

## NOTE

### **AKAMAI: PATENT CLAIMS ARE NOW BROADER THAN THE INVENTION**

BRENDYN M. REINECKE\*

A patent system stifles innovation if it grants an inventor too much power to exclude others from using his or her invention. Much like statutes, patent claims have several elements that identify the patented invention. In *BMC Resources, Inc. v. Paymentech, L.P.*, the Federal Circuit Court of Appeals explicitly stated what was an arguably long-standing rule holding that to directly infringe a patent, a *single entity* must satisfy all elements of a claimed invention in the patent. The court reasoned further that when a party is accused of actively inducing another to infringe a patented invention, the induced infringer alone must satisfy all elements of the claimed invention. In *Akamai Technologies, Inc. v. Limelight Networks, Inc.* the Federal Circuit sitting en banc overturned *BMC* holding that for induced infringement, multiple entities can aggregate their actions to infringe a patent.

This Note analyzes the per curiam majority opinion and Judge Linn’s dissent in *Akamai* and concludes that the majority erred in overturning *BMC*. The single entity rule, as applied to induced infringement, fits squarely within the statutory framework of 35 U.S.C. Section 271, which provides liability for patent infringement. This Note argues that eliminating the single entity rule broadens the subject matter covered by a patent to include scenarios outside a patentee’s invention. Traditional principles of tort law, in addition to statutory liability for patent infringement, provide sufficient protection for inventors, eliminating the need for the *Akamai* court to overturn *BMC*. Finally, this Note suggests a statutory solution to reinstate the single entity rule as applied to induced infringement.

Introduction .....	1232
I. Patents and Indirect Infringement .....	1240
A. Patents in General .....	1241
B. Direct and Contributory Infringement of Patents .....	1242
C. Active Inducement of Infringement and the Single Entity Rule .....	1243
D. <i>Akamai v. Limelight</i> and the District Court .....	1244
E. <i>McKesson v. Epic Systems</i> and the District Court .....	1245
II. “Infringement” Means “Direct Infringement” as Defined in Section 271(a) .....	1246
A. Can “Infringement” Have Different Meanings for	

---

\* J.D. Candidate, 2014. This Note won the 2013 George Laikin Award for the best student article on a general interest topic published in the *Wisconsin Law Review*. I would like to thank all of the professors and students who helped me write and develop this Note.

Different Subsections? .....	1246
1. “Infringement” vs. “Infringes the Patent” .....	1247
2. Does <i>BMC</i> Provide Insufficient Patent Protection? .....	1249
3. Eliminating the Single Entity Rule Over-Broadens the Scope of Patents .....	1251
4. Infringement under Section 271(b) Compared to Criminal and Tort Law .....	1253
B. Properly Interpreting Indirect Infringement Requires Direct Infringement as Defined in Section 271(a) .....	1254
1. Section 271(a) Defines “Infringement” .....	1255
2. If <i>BMC</i> Is Contrary to Congress’s Intent, Leave It to Congress to Overturn <i>BMC</i> .....	1257
3. Principles of Vicarious Liability Provide Sufficient Patent Protection .....	1258
C. A Simple Solution: “As Defined in Section 271(a)” .....	1260
Conclusion: <i>Akamai</i> Over-Broadens the Scope of Patents and Should Be Overturned .....	1261

## INTRODUCTION

*I do not think there is any thrill that can go through the human heart like that felt by the inventor as he sees some creation of his brain unfolding to success . . . Such emotions make a man forget food, sleep, sickness, friends, love, everything.*<sup>1</sup>

It is unquestioned today that inventors deserve protection for their inventions.<sup>2</sup> Though, now that corporations rule the patent world,<sup>3</sup> a

---

1. Cleveland Moffitt, *A Talk with Tesla*, THE ATLANTA CONST., June 7, 1896, at C31, available at [https://secure.pqarchiver.com/ajc\\_historic/doc/495349104.html?FMT=AI&FMTS=ABS:AI&type=historic&date=Jun+7%2C+1896&author=Moffitt%2C+Cleveland&pub=The+Atlanta+Constitution+\(1881-1945\)&desc=A+TALK+WITH+TE+SLA](https://secure.pqarchiver.com/ajc_historic/doc/495349104.html?FMT=AI&FMTS=ABS:AI&type=historic&date=Jun+7%2C+1896&author=Moffitt%2C+Cleveland&pub=The+Atlanta+Constitution+(1881-1945)&desc=A+TALK+WITH+TE+SLA) (quoting Nikola Tesla).

2. For a discussion on three general theories for having a patent system, see Richard S. Gruner, *Why We Need a Strong Patent System and When: Filling the Void Left by the Bilski Case*, 28 SANTA CLARA COMPUTER & HIGH TECH. L.J. 499, 504–16 (2012). For a general discussion on whether business method patents encourage innovation and general pro-patent arguments, see generally Rajnish Kumar Rai & Srinath Jagannathan, *Do Business Method Patents Encourage Innovation?*, 2012 B.C. INTELL. PROP. & TECH. F. 1 (2012).

3. The sheer cost of patents makes an individual inventor an unlikely competitor. The cost of obtaining a single U.S. patent can cost an average of \$20,000 and can be more than \$100,000 for worldwide patent coverage. *Patent Costs | How Much Does a Patent Cost?*, INVENTION STATISTICS | INNOVATION DATA, [http://www.inventionstatistics.com/patent\\_cost.html](http://www.inventionstatistics.com/patent_cost.html) (last visited Oct. 1, 2013). The cost to litigate a patent can be several million dollars, and the patentee only wins about a quarter of the time. *Patent Litigation Costs | How Much Does It Cost to Protect a Patent?*, INVENTION

continuously debated topic among the patent community is the scope of patent protection.<sup>4</sup> The Federal Circuit Court of Appeals recently broadened that scope in *Akamai Technologies, Inc. v. Limelight Networks, Inc.*<sup>5</sup> and held for the first time that the aggregated actions of multiple parties can infringe a patent.<sup>6</sup> Such an expansion of scope is contrary to the text of the statute, unsupported by case law, and unnecessarily muddles the patent law landscape.<sup>7</sup> Not only does the new *Akamai* rule create different legal standards of “infringement” for different portions of the same statute,<sup>8</sup> it also broadens the scope of existing patents to cover scenarios not invented by the inventor.<sup>9</sup>

Patents<sup>10</sup> and patent law have always played a major role in the development of the United States as the dominant economic player in the

---

STATISTICS | INNOVATION DATA, [http://www.inventionstatistics.com/patent\\_litigation\\_costs.html](http://www.inventionstatistics.com/patent_litigation_costs.html) (last visited Oct. 1, 2013).

4. Donald S. Chisum, *The Scope of Protection for Patents after the Supreme Court's Warner-Jenkinson Decision: The Fair Protection—Certainty Conundrum*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 5 (1998) (“The most important issue in intellectual property is the scope of protection: given that an intellectual property right exists, to what does it extend?”). A relatively recent debate has emerged regarding non-practicing entities (NPEs), commonly referred to as “patent trolls,” and their alleged abuse of the patent system. *See, e.g.*, Caroline C. Coursey, *Battling the Patent Troll: Tips for Defending Patent Infringement Claims by Non-Manufacturing Patentees*, 33 AM. J. TRIAL ADVOC. 237, 237 (2009) (“A patent troll is a derogatory term used to describe a company, or an individual, who accumulates a patent portfolio consisting of one or more patents and then sues a large number of companies for patent infringement.”). Such allegations of abuse have spread to corporations that *do* produce manufactured goods. *See, e.g.*, Steve Lohr, *Widening Scrutiny of Google's Smartphone Patents*, N.Y. TIMES, Oct. 10, 2012, at B1, available at [http://www.nytimes.com/2012/10/10/technology/widening-scrutiny-of-googles-smartphone-patents.html?\\_r=0](http://www.nytimes.com/2012/10/10/technology/widening-scrutiny-of-googles-smartphone-patents.html?_r=0). Essentially, the concern is that entities with large numbers of patents undermine the patent system. Todd Klein, *eBay v. Mercexchange and KSR Int'l Co. v. Teleflex, Inc.: The Supreme Court Wages War against Patent Trolls*, 112 PENN ST. L. REV. 295, 299–301 (2007) (asserting that some scholars believe patent trolls are “bad for innovation” because they charge exorbitant licensing fees, deter innovation, and engage in unfair business practice).

5. 692 F.3d 1301 (Fed. Cir. 2012) (en banc).

6. *Id.* at 1306 (“To be clear, we hold that all the steps of a claimed method must be performed in order to find induced infringement, but that it is not necessary to prove that all the steps were committed by a single entity.”).

7. *See infra* Part II.

8. Specifically, 35 U.S.C. §§ 271(a)–(b) (2012).

9. *See infra* Part II.A.3.

10. A patent document includes, *inter alia*, a specification portion that describes, in detail and in whole, the inventor’s invention including various permutations and configurations of the invention. *See* 35 U.S.C. § 112(a). The document concludes with at least one “claim.” *Id.* § 112(b). Each claim describes, in detail, an aspect or version of what the inventor regards as his or her invention. *Id.* Much like a statute, each claim can be broken down into elements. In order for a patent to be infringed, each element of at least one claim must be satisfied by the alleged infringer. *See id.* § 271(a). For examples of patent claims, see *infra* notes 19–21, 23.

world.<sup>11</sup> With the proliferation of computers and the Internet, liability for active inducement of infringement<sup>12</sup> of a patent has never been more important.<sup>13</sup> Many new patents are directed to mobile devices or other inventions using computer networks like the Internet.<sup>14</sup> These networks are designed to facilitate communication and cooperation between multiple actors.<sup>15</sup> Thus, expanding liability for infringement of method claims<sup>16</sup> to include liability for methods requiring multiple users expands patent protection too broadly,<sup>17</sup> especially with regard to computer networks.<sup>18</sup>

---

11. DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW: CASES AND MATERIALS 58–59 (2d ed. 2001) (“Economic research over the past sixty years has amply demonstrated the causal link between intellectual property and the growth of our national economy.”). For a brief discussion on the economic arguments for a patent system, see Kumar & Jagannathan, *supra* note 2, at 1–2.

12. 35 U.S.C. § 271(b). This is especially true for method claims. A “method claim” is a claim in a patent to an invention that is a method or process to accomplish a particular task, usually consisting of several steps. A typical method claim may begin by claiming “A method to make a widget comprising the steps of . . . .” See Wesley L. Austin, *Software Patents*, 7 TEX. INTELL. PROP. L.J. 225, 269 (1999).

13. The inherent nature of the Internet connects multiple computers operated by multiple persons together and has proliferated cooperation of multiple entities to work together to achieve a single task. Put another way, the Internet allows separate individuals to easily work together, intentionally or not, to perform all elements of a patented claim. If that single task is patented, the patent owner will likely want those entities liable for patent infringement.

