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A Case Study of Federal Circuit Policy Making

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A CASE STUDY OF FEDERAL CIRCUIT POLICY MAKING

W. Keith Robinson*

ABSTRACT

The Federal Circuit's legal decisions are perceived to have a significant impact on patent policy because of its close relationship with the patent bar and the United States Patent and Trademark Office (USPTO). Accordingly, litigants before the Federal Circuit may have the unique opportunity to directly influence patent policy. In a 2003 article, Professor Arti Rai suggested that if factual determinations concerning litigation were the responsibility of the USPTO and U.S. District Courts, then the Federal Circuit would be the ideal entity to make patent policy. Interestingly, during a recent panel at the 2013 Intellectual Property Symposium at the Southern Methodist University Dedman School of Law, judges from the Federal Circuit suggested that they would like to see more policy arguments made in appellate briefs. Policy arguments are generally not emphasized in Federal Circuit briefs, but if a litigant does advance policy arguments before the Federal Circuit, it is instructive to observe (1) how the policy arguments are constructed, and (2) whether the Federal Circuit expresses a policy preference in its opinion. As an example, one need look no further than the Federal Circuit's recent en banc decision in Akamai Techs., Inc. v. Limelight Networks, Inc. (Akamai II) where a dissenting judge accused the majority of playing policy maker.

This Article analyzes the Federal Circuit's recent en banc decision in Akamai II from a policy perspective. This Article observes that the Federal Circuit's fractured decision was, at least in part, due to unhelpful statutory language and tension between formalism and policy concerns. Further, this Article argues all three opinions issued in Akamai are in some way consistent with policy concerns raised by the plaintiffs and their amici. Finally, this Article raises several questions, including: When are policy arguments most effective? What are the current limits of the Federal Circuit's policy making? And what is the impact on patent stakeholders when policy arguments are raised more frequently before the Federal Circuit?

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I. INTRODUCTION

SHOULD judicial decisions in patent cases devote more attention to policy concerns? Patent policy is shaped by a number of complex stakeholder incentives. The government stakeholders include the United States Patent and Trademark Office (USPTO), the United States District Courts and the United States Court of Appeals for the Federal Circuit (the Federal Circuit). In addition to administrative and judicial entities, actors such as patentees, patent owners, and defendants in patent litigation have a role in influencing patent policy. Each stakeholder may operate, in part, based on one or more policy incentives. Generally, "the policy underlying our patent system attempts to create four economic-based incentives: (1) incentive to invent, (2) incentive to disclose, (3) incentive to commercialize, and (4) incentive to design around."¹ Every

1. M. Scott McBride, *Patentability of Human Genes: Our Patent System Can Address the Issues Without Modification*, 85 MARQ. L. REV. 511, 525 (2001) (citing DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW 62-67 (1998)).

stakeholder has ideas about the importance of these incentives, and each is instrumental to developing patent policy.

The most interesting problems for the patent system arise when the policy incentives of patent system stakeholders and patent law fail to align. This tension often plays out in litigation. In addition to purely legal arguments, the litigants can raise policy arguments that may influence a court's final disposition of a case. Professor Arti Rai has argued that the courts are better suited to developing patent policy than the slow machinery of the legislature.² Specifically, she argued that, under certain conditions, the Federal Circuit could be in the best position to formulate patent policy.³

In fact, some members of the Federal Circuit seem willing to entertain more policy arguments. On March 22, 2013, the SMU Dedman School of Law hosted a symposium on emerging intellectual property issues called "The Federal Circuit and Patent Law."⁴ During the morning session, Federal Circuit Judges Dyk, Prost and Clevenger spoke about their experience as judges on the Federal Circuit and suggested that more briefs should be filed at the Federal Circuit containing policy arguments.⁵ This suggestion intimated that illuminating important policy concerns would assist the Federal Circuit in making difficult decisions.

The judges' statements were provocative for a number of reasons. For example, a central tenet of the Federal Circuit has been to not engage in policy making with respect to patent claims.⁶ Specifically, the Federal Circuit has said on numerous occasions that it will not redraft claims to ensure the validity of a patent or to establish that a patent has been infringed.⁷ Further, there is a perception that the Federal Circuit generally ignores policy considerations in its jurisprudence.⁸ In fact, in several major areas of patent law, the Federal Circuit's approach to decision making has been a formalist one.⁹

Due to the Federal Circuit's record regarding policy considerations, several practitioners at the symposium suggested that it would disservice clients to commandeer precious space in briefs for policy arguments not likely to influence the court.

In response, one attendee suggested that amicus briefs could fill this void instead. That is, rather than rehashing the same arguments included

2. Arti K. Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035, 1131 (2003).

3. *Id.* at 1102-03.

4. See Raymond C. Clevenger, Timothy B. Dyk, Sharon Prost & Mike McKool, Panel Discussion at SMU Symposium on Emerging IP Issues (Mar. 22, 2013) (video recording available in the SMU Law School Library).

5. *Id.*

6. 3-8 CHISUM ON PATENTS § 8.03.

7. *Id.* ("Generally, courts deny the power to re-write claims, whether to preserve validity or to establish infringement. Under limited circumstances, an error in a patent can be corrected by a certificate from the Patent and Trademark Office.")

8. See Rai, *supra* note 2 at 1101.

9. *Id.* at 1103-04 ("information technology, the intersection of patent and antitrust, and, most recently, the construction of the experimental use defense").

in the parties' briefs, amici could focus on the policy. But how much do amicus briefs focus on policy arguments? And how effective are those policy arguments in influencing the judges?

To answer these policy related questions, it may be instructive to look at the recent en banc decision, *Akamai Technologies, Inc. v. Limelight Networks, Inc.* (*Akamai II*), in which a dissenting Judge Linn accused the majority of policy making.¹⁰ Decided in August of 2012, *Akamai II* concerned the contentious issue of joint infringement.¹¹ Joint infringement is a doctrine that explains how to allocate liability where more than one entity performs the steps of a method claim such that the entities' performance in the aggregate infringes the claimed method.¹² The Federal Circuit has continuously modified the doctrine in cases dating back to 2007.¹³ *Akamai II* is the culmination of four major joint infringement cases heard before the Federal Circuit.¹⁴ As expected, a number of amici filed briefs in the case—many of which highlighted the unique policy issues at stake.

Part II of this Article briefly discusses the evolution of the joint infringement doctrine that led to the Federal Circuit's decision to rehear the most recent case en banc.

Part III of this Article discusses the Federal Circuit's *Akamai II* decision. There, an en banc Federal Circuit narrowly held that to successfully enforce a patent when more than one party performs all of the steps of a claimed method, the patentee must show that one of the alleged infringers induced the infringement of the other party.¹⁵

The opinion is interesting for several reasons. First, it failed to answer many of the questions the Federal Circuit asked the parties to brief. For example, the majority passed on the opportunity to clarify the law of joint infringement as applied to liability for direct infringement under 35 U.S.C. § 271(a).¹⁶ Instead, the Federal Circuit simply acknowledged that doctrinal problems arise "when the acts necessary to give rise to liability for direct infringement are shared between two or more actors."¹⁷ As a result, a slim majority of the court overruled its previous decisions in

10. *Akamai Techs., Inc. v. Limelight Networks, Inc.* (*Akamai II*), 692 F.3d 1301, 1337 (Fed. Cir. 2012) (en banc) (per curiam) ("In its opinion today, this court assumes the mantle of policy maker.").

11. *Id.* at 1305–06.

12. *See generally id.* at 1305–04.

13. *See generally* W. Keith Robinson, *No "Direction" Home: An Alternative Approach to Joint Infringement*, 62 AM. U. L. REV. 59 (2012); W. Keith Robinson, *Ramifications of Joint Infringement Theory on Emerging Technology Patents*, 18 TEX. INTELL. PROP. L. J. 335 (2010).

14. *See generally* McKesson Techs. Inc. v. Epic Sys. Corp., 98 U.S.P.Q.2d (BNA) 1281 (Fed. Cir. 2011); *Akamai Techs., Inc. v. Limelight Networks, Inc.* (*Akamai I*), 629 F.3d 1311 (Fed. Cir. 2010) *rev'd*, *Akamai II*, 692 F.3d 1301; *Muniauction Inc. v. Thomson Corp.*, 532 F.3d 1318 (Fed. Cir. 2008); *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007), *overruled by Akamai II*, 692 F.3d 1301.

15. *Akamai II*, 692 F.3d at 1305.

16. *See id.* at 1305–06.

17. *Id.* at 1305.

BMC Resources and *Muniauction*, establishing a new test under induced infringement for when more than one party performs steps in a method claim.¹⁸

Underlying this change in the Federal Circuit's perspective is an interesting policy debate related to the incentives of the patent system. As a result, the court issued a majority opinion and two dissents. The majority decision in *Akamai II* is a more nuanced approach than the bright-line rule advocated for by the defendants. In one dissent, Judge Linn, joined by three other judges, argued for the preservation of the direction or control test and asserted that the test provides for a finding of liability when there is a joint enterprise.¹⁹ In the second dissent, Judge Newman, writing for herself, argued that there should be liability for infringement whenever one or more parties perform the steps of a claimed method.²⁰ While all three factions of the Federal Circuit argued for different legal standards, the court also struggled to define its role in shaping patent policy. Part III concludes that the Federal Circuit's fractured decision was, at least in part, due to unhelpful statutory language and tension between formalism and policy concerns.

