

MEALEY'S® LITIGATION REPORT

# Intellectual Property

## **Attorney's Fees In Intellectual Property Litigation: Obtaining And Maintaining 'Prevailing Party' Status**

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# Commentary

## Attorney's Fees In Intellectual Property Litigation: Obtaining And Maintaining 'Prevailing Party' Status

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### I. Introduction

A litigant that is a “prevailing party” in an intellectual property case may be eligible to recover its attorney’s fees under certain circumstances. This is true whether it is a patent, copyright, or trademark case because all the federal intellectual property statutes contain provisions that permit an award of reasonable attorney’s fees to the prevailing party when the other requirements of the statute are met.<sup>1</sup> Given the high cost of litigation, this recovery can be significant and is available regardless of whether the prevailing party is the plaintiff or defendant. The threshold eligibility issue, however, is a finding that the party seeking fees is a prevailing party. While that may seem like a straightforward determination, in practice it is not always clear. For example, in one recent Federal Circuit case, the court held that if a patent infringement plaintiff voluntarily dismisses its lawsuit without prejudice under Federal Rule of Civil Procedure 41(a)(1)(A)(i), the dismissal may not be considered a “final decision” sufficient to render the defendant a prevailing party eligible to recover attorney’s fees under 35 U.S.C. § 285.<sup>2</sup> Yet in such a case, the defendant unequivocally did prevail since it is no longer

subject to a claim of infringement. This article will analyze what it means to be a prevailing party under the federal intellectual property statutes, explain why that designation is important, examine the relationship between the federal intellectual property statutes and Federal Rule of Civil Procedure 54(d)(2), and discuss what litigation strategies parties may use in order to be deemed a prevailing party at the close of a case to ensure they are eligible to seek recovery of fees.

### II. What Is A “Prevailing Party”?

In most U.S. litigation, each party bears its own attorney’s fees regardless of who wins. In intellectual property litigation, however, Congress included a statutory rubric for the “prevailing party” to recover its attorney’s fees if certain other factors are met.<sup>3</sup> The Patent Act and the Lanham Act (for trademarks) specify that the court “in exceptional cases may award reasonable attorney fees to the prevailing party.”<sup>4</sup> The Copyright Act does not limit the fee award to exceptional cases and instead simply states: “the court may also award a reasonable attorney’s fee to the prevailing party as part of the costs.”<sup>5</sup> The common, threshold issue in all of these statutes is being designated as a prevailing party by the court.<sup>6</sup>

As noted by the U.S. Supreme Court, the term “prevailing party” appears in several federal fee-shifting statutes, and it has been the Court’s policy to interpret this term consistently.<sup>7</sup> The Supreme Court has defined “prevailing party” as “a party in whose favor a judgment is rendered, regardless of the amount of damages

awarded.”<sup>8</sup> In order to qualify, a party must have been awarded some relief by the court resulting in a material alteration in the legal relationship between the plaintiff and defendant.<sup>9</sup> A voluntary change in conduct of a party lacks the necessary judicial imprimatur on the change to permit an award of attorney’s fees, even though the voluntary change may have accomplished what a party sought to achieve in the lawsuit.<sup>10</sup> The Supreme Court has further instructed that a defendant need not obtain a favorable judgment on the merits in order to be a prevailing party.<sup>11</sup> Rather, a defendant is permitted to recover fees whenever the plaintiff’s claim was “frivolous, unreasonable, or groundless” and the case was resolved in the defendant’s favor.<sup>12</sup> Thus, an understanding of what it means to be a prevailing party is critical for a successful motion for attorney’s fees in intellectual property litigation.

### III. Federal Rule Of Civil Procedure 54(d) And Attorney Fee Awards

Federal Rule of Civil Procedure 54 provides one of the mechanisms through which a party may seek to recover their costs and attorney’s fees. While not specific to intellectual property litigation, Rule 54 is invoked when the party moving for costs and attorney’s fees is doing so pursuant to several grounds, including under both federal and state statutory provisions.<sup>13</sup> Rule 54(d)(1) in all types of cases permits costs other than attorney’s fees to be awarded to “the prevailing party.” While Rule 54 does not set forth any specific grounds of eligibility for attorney’s fees, it does list the procedures and requirements for obtaining such an award in section (d)(2). An excerpt of Rule 54(d) demonstrates the relationship between these sections:

(d) Costs; Attorney’s Fees

(1) *Costs Other Than Attorney’s Fees.* [C]osts – other than attorney’s fees – should be allowed to the **prevailing party**. [...]

