

4-1-2012

## Celebrating Contributions of Chief Judge Rader to Patent Infringement Jurisprudence

Katherine E. White

Follow this and additional works at: <https://digitalcommons.law.uw.edu/wjlta>



Part of the [Intellectual Property Law Commons](#), and the [Judges Commons](#)

---

### Recommended Citation

Katherine E. White, *Celebrating Contributions of Chief Judge Rader to Patent Infringement Jurisprudence*, 7 WASH. J. L. TECH. & ARTS 427 (2012).

Available at: <https://digitalcommons.law.uw.edu/wjlta/vol7/iss4/8>

This Article is brought to you for free and open access by the Law Reviews and Journals at UW Law Digital Commons. It has been accepted for inclusion in Washington Journal of Law, Technology & Arts by an authorized editor of UW Law Digital Commons. For more information, please contact [lawref@uw.edu](mailto:lawref@uw.edu).

CELEBRATING CONTRIBUTIONS OF CHIEF JUDGE RADER  
TO PATENT INFRINGEMENT JURISPRUDENCE

*Katherine E. White*\*

© Katherine E. White

Cite as: 7 Wash. J.L. Tech. & Arts 427 (2012)  
<http://digital.law.washington.edu/dspace-law/handle/1773.1/1129>

ABSTRACT

*Chief Judge Rader's judicial opinions contribute significantly to patent infringement jurisprudence. He writes from a teacher's perspective, providing context and a clear lens through which legal issues may be examined. His deep reverence for the rule of law pervades his opinions, as he injects a cadre of principles governing his approach. Each opinion builds a foundation made of consistency and clarity in upholding the fundamental purposes underlying the patent grant.*

---

\* Professor White has a B.S.E. in Electrical Engineering and Computer Science from Princeton University, a J.D. from the University of Washington, and an LL.M. from George Washington University Law School. From 1995-1996, she served as a judicial law clerk to the Honorable Randall R. Rader, Chief Judge, U.S. Court of Appeals for the Federal Circuit. Professor White is currently a Professor of Law at the Wayne State University Law School in Detroit. She also serves as a Lt. Colonel in the U.S. Army reserves, currently as an Instructor of Law at the United States Military Academy at West Point, NY. Appointed by the Secretary of Agriculture, she serves on the U.S. Department of Agriculture Plant Variety Protection Board (2004-2008, 2010-Present). In addition, she is a statewide elected member of the University of Michigan Board of Regents (1999-Present), a Fulbright Senior Scholar (1999-2000 Max Planck Institute, Munich, Germany), a White House Fellow (2001-2002), a former member of the United States Patent and Trademark Office Patent Public Advisory Committee (2000-2002), and a registered patent attorney.

## TABLE OF CONTENTS

Introduction .....	428
I. <i>AT&amp;T Corp. v. Microsoft Corp.</i> .....	430
II. <i>BMC Resources, Inc. v. Paymentech, LP</i> .....	433
III. <i>DSU Medical Corp. v. JMS Co.</i> .....	436
IV. <i>Johnson &amp; Johnston Assocs. Inc. v. R.E. Service Co., Inc.</i> .	439
V. <i>Sage Products, Inc. v. Devon Industries, Inc.</i> .....	441
VI. <i>Abbot Laboratories v. Sandoz, Inc.</i> .....	443
Conclusion.....	444

## INTRODUCTION

After leaving active duty from the United States Army Judge Advocate General's Corps, I was extraordinarily fortunate to serve a judicial clerk with the Honorable Randall R. Rader, now Chief Judge of the United States Court of Appeals for the Federal Circuit. Through this invaluable experience, I learned the importance of developing a cadre of principles for approaching legal issues, not only analytically, but also in writing text. Building a foundation of knowledge to draw on and build upon in one's written work demonstrates the proper respect for the monumental responsibility of writing judicial opinions.

Chief Judge Rader's judicial opinions have many admirable qualities. Most impressive is his profound belief in the significant role judicial opinions have in preserving our society's adherence to the rule of law. In his opinions there is reverence for the weight of that responsibility as well as an acute awareness of the importance of clarity. His strong conviction to create a consistent body of work that provides public notice of the state of the law is admirable and principled.

As George Harrison said in his song, "Any Road," "[i]f you do not know where you are going, any road will take you there."<sup>1</sup>

---

<sup>1</sup> GEORGE HARRISON, *Any Road*, on BRAINWASHED (Dark Horse 2003). This refrain is considered a paraphrase of a conversation between Alice and Cheshire Cat in LEWIS CARROLL, ALICE'S ADVENTURES IN WONDERLAND 89 (Macmillan Company 1897) (1865).

