Keeping Laches: The Loss of the Laches Defense in Copyright Infringement Cases Does Not Mean Depriving Patent Attorneys of the Time-Honored Defense

"[E]quity aids the vigilant, not those who sleep on their rights."[1] *"In those few and unusual cases where a plaintiff unreasonably delays in bringing suit and consequently causes inequitable harm to the defendant, [laches] permits a court to bring about a fair result."*[2]

I. INTRODUCTION

Defendants use laches, an ancient equitable doctrine, as an affirmative defense in patent infringement suits.[3] Laches applies when a patent owner, referred to as the patentee, unreasonably delays in filing suit against the alleged infringing defendant.[4] Defendants in patent infringement suits invoke laches by showing not only that the patentee unreasonably and inexcusably delayed filing, but that the delay caused "material prejudice" to the defendant.[5] While

1. Stone v. Williams, 873 F.2d 620, 623 (2d Cir. 1989) (translating Latin maxim: "*vigilantibus non dormientibus aequitas subvenit*"), *vacated on other grounds on reh'g*, 891 F.2d 401 (2d Cir. 1989). In *Stone v. Williams*, the district court relied on the doctrine of laches to dismiss Stone's claims seeking a proportional share in the proceeds from the copyright renewal of Hank Williams, Sr.'s songs. *See id.* More than a century ago, the Supreme Court stated: "Courts of equity, it has often been said, will not assist one who has slept upon his rights, and shows no excuse for his laches in asserting them." Lane & Bodley Co. v. Locke, 150 U.S. 193, 201 (1893) (holding plaintiff's preference to receive salary rather than seek royalties not valid excuse for delay).

2. Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1986 (2014) (Breyer, J., dissenting) (arguing "no reason" to remove laches from copyright infringement cases).

3. *See* Gail L. Heriot, *A Study in the Choice of Form: Statutes of Limitation and the Doctrine of Laches*, 1992 BYU L. REV. 917, 926-27 (1992) (explaining history of statutes of limitations and laches); Jean F. Rydstrom, Annotation, *Laches As Defense in Patent Infringement Suits*, 35 A.L.R. Fed. 551, § 2a (1977) (listing instances where laches offers available defense). After Henry VIII implemented a form of the statute of limitations, many equity courts used the Latin phrase "*interest republicae ut sit finis litium*" and applied a form of the laches doctrine according to the unique circumstances of each case. *See* Heriot, *supra* at 926-27. Black's Law Dictionary elaborates on the Latin phrase: "It concerns the state that there be an end of lawsuits. It is for the general welfare that a period be put to litigation." *Id*. at 927 n.37 (quoting BLACK'S LAW DICTIONARY 814 (6th ed. 1979)).

4. *See* 2 ETHAN HORWITZ & LESTER HORWITZ, HORWITZ ON PATENT LITIGATION § 10.16 (2016) (enumerating laches elements). Laches is "firmly rooted in the foundational soils of equity and justice." Odetics, Inc. v. Storage Tech. Corp., 919 F. Supp. 911, 916 (E.D. Va. 1996), *vacated on other grounds*, 116 F.3d 1497 (Fed. Cir. 1997). The United States Patent and Trademark Office (USPTO) issues a patent that "includes not only the patentee to whom the patent was issued but also the successors in title to the patentee." 35 U.S.C. § 100(d) (2012).

5. *See* A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1028 (Fed. Cir. 1992) (en banc) (holding laches valid equitable defense to patent infringement claim under statute).

the laches defense is infrequently raised, it is helpful when eliminating damages awarded to the patentee.[6] Laches remains a powerful tool for defendants by completely barring recovery for infringement before suit.[7]

Recently, in *Petrella v. Metro-Goldwyn-Mayer*,[8] the Supreme Court put patent litigation attorneys on notice that the laches defense for patent infringement may be on its way out.[9] The Court in *Petrella* held that laches is no longer a viable defense in copyright infringement cases because the copyright statute of limitations appropriately takes into account any delay in bringing suit, and allowing laches as a defense conflicts with congressionally specified time bars.[10] Some—including the dissent in a recent split Federal Circuit in the *SCA Hygiene* decision—argue that copyright law has statutory limitations similar to patent law, so laches should also be barred from use in patent infringement suits in light of the Supreme Court's *Petrella* decision.[11] Thus, the issue is whether the *Petrella* holding baring laches reaches beyond copyright infringement cases into the realm of patent law.[12]

6. *See Federal Circuit Narrowly Upholds Laches Defense*, FISH & RICHARDSON (Oct. 7, 2015), http://www.fr.com/fish-litigation/fed-cir-narrowly-upholds-laches/ [http://perma.cc/6GN5-G53B] (reporting on recent Federal Circuit opinion). John Dragseth of Fish & Richardson purports that laches may be useful "[i]f the facts are wonderful and your client looks like an angel and the patent owner looks like the devil." Ryan Davis, *Patent Troll Weapon Survives, But High Court May Be Next*, LAW360 (Sept. 18, 2015), http://www.law360.com/appellate/articles/704617?nl_pk=1f2258a8-7159-4af3-a53d-a32f28e0fc4d&utm_source=newsletter&utm_medium=email&utm_campaign=appellate [http://perma.cc/ZV9S-URB9] [hereinafter Davis, *Patent Troll Weapon Survives*]. Many agree, however, that laches can help eliminate abuse of the patent system. *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 807 F.3d 1311, 1330 (Fed. Cir. 2015) (en banc) (noting "overwhelming[] support" for retaining laches in patent law); *Federal Circuit Narrowly Upholds Laches Defense*, *supra* (highlighting laches useful in defeating parties "unfairly [lying] in wait while damages accumulate"). The court in *SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC* cited to amicus briefs submitted by fourteen companies representing diverse industries from biotechnology to finance, all of whom support upholding laches in patent infringement cases to prevent abuse of the patent system. *See SCA Hygiene*, 807 F.3d at 1330 & n.11.

7. *See* HORWITZ & HORWITZ, *supra* note 4, § 10.15 (describing laches); Rydstrom, *supra* note 3, § 3 (describing cases where laches defense successfully used).

8. 134 S. Ct. 1962 (2014).

9. *See id.* at 1973 (holding laches not allowed to bar pursuit of copyright infringement brought within statute of limitations); *see also infra* note 12 (speculating on validity of continued applicability of laches in patent law). Other areas of law may have a similar question of whether laches applies after the *Petrella* holding. *See* Brief for Amicus Curiae the Chamber of Commerce of the United States of America Supporting Respondents at 8-9, Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962 (2014) (No. 12-1315), 2013 WL 6858296, at *8-9 [hereinafter Brief for Chamber of Commerce]. The laches defense may be unavailable in both antitrust and Title VII cases. *See id.* at *8-10.

10. *See Petrella*, 134 S. Ct. at 1975 (reasoning laches "would tug against the uniformity Congress sought to achieve" with three-year limitation).

11. *See* Todd Vare, *'Raging Bull' Copyright Opinion May Impact Patent Cases*, LAW360 (May 27, 2014), http://www.law360.com/articles/541533/raging-bull-copyright-opinion-may-impact-patent-cases [http://perma.cc/Q9AF-KZFK] (suggesting *Petrella* decision may reopen discussion of laches in patent cases); *infra* notes 138-143 and accompanying text (discussing dissent in *SCA Hygiene* Federal Circuit decision). *Compare* 17 U.S.C. §507(b) (2012) (setting forth three-year limitation on copyright infringement actions), *with* 35 U.S.C. § 286 (2012) (proscribing six-year limitation on damages recovery for patent infringement).

12. *See* Dennis Crouch, *Federal Circuit Defies Supreme Court in Laches Holding*, PATENTLY-O (Sept.

Despite the ruling in *Petrella* barring the laches defense, the Federal Circuit narrowly upheld the laches defense against patent infringement claims.[13] The Supreme Court, however, has frequently admonished the Federal Circuit for creating rules that are unique to patent law.[14] For example, in *Medtronic, Inc. v. Mirowski Family Ventures, LLC*,[15] the Supreme Court held that the Federal Circuit erred in holding the alleged infringer, instead of the patentee, had the burden to prove patent infringement when the potential infringer was seeking a declaratory judgment establishing no infringement.[16] The Court reasoned that a declaratory judgment is only "procedural," and leaves substantive rights, like the burden of proof, unchanged.[17] The Court concluded that the public's interest in maintaining a well-functioning patent system is, at most, in balance, and does not favor changing the ordinary burden of proof rule.[18]

This Note examines the laches defense in recent Federal Circuit and Supreme Court copyright and patent infringement cases, and evaluates whether the Supreme Court should uphold the use of laches in patent infringement cases.[19] Part II.A provides a background of the laches defense, predominantly in patent infringement cases.[20] Part II.B describes, compares, and contrasts United States copyright and patent statutory time limitations on recovery.[21]

21, 2014), http://patentlyo.com/patent/2014/09/federal-supreme-holding.html [http://perma.cc/ZN2F-5D2R] (arguing *Petrella* copyright holding controls in patent law); Davis, *Patent Troll Weapon Survives*, *supra* note 6 (positing sharp divide between Federal Circuit justices could induce writ of certiorari); *see also* Brief for Chamber of Commerce, *supra* note 9, at *2 (asserting ramifications for barring laches in copyright extend beyond copyright context).

13. *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 807 F.3d 1311, 1314-15 (Fed. Cir. 2015) (en banc) (holding by a vote of six to five laches remains viable defense).

