



# PATENT HAPPENINGS®

A publication by MATTHEWS PATENT-LAW CONSULTING on  
judicial, legislative, and administrative developments in U.S. patent law

## HIGHLIGHTS

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## JUDICIAL HAPPENINGS

### Upping the Proof Requirements for Damages

One of the more controversial provisions of the proposed patent-law reform concerns the mandatory apportionment analysis required in assessing reasonable royalty damages for patent infringement when the entire-market-value rule does not apply. Indeed, Chief Judge Michel of the Federal Circuit twice wrote to Congress in 2007 stating the view that a mandatory apportionment analysis was not needed and would overburden the courts.<sup>1</sup> Not surprisingly, when presented with a case that addressed the alleged evils the proposed apportionment provision sought to address in reasonable royalty awards, the Federal Circuit, in an extensive analysis for the court penned by Judge Michel, attempted to demonstrate how and why the current law of patent damages adequately deals with determining reasonable royalty awards.

In *Lucent Tech., Inc. v. Gateway, Inc.*, No. 2008-1485, -1487, -1495, 2009 WL 2902044 (Fed. Cir. Sept. 11, 2009), a jury found that three Microsoft products, including Outlook, infringed a patent based on a “date-picker function” present in these programs. The patentee asserted that a reasonable royalty for the date-picker feature was 8% of the sales revenue of the three software products, and therefore asked the jury to award \$561.9 million dollars. Microsoft argued that a proper royalty would be a lump-sum payment of \$6.5 million dollars. The jury awarded a lump-sum royalty of approximately \$358 million. On appeal, the Federal Circuit vacated the damages award and

<sup>1</sup> See *Patent Happenings*, June 2007 at p.5 (discussing Judge Michel’s letters of May 3, 2007 and June 7, 2007).

remanded for a new trial on damages because the award lacked substantial evidence in the record, and in fact was against the “clear weight” of the record evidence. *Id.* at \*29.

To support the award, the patentee introduced into evidence eight prior license agreements that allegedly showed that the jury’s lump-sum royalty was reasonable. Assessing these agreements, the Federal Circuit instructed that the patentee “had the burden to prove that the licenses were sufficiently comparable [to the infringement scenario] to support the lump-sum damages award.” *Id.* at \*22. According to the Federal Circuit, the patentee failed to meet its burden.

As a first ground for finding insufficient proof to sustain the award, the Federal Circuit noted that the patentee failed to explain how several of the proffered license agreements concerned the same or similar technical subject matter as the patented technology. *Id.* The court found that the only thing these prior agreements had in common with the infringement was that the prior agreements used a lump-sum royalty of approximately the same magnitude as the jury’s damage award. The court held this was insufficient since “a lump-sum damages award cannot stand solely on evidence which amounts to little more than a recitation of royalty numbers, one of which is arguably in the ballpark of the jury’s award, particularly when it is doubtful that the technology of those license agreements is in any way similar to the technology being litigated here.” *Id.*

The court also found fault with the patentee relying on several agreements that used running royalties instead of a lump-sum royalty. The court refused to adopt a *per se* rule that evidence of a running royalty can never be probative of a lump-sum royalty. But it did hold that “[f]or a jury to use a running-royalty agreement as a basis to award lump-sum damages, however, some basis for comparison must exist in the evidence presented to the jury.” *Id.* at \*23. Examining the patentee’s evidence, the court found there was no testimony that allowed the jury to “recalculate in a meaningful way the value of any of the running royalty agreements to arrive at the lump-

sum damages award.” *Id.* at \*23. Hence, these agreements could not support the damages award.

Considering the economic dynamics of the prior license agreements, the court also found that agreements licensing an entire patent portfolio had little relevance to the hypothetical negotiation that only addressed the single patent found to be infringed. *Id.* at \*24. Additionally, the court found that the absence of any evidence showing that the importance of the licensed technology to the licensee’s products in the prior agreements was comparable to the importance of the infringing feature to Microsoft’s Outlook product cast further doubt on the probative value of the prior license agreements to the reasonable royalty analysis. *See id.* at \*24-\*25.

Addressing the “apportionment” issue, the Federal Circuit noted that the “date-picker” feature in Outlook was “but a tiny part of a much larger software program.” It instructed that “the glaring imbalance between infringing and non-infringing features must impact the analysis of how much profit can properly be attributed to the use of the date-picker compared to non-patented elements and other features of Outlook.” *Id.* at \*26.

Further noting that the accused Outlook program had many non-infringing features, the court instructed that “[t]he damages award can’t be supported by evidence that the infringers also used additional, non-infringing features. ... The damages award ought to be correlated, in some respect, to the extent the infringing method is used by consumers.” *Id.* at \*28.

The Federal Circuit also instructed that the parties should have considered the actual usage of the date-picker feature by the users of Outlook during the damages period in determining whether the magnitude of the lump-sum royalty was reasonable. Relying on the “book of wisdom”<sup>2</sup> the Federal Circuit stated that “neither precedent nor economic logic requires us to ignore information about how often a patented invention has been used by infringers.” *Id.* at \*26. It

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<sup>2</sup> *See generally*, Robert A. Matthews, Jr., ANNOTATED PATENT DIGEST § 30:87 Use of Hindsight and the “Book of Wisdom” in Reasonable Royalty Determinations [hereinafter APD].

found that “the evidence of record is conspicuously devoid of any data about how often consumers use the patented date-picker invention.” *Id.* at \*27. While noting that minimal circumstantial evidence that at least one customer likely used the date-picker feature sufficed to sustain the liability verdict on indirect infringement, *see id.* at \*11-\*12,<sup>3</sup> that evidence was insufficient to support the lump-sum royalty award as it only provided speculation as to the actual use made of the date-picker feature. The patentee “had the burden to prove that the extent to which the infringing method has been used supports the lump-sum damages award,” and failed to meet that burden. *Id.* at \*28.

