

PUBLICATION UPDATE

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MILGRIM ON LICENSING

Publication 743 Release 60 October 2024

HIGHLIGHTS

- Current important cases and developments include:

In **DexCom, Inc. v. Abbott Diabetes Care, Inc.** (Fed. Cir.), a no challenge clause provided that neither party could challenge the validity of the other party’s patents during an initial “covenant period” but reserved the right of each party to challenge such a patent in an IPR. Although the agreement had a District of Delaware forum selection clause, it could not limit the parties’ rights to seek an IPR after the covenant period expired. For more forum selection clauses and IPRs, see § 28.04.

NGM Mgmt. Grp., LLC v. Bareburger Grp., LLC (N.Y. App. Div.) recognizes the continuing vitality of licensee estoppel in the context of

trademark license agreements. For a discussion of trademark licensee estoppel, see § 7.17A.

Laatz v. Zazzle, Inc. (N.D. Cal.) considered the validity of a web site’s “browsewrap” license comprised of three documents including a “License FAQs” that was accessible through a link that was not readily visible and through a second link, “Have questions or need more clarification?.” That the links were optional and the second did not clearly indicate additional contract terms, there was an issue of fact as to whether defendant had assented to the license terms contained solely in the License FAQs. For a discussion of browsewrap licenses, see § 11.18.

In re Blue Cross Blue Shield Antitrust Litig. (N.D. Ala.) considers whether the original owner of the well-known “Blue Cross” and “Blue

Shield” trademarks engaged in naked licensing by permitting other entities to use the marks outside of the owner’s territories. The dispute called into play common law rights in different territories. For a discussion of territorially-limited trademarks, see § 4.09.

In **N. Star IP Holdings, LLC v. Icon Trade Servs., LLC** (S.D.N.Y.), a creditor foreclosed a security interest in the trademarks at issue and sold the marks to plaintiff, which then sued the original trademark owner’s exclusive field of use licensee for infringement. The court, recognizing that the U.C.C. permits a secured party that has foreclosed on its security interest to sell the collateral free of any subordinate interest including licenses, the sale of marks terminated defendant’s license such that defendant could be liable for infringement, also reviewed specific aspects of the U.C.C. that would obtain in the situation in respect of a foreclosed mark that had nonexclusive licensees. For a discussion of security interests in intellectual property, see § 27.13.

In **Ericsson v. Lenovo (United States), Inc.** (E.D.N.C.), defendant sought a nonsuit injunction on the ground that the court’s determination of a fair, reasonable and nondiscriminatory (“FRAND”) royalty for the standard essential patents (“SEPs”) at issue would resolve the parties’ worldwide disputes. The court re-

jected defendant’s motion because even were a FRAND royalty determined, defendant might still choose to not use the patented technology or use it and run the risk of an infringement suit. For a discussion of SEPs and FRAND royalties, see § 11.19.

In **Ledo Pizza Sys. v. Ledo’s Inc.** (N.D. Ill. Mar. 7, 2024), the issue of the impact of quality control was examined where defendant contended that plaintiff had engaged in naked licensing by granting a license for its pizza-related trademark to a restaurant and where the restaurant had been the original owner of the mark and had assigned it to plaintiff when the restaurant and plaintiff were owned by the same people. That scenario justified plaintiff to rely on the restaurant maintaining a consistent level of quality for its operations under the mark. For a discussion of naked trademark licensing, see § 4.53.

In **VIAAS Inc. v. Amazon.com Inc.** (W.D. Tex.), plaintiff alleged that it held title to the patent at issue as the assignee of a company that was purportedly the inventor’s assignee, but the un rebutted evidence indicated that the inventor’s assignee was similarly named, but a separate company. For a discussion of standing to bring a patent infringement claim, see § 15.01.

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Publication 743 Release 60

October 2024

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