A LITTLE INFRINGEMENT IS ALL THAT COUNTS

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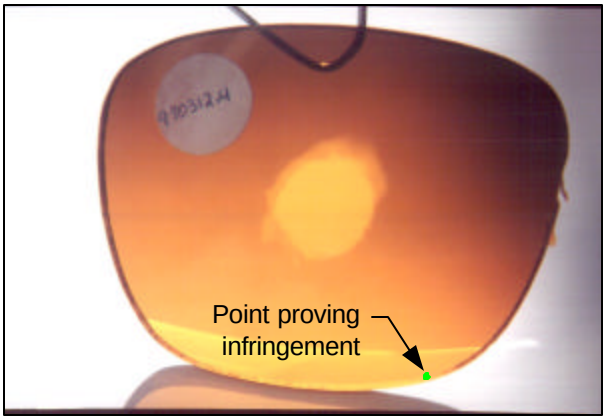
> Charles Darwin once observed, "How odd it is that anyone should not see that all observation must be for or against some view if it is to be of any service."[1]

In *SunTiger, Inc. v. Scientific Research Funding Group*, the Federal Circuit faced the question of how much infringement is enough to constitute patent infringement?[2] SunTiger owned a patent with claims directed to an orange-dyed sunglass lens. The claims required the lens to have certain light-transmission characteristics. Defendant BluBlocker sold sunglasses that SunTiger asserted to be infringing, however, SunTiger's proof of infringement was a single test at one point on the bottom corner of BluBlocker's lens. The diameter of the point proving infringement was less than the tip of a pencil.



BluBlocker argued the case was extreme and that SunTiger's proof of infringement was insignificant. In particular, BluBlocker argued that SunTiger's proof at one point on the lens was at a point far from the center of the lens – the portion primarily used by the human eye. BluBlocker further argued that it applied a gray coating to over 99% of its lens that prevented the lens from

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[1] As quoted in Smithsonian Magazine, April 1992 at 13. The authors offer this article for a view, to be of service to the patent bar. The article does not reflect the views of the authors' law firm or their partners. The opinions expressed are subject to change as the patent law develops.

[2] *SunTiger, Inc. v. Scientific Research Funding Group*, 189 F.3d 1327, 1999 U.S. App. LEXIS 19631 (Fed. Cir. 1999).

satisfying the claims' light-transmission limitations. A District Court granted BluBlocker summary judgment. SunTiger appealed.

In a case of first impression, the Federal Circuit reversed and found that a single point on BluBlocker's lens was all that was necessary to prove infringement. In its opinion, the Federal Circuit first examined the basis for the District Court's decision.

> Reasoning that the gray coating that BluBlocker applied to its accused orange-dyed lens changes the transmission characteristics of the lens such that it is outside the scope of the asserted claims, the district court granted summary judgment of non-infringement to BluBlocker. *See* Joint App. at A69-70, Hearing Tr. Feb. 13, 1998 at 21-22 (before Judge Leonie M. Brinkema). This conclusion was reached despite the evidence that the 'right bottom' of the accused lens met the claim limitations. [3]

The Federal Circuit found error in the District Court's conclusion that BluBlocker's lens did not satisfy the claim limitations:

> The district court was persuaded that the gray coating on the BluBlocker lens changed an inherent property, thereby removing the accused lens from infringement. The district court's error lies in the fact that we have never required that a claim read on the entirety of an accused device in order to infringe.[4]

The Federal Circuit then stated the correct rule: "[i]f a claim reads merely on a part of an accused device, that is enough for infringement."[5] The Federal Circuit explained the rule as reliant on *Stiftung v. Renishaw PLC*:[6]

> It is fundamental that one cannot avoid infringement merely by adding elements if each element recited in the claims is found in the accused device. For example, a pencil structurally infringing a patent claim would not become noninfringing when incorporated into a complex machine that limits or controls what the pencil can

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[3] *SunTiger,* 189 F.3d at __, 1999 U.S. App. LEXIS at *20.
[4] *Id.*
[5] *Id.*
[6] *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1178 (Fed. Cir. 1991)

> write. (*quoting A.B. Dick Co. v. Burroughs Corp.,* 713 F.2d 700, 703, 218 USPQ 965, 967-68 (Fed. Cir. 1983)). *Cf. Bell Communications Research, Inc. v. Vitalink Communications Corp.,* 55 F.3d 615, 623, 34 USPQ2d 1816, 1822 (Fed. Cir. 1995) (holding that part-time infringement is nonetheless infringement). Any other reasoning would allow an infringer to avoid infringement merely by adding additional elements to an infringing device.

The Federal Circuit distinguished the cased relied on by the District Court when it reached its erroneous decision, *Insituform Techs., Inc. v. CAT Contracting, Inc.*, a much-studied case with a seemingly different rule.[7]

> The district court seemed to have relied on the reasoning of *Insituform Techs., Inc. v. CAT Contracting, Inc.,* 99 F.3d 1098, 40 USPQ2d 1602 (Fed. Cir. 1996), in reaching its conclusion that BluBlocker's addition of a gray coating to its lens avoided infringement because it changed an inherent property of the lens. In *Insituform*, this court stated that in certain instances adding elements may allow a product to avoid infringing a claim. *Id.* at 1106, 40 USPQ2d at 1608. If a claim is specific as to the number of elements and the addition of an element eliminates an inherent feature of the claim, then that additional element will prevent a finding of literal infringement. *Id.* The claim at issue here is not specific as to the number of elements (i.e., dyes). Moreover, there is evidence supporting that the addition of the graduated gray coating does not fully eliminate an inherent feature of the claim (i.e., 1% transmission at 515 nm and 90% transmission at 636 nm). Because *Insituform* is inapposite, the district court's reliance on that case was unjustified.

In sum, using the Federal Circuit's language, "[i]f a claim reads merely on a part of an accused device, that is enough for infringement." While the Federal Circuit had precedent before *SunTiger* on the issue of whether part-time infringement is infringement (it is, see above), and on the issue that addition of an element does not avoid infringement (see also above), the Court did not have precedent for the rule that partial infringement, in the sense of infringement by a small portion of a larger whole, is infringement. That issue is now at rest,

because of SunTiger: "[i]f a claim reads merely on a part of an accused device, that is enough for infringement." [8]

[7] *Insituform Techs., Inc. v. CAT Contracting, Inc.*, 99 F.3d 1098 (Fed. Cir. 1996).
[8] *SunTiger,* 189 F.3d at __, 1999 U.S. App. LEXIS at *20.