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Intellectual Property Lawyers
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NEWSLETTER

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Standard Essential Patent Owner May Still Get Injunction

The Federal Circuit explained in *Apple v. Motorola* that, even when the owner of a standard essential patent has an obligation to license on "fair, reasonable, and non-discriminatory terms", the owner may still be entitled to an injunction against infringement - though difficult it may be to obtain.

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Pre-Patent Issuance Activities Can Trigger a Declaratory Judgment Lawsuit Against Patent Owner

The Declaratory Judgment Act provides that where there is a "case of actual controversy" a district court can declare the rights of the parties.

In *Danisco v. Novozymes*, the facts were complex. Novozymes had a patent claim which it asserted interfered with Danisco's patent. Novozymes had asserted that its patent read on Danisco's products and Novozymes sought its patent because it believed that Danisco's products would infringe once the claim issued. Novozymes twice sued Danisco or its predecessors patent infringement regarding related products.

The Federal Circuit stated that whether Novozymes accused Danisco of infringing an issued patent "is not dispositive of whether an actual controversy exists." According to the Federal Circuit, the Declaratory Judgment Act "does not mandate that the declaratory judgment defendant have threatened litigation or otherwise taken action to enforce its rights before a justiciable controversy can arise, and the Supreme Court has repeatedly found the existence of an actual case or controversy even in situations in which there was no indication that the declaratory judgment defendant was preparing to enforce its legal rights.

Accordingly, the question is whether, "under all the circumstances," "there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment." Thus, the "pattern of administrative challenges" is relevant in "analyzing the totality of the circumstances."

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