Finding Case Law

CASES

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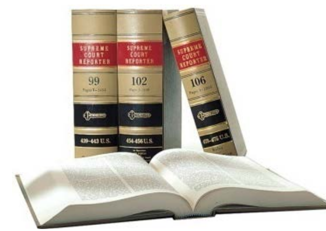

118 OCTOBER TERM, 2006

120 MEDIMMUNE, INC. *v.* GENENTECH, INC.

Opinion of the Court

Maureen E. Mahoney argued the cause for respo
With her on the brief for respondent Genentech, Inc
J. Scott Ballenger, Amanda P. Biles, Daniel M. Wal
A. Flagel, Roy E. Hofer, Meredith Martin Addy, J
Keker, and *Mark A. Lemley*. *Paul M. Smith, Will*
Hohengarten, Ian Heath Gershengorn, Joseph M.
Laura W. Brill, and *Jason Linder* filed a brief for resp
City of Hope.*

JUSTICE SCALIA delivered the opinion of the Court

We must decide whether Article III's limitation of
courts' jurisdiction to "Cases" and "Controversies," r
in the "actual controversy" requirement of the Decl
Judgment Act, 28 U. S. C. §2201(a), requires a pa

*Briefs of *amici cur*
maceutical Association
by *Kenneth C. Bass II*
Defense Council, Inc., by *Scott L. Nelson, Brian Wolfman*, and
E. Wall; and for Three Intellectual Property Professors by *Jay*
Jr., and *A. Samuel Oddi*, both *pro se*.

Briefs of *amici curiae* urging affirmance were filed for the A
Bar Association by *Michael S. Greco, Richard L. Rainey*, and
Remes; for the American Intellectual Property Law Associatio
ward R. Reines, Amber H. Rovner, and *Melvin C. Garner*; for th
Patent Law Association by *Erik Paul Belt*; for a Group of Law P
by *David Hricik, pro se*; for the New York Intellectual Prope
Association by *David F. Ryan* and *Christopher A. Hughes*; for t
maceutical Research and Manufacturers of America by *Marjorie*
ell; for Qualcomm Inc. et al. by *E. Joshua Rosenkranz* and *Alan*
kenheimer; for the Trustees of Columbia University in the City
York et al. by *Jerrold J. Ganzfried, John F. Stanton, Teresa M*
Jennifer A. Sklenar, and *Richard G. Taranto*; for 3M et al. by
Griswold, Steven W. Miller, Q. Todd Dickinson, and *John A. I*

549 U.S. 118

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764 127 SUPREME COURT REPORTER 549 U.S. 118

549 U.S. 118, 166 L.Ed.2d 604

MEDIMMUNE, INC., Petitioner,

v.

GENENTECH, INC., et al.

No. 05–608.

Argued Oct. 4, 2006.

Decided Jan. 9, 2007.

Background: Patent licensee brought action against licensor seeking, inter alia, declaratory judgment as to whether patent was invalid or unenforceable. The United States District Court for the Central District of California, Mariana R. Pfaelzer, Senior District Judge, dismissed declaratory judgment claims, and licensee appealed. The United States Court of Appeals for the Federal Circuit, 427 F.3d 958, affirmed. Petition for certiorari was granted.

Holdings: The Supreme Court, Justice Scalia, held that:

(1) licensee adequately raised and preserved its contract claim;

(2) licensee was not required to terminate or breach license agreement prior to seeking declaratory judgment of patent invalidity, abrogatin
v. Vysis, Inc., 359 F.

(3) Supreme Court w
whether action was
on discretionary grounds.

Reversed and remanded.

Justice Thomas filed a dissenting opinion.

1. Declaratory Judgment ⚿320

Patent licensee's complaint, in declaratory judgment action against licensor, not only alleged that patent was invalid, but also sought interpretation of licensee's contractual obligations under license agreement; first count of amended complaint requested declaratory judgment as to contractual rights and obligations, complaint repeatedly stated that licensee had no obligation to make royalty payments because sale of its product did not infringe any valid claim of patent, and licensee contended further that it had no obligation to pay royalties on an invalid patent, notwithstanding license's requirement that licensee pay royalties until patent claim had been held invalid by a competent body.

2. Federal Courts ⚿461

Patent licensee sufficiently raised its contract claim in declaratory judgment action against licensor before the Court of Appeals so as to preclude finding of waiver, even if licensee limited its contract argument to a few pages of its appellate brief, as limited presentation of claim merely reflected counsel's sound assessment that argument would be futile, given contrary circuit precedent that Court of Appeals panel had no authority to overrule.

