

The Intersection Between Damages Recovery under the Patent Marking Statute and Prosecution Practice

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I. Marking Statute and Underlying Policy

The current notice and marking requirements of 35 U.S.C. § 287 stem from long-standing policy issues. Section 287(a) provides that:

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.," together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.¹

The provision carries forward the policy considerations of its predecessor Section 4900 R.S. The Supreme Court explained these considerations in *Wine Railway Appliance Co. v. Enterprise Railway Equipment Co.*² "The purpose is to prevent an unwitting infringement by a member of the public who, seeing an article bearing no mark indicating that it is patented, proceeds to make other specimens of it."³

The marking requirement does not apply to a patent owner who neither sells nor authorizes others to sell articles covered by the patent.⁴ Failure to mark under Section 287 limits the damages that a manufacturing or licensing patent holder may recover. A patent holder may recover damages on unmarked goods only for periods after either the infringer received notice of infringement or the filing date of an infringement complaint.⁵ Although Section 287 permits both constructive notice of a patent through the marking requirement and the actual notice of a patent through direct communication with an accused infringer, failure to comply with the marking requirement can completely eliminate a patentee's ability to recover any past damages.

For instance, in the situation where a manufacturer declines to mark its product and relies instead on actual notice, the manufacturer may recover nothing if an accused infringer simply changes its product to a nonin-

fringing alternative on receiving actual notice. In spite of the potentially severe financial repercussions of failure to mark, the overwhelming majority of Section 287 cases reported in the past decade indicate that patent holders under an obligation to mark a patented article fail to do so. Such parties are then faced with the requirements of demonstrating the more specific requirements of actual notice under Section 287 to recover past damages.

II. Marking Requirements in Relation to Different Classes of Invention

Case law indicates that the marking requirement applies to any tangible article, including patented products, mixtures,⁶ apparatus,⁷ designs,⁸ biological agents,⁹ and systems.¹⁰ However, where a patent claims only a method (as opposed to a product, or a method and a product), there is no duty to mark.¹¹ This is not surprising as one cannot mark an abstraction. When there are both product and method claims alleged to infringe, the patentee must mark the product. A patentee will not be relieved of its duty to alert the public that its product is patented simply because the patent also alleges method claims.¹² If a patent includes only method claims, a court will not further inquire whether something tangible could be marked.¹³

A. Reconciliation of *Hanson* and *American Medical Systems*

Although the Federal Circuit has addressed the marking requirements in the event both method and apparatus claims are claimed in a single patent, there appears to be an inconsistency in the Federal Circuit's precedent. The decision in *American Medical* suggests that the presence of method claims in a patent also including an apparatus will still require compliance with the marking statute. The decision in the earlier Federal Circuit case *Hanson v. Alpine Valley Ski Area, Inc.*¹⁴ appears to lead to a different result.

1. Analysis of Marking Requirements As Applied to Individual Claims Rather Than Individual Patents

In *Hanson*, the 2,968,164 patent in question included asserted method claims 1, 2, and 6. The text of claim 1 is set forth below. Claims 2 and 6 are similar in their basic recitations.

1. The method of forming, distributing, and depositing snow upon a surface, including: mechanically providing a large volume movement of air at atmospheric pressure; said movement of air created by a motor-driven propeller, said air having an ambient temperature at or below about 30 degrees Fahrenheit; and projecting water into said movement of air in an amount and at a rate such that substantially all of the water so-introduced is at least partially crystallized prior to depositing on said surface.

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The *Hanson* patent also included to apparatus claims 3 and 4, which appears were not asserted in the infringement action. The text of claim 3 is as follows:

3. An apparatus for forming, distributing and depositing snow in flake form upon a surface, which apparatus comprises: a self-propelled platform provided with means for movement over the terrain; a swivelly mounted motor-driven pusher-type propeller capable of being locked in several positions; said propeller capable of providing a large volume movement of air outwardly in several directions from rear of platform; a water tank mounted on said platform; and a flexible conduit connected to said water tank and capable of projecting a stream of water into said movement of air (Emphasis added).

