TABLE OF CONTENTS

CHAPTER 1

Determining the Damages Period

§ 1.01	Introduction	. 1-2
§ 1.02	The Outer Boundary of the Damages	
Ü	Period	. 1-19
	[1] Commercial Cases	. 1-19
	[2] Government Cases	
	[3] Laches	
§ 1.03	Determining When Infringement Starts	
§ 1.04	Public Policy Behind the Marking/Notice	
3 1.0 .	Requirement	. 1-30
	[1] Historical Background	
	[2] Avoiding Innocent Infringement	
	[3] Encouraging Patentees to Give Notice	. 132
	to the Public	. 1-33
	[4] Encouraging Innovation by Aiding the	. 133
	Public to Identify Patented Articles	. 1-34.4
§ 1.05	Marking/Notice Statute Limits on Damages	
y 1.05	[1] Determining if Patentee Is Subject to	. 1-33
	Section 287(a)	. 1-38
	[a] Threshold Analysis	
	[i] Method Claims and	. 1-30
	Apparatus Claims in	
	Same Asserted Patent	. 1-40
	- J	L
	Related Apparatus	1 42
	Patent	. 1-42
	[iii] Assertion of Non-Practiced	1 42
	Unmarked Claims	. 1-43
	[2] Satisfying the Requirements if the	1 42
	Marking/Notice Statute Applies	
	[a] Threshold Analysis	. 1-43

xvi	PATENT INFRINGEMENT	
	[b] Marking and Constructive	
	Notice	1-44
	[i] Licensee/Reseller Marking	1-44
	[ii] Package Marking	1-46
	[iii] Partial or Substantial	
	Compliance	1-46.2
	[iv] Combination Patents	1-46.4
	[v] Virtual Marking	1-46.6
	[c] Actual Notice	1-46.7
	[i] Balancing Between Notice	
	and Declaratory	
	Judgment	1-46.7
	[ii] Notice to Appropriate	1 46 11
	Party	1-46.11
	[iii] Notice by Appropriate	1 46 10
	Party	1-46.12
	[iv] Content of the	1 46 12
	Communication	1-46.13
	[v] Infringer's Conduct [3] Consequences of Not Meeting the	1-46.16
	[3] Consequences of Not Meeting the Marking/Notice Requirements	1-46.17
§ 1.06	Other Limitations and Extensions	1-40.17
y 1.00	[1] Foreseeability and Infringement Under	1-47
	the Doctrine of Equivalents	1-48
	[2] Product-by-Process Infringement	1-49
	[3] Design Patents	1-51
	[4] False Marking and Marking Estoppel	1-53
	[a] False Marking	1-53
	[b] Marking Estoppel	1-58
	[5] Pre-Issuance Damages	1-60
	[6] Non-Statutory Double Patenting	1-62
	[7] Relationship to Timing of Hypothetical	
	Negotiation	1-62.1
	[8] Patent Expiration	1-62.2
§ 1.07		1-63
	CHAPTER 2	
	Determining the Damages Base	
8 2 01	Intuo diretion	2.2
§ 2.01	Introduction	2-3
§ 2.02	The Apportionment Principle	2-7
	[1] Lost Profits and Reasonable Royalty Calculations	2-11
	Culculations	2-11

		1	TABLI	E OF CONTENTS	XVII
	[2]	Asce	rtainir	ng the Applicable Facts	2-13
	[3]			ne Patent	2-14
	[4]	Cate	gorizir	ng the Unpatented	
		Co	ompon	ents	2-18
	[5]			he Apportionment Principle	
		an	d Exc	eptions	2-19
		[a]	Appl	y the Appropriate	
			Aj	pportionment Principle	
			M	ethodology	2-21
			[i]	Damages Base Is the	
				Smallest Salable Unit,	
				Further Apportioned	2-21
			[ii]	Comparable Licenses	2-24
			[iii]	Standards Essential	
				Patents	2-24
		[b]	Exce	ptions to the General Rule—	
			Er	ntire Market Value Rule	2-25
			[i]	Basis for Demand	2-25
			[ii]	Functional Unit	2-29
			[iii]	Analogous to Single	
				Functional Unit	2-30
		[c]	Othe	r Special Circumstances	2-31
			[i]	Foreseeability	2-31
			[ii]	Product Made by Patented	
				Process or by a Patented	
				Machine	2-34
			[iii]	Punitive Damages	2-35
			[iv]	Unpatented Consumables	2-35
			[v]	Collateral or Convoyed	
				Sales	2-35
			[vi]	Apportionment in the	
				Reasonable Royalty	
		_		Context	2-39
	[6]			ng if Limitations to the Entire	
				Value Rule Apply	2-39
		[a]		ortionment	2-39
		[b]		e Parts/Replacement Parts	2-46
		[c]		preseeability	2-46
		[d]		s to United States	2 47
0.00		C		overnment	2-47
§ 2.03				he Damages Base—Indirect	2.40
		rıngen	nent .	CD 4 I C	2-48
	[1]			of Patent Infringement	2-48
	[2]	Elem	ients c	of Indirect Infringement	2-49

