Glaser Weil

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

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

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July 21, 2015

The "Oracle" Predicts It: Supreme Court Declines to Hear Landmark Software Copyright Case

The U.S. Supreme Court declined to grant certiorari in the case of Google, Inc. v. Oracle America, Inc., a closely watched case regarding the eligibility of software for copyright protection. The Supreme Court's decision leaves in place the Federal Circuit's landmark 2014 ruling, which held that Oracle was entitled to copyright protection for its application programming interfaces ("APIs"), which are "preset blocks of code that help developers write in Oracle's popular Java programming language."

TAGS: 35 u.s.c. § 101, computer software, copyright & idea theft, copyright infringement, eligibility of software for copyright protection, fair use doctrine, google inc v oracle america inc, intellectual property, merger doctrine, oracle america inc v. google inc, patent infringement, scenes a fair doctrine, trade secret & unfair competition, us supreme court, write of certiorari; supreme court

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June 10, 2015

No Suit For You! Changes to Patent Pleading Standard Issued By the U.S. Supreme Court Require More Than Bare Bones Pleading

In late April, the U.S. Supreme Court adopted changes to the Federal Rules of Civil Procedure which have significant implications for patent plaintiffs. In an April 29, 2015 order, the high court approved, without comment, changes initially approved by the Judicial Conference of the U.S. in September 2014. While these changes impact several different areas of civil litigation, they specifically impact patent litigation: unlike the previous edition of the Federal Rules, which allowed patent plaintiffs to "file bare-bone complaints," patent plaintiffs will soon be subject to the same heightened pleading standards required of plaintiffs in other types of civil litigation.

TAGS: ashcroft v iqbal, bell atl corp v twombly, federal court, form 18, frcp, intellectual property, model forms, model patent complaint, patent infringement, patent litigation, rule 84, us supreme court

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