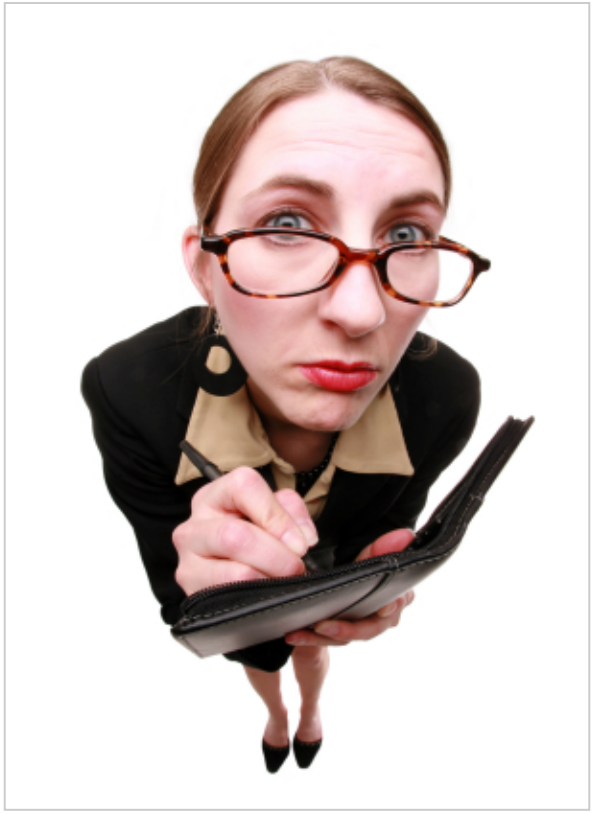
ILN IP Insider

An International Lawyers Network IP Group Publication

PLEADING PATENT INFRINGEMENT IN THE UNITED STATES?

BY DANIEL H. BLISS OF HOWARD & HOWARD ON JANUARY 11, 2017

POSTED IN PATENT INFRINGEMENT, PATENTS, UNITED STATES



How do you plead patent infringement in the United States? Can you survive a motion to dismiss if the defendant challenges the sufficiency of your complaint? What should you do?

Let's say your client has a United States patent that is believed to be infringed by another party. You do not rely on the client solely for facts, but conduct your own investigation to meet a pre-filing due diligence. You review the patent, prior art, and file history for claim construction. You also review the accused infringing device both independently and with your client. You prepare claim charts for all claims of the patent and apply elements of the claims to the accused infringing device in the claim chart. You may even obtain an opinion of counsel that is reasonable, comprehensive, and competent such that a reasonable litigant could believe that an infringement claim could succeed based on the opinion. This pre-filing due diligence will usually meet your obligation under Rule 11 of the Federal Rules of Civil Procedure.

After conducting your pre-filing due diligence, you draft a complaint for patent infringement. In the complaint, you plead the patent number, that the plaintiff owns the patent, that the defendant infringes the patent by selling products, and that notice was given to the defendant of the infringement, and request an injunction and damages. You file the complaint for a civil action in federal court and the defendant files a motion to dismiss under Rule 12 of the Federal Rules of Civil Procedure. What happened? Could you have done something to prevent this? The answer is YES!

Today, there is a higher standard for pleading patent infringement in a civil action in the federal courts of the United States. The law requires that the patent owner must set forth factual allegations that make infringement of the patent plausible and entitled to relief. The complaint should not provide threadbare recitals of elements supported by merely conclusionary statements. Enough underlying facts should be alleged to confirm the elements of a cause of action for patent infringement. Otherwise, the defendant may move to dismiss the complaint for a failure to state a claim under Rule 12(b)(6).

What if the patent has method claims? For direct infringement of a method claim, the complaint must allege that the steps are performed by or attributable to a single party. You must have proof that the defendant performs each step of the method. Although the plaintiff may meet its Rule 11 obligations with good faith, the plaintiff may be unable to make plausible inference of patent infringement. If the information is not readily accessible, information may be generally described in the complaint along with an explanation of why such undisclosed information was not readily accessible and any efforts made by such party to access information. For example, did the plaintiff send a letter to the defendant requesting the information?

What do you do in cases where there is no single party that performs all of the method steps? For joint infringement of a claimed method, multiple actors are involved in practicing the claimed steps. The

patent owner must show that the acts of one party are attributable to the other party such that a single party is responsible for patent infringement in the United States. The party will be responsible for the other party's performance of method steps in two circumstances. The first circumstance is where that entity directs or controls others' performance of the method steps. The second circumstance is where the actors form a joint enterprise. Therefore, in your complaint, you must set fourth any factual allegations that one party directed or controlled the other party.

As for practice tips, allegations of direct infringement of a patent require elements beyond the typical. You should plead counts and facts sufficient to allow a reasonable inference. For example, plead specific claims asserted and specific products by name. In addition, try to plead who, what, where, when, and why for sufficiency. If you find that your opponent has not done that, file a motion for Rule 12(b) prior to filing an answer to the complaint. In particular, you may want to file such a motion in instances where the plaintiff may be unable to amend its complaint. However, if a motion for Rule 12(b) is filed against you, consider amending your complaint before arguing the motion. Otherwise, if you loose on your motion, the judge may dismiss your complaint.

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Executive Offices
179 Kinderkamack Road
Westwood, NJ 07675
Tel: 201.594.9985/ Fax: 201.740.9765

About the ILN IP Specialty Group

Headed by Eddie Powell of Fladgate LLP, London, and Norman Zivin of Cooper & Dunham LLP, New York, New York, the ILN's Intellectual Property Group provides the platform for enhanced communication, enabling all of its members to easily service the needs of their clients requiring advice on cross-border transactions. Members of the group meet regularly at ILN conferences and industry events, and have collaborated on discussions and publications of mutual interest.

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