xviii PATENT INFRINGEMENT

		[a]	Elen	nents of Induced	
			In	fringement	2-49
			[i]	Intentional Actions	2-49
			[ii]	Knowledge of the	
				Patent	2-50
			[iii]	Knowledge that Acts	
				Induced Infringement	2-50
			[iv]	Underlying Direct	
				Infringement	2-51
		[b]	Cont	ributory Infringement	2-52
			[i]	Sale, Offer or	
				Importation	2-53
			[ii]	Act of Direct	
				Infringement	2-55
			[iii]	Not a Staple Article,	
				Commodity, Incapable	
				of Substantial	
				Non-Infringing Use	2-55
			[iv]	Material Part of the	
				Patented Invention	2-56
			[v]	Knowledge	2-56
	[3]	Dete	erminir	ng the Damages Base for	
		It	ndirect	Infringement	2-56
		[a]	Inhe	rently Infringing	
			$\mathbf{A}_{\mathbf{I}}$	pproach	2-57
		[b]	Appo	ortionment Approach	2-57
		[c]	Нуро	othetical Negotiation	
			$\mathbf{A}_{\mathbf{j}}$	pproach	2-58
§ 2.04	Extra			cope of the Damages Base	2-59
	[1]			n	2-59
	[2]			ry Infringement Outside	
		tŀ			2-66
		[a]		le Component	2-66
		[b]		gn Patents	2-66.1
		[c]		ess or Method Patents	2-67
		[d]		puter Software	2-68
	[3]			Products	2-73
	[4]			traddling a Border	2-73
	[5]			ffers to Sell in U.S. Made	
		C	utside	U.S	2-74
8 2.05	Desi	on Pat	ents.		2-78

	TABLE OF CONTENTS	xix
	CHAPTER 3	
	Established Royalty Measure of Damages	
§ 3.01 § 3.02	Introduction	3-1
,	Exists	3-4
	Infringement Began	3-4
	of Persons	3-5 3-6
	Settlement of Litigation	3-6.1
0. 2. 02	[5] Comparable Rights	3-6.2
§ 3.03	Effects on Adequate Compensation	3-7
	[1] Relation to Reasonable Royalty [2] Relation to Lost Profits	3-7 3-9
	CHAPTER 4	
	Reasonable Royalty Measure of Damages	
§ 4.01	Introduction	4-2
§ 4.02	The Hypothetical Negotiation	4-4
§ 4.03	Calculating the Reasonable Royalty	4-10
	[1] The Georgia-Pacific Factors	4-10
	[a] Overview	4-10
	[b] Comparable Licenses [i] Existing Licenses	4-13
	(Factor 1) [ii] Comparable Patents	4-14
	(Factor 2) [iii] Customary Profit	4-19
	Allocation (Factor 12) [c] Scope and Duration of License	4-21
	(Factors 3 & 7)	4-21
	(Factors 4 & 5)	4-22
	(Factors 6 & 13)	4-23 4-25
	[g] Value of the Patented Invention (Factors 9, 10, & 11)	4-27

