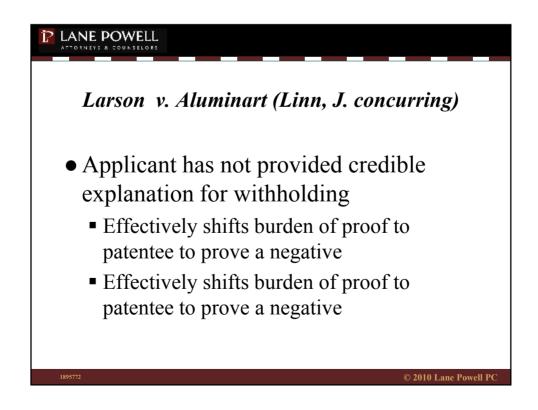
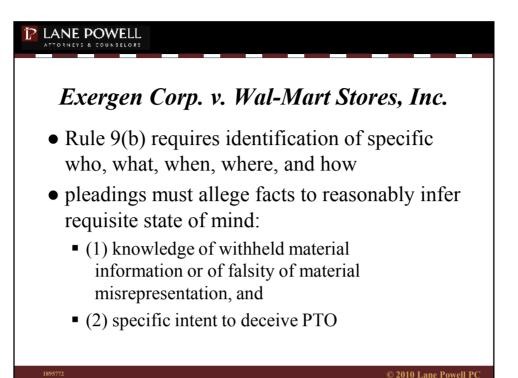


### 

### Larson v. Aluminart (Linn, J. concurring)

- Highly material information is withheld
  - Repeats materiality requirement
  - Inconsistent with principle that materiality and intent are separate elements
- Applicant knew of information and knew/should have known of materiality
  - Negligence standard rejected by Kingsdown
  - If highly material, leads fact-finder to concluded that applicant should have known





# Avid Identification Sys., Inc. v. The Crystal Import Corp.

- precursor product disclosed at trade show highly material to patentability
- to have a duty to disclose information to PTO, individual must

- (1) be associated with filing and prosecution of patent application such that he owes a duty of candor to PTO, and

- (2) know that information in question is material

© 2010 Lane Powell PC

### TTORNEYS & COUNSELORS

# Avid Identification Sys., Inc. v. The Crystal Import Corp., cont.

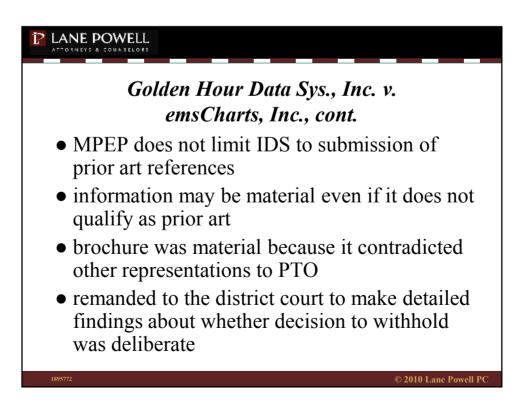
- "substantively involved"
  - content of application or
  - decisions related to content of app
  - not wholly administrative or secretarial in nature
- Court should consider
  - nature of individual's position
  - size of company
  - relationship with patent inventors

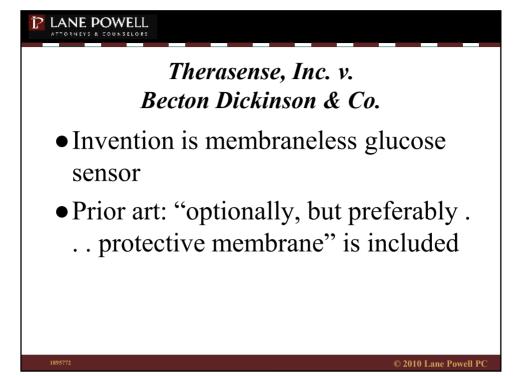
# **CONTACT OF CONTACT OF CONTACT**

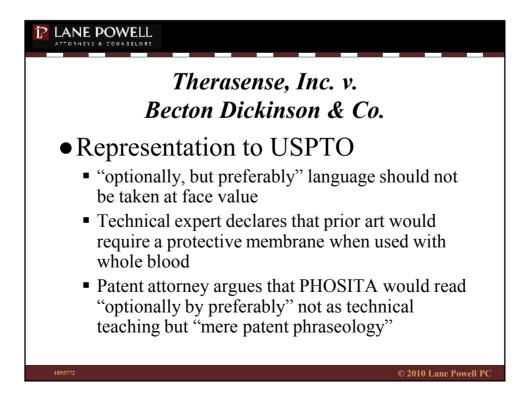
# Golden Hour Data Sys., Inc. v. emsCharts, Inc., cont.

