Patent Law Alert:
In *Life Technologies Corp. v. Promega Corp., U.S. Supreme Court Held That Supply of a Single Component of a Multicomponent Invention for Manufacture Abroad Does Not Give Rise to Liability for Patent Infringement Under 35 U.S.C. § 271(f)(1)*

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On February 22, 2017, the United States Supreme Court issued its decision in *Life Technologies Corp. v. Promega Corp.*, unanimously reversing the United States Court of Appeals for the Federal Circuit's decision that the supply of a single component of a multicomponent invention for manufacture abroad may trigger liability for patent infringement under 35 U.S.C. § 271(f)(1).

The full text of Section 271(f)(1) 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.

35 U.S.C. § 271(f)(1) (emphasis added).

The issue before the Supreme Court was "whether the supply of *a single component* of a multicomponent invention is an infringing act under 35 U.S.C. §271(f)(1)." Slip op. at 4 (emphasis added). The Federal Circuit had previously decided that the scope of the term "a substantial portion of the components of a patent invention" recited in Section 271(f)(1) may encompass a single important component of the invention. *See id*. The Supreme Court rejected the Federal Circuit's broad interpretation of Section 271(f)(1).

First, the Supreme Court determined that the term "substantial portion" in the statute refers to a *quantitative* measurement rather than a qualitative measurement. *See* slip op. at 5-8. The Court then tackled the question of "whether, as a matter of law, a single component can ever constitute a 'substantial portion' so as to trigger liability under §271(f)(1)." Slip op. at 8. After examining the text, context, and structure of Section 271(f)(1), the Court concluded that

Section 271(f)(1) does not cover the supply of a single component of a multicomponent invention. *See* Slip op. at 8-10.

The Court, however, provided no guidance as to how many components of a multicomponent invention would be required to constitute "a substantial portion" to trigger liability under Section 271(f)(1):

We do not today define how close to "all" of the components "a substantial portion" must be. We hold only that one component does not constitute "all or a substantial portion" of a multicomponent invention under §271(f)(1).

Slip op. at 10. The concurring opinion by Justices Alito and Thomas further emphasized this point:

[W]hile the Court holds that a single component cannot constitute a substantial portion of an invention's components for §271(f)(1) purposes, I do not read the opinion to suggest that *any* number greater than one is sufficient. In other words, today's opinion establishes that more than one component is necessary, but does not address *how much* more.

Slip op. at 1 (Alito, J., concurring) (emphasis in original).

We will continue to monitor the Courts for the latest developments on this issue.

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