

CLASS 17

**INFRINGEMENT AND THE SCOPE OF THE
PATENT RIGHT**

**PATENT LAW & POLICY
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Today's Agenda

Indirect Infringement

Territorial Scope of Patents

Patent Exhaustion

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Indirect Infringement

35 U.S.C. 271 Infringement of patent.

(a) ...

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

Indirect Infringement

Inducement Infringement

Contributory Infringement

Lucent v. Gateway (Fed. Cir. 2009)

Lucent's Claims: methods of using on-screen tools to input information.

Microsoft: sells software which (might) infringe when used

Why no direct infringement?

Contributory Infringement

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

Microsoft: the software has many noninfringing uses

Lucent: the "date picker" tool has no other uses

[What is the correct frame of analysis for S N-I Uses?]

Inducement Infringement

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

What must Lucent show to show inducement infringement?

How do they do so?

Inducement v. Contributory

	Inducement Infringement	Contributory Infringement
Source	271(b)	271(c)
Elements	direct infringement D's culpable conduct (intent)	direct infringement D sold material part of invention knowledge (?) no substantial non-infringing uses
Knowledge requirement	"specific intent" { knowledge that the acts infringe the patent } or { willful blindness }	{ knowledge of the patent and of the capability for infringement }
geographic scope	none	the contributory infringement must occur in the US

America Invents Act of 2011

§ 298. Advice of counsel

The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.

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Territorial Scope of Patents

Territorial Limits on Patents

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

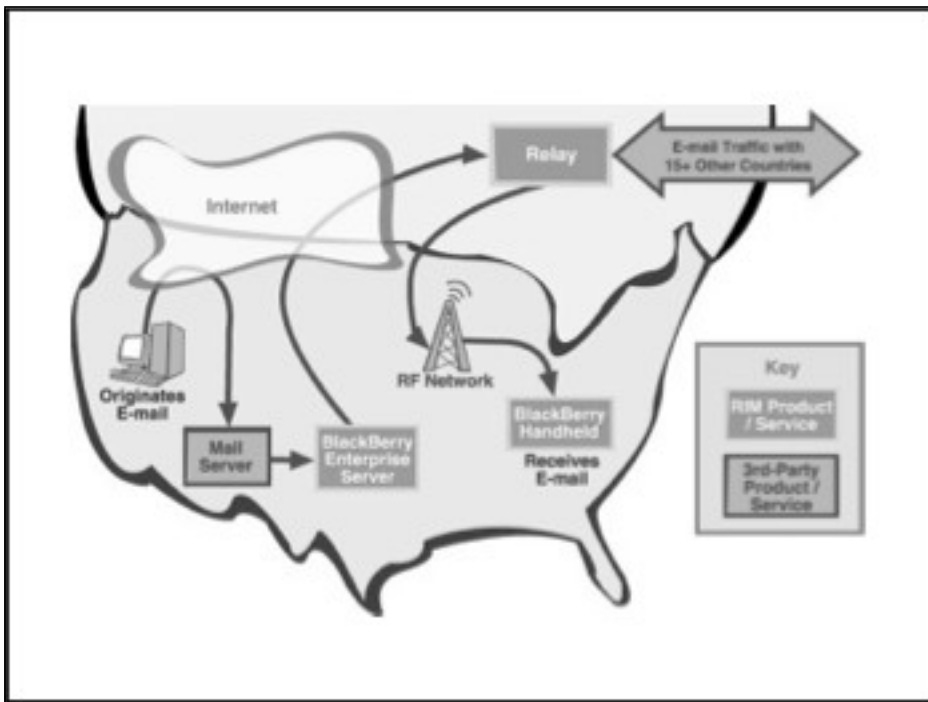
(b) ...

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination,



NTP v. Research in Motion (Fed. Cir. 2005)





The court finds that the apparatus / system claims are "used" in the US, but that the method claims are not. Why?

Why did RIM not “sell” or “offer to sell” the method claims?

35 USC 271(f)

(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

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Patent Exhaustion

Patent Exhaustion

The “first sale” doctrine and “repair vs reconstruction”

Once a patented product is sold,
the patent rights (to the product sold) terminate.



Jazz Photo v. ITC (Fed. Cir. 2001)



Repair vs Reconstruction

Note the burden of proof shift:

[1] patentee proves infringement

[2] infringer proves affirmative defense (repair)

Repair vs Reconstruction

Repair	Reconstruction
disassembly and cleaning	recreation of a use or spent article
replacement of worn parts	creation of a new product
rebuilding of engines	

Why were the Jazz Photo activities not reconstruction?

Does it matter that the original cameras were not meant to be reused?

**How can Fuji avoid the refurbishment
of their single-use cameras?**

Can it?

NEXT CLASS

DEFENSES TO INFRINGEMENT

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