

IP MARKETPLACE®

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

April 2017

[Most-Favored-Licensee Provision Did Not Provide a License to Newly-Acquired Patents or Patents that Did Not Trigger the Provision](#)

by [John C. Paul](#), [D. Brian Kacedon](#), and [Matthew J. Luneack](#)

The Federal Circuit found a license agreement's "most-favored licensee" provision, that could be triggered by assertion of patents that were otherwise not addressed in the remainder of the license agreement, only applied to patents owned by the licensor at the time of the agreement and provided a future license only to such patents that triggered the provision.

[Legal Advice on Patent Strength and Enforceability May Be Shared During Acquisitions and Licensing Negotiations Without Waiving Attorney-Client Privilege](#)

by [John C. Paul](#), [D. Brian Kacedon](#), and [Danielle C. Pfifferling](#)

Under the "common-interest doctrine," attorney-client communications regarding patent strength, prosecution, licensing, and enforceability may remain privileged from discovery during litigation even when shared between companies involved in negotiating an exclusive patent license or acquisition of the patents.

[Sovereign Immunity May Allow Research Institutions at State Universities to Avoid Patent Validity Challenges at the Patent Office](#)

by [John C. Paul](#), [D. Brian Kacedon](#), and [Hala S. Mourad](#)

The Patent Trial and Appeal Board determined that a state's sovereign immunity provided by the Eleventh Amendment barred an inter partes review proceeding from being instituted against a research foundation of a state university that had not waived its sovereign immunity.

[No Laches Defense of "Unreasonable Delay" for Patent Infringement Suits Brought Within Six-Year Limitation Period](#)

by [John C. Paul](#), [D. Brian Kacedon](#), and [Kevin D. Rodkey](#)

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Resources

[Standard-Essential Patents and Pooling Update](#)

January - March 2017 Update

Events

[Webinar: Internet of Things: Patent Liability, Enforcement, and Licensing](#)

May 4, 2017

[Register](#) by May 3, 2017

[Best Practices in Licensing: Developing, Negotiating & Executing Transactions](#)

Washington, DC

May 8-9, 2017

[LES Asia Pacific Conference](#)

Melbourne, Australia

May 9-12, 2017






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Patent App[ears]® 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.

The U.S. Supreme Court found that patent infringement claims brought within the six-year statute of limitations may not be barred for unreasonable delay under the equitable defense of laches.

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