

Abuse of Patents



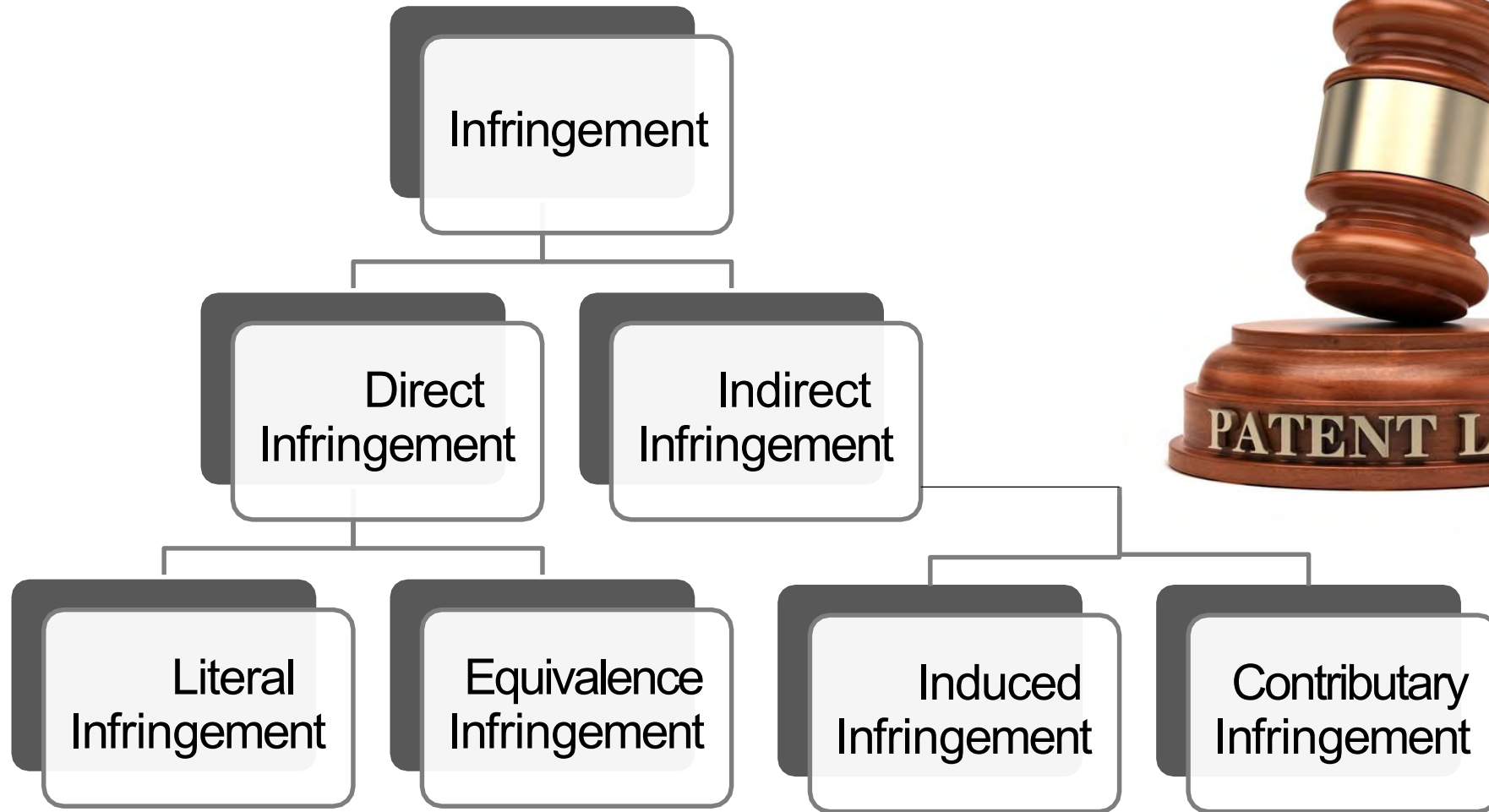
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NALSAR University of Law, Hyderabad
Contact Class; March, 2022.

