
THE INTELLECTUAL PROPERTY AND ANTITRUST REVIEW

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LAW BUSINESS RESEARCH

THE INTELLECTUAL PROPERTY AND ANTITRUST REVIEW

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EDITOR'S PREFACE

Intellectual property is taking a more and more central position in the global economy, and this is true not only in highly developed economies, but also in emerging economies. China and India, to take just two examples, are moving rapidly up the value chain and now have world-class technology companies for which intellectual property protection is crucial.

As the significance of intellectual property grows, so too does the relationship between intellectual property and antitrust law. Antitrust law constrains the exercise of intellectual property rights in certain circumstances, and both owners and users of intellectual property rights need to know how the two bodies of law interact and where antitrust draws lines for intellectual property. Intellectual property practitioners need to look beyond intellectual property laws themselves to understand the antitrust limits on the free exercise of rights.

The task of this book is, with respect to key jurisdictions globally, to provide an annual concrete and practical overview of developments on the relationship between antitrust and intellectual property. This edition, as the first edition, provides not only an update on recent developments but also an overview of the overall existing lay of the land regarding the relationship between the two bodies of law.

Key topics covered in this and future editions include the constraints imposed by antitrust on licensing, the circumstances under which a refusal to license intellectual property rights can be unlawful, the imposition of antitrust obligations on owners of standard-essential patents, the application of antitrust law to cross-border e-commerce, the growing importance of intellectual property issues in merger cases, and the intense disputes regarding the application of antitrust law to patent settlements in the pharmaceutical industry.

As intellectual property continues to gain importance in the world economy, and as the number, resources and sophistication of antitrust authorities grows across the globe, new battles will be fought over the circumstances in which antitrust constrains intellectual property. Existing differences in the application of antitrust to intellectual property – already significant, and perhaps even greater than in intellectual property laws themselves – may grow,

perhaps especially as more net intellectual property-consuming countries devote resources to antitrust enforcement. Future editions of this book will analyse these developments and we hope the reader will find this to be a useful compilation and oft-consulted guide.

Finally, I would like to thank Ashwin van Rooijen, Milena Robotham and Axelle D'heygere for their important contributions to this first edition of *The Intellectual Property and Antitrust Review*.

Thomas Vinje

Clifford Chance LLP

Brussels

August 2016

Chapter 14

UNITED STATES

*Lisa Kimmel and Christie L Stahlke*¹

I INTRODUCTION

Courts and antitrust enforcement agencies in the United States view antitrust and intellectual property (IP) as complementary bodies of law that operate together to promote competition, innovation and consumer welfare.² Conduct involving antitrust and IP does not require separate laws or standards; it is evaluated under the same laws that govern other types of antitrust issues. The key statutes include:

- a* the Sherman Act, which prohibits unreasonable restraints of trade, monopolisation, attempts to monopolise and conspiracies to monopolise;³
- b* the Clayton Act, which prohibits acquisitions that may substantially lessen competition;⁴ and
- c* the Federal Trade Commission Act, which prohibits unfair methods of competition.⁵

The US Department of Justice (DOJ) and Federal Trade Commission (FTC) (collectively, the agencies), which jointly enforce the federal antitrust laws, have also issued key antitrust enforcement guidance for conduct involving IP rights. In 1995, the agencies issued the Antitrust Guidelines for the Licensing of Intellectual Property (the 1995 Licensing Guidelines).⁶ These

1 Lisa Kimmel is a senior counsel and Christie L Stahlke is a counsel at Crowell & Moring LLP.

2 Department of Justice and Federal Trade Commission, Antitrust Enforcement and Intellectual Property Rights: Promoting Innovation and Competition (April 2007) (the 2007 IP Report), available at www.justice.gov/atr/antitrust-enforcement-and-intellectual-property-rights-promoting-innovation-and-competition.

3 15 U.S.C. §§ 1–2.

4 15 U.S.C. § 18.

5 15 U.S.C. § 45.

