

## Federal Circuit Patent Bulletin: *Promega Corp. v. Life Techs. Corp.*

December 15, 2014

*"[T]here are circumstances in which a party may be liable under § 271(f)(1) for supplying or causing to be supplied a single component for combination outside the United States."*

On December 15, 2014, in *Promega Corp. v. Life Techs. Corp.*, the U.S. Court of Appeals for the Federal Circuit (Prost, Mayer, Chen\*) affirmed-in-part, reversed-in-part, vacated-in-part, and remanded the district court's summary judgment, inter alia, that U.S. Patents No. 5,843,660, No. 6,221,598, No. 6,479,235, and No. 7,008,771, which related to multiplex amplification of short tandem repeat (STR) loci, were not invalid for lack of enablement and obviousness, and that LifeTech did not infringe these patents or U.S. Patent No. RE 37,984 (Tautz), which related to a process for examining polymorphism in DNA samples. The Federal Circuit stated:

Under 35 U.S.C. § 271(f)(1), a party may infringe a patent based on its participation in activity that occurs both inside and outside the United States. . . . We first address whether "to actively induce the combination" requires involvement of a third party or merely the specific intent to cause the combination of the components of a patented invention outside the United States. We conclude that no third party is required.

To begin, we acknowledge that the word "induce" can suggest that one is influencing or persuading "another." However, induce also encompasses the more broad concept of "to bring about, to cause." The object of the transitive verb "induce" can either be a person or a thing, such as an activity or result. The statute is written such that an activity—"the combination"—is the object of "induce," not a person. Had Congress wanted to limit "induce" to actions completed by two separate parties, it could easily have done so by assigning liability only where one party actively induced another "to combine the [patented] components." Yet, "another" is absent from § 271(f)(1). Instead, the focus of the statute is to induce "the combination of the components of the patented invention."

We next address whether infringement under § 271(f)(1) requires at least two components to be supplied from the United States. Section 271(f)(1) assigns infringement to anyone who supplies or causes to be supplied “all or a substantial portion of the components of a patented invention.” We hold that there are circumstances in which a party may be liable under § 271(f)(1) for supplying or causing to be supplied a single component for combination outside the United States. And based on the facts of this particular case, we conclude that substantial evidence supports the jury’s verdict that LifeTech is liable for infringement under § 271(f)(1) for shipping the Taq polymerase component of its accused genetic testing kits to its United Kingdom facility.

As with our analysis for “to actively induce the combination,” we begin by examining the ordinary meaning of the text of the statute. The dictionary definition of “substantial” is “important” or “essential.” A “portion” is defined as a “section or quantity within a larger thing; a part of a whole.” Nothing in the ordinary meaning of “portion” suggests that it necessarily requires a certain quantity or that a single component cannot be a “portion” of a multi-component invention. Rather, the ordinary meaning of “substantial portion” suggests that a single important or essential component can be a “substantial portion of the components” of a patented invention. . . .

[T]he use of “component” in § 271(f)(2) does not control the meaning of “components” in § 271(f)(1). The focus of the infringement inquiry under § 271(f)(1) is whether one or more components supplied by a party constitutes “all or a substantial portion of the components of a patented invention” and if so, whether the alleged infringer “actively induce[d] the combination” of those components. On the other hand, the focus of the infringement inquiry under § 271(f)(2) is whether a party has supplied any component “especially made or especially adapted for use in [a patented] invention” that is not a “staple article or commodity of commerce suitable for substantial noninfringing use.” . . .

Our determination that liability under § 271(f)(1) may attach for export of a single component does not end the inquiry, however. According to the statute, this component must be “a substantial portion” of the components of the patented invention. Here, we find substantial evidence to support the jury’s conclusion that the Taq polymerase supplied by LifeTech from the United States to its foreign facility is a “substantial portion” of the components of the LifeTech’s accused genetic testing kits.

Claim 42 of the Tautz patent recites five components: a primer mix, a polymerizing enzyme (such as Taq polymerase), nucleotides, a buffer solution, and control DNA. LifeTech’s domestic arm supplies the Taq polymerase to its facility in the United Kingdom, which both manufactures the remaining four components and assembles all the components into the accused STR kits. Taq polymerase is an enzyme used to amplify the

DNA sequences in order to obtain enough replicated sample for testing. Without Taq polymerase, the genetic testing kit recited in the Tautz patent would be inoperable because no PCR could occur. LifeTech's own witness admitted that the Taq polymerase is one of the "main" and "major" components of the accused kits. In short, there is evidence in the record to support the jury's finding that a polymerase such as Taq is a "substantial portion" of the patented invention.

In sum, we disagree with the district court that a single component supplied from the United States, no matter how important or central to the invention, can never constitute "a substantial portion of the components of a patented invention." The evidence demonstrates that LifeTech supplied a substantial portion of the patented invention—the polymerase—to its overseas facility as a component of its accused genetic testing kits. Further, whether LifeTech exhibited the necessary knowledge and intent to combine the Taq polymerase with the remaining components of its genetic testing kit "in a manner that would infringe" the Tautz patent if that combination occurred within the United States is not contested and is presumed. There is substantial evidence in the record to support the jury's finding that LifeTech is liable for infringement under 35 U.S.C. § 271(f)(1).