



WITCON 2014

BANNER & WITCOFF'S CORPORATE
INTELLECTUAL PROPERTY SEMINAR

FRIDAY, SEPTEMBER 19, 2014
8:30 A.M. TO 4:30 P.M.
CHICAGO, ILLINOIS

Supreme IP: The Supreme Court Weighs in on IP Rights

Ross Dannenberg & Greg Israelsen



BANNER & WITCOFF, LTD.
INTELLECTUAL PROPERTY LAW

2013-2014 Supreme Court Term

- Patent Cases
 - Alice Corp. v. CLS Bank International
 - Nautilus, Inc. v. Biosig Instruments, Inc.
 - Medtronic, Inc. v. Mirowski Family Ventures, LLC
 - Limelight Networks, Inc. v. Akamai Technologies, Inc.
 - Octane Fitness, LLC v. Icon Health & Fitness, Inc.
 - Highmark, Inc. v. Allcare Health Management System, Inc.
- Copyright Cases
 - American Broadcasting Companies, Inc. v. Aereo, Inc.
 - Petrella v. Metro-Goldwyn-Mayer, Inc.



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2014-2015 Supreme Court Term

- Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.
- B&B Hardware v. Hargis Industries
- Hana Financial v. Hana Bank



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Alice Corp. v. CLS Bank International

- *Issue*: Statutory subject matter under 35 U.S.C. § 101
- *Subject*: Patent for mitigating settlement risk
- *Held*: Patent invalid for claiming “abstract idea”
- Courts to use two-step approach:
 - 1. Determine whether claims directed to patent-ineligible concept (e.g., abstract idea)
 - 2. Search for inventive concept



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Nautilus, Inc. v. Biosig Instruments, Inc.

- *Issue*: Definiteness under 35 U.S.C. § 112, ¶ 2
- *Subject*: Patent directed to heart-rate monitor
- *Held*: Court did not express opinion on these claims, but did articulate that “a patent is invalid for indefiniteness if its claims . . . fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention”



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Medtronic, Inc. v. Mirowski Family Ventures, LLC

- *Issue*: Burden of proof to show infringement in declaratory judgment action
- *Held*: Patentee's burden to show infringement
- Three legal propositions combine for result:
 - Burden of proof generally rests on patentee
 - Declaratory Judgment Act is only procedural
 - Burden of proof is a substantive aspect of a claim



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Limelight Networks, Inc. v. Akamai Technologies, Inc.

- *Issue:* Induced infringement under 35 U.S.C. § 271(b)
- *Subject:* Patent for content-delivery network
- *Held:* When no direct infringement has occurred, there is no induced infringement when “the performance of all the patent’s steps is not attributable to any one person”



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Octane Fitness, LLC v. Icon Health & Fitness, Inc.

- *Issue:* Attorney’s fees under Patent Act § 285
- *Subject:* District Court denied Octane’s request for fees
- *Held:* Courts may award fees in “exceptional cases.”
An “exceptional case” is one that stands out from others considering totality of circumstances.
Remanded for review using correct standard



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Highmark, Inc. v. Allcare Health Management System, Inc.

- (Argued together with Octane Fitness)
- *Issue*: Standard of review for fee awards under § 285
- *Held*: District court's award of fees is discretionary, so decision is to be reviewed on appeal for abuse of discretion. Remanded for review using correct standard



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American Broadcasting Companies, Inc. v. Aereo, Inc.

- *Issue*: Public performance under Copyright Act
- *Subject*: Aereo's system allocated a single antenna to a single user to use during a live broadcast
- *Held*: Aereo's system infringed public performance right. Reasoned that Congress would have intended to cover Aereo as much as cable companies



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Petrella v. Metro-Goldwyn-Mayer, Inc.

- *Issue:* Applicability of laches to copyright claims
- *Subject:* Copyright holder waited until infringing film was profitable before bringing suit
- *Held:* Claim was not barred by laches when only seeking damages for past 3 years
 - Congress established a three-year statute of limitations to sue for copyright infringement
 - That regime left “little place” for further limits



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2014-2015 Supreme Court Term

- **Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.**
 - The appropriate standard for reviewing a district court's factual findings during claim construction
- **B&B Hardware v. Hargis Industries**
 - Whether TTAB's finding of likelihood of confusion precludes a respondent from relitigating that issue
- **Hana Financial v. Hana Bank**
 - Who (judge or jury) determines trademark tacking



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Questions?

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