



3. Plaintiff SiOnyx, LLC is awarded post-judgment interest at the rate established by 28 U.S.C. § 1961, which is 2.40%.
4. Judgment is entered in favor of plaintiffs SiOnyx, LLC and the President and Fellows of Harvard College and against defendant Hamamatsu Photonics K.K. as to its claim that Hamamatsu Photonics K.K. willfully infringed United States Patent No. 8,080,467.
5. Judgment is entered in favor of plaintiff SiOnyx, LLC and against defendant Hamamatsu Photonics K.K. on its claim for correction of ownership, and declaring that Dr. James Carey is a co-inventor of United States Patent Nos. 9,614,109; 9,293,499; 9,190,551; 8,994,135; 8,916,945; 8,884,226; 8,742,528; 8,629,485; and 8,564,087, and should be named as such on the patents.
6. Judgment is entered awarding and transferring ownership of the following United States Patents to SiOnyx, LLC: No. 9,614,109; No. 9,293,499; No. 9,190,551; No. 8,994,135; No. 8,916,945; No. 8,884,226; No. 8,742,528; No. 8,629,485; and No. 8,564,087.
7. Hamamatsu Photonics K.K. and Hamamatsu Corporation are ordered to provide SiOnyx, LLC and the President and Fellows of Harvard College, within 60 days of this final judgment and order, with an accounting of sales of any products between April 5, 2019, and July 25, 2019, practicing any of the following United States Patents: No. 9,614,109; No. 9,293,499; No. 9,190,551; No. 8,994,135; No. 8,916,945; No. 8,884,226; No. 8,742,528; No. 8,629,485; No. 8,564,087; and No. 8,080,467.

8. Except as may be otherwise authorized by agreement, Hamamatsu Photonics K.K. and Hamamatsu Corporation, and their officers, agents, servants, employees, attorneys, and all other persons acting in concert or participation with them, are hereby permanently enjoined from making, using, offering for sale, selling, or importing products practicing the following United States Patents: No. 9,614,109; No. 9,293,499; No. 9,190,551; No. 8,994,135; No. 8,916,945; No. 8,884,226; No. 8,742,528; No. 8,629,485; and No. 8,564,087.
9. Except as may be otherwise authorized by agreement, Hamamatsu Photonics K.K. and Hamamatsu Corporation, and their officers, agents, servants, employees, attorneys, and all other persons acting in concert or participation with them, are hereby permanently enjoined from making, using, offering for sale, selling, or importing products practicing United States Patent No. 8,080,467.

**So Ordered.**

Dated: September 24, 2019

/s/ F. Dennis Saylor IV  
F. Dennis Saylor IV  
United States District Judge

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

**SIONYX, LLC and PRESIDENT AND  
FELLOWS OF HARVARD COLLEGE,**

**Plaintiffs,**

**v.**

**HAMAMATSU PHOTONICS K.K.;  
HAMAMATSU CORPORATION;  
OCEAN OPTICS, INC.; and  
DOES 1 THROUGH 10,**

**Defendants.**

**Civil Action No.  
15-13488-FDS**

**FINAL JUDGMENT AND ORDER**

**SAYLOR, J.**

In accordance with the jury verdict rendered May 9, 2019, and the post-trial rulings of this Court on July 25, 2019, it is hereby ORDERED, ADJUDGED, AND DECREED as follows:

1. Judgment is entered in favor of plaintiff SiOnyx, LLC against defendant Hamamatsu Photonics K.K. as to its claim for breach of contract in the amount of \$796,469.00, plus pre-judgment interest in the amount of \$1,091,481.00, for a total judgment of \$1,887,950.00.
2. Judgment is entered in favor of plaintiff SiOnyx, LLC against defendant Hamamatsu Corporation as to its claim for unjust enrichment in the amount of \$580,640.00, plus pre-judgment interest in the amount of \$660,536.00, for a total judgment of \$1,241,176.00.
3. Plaintiff SiOnyx, LLC is awarded post-judgment interest at the rate established by

