Giving Teeth To

to Award Attorneys' Fees Against Vexatious Plaintiff Patentees

With patent litigation expenses on the rise, accused infringers seek effective tools to curb abusive lawsuits brought by patent trolls. This article explores using the fee-shifting provision of 35 U.S.C. § 285 as one such tool, particularly in light of recent Supreme Court decisions that have made it easier to obtain fee awards.

35 U.S.C. § 285

By Jennifer H. Wu and Jenny C. Wu

The Patent Clause of the Constitution empowers Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[1] With respect to inventors and their discoveries, Title 35 provides a patentee with a "remedy by civil action for infringement of his patent."[2] The act also authorizes a prevailing party in a patent action to seek attorneys' fees.[3] Specifically, § 285 of the Patent Act provides in its entirety that the "court in exceptional circumstances may award reasonable attorney fees to the prevailing party." The Supreme Court recently rejected the rigid standard that had been introduced by the Federal Circuit to evaluate what constitutes exceptional circumstances that justify an award of fees under § 285. In two 9-0 decisions this year—*Octane Fitness v. Icon Health & Fitness*[4] and *Highmark v. Allcare Health Management System*[5]—the Supreme Court held that district courts have broad discretion to award fees whenever a case is exceptional, i.e., the case stands out from others with respect to the substantive strength of a party's litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated. The Court reiterated that "a district court may award fees in the rare case in which a party's unreasonable conduct—while not necessarily independently sanctionable—is nonetheless so 'exceptional' to justify the award of fees,"[6] but provided a distinct opening for greater findings of exceptionality and awards of attorneys' fees against plaintiff patentees, such as trolls, who bring improper suits.

The Supreme Court's decisions reversed the Federal Circuit's more onerous test and empowers district courts with considerable discretion to award fees to dissuade plaintiffs (and their law firms) from asserting baseless claims to extract settlements from corporate defendants. This article discusses the history of § 285, the *Octane Fitness* and *Highmark* Supreme Court decisions, and recent cases awarding and denying attorneys' fees post-*Octane Fitness* and *Highmark*.

The History of § 285

Prior to 1946, patent lawsuits were subject to the "bedrock principle known as the 'American Rule,'" whereby "[e]ach litigant pays his own attorney's fees, win or lose."[7] In 1946, Congress enacted a new provision stating that a district court "may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case."[8] The legislative history of 35 U.S.C. § 70 indicated that the award of attorneys' fees was not meant to be "an ordinary thing" in patent cases:

> It is not contemplated that the recovery of attorney's fees will become an ordinary thing in patent suits, but the discretion given the court in this respect, in addition to the present discretion to award triple damages, will discourage infringement of a patent by anyone thinking that all he would be required to pay if he loses the suit would be a royalty. The provision also is made general so as to enable the court to prevent a gross injustice to an alleged infringer.[9]

Similarly, the chair of the Senate Committee on Patents explained that the provision was to "award[] to the court discretionary power to allow plaintiffs to recover attorneys' fees, if the court considers it proper to allow such recoveries."[10]

Courts applied the 1946 provision consistent with congressional intent. First, courts consistently described the 1946 provision as vesting district courts with significant discretion to determine whether fees should be awarded in particular cases, and the courts of appeals consistently reviewed fee awards under a deferential abuse-of-discretion standard.[11] For example, the Seventh Circuit expressed: "We think it clear that under the statute the question is one of discretion. The court exercised its discretion and that ends the matter unless we can say as a matter of law that there was a clear abuse of discretion."[12]

Second, courts awarded fees to discourage bad faith and prevent gross injustice. For example, the Ninth Circuit explained that the goal of the provision was to empower district courts to address conduct marked by "unfairness or bad faith in the conduct of the losing party, or some other equitable consideration of similar force, which makes it grossly unjust that the winner of the particular law suit be left to bear the burden of his own counsel fees."[13] Similarly, the Seventh Circuit explained that an award of fees "is not the usual or customary procedure" in patent cases and is "not to be allowed as a matter of course," but rather only where "vexatious or unjustified litigation is shown."[14] In addition, the Third Circuit noted that the 1946 provision was designed to allow district courts to award fees "to prevent a gross injustice."[15]

