(RE) THINKING INTELLECTUAL PROPERTY

FUNDAMENTAL QUESTIONS AND NEW PERSPECTIVES

Principles for Patent Remedies and Lessons for Intellectual Property Design

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Monday, November 28, 2016 at 5.30 pm
CEIPI– Amphithéâtre 25
11, rue du Maréchal Juin BP 68
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The debate will be animated by Mr. Christophe Geiger, Director General of CEIPI

Free admission subject to availability

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Abstact

Patent remedies have recently emerged as a major focus of policy debates in the United States. The United States Supreme Court's 2006 decision in eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388 (2006), abrogated a "general rule" in favor of injunctive relief for patent infringement, thereby making such relief more difficult to obtain for so-called "patent trolls" and other entities that do not compete directly with accused infringers. Despite eBay, however, concerns with trolls have continued, and reasonable royalty damages have become a particular focus of discussion. Demands for greater precision in the assessment of damages have strained the abilities of judges and juries. Questions have arisen about (1) how a commitment to fair, reasonable, and nondiscriminatory (FRAND) licensing should affect the remedies calculus; (2) what types of evidence should suffice to prove reasonable royalty damages or to obtain enhanced damages or attorney fees; (3) who should bear burdens of proof or production; and (4) how judges and juries are to process the information placed in front of them.

In his prior work on Principles for Patent Remedies, 88 Tex. L. Rev. (2010), Professor Golden identified five principles of legal design—nonabsolutism, antidiscrimination, learning, administrability, and devolution—that should inform development of the law on patent remedies. According to him, these principles remain relevant today. Further, they suggest that, whatever the flaws of Supreme Court decision-making, the Court's emphasis on "channeled discretion," see Halo Elecs., Inc., v. Pulse Elecs., Inc., 136 S. Ct. 1923, 1932 (2016), constitutes, at least in theory, a reasonable response to difficulties in crafting patent remedies. Indeed, the five principles form a subset of approaches to doctrinal and institutional design that are likely to be quite generally useful when the law confronts a policy situation characterized by conflicting goals, difficulties in valuation or normative assessment, high uncertainty, context specificity, and information scarcity. Decision-makers can productively pay attention to such design principles in seeking to ensure that legal systems advance long-term and multifaceted objectives even when, as often occurs in circumstances involving innovation, there is great uncertainty about proper means, likely payoffs, and social priorities.

Bio

John Golden has taught administrative law, contracts, patent law, and writing seminars relating to innovation and intellectual property. Since 2011, he has served as faculty director of the Andrew Ben White Center in Law, Science and Social Policy. His research has focused primarily on issues relating to innovation policy, institutional design, patents, and remedies. John has a Ph.D. in Physics from Harvard University, a J.D. from Harvard Law School, and an A.B. in Physics and History from Harvard College. Before joining the faculty of the University of Texas School of Law, he clerked for the Honorable Michael Boudin of the United States Court of Appeals for the First Circuit and then for Associate Justice Stephen Breyer of the United States Supreme Court. He also worked as an associate in the intellectual property department of Wilmer Cutler Pickering Hale and Dorr LLP.

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