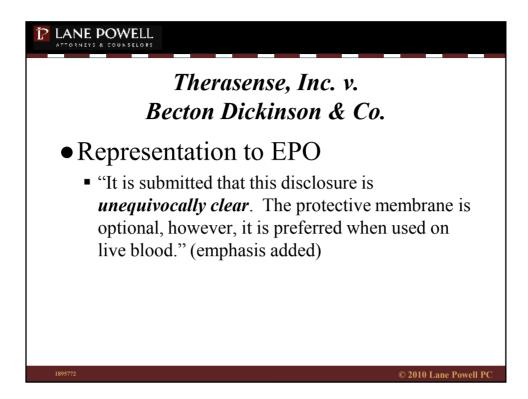
🍞 LANE POWELL

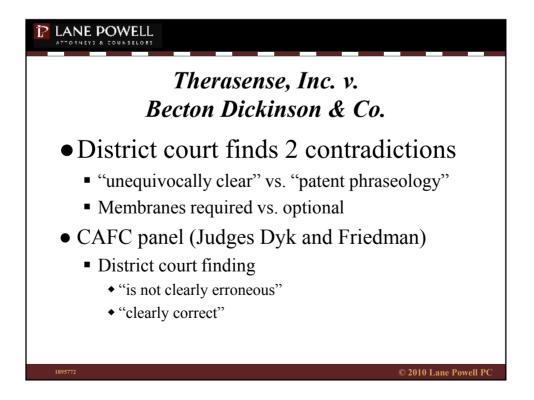
• MPEP section 609 instructs examiners not to consider references included in an IDS which do are not "identified by publisher, author (if any), title, relevant pages of the publication, *date,* and place of publication."







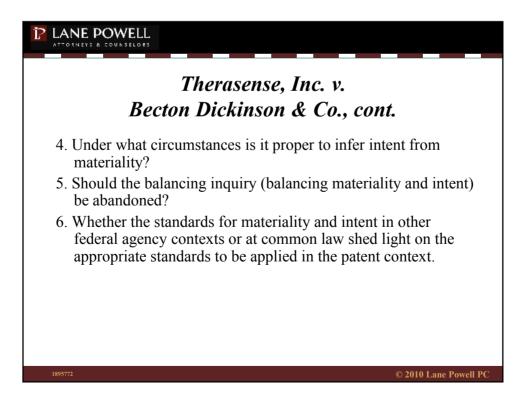


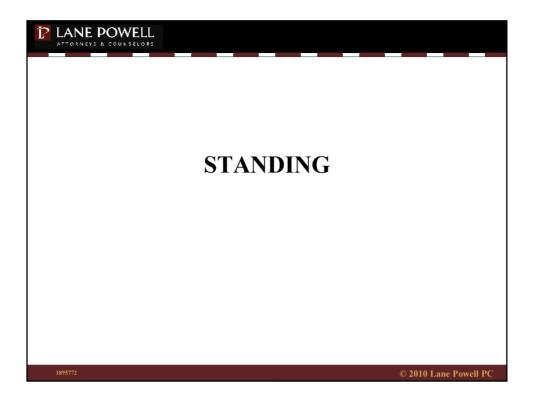


# Therasense, Inc. v. Becton Dickinson & Co.

• CAFC requested briefing on six questions:

- 1. Should the materiality-intent-balancing framework for inequitable conduct be modified or replaced?
- 2. If so, how? In particular, should the standard be tied directly to fraud or unclean hands? If so, what is the appropriate standard for fraud or unclean hands?
- 3. What is the proper standard for materiality? What role should the United States Patent and Trademark Office's rules play in defining materiality? Should a finding of materiality require that but for the alleged misconduct, one or more claims would not have issued?