Between 1946 and 1952, the types of "gross injustices" that courts determined could support a fee award included fraud on the patent office in obtaining the patent alleged to have been infringed;[16] willful infringement by the defendant;[17] "harassing" tactics during the litigation, including delay pursued for tactical gain and vexatious motions generating "needless work" for adversaries;[18] and untenable legal or factual theories on the merits of the case.[19] In awarding fees for the last two grounds, courts made clear that fees were not to be awarded in every case, simply as "a penalty for failure to win a patent infringement suit."[20]

Congress amended the fee-shifting provision in the Patent Act of 1952 as follows:

> The court ~~may in its discretion~~ in exceptional cases may award reasonable attorney fees to the prevailing party ~~upon entry of judgment on any patent case~~.

The legislative history demonstrates that these changes were not intended to change the substantive test for granting fee awards or the district court's discretion in granting such awards. Rather, Congress added the "exceptional cases" language in § 285 "for purposes of clarification only."[21] For example, the Senate Report on the 1952 bill stated that the new provision was "substantially the same as the corresponding provision in [the 1946 act]," and that the "exceptional cases" language was inserted to "express[] the intention of the present [1946] statute as shown by its legislative history and as interpreted by the courts."[22] Similarly, Chief Patent Examiner P.J. Federico testified that the term "exceptional cases" was "picked up from the reports in passing that first law [i.e., the 1946 act], which indicated that was what was meant, and the decisions of the courts that have followed that."[23] Federico further testified that "[w]hat [the phrase 'exceptional cases'] constitutes is left, and stays left, to the discretion of the court that is conducting the case."[24]

As revised and codified at 35 U.S.C. § 285, Congress provided that "[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party." This same version of § 285 remains in effect today.[25] After its creation in 1982 and prior to 2005, the Federal Circuit, like other regional circuits, instructed district courts to consider the totality of circumstances when making fee determinations under § 285. For example, Federal Circuit Judge Rich wrote for a unanimous five-judge panel in *Rohm & Haas Co. v. Crystal Chemical Co.* that § 285 was enacted to "prevent[] injustice to a party involved in a patent suit."[26] Under a totality of circumstances test, the Federal Circuit held that a variety of exceptional circumstances could support a fee award under § 285, including willful infringement, litigation misconduct, inequitable conduct by the patentee in securing the patent, vexatious or unjustified litigation, bad faith, and the assertion of frivolous claims or defenses.[27]

In 2005, however, the Federal Circuit moved away from this holistic approach toward a more rigid formulation. In *Brooks Furniture Manufacturing, Inc. v. Dutailier International, Inc.,*[28] the Federal Circuit held that a case is "exceptional" under § 285 only "when there has been some material inappropriate conduct related to the matter in litigation, such as willful infringement, fraud, or inequitable conduct in procuring the patent, misconduct during the litigation, vexatious or unjustified litigation, conduct that violates Fed R. Civ. P. 11, or like infractions." The Federal Circuit continued by saying fees "may be imposed against the patentee only if both (1) the litigation is brought in subjective bad faith, and (2) the litigation is objectively baseless."[29]

Commentators criticized this heightened standard as curtailing district court discretion to award fees to discourage infringement and to prevent gross injustice. For example, then-Chief Judge Rader of the Federal Circuit wrote last year in a *New York Times* op-ed that "vexatious patent litigation continues to grind through our already crowded courts, costing defendants and taxpayers tens of billions of dollars each year and delaying justice for those who legitimately need a fair hearing of their claims."[30] Rader explained his perspective that the award of attorneys' fees should be used to curtail vexatious "troll" lawsuits:

> Because they don't manufacture products, they need not fear a counterclaim for infringing some other patent. They need not

be concerned with reputation in the marketplace or with their employees being distracted from business, since litigation is their business.