28 U.S.C. § 1961, which is 2.40%.

4. Judgment is entered in favor of plaintiffs SiOnyx, LLC and the President and Fellows of Harvard College and against defendant Hamamatsu Photonics K.K. as to its claim that Hamamatsu Photonics K.K. willfully infringed United States Patent No. 8,080,467.
5. Judgment is entered in favor of plaintiff SiOnyx, LLC and against defendant Hamamatsu Photonics K.K. on its claim for correction of ownership, and declaring that Dr. James Carey is a co-inventor of United States Patent No. 8,080,467 and should be named as such on the patent.
6. Judgment is entered awarding and transferring ownership of the following United States Patents to SiOnyx, LLC: No. 9,614,109; No. 9,293,499; No. 9,190,551; No. 8,994,135; No. 8,916,945; No. 8,884,226; No. 8,742,528; No. 8,629,485; and No. 8,564,087.
7. Hamamatsu Photonics K.K. and Hamamatsu Corporation are ordered to provide SiOnyx, LLC and the President and Fellows of Harvard College, within 60 days of this final judgment and order, with an accounting of sales of any products between April 5, 2019, and July 25, 2019, practicing any of the following United States Patents: No. 9,614,109; No. 9,293,499; No. 9,190,551; No. 8,994,135; No. 8,916,945; No. 8,884,226; No. 8,742,528; No. 8,629,485; and No. 8,564,087.
8. Except as may be otherwise authorized by agreement, Hamamatsu Photonics K.K. and Hamamatsu Corporation, and their officers, agents, servants, employees, attorneys, and all other persons acting in concert or participation with them, are hereby permanently enjoined from making, using, offering for sale, selling, or

importing products practicing the following United States Patents: No.

9,614,109; No. 9,293,499; No. 9,190,551; No. 8,994,135; No. 8,916,945; No.

8,884,226; No. 8,742,528; No. 8,629,485; and No. 8,564,087.

9. Except as may be otherwise authorized by agreement, Hamamatsu Photonics K.K. and Hamamatsu Corporation, and their officers, agents, servants, employees, attorneys, and all other persons acting in concert or participation with them, are hereby permanently enjoined from making, using, offering for sale, selling, or importing products practicing United States Patent No. 8,080,467.

**So Ordered.**

Dated: July 26, 2019

/s/ F. Dennis Saylor  
F. Dennis Saylor IV  
United States District Judge

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

SIONYX, LLC and PRESIDENT AND  
FELLOWS OF HARVARD COLLEGE,

Plaintiffs,

v.

HAMAMATSU PHOTONICS K.K. and  
HAMAMATSU CORPORATION,

Defendants.

Civil Action No.  
15-13488-FDS

VERDICT FORM

**A. Breach of Contract**

1. **Liability.** As to the claim under Massachusetts law for breach of contract, we find for:

☒ SiOnyx, LLC ☐ Hamamatsu Photonics K.K.

*If you find in favor of SiOnyx, LLC on Question 1, proceed to Questions 2 and 3:*

2. **Date of Breach.** We find that the date that the contract was first breached was

February 1, 2008.

3. **Damages.** We award damages to SiOnyx, LLC for breach of contract in the following amount:

\$ 796,469.00 (state the amount)

**B. Unjust Enrichment**

4. **Liability.** As to the claim under Massachusetts law for unjust enrichment, we find for:

☒ SiOnyx, LLC ☐ Hamamatsu Corporation

*If you find in favor of SiOnyx, LLC on Question 4, proceed to Questions 5 and 6:*

5. **Date of Breach.** We find that the date that the unjust enrichment first occurred was

January 10, 2010.

