Better Safe Than Sorry — Damages

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Title 35 of the United States Code

§ 284 - Damages

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

Only "damages" may be recovered (not "profits" as patent law does not punish the infringer).

"compensation for the pecuniary loss he has suffered from the infringement, without regard to the question whether the defendant has gained or lost by his unlawful acts." Coupe v. Royer (1865)

The goal is to put the patentee back in the position the patentee would have been in had the infringement not occurred

"how much had the Patent Holder and Licensee suffered by the infringement...had the Infringer not infringed, what would Patent Holder-Licensee have made?" *Livesay Window v. Livesay Indus.* (5th Cir. 1958)

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- ➤ Only 2 types of Damages allowed, "Lost Profits" and "Reasonable Royalties"
- ➤ "Lost Profits" tends to be higher than "Reasonable Royalties", which is considered as the floor for damages under §284
- > Patentees may be entitled to both "Lost Profits" and "Reasonable Royalties"

Lost Profits

Rational

Giving patentees profits they would have earned "but for" the infringing act effectively puts them in the position absent the infringement

Panduit Factors

- > Demand for the patented product as a whole
- > The absence of acceptable non-infringing alternatives
- Manufacturing and marketing capabilities to exploit the demand
- > The amount of profit it would have made but for the infringement

Reasonable Royalties

Rational

Form of restitution, in the sense that the award forces the infringer to pay back the royalty it wrongfully withheld from the patentee

Georgia Pacific Hypotethical Negotiation

- A hypotethical negotiation between a "willing licensor" (the patent owner) and a "willing licensee" (the infringer), at the time the infringement began, to determine reasonable royalty damages using the listed 15 factors.
- Hypothetical negotiation assumes that the patent in suit was valid and infringed
- "Book of Wisdom" approach may be used in some cases (i.e. commercial success of the invention, extent of the use of the invention by the licensee)

Title 35 of the United States Code

§ 284 - Damages

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive **expert testimony** as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

- ➤ During trial, damages experts from both sides opine on the Reasonable Royalities based on the 15 *Georgia-Pacific* factors for the jury to make the determination
- ➤ The priorities of the 15 *Georgia-Pacific* factors are not set, allowing the damages experts to argue in broad ranges of "reasonable" royalties



Georgia-Pacific Co. v. U.S. Plywood Co. (S.D.N.Y. 1970)

- 1. The <u>royalties received</u> by the patentee for the licensing of the patent in suit, proving or tending to prove an established royalty.
- 2. The <u>rates paid by the licensee</u> for use of <u>other patents comparable to the patent in suit</u>.
- 3. The <u>nature and scope of the license</u>, as exclusive or nonexclusive; or as restricted or nonrestricted in terms of territory or with respect to whom the product may be sold.
- 4. The <u>licensor's established policy and marketing program to maintain his patent</u> monopoly by not licensing others to use the invention or by granting licenses under special conditions designed to preserve that monopoly.
 - > Prior license agreements bear heavy weight in the Georgia-Pacific analysis

Georgia-Pacific Co. v. U.S. Plywood Co. (S.D.N.Y. 1970)

- 5. The <u>commercial relationship between the licensor and licensee</u>, such as, whether they are competitors in the same territory in the same line of business; or whether they are inventor and promoter.
- 6. The effect of selling the patented specialty in <u>promoting sales of other products of the licensee</u>; the existing value of the invention to the licensor as a <u>generator or sales of his non-patented items</u>; and the extent of such derivative or convoyed sales.
- 7. The duration of the patent and the <u>term of the license</u>.
- 8. The <u>established profitability</u> of the product made under the patent; its <u>commercial success</u>; and its <u>current popularity</u>.
- 9. The <u>utility and advantages</u> of the patent property <u>over the old modes or devices</u>, if any, that had been used for working out similar results.
- 10. The <u>nature of the patented invention</u>; the <u>character of the commercial embodiment</u> of it as owned and produced by the licensor; and <u>benefits</u> to those who have used the invention.