Trolls, moreover, often use lawyers to represent them on a contingent-fee basis (lawyers get paid only when they win), allowing trolls to defer significant legal costs that manufacturers, who generally must pay high hourly fees, cannot.

With huge advantages in cost and risk, trolls can afford to file patent-infringement lawsuits that have just a slim chance of success. When they lose a case, after all, they are typically out little more than their own court-filing fees. Defendants, on the other hand, have much more to lose from a protracted legal fight and so they often end up settling.

Lost in the debate, however, is that judges already have the authority to curtail these practices: they can make trolls pay for abusive litigation.[31]

Rader's comments highlight one of the policy considerations animating the Supreme Court's recent decision.[32] Specifically, the allocation of risk (the upside to winning and downside to losing) is profoundly unequal in patent troll lawsuits. Patent trolls who use contingent fee law firms bear little or no risk in bringing suit; they do not pay out-of-pocket for litigation expenses, and if they lose, they have spent only their own court-filing fees. Because of the minimal downside associated with filing actions on a contingent fee basis, patent trolls may be incentivized to bring weak lawsuits. Defendants to these patent troll lawsuits, however, bear the cost of significant legal fees as well as the risk of patent damages. Giving teeth to § 285, as Rader suggested, is one way to allocate risk more equally to both parties in a patent troll lawsuit.

The Supreme Court Weighs In: *Octane Fitness* and *Highmark*

This year, the Supreme Court issued two 9-0 decisions reversing the Federal Circuit's post-2005 analysis for awarding attorneys' fees in patent cases. In *Octane Fitness,* the Supreme Court reversed the Federal Circuit's post-2005 formulation as unduly rigid and "so demanding that it would appear to render § 285 largely superfluous."[33] Instead, the Supreme Court determined that the statute "imposes one and only one constraint on district courts' discretion to award attorneys' fees in patent litigation: The power is reserved for 'exceptional' cases."[34] The Supreme Court held:

> [A]n "exceptional" case is simply one that stands out from others with respect to the substantive strength of a party's litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated. District courts may determine whether a case is "exceptional" in the case-by-case exercise of their discretion, considering the totality of the circumstances. As in the comparable context of the Copyright Act, "'[t]here is no precise rule or formula for making these determinations,' but instead equitable discretion should be exercised 'in light of the considerations we have identified.'"[35]

The Supreme Court suggested that district courts look to "nonexclusive" factors that it had previously set forth concerning a similar provision of the Copyright Act, including "frivolousness, motivation, objective unreasonableness (both in the factual and legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence."[36] Further, a case may be exceptional even if the party's unreasonable conduct is not "independently sanctionable."[37]

The Supreme Court also reversed the Federal Circuit's requirement that fees be proven by clear and convincing evidence. Rather, the Supreme Court held that the award of fees is a simple discretionary inquiry, and "it imposes no specific evidentiary burden, much less a high one."[38] In so holding, the Supreme Court noted that the more relaxed preponderance of evidence standard is the "standard generally applicable in civil actions" because it "allows both parties to 'share the risk of error in roughly equal fashion.'"[39]

Finally, at the same time that the Supreme Court made it easier for patent defendants to obtain attorneys' fees in *Octane Fitness*, the Supreme Court also made it more difficult for the award of fees to be reversed on appeal in *Highmark*. Specifically, the Supreme Court held that, because the § 285 inquiry is, at its heart, "rooted in factual determinations," an award of attorneys' fees is reviewed under an abuse-of-discretion standard.[40]

What Is Exceptional?

Octane Fitness and *Highmark* empower district courts by giving them considerable discretion to award fees in exceptional cases under § 285. How courts will define the boundaries of exceptionality remains an open question, however. For example, is a plaintiff's motivation in bringing suit and/or its status as a nonpracticing entity relevant to the determination of exceptionality?

