



# SHIMOKAJI & ASSOCIATES, P.C.

Intellectual Property Lawyers  
[www.shimokaji.com](http://www.shimokaji.com)

## NEWSLETTER

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We specialize in the litigation and registration of patent, trademark, and copyright matters. The clients we serve range from start-ups to Fortune 500 companies, government entities, and universities. Though located in the US, our expertise and representation has an emphasis in Asia.

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### *US Small Business Administration*

One of the largest US government agencies - Small Business Administration - invited the Firm's founding partner, Michael Shimokaji, to speak last month in Los Angeles on the topic of "Intellectual Property Fundamentals for the Start-Up Company". This US government agency supports the creation and development of start-up companies throughout the US.

More information can be obtained at [info@shimokaji.com](mailto:info@shimokaji.com)



## *Federal Circuit Makes Discoverable Settlement Negotiation Documents*

Patent owners in the US are entitled to damages equal to their lost profits or a reasonable royalty. How the patent owner and the patent infringer establish a reasonable royalty can be the subject of much disagreement. Some evidence of a reasonable royalty is prior licensing agreements for the patent in suit.

The Federal Circuit has now decided that documents related to pre-litigation license negotiations are discoverable. *In re MSTG*. The Federal Circuit further decided that such documents are not protected by the settlement negotiation privilege.

In this case, MSTG sued a number of cell phone service providers. All defendants settled except AT&T. Most settling defendants received a license. MSTG produced the license agreements but refused to produce documents relating to the negotiation of the license agreements. The Federal Circuit found against MSTG.

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