Using Equitable Defenses to Limit Patent Damages and Support Trial Themes (Intervening Rights; Prosecution Laches; Unclean Hands)

DECEMBER 5, 2025

GT GreenbergTraurig

Data Sources and Search Strings

- Docket Navigator
  - Case Filing date: Jan. 1, 2023 – June 30, 2025
  - Case with Legal Issues:
    - Inequitable Conduct (and all subcategories)
    - Laches (and all subcategories)
    - Equitable Estoppel
    - Unclean Hands
  - N=70, active or terminated, including ITC, Ct. Fed. Cl., Fed. Cir.
    - Patentee won 1x, challenger won 3x
    - Missing obvious / well-reported cases, e.g., Staton Techiya

GT GreenbergTraurig

Data Sources and Search Strings

- Lex Machina
  - Terminated Patent cases; with Events: Bench Trial, Events: Jury Trial, or Events: Trial case tags ; pending between 2023-01-01 and 2025-06-30. n=305
    - Terminated Patent cases; with keyword(s) [estoppel] (and other conditions above). n=297 (97%)
      - 21 reached trial on estoppel issues: 7% of all trials, 7% of cases where estoppel was raised
    - Terminated Patent cases; with keyword(s) ["inequitable conduct"] (and other conditions above). n=220 (72%)
      - 20 reached trial on inequitable conduct issues: 6% of all trials, 9% of cases where IC was raised
    - Terminated Patent cases; with keyword(s) ["unclean hands"] (and other conditions). n=213 (70%)
      - 19 reached trial on unclean hands issues: 6% of all trials, 9% of cases where unclean hands was raised
    - Terminated Patent cases; with keyword(s) [laches] (and other conditions above). n=194 (64%)
      - 13 reached trial on laches issues: 4% of all trials, 7% of cases where laches was raised

GT GreenbergTraurig

Statistics (Lex Machina)

- 21 (18 jury) trials involving complaint / answer allegations of:
  - Estoppel (21)
  - Inequitable conduct (20)
  - Unclean hands (19)
  - Laches (13)
- Of these, equitable defenses prevailed at trial in only 3 cases
  - Cap-XX v. Maxwell, D. Del.
  - Staton Techiya v. Samsung Electronics, W.D. Tex.
  - Lindis Biotech, GmbH v. Amgen Inc., D. Del.

GT GreenbergTraurig

Substantive Overlap

Case name	Unenforceable?	Estoppel?	Inequitable Conduct?	Unclean Hands?	Laches?	Court
360Heros, Inc. v. GoPro, Inc.	n	y	y	y	y	D.Del.
CAP-XX, Ltd. v. Maxwell Technologies, Inc.	y	y	y	y	n	D.Del.
DMF Inc v. AMP Plus Inc	n	y	y	y	n	C.D.Cal.
Force Mos Technology Co., Ltd. v. ASUSTeK Computer, Inc.	n	y	y	y	y	E.D.Tex.
Geigtech East Bay LLC v. Lutron Electronics Co., Inc.	n	y	y	y	n	S.D.N.Y.
HQ Specialty Pharma Corp. et al v. Fresenius Kabi USA, LLC	n	y	y	y	y	D.Del.
Lindis Biotech, GmbH v. Amgen Inc.	y	y	y	y	y	D.Del.
Magna Mirrors of America, Inc. v. Samvardhana Motherson Reflectec Grou	n	y	y	y	y	W.D.Mich
Melinta Therapeutics, LLC et al v. Nexus Pharmaceuticals, Inc.	n	y	n	y	y	N.D.Ill.
MGI Digital Technology S.A. v. Duplo U.S.A. Corporation	n	y	y	y	y	C.D.Cal.
Mojo Mobility Inc v. Samsung Electronics Co., LTD	n	y	y	y	y	E.D.Tex.
Multimedia Technologies Pte. Ltd. v. LG Electronics Inc.	n	y	y	y	y	E.D.Tex.
Nichia Corporation v. Feit Electric Company, Inc.	n	y	y	y	y	C.D.Cal.
Ningde Amperex Technology Limited v. Zhuhai CosMX Battery Co., Ltd.	n	y	y	y	n	E.D.Tex.
Puma Biotechnology, Inc. v. AstraZeneca Pharmaceuticals LP	n	y	y	y	y	D.Del.
Sanofi-Aventis U.S. LLC, et al. v. Sandoz Inc.	n	y	y	n	n	D.Del.
Siemens Gamesa Renewable Energy A/S v. General Electric Co.	n	y	y	y	n	D.Mass.
Staton Techiya, LLC et al v. Samsung Electronics Co., Ltd.	y	y	y	y	y	E.D.Tex.
Textron Innovations Inc. v. SZ DJI Technology Co., Ltd.	n	y	y	y	n	W.D.Tex.
The Trustees of Purdue University v. STMicroelectronics International N.V	n	y	y	n	y	W.D.Tex.
TQ Delta, LLC v. CommScope Holding Company, Inc.	n	y	y	y	n	E.D.Tex.