"Would you tell me, please, which way I ought to go from here?"

When drafting judicial opinions, it is important both to understand and to provide context. Consequently, as a judge you must know where you have been and why. You must also know where you are and how you got there. Finally, you must know where you want to go, why you want to go there, and the best way to get there. Judges must develop an approach to examine complicated legal issues that informs a direction consistent with where one wants to take the law, and at the same time, remains faithful to precedent. Although this may seem apparent to experts in exegesis (the critical interpretation of text), when drafting judicial opinions there is often a temptation to address issues haphazardly without regard for the negative impact clumsiness in word choice or rationale can have on judicial opinions.

Although Chief Judge Rader maintains the aforementioned characteristics in his opinions in all different areas of law, I only focus on his contributions in a sampling of patent infringement cases in this presentation. In reviewing patent infringement judgments, Chief Judge Rader's judicial opinions demonstrate consistency, clarity, predictability, and public notice as optimal qualities. Generally, recognizing the fundamental purpose underlying the patent grant and how it informs the outcome of the judgment is the primary consideration. Likewise, Chief Judge Rader acknowledges the role of the judiciary and how it differs from the Congressional role in the background of his opinions; it is as powerful as the undertow that pushes seaward.

Not only is Chief Judge Rader's writing ideology conducive to scripting judicial opinions, it also benefits teachers who can use his opinions as "signposts on the road." Chief Judge Rader, a professor himself, provides context and history in every opinion. He creates a map of where we have been that helps us better understand where we are going and why. His opinions are unique because he always pulls everything together in one opinion so it all fits on one map.

---

"That depends a good deal on where you want to get to," said the Cat.

"I don't much care where--" said Alice.

"Then it doesn't matter which way you go," said the Cat.

"--so long as I get *somewhere*," Alice added as an explanation.

"Oh, you're sure to do that," said the Cat, "if you only walk long enough."

Below is a sampling of the patent infringement cases where the aforementioned principles informed Chief Judge Rader's judicial opinions.

### I. *AT&T CORP. V. MICROSOFT CORP.*<sup>2</sup>

*AT&T Corp. v. Microsoft Corp.* raised issues regarding the extraterritoriality of the patent laws reminiscent of those addressed decades earlier in *Deepsouth Packing Co., Inc. v. Laitram Corp.*<sup>3</sup> To circumvent the patent laws, the defendant in *Deepsouth* sold components of a shrimp deveiner abroad that, if sold in combination in the United States, would have been a direct infringement under § 271(a).<sup>4</sup> The defendant's intent was for the components to be combined abroad, as they could be easily assembled in less than an hour.<sup>5</sup> The issue concerned whether the defendant, while barred from the American market because of the plaintiff's patents, was "also foreclosed . . . from exporting its deveiners, in less than fully assembled form, for use abroad."<sup>6</sup> The Supreme Court held the patent laws "make[] no claim to extraterritorial effect; 'these acts of Congress do not, and were not intended to, operate beyond the limits of the United States.'"<sup>7</sup> In finding that the patent laws are explicitly limited to national jurisdiction, the Supreme Court signaled to Congress that only the legislature has the authority to grant extraterritorial jurisdiction of the patent laws.<sup>8</sup> In response to *Deepsouth*, Congress enacted § 271(f), which expanded the territorial reach of U.S. patent laws.<sup>9</sup>

---

<sup>2</sup> 414 F.3d 1366 (Fed. Cir. 2005), *rev'd sub nom.* *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007).

<sup>3</sup> 406 U.S. 518 (1972).

<sup>4</sup> 35 U.S.C. § 271(a) (2000).

<sup>5</sup> *Deepsouth*, 406 U.S. at 524.

<sup>6</sup> *Id.* at 519.

<sup>7</sup> *Id.* at 531 (quoting *Brown v. Duchesne*, 60 U.S. 183, 195 (1856)).

<sup>8</sup> *Id.* at 530.