The Federal Circuit’s guidance on the need to have evidence of actual usage of the infringing technology potentially could conflict with prior precedent that a patentee can rely on optimistic sales forecasts existing when infringement first began even if these forecasts are never achieved.<sup>4</sup> The court noted in *Lucent*, that data of “evidence of usage after infringement started,” “sales projections based on past sales, consumer surveys, focus group testing, and other sources” can be helpful in assessing whether a royalty is reasonable. *Id.* at \*27. It further instructed that where such evidence “meets admissibility requirements, ought to be given its proper weight, as determined by the circumstances of each case.” *Id.* But the court did not give any guidance as to what weight should apply to a sales projection existing when infringement first began where evidence of actual later sales shows that the forecast was not achieved.<sup>5</sup>

<sup>3</sup> *See generally*, APD § 10:37 Prerequisite Showing of Direct Infringement and § 10:40 Circumstantial Evidence of Direct Infringement.

<sup>4</sup> *See e.g.*, *TWM Mfg. Co. v. Dura Corp.*, 789 F.2d 895, 899 (Fed. Cir. 1986) (ruling that the district court did not abuse its discretion in using an infringer’s projected profit forecasts in determining a 30% reasonable royalty rate and not considering infringer’s evidence that those forecasts were not realized); ; *see also Radio Steel & Mfg. Co. v. MTD Prods., Inc.*, 788 F.2d 1554, 1557 (Fed. Cir. 1986) (upholding royalty rate of 10% even though it exceeded the infringer’s actual profits).

<sup>5</sup> *Cf. Interactive Pictures Corporation v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1384-85 (Fed. Cir. 2002) (finding that

In view of its finding that the proffered license agreements did not support the lump-sum royalty awarded by the jury, that the infringing feature was just a small part of the overall software product, and the evidence of usage of the infringing feature was speculative, the Federal Circuit concluded the substantial evidence did not support the jury’s damage award. It cautioned district courts that “on post-trial JMOL motions, district court judges must scrutinize the evidence carefully to ensure that the ‘substantial evidence’ standard is satisfied, while keeping in mind that a reasonable royalty analysis ‘necessarily involves an element of approximation and uncertainty.’” *Id.* at \*29. Hence, while *Lucent* does not appear to substantively alter the law of reasonable royalty damages, it does instruct the courts to exercise a greater watchful eye on whether evidence alleged to support a damages award truly supports the advocated position.

The *Lucent* court also addressed the applicability of the entire-market-value rule<sup>6</sup> to reasonable royalty determinations. First, the court noted that in view of the patentee’s failure to show that the “date-picker” feature drove the sales of Outlook, the entire-market-value rule could not apply. *Id.* at \*30-\*31. But the court also

explained that even where the predicates for applying the entire-market-value rule are not met, parties may still base a reasonable royalty on the selling price of the overall product so long as the royalty rate is sufficiently small so that it reflects that the patented feature is just a small component of the overall product that is not driving the sales of the product. Thus, “the base used in a running royalty calculation can always be the value of the entire commercial embodiment, as long as the magnitude of the [royalty] rate is within an acceptable range (as determined by the evidence). ... Microsoft surely would have little reason to complain about the supposed application of the entire market value rule had the jury applied a

the failure to meet sales projection did not undermine their use in a reasonable royalty analysis where the projection was not shown to have been “grossly excessive or based only on speculation and guesswork”).

<sup>6</sup> *See generally*, APD § 30:58 Substantive Aspects of the Entire Market Value Rule.

*On post-trial JMOL motions, district court judges must scrutinize the evidence carefully to ensure that the ‘substantial evidence’ standard is satisfied.*

royalty rate of 0.1% (instead of 8%) to the market price of the infringing programs.” *Id.* at \*32.<sup>7</sup>

### **Expanding Defensive Claim Preclusion**

The doctrine of claim preclusion bars a suit where the plaintiff effectively seeks to relitigate a claim that was, or could have been, litigated in an earlier suit between the same parties or their privies.<sup>8</sup> In some circumstances in patent litigation, claim preclusion may bar an accused infringer from challenging the invalidity or enforceability of an asserted patent in a second infringement action based on the accused infringer’s failure to prove the invalidity or unenforceability of that patent in a first infringement action, i.e., “offensive claim preclusion.”<sup>9</sup> In other circumstances, claim preclusion may bar a patentee from asserting an infringement claim in a second suit regarding the same patent that was held not to be infringed in an earlier suit, i.e., “defensive claim preclusion.”<sup>10</sup>

Federal Circuit law holds that claim preclusion can apply, either offensively or defensively, only if the accused product or process at issue in the second suit is “essentially the same” as the accused product at

issue in the first suit.<sup>11</sup> Further, “[a]ccused products ‘are ‘essentially the same’ where the differences between them are merely ‘colorable’ or ‘unrelated to the limitations in the claim of the patent.’”<sup>12</sup>

Potentially expanding the defensive use of claim preclusion based on a prior judgment of noninfringement, the Federal Circuit held in *Nystrom v. Trex Co., Inc.*, No. 2009-1026, 2009 WL 2871357, \*3-\*4 (Fed. Cir. Sept. 8, 2009), that the analysis of whether an accused product in a second suit is “essentially the same” as a previously adjudicated product focuses on the claim limitations that were relevant to the prior adjudication of noninfringement. Hence, differences in the second accused product regarding unclaimed features, and features relating to limitations not germane to the resolution of the first infringement action are “colorable variations” that do not prevent the application of claim preclusion.

In *Nystrom*, the patentee filed a first infringement action against an accused infringer on a first accused product. In the first action, the patentee failed to prove literal infringement and was found to have waived the right to assert infringement under the doctrine of equivalents. The patentee, thereafter filed a second infringement action, against the same accused infringer, asserting that a second accused product, one that allegedly did not exist during the pendency of the first suit, infringed under the doctrine of equivalents the patent asserted in the first action. The parties did not dispute that the second accused product had differences from the first accused product that directly related to some of the claim limitations. Nevertheless, the accused infringer argued that claim preclusion barred the patentee’s second suit because the second accused product contained the identical features that the court in the first action relied on to find that the first accused product did not infringe even though the second accused product had other “material” differences from the first accused product.<sup>13</sup> Noting that the admitted differences

<sup>7</sup> *But cf. Uniloc USA, Inc. v. Microsoft Corp.*, 2009 WL 3106555, \*23 (D.R.I. Sept. 29, 2009) (for claims directed a software activation feature, patentee’s trial counsel using a pie chart comparing the total sales revenue received by the accused infringer from its software sales to the requested royalty for infringement of the activation feature was improper since the entire-market-value rule did not apply, and the referral to total sales revenues could not be condoned as merely being a “gut-check” on the reasonable royalty advocated by the patentee – “[U]se of a large pie stuffed with desirable features of Windows and Office to make a royalty slice for PA seem small and reasonable, combined with repeated references to the numbers under the guise of a ‘gut-check’, encourages exactly what the rule seeks to prevent-awarding damages far in excess of the contribution of the precise patented invention.”).

