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Life Tech v. Promega – Overseas Combinations

🕒 February 24, 2017 👤 SKELJ 📁 Uncategorized 💬 0

There are a couple pending Supreme Court cases dealing with patents that have been rather interesting to follow. On Wednesday SCOTUS issued an [opinion for Life Tech v. Promega](#) overturning CAFC.

Generally, let's say I have a patent covering a device with components A+B+C. Let's say B+C are made in the UK and you ship A from the US to Bristol so a manufacturer can assemble and sell the product. Infringement?

It depends.

I touch on this issue in my [recent article "Coordinating the Offshore Energy Transition"](#).

SCOTUS' short answer in the opinion is no.

*"The question before us is whether the supply of a single component of a multicomponent invention is an infringing act under 35 U. S. C. §271(f)(1). **We hold that it is not.**"*

But, of course, the reason this is at SCOTUS is because this is a little more complicated than that.

At the outset, for you more savvy readers, keep in mind that this case is JUST ABOUT 271(f)1. The case does not address 271(f)2, so if you're

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thinking to yourself about

*“any component of a patented invention that is **especially made or especially adapted for use in the invention**”*

that’s a different analysis. Stop thinking about that. We’re not talking about “special” components designed without substantial noninfringing uses here. We’re talking about plain old, vanilla components. Again, 271(f)1 recites:

*(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.*

Whereas 271(f)2 recites:

*(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.*

(although Sotomayer does touch on the relation between 1 and 2 to be thorough)

So the question is, for 271(f)1, what *exactly* is a “substantial portion”? In my A+B+C example, is it all three? Just two (A+B, A+C)? Or could it just be one component (A)?

Really we're asking is "substantial" a qualitative or quantitative qualifier? If qualitative, then if a single component were super important, 271f1 would read on it. If quantitative, then for an invention with components A+B+C+D+E+F+G, supplying everything but G might be read upon by 271f1, but no matter how important A was, just A alone, would not.

Basically, CAFC thought it was qualitative. SCOTUS here thinks its quantitative. SCOTUS' feeling is that quantitative better complements with the later language in 271f2 (which discusses quality – otherwise the sections would be a little redundant, right?).

So this case is interesting and an important data point, but at you might suspect, all this skirts the real issue(s).

The real issue is zebras. What is a zebra? Is it a a) four legged animal with b) stripes? Well, that could also be a tiger right? Ok, a zebra also has c) hooves. Well so do [Western Bongos](#). Ok, and d) horse-like ears and e) the stripes have to be black on white.

You see there's some play here in the component breakdown. So you can imagine playing these games with a proper invention. "The capacitor and transformer aren't two components, they're all parts of the same power source component." It's as much a linguistic as a logical issue.

So if you're dealing with an export, consider whether 271f1 or 271f2 is a better fit, but just as importantly, ensure that your characterization is logically persuasive.

(Bonus Question: Can you think of a situation where persuasively arguing 271f2 means you've persuasively argued yourself out of 271f1?)

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