

# IP MARKETPLACE

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

## July 2015

### **Patent Owners Cannot Use a Reissue Proceeding to Redefine the Scope of a Patent's Original Claims After a Court Makes an Unfavorable Claim Construction**

by John C. Paul, D. Brian Kacedon, and Kelly Lu

The Federal Circuit recently found that certain patent claims reissued by the U.S. Patent and Trademark Office were invalid in view of the Court's earlier claim construction of the patent's original claims. The patent owner argued that the successful prosecution of the reissued patent claims served as new evidentiary proof that the Federal Circuit's earlier construction of a claim limitation was wrong. However, the Federal Circuit held that the reissued claims could not be used to redefine the scope of the earlier-adjudicated original claims.

### **An Application to Reissue a Patent May Prevent a Preliminary Injunction**

by John C. Paul and D. Brian Kacedon

An Arizona court recently denied a request for a preliminary injunction, finding that the accused infringer established a substantial question about the patent's enforceability because the patent owner filed a reissue patent application characterizing a recent U.S. Supreme Court decision, as "cast [ing] doubt" on the enforceability of its patent.

### **Court Excludes Testimony that Bases Reasonable-Royalty Damages on Unreliable Data and Includes Unpatented Product Features in the Royalty Base**

by John C. Paul, D. Brian Kacedon, and Jerry Zang, Ph.D.

A Florida court recently excluded from evidence an expert's opinions on reasonable-royalty patent-infringement damages to the extent the expert failed to calculate his asserted royalty rate using data pertinent to the patents-in-suit and to limit the royalty base to the value of the patented feature.

### **A Retroactive Agreement Cannot Revive a Licensee's Lawsuit that Failed to Join the Patent Owner**

by John C. Paul, D. Brian Kacedon, and Cara Regan Lasswell

In patent-infringement litigation, a licensee will only have standing to sue without joining the patent owner if it is an exclusive licensee and it holds all substantial rights in the patent. The Federal Circuit recently held that an exclusive licensee who did not hold all substantial rights in the patent at the time it filed its patent infringement suit did not have

## Events

U.S. Patent Litigation Training Program for Asian Corporations  
September 14-18, 2015



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standing to bring suit without the patent owner and could not cure the standing defect through a retroactive license agreement. The licensee's only remedy was to join the patent owner as a co-plaintiff. Because it did not do so prior to the jury's verdict, the Federal Circuit found the licensee lacked standing and vacated the jury's verdict of infringement, with instructions that the case be dismissed.

### **Court Grants Stay of Entire Case Involving 11 Patents While Patent Office Conducts Inter Partes Review Proceedings on Two of the Patents**

*by John C. Paul, D. Brian Kacedon, and Matthew J. Luneack*

A Massachusetts court recently granted a motion to stay an infringement litigation involving 11 patents pending the outcome of inter partes review proceedings of two of the 11 asserted patents. Although the court acknowledged that a stay would not eliminate the need for a trial, the court found that a stay would simplify or streamline issues for trial because the case was still in its infancy; the 11 patents shared similar inventive disclosures; and the patent owner, a non-practicing entity, identified no specific prejudice that would result from a stay.

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