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Patent Infringement

Michael Tanenbaum
Georgia State University College of Law

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Research Guides

Patent Infringement

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Overview

A United States patent is a contract between the U.S. government and the inventor(s). In exchange for the full disclosure of the invention, a limited monopoly is granted to the inventor(s) for a limited time. The limited monopoly allows the inventor(s) to exclude others from making, using, selling, offering to sell, or importing the patented invention (which can be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof). The current duration of this limited monopoly is 20 years from the filing of a utility patent application.

Patent infringement occurs when someone violates the rights of the inventor(s) with respect to the limited monopoly of the inventor(s). Infringement can be either literal – meaning that the infringing product or process directly violates the terms of a claim in the patent – or infringement can be found using the doctrine of equivalents – meaning that even if the infringing product of process does not directly violate the terms of a claim in the patent, the function is the equivalent, and the protection of the patent is extended to this equivalent product or process. There are different categories of infringement, including: direct infringement (directly violating the patent); indirect infringement (assisting another party's direct infringement); inducement of infringement (actively and knowingly aiding and abetting another's direct infringement); and contributory infringement (supplying another with a component that is not suitable for other uses besides infringement of the patent).

The determination of whether patent infringement has occurred involves two steps: (1) interpretation of the patent claims; and (2) comparison of the interpreted claims with the accused device/process. The interpretation of claims is construed by the judge, not the jury, and is based on a variety of intrinsic evidence (claims, specification, prosecution history) and extrinsic evidence (dictionaries, experts, treatises). The comparison of the interpreted claims with the accused device/process is then conducted by the finder of fact, typically a jury. Defenses to a claim of patent infringement include patent invalidity, patent misuse, inequitable conduct, experimental use, and prior use. The remedies for infringement include injunctions and damages (including lost profits or a reasonable royalty).

About the Author

Michael Tanenbaum is a 3L at the Georgia State University College of Law. He holds a masters of science degree in biomedical engineering from Georgia Institute of Technology and a bachelors of science degree in biological engineering from the University of Georgia. He is currently employed as a research engineer in the Department of Biomedical Engineering at the Georgia Institute of Technology.

Scope

The purpose of this research guide is to provide an overview of the infringement of utility patents (not including damages and remedies). There are many intricacies to the topic of patent infringement that are not discussed in this guide. Rather, this guide should serve as a starting point for research on this topic. It provides primary and secondary sources on the topic, as well as electronic resources for accessing relevant materials.

Disclaimer

This research guide is intended as a starting point for a law student or attorney to research the topic of patent infringement. It is recommended to Shepardize or KeyCite all statutes and cases before relying on them. This guide should neither be considered as legal advice nor as a legal opinion on any specific facts or circumstances. If you need further assistance in researching this topic or have specific legal questions, please contact a reference librarian in the Georgia State University College of Law Library, or consult a qualified attorney.

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Primary Sources

Legislation

United States Constitution

United States Constitution, Article I, section 8, clause 8.

The United States Constitution grants Congress the authority to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Rights to their respective Writings and Discoveries." This source is the foundation for United States Patent Law.

United States Code

The Patent Act of 1952 was codified as Title 35 of the United States Code.

35 U.S.C. §154(a)(1)

The exclusive right granted to patent holders is "the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States."

35 U.S.C. §271

Section 271 of the United States Code defines the scope of infringement of patents. The basic definition of infringement is the making, using, selling, offering to sell, or importing the patented invention without authorization.

Legislative History of the Patent Act of 1952

The House and Senate Reports on the Patent Act of 1952 (H.R. Rep. No. 82-1923; S. Rep. No. 82-1979) can be found in LexisNexis and Westlaw. Additionally, selected documents can be found at http://www.ipmall.info/hosted_resources/lipa/patents/patentact.asp.

Rules and Regulations

Code of Federal Regulations

Title 37 of the C.F.R. regulates the practice of the United States Patent and Trademark Office (USPTO). While the USPTO does not make determinations of patent infringement, they do decide patentability, which may be challenged in the course of an infringement suit.

Case Law

Within the subject of patent infringement, determining precisely what is protected by the patent is crucial. Claim interpretation and the doctrine of equivalents are two important aspects of determining the scope of protection of a patent. Important rulings on claim interpretation and the issue of the doctrine of equivalents are below:

Claim interpretation

Markman v. Westview Instruments, 517 U.S. 370 (1996).

This case is the origin of what is now called the Markman hearing - the part of the trial in which the court construes the claims of the patent. This case stands for the proposition that claim interpretation can be conducted by the judge and is not subject to a jury trial. Once the claims are construed by the court, the finder of fact can then make a determination of whether infringement has occurred.

Vitrionics v. Conceptronic, Inc., 90 F.3d 1576 (Fed. Cir. 1996).

Permissible resources that the court can use in the interpretation of claims include not only intrinsic evidence, but extrinsic evidence. The court can use dictionaries and treatises to understand the technology and also when construing claims.

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*).

Discussed what sources could be used for claim interpretation, giving a preference for using intrinsic evidence for claim construction.

Doctrine of equivalents

Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605 (1950).

Not only do the claims of a patent protect something that is explicitly stated in the actual claims, but courts have extended protection to products and processes that perform an equivalent function, in what is termed the doctrine of equivalents.

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002).

It is important to commerce to clearly define the boundaries of the property rights of a patent – even in light of the doctrine of equivalents. Knowing what is protected by a patent and what is not allows people and companies to make informed decisions.

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Secondary Sources

Treatises

Chisum on Patents: A Treatise on the Law of Patentability, Validity, and Infringement (2010).

