

SUPREME COURT YEAR IN REVIEW: 2014-2015 TERM

MIPLA STAMPEDE, MAY 18, 2015

Scott Eidson and Katie Moerke

WWW.STINSONLEONARD.COM



REVIEW: 2013-2014 TERM

- *Alice v. CLS* – subject matter ineligibility
- *Nautilus v. Biosig* – indefiniteness
- *Limelight v. Akamai* – inducement (divided infringement)
- *Highmark v. Allcare* – attorney fees
- *Octane v. Icon* – attorney fees
- *Medtronic v. Boston Scientific* – infringement burden in DJ actions
- *Petrella v. Metro-Goldwyn-Mayer* – laches in copyright suit – post 2014 MIPLA Stampede
- *ABC v. Aereo* – copyright infringement – post 2014 MIPLA Stampede

2014-2015 TERM

- *Teva Pharmaceuticals v. Sandoz* - claim construction (patent)
- *Hana Financial v. Hana Bank* – priority determination (trademark)
- *B&B Hardware v. Hargis* – issue preclusion (trademark)
- *Kimble v. Marvel* – patent misuse
- *Commil v. Cisco* – defense to inducement (patent)
- *Google v. Oracle* – copyright protection
- *Consumer Watchdog v. WARF* – One that got away?

PETRELLA V. METRO-GOLDWYN-MAYER

Issue: Laches

PETRELLA V. METRO-GOLDWYN-MAYER

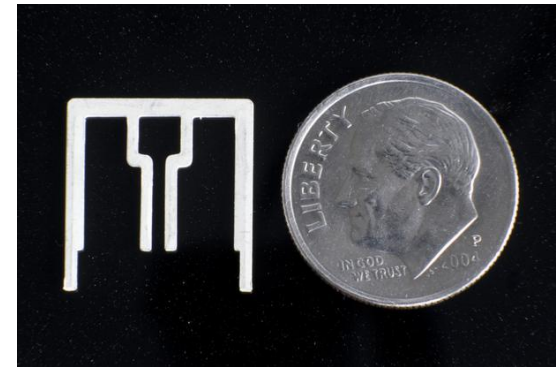
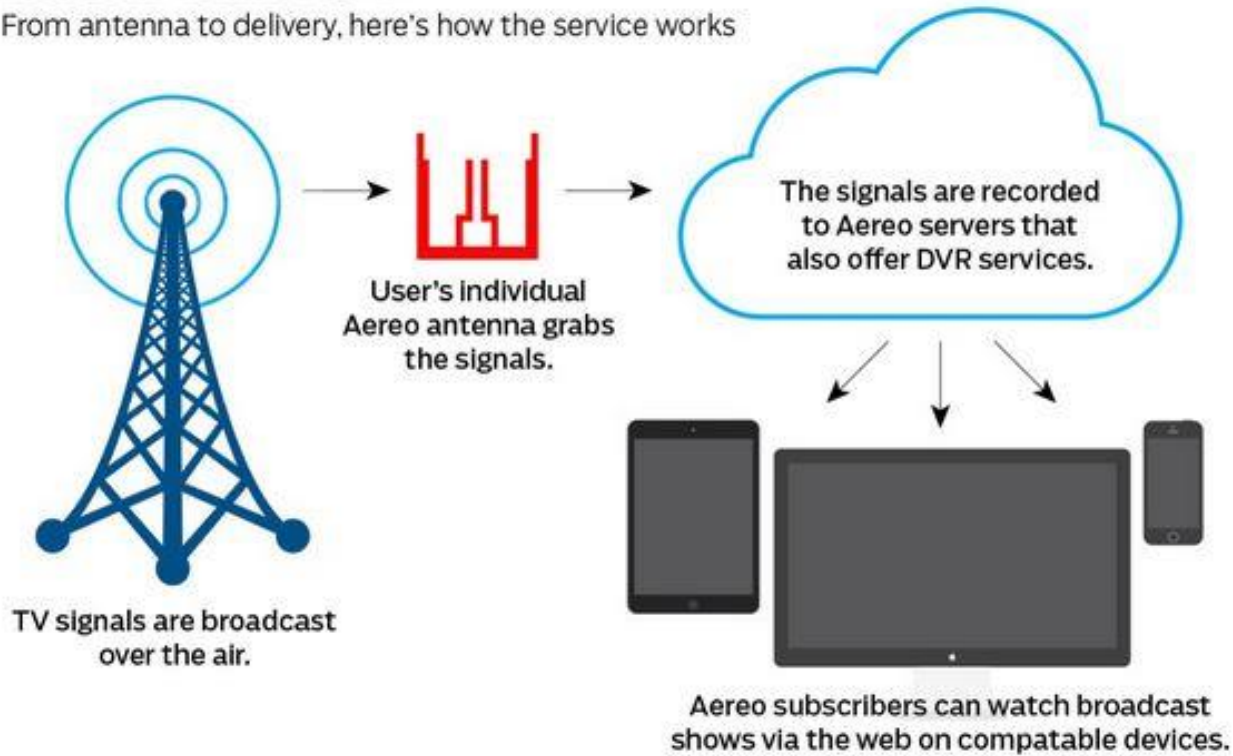
- Decided May 19, 2014
- Issue: Whether laches may bar relief on a copyright infringement claim brought within three-year period in 17 U.S.C. Section 507(b)?
- Holding: No, laches cannot be invoked to preclude adjudication brought within the 3-year statutory period.