GT GreenbergTraurig

Challenger Wins on Equitable Issues

- CAP-XX, Ltd. v. Maxwell Technologies, Inc. (D. Del.)
  - No infringement
  - Invalidity on various grounds
  - 2 patents invalid for lack of correct inventorship
  - All issues tried to jury
- Staton Techiya, LLC et al v. Samsung Electronics Co., Ltd. (E.D. Tex.)
  - One of 2 cases involving the same parties
  - Ex-Samsung in-house lawyer switched sides
  - Bench trial before jury trial disposed of all claims due to unclean hands
- Lindis Biotech, GmbH v. Amgen Inc. (D. Del.)
  - Inequitable conduct tried to the Court (2-day bench trial) after jury trial finding all patents valid and infringed
  - All asserted patents held invalid for inequitable conduct (deliberate failure to withhold 2 material references)
  - Issue of references not tried to the jury as part of invalidity case (per jury instructions)

GT GreenbergTraurig

Defendant Wins on Merits, Not Equity

- 360Heros, Inc. v. GoPro, Inc. (D. Del.)
  - William Ramey case
  - Defense win at jury trial: no infringement
  - Inequitable conduct jury instructions to limit application of doctrine of equivalents
- MGI Digital Technology S.A. v. Duplo U.S.A. Corporation (C.D. Cal.)
  - No infringement
  - All claims invalid
  - Rejected improper inventorship defense included in jury instructions
- Multimedia Technologies Pte. Ltd. v. LG Electronics Inc. (E.D. Tex.)
  - No infringement, all claims invalid, no equitable defense tried to the jury
- Nichia Corporation v. Feit Electric Company, Inc. (C.D. Cal.)
  - Bench trial before jury trial: no inequitable conduct re petition to revive for inadvertent delay
  - Jury later found no infringement

GT GreenbergTraurig

Patentee Wins on Equitable Defenses …

- Force Mos Technology Co., Ltd. v. ASUSTeK Computer, Inc. (W.D. Tex.)
  - Jury tried issue of assignment of rights to one patent from inventor (found assignment was proper)
  - Jury found willful infringement
  - Subsequent bench trial re inequitable conduct: no IC despite failures to file IDS forms re other patents by the same inventor
- Geigtech East Bay LLC v. Lutron Electronics Co., Inc. (S.D. N.Y.)
  - Unenforceability claim disposed of by bench trial before jury trial: rejects co-inventorship claim and on-sale bar defense
- HQ Specialty Pharma Corp. et al v. Fresenius Kabi USA, LLC (D. Del.)
  - Jury trial: split verdict - infringement of claim 1, but claims 2-3 invalid for lack of proper inventorship; inventorship issue discussed at trial
  - Followed by bench trial on inequitable conduct (failure to disclose prior art and omitted inventor), finding no specific intent.

GT GreenbergTraurig

Patentee Wins on Equitable Defenses …

- Magna Mirrors of America, Inc. v. Samvardhana Motherson Reflectec Group Holdings Ltd (W.D. Mich.)
  - Jury trial found asserted claims invalid and no indirect infringement
  - Subsequently, inequitable conduct tried to court - no IC found
- Mojo Mobility Inc v. Samsung Electronics Co., LTD (E.D. Tex.)
  - Bench trial following jury trial
  - Bench trial found no prosecution laches by clear and convincing evidence
- Ningde Amperex Technology Limited v. Zhuhai CosMX Battery Co., Ltd. (E.D. Tex.)
  - Split verdict for plaintiff, 1 patent willfully infringed ($3.7M), 2 patents invalid
  - Tried patent misuse defense to jury

GT GreenbergTraurig

Patentee Wins on Equitable Defenses …

- Puma Biotechnology, Inc. v. AstraZeneca Pharmaceuticals LP (D. Del.)
  - Jury trial found inducement and patents valid
  - Then 2-day bench trial on unclean hands, waiver, and patent misuse before FDA (late Orange Book listing)
  - Court criticized failure to raise belated Orange Book listing to the jury
  - Patents not unenforceable
- Siemens Gamesa Renewable Energy A/S v. General Electric Co. (D. Mass.)
  - Jury trial on infringement and validity, then inequitable conduct (failure to disclose material references, failure to name inventors) bench trial
  - IC defense rejected by the Court
- Textron Innovations Inc. v. SZ DJI Technology Co., Ltd. (W.D. Tex.)
  - Jury trial on infringement and validity (plaintiff win)
  - Post-verdict bench trial on inequitable conduct on failure to disclose material reference fails (no intent to deceive)

GT GreenbergTraurig

Patentee Wins on Equitable Defenses …

- The Trustees of Purdue University v. STMicroelectronics International N.V. (W.D. Tex.)
  - Jury trial on infringement and validity (plaintiff win)
  - Post-verdict bench trial on inequitable conduct on failure to disclose material reference fails (no intent by patent prosecutor; inventor followed prosecutor's instructions)
- TQ Delta, LLC v. CommScope Holding Company, Inc. (E.D. Tex.)
  - Split verdict for plaintiff ($11M on 6/7 patents infringed)
  - 2 patents invalid
  - Jury rejected FRAND/SEP defenseTextron Innovations Inc. v. SZ DJI Technology Co., Ltd. (W.D. Tex.)

GT GreenbergTraurig

Bench Trials Only

- DMF Inc v. AMP Plus Inc. (C.D. Cal.)
- Melinta Therapeutics, LLC et al v. Nexus Pharmaceuticals, Inc. (N.D. Ill.)
- Sanofi-Aventis U.S. LLC, et al. v. Sandoz Inc. (D. Del.)

GT GreenbergTraurig

David S. Bloch

Shareholder, San Francisco

David.Bloch@gtlaw.com

415.590.5110