

Our Latest Industry Insights

IP File

March 9, 2015

Not So Fast: Split Federal Circuit Panel Sided with PTO on Novel IPR Issues

By: Dan Liu

In *In re Cuozzo Speed Technologies, LLC*,^[1] the first ever appeal of the final written decision from an inter partes review (“IPR”) before the Patent Trial and Appeal Board (“PTAB” or the “Board”),^[2] the Federal Circuit decided two novel and fundamental questions arising under the newly enacted IPR proceedings created by the America Invents Act of 2011 (“AIA”). On both issues, the Federal Circuit agreed with the PTO,^[3] holding (1) institution decisions by the Board are almost never reviewable on appeal, either interlocutory or after the Board’s final written decision, and (2) that the “broadest reasonable interpretation” standard is the proper standard for claim construction in IPR proceedings.^[4]

TAGS: 542 u.s. 367 380 2004, aia, america invents act of 2011, block v. cmtly nutrition inst., bri, broadest reasonable interpretation, cheney v. us district court for the dc, claims construed under the broadest reasonable interpretation standard, federal circuit, in re cuozzo speed technologies, inter partes review, ipr, judge newman, patent litigation, pto, section 316d1, uspto

IP File

February 11, 2015

Joinder Denied: The Ins And Outs Of Filing And Joining IPR Petitions On A Timely Basis

By: Dan Liu

For patent infringement defendants filing an Inter Partes Review (“IPR”) petition to challenge the validity of the patents asserted against them has become popular, largely because of the high rate of patents rendered invalid as a result of the petitions. Thus, knowing when to file an IPR petition is crucial.

TAGS: Inter Pares Review, IPR, Patent Litigation

IP File

February 4, 2015

Navigating Patent Damages Part II: How Infringement Allegations Can Impact or Limit Potential Damages

Previously, we discussed the implications of the failure to mark defense on damages prior to the filing of a patent case. In this next article in the series, we examine how allegations of direct and/or indirect infringement, as well as the type of patent claim being asserted (e.g., method, system, or apparatus) can impact the amount of potential damages a patent holder can recover.

TAGS: asserted patents, contributory infringement, direct infringement, direct infringement damages, indirect infringement, indirect infringement theory, induced infringement, infringement allegations, method claims, patent case, patent claim, patent damages, patent holder, patent litigation, pre-filing damages, strict liability tort, synqor inc. v. artesyn techs. inc., system claims

IP File

January 27, 2015

Supreme Court Modifies Claim Construction Review Standard

By: Rex Hwang

On Tuesday, the U.S. Supreme Court issued its decision in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.* partially modifying the standard of review to be applied by the Federal Circuit when reviewing a district court's construction of a claim term. Prior to *Teva*, the Federal Circuit applied a *de novo* standard for claim construction review. Now, based on the *Teva* decision, the Federal Circuit must apply a "clear error" standard for factual questions, and a *de novo* standard for legal questions when reviewing a claim construction on appeal.

TAGS: claim construction, claim term, clear error standard, *de novo* standard, Federal Circuit, intrinsic evidence, patent claim, Patent Litigation, *Phillips*, *Teva*, *Teva Pharmaceuticals USA v. Sandoz Inc.*, U.S. Supreme Court

IP File

January 14, 2015

Low Octane Levels? Octane Fitness' Impact in the Trademark and Trade Secret Realms

We have previously addressed the Supreme Court's decision in *Octane Fitness, LLC v. Icon Health & Fitness, Inc.*, 12-1184, Slip Op. at 7 (2014), which relaxed the standard for awarding attorney's fees under Section 285 of the Patent Act ("§285") and ruled that decisions on §285 are entitled to deference on appeal. In the patent litigation realm, the Octane Fitness decision does not seem to have led to an overwhelming trend toward awarding fees. It does, however, beg the question: how has this impacted the standard for awarding attorney's fees in other types of intellectual property cases, such as trademarks and trade secrets?

