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

November 2015

Expert May Calculate Patent Infringement Damages Using Methods Not Previously Published or Peer-Reviewed

by John C. Paul, D. Brian Kacedon, and Andrew E. Renison

While economic experts can use various different methods to estimate the royalties an infringer would have reasonably paid for a license, the experts must use a reliable method, and the data they use must be tied to the facts of the case. The Federal Circuit recently upheld a jury verdict of $15 million in damages even though the damages expert used a method to calculate the damages that was not previously published or peer-reviewed.

Accused Infringer May Seek an IPR Despite Patent Owner's Inability to Raise an Assignor Estoppel Defense in the IPR

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

Recently, a patent owner argued it would be irreparably harmed if a district court did not bar the accused infringer from seeking IPR because it would be unable to raise assignor estoppel as a defense during IPR. The court refused to bar the IPR, finding the alleged irreparable harm too speculative and noting that multiple contingencies would need to occur before an IPR petition would injure the patent owner, including institution of IPR and determination of unpatentability.

Design Patent Owner May Recover Total Profits on the Entire Product—Not Limited to the Portion of the Infringing Product Subject to the Design

by John C. Paul, D. Brian Kacedon, and R. Benjamin Cassady

Under 35 U.S.C. § 284, infringers may be liable for lost profits or a reasonable royalty. A separate category of damages also exists for design patents. Under 35 U.S.C. § 289, entitled "[a] dditional remedy for infringement of design patent," infringers may be liable for total profits on sales of "any article of manufacture" that incorporate the patented design and are not limited to the portion of the infringing product subject to the design.

Supplier's Alleged Indirect Infringement by Practicing a Patent Standard Requires Evidence of Direct Infringement by Unlicensed Customer

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

Under the patent owner's infringement theory, use of the defendant's standards-compliant software with DVD or Blu-ray discs necessarily infringes the asserted patents because

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.

those patents are essential to playing, copying, and recording data on optical discs that comply with DVD or Blu-ray standards. The patent owner, however, is a member of two groups of licensing pools, which license the asserted patents for purposes of practicing DVD or Blu-ray standard specifications. Recognizing that licensees are not infringers, the Federal Circuit emphasized that the patent owner failed to present any specific allegations and evidence of direct infringement by customers by showing use of *unlicensed* discs and thus affirmed summary judgment of no indirect infringement by the provider of the standards-compliant software.

FINNEGAN

Follow us on

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.