

No. 12-786

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IN THE  
*Supreme Court of the United States*

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LIMELIGHT NETWORKS, INC.,  
*Petitioner,*

—v.—

AKAMAI TECHNOLOGIES, INC. ET AL.,  
*Respondents.*

—  
**On Writ of Certiorari to the United States  
Court of Appeals for the Federal Circuit**  
—

**BRIEF OF PATENT AND INTELLECTUAL  
PROPERTY LAW SCHOLARS AS *AMICI  
CURIAE* IN SUPPORT OF PETITIONERS ON  
THE ISSUE OF JOINT INFRINGEMENT**

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**INTEREST OF *AMICI CURIAE*<sup>1</sup>**

Amici are law scholars who specialize and practice in intellectual property law, including one who has previously published on the issue of joint infringement and active inducement. Amici have no personal stake in the outcome of this case, but have an interest in seeing that the patent laws develop in a way that promotes rather than impedes innovation.

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<sup>1</sup> No counsel of a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief and no person other than amici curiae, its members, or its counsel made a monetary contribution to its preparation or submission.

Petitioners have provided written consent, on file with the clerk, to the filing of briefs in support of either, or neither, party. Respondent has provided written consent for the filing of this brief, which is being submitted herewith.

## SUMMARY OF ARGUMENT

The Federal Circuit's interpretation of 35 U.S.C. § 271 abrogates the single entity rule from induced infringement of method claims under § 271(b). Such an interpretation is inconsistent with the statutory scheme and is unnecessary to provide adequate protection for patent holders. Principles of vicarious liability allow infringement to be found when the actions of multiple parties, together, satisfy all elements of a claimed invention, so long as one party is directing the others.

The Federal Circuit's new rule broadens the scope of patents to include subject matter not invented by the inventor. It is the inventor's duty to identify the invention that is covered by the patent. Accordingly, the inventor should identify which entities perform which elements of his or her invention. If no single entity performs each element of a claim, no entity has performed the invention as conceived of by the inventor. Rather, the putative infringers have performed methods different from the invention. Accordingly, *Amici* respectfully request this Court to overturn the Federal Circuit's decision and reinstate the single entity rule set forth in *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007).

## ARGUMENT

The Federal Circuit removed the single entity rule as applied to indirect infringement when it adopted a new rule allowing a patent holder to aggregate the actions of multiple parties to allege that there has been active inducement of patent infringement. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1306 (Fed. Cir. 2012) (en banc). This view of active inducement is contrary to the plain language of the statute. Further, this view represents poor policy because it provides patent protection for methods not invented by the inventor.<sup>2</sup>

Determining infringement of an apparatus claim is relatively straightforward. If the alleged infringing device contains all elements of the claimed invention, the device infringes the patent. *See Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 528 (1972).<sup>3</sup> The person liable for direct infringement of a patent is the person who adds the final piece to a patented device, thereby creating a

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<sup>2</sup> See Brendyn M. Reinecke, *Akamai: Patent Claims Are Now Broader than the Invention*, 2013 WIS. L. REV. 1231, available at <http://wisconsinlawreview.org/wp-content/files/3-Reinecke-Final-2.pdf>; Shubha Ghosh, *Managing the Intellectual Property Sprawl*, 49 SAN DIEGO L. REV. 979 (2012); Shubha Ghosh, *Patents and the Regulatory State: Rethinking the Patent Bargain Metaphor after Eldred*, 19 BERKELEY TECH. L.J. 1315 (2004).

<sup>3</sup> The “all elements rule” has been traced back to at least *Barrett v. Hall*, 2 F. Cas. 914 (D. Mass. 1818) (No. 1047) (Story, J.); see also, *Evans v. Eaton*, 8 F. Cas. 846, 855 (D. Pa. 1816) (No. 4559) (Washington, J.), rev’d, 3 U.S. (16 Wheat.) 454 (1818).

device that includes all elements of the claim. *Id.* Thus, if a patented machine includes five elements and a person produces a machine with only four of those elements, no matter how trivial the fifth element is, whoever adds that fifth element is liable for direct infringement of the patent. The logic is also straightforward: the machine with only four elements does not infringe because it does not contain all of the claimed elements. Only with the addition of the fifth element does the machine have all claimed elements, thereby infringing the patent.