Patent Right



- ✓ Right to exclude others
- ✓ A patent is not a grant of a right to make, use or sell - a defensive right
- ✓ Grant of patent in return for full disclosure

Types of Infringement



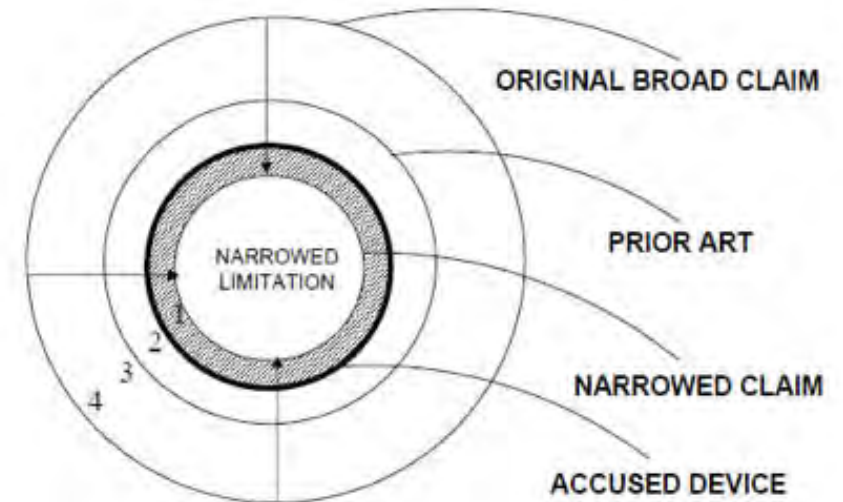
Infringement

A valid patent gives patentee the right to bring an action on both

➤ Direct infringement, and

➤ Indirect infringement

- Induced infringement
- Contributory infringement





Direct Infringement

What is claimed in the patent

- Make,
- Use,
- Offer to sell,
- Sell, or
- Import

Induced Infringement



- Act of actively inducing another to infringe a patent
- Instructing, directing or advising the third party to carry out a direct infringement



Contributory Infringement



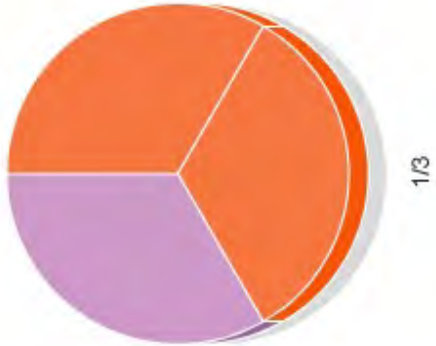
- Sale, offer for sale or importation of a component of a patented article or a material part of the invention already patented.

Literal Infringement

- Every element of the patented claim must be found in the infringing device
- Literal infringement can be avoided by making changes so that the exact elements disclosed in the patented claim are not totally met
- Any discrepancy will make literal infringement void



What is an Equivalent ?



||



- The differences between the claim element and the equivalent must be, insubstantial or interchangeable to a person skilled in the art
- A difference may be insubstantial or interchangeable if the accused elements perform substantially the same function in substantially the same way to obtain substantially the same result as the invention.

Doctrine of Equivalence

- To prevent '*fraud on the patent*'
- Invoked when a patent's claim is not literally infringed
- The infringing device uses substantially the same means in substantially the same way to get substantially the same result
- Favors the patentee



DoE - Basic Test

Function-Way-Result

- Equivalent Function
- Equivalent way
- Equivalent result

Substantiality of Differences

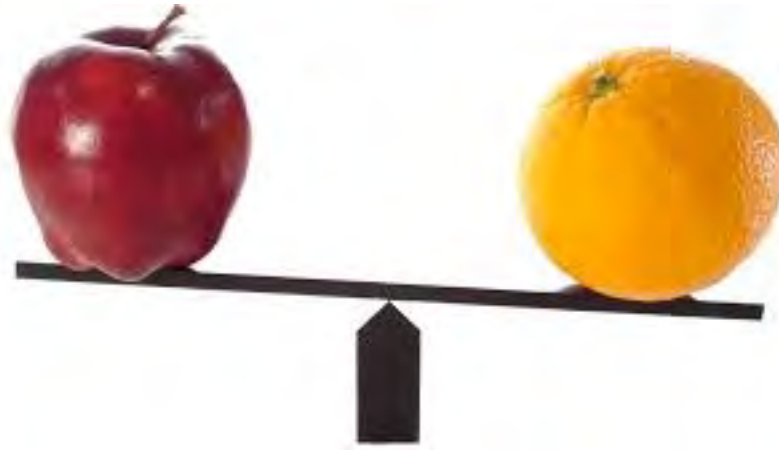
- *“that differences which are unimportant and add nothing to the process/product, yet manage to avoid the claim language, can be considered insubstantial”*
- *“a patentee should not be able to obtain, under the DoE, coverage which he could not lawfully have obtained from the PTO by literal claims”*