Close inspection of method claim 1 and apparatus claim 3 reveals certain narrowing features of the apparatus claim 3 that do not appear in the literal recitations of the method claim 1. Because the marking statute does not apply to a patent holder who neither sells nor authorizes the sale of a patented article,¹⁵ it is reasonable to infer that the patent holder in *Hanson* was permitted to recover for pre-filing damages without marking because he was not deemed to have sold or authorized to have sold the patented apparatus of claim 3. This is one manner in which the decision of *Hanson* can be reconciled with more recent cases that require marking in the presence of method and apparatus claims in a single patent.¹⁶ The fact that the bolded items set forth in claim 3 would cause the apparatus claim to be narrower, such that it is not necessarily practiced with the method claim, would appear to support an explanation of why the apparatus claim was not asserted.

2. Marking Requirement in Patents Having Coextensive Method and Apparatus Claims

By contrast, in a situation where the practice of the method is coextensive with a claimed apparatus, then compliance with the marking statute is a requirement.¹⁷ The decision in the *American Medical* case helps illustrate the point. Here, the patentee asserted both method and apparatus claims related to a prosthesis.

Apparatus claim 1 recited:

A packaged fluid containing prosthesis adapted to be implanted in a sterile condition, said prosthesis comprising:

a prosthetic device having a closed, permeable housing defining a fluid containing chamber;

a sealed, substantially fluid impenetrable enclosure [surrounding] said housing and defining a liquid retaining space between said enclosure and said housing, said enclosure adapted for separation from said device prior to implantation of said device; and

said enclosure containing a liquid in said space with activities that substantially match the activities of the fluid in said chamber such that the mass transfer gradient [across] the permeable housing is insubstantial.

Method claim 14 recited as follows:

A method of packaging a fluid containing prosthesis adapted to be implanted in a sterile condition, said method comprising the steps of:

filling a closable permeable housing within a prosthetic device with a fluid;

enclosing said prosthetic device within an enclosure which contains a liquid with activities that substantially match the activities of the fluid within the housing, thereby rendering insubstantial the mass transfer gradient across the permeable housing; and

sealing said enclosure about said prosthetic device to define a sealed substantially fluid impenetrable barrier to fluid migration.

Unlike the case in *Hanson*, where there were more readily apparent differences between the method and apparatus claims, the claims in *American Medical* appear to be of essentially coextensive scope. In attempting to extricate itself from the marking requirements, the *American Medical* patentee made an improvident statement that the method claim involves *making* of the patented product.¹⁸ The patentee attempted to distinguish the prior decision in *Devices for Medicine* by asserting that the method at issue there involved *using* the patented apparatus rather than making it. The Federal Circuit found this distinction of no importance.¹⁹ By inextricably tying the method and apparatus claim, the patentee in *American Medical* would not be excused from failing to mark its apparatus and would not receive the benefit of an exemption from marking for its associated method claims.

The decision in *American Medical* suggests that if there is some tangible aspect of a method claim that can be marked, then the marking statute would apply. To the extent that this may be construed to create an obligation for patent marking in a patent including only claims directed to a method to manufacture an end product, the decision in *State Contracting* eliminates such an obligation.

In *State Contracting*, the patentee held the '288 patent directed to a method of forming a reinforced concrete column and the later issued '455 patent directed to a reinforced concrete member. Representative claims of the '455 patent appeared to be of somewhat more restricted scope than representative claims of the '288 method patent.²⁰ Whereas the method would lead to the construction of some end product member, the Federal Circuit declined to require marking of this end product.

The Federal Circuit recognized the separation of method and member claims in two patents. Perhaps more significant, however, the court recognized that the two patents were not being asserted independently, that the jury verdict form did not differentiate between the two patents for the award of damages, nor did the defendants' proposed verdict form. There was also no contention that damages attributable to the '455 patent would reduce the overall damages, and therefore the notice requirements for the '455 patent need not be addressed. The latter discussion of the damages and lack of independent treatment of the method and member claims effectively created a merger of the method and apparatus claims between the two patents. Although the

State Contracting decision still refers to the patents being treated on a patent by patent basis, some courts will assess the applicability of marking on a claim by claim basis.

