

INVENTION ANALYSIS AND CLAIMING: Individual Direct Infringers¹



BY RONALD SLUSKY

Ronald Slusky mentored dozens of attorneys in “old school” invention analysis and claiming principles over a 31-year career at Bell Laboratories. He is now in private practice in New York City. Ron’s widely praised two-day seminar based on his book, **“Invention Analysis and Claiming: A Patent Lawyer’s Guide,”** (American Bar Association, 2007), will be presented in several venues this fall. For details see www.sluskyseminars.com. Ron can be reached at 212-246-4546 and rdslusky@verizon.net.

We saw last month that a patent owner may not realize the full value of a patent unless the invention is claimed in all of its commercially significant settings. A “setting” is an environment or context in which the inventive concept is manifest,² and is “commercially significant” when it is expected that others will implement the invention in that particular setting. For example, the settings for cylinder lock having uniquely configured tumblers and thus requiring a unique kind of key could include the lock itself, the key, the tumblers, the key-making machine and possibly even the key blank if patentably distinct from key blanks for prior art locks.

Thus although we might think to claim the lock and be done with it, others might only carry out the invention in other settings by only cutting keys; or only manufacturing the key-cutting machine, or only making replacement tumblers for aftermarket sale to locksmiths. None of these parties’ activities would be covered by a claim to the lock *per se*. Hence the desirability of claiming the invention in the other settings.

Beyond claiming the invention in all of its commercially significant settings, realizing the full value of a patent further

requires that the claims capture the activities of a) individual—as opposed to co-acting—parties who are b) direct infringers. This is largely achieved, it turns out, when the claims define the invention in all of its commercially significant settings. However, drafting and reviewing claims with individual direct infringers specifically in mind helps ensure that our claims meet the above two criteria.

DIRECT INFRINGERS

The invention should, first of all, be claimed in a way that will capture the activities of direct infringers.

Direct infringement of a patent occurs when someone, without authority, makes, uses, offers to sell, sells or imports something that meets all the limitations of at least one of the patent’s claims.³

There are, of course, other ways in which someone can be liable under a patent, such as by inducing someone else to infringe⁴ or by being a contributory infringer,⁵ these being forms of so-called indirect infringement. However, contributory infringement and inducement require proof that some party is a direct infringer.⁶ Without a direct infringer, there can be no contributory infringer. Nor can there be an inducer of infringement. So a case of direct infringement will have to be proved in any event.

Moreover, indirect infringement involves additional proof elements. For example, contributory infringement requires proof that the part of the invention supplied by the party accused of contributory infringement constitutes a “material part” of the invention. Also required is proof that the accused party knew of the patent and knew that that part was especially made or especially adapted for use in an infringement of the patent.⁷

INDIVIDUAL INFRINGERS

Going further, the invention should be claimed in a way that will capture the activities of *individual* direct infringers.

It is true, on the one hand, that multiple parties can be liable as joint direct infringers, such as where Party A carries out the

initial steps of a claimed manufacturing method to produce an intermediate product that is completed by Party B carrying out the remaining steps.⁸ However, the mere fact that parties can be found whose combined respective activities meet all the claim limitations does not *ipso facto* establish them as joint infringers. The case law invokes such concepts as “privity” and “control” and “working in concert” when assessing the relationship that will establish multiple parties as joint direct infringers.⁹ Those kinds of connections between the parties are often just not there.

Even if those connections *are* there, joint infringement may not exist if a claim encompasses the activities of parties in different countries. For example, method claims of a U.S. patent are directly infringed only if all of the claimed steps occur within the U.S.¹⁰

And even if joint infringement *could* be made out in a given case, this is not something we want to have to do. More facts will have to be proved; more parties will have to be deposed; each defendant may hire its own defense team, making the case all the more complicated.; and so forth.

Even if a patent were to contain only multi-party claims, the patent owner may still have *some* recourse. The Opposing Team’s we-don’t-do-everything-called-for-in-the-claim assertion can be responded to by asserting that the Opposing Team’s customers might be liable as joint or contributory direct infringers. The specter of customers being joined in a patent suit may bring the target party to heel. No businessman wants his business relationships strained in that way. But that ploy may not work. The accused party may call the patent owner’s bluff, forcing him to then bring an action that stands a good chance of failing in the final analysis, for the reasons noted above.

In any event, we have full control over the claims when the patent application is being drafted. So there is no excuse for not claiming the invention in a way that will capture the activities of the individual direct infringer if there is any way to do it, which invariably there is. The idea that “we can always get them for contributory or inducement” or that “we can always just sue them jointly” is not a valid reason to pass up the opportunity to draft claims that will be directly infringed by individual parties when we have the chance to do so.

Even if implementations of an invention would seem to require the involvement of multiple parties, there is almost always a way to structure the claims so as to avoid defining the invention in those terms. We'll see some examples of that next month.

ENDNOTES

1. Copyright © 2007, 2010 American Bar Association. Adapted with permission. All rights reserved.
2. The terms “perspective” or “point-of-view” are also sometimes used to refer to what the author calls a claim “setting.”
3. 35 USC 271(a).
4. 35 USC 271(b).
5. 35 USC 271(c).
6. See, e.g., *RF Delaware, Inc. v. Pacific Keystone Technologies, Inc.*, 326 F.3d 1255, 1268, 66 USPQ2d 1593 (Fed. Cir. 2003).
7. See, for example, *Moba, BV v. Diamond Automation, Inc.*, 325 F.3d 1306, 1320-21 (Fed. Cir. 2003).
8. See, for example, *Shields v. Halliburton Co.*, 493 F. Supp. 1376, 1389 (W.D. La. 1980), *aff'd*, 667 F.2d 1232 (5th Cir. 1982).
9. See generally *Mobil Oil Corp. v. Filtrol Corp.*, 501 F.2d 282, 291-2 (9th Cir. 1974); *Faroudja Labs., Inc. v. Dwin Electronics.*, 76 F.Supp.2d 999 (N.D. Cal. 1999); *E. I. du Pont de Nemours & Co. v. Monsanto Co.*, 903 F.Supp. 680 (D. Del. 1995), *aff'd* 92 F.3d 1208 (Fed. Cir. 1996) (unpublished).
10. 35 U.S.C. 271. By contrast, a party within the U.S. who interacts with a system, for example, over communication lines “uses” that system and is therefore an infringer of an apparatus claim directed to that system, even if a portion of the system lies outside the U.S. *NTP v. Research in Motion*, 418 F.3d 1282 (Fed. Cir. 2005).