(2) *Attorney’s Fees.*

(A) *Claim to Be by Motion.* A claim for attorney’s fees and related nontaxable expenses must be made by motion unless the substantive law requires those fees to be proved at trial as an element of damages.

(B) *Timing and Contents of the Motion.* Unless a statute or a court order provides otherwise, the motion must:

- (i) be filed no later than 14 days after the entry of judgment;
- (ii) **specify the judgment and the statute, rule, or other grounds entitling the movant to the award;**
- (iii) state the amount sought or provide a fair estimate of it; and
- (iv) disclose, if the court so orders, the terms of any agreement about fees for the services for which the claim is made.<sup>14</sup>

Accordingly, a party must be deemed a prevailing party in order to be eligible for an award of *costs* at the end of a litigation under Rule 54(d)(1), but there is no such requirement to be eligible for an award of *attorney’s fees* under Rule 54(d)(2). However, Rule 54(d)(2) does require a judgment. Thus, there is a two-step inquiry for attorney’s fee motions brought pursuant to Rule 54(d)(2). First, has there been a “judgment” in the case? What may be considered a judgment was the central issue of *Keith Manufacturing*, analyzed in Section IV, *infra*. Second, does the “statute, rule, or other grounds entitling the movant to the award” of attorney’s fees itself have additional eligibility requirements, such as being a prevailing party that must be satisfied by the movant? This question was examined in *Mossberg* and is analyzed in Section V, *infra*.

### IV. *Keith Manufacturing Co. v. Butterfield*: What Is A ‘Judgment’ Under Rule 54(d)?

*Keith Manufacturing Co.* sued former employee Larry Butterfield, alleging that Butterfield had received a patent based on inventions made during his employment with Keith.<sup>15</sup> Keith asserted several claims against Butterfield, including declaratory judgment of non-infringement, declaratory judgment of invalidity, state-law breach of contract, and state-law misappropriation of trade secrets, as well as to correct the inventorship on the patent. The parties eventually filed a joint stipulation of dismissal with prejudice pursuant to Federal Rule of Civil Procedure 41(a)(1)(A)(ii). Such a dismissal does not require a court order.<sup>16</sup> The stipulation was silent on costs and attorney’s fees.

Twelve days later, Butterfield moved for attorney's fees under Rule 54(d), two Oregon statutes, and 35 U.S.C. § 285. The district court denied the motion, holding that Rule 54(d) requires a judgment, which the parties' stipulation to dismiss with prejudice did not satisfy. The district court made this ruling after consulting Rule 54, which defines a "judgment" as "a decree and any order from which an appeal lies."<sup>17</sup> The district court pointed to the Supreme Court's *Microsoft Corp. v. Baker* decision, which held that a stipulation to dismiss with prejudice is not an appealable order, and ruled that Butterfield was not entitled to recover his attorney's fees under Rule 54.<sup>18</sup> The district court further held that Butterfield was not a prevailing party as required by 35 U.S.C. § 285 because the joint stipulation of dismissal between the parties lacked judicial imprimatur constituting a judicially sanctioned change in the relationship between the parties.<sup>19</sup>

On appeal, the Federal Circuit distinguished *Microsoft*, and found that it was inapplicable to the circumstances in *Keith Manufacturing*.<sup>20</sup> In *Microsoft*, the Supreme Court held that a voluntary dismissal within the context of a class action was not a "final decision" for purposes of appellate jurisdiction under 28 U.S.C. § 1291.<sup>21</sup> This was to prevent a class-action plaintiff from manufacturing finality using a voluntary dismissal with prejudice, thereby avoiding § 1291 by "stopping and starting the district court proceedings with repeated interlocutory appeals" to appeal an adverse class certification decision.<sup>22</sup> The Federal Circuit explained that this concern was not present in *Keith Manufacturing* because it was not a class action and there was no concern with piecemeal appeals. In *Keith Manufacturing*, both parties were able to move for attorney's fees under Rule 54. In class actions, by contrast, only plaintiffs may appeal an adverse class certification ruling. The Federal Circuit also noted that the definition of "judgment" as found in Rule 54 uses the phrase "includes a decree and any order from which an appeal lies" and therefore a judgment is not limited to orders from which an appeal lies. As a result, the Federal Circuit held that a Rule 41(a)(1)(A)(ii) dismissal with prejudice can constitute a judgment for purposes of moving for attorney's fees under Rule 54(d)(2). The Federal Circuit declined to address, however, whether Butterfield qualified as a prevailing party for purposes of awarding fees under the Patent Act and the Oregon state statutes at issue in the case and remanded the case back to the district court for further proceedings.