ABC V. AEREO

Issue: Copyright Infringement

Aereo: From A to D

From antenna to delivery, here's how the service works



Your Current Plan

- \$8/mo+tax**
 - **20 hours** of remote DVR storage
 - 1 remote antenna

- \$12/mo+tax**
 - record **2 shows** at once
 - watch on multiple devices simultaneously
 - save **60 hours** of programming to a remote DVR

Best Deal

ABC V. AEREO

- Decided June 25, 2014
- Issue: Whether the “exclusive righ[t]” to “perform the copyrighted work publicly” in 17 U. S. C. §106(4) is infringed by selling subscribers a technologically complex service that allows them to watch television programs over the Internet at about the same time as the programs are broadcast over the air.
- Holding: Yes, this is infringement.

2014-2015 TERM

TEVA PHARMACEUTICALS V. SANDOZ

Issue: Claim Construction

TEVA PHARMACEUTICALS V. SANDOZ

- Decided January 20, 2015
- Issue: What standard should the Federal Circuit use when it reviews a district court's resolution of an underlying factual dispute in claim construction?
- Holding: Clear error, not de novo, standard of review for findings of fact.
- Rationale: Fed. R. Civ. P. 52(a)(6).
- The ultimate interpretation of patent claims remains de novo.

TEVA PHARMACEUTICALS V. SANDOZ

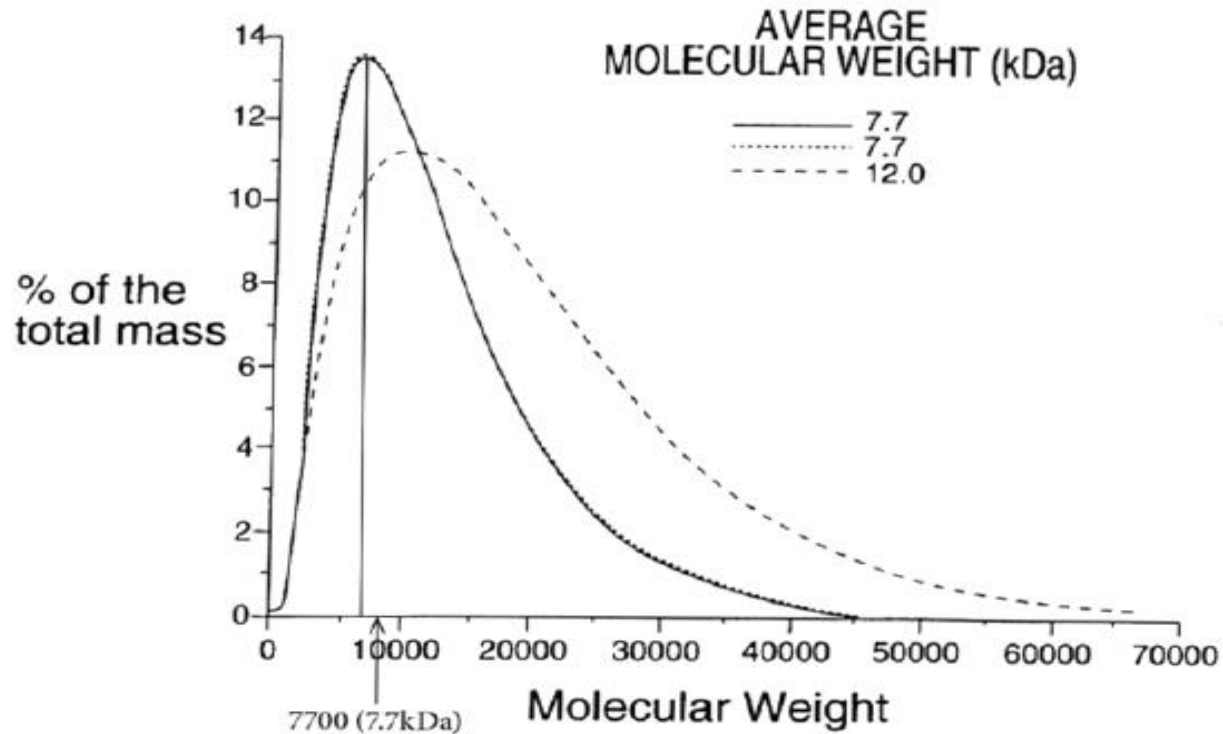


FIG. 1 (with minor additions to emphasize that the peak of the solid curve does not correspond precisely to 7.7kDa)

TEVA PHARMACEUTICALS V. SANDOZ

- “why?” answered, then “how?”
- If only intrinsic evidence (i.e., patent and prosecution history) considered, only determination of law with de novo review.
- If extrinsic evidence, district courts must make subsidiary factual findings.
- These factual findings must be in “clear error” to be overturned.
- And even if such factual findings are “nearly dispositive,” they do not become legal questions.

TEVA PHARMACEUTICALS V. SANDOZ

- Impact (intended): fewer reversals of district court claim constructions.
- Broader theme: patent law is not special.
- Question: if patents are more like contracts than statutes—does this matter for other patent issues?

2014-2015 TERM

HANA FINANCIAL V. HANA BANK

Issue: Trademark Tacking, for the Jury?



vs.



Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 1,987,227

Registered July 16, 1996

SERVICE MARK
PRINCIPAL REGISTER



Hana Financial



HANA FINANCIAL V. HANA BANK

- Decided January 21, 2015