14. For example, patent class number 717 entitled “Data Processing: Software Development, Installation, and Management” has seen an increase in application filings at the U.S. Patent and Trademark Office from a mere thirty-four filings in 1992 to 1,515 filings in 2012. U.S. Patent & Trademark Office, *Patent Counts by Class by Year Report*, USPTO.GOV, at 16 (Apr. 2, 2013, 6:44 PM), available at <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/cbcby.pdf>.

15. See ANDREW S. TANENBAUM & DAVID J. WETHERALL, COMPUTER NETWORKS 2 (5th ed. 2011). For an in-depth introduction into computer networks, such as the Internet, see *id.* at 1–114.

16. Networking and Internet-related patents lend themselves to method claims. Brian R. Yoshida, *Claiming Electronic and Software Technologies: The Effect of the Federal Circuit Decisions in Alappat, Warmerdam, and Lowry on the Claiming of Mathematical Algorithms and Data Structures*, 45 BUFF. L. REV. 457, 468 (1997) (“Most computer program-related invention claims have been drafted either as a process describing a set of actions to be performed on or by specific combinations of means plus function elements, or as a component of a new machine . . . .”); Austin, *supra* note 12, at 269–70 (“Because method claims are intended to define the steps performed and not the hardware, they need not be tied as closely to the disclosed structure as the apparatus claims should be.”).

17. That is to say that varying the requirement as to *who* can infringe a patent varies the scope of enforcing the patent against would-be infringers. Assume, for example, that while prosecuting a patent the inventor was aware that a single entity must perform all elements of a claim for a court to find patent infringement occurred. If the rule is changed, thereby allowing multiple entities to collectively perform all elements of a claim, the scope of the patent (i.e., the right to prevent others from practicing the

For example, if infringement required that only one party perform all elements of a claimed invention, an inventor's patent must contain at least one claim for each actor in order for the patent to cover a system with multiple actors.<sup>19</sup> That is, the inventor must identify which elements each individual actor must perform according to his or her invention.<sup>20</sup> On the other hand, if multiple parties can aggregate their actions to

---

invention) has now expanded for the patent owner, unexpectedly and fortuitously. *See infra* Part II.A.3.

18. *See supra* notes 12–13.

19. *See* “Peanut Butter Batter” Pancake Mix, U.S. Patent No. 6,797,310 (filed Aug. 29, 2002) for an exemplary claim set:

1. A peanut butter batter pancake mix, which comprises:
  - (a) a combination of peanut ingredients comprising peanut flour, peanut butter, peanut chunks, peanut oil and peanut extract oil and
  - (b) a flour-based pancake mixture.
2. A method of using the peanut butter batter pancake mix of claim 1, comprising forming doughnuts, waffles, or crepes with the peanut butter batter pancake mix as a base.

Thus, to infringe Claim 1 of the '310 Patent, a person must create a combination of at least (1) peanut flour, (2) peanut butter, (3) peanut oil, (4) peanut extract oil, and (5) a flour-based pancake mix. Anything less does not infringe. Anything more also infringes.

20. Take, for example, Method of Exercising a Cat, U.S. Patent No. 5,443,036 (filed Nov. 2, 1993) directed to a single actor (a person directing a laser around for the purpose of exercising a cat), claiming:

1. A method of inducing aerobic exercise in an unrestrained cat comprising the steps of:
  - (a) directing an intense coherent beam of invisible light produced by a hand-held laser apparatus to produce a bright highly-focused pattern of light at the intersection of the beam and an opaque surface . . . ; and
  - (b) selectively redirecting said beam out of the cat's immediate reach to induce said cat to run and chase said beam and pattern of light around an exercise area.

Thus, Claim 1 of the '036 patent is directed to capturing the actions of *only the cat owner* because it is the human that is “directing” the laser and “redirecting said beam . . . to induce said cat to run and chase” the laser. If the inventor directed a claim to capture the actions *of the cat* (another actor in this invention) the claim could read, for example:

5. A method of aerobically exercising comprising the steps of:
  - (a) identifying a coherent beam of invisible light produced by a hand-held laser on an opaque surface; and
  - (b) running and chasing said beam when the beam is unreachable.

Notice how neither claim requires the action of another entity: Claim 1 is directed to only the actions of the human (it is noted that the element “to induce said cat to run and chase said beam” is an intention of the human, not a requirement of the cat), and fictional Claim 5 is directed to only the actions of the cat. Thus, at first blush the “invention” requires a human and a cat together, but the claim language can be directed to the actions of only one actor. This example is purely illustrative and ignores any issues of unpatentable subject matter under 35 U.S.C. § 101 (2012). *See In re Bilski*, 545 F.3d 943, 965–66 (Fed. Cir. 2008) (denying patentability to a process directed to human activity).

collectively infringe a patent,<sup>21</sup> the same inventor is incentivized to place all elements for all actors into a single claim, thereby creating ambiguities as to what exactly the inventor claims to be his or her invention.<sup>22</sup>

Determining infringement of an apparatus claim<sup>23</sup> is relatively straightforward. If the alleged infringing device contains all elements of the claimed invention, the device infringes the patent.<sup>24</sup> The person liable

21. Following the '036 Patent example, *supra* note 20, an ambiguous claim could read:

6. A method of inducing aerobic exercise comprising the steps of:
  - (a) directing an intense coherent beam of invisible light produced by a hand-held laser apparatus to produce a bright highly focused pattern of light at the intersection of the beam and an opaque surface;
  - (b) selectively redirecting said beam out of the cat's immediate reach; and
  - (c) running and chasing said beam and pattern of light around an exercise area.

In this example, it is clear that the intent of the inventor is that steps (a) and (b) are performed by a person, and step (c) is performed by a cat. If infringement requires a single entity to perform all steps, *either* the human *or* the cat must (a) direct the laser, (b) redirect the laser, *and* (c) run and chase the laser. If infringement does not require a single entity to perform all steps, Claim 6 could be infringed if a human (a) initially directs the laser and (c) runs and chases the laser while the cat (b) redirects the laser into and out of the cat's own reach. Such an example is obviously trivial, but illustrates the point that the claim language is ambiguous. It can be easily perceived how ambiguous claim language can lead to significant problems with regard to sophisticated or complex patents. Most importantly, this example illustrates how requiring claims to be interpreted as requiring a single actor to perform all steps eliminates such ambiguity.

22. See 35 U.S.C. § 112(b) ("The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the inventor . . . regards as the invention.") (emphasis added).

23. An "apparatus claim" is a claim to an invention that is an apparatus or device consisting of several components. See Austin, *supra* note 12, at 270–72. A typical apparatus claim may begin by claiming "A device to do something consisting of the components . . ." See *id.* For an exemplary apparatus claim, see Method and Device for Comm'n with Animal, U.S. Patent Application Serial No. 10/111,098 (filed Aug. 17, 2001) directed to what amounts to a walkie-talkie for a dog:

5. An apparatus for communicating with an animal comprising:
  - a bone conduction speaker mounted on an animal;
  - a first radio set mounted on said animal together with said bone conduction speaker, said first radio set having at least a receiving function;
  - a second radio set carried by a person, said second radio set having at least a transmitting function.

24. *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 528 (1972). See 35 U.S.C. § 271(a) for liability for direct infringement of a patent. The "all elements rule" has been traced back to at least *Barrett v. Hall*, 2 F. Cas. 914 (D. Mass. 1818) (No. 1047). Harold C. Wegner, Akamai: *Origins of the "All Elements" Rule*, LAIPA (Feb. 6, 2013), <http://www.laipla.net/wp-content/uploads/2013/02/TopTen2013Feb6.pdf> ("[A] patent may be for a new combination of machines to produce certain effects; and this, whether

for direct infringement of a patent is the person who adds the final piece to a patented device, thereby creating a device that includes all elements of the claim.<sup>25</sup> Thus, if a patented apparatus includes five elements and a person produces a device with only four of those elements, no matter how trivial the fifth element is, whoever adds that fifth element is liable for direct infringement of the patent.<sup>26</sup> The logic is also straightforward. The device with only four elements does not infringe.<sup>27</sup> Only with the addition of the fifth element does the device infringe.<sup>28</sup>

But that logic does not follow when applied to method claims.<sup>29</sup> If a patented method contains five steps, and a person performs steps one through four, and another person does step five, then no person has performed the method described in the patent.<sup>30</sup> Therefore, there should be no liability for direct infringement.<sup>31</sup> Unlike adding the final part to a device that ends up containing all elements of a patented device, a person

---

the machines, constituting the combination, be new or old. But in such case, *the patent being for the combination only, it is no infringement of the patent to use any of the machines separately, if the whole combination be not used*; for in such a case the thing patented is not the separate machines, but the combination; and the statute gives no remedy, except for a violation of the thing patented.”) (quoting *Barrett v. Hall*, 2 F. Cas. 914, 924 (D. Mass 1818) (No. 1047) (Story, J.)) (emphasis added in article); see also, *Evans v. Eaton*, 8 F. Cas. 846, 855 (D. Pa. 1816) (No. 4559) (Washington, J.), *rev’d*, 3 U.S. (16 Wheat.) 454 (1818).

25. See *Deepsouth*, 406 U.S. at 528.

26. See *id.* The doctrine of equivalents allows courts to find patent infringement when the literal terms of a claim are not met, but the alleged infringing device performs a similar function in a similar way to achieve similar ends. See *Winans v. Adam*, 56 U.S. 330, 341–44 (1853). The doctrine of equivalents is beyond the scope of this Note. For an introduction to the doctrine of equivalents, see CHISUM, *supra* note 11, at 873–910 and DONALD S. CHISUM, CHISUM ON PATENTS § 18.04 (2013).

27. That is to say, the device with elements one through four is not the device described in the claimed invention because the claim requires all five elements. However, in this example, the person producing the device with elements one through four may be liable for contributory infringement. 35 U.S.C. § 271(c) (providing liability for one who sells a device that substantially, but not actually, infringes a patent if the device does not have a “substantial noninfringing use” and if that individual knows the device is adapted to an infringing use).

28. That is to say, the device now satisfies and contains all elements (i.e., limitations) of the claim.

29. See *supra* notes 20–21 and accompanying text.

30. That is to say that no single person committed all elements of the patented claim.

31. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1307 (Fed. Cir. 2012) (en banc) (noting that for direct infringement under 35 U.S.C. § 271(a), “the accused infringer must perform all the steps of the claimed method, either personally or through another acting under his direction or control”).

committing only the final act of a method does not end up committing all elements of the claimed method.<sup>32</sup>

However, under the new rule adopted in *Akamai*, a person performing the first four steps of a claimed invention is liable as an infringer if that person also actively induced another to commit the final step, but where no single party performs all claimed steps.<sup>33</sup> The rule serves a similar function for active inducement of method claims as contributory infringement does for apparatus claims.<sup>34</sup> If a company produces a device that substantially infringes a patented apparatus and only requires a trivial modification by the end user to infringe the patent, contributory infringement allows the patent owner to sue the manufacturer for patent infringement instead of each individual end user.<sup>35</sup> This cause of action holds the manufacturer liable as the most culpable actor.<sup>36</sup> In this scenario, it is unreasonable to require the patentee to sue each individual end user.<sup>37</sup> Additionally, if the manufacturer cannot be stopped from producing the device because it does not literally infringe the patent, the manufacturer is left untouched

---

32. Providing patent protection for this example would be providing patent protection *for the end result*, and not the method. This Note addresses “method patents” that patent a method or process, not an end result such as a “composition of matter.” See 35 U.S.C. § 101. Arguably one can easily avoid patent infringement by avoiding the final act of a patented method. However, if the final act of a patented method is not committed, then the patent has not been infringed. If the inventor wanted to patent all but the final act of its claim, he or she should have done so. See *infra* Part II.A.3.