Less than a week after its decision in *Keith Manufacturing*, the Federal Circuit once again looked at voluntary dismissals under Rule 41, this time analyzing whether a party can recover attorney's fees after a voluntary dismissal without prejudice. In *O.F. Mossberg & Sons, Inc. v. Timney Triggers, LLC*, the Federal Circuit held that a voluntary dismissal without prejudice under Rule 41(a)(1)(A)(i) cannot confer prevailing party status on a defendant seeking attorney's fees under the Patent Act, and therefore the defendant was not eligible for a fee award. At first glance, these two cases appear to be in conflict with each other since both involve motions for an award of attorney's fees in cases dismissed pursuant to Rule 41(a)(1)(A). Upon deeper analysis, however, it becomes clear that the two cases address separate prongs of the two-step eligibility inquiry. *Keith Manufacturing* considered whether a Rule 41(a)(1)(A)(ii) stipulated dismissal with prejudice could be a judgment under Rule 54(d)(2), a necessary prerequisite to a motion for attorney's fees pursuant to that Rule. *Mossberg* picked up where *Keith Manufacturing* left off and considered whether a voluntary dismissal under Rule 41(a)(1)(A)(i) could satisfy the prevailing party requirements of the statute under which the moving party was entitled to the fee award.

#### **V. *O.F. Mossberg & Sons, Inc. v. Timney Triggers, LLC*: Does A Rule 41(a)(1)(A) Voluntary Dismissal Affect Prevailing Party Status?**

O.F. Mossberg & Sons sued Timney Triggers for infringement of a patent relating to a modular trigger for a firearm. Instead of answering the complaint, Timney filed a petition for *inter partes* reexamination, and at Timney's request the district court case was stayed pending the outcome of the IPR. After five years of activity at the USPTO, the Patent Trial and Appeal Board (PTAB) affirmed the invalidity of all asserted claims of the patent. Following the proceedings at the USPTO, Mossberg filed a notice of dismissal without prejudice under Rule 41(a)(1)(A)(i), which permits a plaintiff to voluntarily dismiss an action without a court order by filing a notice of dismissal before the opposing party files an answer to the complaint.<sup>23</sup> The following day, the district court entered a docket text order stating that the case was dismissed without prejudice under Rule 41(a)(1)(A)(i).<sup>24</sup> Following the dismissal, Timney moved for attorney's fees under § 285 of the Patent Act. The district court denied the motion, holding that "Timney was not a 'prevailing party' because a 'Rule 41 dismissal without prejudice

is not a decision on the merits and thus cannot be a judicial declaration altering the legal relationship between the parties.”<sup>25</sup> Timney then appealed, arguing that by staying the case for five years during the battle at the USPTO, the district court provided the necessary judicial imprimatur and that Supreme Court precedent emphasizes substance over form and that a decision on the merits is not necessary to qualify as a prevailing party.<sup>26</sup>

In its decision, the Federal Circuit agreed with Timney in principle that a decision on the merits is not required and that a party may be a prevailing party even if the court’s final judgment rejects the plaintiff’s claim for a nonmerits reason.<sup>27</sup> What the Federal Circuit focused on however, was “whether there was a final decision at all.”<sup>28</sup> Thus, the relevant inquiry is whether there was a judicially sanctioned change in the legal relationship between the parties and not whether the party seeking attorney’s fees “won” or “lost” the case on the merits.<sup>29</sup> Reviewing the record below, the Federal Circuit noted that the stay put in place during the proceedings at the USPTO was the only order issued by the district court. The Federal Circuit held that this stay order could not serve as a judicial decision that changed the legal relationship of the parties because it remained in place while the parties determined the validity of the asserted patent in a separate venue. The change in the legal relationship between the parties was caused by the PTAB’s invalidity decision and Mossberg’s voluntary Rule 41(a)(1)(A)(i) dismissal, not by any judicial action in the district court. This is particularly true because as the court noted, a Rule 41(a)(1)(A)(i) dismissal is effective when filed, and no subsequent court order is required. Even though the district court subsequently entered a dismissal order, it had no legal effect.<sup>30</sup> Thus, even though Timney was successful in fully invalidating the asserted patent, because there was no final decision in the district court, there could be no prevailing party and no eligibility for an award of attorney’s fees under the Patent Act.