Federal Circuit and district court decisions following *Octane Fitness* and *Highmark* provide some guidance to practitioners. First, in *Homeland Housewares, LLC v. Sorensen Research and Development Trust,*[41] the Federal Circuit affirmed the Central District of California's award of more than $250,000 in attorneys' fees to Homeland, the maker of the Magic Bullet blender, under the Supreme Court's relaxed standard. The district court had granted summary judgment of noninfringement in favor of accused infringer, Homeland, because the plaintiff, Sorensen Research and Development Trust, had not produced any admissible evidence that its patent was infringed by the Magic Bullet.[42] In opposition to Homeland's summary judgment motion, Sorensen only attacked Homeland's evidence of noninfringement but never presented any infringement evidence of its own.[43] The district court awarded fees as a result of the lack of admissible evidence and Sorensen's failure to understand its obligation to produce evidence, along with Sorensen's filings of unsolicited briefs after issues were taken under submission and multiple motions for reconsideration that the district court deemed meritless.[44] On appeal, the Federal Circuit agreed in a nonprecedential opinion that Sorensen's failure to produce admissible evidence stood out as "exceptional."[45] The Federal Circuit expressed doubt that Sorensen's repetitive and unsolicited filings, standing alone, could justify a finding of exceptionality.[46] However, citing *Octane Fitness* and *Highmark*, the Federal Circuit also saw no abuse of discretion by the district court in considering that conduct as part of the "totality of the circumstances."[47]

Second, in *Precision Links Inc. v. USA Products Group Inc.*,[48] the Western District of North Carolina relied on *Octane Fitness* to affirm most of its prior award of fees in favor of an accused infringer,

which had been vacated by the Federal Circuit pre-*Octane Fitness*. The district court had previously determined that the plaintiff's claim construction argument as to one of its three asserted independent patent claims was objectively baseless and that its infringement allegations as to that patent claim was thus sufficiently frivolous that it must have been brought in bad faith.[49] The Federal Circuit disagreed under *Brooks Furniture,* holding that the district court had clearly erred in finding that the plaintiff's proposed claim construction was frivolous.[50] Although the Federal Circuit did agree with the district court that the plaintiff's assertions relating to the two other asserted independent patent claims were frivolous, the Federal Circuit remanded the action and noted that the district court "should determine whether it continues to regard this case as exceptional and deserving of an attorney fee award."[51] On remand, the district court determined that attorneys' fees were indeed appropriate under the Supreme Court standard and awarded $165,000, which was two-thirds of the original fee award.[52]

Third, in *Kilopass Technology Inc. v. Sidense Corp.*,[53] the Northern District of California awarded fees under the Supreme Court standard after reconsidering its pre-*Octane Fitness* decision to deny attorneys' fees. The district court had originally declined to find exceptionality on the sole basis that the defendant had failed to establish that the plaintiff brought its infringement claims in bad faith.[54] On appeal, the Federal Circuit explained that the district court had applied too narrow of an analysis and remanded the action for additional consideration of whether the plaintiff's infringement claims were objectively baseless.[55] Although *Octane Fitness* had not yet issued, the Federal Circuit explained that the district court needed to assess the objective merits of the plaintiff's infringement claims, as that would inform a finding of whether the plaintiff had also acted with subjective bad faith.[56]

After the case was remanded and the Supreme Court issued *Octane Fitness,* the district court awarded fees in favor of the accused infringer after determining the case to be exceptional under the totality of circumstances. In particular, the district court relied on plaintiff's failure to conduct an adequate prefiling investigation, noted that plaintiff's infringement theories were "objectively baseless," and pointed out that plaintiff's "claims for literal infringement were exceptionally meritless."[57] The district court also noted that the plaintiff had shifted its theories of infringement late in litigation without following the proper procedures for amendment of contentions and had engaged in conduct that at times amounted to gamesmanship.[58] Accordingly, the district court concluded that this is a case that "stands out from others with respect to the substantive strength of plaintiff's litigating position and the unreasonable manner in which the case was litigated."[59] The district court, however, noted that its award of fees was not based on the fact that the patentee does not practice the invention, as the court was unaware of any authority showing that this was relevant to the determination of an exceptional case.[60]