<sup>9</sup> *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 576 F.3d 1348, 1360 (Fed. Cir. 2009) ("describing Section 271(f) as a response to the '*Deepsouth* decision which interpreted the patent law not to make it infringement where the final assembly and sale is abroad'") (quoting Patent Law Amendments of 1984, S. REP. NO. 98-663, at 2-3 (1984)). The section states:

Decades later, in *AT&T*, the Federal Circuit faced a challenge to the extraterritorial reach of § 271(f). In that case, AT&T's patents covered an apparatus for digitally encoding and compressing recorded speech. Microsoft incorporated potentially infringing software into its Windows operating system. To avoid infringement on a massive scale, Microsoft sent its foreign licensees master versions of its Windows software, either via "golden master" disks or electronic transmission, for replication abroad.<sup>10</sup> AT&T sued for patent infringement. Microsoft defended by contending that liability does not attach unless a master disk or electronic transmission sent from the United States is in fact incorporated into a foreign-assembled computer abroad, which did not occur. In order to resolve this dispute, the Federal Circuit addressed two issues:

- (1) May software be a *component* of a patented invention under 271(f),<sup>11</sup> and
- (2) Are copies of software replicated abroad from a master version exported from the United States— with the intent that it be replicated—deemed

---

(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

35 U.S.C. § 271(f) (emphasis added).

<sup>10</sup> *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1368 (Fed. Cir. 2005).

<sup>11</sup> *Id.* at 1369.

*supplied* for purposes of 271(f)?<sup>12</sup>

To answer the first question, the court looked to a prior Rader opinion written a few months earlier, *Eolas Technologies Inc. v. Microsoft Corp.*<sup>13</sup> That case held that software code qualifies as a patent eligible invention and that § 271(f) does not limit its language to patented machines or structures. Thus, software may be a component of a patented invention for purposes of § 271(f).<sup>14</sup> But unlike the combination in *Eolas*, where the actual disks exported were incorporated into the foreign computers, in *AT&T* only *copies made abroad* of the exported Windows software were installed on foreign-assembled computers.<sup>15</sup> These computers were then sold to foreign customers, not domestic ones. Nevertheless, the Federal Circuit, with Judge Rader in dissent, found the “act of copying is subsumed in the act of ‘supplying,’ [and sending one copy abroad] with the intent that it be replicated invokes § 271(f) liability . . . .”<sup>16</sup>

Judge Rader dissented, recognizing that the panel’s definition of supplying a component would give “rise to endless liability in the United States under § 271(f) for products manufactured entirely abroad.”<sup>17</sup> He also disagreed with the majority because the ease of copying was “not the proper basis for making distinctions under § 271(f).”<sup>18</sup> Referring to his prior opinion in *Eolas*,<sup>19</sup> Judge Rader cited to the TRIPs<sup>20</sup> Agreement, which states generally that patent rights shall be enjoyed without discrimination as to the field

---

<sup>12</sup> *Id.*

<sup>13</sup> *Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005).

<sup>14</sup> *AT&T Corp.*, 414 F.3d at 1369 (citing *Eolas Techs. Inc.*, 399 F.3d at 1339).

<sup>15</sup> *Id.* at 1369.

<sup>16</sup> *Id.* at 1370.

<sup>17</sup> *Id.* at 1372 (Rader, J., dissenting).

<sup>18</sup> *Id.* at 1374.

<sup>19</sup> *Eolas*, 399 F.3d at 1339.

<sup>20</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, THE LEGAL TEXTS: THE RESULTS OF THE RESULTS OF THE URUGUAY ROUND OF MULTILATERAL TRADE NEGOTIATIONS 320 (1999), 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPs].

of technology.<sup>21</sup> In contrast, the majority treated software inventions differently from other subject matter, contravening both precedent and TRIPs. Appropriately, to address the conflict in precedent and the jeopardized path to predictability, the Supreme Court granted certiorari and resolved the inconsistency by reversing the Federal Circuit, citing to Judge Rader's dissent in the process.<sup>22</sup>

The Court agreed with Judge Rader, noting that “nothing in § 271(f)'s text . . . renders ease of copying a relevant . . . factor in triggering liability for infringement.”<sup>23</sup> Further agreeing, the Court stated that Congress is no doubt aware how easy it is to copy software and any change in the law should be made after careful legislative deliberation, “and not by the [j]udiciary forecasting Congress' likely disposition.”<sup>24</sup> Just like in *Deepsouth*,<sup>25</sup> the Supreme Court signaled to Congress to change the fundamentals of the law, as is its role.