6 Department of Justice and Federal Trade Commission, Antitrust Guidelines for the Licensing of Intellectual Property (6 April 1995), available at www.justice.gov/atr/antitrust-guidelines-licensing-intellectual-property.

guidelines provide the economic and legal framework for agency enforcement policy at the intersection of antitrust and IP more broadly today. The 1995 Licensing Guidelines are based on three main principles: (1) the same antitrust principles apply to IP as to other forms of property, (2) IP does not carry any presumption of market power, and (3) IP licensing is usually pro-competitive because it allows firms to combine complementary assets.⁷

In 2007, the agencies issued ‘Antitrust Enforcement and Intellectual Property Rights: Promoting Innovation and Competition’ (the 2007 IP Report), a more comprehensive statement of antitrust enforcement policy involving IP. The 2007 IP Report applies the broad principles from the 1995 Licensing Guidelines to a wider range of issues, including unconditional unilateral refusals to license, cross-licensing, patent pools and the tying or bundling of IP rights.⁸ Together with federal case law applying the relevant antitrust statutes, these guidance materials provide a roadmap to the intersection of antitrust and IP law in the United States. This chapter provides a concise overview of the case law and enforcement guidance most relevant to the issues practitioners are likely to face today.

II YEAR IN REVIEW

Enforcement and litigation activity at the intersection of antitrust and IP in 2015 continued to centre on patent settlement agreements in the pharmaceutical sector. In May 2015, the FTC settled its long-running lawsuit against Cephalon, Inc. for blocking generic competition from brand-name drug Provigil.⁹ Under the FTC settlement, Teva Pharmaceutical Industries, Ltd., which acquired Cephalon in 2012, agreed to make a total of \$1.2 billion available to injured consumers.

We also saw federal courts continue to define the types of settlement agreements that may run afoul of the antitrust laws. In *Federal Trade Commission v. AbbVie Inc.*, the Pennsylvania District Court dismissed the FTC’s allegations that AbbVie and potential generic rival Teva had restrained trade by settling an infringement claim related to the drug Androgel and simultaneously executing a supply contract that allowed Teva to launch an authorised generic in a separate market for the drug TriCor.¹⁰ According to the FTC, the TriCor deal constituted an anticompetitive reverse payment because the terms were unusually favourable to Teva. The district court disagreed. It held that the TriCor agreement was not actionable under *Actavis* because it increased rather than decreased competition. A few months later, the Third Circuit in *King Drug Co. of Florence, Inc. v. Smithkline Beecham Corp.*¹¹ held that a branded pharmaceutical company’s agreement not to launch an authorised generic during the generic’s 180-day exclusivity period can constitute an anticompetitive reverse payment under *Federal Trade Commission v. Actavis, Inc.*¹² In light of *King Drug*, the FTC petitioned the Pennsylvania district court for reconsideration of its decision in *AbbVie*. The district

7 Id. at 2. In 2006, the United States Supreme later followed suit and held that a patent does not create any presumption of market power. *Illinois Tool Works Inc. v. Indep. Ink, Inc.*, 547 U.S. 28 (2006).

8 2007 IP Report.

9 *FTC v. Cephalon, Inc.*, No. 2:08-cv-2141 (E.D. Pa. 17 June 2015), available at www.ftc.gov/system/files/documents/cases/150617cephalonstip.pdf.

10 107 F. Supp. 3d 428, 436 (E.D. Pa. 2015).

11 791 F.3d 388, 403 (3d Cir. 2015).

12 133 S. Ct. 2223 (2013), see also Section VI, *infra*.

court declined to reverse itself because while both settlements involved an authorised generic, the transfer of value at issue in *AbbVie* did not occur in the same market and the TriCor agreement had pro-competitive benefits that were absent in *King Drug*.¹³

III LICENSING AND ANTITRUST

IP licences allow firms to combine complementary assets and are generally pro-competitive. Consequently, most restrictions in licensing agreements, such as exclusivity provisions, field-of-use restrictions, cross-licensing requirements and grant-backs are evaluated under the rule of reason rather than treated as *per se* unlawful. The rule of reason is a fact-based inquiry that requires a court or agency to consider whether a licensing restriction is likely to have an anticompetitive effect, and if so, whether the restriction is reasonably necessary to support countervailing pro-competitive benefits of the licensing agreement.¹⁴

The competitive effects of licensing restrictions can be analysed in a downstream market for products incorporating the IP or in an upstream technology market for the IP itself. In the 1995 Licensing Guidelines, the agencies also discuss the potential for competitive effects in a separate innovation market consisting of ‘research and development directed to particular new or improved goods or processes, and the close substitutes [...]’.¹⁵ However, the concept of an innovation market has been rejected by some federal courts.¹⁶ The agencies today are likely to consider research and development competition indirectly by reference to potential competition in a product market.¹⁷