Element by Element Comparison

All Elements Rule

- *“decided on an element-by-element basis with reference to the disclosure of the patent specification”*
- *“every limitation of an asserted claim that is not literally met must be equivalently met or there can be no infringement”*



Pennwalt Rule

Narrowly Claimed Lost

- *“for a patentee who has claimed an invention narrowly, there may not be infringement under the DoE in many cases, even though the patentee might have been able to claim more broadly”*
- *“as between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure”*

LOST

Dolly/Sage/Weinner Rule

Not Claimed Lost

- *“Subject matter that is fully disclosed and enabled in the specification, but not claimed, will be deemed by the courts to be dedicated to the public, to be placed in the public domain”*

Maxwell Rule

LOST

Prosecution History Estoppel

- During the examination of the patent by the PTO in the course of the issuance process, the patentee had to change claims to avoid existing prior art and avoid the rejection of his application as not novel, the patentee is held to those new limitations for the rest of the life of the patent. The patentee can't go back to the original, broader claims.
- Favors the accused infringer

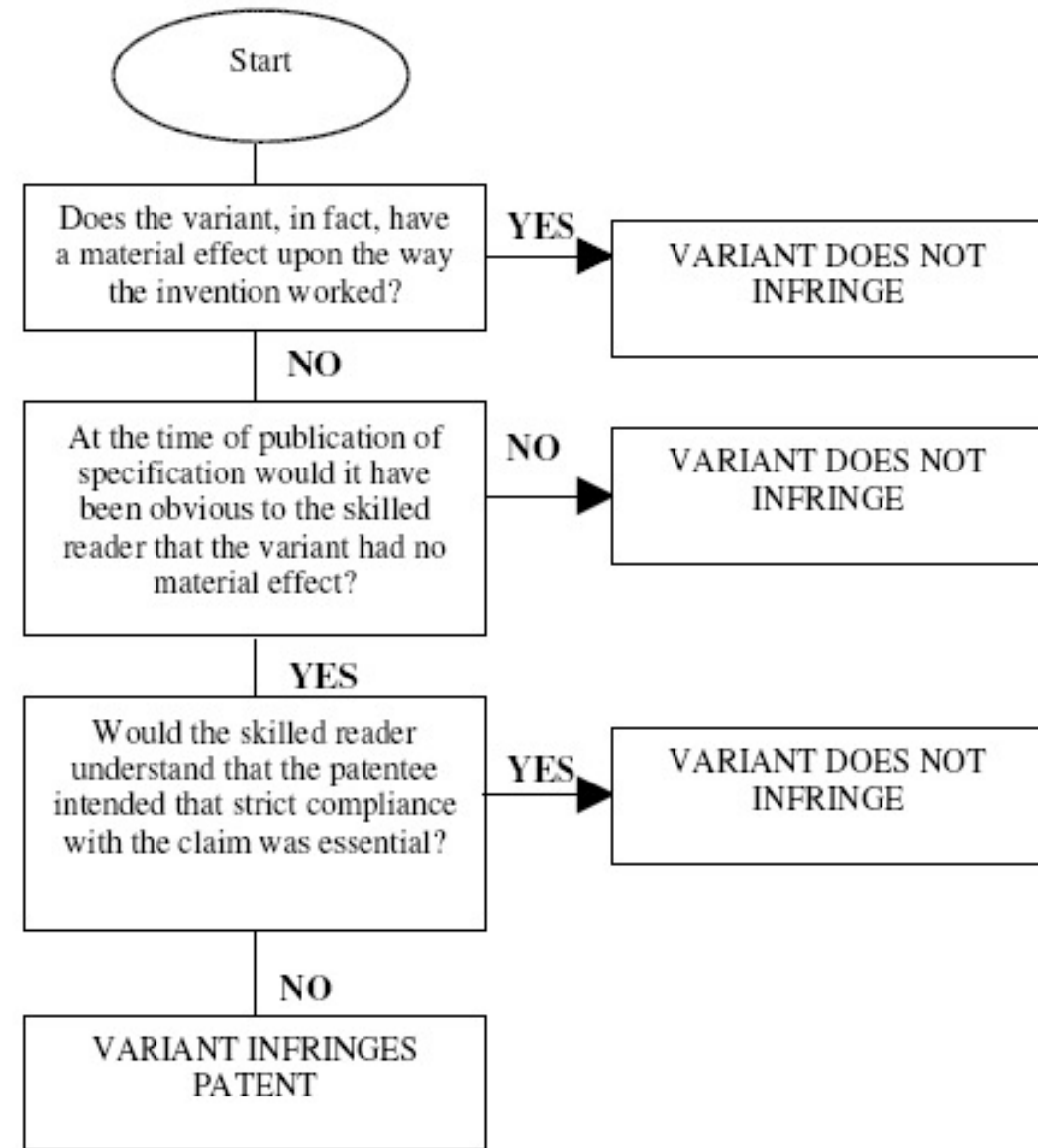


PHE – When?

- No literal infringement
- The patent owner asserts infringement by equivalents
- The accused infringer asserts the defense on the basis that the relevant subject matter has been disclaimed during prosecution
- When a patent applicant amends or cancels claims rejected by the Patent Office as not patentable based upon prior art
- Or other purposes including arguments made by the applicant.
- *“Unmistakable assertions made by the applicant ... also may operate to preclude the patentee from asserting equivalency....”*



DoE vs Catnic/Improver Test



Flowchart 1, based on Bainbridge (2002, 397).

Remedies



- Injunction;
- Damages;
- Accounts of profits; and
- Costs

Prof. Kayton's 9 steps (1-4)

- List the claims in diminishing order of breadth.
- (Optional) Proceed to eliminate the broadest and successively less broad claims by finding prior art to invalidate them.
- With solely the broadest valid claim in mind, consult with technical and marketing experts to select the one, two or more claim-recited elements that is/are of least significance and could be omitted from a commercial product.
- (If step 3 is successful) Write an infringement opinion stating that the proposed product is non-infringing under “*all elements rule*”



Prof. Kayton's 9 steps (5-7)



- (If step 3 is unsuccessful) Select one claim-recited element of least importance and then substitute an element that performs the same function but is physically or chemically (as the case may be) as different as possible from that of the claimed element so as not to be considered an insubstantial change.