Chisum on Patents is a highly regarded patent law resource and contains chapters on Direct Infringement (Chapter 16), Contributory Infringment (Chapter 17), Interpretation and Application of Claims (Chapter 18). Chisum on Patents is available in print (a multivolume set) and on-line through LexisNexis.

Patent Law Digest (2009).

Patent Law Digest summarizes and categorizes relevant patent law cases. It contains a section on Infringement and covers topics including Exclusive Rights, Claim Interpretation, and Doctrine of Equivalents. Patent Law Digest is available through LexisNexis.

Moy's Walker on Patents

Moy's Walker provides in depth analytical treatment of patent law and discussion of statutes, case law, and rules. It analyzzes patent law history, the patent system's process adn patent law issues. The treatise includes explanations of urnresolved areas within the field. It is available through Westlaw.

BNA Treatise: Patents and the Federal Circuit

This treatise offers a comprehensive analysis of Federal Circuit cases with chapters on Patentability, Infringement, Ownership and Enforcement, Remedies, the Patent Office, and the Federal Circuit. It covers important rulings of the Federal Circuit Court of Appeals, including commentary. It is available through Lexis.

American Law Reports

Elizabeth D. Laudon, Annotation, *Construction and Application of Patent Act – United States Supreme Court Cases*, 27 A.L.R. Fed. 2d 151 (2010).

This annotation collects and discusses all United States Supreme Court cases that have construed and applied the Patent Act.

Gary D. Spivey, Annotation, *Right to jury trial in patent infringement action in federal court*, 18 A.L.R. Fed. 690 (2009).

This annotation analyzes cases in which courts have considered whether, and under what circumstances, there exists a right to trial by jury of a patent infringement action in a federal court.

Law Review Articles

Claim interpretation

Jeremy T. Marr, *Foreseeability as a Bar to the Doctrine of Equivalents*, 2003 B.C. Intell. Prop. & Tech. F. 103101 (2003).

This paper examines a series of cases related to the applicability of foreseeability to the doctrine of equivalents. It then attempts to synthesize the current state of the law in the area, and analyzes arguments for and against adopting a foreseeability rule.

David Potashnik, Note, *Phillips v. AWH: Changing the Name of the Game*, 39 Akron L. Rev. 863 (2006).

This note examines the impact of the *Phillips* case on the process of interpreting the claims of a patent with regards to the resources that can be employed in the process.

David B. Pieper, *The Appropriate Judicial Actor for Patent Interpretation: A Commentary on the Supreme Court's Decision in Markman v. Westview Instruments, Inc.*, 51 Ark. L. Rev. 159 (1998).

This note discusses whether the judge has the appropriate expertise for construing the claims of a patent in an infringement case.

Doctrine of equivalents

Mark D. Janis, *Unmasking Structural Equivalency: The Intersection of 112, Paragraph 6 Equivalents and the Doctrine of Equivalents*, 4 Alb. L.J. Sci. & Tech. 205 (1994).

This article investigates the distinction between the 112, paragraph 6 equivalents and equivalents under the doctrine at the level of elemental equivalence.

Jay I. Alexander, *Cabining the Doctrine of Equivalents in Festo: A Historical Perspective on the Relationship Between the Doctrines of Equivalents and Prosecution History Estoppel*, 51 Am. U.L. Rev. 553 (2002).

This article discusses the application of prosecution history estoppel as a balance to the doctrine of equivalents.

Jeff Kuehnle, Note, *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.: Opening the Floodgates on Nonliteral Patent Infringement Through the Doctrine of Equivalents*, 48 Baylor L. Rev. 589 (1996).

This note discusses possible boundaries for application of the doctrine of equivalents.

Legal Encyclopedias

American Jurisprudence

60 Am Jur 2d *Patents* §781 (2010).

This legal encyclopedia article extensively covers the topic of patent infringement, including direct infringement, induced infringement, contributory infringement, literal infringement, doctrine of equivalents, equivalency, omitting elements, file wrapper/prosecution history estoppel. This resource collects and examines law, as well as referencing supporting cases.

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Electronic Resources

1. LexisNexis (and LexisOne)

LexisNexis has Patent Law as a legal topic, and a subtopic of Infringement Actions. Areas covered under Infringement Actions include Claim Interpretation, Doctrine of Equivalents, Exclusive Rights, and Infringing Acts.

2. Westlaw (and FindLaw)

Westlaw has an Intellectual Property research tab with a variety of resources, including cases, databases, statutes, and practice guides.

3. United States Patent Quarterly

United States Patent Quarterly has the full text of federal court cases as well as administrative agency rulings.

4. HeinOnline

HeinOnline's *Intellectual Property Law Journal Library* contains articles from many intellectual property and technology-oriented periodicals.

5. Loislaw

Loislaw provides access to primary law, public records, treatises and legal forms.

6. Intellectual Property Library (BNA)

The IP library contains primary source materials on intellectual property, including all cases in the United States Patents Quarterly, laws, and regulations.

7. Dockets-Patent

Dockets-Patent provides docket information on patent-related cases filed in the U.S. District Courts.

8. CCH Patent Law Library

This library includes current awareness materials, primary source material commonly used by patent practitioners, and patent forms.

9. Legal Websites

United States Patent and Trademark Office

The USPTO website offers a variety of patent-related resources including patents and IP law and policy.

The George Washington University Law School

GW has an intellectual property resource page complete with research guides, research aids, and IP databases.

The Franklin Pierce Law Center Intellectual Property Mall

The Pierce IP Mall offers an IP resource page with links to cases, laws, and articles.

10. Legal Blogs

Patent Baristas

Discusses the state of the IP industry.

Patently-O

IP news source.

IP Law 360

Newswire for IP professionals.

Philip Brooks' Patent Infringement Updates

News and resources related to patent infringement litigation.

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