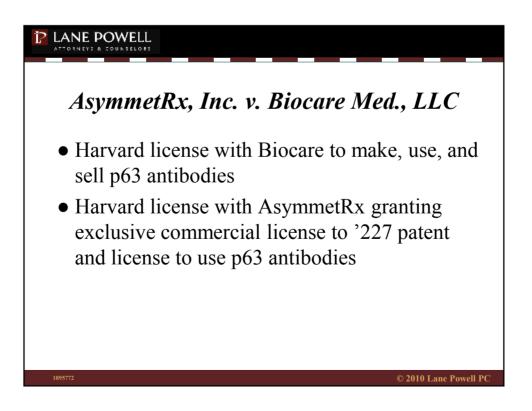




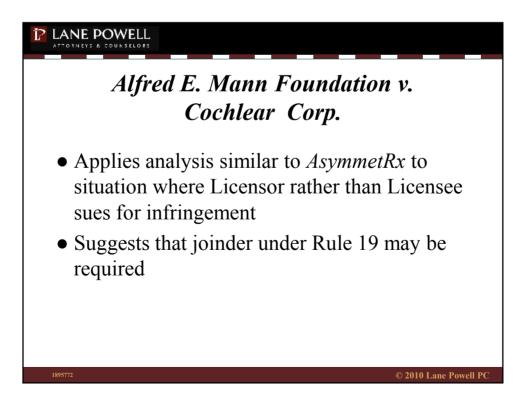


# Bd. of Trustees of Stanford University v. Roche Molecular Sys., Inc., cont'd

- "agree to assign" reflects mere promise to assign rights in the future, not immediate transfer of expectant interests
- "do hereby assign" effects a present assignment of future inventions
- Make clear to researchers that they must obtain approvals for all collaborations to allow research organization to negotiate with potential collaborators







### TTORNEYS & COUNSELOPS

# Enovsys LLC v. Nextel Comm'ns, Inc.

- Sprint Nextel argued that Enovsys is not sole owner of patents and failed to join other owner, the ex-wife of the manager of Enovsys and one of the patents' coinventors
- Manager and wife filed for divorce in California, where all assets acquired during marriage are presumptively community property
- divorce petition "We have no community assets or liabilities"

### 

# Enovsys LLC v. Nextel Comm'ns, Inc., cont'd

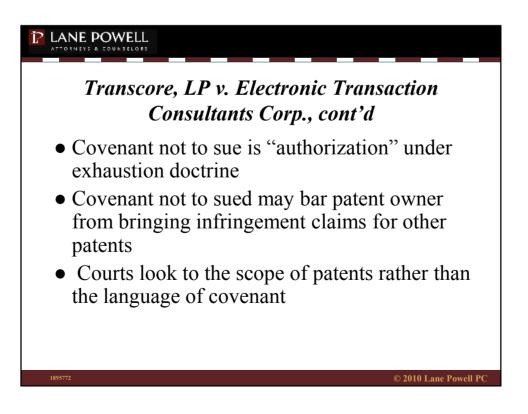
- Before divorce, patents presumptively community property in which wife had <sup>1</sup>/<sub>2</sub> interest
- Presumption overcome by declaration "we have no community assets or liabilities"
- California court entered judgment of dissolution
- Court's judgment entitled to res judicata effect
- Pursuant to divorce decree, wife retained no property rights in patents, so Enovsys had standing