PATENT INFRINGEMENT

	[h] Expert Testimony and the	
	Hypothetical Negotiation	
	(Factors 14 & 15)	4-29
	[i] Other Factors	4-31
	[i] Widespread Infringement	4-31
	[ii] Cost Savings	4-32
	[iii] Price Erosion	4-33
	[iv] Patent Population	4-33
	[v] Other	4-34
	[2] Application of the Georgia-Pacific	
	Factors	4-36
	[a] Trial Court Discretion	4-36
	[b] Appellate Review	4-37
	[3] Throughput or Paid-Up Licenses	4-38
	[4] Percentage of Sales	4-40.1
§ 4.04	Other Approaches	4-41
	[1] The Analytical Approach	4-41
	[2] Mathematical Models	4-42
	[a] The 25-Percent Rule	4-42
	[b] The Nash Bargaining Solution	4-44
	[3] Percentage of Patentee's Profits	4-44.1
	[4] Allocated Cost Savings	4-45
	[5] U.S. Government as the Infringer	4-46
	[6] Licensing of "Standards	
	Essential" Patents	4-48
	[7] Technology Licensing Model	4-50
	[8] Usage-Based Infringement	4-50.4
§ 4.05	Applying Enhancements and Limitations	4-50.5
	[1] Enhancement	4-50.5
	[2] Limitation on Reasonable Royalty	4-54
	[a] Generally	4-54
	[b] Non-Infringing Alternative	4-54
	[c] Infringer's Profits	4-56
§ 4.06	Post-Verdict Royalty	4-59
	CHAPTER 5	
	Lost Profits Measure of Damages	
§ 5.01	Introduction	5-2
§ 5.02	Application of the <i>Panduit</i> Factors	5-7
5 2.02	[1] Demand for the Patented Product	5-7
	[a] Existing Demand	5-7
	[b] No Demand	5-7 5-9

		TA	BLE OF CONTENTS	xxi
		[c] P	Products Made by Patented	5 11
	F07	NT 4	Method	5-11
	[2]		ceptable Non-Infringing	<i>5</i> 11
			stitutes	5-11
			Product Dimension	5-12
		[i	i] Non-Infringing Substitutes Not Found	5-15
		Гi	ii] Non-Infringing Substitutes	3-13
		Ĺı	Found	5-16
		Γi	iii] Market Share Analysis	5-17
		_	iv] Willful Infringement Basis	3-17
		Ľ	for Proving Absence of	
			Non-Infringing	
			Substitute	5-17
		[b] T	Time Dimension	5-18
	[3]		acturing and Marketing Capacity	
		to M	feet the Demand	5-20
			Manufacturing Capability	5-20
			Marketing Capability	5-22
			Special Problems Related to	
			Foreign Sales	5-23
	[4]	Determ	nining the Amount of Lost	
			its	5-24
		[a] D	Determining the Patentee's Sales	
			"but for" the Infringement	5-27
			Lost Profits Enhancements	5-29
		_	i] In General	5-29
		Į i	ii] Entire Market Value Rule	
			and Convoyed Sales	5-30
			iii] Post-Expiration Damages	5-31
			Lost Profits Limitations	5-32
		[d] D	Determining the Lost Profits on	5.22
		г.	the Damages Base	5-33
		[i		5-33
5 02	A	_	ii] Cost Variable	5-34
5.03			nt of Lost Profits Damages	5-36 5-37
3.04	mer	company	Issues	3-3/

PATENT INFRINGEMENT

CHAPTER 6

Limitations on Damages

§ 6.01	Intro	duction	n	6-2				
§ 6.02	Multiple Recovery and Authorization—							
	M	ultiple	Infringers	6-5				
	[1]	[1] Types of Infringing Acts and						
		In	nfringers	6-5				
		[a]	Types of Patent Claims	6-7				
		[b]	Types of Infringing Acts	6-10				
	[2]		ating Authorization	6-15				
		[a]	First Sale of Patented					
			Product—Exhaustion	6-15				
		[b]	Implied License	6-21				
			[i] Creation by Product Sale	6-21				
			[ii] Creation Through Product					
			Circumstances	6-22				
			[iii] Creation Through Equitable					
			Estoppel	6-23				
			[iv] Creation Through Course of					
			Conduct	6-23				
	[3]	Bou	ndaries of Authorization	6-23				
		[a]	Claims and Patents	6-24				
			[i] Apparatus and Method					
			Claims of the Same					
			Patent	6-24				
			[ii] Method Patent	6-24				
			[iii] Combination Patent	6-25				
		[b]	Use Restriction	6-26				
		[c]	Life of the Patented Product	6-27				
		[d]	License Restrictions	6-27				
	[4]	Repa	air/Reconstruction	6-28				
		[a]	Basic Principles	6-28				
		[b]	Effects Both Under Exhaustion					
			and Implied License	6-32				
	[5]		luct Sales by Licensee	6-32				
§ 6.03			fringing Acts	6-34				
§ 6.04			ation	6-36				
	[1]		gation of Indemnification	6-37				
		[a]	Uniform Commercial Code	6-37				
		[b]	Contractual Arrangements					
			Between Parties	6-39				