<sup>8</sup> *See generally*, APD § 38:2 In General; and § 38:7 Bars All Issues that Were Raised or Could Have Been Raised.

<sup>9</sup> *See generally*, APD § 38:15 Barring Defenses where Same Patent is Asserted Against a Different Accused Product of a Prior Action.

<sup>10</sup> *See generally*, APD § 38:16.50 May Patentee Bring Second Infringement Suit on Same Patent but Different Product. *See also* § 38:15.50 May Patentee Bring Second Infringement Suit on Same Patent and Same Product; and § 38:16— “Claim Splitting” – Barring Second Suits Asserting Different Claims of Same Patent.

<sup>11</sup> *Foster v. Hallco Mfg. Co.*, 947 F.2d 469, 479-80 (Fed. Cir. 1991).

<sup>12</sup> *Roche Palo Alto LLC v. Apotex, Inc.*, 531 F.3d 1372, 1379-80 (Fed. Cir. 2008)

<sup>13</sup> Since the accused infringer’s arguments focus on two specific claim limitations and specific features of the second product, it might appear that “issue preclusion” rather than “claim preclusion” should have been the preclusion doctrine analyzed. But, in this case, the question of infringement under the doctrine of equivalents was never actually litigated in the first suit due to the patentee’s



between the two products implicated limitations of the asserted patent claims, the district court rejected the accused infringer's contention that claim preclusion applied.<sup>14</sup> On appeal, the Federal Circuit reversed.

The Federal Circuit implicitly rejected the contention that material differences between the first and second accused products that relate to any claim limitation prevent applying claim preclusion. Rather, the court reasoned that if the second accused product is unchanged from the first accused product with respect to the claim limitations that formed the basis of the noninfringement judgment, then claim preclusion applies to bar an infringement action on the second accused product. *Id.* at \*3. Considering the three differences between the first and second accused products that the patentee had identified, the Federal Circuit held that these differences were only "colorable variations" because they did not impact whether the second accused product met the two claim limitations found not to be met by the first accused product in the first action. *Id.* at \*4. The Federal Circuit, therefore concluded that "[g]iven that the [second accused products] remain materially identical to the [first accused products] with respect to the pertinent claim limitations at issue, this court cannot under *res judicata* permit Nystrom to have a second bite at the apple." *Id.*

As a practical consequence, *Nystrom's* holding allows accused infringers to introduce a redesigned product that changes material features of a previously adjudicated non-infringing product so long as the redesigned product has essentially the same structure that supported the noninfringement finding in the earlier case even if *issue* preclusion cannot apply. It is unclear how *Nystrom* will apply, if at all, where the first action is dismissed with prejudice on procedural

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waiver of that argument. Issue preclusion only applies where an issue was "actually litigated." See RESTATEMENT (SECOND) OF JUDGMENTS § 27, cmt. e. ("In the case of a judgment entered by confession, consent, or default, none of the issues is actually litigated. Therefore, the rule of this Section does not apply with respect to any issue in a subsequent action."); see generally, APD § 38:47 Requirement that Issue be Actually Litigated in Prior Adjudication. Because the issue of infringement under the doctrine of equivalents was never actually litigated in the first action, issue preclusion arguably would not apply.

<sup>14</sup> 553 F. Supp. 2d 628, 632-33 (E.D. Va. May 16, 2008). Although refusing to find that claim preclusion applied, the district court granted the accused infringer summary judgment of noninfringement on the merits.

grounds with no clear indication that any specific claim limitations were lacking in the first accused product.<sup>15</sup>

It seems unlikely, that patentees will be able to take advantage of *Nystrom's* focus on individual claim limitations for purposes of offensive claim preclusions. To prove infringement, the patentee needs to show that each and every claim limitation is met by the accused product. Hence, if a second accused product has a change that is more than colorable that relates to *any* claim limitation, there may be an argument that the second accused product is not "essentially the same" as the first accused product.<sup>16</sup>

### **"Each" Limited Scope of "Comprising"**

Using "comprising" as a transition term in a claim generally signifies "that the claims do not exclude the presence in the accused apparatus or method of factors in addition to those explicitly recited."<sup>17</sup> Nonetheless, "[w]hile 'comprising' permits the presence of additional unrecited components, its application may not be extended so broadly as to alter or abrogate a claim limitation ...."<sup>18</sup> The Federal Circuit's recent opinion in *In re Skvorecz*, No. 2008-1221, 2009 WL 2780366, \*3-\*4 (Fed. Cir. Sept. 3, 2009), illustrates this principle.

The claim before the Patent Office in *Skvorecz*, recited "a wire chafing stand *comprising* a first rim of wire steel ... having *at least two* wire legs with *each wire leg* having two upright sections ... and ... a

<sup>15</sup> See *Pactiv Corp. v. Dow Chem. Co.*, 449 F.3d 1227, 1230 (Fed. Cir. 2006) ("A dismissal with prejudice is a judgment on the merits for purposes of claim preclusion.")

<sup>16</sup> E.g. *Acumed LLC v. Stryker Corp.*, 525 F.3d 1319, 1324, 1326 (Fed. Cir. 2008) (second accused product was not "essentially the same" as a first product, where second product had a different nail length, and nail length was a claim limitation). But see *Roche Palo Alto LLC v. Apotex, Inc.*, 531 F.3d 1372, 1379-80 (Fed. Cir. 2008) (second product was "essentially the same" as a first product, even though it had a different concentration of a claimed chemical where the chemical concentration was claimed in the patent as a range, and the second product's concentration fell within the literal scope of the recited range).

<sup>17</sup> *Vivid Tech., Inc. v. American Science & Eng'g., Inc.*, 200 F.3d 795, 811, (Fed. Cir. 1999); see generally, APD § 4:38 "Comprising" as Transitional Term Permits Presence of Unrecited Elements.