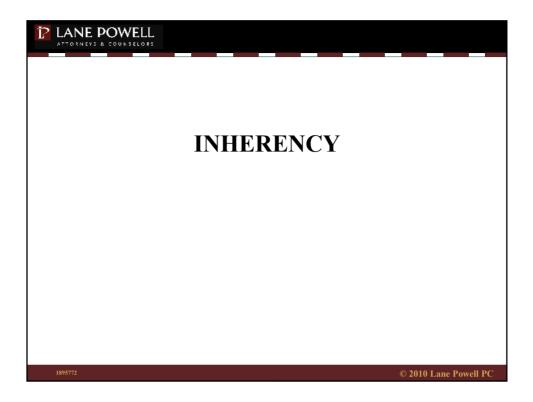
© 2010 Lane Powell PC

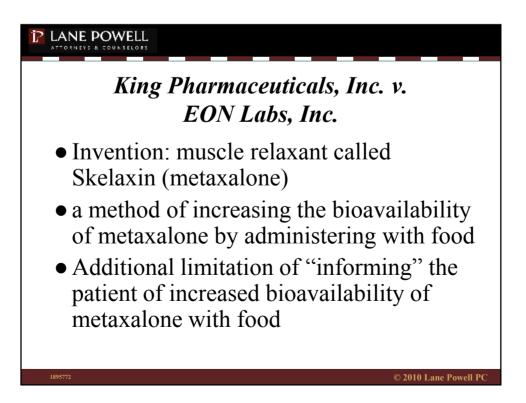
### TTORNEYS & COUNSELOFS

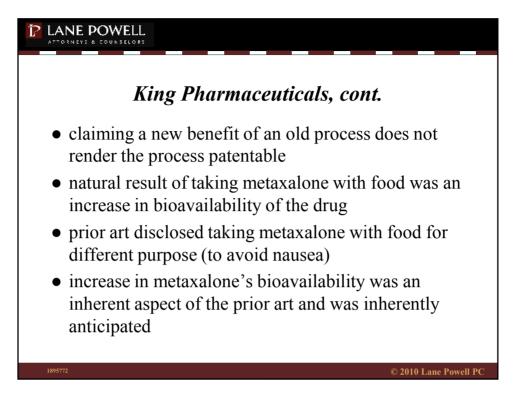
# Transcore, LP v. Electronic Transaction Consultants Corp.

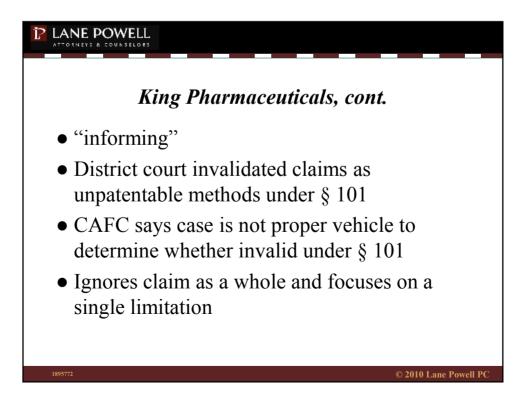
- Unconditional covenant not to sue and release of all existing claims as to Mark IV in prior litigation
- Did not apply to patents not specified or future patents
- ETC installs Mark IV product and is sued by Transcore for infringement