Firms are not required to provide access to or create competition for their own IP. Consequently, the starting point for evaluating the competitive effects of a licensing restriction is to ask whether the restriction ‘harms competition among entities that would have been actual or likely potential competitors in the absence of an agreement’.¹⁸ In limited cases, a restriction in a licensing agreement between actual or potential competitors may be *per se* unlawful. Examples of restrictions that are likely *per se* unlawful include those that limit price competition or allocate territories among firms that would have been horizontal competitors absent the licence. Resale price maintenance agreements in licences are evaluated under the rule of reason.¹⁹

Under US antitrust law, even firms with monopoly power generally have the right to refuse to deal with rivals, customers and suppliers, but that right is not absolute. In *Aspen Skiing Co. v. Aspen Highland Skiing Corp.*, the Supreme Court held that a firm with monopoly power may, in limited circumstances, violate Section 2 of the Sherman Act by terminating a voluntary and profitable course of dealing.²⁰ More recently, however, the Court questioned the economic wisdom of forcing even monopolists to deal with rivals in *Verizon*

13 *AbbVie*, 807 F. Supp. 3d at 436.

14 1995 Licensing Guidelines at 16.

15 *Id.* at 10–11.

16 *Golden Gate Pharm. Servs., Inc. v. Pfizer, Inc.*, 2009 U.S. Dist. LEXIS 11862, at *11 (N.D. Cal. 21 August 2009).

17 See, e.g., *FTC Compl. Against Nielsen Holdings N.V. and Arbitron Inc.*, Dkt. No. C-4439 (28 February 2014).

18 1995 Licensing Guidelines at 6.

19 *Leegin Creative Leather Prods., Inc. v. PSKS, Inc.*, 551 U.S. 877 (2007).

20 472 U.S. 585 (1985).

Communications v. Law Offices of Curtis V. Trinko.²¹ While the Court did not overrule *Aspen Skiing*, it restricted the holding narrowly to the facts, describing the decision as ‘at or near the boundary’ of Section 2 liability based on a unilateral refusal to deal.

The same principle applies to an unconditional unilateral refusal to license IP. Before *Trinko*, appellate courts had disagreed as to whether an unconditional refusal to license IP, even without a prior course of dealing, could violate the antitrust laws.²² While the Supreme Court has yet to address a unilateral refusal to license since its decision in *Trinko*, the agencies have confirmed that the same principle applies, stating that ‘[a]ntitrust liability for mere unilateral, unconditional refusals to license patents will not play a meaningful part in the interface between patent rights and antitrust protections.’²³

Unfair or discriminatory licensing does not, without more, support an antitrust claim in the United States. Conduct that is unfair does not violate the US antitrust laws unless it has an actual or likely anticompetitive effect.²⁴ While the FTC Act prohibits ‘unfair methods of competition’, FTC enforcement principles limit prosecution for unfair methods of competition to conduct that harms or is likely to harm competition or the competitive process under a framework similar to the Sherman Act rule of reason.²⁵

Because there is no general duty to license IP in the United States, there is no duty to license on particular terms or to charge non-discriminatory rates.²⁶ The Robinson-Patman Act, a federal antitrust law that restricts price discrimination in the sale of commodities in certain circumstances, does not apply to IP licences because IP is not considered a commodity.²⁷

US courts and agencies recognise that patent pooling arrangements can generate substantial efficiencies. In some sectors, a large number of firms may own the patent rights necessary to commercialise a product. Combining complementary rights across firms can reduce transaction costs for licensees and licensors and increase monetisation for smaller patent holders who may lack the resources to pursue unlicensed use of their technology.²⁸

Patent pools can nevertheless raise antitrust concerns. The formation of a pool is far more likely to raise concerns if the pool combines substitute patents covering non-infringing

21 540 U.S. 398, 409 (2004); see also *United States v. Colgate & Co.*, 250 U.S. 300 (1919); *Integrgraph Corp. v. Intel Corp.*, 195 F.3d 1346 (Fed. Cir. 1999).

22 *Image Tech. Servs., Inc. v. Eastman Kodak Co.*, 125 F.3d 1195 (9th Cir. 1997) (finding defendant liable for refusing to sell patented parts to rival where business justification was pretextual); *In re Indep. Serv. Orgs. Antitrust Litig.*, 203 F.3d 1322 (Fed. Cir. 2003) (finding that patent rights provided conclusively lawful justification for refusing to sell or license patented parts).

