

## Federal Circuit Holds That Parent Company May Not Recover Lost Profits of Subsidiary in Infringement Action

### 联邦法院裁定

### 母公司可能无法获得子公司因侵权行为导致利润损失的赔偿

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The United States Court of Appeals for the Federal Circuit recently held that a parent company may not recover the lost profits of a wholly owned subsidiary as damages in a patent infringement action, because the parent could not prove that the subsidiary's profits from the diverted sales would have "inexorably flowed" to the parent. *Mars, Inc. v. Coin Acceptors, Inc.*, Nos. 07-1409, 07-1436, 2008 WL 2229783 (Fed. Cir. June 2, 2008). Thus, when one entity in a corporate family holds the patent rights, and another entity sells the products covered by the patent, the patent-holding entity is unlikely to be able to recover the "lost profits" of the entity that sold the relevant products. The Federal Circuit noted, however, that other bases for damages **above** "reasonable royalty" damages may be appropriate. *Mars* at \*5.

在 *Mars, Inc. v. Coin Acceptors, Inc.*, Nos. 07-1409, 07-1436, 2008 WL 2229783 (Fed. Cir. June 2, 2008)一案中，美国联邦巡回上诉法院最近裁定，母公司可能无法从其全资子公司因专利侵权行为所致的利润损失中获得赔付，因为母公司不能证明其全资子公司从该销售中获取的利润“无情地流入”母公司。因此，当公司家族中的一家实体拥有专利权而另一家实体销售为该专利所覆盖的产品时，持有专利的实体不太可能从售卖相关产品的实体的“损失利润”中得到赔付。但是，联邦法院注意到，**超过**“合理许可费”的其它赔偿金计算基础可以是恰当的。

The *Mars* case originated in the United States District Court for the District of New Jersey. Mars alleged that Coin Acceptors, Inc. (Coinco) infringed two patents relating to technology for authenticating coins used in vending machines. After trial, the district court found Coinco infringed both patents.

*Mars* 一案最早由新泽西联邦地区法院审理。Mars 诉称，Coin Acceptors 公司 (下称 Coinco) 侵犯了其两项涉及售货机中使用的硬币识别技术的专利。经过审理，该地区法院认为 Coinco 侵犯了这两项专利。

During the damages proceedings, Mars sought the lost profits of its wholly owned subsidiary, Mars Electronics International (MEI). Mars had earlier granted a nonexclusive license to MEI in exchange for royalty payments based on MEI's sales of coin vending machines. Mars itself did not make or sell any vending machines covered by the patents.

在赔偿金计算过程中，Mars 试图获得其全资子公司 Mars Electronics International (下称 MEI) 的利润损失。Mars 之前给予 MEI 非独占许可，根据 MEI 硬币售货机的销售量来计算许可费。Mars 本身不制造或者销售任何为该专利覆盖的售货机。

The district court held that Mars was not able to recover lost profits, because Mars did not sell the relevant products and Mars only had a licensing relationship with MEI. The court did not recognize the lost licensing revenues as “lost profits” and, importantly, did not allow Mars to recover any of MEI's lost profits. MEI was maintained as a separate corporation from Mars, and profits from MEI did not inexorably flow to Mars. Therefore, Mars could not claim MEI's lost profits as its own. In so holding, the court relied on *Poly-America, L.P. v. GSE Lining Technology, Inc.*, 383 F.3d 1303 (Fed. Cir. 2004)—a case in which the Federal Circuit held a plaintiff may not recover the lost profits of a sister corporation.

地区法院判定，Mars 不能获得这些利润损失，因为它不销售相关产品，而且它与 MEI 之间仅限于许可关系。地区法院没有认为损失的许可收益就是“利润损失”，并且重要的是，它没有允许 Mars 获得 MEI 的任何利润损失。MEI 是独立于 Mars 的公司，MEI 的利润并没有无情地归于 Mars 所有。因此，Mars 不能主张 MEI 的利润损失是自己的。法院引用 *Poly-America, L.P. v. GSE Lining Technology, Inc.*, 383 F.3d 1303 (Fed. Cir. 2004) 一案做出判决，该案中联邦巡回法院判定原告可能不会从其姊妹公司的利润损失中获得补偿。

A unanimous panel of the Federal Circuit affirmed this portion of the district court's order, because the court agreed that MEI's profits did not flow inexorably to Mars. The Federal Circuit acknowledged that MEI's lost sales may have caused other financial harm to Mars in addition to recoverable royalties, but Mars only sought lost profits and reasonable royalties as damages. *Mars* at \*5 (“We have previously recognized that patentees may be entitled to damages above a reasonable royalty on theories entirely distinct from lost profits.”).

联邦巡回法院合议庭全体维持了地区法院判决的这一部分决定，因为地区法院同意 MEI 的利润没有无情地流入 Mars 的怀抱。联邦巡回法院承认，除了可获赔的许可费外，MEI 损失的销售可能还会对 Mars 造成其它财政损害。（我们之前已经认为，根据与损失利润完全不同的理论，专利权人可以获得超过合理许可费的赔偿）。

The *Mars* decision shows that the allocation of intellectual property in an organization's structure can affect recovery of damages. The decision is also a reminder that lost profits and reasonable royalty damages are not the only available forms of damages for patent infringement. Owners of intellectual property should assess whether potential recoveries for infringement are limited by the current allocation of intellectual property.

*Mars* 决定表明，在一个组织机构中知识产权的分配能够影响赔偿金的获得。该决定还提醒，损失利润与合理许可费赔偿不是专利侵权的唯一赔偿模式。知识产权所有人应当评估，现有的知识产权分配是否对潜在的侵权赔偿构成限制。

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