TABLE OF CONTENTS

CHAPTER 1

Determining the Damages Period

§ 1.01	Introduction	1-2
§ 1.02	The Outer Boundary of the	
0	Damages Period	1-14
	[1] Commercial Cases	
	[2] Government Cases	
	[3] Laches	
§ 1.03	Determining When Infringement Starts	
§ 1.04	Public Policy Behind the Marking/Notice	
0	Requirement	1-25
	[1] Historical Background	1-26
	[2] Avoiding Innocent Infringement	
	[3] Encouraging Patentees to Give Notice	
	to the Public	1-27
	[4] Encouraging Innovation by Aiding the	
	Public to Identify Patented Articles	. 1-33
§ 1.05	Marking/Notice Statute Limits on Damages	
	[1] Determining if Patentee Is Subject to	
	Section 287(a)	1-37
	[a] Threshold Analysis	
	[i] Method Claims and	
	Apparatus Claims in	
	Same Asserted Patent	1-39
	[ii] Asserted Method Patent with	
	Related Apparatus	
	Patent	1-40.1
	[iii] Assertion of Non-Practiced	
	Unmarked Claims	1-40.2
	[2] Satisfying the Requirements if the	
	Marking/Notice Statute Applies	1-40.3
	[a] Threshold Analysis	1-40.3

	[b] Marking and Constructive	
	Notice	1-40.4
	[i] Licensee/Reseller Marking	1-40.4
	[ii] Package Marking	1-40.6
	[iii] Partial or Substantial	
	Compliance	1-40.8
	[iv] Combination Patents	1-40.10
	[v] Virtual Marking	1-40.11
	[c] Actual Notice	1-40.12
	[i] Balancing Between Notice	1 10.12
	and Declaratory	
	Judgment	1-40.12
	[ii] Notice to Appropriate	1 10.12
	Party	1-40.16
	[iii] Notice by Appropriate	1-40.10
		1-41
	Party	1-41
	[iv] Content of the	1 40
	Communication	1-42
	[v] Infringer's Conduct	1-45
	[3] Consequences of Not Meeting the	1 40
0.1.06	Marking/Notice Requirements	1-46
§ 1.06	Other Limitations and Extensions	1-47
	[1] Foreseeability and Infringement Under	1 40
	the Doctrine of Equivalents	1-48
	[2] Product-by-Process Infringement	1-49
	[3] Design Patents	1-51
	[4] False Marking and Marking Estoppel	1-52
	[a] False Marking	1-52
	[b] Marking Estoppel	1-56
	[5] Pre-Issuance Damages	1-58
	[6] Non-Statutory Double Patenting	1-60
	[7] Relationship to Timing of Hypothetical	
	Negotiation	1-61
	[8] Patent Expiration	1-61
§ 1.07	Questions of Fact and Questions of Law	1-63
	CHAPTER 2	
	Determining the Damages Base	
0.2.21		2 2
§ 2.01	Introduction	2-3
§ 2.02	The Apportionment Principle	2-7
	[1] Lost Profits and Reasonable Royalty	
	Calculations	2-11

			TABLE OF CONTENTS	XV11
	[2]	Asce	ertaining the Applicable Facts	2-13
	[3]	Scop	pe of the Patent	2-14
	[4]	Cate	egorizing the Unpatented	
			Components	2-18
	[5]	App	lying the Apportionment Principle	
		aı	nd Exceptions	2-19
		[a]	Apply the Appropriate	
			Apportionment Principle	
			Methodology	2-22
			[i] Damages Base Is the	
			Smallest Salable Unit,	
			Further Apportioned	2-22
			[ii] Comparable Licenses	2-25
			[iii] Standards Essential	
			Patents	2-25
		[b]	Exceptions to the General Rule—	
			Entire Market Value Rule	2-26
			[i] Basis for Demand	2-26
			[ii] Functional Unit	2-29
			[iii] Analogous to Single	
			Functional Unit	2-30
		[c]	Other Special Circumstances	2-32
			[i] Foreseeability	2-32
			[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	2-36
			[vi] Apportionment in the	
			Reasonable Royalty	
			Context	2-39
	[6]		ermining if Limitations to the Entire	
		N	Iarket Value Rule Apply	2-40
		[a]	Apportionment	2-40
		[b]	Spare Parts/Replacement Parts	2-47
		[c]	Unforeseeability	2-48
		[d]	Sales to United States	
			Government	2-49
§ 2.03			pe of the Damages Base—Indirect	_
			ment	2-50
	[1]		egories of Patent Infringement	2-50
	[2]	Elen	ments of Indirect Infringement	2-51