But that logic does not follow when applied to method claims. If a patented method contains five steps, and a person performs steps one through four, and another person does step five, then no person has performed the method described in the patent. Therefore, no person should be liable for infringement of the patent. Unlike adding the final part to a device that ends up containing all elements of a patented device, a person committing only the final act of a method does not end up committing all elements of the claimed method.

However, the Federal Circuit held that a person performing the first four steps of a claimed invention is liable as an infringer if that person also actively induced another to commit the final step, but where no single party performs all claimed steps. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1306 (Fed. Cir. 2012) (en banc). In the previous example, the machine with four of the five claimed elements does not infringe the apparatus claim because the machine with only four elements is not the inventor's patented invention. Rather, the inventor patented the machine with all five

elements. Similarly, a person performing only four of five steps does not infringe the method claim because the first four steps are not what the inventor invented and patented. Accordingly, *Amici* respectfully request this Court to overturn the Federal Circuit’s decision and reinstate the single entity rule for the entirety of § 271.

### **I. THE TERM “INFRINGEMENT” CAN HAVE ONLY ONE MEANING WITHIN THE STATUTE**

Basic statutory construction dictates that statutes be read as a whole and in context. *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997). Section 271(a) defines how one “infringes a patent.” 35 U.S.C. § 271(a) (2012).<sup>4</sup> Section 271(b) holds liable one who “actively induces infringement” of the patent. *Id.* § 271(b). Accordingly, the term “infringement” used in § 271(b) depends on another “infring[ing] the patent” as defined in § 271(a). Thus, because § 271(a) requires a single entity to perform all elements of the claimed invention, § 271(b) must also require the single entity rule as it depends on § 271(a). *See Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1310 (Fed. Cir. 2005).

Removing the single entity rule provides patent protection for methods not invented by the inventor. Because the inventor must distinctly claim his or her invention, it is up to the inventor to detail which

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<sup>4</sup> Unless noted otherwise, all references to the United States Code are to the 2012 version.

parties perform which elements according to the invention. *See* 35 U.S.C. § 112(b).

Moreover, eliminating the single entity rule from § 271(b) encourages a patent applicant to ambiguously claim his or her invention. If there is no single entity rule, then, strategically, the applicant would be encouraged to put all elements of the invention into a single claim regardless of which party performs which elements according to the invention. Such a strategy allows the inventor to assign elements to various parties *post hoc*.

**A. There Is No Legal Distinction Between “Infringement” and “Infringes the Patent”**

When interpreting a statute, this Court first examines the text of the statute to determine whether there is any ambiguity. *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 450 (2002). When determining ambiguity, this Court looks “to the language itself, the specific context in which that language is used, and the broader context of the statute as a whole.” *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997). Thus, when interpreting a statute, the text is paramount.

The Federal Circuit noted that § 271(a) details how one infringes a patent, but that “[n]othing in the text indicates that the term ‘infringement’ in [S]ection 271(b) is limited to ‘infringement’ by a single entity [as in Section 271(a)].” *Akamai*, 692 F.3d at 1309 (internal citations omitted). Rather, with respect to § 271(b), the Federal Circuit held that “infringement” refers “most naturally to the acts necessary to infringe a patent, not to whether

those acts are performed by one entity or several.”  
*Id.*

Such an interpretation, however, fails to consider the relation of the words interpreted. It is plausible to read “whoever ‘actively induces infringement,’” as recited in § 271(b), as “whoever ‘actively induces one to infringe a patent.’” If the two statements are equivalent, as *Amici* believe they are, then § 271(b) must rely upon § 271(a). If § 271(a) defines how one directly “infringes a patent,” then it is unnecessary to develop an additional definition of “infring[ing] a patent” with respect to how one “actively induces one to infringe a patent.” Accordingly, if § 271(a) includes the single entity rule, then so must § 271(b).

There is no linguistic distinction to be drawn between a definition of “infringement” as “acts necessary to infringe a patent” and “infring[ing] the patent,” as recited in § 271(a). Neither direct infringement under § 271(a) nor indirect infringement under § 271(b) refers to the single entity rule. Thus, if the single entity rule is to be applied to § 271(a) but not to § 271(b), there should be some textual support for the inconsistency. *Amici* submit that there is no such support.