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Fourth, in *Summit Data Systems, LLC v. EMC Corp.*,[61] the District of Delaware awarded $1.4 million under § 285 based on plaintiff's assertion of "unfounded," "frivolous," and "objectively unreasonable" infringement claims. The plaintiff in that case is a nonpracticing entity. Its sole infringement theory was that defendant NetApp's products interacted with Microsoft software to practice the asserted claims. But two months before bringing suit, NetApp had executed a license agreement with RPX, a computer industry "patent aggregator" that obtains patent licenses for the benefit of its member companies. RPX provided Microsoft, one of its members, with a license to the asserted patents, meaning that there could be no induced infringement claim against NetApp in this system. The district court faulted the plaintiff for being "careless in reading their own multi-million dollar License Agreement before embarking on a lawsuit spanning several years and costing the parties and the court countless resources."[62] The district court also pointed out that the "plaintiff's practice of extracting settlements worth a fraction of what the case would cost to litigate supports a finding of exceptionality," noting that none of the plaintiff's other settlements was "for more than $175,000" and plaintiff's "motivation was to extract quick settlements that were dwarfed by the costs to litigate."[63] The district court concluded that, in the "totality of the circumstances," the case was exceptional and "an award of attorneys' fees in this case [was] necessary to deter this sort of reckless and wasteful litigation in the future."[64]

Nevertheless, the award of attorneys' fees post-*Octane Fitness* and *Highmark* is not automatic, and courts have considerable discretion to deny the award of fees, even under the more relaxed standard. For example, in *Bianco v. Globus Medical Inc.*,[65] Judge Bryson of the Federal Circuit, sitting by designation in the Eastern District of Texas, determined that attorneys' fees for the prevailing accused infringer were not appropriate even under the *Octane Fitness* standard. In that case, prior to *Octane Fitness,* Globus had moved for an award of attorney fees relating to an inventorship claim on Globus's patents filed by the plaintiff, Dr. Bianco.[66] The district court denied the motion under the *Brooks Furniture* standard, explaining that Globus had failed to satisfy either part of the then-governing test.[67] After *Octane Fitness,* Globus moved for reconsideration. The district court denied the motion, concluding that the record still did not support a finding of exceptionality because Globus had neither established that Bianco's inventorship claim was objectively baseless nor established that his claim was brought in subjective bad faith.[68] Further, the district court independently determined that, under the totality of the circumstances, Bianco's inventorship claim was not exceptional in that the substantive strength of his claims did not "stand[] out from others."[69]

In addition, district courts have distinguished situations in which plaintiffs have engaged in aggressive litigation conduct as opposed to

exceptional litigation misconduct. For example, in *Meyer Intellectual Properties Ltd .v. Bodum USA Inc*.,[70] the prevailing accused infringer argued that the plaintiff's case was exceptional because, among others, the inventor of the asserted patents had withheld prior art with intent to deceive the patent examiner and the plaintiff had repeatedly sought to prevent the accused infringer from introducing the withheld prior art. The Northern District of Illinois disagreed. The district court explained that the record did not sufficiently support a finding of inequitable conduct by the inventor.[71] Furthermore, "[a]s far as litigation strategy is concerned, if efforts to limit inequitable conduct as an issue in a patent case as well as efforts to limit the introduction of evidence based on the Rules of Civil Procedure, makes a case an 'exceptional' one, then almost every patent case would be exceptional."[72] The district court noted that "patent lawyers love to litigate aggressively and this was no exception on both sides."[73]

Similarly, the Northern District of California in *CreAgri Inc. v. Pinnaclife Inc.* declined to find the case exceptional in favor of the accused infringer where "the record paints a picture in which both sides were being too aggressive with their discovery positions" instead of just one party acting "willfully obstructive in bad faith."[74] Likewise, the Southern District of New York held in *Rates Technology Inc. v. Broadvox Holding Co.*[75] that fees were not appropriate where the lawsuit was not without merit and the patentee's claim construction positions were not baseless.[76] The district court also rejected the notion that the patentee's status as a "hyper-litigious non-practicing entity" should prevent it from bringing suit on nonfrivolous claims. The district court thus concluded that the accused infringer "did not suffer any unwarranted attorneys' fees or costs as a result of [the patentee's] conduct."[77]

