

Alpine Valley Ski Area, Inc., 718 F.2d 1075, 1082-83 (Fed. Cir. 1983)). At Symantec’s (and its then co-defendants’) request, the Court ordered IV to elect no more than twenty asserted claims, which IV complied with on April 6, 2012. (D.I. 162 at 20-26, 31-32; D.I. 197) From that day forward (including throughout the claim construction and summary judgment proceedings), IV has not asserted any apparatus claims of either the ‘050 or ‘610 patents against Symantec, and in particular IV never pressed for a judgment of liability against Symantec on any such claim.

With respect to the remaining patent-in-suit, the ‘142 patent, the Court finds, as an exercise of its discretion and as proper case management, that it would be unfairly prejudicial to IV to allow Symantec, at nearly the final moment before trial (i.e., listing it as a contested issue in the proposed pretrial order), to put IV in a position in which it must prove that it (or its predecessors and/or licensees) marked embodiments of the ‘142 patent. Symantec mistakenly or misleadingly identified failure to mark as its “Fifth *Affirmative Defense*” in its Answer. (D.I. 23 at 10) (emphasis added).¹ When IV thereafter served an interrogatory seeking “all factual and legal bases for each affirmative defense asserted in Your Answer” (D.I. 622 Ex. A at 9), Symantec said nothing about § 287, and continued to remain silent about § 287 in its supplemental responses to interrogatories on the last day of discovery (D.I. 622 Ex. C). Symantec did not provide expert discovery on failure to mark and did not propose a jury instruction on false marking at the time the parties exchanged jury instruction proposals. All of this suggests to the Court that Symantec failed to give IV adequate, meaningful notice that it contested marking. Under the totality of circumstances (which, the Court recognizes, includes

¹Marking is a limitation on damages, not an affirmative defense. See *Motorola, Inc. v. United States*, 729 F.2d 765, 770 (Fed. Cir. 1984) (“[T]he marking and notice statute cannot be interpreted as a patent defense.”).

amongst the mass of discovery that Symantec did seek deposition testimony and third-party discovery relating to marking), the Court finds that Symantec waived and/or abandoned its right to contest marking at the forthcoming trial.


UNITED STATES DISTRICT COURT