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

June 2016

Seeking Only a Reasonable Royalty for Past Infringement May Be a Factor that Prevents Injunctive Relief

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

A Texas court recently refused to enjoin the continued sales of infringing products, reasoning that a patent owner's request for a reasonable royalty for past infringement showed that a reasonable royalty—as opposed to an injunction—would be sufficient for any future continued infringement. In denying the permanent injunction, the court ordered the parties to negotiate an ongoing reasonable royalty for continued patent infringement.

Recent Federal Circuit Decision Broadening the Attribution Standard for Divided Infringement Results in Reinstatement of Infringement Claims

by John C. Paul, D. Brian Kacedon, and Robert C. MacKichan, III

In *Mankes v. Vivid Seats Ltd.*, the Federal Circuit considered a change in the law of divided patent infringement resulting from the Akami-Limelight series of cases. An *en banc* panel of the Federal Circuit in *Akami Techs. v. Limelight Networks* ("*Akami IV*") recently revisited the standards of direct divided-infringement, holding that steps of one entity could be attributed to another for purposes of finding infringement in a joint-enterprise setting or "when an alleged infringer conditions participation in an activity or receipt of a benefit upon performance of a step or steps of a patented method and establishes the manner or timing of that performance." Applying the broadened attribution standards of *Akami IV*, the Federal Circuit in *Mankes v. Vivid Seats Ltd.* reinstated the divided infringement claims and remanded to allow the plaintiffs to present additional facts related to attribution.

Infringers Seeking to Establish a Patent Marking Defense May Bear the Burden of Showing Unmarked Products are Covered by the Asserted Patents

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

A Florida court recently refused to limit a patent owner's damages recovery for failure of its licensee to mark the patent numbers on products that the accused infringer claimed practiced the patents as required under Section 287 of the Patent Act. The court held that the burden was on the defendant to prove compliance with the marking statute, and the defendant failed to prove that plaintiff's licensee sold unmarked products covered by the patents.

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Subsequent Clarifying Provision Does Not Cause Plain Language of License to Be Redundant or Permit It to Be Ignored

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

A California court recently overturned a jury's finding that Motorola was licensed under a Bluetooth Patent/Copyright License Agreement ("BPLA") as to certain patent claims asserted in an infringement action by Fujifilm. The court was not persuaded that a sentence defining the scope of the agreement could be ignored as redundant in view of a subsequent clarifying provision. Thus, the court held that the plain language of the agreement did not grant Motorola a license to the patent claims.

Company Principals Who Act as Litigation Counsel May Be Barred from Reviewing Confidential Information and From Prosecuting Patents

by John C. Paul, D. Brian Kacedon, and Robert D. Wells

A Delaware court recently barred a patent assertion entity's principals, who also acted as litigation counsel, from having access to an accused infringer's confidential information and from prosecuting patents for related technology.

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