3. Declaratory Judgment ⚿62, 65

To satisfy "actual controversy" requirement of the Declaratory Judgment Act, the dispute must be definite and concrete, touching the legal relations of parties having adverse legal interests; the dis
ostantial and
h a decree of
distinguished
what the law
would be upon a hypothetical state of facts. 28 U.S.C.A. § 2201(a).

See publication Words and Phrases for other judicial constructions and definitions.

4. Declaratory Judgment ⚿235

Patent licensee was not required, by constitutional case-or-controversy requirement, to terminate or breach license agreement prior to seeking declaration, under Declaratory Judgment Act, that underlying patent was invalid, unenforceable, and not infringed, and licensee's continued payment of royalties under agreement did not negate existence of actual controversy,

127 S. Ct. 764

[549 U.S. 118]

MEDIMMUNE, INC., Petitioner

v

GENENTECH, INC., et al.

9 U.S. 118, 127 S. Ct. 764, 166 L. Ed. 2d 604, 2007 U.S. LEXIS 1003

[No. 05-608]

Argued October 4, 2006. Decided January 9, 2007.

sion: Federal Constitution's Article III requirement of case or troversy, reflected in Declaratory Judgment Act (28 U.S.C.S. § 2201), d not to require patent licensee to breach license agreement before king declaratory judgment that patent was invalid, unenforceable, or infringed.

Prior history: 427 F.3d 958, 2005 U.S. App. LEXIS 22370

SUMMARY

er a patent application purportedly had matured into patent, an as- of the patent sent to a licensee—with which the assignee, when the ation was pending, had entered into an agreement that allowed the ee to make, use, and sell products covered by the patent and required censee to pay the assignee royalties on the sales—a letter asserting 1) a drug ma tent; and us, under the assignee ies on the dr

licensee thought that it owed no royalties, as the licensee believed he patent was invalid and unenforceable and that in any event the did not infringe the patent. However, because the licensee considered tter to be a clear threat to enforce the patent, terminate the license ment, and sue for patent infringement if the licensee did not pay— such a suit could have resulted in the licensee's being ordered to pay damages and attorneys' fees and being enjoined from selling the drug, allegedly accounted for more than 80 percent of the licensee's sales

SUBJECT OF ANNOTATION

Beginning on page 1047, infra

upreme Court's views as to what, in federal-court patent litigation, case or controversy, within meaning of Article III of Federal onstitution, or actual controversy, within meaning of Declaratory Judgment Act (28 U.S.C.S. § 2201, or similar predecessor)

166 L.Ed.2d 604

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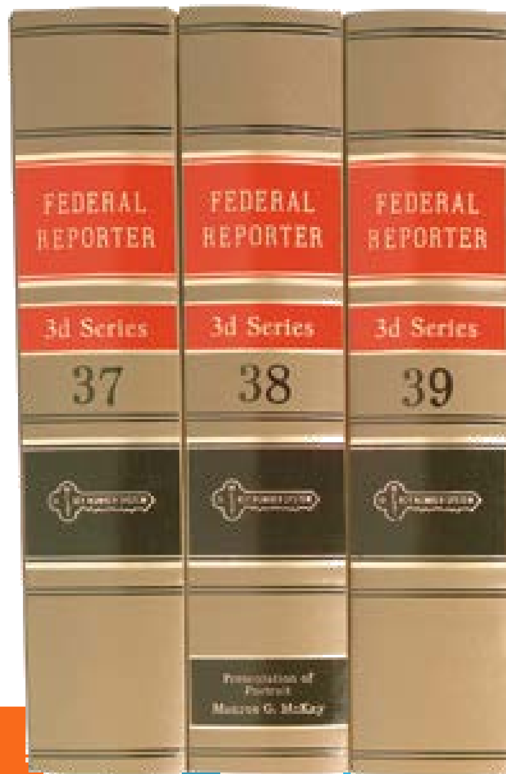

