



## TRENDING

### Designing Around a Patent as an Alternative to a License

In some instances in which a company finds itself in the cross-hairs of a patent infringement cease-and-desist letter or lawsuit, a license may not be a viable option. That is often the case when the patent holder is a competitor intent on enforcing a patent against its rivals. The first line of defense in such situations is to explore whether you have a solid argument of non-infringement based on the absence of an essential element of the patent's independent claims. However even if an element is arguably missing, you still must consider whether your accused product or service might be found to infringe under the doctrine of equivalents.

The next line of defense is to assess whether the patent is invalid for one or more reasons (e.g., non-patentable subject matter, anticipation, obviousness, indefiniteness, enablement, inequitable conduct). Any such defense, however, must overcome the presumed validity of the patent. In addition, the development of such a defense customarily requires time and money, including extensive prior art searches.

An often-overlooked approach is to re-design your product or service to avoid infringement. Design-arounds are encouraged under the law. They entail eliminating a prescribed element or step found in the patent claims. Under the "all elements rule," for a patent to be infringed, the accused product, method or service must include each and every element or step recited in the relevant independent claims. If a particular element or step can be eliminated without compromising the marketability of your accused product or service, it may be possible to avoid infringement. However, simply adding a new element or additional step does not suffice. If it is not possible to eliminate an element or step without undermining the value or functionality of your accused product or service, then you should consider whether it is possible to either substitute something for that element or carry out a step in a materially different way. Even then, your re-designed accused product or service will not necessarily guarantee a safe harbor. The patent holder in response to a design-around may either (1) assert the doctrine of equivalents to reach your new product or service or (2) return to the patent office with a continuation or continuation-in-part (CIP) application squarely aimed at covering your newly-designed product or service, while still taking advantage of the parent or earlier application's priority filing date.

Under the doctrine of equivalents, the test will be whether, notwithstanding your design-around, your product or service accomplishes the same function as the claimed invention in substantially the same way to obtain the same result. The applicability of this doctrine will turn, in part, on the patent's prosecution history. If the patent holder, in an attempt to distinguish over the teachings of prior art patents or

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systems, limited the scope of the patent's reach or narrowed the meaning of particular claim terms, the doctrine of equivalents may not apply.

While it may seem both unfair and contrary to the policy of providing notice of a patent to the public, a patent holder is free to file a continuation application for the express purpose of covering a competitor's newly-designed patent or service. In fact, such second bites at the apple are common. However, in order to invoke and take advantage of the earlier priority date, the applicant must convince the examiner that the "new" patent claims in the continuation or CIP are supported by (1) the patent description found in the earlier application and (2) the prior prosecution history. Wholly new claims or subject matter will not be able to utilize the earlier priority date.

The lesson to be taken away is that the efficacy of a design-around is likely to depend on how significant the change is in terms of the claimed invention's novelty and/or functionality. One should also consider the possibility of incorporating changes that make use of long-standing prior art techniques, methods or elements, especially any that were cited by the patent examiner, in response to which prior art the patentee either amended its claims or distinguished its invention from such prior art during the course of prosecution.

Ultimately, even if your design-around does not hold up in court, it will likely reduce the risk of willful infringement and enhanced damages.

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## **GC SURVIVOR KIT**

### **Beware of Third-Party Solicitation Notices**

If you own issued patents or trademark registrations in the United States, you are required to make certain filings with the U.S. Patent and Trademark Office (USPTO) to keep your patents and trademark registrations alive. There are numerous companies unaffiliated with the USPTO that send solicitation letters to patent and trademark owners offering to assist with the payment of these maintenance fees. In addition, these companies may also reach out to offer services to register your trademark on private registries or to offer various monitoring services.

These solicitation letters look official because they are usually in the form of an invoice, and the information included is generally accurate because it is pulled from public databases. In addition, these solicitations come from businesses using names that resemble the USPTO's name and often include the words "United States," "Trademark," "Patent" or "Office," which leads one to believe that the companies are associated with, or are working on behalf of, the USPTO. Despite this appearance, however, these companies have no association with or connection to the USPTO. Many times the information provided in these solicitation letters is misleading and/or incorrect, and would require you to pay fees that are higher than the official USPTO filing fees.

The USPTO advises that all official correspondence sent by the USPTO concerning your U.S. patents and trademarks will come from the "United States Patent and Trademark Office" in Alexandria, VA, with a Zip code of 22313. If the USPTO contacts you by email, it will be from the domain "@uspto.gov." If you receive a letter or invoice from a different address or from an individual you have not authorized to act on your behalf, or if the request requires you to send a payment to an address other than the USPTO's address above, you may want to consider contacting your

legal counsel to have them advise you on what steps should be taken, or contact the USPTO directly.

For more information on these solicitation letters, please visit <https://www.uspto.gov/patents-getting-started/using-legal-services/scam-prevention/non-uspto-solicitations>.

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