14. *See* Robin Feldman, *Coming of Age for the Federal Circuit*, 18 GREEN BAG 2D 27, 27-28 (2014) (considering tension between Federal Circuit and Supreme Court "coming of age" for Federal Circuit); Ryan Davis, *Fed. Circ.'s Latest Patent-Specific Rule May Rile Justices*, LAW360 (Sept. 18, 2014), http://www.law360.com/articles/578269/fed-circ-s-latest-patent-specific-rule-may-rile-justices [http://perma.cc/DT6M-M88Z] (highlighting Supreme Court's disfavor of patent-specific rules); *see also* Octane Fitness, LLC v. ICON Health & Fitness, Inc., 134 S. Ct. 1749, 1755-56 (2014) (holding no special rules for fee shifting in patent cases); eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 393-94 (2006) (holding no special rules for injunctions in patent law).

15. 134 S. Ct. 843 (2014).

16. *See id*. at 846 (determining no special rules for declaratory judgment in patent law). The general rule places the burden to prove infringement on the patentee. *See id.* at 846, 849, 852.

17. *See id.* at 849 (explaining well-settled in case law concerning procedural nature of declaratory judgments). The Court goes on to consider practical concerns that a burden that shifts depending on the action's form would create uncertainty after the initial litigation concludes. *See id.* at 849-50. The Court pointed out, for example, that a declaratory judgment in a regime following the Federal Circuit's rule could lack definiteness and finality because litigation of an issue decided in one suit is not precluded in a subsequent suit "where the burden of persuasion 'has shifted.'" *See id.* at 850 (internal citations omitted).

18. *See id.* at 851-52 (stating "no convincing reason" why plaintiff should have benefit of burden of proof). The Court stated that the public has an important interest in maintaining patent monopolies, but a patentee should not be able to enforce claims that fall outside of a patent's boundaries. *See id.* at 851.

19. *See infra* Parts II-III.

20. *See infra* Part II.A.

21. *See infra* Part II.B.

Part II.C examines the recent Federal Circuit court decision upholding laches in patent infringement suits, as well as the Supreme Court decision barring the laches defense in copyright infringement cases.[22] Finally, Part III advocates for maintaining the laches defense in patent infringement cases because, unlike the statute of limitations in the copyright statute, the patent statutory damages limitation does not function as a bar to bringing suit.[23]

II. HISTORY

A. Laches Background and Definition

The Supreme Court of Alabama described laches as "a creature of courts of equity, founded upon common sense and natural justice."[24] Laches is meant to address the legal concern that a plaintiff's cause of action should eventually expire for absence of timeliness.[25] The theory behind the application of laches in patent infringement cases is that those who are granted a lawful, limited monopoly under the patent system are then obligated to enforce their rights in a judicious fashion.[26]

A defendant invokes a laches defense by showing the plaintiff unreasonably delayed bringing suit, thereby causing material prejudice to the defendant.[27] In patent law, the "laches clock" starts running at the time the patentee knew or reasonably could have known of the defendant's potential infringement.[28] The clearest example of unreasonable delay arises when a patentee threatens immediate suit for patent infringement, followed by a period of inaction.[29]

22. *See infra* Part II.C.

23. *See infra* Part III.

24. First Nat'l Bank v. Wise, 177 So. 636, 639 (Ala. 1937) (differentiating laches from "hidebound rule" of statute of limitations).

25. *See* Heriot, *supra* note 3, at 918, 921 (elucidating preference for laches by considering doctrine "golden girl of equity jurisdiction"). Heriot posited that statutes of limitations and the doctrine of laches are converging towards similar judicial application whereby the rules of statutes of limitations have become standardlike, and laches standards are applied more like a rule. *See id.* at 922-23 (arguing convergence may leave statutes of limitations and laches vulnerable to judicial self-interest).

26. *See* Rydstrom, *supra* note 3, § 2(a) (explaining relation of laches defense with interests of fairness and equity). Patent protection grants a patentee the ability "to exclude others from making, using, offering for sale, or selling the invention" for twenty years after filing the patent application. 35 U.S.C. § 154(a) (2012) (describing patent contents and term); *see also* Paula D. Heyman, Note, *The Laches Defense in* Wanlass v. General Electric *and Its Effect on Patentees' Duty to Police Their Rights*, 50 SYRACUSE L. REV. 1151, 1154 (2000) (discussing policy basis for laches in patent infringement cases).

27. *See* A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1028-29 (Fed. Cir. 1992) (en banc) (defining legal contextual definition of laches); HORWITZ & HORWITZ, *supra* note 4, §10.16 (describing "factual elements" required to establish laches defense).

28. *See* Johnston v. Standard Mining Co., 148 U.S. 360, 370 (1893). "[W]here the question of laches is in issue the plaintiff is chargeable with such knowledge as he might have obtained upon inquiry, provided the facts already known by him were such as to put upon a man of ordinary intelligence the duty of inquiry." *Id.*; *see also* HORWITZ & HORWITZ, *supra* note 4, § 10.16 (explaining showing of prima facie six-year unreasonable delay to trigger latches defense).

29. *See* Rydstrom, *supra* note 3, § 8 (noting empty threat of suit supports laches assertion). To avoid

Such inaction implies that the accused infringer is safe to continue without fear of suit because the patentee appears to agree that there was no infringement, or decided asserting his or her rights would be unsuccessful.[30]

A court generally looks to all of the "particular facts and circumstances" in a laches defense case, and balances the equities between the parties.[31] Courts have not allowed the laches defense if the delay resulted from certain situations, including: the patentee was unaware of the defendant's infringement; the patentee's ongoing "litigation on the same patent against other infringers"; the patentee's desire to avoid litigation by settling the claims amicably; or existing wartime conditions.[32] Alternatively, defendants successfully invoked laches where the patentee failed to notify the defendant due to other affairs; the patentee suffered from poor health; the patentee lacked sufficient funds to bring suit; and where the patentee refrained from bringing a premature suit after a considered decision.[33]

In addition to considering the reason for delay, courts examine the facts and circumstances of each case to determine whether the length of the delay was unreasonable or inexcusable.[34] Nevertheless, a presumption of laches arises when the delay in filing suit exceeds six years—the time limit for damages as specified in the patent statute.[35] The Federal Circuit explained that the six-year delay presumption "provides a yardstick for reaching comparable results in comparable circumstances rather than leaving the matter without any guidelines to a district court's exercise of discretion."[36]

defeat by a latches defense, a plaintiff must not only file an infringement action, but also pursue the action diligently. *See Johnston*, 148 U.S. at 370.

30. *See* Rydstrom, *supra* note 3, § 8 (explaining Ninth Circuit conclusion supporting defendant's entitlement in believing passage of time suggested no valid claim).

31. *See* HORWITZ & HORWITZ, *supra* note 4, § 10.16 (defining laches and listing required elements).

32. *See* Rydstrom, *supra* note 3, § 2(a) (providing situations where delay not found). Delay, without more, is not enough; there is an important distinction between simple delay and unreasonable delay. *See id.* § 4.

33. *See id.* § 2(a) (specifying successful and failed delay claims). For example, a toy patentee sued a toy manufacturer for patent infringement four to five years after the patentee was aware, or should have been aware, of the manufacturer's potential infringement. *See* Lemelson v. Carolina Enters., Inc., 541 F. Supp. 645, 656-57 (S.D.N.Y. 1982). The court allowed summary judgment and dismissed the complaint based on laches because the patentee did not explain or excuse the delay in suing, and the court found that the patentee's delay prejudiced the manufacturer. *See id.* at 655, 657.

34. *See* A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1032 (Fed. Cir. 1992) (en banc) (stating determination of laches not based on application of "mechanical rules") (internal citations omitted); *see also* Eric W. Guttag, *Laches and Estoppel: The Patentee Who Procrastinates in Filing Suit May Be Lost*, 31 AIPLA Q.J. 47, 51 (2003) (reiterating courts' flexibility in determining reasonableness of delay time).

35. *See* 35 U.S.C. § 286 (2012); *A.C. Aukerman Co.*, 960 F.2d at 1034-35 (stating "borrowing" statute of limitations period reasonable for creation of presumption of laches). Equity courts began to "borrow" the statute of limitations period that previously applied only to legal claims and presumptively against equitable claims. *A.C. Aukerman Co.*, 960 F.2d at 1034. The Federal Circuit in *A.C. Aukerman Co. v. R.L Chaides Construction Co.* labeled the six-year limitation length "arbitrary." *See id.* at 1030-31; *see also infra* note 101 and accompanying text (discussing *A.C. Aukerman Co.* decision and interpretation of congressional intent).

36. *A.C. Aukerman Co.*, 960 F.2d at 1035.

The second element of a laches defense is met by proving evidentiary or economic prejudice.[37] Evidentiary prejudice occurs when the defendant is unable to present a full and fair defense on the merits due to the loss of critical records, death of a material witness, or fallibility of memories of long past events.[38] This type of evidentiary problem prejudices the defendant by undercutting the court's ability to decide the facts appropriately.[39]

Alternatively, economic prejudice occurs when the defendant would suffer a monetary loss or incur damages that likely would have been avoided had the plaintiff filed the suit earlier.[40] Economic prejudice requires more than mere damages a court may award after a finding for the plaintiff.[41] Instead, courts look to the alleged infringer's change in economic position during the period of delay.[42] Further, the loss of investments or damages must have occurred because of the delay and not simply because the alleged infringer attempted to "capitalize on a market opportunity."[43]

The Federal Circuit in *A.C. Aukerman Co.* emphasized that establishing undue delay and prejudice does not require recognition of laches in every case.[44] The court clearly reiterated: "[l]aches is not *established* by undue delay and prejudice"; undue delay and prejudice "merely lay the foundation for the trial court's exercise of discretion."[45] The court concluded by stressing that the application of laches might be denied when some facts would make it unfair to recognize the defense.[46] For instance, the doctrine of "unclean hands" may bar the alleged infringer's successful application of laches.[47]

37. *See* HORWITZ & HORWITZ, *supra* note 4, § 10.16. *But see A.C. Aukerman Co.*, 960 F.2d at 1036 (highlighting factors like prejudice fail to establish latches; they "merely lay the foundation" for courts).

