

Appeal Nos. 2009-1372, -1380, -1416, -1417

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**United States Court of Appeals**  
*for the*  
**Federal Circuit**

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AKAMAI TECHNOLOGIES, INC.,

*Plaintiff-Appellant,*

*and*

THE MASSACHUSETTS INSTITUTE OF TECHNOLOGY,

*Plaintiff-Appellant*

*v.*

LIMELIGHT NETWORKS, INC.,

*Defendant-Cross-Appellant.*

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On Petition for Rehearing *En Banc* of the  
Panel Decision of Circuit Judges Prost, Linn, and Moore

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**BRIEF OF *AMICUS CURIAE* AMERICAN INTELLECTUAL  
PROPERTY LAW ASSOCIATION (“AIPLA”) IN SUPPORT  
OF PETITION FOR REHEARING *EN BANC***

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## CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rules 28(a)(1) and 47.4(a), counsel for *amicus curiae* American Intellectual Property Law Association state the following:

1. The full names of every party or *amicus* represented by us is:

American Intellectual Property Law Association

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by us is:

Not applicable.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or *amicus curiae* represented by us is:

None.

4. The names of all law firms and the partners or associates that appeared for any of the parties or *amicus* now represented by us in the trial court or agency or in a prior proceeding in this case or are expected to appear in this Court are:

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**STATEMENT OF INTEREST OF *AMICUS CURIAE*<sup>1</sup>**

The American Intellectual Property Law Association (“AIPLA”) is a national bar association of approximately 15,000 members engaged in private or corporate intellectual property practice, government service, and the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, copyright, trade secret, trademark and unfair competition law as well as other fields of law affecting intellectual property. AIPLA’s members represent both owners and users of intellectual property.

While AIPLA supports rehearing *en banc*, it has no stake in any of the parties to this litigation or in the result of this case. AIPLA’s only interest is in seeking correct and consistent interpretation of the law as it relates to intellectual property issues. AIPLA’s mission includes providing courts with objective analysis to promote an intellectual property system that stimulates and rewards invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

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<sup>1</sup> Pursuant to Fed. R. App. Proc. 29(c)(5), AIPLA states that this brief was not authored in whole or in part by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than AIPLA and its counsel. Specifically, after reasonable investigation, AIPLA believes that (i) no member of its Board who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter; (ii) no representative of any party to this litigation participated in the authorship of this brief; and (iii) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

## ARGUMENT FOR REHEARING *EN BANC*

There can be little doubt of the exceptional importance of this case to the intellectual property community, and to innovators as a whole. The issue of joint infringement has been the focus of much discussion in recent years by academia, the media, and industry.<sup>2</sup> In its 2014 remand of this case, the Supreme Court suggested this Court would have the opportunity to “revisit the § 271(a) question if it so chooses,” 134 S. Ct. 2111, 2120 (“*Akamai III*”); AIPLA submits that the Federal Circuit should choose to do so by rehearing the case *en banc*.

On remand from the Supreme Court, a divided Federal Circuit panel (the “Panel”) continued to support the “single entity rule” for direct infringement under 35 U.S.C. § 271(a) and, therefore, for indirect infringement. - F.3d -, slip op. at 6-7 (May 13, 2005) (“*Akamai IV*”). This decision is at odds with the plain language of

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<sup>2</sup> See, e.g., S. Moore, Joint-Infringement Potholes - Is My Eligible Claim Enforceable? Why Joint Enforcement Matters From the View of a Litigator, AIPLA Spring Meeting Track Session (5/2/2013) [http://www.aipla.org/learningcenter/library/papers/SM/SM13/SM13Materials/Moore\\_paper.pdf](http://www.aipla.org/learningcenter/library/papers/SM/SM13/SM13Materials/Moore_paper.pdf); N. Galli, et al., Cloud Computing and the Doctrine of Joint Infringement: “Current Impact” and Future Possibilities, 11 J. Marshall Rev. Intell. Prop. L. (2012); D. Gupta, Virtually Uninfringeable: Valid Patents Lacking Protection Under the Single Entity Rule, 94 J. Pat. & Trademark Off. Soc’y 61 (2012); A. Philippidis, Federal Circuit Takes Up En Banc Joint Infringement of Method Patents: Oral arguments beginning today on two separate cases, which don’t involved biotech firms but will affect the industry, Genetic Eng’g & Biotech. News (11/18/2011) <http://www.genengnews.com/insight-and-intelligence-and-153/federal-circuit-takes-up-en-banc-joint-infringement-of-method-patents/77899497>; D. Crouch, Joint Infringement: When Multiple Actors Work in Concert, Patently-O (4/14/2011), <http://patentlyo.com/patent/2011/04/joint-infringement-when-multiple-actors-work-in-concert.html>; W. Robinson, Ramifications of Joint Infringement Theory on Emerging Technology Patents, 18 Tex. Intell. Prop. L.J. 335 (2010).