23 2007 IP Report at 6.

24 *Rambus Inc. v. FTC*, 522 F.3d 456 (D.C. Cir. 2008).

25 Federal Trade Commission, Statement of Enforcement Principles Regarding ‘Unfair Methods of Competition’ Under Section 5 of the FTC Act (13 August 2015) (the Section 5 Statement), available at www.ftc.gov/public-statements/2015/08/statement-enforcement-principles-regarding-unfair-methods-competition.

26 *In re Indep. Serv. Orgs. Antitrust Litig.*, 964 F. Supp. 1479, 1491 (D. Kan. 1997) (finding patentee free to license patent products at different rates to different customers), *aff’d* 203 F.3d 1322 (Fed. Cir. 2000).

27 15 U.S.C. § 13(a) (‘It shall be unlawful [...] to discriminate in price between different purchasers of commodities of like grade and quality [...].’).

28 2007 IP Report at 64 (and citations to authorities therein).

alternative technologies. In 1998, the FTC settled allegations that Summit and VISX had violated the antitrust laws by combining substitute patents covering the manufacture and use of photorefractive keratectomy lasers, equipment used for vision correction surgery. According to the FTC, the pool eliminated competition that otherwise would have existed between Summit and VISX for both licensing their patents and leasing equipment to doctors.²⁹

By contrast, pools that combine complementary patents, particularly where the patents are likely to be essential to practise an industry standard, can create substantial integrative efficiencies and are likely to be pro-competitive.³⁰ Parties can reduce antitrust risks associated with forming a pool by employing an independent expert to confirm that patents submitted to the pool are likely to be essential to a standard and thus complementary.

Restrictions in pooling arrangements that limit the ability of pool members to license outside the pool or require members to offer grant-backs to pool members that extend beyond the scope of the pool technologies may also raise competitive concerns.

Patent pools do not need to be open to all members. However, consistent with general joint venture principles, excluding rivals from a pool can raise antitrust concerns if the pool members collectively possess market power and firms excluded from the pool cannot compete effectively in the downstream market for products incorporating IP.³¹ As with restrictions in IP licences more generally, restrictions in pooling arrangements or pool licences are more likely to create antitrust risk if the parties to the arrangement collectively possess market power.

IV STANDARD-ESSENTIAL PATENTS

In *Illinois Tool Works v. Independent Ink, Inc.*, the Supreme Court held that there is no presumption of market power associated with a patent.³² As with other forms of property, market power is a question of fact. Where IP is marketed separately from a product, market power is typically analysed in a relevant technology market, defined by the smallest group of technologies over which a hypothetical monopolist could exercise pricing power.³³ Market power can be established through either direct evidence that the IP owner has raised the price above competitive levels or excluded competition, or with indirect evidence based on market share and other indicia of market power such as entry barriers.³⁴ The same tests apply to standard-essential patents because even where a particular patent is essential to practising a standard, competition between standards or other market facts can limit a standard-essential patent owner's market power.³⁵

Over the past several years, courts and enforcement agencies have considered whether merely seeking an injunction on a standard-essential patent that is subject to a fair, reasonable and non-discriminatory (FRAND) licensing commitment violates the antitrust laws.

In 2013, the FTC charged two firms, Motorola Mobility and Bosch, with engaging in unfair methods of competition by seeking injunctions for infringement of standard-essential

29 *FTC Compl. Against Summit Technology Inc. and VISX, Inc.*, Dkt. No. 9286 (24 March 1998).

30 2007 IP Report at 66–72.

31 *Northwest Wholesale Stationers, Inc. v. Pacific Stationery & Printing Co.*, 472 U.S. 284 (1985).

32 548 U.S. 28, 46 (2006).

33 1995 Licensing Guidelines at 9.

34 *United States v. Microsoft Corp.*, 253 F.3d 34, 51 (DC. Cir. 2001).

35 *Broadcom Corp. v. Qualcomm Inc.*, 501 F.3d 297, 315 (3d. Cir. 2007).

patents subject to a FRAND commitment.³⁶ In both cases, the FTC claimed that the standard-essential patent owner had breached its FRAND commitment by pursuing injunctions against firms willing to license the patents on FRAND terms. The FTC brought its claims under its ‘stand-alone’ Section 5 authority, which, though rarely used, allows the FTC to challenge unfair methods of competition not actionable under the Sherman or Clayton Acts.³⁷ The FTC did not allege that either Motorola Mobility or Bosch had engaged in deception during the standard-setting process or had excluded competition. According to the FTC, the breach of contract was itself an unfair method of competition because breach of a licensing commitment may degrade the integrity of the standard-setting process in the long run.