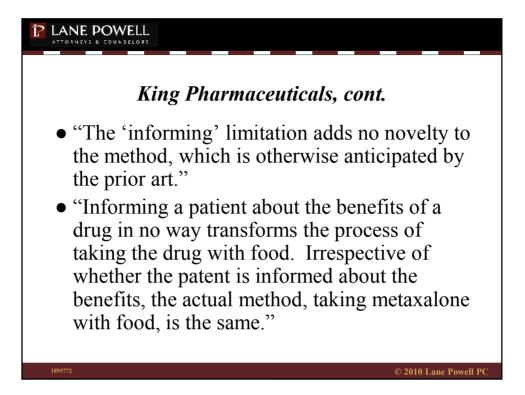


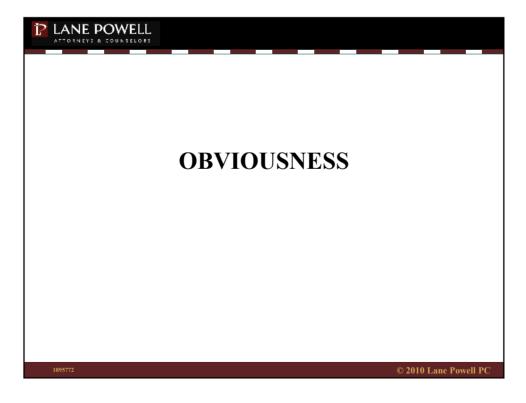


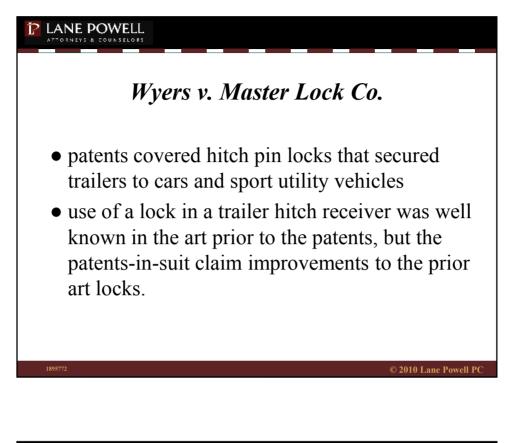


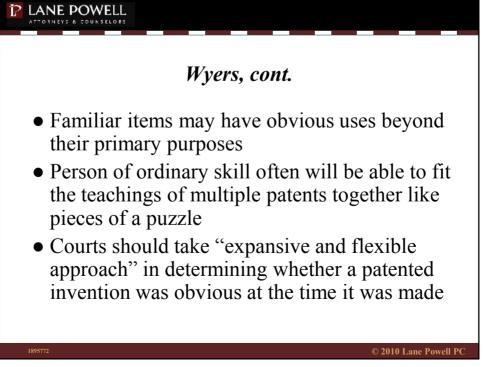


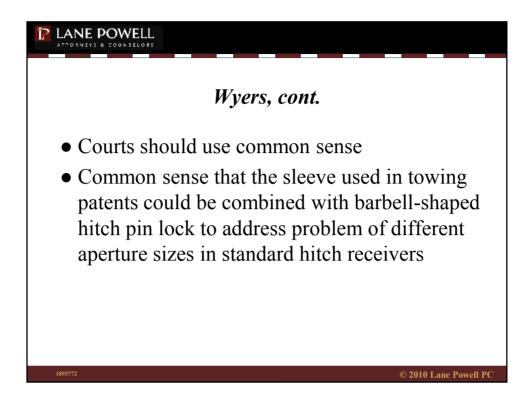


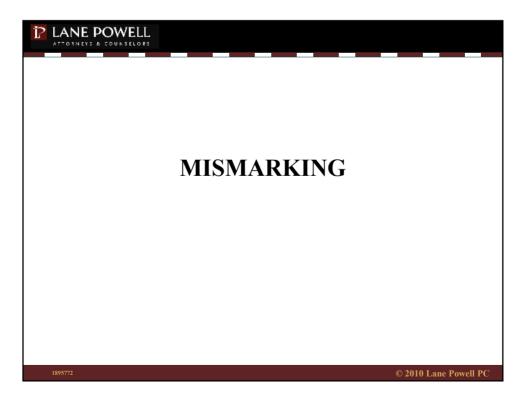


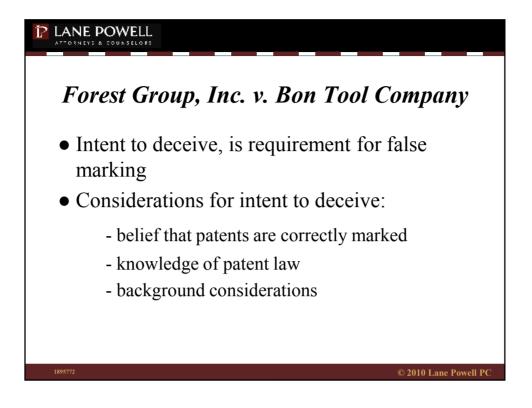


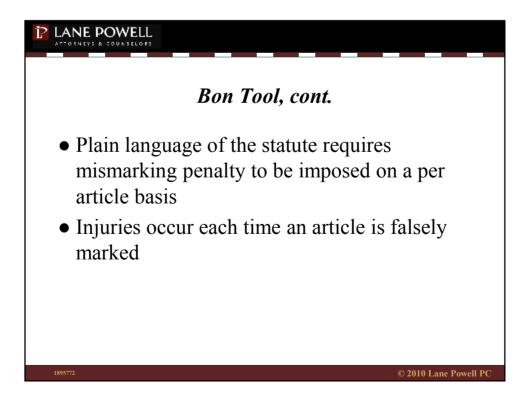


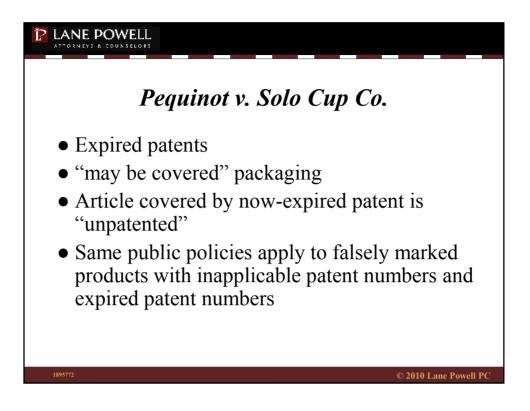


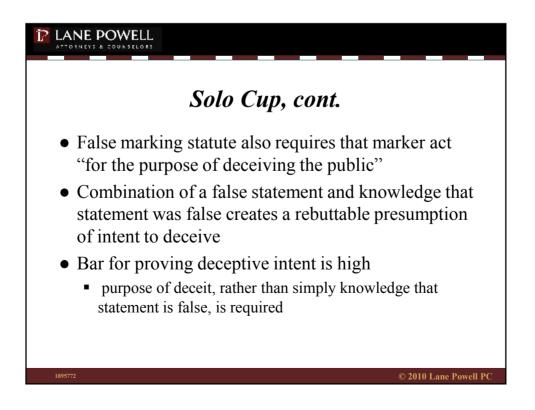


