ORAL ORDER: The Court, having reviewed Defendant's motion for summary judgment that Plaintiff is not entitled to pre-suit damages for the 752 patent because Plaintiff lacks sufficient evidence to show compliance with the marking statute ("Motion"), (D.I. 350), and the briefing related thereto, (D.I. 353 at 22-25; D.I. 392 at 30-34; D.I. 425 at 15-17), and having considered the relevant standard of review, (D.I. 470 at 2-4), hereby ORDERS that the Motion is GRANTED for the reasons set out below: (1) It is undisputed that Plaintiff did not mark its products that read on the claims of the 752 patent prior to suit. (D.I. 353 at 23; D.I. 356 at ¶¶ 5-9; D.I. 396 at ¶¶ 5-9); (2) Binding law from the United States Court of Appeals for the Federal Circuit states that if a party like Plaintiff only asserts method claims in a case, then it need not have marked its products in order to get pre-suit damages, even as to a patent that includes unasserted system claims. Crown Packaging Tech., Inc. v. Rexam Beverage Can Co., 559 F.3d 1308, 1316 (Fed. Cir. 2009); Sapphire Crossing LLC v. Robinhood Mkts., Inc., Civil Action No. 18-1717-MN-CJB (Consolidated), Civil Action No. 20-726-MN-CJB, 2021 WL 149023, at *7 (D. Del. Jan. 15, 2021), report and recommendation adopted, 2021 WL 355154 (D. Del. Feb. 2, 2021); see also 35 U.S.C. § 287(a) ("Section 287(a)"). But a party who did not mark its product that reads on a system claim loses the ability to obtain pre-suit damages, if notice of the patent was not provided pre-suit (as here). Crown Packaging Tech., Inc., 559 F.3d at 1316-17; Ortiz & Assocs. Consulting, LLC v. VIZIO, Inc., Civil Action No. 3:23-CV-00791-N, 2023 WL 7184042, at *2 (N.D. Tex. Nov. 1, 2023).; (3) Here, Plaintiff is asserting claims 11-12, 14-18 and 20 of the 752 patent against Defendant (the "asserted claims"). (D.I. 361, ex. 4 at ¶ 25) Those claims all begin with the words "A method of... " or "The method of..." but then all of them either include as an explicit limitation "providing the system of claim 1" or otherwise depend from claims that do so. (752 patent, cols. 71:31-72:22) In the Court's view, the structure of these asserted claims indicates that pre-suit marking was required, as the claims are each dependent on system claim 1, and (relatedly) facially incorporate the system of claim 1 into the claims. (D.I. 353 at 24-25); Am. Med. Sys., Inc. v. Med. Eng'g Corp., 6 F.3d 1523, 1538 (Fed. Cir. 1993) ("The reason that the marking statute does not apply to method claims is that, ordinarily, where the patent claims are directed to only a method or process there is nothing to mark.") (emphasis added).; (4) With regard to the dependency issue, in order to establish whether a claim is dependent upon another, the Court examines whether "the new claim both refers to an earlier claim and further limits that referent." Amgen Inc. v. Hospira, Inc., 232 F. Supp. 3d 621, 627 (D. Del. 2017) (quoting Monsanto Co. v. Syngenta Seeds, Inc., 503 F.3d 1352, 1357 (Fed. Cir. 2007)); see also Novartis Pharms. Corp. v. Actavis, Inc., Civil Action No. 12-366-RGA-CJB, 2013 WL 6142747, at *11 (D. Del. Nov. 21, 2013) ("While an independent claim stands on its own as described in a single claim, a dependent claim refers to and adds further limitations to an independent claim."). The asserted claims here each refer to independent system claim 1, and they each further limit that claim by way of their own additional specific method-related requirements. (752 patent, cols. 71:31-72:22) Indeed, during prosecution of the application that would become the 752 patent, Plaintiff's predecessor represented to the United States Patent and Trademark Office that there was only one independent claim in the patent—i.e., what became system claim 1—and that all of the remaining claims (including the now-asserted claims) were dependent claims. (D.I. 356 at ¶¶ 11-13 (citing, e.g., D.I. 361, ex. 12 at AGILE0000285; id. at AGILE0000298-99; id. at AGILE0000325; id. at AGILE0000363; id. at AGILE0000413;

id. at AGILE0000586; id. at AGILE0000594); D.I. 396 at ¶ 11); see also Amgen Inc., 232 F. Supp. 3d at 627-28 (finding that the patentee's statements during prosecution as to whether the claim at issue was a dependent claim was crucial to determining the correct answer to that question); Novartis Pharms. Corp., 2013 WL 6142747, at *11 (same); (D.I. 425 at 16). Even Plaintiff's expert has seemed to confirm that the asserted claims depend on system claim 1. (D.I. 361, ex. 24 at ¶ 99 n.9; D.I. 392 at 32 n.10 (Plaintiff noting that "Agilent and its experts have not been perfectly consistent in referring to [the asserted] claims as independent")); and (5) In light of the above, in order to infringe the asserted claims, a party must make use of the system in claim 1. (D.I. 425 at 17) And so the asserted claims, which include and rely on the use of a system that can be marked, are subject to Section 287(a)'s marking requirement. Cf. Align Tech., Inc. v. 3Shape A/S, C.A. No. 17-1646-LPS, 2020 WL 4926164, at *13 (D. Del. Aug. 14, 2020) (citing Am. Med. Sys., Inc., 6 F.3d at 1538-39), on reargument in part, 2021 WL 534903 (D. Del. Feb. 12, 2021). Ordered by Judge Christopher J. Burke on 1/12/2026. (mlc) (Entered: 01/12/2026)
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