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

October 2016

Enhanced Damages and Willful Infringement Depend on What the Infringer Knew at Time of Infringement

by John C. Paul, D. Brian Kacedon, and Danielle C. Pfifferling

In June, the Supreme Court in *Halo Electronics, Inc. v. Pulse Electronics, Inc.* rejected the "Seagate" test for enhancing patenting infringement damages as unduly rigid. On remand from the Supreme Court, the Federal Circuit vacated the district court's finding of no willful infringement made under the *Seagate* framework and directed the district court to reconsider whether enhanced damages were appropriate under the circumstances. The Federal Circuit directed the district court to focus on whether the patent infringer intentionally or knowingly infringed the patent considering what the infringer knew or had reason to know at the time of infringement.

Licensing Proposals May Be Used to Determine Reasonable Royalty Damages

by John C. Paul, D. Brian Kacedon, and Rhianna L. Lindop, Ph.D.

A District Court in Florida permitted licensing proposals to be used as a basis to calculate reasonable royalty damages when the expert reasonably explained and supported the methodology and calculations by comparing the technological and commercial circumstances at the time of licensing proposals to those at the time of the hypothetical negotiations.

Expert Opinion on Reasonable Royalty Based on Prior Settlement Agreement Must Depend on Facts of the Case Rather than Generic Statistics

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

A Delaware court recently excluded an expert's damages opinion estimating a reasonable royalty based on generic statistics rather than the specific facts of the case. Though the expert considered the royalty rate of a license in a prior settlement agreement for the asserted patent, the court faulted his opinion on translating the royalty rate in that past license his opinion on the amount of a reasonable royalty in

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the present case for failing to consider the particular facts of the present case, such as the nature of the asserted patent, the accused products, and the litigation strategy of the parties.

License Defense Is Waived Due to Unjustified Delay and Prejudice

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

A Texas court recently held that an infringer waived a license defense that components in the accused products were supplied by a licensed supplier by failing to raise the defense sufficiently before trial to allow the patent owner to respond to the defense, take discovery on the issue, file briefings with the court, and hold a hearing if necessary.

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