6. **Damages.** We award damages to SiOnyx, LLC for unjust enrichment in the following amount:

\$ 580,640.00 (state the amount)

**C. Statute of Limitations/Equitable Estoppel**

*The following questions concern the contentions of Hamamatsu Photonics K.K. and Hamamatsu Corporation that the statute of limitations or equitable estoppel bars the claims of SiOnyx, LLC for breach of contract and unjust enrichment. Your verdict must be consistent: in other words, as to either claim, you may not find both that Hamamatsu Photonics K.K. or Hamamatsu Corporation is liable and that either the statute of limitations or equitable estoppel applies.*

7. We find that the claims of SiOnyx, LLC for breach of contract and unjust enrichment are barred by the statute of limitations:

           Yes ✓ No

8. We find that the claims of SiOnyx, LLC for breach of contract and unjust enrichment are barred by equitable estoppel:

           Yes ✓ No

**D. Correction of Inventorship**

*The following questions concern the contention of SiOnyx, LLC that certain patents of Hamamatsu Photonics K.K. (U.S. Patent Nos. 9,614,109; 9,293,499; 9,190,551; 8,994,135; 8,916,945; 8,884,226; 8,742,528; 8,629,485; and 8,564,087) do not list the correct inventors, because Dr. James Carey is not included. If you find for SiOnyx, LLC, you must further decide whether Dr. Carey is the sole inventor or a co-inventor; you may not find that he is both.*

9. As to the claim under 35 U.S.C. § 256 for change of inventorship, we find for:

✓ SiOnyx, LLC

           Dr. Carey is the sole inventor or

✓ Dr. Carey is a co-inventor

           Hamamatsu Photonics K.K.



**E. Patent Infringement**

**10. Liability.** As to the claim under 35 U.S.C. § 271 for infringement of U.S. Patent No. 8,080,467 ("the '467 patent"), we find for:

☒ SiOnyx, LLC and the President and Fellows of Harvard College ☐ Hamamatsu Photonics K.K.

*If you find for SiOnyx, LLC and the President and Fellows of Harvard College on Question 10, proceed to Questions 11, 12, and 13:*

**11. Date of Infringement.** We find that the date that the '467 patent was first infringed was

December 20, 2011

**12. Willfulness.** We find that SiOnyx, LLC and the President and Fellows of Harvard College have proved that Hamamatsu Photonics K.K. infringed the '467 patent willfully:

☒ Yes ☐ No

**13. Damages.** We award damages to SiOnyx, LLC and the President and Fellows of Harvard College for patent infringement in the following amount:

\$ 0 (state the amount)

**F. Defenses: Patent Invalidity**

*The following questions concern the contention of Hamamatsu Photonics K.K. that certain claims of the '467 patent are invalid for one or more reasons. Your verdict must be consistent: in other words, you may not find both that Hamamatsu Photonics K.K. is liable for infringement and that any defense as to that claim has been proved.*

**14. Obviousness.** We find that the following claim of the '467 patent is invalid because it is obvious:

Claim 2: ☐ Yes ☒ No

**15. Anticipation.** We find that the following claims of the '467 patent are invalid because they were anticipated:

Claim 1: ☐ Yes ☒ No

Claim 3: ☐ Yes ☒ No

**16. Lack of Enablement.** We find that the following claim of the '467 patent is invalid because it does not satisfy the enablement requirement:

Claim 1: \_\_\_\_\_ Yes ☒ No

**Your deliberations are complete. Please sign and date this form, and notify the court officer.**

Stephen M. Kelleher  
Foreperson

5/9/2019  
Date

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

**SIONYX, LLC, and  
PRESIDENT AND FELLOWS OF  
HARVARD COLLEGE,**

**Plaintiffs,**

**v.**

**HAMAMATSU PHOTONICS K.K.,  
HAMAMATSU CORP., OCEAN OPTICS,  
INC., and DOES 1-10,**

**Defendants.**

**Civil Case No.  
15-13488-FDS**

**ORDER ON DEFENDANTS' MOTION FOR JUDGMENT AS A MATTER OF LAW**

**SAYLOR, J.**

Defendants Hamamatsu Photonics K.K. and Hamamatsu Corporation have moved post-trial for judgment in their favor as a matter of law. In a patent case, the district court must analyze a motion for judgment as a matter of law according to the law of the First Circuit. *See August Tech. Corp. v. Camtek, Ltd.*, 655 F.3d 1278, 1281 (Fed. Cir. 2011).