<sup>18</sup> APD § 4:39 Cannot Contort "Comprising" to Alter or Vitiolate a Claim Limitation.

plurality of offsets located either in said upright sections of *said* wire legs.” The Board, applying what it viewed was the “broadest reasonable” construction of the claim, determined that the claim permitted the presence of wire legs that lacked the recited offsets so long as there were at least two other wire legs that had the recited offsets. Reversing the ensuing anticipation rejection, the Federal Circuit held that the Board erred because the Board’s construction read out the requirement that “each” leg have the recited offset. *Id.* at \*3-\*4.<sup>19</sup>

Addressing the concept of the “broadest reasonable construction,”<sup>20</sup> perhaps in response to recent public criticism, the Federal Circuit explained that the “broadest reasonable construction” concept does not rise to the status of being a rule of claim construction. *Id.* at \*3. Instead, the “protocol is solely an examination expedient, not a rule of claim construction.” *Id.* “Its purpose is to facilitate exploring the metes and bounds to which the applicant may be entitled, and thus to aid in sharpening and clarifying the claims during the application stage, when claims are readily changed.” *Id.* Stating the obvious, the Federal Circuit further instructed that “[t]he protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation.” *Id.* Unfortunately, the court did not elaborate further as to whether, when giving claims a “legally” correct construction, the PTO should consider disclaimers of claim scope evident in the specification or file history in the same manner as a court will treat disclaimers in litigation.<sup>21</sup>

*“The protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation.”*

<sup>19</sup> *But cf. Finisar Corp. v. DirectTV Gp., Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008) (where claim used open terminology rejecting accused infringer’s argument that its accused product did not meet the requirement to assign “each” selected portion of a database because it worked with other data not contained in a database).

<sup>20</sup> *See generally*, APD § 3:45 —Construed During Prosecution.

<sup>21</sup> *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (“[T]his court counsels the PTO to avoid the temptation to limit broad claim terms solely on the basis of specification passages. Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources

### Registered Copyright as a Printed Publication

Well settled law holds that a printed publication that anticipates or renders obvious a claimed invention can invalidate a patent claim only if the publication is publicly available.<sup>22</sup> According to the Federal Circuit, “[a] reference is publicly accessible ‘upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it’”<sup>23</sup> Addressing whether the mere registration of copyright in an article with the United States Copyright Office makes that article publicly available for purposes of invalidating a patent claim, the Federal Circuit held in *In re Lister*, No., 2009-1060, 2009 WL 2998922, \*5-\*7 (Fed. Cir. Sept. 22, 2009), that it did not.

The inventor in *Lister* had claimed a method of playing a game of golf whereby the players could tee the ball on each shot except for putting on the green. Seeking to protect his game, the inventor prepared an article describing the game and registered it in the Copyright Office. The Copyright Office duly issued a copyright registration on the article, and the article was sometime thereafter posted on commercial databases. Over a year after registering the article with the Copyright Office, the inventor determined that he needed a patent to protect his game, and filed a patent application. Based on an information disclosure statement that the inventor filed regarding the copyright registration, the Board affirmed an examiner’s § 102(b) rejection of the claims in view of the article. The Federal Circuit reversed.

On appeal the Federal Circuit considered whether the registration of the article with the Copyright Office made the article a “printed publication” for purposes of § 102(b). Articulating the analytical standard for determining whether the article was

expressly disclaim the broader definition.”); see also APD § 5:57 Patent Office Should Not Read in Limitations.

<sup>22</sup> *See generally*, APD § 17:17 Publication Must Be Publicly Accessible.

<sup>23</sup> *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008).

publicly available based on its registration in the Copyright Office, the Federal Circuit instructed that “we must consider all of the facts and circumstances surrounding the disclosure and determine whether an interested researcher would have been sufficiently capable of finding the reference and examining its contents.” *Id.* at \*4. Applying this standard, the Federal Circuit ruled that the Copyright Office’s procedure in indexing registered works did not make those works publicly available. The Copyright Office only indexed the article in its automated database by the author’s name and the first word of the article’s title. It did not list the full title of the article, nor index the article by subject matter. In view of these facts, the publication of the article in the Copyright Office did not make the article publicly available for purposes of § 102. *Id.* at \*6-\*7.<sup>24</sup>

Regarding the commercial databases that reprinted registered copyright works, the court found that the commercial databases permitted keyword searching of the full title of the article and the author’s name. Even though the commercial databases did not permit searching the text of the article, the Federal Circuit rejected the inventor’s argument that keyword searching on the full article title was insufficient to make the article publicly available via the commercial database. *Id.* at \*7. The court concluded that an interested person, exercising reasonable diligence, could run keyword searches on the title in a manner that would have yielded the article in the search results. *Id.*

Seeking to rebut this conclusion, the inventor further argued that the search query posed by the court as something a reasonable searcher would run would have yielded so many results that it would have effectively concealed the inventor’s article. The court side-stepped this issue by noting that the inventor had failed to introduce evidence showing that the proposed search would have yielded an unmanageable number of references, and therefore left open the possibility that in “some circumstances an overwhelming number of search results might warrant a conclusion that a particular reference included in the list was not publicly accessible.” *Id.* at \*7 n.2.

Although concluding the commercial databases provided a publicly accessible version of the inventor’s article, the Federal Circuit still reversed the claim rejection because the PTO failed to make a

prima facie case that the article was available on these databases before the “critical date,” i.e., one year before the application’s filing date. The information disclosure statement identified the article as being registered with the Copyright Office before the critical date but it failed to provide any evidence as to when the commercial database may have first published the article.<sup>25</sup> Analogizing to the scenario where the PTO discovers an undated anticipatory reference, the Federal Circuit held that it could not simply presume that the commercial databases published the inventor’s article before the critical date from the mere fact that the article was allegedly sent “directly” to the commercial database providers from the Copyright Office. *Id.* at \*8. The court explained that “absent any evidence pertaining to the general practices of the Copyright Office, Westlaw, and Dialog [the two commercial databases], or the typical time that elapses between copyright registration, inclusion in the Copyright Office’s automated catalog, and subsequent incorporation into one of the commercial databases, any presumption along those lines would be pure speculation.” *Id.* at \*9. Accordingly, the Federal Circuit rejected the PTO’s contention that the burden should have shifted to the inventor to show that his article was not published in the commercial databases before the critical date. *Id.*

### **Bifurcation of Liability from Damages**

Rule 42(b) of the Federal Rules of Civil Procedure permits a court to bifurcate, i.e. separate, for purposes of discovery and/or trial any claims or issues.<sup>26</sup> “[C]onsiderations of judicial economy and avoiding

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<sup>25</sup> See generally, APD § 17:16 Effective Date of Prior-Art Publication Reference.

