

Patent Licensing Post *MedImmune*: Proceed with Caution

Best Practices for Adapting to Sweeping Change in Licensing

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This year, the legal landscape for patent licensing changed dramatically. The Supreme Court rejected the Federal Circuit's long-standing "reasonable apprehension of suit" test in *MedImmune v. Genentech* in January. Now, the Federal Circuit for the first time substantively applied that decision on March 26 in *SanDisk v. STMicroelectronics*.

In a decision that the Federal Circuit itself described as "sweeping change" to patent licensing law, *SanDisk* holds that a patent owner that asserts infringement against another entity to demand licensing and royalties cannot prevent the alleged infringer from then litigating the merits of these infringement assertions.

This teleconference will examine the Federal Circuit's first application of *MedImmune* and discuss the impact for patent holders and licensees - and best practices for IP asset owners to adapt to the latest developments in patent licensing law.

- I. *SanDisk v. STMicroelectronics*
 - A. The fallout from *MedImmune*
 - B. New test – threshold for case or controversy for declaratory judgment jurisdiction significantly lowered
 - C. Impact on patent holders
 - D. Impact on prospective licensees
- II. Drafting and negotiating licenses
 - A. Initial letters or offers of patent license
 - B. Short license terms, multiple renewals
 - C. Confidentiality agreement restricting use of information obtained during negotiations
 - D. Termination provisions
 - E. License estoppel clauses
 - F. Forum selection
 - G. Pre-suit notification clauses
 - H. Royalty rates
- III. Declaratory judgments and infringement accusations
 - A. Framing infringement accusations without creating declaratory judgment jurisdiction
 - B. Filing a declaratory judgment - considerations of when to respond to infringement accusations with DJ action
 - C. Timing of filing

continued

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