A party that seeks to overturn a jury verdict “faces an uphill battle.” *Monteagudo v. Asociacion de Empleados del Estado Libre Asociado de P.R.*, 554 F.3d 164, 170 (1st Cir. 2009). To grant judgment as a matter of law, the court must determine that the “evidence points so strongly and overwhelmingly in favor of the moving party that no reasonable jury could have returned a verdict adverse to that party.” *Malone v. Lockheed Martin Corp.*, 610 F.3d 16, 20 (1st Cir. 2010). All evidence presented to the jury, and all reasonable inferences drawn from that evidence, must be viewed in the light most favorable to the verdict. *Osorio v. One World Techs.*,

*Inc.*, 659 F.3d 81, 84 (1st Cir. 2011). The jury’s verdict should stand unless the evidence, viewed in such a favorable light, nonetheless “points unerringly to an opposite conclusion.” *Zimmerman v. Direct Fed. Credit Union*, 262 F.3d 70, 75 (1st Cir. 2001).

First, defendants seek to overturn the jury’s finding that plaintiffs’ claims for breach of contract and unjust enrichment were not barred by the statute of limitations. Essentially, defendants contend that plaintiffs knew or should have known that defendants had breached the non-disclosure agreement when they failed to return plaintiffs’ confidential information in February 2008.

“Whether a plaintiff knew or should have known of an injury so as to trigger the running of a statute of limitations is, with rare exception, a jury issue.” *Santiago Hodge v. Parke Davis & Co.*, 909 F.2d 628, 633 (1st Cir. 1990); *Lawson v. Affirmative Equities Co., L.P.*, 341 F. Supp. 2d 51, 68 (D. Mass. 2004). Defendants here have not shown that this case qualifies as such a “rare exception.”

Second, defendants contend that plaintiffs are not owed damages for the breach of contract and unjust enrichment claims after the non-disclosure agreement expired on January 11, 2015. Defendants contend that “any actions taken by [defendants] after January 11, 2015 that resulted in disclosing [plaintiffs’] confidential information did not violate the [non-disclosure agreement] and therefore cannot sustain an action for breach of contract.” (Docket 772 at 17). Defendants therefore seek to reduce the award for unjust enrichment to include only plaintiffs’ profits earned through 2014, which would lower the award from \$580,640 to \$198,517. Defendants do not, however, seek to reduce the jury’s award for breach of contract because the “jury’s verdict does not explain” those damages.

Although defendants may not have “disclosed” confidential information after the non-disclosure agreement ended in January 2015, the jury’s verdict can be reasonably construed to incorporate a finding that defendants continued to reap the benefit of their earlier breach by selling products that it had designed using plaintiffs’ confidential information. Defendants have not presented a compelling reason to overturn the verdict in that respect, and the Court will not do so.

Third, and finally, defendants contend that the Court should reverse the jury’s finding that HPK willfully infringed the ’467 patent. Essentially, defendants contend that because plaintiffs presented evidence that defendants were monitoring plaintiffs’ intellectual property only between 2006 and 2009, and because plaintiffs did not file the ’467 patent application until 2010, defendants “simply could not have known about the ’467 Patent or its application during the time it might be said to have been monitoring [plaintiffs’] patents.” But, as defendants acknowledge, the evidence established that defendants were monitoring plaintiffs’ related antecedent patents and applications. The jury’s verdict can be reasonably construed to mean that this monitoring gave defendants knowledge of the ’467 patent and its teachings. The Court will therefore not overturn the jury’s finding that of willful infringement.

Accordingly, and for the foregoing reasons, defendants’ motion for judgment as a matter of law is DENIED.