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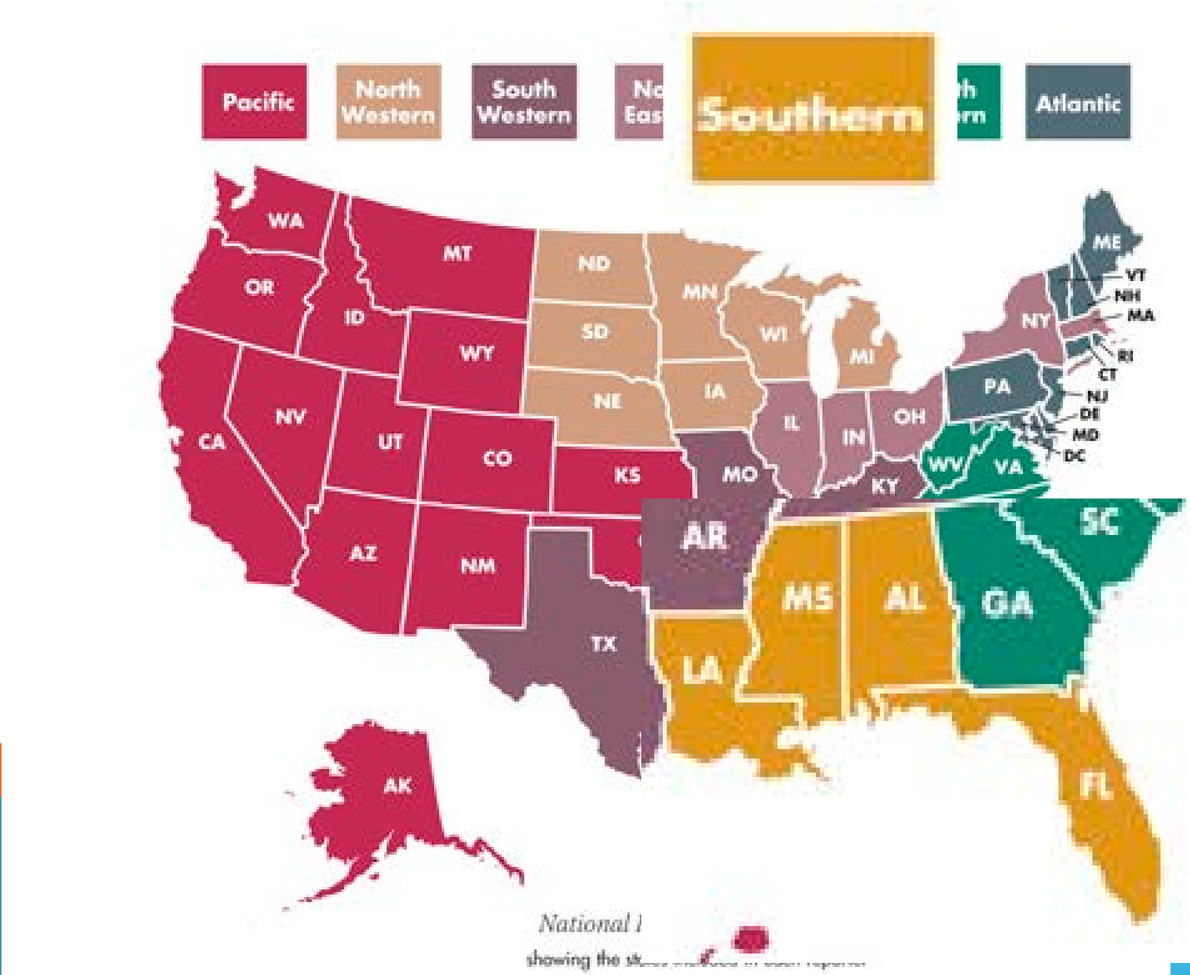

DIGESTS

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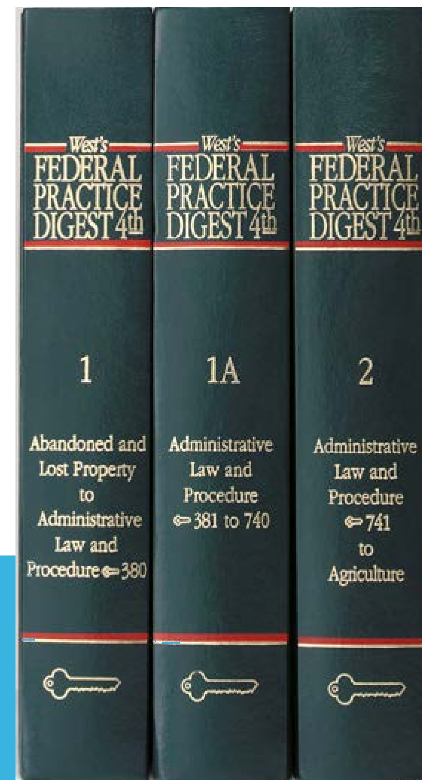
- Provide a headnote for each case

4600. —— Right to fair trial in general.

