

No. 10-06

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**In the Supreme Court of the United States**

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GLOBAL-TECH APPLIANCES, INC., ET AL.  
*Petitioners,*

v.  
SEB, S.A.,  
*Respondent.*

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

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**BRIEF OF LAW PROFESSORS, AS *AMICI*  
*CURIAE*, IN SUPPORT OF RESPONDENT**

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

Amici are professors who teach and write about patent law at law schools and universities throughout the United States. A complete list of signatories is attached as Appendix A. We would like patent law to develop in a way that robustly encourages innovation.

## SUMMARY OF ARGUMENT<sup>2</sup>

The Patent Act of 1952 provides at 35 U.S.C. § 271(b) that “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” This provision codified long-standing precedent deriving from tort law that those who aid and abet direct patent infringement shall be liable for indirect infringement.

Opinions from this Court and lower courts from the mid-19th century through the passage of the 1952 Act repeatedly held that aiding and abetting direct patent infringement solely required *specific intent* merely to further the *acts* that constituted direct infringement. Other than a few lines of aberrant dicta, this Court and others never required knowledge by the aider and abettor that he was

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<sup>1</sup> *Amici* have no financial interest in the outcome of this case. No counsel for a party authored this brief in whole or in part, and no persons other than *amici* made a monetary contribution to its preparation or submission. Pursuant to Rule 37.3, copies of consent letters have already been filed with the Clerk by both parties to the case.

<sup>2</sup> For a more detailed version of the arguments presented here, see Ted Sichelman, *Minding Patent Infringement*, available at <http://ssrn.com/abstract=1734380>.



assisting in the breach of a legal duty (i.e., infringement of a known patent). As a late 19th century article canvassing the case law succinctly stated: “If he intentionally contributed to the act, which the Court holds to be an infringement of the patent, he is [an indirect] infringer, and his actual lack of knowledge of the patent will not excuse him.”<sup>3</sup> This view persisted through the first half of the 20th century and was black-letter law at the time of the passage of the 1952 Patent Act.

Congress intended to codify this long-standing scienter standard when it enacted Section 271(b). Unfortunately, this section’s key phrase—“actively induces infringement”—is not clear on its face, as evidenced by the Federal Circuit’s acknowledgment of as much in its en banc decision in *DSU Medical*.<sup>4</sup> Specifically, this phrase does not readily convey whether “infringement” refers simply to “acts *that happen to be infringing*” or rather to “acts that *the actor knows or should know are infringing*.”

Moreover, this Court’s recitation of the inducement standard in *Grokster*<sup>5</sup>—which stated that Section 271(b) requires a “showing that infringement was encouraged”—suffers from the same ambiguity. Because Congress intended to

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<sup>3</sup> See Hubert Howson, *Contributory Infringement of Patents*, *Electrical Engineer*, Vol. 19, No. 355, pp. 174-75 (Feb. 20, 1895), available at Google Books, <http://books.google.com/books?id=UbvAAAAAMAAJ&dq=Howson%2C%20contributory%20infringement%20patents&pg=PA174#v=onepage&q=Howson,%20contributory%20infringement%20patents&f=false>.

<sup>4</sup> *DSU Medical Corp. v. JMS Co., Ltd.*, 471 F.3d 1293 (Fed. Cir. 2006) (en banc in relevant part).

<sup>5</sup> *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005).

adopt the historical scienter standard—which did not require knowledge of the patent—when it enacted the 1952 Act, the relevant language of Section 271(b) should be interpreted as “actively induces those acts *that happen to constitute infringement, regardless of the actor’s knowledge of such.*”

Moreover, unlike contributory infringement under Section 271(c)—which contains specific verbiage this Court read in *Aro II* (1964) to mandate a deviation from historical practice—nothing in the language of Section 271(b) points towards any standard other than the one applied historically before the Patent Act of 1952. Nor does such a reading of Section 271(b) render Section 271(c) superfluous. Specifically, Section 271(b) expressly requires *specific intent* on the part of the indirect infringer to encourage the acts of the direct infringer, while Section 271(c) does not.

So, on the one hand, we agree with Petitioners that “‘purposeful, culpable expression and conduct’ to encourage an infringement” is required for a finding of inducing infringement. Pet. Br. 14 (quoting *Grokster*, 545 U.S. at 936-37). On the other hand, this requirement merely refers to the “purposeful, culpable ... conduct”—that is, the *specific intent*—of the aider and abettor in encouraging *the acts* constituting direct infringement. Thus, like the Federal Circuit in *DSU Medical*, Petitioners misread *Grokster* when they go one step further to infer that a finding of inducement requires actual knowledge of the patent-at-issue. Pet Br. 14. Rather, the language of Section 271(b), the legislative history of the 1952 Act, and this Court’s own precedent preclude any such prerequisite to a finding of inducement.

Importantly, this result is sensible as a policy matter. First, it places system and method patent claims on more equal footing. Specifically, system claim suits are usually direct infringement actions brought against a patent holder’s *competitors*, while method claim suits frequently lie as direct infringement actions solely against *customers and end-users*, which patent holders are generally averse to sue, or simply cannot sue as a practical matter. In effect, for method patent infringement, patent holders must often sue direct competitors only under a theory of indirect infringement. Eliminating knowledge of the patent as a threshold requirement for inducement thereby diminishes institutional bias in favor of product over process innovations.

Second, the approach advocated here eliminates a strategy of “willful blindness,” whereby potential indirect infringers forgo searching for patents prior to undertaking their potentially infringing behavior—even when it is not costly to do so—to avoid charges of indirect infringement.

Third, for those infringers that are aware of patents prior to infringement, it ends the self-serving and generally meaningless “opinion of counsel” defense strategy, whereby outside counsel immunize indirect infringers by writing conclusory—but usually outcome-determinative—letters stating that the patent-at-issue is not infringed, invalid, or unenforceable.

For these reasons, this Court should find that knowledge of the patent is not an element of inducing infringement under Section 271(b).

## ARGUMENT

### I. HISTORICALLY, INDIRECT INFRINGEMENT MERELY REQUIRED SPECIFIC INTENT, BUT NOT KNOWLEDGE OF THE PATENT

Historically, indirect infringement was modeled on the tort law notion of aiding and abetting, which requires “specific intent” on the part of the aider and abettor to encourage the acts of the direct tortfeasor. *See, e.g., Water Technologies Corp. v. Calco, Ltd.*, 850 F.2d 660, 668 (Fed. Cir. 1988) (finding liability for inducement inheres where one “actively and knowingly aid[s] and abet[s] another’s direct infringement”) (emphasis deleted) (cited with approval in *Grokster*, 545 U.S. at 936).