- (If step 5 is successful) Write a non-infringement opinion but rely on "*substituted element rule*"
- (If steps 3 and 5 are both unsuccessful) Select the least important claim-recited element and have experts explain how to change it physically or chemically so as to force it to function in a different way while producing precisely the same result.

Prof. Kayton's 9 steps (8-9)

- (If step 7 is successful) Write a non-infringement opinion.
- If unable to succeed in achieving any one of steps 3, 5, or 7 your technical and marketing experts are gloriously incompetent or in the patentee's employ. They should be fired, and relegated to an appropriate institution. Hire new experts, and start over at step 1.





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Advise the client on infringement and validity of his patent and on the other questions asked by him. Your advice can be in the form of notes or a letter to the client but in either case you must provide the reasons for you advice.

(I) CLIENT'S LETTER

Dear Patent Agent,

We are manufacturers of luggage.

We have developed a suitcase with wheels for which we have obtained Singapore patent 500,000. The suitcase is selling very well thanks to the monopoly position that the patent gives us.

It has come to our attention that a competitor is marketing a suitcase. The competing suitcase is illustrated in document C1 and we think it is an infringement of our patent. It is certainly causing a serious drop in the sales of our product.

Please advise us. Can we use our patent to stop the competitor's sales immediately?

Not only do we need to know what we can do, we also need to know what action the competitor can take against us if we proceed against him. Further, is there anything we should do to strengthen our position?

Yours faithfully,
Client.

You establish the following facts:

- a) The client's Singapore Patent No.500,000 is in force.
- b) You make a search for prior art and find the Municipal News document D1 which was published before the priority date of the client's patent.
- c) Investigations into the competing company reveal that it has very limited financial resources.

(II) Singapore Patent No 500,000

This invention relates to a container and more particularly an article of luggage such as a suitcase.

In order to avoid having to carry heavy suitcases it has become common practice to use a wheeled tubular framework, rather like a small trolley. On which the suitcase can be secured for example by an elasticated strap. The framework includes a telescopic handle by which the wheeled framework with the suitcase on it can be towed or pushed thus making it easy to move the suitcase from one place to another even when it is very heavy.

