

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

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

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

November 3, 2014

Half a year since Octane

By: Andrew Choung

It's been nearly half a year since the Supreme Court, in *Octane Fitness*, ostensibly lowered the standard for finding a patent case to be exceptional for purposes of fee-shifting. At the time, *Octane* generated much commentary and speculation, with some predicting a flood of fee awards and others predicting even more confusion at the district court level.

TAGS: attorneys' fees, fee-shifting, *Octane Fitness*, patent, Patent Law, Patent Litigation, Supreme Court

April 23, 2014

SimpleAir Wins a \$85 Million Jury Verdict Against Google

By: Rex Hwang

A Texas jury has awarded SimpleAir, Inc. \$85 million from Google for infringing the company's patent generally relating to transmitting Internet-based data to computers and mobile devices. Google's accused services included Google Cloud Messaging (GCM) and Android Cloud to Device Messaging (C2DM), which are used by Google to process and send notifications to handheld devices that run on Google's Android operating system.

TAGS: Google, Patent Law, Patent Litigation, SimpleAir
