

Statement of

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Mr. Chairman and Members of the Subcommittee:

My name is Jay Thomas. I currently serve on the law faculty of the Georgetown University. I am honored to have the opportunity to testify at this hearing in my individual capacity, as a concerned observer of the patent system.

This subcommittee deserves congratulations for its perseverance in its efforts to reform the legal regime that is widely regarded as America's engine of innovation. Many of the provisions of H.R. 2795 have been the subject of serious discussion since the publication of the Report of the President's Commission on the Patent System—which was issued in 1966 at the request of the Johnson administration. Your leadership in advancing these reforms has been remarkable, and we remain confident that you will achieve a bill that will balance the interests of patent owners, innovative industry, and the public alike.

I. Apportionment of Damages

Pending legislation would address the award of damages where the patented invention forms but one component of the infringer's larger commercial product or process. Section 6 of both the July 26, 2005, substitute to H.R. 2795, as well as the proposal of September 1st, are directed towards perceived concerns about overly generous damages awards in this context. Generally speaking, they both call for the apportionment of infringement damages in a manner that takes into account the infringer's own contributions. The proposed language derives in part from the seminal 1970 opinion of the federal district court in *Georgia-Pacific Corp. v. United States Plywood Corp.*,¹ which has in turn been frequently relied upon by the Federal Circuit.²

Given that this general concept of apportionment has been part of the patent law for at least

¹318 F. Supp. 1116 (S.D.N.Y. 1970).

²*See, e.g., Imonex Servs., Inc. v. W.H. Munzprufer Dietmar Trenner GmbH*, 408 F.3d 1374 (Fed. Cir. 2005).

