

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.

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

April 6, 2016

35 U.S.C. § 101 – If At First You Don't Succeed, Try, Try Again

By: Rex Hwang

As most practitioners know, even a duly issued patent can be invalidated under 35 U.S.C. § 101 if the patent's claims are directed to a "patent-ineligible concept," such as an abstract idea. Yet, trying to anticipate whether a patent claim will actually be invalidated under § 101 remains as difficult as ever. The dispute between Global Cash Access, Inc. ("Global Cash") and NRT Technology Corp. ("NRT") involving U.S. Patent No. 6,081,792 (the "792 Patent") is illustrative.

TAGS: federal court, Intellectual Property, Intellectual Property, Litigation, patent, patent act, patent case, patent claim, Patent Law, Patent Litigation, patent litigation, patent-eligible, PTAB, PTAB, 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

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*

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

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

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

October 7, 2014

Federal Circuit Decision Highlights Risk of Co-owning Patents

By: Rex Hwang

Co-owning any piece of property can lead to unwanted and unexpected headaches. And as demonstrated by the Federal Circuit in *STC.UNM v. Intel Corp.*, Fed. Cir. No. 2013-1241, this is especially true with respect to co-ownership of patents. Here, the Federal Circuit held that STC lacked standing to bring its patent infringement lawsuit against Intel because Sandia Corp., a co-owner of the patent-in-suit, refused to voluntarily join the lawsuit, and could not be involuntarily joined under Federal Rule of Civil Procedure 19(a).

TAGS: co-owned patents, Federal Circuit, Intel, invention patent, patent act, Patent Litigation, patent-in-suit, Sandia Corp., STC, University of Mexico

August 7, 2014

PTAB Issues First Precedential Opinion in an AIA Post-Grant Proceeding

By: Rex Hwang

PTAB Issues First Precedential Opinion in an AIA Post-Grant Proceeding

TAGS: AIA, CardinalCommerce, CBM, covered business method, infringement, patent, Patent Litigation, post-grant proceedings, precedential decision, PTAB, PTAB, SecureBuy, SecureBuy LLC v. CardinalCommerce Corp.

June 23, 2014

High Court Says Computerized Abstract Ideas Not Patent Eligible

By: Rex Hwang

In its highly anticipated decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, the United States Supreme Court unanimously ruled that an abstract idea is not patentable simply because it is implemented on a computer.

TAGS: *Alice Corp. Pty. Ltd.*, CLS Bank Int'l, electronic "shadow" accounts, Intellectual Property, Litigation, Patent Litigation, software patent case law, Supreme Court, Trial Practice Federal Circuit