Georgia-Pacific Co. v. U.S. Plywood Co. (S.D.N.Y. 1970)

- 11. The extent to which the infringer has <u>made use of the invention</u>; and any evidence probative of the value of that use.
- 12. The <u>portion of the profit or of the selling price that may be customary in the</u> <u>particular business</u> or in comparable businesses to allow for the use of the invention or analogous inventions.
- 13. The <u>portion of the realizable profit that should be credited to the invention as</u> distinguished from non-patented elements, the manufacturing process, business risks, or significant features or improvements added by the infringer.
- 14. The opinion testimony of qualified experts.
- 15. The amount that a licensor and a licensee would have agreed upon (at the time the infringement began) if both had been <u>reasonably and voluntarily trying to reach an agreement</u>

Other Methods of Damage Calculation

- ➤ The Federal Circuit expressly stated that *Georgia-Pacific* approach is not the only possible approach to computing reasonable royalty damages.
 - Infringer had an internal memo just before infringement began projecting net profit to be about 40% of the anticipated sales price. As the standard industry net profit was about 10% of the sales price, the patentee was awarded a reasonable royalty damages of 30%, the difference between the two. TWM Manufacturing Co. v. Dura Corp. (1986)
- ➤ "Rule of thumb" approach: some courts have found that 25% of the profit margin for any infringing products to be attributed to the infringed patent. This approach was rejected by the Federal Circuit in *Uniloc USA v. Microsoft* (2011)
- ➤ "Nash Bargaining Solution" approach: 50/50 split of profits between the patent owner and infringer as a starting point to establish reasonable royalty. Federal circuit has been reluctanct to accept this approach, for example, denied expert's damages testimony as inadmissable in *Virnetx v. Cisco Systems* (2014)

SSPPU v. EMVR v. FRAND

Smallest Salable Patent Practicing Unit

Cornell University v Hewlett-Packard Company, (N.D. NY, 2009)

- ➤ Plaintiff Cornell University claimed infringement by Hewlett-Packard's sales of \$36 billion of workstations and computer servers
- ➤ Judge had reminded Cornell of the "vast amounts of technology beyond the infringing part of the processors" and had advised the plaintiff "to present well-documented economic evidence closely tied to the scope of the claimed invention".
- ➤ "The logical and readily available alternative was the smallest saleable infringing unit with close relation to the claimed invention namely the **processor** itself"
- > The doctrine aims to reflect the correct "economic footprint" of the invention

Entire Market Value Rule

Power Integrations v. Fairchild Semicon. (Fed. Cir. 2018)

- Admission of evidence of the entire market value only serves to make a patentee's proffered damages amount appear modest by comparison, and to artificially inflate the jury's damages calculation
- ➤ To invoke the entire market rule in assessing damages, a patentee bears the burden of proving "the patented feature is the sole driver of customer demand or substantially creates the value of the component parts"
- ➤ Even when a damages theory relies on the smallest salable unit as the basis for calculating the royalty, the patentee must estimate what portion of that smallest salable unit is attributable to the patented technology when the smallest salable unit itself contains several non-infringing features

FRAND

- > "Top-down" approach: Start by taking a total aggregate royalty for all SEPs related to the standard and work backwards to determine the value of a given patent or portfolio
- ➤ Enhanced Damages: District Courts has ruled to increase FRAND rates upon finding of willful infringement. *Core Wireless Licensing S.a.r.l. v. LG Electronics, Inc. and LG Electronics Mobilecomm U.S.A., Inc.*, (E.D. Tx 2016)
- ➤ **Injunction**: Federal Circuit opined that there is no *per se* rule precluding injunctions for SEPs, which may lead to an argument that royalties in excess of FRAND rates may be available. *Apple, Inc. and Next Software Inc. v. Motorola, Inc. and Motorola Mobility, Inc.* (Fed. Cir. 2014)

Webinar Series ~ Better Safe than Sorry ~

No. 1: Introduction (2021.01.29)

No. 2: Willful Infringement (2021.02.26)

No. 3: Virtual Patent Marking (2021.05.28)