33. *Akamai*, 692 F.3d at 1306; 35 U.S.C. § 271(b). Similarly, under the new rule adopted in *Akamai*, a person who actively induces others to collectively perform all steps of a patented method claim is liable as an infringer even if no single party performs all steps. *Akamai*, 692 F.3d at 1306.

34. *Akamai*, 692 F.3d at 1309.

35. See 35 U.S.C. § 271(c).

36. However, “the patentee always has the burden to show direct infringement for each instance of indirect infringement.” *DSU Medical Corp. v. JMS, Co.*, 471 F.3d 1293, 1303 (Fed. Cir. 2006) (citing *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263, 1272 (Fed. Cir. 2004) and *Joy Techs., Inc. v. Flakt, Inc.*, 6 F.3d 770, 774 (Fed. Cir. 1993)); see *Brantingson Fishing Equip. Co. v. Shimano Am. Corp.*, 8 U.S.P.Q.2d 1669, 1675 (Fed. Cir. 1988) (noting that, with respect to contributory infringement, “direct infringement may be proven by circumstantial evidence including evidence which shows that the accused device has no practical use other than in an infringing system”) (citations omitted).

37. *Wallace v. Holmes*, 29 F. Cas. 74, 80 (C.C.D. Conn. 1871) (No. 17100) (noting that if contributory infringement did not exist, “the complainants would be driven to the task of searching out the individual purchasers for use who actually [infringe the patent]—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”).

and free to continue to sell a device that is one trivial step away from infringing.<sup>38</sup>

When one company performs most steps of a method claim but leaves one step for the end user, the new *Akamai* rule holds the company responsible for infringement instead of requiring the patentee to sue each individual end user.<sup>39</sup> The rule allows the patentee to sue the company as the most culpable actor.<sup>40</sup> Thus, the *Akamai* rule performs the same function for method claims that contributory infringement performs for apparatus claims.<sup>41</sup>

However sympathetic the *Akamai* rule may sound, the rule unreasonably expands the scope of patents. Traditional notions of vicarious liability and tort law already adequately protect the patentee from actors working together to infringe a patent or from an actor directing innocents to infringe.<sup>42</sup> The *Akamai* rule blurs the scope of patents by allowing the patentee to allocate steps in a method claim to various actors *post hoc*.<sup>43</sup> If no single entity performs all elements of a patented method claim, there simply has been no patent infringement and there should be no liability.<sup>44</sup>

---

38. *Id.* (“If, in actual concert with a third party, with a view to the actual production of the patented improvement in lamps, and the sale and use thereof, they consented to manufacture the burner, and such other party to make the chimney, and, in such concert, they actually make and sell the burner, and [the third party] the chimney, *each utterly useless without the other, and each intended to be used, and actually sold to be used, with the other*, it cannot be doubtful, that they must be deemed to be joint infringers of the complainants’ patent.”) (emphasis added).

39. *See Akamai*, 692 F.3d at 1306. However, without the new *Akamai* rule, not even the individual end user is liable for direct infringement under 35 U.S.C. § 271(a) because the individual end user did not perform all steps of the claimed method. *See id.*; *infra* Part I.C. (discussing the single entity rule).

40. After all, in this scenario the company is achieving the same end result as the patented method even if the company itself is not performing all of the elements of the claim in the patent.

41. *See Akamai*, 692 F.3d at 1309.

42. *Id.* at 1348 (Linn, J., dissenting); *see infra* Part II.B.3.

43. *See infra* Part II.A.3. One of the primary purposes of claims is to explicitly notify the world of what the patented method is, and how to avoid it. *See* 35 U.S.C. § 112; *Magnesystems, Inc. v. Nikken, Inc.*, 34 U.S.P.Q.2d 1112, 1113 n.1 (C.D. Calif. 1995) (“A patent claim defines in words the boundaries of an invention. *The claim advises the public what the invention is, so that the public can avoid infringing upon it.*”) (emphasis added). Allowing the patentee to allocate steps of the claimed method to different actors after the patent has been granted does not provide the world with sufficient notice of how to avoid infringement. This is especially true for innocent actors who are unaware that they may be performing the final step of a patented method claim.

44. *See supra* note 32 and accompanying text; *infra* note 138 and accompanying text.

This Note argues that providing protection for method claims performed by multiple actors is contrary to the statute<sup>45</sup> that provides protection for patented inventions and unreasonably expands the scope of method claims. Part I of this Note generally describes liability for active inducement of patent infringement and describes the factual background of the cases involved in *Akamai*. Part II analyzes the arguments made in *Akamai* and sets forth additional arguments against the majority in *Akamai*. Part II further analyzes the active inducement statute and concludes that active inducement requires direct infringement as defined in 35 U.S.C. Section 271(a). Part II also explores the ramifications of over-expanding protection of method claims, as *Akamai* does, and offers alternatives to hold multiple parties liable for infringement. Finally, this Note concludes that *Akamai* should be overturned, either judicially or legislatively, and that *Akamai* should not affect prudent claim drafters who direct claims to individual actors.<sup>46</sup>

#### I. PATENTS AND INDIRECT INFRINGEMENT

The basic principle of the U.S. patent system is utilitarian.<sup>47</sup> Patent law provides inventors with the exclusive right to enjoy the benefits of their invention, thereby encouraging inventors to develop new and useful inventions.<sup>48</sup> Additionally, in exchange for the time-limited monopoly, society gets the benefit of knowledge of the invention and the right to use the invention once the monopoly expires.<sup>49</sup> On the one hand, granting inventors the exclusive right to practice their invention encourages innovation by allowing inventors to recoup the costs of invention.<sup>50</sup> On the other hand, granting inventors too much power may stifle innovation by scaring away would-be inventors.<sup>51</sup>

---

45. 35 U.S.C. § 271.

46. If a claim is directed to a single entity (i.e., one entity that performs all elements), a rule allowing multiple actors to aggregate their actions to infringe the claim not only provides protection against that single entity, but also provides protection in the fortuitous and unforeseen scenario where multiple actors can perform the elements of the claim.

47. CHISUM, *supra* note 11, at 42–43.

48. Peter S. Menell, *Intellectual Property: General Theories*, 132–33, available at <http://www.dklevine.org/archive/ittheory.pdf>.

49. *Universal Oil Prods. Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944).

50. CHISUM, *supra* note 11, at 70–71.

51. Nikola L. Datzov, *The Machine-or-Transformation Patentability Test: The Reinvention of Innovation*, 33 HAMLINE L. REV. 281, 283 (2010); see *Bilski v. Kappos*, 130 S. Ct. 3218, 3256–57 (2010) (Stevens, J., concurring) (“These many costs of business method patents not only may stifle innovation, but they are also likely to ‘stifle competition.’ Even if a business method patent is ultimately held invalid, patent holders

*A. Patents in General*

Congress derives its power to establish a patent system from the Constitution.<sup>52</sup> A patent confers to an inventor the exclusive right to make, use, and sell his or her invention.<sup>53</sup> The exclusive right is a negative right, meaning that the patentee can exclude others from making, using, or selling the invention.<sup>54</sup> However, a U.S. patent only provides that exclusive right in the United States.<sup>55</sup> Similarly, a foreign patent confers no right to exclude in the United States.<sup>56</sup>

Not all inventions are patentable. The Patent Act<sup>57</sup> sets forth specific requirements that must be fulfilled as prerequisites to patentability.<sup>58</sup> A patent may be granted only for inventions of a “new and useful process, machine, manufacture, or composition of matter, or [an] improvement thereof.”<sup>59</sup> In addition to falling within one of the enumerated subject matter categories, the invention must also be novel<sup>60</sup> and not obvious.<sup>61</sup>

---

may be able to use it to threaten litigation and to bully competitors, especially those that cannot bear the costs of a drawn out, fact-intensive patent litigation. That can take a particular toll on small and upstart businesses.”) (citations omitted).

52. U.S. CONST. art. I, § 8, cl. 8 (granting Congress the power “[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”). At the time the Constitution was written, “science” meant “knowledge.” Edward C. Walterscheid, *The Nature of the Intellectual Property Clause: A Study in Historical Perspective*, 83 J. PAT. & TRADEMARK OFF. SOC’Y 763, 781 (2001). The term “useful arts” refers to inventions. *Id.* at 779–81; *Whitney v. Emmett*, 29 F. Cas. 1074, 1082 (C.C.E.D. Pa. 1831) (No. 17585).

53. See 60 AM. JUR. 2D *Patents* § 6 (2013).

54. *Bloomer v. McQuewan*, 55 U.S. (1 How.) 539, 549 (1852) (“The franchise which the patent grants, consists altogether in the right to exclude every one from making, using, or vending the thing patented, without the permission of the patentee.”). This right is commonly referred to as the right to sue.

55. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 441 (2007) (“In short, foreign law alone, not United States law, currently governs the manufacture and sale of components of patented inventions in foreign countries.”); see *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F.3d 1296, 1309 (Fed. Cir. 2010) (quoting *Microsoft Corp.*, 550 U.S. at 441).

56. *Boesch v. Graeff*, 133 U.S. 697, 703 (1890).

57. See 35 U.S.C. §§ 1–42 (2012).

58. See, e.g., *id.* §§ 101–03, 112.

59. *Id.* § 101.

60. See *id.* § 102 (laying out the conditions for “novelty”); *Diamond v. Diehr*, 450 U.S. 175, 190 (1981) (“The question . . . of whether a particular invention is novel is ‘wholly apart from whether the invention falls into a category of statutory subject matter.’”) (quoting *In re Bergy*, 596 F.2d 952, 961 (C.C.P.A. 1979)).

61. 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). A patent will not be granted if “the subject matter [of the patent application] as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103.

Furthermore, the inventor must fully disclose the invention in sufficient detail to enable others to make and use the invention.<sup>62</sup> The inventor must also expressly assert exactly what he or she believes to be his or her invention, commonly referred to as “claims.”<sup>63</sup> Generally, a patent is valid for twenty years from the application date.<sup>64</sup>

### *B. Direct and Contributory Infringement of Patents*

While patents provide an inventor with an exclusive right to make and use his or her invention, the only way to vindicate that right is for the patentee to sue infringers.<sup>65</sup> Direct infringement and indirect infringement are the two basic ways a person can infringe a patent.<sup>66</sup> Direct infringement is a strict liability offense<sup>67</sup> and attaches to one who “without authority makes, uses, offers to sell, or sells any patented invention.”<sup>68</sup> Direct infringement requires that the person infringe each and every element of a claim.<sup>69</sup>

Indirect infringement comes in two varieties: contributory infringement and active inducement of infringement.<sup>70</sup> Regardless of the type of indirect infringement, there must be direct infringement, usually from someone other than the indirect infringer.<sup>71</sup> Contributory infringement attaches to “one who sells a component especially designed for use in a patented invention” so long as that component is not capable of a substantial non-infringing use.<sup>72</sup> Additionally, a contributory infringer must know that the component is both patented and

---

62. 35 U.S.C. § 112(a); *see supra* note 10.