38. *See* Studiengesellschaft Kohle mbH v. Eastman Kodak Co., 616 F.2d 1315, 1326-27, 1330 (5th Cir. 1980) (finding evidentiary prejudice to defendant but holding conduct not unreasonable); *see also* Odetics, Inc. v. Storage Tech. Corp., 919 F. Supp. 911, 922 (E.D. Va. 1996) (stating party may claim evidentiary prejudice by showing denial of opportunity to present full defense), *vacated on other grounds*, 116 F.3d 1497 (Fed. Cir. 1997).

39. *See* Guttag, *supra* note 34, at 56 (describing forms of evidentiary and economic prejudice).

40. *See* State Contracting & Eng'g Corp. v. Condotte Am., Inc., 346 F.3d 1057, 1066 (Fed. Cir. 2003) (explaining alleged infringer must change position "because of and as result of . . . delay") (internal citation omitted); Medinol Ltd. v. Cordis Corp., 15 F. Supp. 3d 389, 401-02 (S.D.N.Y. 2014) (noting economic prejudice arises when defendants suffer alterations to their economic well-being).

41. *See* A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1033 (Fed. Cir. 1992) (en banc) (rejecting concept that routine damages equal material prejudice); *see also infra* note 42 (describing relationship between damages and economic prejudice).

42. *See A.C. Aukerman Co.*, 960 F.2d at 1033 (stating "[e]conomic prejudice would . . . arise in every suit" if losses attributed merely to liability).

43. *See* Heyman, *supra* note 26, at 1155-56 (describing prejudicial element of establishing laches defense).

44. *See A.C. Aukerman Co.*, 960 F.2d at 1036 (making special note to emphasize laches application not necessarily required).

45. *Id.* (emphasis in original); *see also* Heriot, *supra* note 3, at 918 (discussing popularity of discretionary doctrines giving power to judiciary).

46. *See A.C. Aukerman Co.*, 960 F.2d at 1036 (suggesting other factors may exist to preempt laches use).

47. *See* Russell D. Slifer, Comment, *En Banc Ruling Bursts More Than Bubbles in Patent Litigation:*

The flexible nature of the applicability of laches likely supports the defense's popularity with courts today.[48] To be sure, it is appealing to have a mode of decision making that allows for an equitable result in light of case-specific facts.[49] Nevertheless, laches provides structure and guidance to judges by focusing attention on properly resolving cases where plaintiffs abuse the court system by causing material prejudice to defendants through undue delay.[50] The dissent in *Petrella* acknowledged that the legal system contains principles that help courts avoid any unfairness that may arise when rules are applied strictly to every case.[51]

Because laches is an unpredictable principle, with outcomes dependent on facts and circumstances, potential litigants may not be able to predict future behavior.[52] Advocating that courts should provide and apply general rules and guidance instead of evaluating the totality of the circumstances or employing a balancing approach, the late Justice Scalia urged courts to avoid doctrines that leave too much discretion in the hands of the judiciary wherever possible.[53] In

A.C. Aukerman Co. v. R.L. Chaides Construction Co. *and Its Impact*, 13 N. ILL. U. L. REV. 335, 343-44 (1993) (highlighting scenarios where defendant's conduct would bar laches application despite establishing laches elements); *see also* Serdarevic v. Advanced Med. Optics, Inc., 532 F.3d 1352, 1361-62 (Fed. Cir. 2008) (holding unclean hands not proven, therefore application of laches not barred). A successful application of unclean hands requires more than a showing of misconduct, but requires the plaintiff prove the defendant's misconduct *caused* the plaintiff's delay in suing. *See Serdarevic*, 532 F.3d at 1361.

48. *See* Heriot, *supra* note 3, at 918 (asserting judicial favoritism of laches over statute of limitations).

49. *See* Antonin Scalia, *The Rule of Law As a Law of Rules*, 56 U. CHI. L. REV. 1175, 1176-77 (1989) (explaining case-by-case justice not outmoded and sometimes appealing). Justice Scalia admitted that generalized laws are sometimes a bad fit and "perfect justice" cannot be achieved unless courts are unfettered by imperfect general rules. *See id.* at 1177.

50. *See* Samuel L. Bray, *A Little Bit of Laches Goes a Long Way: Notes on* Petrella v. Metro-Goldwyn-Mayer, Inc., 67 VAND. L. REV. EN BANC 1, 7 (2014) (discussing prejudicial delay of laches in context of then forthcoming Supreme Court *Petrella* decision).

51. *See* Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1979 (2014) (Breyer, J., dissenting) (asserting equitable doctrines used to correct defective laws due to universal application). Justice Breyer states that the majority decision in *Petrella* "disables" courts by disallowing the application of laches in cases where a copyright owner knows of an infringement and stands idly by while the alleged infringer invests a fortune. *See id.*

52. *See* Heriot, *supra* note 3, at 919 (highlighting criticism of judicial discretion); *see also* Shyamkrishna Balganesh & Gideon Parchomovsky, *Equity's Unstated Domain: The Role of Equity in Shaping Copyright Law*, 163 U. PA. L. REV. 1859, 1863 (2015) (highlighting Court seeks "minimiz[ation] of judicial discretion"); Bray, *supra* note 50, at 15-16 (stating reasons for prohibiting equitable remedies); Scalia, *supra* note 49, at 1176 (exploring general laws versus judicial discretion). A bright line rule, unhindered by the uncertainty of application, allows a party who has tied up resources in anticipation of litigation to focus on other, more productive uses of such resources. *See* Heriot, *supra* note 3, at 941. Further, the application of equitable remedies may be a detriment to third parties, defendants, and the courts. *See* Bray, supra note 50, at 16. Regarding the potential detriment to courts, Justice Scalia equates discretionary judicial decisions to fact finding, which he argues should remain in the province of juries. *See* Scalia, *supra* note 49, at 1180-81, 1187 (asserting making generally applicable, broad statements of law constitutes proper purpose for judges).

53. *See* Scalia, *supra* note 49, at 1187 (arguing courts should avoid role of fact-finder instead of "expositors of the law"); *see also* Bray, *supra* note 50, at 16 (explaining equitable remedies represent "extremities of judicial power"). Justice Scalia advocated against causes of action that were not established by broadly applicable, general principles because he believed such establishments are an essential component of

certain areas of copyright jurisprudence, the Supreme Court has rejected doctrinal formulations, seeking to minimize judicial discretion.[54] Furthermore, legislators are likely to favor a rule-like statute of limitations to maintain homogeneous case outcomes, restrict adjudicators who do not maintain the same values as lawmakers, and limit judges' decisions that cannot be easily overturned.[55]

B. Copyright and Patent Statutes: Focusing on Statutory Limitations

1. Patent Statute

The U.S. Constitution grants Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[56] Congress exercises this power through the federal patent system by authorizing patentees "the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States."[57] This right to exclude others for a specified time is offered as an incentive to inspire inventors, investors, and entrepreneurs to expend the necessary time and resources researching and developing in order to create useful and beneficial inventions for society.[58] In exchange for a federally granted, time-limited exclusionary right, the patentee must disclose the invention.[59] The constitutionally founded grant of a patent, and the corresponding statutory restrictions and requirements, attempt to strike a balance between encouraging innovation and preventing monopolies that stifle competition, with the ultimate goal of providing the

the judicial process. *See* Scalia, *supra* note 49, at 1185 (articulating preference for "broadly applicable general principles").

54. *See* Balganesh & Parchomovsky, *supra* note 52, at 1863 (listing areas Court maximized judicial discretion). There are a few areas in which the Court has rejected doctrinal formulations: (1) awarding attorney's fees to the wining party; (2) requiring copyright registration as mandatory before filing suit; and (3) allowing the laches defense to bar copyright infringement claims. *See id*.

55. *See* Heriot, *supra* note 3, at 943 (elucidating "divergent paths of the statute of limitations and laches").

56. U.S. CONST. art. I, § 8, cl. 8. The Intellectual Property Clause—as Article 1, Section 8, Clause 8 is known—is thought of as the "Patent Clause" by patent attorneys and the "Copyright Clause" by copyright attorneys. Eugene R. Quinn, Jr., *An Unconstitutional Patent in Disguise: Did Congress Overstep its Constitutional Authority in Adopting the Circumvention Prevention Provisions of the Digital Millennium Copyright Act?*, 41 BRANDEIS L.J. 33, 37 (2002).

57. 35 U.S.C. § 154(a)(1) (2012) (enumerating patent rights and twenty-year term length).

58. *See* Quinn, *supra* note 56, at 40-41.

