

IP File

The IP File's mission is to scour the universe for compelling stories in intellectual property law. In the United States, there are four main types of intellectual property protection available: patents, copyrights, trademarks and trade secrets.

January 28, 2016

Glaser Weil Partner Mieke Malmberg Moderated a Panel for the AIPLA Mid-Winter Institute in La Quinta, CA

On January 27, 2016, Glaser Weil Partner, Mieke Malmberg, moderated a panel for the AIPLA Mid-Winter Institute in La Quinta, California.

TAGS: Copyrights, Intellectual Property, Intellectual Property, Litigation, Patent Litigation, Trade Secrets, Trademarks

October 20, 2015

The En Banc Federal Circuit in Akamai v. Limelight Broadens the Scope of Direct Infringement under Section 271(a)

By: Dan Liu

Recently, the Federal Circuit, for a second time this year, evaluated infringement of a method claim.[1] The Court, vacating the recent panel decision in May, outlined the governing framework for direct infringement of a method claim. It held that direct infringement occurs "where all steps of a claimed method are performed by or attributable to a single entity." [2] This holding is significant because proving direct infringement of a method claim where steps of the method are performed by more than one party no longer requires the parties to be in principal-agent or contractual relationships, or joint enterprise, as demanded by the vacated panel decision.

TAGS: akamai technologies, direct infringement, Federal Circuit, Intellectual Property, Intellectual Property, limelight, patent claim, Patent Law, Patent Litigation, patent litigation, Section 271(a), Supreme Court, USPTO

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

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 electronics, 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

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

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*

July 8, 2015

Federal Circuit’s Latest Patent Subject Matter Decision in *Ariosa v. Sequenom* Renders Many Biotech Patents at Risk

By: Dan Liu

On June 12, 2015, the Federal Circuit issued its decision in *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*,^[1] finding that Sequenom’s patent claiming methods of using cell-free fetal DNA (“cffDNA”) for prenatal diagnosis test is patent ineligible under 35 U.S.C. § 101. The Sequenom’s patent is directed to a revolutionary finding that there is cffDNA in the blood stream of a pregnant woman. The presence of cffDNA in maternal blood samples provides a safer, cheaper, and faster alternative to the conventional invasive methods to determine fetal genetic abnormalities, such as Down Syndrome. Several popular prenatal diagnosis tests, including Sequenom’s MaterniT21 and Ariosa’s Harmony, embody Sequenom’s discovery.

TAGS: 35 U S C 101, *Ariosa v Sequenom*, cffDNA, Federal Circuit, inventive concept, *Mayo Collaborative Services v Prometheus Laborites Inc*, natural phenomenon, patent eligibility, Patent Litigation, patent-ineligible, Supreme Court

June 10, 2015

No Suit For You! Changes to Patent Pleading Standard Issued By the U.S. Supreme Court Require More Than Bare Bones Pleading

In late April, the U.S. Supreme Court adopted changes to the Federal Rules of Civil Procedure which have significant implications for patent plaintiffs. In an April 29, 2015 order, the high court approved, without comment, changes initially approved by the Judicial Conference of the U.S. in September 2014. While these changes impact several different areas of civil litigation, they specifically impact patent litigation: unlike the previous edition of the Federal Rules, which allowed patent plaintiffs to "file bare-bone complaints," patent plaintiffs will soon be subject to the same heightened pleading standards required of plaintiffs in other types of civil litigation.

TAGS: ashcroft v iqbal, bell atl corp v twombly, federal court, form 18, frcp, intellectual property, model forms, model patent complaint, patent infringement, patent litigation, rule 84, us supreme court

June 5, 2015

Good-Faith Belief of Invalidity Not a Defense to Inducement

In its recent ruling in *Commil USA v. Cisco Systems*, 575 U.S. ___ (2015), the Supreme Court addressed the knowledge requirement for a claim of inducing patent infringement, holding that defendants in a patent case could not evade liability by asserting a "good-faith belief" that the patent was invalid.

TAGS: 395, 430, 6, a claim of inducing patent infringement, a good faith belief of invalidity is no defense, cardinal chemical co v morton int'l, certiorari, cisco systems, commil usa, eastern district of texas, good-faith belief, induced infringement under 271b requires knowledge that the induced acts constitute patent infringement, intellectual property, supreme court

May 19, 2015

Federal Circuit Reaffirms Single Entity Rule for Divided Infringement under Section 271(a) in Akamai, Making Method Claims Difficult to Enforce

By: Dan Liu

On May 13, 2015, the Federal Circuit issued the much-anticipated decision in *Akamai Technologies, Inc. v. Limelight Networks, Inc.* following a remand from the Supreme Court.[1] The Federal Circuit, in a 2-1 decision, held that “direct infringement liability of a method claim under 35 U.S.C. § 271(a) exists when all of the steps of the claim are performed by or attributed to a single entity[.]” This is consistent with its 2008 *Muniauction* decision, where the Federal Circuit first made clear that “direct infringement requires a single party to perform every step of a claimed method.”[2] The *Akamai* Court concluded that when “one party, acting as ‘mastermind’ exercises sufficient ‘direction or control’ over the actions of another,” the “single entity” requirement may be met and the direct infringement may be found. Sufficient direction or control may occur in a principal-agent relationship, a contractual arrangement, or a joint enterprise.

TAGS: 35 U.S.C. § 271(a), akamai technologies, Akamai Technologies Inc v Limelight Networks Inc, direct infrignment liability, Fed Cir, Inc., Intellectual Property, limelight, Muniauction Inc., Patent Litigation