

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.

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

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

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

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

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

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

February 4, 2015

Navigating Patent Damages Part II: How Infringement Allegations Can Impact or Limit Potential Damages

Previously, we discussed the implications of the failure to mark defense on damages prior to the filing of a patent case. In this next article in the series, we examine how allegations of direct and/or indirect infringement, as well as the type of patent claim being asserted (e.g., method, system, or apparatus) can impact the amount of potential damages a patent holder can recover.

TAGS: asserted patents, contributory infringement, direct infringement, direct infringement damages, indirect infringement, indirect infringement theory, induced infringement, infringement allegations, method claims, patent case, patent claim, patent damages, patent holder, patent litigation, pre-filing damages, strict liability tort, *synqor inc. v. artesyn techs. inc.*, system claims

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