59. *See* 35 U.S.C. § 112(a) (2012) (providing requirement for written description of invention). The patent statute specifies that the written description must contain "the manner and process of making and using" the invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same, and shall set forth the best mode contemplated by the inventor . . . of carrying out the invention." *Id.* "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor . . . regards as the invention." § 112(b).

maximum benefit to society.[60]

The 1952 Patent Act (Patent Act) and resulting statute broadly define defenses available in patent infringement or validity suits.[61] Several defenses are specifically codified in § 282 of the Patent Act: "noninfringement, absence of liability for infringement or unenforceability," and "invalidity of the patent or any claim" within the patent.[62] The Patent Act replaced the previous five named defenses with the current broader paragraph, changing the language of the statute, but not intending to materially change the substance.[63] The currently listed defenses are intended to include many defenses that are not explicitly specified, like laches.[64]

Case law also established a laches defense to patent-infringement claims at the time the Patent Act was codified, despite that the statute did not explicitly enumerate laches or other equitable defenses.[65] In 1985, the Federal Circuit explicitly interpreted § 282 of the Patent Act as including "equitable defenses such as laches, estoppel and unclean hands."[66] In 2011, the Leahy-Smith America Invents Act (AIA) signified the most substantial change to the U.S. patent system since 1952, but the AIA did not alter the six-year statute of limitations or the defenses listed in the Patent Act.[67]

The Patent Act provides a limitation on damages, not a statute of limitations

60. *See* Quinn, *supra* note 56, at 47-48 (describing ways Congress seeks achieving adequate balance). Congress has the authority to determine ultimate patentability requirements. *Id.* at 49.

61. *See* 35 U.S.C. § 282 (2012) (describing presumption of patent validity and defenses).

62. *See* § 282(b) (listing patent infringement defenses).

63. *See* P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1 (1954), *reprinted in* 75 J. PAT. & TRADEMARK OFF. SOC'Y 161, 215-16 (1993). Many of the Patent Act's defenses were already incorporated into other aspects of the statute. *See id.* at 216. Federico was "a principal draftsman of the 1952 [patent law] recodification." SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 807 F.3d 1311, 1322 (Fed. Cir. 2015) (en banc) (internal citations omitted). Federico stated that "[a]ll the defenses usually listed in textbooks on patent law may be placed in one or another of the enumerated categories, except a few which are no longer applicable in view of changes in the new statute." Federico, *supra*, at 215-16.

64. *See* Federico, *supra* note 63, at 215 (listing implied defenses). The statute's general language intends to encompass other defenses, such as the patented invention was not "made, used or sold by the defendant"; the defendant possessed a valid license to use the invention; and other defenses like "laches, estoppel, and unclean hands." *See id.*

65. *See* Envtl. Def. Fund v. Alexander, 614 F.2d 474, 481 (5th Cir. 1980) (affirming district court's dismissal on basis of laches); Brennan v. Hawley Prods. Co., 182 F.2d 945, 947-48 (7th Cir. 1950) (affirming plaintiff did not properly pursue infringement claim after thirteen-year delay), *cert. denied*, 340 U.S. 865 (1950); Latta v. W. Inv. Co., 173 F.2d 99, 107 (9th Cir. 1949) (holding alleged claims lost by "gross laches"); Westco-Chippewa Pump Co. v. Del. Elec. & Supply Co., 64 F.2d 185, 187-88 (3d Cir. 1933) (holding elements of laches met).

66. *See* Federico, *supra* note 63, at 215..

67. *See* Grace Heinecke, Note, *Pay the Troll Toll: The Patent Troll Model Is Fundamentally at Odds with the Patent System's Goals of Innovation and Competition*, 84 FORDHAM L. REV. 1153, 1159-62 (2015) (noting switch to first-to-file over first-to-invent most significant change); *see also* 35 U.S.C. § 286 (2012) (setting time limitation on damages). The AIA also established a "two-part standard for joinder of defendants," allowed the public to be more interactive with the patent process, and modified "business-method patents." *See* Heinecke, *supra*, at 1160-62. Changes implemented through the AIA did not include venue restrictions or damages. *Id.* at 1162.

phrased in the typical manner.[68] Section 286 of the statute provides that "no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for [a patent] infringement in the action."[69] Because the limitation on recovery is not a statute of limitations that completely bars bringing suit, the effect of the § 286 limitation is merely to limit recovery of any damages to within six years of the filing of the complaint.[70]

Laches was and is used in patent cases because the federal patent laws do not specify a limitation period for initiating an infringement suit.[71] Even though both are designed to "give defendants repose" and peace of mind, laches differs from statutes of limitations in that it requires more than a mere lapse of time, while statutes of limitations require strict application.[72] Unlike a statute of limitations that completely bars the ability to bring suit, the time limitation in § 286 limits recovery for infringing acts to damages committed within six years of the date of filing suit.[73]

In the damages limitation section of the Patent Act, Congress does not mention the availability of equitable doctrines.[74] Yet in a different section, Congress explicitly states that courts may grant injunctions per equity

68. 35 U.S.C. § 286 (setting time limitation in patent cases for damages only). Laches operates independently of the statute of limitations because it does not arise merely due to lapse of time, but when a lapse of time has occurred under prejudicial circumstances. *See* 31 WILLISTON ON CONTRACTS § 79:11 (4th ed.).

69. 35 U.S.C. § 286 (enumerating damages time limitation).

70. *See* 60 AM. JUR. 2D *Patents* § 794 (2014) [hereinafter AM. JUR. 2D *Patents*] (stating § 286 provision operates differently than usual context of statutes of limitations). The damages limitation period counts backward six years from the filing of the patent infringement action. *See id.*

71. *See* 35 U.S.C. § 286 (limiting time to recover damages, not time to sue). Estoppel is also an equitable affirmative defense to patent infringement suits and applies when a patent owner or plaintiff's conduct appears to have permitted the alleged infringing activity. *See* 6 John Gladstone Mills III et al., Patent Law Fundamentals § 20:45 (2d ed. 2015). Estoppel is established when:

> (1) The patentee, through misleading conduct (or silence), leads the alleged infringer to reasonably infer that the patentee does not intend to enforce its patent against the alleged infringer; (2) the alleged infringer relies on that conduct; and (3) the alleged infringer will be materially prejudiced if the patentee . . . proceed[s] with its claim.

Radio Sys. Corp. v. Lalor, 709 F.3d 1124, 1130 (Fed. Cir. 2013); *see also* Mills, *supra*, § 20:45 (relaying elements of estoppel). "Laches focuses on the reasonableness of the plaintiff's delay," while "equitable estoppel focuses on what the defendant has been led to reasonably believe from the plaintiff's conduct." A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1034 (Fed. Cir. 1992) (en banc).

72. *See* Jackson v. Axton, 25 F.3d 884, 888 (9th Cir. 1994) (comparing laches and statute of limitations); *see also* Heriot, *supra* note 3, at 918 (favoring statutes over statute of limitations). Litigants may sense a perceived unfair application of latches over statute of limitations as courts extoll the virtues of laches as a defense "founded on common sense and justice." *See* Heriot, *supra* note 3, at 918-19.

73. *See* Standard Oil Co. v. Nippon Shokubai Kagaku Kogyo Co., 754 F.2d 345, 347-48 (Fed. Cir. 1985) (elucidating "no suit shall be maintained" missing from statute, so no statute of limitations set).

74. *See* 35 U.S.C. § 286 (remaining silent on issue of availability of equitable doctrines).

principles.[75] The statute further elaborates that equitable principles may be used to "prevent the violation of any right secured by patent, on such terms as the court deems reasonable."[76]

2. Copyright Statute

Congress may also exercise power granted by the U.S. Constitution's Intellectual Property Clause through copyright legislation.[77] Similar to the Patent Act, the 1976 Copyright Act (Copyright Act) provides federal protection to original works of authorship if the works meet certain criteria.[78] A copyright grants a limited-time incentive to authors to create and share their work while providing intellectual enrichment for society.[79] The right to sue for copyright infringement typically vests in the copyright owner when an unauthorized third party displays, performs, reproduces, adapts, or distributes the protected work.[80] Once sued for copyright infringement, a defendant can invoke various applicable defenses such as the doctrines of fair use or first sale.[81]

Unlike the patent statute, the copyright statute has an explicit three-year

75. *See* 35 U.S.C. § 283 (2012) (prescribing availability of equitable doctrines).

76. *See id.* (explaining how courts may use equitable doctrines when granting injunctions).

77. U.S. CONST. art. I, § 8, cl. 8 (authorizing congressional granting of exclusive rights to "Authors"); *see also* Balganesh & Parchomovsky, *supra* note 52, at 1868 (tracing copyright law to foundations in U.S. Constitution).

78. *See* 17 U.S.C. § 102(a) (2012) (requiring tangible work, capable of perception and reproduction); *see also* Quinn, *supra* note 56, at 43 n.55 (noting Copyright Act federalized copyright protection and abolished state copyright common law); Daniel Brainard, Note, *The Remains of Laches in Copyright Infringement Cases: Implications of* Petrella v. Metro-Goldwyn-Mayer, 14 J. MARSHALL REV. INTELL. PROP. L. 432, 434 (2015) (providing background on Copyright Act and laches).

79. *See* Balganesh & Parchomovsky, *supra* note 52, at 1868 (explaining copyright law serves predominantly utilitarian goals of encouraging authors and insuring benefit to society); Quinn, *supra* note 56, at 43 (specifying purpose to stimulate arts by "permitting authors to reap . . . rewards of their creative efforts"). Works created on or after January 1, 1978, are generally protected from the date of creation until seventy years after the author's death. 17 U.S.C. § 302(a) (2012). If the work was created before 1978, the first term of protection lasts for twenty-eight years with the option to renew and extend the copyright for a term of sixty-seven years. 17 U.S.C. § 304(a) (2012).