It remains to be seen whether application of the *Octane Fitness* and *Highmark* standard will deter vexatious litigation or other litigation misconduct, or even reduce the number of abusive lawsuits brought by trolls. In the meantime, we can expect more parties to seek attorneys' fees as litigants test the boundaries of § 285 under the Supreme Court's standard. ⊙


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Endnotes

[1]U.S. Const. Art. I, § 8, Cl. 8.

[2]35 U.S.C. § 281.

[3]35 U.S.C. § 285.

[4]134 S. Ct. 1749 (2014).

[5]134 S. Ct. 1744 (2014).

[6]*Octane Fitness*, 124 S. Ct. at 1756–57.

[7]*Marx v. General Revenue Corp.*, 133 S. Ct. 1166, 1175 (2013) (citation omitted; brackets in original).

[8]Act of Aug. 1, 1946, ch. 726, 60 Stat. 778 (codified at 35 U.S.C. § 70 (1946)).

[9]*See* Brief of the United States as Amicus Curiae Supporting Petitioner Octane Fitness in the Supreme Court (hereinafter "United States Amicus Brief"), 2013 WL 6512964, at *2-3 (Dec. 9, 2013) (citing S. Rep. No. 1503, 79th Cong., 2d Sess. 2 (1946)).

[10]92 Cong. Rec. 9188 (1946) (statement of Sen. Pepper, chair of the Senate Comm. on Patents); *see* United States Amicus Brief, *supra* note 9, at *10.

[11]*See* United States Amicus Brief, *supra* note 9, at *13-14 (citing cases).

[12]*Blanc v. Spartan Tool Co.,* 168 F.2d 296, 300, *cert. denied*, 335 U.S. 853 (1948).

[13]*Park-In-Theatres Inc. v. Perkins,* 190 F.2d 137, 142 (9th Cir. 1951); *see* United States Amicus Brief, *supra* note 9, at *10.

[14]*Laufenberg Inc. v. Goldblatt Bros.,* 187 F.2d 823, 825 (7th Cir. 1951); *see* United States Amicus Brief, *supra* note 9, at *10-11.

[15]*Pennsylvania Crusher Co. v. Bethlehem Steel Co.,* 193 F.2d 445, 450-451 (3d Cir. 1951); *see* United States Amicus Brief, *supra* note 9, at *11.

[16]United States Amicus Brief, *supra* note 9, at *11 (citing *Pennsylvania Crusher*; *Dubil v. Rayford Camp & Co.,* 184 F.2d 899, 903 (9th Cir. 1950)).

[17]United States Amicus Brief, *supra* note 9, at *12 (citing *Krieger v. Colby,* 106 F. Supp. 124, 131-32 (S.D. Cal. 1952); *Packwood v. Briggs & Stratton Corp.,* 99 F. Supp. 803, 808 (D. Del. 1951), *rev'd on other grounds*, 195 F.2d 971 (3d Cir.), *cert. denied*, 344 U.S. 844 (1952); *Brennan v. Hawley Prods. Co.,* 98 F. Supp. 369, 370 (N.D. Ill. 1951)).

[18]*Id.* (citing *Dubil v. Rayford Camp & Co.,* 184 F.2d 899, 902-03 (9th Cir. 1950) (dilatory tactics); *Vischer Prods. Co. v. National Pressure Cooker Co*., 92 F. Supp. 138, 139 (W.D. Wis. 1950) ("undue harassment" and unreasonable delay); *National Brass Co. v. Michigan Hardware Co.,* 75 F. Supp. 140, 142 (W.D. Mich. 1948) ("harassing or vexatious tactics" such as unreasonable delays); *Orrison v. C. Hoffberger Co.,* 190 F.2d 787, 791 (4th Cir. 1951) (baseless motion for new trial); *Aeration Processes Inc. v. Walter Kidde & Co.,* 177 F.2d 772, 773 (2d Cir. 1949) (abandoned claim requiring "needless work" by prevailing party)).

