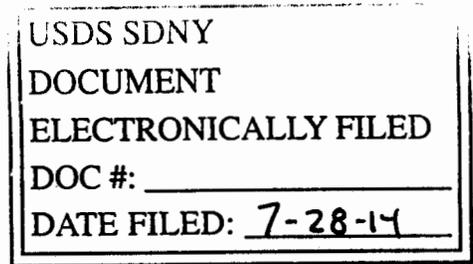


UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK



JOAO CONTROL & MONITORING
SYSTEMS, LLC,

Plaintiff,

-v-

LIQUID CASH, LLC,

Defendant.

No. 12-cv-6315 (RJS)
ORDER

RICHARD J. SULLIVAN, District Judge:

On May 31, 2013, the Court entered default judgment against Defendant. (Doc. No. 12.) Now before the Court is Plaintiff's motion to set damages against Defendant. (Doc. No. 20.) For the reasons set forth below, the motion is denied without prejudice to renewal.

Pursuant to 35 U.S.C. § 284, Plaintiff is entitled to "damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court." 35 U.S.C. § 284. Where, as here, the "damages sought are based on a 'reasonable royalty,' that royalty is derived 'from a hypothetical negotiation between the patentee and the infringer when the infringement began.'" *Astrazeneca AB v. Apotex Corp.*, 985 F. Supp. 2d 452, 489 (S.D.N.Y. 2013) (quoting *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 868 (Fed. Cir. 2010)). "The royalty is to be determined by considering the fifteen so-called *Georgia-Pacific* factors." *Id.*; see *Georgia-Pac. Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970). Nevertheless, although § 284 requires a reasonable royalty as a minimum, "a patentee who puts on little or no satisfactory evidence of a reasonable royalty can[not] successfully appeal on the ground that the amount awarded by the court

is not 'reasonable' and therefore contravenes section 284." *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1382 (Fed. Cir. 2003) (internal quotation marks omitted).

Here, Plaintiff has given the Court insufficient evidence to calculate any reasonable royalty. Plaintiff has provided the Court with the amount of Defendant's gross revenues from 2006 to 2013 and with two settlement agreements with other defendants in other cases. Plaintiff does not state how much of Defendant's revenues were generated from infringing products, although it submitted a declaration from Defendant claiming that none of Defendant's revenues resulted from infringing products. (Decl. of Brian A. Capobianco, dated Mar. 24, 2014, Doc. No. 22.) For one of the settlement agreements, Plaintiff provides the settlement payment but does not provide the revenues from infringing products or the defendant's gross revenues. For the other settlement agreement, Plaintiff provides the settlement payment and the revenues from infringing products, but does not provide the defendant's gross revenues. With this data alone, the Court has no way to compare the settled cases to this case and cannot compute a reasonable royalty. *See Georgia-Pac. Corp.*, 318 F. Supp. at 1120.

Accordingly, IT IS HEREBY ORDERED THAT the motion is DENIED without prejudice to renewal. IT IS FURTHER ORDERED THAT the parties, including Defendant, shall appear for a conference on September 4, 2014 at 2:00 p.m. to address whether Plaintiff will be able to obtain adequate information to renew its motion. If the parties intend to appear telephonically, they shall contact the Court for further instructions no later than August 29, 2014. The Clerk of the Court is respectfully directed to terminate the motion pending at docket number 20.

SO ORDERED.

Dated: July 28, 2014
New York, New York


RICHARD J. SULLIVAN
UNITED STATES DISTRICT JUDGE