## VI. Prevailing Party Analysis In Trademark And Copyright Litigation

Determining prevailing party status is also a threshold inquiry in the availability of attorney’s fee awards under the Lanham Act and the Copyright Act. Several U.S. courts of appeals have addressed whether voluntary dismissals under Rule 41(a)(1)(A) may confer prevailing party status in the context of trademark and copyright

litigation. For example, in *Xlear, Inc. v. Focus Nutrition LLC*, the Tenth Circuit held that a joint stipulated dismissal with prejudice pursuant to Rule 41(a)(1)(A)(ii) does not provide the necessary judicial relief resulting in a change in the legal relationship between the parties required for prevailing party status under the Lanham Act.<sup>31</sup> The court remanded the case back to the district court to determine whether movant Focus Nutrition could still qualify as a prevailing party under its other ground for attorney’s fees, the Utah Truth in Advertising Act, since Utah law has a different definition of and analysis for determining prevailing party status.<sup>32</sup>

In *Balsley v. LFP, Inc.*, the Sixth Circuit held that there was no prevailing party on claims for contributory and vicarious copyright infringement under the Copyright Act because the claims were dismissed pursuant to a joint stipulated dismissal under Rule 41(a)(1) and consequently “the district court made no judicial determination as to a legal change in the relationship of the parties but merely recognized the parties’ own mutual decision to remove those claims from the district court’s consideration.”<sup>33</sup> Notably, the Seventh Circuit has held that a defendant may be deemed a prevailing party for the purpose of an award of attorney’s fees under the Copyright Act when the district court grants a plaintiff’s motion to dismiss, with prejudice, under Rule 41(a)(2).<sup>34</sup> Rule 41(a)(2) provides, in part, that “an action may be dismissed at the plaintiff’s request only by court order, on terms that the court considers proper.”<sup>35</sup> Section (a)(2) of Rule 41, therefore, explicitly provides for the sort of judicial action on the change in legal relationship between the parties required for prevailing party status under federal case law.

In sum, these cases inform that in order to be a prevailing party eligible for an award of attorney’s fees under the federal intellectual property statutes, there must be judicial imprimatur. This requires judicial action that alters or modifies the legal relationship between the parties. The next section of this article provides several recommendations and strategies practitioners should consider to preserve the right to claim prevailing party status at the conclusion of a case.

## VII. Practice Recommendations

Not every case goes to trial or is decided on summary judgment. Very often, the case is resolved for other reasons, be they settlement, a covenant not to sue, or voluntary dismissal. In order to preserve the ability to

recover attorney's fees, however, care must be given to the way the case is resolved and how any dismissal is structured. From the moment the case is instituted, you must know what fee-shifting statutes and rules are in play and what must be done to preserve the ability to recover fees later in the case. This rationale applies equally to plaintiffs and defendants since either party could be the "prevailing party."

First and foremost, care must be taken to ensure that the dismissal order constitutes a "judgment" for purposes of Rule 54(d). The Federal Circuit made clear in *Keith Manufacturing* that a Rule 41(a)(1)(A) voluntary dismissal with prejudice can be a judgment for purposes of seeking attorney's fees under Rule 54. But Rule 41(a)(1)(A) dismissals are without prejudice unless stated otherwise.<sup>36</sup> And as the Federal Circuit held in *Mossberg*, voluntary dismissals without prejudice under Rule 41(a)(1)(A) cannot provide the requisite judicial imprimatur on the dismissal needed to obtain prevailing party status under federal fee-shifting statutes. Thus, to preserve the ability to recover fees, a litigant must ensure both a final judgment and prevailing party status. Additionally, parties may seek attorney's fees on multiple grounds – such as state-law or common-law provisions – and these mechanisms may have a different definition of and analysis to determine prevailing party status.<sup>37</sup>

