



2013 SENATE BILL 498

1 **AN ACT** *to create* 100.197 of the statutes; **relating to:** notifications concerning
2 the assertion of rights under a patent or pending patent and providing a
3 penalty.

Analysis by the Legislative Reference Bureau

The people of the state of Wisconsin, represented in senate and assembly, do enact as follows:

4 **SECTION 1.** 100.197 of the statutes is created to read:
5 **100.197 Patent notifications.** (1) DEFINITIONS. In this section:
6 (a) “Patent notification” means a letter, e-mail, or other written
7 communication attempting in any manner to enforce or assert rights in connection
8 with a patent or pending patent.
9 (b) “Target” means a person who meets at least one of the conditions described
10 in s. 801.05 (1) (b), (c), and (d) and satisfies at least one of the following:

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1 1. The person has received a patent notification.

2 2. One or more of the person's customers has received a patent notification
3 concerning a product, service, process, or technology of the person.

4 **(2) PATENT NOTIFICATION REQUIREMENTS.**

5 (a) A patent notification shall contain all of the following:

6 1. The number of each patent or patent application that is the subject of the
7 patent notification.

8 2. A physical or electronic copy of each patent or pending patent.

9 3. The name and physical address of the owner of each patent or pending patent
10 and all other persons having a right to enforce the patent or pending patent.

11 4. An identification of each claim of each patent or pending patent being
12 asserted and the target's product, service, process, or technology to which that claim
13 relates.

14 5. Factual allegations and an analysis setting forth in detail the person's theory
15 of each claim identified under subd. 4., if any, and how that claim relates to the
16 target's product, service, process, or technology.

17 6. An identification of each pending or completed court or administrative
18 proceeding, including any proceeding before the U.S. patent and trademark office,
19 concerning each patent or pending patent.

20 (b) A patent notification may not contain false, misleading, or deceptive
21 information.

22 (c) 1. If a patent notification lacks any of the information required under par.
23 (a), the target may notify the person who made the patent notification that the patent
24 notification is incomplete.

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1 2. Within 30 days after the date on which a target notifies a person under subd.
2 1., the person shall provide the target with the information required under par. (a)
3 that is necessary to complete the patent notification.

4 **(3) ENFORCEMENT AND REMEDIES.** (a) 1. The department or the attorney general
5 may investigate an alleged violation of sub. (2) (b) or (c) 2.

6 2. The attorney general may commence an action in the name of the state to
7 restrain by temporary or permanent injunction a violation of sub. (2) (b) or to compel
8 a person who has violated sub. (2) (c) 2. with respect to a target to provide the target
9 with the information specified in sub. (2) (c) 2. Before entry of final judgment in an
10 action commenced under this subdivision, the court may make any necessary orders
11 to restore to any person any pecuniary loss the person has suffered because of the
12 violation of sub. (2) (b) or (c) 2.

13 3. The attorney general may commence an action in the name of the state to
14 recover a forfeiture to the state of not more than \$50,000 for each violation of sub.
15 (2) (b) or (c) 2.

16 (b) A target or other person aggrieved because of a violation of sub. (2) (b) or
17 (c) 2. may commence an action for the following:

18 1. A temporary or permanent injunction restraining a violation of sub. (2) (b)
19 or compelling a person who has violated sub. (2) (c) 2. with respect to a target to
20 provide the target with the information specified in sub. (2) (c) 2.

21 2. An appropriate award of damages.

22 3. The person's costs and, notwithstanding the limitations under s. 814.04 (1),
23 reasonable attorney fees.

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1 4. An award of punitive damages not to exceed \$50,000 for each violation or 3
2 times the aggregate amount awarded for all violations under subds. 2. and 3.,
3 whichever is greater.

4 (c) Each patent notification that violates sub. (2) (b) or is the subject of a
5 violation of sub. (2) (c) 2. is a separate violation.

6 **(4) EXEMPTIONS.** Subsection (2) does not apply to any of the following:

7 (a) A patent notification of an institution of higher education or of a technology
8 transfer organization that is owned, controlled, or operated by, or associated with,
9 an institution of higher education.

10 (ag) A patent notification of a health care or research institution that has
11 annual expenditures of at least \$10,000,000 and that receives federal funding.

12 (ar) A patent notification of an organization that is owned, controlled, or
13 operated by an institution specified in par. (ag).

14 (b) A patent notification attempting to enforce or assert a right in connection
15 with a patent or pending patent on a device, or a component of that device, that is
16 subject to approval by the federal food and drug administration or the federal
17 department of agriculture.

18 (c) A patent notification attempting to enforce or assert a right arising under
19 35 USC 271 (e) (2) or 42 USC 262.

20 **(5) NO LIMITATION OF RIGHTS AND REMEDIES UNDER OTHER LAW.** Nothing in this
21 section may be construed to limit rights and remedies available to the state or any
22 person under any other law.

23 **SECTION 2. Initial applicability.**

24 (1) This act first applies to a patent notification, as defined in section 100.197
25 (1) (a) of the statutes, as created by this act, received by a target, as defined in section

