

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 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 30, 2016

Freedom of Speech Protects “Disparaging” Marks, Federal Circuit Holds

By: Dan Liu

In a recent landmark ruling, the Federal Circuit, sitting en banc, held that Section 2(a) of the Lanham Act’s ban on “disparaging” marks violates the First Amendment.[1] Section 2(a) provides that no trademark shall be refused registration “unless it consists of or comprises . . . matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols[.]”[2] The majority found that the government’s prohibition of registration of disparaging marks “amounts to viewpoint discrimination, and under the strict scrutiny review, . . . is unconstitutional.”[3] It further concluded that such prohibition is unconstitutional even under the intermediate scrutiny review because the government offered no legitimate interests to justify such prohibition.[4]

TAGS: Federal Circuit, First Amendment, Intellectual Property, Intellectual Property, Lanham Act, Trademark & Trade Dress, Trademarks, USPTO

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

March 9, 2015

Not So Fast: Split Federal Circuit Panel Sided with PTO on Novel IPR Issues

By: Dan Liu

In *In re Cuozzo Speed Technologies, LLC*,[1] the first ever appeal of the final written decision from an inter partes review (“IPR”) before the Patent Trial and Appeal Board (“PTAB” or the “Board”),[2] the Federal Circuit decided two novel and fundamental questions arising under the newly enacted IPR proceedings created by the America Invents Act of 2011 (“AIA”). On both issues, the Federal Circuit agreed with the PTO,[3] holding (1) institution decisions by the Board are almost never reviewable on appeal, either interlocutory or after the Board’s final written decision, and (2) that the “broadest reasonable interpretation” standard is the proper standard for claim construction in IPR proceedings.[4]

TAGS: 542 u.s. 367 380 2004, aia, america invents act of 2011, block v. cmtly nutrition inst., bri, broadest reasonable interpretation, cheney v. us district court for the dc, claims construed under the broadest reasonable interpretation standard, federal circuit, in re cuozzo speed technologies, inter partes review, ipr, judge newman, patent litigation, pto, section 316d1, uspto

July 31, 2014

A “Giant” Decision: Trademark Trial and Appeal Board Denies Registration of “G-Men” to the New York Giants

It’s not just the Redskins anymore! Following the cancellation of the Redskins trademark earlier this summer, the Trademark Trial and Appeal Board has issued another football related decision regarding the New York Giants’ trademark of their commonly used nickname, the “G-Men.”

TAGS: g-men, intellectual property, new york giants, redskins, trademark, trademark & trade dress, ttab, uspto

July 9, 2014

The USPTO's Response to Alice Corp. v. CLS Bank

By: Dan Liu

Six days after the Supreme Court handed down its opinion in Alice Corp. v. CLS Bank, which invalidated certain patents disclosing “a computer-implemented scheme for mitigating ‘settlement risk,’” the USPTO issued its own Preliminary Examination Instructions. (An overview of the Alice Corp. decision can be found [here](#).)

TAGS: Alice Corp., CLS Bank, Mayo Collaborative Services, Patent Litigation, Prometheus Laboratories, USPTO