[19]*Id.* (citing *Algren Watch Findings Co. v. Kolinsky,* 197 F.2d 69, 72 (2d Cir. 1952) (upholding award based on deficiency of proof at trial); *Orrison*, 190 F.2d at 791 (upholding award when there was "no reasonable ground" for plaintiff to prosecute motion for new trial); *Blanc v. Spartan Tool Co.,* 178 F.2d 104, 105 (7th Cir. 1949) (upholding award based on district court's analysis of "the character of the . . . patents here involved," the construction of the defendant's allegedly infringing devices, and prior decisions of other courts)).

[20]*Park-In-Theatres,* 190 F.2d at 142.

[21]*General Motors Corp. v. Devex Corp.,* 461 U.S. 648, 653 n.8 (1983); *see* United States Amicus Brief, *supra* note 9, at *14.

[22]United States Amicus Brief, *supra* note 9, at *14 (quoting S. Rep. No. 1979, 82d Cong., 2d Sess. 30 (1952)).

[23]*Id.* at *14-15 (quoting Patent Law Codification and Revision: Hearings Before Subcomm. No. 3 of the House Comm. on the Judiciary, 82d Cong., 1st Sess. 109 (1951)).

[24]*Id. Accord, e.g., P.J. Federico, Commentary on the New Patent*

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Endnotes

[1]*Clontech Laboratories, Inc. v. Invitrogen Corp.,* 406 F.3d 1347 (Fed. Cir. 2005).

[2]35 U.S.C. § 292(a) (1994).

[3]*London v. Everett H. Dunbar Corp.,* 179 F. 506, 508 (1st Cir. 1910).

[4]*See e.g.*, *Icon Health & Fitness Inc. v. Nautilus Group Inc.,* 2006 U.S. Dist. LEXIS 24153 (D. Utah 2006); *Krieger v. Colby,* 106 F. Supp. 124 (S.D. Cal. 1952).

[5]*See* Nicholas W. Stephens, *From Forest Group to the America Invents Act: False Patent Marking Comes Full Circle,* 97 Iowa L. Rev. 1003, 1007 (2012).

6590 F.3d 1295 (Fed. Cir. 2009).

[7]*See* Justin E. Gray, *2010 False Marking Year in Review, Looking Forward,* Gray on Claims (Jan. 28, 2011), www.grayonclaims.com/home/2011/1/28/2010-false-marking-year-in-review-looking-forward.html (last visited Aug. 14, 2014).

[8]608 F.3d 1356 (Fed. Cir. 2010).

[9]Gray, *supra* note 7; *False Marking Case Information*, www.grayonclaims.com/false-marking-case-information/ (last updated Dec. 20, 2011).

[10]702 F.3d 1351 (Fed. Cir. 2012).

[11]702 F.3d 624 (Fed. Cir. 2012).

[12]559 Fed. Appx. 1042 (Fed. Cir. 2012).

[13]2014 U.S. App, LEXIS 13014 (Fed. Cir. 2014).

[14]511 U.S. 244 (1993).

[15]Leahy-Smith America Invents Act, 112 P.L. 29, § 16(b)(4), 125 Stat. 284 (2011).

[16]172 U.S. 102, 123-24 (1917).

[17]*Stauffer, supra* note 13, at 3.

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Act, 75 J. Pat. & Trademark Off. Soc'y 161, 216 (1993); 98 Cong. Rec. 9097 (1952) (statement of Sen. Wiley) (noting that 1952 bill "simply constitutes a restatement of the patent laws of the United States); 98 Cong. Rec. at 9323 (statement of Sen. McCarran) (indicating that bill would "codif[y] the present patent laws"); 7 Donald S. Chisum, Chisum on Patents § 20.03[4][c] [i], at 20-464 (1999) (noting that "no change in meaning was intended" by the 1952 amendments).