The Federal Circuit redefined “infringement” for purposes of § 271(b) because “[n]othing in the text indicates that the term ‘infringement’ in [S]ection 271(b) is limited to ‘infringement’ by a single entity.” *Akamai*, 692 F.3d at 1309. However, the same can be said of § 271(a), yet the Federal Circuit did not suggest, nor do *Amici* support the notion, that the single entity rule does not apply to direct infringement. *See id.* at 1307. Defining a term

differently for different subsections is inconsistent with Congress’s statutory scheme and fails to consider § 271(b) in light of the entire statute. *See United States v. Boisdore’s Heirs*, 49 U.S. 113, 122 (1850) (“In expounding a statute, we must not be guided by a single sentence or member of a sentence, but look to the provisions of the whole law, and to its object and policy.”).

**B. It Is the Duty of the Inventor to Identify Which Entities Perform the Claimed Elements According to the Invention**

During prosecution of a patent in the Patent and Trademark Office, the inventor has the opportunity and the duty to “particularly [point] out and distinctly [claim] the subject matter which the inventor . . . regards as the invention.” 35 U.S.C. § 112(b). Assuming that the inventor drafted the claims with the single entity rule in mind, any scenario where there is no direct infringement under § 271(a) is not a scenario the inventor contemplated or invented. Accordingly, any scenario where there is no “infringement” as in § 271(a) does not deserve protection. Furthermore, patent law allows and even promotes others to find non-infringing design-arounds of patented inventions.

The Federal Circuit reasoned that there is no sound policy for holding a party liable for inducing one entity to perform all elements of a claim, but not for holding a similar party liable for inducing two or more entities to perform the elements of the claim. *Akamai*, 692 F.3d at 1309. The court reasoned that both inducers have the same effect on the patent

and, therefore, should he held equally liable for infringement. *Id.* The same argument could also be applied to direct infringement under § 271(a), yet the Federal Circuit does not suggest that the single entity rule should be eliminated for direct infringement.

For example, one who builds a machine patented by another, except for some trivial element in the claim that is non-limiting in any practical way, is not literally liable under § 271(a). This is true even though the patentee is impacted in the same way. Having the same effect on a patentee is not enough of a reason to expand liability of a *statute* that has already been interpreted by courts as requiring the single entity rule. *See BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1379 (Fed. Cir. 2007).

### **C. Eliminating the Single Entity Rule Over-Broadens the Scope of Patents to Include Inventions Not Invented by the Inventor**

Modifying a requirement for who infringes a patent necessarily modifies the scope of patents. If the single entity rule is in effect, a patent owner can assert his or her right to exclude others from practicing a patented claim only in the scenario where one entity satisfies all elements of the patented claim. If the single entity rule is not in effect, the scope of the patented claim expands to include scenarios where multiple parties collectively satisfy all elements of the patented claim. Thus, modifying the legal definition of “infringement”

modifies the scope of patent claims without modifying the language of the claim itself.

Eliminating the single entity rule with respect to induced infringement under § 271(b)—but not with respect to direct infringement under § 271(a)—provides patent claims with a dual scope that depends on the legal theory of infringement liability. Such a dual scope adds uncertainty and indefiniteness to the patent system. That is, a claimed invention has one scope limited to scenarios where one entity satisfies all elements of a patented claim *for direct infringement under § 271(a)*. But the same claim has another scope that is broadened to include scenarios where multiple entities aggregate their actions to satisfy all elements of the patented claim *for induced infringement under § 271(b)*. Under the Federal Circuit’s holding, the legal rules for how the claimed subject matter applies to a particular scenario changes depending upon the legal theory of liability.

If method claims are properly drafted to be infringed by a single actor, then eliminating the single entity rule provides protection to a method not invented by the inventor. Specifically, the new rule provides protection for that same method, but performed by multiple actors, not a single actor. That is not what the inventor invented, and it does not deserve protection. *See* 35 U.S.C. § 112(b) (“The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the inventor . . . regards as the invention.”) (emphasis added). To “particularly point out and distinctly claim” what the inventor asserts is his or her intellectual property, the inventor must

identify the requirements for each actor in the invented system. Under this type of patent system, if multiple actors' actions collectively perform all elements of a claim, that is not an infringement of the invention because the inventor's invention requires *a single* party to perform such elements.