Parts IV and V of this Article use the litigants and amici's appellate briefs to analyze the arguments presented in *Akamai II* from a policy perspective. Parts IV and V conclude that all three opinions issued in *Akamai II* are in some way consistent with policy concerns raised by the plaintiffs and their amici. While there is no way to ascertain whether any of the policy arguments had a direct effect on the outcome of the case, the Federal Circuit's fractured decision was most likely a result of poor alignment between the current infringement statute and the policy concerns raised by personalized medicine and Internet-age inventions.

Thus, the Federal Circuit's opinion presents uncertainty and several questions without definitive answers. Is the opinion in *Akamai II* a signal to the Supreme Court or to Congress for help? How should the court rule when the applicable statute is clear and yet unhelpful? How can policy-focused stakeholders, such as frequently sued litigants, be more effective at influencing patent policy at the appellate level? Finally, can developing a further understanding of this instance of judicial policy making help identify other legal issues in cases before the Federal Circuit where policy arguments may play a larger role in the outcome?

II. THE FEDERAL CIRCUIT'S JOINT INFRINGEMENT PROBLEM

In *BMC Resources*, the Federal Circuit established a standard for joint infringement liability when multiple parties perform one or more but not

18. *Id.*

19. *See generally id.* at 1337–51.

20. *Id.* at 1319–37.

all the steps of a method claim.²¹ The Federal Circuit's *Muniauction* decision expanded on *BMC Resources* by setting forth specific examples of when the *BMC Resources* test could be satisfied.²² The decisions in *Akamai I* and *McKesson* followed several years later, both resulting in the Federal Circuit deciding to rehear both cases en banc.²³ Both *Akamai I* and *McKesson* will be discussed briefly below. This Part begins with an overview of the *BMC Resources* and *Muniauction* cases.

A. EARLY DEVELOPMENT OF JOINT INFRINGEMENT LIABILITY

Both patents at issue in *BMC Resources* and *Muniauction* involved methods carried out over an electronic network. The asserted patent in *Muniauction* purported to cover a method for auctioning financial instruments over an electronic network using a web browser.²⁴ The claims at issue in *Muniauction* required the participation of more than one entity.²⁵ Similarly, in *BMC Resources*, the plaintiff, BMC Resources, Inc. (BMC), alleged that the defendant, Paymentech L.P. (Paymentech), infringed two patents claiming methods for processing debit transactions over a network with a touch-tone telephone.²⁶ One of the asserted claims required four different parties to perform different acts within the single claim.²⁷ To illustrate, claim 2 of the asserted U.S. Patent No. 5,715,298 asserted in *BMC Resources* is reproduced below. Since claim 2 depends on claim 1, claim 1 is also included. Claims 1 and 2 read:

1. A method of paying bills using a telephone connectable to at least one remote payment card network via a payee's agent's system, wherein a caller places a call using said telephone to initiate a spontaneous payment transaction that does not require pre-registration, to a payee, the method comprising the steps of: prompting the caller to enter an account number using the telephone, the account number identifying an account of a payor with the payee in connection with the payment transaction; responsive to entry of an account number, determining whether the entered account number is valid; prompting the caller to enter a payment number using the telephone, the payment number being selected at the discretion of the caller from any one of a number of credit or debit forms of payment; responsive to entry of the payment number, determining whether the entered payment number is valid; prompting the caller to enter a payment amount for the payment transaction using the telephone; responsive to a determination that a payment amount has been entered and fur-

21. *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1378 (Fed. Cir. 2007), *overruled by Akamai II*, 692 F.3d 1301.

22. *Muniauction Inc. v. Thomson Corp.*, 532 F.3d 1318, 1330 (Fed. Cir. 2008).

23. *See Akamai I*, 629 F.3d 1311 (Fed. Cir. 2011), *rev'd, Akamai II*, 692 F.3d 1301; *McKesson Techs. Inc. v. Epic Sys. Corp.*, 98 U.S.P.Q.2d (BNA) 1281 (Fed. Cir. 2011).

24. *Id.*

25. *See Muniauction*, 532 F.3d at 1321–22.

26. *See BMC Res.*, 498 F.3d at 1375 (stating that BMC's patents required the combined actions of several participants, including the payee's agent, a remote payment network, and the financial institution that issued the card).

27. *Id.* at 1382.

ther responsive to a determination that the entered account number and payment number are valid, and during the call: accessing a remote payment network associated with the entered payment number, the accessed remote payment network determining, during the call, whether sufficient available credit or funds exist in an account associated with the entered payment number to complete the payment transaction; responsive to a determination that sufficient available credit or funds exist in the associated account, charging the entered payment amount against the account associated with the entered payment number, adding the entered payment amount to an account associated with the entered account number, informing the caller that the payment transaction has been authorized, and storing the account number, payment number and payment amount in a transaction log file of the system during the call; and responsive to a determination that sufficient available credit or funds do not exist in the associated account, informing the caller during the call that the current payment transaction has been declined and terminating the current payment transaction.

2. The method of claim 1 wherein said payment number is a debit card number.²⁸

In both *BMC Resources* and *Muniauction*, the defendants' arguments focused on the fact that it did not perform all the steps of the asserted claims. Specifically, Paymentech argued that it did not infringe BMC's claims because it did not perform all the claimed steps by itself or in coordination with other financial institutions or customers.²⁹ In *Muniauction*, both parties agreed that no single entity performed all the claimed method steps.³⁰ Accordingly, in both cases, the central question arose: Under what circumstances could an accused infringer be liable for infringement when they do not perform all the claimed method steps?

In *BMC Resources*, the Federal Circuit explained that to succeed in a claim for direct infringement under 35 U.S.C. § 271(a), a plaintiff must show that a single entity performed each step of the asserted claim.³¹ Further, even liability under an indirect infringement theory required an initial finding of direct infringement.³² A defendant, however, could not escape liability by having another party perform a step on its behalf.³³ Accordingly, the Federal Circuit established a control or direction standard that imposed liability on a controlling party for the acts of another where the controlling party controlled or directed the conduct of the acting party.³⁴ The court further explained that arms-length cooperation would not satisfy the direction or control standard.³⁵ But the standard

28. U.S. Patent No. 5,715,298 (filed Jan. 22, 1997).

29. *BMC Res.*, 498 F.3d at 1377.

30. *Muniauction*, 532 F.3d at 1328.

31. *BMC Res.*, 498 F.3d at 1380 (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (2007)).

32. *Id.* at 1379.

33. *Id.*

34. *Id.* (citing *Engle v. Dinehart*, 213 F.3d 639 (5th Cir. 2000)).

35. *Muniauction*, 532 F.3d at 1329 (citing *BMC Res.*, 498 F.3d at 1371).

might be satisfied in a situation where the accused infringer is held vicariously liable for the acts of another party.³⁶

The policy issues debated in *Akamai II* began to take shape in *BMC Resources* and *Muniauction*. The Federal Circuit reiterated that it would not restructure claims to support a finding of infringement.³⁷ Both defendants were found not to infringe the claims—a trend of non-infringement findings that continued throughout the cases heard by the Federal Circuit and the majority of district court cases.³⁸ In addition, the Federal Circuit acknowledged that its interpretation of the infringement statutes created a loophole in the law that allowed parties to escape liability by entering into arms-length agreements.³⁹ The court, however, warned that expanding the reach of the statute would subvert the statutory scheme underlying indirect infringement.⁴⁰ Finally, it is important to note that the patents at issue in both cases were related to Internet-Age technologies—technology that did not exist in 1952 when the patent infringement laws were codified by statute.

B. MODIFICATION OF THE JOINT INFRINGEMENT DOCTRINE

The Federal Circuit modified its position on joint infringement liability in *Akamai I* and *McKesson*. Similar to *BMC Resources* and *Muniauction*, the technologies at issue in *Akamai I* and *McKesson* were Internet-Age technologies.⁴¹ In *Akamai I*, Akamai Technologies, Inc. and the Massachusetts Institute of Technology (collectively, Akamai) sued Limelight Networks, Inc. (Limelight) for infringing patents directed to a content delivery network service.⁴² Generally, a content delivery service is a system of computers that allows an Internet content provider to outsource the storage and delivery of website content.⁴³ In *McKesson*, the technology at issue related to a method for sharing medical information over the Internet between a patient and a healthcare provider.⁴⁴ *McKesson* accused Epic Systems Corporation (Epic) of inducing infringement of its patents by licensing Epic's "MyChart" software to healthcare providers who then provided the software to patients.⁴⁵

A central fact common to *Akamai I* and *McKesson* was that neither defendant performed all the steps of the claimed method. In fact, in both

36. *Id.* at 1330 (citing *BMC Res.*, 498 F.3d at 1379).

37. *BMC Res.*, 498 F.3d at 1381 (citing *Sage Prods. Inc. v. Devon Indus. Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997)).

38. *See id.*; *see also Muniauction*, 532 F.3d at 1330.

39. *BMC Res.*, 498 F.3d at 1381.

40. *Id.*

41. *See generally* *McKesson Techs. Inc. v. Epic Sys. Corp.*, 98 U.S.P.Q.2d (BNA) 1281, 1282 (Fed. Cir. 2011); *Akamai I*, 629 F.3d 1311, 1314–15 (Fed. Cir. 2010), *rev'd*, *Akamai II*, 692 F.3d 1301 (Fed. Cir. 2012) (en banc) (per curiam).