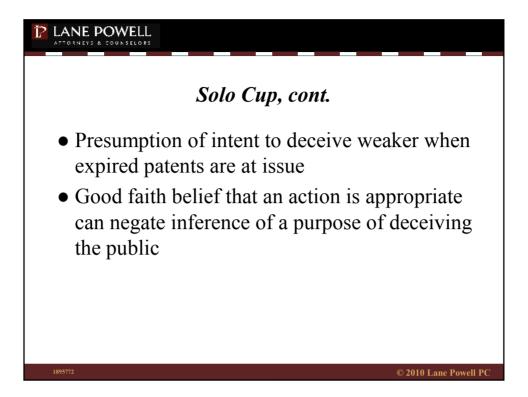


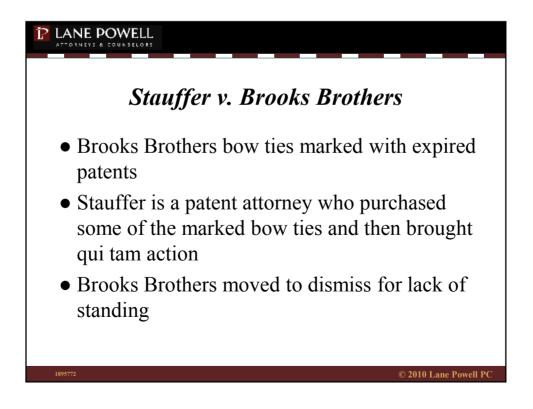


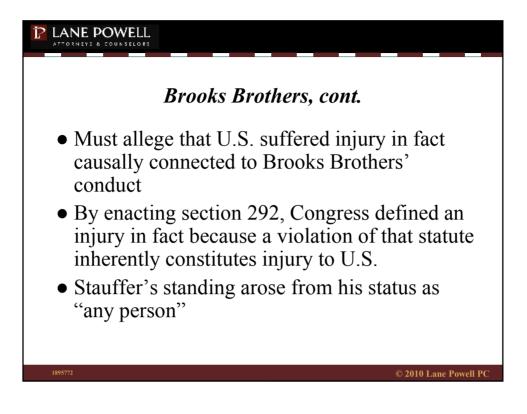




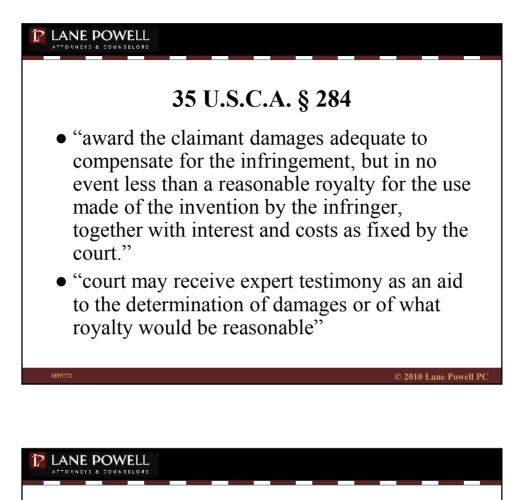


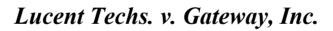






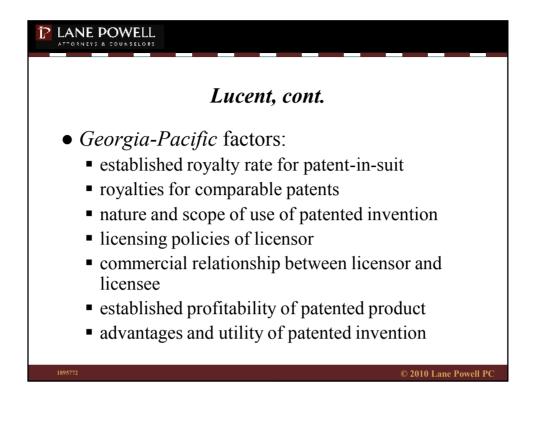


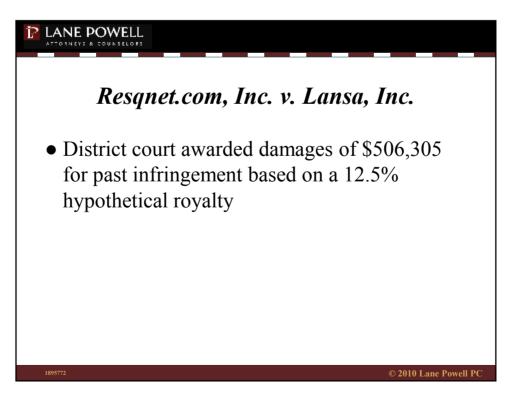


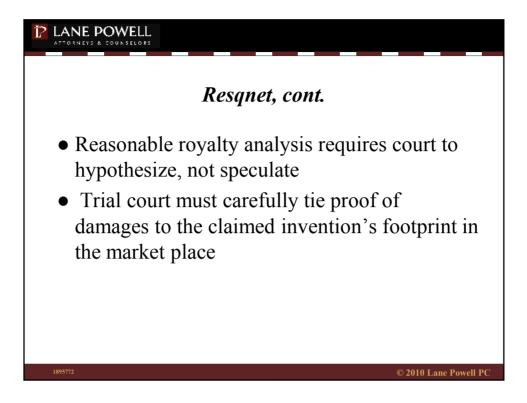


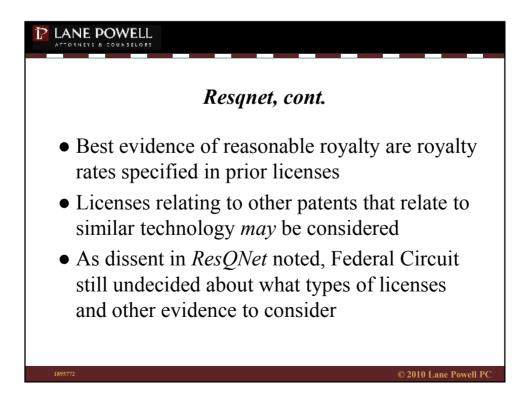
- Jury awarded \$357,693,056.18 in damages for patent infringement
- Patented device was small component of larger product

© 2010 Lane Powell PC









# Wordtech Sys. Inc. v. Integrated Network Solutions, Inc.

- Jury awarded \$250,000 in damages, a 26.3% royalty on the total alleged sales
  - Plaintiffs only asked for a 12% royalty
- After trial, the district court found the case "exceptional" and awarded treble damages, attorneys' fees, interest, and costs