63. 35 U.S.C. § 112(b).

64. *Id.* § 154(a)(2). However, if the USPTO delays in processing the application, the patent term can be increased. *Id.* § 154(b).

65. *WiAV Solutions LLC v. Motorola, Inc.*, 631 F.3d 1257, 1264 (Fed. Cir. 2010) (noting that “patentee” includes the patent owner and other parties with an exclusionary right provided by a patent).

66. Ben Morgan, *Joint Infringement and the Impact of BMC Resources, Inc. v. Paymentech, L.P.*, 12 SMU SCI. & TECH. L. REV. 173, 173 (2009).

67. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1527 (Fed. Cir. 1995).

68. 35 U.S.C. § 271(a) (“[W]hoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”).

69. *Lemelson v. United States*, 752 F.2d 1538, 1551 (Fed. Cir. 1985).

70. *Dynacore Holdings Corp. v. U.S. Phillips Corp.*, 363 F.3d 1263, 1272 (Fed. Cir. 2004); *see infra* Part I.C for a discussion of active inducement of infringement.

71. *Dynacore Holdings*, 363 F.3d at 1272; *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 341 (1961).

72. *Ricoh Co., Ltd. v. Quanta Computer Inc.*, 550 F.3d 1325, 1337 (Fed. Cir. 2008); 35 U.S.C. § 271(c).

infringing.<sup>73</sup> The other variety of indirect infringement, active inducement of infringement, is discussed in the next Subsection.

### *C. Active Inducement of Infringement and the Single Entity Rule*

Generally, one who intentionally induces another to act and knows that those acts constitute direct infringement of a patent is liable for active inducement of infringement.<sup>74</sup> It is well settled that there can be no liability for active inducement if there is no actual infringement.<sup>75</sup> However, this Note addresses the question of what constitutes “infringement.”

There are basically two competing theories of what can constitute direct infringement. The first is that direct infringement is defined in 35 U.S.C. Section 271(a) and, accordingly, requires a single entity to perform each and every element of the infringed claim.<sup>76</sup> The second is that direct infringement occurs when one or more infringers, together, satisfy all elements of a claim.<sup>77</sup> Under the latter view, a party can be liable for active inducement when the party actively induces one actor to commit some elements of a claim and another actor to commit the remaining elements.<sup>78</sup>

In *BMC Resources, Inc. v. Paymentech, L.P.*,<sup>79</sup> a three-judge panel of the Federal Circuit<sup>80</sup> unanimously adopted the single entity rule with

---

73. 35 U.S.C. § 271(c); *Aro*, 365 U.S. at 348.

74. *DSU Medical Corp. v. JMS Co., Ltd.*, 471 F.3d 1293, 1306 (Fed. Cir. 2006); 35 U.S.C. § 271(b) (“Whoever actively induces infringement of a patent shall be liable as an infringer.”).

75. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1308 (Fed. Cir. 2012) (en banc). The *Akamai* majority uses the term “actual infringement” to be equal to “direct infringement.” *Id.*

76. *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007); *Akamai*, 692 F.3d at 1308.

77. *Akamai*, 692 F.3d at 1308–09.

78. *Id.*

79. 498 F.3d 1373 (Fed. Cir. 2007).

80. The Federal Circuit Court of Appeals has exclusive jurisdiction over patent cases. 28 U.S.C. § 1295 (2012). Since its creation in 1982, the Federal Circuit has become the de facto supreme court with respect to patent law. See Glynn S. Lunney, Jr., *Patent Law, the Federal Circuit, and the Supreme Court: A Quiet Revolution*, 11 SUP. CT. ECON. REV. 1, 2 (2004) (“Although the Court undoubtedly has some power to reign in the Federal Circuit’s rewriting of patent law, the Court has so far shown surprisingly little willingness to do so.”); but see Rebecca S. Eisenburg, *The Supreme Court and the Federal Circuit: Visitation and Custody of Patent Law*, 106 MICH. L. REV. FIRST IMPRESSIONS 28, 28 (2007) (“The increasing propensity of the Supreme Court to grant review in patent cases suggests that it is concerned about how good a job the Federal Circuit is doing.”). In 2012, there were a total of 471 cases filed at the Federal Circuit regarding patent infringement alone. U.S. CT. APPEALS FOR FED. CIR., *Filings of Patent*

regard to active inducement.<sup>81</sup> However, in *Akamai*, a fractured Federal Circuit sitting en banc expressly overruled the single entity rule of *BMC* and held that “all the steps of a claimed method must be performed in order to find induced infringement, but that *it is not necessary to prove that all the steps were committed by a single entity.*”<sup>82</sup> Thus, the Federal Circuit adopted a rule where active inducement of infringement may be found without a finding of direct infringement under Section 271(a).<sup>83</sup>

#### D. *Akamai v. Limelight and the District Court*

The subject matter of the patent at issue in *Akamai I*,<sup>84</sup> “the ’703 Patent,”<sup>85</sup> is directed to electronically delivering elements of web pages to clients.<sup>86</sup> More specifically, the ’703 Patent describes a method of more efficiently and rapidly providing elements of a web page to users by locating those elements on servers physically closer to the users.<sup>87</sup> *Akamai Technologies, Inc.*, the owner of the ’703 Patent, accused *Limelight Networks, Inc.* of infringing several claims of the ’703 Patent.<sup>88</sup> However, *Limelight* did not perform every element in each of the asserted claims.<sup>89</sup> Under *Limelight’s* system, the *content* provider modified its own links to point to the service provider’s servers whereas

---

*Infringement Appeals from the U.S. District Courts*, [http://www.cafc.uscourts.gov/images/stories/the-court/statistics/Caseload\\_Patent\\_Infringement\\_2003-2012.pdf](http://www.cafc.uscourts.gov/images/stories/the-court/statistics/Caseload_Patent_Infringement_2003-2012.pdf) (last visited September 26, 2013). Compare that with the two patent infringement cases in which the Supreme Court granted certiorari in 2012. *Monsanto Co. v. Bowman*, 657 F.3d 1341 (Fed. Cir. 2011) *cert. granted*, 133 S. Ct. 420 (2012); *Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office*, 689 F.3d 1303 (Fed. Cir. 2012) *cert. granted in part*, 133 S. Ct. 694 (2012).

81. *BMC*, 498 F.3d at 1380 (Circuit Judge Rader authored the opinion with Circuit Judges Gajarsa and Prost concurring).

82. *Akamai*, 692 F.3d at 1306 (showing Circuit Judges Rader, Lourie, Bryson, Moore, Reyna, and Wallach voting in favor of the “inducement only” rule; Circuit Judge Newman voting for a rule that direct infringement under 35 U.S.C. § 271(a) (2012) does not require a single entity to commit all of the elements; Circuit Judges Linn, Dyk, Prost, and O’Malley voting in favor of the single entity rule) (emphasis added). It is interesting to note that in this *per curiam* decision, Chief Judge Rader supports the majority, overturning his authored opinion in *BMC*, 498 F.3d 1373.

83. *Akamai*, 692 F.3d at 1306.

84. *Akamai Techs., Inc. v. Limelight Networks, Inc. (Akamai I)*, 614 F. Supp. 2d 90 (D. Mass. 2009).

85. Global Hosting System, U.S. Patent No. 6,108,703 (filed May 19, 1999) (issued Aug. 22, 2000).

86. *Id.*; *Akamai I*, 614 F. Supp. 2d at 96.

87. *Akamai I*, 614 F. Supp. 2d at 97–98.

88. *Id.* at 116–17.

89. *Id.* at 116.

the claim requires the *service* provider to modify the links.<sup>90</sup> Nevertheless, the jury found that Limelight infringed several claims of the '703 Patent.<sup>91</sup> The trial court reversed the jury verdict in view of *BMC* and the single entity rule because Limelight did not perform every element of the asserted claims.<sup>92</sup>

*E. McKesson v. Epic Systems and the District Court*

The *McKesson Information Solutions LLC v. Epic Systems Corp.*<sup>93</sup> case presents a similar question as in *Akamai I*, but not an identical one. Whereas the issue in *Akamai I* is “whether a defendant may be held liable for induced infringement if the defendant has performed some of the steps of a claimed method and has induced other parties to commit the remaining steps,”<sup>94</sup> the issue in *McKesson* is “whether a defendant may be held liable for induced infringement . . . if the defendant has induced other parties to collectively perform all the steps of the claimed method, but no single party has performed all of the steps itself.”<sup>95</sup> Essentially, the difference is that in *Akamai I*, the defendant performed at least some of the elements of the claimed invention, but in *McKesson*, the defendant did not perform any of the elements of the claimed invention.<sup>96</sup>

The subject matter of the patent at issue in *McKesson*, “the '898 Patent,”<sup>97</sup> is electronic medical records.<sup>98</sup> More specifically, the '898 Patent describes a system that automates electronic delivery of information to help doctors provide personalized service to their patients.<sup>99</sup> The '898 Patent recites a single, independent method claim<sup>100</sup> that includes several steps performed by a computing system, and one

---

90. *Id.* at 116–17.

91. *Id.* at 100.

92. *Id.* at 122–23. For example, Limelight did not perform the first step of Claim 19 of the '703 Patent, *id.* at 122, which recites “replicating a set of page objects across a wide area network of content servers *managed by a domain other than a content provider domain.*” '703 Patent, col.19 ll.7–9 (emphasis added).

93. No. 1:06-CV-2965-JTC, 2009 WL 2915778 (N.D. Ga. 2009).

94. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1305 (Fed. Cir. 2012) (en banc).

95. *Id.*

96. *See id.*

97. Electronic Provider, U.S. Patent No. 6,757,898 (filed Jan. 18, 2000) (issued June 29, 2004).

98. *McKesson*, No. 1:06-CV-2965-JTC, 2009 WL 2915778 at \*1.

99. '898 Patent, col.9 ll.27–31.

100. *See id.*, col.44 l.60–col.46 l.43.

step performed by a doctor.<sup>101</sup> Thus, by its own terms, infringement of the patent requires multiple actors<sup>102</sup> and, therefore, can never be directly infringed under the single entity rule.<sup>103</sup>

## II. “INFRINGEMENT” MEANS “DIRECT INFRINGEMENT” AS DEFINED IN SECTION 271(A)

In *Akamai*,<sup>104</sup> the Federal Circuit adopted a new rule allowing a patent holder to aggregate the actions of multiple parties to allege that there has been active inducement of patent infringement.<sup>105</sup> However, this view of active inducement is contrary to the plain language of the statute and represents poor policy. Thus, *Akamai* should be overturned, either judicially or legislatively.