the Patent Act; continues conflicts and tensions with longstanding common law concepts of joint tortfeasor liability; and creates a “gaping loophole in infringement liability.” *See id.* at 7 (Moore, J., dissenting). As the Supreme Court recently noted, “[a] patent holder, and the holder’s lawful licensees, can recover for monetary injury when their exclusive rights are violated by others’ wrongful conduct,” including “when the actor induces others to infringe the patent.” *Commil USA, LLC v. Cisco Sys., Inc.*, 575 U.S. --, --, slip op. at 1 (May 26, 2015). The single entity rule, however, removes that ability by unnecessarily limiting direct infringement, a prerequisite for finding inducement, despite the fact that the claimed method actually was performed. Because of the importance of the issue of joint infringement, AIPLA supports the Petition and submits that this case should be reheard *en banc*.

### **I. The Importance Of The Issue Merits *En Banc* Reconsideration**

Multi-actor patent infringement is not a new phenomenon. *See, e.g., Akamai IV*, slip op. at 10-11; *id.* at 17-20 (Moore, J., dissenting); *see also E.I. du Pont de Nemours & Co. v. Monsanto Co.*, 903 F. Supp. 680, 735 (D. Del. 1995), *aff’d*, 1996 U.S. App. LEXIS 17512 (Fed. Cir. 1996). Many patents, including (but not limited to) those involving software, Web-related technology, or telecommunications, contain method claims having a series of steps that either can be or must be performed by multiple actors. Often it is not possible for parties to draft a claim that could eliminate all possibilities that multiple actors would be involved, *see* Brief of Amicus Curiae AIPLA in *Akamai III* (“AIPLA Sup. Ct. Br.”) at 9-10, but this does not mean that the innovations embodied in these patents are somehow less deserving of the legal protections offered by the Patent Act. Nonetheless, the

single entity rule as set out by the Panel majority would make it nearly impossible for these patent holders to enforce their patents against joint infringers and “permit[s] ready evasion of valid method claims with no apparent countervailing benefits” and the development of business models designed to misappropriate the patented methods of others. *See Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1318 (Fed. Cir. 2012) (*en banc*) (“*Akamai I*”), *vacated by Akamai III and withdrawn by* 571 Fed. Appx. 958 (Fed. Cir. 7/24/2014).

## II. The Single Entity Rule Is Not Supported By Statute Or Case Law

### A. Section 271(a) Is Not Confined to a Single Entity

Just as the rights conferred by the grant of a patent are created by statute, *see Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964), so too are the tests to determine infringement of those rights, *see* Giles S. Rich, *Infringement Under Section 271 of the Patent Act of 1952*, 35 J. Pat. Off. Soc’y 476 (1953). Thus, “[a]s with any question of statutory interpretation, [an] analysis begins with the plain language of the statute.” *Jimenez v. Quarterman*, 555 U.S. 113, 118 (2009).

The direct infringement statute states “*whoever* ... uses ... any patented invention ... infringes the patent.” 35 U.S.C. § 271(a) (emphasis added). As a matter of statutory construction, the word “whoever” as used in Section 271(a) – and indeed the entire U.S. Code – encompasses both the single and the plural. 1 U.S.C. § 1, ¶ 2 (“words importing the plural include the singular”); *see* AIPLA Sup. Ct. Br. at 11 (*citing id.* and *The American Heritage® Dictionary of the English Language* (4th ed. 2000)); *see also Akamai IV*, slip op. at 9-10 (Moore, J., dissenting); *Akamai II*, 692 F.3d at 1322 (Newman, J., dissenting). The word “whoever” does

not support a single entity rule – it can be met by multiple actors – and nothing in the statute or the legislative history of Section 271 supports such a rule. *See* AIPLA Sup. Ct. Br. at 15-16.

The term “whoever” is also used elsewhere in the Patent Act to include the plural. *See Akamai IV*, slip op. at 10 (Moore, J., dissenting); AIPLA Sup. Ct. Br. at 11-12. Since it is a well-known principle of statutory construction that the same term presumptively has the same meaning when used in separate sections of a statute, *Gustafson v. Alloyd Co.*, 513 U.S. 561, 568 (1995), Section 271(a) must be interpreted so that a patent is directly infringed by any person (single entity) who uses a patented invention, *or* by any group of “persons” (multiple entities) who together use a patented invention.