## II. *BMC RESOURCES, INC. v. PAYMENTECH, LP*<sup>26</sup>

BMC appealed a summary judgment finding of non-infringement of two of its patents on a method for processing debit transactions without a personal identification number (PIN).<sup>27</sup> The trial court found that Paymentech, the alleged infringer, had performed some, but not all, of the steps in the averred method claims.<sup>28</sup> Instead, other parties performed the remainder of the claimed method steps.<sup>29</sup> This case presented the opportunity to

---

<sup>21</sup> TRIPs, Part II, § 5 (“Patents shall be available and patent rights enjoyable without discrimination as to the place of invention . . . [and] the field of technology”).

<sup>22</sup> *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 453 (2007).

<sup>23</sup> *Id.*

<sup>24</sup> *Id.* at 459.

<sup>25</sup> *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 530 (1972) (“[T]he sign of how far Congress has chosen to go [regarding the infringement of combination patents abroad] can come only from Congress.”).

<sup>26</sup> 498 F.3d 1373 (Fed. Cir. 2007).

<sup>27</sup> *Id.* at 1375.

<sup>28</sup> *Id.*

<sup>29</sup> *Id.* at 1378.



address the requirements for proving direct or indirect infringement of a method claim, when no one party performs all the steps of the patented method invention. To address this question, two issues had to be resolved: first, whether direct infringement of method claims requires each step in the claim to be performed, and second, whether vicarious liability for the acts of other parties requires control over of the conduct of the other parties.<sup>30</sup>

The case law on whether each step of a method claim must be performed for direct infringement liability is a well-settled issue: “[Direct] infringement occurs when a party performs all of the steps of the process.”<sup>31</sup> The standards for vicarious liability, however, had been apparently muddled by an earlier Federal Circuit case, *On Demand Machine Corp. v. Ingram Industries, Inc.*<sup>32</sup> By not directly analyzing the infringement, the *On Demand* court ostensibly affirmed a jury instruction that was perceived as an inaccurate description of Federal Circuit precedent by *BMC*.<sup>33</sup>

*On Demand* could be interpreted as conceding that joint infringers are jointly liable for infringement in cases where neither infringer performs all of the claimed steps. Consequently, to show

---

<sup>30</sup> See *id.* at 1379-80.

<sup>31</sup> *Id.* at 1379 (citing *Joy Techs., Inc. v. Flakt, Inc.*, 6 F.3d 770, 773 (Fed. Cir. 1993)).

<sup>32</sup> *On Demand Mach. Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331 (Fed. Cir. 2006).

<sup>33</sup> The language in *On Demand*, reads:

It is not necessary for the acts that constitute infringement to be performed by one person or entity. When infringement results from the participation and combined action(s) of more than one person or entity, they are all joint infringers and jointly liable for patent infringement. Infringement of a patented process or method cannot be avoided by having another perform one step of the process or method. Where the infringement is the result of the participation and combined action(s) of one or more persons or entities, they are joint infringers and are jointly liable for the infringement.

*On Demand*, 442 F.3d at 1344-45; see also *BMC*, 498 F.3d at 1379-80 (stating the court merely discerned no flaw in the instructions above as a statement of law, but did so without any analysis of the issues related to divided infringement).

vicarious liability, there would be no requirement for one infringer to have control over the other. Judge Rader writes for the court in *BMC*, dispelling this misconception and clearly articulating the following standards:

- (1) “Infringement requires, as it always has, a showing that a defendant has practiced each and every element of the claimed invention.”<sup>34</sup>
- (2) Where a party is engaged in indirect infringement, “this court has held that inducement of infringement requires a predicate finding of direct infringement.”<sup>35</sup>
- (3) “A party cannot avoid infringement . . . simply by contracting out steps of a patented process to another entity. . . . The party in control [is] liable for direct infringement.”<sup>36</sup>

In other words, regarding points one and two, properly pleading an act of indirect infringement, including either active inducement infringement under § 271(b)<sup>37</sup> or contributory infringement under § 271(c),<sup>38</sup> requires alleging an act of direct infringement. Rather than merely stating this point like prior cases have, Judge Rader explains why this requirement exists by exploring the statutory scheme for indirect infringement. Because “[d]irect infringement is a strict-liability offense, . . . it is limited to those who practice each and every element of the claimed invention.”<sup>39</sup> On the other hand, active inducement infringement is not a strict liability offense. Instead, active inducement requires showing specific intent to induce infringement, yet it does not call for each and every element of the claimed invention to be infringed by the inducer. Similarly, contributory infringement, also not a

---

<sup>34</sup> *BMC*, 498 F.3d at 1380 (citing *Warner-Jenkinson Co. v. Hilton-Davis Chem. Corp.*, 520 U.S. 17, 40 (1997)).