The most important step to take to preserve the ability to recover fees is to make sure any resolution of the case is sanctioned by a court order since eligibility for attorney's fees is contingent on judicial imprimatur on the change of the legal relationship between the parties. The defendant in *Mossberg* made the mistake of not filing an answer before filing the petition for *inter partes* reexamination and staying the case. Had the defendant filed an answer, the patent owner could not have unilaterally dismissed the case under Rule 41(a)(1)(A)(i). The dismissal would then have had to have been a joint stipulation to dismiss with prejudice or by motion that would have required a court order and subsequent judgment dismissing the case. Filing an answer with a declaratory judgment counterclaim of non-infringement or invalidity can bolster the prevailing party claim even more.

Additionally, when negotiating a settlement or other joint termination of the case, avoid a voluntary stipulated dismissal under Rule 41(a)(1)(A)(ii), which does

not require a court order to be effectuated. While such a dismissal can constitute a judgment for purposes of Rule 54(d), it cannot confer prevailing party status. Rather, seek a dismissal under Rule 41(a)(2), which permits an action to be dismissed at the plaintiff's request, but only by court order.<sup>38</sup> Further, courts have held that a stipulation of dismissal that reserves the issue of attorney's fees and permits the district court to retain jurisdiction over that issue does not qualify as judicial imprimatur on the dismissal of the action.<sup>39</sup> Rather, consider seeking an enforceable judgment on the merits or a court-ordered consent decree (which enforces settlement agreements), both of which have been found to involve sufficient judicial imprimatur to confer prevailing party status.<sup>40</sup> Finally, a party should ensure that the dismissal of the matter is final. Courts have generally held that dismissal without prejudice cannot convey prevailing party status because the defendant remains subject to the risk of the plaintiff refiling the complaint.<sup>41</sup> Several courts have also found that covenants not to sue may be considered to be essentially the same as a dismissal with prejudice.<sup>42</sup>

## VIII. Conclusion

Each of the federal intellectual property statutes contain a provision that may permit a "prevailing party" to an award of attorney's fees under certain circumstances. Prevailing party status is a threshold issue a court must address when determining whether a party is eligible for an award of attorney's fees under these statutes. A prevailing party is one in whose favor a judgment is rendered, regardless of the amount of damages awarded or whether the judgment was on the merits of the case. The crucial qualification for prevailing party status is that the party must have been awarded some relief *by the court* that caused a material alteration in the relationship between the litigants. Therefore, the manner in which a case is resolved can affect prevailing party status. As seen in recent Federal Circuit case law, a case voluntarily dismissed under Rule 41(a)(1) can be considered a judgment for a motion for attorney's fees made under Rule 54(d)(2), but cannot not be considered a final decision by the court imparting the judicial imprimatur necessary for a party to be a prevailing party entitled to attorney's fees under the federal intellectual property statutes. Therefore, when resolving an intellectual property case, it is critical to ensure that resolution of the case is effectuated by court order and that the dismissal is final.