Infringement occurs when all claim steps are performed. *See, Akamai III*, 134 S. Ct. at 2117 (“A method patent claims a number of steps; under this Court’s case law, the patent is not infringed unless all the steps are carried out.”). But there is nothing in the statute suggesting that a claimed process is infringed only when a *single* person “uses” the patented invention rather than when it is performed by the combined actions of two or more persons. *Cf. Akamai II*, 692 F.3d at 1323 (Newman, J., dissenting) (“Infringement is not a question of how many people it takes to perform a patented method.”). The Panel majority’s holding that such a requirement exists is therefore contrary to the statute; in imposing that requirement, the decision conflates the *existence* of infringement with the *liability* therefor.<sup>3</sup> In-

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<sup>3</sup> The principles of joint tortfeasors also recognize this distinction between the existence of a tort and liability therefor. *See, e.g., Akamai IV*, slip op. at 21-22

fringement and liability are distinct, as the Supreme Court recently reiterated in holding that a party can infringe an invalid patent but still avoid liability. *Commil*, slip op. at 11 (“...invalidity is not a defense to infringement, it is a defense to liability.”); *see* 35 U.S.C. § 282(b) (“Defenses. - The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded: (1) Noninfringement, absence of liability for infringement or unenforceability.”).

**B. Rehearing *En Banc* Is Needed To Resolve Tensions With Other Decisions Of This Court**

The Panel majority’s opinion relies on *BMC Resources, Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007), and *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1329 (Fed. Cir. 2008). *See Akamai IV* at slip. op. 5-6. Those decisions, however, are not the first or only Federal Circuit decisions on joint infringement. The Panel majority failed to fully account for other prior panel opinions that addressed the single entity rule.

For example, in *On Demand Mach Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331 (Fed. Cir. 2006), which predates both *BMC* and *Muniauction*, a Federal Circuit panel reviewed a jury’s infringement verdict based upon the following instruction that method claims could be infringed by the combined actions of defendants and their customers, 442 F.3d at 1344-45 (emphasis added):

***It is not necessary for the acts that constitute infringement to be performed by one person or entity.*** When infringement results from the participation and combined action(s) of more than one person or entity, they are all joint infringers and jointly liable for patent in-

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(Moore, J., dissenting); AIPLA Sup. Ct. Br. at 26-27; *see also, e.g., Akamai II*, 692 F.3d at 1312-1314.

fringement. ***Infringement of a patented process or method cannot be avoided by having another perform one step of the process or method.*** Where the infringement is the result of the participation and combined action(s) of one or more persons or entities, they are joint infringers and are jointly liable for the infringement.

On appeal, those defendants challenged the instruction as misstating the “***legal requirements for ‘joint infringement,’***” which were crucial to the jury’s verdict.” Br. of Appellants, *On Demand Mach. Corp. v. Ingram Indus., Inc.*, 2005 U.S. Fed. Cir. Briefs 1074 (Lexis) (the “*On Demand* App. Brief”) at \*8 (emphasis added). The Federal Circuit panel approved the jury instruction, holding that it “discern[ed] no flaw in this instruction as a statement of law.” *On Demand*, 442 F.3d at 1344-45; *see id.* at 1337. That is the very same issue presented here. Yet *BMC* and *Muniauction* dismissed the *On Demand* discussion of joint infringement as *dicta*, in part because the case was reversed on other (claim construction) grounds. *See BMC*, 498 F.3d at 1380. Tensions between *On Demand*, *BMC* and *Muniauction* exemplify why the single-entity rule should be reconsidered *en banc*.

Nor is *On Demand* the only prior Federal Circuit panel decision that is in tension with *BMC* and *Muniauction*. For instance, *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1568 (Fed. Cir. 1983), stated in *dicta*<sup>4</sup> that a supplier cannot be directly liable for making and selling plates with “diazco coating” when the final step of the process – applying the coating – is performed by customers, but may nonetheless be liable for contributory infringement for supplying the cus-

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<sup>4</sup> The *Fromson* panel held that the trial court’s judgment of infringement was based on an erroneous claim construction, making the joint infringement discussion *dicta*. Moreover, the discussion lacked any analysis of the joint tortfeasor issue or any citation to authority. *See Akamai II*, 692 F.3d at 1342 (Linn, J., dissenting).

tomers with the plates to be coated. With these statements on liability for contributory infringement, the *Fromson* panel implies that direct infringement could *exist* even if no single party was *liable*, and that contributory infringement can exist without an identifiable direct infringer. See *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 526-27 (1972) (contributory infringement is predicated on the existence of direct infringement); *Commil*, slip op. at 7-8 (contributory infringement should be treated similarly to inducement); see also *Akamai II*, 692 F.3d at 1327 (Newman, J., dissenting).

