

IP MARKETPLACE

Finnegan's monthly update on developments affecting licensing and other IP transactions

December 2015

Laches Remains a Viable Defense for Unreasonable Delay in Suing for Patent Infringement

by John C. Paul, D. Brian Kacedon, and Xiaoxiao Xue

Despite a recent Supreme Court case denying a laches defense for unreasonable delay in suing for copyright infringement, the Federal Circuit held that laches remains a viable defense for unreasonable delay in suing for patent infringement. The court also held that a laches defense for unreasonable delay in suing can prevent a permanent injunction but does not preclude an ongoing royalty, absent extraordinary circumstances.

Pattern of Nuisance–Value Settlements, Failure to Disclose Material Prior Art, and Uncooperativeness in Settlement Results in Award of Attorney's Fees

by John C. Paul, D. Brian Kacedon, and Laith Abu-Taleb

In considering the totality of the circumstances, a Maryland court recently deemed a case "exceptional" and awarded attorney's fees against a company that displayed a pattern of threatening or instituting litigation to induce nuisance-value licenses or settlements, delayed disclosure to the USPTO of material prior art in its possession, and exhibited questionable litigation conduct, including being uncommunicative and uncooperative in the face of its opponent's reasonable attempts to conclude the dispute and making spurious arguments to avoid paying costs or fees. The court also found that the patent owner's dissolution did not shield it from paying the award of attorney fees, noting that the terminated entity continues to survive for purposes of the action until all judgments, orders, and decrees have been fully executed.

Amazon Not Liable for Patent Infringement When Other Companies Sell Infringing Products on Amazon's Website

by John C. Paul, D. Brian Kacedon, and Sonja W. Sahlsten

A Washington court recently held that Amazon was not liable



Patent App[eals]®
Click here to download

Patent App[eals]® includes PDFs of all patent-related Federal Circuit decisions dating back to 2001. A user can search on keywords, judges, dates of decisions, lower court from which the case was appealed, case name, case number, and whether or not a case was heard en banc. In addition, if the decision was summarized for [Federal Circuit IP blog](#), the Finnegan case summary is included.




for patent infringement when other companies sold infringing goods on Amazon's website because it found that Amazon itself did not offer to sell infringing goods or engage in any other infringing acts.

The International Trade Commission Has No Authority to Prevent Infringing Digital Data Files From Being Electronically Imported Into the United States

by John C. Paul, D. Brian Kacedon, and Robert C. MacKichan III

In a split 2-1 panel decision, the Federal Circuit ruled that the International Trade Commission's jurisdiction to remedy unfair acts involving the importation of "articles" extends only to material things, and that it could not block the electronic importation of digital data files used to manufacture orthodontic appliances in the United States.

FINNEGAN

Follow us on   

DISCLAIMER: The information contained herein is intended to convey general information only and should not be construed as a legal opinion or as legal advice. The firm disclaims liability for any errors or omissions and readers should not take any action that relies upon the information contained in this newsletter. You should consult your own lawyer concerning your own situation and any specific legal questions. This promotional newsletter does not establish any form of attorney-client relationship with our firm or with any of our attorneys.

If you have any questions or need additional information, please contact:

John C. Paul, Editor
D. Brian Kacedon, Editor
Robert D. Wells, Editor
Christopher L. McDavid, Editor

Finnegan Resources

Finnegan publishes newsletters, blogs, and *IP Updates* that provide news, statistics, and analysis of recent court decisions. Our newsletters and blogs focus on Federal Circuit IP blog, PTAB practice, trademark and copyright law, patent prosecution and counseling, and IP licensing. To sign-up to receive newsletters, blog posts, or *IP Updates*, please click here.

Atlanta • Boston • London • Palo Alto • Reston • Seoul • Shanghai • Taipei • Tokyo • Washington, DC

www.finnegan.com

Copyright © 2015 Finnegan, Henderson, Farabow, Garrett & Dunner, LLP | All rights reserved