

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 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

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. 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

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

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

July 28, 2014

Estoppel effects of post-grant patent proceedings under the AIA

By: Andrew Choung

By now, most patent practitioners are quite familiar with the post-grant patent proceedings (e.g., IPR, PGR, CBM) newly established by the AIA, and their key features, such as the stay and estoppel provisions. Numerous courts have addressed the issue of a stay of civil litigation during the pendency of a post-grant proceeding. The growing defense strategy, upon being sued for patent infringement, is to file a post-grant patent proceeding and seek a stay of the civil litigation, which allows the defendant to move the patent validity issue into a more favorable and usually less expensive forum. Most statistics show that courts in the various jurisdictions with active patent case dockets are quite willing to stay cases.

TAGS: cbm, civil litigation, estoppel, et al, evolutionary intelligence, evolutionary intelligence llc v. millennial media inc., intellectual property, ipr, itc, locata lbs, locata lbs llc v. yellopages.com llc, motions to stay, patent case, patent litigation, pgr, post-grant patent proceedings, ptab