		TABLE OF CONTENTS	xxiii
§ 6.05	[2] [3] Joint	Limitations on Indemnification Federal Preemption	6-42 6-43 6-46
		CHAPTER 7	
		Enhancements to Damages	
§ 7.01 § 7.02	Incre	duction	7-3 7-5 7-5
	[2] [3]	Two-Part Inquiry: Entitlement and Quantification Pre-Seagate Entitlement to Enhanced	7-7
	[2]	Damages for Willful Infringement [a] Knowledge and Duty	7-9 7-16
		Infringement	7-21 7-21
		Inference	7-23
	[4]	Opinion Post-Seagate Entitlement to Damages [a] Objectively High Likelihood That Acts Constituted	7-26 7-29
	[5]	Infringement	7-31 7-32
	[6]	Damages	7-33 7-35 7-35 7-35 7-37
		Belief in Invalidity or Non-Infringement [iii] Infringer's Behavior [iv] Infringer's Size and	7-38 7-38
		Financial Condition [v] Closeness of the Case [vi] Duration of Infringer's Misconduct	7-39 7-40 7-40

xxiv		PAT	TENT INFRINGEMENT	
		_	rii] Remedial Actions	7-41
			for Harm	7-41
		[iː	x] Infringer's Attempt to	
			Conceal Misconduct	7-41
§ 7.03	Attorn		Under 35 U.S.C. § 285	7-43
	[1]		ction	7-43
	[2]		ination of Whether the Case is	
			ptional—Historical Evolution	
			sues	7-46
			atentee Is the Prevailing Party	7-46
		[b] A	ccused Infringer Is the	
			Prevailing Party	7-50
		[i		7-51
		[ii	-	7-54
			ommon Issues	7-56
			Litigation Misconduct	7-57
		_	i] Defenses	7-58.1
	F0.7	_	ii] Appeals	7-58.2
	[3]		ining Whether the Case is	
			ptional—Brooks Furniture	7.50.0
			2005-2014	7-58.2
			tandard	7-58.3
	F 43		urden of Proof	7-58.3
	[4]		ining Whether the Case is	
			ptional—Post- <i>Octane</i>	7.50.3
		~	ess Era	7-58.3
			tandard	7-58.3
			tandard of Review	7-58.4
			ost-Octane Fitness Decisions	7-58.5
		[i]	-	7.50.5
		F::	Prevailing Plaintiff	7-58.5
		Lii	-	7 50 6
		F::	Prevailing Defendant	7-58.6
	[5]		ii] Fee-Shifting Denied	7-58.7
	[5]		ination of the Attorney Fee	7 50 7
			unt	7-58.7
			enerally	7-58.7 7-58.9
			pecial Circumstances	7-58.9
		[i]	1	
		[ii	- X	7-58.9
		-	-	7-58.10 7-58.11
8 7 04	Drain	[i]	2	
§ 7.04			nterest Under Damages Statute	7-58.12 7-58.12
	[1]	muoau	ction	1-30.12

