Glaser Weil

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 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

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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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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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

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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

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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,[1] 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"),[2] 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,[3] 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.[4]

TAGS: 542 u.s. 367 380 2004, aia, america invents act of 2011, block v. cmty 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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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

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January 7, 2015

Ericsson, Inc. v. D-Link Sys., Inc. Guidance on Determining Damages for Standard Essential Patents

Patents claiming inventions which must be used to comply with certain technical standards (for example, the Wi-Fi standard or standards for 3G) are referred to as standards-essential patents or “SEPs”. There has, historically, been little judicial guidance concerning damages in cases where SEPs are implicated.[1] The recent Federal Circuit ruling in Ericsson, Inc. v. D-Link Sys., Inc., finally provides some guidance on the issue of determining damages in such cases. No. 2013-1625, 2014 WL 6804864 (Fed. Cir. Dec. 4, 2014). In addition to providing insight on several apportionment issues specific to SEPs, the court also held that simply reciting all Georgia-Pacific factors to a jury is unacceptable and that jury instructions must only include the specific factors relevant to the evidence presented.

TAGS: apportionment of value, d-link, eastern district of texas, ericsson, ericsson inc. v. d-link sys. inc., federal circuit, frand terms, garretson v. clark, georgia-pacific factors, intel, patent hold-up, patent litigation, royalty stacking, sep patents, seps, standards-essential patents, supreme court

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