Glaser Weil

Our Latest Industry Insights

IP File
March 28, 2017
Supreme Court Kills Laches Defense for Patent Infringement

On March 21, 2017 the Supreme Court issued an opinion that abrogated the equitable defense of laches, for unreasonable and prejudicial delay in filing suit, in patent cases. SCA Hygiene Prod. Aktiebolag v. First Quality Baby Prod., LLC, No. 15-927, 2017 WL 1050978 (U.S. Mar. 21, 2017). In that case, Appellant SCA Hygiene argued that the Supreme Court's 2014 Petrella decision, which conclusively eliminated laches as a defense in copyright cases, also mandated the elimination of laches as a defense to patent infringement. The Supreme Court agreed, reversing the Federal Circuit's holding of unenforceability due to laches, and remanding for trial on infringement and Appellee First Quality's equitable estoppel defense.

TAGS: intellectual property, laches, patent infringement, patent litigation, petrella, sca hygiene prod. aktiebolag v. first quality baby prod.

IP File
June 21, 2016
The Cuozzo Conundrum: Prosecution History Estoppel Remains An Open Issue

By: Andrew Choung
On June 20, 2016, the Supreme Court issued its decision in Cuozzo Speed Technologies, LLC v. Lee. One of the questions presented to the Court was the appropriate claim construction standard for inter partes review (IPR). The fundamental dispute, as framed by the Court, was the apparent intent of the Leahy-Smith America Invents Act (AIA) and the express rule-making authority it granted. Pursuant to the rule-making authority granted by the AIA, the Patent Office set forth the broadest reasonable interpretation (BRI) as the standard for construing claims under an IPR. This is the standard used during original examination of an application for a patent. The patent-owner argued that, since IPRs were intended to be an alternative to litigating validity in the courts, it should be subject to the same standard of claim construction used there, which is generally understood to be narrower. Ultimately, the Court held that the rule-making authority trumped any arguments about intent and consequences and affirmed the Patent Office's application of the BRI standard.

TAGS: broadest reasonable interpretation, claim construction, Intellectual Property, inter partes review, IPR, patent, patent act, patent case, Patent damages, patent infringement, Patent Law, Patent Litigation, patent litigation, prosecution disclaimers, prosecution history estoppel, PTAB, PTAB, Supreme Court, U.S. Supreme Court, US Supreme Court

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IP File
June 14, 2016

The Supreme Court Relaxes The Standard For Increased Patent Damages

By: Rex Hwang

Through its recent decision in Halo Elecs., Inc. v. Pulse Elecs., Inc.[1], the Supreme Court discarded the mechanical two-part test governing enhanced damages fashioned by the Federal Circuit in Seagate, and gave district courts broad discretion to decide when to award enhanced damages in cases involving willful patent infringement. The Supreme Court also held that enhanced damages do not need to be proven by clear and convincing evidence, but only by a preponderance of the evidence. While this will make it easier for plaintiffs to obtain enhanced patent damages involving willful patent infringement, the high court made it clear that enhanced damages should still be reserved for cases involving egregious infringement behavior.

TAGS: Intellectual Property, Intellectual Property, patent, patent act, patent case, patent claim, Patent damages, patent infringement, Patent Law, Patent Litigation, patent litigation, patent-eligible, patent-ineligible, PTAB, PTAB, Seagate, Supreme Court, U.S. Supreme Court, USPTO

IP File
April 1, 2016

Glaser Weil Partner Mieke Malmberg Speaking at “Patent Disputes for Our Time: New Realities, New Approaches”, Presented by the State Bar of California

On March 23, 2016, Glaser Weil Partner, Mieke Malmberg, along with co-presenter, Jason Angell of Freitas Angell & Weinberg, LLP, presented a one hour talk on changes in patent litigation to participants in a one day conference sponsored by the State Bar of California, in San Francisco. The program, entitled, "Patent Disputes for Our Time: New Realities, New Approaches", focused on patent litigation and management of patent disputes in today's changing landscape.

