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

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Seller May Be Sued Outside Its Home State for Infringing Online Sales Through Amazon.com

by John C. Paul, D. Brian Kacedon, and Benjamin A. Saidman

A Massachusetts court found that it had jurisdiction to hear a patent and trademark infringement suit filed against a seller located in Washington because the seller purposefully directed activities at residents of Massachusetts through the national online retailer Amazon.com.

No Attorney Fees Awarded Despite Weak and Changing Positions and No Direct Evidence of Infringement

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

A Delaware court recently found that continuing to prosecute a patent infringement case without direct evidence of infringement and that had become weaker after several unfavorable evidentiary rulings did not render the case exceptional and worthy of requiring the losing party to pay the attorney fees of the prevailing party. The court found that parties should not be discouraged from presenting imperfect theories or dropping discredited positions out of a fear of being penalized for attorney fees, and that sanctions for attorney misconduct should be balanced against the ethical obligation of attorneys to zealously represent their clients.

Accused Infringer Must Disclose Foreign Sales Data in U.S. Patent Infringement Case

by John C. Paul, D. Brian Kacedon, and Daniel F. Klodowski

A New York district court recently held that a defendant's foreign sales figures for a product accused of patent infringement were discoverable, explaining that such data are potentially relevant to determining patent-infringement damages because, at a minimum, the data have implications for valuing the invention. In reaching its conclusion, the court rejected the defendant's argument that the discovery of foreign sales information is precluded by the presumption against extraterritoriality.

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Retroactive License from Sole Patent Owner Can Be Sub-Licensed

by John C. Paul, D. Brian Kacedon, and Kevin D. Rodkey

A New York district court recently held that a retroactive license agreement allowed a licensee to grant a retroactive sublicense to corporate subsidiaries. The court also found that product sales from a supplier to a sublicensed affiliate exhausted the patent owner's right to prevent the products from being resold through an unlicensed affiliate.

District Courts Increasingly Award Attorneys' Fees Based on Patentees' Unreasonable Positions and Vexatious Litigation Strategies

by John C. Paul, D. Brian Kacedon, and Benjamin A. Saidman

Following a Supreme Court ruling in 2014, district courts have awarded attorneys' fees to defendants in an increasing number of patent litigations. As one example, a district court in Texas recently awarded attorneys' fees to prevailing defendants finding the case "exceptional" because of the plaintiff's unreasonable positions and vexatious litigation strategy.

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