

## 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.

February 24, 2017

### **Life Technologies v. Promega: Supreme Court Limits Infringement Liability under Section 271(f)(1)**

**By:** Dan Liu

On February 22, 2017, the Supreme Court in *Life Technologies v. Promega* ruled that “a single component does not constitute a substantial portion of the components that can give rise to liability under §271(f)(1).”<sup>[1]</sup> This ruling limits the reach of §271(f)(1) and will benefit U.S. manufacturers across the board.

**TAGS:** genetic testing, Intellectual Property, Intellectual Property, Life Technologies, Patent Litigation, Promega, Section 271(f)(1)

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October 14, 2016

### **Supreme Court October Term 2016 Preview – Patent Cases**

**By:** Dan Liu

As the Supreme Court kicked off October Term 2016, it continues to show a strong interest in patent law, granting three petitions so far with more petitions to be considered.

**TAGS:** Apple Inc. v. Samsung Elecs. Co., First Quality, Intellectual Property, Life Technology, Patent Litigation, Promega, SCA Hygiene

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March 30, 2016

## **Freedom of Speech Protects “Disparaging” Marks, Federal Circuit Holds**

**By:** Dan Liu

In a recent landmark ruling, the Federal Circuit, sitting en banc, held that Section 2(a) of the Lanham Act’s ban on “disparaging” marks violates the First Amendment.[1] Section 2(a) provides that no trademark shall be refused registration “unless it consists of or comprises . . . matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols[.]”[2] The majority found that the government’s prohibition of registration of disparaging marks “amounts to viewpoint discrimination, and under the strict scrutiny review, . . . is unconstitutional.”[3] It further concluded that such prohibition is unconstitutional even under the intermediate scrutiny review because the government offered no legitimate interests to justify such prohibition.[4]

**TAGS:** Federal Circuit, First Amendment, Intellectual Property, Intellectual Property, Lanham Act, Trademark & Trade Dress, Trademarks, USPTO

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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

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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.*,<sup>[1]</sup> 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

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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.<sup>[1]</sup> 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."<sup>[2]</sup> 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

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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*,<sup>[1]</sup> 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”),<sup>[2]</sup> 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,<sup>[3]</sup> 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.<sup>[4]</sup>

**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

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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

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October 28, 2014

## **A Sea Change after Alice: Recent Court Decisions Show Patents Are Vulnerable under Section 101 Attack**

**By:** Dan Liu

Since 2010, the Supreme Court has issued four decisions on patent-eligible subject matter under 35 U.S.C. § 101. In the most recent decision, *Alice Corp. v. CLS Bank*, the Court continued the restrictive approach set forth in its own precedents in *Gottschalk v. Benson*,<sup>[1]</sup> *Parker v. Flook*,<sup>[2]</sup> and *Diamond v. Diehr*,<sup>[3]</sup> and invalidated patents directed to computerized methods for mitigating settlement risk by using a third-party intermediary. The most significant passage in the *Alice* decision is that the Court expressly adopted the two-step test it elaborated in *Mayo Collaborative Services v. Prometheus Laboratories*<sup>[4]</sup> for all types of patent subject matter issues, including laws of nature, natural phenomena, and abstract ideas.<sup>[5]</sup>

**TAGS:** Alice, Alice Corp. v. CLS Bank, Patent Litigation, patent litigation, patent-eligible, patent-ineligible, patents, section 101, Supreme Court

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September 9, 2014

## **Emerging Impact of Inter Partes Review on Hatch Waxman Litigation - A Primer**

**By:** Dan Liu

Hatch-Waxman Litigation in a Nutshell Hatch-Waxman litigation refers to pharmaceutical patent litigation between a brand drug manufacturer and a generic drug manufacturer under the Hatch-Waxman Act (“Act”). The Act was enacted to facilitate generic drug entry into the market while encouraging pioneer drug development. This is achieved by providing carefully balanced statutory incentives, such as a five-year data exclusivity to the brand firm and a 180-day market exclusivity to the first generic firm, and procedures for approval and marketing of generic drugs.

**TAGS:** brand drug patents, district court proceedings, hatch-waxman act, hatch-waxman litigation, ipr, patent litigation, patent litigation, pharmaceutical patents, ptab

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