<sup>35</sup> *Id.* (citing *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263, 1272 (Fed. Cir. 2004)).

<sup>36</sup> *Id.* at 1381.

<sup>37</sup> 35 U.S.C. § 271(b).

<sup>38</sup> 35 U.S.C. § 271(c).

<sup>39</sup> *BMC*, 498 F.3d at 1381.

strict-liability offense, requires knowledge of sales of components or materials without having substantial non-infringing uses.<sup>40</sup> In adhering to and discussing the purpose behind § 271(a) versus indirect infringement under § 271(c), the court addresses strict liability versus the knowledge or intent requirements.<sup>41</sup>

*BMC* is a wonderful case to use when teaching about patent enforcement litigation. It is often difficult to explain to students how to properly plead a claim of contributory infringement because, to plead correctly, one must allege one act of direct infringement.

### III. *DSU MEDICAL CORP. v. JMS CO.*<sup>42</sup>

The en banc court in *DSU* looked at the Supreme Court opinion in *MGM Studios, Inc. v. Grokster, Ltd.*,<sup>43</sup> where the Court established the standard for active inducement infringement in copyright cases and resolved conflicting precedent.<sup>44</sup> As with previous Supreme Court cases over the last decade and a half, the Court signaled its disapproval for carving out special rules that treat patent cases differently when precedent incorporates traditional notions of equity, intent, and willfulness.<sup>45</sup>

---

<sup>40</sup> *Id.*

<sup>41</sup> *Id.*; see *Waymark Corp. v. Porta Sys. Corp.*, 245 F.3d 1364, 1367 (Fed. Cir. 2001) (opinion written by Judge Rader states that 271(f)(2) only requires intent that components will be combined abroad and that it does not incorporate the doctrine of contributory infringement). Although an act of direct infringement need not be alleged, 271(f)(2) is not a strict liability standard. Intent is required. Thus, when not infringing each and every element of the invention, knowledge or intent is required, as *BMC* advises. See *BMC*, 498 F.3d at 1381.

<sup>42</sup> 471 F.3d 1293 (Fed. Cir. 2006).

<sup>43</sup> *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005).

<sup>44</sup> *Grokster*, 545 U.S. at 934-36 (requiring active steps in encouraging infringement to prove inducement).

<sup>45</sup> See *Safeco Ins. Co. of Am. v. Burr*, 551 U.S. 47, 56-59 (2007) (setting forth a general standard for willfulness includes recklessness); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391-92 (2006) (traditional notions of equity should be applied to decisions to grant permanent injunctions); *MGM Studios*, 545 U.S. at 934-36. See generally *MedImmune, Inc. v. Genentech, Inc.*,

In order to incorporate these longstanding principles, Judge Rader, writing for the court, resolved conflicting precedent regarding the requirements for proving active inducement infringement.<sup>46</sup> Although *DSU* is a panel opinion, it has an en banc component, Section III. B. It addressed the requirement in *Grokster* that inducement includes active steps encouraging infringement.<sup>47</sup>

In *DSU*, Judge Rader addressed three guiding principles or rules resolving conflicting precedent involving required intent for proving active inducement infringement:

(1) To prove inducement, the plaintiff has the burden of showing the alleged infringer “knew or should have known his actions would induce actual infringement.”<sup>48</sup>

(2) Proving inducement necessarily requires showing that the alleged infringer knew of the patent.<sup>49</sup>

(3) Plaintiff must prove that once the alleged infringers “knew of the patent, they ‘actively and knowingly aid[ed] and abett[ed] another’s direct infringement.’”<sup>50</sup> In other words, “specific intent and action to induce infringement”<sup>51</sup> is required; mere “‘knowledge of the acts alleged to constitute infringement’ is not enough.”<sup>52</sup>

Although *DSU* finally clarified Federal Circuit precedent, in

---

549 U.S. 118 (2007).

<sup>46</sup> *DSU*, 471 F.3d at 1305.

<sup>47</sup> *Id.* at 1304-06 (citing *Grokster*, 545 U.S. at 934-36).

<sup>48</sup> *Id.* at 1304.

<sup>49</sup> *Id.* (citing *Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354, 1364 n.4 (Fed. Cir. 2006)).

<sup>50</sup> *Id.* (quoting *Water Techs. Corp. v. Calco, Ltd.*, 850 F.2d 660, 668 (Fed. Cir. 1988)) (modifications in original).