Furthermore, removing the single entity rule can provide patent protection for an idea that is unpatentable. To be patentable, a method must be novel and nonobvious. 35 U.S.C. §§ 102-3. In some instances, a method is disclosed in the prior art if it is performed by multiple actors, but novel and nonobvious if performed by a single entity. In such a situation, the method can be patented over the prior art by including all steps of the method into a single claim. If the patentee can then assert the method claim against multiple actors under the Federal Circuit's interpretation of § 271(b), then the patentee is gaining patent protection for a method that is unpatentable because it is disclosed in the prior art.

Removing the single entity rule for part of the statute adds unnecessary uncertainty and complexity. A question that remains unanswered is what effect removing the single entity rule should have on the Patent Office during patent prosecution. If the single entity rule does not apply to § 271(b), the patent examiner may be able to assume, for purposes of novelty and nonobviousness, that multiple entities can perform the method claim being examined. If the examiner can assume such, then an inventor with a patentable claim under the rules of § 271(a) cannot obtain a patent. If the examiner cannot, then the Patent Office may be able

to issue patents to be asserted against others under § 271(a) but not § 271(b).

Finally, eliminating the single entity rule incentivizes patentees to be ambiguous with their claim language. If the law allows a patent owner to aggregate actions of multiple parties to collectively infringe a patent, the inventor is incentivized to place all elements for all actors into a single, super claim because the claim elements can be divvied up by the patent owner after the patent is granted and he or she finds a scenario to sue for patent infringement. Such a patent creates ambiguities as to what exactly the inventor claims to be the invention and, therefore, is contrary to a purpose of the patent system. *See* 35 U.S.C. § 112(b).

## **II. PROPERLY INTERPRETING INDIRECT INFRINGEMENT IN § 271(B) REQUIRES DIRECT INFRINGEMENT AS DEFINED IN § 271(A)**

The single entity rule set forth in *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007) should apply to § 271(b) in the same manner as the rule applies to § 271(a). Further, § 271(a) should provide the definition of “infringement” for *all* subsections of § 271. Even if *BMC* should have been decided in favor of the position taken by the Federal Circuit in the present case, there is not enough support for this Court to uphold the Federal Circuit’s overturning of *BMC*. Rather, if the decision was not what Congress intended, it should be left to Congress to fix, as it did in a similar situation after this Court’s decision in

*Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972).

**A. Section 271(a) Defines “Infringement”**

The statutory scheme of § 271 indicates that Subsection (a) defines what “infringement” is. Subsections (b) and (c) were initially drafted by Congress as the only other ways that one can be liable for infringement without violating Subsection (a).<sup>5</sup> Accordingly, one who does not perform each element of a claim is not liable under Subsection (a), and one who induces another to perform only a portion of the elements should not be liable under Subsection (b).

The meanings of terms in a statute are derived from context, including the definitions of related terms. *Federal Commc’ns Comm’n v. AT&T, Inc.*, 131 S. Ct. 1177, 1182-83 (2011). Section 271(a) defines who “infringes the patent.” Accordingly, § 271(a) defines the term “infringe” as used in § 271(b). The terms “infringes the patent” and “infringement” are more than related: they stem from the same root word, already defined in § 271(a). Thus, the meaning of the two terms must be closely related in a legal sense. *See id.*

Within the statutory framework of § 271, Congress was very careful in defining what constitutes “infringement.” Only two subsections define actions that constitute “infringement.” Section 271(a) states that whoever “makes, uses,

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5. Subsections (e) through (g) were added after the Patent Act of 1952. *See Akamai*, 692 F.3d at 1342–43 (Linn, J., dissenting).

offers to sell, or sells any patented invention . . . infringes the patent.” Section 271(e)(2) begins by reciting that “[i]t shall be an act of infringement to . . .” and goes on to describe scenarios concerning applications to the Food and Drug Administration regarding patented inventions.