**So Ordered.**

Dated: July 25, 2019

/s/ F. Dennis Saylor IV  
F. Dennis Saylor IV  
United States District Judge

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

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**SIONYX, LLC, and  
PRESIDENT AND FELLOWS OF  
HARVARD COLLEGE,**

**Plaintiffs,**

**v.**

**HAMAMATSU PHOTONICS K.K.,  
HAMAMATSU CORP., OCEAN OPTICS,  
INC., and DOES 1-10,**

**Defendants.**

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**Civil Case No.  
15-13488-FDS**

**ORDER ON PLAINTIFFS' MOTION FOR EQUITABLE RELIEF**

**SAYLOR, J.**

Plaintiffs have filed a post-trial motion seeking multiple forms of injunctive relief that they seek to incorporate in the final judgment.<sup>1</sup>

**1. Ownership of the Disputed Patents**

First, plaintiffs seek an injunction awarding ownership of the nine disputed patents to SiOnyx, and directing HPK to take any steps necessary to perfect that ownership.<sup>2</sup> SiOnyx asserted a claim for correction of inventorship under 35 U.S.C. § 256 as to the disputed patents, contending that Dr. James Carey should have been listed as the inventor (or a co-inventor). The

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<sup>1</sup> Plaintiffs also filed a motion seeking pre-judgment and post-judgment interest and an accounting. (Docket No. 780). The issue of an accounting, which is a form of equitable relief, is addressed in this memorandum and order.

<sup>2</sup> The term “disputed patents” refers to the following United States Patents: No. 9,614,109; No. 9,293,499; No. 9,190,551; No. 8,994,135; No. 8,916,945; No. 8,884,226; No. 8,742,528; No. 8,629,485; and No. 8,564,087.

jury was asked both to render a verdict as to that claim (it found for SiOnyx) and specifically to find whether Dr. Carey was the sole inventor or a co-inventor of those patents (it found that he was a co-inventor). The jury also found for SiOnyx on the breach of contract claim, which was based on the non-disclosure agreement between SiOnyx and HPK.

The request for injunctive relief arises out of section 5 of the non-disclosure agreement, which provides that “the Disclosing Party” (that is, SiOnyx) “claims ownership of the Confidential Information disclosed by the Disclosing Party and all *patent . . .* and other intellectual property rights in, or *arising from*, such Confidential Information.” (Ex. 11 § 5) (emphasis added). Essentially, plaintiffs contend that (1) because the jury found that HPK breached the non-disclosure agreement, (2) it necessarily found that HPK used plaintiffs’ confidential information in obtaining the disputed patents, (3) those patents therefore “arose from” that confidential information, and (4) the patents are therefore owned by SiOnyx pursuant to section 5 of the agreement.

There appears to be no doubt, based on the jury’s verdict, that the disputed patents arose, at least in part, from the use of plaintiffs’ confidential information. There was substantial evidence that HPK employees used the confidential information in the course of developing the technology that resulted in the patents, and it is difficult to construe the verdict reasonably in any other way. The jury also specifically found that Dr. Carey was a co-inventor, not the exclusive inventor, of the technology in those patents. The question is whether those conclusions can be reconciled with Section 5 of the agreement: that is, if Dr. Carey was only a co-inventor, can SiOnyx nonetheless claim exclusive ownership of the patents?

The answer to that question appears to be “yes.” It is clear that “issues of patent ownership are distinct from questions of inventorship.” *Israel Bio-Engineering Project v.*

*Amgen, Inc.*, 475 F.3d 1256, 1263 (Fed. Cir. 2007). The jury here concluded, in substance, that HPK took Dr. Carey’s inventive ideas, added other inventive ideas to it, and obtained the disputed patents as a result.<sup>3</sup> HPK should not be deemed a joint *owner* of the disputed patents simply because the jury concluded it was a joint *inventor*; to do so would treat section 5 of the agreement as a nullity.

