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Implicit License to Asserted Patent Barred Patentee's Infringement Claims

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Cheetah Omni LLC v. AT&T Services, Inc., et al., No. 2019-1264 (Fed. Cir. Feb. 6, 2020)

The patentee sued the alleged infringer in the Northern District of Texas alleging patent infringement. The manufacturer of components of the accused product intervened. The district court granted summary judgment that the patentee was barred from enforcing its patent against the alleged infringer under the terms of agreements settling prior litigation between the patentee and the manufacturer because those agreements included implicit licenses to the asserted patent covering all accused products.

The patentee appealed. Under the agreements, the grandparent and uncle of the patent-in-suit were licensed, and the court held the asserted patent was also licensed, finding the agreements included an implied license to the asserted patent that extended to the accused products. The court applied the presumption of an implied license, and since the grandparent was expressly licensed, a continuation of a continuation of the grandparent was also licensed. The patentee's argument that the claims in the asserted patent were narrower or different than the grandparent's claims was unpersuasive because the same inventive subject matter was disclosed in the expressly licensed patents, and if the patentee did not intend to extend the license to claims in continuations, then the patentee had an obligation to make that clear. The court also rejected the patentee's argument that the parties to the license knew about the asserted patent at the time of the settlement agreements and did not expressly list it, noting that the naming of certain patents does not evince a clear mutual intent to exclude other patents falling within the general definition in the agreements.

A copy of the opinion can be found here.

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