

## 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 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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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

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