

# IP MARKETPLACE

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

## February 2016

### **Court Refuses to Summarily Dismiss Patent-Infringement Claims Where Questions Exist As to Whether Some or All of a License Agreement Remains in Effect**

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

In *Seoul Laser Dieboard System Co., Ltd. v. Computerized Cutters, Inc.*, an action for breach of contract and patent infringement, accused infringer Computerized Cutters, Inc. (CCI) moved for summary judgment that it could not be sued for patent infringement. CCI argued that despite its termination of a license agreement with patent owner Seoul Laser Dieboard System Co., Ltd. (SDS), a survival provision in the agreement kept in force a covenant not to sue. The U.S. District Court for the Southern District of California, however, denied CCI's motion, finding the record incomplete and that questions remained concerning whether some or all of the license agreement continues in effect.

### **Further Awards of Interest, an Accounting, and Ongoing Royalties After a Jury Verdict May Depend on the Jury Instructions and the Court's Discretion**

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

A Nebraska court granted pre-judgment and post-judgment interest on a jury award for patent infringement but refused to order an accounting and ongoing royalties, finding the jury verdict already accounted for a reasonable royalty adequately compensating the plaintiff for past, present, and ongoing infringement of its patents.

### **Court Enforces Hand-Shake Deal in Mediation**

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

Agreements reached during court-appointed mediation are just as binding as court-sanctioned settlements. For example, the parties in a recent patent-infringement suit ostensibly reached a settlement during mediation, only for one party to recant days later. Giving weight to the neutral-mediator's view that a settlement had in fact been reached, the Court rejected

## Resources

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October 2015 – February 2016 Update

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the recanting party's about-face and sanctioned it for the additional fees and costs its actions forced its opponent to incur in enforcing the original agreement.

### **Damages May Be Awarded for Lost Sales Occurring After Patent Expiration**

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

A Michigan court recently rejected an accused infringer's motions seeking to foreclose recovery of post-expiration and future damages, ruling that post-expiration lost-profit damages are available under Supreme Court precedent and that the question of future patent damages, despite being inherently speculative, should go to the jury.

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