This part of the brief first succinctly describes the various types of scienter in tort law, and how they map onto patent law. *See, e.g., Carbice Corp. v. Am. Patents Corp.*, 283 U.S. 27, 33 (1931) (“Infringement, whether direct or contributory, is essentially a tort, and implies invasion of some right of the patentee.”). Next, directly contrary to the erroneous assertion made by our fellow professors in Brief for 41 Law, Economics, and Business Professors in Support of Petitioner (at 2-3), this part recounts in detail the relevant pre-1952 opinions, which—other than a few lines of aberrant dicta—did not require any knowledge of the legal duty (i.e., the patent) being infringed for a finding of specific intent.

## A. Levels of Scier in Tort and Patent Law

### 1. *Strict Liability*

Strict liability torts have no scier requirement. *See, e.g., Dalehite v. United States*, 346 U.S. 15, 44 (1953). In patent law, *direct* infringement is a strict liability offense in that intent, knowledge, and even negligence are irrelevant to liability. *See Sontag Chain Stores Co. v. National Nut Co.*, 310 U.S. 281, 295 (1940). As such, scier only plays a role in patent infringement when considering *indirect* and *willful* infringement.

### 2. Negligence, Recklessness & Knowledge

“Negligence is any conduct, except conduct recklessly disregardful of an interest of others, which falls below the standard established by law for the protection of others against unreasonable risk of harm.” Restatement (First) of Torts § 282 (1934). Negligence does not play an immediate role in indirect infringement; however, as described below, it plays a secondary role via constructive knowledge.<sup>6</sup>

The First Restatement of Torts defines “recklessness” as the “disregard of the safety of another if [an actor] intentionally does an act or fails to do an act which it is his duty to the other to do, knowing or having reason to know of facts which

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<sup>6</sup> The Federal Circuit has made clear that negligence is no longer sufficient for a finding of willful infringement. *See In re Seagate*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en banc).

would lead a reasonable man to realize that the actor's conduct not only creates an unreasonable risk ... to the other but also involves a high degree of probability that substantial harm will result to him." Restatement (First) of Torts § 500 (1934). Recklessness plays a role in determining willful infringement, see *In re Seagate, supra*, 497 F.3d at 1370-72, but historically has not been an element of indirect infringement, see Chisum on Patents, § 17.04[2] (2010).

However, knowledge (including constructive knowledge) plays role in assessing contributory infringement under Section 271(c), which states in relevant part:

Whoever offers to sell or sells within the United States ... a component of a patented machine, manufacture, combination or composition ... constituting a material part of the invention, *knowing the same to be especially made or especially adapted for use in an infringement of such patent*, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

35 U.S.C. § 271(c) (emphasis added).

In *DSU*, the Federal Circuit held actual or constructive knowledge of the patent-at-issue is also required to satisfy scienter requirements under Section 271(b). See, e.g., *DSU Medical, supra*, 471 F.3d at 1306. In this case, the Federal Circuit elaborated upon the constructive knowledge prong, adopting a "deliberate indifference of a known risk" standard. *SEB S.A. v. Montgomery Ward & Co., Inc.*,

594 F.3d 1360, 1377 (Fed. Cir. 2010).

However, whether and to what extent knowledge plays any role for inducing infringement under Section 271(b) has never been decided by this Court.

### 3. Intent

Intent tends to come in two flavors—general intent and specific intent. These concepts are aptly illustrated by a driver of a getaway car in a bank robbery hypothetical. If the getaway car driver has the intent to drive the car *per se*, which coincidentally happens to harbor the bank robber, then in legal terminology, the driver has “general intent” to commit the underlying act that aids and abets the bank robber. *See, e.g., Carter v. United States*, 530 U.S. 255, 268 (2000); *Times-Picayune Pub. Co. v. United States*, 345 U.S. 594, 626 (1953).

However, aiding and abetting a bank robbery requires more than general intent. Otherwise, a taxi driver that happens to pick up a bank robber as the robber leaves the scene would be liable for aiding and abetting. Rather, the driver must have “specific intent” to further the bank robber’s actions by intentionally assisting the robber’s escape. *See, e.g., State v. Jackson*, 344 So.2d 961 (La. 1977).

That is, the driver must know of and intend to assist the bank robber in *the act* of taking money from the bank. *See Carter*, 530 U.S. at 268 (“Though this defendant knowingly engaged in the acts of using force and taking money (satisfying ‘general intent’), he did not intend permanently to deprive the bank of its possession of the money (failing to satisfy ‘specific intent’.”); *Nye & Nissen v. United States*, 336 U.S. 613, 619 (1949) (“The trial court

charged that one ‘who aids, abets, counsels, commands, induces, or procures *the commission of an act* is as responsible for that act as if he committed it directly.’ That theory is well engrained in the law.”) (emphasis added); Restatement (First) of Torts § 876 (1939).

In this regard, it is a truism of tort and criminal law that “ignorance of the law is no excuse.” See *Barlow v. United States*, 32 U.S. 404, 411 (1833) (cited with approval in *Jerman v. Carlisle, McNellie, Rini, Kramer & Ulrich LPA*, 130 S. Ct. 1605, 1612 (2010)).

In other words, the common law does not require that the aider and abettor know (or even constructively know) that the bank robber *is breaking the law*. Rather, as long as the aider and abettor intended to assist in acts *that happen to violate a criminal or civil duty*, liability for aiding and abetting will lie (assuming the other elements of the tort or crime are met). See Restatement (First) of Torts § 876(a) (1939) (“For harm resulting to a third person from the tortious conduct of another, a person is liable if he ... orders or induces such conduct, knowing of the conditions under which the act is done or intending the consequences which ensue.”).<sup>7</sup>

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<sup>7</sup> Liability will also lie in tort when the aider and abettor knows that he is assisting the direct tortfeasor in the breach of legal duty—however, such knowledge, while sufficient for a scienter finding, is not necessary. See Restatement (First) of Torts § 876(b) (1939). Thus, statements such that “the common law origin of indirect infringement in accessory liability, which requires that the defendant know that the behavior she aids is wrongful,” Mark A. Lemley, *Inducing Patent Infringement*, 39 U.C. Davis L. Rev. 225, 236 (2005), mistakenly confuse what is merely *sufficient* for what is *necessary* for a finding of secondary liability under the common law.