### *A. Can “Infringement” Have Different Meanings for Different Subsections?*

The holding of the per curiam decision in *Akamai* is unambiguous: “To be clear, we hold that all the steps of a claimed method must be performed in order to find induced infringement, but that it is not necessary to prove that all the steps were committed by a single entity.”<sup>106</sup> However, the legal support for such a holding is not so unambiguous. First, the slight majority found that the text of the statute supported its holding because “infringement” was not defined.<sup>107</sup> Second, the majority reasoned that policy considerations supported its holding because the court did not want potential infringers to be able to split up the elements of a claim, thereby getting around the patent.<sup>108</sup> Finally, the

---

101. See *id.*, col.44 l.60–col.45 l.24 (“initiating a communication by one of the plurality of users”).

102. That is, (1) a doctor and (2) a computing system that are not under the direction/control/ownership of another. However, a hospital, for example, that directs and controls both the doctor and the computer system may directly infringe the ’898 Patent. See *infra* Part II.A.2.

103. That a claimed invention is de facto worthless because it cannot be infringed under the single entity rule is not a failure of the patent system. Rather, it is a failure on the part of the draftsman of the claim.

104. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301 (Fed. Cir. 2012) (en banc).

105. *Id.* at 1306.

106. *Id.*

107. *Id.* at 1309.

108. *Id.*

majority found similarities between its new rule and other areas of law, such as tort and criminal law.<sup>109</sup>

The majority opinion decided that it need not address the single entity rule as it pertains to direct infringement, as defined in Section 271(a).<sup>110</sup> It reasoned that because direct infringement is a strict liability tort,<sup>111</sup> it can ensnare infringers who are not aware that they are infringing.<sup>112</sup> Thus, the single entity rule is one method of reining in liability for patent infringement to help protect innocent contributors to what otherwise would be patent infringement.<sup>113</sup> According to the majority, this reasoning did not apply to active inducement because knowledge of infringement is required for active inducement liability.<sup>114</sup> Lastly, the majority stated that agency law can still be applied to direct infringement, but concluded that it was insufficient for protecting against “parties [that] have arranged to ‘divide’ their acts of infringing conduct.”<sup>115</sup>

#### 1. “INFRINGEMENT” VS. “INFRINGES THE PATENT”

The textual argument set forth by the majority is flatly incorrect.<sup>116</sup> The majority quickly dispenses with its textual argument noting simply that Section 271(a) details how one infringes a patent, but that “[n]othing in the text indicates that the term ‘infringement’ in [S]ection 271(b) is limited to ‘infringement’ by a single entity [as in Section 271(a)].”<sup>117</sup> Rather, with respect to Section 271(b), “infringement” refers “most

---

109. *Id.* at 1311–12. The majority also cited the legislative history for the 1952 Patent Act as supporting its holding. *Id.* at 1309–12. However, as is the case whenever a court must turn to legislative history to support its position, the history is ambiguous and can be interpreted either way. *See id.* at 1338–39, 1341 (Linn, J., dissenting). Thus, legislative history is of no help in this case.

110. *Id.* at 1305–06. In her dissent, Judge Newman takes this issue head-on. *Id.* at 1319–36 (Newman, J., dissenting).

111. 35 U.S.C. § 271(a) (2012) (not requiring a mens rea); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1579 (Fed. Cir. 1986) (“Infringement is a tort.”) (citing *Carbice Corp. v. Am. Patents Dev. Corp.*, 283 U.S. 27, 33 (1931)).

112. *Akamai*, 692 F.3d at 1307.

113. *Id.*

114. *Id.* at 1308 (citing *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2068 (2011) and quoting *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1306 (Fed. Cir. 2006) (en banc)). Thus, active inducement is not a strict liability tort.

115. *Id.* at 1307.

116. 35 U.S.C. § 271(a) recites: “Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.” 35 U.S.C. § 271(b) recites: “Whoever actively induces infringement of a patent shall be liable as an infringer.”

117. *Akamai*, 692 F.3d at 1309 (internal citations omitted).

naturally to the acts necessary to infringe a patent, not to whether those acts are performed by one entity or several.”<sup>118</sup>

It is readily apparent why the majority spends little time arguing that the text of statute supports its holding: it is, on its face, wrong. It is not a stretch of the imagination to read whoever “actively induces infringement,” as recited in Section 271(b), as whoever “actively induces one to infringe a patent.”<sup>119</sup> If the two statements are equivalent, then the majority has no ground to argue that Section 271(b) does not rely upon Section 271(a) because both statutes would recite the exact same words. If Section 271(a) defines how one directly “infringes a patent,” then it is unnecessary to develop an additional definition of “infring[ing] a patent” with respect to how one “actively induces one to infringe a patent.”

Still, the majority states that the two statements are not equivalent and, therefore, that Section 271(b) does not rely on Section 271(a) to define “infringement.”<sup>120</sup> Rather, the majority simply states that the term “infringement” in Section 271(b) refers to “acts necessary to infringe a patent.”<sup>121</sup> It is hard to draw a distinction, if one can be drawn at all, between the majority’s definition of “infringement” as “acts necessary to infringe a patent” and “infring[ing] the patent,” as recited in Section 271(a).<sup>122</sup> This is especially apparent when it is noted that the single entity rule applies to Section 271(a), yet Section 271(a) does not explicitly or implicitly refer to a single entity as infringing a patent.<sup>123</sup> Nevertheless, the majority holds that the single entity rule applies to Section 271(a), but not Section 271(b)—although *neither* statute refers to a single infringer.<sup>124</sup>

118. *Id.*

119. *C.f., infra* Part II.B.; *Akamai*, 692 F.3d at 1339–40 (Linn, J., dissenting).

120. *Akamai*, 692 F.3d at 1309. According to the majority, whether or not one “infringes the patent” is irrelevant to determining if another “actively induces infringement” of the patent. *Akamai*, 692 F.3d at 1309 (referencing 35 U.S.C.

§§ 271(a)–(b)). The majority provides little reasoning on this point and even less legal theory.

121. *Akamai*, 692 F.3d at 1309.

122. *Id.*; 35 U.S.C. § 271(a).

123. 35 U.S.C. § 271(a) (“[W]hoever without authority makes, uses, offers to sell, or sells any patented invention . . . infringes the patent.”).

124. In fact, although the majority does not touch the issue, in her dissent Judge Newman argues that the plain text of § 271(a) supports an interpretation that the single entity rule does not apply to direct infringement. *Akamai*, 692 F.3d at 1322–25. Judge Newman interprets “whoever” in §§ 271(a) and (b) to be plural, thus supporting the notion that multiple entities can collectively act to infringe a patent. *Id.* at 1322. However, at least with respect to § 271(a), “whoever” has long been held to be singular. *See Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 340 (1961). Thus, although her interpretation is incorrect, it illustrates that neither § 271(a) nor § 271(b) explicitly refers to a single infringer.

It is well established that when interpreting a statute, courts first must examine the text of the statute to determine whether there is any ambiguity.<sup>125</sup> When determining ambiguity, courts are to look “to the language itself, the specific context in which that language is used, and the broader context of the statute as a whole.”<sup>126</sup> Thus, when interpreting a statute, the text is paramount.<sup>127</sup> The majority is satisfied that it can redefine “infringement” for purposes of Section 271(b) simply because “[n]othing in the text indicates that the term ‘infringement’ in [S]ection 271(b) is limited to ‘infringement’ by a single entity.”<sup>128</sup> However, the same can be said of Section 271(a), yet the majority does not suggest that the single entity rule does not apply to direct infringement.<sup>129</sup> Defining a term differently for different subsections is inconsistent with Congress’s statutory scheme and fails to consider Section 271(b) in light of the entire statute.<sup>130</sup> The majority’s lack of real and substantive textual analysis is evinced by its focus on whether the text of Section 271(b) necessarily requires the single entity rule.<sup>131</sup>

## 2. DOES *BMC* PROVIDE INSUFFICIENT PATENT PROTECTION?

The majority’s policy argument is similarly unpersuasive. The majority reasons that there is no sound policy for holding a party liable

---

125. *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 450 (2002) (“As in all statutory construction cases, we begin with the language of the statute. The first step is to determine whether the language at issue has a plain and unambiguous meaning with regard to the particular dispute in the case.”) (internal quotation and citation omitted); *Lamie v. United States Tr.*, 540 U.S. 526, 534 (2004); *United States v. Ron Pair Enters.*, 489 U.S. 235, 241 (1989).

126. *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997).

127. William D. Popkin, *Law-Making Responsibility and Statutory Interpretation*, 68 IND. L.J. 865, 879 (1993) (noting that the text of a statute is paramount and can only be trumped if strict textualism results in absurdity).

128. *Akamai*, 692 F.3d at 1309.

129. *Id.* at 1307; see 35 U.S.C. § 271(a).

130. See *United Savings Ass’n of Tex. v. Timbers of Inwood Forest Assocs., Ltd.*, 484 U.S. 365, 371 (1988) (“Statutory construction . . . is a holistic endeavor. A provision that may seem ambiguous in isolation is often clarified by the remainder of the statutory scheme—because the same terminology is used elsewhere in a context that makes its meaning clear . . . .”) Thus, although the text of § 271(b) does not indicate the single entity rule, when viewed in context of the entire statute, it becomes clear that direct infringement does require the single entity rule under § 271(a). See *id.*; 35 U.S.C. §§ 271(a)–(b).

131. *Akamai*, 692 F.3d at 1309; see *United States v. Boisdore’s Heirs*, 49 U.S. 113, 122 (1850) (“In expounding a statute, we must not be guided by a single sentence or member of a sentence, but look to the provisions of the whole law, and to its object and policy.”). The *Akamai* majority devotes a mere paragraph to explicit textual interpretation before jumping into the quagmire that is the congressional record. *Akamai*, 692 F.3d at 1309.

for inducing one entity to perform all elements of a claim, but not for holding a similar party liable for inducing two or more entities to perform the elements of the claim.<sup>132</sup> Both inducers have the same effect on the patent.<sup>133</sup> Similarly, according to the majority, one who performs some of the elements of a claim and induces another to perform the rest should be just as liable as one who induces another to perform all of the elements.<sup>134</sup> The fundamental problem with this argument is that during prosecution of the patent,<sup>135</sup> the inventor had the opportunity and the duty to “particularly [point] out and distinctly [claim] the subject matter which the inventor . . . regard[ed] as the invention.”<sup>136</sup> Assuming that the inventor drafted the claims with the single entity rule in mind,<sup>137</sup> any scenario where there is no direct infringement under Section 271(a) is not a scenario the inventor contemplated or invented and does not deserve protection.<sup>138</sup> Furthermore, patent law allows and even promotes others to find non-infringing design-arounds of patented inventions.<sup>139</sup>

---

132. *Akamai*, 692 F.3d at 1309. This is the fact pattern set forth in *Akamai I*, 614 F. Supp. 2d 90, 116–19 (D. Mass. 2009).

133. *Akamai*, 692 F.3d at 1309.

