

Extra Judicial Enforcement: Crossing Borders

Your Panel

Denis Monégier du Sorbier

Founding Partner: HOYNG ROKH MONEGIER



Dr. Roland Kehrwald

Partner: Wildanger Kehrwald Graf v. Schwerin & Partners mbB



Matthew Hitching

Head of European Intellectual Property Group
Canon



Infringement is Limited Territorially

35 U.S.C. 271(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.

- The U.S. patent laws ‘do not, and were not intended to, operate beyond the limits of the United States.’” *Brown v. Duchesne*, 60 U.S. (19 How.) 183, 15 L.Ed. 595 (1856),

... Except When It Is Not Limited Territorially

35 USC Section 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.

... Except When It Is Not Limited Territorially

35 USC Section 271(f)(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.

*CASE STUDY 1:
NTP, INC. V. RESEARCH IN MOTION, LTD.,
418 F.3D 1282 (FED CIR 2005)*

Section 271(a)

Infringement is (Sometimes) Limited Territorially

NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282 (2005)

- The use of a claimed system under section 271(a) is the place at which the system as a whole is put into service, i.e., the place where control of the system is exercised and beneficial use of the system obtained.
 - The location of the Relay in Canada **did not**, as a matter of law, **preclude infringement** [based on use] of the asserted **system** claims in this case.
 - Because beneficial use by customers occurred in the U.S.
- But . . .

Infringement is (Sometimes) Limited Territorially

NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282 (2005)

- "We reach a different conclusion as to NTP's asserted method claims. [. . .] We therefore hold that a process cannot be used 'within' the United States as required by section 271(a) unless each of the steps is performed within this country."
 - The location of the Relay in Canada **did preclude infringement** of the asserted **method** claims in this case.

CASE STUDY 2:
LIFE TECHNOLOGIES CORP. V. PROMEGA CORP.,
U.S. NO. 14-1538 (2017)

Section 271(f)

Life Technologies v. Promega: The Facts

- Invention relates to a toolkit for genetic testing. The toolkit is used to "amplify" small samples of genetic material so they can be used by e.g., law enforcement.
- Life-Tech shipped only the claimed enzyme *Taq* polymerase from the United States to the U.K.
 - where it was combined with four other claimed components
 - to produce toolkits containing all five claimed components.
- Jury returned a verdict finding infringement and that all of LifeTech's worldwide sales were attributable to infringing acts in the United States.
- District Court overruled the jury. Judgment for LifeTech.

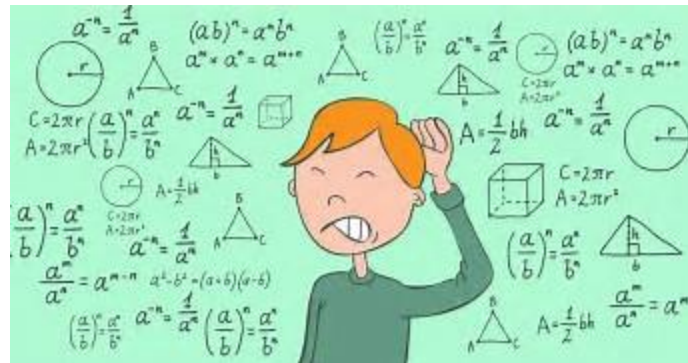
Life Technologies v. Promega: The Fed. Cir. Ruling

- A single *important* component can be a "substantial portion" of the components of the patented invention.
- Substantial evidence supports the jury's conclusion that the *Taq* polymerase is a "substantial portion."



Life Technologies v. Promega: The Holding

1 component \neq "substantial portion"



Life Technologies v. Promega: Supreme Court's Rationale

- "substantial portion" is quantitative, not qualitative.
- "components" in § 271(f)(1) is plural, therefore a single component can never constitute a "substantial portion"
- Any other read of § 271(f)(1) would "undermine § 271(f)(2)'s express reference to a single component":
 - "**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, * * * intending that such component will be combined outside of the United States."

Life Technologies v. Promega: Future

Not Decided:

- How much more than one component is needed to satisfy the "substantial portion" requirement?
 - Would 2 of the 5 components suffice?
 - What if there are only two components in the claimed system?

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