Other than one line of aberrant dicta, prior to the adoption of the Patent Act of 1952, this Court had always used the traditional standard of specific intent from tort and criminal law as the appropriate level of scienter for indirect patent infringement. *See infra* Section I.B. Thus, pre-1952 precedent from this Court has not required knowledge of the patent to satisfy scienter for indirect infringement.

#### 4. Willfulness

Willfulness in the punitive context—which is how it applies in patent law—usually requires knowledge on the part of the actor of the legal duty otherwise being violated. *See, e.g., United States v. Bishop*, 412 U.S. 346, 360 (1973) (“The Court ... has recognized that the word ‘willfully’ in these statutes generally connotes a voluntary, intentional violation of a *known legal duty*.”) (emphasis added).

Indeed, in patent law, willfulness requires knowledge of the patent itself, i.e., of the source of the legal duty, on the part of the accused infringer. *See, e.g., State Industries, Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (1985) (“To willfully infringe *a patent*, the patent must exist and one must have knowledge of it.”).

Thus, it is important to distinguish willful patent infringement, which has always required knowledge of the patent, from indirect infringement, which did not.

**B. The Historical Doctrine of Indirect Infringement Mirrors Tort Law and Only Requires Specific Intent to Encourage Acts That Happen to Be Directly Infringing**

Early cases in this Court held that the manufacture, sale, or use of some—but not all—of the parts of a combination patent does not constitute infringement. *See, e.g., Prouty v. Draper, Ruggles & Co.*, 41 U.S. 336, 341 (1842) (“The use of any two of these [three patented] parts only ... is, therefore, not the thing patented.”); *see also Eames v. Godfrey*, 68 U.S. 78, 80 (1863).

In *Wallace v. Holmes*, 29 F. Cas. 74 (C.C. Conn. 1871), a lower court adopted for the first time in American jurisprudence the general doctrine of “indirect” (or as it was called until 1952, “contributory”) infringement. The patent concerned an improved lamp, which consisted of a multitude of components, including a “glass chimney” and a “burner.” *Id.* at 79. However, the accused infringers manufactured and sold only the burners, but not the chimneys, and argued under the rule of *Prouty* and *Eames* that they should not be liable for infringement, because they “sold only some of the parts included in the patented combination.” *Id.*

Yet the *Wallace* court rejected the proffered defense. *Id.* at 79-80. Specifically, it noted that the defendants “have exhibited their burner furnished with a chimney, using it in their sales room, to recommend it to customers, and prove its superiority, and, therefore, as a means of inducing the unlawful use of the complainants’ invention.” *Id.*

at 80. Drawing on principles from the common law of torts, the court found that the defendants “have done this for the express purpose of assisting, and making profit by assisting, in a gross infringement of the complainants’ patent.” *Id.* at 79-80; *see also id.* at 81 (“In such case, all are tort-feasors, engaged in a common purpose to infringe the patent, and actually, by their concerted action, producing that result.”).

Without allowing for contributory infringement, the court recognized that the patentee “would be driven to the task of searching out the individual purchasers for use who actually place the chimney on the burner and use it—a consequence which, considering the small value of each separate lamp, and the trouble and expense of prosecution, would make the complainants helpless and remediless.” *Id.*

Although the *Wallace* court’s test might casually be read to require knowledge of the patent, the court held that scienter turned on the “certain knowledge that such burners are to be used, as they can only be used, by the addition of a chimney.” *Id.* Thus, the *Wallace* decision—which is the progenitor of all indirect infringement opinions and has been cited with approval several times by this Court, *see infra*—emphatically did not require any knowledge of the patent for a finding of indirect infringement. *See Dawson Chemical Co. v. Rohm and Haas Co.*, 448 U.S. 176, 188 (1980) (“Yet the court [in *Wallace*] held that there had been ‘palpable interference’ with the patentee’s legal rights, because purchasers would be certain to complete the combination, and hence the infringement, by adding the glass chimney.”); Odin B. Roberts, *Contributory Infringement of Patent Rights*, 12 Harv. L. Rev. 35, 37 (1898) (“The act was found to be wrongful because

of the obvious intent of the defendants to make the burner for use only with another thing which the user was to supply.”).

About a decade after *Wallace v. Holmes*, in *American Cotton-Tie Co. v. Simmons*, 106 U.S. 89 (1882), this Court relied on two lower court opinions that implemented the *Wallace* rule to find that the sale of a component used in an infringing combination constitutes infringement when “the defendants prepare and sell the [component] . . . intending to have it used . . . to produce the results set forth in the [asserted] patents . . .” *Id.* at 95.

Importantly, consistent with the common law of torts, this Court merely required *specific intent* on the part of the alleged infringer that the component be used in the combination *that happened to be infringing*, but not that the alleged indirect infringer know of the patent covering the component. *See id.* Specifically, this Court wrote regarding the sale of a tie (the patented component) for use in baled cotton (the patented product):

They [i.e., the accused infringers] sell the tie having the capacity of use in the manner described, and intended to be so used. Only the bale of cotton and the press are needed to produce the result set forth in the specifications of the patents, and without the bale of cotton and the press the tie would not be made or sold. . . . and, although a person who merely makes and sells the buckle or link in each case may be liable for infringing those patents, he is so liable only as he is regarded as doing what he does *with the purpose of having the buckle or link combined with a band and used to bale*

*cotton.*

*Id.* at 94-95 (emphasis added).<sup>8</sup> In other words, in *American Cotton-Tie*, this Court merely focused on the indirect infringers' specific intent with respect to the direct infringer's acts.

In *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U.S. 425 (1894), this Court cited *Wallace v. Holmes* and other cases for the proposition that "the manufacture and sale of a single element of a combination, with intent that it shall be united to the other elements, and so complete the combination, is an infringement." *Id.* at 433. Importantly, this Court again held that specific intent as to the direct infringer's *act* to combine the component with other elements so as to create a combination (that happened to be patented) was the relevant scienter inquiry—and not whether the alleged contributory infringer knew it was aiding infringement *per se*, i.e., had knowledge of the patent-in-suit.<sup>9</sup>

In the following years, numerous lower court cases cited to the rule of *Wallace v. Holmes*, and this Court's adoption of it in *American Cotton-Tie* and *Morgan Envelope*.<sup>10</sup> Nearly all of these lower court

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<sup>8</sup> See also *id.* ("Because the defendants prepare and sell the arrow tie, composed of the buckle or link and the band, intending to have it used to bale cotton and to produce *the results* set forth in the Cook and the McComb patents, they infringe those patents.") (emphasis added).