134. *Id.* This is the fact pattern set forth in *McKesson Info. Solutions LLC v. Epic Sys. Corp.*, No. 1:06-CV-2965-JTC, 2009 WL 2915778, at \*2–\*6 (N.D. Ga. 2009).

135. Patent prosecution is the interaction between a patent applicant and the United States Patent and Trademark Office. When the Patent Office is satisfied that the patent applicant deserves a patent for his or her application, the Patent Office will grant the applicant a patent. 35 U.S.C. § 131 (2012).

136. 35 U.S.C. § 112(b) (2012).

137. The majority in *Akamai* is not advocating for leniency because of poorly drafted claims (i.e., claims not drafted with the single entity rule in mind), nor could it. *See generally Akamai*, 962 F.3d 1301. Patent prosecutors generally agree that it is good practice to draft claims in accordance with the single entity rule. *See* Cortney S. Alexander, *Joint Infringement, Patent Reform, and the Impact of Non-Practicing Entities on Patent Law Strategies and Litigation*, ASPATORE, 2011 WL 6742517, at \*8 (noting that “[w]ith a little forethought, method claims can usually be drafted to avoid the joint infringement problem.”); *but see* Reza Dokhanchy, *Cooperative Infringement: I Get By (Infringement Laws) with a Little Help from My Friends*, 26 BERKELEY TECH. L.J. 135, 136 (2011) (arguing that “proper claim drafting cannot solve the problem of firms cooperating to evade infringement claims”).

138. It is well settled that all elements of a claim must be satisfied for there to be infringement. *See supra* note 24; *see, e.g., Fay v. Cordesman*, 109 U.S. 408, 420–21 (1883) (“[I]f the patentee specifies any element as entering into the [patent], . . . he makes such element material to the [patent], and the court cannot declare it to be immaterial.”). Essentially, the single entity rule reads into every claim that a single entity infringes every element. If that requirement is not met, that is no different than failing to satisfy an element of the claim, and, therefore, no infringement should be found.

139. CHISUM, *supra* note 11, at 75 (noting that, with regard to design-around, “the patent provides a strong[] . . . incentive for third parties to invent non-infringing substitutes . . . . While at first blush this may seem wasteful, as redundant, it becomes immediately apparent that such secondary inventive activity is usually a very good thing.

The majority's argument could also be applied to direct infringement under Section 271(a), yet the court is not suggesting that the single entity rule be eliminated for direct infringement.<sup>140</sup> For example, one who builds a machine patented by another, except for some trivial element in the claim that is non-limiting in any practical way, is not literally liable under Section 271(a) even though there is "precisely the same impact on the patentee."<sup>141</sup> Having "the same impact" on a patent is a poor reason to expand liability of a *statute* that has already been interpreted by the court as requiring the single entity rule.<sup>142</sup>

### 3. ELIMINATING THE SINGLE ENTITY RULE OVER-BROADENS THE SCOPE OF PATENTS

Modifying a requirement for who can infringe a patent<sup>143</sup> necessarily modifies the scope of patents.<sup>144</sup> If the single entity rule is in effect, a patent owner can assert his or her right to exclude others from practicing a patented claim only in the scenario where one entity satisfies all elements of the patented claim.<sup>145</sup> If the single entity rule is not in effect, the scope of the patented claim expands to include scenarios where multiple parties collectively satisfy all elements of the patented claim.<sup>146</sup> Thus, modifying the legal definition of "infringement" modifies the scope of patent claims without modifying the language of the claim itself.

Eliminating the single entity rule with respect to induced infringement under Section 271(b)—but not with respect to direct infringement under Section 271(a)—provides patent claims with a dual scope that depends on the legal theory of infringement liability. That is, a claimed invention has one scope limited to scenarios where one entity

---

Often, a second-generation product is better than the first: perhaps being cheaper, more effective, or having fewer collateral costs or side effects.").

140. See *Akamai*, 692 F.3d at 1306–07. However, Judge Newman's dissent does argue for this. *Id.* at 1322–24 (Newman, J., dissenting); see also *supra* note 124 and accompanying text.

141. See *Akamai*, 692 F.3d at 1309.

142. *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1379 (Fed. Cir. 2007) (holding that "[i]ndirect infringement requires, as a predicate, a finding that some party amongst the accused actors has committed the entire act of direct infringement").

143. One such requirement is the single entity rule.

144. See Joshua P. Larsen, *Liability for Divided Performance of Process Claims after BMC Resources, Inc. v. Paymentech, L.P.*, 19 DEPAUL J. ART, TECH. & INTELL. PROP. L. 41, 47 (2008); Harry Surden, *Efficient Uncertainty in Patent Interpretation*, 68 WASH. & LEE L. REV. 1737, 1762–66 (2011) (discussing the effect of law on the scope of claims).

145. *Akamai*, 692 F.3d at 1307.

146. See *id.* at 1306–07.

satisfies all elements of a patented claim *for direct infringement under Section 271(a)*. But the same claim has another scope that is broadened to include scenarios where multiple entities aggregate their actions to satisfy all elements of the patented claim *for induced infringement under Section 271(b)*. Patent claims “particularly point[] out and distinctly claim[] the *subject matter* which the inventor or a joint inventor regards as the invention.”<sup>147</sup> However, under *Akamai*, the legal rules for how the claimed subject matter applies to a particular scenario changes depending upon the legal theory of liability.<sup>148</sup> Such flexibility and indefiniteness add uncertainty to the patent system.<sup>149</sup>

If method claims are properly drafted to be infringed by a single actor,<sup>150</sup> then the new *Akamai* rule provides protection to a method not invented by the inventor. Specifically, *Akamai* provides protection for that same method, but performed by multiple actors, not a single actor.<sup>151</sup> That is not what the inventor invented,<sup>152</sup> and it does not deserve protection. Poorly drafted claims<sup>153</sup> provide a better case for attorney malpractice than patent infringement.<sup>154</sup>

Furthermore, the *Akamai* rule incentivizes patentees to be ambiguous with their claim language.<sup>155</sup> If the law allows multiple parties to aggregate their actions to collectively infringe a patent, the

147. 35 U.S.C. § 112(b) (2012) (emphasis added).

148. See *Akamai*, 692 F.3d at 1306–07.

149. See *supra* note 43 and accompanying text.

150. See *supra* notes 46, 137 and accompanying text.

151. *Akamai*, 692 F.3d at 1306–07.

152. See 35 U.S.C. § 112(b) (“The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the inventor . . . regards as the invention.”) (emphasis added). The claims section of a patent is where the inventor “claims” against the world what his or her invention is. Under the single entity rule, each actor in an inventor’s invention requires its own claim because to find infringement, one actor must perform all elements of the claim. Thus, to “particularly point out and distinctly claim” what the inventor asserts is his or her intellectual property, the inventor must identify the requirements for each actor in the invented system. Under this type of patent system (the pre-*Akamai* system), if multiple actors’ actions collectively perform all elements of a claim, that is not an infringement of the invention because the inventor’s invention requires *a single* party to perform those elements. Presumably, the inventor claimed his or her invention with the single entity rule in mind, and, thus, a single entity should be required to infringe the patent.

153. That is, those that do not conform to the single entity rule.

154. For a malpractice claim against a patent attorney, the plaintiff can prove, *inter alia*, that a patent was unenforceable. See, e.g., *Air Measurement Techs., Inc. v. Akin Gump Strauss Hauer & Feld, L.L.P.*, 504 F.3d 1262, 1266 (Fed. Cir. 2007).

155. See Gretchen Ann Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time Is Ripe for a Consistent Claim Construction Methodology*, 8 J. INTELL. PROP. L. 175, 209–11 (2001) (noting that a goal of the patent system should be to provide clear and unambiguous claims but that under the U.S. patent system, inventors benefit from ambiguous claim language).

inventor is incentivized to place all elements for all actors into a single super claim because the claim elements can be divvied up by the patent owner after the patent is granted and he or she finds a scenario to sue for patent infringement.<sup>156</sup> Such a patent creates ambiguities as to what exactly the inventor claims to be the invention and, therefore, is contrary to the purpose of the patent system.<sup>157</sup>

#### 4. INFRINGEMENT UNDER SECTION 271(B) COMPARED TO CRIMINAL AND TORT LAW

The majority's comparison of induced infringement to aiding and abetting in criminal law and inducing an innocent actor to commit a tortious act is misplaced.<sup>158</sup> The majority first looks to criminal law to find that aiding and abetting is similar to the new rule adopted by the majority.<sup>159</sup> In support of its comparison, it quotes 18 U.S.C. Section 2(a) of the Federal Criminal Code: "[w]hoever commits an offense against the United States or aids, abets, counsels, commands, induces or procures its commission is punishable as a principal."<sup>160</sup> The court also notes that the "language [in 18 U.S.C. Section 2(a) is] similar to the language of [S]ection 271(b)."<sup>161</sup>

The court's comparison is unpersuasive. First, there is one glaring difference between the new *Akamai* rule and the aiding and abetting statute: to determine if a crime has been committed, one refers back to the statute that defines the crime.<sup>162</sup> Nevertheless, the majority does not refer back to Section 271(a) to determine if infringement has occurred.<sup>163</sup> Rather, the court looks to the elements of the claim.<sup>164</sup> However, the

---

156. See *supra* note 21. In other words, the patentee can allocate patent claim elements to different entities in different situations.

157. See 35 U.S.C. § 112(b) (2012) ("The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the inventor . . . regards as the invention.") (emphasis added). One primary purpose of patent claims is to provide clear public notice of the patent's scope. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997).

158. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1311–12 (Fed. Cir. 2012) (en banc).

159. *Id.* at 1311.

160. *Id.*

161. *Id.* Section 271(b) recites that "[w]hoever actively induces infringement of a patent shall be liable as an infringer." 35 U.S.C. § 271(b).

162. See, e.g., *United States v. Standefer*, 610 F.2d 1076 (3d Cir. 1979) (discussing the interpretation of 18 U.S.C. § 2(a)), *aff'd*, 447 U.S. 10 (1980).

163. *Akamai*, 692 F.3d at 1309.

164. *Id.*

claim does not set forth what constitutes infringement; Section 271(a) defines what “infringes a patent.”<sup>165</sup>

Second, the aiding and abetting statute explicitly states that the aider and abettor can commit only some of the elements of the crime.<sup>166</sup> Contrarily, Section 271(b) only provides that “[w]hoever . . . induces . . . shall be liable as an infringer.”<sup>167</sup> The majority’s argument would be much stronger if Section 271(b) read “whoever aids, abets, counsels, commands, induces, or procures infringement of a patent shall be liable as an infringer.” However, such language is not remotely similar to the language of Section 271(b), as the majority flatly asserts it is.<sup>168</sup>

The majority also analogizes Section 271(b) to tort law.<sup>169</sup> Specifically, the majority refers to “the doctrine of liability for inducing innocent actors to commit tortious acts.”<sup>170</sup> Essentially, the doctrine subjects a person to liability if that person induces another to commit a tort.<sup>171</sup> The majority’s analogy, however, is misplaced because the single entity rule already incorporates principles of vicarious liability.<sup>172</sup> Additionally, the doctrine is not analogous to the proposed interpretation of Section 271(b) because it is an innocent actor that commits the tort, not part of the tort.<sup>173</sup> The majority fails to reference any tort principle where the combined actions of two parties can commit a tort. Furthermore, the majority fails to explain why its argument supports eliminating the single entity rule from Section 271(b), but not from Section 271(a).