TAGS: apple inc. v. samsung elects. co., bmw of north america v. cudahar, fair wind sailing v. dempster, intellectual property, lanham act, monster daddy v. monster cable products, ninth circuit, octane fitness, octane fitness llc v. icon health & fitness inc., patent act, patent infringement, patent litigation, patent litigation, premium balloon accessories v. creative ballon mfg., sixth circuit, supreme court, third circuit court of appeals, tivo research, tns, tns media research v. tivo research, trade secret & unfair competition, trade secret statutes, trade secrets, trademark & trade dress, trademark attorney fees, trademarks, uniform trade secrets act, utsa

IP File

January 7, 2015

Ericsson, Inc. v. D-Link Sys., Inc. Guidance on Determining Damages for Standard Essential Patents

Patents claiming inventions which must be used to comply with certain technical standards (for example, the Wi-Fi standard or standards for 3G) are referred to as standards-essential patents or "SEPs". There has, historically, been little judicial guidance concerning damages in cases where SEPs are implicated.[1] The recent Federal Circuit ruling in *Ericsson, Inc. v. D-Link Sys., Inc.*, finally provides some guidance on the issue of determining damages in such cases. No. 2013-1625, 2014 WL 6804864 (Fed. Cir. Dec. 4, 2014). In addition to providing insight on several apportionment issues specific to SEPs, the court also held that simply reciting all Georgia-Pacific factors to a jury is unacceptable and that jury instructions must only include the specific factors relevant to the evidence presented.

TAGS: apportionment of value, d-link, eastern district of texas, ericsson, ericsson inc. v. d-link sys. inc., federal circuit, frand terms, garretson v. clark, georgia-pacific factors, intel, patent hold-up, patent litigation, royalty stacking, sep patents, seps, standards-essential patents, supreme court

IP File

December 23, 2014

Federal Circuit Reverses Judgment for Willful Infringement

By: Rex Hwang

Through its recent decision in *Stryker Corp. v. Zimmer, Inc.*, the Federal Circuit gave Zimmer an early Christmas gift worth approximately \$140 million by reversing a district court's determination of willfulness and vacating a corresponding award of trebled damages against Zimmer. The reversal was based on the Federal Circuit's finding that the noninfringement and invalidity defenses raised by Zimmer were "not objectively unreasonable."

TAGS: Federal Circuit, noninfringement and invalidity defenses, not objectively unreasonable, orthopedic procedures, patent infringement, Patent Litigation, pressurized irrigation for certain medical therapies, *Stryker Corp v Zimmer Inc*, willfulness

IP File

December 4, 2014

Navigating Patent Damages Part I: A Primer on the Failure to Mark Defense

Navigating damages in patent cases is a complex exercise. In this series, beginning with the marking statute, we explore various nuances of damages analysis.

TAGS: *american medical systems inc. v. medical engineering corp.*, apparatus claims, *k&k jump startchargers inc. v. schumacher elec. corp.*, mark defense, marking requirements, *maxwell v. j. baker inc.*, patent damages, patent infringement damages, patent litigation, statutory authority

IP File

November 17, 2014

Ultramercial Finally Strikes Out at the Federal Circuit

By: Rex Hwang

In its most recent decision in *Ultramercial, Inc. v. Hulu*, the Federal Circuit finally concluded that the claims-at-issue do not cover patent-eligible subject matter under 35 U.S.C. § 101. This comes after two prior decisions by the Federal Circuit reaching the opposite conclusion, and two orders from the U.S. Supreme Court instructing the Federal Circuit to reconsider those two decisions.

TAGS: *Alice*, Federal Circuit, Litigation, Patent Litigation, patent litigation, patent-eligible, section 101, *Ultramercial*, *Write of Certiorari*; Supreme Court

IP File

November 3, 2014

Half a year since Octane

By: Andrew Choung

It's been nearly half a year since the Supreme Court, in *Octane Fitness*, ostensibly lowered the standard for finding a patent case to be exceptional for purposes of fee-shifting. At the time, *Octane* generated much commentary and speculation, with some predicting a flood of fee awards and others predicting even more confusion at the district court level.

TAGS: attorneys' fees, fee-shifting, *Octane Fitness*, patent, Patent Law, Patent Litigation, Supreme Court