<sup>9</sup> The Court ultimately held in *Morgan Envelope* that contributory infringement did not apply "where the element made by the alleged infringer is an article of manufacture perishable in its nature." 152 U.S. at 433.

<sup>10</sup> See, e.g., *Saxe v. Hammond*, *supra*; *Bowker v. Dows*, *supra*; *Renwick v. Pond*, 20 F. 536 (C.C.N.Y. 1872); *Richardson v.*

cases adhered to the established rule that the scienter required for indirect infringement is specific intent with respect to the direct infringer's acts, but not knowledge of the patent-at-issue.<sup>11</sup>

In this regard, the *Thomson-Houston* line of cases are of particular note. In *Thomson-Houston Elec. Co. v. Kelsey Elec. Railway Specialty Co.*, 72 F. 1016 (C.C. Conn. 1896) (*Thomson-Houston I*), the court quoted from *Wallace v. Holmes* and a number of other post-*Wallace* cases for the proposition that the sale of components “which are useful only for the purpose of performing functions involved in the operation of the patent ... raises a presumption that [the accused infringers] intend their [components]

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*Noyes*, 20 F. Cas. 723 (C.C. Mass. 1876); *Rumford Chemical Works v. Hecker*, 20 F. 1342 (C.C.N.J. 1876); *Holly v. Machine Co.*, 4 F. 74 (C.C. Vt. 1880); *Travers v. Beyer*, 26 F. 450 (C.C.N.Y. 1886); *Alabastine Co. v. Payne*, 27 F. 559 (C.C.N.Y. 1886); *Snyder v. Bunnell*, 29 F. 47 (C.C.N.Y. 1886); *Celluloid Manuf'g Co. v. American Zylonite Co.*, 30 F. 437 (C.C.N.Y. 1887); *Thomson-Houston Elec. Co. v. Kelsey Elec. Railway Specialty Co.*, *infra*; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, *infra*; *Boyd v. Cherry*, 50 F. 279 (D. Iowa 1883); *Heaton Peninsular Button Fastener Co. v. Eureka Specialty Co.*, 77 F. 288 (6th Cir. 1896); *Shickle, Harrison & Howard Iron Co. v. St. Louis Car-Coupler Co.*, 77 F. 739, 743 (8th Cir. 1896); *Red Jacket Mfg. Co. v. Davis*, 82 F. 432, 439 (7th Cir. 1897); *American Graphophone Co. v. Leeds*, 87 F. 873 (S.D.N.Y. 1898); *Loew Filter Co. v. German American Filter Co.*, 107 F. 949 (6th Cir. 1901); *Canda v. Michigan Malleable Iron Co.*, 124 F. 486, 489 (6th Cir. 1903); *James Heekin Co. v. Baker*, 138 F. 63, 66 (8th Cir. 1905) (Van Devanter, Circuit Judge).

<sup>11</sup> See *supra* note 10 (citing cases). The only exception we could locate is *Tubular Rivet & Stud Co. v. O'Brien*, 93 F. 200 (D. Mass. 1898), which misread some of the opinions cited earlier to incorrectly find “that a necessary condition of the defendant's guilt is his knowledge of the complainant's patent.” *Id.* at 202-05.

should be so used.” *Id.* at 1018.

In an article cited in *Thomson-Houston I* reviewing many of the 19th century cases, the author confirmed that intent as to the direct infringer’s acts, not knowledge of the patent-in-suit, was the relevant concern of the scienter standard of contributory infringement:

The principle [of contributory infringement] requires an intention on the part of the defendant to participate *in the act* which constitutes the infringement. *By this it is not meant that the party must have known of the patent and intended to infringe it.* If he intentionally contributed to *the act*, which the Court holds to be an infringement of the patent, he is an infringer, and his actual lack of knowledge of the patent will not excuse him. The publication of patents is assumed in law to be sufficient notice to the public of their existence.

Howson, *supra* note 3, at 175 (emphasis added in part). Similarly, one of the leading patent law treatises of the late 19th century stated, “To make or sell a single element, with the intent that it shall be united to the other elements, and so complete the combination, is infringement.” William Callyhan Robinson, *The Law of Patents for Useful Inventions*, Vol. 3, at 101 (1890).

In *Thomson-Houston Elec. Co. v. Ohio Brass Co.*, 80 F. 712 (6th Cir. 1897) (*Thomson-Houston II*)—which was written by then-Circuit Judge William Howard Taft and has been quoted with approval by this Court. *see Aro II*, 377 U.S. at 487—the Sixth

Circuit arrived at the same conclusion as *Thomson-Houston I* regarding the appropriate scienter standard:

[W]here one makes and sells one element of a combination covered by a patent with the *intention and for the purpose of bringing about its use in such a combination* he is guilty of contributory infringement and is equally liable to the patentee with him who in fact organizes the complete combination.

*Thomson-Houston II*, 80 F.2d at 721 (emphasis added).

In *Cortelyou v. Johnson & Co.*, 207 U.S. 196 (1907), this Court briefly addressed a claim of indirect infringement and inducement of breach of contract for the sale of ink for use with a patented machine, the “Neostyle,” which by the terms of its sale was to be used with the seller’s ink. *See id.* at 198-99. In dismissing the claims, this Court wrote:

True, the defendant filled a few orders for ink to be used on a rotary Neostyle, but it does not appear that it ever solicited an order for ink to be so used, that it was ever notified by the plaintiffs of the rights which they claimed, or that anything which it did was considered by them an infringement upon those rights. Further, none of the chief executive officers of the company had knowledge of the special character of the rotary Neostyle machine or the restrictions on the purchase of supplies.

*Id.* at 200-201.



