

U.S. Philips Corp. v. Iwasaki Electric Co.

No. 07-1117, Federal Circuit (Newman, Lourie, Linn*)

Although the assignation printed on the face of a patent is not a conclusive indication of the patent's current ownership, we hold that when the information printed on the patent is correct, it is enough to put an accused infringer on notice of the patentee's identity.

On November 2, 2007, the Federal Circuit, inter alia, reversed the district court's summary judgment limiting U.S. Philips's right of recovery, because of inadequate notice under 35 U.S.C. § 287(a), to acts of infringement after the complaint was filed that alleged Iwasaki infringed U.S. Patent No. 5,109,181, which related to certain high-pressure mercury vapor discharge lamps. The Federal Circuit stated:

Mr. Rolfes, an employee of Philips International B.V., Corporate Intellectual Property, sent Iwasaki a letter on Philips International B.V. letterhead [that] notified Iwasaki of potential infringement [by] Iwasaki's UHE-U HSCR 120 E5H lamp. The '181 patent was listed in the letter, and a copy of the patent was enclosed. The letter also contained an offer for a non-exclusive license. The letter did not identify U.S. Philips as the patent owner or identify Mr. Rolfes as an attorney, nor did it disclose the corporate relationship between U.S. Philips and Philips International B.V. The letter did, however, identify Mr. Rolfes as "Patent Portfolio Manager," speaking on behalf of "Corporate Intellectual Property, Philips International B.V." [T]he corporate intellectual property department of Philips International B.V. is responsible for prosecution, licensing, and enforcement of many of the patents that belong to the Philips family of companies, including patents assigned to U.S. Philips Corporation

We begin with the question of whether the Rolfes letter provided notice of alleged infringement sufficient to satisfy 35 U.S.C. § 287(a). When there has been a failure to mark a patented product, 35 U.S.C. § 287(a) forecloses damages for infringement "except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice." [A]ctual notice under § 287(a) "requires the affirmative communication of a specific charge of infringement by a specific accused product or device." It is not disputed that the Rolfes letter meets these criteria. "[T]he actual notice requirement of § 287(a) demands notice of the patentee's identity as well as notice of infringement," and that the notice must arise by "an affirmative act on the part of the patentee which informs the defendant of infringement."

Iwasaki [argues] that the Rolfes letter was deficient [because] it was not sent by, and did not reference, the patent owner U.S. Philips. The district court held in

Iwasaki's favor on both of these grounds. We disagree. [T]he front page of the '181 patent, which was enclosed with the Rolfes letter, correctly identifies "U.S. Philips Corporation, New York, N.Y." as the assignee. Although the assignment printed on the face of a patent is not a conclusive indication of the patent's current ownership, we hold that when the information printed on the patent is correct, it is enough to put an accused infringer on notice of the patentee's identity. Second, although the Rolfes letter did not purport to come from U.S. Philips Corporation, it is undisputed that Philips International B.V. had the ultimate responsibility for licensing and enforcement of the '181 patent. [In] this case, the Rolfes letter constituted notice under § 287(a), and Iwasaki is liable for any acts of infringement that U.S. Philips can demonstrate took place after the June 7, 2000, date of the letter. The district court's contrary ruling is reversed. . .

U.S. Philips argues that the term "between 10^{-6} and 10^{-4} $\mu\text{mol}/\text{mm}^3$ " expresses a range of orders of magnitude, not a range of more-precise numbers, and [that] one of ordinary skill in the art of lamp chemistry would understand " 10^{-4} " to mean something different and less precise than " 1×10^{-4} "; i.e., the absence of a coefficient ("1") means that the term encompasses all values that are closer on a logarithmic scale to 10^{-4} than to 10^{-5} or 10^{-3} , or a range of approximately 3.2×10^{-5} to 3.2×10^{-4} . Thus, according to U.S. Philips, the full range should be construed as approximately 3.2×10^{-7} to 3.2×10^{-4} $\mu\text{mol}/\text{mm}^3$, and Iwasaki's lamps with admitted halogen concentrations of 1.2×10^{-4} to 2.0×10^{-4} $\mu\text{mol}/\text{mm}^3$ literally infringe.

We disagree with U.S. Philips and, like the district court, conclude that the claim limitation is properly construed to mean "between 1×10^{-6} and 1×10^{-4} $\mu\text{mol}/\text{mm}^3$." [T]he claim construction we affirm today should not be read to state the endpoints of the claimed range with greater precision than the claim language warrants. In some scientific contexts, "1" represents a less precise quantity than "1.0," and "1" may encompass values such as 1.1 that "1.0" may not. In other words, "1.0" may be said to have more significant digits than "1" with no decimal point. Because " 10^{-6} " and " 10^{-4} " are simply the numbers 0.000001 and 0.0001 expressed as powers of ten, the claim language provides no basis for inferring any level of precision beyond the single digit "1." [I]t is technically incorrect to assert, as Iwasaki does in its brief before this court, that " 10^{-x} " should be construed to mean " 1.0×10^{-x} ." It means, simply, " 1×10^{-x} ." " 1.0×10^{-x} " expresses a quantity with greater precision, reflected in the recitation of a significant digit following the decimal point.

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