<sup>26</sup> See generally, APD § 39:92 General Aspects of Bifurcation.

In some circumstances, a court may alternatively “sever” claims, and/or parties, under Rule 21. *E.g. Reid v. Gen. Motors Corp.*, 240 F.R.D. 260, 263 (E.D. Tex. Jan. 16, 2007) (severing under Rule 21 infringement claims asserted against one accused infringer from that of the other accused infringers where the accused infringers sold different accused products). Severing a claim under Rule 21 differs from separating a claim for trial under Rule 42. “Separate trials under Rule 42(b) result in a single judgment while claims severed under Rule 21 become independent actions with separate judgments entered in each. While judgment on a claim severed under Rule 21 is final for purposes of appeal, judgment on a claim bifurcated under Rule 42(b) is not an appealable final judgment, absent a Rule 54(b) certification.” *Id.*

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<sup>24</sup> See generally, APD § 17:20 Distribution and Indexing of Publication or Lack Thereof.



duplicative efforts often govern the decision to grant or deny a motion to separate issues.”<sup>27</sup> In patent cases, parties may, and often do, seek bifurcation on a myriad of issues such as separating infringement from validity, infringement from inequitable conduct, infringement and validity from damages and willfulness, infringement from antitrust or unfair competition counterclaims, or a plaintiff’s infringement claims from the defendant’s infringement counterclaims.<sup>28</sup> A motion to bifurcate often turns on the specific circumstances of a given case and the district court’s discretion.

Because bifurcation for purposes of trial generally requires using two separate juries, some district courts have disfavored bifurcation in patent cases.<sup>29</sup> Two recent orders from the United States District Court for the District of Delaware, a court with a heavy patent docket, may signal a shift in the judiciary’s attitude towards bifurcation in patent cases. In *Exstream Software*<sup>30</sup> and *Robert Bosch*,<sup>31</sup> Judge Robinson, in ordering that the issue of infringement liability be separated for purposes of discovery and trial from the issues of damages and willful infringement, stated her view that “bifurcation is appropriate, if not necessary, in all but exceptional patent cases.”

Judge Robinson based her conclusion on her practical experience in handling many patent infringement litigations (noting that she presently had 89 patent cases pending on her docket). She stated that in her “experience, discovery disputes [in patent

cases] related to document production on damages and the *Daubert* motion practice related to damages experts are a drain on scarce judicial resources.” *Exstream Software*, 2009 WL 2705932, \*1. Judge Robinson further explained that too great a burden is placed on the jury in a patent infringement trial. She noted that without bifurcation, the jury must not only have to resolve the “complex technical issues regarding infringement and invalidity,” but to also “understand the commercial complexities of the relevant market (or, even more impenetrable, the commercial complexities of the hypothetical market) in order to determine the economic consequences of their liability decisions.” *Id.* Given these burdens, Judge Robinson “concluded that bifurcation promotes the just and efficient resolution of what damages, if any, should be awarded by: (1) giving the parties—those with the most expertise in the market—the first

“[B]ifurcation is appropriate, if not necessary, in all but exceptional patent cases.”

opportunity to translate the Federal Circuit’s final legal decision on liability into practical commercial consequences; or (if the parties cannot resolve the matter) (2) giving the damages jury a focused dispute to resolve.” *Id.* According to Judge Robinson, “absent the use of such administrative tools as bifurcation (also referred to as separation of issues), timed trials, etc., the burden of managing a substantial patent caseload will be reflected in extending the time needed to reach trial on the merits.” *Id.*

Specifically, addressing the issue of willful infringement, Judge Robinson stated her view that “[w]illfulness is an intrusive and inflammatory issue to discover and try.” *Robert Bosch LLC*, 2009 WL 2742750, \*1 at n.3. Relying on *Voda*,<sup>32</sup> she rejected the patentee’s argument that the right to a jury trial under the Seventh Amendment requires that the jury that decided infringement must decide willful infringement. Accepting that a patentee has a right to

<sup>27</sup> APD § 39:93 Specifics of Rule 42(b) and Factors Considering in Bifurcating.

<sup>28</sup> For cases addressing the various issues parties have sought to bifurcate in patent litigation see APD §§ 39:99 thru 39:109.

<sup>29</sup> See e.g., *DSM Desotech Inc. v. 3D Sys. Corp.*, 2008 WL 4812440, \*3-7 (N.D. Ill. Oct. 28, 2008) (denying accused infringer’s motion to bifurcate damages and willful infringement from the liability portion of the case and stating that “bifurcation in patent cases, as in others, is the exception, not the rule. Separate trials should not be ordered ‘unless such a disposition is clearly necessary.’”).

<sup>30</sup> *Dutch Branch of Streamserve Development AB v. Exstream Software, LLC*, 2009 WL 2705932, \*1 (D. Del. Aug. 26, 2009).

<sup>31</sup> *Robert Bosch LLC v. Pylon Mfg. Corp.*, 08-542-SLR, 2009 WL 2742750, \*1 (D. Del. Aug. 26, 2009).

<sup>32</sup> *Voda v. Cordis Corp.*, 536 F.3d 1311, 1329 (Fed. Cir. 2008) (rejecting without analysis that the Seventh Amendment required that a grant of a new trial on the issue of willful infringement also required a grant of a new trial on the issue of infringement). See also *Power Integrations, Inc. v. Fairchild Semiconductor Intern., Inc.*, 585 F. Supp. 2d 583, 590-91 (D. Del. Dec. 12, 2008) (following *Voda* but noting that there was some merit to the argument that the Seventh Amendment might *per se* prevent bifurcating willful infringement from infringement).



a jury trial on the issue of infringement,<sup>33</sup> Judge Robinson questioned “whether this right is so broad as to trump a court’s right to manage its caseload, especially when the potential costs are so high.” *Id.* at \*1.