42. *Akamai I*, 629 F.3d at 1315.

43. *Id.* at 1315–16.

44. *McKesson Info. Solutions LLC v. Epic Sys. Corp.*, No. 1:06-CV-2965-JTC, 2009 WL 2915778, at *1 (N.D. Ga. Sept. 8, 2009), *aff'd sub nom.* *McKesson Techs. Inc. v. Epic Sys. Corp.*, 98 U.S.P.Q.2d (BNA) 1281 (Fed. Cir. 2011).

45. *McKesson*, 98 U.S.P.Q.2d (BNA) at 1282.

cases, all parties agreed that the accused products did not perform all the steps of the asserted claims.⁴⁶ Instead, using a theory of joint infringement, the plaintiffs argued that the defendants directed or controlled customers to perform the remaining steps of the accused method claims.⁴⁷ In *Akamai I*, the Federal Circuit narrowed the scope of its precedent in *BMC Resources* and *Muniauction* by stating that joint infringement could only occur (1) “when there is an agency relationship between the parties who perform the method steps,” or (2) “when one party is contractually obligated to the other to perform the steps.”⁴⁸ Applying this agency or contractual obligation test in both *Akamai I* and *McKesson*, the Federal Circuit found that neither provider–customer relationships rose to the level of an agency or contractual obligation.⁴⁹ Accordingly, neither defendant was found to have infringed the asserted claims.⁵⁰

Unfortunately, these two rulings did not settle many of the concerns first raised in *BMC Resources* and *Muniauction*, such as whether a claim could be directly infringed by separate entities.⁵¹ Judge Newman asserted that the decision in *McKesson* was an attack on all interactive methods and Internet-Age technologies.⁵² Further, Judge Newman warned that the Federal Circuit’s holdings harmed the incentive to patent for many technology companies.⁵³ Subsequently, the Federal Circuit decided to rehear both cases en banc in *Akamai II*. The central question before the Federal Circuit was whether there can be liability for infringement when different entities each perform separate steps of a method claim?⁵⁴

III. ASSUMING THE MANTLE AS POLICY MAKER

The Federal Circuit’s decision in *Akamai II* is perplexing. First, the per curiam opinion failed to resolve many of the issues the parties were asked to brief.⁵⁵ Most notably, the opinion did not clarify the rule for finding liability in multiple parties for direct infringement under 35 U.S.C. § 271(a).⁵⁶ Instead, the court partially overruled *BMC Resources* and *Muniauction*, and crafted a new inducement-only test.⁵⁷

46. See *Akamai I*, 629 F.3d at 1317; *McKesson*, 98 U.S.P.Q.2d (BNA) at 1282.

47. See *Akamai I*, 629 F.3d at 1317; *McKesson*, 98 U.S.P.Q.2d (BNA) at 1283.

48. *Akamai I*, 629 F.3d at 1320.

49. See *id.* at 1321; *McKesson*, 98 U.S.P.Q.2d (BNA) at 1284 (opining that MyChart users only acted for their own benefit and were not under the MyChart providers’ control).

50. *Akamai I*, 629 F.3d at 1322; *McKesson*, 98 U.S.P.Q.2d (BNA) at 1284.

51. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 419 F. App’x 989, 989 (Fed. Cir. 2011).

52. *McKesson*, 98 U.S.P.Q.2d (BNA) at 1291 (Newman, J., dissenting) (claiming that the majority’s decision removed all interactive methods from patent eligibility).

53. *Id.* (“A patent that cannot be enforced on any theory of infringement, is not a statutory patent right.”).

54. See *id.* (Newman, J., dissenting) (explaining the question as “identifying the circumstances in which it is just to hold one individual accountable for the actions of another” (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 435 (1984)) (internal quotation marks omitted)).

55. *Akamai II*, 692 F.3d 1301 (Fed. Cir. 2012) (en banc) (per curiam).

56. *Id.* at 1305–06.

57. *Id.* at 1306.

Possibly due to the complex legal and policy questions, the Federal Circuit was split into three camps. The majority opinion opined that there could be third-party liability under an inducement theory.⁵⁸ The first dissent, authored by Judge Newman, asserted that there should be liability for infringement whenever one or more parties perform the steps of a claimed method.⁵⁹ The second dissent, authored by Judge Linn, argued that the control or direction test was sound and could be interpreted to include a finding of liability where there is a joint enterprise.⁶⁰ The sub-Parts below will briefly summarize the positions taken by the judges in *Akamai II*, highlighting where policy concerns may have had a significant impact.

A. THE CREATION OF A PARTIAL INDUCEMENT TEST

1. *The Majority's Reinterpretation of § 271(b)*

The majority acknowledged that with respect to method patents parties can, and often do, share the performance of method steps between them.⁶¹ Accordingly, instead of addressing the issue of whether direct infringement can be found when there is no single party that performs all the claimed steps, the majority opinion sought to answer two questions.⁶² First, can a party be held liable for induced infringement if the defendant has performed some claimed steps and induced other parties to commit the remaining steps?⁶³ Second, can a party be held liable for induced infringement if the defendant has induced other parties to collectively perform all the steps of a claimed method?⁶⁴

In answering these questions, the majority overruled parts of its holdings in *BMC Resources* and *Muniauction*.⁶⁵ In *BMC Resources* and *Muniauction*, the Federal Circuit held that a defendant was liable for induced infringement under § 271(b) only if the defendant directed or controlled another party to perform the claimed steps.⁶⁶ *BMC Resources* required that infringement be committed by a single entity under the direction or control of another entity.⁶⁷ The holdings in *BMC Resources* and *Muniauction* resulted in immunizing an inducer of infringement when there is no direct infringement.⁶⁸ In response, the holding in *Akamai II* did away with the "single entity" requirement under § 271(b).⁶⁹

The majority's approach was to reinterpret the inducement statute in order to cover some multi-party activities. Generally, a party is liable for

58. *Id.* at 1305–19.

59. *Id.* at 1336 (Newman, J., dissenting).

60. *Id.* at 1350 (Linn, J., dissenting).

61. *Id.* at 1306 (majority opinion).

62. *Id.*

63. *Id.* at 1305.

64. *Id.*

65. *Id.* at 1306.

66. *Id.* at 1314.

67. *Id.* at 1315.

68. *Id.*

69. *Id.* at 1308–09.

inducement under § 271(b) if he advises or encourages another to infringe, and the inducement leads to actual infringement.⁷⁰ Induced infringement requires that the inducer intend to induce acts that infringe.⁷¹ However, for liability to attach, the induced party does not have to be under the direction or control of the inducer.⁷² Instead of following *BMC Resources*, which required that there be direct infringement committed by a single actor for inducement liability, the majority held that a party who induces others to collectively perform claimed method steps or performs some steps and induces others to perform the remaining steps is liable under § 271(b).⁷³

2. Support for the Majority's Position

To support its argument that induced infringement does not require direct infringement committed by a single actor, the majority relied heavily on the legislative history of the 1952 Patent Act. Specifically, the majority relied on a hypothetical given by Judge Giles Rich while commenting on the future of 35 U.S.C. § 271(b). Judge Rich opined that the Supreme Court cases at that time made it impossible to enforce patents where there is obvious infringement, but instead of a direct infringer, there are multiple contributory infringers.⁷⁴ Thus, the majority concluded that indirect infringement is a cause of action that should be recognized.⁷⁵

Further, the majority asserted that support for the idea that an actor is liable for inducing intermediaries can be found by analogy in criminal⁷⁶ and tort law.⁷⁷ The majority explained that § 271(b) codified the common law standard for indirect infringement, which applied to parties that directed, encouraged or aided in patent infringement.⁷⁸ The majority observed that a key difference between vicarious liability and liability for inducement in tort law is that inducement requires knowledge of the consequences of the induced conduct.⁷⁹ Further, because tort law assigns liability even when the induced party is an innocent actor, the court concluded that liability for patent infringement could be found in the absence of direct infringement.⁸⁰

The majority's opinion also rebutted several arguments made by the litigants and dissenting judges. In a response to Judge Linn's dissent, the majority stated that an act of infringement under § 271(b) need not qual-

70. *Id.* at 1307.

71. *Id.* at 1308.

72. *Id.*

73. *Id.* at 1305–06.

74. *Id.* at 1310. Given his hypothetical of a claim directed to the operation of radio communication, requiring both reception and transmission.

75. *Id.* at 1311.

76. *Id.*

77. *Id.* at 1312.

78. *Id.* at 1311.

79. *Id.* at 1312–13.

