



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

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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

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