It is true that “where inventors choose to cooperate in the inventive process, their joint inventions may become joint property without some express agreement to the contrary.” *Ethicon, Inc. v. U.S. Surgical Corp*, 135 F.3d 1456, 1466 (Fed. Cir. 1998). Here, however, there is such an express agreement. Again, that agreement specifically provided that SiOnyx “claim[ed] ownership” of “all patent[s]” that “ar[ose] from” its confidential information. And rather than cooperating in the inventive process with SiOnyx, HPK instead took confidential information SiOnyx had entrusted to it and used it for its own gain. Because section 5 makes clear that SiOnyx owns any patents that arose from the use of its confidential information, and because the disputed patents clearly arose from the information, the Court concludes that SiOnyx is the owner of the disputed patents.

Defendants further contend that because the confidentiality obligation in the non-disclosure agreement expired in seven years (that is, on January 11, 2015), the provision in section 5 likewise expired and cannot be enforced. Nothing in the agreement, however, suggests that any patent rights of SiOnyx arising out of the confidential information would expire in 2015, or that HPK would get a free pass for misappropriating such information after 2015. Indeed, that would be an irrational interpretation of the agreement; the fact that the confidentiality restrictions

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<sup>3</sup> For the sake of simplicity, the Court will refer to HPK as the “inventor,” rather than the assignee of the actual inventors.



expired in 2015 did not mean that HPK could misappropriate that confidential information in 2008, use it to acquire patents without the knowledge of SiOnyx, and avoid any consequence after 2015. The fact that the information at issue may no longer be confidential does not mean that the ownership of the patents did not vest in SiOnyx at the time they were obtained.

Accordingly, the Court will issue an injunction granting ownership of the disputed patents to SiOnyx. The Court will not, however, grant plaintiffs' request to direct HPK to take steps necessary to perfect that ownership. As phrased, that request is unduly vague and would not permit the Court to enter a clear and enforceable injunction.

## **2. Injunctive Relief for Breach of Contract**

Second, plaintiffs seek an injunction prohibiting defendants "from making, using, offering for sale, selling, or importing the accused products and/or products practicing the disputed patents as a remedy for the breach of contract."

Again, SiOnyx has established that it owns the disputed patents in question, pursuant to contract. Furthermore, Section 9 of the non-disclosure agreement states explicitly that "any breach of [defendant's] obligations under this Agreement will cause irreparable harm to [SiOnyx]." (Ex. 11 § 9). While such a stipulation may not be dispositive, it is entitled to considerable weight. The evidence at trial indicated that the principal assets of SiOnyx consisted of its intellectual property; it is common sense that the misuse of its confidential information, and the obtaining of patents based on that information, would constitute irreparable harm to the company. Any monetary damages awarded fail to compensate plaintiffs for the entirety of the business opportunities lost due to the use of their confidential information. Moreover, defendants themselves testified that the accused products only constitute an "insignificant" amount of its overall business, and the public interest is not disserved by enjoining HPK from

continuing to sell the products.

Accordingly, HPK will be enjoined, as a remedy for breach of contract, from making, using, offering for sale, selling, or importing the accused products and/or products practicing the disputed patents.

### **3. Injunctive Relief for Patent Infringement**

Third, plaintiffs also seek an injunction as a remedy for infringement of U.S. Patent No. 8,080,467 (“the ’467 patent”) prohibiting HPK from “making, using, offering for sale, selling, or importing the accused products” or, in the alternative, that the Court should “grant an ongoing royalty to Plaintiffs under 35 U.S.C. § 283.”

In addition to succeeding on the merits, a party seeking a permanent injunction based on patent infringement must demonstrate:

- (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of the hardships between the [parties], a remedy in equity is warranted; and (4) that the public interest will not be disserved by a permanent injunction.”

*eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 390 (2006).