U.S.Ill. 1997. Constitutional floor established by Due Process Clause of Fourteenth Amendment requires fair trial in fair tribunal before judge with no actual bias against defendant or interest in outcome of his particular case. U.S.C.A. Const.Amend. 14.

Bracy v. Gramley, 117 S.Ct. 1793, 520 U.S. 899, 138 L.Ed.2d 97.



PARTS OF THE DIGEST

- Descriptive Word Index
- Table of Cases
- Topic Outlines
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- Words & Phrases

DIGEST TOPICS

See, also, Outline of the Law by Seven Main Divisions of Law, preceding this section

The topic numbers shown below may be used in WESTLAW searches for cases within the topic and within specified key numbers.

1 Abandoned and Lost Property
2 Abatement and Revival
4 Abortion and Birth Control
5 Absentees
6 Abstracts of Title
7 Accession
8 Accord and Satisfaction
9 Account
10 Account, Action on
11 Account Stated
11A Accountants
12 Acknowledgement
13 Action
14 Action on the Case
15 Adjoining Landowners
15A Administrative Law and Procedure
16 Admiralty
17 Adoption
18 Adulteration
19 Adultery
20 Adverse Possession
21 Affidavits
23 Agriculture
24 Aliens
25 Alteration of Instruments
26 Ambassadors and Cons

42 Assumpsit, Action of
43 Asylums
44 Attachment
45 Attorney and Client
46 Attorney General
47 Auctions and Auctioneers
48 Audita Querela
48A Automobiles
48B Aviation
49 Bail
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79 Clerks of Courts
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98 Convicts
99 Copyrights and Intellectual Property
100 Coroners
101 Corporations
102 Costs
103 Counterfeiting

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How to begin

- Use Topics and Key Numbers from other cases/sources
- Descriptive Word Index
- Outline of Law/ Topic Outline

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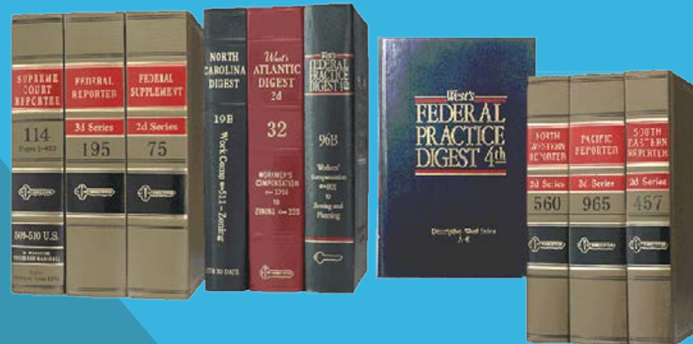
4. Mini-Digest in the REPORTER volumes



FOR EXAMPLE…

You have a client who is a tree farmer…

DESCRIPTIVE WORD INDEX

TIMBER,
Cutting,
Element, Adv Poss ⇐ 23

TREES,
Cutting,
Element, Adv Poss ⇐ 23

Adv Poss = **Adverse Possession**

References are to Digest Topics and Key Numbers

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Property subject to receivership,
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DIGEST VOLUME

⚷23. Cutting timber.

Library references

C.J.S. Adverse Possession §§ 41, 43.

Fla. 1939. The uses of uninclosed land for pasturage, and to cut timber used for commercial purposes and for fuel and fencing purposes, were sufficient to constitute "adverse possession," under statute governing adverse possession under color of title. F.S.A. §§ 95.16, 95.17.
McRae v. Ketchum, 189 So. 853, 138 Fla. 610.

For later cases, see same Topic and Key Number in Pocket Part

parcel in order to perfect title by adverse possession.
Hutchison v. Harrell's Groves, Inc., 234 So.2d 142.

Fla.App. 2 Dist. 1959. Navigable water may form at least part of a substantial enclosure in determining whether land has been acquired by adverse possession.
Tampa Mortg. & Title Co. v. Smythe, 109 So.2d 202.

⚷20. Improvements.

Library references

C.J.S. Adverse Possession § 37.

