

## 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

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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 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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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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August 4, 2015

## **Navigating Patent Damages Part III: Statutory Indemnification - Implied Warranty Against Infringement**

In this third article relating to patent damages, we explore the effects of implied indemnification provisions when evaluating who is responsible for litigation costs when faced with an infringement suit.

**TAGS:** 84 lumber co v mrk techs ltd, chemtron inc v. aqua products inc, implied indemnification, implied warranty against infringement, inc v olaes enterprises, inc v sony electronics, inc., infringement claim, motorola inc v. varo inc, pacific sunwear of california, patent damages, patent infringement, patent litigation, phoenix solutions, rightful claim, sun coast merchandise corp v. myron corp, ucc, ucc § 2-3123, uniform commercial code

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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

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December 4, 2014

## **Navigating Patent Damages Part I: A Primer on the Failure to Mark Defense**

Navigating damages in patent cases is a complex exercise. In this series, beginning with the marking statute, we explore various nuances of damages analysis.

**TAGS:** american medical systems inc. v. medical engineering corp., apparatus claims, k&k jump startchargers inc. v. schumacher elec. corp., mark defense, marking requirements, maxwell v. j. baker inc., patent damages, patent infringement damages, patent litigation, statutory authority