TAGS: Intellectual Property, Intellectual Property, patent, patent act, patent case, patent claim, Patent damages, patent infringement, Patent Law, Patent Litigation, patent litigation, PTAB, USPTO

IP File
March 16, 2016

Lexmark International, Inc. v. Impression Products, Inc. – The Latest on Patent Exhaustion

By: Steven Basileo

Summary

TAGS: Federal Circuit, federal court, Intellectual Property, Intellectual Property, Litigation, patent, patent case, patent claim, Patent damages, patent infringement, Patent Law, Patent Litigation, patent litigation, PTAB, PTAB, Supreme Court, U.S. Supreme Court

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IP File
February 12, 2016

Slaying the Dragon: Understanding and Effectively Managing the Use of the Model Order on E-Discovery in Patent Cases

On February 11, 2016, Glaser Weil Partner, Mieke Malmberg, presented a one hour webinar sponsored by the State Bar of California on the use of the Federal Circuit's Model order on electronic discovery in patent cases.

TAGS: federal circuit, federal court, intellectual property, litigation, patent, patent case, patent claim, patent damages, patent infringement, ptab, uspto

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IP File
September 30, 2015

Laches As a Defense to Patent Damages Survives – For Now

By: Rex Hwang
In last week's 6-5 decision in SCA Hygiene Prod. v. First Quality Baby Prod., LLC, No. 2013-1564, 2015 WL 5474261 (Fed. Cir. Sept. 18, 2015), the US Court of Appeals for the Federal Circuit, sitting en banc, reaffirmed that laches remains a viable defense in patent infringement lawsuits. The decision was reached despite the relatively recent U.S. Supreme Court decision in Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S.Ct. 1962 (2014), where the high court struck laches as an available copyright infringement defense. However, the Federal Circuit's sharp divide on this issue suggests that further review by the U.S. Supreme Court may be on its way.

TAGS: Federal Circuit, federal court, Intellectual Property, Intellectual Property, laches, patent act, patent case, patent claim, patent infringement, Patent Law, Patent Litigation, patent litigation, U.S. Supreme Court, US Supreme Court

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IP File
August 4, 2015

Navigating Patent Damages Part III: Statutory Indemnification - Implied Warranty Against Infringement

In this third article relating to patent damages, we explore the effects of implied indemnification provisions when evaluating who is responsible for litigation costs when faced with an infringement suit.

TAGS: 84 lumber co v mrk techs ltd, chemtron inc v. aqua products inc, implied indemnification, implied warranty against infringement, inc v olaes enterprises, inc v sony eletronics, inc., infringement claim, motorola inc v. varo inc, pacific sunwear of california, patent damages, patent infringement, patent litigation, phoenix solutions, rightful claim, sun coast merchandise corp v. myron corp, ucc, ucc § 2-3123, uniform commercial code

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IP File
July 21, 2015

The “Oracle” Predicts It: Supreme Court Declines to Hear Landmark Software Copyright Case

The U.S. Supreme Court declined to grant certiorari in the case of Google, Inc. v. Oracle America, Inc., a closely watched case regarding the eligibility of software for copyright protection. The Supreme Court’s decision leaves in place the Federal Circuit’s landmark 2014 ruling, which held that Oracle was entitled to copyright protection for its application programming interfaces (“APIs”), which are “preset blocks of code that help developers write in Oracle’s popular Java programming language.”

TAGS: 35 u.s.c. § 101, computer software, copyright & idea theft, copyright infringement, eligibility of software for copyright protection, fair use doctrine, google inc v oracle america inc, intellectual property, merger doctrine, oracle america inc v. google inc, patent infringement, scenes a fair doctrine, trade secret & unfair competition, us supreme court, write of certiorari; supreme court

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IP File
July 14, 2015

Federal Circuit Attacks Functional Claim Drafting Under 35 U.S.C. § 101

By: Rex Hwang
In Internet Patents Corp. v. Active Networks, the Federal Circuit affirmed yet another dismissal of a patent infringement lawsuit due to the asserted patent being invalid for lacking patent eligible subject matter under 35 U.S.C. § 101. Here, the sole patent-in-suit, U.S. Patent No. 7,707,505 (the “’505 Patent”), was generally directed to the use of a web browser Back and Forth navigational functionalities without data loss in an online application consisting of dynamically generated webpages. Claim 1 of the ’505 Patent recites:

TAGS: 35 U.S.C. § 101, Federal Circuit, Internet Patents Corp v Active Networks, inventive concept, patent eligible subject matter, patent infringement, Patent Litigation, Williamson v Citrix Online LLC