Others appear to share Judge Robinson’s view. The United States District for the Southern District of Ohio, in its proposed local patent rules,<sup>34</sup> automatically bifurcates for purposes of trial and discovery all claims of willful infringement from liability. Local Patent Rule 107.1 provides that the court shall first conduct a trial on “all issues except for willful infringement.” Rule 107.2 provides that if a patentee succeeds in proving infringement for at least one valid claim of the patent, then the court will set on an accelerated basis a trial for the issue of willful infringement after all other infringement claims and defenses have been fully adjudicated. The rule further provides that all discovery relating to willful infringement is automatically stayed until the patentee obtains a judgment that at least one valid claim is infringed and all other infringement claims and legal defenses have been fully adjudicated. Local Patent Rule 107.3.

Under *Seagate*, defenses to infringement (both noninfringement and invalidity) are to be considered in determining whether there was an objectively high risk of infringement to support a finding of willful infringement.<sup>35</sup> Accordingly, it seems questionable that bifurcating willful infringement from infringement can achieve judicial economy in an individual case. If bifurcated, and if the patentee succeeds in proving infringement and withstanding the invalidity challenges, a second jury would then have to hear testimony about the litigation defenses

the first jury already considered and rejected. Arguably, absent a summary judgment, the parties would almost have to re-present to the second jury their respective cases on the liability issues. But perhaps, the collective savings in judicial resources in cases where the patentee fails to prove infringement will outweigh the extra resources expended in cases where the patentee prevails on liability, and the parties must then proceed with a separate trial on the issue of willful infringement.

### **Funding University Research**

For a variety of reasons, corporations may find it worthwhile to sponsor and fund research in the nation’s universities. When funding such research, corporations should take care to expressly spell out in any agreement under which they agree to fund university research what rights, if any, they will have to the results of the funded research and any associated intellectual property. As shown by the following, failing to do so can place the corporation at the wrong end of a patent-infringement dispute.

In *Wisconsin Alumni Research Foundation v. Intel Corp.*, 2009 WL 3003835 (W.D. Wis. Sept. 17, 2009), Intel had given the university plaintiff several “unrestricted” grants to fund research. The agreement providing the funding specified that Intel “shall have unrestricted rights at no cost to the results of this research.” But the agreement failed to expressly address what rights, if any, Intel would have to any patents emerging from the research. After completing the research, the university filed for a patent application. The university, as part of its “equity review” process, considered whether it had an obligation to notify Intel of the pending patent application. Since Intel gave the funding as an “unrestricted” “gift,” the university determined that it was not obligated to notify Intel of the pending patent application. Additionally, the professor performing the research had discussed the technical results of the research with Intel personnel, but never told Intel that the university had applied for a patent on the resulting technology. A patent subsequently issued. After issuance, and before Intel began its own work developing a product in the field related to the patented technology, the university offered to license the patent to Intel. Negotiations stalled, and the university sued Intel for patent infringement.

During the litigation, Intel raised the defense of license, implied license and equitable estoppel. On the university’s motion for summary judgment the district court dismissed these defenses. The court

<sup>33</sup> See generally, APD § 31:15 Right to Jury Trial on Issue of Willfulness (noting conflict judicial opinions in whether a Seventh Amendment right to a jury trial applies to willful infringement).

<sup>34</sup> The proposed patent rules are available at <http://www.ohsd.uscourts.gov/localrules/ohsdpatentrules.pdf>. The court announced its proposed Local Patent Rules on June 11, 2009, requesting the public to submit comments by August 3, 2009. Although the proposed rules specify a September 1, 2009 effective date, the court has not yet officially approve the rules. It plans to consider the rules in a meeting set for Oct. 22, 2009, with an announcement of the adoption of the rules expected sometime thereafter.

<sup>35</sup> See generally, APD § 31:40 Litigation Defenses and Good Faith and Substantial Challenges to the Patent; and *Patent Happenings*, Sept. 2009 at pp. 1-5.

found that the provision in the funding agreement granting Intel “unrestricted rights at no cost to the results of this research” was ambiguous on whether it granted rights to practice the patented technology. After considering extrinsic evidence of the parties’ intent, the court concluded that no reasonable jury could find that the funding agreement intended to convey a license to any resulting patents, and therefore dismissed the express license defense. *Id.* at \*11-\*16.

Intel also argued that the failure of the research professor and the university to tell Intel that the university had applied for a patent while freely sharing the technical results of the research created an implied license and/or equitably estopped the university from enforcing the patent against Intel. Rejecting the implied license defense, the district court found that regardless of the professor’s and the university’s failure to inform Intel of the patent application, the undisputed facts showed that after the patent issued the university offered to license the patent to Intel several months *before* Intel began its work in developing the accused product. The offer of a license, according to the district court, was an act inconsistent with any contention that the university had impliedly granted a license to Intel.<sup>36</sup> Since the university made the offer before Intel began its accused activity, the district court held there was no basis for finding an implied license. *Id.* at \*16-\*17. The court also ruled that “[r]egardless whether [the professor]’s assurances may have misled defendant earlier, the January 2001 licensing letter undid any damage done. By the time defendant began work on the first of the allegedly infringing products in September 2001, it could not have reasonably inferred that plaintiff would allow it to practice the patent without obtaining a formal license.” *Id.* at \*18. Without reasonable reliance, Intel’s equitable estoppel defense also failed.<sup>37</sup> *Id.*

Despite granting summary judgment to the university dismissing the license defenses, the district court further held that the express license defense raised a “close” question. Based solely on this defense, and not accounting for Intel’s other defenses of invalidity, noninfringement, implied license, and

equitable estoppel, the district court granted Intel summary judgment dismissing the university’s claim of willful infringement.<sup>38</sup> The court concluded that “[b]ecause this question [i.e., the express license] was relatively close, it dooms plaintiff’s willfulness claim.” *Id.* at \*25. Accordingly, it rejected the university’s contention the issue of “of willfulness is best left for determination after trial, when the record has been fully developed,” because it found “that there was not an ‘objectively high likelihood’ of a finding of infringement in light of defendant’s licensing defense,” *id.*; a defense that appears to have been fully developed on the summary judgment record.

### **Assigning Rights in Future Inventions**

Inventors may contractually assign their rights to future inventions even before they conceive the invention.<sup>39</sup> Taking advantage of this principle, employment agreements often will include a provision assigning to the employer future inventions that the employee makes. As shown by *Board of Trustees of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.*, No. 2008-1509, -1510, 2009 WL 3110809 (Fed. Cir. Sept. 30, 2009), the words used in these agreements matter.

