

## 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.

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.

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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)."[1] 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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February 2, 2017

## **Strategies Against Nuisance Patent Suits Part II – Cases on California Civil Procedure Code 1030**

This is the next part of our series of posts on utilizing California Code of Civil Procedure, Section 1030, in patent cases, particularly as a strategy against nuisance suits. Section 1030 provides that a defendant may move the court to require an out-of-state plaintiff to file an undertaking to secure an award of costs and attorneys' fees upon showing a reasonable possibility of success on the merits. Part one of our series, discussing the requirements of Section 1030, can be found [here](#).

**TAGS:** california code of civil procedure, patent litigation, patent litigation, section 1030

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January 5, 2017

## **Strategies Against Nuisance Patent Suits – Utilizing California Civil Procedure Code 1030**

**By:** Andrew Choung

Much is lamented about the burden and costs that nuisance patent litigation imposes. Recently, with the Supreme Court agreeing to hear a case on restricting patent litigation venue, the problems of forum shopping by NPEs have come back into the spotlight. Limiting venue is one way that might reduce or discourage nuisance litigation by NPEs. But as some defendants quickly realize, even after successfully transferring venue out of so-called patent friendly jurisdictions, the fundamental problem of the lawsuit remains. You may now be in a court you think is favorable to you, but you still have to litigate what you may believe is a frivolous case.

**TAGS:** California code of civil procedure section 1030, Patent Litigation, patent litigation, patent litigation venue

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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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July 5, 2016

## **Litigation Financing Is Not Champerty: Delaware Confirms That Litigation Financing Is Here To Stay**

**By:** Andrew Choung

On March 9, 2016, in *Charge Injection Technologies, Inc. v. E.I. Dupont De Nemours & Company*, C.A. No. 07C-12-134-JRL, the Superior Court of the State of Delaware issued a decision on a motion to dismiss for violating state champerty and maintenance laws. In 2008, plaintiff Charge Injection Technologies, Inc. (“CIT”) sued E.I. Dupont De Nemours & Company (“Dupont”) for various patent and trade secrets related infractions. During the course of the litigation, CIT entered into a litigation financing arrangement with Burford Capital LLC (“Burford”). Dupont sought to have the case dismissed, arguing in part that CIT was not the true owner of the claims and Burford was wielding de facto control over the lawsuit. The Court denied Dupont’s motion, finding that CIT had not assigned its claim to Burford, and Burford had no right to maintain, direct, control or settle the litigation. In denying the motion, the Court affirmed the propriety of litigation financing, and strongly dispelled many of the criticisms raised by those opposed to such arrangements.

**TAGS:** champerty, champerty and maintenance, CIT v. Dupont, ethical conflicts, frivolous litigation, Intellectual Property, Intellectual Property, legal ethics, Litigation, litigation financing, patent, patent case, patent claim, Patent Litigation, patent litigation

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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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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

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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

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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

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