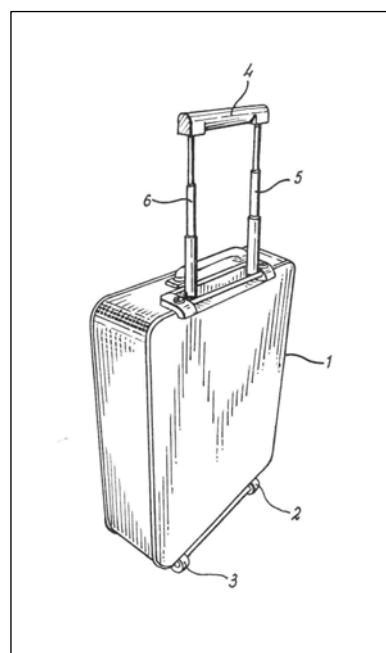
While this arrangement works well for suitcases that are not too large. The fact that the wheels on the framework are at a fixed distance apart means that it becomes less satisfactory to use with large suitcases which overhang the sides of the framework. Unless the weight of the suitcase is evenly distributed on the framework wheels there will be a tendency for the combined suitcase and framework to tip over on one side or the other.

The present invention seeks to deal with this problem and provides a container having wheels mounted on the bottom and adjacent the sides whereby the container can be tilted about the axis of the wheels so that its weight is supported by the wheels whereupon the container can be towed or pushed.

By providing the wheels on the container itself in the position defined above the possibility of the container tipping over on one side or another is eliminated.

Preferably the container includes a handle by which it can be towed or pushed. The handle is preferably provided at the top of the container.

A specific embodiment of the invention will now be described by way of example with reference to the accompanying drawing which is a perspective view from the rear and one side of a suitcase.



A handle 4 is provided at the top of the suitcase. The handle is mounted on telescopic supports 5,6 so that the handle can be extended from the suitcase (as illustrated) for pulling or pushing it or can be collapsed into a housing in the suitcase when not required.

In use the handle is moved into the illustrated position with the supports extended. The suitcase can then be tilted about the axis of the wheels so that its weight is supported by the wheels. In this disposition the suitcase can be pushed or pulled easily.

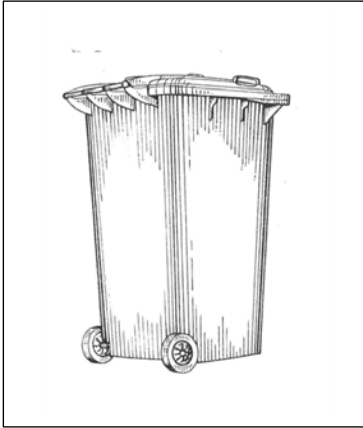
Claims.

1. A container having wheels mounted on the bottom and adjacent the sides whereby the container can be tilted about the axis of the wheels so that its weight is supported by the wheels whereupon the container can be towed or pushed.
2. A container as claimed in claim 1, wherein a handle is provided at the top thereof.
3. A container as claimed in claim 2, wherein the handle is mounted on supports receivable in a housing in the container.
4. A container as claimed in claim 3, wherein the supports are telescopically expandable and retractable.
5. A container as claimed in any preceding claim, wherein the wheels are located at the lower edge of the rear thereof.

(III) D1 Extract from the Municipal News

A New Garbage Bin for Manchester

Manchester city council is introducing a new wheeled garbage bin for domestic use. Householders, who will be given the new bin, will be asked to move it to the roadside on garbage collection days. This will mean that the garbage disposal operatives (known as bin men) will no longer have to carry heavy bins to the garbage disposal truck.



Residents have complained that the new bins are much bigger than the traditional dustbins and will be difficult to move. However, the council have pointed out that the fixed handle on the bin makes the wheeled bin easy to push or pull even when it is full of garbage. The new wheeled bin for Manchester. It consists of a large open topped, boxlike container with wheels at the bottom. The axis of the wheels lies along the rear edge of the bottom.