Here, some amici interpret the Court's argument regarding notification "by the plaintiffs of the [patent] rights" as requiring knowledge of the patent for indirect infringement. *See, e.g.*, Brief of Comcast Corp., et al, as Amici Curiae in Support of Petitioner, at 14. However, this interpretation is unsubstantiated. First, the accused infringers also had no "knowledge of the special character of the rotary Neostyle machine," which is the essential scienter element for indirect infringement. In this regard, if the patentee had put the accused infringers on direct notice of the patent, then they would have had such knowledge. Thus, while knowledge of the patent may be *sufficient* to meet the scienter requirement, it is not *necessary*. *Cf.* Restatement (First) of Torts § 876(b) (1939) (stating that knowledge of the legal duty binding the direct tortfeasor is sufficient, but not necessary, for a finding of scienter on the part of the indirect tortfeasor).

Second, knowledge of the patent would be relevant for a finding of inducement of breach of contract. Because the Court did not separately address each claim in the quoted passage, it could have simply been referring to the contract claim in its discussion of "the [patent] rights." Thus, *Cortelyou* should not be read as endorsing any sort of knowledge-of-the-patent requirement.

In *Leeds & Catlin Co. v. Victor Talking Mach. Co.*, 213 U.S. 325 (1909), the Court found Leeds liable for contributory infringement for selling a component of Victor's patented invention to Victor's customers (namely, a record for use in Victor's patented machine). Although the Court only briefly remarked upon the scienter requirements for

contributory infringement, its discussion in no manner deviated from earlier doctrine that knowledge of the patent is not such a requirement. *See id.* at 332-34 (discussing knowledge and intent with respect to the end-use of Leeds' records in the patented machines, but never considering whether Leeds had knowledge of the patent-at-issue); *id.* at 337 ("Petitioner was found guilty of selling records which constituted an element in the combination of the patent in suit, and for that petitioner was punished.").

This Court next addressed the rule in *Henry v. A.B. Dick Co.*, 224 U.S. 1 (1912), *overruled on other grounds by Motion Picture Co. v. Universal Film Co.*, 243 U.S. 502 (1917).<sup>12</sup> Contrary to its prior holdings, the Court stated in *A.B. Dick* without citation that "if the defendants [accused of contributory infringement] *knew of the patent* and that [the direct infringer] had unlawfully made the patented article ... with the intent and purpose that [the direct infringer] should use the infringing article ... they would assist in her infringing use." *Id.* at 33-34 (emphasis added).

This is the only statement by this Court—or any lower courts cited with approval by this Court—that knowledge of the patent is a pre-requisite to a finding of indirect infringement. However, in *A.B. Dick*, the knowledge requirement was not in dispute, and this Court provided no analysis to support its contention. Indeed, the Court went on to cite *Thomson-Houston I*, *see id.*, which as noted earlier,

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<sup>12</sup> Just one year earlier, this Court briefly addressed contributory infringement in the context of copyright law. *See Kalem Co. v. Harper Bros.*, 222 U.S. 55, 63 (1911) (citing *Morgan-Envelope* with approval).

did not require knowledge of the patent to support a finding of indirect infringement.<sup>13</sup>

Rather, the *A.B. Dick* court appeared to misread the use of the phrase “patented invention” in *Thomson-Houston I* as requiring knowledge of the patent. *See id.* Thus, the statement in *A.B. Dick* should be viewed as one line of aberrant and unsupported dicta in a sea of otherwise consistent holdings from this Court. Indeed, following *A.B. Dick*, lower courts continued to hold that knowledge of the patent was not a requirement for indirect infringement (and it does not appear any court followed the mistaken dicta in *A.B. Dick*).<sup>14</sup>

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<sup>13</sup> The Court also cited a number of other cases approvingly in *A.B. Dick*, none of which adopted a knowledge-of-patent requirement. *See* 224 U.S. at 33-34 (citing *Wallace v. Holmes*, *Risdon Iron & Locomotive Works v. Trent*, *Thomson-Houston Electric Co. v. Ohio Brass Co.*, and *American Graphophone Co. v. Hawthorne*).

<sup>14</sup> *See, e.g.*, *New York Scaffolding Company v. Whitney*, 224 F. 452, 459 (8th Cir. 1915); *Safety Car Heating & Lighting Co. v. Gould Coupler Co.*, 229 F. 429 (D.N.Y. 1916); *Individual Drinking Cup Co. v. Errett*, 300 F. 955 (D.N.Y. 1916) (Learned Hand, J.); *Wilson v. Union Tool Co.*, 265 F. 669, 672 (9th Cir. 1920); *Individual Drinking Cup Co. v. Errett*, 297 F. 733 (2d Cir. 1924); *Lenk v. Hunt-Lasher Co.*, 14 F.2d 335, 337 (D. Mass. 1926); *Westinghouse, etc., Co. v. Precise, etc., Co.*, 11 F.2d 209 (2d Cir. 1926); *Electro Bleaching Gas Co. v. Paradon Engineering Co.*, 12 F.2d 511, 513 (2d Cir. 1926); *Bassick Mfg. Co. v. Ready Auto Supply Co.*, 22 F.2d 331 (D.N.Y. 1927); *National Brake & Elec. Co. v. Christensen*, 38 F.2d 721, 723 (7th Cir. 1930); *Trico Products Corp. v. Apco-Mossberg Corp.*, 45 F.2d 594 (1st Cir. 1930); *American Voting Mach. Corporation v. City of New York*, 2 F. Supp. 191, 192 (S.D.N.Y. 1933); *Chas. H. Lilly Co. v. I.F. Laucks, Inc.*, 68 F.2d 175 (9th Cir. 1933); *Autographic Register Co. v. Sturgis Register Co.*, 110 F.2d 883, 885 (6th Cir. 1940). *See generally* 3 Walker, Patents, at 1764-1765 (Deller ed. 1937) (citing cases).

Following *A.B. Dick*, in a line of cases culminating with *Mercoïd Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661 (1944),<sup>15</sup> this Court effectively narrowed the applicability of indirect infringement by holding that the sale of unpatented material cannot constitute contributory infringement, even “where the unpatented material or device is itself an integral part of the structure embodying the patent,” because to allow as much would run afoul of the antitrust laws. *Id.* at 665-66.

## II. CONGRESS DID NOT ALTER THE HISTORICAL PRECEDENT REGARDING SCIENTER IN ENACTING SECTION 271(B) OF THE PATENT ACT OF 1952

Following this Court’s decision in *Mercoïd*, as part of the Patent Act of 1952, Congress decided to reinstate the law of indirect infringement by codifying precedent as it existed prior to *Mercoïd*. This section discusses that codification and shows that—in enacting the inducement provision of Section 271(b)—Congress did not intend to deviate from the historical practice that knowledge of the patent was not required.