Additionally, in *Golden Hour Data Sys., Inc. v. emsCharts, Inc.*, 614 F.3d 1367, 1371, 1380-81 (Fed. Cir. 2010), a panel of this Court declined to find direct infringement where two defendants “formed a strategic partnership, enabled their two programs to work together, and collaborated to sell the two programs as a unit” that practiced all of the claimed method steps. But this finding of no liability is the *exact circumstances* described by the *Akamai* Panel majority as establishing liability under the single entity rule. *Akamai IV*, slip op. at 8. It also was the basis for the decision in *Akamai II*, 692 F.3d at 1307, 1312, and led to dissents by both Judges Linn (*id.* at 1349) and Newman (*id.* at 1324-25, also discussing other conflicting cases) arguing for *en banc* review.

As these examples show, the Panel majority’s creation of a single entity rule “is admittedly at odds with binding precedent,” *Akamai IV*, slip op. 31 (Moore, J., dissenting). Accordingly, this Court should reconsider this case *en banc* to resolve tensions in prior decisions concerning joint infringement.

### III. Section 271(a) Actions Against Multiple Parties Will Not Render The Remaining Provisions of Section 271 Superfluous

One reason given by the Panel majority for the single entity rule was concern that otherwise Sections 271(b) and (c) were redundant. *See Akamai IV*, slip op. at 11-15. AIPLA respectfully disagrees since, at a minimum, the proper consideration is not the statutory scheme for indirect infringement in a vacuum, but rather the statutory scheme for infringement as a whole. Each separate paragraph of the statute need not be an *entirely discrete* category of prohibited activity, and there may be overlap in those paragraphs as applied to a specific accused conduct to ensure patent protection. Any overlap to prevent lacunae in patent rights is recognized as being a proper Congressional exercise. *See Conn. Nat'l Bank v. Germain*, 503 U.S. 249, 253 (1992) (overlapping statutory sections not superfluous where each “confers jurisdiction over cases that the other section does not reach”); *see also James v. Santella*, 328 F.3d 1374, 1381-82 (Fed. Cir. 2003) (interpretation not superfluous where “prevailing party” not always “substantially innocent”).

Alternative approaches to the issue of joint infringement, such as the ones advocated by the Panel dissent or others (*see, e.g., AIPLA Sup. Ct. Br.* at 14), show that the indirect infringement provisions of Section 271(b) and Section 271(c) would continue to apply in circumstances where Section 271(a) does not, as other precedent from this Court shows.<sup>5</sup> Therefore, even if Section 271(a) would

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<sup>5</sup> *See, e.g., Arthrocare Corp. v. Smith & Nephew, Inc.*, 406 F.3d 1365, 1376-77 (Fed. Cir. 2005) (induced infringement where the accused infringer actively induced each and every element of the claim); *Preemption Devices, Inc. v. Minn. Mining & Mfg. Co.*, 803 F.2d 1170, 1174 (Fed. Cir. 1986) (accused contributorily infringed where it provided a non-staple, material component of claimed process).

not apply in the situation where an entity performs *no* steps of a patented method, that same entity could still be liable for indirect infringement under Section 271(b) or Section 271(c).

#### IV. CONCLUSION

As set out above, this is a case of exceptional importance. Moreover, the Panel decision's treatment of 1 U.S.C. § 1, ¶ 2 and common law joint tortfeasor principles, as well as conflicts with other Federal Circuit panel decisions requires *en banc* review. Accordingly, AIPLA respectfully submits that this Court should reconsider the matter *en banc*.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that, on this 23 of June 2015, I filed the foregoing foregoing **Brief of *Amicus Curiae* American Intellectual Property Law Association (“AIPLA”) in Support of Petition for Rehearing *En Banc*** with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system, which will send notice of such filing to all registered CM/ECF users.

Dated: Washington, DC  
June 23, 2015

/s/ Joseph R. DeSantis  
Joseph R. DeSantis

**CERTIFICATE OF COMPLIANCE**

Counsel for *amicus curiae* American Intellectual Property Law Association certifies that:

1. The brief complies with the type-volume limitations of Federal Circuit Rule 40(g) because it does not exceed 10 double-spaced pages.
2. The brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type-style requirements of Federal Rule of Appellate Procedure 32(a)(6) because it has been prepared using Microsoft Word 2010 in a proportionally spaced typeface: Times New Roman, font size 14 point.

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