80. *See* 17 U.S.C. § 501(a)-(b) (2012); Balganesh & Parchomovsky, *supra* note 52, at 1868 (describing copyright statute rights and limitations). Establishing copyright infringement generally requires proving ownership of "a valid copyright in the work, that the defendant copied . . . from the work, and that such copying was 'substantial.'" Balganesh & Parchomovsky, *supra* note 52, at 1868; *see also* 17 U.S.C. § 107 (2012) (describing fair use defense).

81. *See* 17 U.S.C. § 107 (describing fair use limitation on copyright rights); 17 U.S.C. § 109 (2012) (describing first sale doctrine); *see also* Balganesh & Parchomovsky, *supra* note 52, at 1868 (describing available defenses to copyright infringement). Fair use of a copyrighted work for "criticism, comment, news reporting, teaching[,] . . . scholarship, or research" is not generally considered to be infringement. 17 U.S.C. § 107. Provisions of 17 U.S.C. § 109(a) provide that a copyright owner who has transferred ownership of a particular copy of the copyrighted work to a third party cannot restrict the subsequent disposal of that particular copyrighted work. 17 U.S.C. § 109(a). For example, the first-sale doctrine allows a purchaser of a book of artwork to resell the book. *See* Kirtsaeng v. John Wiley & Sons, Inc., 133 S. Ct. 1351, 1354-55 (2013) (explaining codification of first-sale doctrine in 17 U.S.C. § 109).

limitation on suits brought for copyright infringement.[82] Each copyright infringing act begins a new period of limitation, but each infringing act is actionable only within three years of its occurrence.[83] As Justice Ginsburg elucidated in *Petrella*, Congress specified two time periods: the longer copyright term, sometimes extending over generations, and the relatively short limitations period, allowing retrospective relief only three years back from the initiation of suit.[84]

Despite the Copyright Act's statute of limitations, courts applied the laches defense in copyright cases before and after the 1957 federal copyright codification.[85] Congress's amendment to the copyright laws, which would become the Copyright Act, included some equitable considerations that would still be applicable.[86] Laches was absent from the list of anticipated equitable considerations.[87] Until the Supreme Court spoke on the issue of laches in copyright infringement suits, the circuits were split as to whether laches was available to bar recovery for claims brought within the statute of limitations.[88]

82. 17 U.S.C. § 507(b) (2012) (providing "no . . . action shall be maintained . . . unless . . . commenced within three years after the claim accrued"). Prior to 1957, the federal government had not codified a statute of limitations for copyright infringement, and federal courts used state statutes of limitations to assess the timeliness of infringement claims. Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1968 (2014). Before 1957, defendants utilized laches in infringement claims by invoking the appropriate state statute of limitations. Daniel Sheerin, Note, *"You Never Got Me Down, Delay":* Petrella v. Metro-Goldwyn-Mayer, Inc. *and the Availability of Laches in Copyright Infringement Claims Brought Within the Statute of Limitations*, 24 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 851, 853 (2014). "Congress amended the 1909 Copyright Act to include" a uniform "statute of limitations for civil copyright claims." *Id.* at 861. The intent behind enacting a uniform statute of limitations was to limit forum shopping among claimants. *See id.* (noting, for example, California's relatively short statute of limitations due to concentration of movie industry).

83. *See Petrella*, 134 S. Ct. at 1969 (explaining "the infringer is insulated from liability for earlier infringements of the same work").

84. *See id.* at 1970.

85. *See* Sheerin, *supra* note 82, at 858-59.

86. *See id.* at 862 (listing equitable considerations). Disabilities, including infancy, insanity, the defendant's failure to appear in the applicable jurisdiction, and fraudulent concealment were some of the equitable considerations mentioned in the House Report accompanying the copyright amendment. *See id*.

87. *See id*.; *see also* Petrella v. Metro-Goldwyn-Mayer, Inc., 695 F.3d 946, 958 (9th Cir. 2012) (noting Senate Report described extinguishing latches and other equitable defenses), *rev'd*, Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962 (2014). When amending the Copyright Act, Congress intended to "establish uniformity and predictability" for statutes of limitations use, and to preclude the use of equitable defenses. *See* Sheerin, *supra* note 82, at 862.

88. *See* Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1967 (2014) (holding laches defense not available in copyright infringement when brought in three-year timeframe); Sheerin, *supra* note 82, at 865-84 (describing different circuits' approaches to laches in copyright infringement cases). Concerned about separation of power issues, the Fourth Circuit did not allow laches for copyright infringement claims that plaintiffs brought within the statute of limitations. *See* Sheerin, *supra* note 82, at 865-67. The Eleventh Circuit recognized laches "only in the most extraordinary circumstances," but maintained a strong presumption that a suit was timely if filed before the statute of limitations ran. *Id.* at 867-69. The Tenth Circuit held a laches defense was available in "rare cases." *Id.* at 869-70. The Sixth Circuit allowed laches only in "the most compelling of cases," similar in application to the Tenth Circuit, by presuming "deference to the statute of limitations." *Id.* at 871, 873. The Second Circuit held laches could be used to bar injunctive relief, "but not legal remedies" for copyright infringement claims "brought within the statute of limitations." *Id.* at 875. The

C. Supreme Court and Federal Circuit Infringement and Laches Decisions

Early on, the Supreme Court recognized defendants' rights to assert laches in patent infringement cases.[89] For example, in 1893 the Court held that the plaintiff who "slept upon his rights" was barred from pursuing his patent infringement claim.[90] In that case, the plaintiff delayed filing suit in order to continue receiving a salary from the defendant, explaining that he felt the defendant would have rejected any demand he made for royalties.[91] The plaintiff further explained that he wished to maintain "amicable relations" with the defendant so long as they continued to pay him a sum that was larger than he would have been entitled to if he had pushed for a patent-based royalty instead.[92] The Court reasoned that such a delay earned the plaintiff "less favorable consideration" than if his conduct was based on "mere inaction."[93]

1. A.C. Aukerman Co. *Decision*

More recently, but before the *Petrella* decision, the Federal Circuit in *A.C. Aukerman Co.* considered the applicability of laches in patent infringement cases.[94] The lower court rejected Aukerman's proffered excuses for delaying pursuit of patent infringement claims, and found there was evidence that the defendant, Chaides, was prejudiced by Aukerman's delay.[95] In agreeing that the specific facts supported the finding of laches, the Federal Circuit confirmed laches as a cognizable equitable defense to a patent infringement claim.[96]

Aukerman unsuccessfully argued that the six-year limitation on damages as specified in 35 U.S.C. § 286 effectively preempted the laches defense.[97] The court explained that the six-year limitation in § 286 does not bar an

Ninth Circuit "adopted a presumption in favor of [the] laches defense, available to bar all relief sought. *Id.* at 877-78.

89. *See* Lane & Bodley Co. v. Locke, 150 U.S. 193, 201 (1893) (holding laches barred plaintiff's suit due to delay in asserting patent rights); *see also* Wollensak v. Reiher, 115 U.S. 96, 100 (1885) (holding laches barred claim when no "special circumstances" excused five-year delay); Mahn v. Harwood, 112 U.S. 354, 363 (1884) (discussing nearly four-year delay too long for obtaining patent reissue).

90. *See Lane & Bodley Co.*, 150 U.S. at 201 (opining plaintiff could not offer good excuse to defeat laches claim).

91. *Id.* at 200 (recounting plaintiff's stated excuse for delay).

92. *See id.* at 201 (quoting plaintiff's testimony).

93. *Id.* at 201 (holding plaintiff's delay not defensible).

94. A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1032 (Fed. Cir. 1992) (en banc) (reaffirming laches applicable in patent infringement cases). The case also evaluates and decides the issue of how equitable estoppel applies to patent infringement. *Id.* at 1026, 1041-45 (considerating equitable estoppel cognizable defense if three elements established).

95. *See id.* at 1027 (highlighting Chaides would have entered bankruptcy if he knew of potential infringement liability). The district court granted summary judgment in favor of Chaides because both laches "and estoppel barred Aukerman's claims for relief." *Id.*

96. *See id*. at 1032.

97. *See id*. at 1029 (summarizing plaintiff's argument). The court discussed and rejected the plaintiff's argument that laches cannot apply within a statute of limitation period. *See id*. at 1030.

infringement suit, but merely places a limit on recovery of damages for infringing acts committed within six years of the infringement suit's filing.[98] The court described a "borrowing" concept where the time period specific to a statute of limitations is applied presumptively to an equitable claim.[99] Accordingly, courts borrow the six-year damages limitation in § 286 and apply it presumptively to the laches defense in patent infringement cases.[100] The court elaborated that the "arbitrary" six-year limitation on damages imposed by Congress does not conflict with laches because the defense is applicable within the discretion of the district court.[101]

Further, the Federal Circuit Court of Appeals reaffirmed that the presumption of laches arises when a patentee delays suing for more than six years.[102] A plaintiff may eliminate the laches presumption by offering evidence showing either a justification for the delay, or that no additional prejudice occurred in the six-year period.[103] A plaintiff may also eliminate the presumption of laches by showing the alleged infringer is guilty of "misdeeds towards the patentee."[104]

2. Petrella *Decision*

In 2014, the Supreme Court held in *Petrella* that defendants cannot invoke laches to bar a copyright infringement suit brought within the three-year statute of limitations window specified in 17 U.S.C. § 507(b).[105] In *Petrella*, the

98. *A.C. Aukerman Co.*, 960 F.2d at 1030 (stating plaintiff's argument "flawed"). The court further explained that there is no specified length of time that is deemed unreasonable, but that the length of time will depend on the circumstances. *See id.*

99. *See id.* at 1034 (explaining reasons for "repose of the claim" same between law and equity).