80. *Id.* at 1313.

ify as an act of infringement under § 271(a).⁸¹ In support of this assertion, the majority cited several other provisions of § 271 that specifically define different conduct as infringement.⁸² None of the provisions cited first require a finding of infringement under § 271(a). The majority distinguished *Aro* by pointing out that *Aro* is related to a product claim where there is always a direct infringer.⁸³ In contrast, there may not always be a direct infringer for method claims. Further, the majority noted that none of the cases before *BMC Resources* held that all the steps of a method claim must be performed by a single entity to find indirect infringement.⁸⁴ For example, in *Solva Waterproof Glue Co.*, the defendant was a contributory infringer by performing one step of a two-step process.⁸⁵

Based on its new inducement test, the majority summarized what must be shown to find liability in each of the specific cases on appeal. First, in *McKesson*, Epic would be liable if “(1) it knew of McKesson’s patent, (2) it induced the performance of the steps of the method claimed in the patent, and (3) those steps were performed.”⁸⁶ In *Akamai I*, Limelight would be liable if it knew of Akamai’s patent, performed some of the steps of the claimed method, induced the performance of the remaining step or steps, and those remaining steps were performed.⁸⁷

In sum, the majority held that there can be liability for induced infringement where all the steps are not performed by a single entity.⁸⁸ Because inducement does not require the induced party to be an agent of the inducer or under the direction or control of the inducer, the effect of the majority’s opinion is to eliminate the “control or direction” test established and elaborated upon in *BMC Resources* and *Muniauction*. Relying on the House Report on the 1952 Patent Act, the majority reasoned that inducement applies to joint infringement cases because one who aids or abets infringement is “likewise an infringer.”⁸⁹ In support of its inducement only rule, the majority also explained that an inducer has the same impact on the patentee whether he induces one party or multiple parties to infringe.⁹⁰

B. JUDGE NEWMAN’S DISSENT

Judge Newman has consistently opined that there should be liability for infringement of a claimed method no matter how it is performed, whether it be by a single entity or multiple independent parties.⁹¹ In the

81. *Id.* at 1314.

82. *Id.* at 1314.

83. *Id.* at 1316.

84. *Id.* at 1317.

85. *Id.*

86. *Id.* at 1318.

87. *Id.*

88. *Id.* at 1306.

89. *Id.* at 1309.

90. *Id.* at 1309–10.

91. *Id.* at 1323 (Newman, J., dissenting) (“Infringement is not a question of how many people it takes to perform a patented method.”).

absence of recognizing such liability, Judge Newman has stated that the patent incentive for interactive procedures is severely weakened.⁹² Thus, a patent that cannot be infringed does not provide the patentee with a patent at all.⁹³ These policy principles are clearly on display in her dissent in *Akamai II*.

In her dissent, Judge Newman claimed that “[t]he majority’s theory is a spontaneous judicial creation.”⁹⁴ Specifically, Judge Newman interpreted the majority’s opinion as assigning liability solely to the party inducing infringement while exonerating the party that was induced (and directly infringed the claimed steps) from liability.⁹⁵ Accordingly, Judge Newman asserted that the majority created new enforcement and compensation problems as well as “new opportunities for gamesmanship and abuse and inequity.”⁹⁶

Judge Newman argued that the majority’s test created a new standard for patent infringement—one where inducement, without direct infringement is sufficient for patent liability.⁹⁷ Consistent with previous holdings in *BMC Resources* and *Muniauction*, Newman alternatively suggested that for there to be liability for inducement, there must be a direct infringement.⁹⁸ In support of this position, she cited several cases.⁹⁹ In addition, Judge Newman relied on a statement made by Judge Rich in congressional hearings in 1949 and 1951 stating that for there to be contributory infringement there must be direct infringement.¹⁰⁰ Based on Judge Rich’s testimony, when two or more parties act together to infringe a patent they are not direct infringers, but instead are contributory infringers.¹⁰¹

The majority’s interpretation, Judge Newman argued, results in the inability of a patentee to sue direct infringers of a patent when infringement occurs by the aggregate acts of multiple parties.¹⁰² The patentee’s only recourse is against a party that has induced the infringing acts.¹⁰³ In Judge Newman’s view, the main issue was “whether a method patent is

92. *McKesson Techs. Inc. v. Epic Sys. Corp.*, 98 U.S.P.Q.2d (BNA) 1281, 1285–86 (Fed. Cir. 2011) (stating that by upholding the notion that “neither collaboration nor joint action nor facilitation nor authorization nor invitation can overcome the immutable barrier to infringement when all of the participating entities are not under the ‘control or direction’ of a mastermind infringer,” the court eliminates the patent incentive for interactive procedures and “disserves commerce, fairness, and the innovation incentive.”).

93. *See id.* at 1291 (“A patent that cannot be enforced on any theory of infringement, is not a statutory patent right.”).

94. *Akamai II*, 692 F.3d at 1321 (Newman, J., dissenting).

95. *Id.* at 1320.

96. *Id.*

97. *Id.* at 1329.

98. *Id.* at 1328.

99. *Id.* at 1328–29 (discussing *Met-Coil Systems Corp. v. Korners Unlimited, Inc.*, 803 F.2d 684, 687 (Fed. Cir. 1986); *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1318 (Fed. Cir. 2005); *Nat’l Presto Indus., Inc. v. West Bend Co.*, 76 F.3d 1185 (Fed. Cir. 1996)).

100. *Id.* at 1329.

101. *Id.* at 1330.

102. *Id.*

103. *Id.*

infringed when more than one entity performs the claimed steps of the method.”¹⁰⁴ And based on the existing law of infringement, her answer would be yes.¹⁰⁵

Accordingly, instead of the inducement-only rule or the single-entity rule, Judge Newman suggested that the current law under § 271 already crafts an appropriate remedy.¹⁰⁶ Specifically, direct infringement can be accomplished by more than one entity.¹⁰⁷ In support of her position, Judge Newman observed that § 271(a) uses the word “whoever,” which can stand for a singular entity or multiple entities.¹⁰⁸ Second, prior to *BMC Resources* and *Muniauction*, Judge Newman argued that a claim was directly infringed when all the steps of the claimed method were performed regardless of how many entities performed the individual steps.¹⁰⁹ Third, Judge Newman referenced the Federal Circuit approval of a jury instruction in *On Demand Machine Corp. v. Ingram Industries, Inc.*, in which it was not necessary for a jury to find a solo actor liable for infringement because multiple parties can be found jointly liable.¹¹⁰ Judge Newman’s opinion then quoted *The Law of Useful Inventions*, which stated that “any person who participates in any wrongful appropriation of the invention becomes thereby a violator of the rights protected by the patent.”¹¹¹

According to Judge Newman, the majority’s test also fell short because it failed to explain how liability is assessed.¹¹² She asserted that when a patent is infringed by more than one entity a remedy should be allocated based on tort principles of apportionment.¹¹³ Factors that are considered under this apportionment calculus include: the relative contribution to the injury; the economic benefit received by the infringer; and the knowledge or culpability of the contributory infringer.¹¹⁴ In practical terms, Judge Newman suggested that the allocation of a remedy to patentees for infringement of their method by multiple entities should be determined on a case-by-case basis.¹¹⁵

Finally, Judge Newman addressed the policy concern that innocent third parties may be held liable for infringement by (1) stating that such a result is not required by the law and (2) pointing out that most defendants in patent infringement suits are commercial participants with significant financial resources.¹¹⁶ This is not to say that the innocent infringer

104. *Id.* at 1327.

105. *Id.*

106. *Id.* at 1321.

107. *Id.* at 1322.

108. *Id.*

109. *Id.*

110. *Id.* at 1325.

111. *Id.* at 1324.

112. *Id.* at 1330.

113. *Id.* at 1331.

114. *Id.*

115. *Id.* at 1332.

116. *Id.*

cannot be sued; rather, the portion of an innocent party's damages would be insignificant compared to the commercial actor.

C. JUDGE LINN'S DISSENT

This Part summarizes Judge Linn's dissent in *Akamai II* in which three other judges joined. The dissent began forcefully by accusing the majority of judicial policy making.¹¹⁷ Next, Judge Linn provided his own interpretation of the patent infringement statutes at issue.¹¹⁸ The dissent then refuted the majority's interpretation of § 271 and admonished the majority for not resolving the issue of how joint infringement applies to liability for direct infringement.¹¹⁹ In its place, Judge Linn argued for an expanded interpretation of the "direction or control" test.¹²⁰

1. Statutory Interpretation

Patent infringement is a statutorily defined tort under 35 U.S.C. § 271.¹²¹ Sections 271 (a)–(c) are the most relevant to joint infringement, and the dissent briefly discussed the contours of these sections. Section 271(a) defines direct infringement. In his dissent, Judge Linn initially defined direct infringement as a strict liability offense requiring that a single actor meets the "all elements rule"—that is, performs each and every step of a method claim.¹²² In Judge Linn's view, strict liability "protects" an actor who does not perform all the steps of a claim from infringement liability.¹²³ In response to the argument that the word "whoever" undermines the single entity rule, he argued that the use of the word "whoever" implies that more than one person can be independently liable for patent infringement.¹²⁴ In addition, because §§ 271(b) and 271(c) cover specific examples of when a party is liable for acts other than direct infringement, Judge Linn concluded that § 271(a) is limited to acts of infringement performed by a single entity.¹²⁵ Further, the dissent argued that the term infringement has the same meaning in § 271(a) that it does in §§ 271(b) and 271(c).¹²⁶

Subsections (b) and (c) address multi-party conduct.¹²⁷ While § 271(b) codifies the doctrine of inducement, § 271(c) codifies the doctrine of contributory infringement.¹²⁸ Specifically, § 271(b) assigns liability to one who induced "infringement" as defined in § 271(a).¹²⁹ Similarly, § 271(c)

117. *Id.* at 1337.

118. *Id.* at 1338–39.

119. *Id.* 1338.

120. *Id.* at 1350.

121. *Id.* at 1338.

122. *Id.* at 1347.

123. *Id.*

124. *Id.* at 1348.

125. *Id.*

126. *Id.* at 1340.

127. *Id.* at 1339.

128. *Id.* at 1338.