		[a]	Elen	nents of Induced	
			In	fringement	2-51
			[i]	Intentional Actions	2-51
			[ii]	Knowledge of the	
				Patent	2-52
			[iii]	Knowledge that Acts	
				Induced Infringement	2-52
			[iv]	Underlying Direct	
				Infringement	2-53
		[b]	Cont	ributory Infringement	2-54
			[i]	Sale, Offer or	
				Importation	2-54
			[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
			$[\mathbf{v}]$	Knowledge	2-56
	[3]	Dete	erminir	ng the Damages Base for	
				Infringement	2-56
		[a]		rently Infringing	
				pproach	2-57
		[b]		ortionment Approach	2-57
		[c]		othetical Negotiation	
				pproach	2-58
§ 2.04	Extra	aterrito		cope of the Damages Base	2-59
Ü	[1]			on	2-59
	[2]			ry Infringement Outside	
					2-65
		[a]	Sing	le Component	2-65
		[b]		gn Patents	2-66
		[c]		ess or Method Patents	2-66
		[d]	Com	puter Software	2-67
	[3]	Īmp		Products	2-72
	[4]			traddling a Border	2-73
	[5]			ffers to Sell in U.S. Made	
		C	utside	U.S	2-74
§ 2.05	Desi				2-75

	TABLE OF CONTENTS	xix
	CHAPTER 3	
	Established Royalty Measure of Damages	
§ 3.01 § 3.02	Introduction	3-1
y 3.02	Exists	3-4
	Infringement Began	3-4
	of Persons	3-5
	[3] Uniformity	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	4-9
	[1] The Georgia-Pacific Factors	4-9
	[a] Overview	4-9
	[b] Comparable Licenses [i] Existing Licenses	4-12
	(Factor 1) [ii] Comparable Patents	4-13
	(Factor 2) [iii] Customary Profit	4-17
	Allocation (Factor 12) [c] Scope and Duration of License	4-19
	(Factors 3 & 7)	4-19
	[d] Relationships Between Parties (Factors 4 & 5)	4-20
	[e] Role of Non-Patented Elements	4-20
	(Factors 6 & 13) [f] Product Profitability (Factor 8)	4-20 4-23
	[g] Value of the Patented Invention (Factors 9, 10 & 11)	4-24

	[h] Expert Testimony and the	
	Hypothetical Negotiation	
	(Factors 14 & 15)	4-26
	[i] Other Factors	4-28
	[i] Widespread Infringement	4-28
	[ii] Cost Savings	4-29
	[iii] Price Erosion	4-30
	[iv] Patent Population	4-30
	[v] Other	4-31
	[2] Application of the Georgia-Pacific	
	Factors	4-32
	[a] Trial Court Discretion	4-32
	[b] Appellate Review	4-33
	[3] Throughput or Paid-Up Licenses	4-35
	[4] Percentage of Sales	4-37
§ 4.04	Other Approaches	4-40
	[1] The Analytical Approach	4-40
	[2] Mathematical Models	4-41
	[a] The 25-Percent Rule	4-41
	[b] The Nash Bargaining Solution	4-43
	[3] Percentage of Patentee's Profits	4-44
	[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	4-50.3
§ 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
	[1] Demand for the Patented Product	5-7
	[a] Existing Demand	5-7
	[b] No Demand	5-8

		TABLE OF CONTEN	TS	xxi
		[c] Products Made by F		5.10
	[0]	Method		5-10
	[2]	No Acceptable Non-Infrin		<i>7</i> 10
		Substitutes		5-10
		[a] Product Dimension.		5-11
		[i] Non-Infringing		5 12
		Not Found.		5-13
		[ii] Non-Infringing		5 14
			A malayaia	5-14 5-15
			Analysis	3-13
		[iv] Willful Infring		
		Non-Infring	Absence of	
			3111g	5-16
		[b] Time Dimension		5-16
	[3]	Manufacturing and Marke		3-10
	[2]	to Meet the Demand		5-18
		[a] Manufacturing Capa		5-18.1
		[b] Marketing Capabilit		5-19
		[c] Special Problems Ro	elated to	5-17
		Foreign Sales		5-20
	[4]	Determining the Amount	of Lost	2 20
	Γ.1	Profits		5-21
		[a] Determining the Pat		
		"but for" the Infr		5-23
		[b] Lost Profits Enhance		5-25
				5-25
		[ii] Entire Market		
		E - 3	yed Sales	5-25
			n Damages	5-26
		[c] Lost Profits Limitati	ions	5-27
		[d] Determining the Los	st Profits on	
		the Damages Bas	e	5-27
			.	5-27
		[ii] Cost Variable		5-29
5.03		rtionment of Lost Profits D	amages	5-31
5.04	Inter	company Issues		5-32