[25]In 1974, Congress added an identical attorneys' fee provision to the Lanham Act, which governs trademarks and false advertising. *See* 15 U.S.C. § 1117(a).

[26]736 F.2d 688, 691-92 & n.5 (Fed. Cir. 1984); *see also, e.g., Yamanouchi Pharm. Co. v. Danbury Pharmaca Inc.,* 231 F.3d 1339, 1347 (Fed. Cir. 2000) ("In assessing whether a case qualifies as exceptional, the district court must look at the totality of the circumstances.").

[27]United States Amicus Brief, *supra* note 9, at *17-18 (citing *Epcon Gas Sys. Inc. v. Bauer Compressors Inc.,* 279 F.3d 1022, 1034 (Fed. Cir. 2002); *Hoffmann-La Roche Inc. v. Invamed Inc.,* 213 F.3d 1359, 1365 (Fed. Cir. 2000); *Eltech Sys. v. PPG Indus. Inc.,* 903 F.2d 805, 807 (Fed. Cir. 1990); *Mathis v. Spears,* 857 F.2d 749, 754, 755 (Fed. Cir. 1988)).

[28]393 F.3d 1378 (2005).

[29]*Id.* at 13.

[28]Randall R. Rader, Colleen V. Chien & David Hricik, *Make Patent Trolls Pay in Court,* N.Y. Times, June 4, 2013, www.nytimes.com/2013/06/05/opinion/make-patent-trolls-pay-in-court.html.

[29]*Id.*

[30]*See Octane Fitness,* 134 S. Ct. at 1758.

[31]*Id.*

[32]*Id.* at 1755-56.

[33]*Id.* at 1756.

[34]*Id.* at 1756, n.6 (quoting *Fogerty v. Fantasy,* 510 U.S. 517, 524, n.19 (1994)).

[35]*Id.* at 1756-57 (citations omitted).

[36]*Id.* at 1758.

[37]*Id.*

[38]*Highmark,* 134 S. Ct. at 1748-49.

[39]No. 2013-1537, 2014 WL 4400184 (Fed. Cir. Sept. 8, 2014).

[40]*Id.* at *1.

[41]*Id.* at *3.

[42]*Id.* at *1.

[43]*Id.* at *3.

[44]*Id.*

[45]*Id.*

[46]No. 08-cv-00576, 2014 WL 2861759 (W.D.N.C. June 24, 2014).

[47]*Precision Links Inc. v. USA Prods. Group Inc.,* 527 Fed. App'x 852, 853-57 (Fed. Cir. 2013).

[48]*Id.* at 856.

[49]*Id.* at 858.

[50]2014 WL 2861759 at *4.

[51]No. 10-cv-020566, 2014 WL 3956703 (N.D. Cal. Aug. 12, 2014).

[52]*Id.* at *8.

[53]*Id.*; *see also Kilopass Tech. Inc. v. Sidense Corp.,* 738 F.3d 1302 (Fed. Cir. 2013).

[54]*Id.* at 1314, 1317.

[55]2014 WL 3956703 at *14.

[56]*Id.*

[57]*Id*

[58]*Id.* at *14 n.15.

[59]No. 10-cv-759, 2014 WL 2508386 (D. Del. Sept. 25, 2014).

[60]*Id.* at *4.

[61]*Id.*

[62]*Id.* at *5.

[63]No. 12-cv-0147, 2014 WL 1904228 (E.D. Tex. May 12, 2014).

[64]*Id.* at *2.

[65]*Id.*

[66]*Id.*

[67]*Id.*

[68]No. 06-cv-6329, 2014 WL 3724797 (N.D. Ill. July 28, 2014).

[69]*Id.* at *2.

[70]*Id.*

[71]*Id.*

[72]No. 11-cv-6635, 2014 WL 2508386 at *13 (N.D. Cal. June 3, 2014).

[73]No. 13-cv-0152, slip op. at 33-37 (S.D.N.Y. Oct. 7, 2014).

[74]*Id.* at 34-35.

[75]*Id.* at 37.