<sup>51</sup> *Id.*

<sup>52</sup> *DSU*, 471 F.3d at 1305. (quoting *Warner-Lambert Co. v. Apotex Corp.*, 316 F.3d 1348, 1363 (Fed. Cir. 2003)).

*Global-Tech Appliances, Inc. v. SEB S.A.*,<sup>53</sup> the Supreme Court clarified the knowledge threshold required to prove active inducement infringement. The Court recognized that both the language in 271(b) and the pre-1952 case law were “susceptible to conflicting interpretations” of the intent required to show inducement.<sup>54</sup> The Court held that the same knowledge needed to show contributory infringement was required for active inducement infringement.<sup>55</sup> The Court adopted the “willful blindness” standard in criminal law as the required proof that the alleged infringer acted knowingly and willfully to induce infringement.<sup>56</sup>

The Court noted that “willful blindness” is a concept holding defendants who “deliberately shield[] themselves from clear evidence” as criminally liable “as those who have actual knowledge.”<sup>57</sup> The Court stated that “willful blindness” has two basic requirements: (1) the defendant must subjectively believe that there is a high probability that a fact exists and (2) the defendant must take deliberate actions to avoid learning of that fact.<sup>58</sup>

The Court clarifies that “willful blindness” is more limited in scope than recklessness or negligence. With “willful blindness,” it is almost as if the defendant actually knew of the wrongdoing; “[b]y contrast, a reckless defendant is one who merely knows of a substantial and unjustified risk of such wrongdoing . . . .”<sup>59</sup>

The Supreme Court’s test departs from the Federal Circuit’s test in two ways. First, the Federal Circuit permits a finding of

---

<sup>53</sup> *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011).

<sup>54</sup> *Id.* at 2067.

<sup>55</sup> *Id.* at 2068 (noting 271(b) and 271(c) “have a common origin in the pre-1952 understanding of contributory infringement,” and thus both should have same meaning).

<sup>56</sup> *Id.* at 2068-69.

<sup>57</sup> *Id.* at 2069 (citing J. LI. J. Edwards, *The Criminal Degrees of Knowledge*, 17 MOD. L. REV. 294, 302 (1954)).

<sup>58</sup> *Global-Tech Appliances*, 131 S. Ct. at 2070.

<sup>59</sup> *Id.* at 2071.

knowledge when there is merely a “‘known risk’ that the induced acts are infringing.”<sup>60</sup> Second, the Federal Circuit’s test “does not require active efforts by the inducer to avoid knowing about the infringing nature of the activities.”<sup>61</sup>

IV. *JOHNSON & JOHNSTON ASSOCS. INC. V.  
R.E. SERVICE CO., INC.*<sup>62</sup>

The Federal Circuit case *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.* involves the patentee’s invention for an assembly tool that prevents damage to thin sheets of copper foil that are used in making circuit boards as workers manually handle the sheets during the layering process. The invention is a stiff substrate that adheres to the fragile copper foil, thereby protecting it from damage.<sup>63</sup> The patent specification discloses aluminum as the preferred substrate, but also lists other metals, such as stainless steel or nickel alloys.<sup>64</sup> Although the patent discloses the use of other metals, it does not claim their use, instead only claiming aluminum.<sup>65</sup> RES, a competitor, instead of using aluminum as a substrate, used steel. The patentee sued RES for patent infringement. RES cited *Maxwell v. J. Baker, Inc.*<sup>66</sup> as a foundation for its argument that the steel substrate is dedicated to the public because the patentee disclosed but did not claim steel. *Maxwell* prohibits expanding claim scope in a non-textual infringement analysis to cover material disclosed, but not claimed.<sup>67</sup> The patentee disagreed, citing *YBM Magnex, Inc. v. International Trade Commission*,<sup>68</sup> where a similar magnet alloy

---

<sup>60</sup> *Id.*

<sup>61</sup> *Id.*

<sup>62</sup> 285 F.3d 1046 (Fed. Cir. 2002) (en banc).

<sup>63</sup> *Id.* at 1049.

<sup>64</sup> *Id.* at 1050.

<sup>65</sup> *Id.* at 1051.

<sup>66</sup> 86 F.3d 1098, 1106 (Fed. Cir. 1996) (holding “subject matter disclosed but not claimed in a patent application is dedicated to the public”) (quoting *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562-63 (Fed. Cir. 1991).

<sup>67</sup> *Maxwell*, 86 F.3d at 1106.