CHAPTER 6

Limitations on Damages

§ 6.01	Intro	duction	n	6-2	
§ 6.02	Multiple Recovery and Authorization—				
	M		e Infringers	6-5	
	[1] Types of Infringing Acts and				
		In	nfringers	6-5	
		[a]	Types of Patent Claims	6-6	
		[b]	Types of Infringing Acts	6-9	
	[2]	Crea	ating Authorization	6-15	
		[a]	First Sale of Patented		
			Product—Exhaustion	6-15	
		[b]	Implied License	6-19	
			[i] Creation by Product Sale	6-20	
			[ii] Creation Through Product		
			Circumstances	6-21	
			[iii] Creation Through Equitable		
			Estoppel	6-21	
			[iv] Creation Through Course of		
			Conduct	6-22	
	[3]	Bou	ndaries of Authorization	6-22	
		[a]	Claims and Patents	6-22	
			[i] Apparatus and Method		
			Claims of the Same		
			Patent	6-22	
			[ii] Method Patent	6-23	
			[iii] Combination Patent	6-23	
		[b]	Use Restriction	6-24	
		[c]	Life of the Patented Product	6-25	
		[d]	License Restrictions	6-26	
	[4]	Repa	air/Reconstruction	6-27	
		[a]	Basic Principles	6-27	
		[b]	Effects Both Under Exhaustion		
			and Implied License	6-30	
	[5]	Prod	duct Sales by Licensee	6-31	
§ 6.03	Mult		nfringing Acts	6-33	
§ 6.04	Inde	mnifica	ation	6-35	
	[1]	Obli	igation of Indemnification	6-35	
		[a]	Uniform Commercial Code	6-35	
		[b]	Contractual Arrangements		
			Between Parties	6-38	

		TABLE OF CONTENTS	xxiii
§ 6.05	[2] [3] Joint	Limitations on Indemnification Federal Preemption	6-38.2 6-38.3 6-38.6
		CHAPTER 7	
		Enhancements to Damages	
§ 7.01	Intro	duction	7-3
§ 7.02		eased Damages Under 35 U.S.C. § 284	7-5
	[1]	Introduction	7-5
	[2]	Two-Part Inquiry: Entitlement and	77
	[3]	QuantificationPre-Seagate Entitlement to Enhanced	7-7
	[2]	Damages for Willful Infringement	7-9
		[a] Knowledge and Duty	7-15
		[b] Affirmative Actions to Avoid	, 10
		Infringement	7-21
		[i] Opinion of Counsel	7-21
		[ii] Effect of Adverse	
		Inference	7-23
		[iii] Competency of the	
	F 43	Opinion	7-24.1
	[4]	Post-Seagate Entitlement to Damages	7-27
		[a] Objectively High Likelihood That Acts Constituted	
		Infringement	7-29
		[b] Risk Known or Obvious	7-29
	[5]	Post- <i>Halo</i> Standard for Enhanced	7 30
	[0]	Damages	7-31
	[6]	Quantification of Enhanced Damages	7-33
		[a] Award Amount Is Discretionary	7-33
		[b] The <i>Read</i> Factors	7-34
		[i] Deliberate Copying	7-35
		[ii] Infringer's Good Faith	
		Belief in Invalidity or	= 26
		Non-Infringement	7-36
		[iii] Infringer's Behavior	7-36
		[iv] Infringer's Size and Financial Condition	7-37
		[v] Closeness of the Case	7-38
		[vi] Duration of Infringer's	1-30
		Misconduct	7-39

xxiv		PATENT INFRINGEMENT	
		[vii] Remedial Actions	7-39
		[viii] Infringer's Motivation	
		for Harm	7-39
		[ix] Infringer's Attempt to	
		Conceal Misconduct	7-40
§ 7.03	Attorr	ney Fees Under 35 U.S.C. § 285	7-40.1
3 7.00	[1]	Introduction	7-40.1
	[2]	Determination of Whether the Case is	, .0.1
	[-]	Exceptional—Historical Evolution	
		of Issues	7-43
		[a] Patentee Is the Prevailing Party	7-43
		[b] Accused Infringer Is the	7 13
		Prevailing Party	7-46
		[i] Inequitable Conduct	7-47
		[ii] Patent Misuse	7-50
		[c] Common Issues	7-52
		[i] Litigation Misconduct	7-52
		[ii] Defenses	7-54
		[iii] Appeals	7-54
	[2]	Determining Whether the Case is	7=34
	[3]	Exceptional—Brooks Furniture	
		Era 2005-2014	7-54.1
			7-54.1
		£ 3	7-54.1
	Γ <i>4</i> 1		7-33
	[4]	Determining Whether the Case is	
		Exceptional—Post-Octane	7 55
		Fitness Era	7-55
		[a] Standard	7-55
		[b] Standard of Review	7-56
		[c] Post-Octane Fitness Decisions	7-56
		[i] Fees Shifted from	7.57
		Prevailing Plaintiff	7-57
		[ii] Fees Shifted from	7.57
		Prevailing Defendant	7-57
	F.63	[iii] Fee-Shifting Denied	7-58
	[5]	Determination of the Attorney Fee	7.50
		Amount	7-58
		[a] Generally	7-58
		[b] Special Circumstances	7-58.2
		[i] Dual Awards	7-58.2
		[ii] Expert Witness Fees	7-58.3
		[iii] In-House Counsel	7-58.3
		[iv] Contingent Fees	7-58.4
§ 7.04		dgment Interest Under Damages Statute	7-58.5
	[1]	Introduction	7-58.5