129. *Id.*

assigns liability to one who sells a component part that is especially adapted for use in infringement.¹³⁰ Accordingly, Linn deduced that if the entire invention is not practiced as required under § 271(a), then there can be no infringement under subsections (b) or (c).¹³¹ In support of this statement, Judge Linn's dissent noted that in *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, the Supreme Court stated that "if there is no direct infringement of a patent there can be no contributory infringement."¹³² That is, "[u]nless someone is liable as a direct infringer, no one can be liable for indirect infringement."¹³³

2. Judge Linn's Proposal

As an alternative to the majority's position, Judge Linn proposed to simply apply the "control or direction" test as articulated in *BMC Resources*.¹³⁴ He explained that despite the single-entity rule, liability under § 271(a) can be found where there is vicarious liability.¹³⁵ That is, where one party controls or directs each step of a patented process, the directing party is liable for infringement under § 271(a).

To address broader policy concerns, Judge Linn expanded the contours of *BMC Resources* and *Muniauction* to encompass what he refers to as "joint enterprises."¹³⁶ According to the dissent, joint enterprises are individual participants who act together to infringe a patent.¹³⁷ The acts of one member are imputed to the others, thus creating a separate infringing consciousness referred to as a joint enterprise.¹³⁸ Thus, if a party participates in a joint enterprise that infringes a claim, they are liable as direct infringers under § 271(a).¹³⁹

But what must happen for a joint enterprise to be created? Judge Linn explained that for a joint enterprise to exist: (1) an express or implied agreement must exist between the members of the group; (2) the group carries out a common purpose; (3) the group's members have a pecuniary interest in that purpose, and (4) each member presumably has an equal right to a voice in the direction of the joint enterprise.¹⁴⁰ Based on these factors, Judge Linn concluded that the decision in a previous joint infringement case, *Golden Hour*, should be overruled.¹⁴¹ Further, Judge Linn argued for a finding of non-infringement in both *Akamai* and *McKesson* because there was no evidence of direction or control of an

130. *Id.* at 1339.

131. *Id.*

132. *Id.* at 1340 (Linn, J., dissenting) (quoting *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 341 (1961)).

133. *Id.* at 1341.

134. *Id.* at 1350.

135. *Id.* at 1348.

136. *Id.* at 1349.

137. *Id.*

138. *Id.*

139. *Id.* at 1350.

140. *Id.* at 1349.

141. *Id.*

outside entity or a joint enterprise.¹⁴²

3. Judge Linn's Rejection of the Majority's Partial Inducement Test

Judge Linn's dissent also addressed several of the supporting arguments made by the majority. He discounted Judge Rich's testimony as a basis for the majority's interpretation and formulation of its new rule. For example, Judge Linn stated that the testimony of Judge Rich relied on by the majority was inconclusive and contradictory.¹⁴³ Moreover, Judge Linn argued that Judge Rich's testimony was not entitled to any weight because he was not a member of Congress.¹⁴⁴

The dissent also took issue with the analogies to other areas of the law drawn by the majority opinion. In response to the majority's analogy to criminal law, Judge Linn explained that the Supreme Court requires proof of the underlying statutory violation to convict an accessory who induces a criminal act.¹⁴⁵ That is, criminal liability requires an actual offense similarly to how § 271(b) requires direct infringement.¹⁴⁶ Further, the dissent argued that the sources cited by the majority stand for the proposition that a party that is encouraged or induced to commit a tort is also liable.¹⁴⁷ In addition, inducement liability only exists when there is an underlying breach of duty.¹⁴⁸ In sum, with respect to patent infringement, the dissent concluded that there can be no inducement without direct infringement.¹⁴⁹

Judge Linn's dissent also addressed some of the policy concerns raised by the other opinions. First, he reiterated that most of these problems can be resolved with proper claim drafting and warned that the court should not change the law to accommodate poorly drafted claims.¹⁵⁰ In addition, Judge Linn argued that Judge Newman's formulation of liability leads to undesirable results when applied to system and apparatus claims.¹⁵¹ Finally, Judge Linn argued that it is not the Federal Circuit's role to close the loophole the court itself acknowledges exists.¹⁵² Instead, where Congress sought to expand or add to the definition of infringement, Judge Linn argued that Congress did so by creating subsections (e), (f) and (g) to § 271.¹⁵³ In other words, where loopholes existed, Congress enacted legislation to close them.¹⁵⁴ Finally, Judge Linn's dissent argued that Congress, given the recent enactment of the AIA, had an opportunity to

142. *Id.* at 1350–51.

143. *Id.* at 1341.

144. *Id.*

145. *Id.* at 1344.

146. *Id.* at 1345.

147. *Id.* at 1345–46.

148. *Id.* at 1346.

149. *Id.* at 1347.

150. *Id.* at 1349–1350.

151. *Id.* at 1330.

152. *Id.* at 1343.

153. *Id.* at 1343.

154. *Id.*

change the law, but since it did not, it must have been satisfied with the decisions in *BMC* and *Muniauction*.¹⁵⁵

IV. THE POLICY PERSPECTIVES OF THE APPEAL BRIEFS

A. PATENTEE POLICY CONSIDERATIONS

The plaintiffs' briefs addressed policy considerations from a patentee perspective. However, very little policy is discussed in McKesson's opening or reply brief.¹⁵⁶ Instead, the fifty-two pages of text were dedicated to the legal arguments at issue.¹⁵⁷ In contrast, Akamai's principal brief addressed several policy issues.¹⁵⁸ Akamai also dedicated a few paragraphs in its reply brief to policy arguments.¹⁵⁹ These arguments addressed issues such as claim drafting, foreign law, innocent infringer liability, and the desirability of a bright-line legal rule.¹⁶⁰ Overall, the policy arguments illustrate the disadvantages of a rigid test for joint infringement liability while acknowledging the need to protect innocent consumers from liability. All three opinions issued in *Akamai II* are consistent with these policy concerns.

1. *Bright-Line Rules Should Be Discouraged*

Akamai's brief discouraged the Federal Circuit from adopting a bright-line rule just because it would be easy to apply.¹⁶¹ The brief referenced recent Supreme Court decisions that discourage the adoption of rigid rules instead of more flexible guidelines.¹⁶² Accordingly, Akamai argued that a flexible joint infringement test comports with the Supreme Court's preference for flexible standards in lieu of bright-line rules.¹⁶³

Akamai argued that the test formulated in *Akamai I* (finding joint infringement if there is a master-servant or contractual relationship) cre-

155. *Id.*

156. See Opening En Banc Brief of Plaintiff-Appellant McKesson Technologies, Inc., McKesson Techs. Inc. v. Epic Sys. Corp., No. 2010-1291 (Fed. Cir. Jun. 20, 2011), 2011 WL 2822667.

157. *Id.* at 1.

158. Principal Brief for Plaintiff-Appellant Akamai Technologies, Inc. on Rehearing En Banc at 30-37, Akamai Techs., Inc. v. Limelight Networks, Inc., 692 F.3d 1301 (Fed. Cir. 2012) (Nos. 2009-1372, 2009-1380, 2009-1416, 2009-1417), 2011 WL 2822716.

159. Reply Brief for Plaintiff-Appellant Akamai Technologies, Inc. on Rehearing En Banc at 20-26, Akamai Techs., Inc. v. Limelight Networks, Inc., 692 F.3d 1301 (Fed. Cir. 2012) (Nos. 2009-1372, 2009-1380, 2009-1416, 2009-1417), 2011 WL 4438648.

160. *Id.*

161. *Id.* at 25.

162. *Id.*

163. *Id.* In *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007), for example, the Supreme Court rejected a rigid approach of using solely a "TSM test" for determining obviousness, noting that it may be a test for determining obviousness, but it was not the only test. See also *Bilski v. Kappos*, 130 S. Ct. 3218, 3225-26 (2010) (rejecting bright-line machine or transformation test for determining patentable subject matter); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392-93 (2006) (rejecting the Federal Circuit's bright-line grant of permanent injunctions when validity and infringement have been found); *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 65-67 (1998) (rejecting a bright-line rule that an invention cannot be "on sale" unless and until it is reduced to practice).

ated a loophole that devalues multi-participant claims.¹⁶⁴ To illustrate, Akamai noted that a recent legal strategy among in-house counsel was to structure contracts so that a “mastermind” is not identified.¹⁶⁵ Further, Akamai raised the *Golden Hour* case as an example of two companies who avoided infringement liability even though they were strategic partners and collaborated to sell the allegedly infringing product.¹⁶⁶ Akamai concluded, drawing from Judge Newman’s dissent in *McKesson*, that an unenforceable patent is essentially a grant of illusory rights.¹⁶⁷ Thus, it is no surprise that Judge Newman’s proposal in *Akamai II* is the least likely to resemble a bright-line rule.

2. Careful Claim Drafting Is Not a Cure-all

In response to the argument that most joint infringement issues could be addressed by proper claim drafting, Akamai asserted that using “wordsmithing” to draft claims directed to a single entity may be inconsistent with a patentee’s responsibility to clearly claim an invention.¹⁶⁸ Further, Akamai pointed to the claims at issue in the *Golden Hour* case as an example of claims directed to a single entity that still gave rise to joint infringement concerns.¹⁶⁹ That is, the defendants still managed to divide the steps among them.¹⁷⁰ Finally, Akamai argued that accurate claiming of multi-participant inventions requires multi-participant claims.¹⁷¹ In support of this assertion, Akamai’s reply brief gave examples of multi-participant claims from the biotechnology area including claims at issue in *Prometheus*, *Metabolite*, and *Myriad*.¹⁷² Thus, it is clear that

164. Principal Brief for Plaintiff-Appellant Akamai, *supra* note 158 at 33.

165. *Id.*

166. *Id.*; see also *Golden Hour Data Sys., Inc. v. emsCharts, Inc.*, 614 F.3d 1367, 1380–81 (Fed. Cir. 2010).