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<sup>15</sup> Previous cases addressing the issue included *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502 (1917); *Carbice Corp. v. American Patents Development Corp.*, 283 U.S. 27 (1931); *Leitch Mfg. Co. v. Barber Co.*, 302 U.S. 458 (1938); and *B.B. Chemical Co. v. Ellis*, 314 U.S. 495 (1942).

**A. The Legislative History of the 1952 Act Demonstrates Congress Intended No Change in Scienter Standards from Pre-1952 Doctrine**

The Patent Act of 1952 codified the historical precedents in Sections 271(b) and 271(c), other than to effectively overrule this Court's holding in *Mercoïd*. See 35 U.S.C. § 271(d); S. Rep. No. 82-1979, at 8, 28 (1952); H.R. Rep. No. 82-1923, at 9 (1952); *Dawson Chemical*, 448 U.S. at 198-212 (recounting the effort to resurrect the doctrine of contributory infringement in the Patent Act of 1952); see also Charles W. Adams, *A Brief History of Indirect Liability for Patent Infringement*, 22 Santa Clara Computer & High Tech. L.J. 369, 384-89 (2006); Note, *Section 271(b) of The Patent Act of 1952: Confusion Codified*, 66 Yale L.J. 132, 139 (1956)

Specifically, Congress intended Section 271(c) to codify those cases relating to the sale of a component of an infringing combination, and Section 271(b) to codify those cases relating to general aiding and abetting of direct infringement. See S. Rep. No. 82-1979, at 8, 28 (1952); H.R. Rep. No. 82-1923, at 9 (1952); *Aro II*, 377 U.S. at 486 (“[S]ection [271(c)] was designed to ‘codify in statutory form principles of contributory infringement’ which had been ‘part of our law for about 80 years.’”); Chisum on Patents § 17.04[2] (2010) (“[The] legislative history indicates that the two sections were intended as complementary provisions, together codifying the basic principles of contributory infringement developed by the courts before 1952.”). Indeed, this Court confirmed as much in *Grokster*: “The rule on

inducement of infringement as developed in the early cases is no different today.” 545 U.S. at 936.

Contrary to the view of Petitioners and some of our fellow professors writing in support of Petitioners, the legislative history of the 1952 Act does not in any manner show intent by Congress to impose a “knowledge of the patent” requirement onto Section 271(b). Although the legislative history notes that indirect infringement “has been applied to enjoin those who sought *to cause infringement* by supplying someone else with the means and directions for infringing a patent,” S. Rep. No. 82-1979, at 8 (emphasis added), this language is no less ambiguous than that of Section 271(b) (“actively induces infringement”). Indeed, the legislative history goes on to note that “Paragraph (b) recites *in broad terms* that one who aids and abets an infringement is likewise an infringer.” *Id.* (emphasis added). This and other portions of the legislative history confirm the understanding that Section 271(b) codified the historical precedent, which—relying on the same principles as the common law of torts—did not require any knowledge of the legal duty (i.e., patent) at issue, but merely specific intent to encourage the direct infringer’s acts. *See* S. Rep. No. 82-1979 at 8 (“One who actively induces infringement as by aiding and abetting the same is liable as an infringer ....”).

**B. Section 271(b) is Ambiguous on Its Face and Must Be Interpreted in View of the Legislative History and Historical Context, Which Preclude a “Knowledge of the Legal Duty” Requirement**

In *DSU Medical*, the Federal Circuit held in an en banc portion of that opinion that inducement of infringement under Section 271(b) requires that “the alleged infringer knew or should have known his actions would induce actual infringement . . . .” *DSU Medical*, 471 F.3d at 1304. On this basis, the Federal Circuit reasoned that this test necessarily “includes the requirement that [the alleged infringer] knew of the patent.” *Id.*

Importantly, the Federal Circuit noted in its opinion that Section 271(b) is ambiguous on its face:

The statute does not define whether the purported infringer must intend to induce the infringement [i.e., have knowledge that acts are infringing] or whether the purported infringer must merely intend to engage in acts that induce the infringement regardless of whether it knows it is causing another to infringe.

471 F.3d at 1305. *See also* Chisum on Patents § 17.04[2] (2010) (noting the ambiguity present in Section 271(b)).

Instead of resort to the legislative history of the Patent Act of 1952 or historical precedent, the Federal Circuit interpreted a few lines from this Court in *Grokster* as mandating that Section 271(b) requires knowledge that the underlying acts

constituted infringement. *See DSU Medical*, 471 at 1306 (“*Grokster*, thus, validated this court’s articulation of the state of mind requirement for inducement ... that the ‘the alleged infringer must be shown ... to have knowingly induced infringement,’ not merely knowingly induced the acts that constitute direct infringement.”) (citations omitted).

However, the Federal Circuit’s reading of *Grokster* is *not* supported by the language it quoted, which reads:

Evidence of “active steps ... taken to encourage direct infringement,” such as advertising an infringing use or instructing how to engage in an infringing use, show an affirmative intent that the product be used to infringe, and a showing that infringement was encouraged overcomes the law’s reluctance to find liability when a defendant merely sells a commercial product suitable for some lawful use.

545 U.S. at 936 (citations and footnote omitted).<sup>16</sup>

In particular, the key phrases in the quoted passage—such as “encourage direct infringement,” “affirmative intent that the product be used to infringe,” and “showing that an infringement was encouraged”—simply mirror the ambiguous language of Section 271(b) itself, which states in relevant part: “[w]hoever *actively induces*

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<sup>16</sup> All of the citations made by this Court in this paragraph were to Federal Circuit and other lower court opinions that are not determinative of the question presented in this case—which, of course, was not directly presented in *Grokster*. 545 U.S. at 936.



*infringement* of a patent shall be liable . . . .”<sup>17</sup> And the Court’s phrase “merely sells a commercial product suitable for some lawful use” is of no assistance, because it refers to a sale for purposes not intended for use in the patented product or method.<sup>18</sup> *See id.*

This Court did examine whether Grokster engaged in “purposeful, culpable expression and conduct[.]” *See* Grokster, 125 S. Ct. at 2780. But as described in Part I, culpability for aiding and abetting in tort need not—and, usually, does not turn on whether the alleged tortfeasor knew that the acts he or she intended violated a legal duty. Rather, mere specific intent to encourage the *acts* of the primary tortfeasor is sufficient to show culpability. *See, e.g.*, Restatement (First) of Torts § 876(a) (1939).