<sup>68</sup> *YBM Magnex, Inc. v. Int’l Trade Comm’n*, 145 F.3d 1317, 1321 (Fed. Cir. 1998) (limiting *Maxwell* to instances where an unclaimed alternative is

differed from the claimed alloy in its oxygen content.<sup>69</sup> *YBX* limits *Maxwell* to cases where an unclaimed alternative is disclosed and is distinct from the claimed invention. *YBX* also affirmatively states *Maxwell* “did not create a new rule of law that doctrine of equivalents could never encompass subject matter disclosed in the specification but not claimed.”<sup>70</sup>

To resolve the conflict in precedent, the Federal Circuit took *Johnson* en banc and held that “when a patent drafter discloses but declines to claim subject matter,”<sup>71</sup> the unclaimed subject matter is dedicated to the public. The court also overruled any portion of *YBX* that was inconsistent with its ruling in *Johnson*.<sup>72</sup> Judge Rader wrote separately to further identify and clarify the competing interests involved when unclaimed alternatives are disclosed in a patent.

Judge Rader’s concurrence, in which then-Chief Judge Mayer joined, articulates the crucial public and notice function of patent claims that the Supreme Court describes in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*<sup>73</sup> In his concurrence, Judge Rader reconciles the “preeminent notice function of patent claims with the protective function of the doctrine of equivalents.”<sup>74</sup>

He emphasizes that the purpose of the doctrine of equivalents is to prevent the unscrupulous copyist from escaping infringement.<sup>75</sup> The doctrine of equivalents, however, must be balanced as to not upset the notice function of claim language. The patentee should be prevented from capturing equivalents the “drafter reasonably could have foreseen during the application process and included in the claims.”<sup>76</sup> Judge Rader mentions that the Supreme Court and Federal Circuit have addressed this conflict through limiting non-textual infringement to require an equivalent

---

disclosed that is distinct from the claimed invention).

<sup>69</sup> *Id.* at 1319.

<sup>70</sup> *Johnson & Johnston*, 285 F.3d at 1051 (citing *YBX*, 145 F.3d at 1321).

<sup>71</sup> *Id.* at 1054.

<sup>72</sup> *Id.* at 1055.

<sup>73</sup> 520 U.S. 17, 29 (1997).

<sup>74</sup> *Johnson & Johnston*, 285 F.3d at 1056 (Rader, J., concurring).

<sup>75</sup> *Graver Tank & Mfg. Co., Inc. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950).

<sup>76</sup> *Johnson & Johnston*, 285 F.3d at 1056 (Rader, J. concurring).

for each and every element of a patent claim.<sup>77</sup>

To further balance these juxtaposed goals, Judge Rader suggests an additional limitation for analyzing non-textual infringement. When a skilled artisan “in the relevant art would foresee coverage of an invention, a patent drafter has an obligation to claim those foreseeable limits.”<sup>78</sup> In that way, the definitional and notice function of the claims are further preserved, thereby encompassing the entire claim scope for all foreseeable circumstances.<sup>79</sup> In essence, Judge Rader advocates providing a foreseeability bar as a way to boost the notice function of claims.<sup>80</sup> As he makes this suggestion, he hearkens back to a prior case he wrote for the court, *Sage Products, Inc. v. Devon Industries, Inc.*,<sup>81</sup> which articulates this principle.

#### V. *SAGE PRODUCTS, INC. v. DEVON INDUSTRIES, INC.*

In *Sage Products, Inc. v. Devon Industries, Inc.*, the patentee disclosed a disposal container to safely deposit sharp medical waste without touching the waste already present in the container.<sup>82</sup> Sage claimed its invention clumsily by requiring “an elongated slot at the top of the container body for permitting access to the interior of the container body.”<sup>83</sup> The alleged infringer’s elongated slot, however, lies within the container body, not on top of it.<sup>84</sup> Sage therefore could not prove literal infringement and so it sought to find Devon liable for infringement under the doctrine of equivalents. Devon relied on *Warner-Jenkinson*<sup>85</sup> when it asserted that “the doctrine of equivalents d[id] not grant Sage license to

---

<sup>77</sup> *Id.* at 1056-57 (Rader, J. concurring) (citations omitted).

<sup>78</sup> *Id.* at 1057 (Rader, J. concurring).

<sup>79</sup> *Id.*

<sup>80</sup> *Id.*

<sup>81</sup> 126 F.3d 1420 (Fed. Cir. 1997).

