

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

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

April 6, 2015

Will 101 lead to mutually assured destruction?

By: Andrew Choung

Although the Supreme Court's decision in *Alice Corp. v. CLS Bank International* has been hailed by some as an important development in the efforts to curb abusive patent litigation by non-practicing entities, others have raised concerns about unintended effects. For example, software companies have been particularly concerned about the long-term impact of *Alice* on the viability of patent protection for software. More generally, it is important to note that *Alice* is not limited to NPEs, but affects even competitor (B2B) disputes.

TAGS: *Alice Corp v CLS Bank International*, B2B, Hewlett-Packard Company, Hewlett-Packard Company v ServiceNow, Inc., ITSM, motions to dismiss, NPE, Patent Litigation, PTAB, ServiceNow, summary judgment based on patent

September 9, 2014

Emerging Impact of Inter Partes Review on Hatch Waxman Litigation - A Primer

By: Dan Liu

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

August 7, 2014

PTAB Issues First Precedential Opinion in an AIA Post-Grant Proceeding

By: Rex Hwang

PTAB Issues First Precedential Opinion in an AIA Post-Grant Proceeding

TAGS: AIA, CardinalCommerce, CBM, covered business method, infringement, patent, Patent Litigation, post-grant proceedings, precedential decision, PTAB, PTAB, SecureBuy, SecureBuy LLC v. CardinalCommerce Corp.

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. yellpages.com llc, motions to stay, patent case, patent litigation, pgr, post-grant patent proceedings, ptab