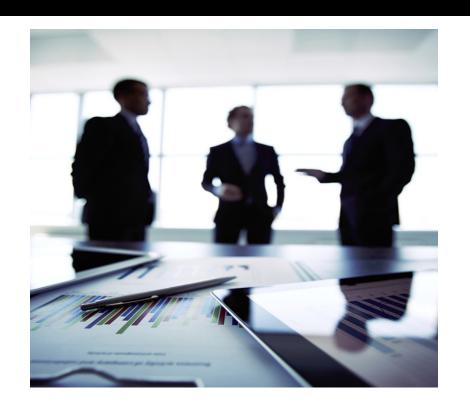
No. 4: Jury Trial (2021.06.25)

No. 5: Damages (2021.07.30)

No. 6: Discovery (2021.09.24)

No. 7: Doctrine of Equivalents (2021.10.29)

No. 8: ITC (2021.11.26)



Presenter



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Jitsuro Morishita devotes his practice to resolving complex global disputes in the areas of intellectual property, antitrust, governmental investigations, labor, and environmental issues.

Early in his career, he worked in-house for two global technology companies, Pioneer Corporation and Fujifilm Corporation, bringing unique expertise to advocate using profound understanding of Japanese company cultures.

Jitsuro is devoted to bringing his clients (i) easy communication using excellent communication skills, (ii) pleasant surprises from creative and out-of-the-box ways of thinking, and (iii) deep satisfaction through great results and client-friendly experiences.







損害賠償額の算定方法についての近年の考え方

令和3年7月30日 東京ステーション法律事務所 所長 特許業務法人志賀国際特許事務所 顧問 弁護士・弁理士 三縄 降





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0 はじめに





0 はじめに

損害賠償額の算定方法に関して、令和元年に特許法102条1項及び3項について改正があり、また令和元年及び令和2年に知財高裁が損害論に関して、注目すべき判決を出した。









く 昔の考え方 >

利益@1個 × 被告の販売数量 × 寄与率

利益 : 原告の限界利益





く 少し前の考え方 >

利益@1個 × 数量 × 寄与率

利益: 原告の限界利益

数量: 被告の販売数量×(1-推定覆滅割合)

推定覆滅割合 : 特許権者が販売することができな

いとする事情による割合





< 知財高裁令和2年2月28日大合議判決 >

「原告製品の単位数量当たりの利益の額の算定に当たっては、本件発明2が原告製品の販売による利益に貢献している程度を考慮して、原告製品の限界利益の全額から6割を控除し、・・・。仮に、一審被告の主張が、これらの控除とは別に、本件発明2が被告製品の販売に寄与した割合を考慮して損害額を減額すべきであるとの趣旨であるとしても、これを認める規定はなく、また、これを認める根拠はないから、そのような寄与度の考慮による減額を認めることはできない。」





< 知財高裁令和2年2月28日大合議判決 >

寄与度(寄与率)といった考え方を否定





現在の考え方(1号) >

利益@1個 × 数量

利益 : 原告の限界利益 × (1-推定覆滅割合①)

数量 : 被告の販売数量 ×(1-推定覆滅割合②)

注意)数量は原告の実施能力以下であること

推定覆滅割合①: 特許以外の貢献割合

特許権者が販売することができないとす る事情による割合 推定覆滅割合②:





< 現在の考え方(1号) >

推定覆滅割合①: 特許以外の貢献割合

発明の特徴部分以外で、利益に貢献している割合

EX. 製品の他の特許技術、顧客吸引力のある部分

推定覆滅割合②: 特許権者が販売することができないとする事情による割合

EX. 業務態様や価格等の違い、競合品の存在、侵害者の営業努力、 侵害品の性能





く 現在の考え方(2号) >

1号の金額に

(被告の販売数量 – 1号の数量) × ライセンス料

を加算することを認めている。

(被告の販売数量 – 1号の数量) は、通常、被告の販売数量×推定覆滅割合②となる。

例外:1号の数量が、実施能力によって限定されている場合





< 例 >

被告の販売数量 : 100個

原告の実施能力: 60個

推定覆滅割合① (特許以外の貢献割合) : 30%

推定覆滅割合②(販売できない事情) : 0%

原告の限界利益@1個: 1万円

ライセンス料 : 100円

1号 : 1万円×(1-0.3)×60 = 42万円

2号: 40×100円 = 4000円





< 例 >

被告の販売数量 : 100個 原告の実施能力 : 60個

推定覆滅割合①(特許以外の貢献割合): 30% 推定覆滅割合②(販売できない事情): 60%

原告の限界利益@1個: 1万円

ライセンス料 : 100円

1号 : 1万円×(1-0. 3)×100×(1-0. 6) = 28万円

2号: 60×100円 = 6000円





2 特許法102条2項





2 特許法102条2項

く 昔の考え方 >

利益@1個 × 被告の販売数量 × 寄与率

利益 : 被告の限界利益





< 知財高裁令和元年6月7日判決 >

「同項所定の侵害行為により侵害者が受けた利益の額とは、原則として、侵害者が得た利益全額である。」

同項の推定を否定することに関して、「同条1項ただし書の事情と同様に、侵害者が主張 立証責任を負うものであり、侵害者が得た利益と特許権者が受けた損害との相当因果関係 を阻害する事情がこれに当たると解される。」(事情として、推定覆滅割合②と同様の事 情が例示された。)

特許の特徴が製品の一部の部材部分であることに関して、「推定覆滅の事情として考慮することができるが、特許製品が侵害品の部分のみに実施されていることから、直ちに上記推定の覆滅が認められるのではなく、特許発明が実施されている部分の侵害品中における位置付け、当該特許発明の顧客誘引力等の事情を総合的に考慮してこれを決するのが想到である。」





く 現在の考え方 >

利益 × (1-推定覆滅割合)

利益: 被告の限界利益

推定覆滅割合 : 推定覆滅割合①と推定覆滅割合②

を考慮か?





< 東京地裁令和3年1月29日判決 >

推定覆滅割合: 30%(顧客吸引力が限定的なため)





< 東京地裁令和3年3月10日判決 >

推定覆滅割合 : 50% (特許の貢献と市場の両方を加味

してこの割合を認定)





< 東京地裁令和3年5月18日判決 >

推定覆滅割合 : 0%

65% (原告が公認用具ではなくなっ

た時点以降)





< 東京地裁令和3年5月20日判決 >

推定覆滅割合: 特許の貢献によるもの 80%

市場シェアによるもの 50%

被告の限界利益 × (1-0.8)×(1-0.5)









く 昔の考え方 >

被告の販売数量 × ライセンス料

ライセンス料 : 『実施料率』、又は、『ロイヤリティ 料率データハンドブック』を参照して決 定。





< 知財高裁令和元年6月7日判決 >

「同項に基づく損害の算定に当たっては、必ずしも当該特許権についての実施許諾契約における実施料率に基づかなければならない必然性はなく、特許権侵害をした者に対して事後的に定められるべき、実施に対し受けるべき料率は、むしろ、通常の実施料率に比べて自ずと高額になるであろうことを考慮すべきである。」

これを俗に「侵害プレミアム」という。





< 知財高裁令和元年6月7日判決 >

「実施に対し受けるべき料率は、①当該特許発明の実際の実施許諾契約における実施料率や、それが明らかでない場合には業界における実施料の相場等も考慮に入れつつ、②当該特許発明自体の価値すなわち特許発明の技術内容や重要性、他のものによる代替可能性、③当該特許発明を当該製品に用いた場合の売上げ及び利益への貢献や侵害の態様、④特許権者と侵害者との競業関係や特許権者の営業方針等訴訟に現れた諸事情を総合考慮して、合理的な料率を定めるべきである。」





く 現在の考え方 >

被告の販売数量 × ライセンス料

ライセンス料 : 当事者の実績を重視した侵害プレミアム。





< 東京地裁令和3年1月15日判決 >

ライセンス料として、『実施料率』及び『ロイヤリティ料率 データハンドブック』記載の金額に言及するも、採用せず、被 告が他社と締結していた契約を重視。

認定料率は、0.01%





< 東京地裁令和3年1月20日判決 >

原告が他社と締結していた契約を重視。

認定料率は、1.5%と3%





< 東京地裁令和3年1月29日判決 >

原告が他社と締結していた契約と『ロイヤリティ料率データ ハンドブック』の記載の料率(平均値3.8%,最大値は15. 5%,最小値は0.5%,標準偏差は2.7%))を参考にし て認定。

認定料率は、3%