In sum, this Court did not decide the issue presented here in its *Grokster* opinion.<sup>19</sup>

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<sup>17</sup> *See, e.g.*, Timothy R. Holbrook, *The Intent Element of Induced Infringement*, 22 Santa Clara Computer & High Tech. L.J. 399, 407-08 (2006) (“The Court’s analysis [in *Grokster*], however, does not expressly or implicitly establish which intent standard is the correct one.”).

<sup>18</sup> This Court continued to use the same sort of ambiguous language in the remainder of *Grokster*. *See, e.g.*, 125 S. Ct. at 2781 (requiring a “showing that active steps were taken with the purpose of bringing about infringing acts, and of showing that infringing acts took place by using the device distributed”).

<sup>19</sup> Indeed, as one amici in favor of Petitioners rightly points out, “Knowledge of infringement was not disputed in *Grokster*; it was incontrovertible in that case that the online service providers knew that they were facilitating massive amounts of copyright infringement.” Brief of Comcast Corp., et al., as Amici Curiae in Support of Petitioner, at 6 (citing *Grokster*, 545 U.S. at 920).

**C. This Court's Holding in *Aro Convertible II* Regarding 271(c) Does Not Affect the Interpretation of 271(b)**

As discussed at length in Part I—other than one line of aberrant dicta—prior to the 1952 Act, knowledge of the patent was consistently held by this Court *not* to be a prerequisite for a finding of contributory infringement. However, in *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476 (1964) (*Aro II*), this Court held otherwise in a 5-4 decision regarding the 1952 Act's codification of contributory infringement in Section 271(c).<sup>20</sup>

For the reasons stated by the four dissenting Justices, we urge this Court to overrule the incorrect holding in *Aro II*—and this Court may do so because it would necessarily resolve the issue in this case.<sup>21</sup> See *Blonder-Tongue Laboratories, Inc. v. University Foundation*, 402 U.S. 313, 320 n.6 (1971); see also *U.S. v. Hasting*, 461 U.S. 499, 513 n.4 (1983) (Stevens, J., concurring).

Regardless, *the majority's holding in Aro II does not mandate the outcome in this case*. Specifically, all nine Justices in *Aro II* agreed that imposing a knowledge-of-the-patent requirement on Section 271(c) could not be premised upon Congress's codification of historical precedent. *Aro II*, 377 U.S. at 487-88; see also *id.* at 525-28 (Black, J., concurring) (relying on other arguments to find such

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<sup>20</sup> Chief Justice Warren and Justices Black, Douglas, Clark, and White held this view. Justices Harlan, Brennan, Stewart, and Goldberg dissented on the issue. 377 U.S. at 482 n.8.

<sup>21</sup> A detailed discussion of why *Aro II* was wrongly decided can be found in Ted Sichelman, *Minding Patent Infringement*, available at <http://ssrn.com/abstract=1734380>.

a requirement). Rather, the issue arose solely because of the peculiar, narrow wording of Section 271(c), which reflected a compromise in response to congressional testimony regarding the appropriate scienter standard for that section. *See id.* at 487-88; 525-28. Five justices relied on that testimony and the statutory amendment to find that Congress deviated from historical precedent, while four justices disagreed, arguing that Congress codified that precedent. *See id.*

Irrespective of the outcome in *Aro II*, Section 271(c)'s narrow wording (and associated legislative history) does not appear in (nor applies to) Section 271(b), which contains very broad, unrestricted language. As such, this Court's holding in *Aro II* does not imply imposing a knowledge-of-the-patent requirement on Section 271(b).

Petitioners argue that by eliminating the knowledge-of-the-patent requirement under Section 271(b), that section would effectively render meaningless the stricter requirements under Section 271(c), recapturing activity that would otherwise escape liability under Section 271(c). Pet. Br. 11; *see also* Holbrook, *supra*, at 408 ("Using the broader intent standard risks swallowing section 271(c) altogether.").

However, the premise that Section 271(b) would somehow "swallow" Section 271(c) is without basis. Specifically, Section 271(b) imposes two additional hurdles (general and specific intent) not present in Section 271(c). *See* Giles S. Rich, *Infringement Under Section 271 of the Patent Act of 1952*, 21 Geo. Wash. L. Rev. 521, 538-39 (1953) (noting the differences in the scienter requirements between the two provisions) ("A significant difference between

paragraphs (b) and (c) is that proof of facts which comply with the provisions of the latter gives rise to liability without any further proof of intent or inducement ...."); Charles E. Miller, *Some Views on the Law of Patent Infringement by Inducement*, 53 J. Pat. Off. Soc'y 86, 97-98 (1971) (same). As this Court recognized in *Grokster*, unlike Section 271(c), mere "knowledge" of potential infringing uses does not suffice for finding of inducement under Section 271(b); rather, specific intent to encourage the acts constituting infringement is necessary. *See Grokster*, 545 U.S. at 935-937.

### **III. ELIMINATING A "KNOWLEDGE OF THE PATENT" REQUIREMENT IS SENSIBLE ON POLICY GROUNDS**

Aside from statutory interpretation arguments, there are a number of important policy rationales that support this Court adhering to its historical precedent. In addition, countervailing rationales propounded by the Petitioners, amici in support of Petitioners, and commentators are not persuasive.

#### **A. Eliminating a "Lack of Knowledge of the Infringement" Defense Properly Places System and Method Claims on More Equal Footing**

Currently, there is an asymmetry between system claims—which tend to protect product innovations—and method claims—which tend to protect process innovations. Specifically, direct infringement under Section 271(a) lies for anyone

who makes, uses, sells, or offers to sell the *entire* patented invention. Thus, a patentee can sue a competitor that makes or sells a patented product for direct infringement.

However, many patented processes only cover a method performed by end-user customers of a competitor, because the competitor itself does not perform the method. For instance, a competitor of the patentee may sell a tool that is not patented, but the competitor nonetheless instructs end-user customers how to use that tool in performing the patented process. Similarly, a competitor may sell an unpatented drug but provide instructions on how to use the drug in a manner so as to infringe a process patent on a “new use” of the drug. *See Dawson Chemical*, 448 U.S. at 188.