III. Claim Scope Analysis for the Marking Requirement

At least one court has determined that the question of whether a patentee's product (or his licensee's product) embodies a "patented article" pursuant to the marking statute parallels the determinations for infringement. Both inquiries look to the relationship between the patent claim and the article in question. The sole difference is the identity of the article's manufacturer—in infringement analysis, the manufacturer does not own the patent, whereas in the "embodiment" analysis, the manufacturer does own the patent. An infringement determination, and by extension, an embodiment determination require a two-step analysis. The first step is to construe the patent claim to determine its scope and meaning. Once properly construed, the claim must be compared to the article in question. Such claim construction would be determined through a Markman hearing.²¹

At least one court has expressly determined that it is proper to analyze the marking requirements in an individual patent on a claim basis rather than looking to the patent as a whole.²² In *Toro Co. v. McCulloch Corp.*, the patent in question included independent claims directed to two distinct parts of a vacuum/blower. The first component, recited in claim 1, related to a safety switch to prevent motor operation when an air inlet cover is removed to prevent the user from being exposed to rotating blades. The second component, recited in claims 16-17, related to a pressure ring to improve the performance of the blower/vacuum. Toro licensed Black and Decker to use the safety switch claim of the '528 patent but not the pressure ring. Toro asserted that Black and Decker did not use its licensed safety switch. In the action between Toro and McCulloch, Toro asserted infringement of the pressure ring claims of the '528 patent, where Toro adequately marked the vacuum/blower containing such a component. The issue raised was the effect of Black and Decker's failure to mark its products purportedly containing the licensed switch. The threshold issue was whether Section 287(a) applies to limit recovery in a patent infringement action when an unmarked article, which has been made or sold, contains one of the inventions disclosed in the patent but does not contain the invention of the predicate suit.

Toro advocated the position that its pressure ring related to a separate patented article under Section 287. Accordingly, Toro argued that its right to recover in an infringement action against a party that sells a blower/vacuum is limited by the marking requirements only if it has made or sold blower/vacuums with the pressure ring disclosed in the '528 patent without affixing a proper mark. In contrast, McCulloch argued that the marking provision limits damages in any action

for infringement of any portion of a patent, not just an action for infringement based on the unmarked patented article. According to McCulloch, the patentee may not recover damages for infringement on *any claims* of a patent if a product containing an invention disclosed in a *single* claim of a patent has not been adequately marked.²³

The district court adopted Toro's view that assesses the marking requirements for a patented article on a claim-by-claim basis. Because a patent may encompass several independent claims, there may be several distinct "patented articles" arising under that patent, each of which may be the subject of an independent infringement action.²⁴ Section 287 does not limit recovery in an action when an unmarked article, which has been made or sold, contains one of the inventions disclosed in the patent but does not contain the invention of the predicate suit.²⁵ The U.S. District Court for the District of Delaware also appears to adopt a claim-by-claim assessment of asserted claims on the applicability of the marking statute to a patent that includes multiple inventions, in which some claims correspond to products that are marked, and some claims correspond to unmarked products.²⁶

IV. Prosecution Practice Notes in View of Marking Requirements

In view of the foregoing observations on (1) the widespread practice of not marking patented apparatus and (2) the disparate treatment of method claim patents and patents including both methods and apparatus in the case law, practitioners may wish to consider the following in filing and prosecuting applications.

