show a court’s attitude.

The Federal Circuit may talk about its past decisions. In such case, “verb” will be past tense. For example, in *Juniper Networks, Inc. v. Shipley* (2011), the Federal Circuit stated (p. 12),

This case differs from *BP Lubricants*. In *BP Lubricants*, this court directed a trial court to dismiss the original complaint in a false marking qui tam action but granted leave to amend, in part because this court had not previously opined on the applicability of Rule 9(b) to false marking. *BP Lubricants*, 2011 WL 873147, at \*3-5.

The Federal Circuit used “directed” to explain its past decision.

### 3.4 Step three: Summarize the legal rules applied and rulings made

After analyzing or collecting all necessary information throughout a court decision, a reader has to summarize the legal rules applied and rulings made, so that the court decision summary could be used for further legal or business purposes.

A case study of *Billups-Rothenberg, Inc. v. Associated Regional and University Pathologists, Inc.* (2011) is presented. The further discussion will eliminate too much unnecessary, technical information to let the readers easily capture the ideas of the analytic method proposed here.

According to page 1 of the *Billups-Rothenberg, Inc.* decision, Billups-Rothenberg, Inc. was the plaintiff and appellant, which indicates that Billups-Rothenberg, Inc. was not satisfied with the district court. Associated Regional and University Pathologists, Inc. was the defendant and appellee.

According to page 2, the patents at dispute were U.S. Patent Nos. 5,674,681 (“681 patent”) and 6,355,425 (425 patent). The district court held that the 681 patent was invalid for lack of written description and that the 425 patent was invalid because of anticipation. According to page 9, the district court’s judgment was summary judgment.

The legal theory of “written description” can be found in the discussion section beginning at page 9 (subsection I). The legal theory of “anticipation” can be found at page 13 (subsection II). Here, the author focuses on “written description” and the 681 patent.

The first two paragraphs of the subsection I show the law of “written description” which can be summarized as follows:

- “The written description requirement requires the inventor to disclose the claimed invention so as to allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed” (p. 9).
- “The level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology” (p. 10).

Because the *Billups-Rothenberg, Inc.* decision was about DNA-related technology, the Federal Circuit also provided some rules for the DNA field:

- “Claiming all DNA’s that achieve a result without defining what means will do so is not in compliance with the description requirement” (p. 10).
- “An adequate description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself” (p. 10).

The 681 patent was about a method to test mutations. The claims at dispute comprised “a gene encoding a nonclassical MHC class I heavy chain,” and the claimed gene provided a therapeutic function.

The Federal Circuit affirmed the district court’s summary judgment on “written description, because the district court properly found that the description did not provide the structure of the claimed gene, so as not to meet the written description requirement. The Federal Court reached this conclusion because the claimed gene is a genus of unknown genetic mutations.

The key legal issue then becomes the written description requirement for genus claims. The law is stated as:

- For genus claims, “an adequate written description of a claimed genus requires more than a generic statement of an invention’s boundaries” (p. 11-12).
- A patent must set forth “either a representative number of species falling within the scope of the genus or structural features common to the members of the genus” (p. 12).

The Federal Circuit found that the 681 patent did not identify a single species. The description only disclosed one gene species, but did not have sufficient, structural information of this gene species to conclude the correlation between the claimed therapeutic function and claimed gene. Therefore, the Federal Circuit held that the 681 patent lacked of the written description requirement.

At page 11, the Federal Circuit stated a factual background to support its legal conclusion (p. 11):

Given the lack of knowledge of sequences for the hemochromatosis gene and its mutations in the field, the limited extent and content of the prior art, and the immaturity and unpredictability of the science when the '681 patent was filed, Billups cannot satisfy the written description requirement merely through references to later-acquired knowledge.

The above case study is a brief demonstration about how to analyze a case based on the proposed method. It should be aware that people with a relevant technology background will certainly understand more about the factual supports for a decision.

With the key information of a court decision, a reader can provide to others, such as her clients, the useful information of the decision which may help make business decisions.

#### **4. Conclusion**

In this article, a proposed method for analyzing an American patent law case is provided. First, re-organize the court decision by briefly analyzing the first sentence of each paragraph. Second, identify whether a paragraph is about facts, legal doctrines, or legal issue analysis. Third, summarize the legal rules applied and rulings made. The author thinks that because of the formality of the legal writing tradition in American, it is not difficult to identify the law applied by the court, and that the relevant facts supporting the rulings in a decision can also be identified, so that those facts in that decision could be useful for supplying a legal opinion under the facts provided by a client.

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## Appendix

*Creative Compounds, LLC. v. Starmark Laboratories* (2011); *General Protecht Group, Inc. v. Leviton Manufacturing Co., Inc.* (2011); *In re Brimonidine Patent Litigation* (2011); *Advanced Software Design Corp. v. Fiserv, Inc.* (2011); *Radio Systems Corp. v. Accession, Inc.* (2011); *McKesson Technologies Inc. v. Epic Systems Corp.* (2011); *Tivo Inc. v. Echostar Corp.* (2011); *Duramed Pharmaceuticals, Inc. v. Paddock Laboratories, Inc.* (2011); *Retractable Technologies, Inc. v. Becton, Dickinson and Co.* (2011); *Billups-Rothenberg, Inc. v. Associated Regional and University Pathologists, Inc.* (2011); *Rembrandt Data Technologies, LP. v. AOL, LLC.* (2011); *Juniper Networks, Inc. v. Shipley* (2011); *Lexion Medical, LLC. v. Northgate Technologies, Inc.* (2011); *Boston Scientific Corp. v. Johnson & Johnson* (2011); *Spectralytics, Inc. v. Cordis Corp.* (2011); *Crown Packaging Technology, Inc. v. Ball Metak Beverage Container Corp.* (2011). All cases can be downloaded at the Federal Circuit’s official website, <http://www.cafc.uscourts.gov/opinions-orders/search/report.html>.

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## Learning American Patent Law Through Court Decision

### Analysis

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### Abstract

This article provides a method for non-American-trained law students to analyze American patent law cases. Particularly, the method is designed for Taiwanese students. The American legal writing has its own style. Without being trained in an American law school, a person cannot analyze the cases comprehensively. It is necessary to develop a method to help local students to analyze cases, so they can acquire the knowledge of American patent law. For elaborating the proposed method, this article begins with a background introduction about American legal writing and patent law. Then, five aspects of the proposed method are explained in details with examples. In the conclusion, a brief summary of the proposed method is provided. First, re-organize the court decision by briefly analyzing the first sentence of each paragraph. Second, identify whether a paragraph is about facts, legal doctrines, or legal issue analyses. Third, summarize the legal rules applied and rulings made. Because of the formality of the legal writing tradition in American, it is not difficult to identify the law applied by the court, and that the relevant facts supporting the rulings in a decision can also be identified, so that those facts in that decision could be useful for supplying a legal opinion under the facts provided by a client.

**Keywords: Patent law, legal writing, Federal Circuit, Patent English**

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