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

July 2016

Patent Eligibility Requires Claims to Specific Improvement of Computer Functionality: Patent Eligibility of Categorical Data Storage Claims Not Saved by Federal Circuit's *Enfish* Decision

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

Since the Supreme Court's decision in *Alice Corp. v. CLS Bank International*, courts have grappled with the scope of subject matter eligibility under § 101 of the Patent Act in determining whether the claimed subject matter is eligible for patent protection. In *Visual Memory v. Nvidia Corp.*, a district court analyzed the Federal Circuit's recent *Enfish* opinion on patent-eligibility, and concluded that claims directed to categorical data storage, which generically purported to improve computer functionality, failed to meet the threshold requirement for patent-eligibility.

Court Finds an Agreement Not-to-Sue is a Patent License Despite Language to the Contrary

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

A Minnesota court required a patent owner to provide the accused infringer with documents relating to an agreement after finding that the agreement was a patent license despite explicit language to the contrary.

Exclusive Field of Use Licensee Must Join Patent Owner to Sue for Patent Infringement

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

A District of Delaware court ruled that an exclusive licensee lacked standing to sue where the licensor retained a right to sue in its field of use. According to the court, Federal Circuit precedent dictates that holders of field of use licenses do not hold all substantial rights to the patent and therefore lack standing to sue. Accordingly, the court found that the patent infringement action should be dismissed unless the licensor was added as a plaintiff.

Attorney-Client Communications Can Be Privileged and Protected from Production Even When They Contain Discoverable Facts

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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.

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

Entire communications between attorneys and their clients can be protected by the attorney-client privilege even when they contain a mix of discoverable facts and privileged legal advice. While the attorney-client privilege does not extend to protect the underlying facts, a magistrate judge did not permit the underlying-facts exception to swallow the attorney-client privilege rule, and noted that the correct way to discover facts underlying a privileged communication would be by depositions or third-party subpoenas.

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