

[Revised Draft Sept 23]

Ms. Ehrlich of Marblehead moves to amend the bill by inserting the following section:  
SECTION XX. The General Laws are hereby amended by inserting after chapter 93K the following new chapter: –

“CHAPTER 93L

#### BAD FAITH ASSERTIONS OF PATENT INFRINGEMENT

Section 1. As used in this chapter, the following words shall have the following meanings unless the context clearly requires otherwise: -

“Assertion of patent infringement”, means (i) sending or delivering a demand letter to a target; (ii) threatening a target with litigation asserting, alleging or claiming that the target has engaged in patent infringement; (iii) sending or delivering a demand letter to the customers of a target; or (iv) otherwise making claims or allegations, other than those made in litigation against a target, that a target has engaged in patent infringement or that a target should obtain a license to a patent in order to avoid litigation.

“Demand letter”, means a letter, e-mail, or other communication asserting, alleging or claiming that the target has engaged in patent infringement or that a target should obtain a license to a patent in order to avoid litigation, or any similar assertion.

“Target”, means a person residing in, conducting substantial business in, or having its principal place of business in Massachusetts and with respect to whom an assertion of patent infringement is made.

Section 2. (a) A person shall not make, in bad faith, an assertion of patent infringement. (b) In determining whether a person has made an assertion of patent infringement in bad faith, a court may consider the following factors and any other factor the court finds relevant:

(1) The demand letter does not contain the following information:

(i) the patent number;

(ii) the name and address of the patent owner or owners and assignee or assignees, if any; and

(iii) factual allegations concerning the specific areas in which the target's products, services, and technology infringe the patent or are covered by the claims in the patent.

~~(2) Prior to sending the demand letter, the person fails to conduct an analysis comparing the claims in the patent to the target's products, services, and technology, or such an analysis was done but does not identify specific areas in which the products, services, and technology are covered by the claims in the patent.~~

~~(3)~~ (2) The demand letter lacks the information described in subsection (a)(b)(1), the target requests the information, and the person fails to provide the information within a reasonable period of time.

~~(4)~~ The demand letter demands payment of a license fee or response within an unreasonably short period of time.

~~(5) The person offers to license the patent for an amount that is not based on a reasonable estimate of the value of the license.~~

~~(6)~~ (4) The claim or assertion of patent infringement is meritless, and the person knew, or should have known, that the claim or assertion is meritless.

~~(7)~~ The claim or assertion of patent infringement is deceptive.

~~(8)~~ (6) The person or its subsidiaries or affiliates have previously filed or threatened to file one or more lawsuits based on the same or similar claim of patent infringement and:

(i) those threats or lawsuits lacked the information described in subsection (a); or

(ii) the person attempted to enforce the claim of patent infringement in litigation and a court found the claim to be meritless.

~~(9)~~ (7) The patent has been held invalid or unenforceable in a final judgment or administrative decision.

(c) A court may consider the following factors, and any other factor the court finds relevant, as evidence that a person has not made an assertion of patent infringement in bad faith:

(1) The demand letter contains the information described in subsection (1) of this section.

(2) Where the demand letter lacks the information described in paragraph (1) of subsection (b) and the target requests the information, the person provides the information within a reasonable period of time.

(3) The person engages in a good faith effort to establish that the target has infringed the patent and to negotiate an appropriate remedy.

(4) ~~The~~ Prior to sending the demand letter, the person ~~makes a substantial investment~~ conducts an analysis comparing the claims in the ~~use of the~~ patent ~~or in the production or sale of a product or item covered by the patent to the target's products, services, and technology.~~

~~(5) The person is:~~

~~(i) the inventor or joint inventor of the patent or, in the case of a patent filed by and awarded to an assignee of the original inventor or joint inventor, is the original assignee; or~~

~~(ii) an institution of higher education or a technology transfer organization owned or affiliated with an institution of higher education.~~

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(d) This section shall not apply to:

(1) Any party who is currently making significant investments in:

(i) research and development in connection with the patented technology, where development means technical or experimental work to create, test, qualify, modify, or validate technologies or processes for commercialization of goods or services;

(ii) development, product marketing, manufacturing, or sale of products or processes embodying the patented technology;

(iii) use of patented technology in the delivery or provision of goods or commercial services; or

(iv) a combination of any of the areas of business described in clauses (i) through (iii)

(2) Any party whose business is the licensing of patents as a wholly-owned subsidiary of any party described in paragraph (1).

(3) Any institution of higher education, public or private, or non-profit research institute, or an organization which has as one of its primary functions the management of inventions on behalf of the aforementioned entities.

Section 3. ~~(a)~~ A target of conduct involving assertions of patent infringement and any other person aggrieved by a violation of section 2 may bring an action in Superior Court.

~~(b) A court may award to a defendant who prevails in an action brought pursuant to this section costs and fees, including reasonable attorneys' fees, if the court finds the action was not well-grounded in fact and warranted by existing law or was interposed for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation.~~

Section 4. (a) The attorney general shall have the same authority under this chapter to make rules, conduct civil investigations, bring civil actions, and enter into assurances of discontinuance as provided under chapter 93A. In an action brought by the attorney general pursuant to this section, the court may award or impose any relief available under this chapter.

~~(b) This chapter shall not be construed to limit the rights and remedies available to the state or another person under any other law, or alter or restrict the attorney general's authority under other law, with regard to conduct involving claims of patent infringement.~~

Section 5. (a) A court may award the following remedies to a plaintiff who prevails in an action brought pursuant to this chapter:

(i) equitable relief;

(ii) damages;

(iii) costs and fees, including reasonable attorney's fees; and

(iv) exemplary damages in an amount equal to \$50,000 or 3 times the total of damages, costs, and fees, whichever is greater.

(b) Any person who by contract, agreement, or otherwise, directly or indirectly, arranged for the bad faith assertion of patent infringement and any person who otherwise caused or is legally responsible for such bad faith assertion of patent infringement under the principles of the common law shall be liable to a prevailing plaintiff for all damages, costs and fees. Such liability shall be joint and several.

(bc) In an action arising under section 3 or 4 of this chapter, any person who has delivered or sent, or caused another to deliver or send, a demand to a target in Massachusetts has purposefully availed himself or herself of the privileges of conducting business in the commonwealth and shall be subject to suit in the commonwealth, whether or not the person is transacting or has transacted any other business in the commonwealth, and a court may exercise personal jurisdiction over such person.

Section 6. The Commonwealth recognizes the importance of patents, and enforceability of patents, to the innovation economy of the Commonwealth. This chapter shall not be construed to limit rights and remedies available to the commonwealth impair the legitimate, good faith commercial use, licensing, sale, or to any person under any other law enforcement of patents, consistent with this Chapter and shall not alter or restrict the attorney general's authority.” Title 35 of the United States Code.