	TABLE OF CONTENTS	XXV
	[2] Awarding Prejudgment Interest is	
	the Norm	7-59
	[a] Denial Proper	7-59
	[b] Denial Not Proper	7-60
	[c] Partial Denial	7-60
	[3] Damage Components	7-61
	[a] Excluding Punitive Components	7-62
	[b] Compensation for Past Damages	7-62
	[4] Interest Rate and Compounding	7-63
	CHAPTER 8	
	Proving Damages	
§ 8.01	Introduction	8-2
	[1] Standards of Proof and Review	8-2
§ 8.02	Admissibility under Federal Rule	0.5
6 6 02	of Evidence 403	8-5
§ 8.03	Expert Testimony under Federal Rule of Evidence 702	8-6
	[1] Historical Admissibility	8-6
	[2] Applicability of Admissibility	0-0
	Standards	8-8
	[a] Expert Testimony Admissible	8-10
	[i] Disputed Facts	8-10
	[ii] Market Research Studies	8-11
	[iii] Disputed Methodology	8-11
	[iv] Speculative Testimony	8-12
	[b] Expert Testimony Inadmissible	8-12
	[i] Invalid or Erroneous	
	Conclusion	8-12
	[ii] Unsupported Methodology	
	or Speculation	8-13
	[iii] Failure to Relate Conclusion	
	to Supporting Evidence	8-13
	[c] Qualifications	8-14
0.04	[3] Case Outcome	8-14
§ 8.04	Record Retention	8-15 8-15
		8-15 8-16
§ 8.05	[2] Defenses	8-10
y 0.03	[1] Judicial Economy	8-17
§ 8.06	Discovery and Local Rules	8-19

CHAPTER 9

Damages Accounting Issues

§ 9.01	Intro	oduction	9-2
§ 9.02	Asse	essing Expert Testimony: Accounting	
	St	tandards for Reliability	9-5
	[1]	Generally	9-5
	[2]	Admissibility Under Federal Rule of	
		Evidence 702	9-5
		[a] Use of the term "Opinion"	
		by Accountants	9-5
		[b] Professional Qualifications, Rules	, ,
		and Ethical Standards	9-5
		[i] GAAP	9-6
		[ii] AICPA Code of Professional	, ,
		Conduct Rules	9-6
		[iii] MCS/SCSS	9-6
		[iv] Other Certifications	9-8
	[3]	Probative Value of Expert Testimony)-0
	[2]	and Limitations	9-9
		[a] Rule 26	9 - 9
		[b] International Methods	9-10
		[c] Completeness and Disclosure	9-10
			9-11
		[d] Valuation	9-11
0.02	A	[e] Skill at Persuading the Court	9-12
§ 9.03		ounting Issues in Reasonable Royalty	0.14
		etermination	9-14
	[1]	Percentage of Sales (or Revenues)	0.15
		Method	9-15
		[a] Royalty Rate	9-15
		[b] Royalty Base	9-16
		[i] Revenue Recognition	0.17
		Principles	9-17
		[ii] Other Issues in Calculating	0.40
	507	Applicable Sales	9-18
	[2]	Percentage of Profits Method	9-19
		[a] Production Costs	9-20
		[b] Fixed and Variable Costs	9-21
		[c] Incremental Cost	9-23
		[d] Standard Cost	9-23
		[e] Activity Based Costing	9-23
		[f] Other Costs	9-24
	[3]	Percentage of Cost Savings Method	9-24
	[4]	Nash Bargaining Solution	9-26

	TABLE OF CONTENTS	xxvi		
§ 9.04	Accounting Issues in Lost Profits	0.26.1		
	Determination	9-26.1		
	[1] Panduit Factors	9-26.1		
	[a] Variables To Include	9-26.1		
	[b] Incremental Profits	9-27		
	Interest	9-28		
§ 9.05	Sources of Information to Support Estimation			
	of Damages	9-29		
§ 9.06	Internal Accounting for Damages Awards			
	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	10-17		
	[2] Temporary Injunctions	10-18		
§ 10.03	International Trade Commission Actions	10-21		
	[1] In General	10-21		
	[2] Special Issues with Respect to			
	Non-Practicing Entities	10-24		
INDEX		I-1		