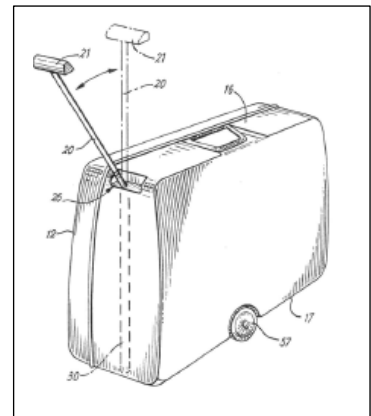
A handle is fixed along the rear edge of the top to which is hinged a lid for closing the open top. For moving, the bin it is tilted about the axis of the wheels so that the bottom is clear of the ground whereupon it can be easily pushed or pulled by the handle.

(IV) C1 Competitors Product

As shown in the attached drawing the competitor's product is a suitcase with wheels 57 mounted on an axis across the center of the bottom 17.

For towing the suitcase, a handle 21 on a shaft 20 is provided. The shaft can be stowed in a channel 30 in the suitcase when the handle 21 is not required.

To make it easier to use the shaft is hinged at 26.





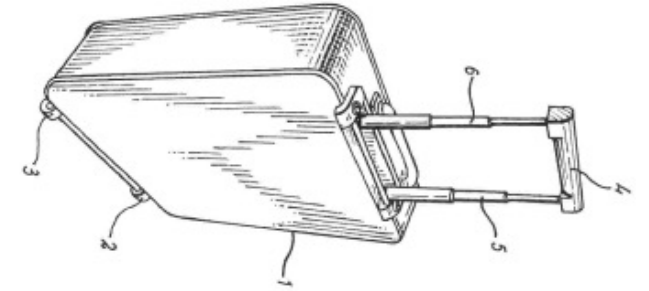
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Advise the client on infringement and validity of his patent and on the other questions asked by him.

- Analysis of Claims
- Infringement
- Validity
- Other matters

Analysis of Claims



❑ Claim 1

- Container
- Wheels mounted on bottom and adjacent sides
- Container can be tilted about axis of the wheels so that weight is supported by wheels

❑ Claim 2

- Handle provided at top of container

❑ Claim 3

- Handle mounted on supports
- Receivable in a housing in the container

❑ Claim 4

- Supports telescopically expandable and retractable

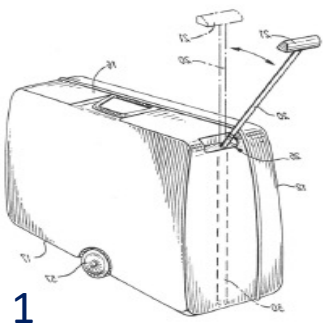
❑ Claim 5

- Wheels located at the lower edge of the rear of the container

Claims.

1. A container having wheels mounted on the bottom and adjacent the sides whereby the container can be tilted about the axis of the wheels so that its weight is supported by the wheels whereupon the container can be towed or pushed.
2. A container as claimed in claim 1, wherein a handle is provided at the top thereof.
3. A container as claimed in claim 2, wherein the handle is mounted on supports receivable in a housing in the container.
4. A container as claimed in claim 3, wherein the supports are telescopically expandable and retractable.
5. A container as claimed in any preceding claim, wherein the wheels are located at the lower edge of the rear thereof.

This may form part of the discussion on infringement and validity



Infringement

Claim 1

- Is product a container?
- Are the wheels on the bottom adjacent the sides?
- Can product be tilted as required by the claim?
- Will this result in the wheels supporting the weight of the container?

Claim 2

- What is the top of the product? Is the handle provided there?

Claim 3

- Does the product meet the requirement of ‘Supports’ (plural) for the handle?

□ Claim 4

- Are supports telescopically expandable and retractable?

□ Claim 5

- What is the rear of the suitcase?

Claims.

1. A container having wheels mounted on the bottom and adjacent the sides whereby the container can be tilted about the axis of the wheels so that its weight is supported by the wheels whereupon the container can be towed or pushed.
2. A container as claimed in claim 1, wherein a handle is provided at the top thereof.
3. A container as claimed in claim 2, wherein the handle is mounted on supports receivable in a housing in the container.
4. A container as claimed in claim 3, wherein the supports are telescopically expandable and retractable.
5. A container as claimed in any preceding claim, wherein the wheels are located at the lower edge of the rear thereof.

Discuss - Does competitors product include features of the claims?