Any definition of “infringement” other than the definition in §§ 271(a) and (e)(2) is superfluous. Other subsections of § 271, including § 271(b), do not describe acts that constitute infringement, but rather describe scenarios where one can be liable “as an infringer” for another’s infringement.<sup>6</sup> Thus, when Congress drafted § 271(b) requiring another to infringe a patent for one to be “liable as an infringer,” it was not an attempt by Congress to define *an additional* way to infringe a patent. Rather, § 271(b) necessarily relies on other portions of the statute to define what acts constitute

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6. *Id.* § 271(b) (“Whoever actively induces infringement of a patent shall be liable *as an infringer.*”) (emphasis added); *id.* § 271(f)(1) (“Whoever without authority supplies [a substantial portion of the patented invention] shall be liable *as an infringer.*”) (emphasis added); *id.* § 271(f)(2) (“Whoever without authority supplies [any component especially adapted to infringe a patent] shall be liable *as an infringer.*”) (emphasis added); *id.* § 271(g) (“Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable *as an infringer . . .*”) (emphasis added). Section 271(c) sets forth requirements for one to “be liable *as a contributory infringer.*” *Id.* § 271(c) (emphasis added). While some of the subsections cited in this footnote do not require a showing of another’s infringement for the statute to be satisfied, the underlying idea is that one is “liable as an infringer” for making it easy for others to infringe. *See id.* §§ 271(b), (c), (f), and (g).

“infringement.” Any additional definition of “infringement” is extraneous to the statute and should be discarded.

**B. Because the Single Entity Rule has Already Been Established, This Court Should Leave It to Congress to Abrogate**

In *Deepsouth*, this Court interpreted § 271 to not hold liable a party that supplied the materials necessary to infringe a patent where the assembly of the materials occurred outside of the United States. *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972). In response to that decision, Congress enacted § 271(f) that holds such a supplier liable “as an infringer.” Thus, Congress has shown not only the ability to overturn a patent law ruling it finds improper, but also the capacity and willingness to do so.

At least because the single entity rule has already been established for active inducement of infringement under § 271(b) in *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007), it should be left to Congress to change the interpretation. Indeed, this Court has already noted that

*we should not expand patent rights by overruling or modifying our prior cases construing the patent statutes, unless the argument for expansion of privilege is based on more than mere inference from ambiguous statutory language. We would*

require a clear and certain signal from Congress before approving the position of a litigant who, as respondent here, argues that the beachhead of privilege is wider, and the area of public use narrower, than courts had previously thought.

*Deepsouth*, 460 U.S. at 531 (emphasis added). Congress recently had the opportunity to overturn *BMC* in the Leahy-Smith America Invents Act, but did not do so. *See* Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011). Maintaining *BMC* and the single entity rule in what is otherwise a patent system overhaul indicates that Congress agreed with *BMC*.

**C. Proper Claim Drafting and Principles of Vicarious Liability Provide Sufficient Patent Protection to the Patentee**

The single entity rule and the holding of *BMC* sufficiently protect against entities that attempt to evade liability by directing another to perform only some elements of a claimed invention. If one party “control[s] or direct[s] each step of the patented process,” that party is liable for direct infringement under § 271(a). *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007). This is a basic notion of vicarious liability. Additionally, each entity in such an enterprise is liable for patent infringement, not just the director. If two parties work together to split up the elements of a claim such that no one entity satisfies every element, yet

their collaboration does not rise to the level of holding one or both liable through the legal principles of vicarious liability, then neither *should* be liable for infringement because there has been no cognizable harm.<sup>7</sup>

Patent law is unique from other areas of law in that it allows an individual to prevent others from doing something that would otherwise be legal, as defined by a patent's claims. Further, the patentee has control over what activities are covered by the patent by properly drafting claims. Accordingly, "[t]he concerns over a party avoiding infringement by arms-length cooperation can usually be offset by proper claim drafting. A patentee can usually structure a claim to capture infringement by a single party." *BMC*, 498 F.3d at 1381.

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<sup>7</sup> See Mark A. Lemley, et al., *Divided Infringement Claims*, 33 AIPLA Q.J. 255 (2005).

**CONCLUSION**

For the foregoing reasons, and those set forth in the Petitioner's brief, the judgment of the court of appeals should be reversed.

Respectfully submitted,

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