Federal courts have reached different conclusions. Where the underlying infringement claim is not a sham, courts have held that seeking an injunction is protected petitioning activity that cannot form the basis for an antitrust claim.³⁸ In addition, federal courts applying unilateral conduct standards under the Sherman Act have required a showing of anticompetitive exclusion to support a violation. In *FTC v. Rambus*, the DC Circuit overruled an FTC decision finding that Rambus had violated Section 2 by deceptively failing to disclose that it held patents that read on the developing standard during the standards-development process. According to the FTC, but for that deception, the standards-development organisation would have either selected a different technology or would have required Rambus to commit to license its standard-essential patents on reasonable and non-discriminatory terms. Since the FTC did not prove that one or the other outcome was more likely, the court of appeals reversed the FTC decision, finding that merely evading a contractual commitment could not form the basis for an antitrust claim and the FTC had failed to prove anticompetitive exclusion.³⁹

Disagreements over the terms of a FRAND licence are resolved as matters of contract law in the United States and do not form the basis for an antitrust claim. Though the FTC has brought claims for unfair methods of competition in cases where a standard-essential patent owner allegedly breached a FRAND commitment by seeking injunctions against firms willing to agree to a FRAND licence, the agency chair has stated that a disagreement on the royalty rate or base does not give rise to an antitrust claim.⁴⁰ Courts that have either resolved contractual disputes over the terms of a FRAND licence or set royalty rates for infringement of a standard-essential patent subject to a FRAND commitment have sometimes relied on a modified version of the reasonable royalty framework from a seminal district court

36 *FTC Compl. Against Motorola Mobility LLC and Google Inc.*, Dkt. No. C-4410 (24 July 2013); *FTC Compl. Against Robert Bosch GmbH*, Dkt. No. C-4377 (26 November 2012).

37 Section 5 Statement.

38 See *infra* Section VI; see also *Apple, Inc. v. Motorola Mobility, Inc.*, 886 F. Supp. 2d 1061, 1077 (W.D. Wisc. 2012).

39 *Rambus Inc. v. FTC*, 522 F.3d 456 (D.C. Cir. 2008); see also *Integrat Corp. v. Intel Corp.*, 195 F.3d 1346, 1351 (Fed. Cir. 1999).

40 FTC Chairwoman Edith Ramirez, ‘Standard-Essential Patents and Licensing: An Antitrust Enforcement Perspective’ Address (10 September 2014), available at www.ftc.gov/system/files/documents/public_statements/582451/140915georgetownlaw.pdf.

case, *Georgia-Pacific v. U.S. Plywood*.⁴¹ In *Ericsson v. D-Link*, the Federal Circuit agreed that applying modified *Georgia-Pacific* factors may be appropriate but that the factors must be tailored to the facts of the particular case, including the particular details of the licensing commitment at issue.⁴²

V INTELLECTUAL PROPERTY AND MERGERS

In the United States, acquisitions involving IP rights are evaluated under the same standards and principles as other acquisitions. Thus, a transaction is reportable under the Hart-Scott-Rodino Antitrust Improvements Act (the HSR Act) if the value of the IP rights to be acquired triggers the statutory thresholds, and the parties otherwise meet the regulatory requirements.⁴³

Some transfers of IP rights that fall short of outright sales may also be reportable. Based on informal guidance from the FTC Premerger Notification Office (PNO), exclusive patent or trademark licences may be reportable under the HSR Act. When determining whether a licence is exclusive, PNO has applied the ‘make, use and sell’ approach, which deems licences exclusive where the licensee is granted the exclusive right to develop, manufacture and sell the product without restriction. Licences with only partial exclusivity, for example, in a specific geography, are still deemed exclusive for purposes of determining reportability.