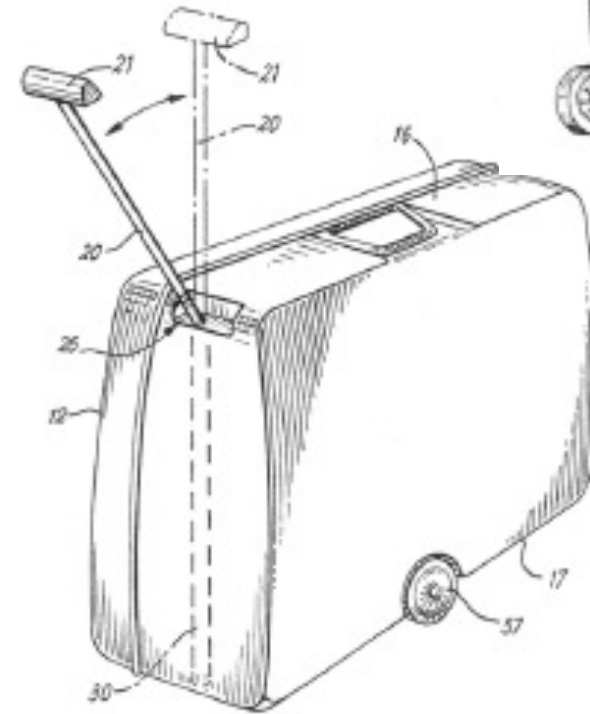
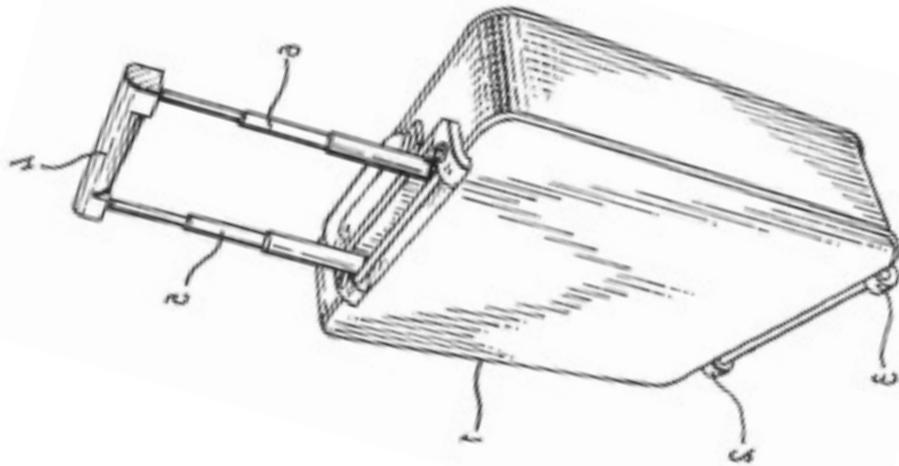
Validity



- ❑ Claim 1
 - Is garbage bin a container?
 - Where are the wheels located?
 - Can the bin be tilted as required by the claim?
- ❑ Claim 2
 - Is handle provided at the top of the bin?
- ❑ Claim 3
 - Is handle mounted on supports receivable in a housing in the bin?
- ❑ Claim 4
 - Are supports telescopically expandable and retractable?
- ❑ Claim 5
 - Where is the rear of the bin?
 - Seems likely that infringed claims are invalid

Other Matters

- ❑ Competitor can seek to revoke patent or counterclaim for revocation. Consequence?
- ❑ To strengthen position client could amend claim 1 to limit to suitcase. Consequence?
- ❑ Limited resources of competitor may support an application for interlocutory injunction.
- ❑ Cross undertaking from client required.
- ❑ Is amendment required before seeking interlocutory relief? Effect of delay?



Claim Mapping

Singapore Patent # SG 500,000		Present / Absent	Met by substitution	DoE (Y/N)	Remarks
Claim 1	A container having				
	wheels mounted on the bottom and adjacent the sides whereby				
	the container can be tilted about the axis of the wheels so that its weight is supported by the wheels whereupon the container can be towed or pushed.				
	wheels mounted on the bottom and adjacent the sides whereby the container can be tilted about the axis of the wheels so that its weight is supported by the wheels whereupon				
	the container can be towed or pushed.				

- ☐ Claim chart mapping is a comparison of subject patent claims with the product/ process that may be infringing the subject patent claims.
- ☐ Claim chart are used to depict the real world product or service that is infringing your patent claim. The depth of claim-chart can be dependent on how it will be used.



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