



## WISCONSIN LEGISLATIVE COUNCIL ACT MEMO

**2013 Wisconsin Act 339**  
[2013 Senate Bill 498]

**Assertions of Patent Rights**

2013 Wisconsin Act 339 relates to notifications concerning the assertion of rights under a patent or pending patent.

### PATENT NOTIFICATIONS

Act 339 defines “patent notification” as “a letter, e-mail, or other written communication attempting in any manner to enforce or assert rights in connection with a patent or pending patent.” A “target” is a person to whom a patent notification is addressed. The Act specifies that a patent notification may not contain false, misleading, or deceptive information and requires that a patent notification contain all of the following information:

- The number of each patent or patent application that is the subject of the patent notification.
- A physical or electronic copy of each patent or pending patent.
- The name and physical address of the owner of each patent or pending patent and all other persons having a right to enforce the patent or pending patent.
- An identification of each claim of each patent or pending patent being asserted and the target’s product, service, process, or technology to which that claim relates.
- Factual allegations and an analysis setting forth in detail the person’s theory of each claim identified and how that claim relates to the target’s product, service, process, or technology.
- An identification of each pending or completed court or administrative proceeding, including any proceeding before the U.S. Patent and Trademark Office, concerning each patent or pending patent.

If the target of a patent notification informs the person making the notification that the notification is incomplete, the person is required to provide the target the lacking information.

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This memo provides a brief description of the Act. For more detailed information, consult the text of the law and related legislative documents at the Legislature’s Web site at: <http://www.legis.wisconsin.gov>.

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## EXEMPTIONS

Act 339 exempts the following types of communications from the Act's requirements:

- A patent notification of an institution of higher education or of a technology transfer organization that is owned, controlled, or operated by, or associated with, an institution of higher education.
- A patent notification attempting to enforce or assert a right in connection with a patent or pending patent on a device, or a component of that device, that is subject to approval by the federal Food and Drug Administration (FDA) or the federal Department of Agriculture.
- A patent notification attempting to enforce or assert a right arising under certain provisions of federal law, namely 35 U.S.C. s. 271 (e) (2) (patent infringement by submitting specified types of applications under the federal Food, Drug, and Cosmetic Act or the Public Health Service Act) or 42 U.S.C. s. 262 (introduction of specified types of projects without a biological products license).
- A patent notification of a health care or research institution that has annual expenditures of at least \$10,000,000 and that receives federal funding or by an organization owned, controlled, or operated by such an institution.

## ENFORCEMENT AND REMEDIES

Act 339 creates several enforcement mechanisms and remedies for violations of its provisions. It authorizes the Attorney General and the Department of Agriculture, Trade and Consumer Protection to investigate alleged violations, and authorizes the Attorney General to commence an action to enjoin a violation or to compel the person making the notification to provide the target any information lacking from the notification. The court may make any orders necessary to restore any pecuniary losses any person has suffered due to the notification and to impose a forfeiture of not more than \$10,000 for each violation.

In addition, a target or any other person aggrieved because of a violation may commence an action for any of the following:

- An order enjoining a violation or compelling the person making the notification to provide the target any information lacking from the notification.
- An appropriate award of damages.
- The costs of bringing the action, including reasonable attorney fees.
- Punitive damages not to exceed the greater of \$50,000 for each violation or three times the aggregate amount awarded in damages and costs for all violations.

*Effective date:* April 25, 2014. The Act first applies to a patent notification received by a target or a customer of a target on the effective date.

*Prepared by:* David L. Lovell, Principal Analyst

April 29, 2014

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