100. See A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1034 (Fed. Cir. 1992) (en banc) (considering "borrowing" reasonable in this context); *see also* Bray, *supra* note 50, at 9-12 (highlighting early Supreme Court cases where laches used in conjunction with statute of limitations). For example, the Court applied laches to an eight-year-old claim to enforce a trust, despite an existing ten-year statute of limitations. *See* Patterson v. Hewitt, 195 U.S. 309, 317 (1904) (reasoning "some degree of diligence" required in filing suit); Bray, *supra* note 50, at 12 (summarizing Court's laches application in *Patterson v. Hewitt*, 195 U.S. 309 (1904)).

101. *See A.C. Aukerman Co.*, 960 F.2d at 1030 (asserting lack of Congressional intent to take away court's "equitable powers" in patent cases). The court further explained that "[n]othing in section 286 suggests that Congress intended by reenactment of this damage limitation to eliminate the long recognized defense of laches or to take away a district court's equitable powers in connection with patent cases." *Id.* The court stated unequivocally that "an equitable defense under section 282 and the arbitrary limitation of section 286 do not conflict." *Id.* at 1030-31.

102. *See id.* at 1037-39 (clarifying burden of persuasion does not shift once presumption established). The laches period begins when a patentee knows or should know of infringement, where the court assesses the six years backward from the date of suit, in accordance with the patent statute. *See id*. at 1034-35.

103. *See id*. at 1038 (explaining patentee's options to rebut laches defense).

104. *See id*. (stating maxim, "He who seeks equity must do equity"); *see also supra* note 46 and accompanying text (discussing unclean hands doctrine may bar recovery in equity).

105. *See* Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1967 (2014) (summarizing holding). Boxer, Jake LaMotta, collaborated with Frank Petrella in creating a screenplay that became the subject of this case. *See id.* at 1970. Metro-Goldwyn-Mayer (MGM) acquired the rights to the screenplay, and created an

alleged infringing work was the movie Raging Bull, which is based on the life of boxing champion, Jake LaMotta.[106] In 1998, his daughter, Paula Petrella, informed MGM, the purported infringer, that she had obtained the copyright to Raging Bull, and that any derivative work—specifically, exploitation of the film—infringed her copyright.[107] Nine years later, Paula Petrella filed an infringement suit alleging MGM "violated and continued to violate her copyright."[108] Asserting the equitable doctrine of laches, MGM moved for summary judgment.[109]

The Court held that if a copyright infringement claim is brought in the three-year statutory window, laches cannot bar a claim for damages.[110] The Court reasoned that when Congress enacts a statute of limitations, as it did in copyright law, laches is no longer available because it is an equitable defense that directly conflicts with the statute.[111] Justice Ginsburg explained that laches is "essentially gap-filling, not legislation-overriding."[112] The Court noted that allowing judges to set a time limit other than the one Congress approved "would tug against the uniformity Congress sought to achieve when it enacted § 507(b)."[113] In sum, the majority asserted that Congress had clearly spoken

Academy Award-winning movie based on Mr. LaMotta's life story. *See id.* at 1970-71. When Mr. Petrella died in 1981, his copyright renewal rights passed to his heirs; the petitioner and sole heir of the screenplay copyright was Mr. Petrella's daughter, Paula Petrella. *See id.* at 1971.

106. *See id*. at 1970 (describing allegedly infringing work).

107. *See id.* at 1971.

108. *Id.* (noting first hint of suit given seven years after filing renewal of copyright).

109. *Petrella*, 134 S. Ct. at 1971 (asserting several grounds for summary judgment); Brief in Opposition at 7-8, Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962 (2014) (No. 12-1315), 2013 WL 3991860 (arguing "district court had ample discretion" to find laches due to unreasonable delay causing prejudice). The U.S. District Court for the Central District of California granted, and the Ninth Circuit affirmed, the laches-based dismissal. *See Petrella*, 134 S. Ct. at 1971-72.

110. *See Petrella*, 134 S. Ct. at 1967 (explaining delay in suit can be considered at remedial stage).

111. *See* Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1973 (2014) (recognizing "merger of law and equity" courts in 1938); *see also* Bray, *supra* note 50, at 12-13 (noting Supreme Court will not apply laches when statute of limitations applies). The issue for the Court then turned on whether a claim was brought in equity or at law. *See* Bray, *supra* note 50, at 12 (explaining categorization of "exclusive" equitable jurisdiction or "concurrent" law and equity jurisdiction not consistently applied). Justice Harlan opined that when a suit is brought within the statute of limitations, laches should be used only when there is a "clear case of unreasonable delay" by the plaintiffs. *See* Sheldon v. Keokuk N. Line Packet Co., 8 F. 769, 773 (C.C.W.D. Wis. 1881); *see also* Bray, *supra* note 50, at 13 (advocating requirement of "clear case" of laches works alongside statute of limitations).

112. *Petrella*, 134 S. Ct. at 1974 (explaining flaws of defendant's assertion). Interpreting equity doctrines into statutes provides grounds for potentially violating the separation of powers doctrine. *See* Balganesh & Parchomovsky, *supra* note 52, at 1867.

113. *See Petrella*, 134 S. Ct. at 1975 (explaining dangers of allowing laches in copyright infringement suits). Before the *Petrella* decision, the circuits were split on whether laches applied to copyright infringement suits. *See* Emily A. Calwell, Note, *Can the Application of Laches Violate the Separation of Powers?: A Surprising Answer from a Copyright Circuit Split*, 44 VAL. U. L. REV. 469, 470-71 (2010) (writing before *Petrella* decision); *see also supra* note 88 (describing different outcomes on laches applicability in copyright law amongst circuits). A few of the circuits that restricted laches argued the defense drew concerns for the separation of powers. *See* Calwell, *supra*, at 490. The Ninth Circuit alone upheld the use of laches within the statutory limit, reasoning infringements that occurred over a long period that were "so similar in nature, they

and courts were wrong to use laches to try to shorten the congressionally imposed limitation.[114] Laches remains available to bar equitable relief, but only in extraordinary circumstances.[115]

The dissent in *Petrella* centers around the inequitable action of the copyright owner, who, with full notice of an intended infringement, delays suit while the supposed infringer spends large sums of money and intervenes only after the alleged infringer has generated profits.[116] Justice Breyer, for the dissent, argued that the Copyright Act's three-year statute of limitations does not necessarily imply Congress intended to bar the use of laches.[117] Justice Breyer pointed out that perhaps Congress solely wished to create uniformity in the federal courts instead of borrowing state statutes of limitations, which varied among jurisdictions.[118]

The dissent highlighted that Congress and the Federal Rules of Civil Procedure define the civil action as *one* action that is amenable to both legal and equitable defenses.[119] Although conceding laches may not apply often, the dissent argued that the doctrine helps a court "bring about a fair result" where

should be treated as one infringement"; the Ninth Circuit "did not include any mention of the separation of powers doctrine in its opinion." *See id.* at 494-95.

114. *See Petrella*, 134 S. Ct. at 1975 (reiterating court never used laches to bar entire claims within congressionally prescribed limitations period). *But see* Bray, *supra* note 50, at 14-15 (highlighting Court implicitly required "clear statement from Congress" in abrogating application of equitable doctrines). It remains unclear if Congress, by enacting a statute of limitations, intended to forestall the use of equitable doctrines, because the Court has previously allowed coexistence between laches and statutes of limitations. *See id.* at 17 (noting statutes of limitations not irrelevant in applying laches).

115. *See Petrella*, 134 S. Ct. at 1977 (stating lower courts may take into account delay in assessing profits and injunctive relief). The Court stated that the lower courts should also consider MGM's reliance on Petrella's delay, MGM's early notice of the claims, the benefit to MGM in seeking a declaratory judgment, the protection afforded MGM's investment, and any other factors justifying modifying injunctive relief or profits. *See id.* at 1978-79.

116. *See id.* at 1979 (Breyer, J., dissenting) (asserting majority decision "disables federal courts from addressing . . . inequity"). Justice Ginsburg responded that "there is nothing untoward about waiting to see whether an infringer's exploitation undercuts the value of the copyrighted work, has no effect on the original work, or even complements it." *Id.* at 1976 (majority opinion).

117. *See* Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1982 (2014) (Breyer, J., dissenting) (highlighting no mention of barring laches in 1957 Act or text of copyright statute); *see also* Bray, *supra* note 50, at 16 (asserting Congress's lack of intent to bar laches with enactment of statute of limitations). *But see* Sheerin, *supra* note 82, at 890-91 (asserting laches availability in some jurisdictions undermines congressional desire for uniformity and reducing forum shopping).

118. *See Petrella*, 134 S. Ct. at 1982 (Breyer, J., dissenting) (providing alternative theory for congressional action). Justice Breyer reacts to the majority's assertion that the use of laches would "tug against the uniformity Congress sought to achieve" by explaining Congress was likely silent because "federal district courts, generally, recognize these equitable defenses anyway." *Id.*; *see supra* note 112 (discussing conflict between Congress and courts).