167. Principal Brief for Plaintiff-Appellant Akamai, *supra* note 158 at 34.

168. *Id.* at 35–36.

169. *Id.* at 36.

170. *Id.*

171. *Id.*

172. Amici Pharma, Bio, and Myriad provide other examples of multi-participant claims. Myriad, for example, notes that the Court’s current rule will be “devastating in personalized medicines” and points to two cases as evidence, *Prometheus Laboratories, Inc. v. Mayo Collaborative Services*, and *Metabolite Laboratories, Inc. v. Laboratory Corp. of America Holdings*, (“*LabCorp*”). Both *Prometheus* and *LabCorp* involve claims with steps routinely performed by two different parties, a doctor and a laboratory, where it is the correlation between these steps that constitutes the invention[.] Further, as noted by Myriad, “the USPTO currently interprets 35 U.S.C. § 101 and *Bilski v. Kappos* to require the explicit recitation of a transformative step (e.g., the ‘determining’ step and/or the ‘administering’ step). In other words, the claims in *Prometheus* and *LabCorp* could not have been drafted better and still survived examination.”

Similarly, in the biotechnology field, the efficacy of certain drug treatments has been linked to biomarkers. This allows, for example, patients taking oncology drugs to save precious time by undergoing treatments that will be more effective for them. But, because these drugs were previously used to treat the general population, the addition of an assay step—necessarily performed by a *different* party from that administering the drug—is needed to

Akamai made a significant effort to illuminate broader policy issues related to claim drafting and new technologies such as personalized medicine and Internet-Age inventions. Further, although the test described in each opinion operates differently, it is clear that as a whole, the Federal Circuit recognizes that there must be an avenue of enforcement of or multi-participant claims.

2. *Protect the Innocent and Conform with Foreign Law*

Akamai also argued that an innocent infringer would not be liable for infringement under any one of a “direction-or-control” theory, an “acting-in-concert” theory, or a “knowingly-combine-to-perform-the-steps” theory. Akamai explained that under traditional common law, a party that acted innocently or unknowingly may not necessarily be liable.¹⁷³ Accordingly, Akamai concluded that there is no risk that an innocent actor would be liable for patent infringement under any of its proposed tests.¹⁷⁴ Finally, Akamai quickly dismissed the notion that innocent actors would be ensnared by their proposed joint infringement standard by reiterating that an innocent actor would not be liable for infringement unless they performed claimed steps with the knowledge that other steps were being performed.¹⁷⁵ By using inducement, the majority opinion in *Akamai II* imposed a similar knowledge requirement.¹⁷⁶

Akamai’s brief also acknowledged that consumer liability is a risk in patent law.¹⁷⁷ But, there is generally not a reason for patentees to sue consumers.¹⁷⁸ In cases where consumers are sued, Akamai argued that courts would likely protect consumers committing *de minimus* acts of infringement by imposing little to no damages.¹⁷⁹ Finally, Akamai concluded that consumer defendants, characterized as permissive parties, do not have to be named in a lawsuit.¹⁸⁰

With respect to foreign law, Akamai argued that current U.S. law was inconsistent with foreign law.¹⁸¹ In support of this assertion, the brief mentioned two theories used in the U.K. and Japan that apply to joint infringement.¹⁸² In Japan, where the purchaser carries out the final step

confer patentability. Otherwise, the claims would likely be inherently anticipated. There is no basis for essentially disallowing patents on such inventions by making it difficult if not impossible to impose liability for joint infringers of the claimed method.

Reply Brief for Plaintiff-Appellant Akamai, *supra* note 159 at 22–24 (internal citations omitted).

173. Principal Brief for Plaintiff-Appellant Akamai, *supra* note 158 at 37.

174. *Id.* at 38.

175. *Id.* at 24.

176. *Akamai Techs., Inc., v. Limelight Networks, Inc.*, 692 F.3d 1301, 1318 (Fed. Cir. 2012).

177. Principal Brief for Plaintiff-Appellant Akamai, *supra* note 158, at 39.

178. *Id.*

179. *Id.* at 39–40.

180. *Id.* at 40.

181. Reply Brief for Plaintiff-Appellant Akamai, *supra* note 159, at 21.

182. *Id.*

as a “tool” of the vendor, Japanese courts have held the vendor liable for infringement.¹⁸³ Similarly, in the U.K., where there is evidence of a “common design” between parties, courts have found joint infringement.¹⁸⁴ The “common design” rule is analogous to the “joint enterprise” characterization introduced by Judge Linn in his *Akamai II* dissent.¹⁸⁵

In sum, this sub-Part described policy arguments made in the patent owners’ briefs. McKesson did not include policy arguments in its brief.¹⁸⁶ In contrast, Akamai’s principal brief and reply brief address several policy issues including claim drafting, foreign law, innocent infringer liability, and the desirability of a bright-line legal rule.¹⁸⁷ The policy arguments advocate for a flexible joint infringement standard that acknowledges the innate difficulties of claim drafting and still protects innocent consumers from liability. The next sub-Part will briefly discuss the policy arguments made by the defendants.

B. POLICY CONSIDERATIONS OF NON-PATENTEES AND COMPETITORS

The defendants’ brief also address some policy considerations from the perspective of non-patentees and competitors. For example, Limelight asserted that no legitimate policy concern will justify imposing liability for direct infringement when no party performs each step of the claimed method.¹⁸⁸ Both briefs touched on the public notice function, claim drafting, and the incentive to design around. In sum, the policy arguments made by the defendants argue for no change in the law and place the burden for crafting enforceable claims squarely on the patentee’s shoulders.

1. Preserving The Public Notice Function

Both *Epic* and *Limelight* relied on the idea that patent claims serve a public notice function to argue for a strict reading and interpretation of the claims at issue. Epic’s reply brief stated,

The public notice function of the patent system is designed to promote innovation and improvements in science and technology by granting a limited monopoly to a patent holder in exchange for the public disclosure of the invention that enables “one skilled in the art to practice the invention once the period of the monopoly has expired” and “to provide notice of the boundaries of the right to

183. *Id.*

184. *Id.*

185. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1338 (Fed. Cir. 2012).

186. See Opening En Banc Brief of Plaintiff-Appellant McKesson, *supra* note 156.

187. See Principal Brief for Plaintiff-Appellant Akamai, *supra* note 158; Reply Brief for Plaintiff-Appellant Akamai, *supra* note 159.

188. Brief of Defendant-Cross-Appellant Limelight Networks, Inc. on Rehearing En Banc at 52, *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301 (Fed. Cir. 2012) (Nos. 2009-1372, 2009-1380, 2009-1416, 2009-1417), 2011 WL 3796785.

exclude.”¹⁸⁹

Limelight emphasized that patent claims define the invention and put the inventor and public on notice of what they own.¹⁹⁰ Limelight further argued that the patentee should bear the cost of enforcement failure if a party achieves a desired result without infringing the patentee’s claims.¹⁹¹ Accordingly, Epic argued that McKesson should be held to the scope of its multi-party claims and not be allowed to trivialize any claim steps as less important than the other claimed steps.¹⁹²

2. *Claims Must Be Carefully Drafted*

Further, Epic argued that the public notice function should prevent courts from rewriting claims such as the ones asserted by McKesson.¹⁹³ Epic pointed out that McKesson could have written its claims so that they were directed to a single actor or pursued system claims that would have avoided a joint infringement analysis.¹⁹⁴ Limelight further asserted that meaningful protection for multi-party claims can be obtained if the claims are carefully drafted and directed toward a single entity.¹⁹⁵ In this instance, Limelight concluded that Akamai simply did not draft its claim to cover Limelight’s activities.¹⁹⁶

Akamai insists that it could have drafted its patent to cover a method that did not require affirmative performance of the tagging step by any party; in the ‘703 patent, however, it did not. . . . That is, while Akamai’s claim 34, as drafted, is infringed only if the defendant “tag[s] at least some of the embedded objects,” Akamai could instead have applied for a patent claiming “*supplying a tag for tagging at least some of the embedded objects.*”¹⁹⁷

Accordingly, Limelight argued that Akamai should not be allowed to claim a broader claim scope than it asked the PTO to examine and allow.

189. Defendant-Appellee’s Response to Plaintiff-Appellant’s Opening En Banc Brief at 40, *McKesson Techs. Inc. v. Epic Sys. Corp.*, No. 2010-1291 (Fed. Cir. Aug. 8, 2011), 2011 WL 3796780 (citing *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1349, 1364 (Fed. Cir. 2011)).

190. Brief of Defendant-Cross-Appellant Limelight, *supra* note 188, at 52. (“‘It is a bedrock principle of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude.’ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal quotation marks omitted). Enforcement of patents in conformity with their claims is ‘essential to promote progress, because it enables efficient investment in innovation. A patent holder should know what he owns, and the public should know what he does not.’ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730–31 (2002).”).

