



Contributory Infringement, Proof of Infringement & Repairs: The US Perspective

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Outline

- Types of Infringement
 - Direct Infringement
 - Induced Infringement
 - Contributory Infringement
- Proving Infringement
- Physician's Immunity Statute
- Claim Drafting Tips
- Repair/Reconstruction

Types of Infringement

- Direct Infringement: 35 U.S.C. 271(a)
 - Actually practicing a claimed invention
 - Making, using, offering to sell, or selling a claimed product or performing a claimed method – **in the US**
 - or
 - Importing a patented product – **into the US**
 - Does not require knowledge of the patent
- Induced (Indirect) Infringement: 35 U.S.C. 271(b)
 - Actively inducing another to directly infringe a patent.
 - Requires knowledge of the patent.
- Contributory (Indirect) Infringement: 35 U.S.C. 271(c)
 - Offering to sell or selling a component of a patented invention leading to another's direct infringement.
 - Requires knowledge that the component is a material part of the invention and has no non-infringing use.
 - Requires knowledge of the patent.

Proving Induced Infringement

Must Prove:

- Direct infringement and knowledge of the Patent
- Defendant actively, knowingly, and intentionally encouraged the infringement.
- Defendant intended to cause the infringement.

May Rely On:

- Instructions for use
- Brochures
- Advertisements
- Promotional materials

Induced Infringement

Extraterritorial Inducement

The weight of authority supports the finding that

1. extraterritorial manufacture and sale of a product, coupled with
2. importation of that product by another into the US

constitutes induced infringement by the extraterritorial manufacturer under 35 U.S.C. § 271(b).

Proving Contributory Infringement

Patent Owner Must Prove:

- Direct infringement and knowledge of the Patent
- That defendant:
 - offered to sell or sold within the US . . .
 - a component of a patented product or material used in practicing a patented process
 - the product/material constitutes a material part of the invention and . . .
 - knew the same to be especially made or adapted for use in an infringement, and not a staple article of commerce
- Accused product has no substantial non-infringing uses
- Alleged contributory act had a direct nexus to a specific act of direct infringement.

Physician's Immunity Statute

US law provides patent protection for therapeutic and diagnostic methods

However, 35 U.S.C. 287(c) shields a medical practitioner or health care entity performing a medical activity which is a direct infringement or an induced infringement

Balance between medical community and patent community

Harmonizes with other countries

No shield to commercial clinical labs

Excludes

use of a patented machine, manufacture, or composition of matter in violation of such patent

practice of a patented use of a composition of matter in violation of such patent, or

practice of a process in violation of a biotechnology patent

Physician's Immunity Statute

Example: Medical device company holds patents for 1) surgical tool and 2) the method of using the device

Hospital buys tool and thereby medical practitioner has a license to use it

Medical device company won't sue hospital or practitioner for infringing method claims

Medical device company can sue another company for
direct infringement for making a tool falling within the claims
inducing infringement by offering to sell device to hospitals or
physicians and providing instructions for use

Claim Drafting Tips

- Claims to a device or composition unqualified by functional language or “method-like” limitations
- Claims to a kit including the device, associated hardware (screws, rods), and instructions for use
- Claims to a method of using the device/kit
- Claims to a therapeutic method using the device/kit

Example

- Inadvisable (claim to device in-use):
 - “. . . bone interface operatively joined to said bone segment.”
- Better (claim device only):
 - “. . . bone interface configured to be joined to said bone segment.”
- Best (claim device):
 - “. . . bone interface.”

Repair /Reconstruction of Patented Item

Repair

- Keeping an item in proper working order
- Permitted (impliedly licensed)
 - but only to the extent that the patent on the product being repaired does not prohibit the repair.
- Replacement parts and methods of repair may be *separately* patented.

Reconstruction

- Making a totally spent item operable again.
- Transforming the item into a new product.
- Not Permitted.

Repair /Reconstruction of Patented Item

Aro Manufacturing Co. v. Convertible Top Replacement Co., 365 U.S. 336 (1960)

- U.S. Patent 2,569,724 claimed a convertible folding top
- U.S. Supreme Court held
 - replacement of fabric on patented convertible folding top was permissible “repair” and not infringing “reconstruction”
 - automobile owner did not infringe by repairing his convertible top
 - manufacturer of fabric did not *contributorily* infringe combination patent on folding top