Fla. 1951. Where former mortgagee, after contiguous improved lots damaged by hurricane had been conveyed to her by quitclaim deed in payment of debts secured by purchase-money mortgages, made repairs and maintained the property in a condition corresponding with other property in the neighborhood, the property, considering its nature and location, was "usually improved" within meaning of statutory definitions of possession and occupation for purposes of adverse possession. F.S.A. §§ 95.17, 95.19.
Baldwin Co. v. Mason, 52 So.2d 668.

⚷21. Cultivation.

Library references

C.J.S. Adverse Possession § 38.

Fla.App. 1 Dist. 1974. Where possessor's predecessors in title actually used the land from before 1920 until present time for raising peanuts and chufa and for grazing cattle and hogs, possession was actual and continuous for purposes of establishing title by adverse possession.
Porter v. Lorene Inv. Co., 297 So.2d 622.

Fla.App. 2 Dist. 1972. Purpose of statute, which provides that for purpose of constituting an adverse possession land shall be deemed to have been possessed and occupied where it has been cultivated or it has been protected by a substantial enclosure, was to substitute readily provable fact of enclosure or cultivation for unpredictable outcome of cases in which subjective intent of possessor is put in issue. F.S.A. § 95.17.
Meyer v. Law, 265 So.2d 737, quashed 287 So.2d 37.

⚷22. Pasturage.

Library references

C.J.S. Adverse Possession § 39.

Fla. 1939. The uses of uninclosed land for pasturage, and to cut timber used for commercial purposes and for fuel and fencing purposes, were sufficient to constitute "adverse possession," under statute governing adverse possession under color of title. F.S.A. §§ 95.16, 95.17.
McRae v. Ketchum, 189 So. 853, 138 Fla. 610.

Fla.App. 1 Dist. 1991. Evidence supported deed grantee's claim to disputed property by adverse possession without color of title; grantee kept livestock fenced within disputed area for more than 20 years, and grantee's predecessors held deed that purported to cover disputed area prior to change in law that required showing that land was returned for taxes. West's F.S.A. § 95.18.
Bailey v. Hagler, 575 So.2d 679, review denied 587 So.2d 1327.

Fla.App. 1 Dist. 1974. Where possessor's predecessors in title actually used the land from before 1920 until present time for raising peanuts and chufa and for grazing cattle and hogs, possession was actual and continuous for purposes of establishing title by adverse possession.
Porter v. Lorene Inv. Co., 297 So.2d 622.

⚷23. Cutting timber.

Library references

C.J.S. Adverse Possession §§ 41, 43.

Fla. 1939. The uses of uninclosed land for pasturage, and to cut timber used for commercial purposes and for fuel and fencing purposes, were sufficient to constitute "adverse possession," under statute governing adverse possession under color of title. F.S.A. §§ 95.16, 95.17.
McRae v. Ketchum, 189 So. 853, 138 Fla. 610.

⚷24. Occasional or temporary use or occupation.

Library references

C.J.S. Adverse Possession § 35 et seq.

Fla.App. 1 Dist. 1962. Defendant did not acquire title by adverse possession as to subdivision lot which was in wooded area, whose boundaries were not marked, which was not cultivated, improved, or fenced, and as to which defendant had tax deed, even though defendant visited lot on number of occasions, often ate picnic lunches there, and once roughly staked out outline of building he contemplated constructing.
Stewart v. Gadarian, 141 So.2d 289.

⚷25–26. *For other cases see earlier editions of this digest, the Decennial Digests, and WESTLAW.*

Library references

C.J.S. Adverse Possession.

UPDATING DIGEST

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advance adoption of special needs children, permits but does not require states to pay retroactive adoption maintenance subsidies when an adopted child is determined to be special needs postadoption. Social Security Act, § 470 et seq., as amended, 42 U.S.C.A. § 670 et seq.—Greenfield v. Department of Children and Family Services, 794 So.2d 739.

Adoptive parents of special needs children were not entitled to receive retroactive adoption assistance subsidy payments when their children were determined to be special needs postadoption, as legislative intent as expressed in statute was to restrict payment of adoption subsidies only to those circumstances where placement could otherwise not be made, and both children were placed without a subsidy. West's F.S.A. § 409.166.—Id.

Denying adoptive parents' request for retroactive adoption maintenance subsidies did not deny their adoptive children's right to equal protection of the law, where children were determined to be special needs postadoption; state's policy of conserving its financial resources through the adoption out of foster care special needs children provided rational basis for treating special needs children in foster care differently than special needs children who had already been adopted. U.S.C.A. Const.Amend. 14; West's F.S.A. § 409.166(1).—Id.

