

Wiley Nonprofit Authority

5TH EDITION

INTELLECTUAL PROPERTY

VALUATION, EXPLOITATION, AND
INFRINGEMENT DAMAGES

2022 CUMULATIVE SUPPLEMENT

YURIDIA CAIRE
AND
RUSSELL L. PARR

WILEY

INTELLECTUAL PROPERTY



Subscriber Update Service

BECOME A SUBSCRIBER!

Did you purchase this product from a bookstore?

If you did, it's important for you to become a subscriber. John Wiley & Sons, Inc. may publish, on a periodic basis, supplements and new editions to reflect the latest changes in the subject matter that you **need to know** in order to stay competitive in this ever-changing industry. By contacting the Wiley office nearest you, you'll receive any current update at no additional charge. In addition, you'll receive future updates and revised or related volumes on a 30-day examination review.

If you purchased this product directly from John Wiley & Sons, Inc., we have already recorded your subscription for this update service.

To become a subscriber, please call **1-877-762-2974** or send your name, company name (if applicable), address, and the title of the product to:

mailing address: **Supplement Department**
 John Wiley & Sons, Inc.
 10475 Crosspoint Blvd.
 Indianapolis, IN 46256

e-mail: **subscriber@wiley.com**
fax: **1-800-605-2665**
online: **www.wiley.com**

For customers outside the United States, please contact the Wiley office nearest you:

Professional & Reference Division
John Wiley & Sons Canada, Ltd.
90 Eglinton Ave. E. Suite 300
Toronto, Ontario M4P 2Y3
Canada
Phone: 416-236-4433
Phone: 1-800-567-4797
Fax: 416-236-8743
Email: canada@wiley.com

John Wiley & Sons, Ltd.
European Distribution Centre
New Era Estate
Oldlands Way
Bognor Regis, West Sussex
PO22 9NQ, UK
Phone: (0)1243 779777
Fax: (0)1243 843 123
Email: customer@wiley.co.uk

John Wiley & Sons Australia, Ltd.
42 McDougall Street
Milton, Queensland 4064
AUSTRALIA
Phone: 61-7-3859-9755
Fax: 61-7-3859-9715
Email: aus-custservice@wiley.com

John Wiley & Sons (Asia) Pte., Ltd.
1 Fusionopolis Walk
#07-01 Solaris South Tower
SINGAPORE 138628
Phone: 65-6302-9838
Fax: 65-6265-1782
Customer Service: 65-6302-9800
Email: asiacart@wiley.com

5TH EDITION

INTELLECTUAL PROPERTY

VALUATION, EXPLOITATION, AND
INFRINGEMENT DAMAGES

2022 CUMULATIVE SUPPLEMENT

YURIDIA CAIRE
AND
RUSSELL L. PARR

WILEY

Copyright © 2022 by John Wiley & Sons, Inc. All rights reserved.

Published by John Wiley & Sons, Inc., Hoboken, New Jersey.

Published simultaneously in Canada.

No part of this publication may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, electronic, mechanical, photocopying, recording, scanning, or otherwise, except as permitted under Section 107 or 108 of the 1976 United States Copyright Act, without either the prior written permission of the Publisher, or authorization through payment of the appropriate per-copy fee to the Copyright Clearance Center, Inc., 222 Rosewood Drive, Danvers, MA 01923, (978) 750-8400, fax (978) 750-4470, or on the web at www.copyright.com. Requests to the Publisher for permission should be addressed to the Permissions Department, John Wiley & Sons, Inc., 111 River Street, Hoboken, NJ 07030, (201) 748-6011, fax (201) 748-6008, or online at <http://www.wiley.com/go/permission>.

Limit of Liability/Disclaimer of Warranty: While the publisher and author have used their best efforts in preparing this book, they make no representations or warranties with respect to the accuracy or completeness of the contents of this book and specifically disclaim any implied warranties of merchantability or fitness for a particular purpose. No warranty may be created or extended by sales representatives or written sales materials. The advice and strategies contained herein may not be suitable for your situation. You should consult with a professional where appropriate. Further, readers should be aware that websites listed in this work may have changed or disappeared between when this work was written and when it is read. Neither the publisher nor authors shall be liable for any loss of profit or any other commercial damages, including but not limited to special, incidental, consequential, or other damages.

