

**Authors:****David D. Conway**

Venable LLP
ddconway@Venable.com
202.344.4489

Andrew Dodd

Field Fisher Waterhouse LLP
andrew.dodd@ffw.com
+44 (0)20 7861 4000

Ryan M. Flandro

Venable LLP
rmflandro@Venable.com
202.344.4221

Justine A. Gozzi

Venable LLP
jagozzi@Venable.com
202.344.8279

Christopher T. La Testa

Venable LLP
ctlatesta@Venable.com
410.244.7523

Elissa B. Reese

Venable LLP
ebreese@Venable.com
202.344.4530

Nick Rose

Field Fisher Waterhouse LLP
nick.rose@FFW.com
+44 (0)20 7861 4226

Editors:**Clifton E. McCann**

cemccann@Venable.com
202.344.8162

Lisa M. Kattan

lmkattan@Venable.com
202.344.4721

In this issue:

[Click on any headline for more information or to view the article in its entirety.](#)

It's Not a Croc - or Is It? Federal Circuit Relies on 'Secondary Considerations' to Reverse ITC's Obviousness Finding

With a recent reversal of an ITC's ruling, the CAFC reaffirmed the "ordinary observer" test for design patent infringement and reiterated utility patent obviousness standards by relying on secondary considerations in making the the determination.

Congress and Private Industry React to Recent Patent Marking Developments

Congress has taken note of the recent explosion of false marking suits in the wake of *Forest Group v. Bon Tool*. Pending bills would limit standing to entities who've suffered a competitive injury as a result of false marking. Other proposals would allow patentees to provide notice by marking products with a publicly-accessible web address having current patent information. At least one company recently announced a new online tool for this purpose.

SEB v. Montgomery Ward Expands Liability for Induced Patent Infringement

The Federal Circuit issued a recent decision that may help patentees claiming induced patent infringement. In *SEB S.A. v. Montgomery Ward & Co.*, a foreign company intentionally copied a U.S. patented deep fryer abroad, subsequently supplying its deep fryer to various U.S. retailers. The Federal Circuit held that plaintiff's claim for induced patent infringement could be successful even without evidence that the accused infringer had actual knowledge of the patent-in-suit. The effects of this decision may be far-reaching by significantly expanding U.S. patent rights extraterritorially, and opening the door for patentees to be able to meet the "knowledge of the patent" standard of induced infringement merely by marking its products.

Acceleron Lowers the Bar for Declaratory Judgment Jurisdiction in Patent Cases

In *Acceleron v. Hewlett-Packard*, the Federal Circuit continued its post-MedImmune trend by making it easier for potential patent infringers to establish declaratory judgment jurisdiction. The court ruled that Acceleron, a patent holding company, had implicitly threatened patent infringement litigation against Hewlett-Packard sufficient to establish a controversy when it exchanged letters demanding HP's agreement not to file a DJ action while refusing HP's proposed 120-day litigation standstill. According to the court, jurisdiction was appropriate because Acceleron--a patent holding company that receives no benefits from its patents without enforcement--twice took the affirmative step of contacting HP directly to make an implied assertion of its rights against HP under the patent. Acceleron is important for accused patent infringers who wish to dictate the forum and location of their inevitable infringement suit.

LG Electronics USA Inc. v. Whirlpool Corp. – 7th Circuit Court of Appeals Requires Company to Produce Communications Between Its Counsel and Outside Advertising Agencies

In a recent decision in the *LG Electronics USA Inc. v. Whirlpool Corp.* false advertising case, the U.S. Court of Appeals for the Seventh Circuit compelled the production of communications between Whirlpool's counsel and its outside advertising agencies relating to the content of alleged false advertisements. Despite Whirlpool's claims the documents were privileged, the court held that long-term relationship between Whirlpool and its ad agencies was in the ordinary course of business and not for the purpose of responding to litigation. In addition, the court rejected Whirlpool's common-legal-interest argument because it found that the only legal interest Whirlpool shared with its ad agencies was "the fear of a lawsuit," and this fear was not sufficient to warrant an expansion of the attorney-client privilege.

Venable has formed a strategic alliance in Europe with Field Fisher Waterhouse, LLP and presents the following articles of interest from our FFW colleagues.

BSkyB Wins Long-Running Court Battle with EDS

In a landmark court ruling on 26 January 2010, a judge has ruled in favour of BSKyB in its bitterly contested £710 million legal battle with EDS. Mr Justice Ramsey found that EDS had fraudulently misrepresented to BSKyB what it could deliver, and when, in the procurement of a new customer relationship management system for BSKyB.

Google Wins Keyword Victory in Europe

The Court of Justice of the European Union ("CJEU" - formerly known as the European Court of Justice) has handed down its eagerly awaited judgment in three joined cases referred by the French supreme court (Cour de Cassation), ruling that Google's AdWords service through which it offers sponsored listings in its search results based on the purchase by advertisers of keywords does not infringe trade mark rights in Europe.

If you have friends or colleagues who would find this newsletter useful, please invite them to subscribe at www.Venable.com/subscriptioncenter.

© 2010 Venable LLP. This newsletter is published by the law firm Venable LLP. It is not intended to provide legal advice or opinion. Such advice may only be given when related to specific fact situations that Venable has accepted an engagement as counsel to address. Further, each newsletter article has been prepared by the named author or authors, and does not represent the views of Venable LLP or unnamed Venable attorneys. This newsletter may be reproduced without the express permission of Venable LLP as long as it is reproduced in its entirety, including the Venable name and logo.