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No Inducement under Section 271(f)(1) for Shipping Abroad a Single Component of a Multicomponent Invention

In its recent decision in *Life Technologies* Corp. *v. Promega Corp*.[1], the Supreme Court limited infringement liability under 35 U.S.C. § 271(f)(1). This section of the patent infringement statute imposes liability upon an entity that 1) supplies from the U.S. "a substantial portion of the *components* of a patented invention" and 2) actively induces the combination of such *components*, outside of the U.S., in a manner that would infringe a U.S. patent. The Supreme Court held that infringement under Section 271(f)(1) does not cover the export of a single component of a patented invention.

In 2010, Promega sued Life Technologies ("Life Tech") on multiple grounds, including infringement of U.S. Reissue Patent No. RE 37,984 (the '984 patent), based on Life Tech's sales of a diagnostic kit in breach of a license. The kit at issue amplifies DNA and is used primarily by law enforcement for forensic purposes. The '984 patent claims a kit having five key components. Life Tech conceded that its kits were covered by the claims of the '984 patent. However, Life Tech only manufactured one kit component within the U.S. and induced the combination of all five components of the kit overseas.

At the district court level, a jury found Life Tech liable for infringement under Section 271(f)(1). However, the district court granted a Life Tech's motion for judgment as a matter of law that shipping a single component abroad could not give rise to liability under this section of the statute.

On appeal, the Court of Appeals for the Federal Circuit ("CAFC") reversed the district court and held that "a substantial portion of the *components* of a patented invention" could cover a single important component. In other words, the CAFC set out a qualitative test that could vary based on the evidence of each separate case.

The Supreme Court reversed. In an interesting departure from the Supreme Court's typical unmaking of the CAFC's bright line tests, the Supreme Court opted to interpret the statute to require a quantitative test. The Supreme Court reached its decision by primarily focusing on the plain language of the statue in the context of Section 271(f)(2). Section

[1] 580 U.S. ____ (2017).

271(f)(2) imposes liability upon an entity that 1) supplies from the U.S. "*any component* of a patented invention that is especially made or especially adapted for use in the invention", 2) knows that the *component* is not a staple article suitable for substantial non-infringing use, and 3) knows that the *component* will be combined outside of the U.S. in a manner that would infringe a U.S. patent. The Supreme Court reasoned that because Section 271(f)(2) explicitly covers a single, specialized component of a patented invention, while Section 271(f)(1) referred to multiple components and a substantial portion thereof, there is no contextual support for departing from the plain meaning of the statute.

As Justice Alito's concurring opinion points out, it is not clear just how many components can a defendant export from the U.S. before running afoul of Section 271(f)(1). Answering this quantitative question would seem to be just as case specific and uncertain for market players as the original test set forth by the CAFC.