119. *See Petrella*, 134 S. Ct. at 1985 (Breyer, J., dissenting) (highlighting changes in modern litigation); FED. R. CIV. P. 2 (providing "[t]here is one form of action—the civil action"); FED. R. CIV. P. 8(c) (relating non-exclusive list of affirmative defenses). The Federal Rules of Civil Procedure specify laches as an affirmative defense, further codifying the equitable defense's availability to defendants. FED. R. CIV. P. 8(c) (specifying eighteen affirmative defenses).

appropriate.[120] The dissent concluded that while Congress was clear about a three-year limitation, such a limitation does not necessarily limit the application of equitable defenses.[121]

3. SCA Hygiene *Decision*

In September 2015, the Federal Circuit again upheld laches as a defense to patent infringement despite the holding in *Petrella*.[122] In *SCA Hygiene*, the petitioner, SCA Hygiene Products Aktiebolag (SCA), notified the defendant, First Quality Baby Products, LLC (First Quality), that First Quality's incontinence product infringed SCA's patent in October 2003.[123] First Quality promptly responded to SCA's notice in November 2003, claiming SCA's patent was invalid.[124] Starting in 2006, First Quality expended capital "surrounding its adult incontinence business," arguing such expenditures satisfied the prejudice element of laches.[125] After seeking reexamination and confirming the patentability of all of SCA's patent claims in March 2007, SCA filed a patent infringement suit against First Quality in August 2010—more than six years after the preliminary correspondence.[126]

In upholding laches, the majority reiterated the reasoning in *A.C. Aukerman Co.*, noting that 35 U.S.C. § 282 codified laches and the time limitation in 35 U.S.C. § 286 is not an explicit statute of limitations.[127] The court asserted that merging courts of law and equity "allowed laches to bar legal relief," and

120. *See Petrella*, 134 S. Ct. at 1986 (Breyer, J., dissenting) (arguing for retention of laches in "copyright's lexicon").

121. *See id.* (questioning different treatment of copyright by removal of equitable defenses).

122. *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 807 F.3d 1311, 1315 (Fed. Cir. 2015) (en banc) (concluding Congress codified laches in 35 U.S.C. § 282(b)(1)). In another recent patent infringement case, plaintiffs moved for reconsideration of their case, arguing laches was unavailable in light of the Supreme Court's decision in *Petrella*. *See* Reese v. Sprint Nextel Corp., No. 2:13-cv-03811-ODW(PLAx), 2014 WL 3724055, at *1 (C.D. Cal. July 24, 2014); Olivia T. Luk et al., *Area Summary: 2014 Patent Law Decisions on Key Issues at the Federal Circuit*, 64 AM. U. L. REV. 735, 756-57 (2015) (highlighting two patent infringement cases questioning laches after *Petrella* decision).

123. *See SCA Hygiene*, 807 F.3d at 1315 (demonstrating SCA's contention First Quality infringed its patent on "adult incontinence products").

124. *See id.* (claiming in letter to SCA, First Quality alleged, "an invalid patent cannot be infringed").

125. *See id.* at 1316 (describing panel's holding of harmless prejudice in granting summary judgment on latches defense).

126. *See id.* at 1315-16 (detailing history of correspondence-or lack thereof-between SCA and First Quality); Luk et al., *supra* note 122, at 757-58 (describing *SCA Hygiene* en banc Federal Circuit case facts). SCA filed with the USPTO on July 7, 2004, seeking reexamination. *See SCA Hygiene*, 807 F.3d at 1316. A panel of the Federal Circuit first heard the case. *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC (*SCA Hygiene I*), 767 F.3d 1339, 1340-41 (Fed. Cir. 2014) (writing for three judges); Luk et al., *supra* note 122, at 757-58 (describing procedural history of *SCA Hygiene* case).

127. *See SCA Hygiene*, 807 F.3d at 1318. The Federal Circuit panel decided that *A.C. Aukerman Co.* remained valid precedent because *A.C. Aukerman Co.* could "only be overruled by the Supreme Court or an en banc panel" of the Federal Circuit. *SCA Hygiene I*, 767 F.3d at 1345. The panel rejected SCA's argument that the *Petrella* holding should reach beyond the copyright context into patent law. *See id.*

reiterated that laches bars "recovery of pre-filing damages only."[128] The majority submitted that the damages limitation in the patent statute and the statute of limitations in the Copyright Act are functionally equivalent, but maintained that Congress intended to incorporate laches into § 282(b)(1).[129] The majority pointed to House and Senate Reports at the time Congress codified § 282 that indicated laches was incorporated into the patent statutes.[130]

The court also held that laches is a bar to legal relief by way of pre-1952 case law incorporated into the congressional understanding of the 1952 Patent Act.[131] The court highlighted two circuit court cases that allowed equitable defenses to bar legal claims.[132] Further, the court mentioned that laches and the congressionally imposed time limitation present no conflict with the separation of powers doctrine because Congress intended to preserve laches within § 282.[133]

Finally, the court asserted that acts of patent infringement are fundamentally different than copyright infringement because "innocence is no defense to patent infringement."[134] The court explained that to maintain a copyright suit, the accuser must have some evidence that the alleged infringer had access to or should have known of the infringing work, thereby putting the infringer on notice.[135] By contrast, in the patent field, companies may have independently developed an infringing product, and therefore, have "no safeguard against tardy claims demanding a portion of their commercial success."[136] The court concluded by noting that laches does not typically bar the patentee's rights in recovering ongoing royalties, yet the flexibility of equitable doctrines allows a

128. *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 807 F.3d 1311, 1318 (Fed. Cir. 2015) (en banc).

129. *See id.* at 1321 (recognizing "no substantive distinction" between copyright statute of limitations and § 286 damage limitation application).

130. *See id.* at 1321-22 (noting § 282 "broadly sets out" available defenses). The court relied on commentary by Federico that stated section § 282 "*would include . . . equitable defenses such as laches*, estoppel and unclean hands." *Id.* at 1322 (emphasis in original). The dissent takes issue with such reliance on Federico's "statement made two years after the enactment of the Patent Act" and asserted that, "though [Federico was] central to its drafting, [he] was not a member of Congress voting on the measure." *Id.* at 1337 (Hughes, C.J., dissenting) (noting Supreme Court does not consider such "post-hoc" statements legislative history).

131. *See id.* at 1323-26 (majority opinion) (recognizing laches defense to legal claims in "[n]early every circuit").

132. *See SCA Hygiene*, 807 F.3d at 1326-28. The court noted that neither "SCA, nor amici, . . . identify . . . single appellate-level . . . case stating . . . laches is inapplicable to legal damages." *See also* Banker v. Ford Motor Co., 69 F.2d 665, 666 (3d Cir. 1934) (supporting proposition laches bars relief for legal claims); Ford v. Huff, 296 F. 652, 658 (5th Cir. 1924) (recognizing equitable claim of laches bars legal relief).

133. *See SCA Hygiene*, 807 F.3d at 1329-30; *supra* note 129 and accompanying text (discussing § 282's incorporation of equitable doctrines including laches).

134. SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 807 F.3d 1311, 1330 (Fed. Cir. 2015) (en banc) (explaining "major difference" between patent and copyright infringement).

135. *See id.* at 1330 (relying on N. Coast Indus. V. Jason Maxwell, Inc., 972 F.2d 1031, 1033 (9th Cir. 1992)).

136. *See id.* (stating "calculus is different" in patent law).

court to balance the circumstance-specific factors to reach a just solution for recovery.[137]

The dissent in *SCA Hygiene* argued that the majority espouses a "patent-specific approach" to laches applicability, and ignores Congress's intent and Supreme Court precedent as recently expressed in *Petrella*.[138] The dissent emphasized that the Supreme Court made it "abundantly clear that there must be a particular justification in the statute" before the Federal Circuit can pronounce "special rules for patent cases that depart from the rules for other areas of civil litigation."[139] The dissent pointed out that Supreme Court clarity on the issues of statutes of limitations and laches, referring in part to the *Petrella* decision, should stand before lower court precedent upholding the use of laches under questionable circumstances.[140]

The dissent contended that Congress did not intend to incorporate laches into the Patent Act as an additional "time-bar" for patent infringement claims because Supreme Court case law clearly stated laches could not bar a claim for legal relief filed within a statutorily defined limitations period.[141] The dissent pointedly stated that "Congress was well-aware of the nature of patent infringement in 1952, and it must be presumed that Congress took these concerns into account when it established the six-year limitations period for bringing a claim for damages."[142] Ultimately, the dissent maintained that matters of policy relating to the differences between patent and copyright infringement claims should be, and have been, left to Congress to decide rather than the courts.[143]

III. ANALYSIS

In copyright law, Congress enacted an explicit statute of limitations by

137. *See id.* at 1333 (highlighting importance of flexible rules of equity and court discretion in making determinations about injunction). This is similar to the concept highlighted in *Petrella* where the Supreme Court allowed lower courts to take into account laches-like circumstances in determining damages in copyright cases, even though laches may not be allowed to completely bar a claim. *See* Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1978 (2014).

138. *See SCA Hygiene*, 807 F.3d at 1333 (Hughes, C.J., dissenting) (warning Supreme Court repeatedly cautioned Federal Circuit against creating patent-specific rules). Five justices dissented and joined in Circuit Judge Hughes's opinion that concurs in part and dissents in part with the majority opinion. *Id*. The dissent agreed that laches should remain available to bar requests for equitable relief. *See id*.

139. *Id.* at 1335 (asserting need for "clear evidence" of congressional intent justifying departure from *Petrella* holding).

140. *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 807 F.3d 1311, 1342 (Fed. Cir. 2015) (en banc) (Hughes, C.J., dissenting) (arguing difference between copyright and patent law not enough to ignore *Petrella* holding).