191. *Id.*

192. Defendant-Appellees Response, Epic, *supra* note 189, at 39.

193. *Id.* at 40.

194. *Id.* at 41.

195. Brief of Defendant-Cross-Appellant Limelight, *supra* note 188, at 54–55.

196. *Id.* at 55.

197. *Id.* (internal citations omitted).

3. *Statutory Construction and the Incentive to Design Around*

The defendants' briefs also addressed the language of the statute and the incentive to design around a patent. In response to Akamai's argument that the test put forth in *Akamai* would encourage business models designed to misappropriate technology, Limelight pointed out that one of the fundamental practices in patent law is the attempt by competitors to design around the patent.¹⁹⁸ Thus, Limelight concluded that Akamai's complaint lacked merit, and designing around patents was in fact just the nature of patent law and competition in this country.¹⁹⁹ Epic argued in its reply brief that Congress has not modified § 271(a) to contemplate multiple actors.²⁰⁰ This argument mirrors the one the majority made in *Akamai II*. There, the majority opined that if Congress had wanted to change the infringement statute to directly address the joint infringement issue, it had the opportunity during its work on the America Invents Act.²⁰¹

This sub-Part described policy arguments made in the defendants' briefs. The Defendant's briefs focused on the benefits of clear claim drafting to the patent system. Overall, the policy arguments made by the defendants place the burden for crafting enforceable claims on the patentee without concern for the difficulties that accompany drafting claims for multi-party inventions. The next Part will discuss the policy arguments made in some of the key Amicus briefs.

V. THE POLICY PERSPECTIVES OF THE AMICUS BRIEFS

Several companies and organizations filed Amicus briefs in *Akamai II*. The amici were in the position to make broader and more substantive policy arguments than the litigants—and did so. This Part details some of the major policy concerns addressed by the amici. It is difficult to discern what the overall impact the amici's policy arguments had on the outcome of *Akamai II*. However, a few of the policy concerns addressed by the amicus briefs were present as thematic notes in the Federal Circuit's opinion.

A. TECHNOLOGICAL IMPACT

Many amici from the personalized medicine and computer industry were motivated to submit briefs. The rationale for submitting briefs was generally related to the author's industry or specifics related to the services and products they offered. For example, Thomson Reuters stated that it operates businesses in the information technology, software,

198. *Id.* at 54.

199. *Id.*

200. Defendant-Appellee's Response, *supra* note 189, at 37–38.

201. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1343 (Fed. Cir. 2012).

networking, communications, computer and Internet industries.²⁰² Thomson Reuters further explained that their services depend on working with third parties to transfer information.²⁰³ A brief authored by Cisco, Dell, eBay, Google, HP, Intel and others (the Cisco brief) stated that they were frequently targeted by litigious patentees with poorly drafted claims.²⁰⁴ Accordingly, one policy function of the amicus briefs was to educate the Federal Circuit about the specific technology areas affected by their decision.

B. THE PATENTEE AS THE LEAST-COST AVOIDER

Within these specific technology areas, amici argued that the patentee is the least-cost avoider. For example, in a brief authored by the Electronic Frontier Foundation (EFF), the EFF made a policy argument about the least-cost avoider in the patent system—that is, which party (the patentee or other non-patentee) should bear the burden of avoiding harm. Written in support of the defendant, the EFF brief concluded overwhelmingly that the patentee is the least-cost avoider.²⁰⁵

The EFF brief listed a few reasons why the patentee is the least-cost avoider. First, the brief asserted that the patentee bears the burden of defining the scope of their rights with proper claims.²⁰⁶ This argument ties in with one of the central premises of the defendants' argument that most joint infringement issues can be avoided by proper claim drafting. Second, EFF argued that a patentee bears the burden of monitoring and suing for infringement.²⁰⁷ Having squarely defined the patentees' obligations, the brief then addressed the obligations of non-patentees, i.e., third parties.

Concerning non-patentees, the EFF brief identified two different types of actors, each with their own burden.²⁰⁸ Generally, these two actors are (1) parties affirmatively seeking to use potentially patented technology and (2) "innocent" third parties.²⁰⁹ The EFF acknowledged that users bear the burden of seeking a license to use patented technology.²¹⁰ However, the EFF stated that allowing parties to be found liable for infringement for performing less than the full combination of claimed steps

202. Brief of Amicus Curiae Thomson Reuters Corp. in Support of Defendant-Cross-Appellant Limelight Networks, Inc. and Supporting Affirmance at 1, *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301 (Fed. Cir. 2012) (Nos. 2009-1372, 2009-1380, 2009-1416, 2009-1417), 2011 WL 4071505.

203. *Id.*

204. Corrected Brief of Amici Curiae Cisco Systems, Inc. et al. in Support of Defendant-Cross-Appellant at 1, *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301 (Fed. Cir. 2012) (Nos. 2009-1372, 2009-1380, 2009-1416, 2009-1417) 2011 WL 4438649.

205. Brief of Amicus Curiae Electronic Frontier Foundation in Support of Defendant at 3-4, *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301 (Fed. Cir. 2012) (Nos. 2009-1372, 2009-1380, 2009-1416, 2009-1417), 2011 WL 3796789.

206. *Id.* at 17.

207. *Id.* at 16.

208. *Id.* at 16-18.

209. *Id.*

210. *Id.* at 16.

impermissibly shifts the burden and risk of avoiding infringement from the patentee to the third party.²¹¹

In sum, the EFF concluded that patentees are the least-cost avoiders and bear the risk of avoiding harm.²¹² Although users bear the burden of seeking licenses, the patentee's initial responsibility is to define the invention. If the patentee does this effectively, the EFF concluded that the risk of avoiding infringement will not unfairly fall on third parties.²¹³ While both the majority opinion and Judge Linn's dissent seem to agree with this basic premise, neither is clearly ready to absolve third parties of all liability. This view possibly reflects the Federal Circuit's concern with the results of joint infringement litigation in district courts discussed in other amicus briefs.

C. DISTURBING TRENDS AT THE DISTRICT COURT LEVEL

Amici highlighted that it was incredibly difficult to find a party liable for joint infringement at the district court level. Specifically, a brief, authored by Cascades Ventures, Inc. and VNS Corporation, focused on the impact that the "control or direction" test, established in *BMC Resources*, had on the outcome of other joint infringement cases. The brief pointed out that the Federal Circuit had not affirmed a district court finding of liability under the "control or direction" test.²¹⁴ Although by no means determinative, the authors used this fact to suggest that something is wrong with the "control or direction" test and the Federal Circuit's current direction. This suggests that a "good" test would have yielded at least one result where liability is found, and that *BMC Resource's* "control or direction" calculus is not such a test. Perhaps the majority's partial inducement test is an attempt to create a passable test. Judge Linn's dissent and his formulation of a joint enterprise determination also seem to respond to this concern. Specifically, Judge Linn noted that the *Golden Hour* case would have had a different outcome (a finding of infringement) under his test.

D. IMPACT ON PATENTS

In addition to the district courts, amici also discussed the impact of joint infringement concerns on how patents were written. The Federal Circuit routinely considers the impact of its decisions on other patents.²¹⁵ Accordingly, the amicus briefs also discussed what impact the en banc panel's ruling would have on other patents. Several of the amicus briefs in support of the defendants argued that enforcement of multi-actor claims

211. *Id.* at 17–18.

212. *Id.* at 3–4.

213. *Id.* at 17–18.

214. Amicus Curiae Brief of Cascades Ventures, Inc. and VNS Corp. in Support of Plaintiffs-Appellants and in Support of Reversal at 6, *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301 (Fed. Cir. 2012) (Nos. 2009-1372, 2009-1380, 2009-1416, 2009-1417), 2011 WL 2323820.

215. Corrected Brief of Amici Curiae Cisco Systems, Inc. et al., *supra* note 204, at 4.

should be extremely limited. For example, The Cisco brief argued that expanding joint infringement liability would encourage more multi-actor claims in order to ensnare more parties in litigation.²¹⁶ In contrast, the amicus briefs in support of the plaintiffs argued for more liberal enforcement of multi-actor claims. For example, the Cascades Ventures brief argued that existing method and process patents call for steps that must be performed by more than one entity.²¹⁷ As a result, the panel decision in *Akamai* made it impossible for these existing patents to be infringed.²¹⁸ Further, the brief quoted one of Newman's policy arguments from her dissent in *McKesson*, and reiterated in *Akamai II*, for the idea that a patent that cannot be infringed is not a patent under the law since it does not afford its owner the right to exclude.²¹⁹ Thus the overall policy concern expressed to the Federal Circuit was how to balance the interest of patentees of multi-actor claims with the concerns of commercial actors.

E. IMPACT ON LITIGATION AND COMMERCE

Excessive patent litigation is a common complaint of commercial actors, and its impact on commerce was also touched upon in the briefs. Most of the amici supporting the defendants were concerned with the impact the ruling will have on patent litigation. Their briefs favored bright-line rules over the flexible tests proposed by the plaintiffs. Thomson warned that the inducement and concerted action test proposed by the plaintiffs were not bright-line rules.²²⁰ Further, Thomson argued that flexible standards as proposed by *Akamai* complicated the analysis for companies—requiring analysis of what claimed steps were performed and the relationship between actors that performed the steps.²²¹ Accordingly, Thomson argued that *Akamai*'s test would increase the cost, complexity, and the amount of litigation.²²²

In defense of the control or direction test, Thompson argued that *Akamai*'s proposed rule would complicate negotiations between vendors or service providers.²²³ For example, in a case where a vendor wants to keep their methods a secret, it is possible that these unknown methods may expose its partners to infringement liability.²²⁴ Thus, to avoid infringement, a vendor may need to negotiate the disclosure of proprietary methods and technology. Further, EFF argued that holding "downstream users" of technology liable for infringement would not spur innovation.²²⁵

Both sides seemed to agree with a central premise that the patent sys-

216. *Id.* at 1382.