Non-exclusive licences are not typically reportable. However, there is one important exception to that general rule. In 2013, the FTC issued a rule expanding the ‘make, use and sell’ approach for certain exclusive pharmaceutical patent licences that transfer all ‘commercially significant rights’, even where the licensor retains manufacturing rights.⁴⁴ The rule is the first to focus on one particular industry with regard to reportability. The rule was upheld in July 2015 by the DC Circuit and remains in effect today.⁴⁵

Mere acquisition of IP rights without more does not violate the antitrust laws.⁴⁶ Where a merger involving IP would be likely to result in anticompetitive effects, however, the agencies may pursue enforcement action. When evaluating competitive effects, the agencies may consider whether the combination of substitute patents could enhance market power in one or more technology markets. In addition, since IP can be an input into a downstream product market, the agencies may also consider whether the transfer of IP may lessen competition by foreclosing entry or raising a rival’s costs in a downstream market.

From 2011 to 2012, the DOJ investigated a series of mergers involving the acquisition of large patent portfolios that included standard-essential patents or patents subject to open-source commitments, examining whether the mergers would lead to a substantial lessening of competition under Clayton Act Section 7.⁴⁷ The DOJ expressed concerns that

41 318 F. Supp. 1166 (S.D.N.Y. 1970); see, e.g., *In re Innovatio IP Ventures, LLC Patent Litig.*, 2013 WL 5593609, at *5-6 (N.D. Ill. 3 October 2013); *Microsoft Corp. v. Motorola, Inc.*, 2013 WL 2111217 at *3, *12 (W.D.Wash. 25 April 2013).

42 773 F.3d 1201, 1230-31 (Fed. Cir. 2014).

43 15 U.S.C. § 18a; 16 C.F.R. 801-803.

44 78 Fed. Reg. 68,705, 68,706-07 (15 November 2013).

45 *Pharm. Research and Mfrs. of Am. v. FTC*, No. 14-5182 (D.C. Cir. 9 June 2015).

46 *United States v. United Shoe Mach. Corp.*, 110 F. Supp. 295 (D. Mass. 1953), aff’d, 347 U.S. 521 (1954).

47 *Google/Motorola Mobility* (2012), *Rockstar Bidco* (Nortel patents) (2012), *Apple/Novell* (2012).

the acquisitions would change the incentives and ability of the acquirers to alter the terms of prior licensing agreements in ways that would raise costs to downstream product market rivals and restrict competition. Older federal court cases addressed similar scenarios, finding Sherman Act violations where the transfer was made to facilitate infringement actions to block competitors, and where the party acquired all key patents in a field and committed other anticompetitive acts in order to exclude competition.⁴⁸ The DOJ ultimately closed its investigation into all three mergers in large part because the parties made certain commitments, including the promise to license on FRAND terms and not to seek injunctive relief. Notably, the DOJ made clear that its decision to close the investigations regarded the transfer of ownership rights, not the exercise of those rights.

The agencies may also seek remedies involving the assignment of IP rights to address likely anticompetitive effects of broader transactions. In 2013, the FTC approved Honeywell's acquisition of Intermec with conditions, requiring Honeywell to license key patents to a third party. Honeywell and Intermec were two of only three 2D scan engine makers in the US, and the transaction, the FTC alleged, would be anticompetitive – especially given high entry barriers due to existing IP protection. The parties' settlement included a 12-year compulsory licence by Honeywell to a foreign competitor that lacked the IP needed to compete in the US, thereby eliminating the key entry barrier that would have otherwise restricted competition in the US market after the acquisition.⁴⁹

VI OTHER ABUSES

The First Amendment to the US Constitution protects legitimate petitioning activity from antitrust scrutiny except in cases where the conduct is a 'mere sham' to interfere directly with the business of a competitor.⁵⁰ This immunity applies to efforts to influence all branches of government, including the legislature, administrative agencies and courts.⁵¹ In *Professional Real Estate Investors v. Columbia Pictures Industries* (PRE), the Supreme Court held that litigation to enforce IP rights cannot support an antitrust claim unless two conditions are satisfied.⁵² Most importantly, the lawsuit must be objectively baseless in that 'no reasonable litigant could realistically expect success on the merits.' Only if the court finds the suit is objectively baseless may it then consider whether the lawsuit was also subjectively baseless (brought solely to interfere with the business of a competitor rather than seek relief from the court). Where the underlying claim is a sham, filing a lawsuit can constitute attempted monopolisation if there is a dangerous probability the conduct would lead to monopolisation of a properly defined relevant market.

Conduct that is incidental to filing a lawsuit, such as sending infringement notices, is also immune from antitrust liability unless the underlying claim is both objectively and

48 *United States v. Singer Mfg. Co.*, 374 U.S. 174 (1963); *Kobe, Inc. v. Dempsey Pump Co.*, 198 F.2d 416 (10th Cir. 1952).