For general information on our other products and services or for technical support, please contact our Customer Care Department within the United States at (800) 762-2974, outside the United States at (317) 572-3993 or fax (317) 572-4002.

Wiley also publishes its books in a variety of electronic formats. Some content that appears in print may not be available in electronic formats. For more information about Wiley products, visit our web site at www.wiley.com.

Library of Congress Cataloging-in-Publication Data is Available:

ISBN: 9781119356219 (main edition)

ISBN: 9781119873594 (paperback)

ISBN: 9781119873617 (ePub)

ISBN: 9781119873624 (ePDF)

Cover Design: Wiley

CONTENTS

ABOUT THE AUTHORS	vii
CHAPTER 13A EXPLOITATION STRATEGIES	1
CHAPTER 28A ROYALTY RATES AND THE <i>GEORGIA-PACIFIC</i> FACTORS	27
CHAPTER 29A EVOLVING PATENT DAMAGES	51
CHAPTER 30A TRADEMARK, COPYRIGHT, AND TRADE SECRET DAMAGES	75
INDEX	79

ABOUT THE AUTHORS

Yuridia Caire is a senior associate for Kramer Levin Naftalis & Frankel in the Intellectual Property group. With a master of science in chemistry and strong expertise in intellectual property disputes, as well as a minor in mathematics, she has over 12 years of experience as a trusted advisor on various intellectual property issues. She graduated from the University of Texas at Austin, School of Law, University of Notre Dame, and the University of Texas at El Paso. She also completed the George Washington University Law School Munich Intellectual Property Summer Program and Fashion Law Bootcamp, offered through the Fashion Law Institute. She has received recognition for her outstanding pro bono contributions and was named to the Best Lawyers List for 2021, Ones to Watch. She is a trial lawyer who litigates intellectual property cases involving complex technology, with a particular emphasis on computer science, chemistry, and the life sciences. Yuridia litigates patent infringement actions in federal district courts across the country, both representing patent owners seeking to enforce their rights and defending companies against allegations of infringement. Her recent litigation work includes patent infringement actions in the Eastern District of Texas, the Central, Southern, and Northern Districts of California, Eastern District of Virginia, and the District of Delaware. She also handles proceedings before the U.S. Patent and Trademark Office.

Yuridia's work involves all aspects of litigation. She also provides infringement analyses, advises clients on intellectual property licensing patent valuations, and transactional matters, and assists

clients in entity formation, partnering agreements, employment and inventor agreements, negotiation and structuring of license agreements, due diligence, and general corporate matters.

Yuridia was part of the trial team that represented Centripetal Networks, Inc., in U.S. District Court for the Eastern District of Virginia. The case is noted as the first-ever virtual federal trial, after a nearly eight-week bench trial, and the largest patent verdict ever, guaranteeing the client a minimum of \$2.65 billion and a maximum of \$3.25 billion based on the running royalty for the next six years.

Yuridia also handled various aspects of multi-patent litigations in the Northern District of California involving antivirus software and computer products for client Finjan, Inc., including cases against Sophos, Inc., which resulted in a jury verdict of \$15 million, and Blue Coat, Inc., which resulted in one of the Daily Journal's Top Verdicts of 2015, with a \$40 million jury verdict. Yuridia has also secured a preliminary injunction and temporary restraining order for a defendant in a copyright litigation in the Northern District of California and obtained favorable outcomes for clients in trademark matters.

In addition to her work on behalf of clients, Yuridia dedicates significant time to pro bono matters, volunteering with the Legal Aid Society of San Mateo County, serving for several years on its Golf Committee and providing legal assistance at its Housing Clinic, and representing clients of the Community Legal Services in East Palo Alto in securing favorable outcomes at mandatory settlement conferences. Yuridia has also represented pro bono clients in immigration, conservatorship, guardianship, liens, contract, and refugee resettlement matters. Yuridia's publications include articles regarding criminal intellectual property and trademark cases, entitled "Changes to the Enforcement of Intellectual Property Crimes," and "From the Red Carpet to Red Soles."

Russell L. Parr is president of IPRA, Inc. He is an expert at determining the value and royalty rate pricing of intellectual property.