217. *Id.* at 11.

218. *Id.* at 11–12.

219. *Id.* at 7.

220. Brief of Amicus Curiae Thomson Reuters Corp., *supra* note 202, at 15.

221. *Id.* at 16.

222. *Id.*

223. *Id.* at 10–11.

224. *Id.* at 11.

225. Brief of Amicus Curiae Electronic Frontier Foundation, *supra* note 205, at 5–6.

tem should not impede commerce.²²⁶ However, the amici disagreed as to which legal rule would best support this goal. For example, the Cascade Ventures brief argued that the current law allows companies like Teva Pharmaceutical Industries to use exploitation of the loophole as a lucrative business model.²²⁷ All three opinions of the Federal Circuit seem to be responding to this concern, but in different ways. Judge Newman wanted to do away with the loophole completely.²²⁸ Judge Linn wanted to expand “control or direction” to include activities by a joint enterprise,²²⁹ and the majority held that there was liability if there was partial inducement.²³⁰

F. PUBLIC NOTICE

Another way patent policy attempts to avoid excessive litigation and spur commerce is through the public notice function. Specifically, the public notice function of a patent helps third parties and patent owners avoid uncertainty as to the patentees’ rights.²³¹ Certainty as to what ideas are free to develop promotes commercialization of innovative products.²³² Thus, the public notice function of patents allows businesses to conduct activities knowing that their actions or products or both will not infringe others’ patents.²³³

Thomson argued that if liability is imposed in the aggregate for third parties acting “in concert,” then it is difficult for third parties to judge and control risk.²³⁴ Multi-party liability would disincentivize patent owners from engaging in third party transactions.²³⁵

Further, the Cisco brief asserted that analyzing infringement allegations would become more costly if the standard proposed by Akamai was adopted.²³⁶ Akamai’s proposed test would involve not only analyzing whether the alleged infringer performed a step but also whether independent third parties performed a step.²³⁷ Under Akamai’s proposed test, businesses like Thomson would have to evaluate their actions—as well as those of numerous unaffiliated entities, which would severely undermine the public notice function.²³⁸

Most of the judge’s views on the Federal Circuit are consistent with the public notice function. Judge Linn’s proposed test would not require a

226. Corrected Brief of Amici Curiae Cisco Systems, Inc. et al., *supra* note 204, at 2–3.

227. Amicus Curiae Brief of Cascades Ventures, Inc. et al., *supra* note 214, at 13.

228. Akamai Techs., Inc. v. Limelight Networks, Inc., 692 F.3d 1301, 1319 (Fed. Cir. 2012).

229. *Id.* at 1337–38.

230. *Id.* at 1308.

231. Brief of Amicus Curiae Electronic Frontier Foundation, *supra* note 205, at 8.

232. *Id.*

233. Brief of Amicus Curiae Thomson Reuters Corp., *supra* note 202, at 8.

234. *Id.* at 10.

235. *Id.* at 11.

236. Corrected Brief of Amici Curiae Cisco Systems, Inc. et al, *supra* note 204, at 10.

237. *Id.*

238. Brief of Amicus Curiae Thomson Reuters Corp., *supra* note 202, at 9.

company to monitor the activities of actors it was unfamiliar with. Further, the majority's partial inducement rule would also limit the amount of third party activity a service provider would have to monitor.

G. CLAIM DRAFTING

Another issue that is closely related to the public notice function is whether joint infringement issues can be addressed by proper claim drafting. In its brief, Cascade Ventures argued that proper claim drafting is not a cure-all. First, an inventor cannot predict which step of a method claim may be farmed out to another company.²³⁹ Second, Cascade Ventures argued that most issued patents could not be corrected to meet the tests proposed for joint infringement liability in *BMC Resources*, *Muniauction*, and *Akamai I*.²⁴⁰ Cascade Ventures also argued that prior Federal Circuit precedent made any claim where the user is required to perform a step virtually impossible to cover with a method claim.²⁴¹ Specifically, a claim that requires a user to interact with a cell phone or computer could not be enforced²⁴² because users are neither contractually obligated agents of the manufacturer, nor directed or controlled to perform the claimed step.²⁴³ Accordingly, several amici concluded that simply encouraging patentees to write better claims would not be enough to alleviate the controversy over joint infringement liability.

In contrast, the Cisco brief explained that the claim drafting issue is well known to the patent bar and cited Hal Wegner's lecture on claim drafting as an example of this awareness.²⁴⁴ Specifically, the Cisco brief argued that patentees have been on notice since the *Aro Manufacturing* and *DeepSouth* cases that claims must be directed to cover the activity of one entity.²⁴⁵ The simplest solution to the problem is careful claim drafting that will avoid joint infringement issues and put parties on notice of potential infringement.²⁴⁶ Accordingly, Cisco's brief asserted that "[c]laim drafting can solve virtually all of the issues raised by Akamai."²⁴⁷ For example, the Cisco brief said that the tagging step in the asserted Akamai claim could have been rewritten to say "for a given page normally served from the content provider domain, (receiving at the server at least some tagged) the embedded objects of the page so that requests for the objects resolve to the domain instead of the content provider domain."²⁴⁸

239. Amicus Curiae Brief of Cascades Ventures, Inc. et al., *supra* note 214, at 15.

240. *Id.* at 15–16.

241. *Id.* at 11.

242. *Id.* at 14.

243. *Id.*

244. Corrected Brief of Amici Curiae Cisco Systems, Inc. et al., *supra* note 204, at 8.

245. *Id.*

246. Brief of Amicus Curiae Electronic Frontier Foundation, *supra* note 205, at 3.

247. *Id.* at 8–9.

248. *Id.* at 11.

Overall, Amici in support of the defendants argued that it was the patentee's responsibility to draft clear claims that could be infringed by a single entity. Further, bad claims should not be enforced. These Amici asserted that not enforcing patents with bad claims will force patentees to write better claims.²⁴⁹ For example, EFF referred to the *Chef America, Inc. v. Lamb-Weston, Inc.* case to argue that there is nothing bad about patents not being enforceable against defendants. There, the court refused to correct a drafting error that resulted in a finding of non-infringement.²⁵⁰ Accordingly, amici in support of the defendants asserted that the patentee solely responsible for determining the scope of its rights by drafting claims that set out the scope of infringing activity.²⁵¹

The Federal Circuit's policy that it will not redraft claims for policy reasons is longstanding. Despite this fact, it is clear that most judges on the Federal Circuit are somewhat sympathetic to the complex claim drafting issues that are raised by joint infringement liability. Judge Newman argued that the number of infringers of a claim should not matter. Judge Linn argued to expand infringement liability to capture infringers engaged in a joint enterprise. Finally, the majority's introduction of a partial inducement rule was likely due to an attempt to preserve the public notice function of claim language while imposing a flexible test that is more workable for personalized medicine and Internet-Age patentees.

VI. CONCLUSION

Policy concerns can play an enhanced role in patent infringement cases where the law is unclear or new technology is at issue. Technology such as personalized medicine and Internet-age technologies may trigger joint infringement issues. Joint infringement is a doctrine that attempts to explain how to allocate liability where more than one entity performs the steps of a method claim such that the entities' performance in the aggregate infringes the claimed method. The Federal Circuit has continued to modify the doctrine in several cases since 2007.²⁵² *Akamai II* is the culmination of four major joint infringement cases heard at the Federal Circuit.²⁵³ As a result, a number of amici filed briefs in the case—many of which highlighted the unique policy issues at stake.

This article concludes that the opinions issued in *Akamai II* suggest that most of the judges on the en banc panel were sympathetic to the policy concerns raised by the plaintiffs and their amici. However, the frac-

249. *Id.* at 16.

250. *Id.* at 14.

251. *Id.* at 7.

252. See W. Keith Robinson, *Ramifications of Joint Infringement Theory on Emerging Technology Patents*, 18 TEX. INTELL. PROP. L. J. 335 (2010); W. Keith Robinson, *No "Direction" Home: An Alternative Approach to Joint Infringement*, 62 AM. U. L. REV. 59 (2012).

253. See generally *McKesson Techs. Inc. v. Epic Sys. Corp.*, 98 U.S.P.Q.2d. (BNA) 1281 (Fed. Civ. 2011); *Akamai I*, 629 F.3d 1311 (Fed. Cir. 2010 (per curiam)); *Muniauction Inc. v. Thomson Corp.*, 532 F.3d 1318 (Fed. Cir. 2008); *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007).

tured decision illustrates the judges' inability to come to a consensus on what it means for a multi-party claim to be directly infringed. Specifically, the Federal Circuit was torn between a formalistic approach and a measured approach that expresses some policy preference for either a change in the law or a change in how the law is interpreted. Thus, while there is no way to ascertain whether any policy argument had a direct effect on the outcome of the case, the result in *Akamai II* is a clear example of the uncertainty caused when a loophole in the patent statute forces the court into the role of policy maker.