ADVERSE POSSESSION

I. NATURE AND REQUISITES.

(A) ACQUISITION OF RIGHTS BY PRESCRIPTION IN GENERAL.

Library references
C.J.S. Adverse Possession §§ 2 et seq., 25 et seq., 30 et seq., 48 et seq., 54 et seq., 59 et seq., 149 et seq., 206 et seq., 210 et seq., 327 et seq.

⚷1. Nature and grounds of prescription.

Fla.App. 1 Dist. 2007. Adverse possession is not favored and all doubts are resolved in favor of the owner.—Candler Holdings Ltd. I v. Watch Omega Holdings, L.P., 947 So.2d 1231.

Fla.App. 5 Dist. 2004. Acquisition of rights by one in the lands of another, based on possession or use, is not favored in the law, and the acquisition of such rights will be restricted.—Bentz v. McDaniel, 872 So.2d 978.

⚷8(1). In general.

Fla.App. 1 Dist. 2001. When a public entity has acquired an easement for a street right-of-way, with the fee title to the center of the street remaining in the owners of the property abutting each side of the dedicated street, one owner of abutting property cannot acquire fee simple title to the other owner's half of the dedicated street by adverse possession.—Brown v. O'Dea, 786 So.2d 1289.

⚷13. Character and elements of adverse possession in general.

Fla.App. 1 Dist. 2007. An adverse possession claimant who does not have color of title must show seven years of open, continuous, actual possession, hostile to all who would challenge such possession, must both pay all taxes for the seven year period, returning said land for taxes during the first year of occupation, and enclose or cultivate said lands for the seven year period; with color of title, the claimant must show he entered into possession of the premises under a claim based upon a written instrument of conveyance of the premises in question, or deed, or judgment of a competent court, and there has been a continued occupation and possession of the premises. West's F.S.A. §§ 95.16, 95.18.—Candler Holdings Ltd. I v. Watch Omega Holdings, L.P., 947 So.2d 1231.

Public policy and stability of society requires strict compliance with the appropriate statutes by those seeking ownership through adverse possession. West's F.S.A. §§ 95.16, 95.18.—Id.

The possession of the real property by the one asserting a claim of adverse possession must be continuous, adverse, and exclusive of any other right. West's F.S.A. §§ 95.16, 95.18.—Id.

Fla.App. 4 Dist. 2002. Title to trapezoid area, which was one of two dominant estates, was in owners of servient estate, despite claims of owners of other dominant estate, that they had adversely possessed or acquired prescriptive easement to property, given that prior owner, who had owned all three parcels had conditionally conveyed property to purchasers of servient estate, conditions were fulfilled when other dominant estate was sold, and purchasers of dominant estate could not show 20 years of continuous use of parcel.—Tyler v. Price, 821 So.2d 1121, rehearing denied, review granted 842 So.2d 845, decision approved 890 So.2d 246, rehearing denied.

Fla.App. 5 Dist. 2005. One may acquire property by adverse possession under either available statutory method, by color of title or without color of title; however, under either statutory method, the possession of the real property by the one asserting the right must be continuous, adverse, and exclusive of any other right. West's F.S.A. §§ 95.16, 95.18.—Mullins v. Colbert, 898 So.2d 1149.

Fla.App. 5 Dist. 2004. In adverse possession, the right is acquired by actual, continuous, and uninterrupted use by the claimant of the lands of another for a prescribed period; in addition, the use must be adverse under claim of right and must either be with the knowledge of the owner or so open, notorious, and visible that knowledge of the use of the claimant is imputed to the owner.—Bentz v. McDaniel, 872 So.2d 978.

(D) DISTINCT AND EXCLUSIVE POSSESSION.

Library references
C.J.S. Adverse Possession § 54.

⚷36. Possession exclusive of others.

Fla.App. 1 Dist. 2007. The possession of the real property by the one asserting a claim of adverse possession must be continuous, adverse, and exclusive of any other right. West's F.S.A. §§ 95.16, 95.18.—Candler Holdings Ltd. I v. Watch Omega Holdings, L.P., 947 So.2d 1231.

(E) DURATION AND CONTINUITY OF POSSESSION.

Library references
C.J.S. Adverse Possession § 202.

⚷44. Continuity in general.

Fla.App. 1 Dist. 2007. The possession of the real property by the one asserting a claim of adverse possession must be continuous, adverse,

† This Case was not selected for publication in the National Reporter System

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