49 *Honeywell/Intermec* (2013).

50 *Eastern R.R. Presidents Conference v. Noerr*, 365 U.S. 127, 144 (1961).

51 *United Mine Workers v. Pennington*, 381 U.S. 657, 669 (1965); *Cal. Motor Transp. Co. v. Trucking Unlimited*, 404 U.S. 508, 510 (1972).

52 508 U.S. 49, 60 (1993).

subjectively baseless.⁵³ However, several appellate courts have held that the two-part PRE test does not apply where the litigant pursues a pattern of filing baseless lawsuits without consideration of the merits of the underlying claim.⁵⁴

Under *Walker Process v. Food Machinery & Chemical Corp.*, enforcement of a patent procured by fraud on the United States Patent and Trademark Office (PTO) can constitute attempted monopolisation if the other elements of a Section 2 claim are satisfied.⁵⁵ To prevail on a claim for *Walker Process* fraud, the plaintiff must show that the patent was procured by fraud on the PTO and that the patent owner was aware of the fraud at the time it initiated the lawsuit. The plaintiff must also show that the patent would not have issued absent the fraudulent conduct. In addition to showing fraud, the plaintiff must establish the other elements of an attempt to monopolise claim. Appellate courts have held that an antitrust claim for *Walker Process* fraud can succeed even if the underlying infringement litigation is not sham under the Supreme Court's two-part test in *PRE*.⁵⁶

Separate from the federal antitrust laws, the doctrine of patent misuse can provide a defence to an infringement claim where the patent owner takes action that expands the scope of its statutory patent grant. Conduct that constitutes patent misuse does not necessarily support an affirmative antitrust claim even though the doctrine of patent misuse draws on antitrust principles. In most cases, a patent misuse defence can succeed only where the conduct harms competition under a rule of reason analysis. The Patent Act itself bars a claim for misuse based on tying unless the patent owner has market power in the tying product or patented technology.⁵⁷ However, charging royalties beyond the term of a patent remains *per se* unlawful patent misuse without any showing of anticompetitive harm.⁵⁸

While courts in the United States favour settlement of legitimate IP disputes, settlement agreements are not immune from antitrust scrutiny and are instead evaluated under the same principles that apply to other agreements. As noted above, patent settlements in the pharmaceutical sector that include a reverse payment from the owner of a patent on a branded drug to an alleged generic infringer have been the subject of scrutiny from enforcement agencies and have been widely litigated by private plaintiffs as well.

The Drug Price Competition and Patent Term Restoration Act, also referred to as the Hatch-Waxman Act, creates an abbreviated approval process for generic drugs and a mechanism to resolve patent disputes.⁵⁹ A generic applicant that seeks to enter a market for a patent-protected branded drug can file a statement claiming that either its product does not infringe the incumbent's patents or that the patents are invalid. That statement, known as a 'paragraph IV certification', is treated as an act of infringement that allows the branded manufacturer to file suit against the generic for infringement. If the generic filer is successful, it enjoys a 180-day exclusivity period in which no other generic can enter the market.

In infringement cases based on a paragraph IV certification, the patent owner and the potential generic entrant will sometimes reach a settlement agreement that provides for

53 See, e.g., *Globetrotter Software v. Elan*, 362 F.3d 1167, 1376 (Fed. Cir. 2004).

54 *USS-POSCO Indus.*, 31 F.3d 800, 811 (9th Cir. 1994) (citing *California Motor. Transp. Co. v. Trucking Unlimited*, 404 U.S. 508 (1972)).

55 382 U.S. 172 (1965).

56 *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 1072 (Fed. Cir. 1998).

57 35 U.S.C. § 271(d).

58 *Kimble v. Marvel Enters.*, 135 S. Ct. 2401 (2015).

59 21 U.S.C. § 335.

a payment from the patentee to the allegedly infringing generic entrant. Settlements also typically include a generic entry date that falls after the date that the generic likely could have entered had it prevailed in court but before the expiration of the patent.