As to the merits, the jury specifically concluded that HPK willfully infringed the ’467 patent. There is some question as to whether plaintiffs have shown ongoing irreparable harm damages arising from HPK’s infringement of the ’467 patent; as plaintiffs acknowledge, “SiOnyx does not currently make CCD image sensors, photodiodes, or avalanche photodiodes.” (Pl. Mem. at 13). Nonetheless, SiOnyx does make laser-processed CMOS image sensors, and those sensors (according to the trial testimony) are competitive products with CCD sensors. Furthermore, and in any event, direct competition with an infringer is not necessary for a permanent injunction to issue. *See Mytee Prods. v. Harris Research, Inc.*, 439 Fed. Appx. 882,

887 (Fed. Cir. 2011) (non-precedential). Under the circumstances, principles of equity weigh in favor of granting an injunction.

It is highly doubtful that money damages are adequate to compensate plaintiff for the harms caused by the infringement. SiOnyx was a small startup, competing against a large foreign manufacturer, and it is impossible to quantify the full extent of the harms, including such things as loss of market share, lost business opportunity, and harm to reputation. The balance of hardship weighs heavily in favor of an injunction, as SiOnyx is a tiny company relying on a single type of technology, whereas HPK is a large company with a broad and diversified range of products. Finally, the public interest would not be disserved by the issuance of an injunction.

Accordingly, plaintiffs have satisfied the *eBay* factors required to obtain a permanent injunction as to infringement of the '467 patent.

#### **4. Accounting**

Finally, plaintiffs seek an order requiring defendants to provide an “accounting of [their] revenues and profits” from the sales of accused products during the period between April 5, 2019, and whatever future date that defendants have shown compliance with any injunction prohibiting them from selling the accused products as a remedy for the breach of contract. “A damages award for pre-verdict sales of the infringing product does not fully compensate the patentee because it fails to account for post-verdict sales . . . .” *Fresenius USA, Inc. v. Baxter Intern., Inc.*, 582 F.3d 1288, 1303 (Fed. Cir. 2009). Accordingly, in order to ensure that plaintiffs are appropriately compensated, the Court will order defendants to provide an accounting of revenues and profits from the sale of the accused products between April 5, 2019, and July 25, 2019.

**5. Conclusion**

For the foregoing reasons, plaintiffs' motion for equitable relief and motion for an accounting are GRANTED in part and DENIED in part, as follows:

1. The final judgment will include an injunction awarding and transferring ownership of the disputed patents to SiOnyx, LLC.
2. The final judgment will include an injunction prohibiting HPK and HC from making, using, offering for sale, selling, or importing products practicing the disputed patents.
3. The final judgment will include an injunction prohibiting HPK and HC from making, using, offering for sale, selling, or importing products infringing the '467 patent.
4. The final judgment will require defendants to provide an accounting of sales of any products practicing the disputed patents between April 5, 2019, and July 25, 2019.

**So Ordered.**

Dated: July 25, 2019

/s/ F. Dennis Saylor IV  
F. Dennis Saylor IV  
United States District Judge

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

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SIONYX, LLC, and  
PRESIDENT AND FELLOWS OF  
HARVARD COLLEGE,

Plaintiffs,

v.

HAMAMATSU PHOTONICS K.K.,  
HAMAMATSU CORP., OCEAN OPTICS,  
INC., and DOES 1-10,

Defendants.

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Civil Case No.  
15-13488-FDS

ORDER ON PLAINTIFFS' MOTION FOR PRE-JUDGMENT INTEREST  
AND POST-JUDGMENT INTEREST

SAYLOR, J.

Plaintiffs have moved post-trial for an award of both pre- and post-judgment interest.<sup>1</sup>

First, plaintiffs seek \$1,091,481 as prejudgment interest on the damages awarded for breach of contract.

Mass. Gen Laws ch. 231, § 6C provides as follows: "In all actions based on contractual obligations, upon a verdict, finding or order for judgment for pecuniary damages, interest shall be added by the clerk of the court to the amount of damages, at the contract rate, if established, or at the rate of twelve per cent per annum from the date of the breach or demand."

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<sup>1</sup> In the same motion (Docket No. 780), plaintiffs seek additional relief in the form of a post-verdict accounting. The resolution of that issue will be included in the Court's order on plaintiffs' motion for equitable relief.

