



Claims for Pre-issuance Damages Require Actual Notice of and Substantially Identical Claims between the Published Application and the Issued Patent

Feb 10, 2016

Reading Time : **1 min**

By: Rachel J. Elsby

Section 154(d), a rarely invoked statute, provides for damages that take place before a patent issues if the infringer had actual notice of the published application. Although actual notice is required, Section 154(d) does not specify what constitutes actual notice.

Adobe argued that actual notice requires Rosebud to provide notice about the published patent application to Adobe, which it did not do. Rosebud argued that Adobe had constructive notice of the published patent application based on the parties' prior litigation involving the published application's parent and grandparent patents.

The court rejected Rosebud's argument because actual notice requires more than mere knowledge of the related patents. But the court stopped short of requiring an affirmative act by an applicant to give notice to an accused infringer (*c.f.* 35 U.S.C. § 287). The panel judges also read actual notice to require notice of the claims because without it, the accused infringer cannot know the scope the claimed invention. Under this reading, giving notice of only the specification (e.g., from related applications or patents) is insufficient to establish actual notice.

Rosebud LMS Inc v. Adobe Sys., Inc. (Fed. Cir. Feb. 9, 2016) (Moore, Hughes & Stoll, JJ.).

Categories

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.