In *Federal Trade Commission v. Actavis, Inc.*, the Supreme Court held that even in cases where the underlying infringement claim was not a sham, reverse payment settlements are subject to antitrust scrutiny under a Section 1 rule of reason standard.⁶⁰ The Court explained that an ‘unexplained large reverse payment itself would normally suggest that the patentee has serious doubts about the patent’s survival’, suggesting the objective of the settlement is to preserve and share monopoly profits by avoiding price competition.⁶¹ However, the court refused to find that reverse payment settlements were presumptively unlawful, which would effectively shift the burden to the settling parties to prove that the agreement was pro-competitive. The Court held that the anticompetitive effects of a settlement depended on a variety of factors including the size of the payment relative to likely litigation costs and whether the payment provided compensation for other services, and that a plaintiff ‘must prove its case as in other rule-of-reason cases’.⁶²

Since *Actavis*, most district courts have concluded that a non-cash transfer of value from the branded pharmaceutical to the potential generic can constitute a reverse payment. One appellate court has held that the branded pharmaceutical firm’s agreement to refrain from introducing an authorised generic during the first-filer’s 180-day exclusivity period can constitute a reverse payment and support an antitrust claim.⁶³

VII OUTLOOK AND CONCLUSIONS

Enforcement and litigation at the intersection of antitrust and IP is likely to remain most active in the area of pharmaceutical patent settlements as both firms and enforcers test the limits imposed by *Actavis*. On 31 March 2016 the FTC filed a case in federal court alleging that Endo Pharmaceuticals had entered into unlawful settlements with the first generic filers that included an agreement to forgo entry with an authorised generic,⁶⁴ while the Supreme Court has asked the United States to weigh in on whether it should accept a petition to review the Third Circuit’s decision in *King Drug*. These developments and others will continue to define the antitrust landscape for reverse payment settlements in the United States.

60 133 S. Ct. 2223 (2013).

61 Id. at 2236.

62 Id. at 2237.

63 *King Drug Co. v. Smithkline Beecham Corp.*, 791 F.3d 388, 404 (3d Cir. 2015), see Section II, *supra*.

64 Press Release, FTC Sues Endo Pharmaceuticals Inc. and Others for Illegally Blocking Lower-Cost Generic Versions of the Branded Drugs Opana ER and Lidoderm (31 March 2016) available at www.ftc.gov/news-events/press-releases/2016/03/ftc-sues-endo-pharmaceuticals-inc-others-illegally-blocking-lower.

Appendix 1

ABOUT THE AUTHORS

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Lisa Kimmel is a senior counsel in Crowell & Moring's antitrust group. She resides in the firm's Washington, DC office. Lisa's practice covers merger and civil non-merger investigations as well as antitrust counselling often in the information and communication technology and healthcare sectors.

Before joining Crowell & Moring in 2015 Lisa spent nearly five years at the Federal Trade Commission as an attorney adviser on antitrust and competition policy matters for Commissioner and later, Chairwoman, Edith Ramirez. During her time at the FTC, Lisa advised the chairwoman on antitrust enforcement and policy matters across a broad range of sectors, and was her lead adviser on antitrust enforcement and competition policy matters in the technology sector, including matters related to industry standards and the acquisition or assertion of intellectual property rights. Before joining the FTC, Lisa practised with the antitrust group at an AmLaw 100 firm, where she worked in the firm's San Francisco and Washington, DC offices representing clients on antitrust matters in a broad range of industries.

Lisa earned her JD and a PhD in economics from the University of California, Berkeley and is a member of the California and DC bars. She is an active member of the ABA Antitrust Section, where she is vice-chair of the Media & Technology Committee, past editor of the Unilateral Conduct Committee newsletter, and co-editor of a forthcoming revision to the *Handbook on Antitrust Aspects of Standard Setting*.

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Christie L Stahlke is a counsel in Crowell & Moring's antitrust group. From the firm's D.C. office, Christie's practice involves counselling clients on a wide range of antitrust issues, including merger compliance, the interaction of antitrust and intellectual property law, business planning, conduct investigations, and competitor collaborations. Her antitrust experience spans multiple industries, in particular, technology, telecommunications, healthcare, aerospace, energy/natural resources and chemicals. Christie has represented clients

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A dedicated member of the American Bar Association Section of Antitrust Law Intellectual Property Committee, Ms Stahlke is currently co-editor for the Committee's newsletter, Public Domain, and was selected as co-Young Lawyer Representative for the Committee effective 1 September 2016.

Ms Stahlke received her bachelor's degree from the University of California at Berkeley in 2005, and graduated *cum laude* from the American University Washington College of Law in 2010, where she was a member of the American University Administrative Law Review. She is a member of both the California and DC bars.

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