Life Technologies v. Promega

Banner & Witcoff offers the following content as a resource to help clients understand and prepare for the potential impact of this case:

Promega Corp. licensed the Tautz patent (U.S. Reissue No. 37984), which claims a toolkit for genetic testing, to Life Technologies Corp. for the manufacture and sale of the kits in limited licensed law enforcement fields worldwide.

One of the kit's five components, an enzyme known as the Taq polymerase, was manufactured by Life Technologies in the United States and then shipped to the United Kingdom, where it was combined with the other four other kit components and sold. No U.S. infringement would be found for kit sales made outside the United States, but for one part of the patent statute – 35 U.S.C. §271(f)(1), which reads as follows:

> "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."

When Life Technologies began selling the kits outside of its licensed fields of use, Promega sued, claiming that under 35 U.S.C. §271(f)(1), such activity was U.S. patent infringement, since Section 271(f)(1) prohibits the supply from the United States of "all or a substantial portion of the components of a patented invention" for combination abroad.

In the district court case, the jury returned an infringement verdict ($52 million) in favor of Promega, but the court granted Life Technologies' motion for judgment as a matter of law, holding that §271(f)(1)'s phrase "all or a substantial portion" did not encompass the supply of a single component of a multicomponent invention.

On appeal, the Federal Circuit reversed. In a 2-1 decision, the court held that a single important component could constitute a "substantial portion" of the components of an invention under §271(f)(1) and found the Taq polymerase to be such a component. The Federal Circuit concluded that one dictionary definition of "substantial" is "important" or "essential," which it read to suggest that a single important component can be a "'substantial portion of the components'" of a patented invention.

In its 7-0 decision (with Chief Justice Roberts not participating), the Supreme Court reversed the decision of the Federal Circuit, holding that the supply of a single component of a multi-component invention for manufacture abroad does not give rise to §271(f)(1) liability. Quantity trumps quality.

Because only a single component of the patented invention at issue here was supplied

from the United States, the case was reversed and remanded to the Federal Circuit.

IMPORTANT DATES

- Feb. 22, 2017 – Supreme Court issues decision
- Dec. 6, 2016 – Supreme Court hears arguments
- June 27, 2016 – Supreme Court grants petition for a writ of certiorari
- June 26, 2015 – Life Technologies files petition for a writ of certiorari with Supreme Court
- Dec. 15, 2014 – Federal Circuit issues decision

COURT DOCUMENTS

- Supreme Court decision
- Supreme Court arguments transcript
- Federal Circuit decision

MEDIA

Banner & Witcoff attorneys are available to answer questions and discuss this case. Media inquiries should be directed to Amanda Robert (312) 463-5465 or arobert@bannerwitcoff.com.