Claim Drafting Tips

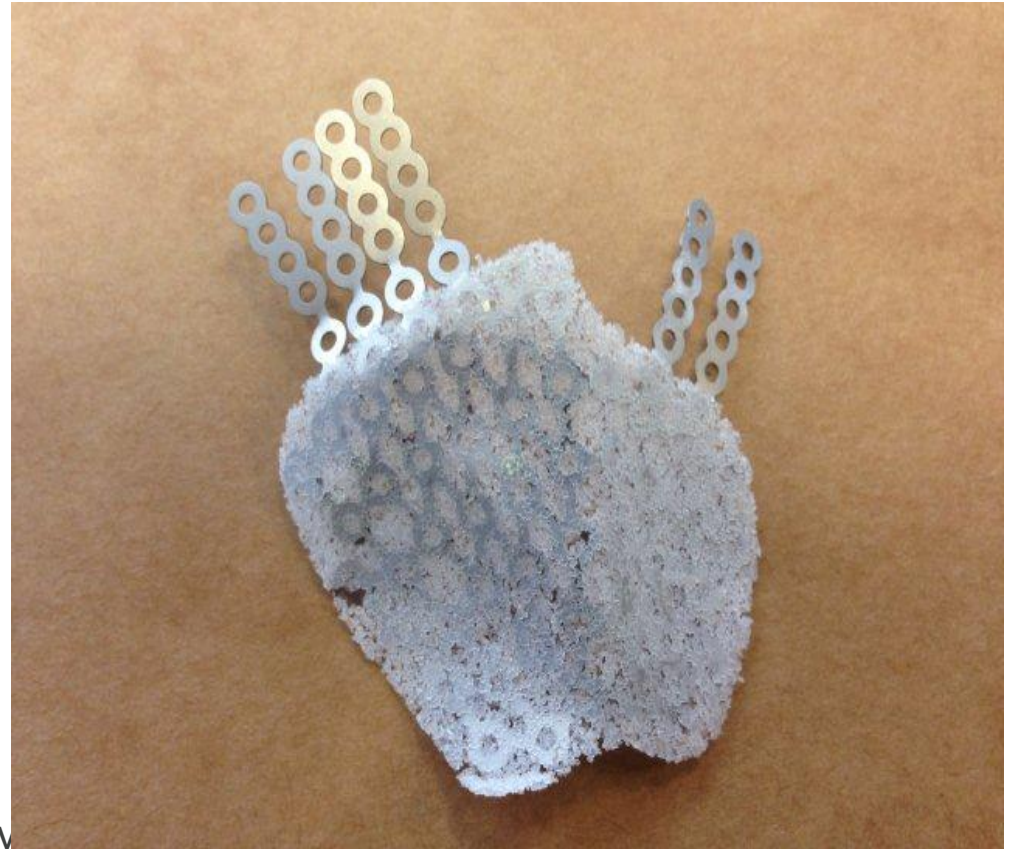
- Include claims to a patented machine or device
- Include claims to potential replacement parts
- Include claims to methods of making repairs/replacements

War Story & Review

US 7,655,047

A craniofacial Implant comprising a porous polyethylene matrix and a surgical grade metal mesh embedded within the matrix such that the porous polyethylene matrix fills spaces within the mesh and encases the mesh such that all sides of the porous polyethylene matrix forming surfaces of the implant have pores that are sized between 20-500 microns, and wherein the implant is able to be bent or displaced by manipulation by

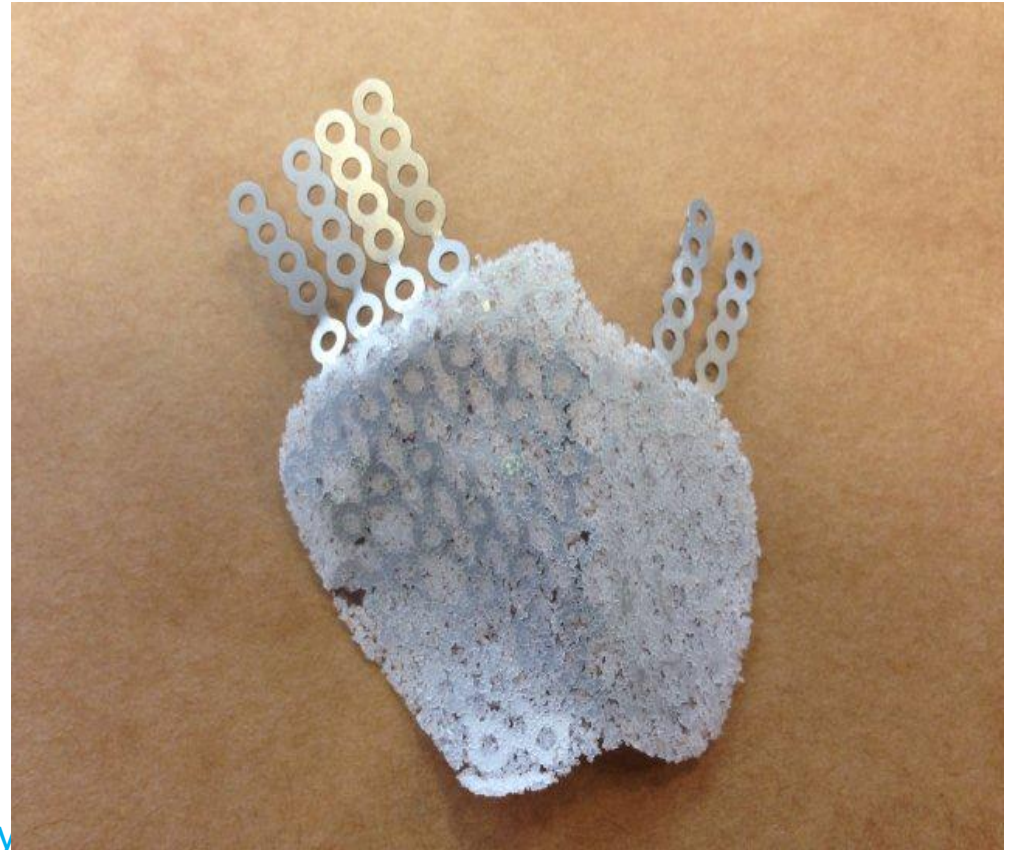
hand such that the implant will generally maintain the shape to which it has been bent or displaced in a rigid and fixed position for attachment to bone, wherein the mesh provides a structure for attachment to bone.




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Questions?
Thank you.



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