- Issue: Whether the jury or the court determines whether use of an older mark may be tacked to a newer one.
- What is Tacking? To own a trademark, one must be the first to use it; the first to use a mark has 'priority.' The trademark 'tacking' doctrine permits a party to 'tack' the use of an older mark onto a new mark for purposes of determining priority, allowing one to make slight modifications to a mark over time without losing priority. Trademark tacking is available where the two marks are 'legal equivalents.'
- Holding (unanimous): **Jury**. "when a jury trial has been requested and when the facts do not warrant entry of summary judgment or judgment as a matter of law, whether tacking is warranted must be decided by a jury."

2014-2015 TERM

B&B HARDWARE V. HARGIS

Issue: Issue Preclusion

B&B HARDWARE V. HARGIS

Sealtight® Is:

- LEAKPROOF
- REUSEABLE
- BEST IN ITS CLASS

EVERY HEAD STYLE

Sealtight® The High Tech Leader



B&B HARDWARE V. HARGIS

- Decided January 20, 2015
- Issue: Should the District Court have applied issue preclusion to the TTAB's decision that a trademark is confusingly similar to another trademark?
- Holding: A court should give preclusive effect to TTAB decisions—if the ordinary elements of issue preclusion are met.
- I.e., preclusion sometimes, not never.
- Impact: More caution in TTAB proceedings? More preclusion arguments in court?

KIMBLE V. MARVEL

Issue: Royalties on Expired Patents

KIMBLE V. MARVEL

Legal Framework:

- [B]ecause royalty payments under the parties' contract extended undiminished beyond the expiration date of the assigned patent, Respondent's obligation to pay was excused under *Brulotte v. Thys Co.*, 379 U.S. 29, 32 (1964), which had held that 'a patentee's use of a royalty agreement that projects beyond the expiration date of the patent is unlawful *per se*.'

U.S. PATENT NO. 5,072,856

United States Patent [19]
Kimble

[11] Patent Number: 5,072,856
[45] Date of Patent: Dec. 17, 1991

[54] TOY WEB-SHOOTING GLOVE
[76] Inventor: Stephen E. Kimble, 2607 N. Wilson Ave., Tucson, Ariz. 85719
[21] Appl. No.: 528,419
[22] Filed: May 25, 1990
[51] Int. Cl.⁵ B67D 5/64
[52] U.S. Cl. 222/78; 222/175; 222/402.25; 2/160; 239/529; 446/475
[58] Field of Search 2/159, 160, 161 R, 161 A, 2/16; 42/1.11, 54; 109/29, 32; 239/211, 289, 375, 529; 272/27 W, 27 N; 273/349; 446/26, 475, 473, 483; 222/192, 175, 78, 79, 74, 75, 635, 394, 402.23, 402.25, 405