In these situations, the patentee could sue the competitors’ customers for performing the patented method, but usually chooses not to do so for at least two reasons: (1) the competitors’ customers are usually potential customers of the patentee; (2) the customers are numerous, and suing them would be costly and fraught with uncertainty in terms of recovery, even in a class-action context.

As this Court stated in *Dawson Chemical*, this “protection [of indirect infringement] is of particular importance in situations, like the oil lamp case [*Wallace v. Holmes*] itself, where enforcement against direct infringers would be difficult, and where the technicalities of patent law make it relatively easy to profit from another’s invention without risking a charge of direct infringement.” 448 U.S. at 188; *see also* Rader, *Toward a Coherent Law of Inducement To Infringe: Why the Federal Circuit Should Adopt the Hewlett-Packard Standard for*

*Intent Under § 271(b)*, 10 Fed. Cir. B.J. 299, 306 (2000) (“Without inducement to infringe under § 271(b), many patentees would have no recourse against wholesale infringement of their patents.”).

For these reasons, to the extent indirect infringement encompasses any requirements not present for direct infringement, a bias results favoring product over process innovations. *See generally Dawson Chemical*, 478 U.S. at 221-22 (noting the importance of contributory infringement to the protection of chemical process inventions).

Of course, from a policy perspective, against the interest in equalizing incentives to generate product and process innovations, is the interest in promoting the manufacture, sale, and use of non-patented goods. For this reason, we do not advocate a mere strict liability or general intent scienter standard for indirect infringement.<sup>22</sup>

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<sup>22</sup> Some amici have expressed a concern that a rule not requiring knowledge of the patent will have pernicious consequences in the copyright context. *Cf. Grokster*, 545 U.S. at 936 (importing the rule of inducing patent infringement into copyright). As an initial matter, this Court’s adoption of inducement in the copyright context need not be cabined by the statutory construction required for Section 271(b), since there is no similar statutory provision in the Copyright Act. Furthermore, we believe that the requirement of specific intent adequately protects companies such as Google, Facebook, Yahoo, and other content providers whose websites and software might be used to facilitate copyright infringement. While these companies have “general intent” to operate their sites and software, they do not have “specific intent” to further acts of end-users that happen to constitute infringement. *See supra* Part I.A. And unlike *Grokster*, there is no evidence that these sites are used primarily to facilitate copyright infringement, which might provide circumstantial evidence of such intent. *See Grokster*, 545 U.S. at 922-23. Just as a gun

Rather, Section 271(b) appropriately achieves the balance between competing policy interests by requiring specific intent on the part of the indirect infringer to further the *acts* of direct infringement. This might be proved, for example, by the indirect infringer providing instructions to a customer on how to perform a patented method. Knowledge of the patent, on the other hand, is not necessary to determine whether the indirect infringer engages in activity that encourages acts that infringe the patented method.<sup>23</sup> Rather, such knowledge is only essential in deciding whether the indirect infringer’s activity is “willful” in the punitive sense. Like aiding and abetting in tort law, knowledge of the legal duty should not be a requirement with respect to indirect infringement.<sup>24</sup>

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manufacturer has general intent to sell guns and specific intent that its purchasers fire the guns—and even though it might know some of its guns will be used to commit illegal acts—it lacks specific intent to further the illegal acts, and hence would not be liable under the common law for its sales. For the same reasons, ordinary website content providers would not be liable for inducing copyright infringement under the rule we advocate.

<sup>23</sup> As we noted earlier, knowledge of the patent may *suffice* to show that the indirect infringer specifically intended to encourage the acts of the direct infringer, but such knowledge is not *necessary* to a finding of specific intent. *See supra* note 7.

<sup>24</sup> For these reasons, Petitioners’ and some amici’s contention that “an accused inducer cannot engage in ‘purposeful, culpable expression and conduct’ without actual knowledge of the patent” is meritless. Pet. Br. 14. As we noted earlier, specific intent to further the acts of direct infringement is sufficient for a finding a “purposeful, culpable expression and conduct.” *See Grokster*, 545 U.S. at 936-37.

**B. A “Lack of Knowledge of the Infringement” Requirement Would Lead to Willful Blindness and Diminish the Incentive to Read Patents**

If lack of knowledge of the patent-at-issue can preclude liability, then potential infringers will have a strong incentive to adopt a strategy of “willful blindness” by avoiding reading patents. Specifically, when a potential infringer conducts a pre-product launch “freedom to operate” search of patents that might cover its product, it increases the odds that it will find – and, hence, gain knowledge – of a patent that will later be asserted against it. By forgoing these searches in a strategy of willful blindness, potential infringers can reduce the possibility of paying damages for indirect infringement by defending on the grounds of lack of knowledge of the patent-at-issue.

Such a strategy decreases the value of patents in driving innovation by immunizing otherwise infringing behavior. Moreover, it leads to widespread avoidance of reading patents, which directly contradicts one of the fundamental goals of patent law—the dissemination of inventive technical information in patent disclosures. *See Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 63 (1998).



**C. Eliminating a “Lack of Knowledge of the Infringement” Defense Would End the Usually Meaningless Advice-of-Counsel Defense**

When a potential indirect infringer does become aware of patents, a scienter standard that requires the infringer to know of the applicable legal duty (i.e., the patent), and to intend the breach thereof, allows the potential infringer to easily immunize itself via a advice-of-counsel defense. In particular, if counsel provides a letter stating that the patent-at-issue is not infringed, invalid, or unenforceable—and that letter meets the relatively minimal requirement of plausibility under current Federal Circuit doctrine—this will immunize any accused infringer from a finding of indirect infringement. *See Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 699 (2008). As many have recognized, opinion-of-counsel letters are notoriously unreliable as an indicator of the accused infringer’s state of mind, because they are prepared solely for the purpose of providing an excuse to engage in otherwise infringing activities. *See Rader, supra*, at 332 (“[O]btaining an opinion of counsel regarding inducement would ... enabl[e] a would-be inducer to forge ahead with the harmful activity, by having it rubber-stamped by an outside law firm.”).

By eliminating “lack of knowledge of the infringement” as a defense to inducement, this Court would end reliance on this self-serving and generally meaningless defense.

**CONCLUSION**

For these reasons, the judgment of the Court of Appeals should be affirmed, but on other grounds.

Respectfully submitted,

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**APPENDIX A – LIST OF SIGNATORIES<sup>1</sup>**

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<sup>1</sup> All signatories to this brief sign in their personal capacity, and in no manner represent the views of their academic institutions.