In *Roche*, a university researcher had signed a patent agreement with the university addressing future inventions the researcher may make while working for the university. The university’s patent agreement contained language that the researcher “agree[d] to assign” future inventions. Later the researcher began some consulting work with a commercial institution (Cetus). As part of this work the researcher executed a “Visitors Confidentiality Agreement,” which also contained an assignment of patent rights in future inventions that related to the researcher’s consulting work with Cetus. Unlike the agreement with the university, the agreement with Cetus stated that the researcher “will assign and *do[es] hereby assign*” to Cetus his rights in future inventions covered by the agreement.

Thereafter, the researcher, along with other university researchers, developed a method for quantifying the amount of the HIV virus that causes AIDS. The university subsequently filed a patent application on this technology and obtained executed

<sup>36</sup> See generally, APD § 11:22 Implied License Arising From Patentee’s Conduct; and § 11:46 Requirement to Find Implied License from Equitable Estoppel.

<sup>37</sup> See generally, APD § 11:198 Reasonable Reliance by an Accused Infringer.

<sup>38</sup> See generally, APD § 31:40 Litigation Defenses and Good Faith and Substantial Challenges to the Patent.

<sup>39</sup> See generally, APD § 35:21 Assignment Before Creation of Invention.

assignments from each of the researchers of their individual rights in the invention. In the meantime, Roche acquired Cetus and Cetus's agreement with the university researcher. Seeking to commercialize the patent application, the university offered a patent license to Roche. The parties failed to reach a license deal, and a few years later the university sued Roche for patent infringement.

In defending the infringement suit, Roche claimed an ownership interest in the asserted patent based on the agreement the university researcher had with Cetus. Roche further alleged that based on its ownership interest in the patent, the university lacked standing to bring the infringement suit.

The district court ruled that a state statute of limitations barred Roche's affirmative claim of ownership based on the agreement with Cetus. It therefore dismissed the ownership claim and struck the related defenses. On appeal the Federal Circuit affirmed the dismissal of the affirmative claim of ownership, but reversed the dismissal of the defense for lack of standing.

Considering the language in the two agreements, the Federal Circuit held that the "agree to assign" language in the agreement with the university only created a promise for the researcher to assign at some future time his rights in any invention falling within the scope of the agreement. The agreement did not create "an immediate transfer of expectant interest." *Id.* at \*6. In contrast, the researcher's agreement with Cetus, having the language "I will assign and *do hereby assign*" "effected a present assignment of [the researcher]'s future invention to Cetus." *Id.* Consequently, "Cetus immediately gained equitable title to [the researcher]'s inventions." *Id.* In the priority issue between the two agreements, the court ruled that "because Cetus's legal title vested first, [the researcher] no longer retained his rights, negating his subsequent assignment to Stanford during patent prosecution." *Id.*

The Federal Circuit found that Roche also demonstrated that the patented invention fell within the scope of agreement with Cetus, and therefore Roche had shown that the university did not own the entire right in the patent application since it did not own the particular researcher's rights to the invention. Roche did.<sup>40</sup>

<sup>40</sup> The Federal Circuit also rejected the university's contention that Roche's ownership interest could not be sustained on the grounds that the university was a bona fide

However, Roche did not prevail on its claim to be declared an owner of the patent since a state statute of limitation barred its cause of action. *Id.* at \*10-12. But the court found that since "standing" presents a jurisdictional defense that cannot be waived,<sup>41</sup> and since all co-owners of a patent must normally be joined in an infringement suit for the plaintiff to have standing,<sup>42</sup> Roche's defense for lack of standing had to be sustained. *Id.* at \*13.

### **"Present Invention" Limits Claim Scope**

Since its 2001 opinion in *SciMed*,<sup>43</sup> the Federal Circuit appears to have consistently ruled that if an inventor, in a patent specification, describes an embodiment as being "the present invention" or "the invention" *and* does not describe any other embodiments of the invention, the description of that particular embodiment generally will limit the scope of the claim.<sup>44</sup> The narrow construction dictated by the disclosure will apply even if the claim's language would otherwise permit a broader construction. The recent opinions of *Lydall Thermal/Acoustical, Inc. v. Federal-Mogul Corp.*, No. 2009-1135, 2009 WL 2893190 (Fed. Cir. Sept. 8, 2009) (*nonprecedential*) and *Edwards Lifesciences LLC v. Cook Inc.*, No. 2009-1006, 2009 WL 2998543 (Fed. Cir. Sept. 22, 2009), illustrate this principle.

In *Lydall* the Federal Circuit had to construe a claim limitation reciting a "fibrous batt of fibers." The district court construed the claim to require that the "batt" must have a three-layered structure made up of an insulating layer sandwiched between two binding layers of fibers. The patentee argued that the construction impermissibly read into the claim a limitation described in the specification but not

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purchaser for value of the researcher's rights in the invention because the researcher's knowledge of Cetus's rights to the invention was imputable to the university. *Id.* at \*7. *See generally*, APD § 35:26 Bona Fide Purchasers. The court also rejected the contention that the Bayh-Dole Act operated to defeat Roche's ownership interest. *Id.* at \*8-\*9. *See generally*, APD § 35:46 Federal Licenses.

<sup>41</sup> *See generally*, APD § 9:35 Requirement of Standing may Not be Waived.

<sup>42</sup> *See generally*, APD § 9:40 Infringement Action Must be Brought by All Co-owners.

<sup>43</sup> *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343-44 (Fed. Cir. 2001).

<sup>44</sup> *See generally*, APD § 5:17.50 "Present Invention" or "The Invention" Statements; *see also* APD § 5:58 Explicit Statements Limiting Scope of Claimed Invention.



required by the claim language. According to the patentee, the district court should have more broadly construed the term to cover a structure having a single-layer of fibers as in the accused product. The patentee argued that in view of usage of the term “batt” as referring to a single-layered structure in the prior art and the inventor’s statements in the prosecution history of its reissue patent that the inventors intended to cover a homogenous (i.e., single layer) batt with the claim, the term batt could not be limited to the multi-layered structure described in the specification.