4,214,674 7/1980 Jones et al. 222/79
4,286,407 9/1981 Adickes, Jr. et al. 222/215 X
4,768,681 9/1988 Dean et al. 222/175 X
4,848,246 7/1989 Rosen 109/25
4,890,767 1/1990 Burlison 222/78
4,903,864 2/1990 Sirhan 222/78
4,997,110 3/1991 Swenson 222/175

Primary Examiner—Kevin P. Shaver
Assistant Examiner—Kenneth DeRosa
Attorney, Agent, or Firm—Antonio R. Durando; Harry M. Weiss

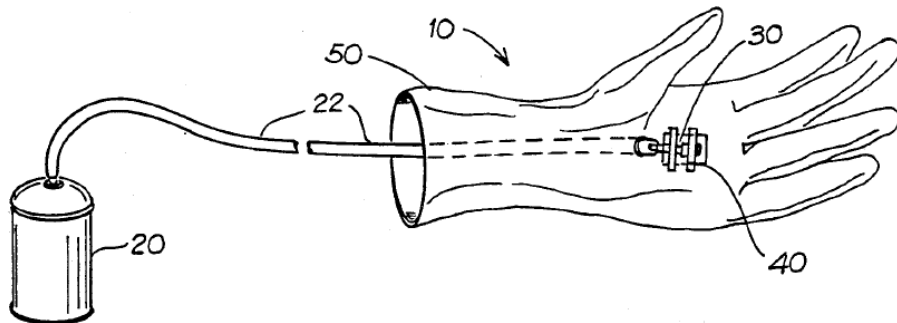
[57] ABSTRACT

The combination of known components to produce a new toy shooting apparatus. A toy that makes it possible for a player to act like a spider person by shooting webs from the palm of his or her hand. The webbing material consists of string foam delivered from a hidden pressurized container through a valve incorporated into a glove worn by the player. A trigger mechanism enables the player to activate the valve at will by the exercise of pressure with the fingers of the hand wearing the glove.

[56] References Cited
U.S. PATENT DOCUMENTS

1,177,412 3/1916 Hopkins 239/529
1,534,208 4/1925 Gibson 239/529 X
1,885,180 11/1932 Cameron 222/175
2,192,082 2/1940 Hunicke 222/175
3,445,046 5/1969 Wilson 224/26
3,523,645 8/1970 Beauchamp 239/154
3,945,571 3/1976 Rash 239/152
4,037,790 7/1977 Reiser et al. 239/529

20 Claims, 1 Drawing Sheet



STINSON
LEONARD
STREET

KIMBLE V. MARVEL

- Issue: Whether the Court should overrule *Brulotte v. Thys Co.*, which held that “a patentee’s use of a royalty agreement that projects beyond the expiration date of the patent is unlawful *per se*.”
- Holding: ?
- Argument: March 31, 2015
- Potential impact: Greater flexibility in licensing.

COMMIL V. CISCO

Issue: Inducement Defense

COMMIL V. CISCO



US006430395B2

(12) **United States Patent**
Arazi et al.

(10) **Patent No.:** US 6,430,395 B2
(45) **Date of Patent:** Aug. 6, 2002

(54) **WIRELESS PRIVATE BRANCH EXCHANGE (WPBX) AND COMMUNICATING BETWEEN MOBILE UNITS AND BASE STATIONS**

(75) Inventors: **Nitzan Arazi**, Ramat Hasharon; **Yaron Soffer**, Nes-Ziona; **Haim Barak**, Kfar Saba, all of (IL)

(73) Assignee: **Commil Ltd.**, Ramat Hasharon (IL)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: **09/784,109**

(22) Filed: **Feb. 16, 2001**

Related U.S. Application Data

(60) Provisional application No. 60/195,219, filed on Apr. 7, 2000, and provisional application No. 60/208,306, filed on Jun. 1, 2000.