The application of § 6C leads to a straightforward calculation here. The jury awarded plaintiffs damages of \$796,469 for breach of contract; the jury found that the contract was breached on February 1, 2008; and the non-disclosure agreement did not contain a “contract rate.” Accordingly, therefore, applying a rate of 12% per annum from February 1, 2008, to the jury's damages award results in a total of \$1,091,481 in prejudgment interest.<sup>2</sup>

Second, plaintiffs seek \$660,536 as prejudgment interest on the damages awarded for unjust enrichment. The parties’ main dispute centers on whether § 6C or § 6H of Chapter 231 applies to the unjust-enrichment claim. Plaintiffs rely on *Bushkin Associates, Inc. v. Raytheon Co.*, 906 F.2d 11 (1st. Cir. 1990), in which the First Circuit held that actions for unjust enrichment, or quantum meruit, are “encompassed” by ch. 231, § 6H. *Id.* at 18. That case does not answer the precise question here, however, because, as the *Bushkin* court noted, § 6H was not “enacted” until “after the . . . commencement” of that case. *Id.* at 14, n.3. Defendants, by contrast, rely on *Mill Pond Associates, Inc. v. E & B Giftware, Inc.*, 751 F. Supp. 299 (D. Mass. 1990). Defendants point to language in *Mill Pond* that “Massachusetts courts have held that prejudgment interest should not be applied to cases in which the court calculates the plaintiff's damages by measuring the defendant's wrongful profits.” *Id.* at 300. Defendants appear to contend that because the jury's award for unjust enrichment in this case was calculated by measuring HPK's wrongful profits, prejudgment interest should not apply. *Id.*

Arguably, *Bushkin* and *Mill Pond* point in different directions. Nonetheless, and for two reasons, the Court will apply § 6H. First, although *Mill Pond* did not include any claims for

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<sup>2</sup> Defendants contend that the prejudgment interest award should be limited under the Supreme Judicial Court's decision in *Bank v. Thermo Elemental Inc.*, 451 Mass. 638 (2008). That case allows for the reduction of an interest award when “expenses incurred as a result of a contract breach are not paid by a plaintiff until after the breach has occurred.” *Id.* at 662-63. In this case, however, the jury's award for breach of contract damages did not include any “expenses” that plaintiffs have attempted to recover. *Thermo Elemental* is thus inapplicable.

unjust enrichment, and thus did not even attempt to answer the question at issue here. Second, nothing in *Mill Pond* calls directly into question the First Circuit's clear holding in *Bushkin* that unjust enrichment claims are encompassed by § 6H. Accordingly, applying § 6H, and applying a date of breach of January 10, 2010, prejudgment interest will be ordered in the amount of \$660,536.

Third, plaintiffs seek post-judgment interest under 28 U.S.C. § 1961 on all damages awarded. Section 1961 provides that “interest shall be allowed on any money judgment in a civil case recovered in a district court” and that “such interest shall be calculated from the date of the entry of the judgment, at a rate equal to the weekly average 1-year constant maturity Treasury yield, as published by the Board of Governors of the Federal Reserve System, for the calendar week preceding the date of the judgment.” Defendants do not oppose such an order. Defendants will therefore be ordered to pay post-judgment interest at the statutory rate.

Accordingly, and for the foregoing reasons, plaintiffs’ motion for pre-judgment and post-judgment interest is GRANTED in part, as follows:

1. The judgment will include a provision requiring HPK to pay \$1,091,481 in pre-judgment interest;
2. The judgment will include a provision requiring HC to pay \$660,536 in pre-judgment interest; and
3. The judgment will include a provision requiring plaintiffs to pay post-judgment interest at the rate established by 28 U.S.C. § 1961.

**So Ordered.**

Dated: July 25, 2019

/s/ F. Dennis Saylor IV  
F. Dennis Saylor IV  
United States District Judge