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**Endnotes**

1. See 35 U.S.C. § 285; 15 U.S.C. § 1117; 17 U.S.C. § 505; and 18 U.S.C. § 1836(b)(3)(D).
2. *O.F. Mossberg & Sons, Inc. v. Timney Triggers, LLC*, 955 F.3d 990 (Fed. Cir. 2020).
3. This is in addition to the non-attorney fee “costs” recoverable to the prevailing party under Federal Rule of Civil Procedure 54(d).
4. 35 U.S.C. § 285; 15 U.S.C. § 1117.
5. 17 U.S.C. § 505.
6. *Manildra Milling Corp. v. Ogilvie Mills, Inc.*, 76 F.3d 1178, 1182 (Fed. Cir. 1996).
7. *CRST Van Expedited, Inc. v. EEOC*, 136 S. Ct. 1642, 1646 (2016).
8. *Buckhannon Bd. & Care Home, Inc. v. W. Va. Dep’t of Health & Human Res.*, 532 U.S. 598, 603 (2001) (quoting Black’s Law Dictionary 1145 (7th ed. 1999)).
9. *Xlear, Inc. v. Focus Nutrition, LLC*, 893 F.3d 1227, 1236-1237 (10th Cir. 2018).
10. *Buckhannon*, 532 U.S. at 605.
11. *CRST Van Expedited, Inc.*, 136 S. Ct. at 1652-1653.
12. *Id.*, at 1652.
13. See *Xlear, Inc.*, 893 F.3d at 1231.
14. Fed. R. Civ. P. 54(d)(1)-(2) (emphasis added).
15. *Keith Mfg. Co. v. Butterfield*, 955 F.3d 936, 938 (Fed. Cir. 2020).
16. Fed. R. Civ. P. 41(a)(1)(A)(ii).
17. Fed. R. Civ. P. 54(a).
18. *Keith Mfg., Co. v. Butterfield*, 256 F. Supp. 3d 1123, 1130 (D. Or. 2017).
19. *Id.* at 1135.
20. *Keith Mfg.*, 955 F.3d at 938.
21. *Microsoft Corp. v. Baker*, 137 S. Ct. 1702, 1707 (2017).
22. See *id.* at 1715.
23. Fed. R. Civ. P. 41(a)(1)(A)(i).
24. *O.F. Mossberg & Sons, Inc.*, 955 F.3d at 992.
25. *Id.* (quoting *O.F. Mossberg & Sons, Inc. v. Timney Triggers, LLC*, No. 3:12-cv-00198, 2018 U.S. Dist. LEXIS 156931, at \*14-15 (D. Conn. Sept. 14, 2018)).
26. *O.F. Mossberg & Sons, Inc.*, 955 F.3d at 993.
27. *Id.*, at 992 (citing *CRST Van Expedited, Inc.*, 136 S. Ct. at 1646).
28. *O.F. Mossberg & Sons, Inc.*, 955 F.3d at 993.
29. *Id.*, at 992 (Fed. Cir. 2020).
30. *Id.*, at 993.
31. *Xlear, Inc.*, 893 F.3d at 1239.
32. *Id.*, at 1240-1241.
33. *Balsley v. LFP, Inc.*, 691 F.3d 747, 771-772 (6th Cir. 2012).
34. *Riviera Distribs. v. Jones*, 517 F.3d 926, 928 (7th Cir. 2008).
35. Fed. R. Civ. P. 41(a)(2).
36. Fed. R. Civ. P. 41(a)(1)(B) (“Unless the notice or stipulation states otherwise, the dismissal is without prejudice.”).
37. *Xlear, Inc.*, 893 F.3d at 1240-1241; see also *Keith Mfg.*, 256 F. Supp. 3d at 1132 (“Federal law, however, does not apply to the question of whether a party is entitled to recover attorney’s fees in a diversity case, or when state law provides the rule of decision. . . . Thus, the Court evaluates whether Oregon law provides a



definition of 'prevailing party' that may inform these circumstances. It does.") (citations omitted)).

38. Fed. R. Civ. P. 41(a)(2).
39. *Xlear, Inc.*, 893 F.3d at 1237.
40. *Buckhannon*, 532 U.S. at 604.
41. *RFR Industries, Inc. v. Century Steps, Inc.*, 477 F.3d 1348, 1353 (Fed. Cir. 2007); *see also Oscar v. Alaska Dept. of Educ. and Early Dev.*, 541 F.3d 978, 981 (9th Cir. 2008).
42. *See Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 2007 U.S. Dist. LEXIS 98687 at \*12 (C.D. Cal.

Sept. 26, 2007) ("Though [plaintiff's] voluntary dismissal of its patent infringement claims is without prejudice, the covenant precludes [plaintiffs] from refileing a complaint based on Defendant's actions prior to the filing of [plaintiff's] motion to dismiss."); *Graco, Inc. v. Techtronic Indus., North Am.*, 2010 U.S. Dist. LEXIS 21488, at \*10-11 (D. Minn. Feb. 10, 2010) ("[W]e cannot meaningfully distinguish a Covenant Not to Sue from the dismissal with prejudice [in this case]."); *Ameranth, Inc. v. Genesis Gaming Solutions, Inc.*, 2015 U.S. Dist. LEXIS 53639 at \*15 (C.D. Cal. Apr. 22, 2015) ("Where patentees unilaterally dismiss cases after adverse findings, or move to dismiss them after granting a covenant not to sue, the accused infringer is the prevailing party."). ■

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