*B. Properly Interpreting Indirect Infringement Requires Direct Infringement as Defined in Section 271(a)*

In his dissent, Judge Richard Linn persuasively and correctly argues that *BMC*<sup>174</sup> should be upheld and that Section 271(a) should provide the

165. 35 U.S.C. § 271(a).

166. 18 U.S.C. § 2(a) (2012) (“Whoever . . . aids . . . its commission, is punishable as a principal.”).

167. 35 U.S.C. § 271(b).

168. *Akamai*, 692 F.3d at 1311.

169. *Id.* at 1312.

170. *Id.*; RESTATEMENT (SECOND) OF TORTS § 877(a) (1979) (“For harm resulting to a third person from the tortious conduct of another, *one is subject to liability if he . . . orders or induces the conduct*, if he knows or should know of circumstances that would make the conduct tortious if it were his own . . .”) (emphasis added).

171. *See* RESTATEMENT (SECOND) OF TORTS § 877(a).

172. *Akamai*, 692 F.3d at 1307.

173. *See id.* at 1312.

174. *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007).

definition of “infringement” for all subsections of Section 271.<sup>175</sup> Judge Linn takes the opposite approach of the majority: instead of overturning *BMC*, “infringement” is defined in Section 271(a) and applies throughout the section.<sup>176</sup> Even if *BMC* should have been decided in favor of the position taken by the *Akamai* majority, Judge Linn argues that there certainly is not enough support for the court to overturn its decision.<sup>177</sup> Rather, if the decision was not what Congress intended, it should be left to Congress to fix, as it did in a similar situation after the Court’s decision in *Deepsouth Packing Co. v. Laitram Corp.*<sup>178</sup>

#### 1. SECTION 271(A) DEFINES “INFRINGEMENT”

Judge Linn first argues that the statutory scheme of Section 271 indicates that Subsection (a) defines what “infringement” is.<sup>179</sup> Subsections (b) and (c) were drafted by Congress as the only other ways that one can be liable for infringement without violating Subsection (a).<sup>180</sup> Judge Linn reasons that:

[a] person who practices the entire invention is an infringer, liable under subsection (a); a person who actively induces such practice is an inducer, liable under subsection (b) (“positive articulation”). The negative inference is equally straightforward: A person who does not practice the entire invention is not liable under subsection (a); a person who actively induces such partial practice is not liable under subsection (b) (“negative articulation”).<sup>181</sup>

Judge Linn argues that instead of a simple, logical reading of the statute, the majority interprets Section 271(b) to read, “Whoever actively induces infringement of [*or induces two or more separate parties to take actions that, had they been performed by one person, would infringe*] a patent shall be liable as an infringer.”<sup>182</sup>

---

175. *Akamai*, 692 F.3d at 1337–50 (Linn, J., dissenting).

176. *Id.* at 1337–38 (Linn, J., dissenting).

177. *See id.* at 1337–46 (Linn, J., dissenting).

178. *Id.* at 1343 (Linn, J., dissenting); *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972).

179. *Akamai*, 692 F.3d at 1338 (Linn, J., dissenting).

180. *Id.* (Linn, J., dissenting). Subsections (e) through (g) were added after the Patent Act of 1952. *See id.* at 1342–43 (Linn, J., dissenting).

181. *Id.* at 1339 (Linn, J., dissenting).

182. *Id.* (Linn, J., dissenting) (bracketed text added by the dissent).

Judge Linn also takes issue with the majority's position that "infringement" in Section 271(b) can be defined however the court pleases.<sup>183</sup> Section 271(a) defines who "infringes the patent."<sup>184</sup> The majority's holding that Section 271(a) does not define "infringement" is unsupported and frivolous.<sup>185</sup> The majority is essentially arguing that defining who "*infringes* the patent" does not also define "*infringement*."<sup>186</sup> The same root word is used in each instance: "infringe."<sup>187</sup> However, the majority holds that the two words are not legally dependent, essentially because one is a verb and the other is a noun.<sup>188</sup> The majority's approach is simply not how statutes are supposed to be construed.<sup>189</sup> Furthermore, it is well settled that "if there is no direct infringement of a patent there can be no contributory infringement."<sup>190</sup>

It is worth noting that within the statutory framework of Section 271, Congress was very careful in defining what constitutes "infringement."<sup>191</sup> Only two subsections define actions that constitute "infringement."<sup>192</sup> Section 271(a) states that whoever "makes, uses, offers to sell, or sells any patented invention . . . infringes the patent."<sup>193</sup> Section 271(e)(2) begins by reciting that "[i]t shall be an act of infringement to . . ." and goes on to describe scenarios concerning applications to the Food and Drug Administration regarding patented

---

183. *Id.* at 1314, 1339–40 (Linn, J., dissenting).

184. 35 U.S.C. § 271(a) (2012).

185. *Akamai*, 692 F.3d at 1339–40 (Linn, J., dissenting).

186. *Id.* (Linn, J., dissenting).

187. *Id.* at 1340 (Linn J., dissenting).

188. *See id.* at 1339–40 (Linn, J., dissenting).

189. *Id.* at 1340 (Linn, J., dissenting) (citing *Taniguchi v. Kan Pac. Saipan, Ltd.*, 132 S. Ct. 1997, 2004–05 (2012) ("[I]t is a normal rule of statutory construction that identical words used in different parts of the same act are intended to have the same meaning.") (internal quotations omitted by the Court); *Hall v. United States*, 132 S. Ct. 1882, 1891 (2012) ("At bottom, identical words and phrases within the same statute should normally be given the same meaning . . . . Absent any indication that Congress intended a conflict between two closely related chapters, we decline to create one." (internal quotation omitted by the Court)); *Powerex Corp. v. Reliant Energy Servs., Inc.*, 551 U.S. 224, 232 (2007) (when relevant language "was inserted into [the statutory provisions] at the same time . . . [t]hat maxim is doubly appropriate."); *Comm'r v. Lundy*, 516 U.S. 235, 250 (1996) ("The interrelationship and close proximity of these provisions of the statute presents a classic case for application of the normal rule of statutory construction that identical words used in different parts of the same act are intended to have the same meaning." (internal quotations omitted by the Court))).

190. *Akamai*, 692 F.3d at 1340 (Linn, J., dissenting) (quoting *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 341 (1961)).

191. *See* 35 U.S.C. § 271 (2012).

192. *See id.* §§ 271(a), (e)(2).

193. *Id.* § 271(a).

inventions.<sup>194</sup> Other subsections of Section 271, including Section 271(b), do not describe acts that constitute infringement, but rather describe scenarios where one can be liable “as an infringer” for another’s infringement.<sup>195</sup> Thus, when Section 271(b) requires another to infringe a patent for one to be “liable as an infringer,” it is not an attempt by Congress to define *an additional* way to infringe a patent.<sup>196</sup> Rather, Section 271(b) necessarily relies on other portions of the statute to define what acts constitute “infringement.”<sup>197</sup> Any additional definition of “infringement” is extraneous to the statute and should be discarded.

2. IF *BMC* IS CONTRARY TO CONGRESS’S INTENT, LEAVE IT TO CONGRESS TO OVERTURN *BMC*

Judge Linn would prefer that the court follow the example of *Deepsouth*.<sup>198</sup> In that case, the Supreme Court interpreted Section 271 to not hold liable a party that supplied the materials necessary to infringe a patent where the assembly of the materials occurred outside of the United States.<sup>199</sup> In response to that decision, Congress enacted Section 271(f) that holds such a supplier liable “as an infringer.”<sup>200</sup> Thus, Judge Linn argues that Congress has shown not only the ability to overturn a ruling it finds improper, but also the capacity and

194. *Id.* § 271(e)(2). The details of Section 271(e) are not relevant to this discussion.

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

196. *Compare id.* § 271(b) (“Whoever *actively induces infringement* of a patent shall be liable as an infringer.”) (emphasis added), *with id.* § 271(a) (“[W]hoever without authority makes, uses, offers to sell, or sells any patented invention . . . *infringes the patent*.”) (emphasis added), *and id.* § 271(e)(2) (“It shall be an act of infringement to . . .”).

197. *See id.* § 271.

198. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1343 (Fed. Cir. 2012) (Linn, J., dissenting) (en banc); *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972).

199. *Akamai*, 692 F.3d at 1343 (Linn, J., dissenting); *Deepsouth*, 406 U.S. 518.

200. *Akamai*, 692 F.3d at 1343 (Linn, J., dissenting); 35 U.S.C. § 271(f).

willingness.<sup>201</sup> At least because the single entity rule has already been established for active inducement of infringement under Section 271(b) in *BMC*,<sup>202</sup> it should be left to Congress to change the interpretation.<sup>203</sup> Congress recently had the opportunity to overturn *BMC* in the Leahy-Smith America Invents Act, but did not do so.<sup>204</sup> Maintaining *BMC* in what is otherwise a patent system overhaul<sup>205</sup> indicates that Congress agreed with *BMC*.

### 3. PRINCIPLES OF VICARIOUS LIABILITY PROVIDE SUFFICIENT PATENT PROTECTION

First, in responding to Judge Pauline Newman's dissent, Judge Linn argues that the single entity rule does apply to Section 271(a).<sup>206</sup> Second, Judge Linn points out that vicarious liability has always applied to patent infringement.<sup>207</sup> Thus, the concern that the majority has that entities can escape liability by directing another to perform some of the elements of a claim is simply overstated.<sup>208</sup>

The holding of *BMC* sufficiently protects against the majority's concern.<sup>209</sup> If one party "control[s] or direct[s] each step of the patented process," that party is liable for direct infringement under

201. *Akamai*, 692 F.3d at 1343 (Linn, J., dissenting).

202. *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007).

203. *Deepsouth*, 460 U.S. at 531 ("[W]e should not expand patent rights by overruling or modifying our prior cases construing the patent statutes, unless the argument for expansion of privilege is based on more than mere inference from ambiguous statutory language. We would require a clear and certain signal from Congress before approving the position of a litigant who, as respondent here, argues that the beachhead of privilege is wider, and the area of public use narrower, than courts had previously thought.").

204. *Akamai*, 692 F.3d at 1343 (Linn, J., dissenting); Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011).

205. The Leahy-Smith America Invents Act has been widely described as a patent system overhaul. See, e.g., David Orozco, *Administrative Patent Levers*, 117 PENN. ST. L. REV. 1, 3 (2012).

206. *Akamai*, 692 F.3d at 1322 (Linn, J., dissenting); *Id.* at 1347-48 (Linn, J., dissenting) ("First, if one interprets 'whoever' to include the plural, the statute simply states the obvious: More than one entity can be independently liable for direct patent infringement if each entity practices every element of the claim. Second, the statutory context, with § 271(b) and (c) extending liability to actors who do not independently infringe in limited, specifically defined circumstances, indicates that § 271(a) excludes joint liability.").