141. *See id.* at 1334 (asserting § 286 expresses congressional judgment on timeliness of damages claims).

142. *Id*. at 1342 (advocating resolve of competing policy concerns best left to Congress, not judiciary).

143. *See id*. (stating *Petrella* decision "turned on the conflict between laches and a statutory limitations period"). The dissent argues the court "should not undermine Congress' judgment in 1952 according to our own assessment of the current policy landscape." *Id.*

clearly stating, "No Civil action shall be maintained . . . unless it is commenced within three years after the claim accrued."[144] The Court in *Petrella* reasoned that when Congress creates an express statute of limitations, as in copyright law, equitable doctrines such as laches are no longer applicable to claims seeking legal relief.[145] Allowing laches in the circumstances like copyright law constitutes a conflict between the judicial and legislative branches of government, violating the separation of powers doctrine.[146]

Patent law, however, does not have an explicit statute of limitations.[147] Instead, Congress enacted a six-year damages limitation.[148] As demonstrated by the express statute of limitations in copyright law, Congress is capable of enacting explicit statutes of limitations, implying that Congress deliberately chose not to do so for patent law.[149] While Congress may prefer to limit judicial discretion by overriding case law with statutes, Congress specifically did not do so in the context of patent law.[150] Congress merely enacted a limit on damages, and not a firm statute of limitations.[151] And had Congress wished to overrule case law precedent on the application of laches, the 2011 enactment of the AIA presented the perfect opportunity.[152]

Furthermore, Congress did not intend to abrogate the use of equitable doctrines in patent law, as described by one of the key 1952 patent law drafters.[153] To be sure, Congress did not outright include laches in the Patent Act, and it is hard to know what Congress intended when it did not clearly write the doctrine into the statute.[154] But with the recent opportunity to amend

144. 17 U.S.C. § 507(b) (2012) (articulating copyright law limitations on criminal proceedings and civil actions); *see supra* note 82 and accompanying text (describing copyright law statute of limitations).

145. *See supra* note 111 and accompanying text (describing Supreme Court majority's reasoning in *Petrella* decision).

146. *See supra* notes 112-113 and accompanying text (discussing conflict between legislative and judicial branches when applying equitable doctrines).

147. *See supra* notes 68-70 and accompanying text (describing time limitation on damages applicable in patent law). Patent law treatises explicitly describe the time limitation in 35 U.S.C. § 286 as *not* a statute of limitations. *See* AM. JUR. 2d. *Patents*, *supra* note 70, § 794.

148. 35 U.S.C. § 286 (2012).

149. *Compare* 17 U.S.C. § 507 (providing limitations period in criminal and civil matters), *with* 35 U.S.C. § 286 (providing limitation on damages only). Further highlighting that there is a difference between Congress's direction in copyright law and patent law, it is worth noting the difference in title between the copyright and patent time limitation sections. *Compare* 17 U.S.C. § 507 (labeling copyright law statute of limitations "[l]imitations on actions"), *with* 35 U.S.C. § 286 (naming patent law limitations provision "[t]ime limitation on damages").

150. *See* Heriot, *supra* note 3, at 943-44 (positing legislators and courts in equity favor rule-like and standard-like limitations respectively). As fact patterns and case circumstances begin to vary widely, a more standard-like approach, with flexibility in application, may be more helpful in avoiding inequitable case outcomes. *See id.*

151. *See supra* note 149 (comparing copyright and patent statutes).

152. *See supra* note 67 and accompanying text (discussing enactment of AIA).

153. *See supra* notes 63-64, 130 and accompanying text (describing commentary by Federico and reliance on commentary by Federal Circuit).

154. *See supra* notes 141-143 and accompanying text (discussing dissenting argument in *SCA Hygiene*).

the statute, and the ability to remove laches from the purview of judges through enactment of a statute of limitations, laches clearly should remain available in patent cases.[155]

Upholding laches in patent law even though it is not allowed in the copyright context does not create a special, unjustified rule for patent law alone.[156] Congress has designated different limitation rights for both patent and copyright law by creating a true statute of limitations for copyright infringement and merely a damages limitation in patent infringement suits.[157] By allowing laches in patent cases, the Federal Circuit is not creating a unique rule just for patent law, but is merely carrying out Congress's intention.[158]

Because Congress did not intend to remove laches from the list of available defenses to patent infringement, judges that allow the defense in appropriate cases are not violating the separation of powers doctrine.[159] Indeed, unfettered judicial discretion is concerning, especially when such discretion is viewed as not only imprudent decision making, but overstepping constitutional prohibitions.[160] Yet as long as courts remain within their constitutionally mandated realm of power, judicial discretion can be more successful in achieving justice than an arbitrary line drawn up in a statute.[161]

Concededly, the evaluation and application of laches is discretionary because a judge can choose whether to apply laches as case-specific

Chief Justice Hughes concernedly asserted that the Federal Circuit majority is putting its own interpretation based on "the current policy landscape" above the judgment of the 1952 Congress. *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 807 F.3d 1311, 1342 (Fed. Cir. 2015) (en banc) (Hughes, C.J., dissenting).

155. *See supra* note 67 and accompanying text (detailing AIA enactment).

156. *See supra* notes 138-139 and accompanying text (describing *SCA Hygiene* dissent's warning about creating a "patent-specific approach" to laches); *see also supra* note 14 and accompanying text (highlighting specific instances where Supreme Court admonished special patent-specific rules).

157. *See supra* notes 68-70 and accompanying text (describing time limitation on damages applicable in patent law); *supra* note 82 and accompanying text (describing copyright law statute of limitations); *supra* note 149 and accompanying text (noting section title differences between copyright and patent statutory limitations).

158. *Compare supra* notes 68-70 and accompanying text (describing time limitation on damages applicable in patent law), *with supra* note 82 and accompanying text (describing copyright law statute of limitations). If Congress intended to bar laches in patent law—as the Supreme Court asserts is the case in copyright law—then Congress would have enacted a typical statute of limitations instead of a time limitation on damages. *See supra* note 111 and accompanying text (noting enactment of statute of limitations generally bars laches). *But see supra* notes 68-70 and accompanying text (highlighting patent statutory time limitation on damages not equivalent to statute of limitations).

159. *See supra* notes 112-113 and accompanying text (discussing conflict between legislative and judicial branch when applying equitable doctrines to legal claims); *supra* note 149 and accompanying text (noting additional differences between copyright and patent law statutory limitations).

160. *See supra* notes 113-114 and accompanying text (discussing Justice Ginsburg's concern application of laches would "tug against the uniformity Congress sought"); *see also supra* note 53 and accompanying text (noting Justice Scalia's preference for broadly applicable rules).

161. *See supra* note 49 and accompanying text (discussing how case-by-case justice can be more appealing and just in certain circumstances).

circumstances unfold.[162] Even so, laches is a well-established doctrine mandating particular elements that must be met in order to be relevant.[163] Laches is not just about barring suit after a certain amount of time has passed, but turns on whether the plaintiff delayed and whether such delay caused the defendant material prejudice.[164] Inherent due to the specific, well-established elements of laches on the discretionary use of the doctrine, these restrictions help to quell fears that laches is not the kind of policy the judiciary should be supporting.[165]

IV. CONCLUSION

The Supreme Court's holding in *Petrella* called into question the applicability of laches in patent infringement suits. Copyright and patent law both protect intellectual property, and both have statutory limitation requirements for infringement suits. For patent law, however, Congress proscribed merely a limit on the amount of recoverable damages, and not a complete bar to suing, as is the case in copyright law.

The key argument in *Petrella* was that if Congress enacts a statute of limitations—a complete bar to filing suit after the specified period has lapsed—then Congress has clearly stated that equitable defenses, such as laches, no longer apply. The Federal Circuit distinguished this from patent infringement suits by highlighting that Congress did not enact a statute of limitations for patent infringement suits, inferring that they may have intended to make laches an available defense. Furthermore, there is evidence that Congress intended to preserve the equitable defenses for patent law.

Finally, while laches' applicability is at the discretion of judges, its well-defined elements provide clear guidelines for all parties in predicting and determining whether laches is a viable argument under the particular circumstances. Laches is meant to provide a sense of justice that encourages plaintiffs to assert their rights in a timely manner. By maintaining laches as an available defense for patent infringement, the judiciary can better promote

162. *See supra* notes 44-45 and accompanying text (emphasizing discretionary nature of laches and equitable doctrines); *supra* note 48 and accompanying text (noting likely reason for laches popularity with courts).

163. *See supra* note 27 and accompanying text (highlighting two required elements of laches); *supra* note 31 and accompanying text (describing applicability of laches depends on particular facts and circumstances); *see also supra* note 25 (noting laches applied in rule-like fashion).

164. *See supra* note 72 and accompanying text (specifying differences between time-bar of statute of limitations and time-bar of laches requiring more).

165. *See supra* note 50 and accompanying text (highlighting structure and guidance provided by doctrine of laches); *see also supra* note 120 and accompanying text (explaining laches helps to bring about "fair result"); *supra* note 137 and accompanying text (explaining flexibility of latches allows court to reach "just solution" by balancing circumstance-specific factors). The circumstance-specific factors must still be weighed within the framework of the well-established laches elements of inexcusable delay that caused material prejudice. *See supra* note 27 and accompanying text (highlighting two required elements of laches).

equitable results because "there is justice too in an end to conflict and in the quiet of peace."[166]

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166. Envtl. Def. Fund v. Alexander, 614 F.2d 474, 481 (5th Cir. 1980) (affirming district court's dismissal on basis of laches).