



Knowledge of a Complaint May Be Insufficient to Support Claims of Indirect Infringement and Willfulness

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In that case, the plaintiff sought damages for post-suit indirect infringement and willfulness for the first time in its second amended complaint, alleging that the defendant possessed knowledge of the patent “since at least the filing” of the original complaint. The defendant moved to dismiss, arguing that the plaintiff could not rely on the original complaint to establish knowledge of the patent.

In granting the defendant’s motion to dismiss, the district court first pointed out that there is no binding authority on the question of whether a defendant must have the knowledge necessary to satisfy a claim for indirect infringement or willfulness **before** a lawsuit is filed. District courts across the country have disagreed on the issue, including different judges within the District of Delaware, and neither the Supreme Court nor the Federal Circuit have ruled on the issue. Against that backdrop, the district court reasoned that no other area of tort law permits a plaintiff to establish an element of a legal claim simply with evidence it filed a complaint.

Thus, the district court held that the plaintiff’s complaint failed to state a claim for indirect or willful infringement where the defendant’s alleged knowledge of the asserted patents is based **solely** on the filing of a prior version of the complaint in the same lawsuit. The district court explained that “[i]t seems to me neither wise nor consistent with the principles of judicial economy to allow court dockets to serve as notice boards for future legal claims.” And with respect to enhanced damages under 35 U.S.C. § 284, that remedy is punitive and should be reserved for extraordinary cases. Enhanced damages do not exist to provide an

incentive to sue innocent actors who have no knowledge of the patent. Finally, the court stressed the efficiency gained when a plaintiff provides a pre-suit notice letter, allowing the parties to potentially avoid an expensive patent infringement lawsuit.

Notwithstanding its decision here, the district court explained that pleadings that allege other facts from which it is plausible to infer that defendants had sufficient pre-suit knowledge may adequately plead such claims because, in those instances, the knowledge is not based **solely** on the filing of a complaint. Similarly, the district court noted that its decision does not prevent a plaintiff from filing a second lawsuit alleging that a defendant had the requisite knowledge based on the defendant's awareness of the first lawsuit.

Practice tip: To the extent possible, a plaintiff should include in its complaint all factual allegations that show or support an inference that the defendant knew of potential infringement of the asserted patent(s) prior to suit. If such facts do not exist, a potential plaintiff should consider whether a pre-suit notice letter might bolster its allegations of indirect or willful infringement.

ZapFraud, Inc. v. Barracuda Networks, Inc., No. 19-1687-CFC-CJB (D. Del. Mar. 24, 2021) (J. Connolly)

Categories

District Court

District of Delaware

Willful Infringement

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