207. *Id.* at 1348. Specifically, vicarious liability can apply to direct infringement under 35 U.S.C. § 271(a) (2012).

208. *Id.* This is basically the fact pattern of *McKesson. McKesson Info. Solutions LLC v. Epic Sys. Corp.*, No. 1:06-CV-2965-JTC, 2009 WL 2915778, at \*2-\*6 (N.D. Ga. 2009).

209. *Akamai*, 692 F.3d at 1348 (Linn, J., dissenting).

Section 271(a).<sup>210</sup> This is a basic notion of vicarious liability.<sup>211</sup> Additionally, each entity in such an enterprise is liable for patent infringement, not just the director.<sup>212</sup> Judge Linn further argues that if two parties work together to split up the elements of a claim such that no one entity satisfies every element, yet their collaboration does not rise to the level of holding one or both liable through the legal principles of vicarious liability, then *neither* should be liable for infringement because there has been no cognizable harm.<sup>213</sup>

As discussed above, patent law is unique from other areas of law in that it allows an individual<sup>214</sup> to prevent others from doing something that would otherwise be legal, as defined by the patent's claims.<sup>215</sup> Further, the patentee has control over what activities are covered by the patent.<sup>216</sup> Accordingly, "[t]he concerns over a party avoiding infringement by arms-length cooperation can usually be offset by proper claim drafting. A patentee can usually structure a claim to capture infringement by a single party."<sup>217</sup>

---

210. *Id.* (Linn, J., dissenting) (quoting *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007)).

211. *Akamai*, 692 F.3d at 1348 (Linn, J., dissenting) (citing RESTATEMENT (SECOND) OF TORTS § 877 (1979) ("For harm resulting to a third person from the tortious conduct of another, one is subject to liability if he . . . orders or induces the conduct . . . , [or] controls, or has a duty to use care to control, the conduct of the other . . . and fails to exercise care in the control."); RESTATEMENT (THIRD) OF AGENCY § 1.01 (2006) ("Agency is the fiduciary relationship that arises when one person (a 'principal') manifests assent to another person (an 'agent') that the agent shall act on the principal's behalf and subject to the principal's control, and the agent manifests assent or otherwise consents so to act."); RESTATEMENT (SECOND) OF TORTS § 315 (1965) ("There is no duty so to control to the conduct of a third person as to prevent him from causing physical harm to another unless . . . a special relation exists between the actor and the third person which imposes a duty upon the actor to control the third person's conduct.")).

212. *Akamai*, 692 F.3d at 1349 (Linn, J., dissenting).

213. *Id.*

214. That is, the inventor or patent owner.

215. *See supra* Part I.A.

216. *See* 35 U.S.C. § 112(b) (2012) ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the *inventor or a joint inventor regards as the invention.*") (emphasis added).

217. *BMC*, 498 F.3d at 1381; *see Alexander supra* note 137. For example, the patent at issue in *McKesson Info. Solutions LLC v. Epic Sys. Corp.*, No. 1:06-CV-2965-JTC, 2009 WL 2915778 (N.D. Ga. 2009), the '898 Patent, could have been drafted without requiring another infringer by removing the element of "initiating a communication by one of the plurality of users." *See supra* note 101 and accompanying text. Similarly, the patent at issue in *Akamai I*, 614 F. Supp. 2d 90, 97 (D. Mass. 2009), the '703 Patent, could have been drafted differently. The actions the plaintiff alleges the defendant did to infringe the '703 Patent may fit better under an apparatus claim. *See supra* note 92 and accompanying text; *see supra* Part I.D. The '703 Patent does, however, contain several apparatus claims. *See, e.g.*, the '703 Patent, col.17 l.16–col.18 l.15. If an apparatus claim is best suited to describe the defendant's alleged infringing acts and the

*C. A Simple Solution: “As Defined in Section 271(a)”*

The *Akamai* holding incorrectly overturns the single entity rule as applied to Section 271(b). *Akamai* is inconsistent with the statutory construction because it defines “infringement” differently for the same subsections of Section 271.<sup>218</sup> Additionally, the policy rationale of overturning the single entity rule is flawed because principles of vicarious liability and proper claim drafting are sufficient to protect patent owners from multiple parties escaping liability by conspiring to infringe the patent.<sup>219</sup>

Thus, the holding in *Akamai* needs to be overturned. The Supreme Court may decline to overturn *Akamai* directly.<sup>220</sup> However, the Court always has the option of overturning *Akamai* on a different set of facts in a future case.<sup>221</sup> Absent judicial action, a statutory correction is necessary.

---

defendant did not infringe the claimed apparatus, then perhaps the defendant should not be liable for infringement at all. It is unclear why the apparatus claims were not pursued by the plaintiff. See Amended Complaint at ¶ 13, *Akamai I*, 614 F. Supp. 2d 90, 96 (D. Mass. 2009) (No. 1:06-cv-11109-RWZ) (alleging defendant infringed “one or more of the inventions claimed in the ’703 patent.”). Claims in the other patents asserted by the plaintiff were also method claims. See *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 494 F. Supp. 2d 34, 39–47 (D. Mass. 2007); U.S. Patent No. 6,553,413 col.18 ll.14–51, col.19 l.36–col.20 l.8, col.20 ll.18–50 (filed June 28, 2000); U.S. Patent No. 7,103,645 col.17 l.39–col.18 l.29 (filed April 17, 2003). Of course it is possible that the defendant admitted to infringing the apparatus claims and settled out of court with plaintiffs.

218. See *Akamai*, 692 F.3d at 1314, 1339–40 (Linn, J., dissenting).

219. See *id.* at 1348 (Linn, J., dissenting); see *supra* note 207 and accompanying text.

220. The Federal Circuit has become the de facto supreme court with respect to patents. See sources cited *supra* note 80. The Supreme Court dismissed all of petitioners’ requests for certiorari in *McKesson v. Epic Sys.* after the parties announced that they reached a settlement. *Epic Sys. Corp. v. McKesson Techs., Inc.*, No. 12-800, *cert. dismissed*, 133 S. Ct. 1520 (2013); *McKesson Techs., Inc. v. Epic Sys. Corp.*, No. 12-970, *cert. dismissed*, 133 S. Ct. 1521 (2013); Stewart Bishop, McKesson, *Epic End High Court Induced-Infringement Fight*, LAW360 (Mar. 5, 2013, 4:14 PM), <http://www.law360.com/articles/420852/mckesson-epic-end-high-court-induced-infringement-fight>. After deferring its decision whether to grant certiorari twice, the Court asked the Solicitor General whether *Limelight v. Akamai* (joint induced infringement) and *Akamai v. Limelight* (joint direct infringement) should be granted certiorari. See *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 133 S. Ct. 2879 (2013); *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 133 S. Ct. 2879 (2013); *Akamai Technologies Inc. v. Limelight Networks, Inc.*, SCOTUSBLOG, <http://www.scotusblog.com/case-files/cases/akamai-technologies-inc-v-limelight-networks-inc> (last visited Oct. 14, 2013). The Solicitor General is expected to weigh in before the end of November, 2013, and the Court is expected to grant or deny certiorari shortly thereafter.

221. Patent infringement liability is already being determined based on *Akamai*. See, e.g., *Move, Inc. v. Real Estate Alliance Ltd.*, 709 F.3d 1117, 1122–24 (Fed. Cir. 2013) (vacating the trial court’s decision in view of *Akamai*); *Travel Sentry, Inc. v. Tropp*, 497 Fed. App’x 958, 967 (Fed. Cir. 2012); *Helperich Patent Licensing, LLC v.*

The *Akamai* case is all about defining “infringement” for the purposes of Section 271(b). The majority would define it independently from Section 271(a).<sup>222</sup> However, actions constituting “infringement” for the purposes of finding induced infringement in Section 271(b) should be defined in Section 271(a), including the single entity rule for direct infringement.

Thus, a simple yet effective statutory amendment is sufficient. Section 271(b) should be amended to read:

Whoever actively induces infringement of a patent, as defined in subsection (a), shall be liable as an infringer.

Although such an amendment would make clear that Section 271(a) applies for defining “infringement” for the purposes of Section 271(b), the amendment would apply *only* to induced infringement, and not to Subsections (c) through (g). Regardless of the legal theory of secondary liability for infringement of a patent, “infringement” should be defined in Section 271(a). Thus, a more complete and sweeping amendment to Section 271 would be to add another subsection that recites, for example:

As used in this section, infringement has occurred if either subsection (a) or (e)(2) is satisfied.

Such an amendment would make clear that Section 271(a) defines direct infringement, but also allows Section 271(e)(2)<sup>223</sup> to be the basis of infringement.

CONCLUSION: *AKAMAI* OVER-BROADENS THE SCOPE OF PATENTS AND SHOULD BE OVERTURNED

The Federal Circuit, sitting en banc, adopted a new rule allowing a patent owner to aggregate the actions of multiple parties to allege that a patent was infringed with respect to induced infringement of the patent under 35 U.S.C. Section 271(b).<sup>224</sup> This rule is in contrast to the single entity rule for direct infringement under Section 271(a) that requires one party to satisfy all elements of a claimed invention. The new *Akamai* rule

---

*Legacy Partners LLC*, 917 F. Supp. 2d 985, 990 (D. Ariz. 2013). The Court may deny certiorari in this case because, procedurally, this case is not ideal.

222. See *Akamai*, 692 F.3d at 1308–09.

223. Section 271(e)(2) begins with “It shall be an act of infringement to . . .” 35 U.S.C. § 271(e)(2) (2012). The subsection goes on to lay out instances of patent infringement related to submitting applications to the Food and Drug Administration. See *id.*

224. *Akamai*, 692 F.3d at 1306.

adopts one definition of “infringement” for liability for direct infringement under Section 271(a), but another for induced infringement under Section 271(b).<sup>225</sup>

The *Akamai* interpretation of Section 271 is not only inconsistent with the statutory scheme, but is unnecessary to provide adequate protection for patent holders. Principles of vicarious liability allow infringement to be found when the actions of multiple parties, together, satisfy all elements of a claimed invention, so long as one party is directing the others. Thus, the new rule allows “infringement” to be found even when multiple parties have nothing to do with one another, but together satisfy all elements of the claimed invention. Furthermore, assuming the patent claim draftsman had the single entity rule in mind, the rule broadens the scope of patents to include scenarios not invented by the inventor.

The rule adopted in *Akamai*, therefore, is too broad and is inconsistent with the statutory scheme of Section 271 as a whole. The Supreme Court should grant certiorari to resolve this issue by overturning *Akamai* and reinstating the prior rule set forth in *BMC*.<sup>226</sup> Alternatively, Congress should amend Section 271 such that Section 271(b) refers to Section 271(a) to define “infringement” in no uncertain terms.

---

225. *Id.* at 1306–07 (maintaining the single entity rule for § 271(a), but eliminating the rule for § 271(b)).

226. *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007).