



## 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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