<sup>82</sup> *Id.* at 1422.

<sup>83</sup> *Id.* (emphasis removed).

<sup>84</sup> *Id.* at 1423.

<sup>85</sup> *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (“It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.”).



remove entirely the ‘top of the container’ and ‘over said slot’ limitations from the claim.”<sup>86</sup> Devon’s position was, in effect, that if a patentee claims narrowly, but could have claimed more broadly, the doctrine of equivalents should not be a vehicle for fixing ineptly drafted claim language.

The question to the court, then, was who should bear the risk of loss as “between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large.”<sup>87</sup> The court stated that the patentee must bear the risk of loss:<sup>88</sup> “If Sage desired broad patent protection for any container that performed a function similar to its claimed container, it could have sought claims with fewer structural encumbrances.”<sup>89</sup> A premium is placed on forethought in patent drafting.<sup>90</sup>

Another important statement in the opinion holds the patent drafter’s feet to the fire regarding the importance of ensuring that what is said during prosecution must be consistent with what is said when arguing for equivalents:

Where a patent claim recites a specific function for an element of the claim and the written description reiterates the importance of that particular function, a patentee may not later argue, during the course of litigation, that an accused device lacking that functionality is equivalent.<sup>91</sup>

The entire opinion reflects on the public notice function of claims, which will limit a patentee’s ability to circumvent what it initially claimed and later obtain broader coverage through equivalents. In other words, the patent grant is not a *carte blanche* to capture patent protection where none was conceived.

---

<sup>86</sup> *Sage Prods.*, 126 F.3d at 1424.

<sup>87</sup> *Id.* at 1425.

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* at 1429-30 (citing *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 938 (Fed. Cir. 1987)).

VI. *ABBOT LABORATORIES V. SANDOZ, INC.*<sup>92</sup>

In *Abbot Laboratories v. Sandoz, Inc.*,<sup>93</sup> the Federal Circuit, en banc, clarified the scope of product-by-process claims by adopting the rule in an earlier Rader opinion, *Atlantic Thermoplastics Co. v. Faytex Corp.*<sup>94</sup> In that case, Judge Rader, writing for the panel, criticized the rule in *Scripps Clinic & Research Foundation v. Genentech, Inc.*,<sup>95</sup> which stated “the correct reading of product-by-process claims is that they are not limited to product prepared by the process set forth in the claims.”<sup>96</sup> The court justified rejecting this rule because the rule need not be followed if the court determines that the prior panel would have reached a different conclusion if it had considered controlling precedent.<sup>97</sup>

Recognizing the need to resolve the conflict in precedent, Judge Rader, writing for the court, held that the scope of product-by-process claims in patent infringement determinations is limited by the recited process terms, and in so doing finally overruled and laid to rest *Scripps Clinic*.<sup>98</sup> The *Abbot* opinion clarified that limiting language in the specification will not be read into the claims unless there is a clear and intentional disavowal of claim scope.<sup>99</sup> But, the proper reading of product-by-process claims incorporates process limitations in defining claim scope for infringement purposes.<sup>100</sup>

---

<sup>92</sup> 566 F.3d 1282 (Fed. Cir. 2009).

<sup>93</sup> *Id.* (en banc as to the cited issue).

<sup>94</sup> 970 F.2d 834 (Fed. Cir. 1992). In that case, Judge Rader, writing for the panel, criticized the rule in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, which stated “the correct reading of product-by-process claims is that they are not limited to product prepared by the process set forth in the claims.” *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1583 (Fed. Cir. 1991), *overruled by* *Abbot Labs. v. Sandoz, Inc.*, 566 F.3d 1282 (Fed. Cir. 2009) (en banc).

<sup>95</sup> *Id.* at 1565.

<sup>96</sup> *Id.* at 1583.

<sup>97</sup> *Atlantic Thermoplastics*, 970 F.2d 838 n. 2.

<sup>98</sup> *Id.* at 838.

<sup>99</sup> *Abbot Labs.*, 566 F.3d at 1290.

<sup>100</sup> *Id.* at 1292.

### CONCLUSION

Chief Judge Rader's judicial opinions contribute significantly to patent infringement jurisprudence. He writes from a teacher's perspective, providing context and a clear lens through which legal issues may be examined. His deep reverence for the rule of law pervades his opinions, as he injects a cadre of principles governing his approach. Each opinion builds a foundation made of consistency and clarity in upholding the fundamental purposes underlying the patent grant.