		TABLE OF CONTENTS	XXV
	[2] Awa	arding Prejudgment Interest is	
	tł	ne Norm	7-59
	[a]	Denial Proper	7-59
	[b]	Denial Not Proper	7-60
	[c]	Partial Denial	7-60
	[3] Dan	nage Components	7-62
	[a]	Excluding Punitive Components	7-62
	[b]	Compensation for Past Damages	7-62
	[4] Inte	rest Rate and Compounding	7-63
		CHAPTER 8	
		Proving Damages	
§ 8.01	Introductio	on	8-2
Ü		ndards of Proof and Review	8-2
§ 8.02	Admissibil	ity under Federal Rule	
	of Evide	ence 403	8-5
§ 8.03		stimony under Federal Rule	
		ence 702	8-7
		corical Admissibility	8-7
		licability of Admissibility	
		tandards	8-9
	[a]	Expert Testimony Admissible	8-11
		[i] Disputed Facts	8-11
		[ii] Market Research Studies	8-12
		[iii] Disputed Methodology	8-12
	LP1	[iv] Speculative Testimony	8-13
	[b]	Expert Testimony Inadmissible [i] Invalid or Erroneous	8-13
		Conclusion	8-13
		[ii] Unsupported Methodology	0-13
		or Speculation	8-14
		[iii] Failure to Relate Conclusion	0-14
		to Supporting Evidence	8-14.1
	[c]	Qualifications	8-14.1
		e Outcome	8-14.1
§ 8.04		tention	8-15
U		verse Inference	8-15
		enses	8-16
§ 8.05		1	8-17
	[1] Judi	cial Economy	8-17
§ 8.06	Discovery	and Local Rules	8-19

PATENT INFRINGEMENT CHAPTER 9

Damages Accounting Issues

§ 9.01			n	9-2			
§ 9.02			Expert Testimony: Accounting	0.5			
			ls for Reliability	9-5			
	[1]		erally	9-5			
	[2]		nissibility Under Federal Rule of				
			vidence 702	9-5			
		[a]	Use of the term "Opinion"				
			by Accountants	9-5			
		[b]	Professional Qualifications, Rules,				
			and Ethical Standards	9-6			
			[i] GAAP	9-6			
			[ii] AICPA Code of Professional				
			Conduct Rules	9-6			
			[iii] MCS/SCSS	9-6			
			[iv] Other Certifications	9-8			
	[3]	Proh	pative Value of Expert Testimony	, ,			
	[2]		nd Limitations	9-10			
		[a]	Rule 26	9-10			
		[b]	International Methods	9-12			
		[c]	Completeness and Disclosure	9-12			
				9-12			
		[d]	Valuation	9-12 9-14			
6 0 02	A	[e]	Skill at Persuading the Court	9-14			
§ 9.03			Issues in Reasonable Royalty	0.15			
			nation	9-15			
	[1]						
			lethod	9-16			
		[a]	Royalty Rate	9-16			
		[b]	Royalty Base	9-18			
			[i] Revenue Recognition				
			Principles	9-18			
			[ii] Other Issues in Calculating				
			Applicable Sales	9-19			
	[2]	Perc	entage of Profits Method	9-21			
		[a]	Production Costs	9-21			
		[b]	Fixed and Variable Costs	9-21			
		[c]	Incremental Cost	9-23			
		[d]	Standard Cost	9-24			
		[e]	Activity Based Costing	9-24			
		[f]	Other Costs	9-24			
	[3]		entage of Cost Savings Method	9-25			
	[4]		Bargaining Solution	9-26			
	1 ' 1	1 1001		/ 20			

	TABLE OF CONTENTS	xxvi
§ 9.04	Accounting Issues in Lost Profits	
	Determination	9-28
	[1] Panduit Factors	9-28
	[a] Variables To Include	9-28
	[b] Incremental Profits	9-29
§ 9.05	Interest	9-30
0	of Damages	9-31
§ 9.06	Internal Accounting for Damages Awards	9-32
	CHAPTER 10	
	Injunctive Relief and the	
	International Trade Commission	
§ 10.01	Introduction and Overview	10-1
§ 10.02	Injunctive Relief	10-3
	[1] Permanent Injunctions	10-3
	[a] Historical Background	10-3
	[b] Equitable Standards Test	10-5
	[i] Irreparable Injury[ii] Remedies Available	10-10
	at Law Inadequate	10-13
	[iii] Balance of Hardships	10-16
	[iv] Public Interest	10-17
	[c] Non-Practicing Entities and	
	Permanent Injunctions	10-18
	[2] Temporary Injunctions	10-19
§ 10.03	International Trade Commission Actions	10-22
	[1] In General	10-22
	[2] Special Issues with Respect to Non-Practicing Entities	10-26
	Non-Fractioning Enduces	10-20
INDEX		I-1