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PROTECTING YOUR INVENTION

PART VI: INFRINGEMENT

Congratulations, your hard work and effort has paid off and you have received a patent on your invention from the U.S. Patent Office. After admiring the ribbon copy of your patent, you notice an advertisement in a magazine for an exact replica of your invention being sold by a company other than yours. After you have recovered from aspirating your morning cup of coffee, what should you do? Call the police? Nope. Call the Patent Office? Nope. Call the President? Nope. Call your lawyer? Yes. The patent which has been issued grants you the right to exclude others from making, using or selling your invention in the United States for approximately 20 years. If your patent is infringed, the Patent Office, police and the President are not going to help you. You have to go to a United States District Court and file a lawsuit asking for relief if an amicable resolution cannot be reached with the infringer. The relief that you may obtain may be an injunction in some cases, ordering the infringer to stop making, using or selling your invention in the United States. The relief obtained may be in the form of money damages for lost profits related to the infringer's sale of your invention which presumably would have been your profits had the infringer not come along and sold your invention. In some cases where the infringement is found to be "willful" your relief may include attorney's fees and a multiple of your actual damages. However, it is the patent owner's burden to prove that the infringer is actually infringing the patent.

There are a couple of types of infringement. The first type is direct infringement which as the term implies, the infringer simply makes, uses or sells the invention in the United States. Another type of infringement is infringement by inducement. In infringement by inducement, the infringer causes someone else to infringe a patent. As an example of infringement by inducement, a clinical laboratory offers a particular laboratory test and markets the test to physicians as a method for diagnosis of a disease condition. The clinical laboratory knows that the physician's use of the laboratory test for diagnosis of the disease condition will infringe upon a medical method patent issued to a physician/inventor. When a doctor uses the laboratory test for the purpose of diagnosis of the disease

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condition, the clinical lab may be liable to the inventor for infringement by inducement. However, the physician who uses the test for the indicated reason is not liable to the inventor for infringement according to Federal law.

The principal defenses to an infringement suit other than showing that the infringer's product is substantially different than the invention disclosed in the patent is to show that the patent itself is invalid. In court, the patent will be presumed to be valid. However, there are a number of ways that the alleged infringing party may attempt to show that the patent is invalid. Anyone who has jumped through the fiery hoops thrown out by the Patent Office Examiner during the prosecution of a patent application might think that the issuance of a patent would effectively preclude somebody from being able to challenge the validity of the patent at some later time. Such is clearly not the case because a patent can be found to be invalid on any number of grounds which were not considered during prosecution of the patent application. For example, a patent may be found to be invalid because all of the inventors were not properly named as inventors in the patent application. A patent may be invalid if the court finds that there was willful misconduct on the part of the inventor during prosecution of the patent application. This willful misconduct occurs in circumstances such as when an inventor fails to disclose an article of prior art or other critical information of which the inventor is aware and which might preclude the issuance of a patent. Invalidity of a patent may also be found if a publication comprising prior art is found in some obscure journal which literally describes the invention. A patent may also be found to be invalid if there is evidence that the inventor offered to sell the invention more than one year prior to filing the patent application. In litigation the party accused of infringement will assemble a team of lawyers who will scour the literature, patent application file and the patent looking for anything which will render the patent invalid. A finding that the patent is invalid negates any claim of infringement by the inventor.

Rather than going to the court house and litigating the infringement lawsuit, including the validity of the underlying patent, sometimes the infringer is asked to take a license which permits the infringer to sell the invention with payment of royalties to the inventor. In the past, if the infringer wanted to challenge the invalidity of the patent after entering into a license agreement, the infringer had to breach the license agreement and file suit against the inventor alleging invalidity of the patent. This inevitably lead to a breach of contract suit by the inventor against the infringer for breach of the license agreement. Recently, the Supreme Court of the United States has resolved this dilemma for those potential infringers forced to take a license by holding that the infringer did not have to breach the license in order to challenge the validity of the patent. In this way, the infringer would not be subject to additional litigation for breach of the license while asking the court to determine the validity of the patent.

Infringement lawsuits which result in a finding of invalidity of the patent due to incorrect inventorship or willful misconduct during prosecution of the patent application can be avoided. At the very beginning the identity of all inventors should be determined as well as the role that each inventor played in the conception of the invention. The correct inventors should be disclosed in a timely fashion to the Patent Office. If a mistake in inventorship is made, such mistake should be corrected as soon as possible. Each inventor and the lawyers representing them owe a duty of candor to the Patent Office. This duty of candor requires that each inventor and their lawyers should act honestly in their dealings with the Patent Office and disclose, to the extent of which they are aware, all relevant information, potential prior art publications and other material information to the examiner during prosecution. By full and prompt disclosure of the facts to the examiner, one can successfully defend a challenge of incorrect inventorship and/or willful misconduct during the infringement lawsuit.

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