(51) **Int. Cl.⁷** **H04B 5/00**

(52) **U.S. Cl.** **455/41; 455/426; 455/432; 455/562; 370/347; 370/466**

(58) **Field of Search** **455/555, 561, 455/560, 41, 436, 554, 426, 562, 446, 449, 432, 557, 502; 370/331, 347, 466, 467, 469; 709/268, 223**

(56) **References Cited**

U.S. PATENT DOCUMENTS

5,353,331 A	10/1994	Emery et al.
5,469,496 A	11/1995	Emery et al.
5,506,887 A	4/1996	Emery et al.
5,579,379 A	11/1996	D'Amico et al.
5,610,972 A	3/1997	Emery et al.
5,664,008 A	9/1997	Emery et al.
5,734,699 A	3/1998	Lu et al.
5,758,281 A	5/1998	Emery et al.
5,818,824 A	10/1998	Lu et al.
5,845,211 A	12/1998	Roach

5,887,256 A	3/1999	Lu et al.
5,896,375 A *	4/1999	Dent et al. 370/347
5,911,120 A	6/1999	Jarett et al.
5,913,163 A	6/1999	Johansson
5,960,344 A *	9/1999	Mahany 455/432
5,999,813 A	12/1999	Lu et al.
6,005,856 A	12/1999	Jensen et al.
6,011,975 A	1/2000	Emery et al.
6,021,138 A	2/2000	Lee
6,047,177 A	4/2000	Wickman
6,058,106 A	5/2000	Cudak et al.
6,069,588 A	5/2000	O'Neill
6,163,546 A *	12/2000	Sipila 370/466
6,175,860 B1 *	1/2001	Gaucher 709/208
6,226,515 B1 *	5/2001	Pauli et al. 455/426

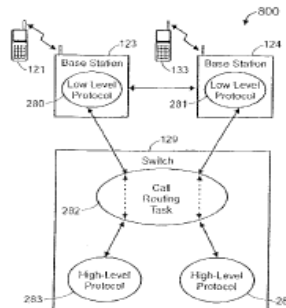
* cited by examiner

Primary Examiner—Tracy Legree
(74) *Attorney, Agent, or Firm*—Mark M. Friedman

(57) **ABSTRACT**

Methods to create a cellular-like communication system, such as a Wireless Private Branch Exchange (WPBX), which includes mobile devices such as standard cordless phones (handsets), particularly, mobile devices utilizing the Bluetooth short-range wireless communication protocol. The methods provide seamless and reliable handoff of sessions between Base Stations while the mobile device is moving between picocells, by implementing a high-level of synchronization between the Base Stations and the Switch. Base Stations of picocells having small coverage areas communicate with the handsets. The communication protocol is divided into a low-level protocol performed by the Base Stations and a high-level protocol performed by the Switch connected to all the Base Stations. The methods support mobile computing or telephony devices and communication protocols, which are not specified to handle handoffs of sessions while moving between Base Stations coverage areas in a data, voice or telephony wireless network.

12 Claims, 24 Drawing Sheets



COMMIL V. CISCO

- Issue: Is a good faith belief that a patent is invalid a defense to inducement?
- Holding: ?
 - Parallel to rule that good-faith belief in non-infringement is evidence of lack of intent for inducement.
 - But undermines enforcement of patent rights.
 - But *Global Tech.* held that “induced infringement . . . Requires knowledge that the induced acts constitute patent infringement.”
- Argument: March 31, 2015

2014-2015 TERM

GOOGLE V. ORACLE

Issue: Reach of Copyright Protection

PREVIEW: GOOGLE V. ORACLE

- Issue: Whether copyright protection extends to all elements of an original work of computer software, including a system or method of operation, that an author could have written in more than one way.
- Holding: ?
- Argument: ?
- Petition for a writ of certiorari filed on October 6, 2014.
- Solicitor General invited to file a brief on January 12, 2015.

THE ONE THAT GOT AWAY?

CONSUMER WATCHDOG V. WARF

Issue: Appeal of PTAB PGRDecisions

ONE THAT GOT AWAY?

CONSUMER WATCHDOG V. WARF

- Issue: Does a statute that expressly provides a requester of agency action a right to appeal any dissatisfactory decision of the agency on her request to the courts provide sufficient Article III standing for the appeal, or must additional requirements be satisfied above and beyond the statute?
- Federal Circuit: **No standing.**
- Supreme Court: Petition denied.
- Problem: Because Consumer Watchdog suffered no injury, it lacked standing to appeal—despite rights granted by statute. **Public interest and non-competitive entities lose their statutory right to appeal a PTAB decision.**

WHERE IS OUR APPEAL?



SUPREME COURT YEAR IN REVIEW: 2014-2015 TERM

MIPLA STAMPEDE, MAY 18, 2015

Thank You

Scott Eidson: scott.eidson@stinsonleonard.com

Katie Moerke: katie.moerke@stinsonleonard.com

www.stinsonleonard.com