Reiterating its instruction of *Honeywell*,<sup>45</sup> the Federal Circuit explained that “when a patentee consistently describes one embodiment as ‘the present invention,’ [t]he public is entitled to take the patentee at his word.” *Id.*, 2009 WL 2893190 at \*5. Because the specification repeatedly described only the three-layered structure and identified that structure as being “the present invention,” the Federal Circuit affirmed the district court’s narrow construction. *Id.*

As to the statements in the prosecution history of the reissue application that allegedly supported a broader construction of the term based on the inventor’s subject intent in broadly claim the batt,<sup>46</sup> the Federal Circuit explained that the prosecution history “cannot enlarge the content of the specification.” *Id.* at \*6. Consequently, it further instructed that “when the prosecution history appears in conflict with the specification, any ambiguity must be resolved in favor of the specification.” *Id.* Since the sole embodiment disclosed in the specification had a three-layered batt, the Federal Circuit concluded that “[t]he patentee’s efforts during the prosecution of the reissue patent to enlarge the claims beyond what the specification discloses also must fail.” *Id.*

In *Edwards*, the Federal Circuit affirmed a district court’s construction of the term “graft” as being limited to an “intraluminal graft,” i.e., a graft inside a blood vessel. The court based its conclusion on three

observations. First, the specification used the terms “graft” and “intraluminal graft” interchangeably. According to the court, “[t]he interchangeable use of the two terms is akin to a definition equating the two.” *Id.*, 2009 WL 2998543 at 5. Second, the only devices described in the specification were intraluminal.” *Id.* at \*6. Third, “the specification frequently describe[d] an ‘intraluminal graft’ as ‘the present invention’ or ‘this invention,’ indicating an intent to limit the invention to intraluminal devices.” *Id.* The court also rejected the patentee’s contention that a deletion of the word “intraluminal” from a claim limitation reciting an “intraluminal graft” during prosecution mandated not limiting the term “graft” to intraluminal grafts. In the accompanying remarks, the applicant referred to the graft as being an “intraluminal graft.” In view of this, the Federal Circuit stated that “the inventors’ statements urged a change in claim language that did not affect the breadth of the claim, and we cannot allow the claim to now be broadened.” *Id.* at \* 7.

#### **Notice of Patent Pool Failed Under § 287(a)**

Pursuant to § 287(a) of the Patent Act, if a patentee fails to mark its patented products with the number of its patent, the patentee can only recover money damages for infringement occurring after the patentee gave the accused infringer actual notice of the charge of infringement.<sup>47</sup> Under Federal Circuit precedent, the notice of infringement must come directly from the patentee, must specifically identify the asserted patent,<sup>48</sup> and must specifically identify the product the patentee alleges infringes its patent.<sup>49</sup> A general notice to an industry of the patentee’s patents normally does not meet the requirements of actual notice under § 287.<sup>50</sup>

*“When the prosecution history appears in conflict with the specification, any ambiguity must be resolved in favor of the specification.”*

<sup>45</sup> *Honeywell Int’l Inc. v. ITT Indus., Inc.*, 452 F.3d 1312, 1318 (Fed. Cir. 2006).

<sup>46</sup> See generally, APD § 6:5 Public Notice Aspect Requiring Objective View Point.

<sup>47</sup> See generally, APD § 30:163 Providing Actual Notice When Patentee Did Not Mark. See also § 30:173 Cases Finding Notice Sufficient; § 30:174 Cases Finding Notice Insufficient.

<sup>48</sup> See generally, APD § 30:172 Need to Identify Specific Patent.

<sup>49</sup> See generally, APD § 30:171 Notice Must Identify Specific Product.

<sup>50</sup> *Amsted Industries v. Buckeye Steel Castings*, 24 F.3d 178, 187 (Fed. Cir. 1994).



The recent opinion *Fujitsu Ltd. v. Netgear, Inc.*, 2009 WL 3047616, \*9 (W.D. Wis. Sept. 18, 2009), presents an interesting analysis of the notice requirements in the context of a patent pool purportedly covering an industry standard. In *Fujitsu*, several owners of several patents covering different aspects of an industry standard pooled their respective patents. The pool, via a licensing agent, sent letters to individual accused infringers notifying the recipient of the patents in the pool and offering a license. Rather than identifying specific accused products that allegedly infringed specific patents, as § 287(a) requires, the notice simply alleged that any product that complied with the industry standard infringed one or more of the patents in the pool.

Noting that the industry standard “has many sections that permit wireless devices to function in several ways and still comply with the standard,” the district court determined that “[o]bviously, not every patent in the license pool covers every section of the standard.”<sup>51</sup> The court then faulted the plaintiffs’ licensing agent for refusing to tell the defendants which sections or functions of the standards were at issue for the individual accused infringer’s products, and determined that “[f]or that reason alone, the letters [the agent] sent were insufficient to meet § 287(a)’s notice requirement.” *Id.* The court further stated: “It cannot be considered adequate notice for a group of patent holders pooling their patents to simply state without proof that products practicing an industry standard necessarily practice some of the pooled patents and inform parties that advertise products practicing the standard that they can obtain a license over all patents in the pool while never identifying which specific products may infringe any specific patent.” *Id.* Commenting on the practical reasons for why a blanket notice cannot be effective under § 287(a), the district court explained that “[a]pproving plaintiffs’ strategy would permit licensing pools to bully potential infringers into licensing agreements.” *Id.* Faced with the task of having to examine all of its products to determine if any implicate any of the patents, the potential infringer “is placed in an untenable position: (1) turn down the license and face a potential infringement action involving an unknown

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<sup>51</sup> The district court also found that the pool’s assumption that any product sold as compliant with the standard infringed one or more of the patents in the licensing pool was not a valid assumption, as it had granted the accused infringers’ motion for summary judgment of noninfringement.

number of patents and an unknown number of products or (2) pay for a license even though the license (a) may be completely unnecessary; (b) may not cover many of the alleged infringer’s products; or (c) may cover many patents that its products do not practice.” *Id.*

Consequently, the district court found that the patentees’ pre-suit notice failed to satisfy § 287(a). The court also ruled that the patentees’ original complaint did not give sufficient notice to the accused infringer of the charge of infringement because it too failed to identify any specific accused products. *Id.* Only when the patentees filed their amended complaint, which for the first time identified specific accused products, did they properly put the accused infringers on notice of the alleged infringement. *Id.* Thus, the court limited the damages period to infringement done after the filing of the first amended complaint.

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