A. Safest Approach (but Least Practical): Pursue Method and Apparatus Claims in Separate Patent Applications.

One obvious way to limit the effects of a marking statute for method claims is to segregate method claims and apparatus claims into different applications. This may be achieved either through the original filing of two applications or may occur over the course of prosecution. In the latter case, the segregation would preferably result from a restriction requirement imposed by the examiner, where the election of one class of claims (e.g., the methods) is pursued whereas a divisional is filed to pursue the other class of claims (e.g., the apparatus).²⁷ Because attempts to traverse a restriction requirement create representations in the file history that the two classes of claims are essentially directed to the same invention or that the method and apparatus are practiced in conjunction with each other, this would tend to tightly couple the method and apparatus claims. This effectively makes them coextensive in scope.²⁸ In the event that traversal of the restriction does not succeed, which is often the case, representations in the file history will make each patent susceptible to the prior art that is applied against the other set of claims. Therefore, if faced with a restriction requirement, the more prudent course would

be to segregate the method claims and apparatus claims in separate applications. As a result, recovery of damages for the method claims will not be predicated on marking requirements should the patentee seek to enforce its patent rights to the invention.

B. Purposefully Differentiate Method Claims from "Tangible" Claims.

Filing, prosecuting, and maintaining two patents on essentially the same invention lead to inefficiencies and can prove cost-prohibitive as well. Therefore, if method and apparatus claims are pursued in a single application, one can still consider the following precautions to avoid an effective "merger" between the method and apparatus claim scope, thereby avoiding marking requirements as in the case of *Hanson* rather than mandatory compliance as in *American Medical* or *Halliburton*.

1. Broader Method Claim Scope than Apparatus Claim Scope

To the extent possible, craft the method claim more broadly than the apparatus claim. In such a situation, it may be possible to argue at a later date, if necessary, that the narrower apparatus claim is not being practiced by the patentee and thus is not subject to the marking statute. Under the literal requirements of the statute, the broader method claims will not be subject to the marking requirement. On the other hand, if the apparatus claim is broader in scope than the method claim, then the patentee's practice of the narrower method claim may necessarily result in practice of the apparatus claim, thereby necessitating compliance with the marking statute.

2. Traverse the Same Rejection of Method and Apparatus Claims on Similar, but Distinctive, Grounds

Related to the concept of maintaining some disparity in the method and apparatus claims, it would be beneficial not to rely only on verbatim arguments to traverse rejections of both the method and apparatus claim rejected over common art. More specifically, in the situation where independent method claim 1 and independent apparatus claim 2 are each rejected over the reference combination A and B, avoid relying solely on the similarity in claim recitations to traverse each rejection over A and B. Consistent with the point raised in Section III.B.1 above, relatively fewer comments may be made to traverse the rejection over method claim 1 in comparison with the number of comments made to traverse the rejection over apparatus claim 2. In other words, create a perception in a disparity in claim scope to leave a potential basis to argue that the apparatus claim is not being practiced by the patentee.

3. Reserve Opportunities to Note Future Disparate Treatment of Method and Apparatus Claim Scope

Finally, when method and apparatus claims become allowable in a single application, carefully review any examiner comments on "Reasons for Allowance" for both the method and apparatus claims. It is a common practice for examiners to replicate the recitations of one

of the claims (method or apparatus) but apply the comments to both claim classes. In such an event, to preserve any objections to a reading of coextensive claim scope between the method and the apparatus, it would be advisable to file a response to the comments on "Reasons for Allowance." The response could simply note that the method need not be limited to use or practice of the apparatus and vice versa.

V. Marking Compliance as Related to Claim Structure

Of course the obvious way to mitigate the possibility of not recovering damages as a result of insufficient marking is to comply with the marking statute. The marking statute itself suggests forms of marking that are suitable. The product itself can be marked, or the packaging containing the patented product can be marked.²⁹ Given these acceptable marking techniques, the patentee may have more difficulty complying with the marking requirement if the claimed product encompasses a large area or the component parts of the invention are not centralized. For example, it is relatively easier to mark a product embodied by a claim directed to a discrete object such as a display monitor as compared with a product embodied by the multiple servers and transmitters of a wireless communication system. This is especially true when the case law indicates some ambiguity on whether identifying a patent in product literature is sufficient to meet the marking requirements.³⁰ Therefore, if a patent includes system type claims, it would be advisable to prosecute claims directed to patentable individual key components of the system. In this case, the individual component or its packaging could be marked with lesser burden.

A. Marking Requirements for Unclaimed Products

1. Additional Reason for Claiming Individual Elements Rather Than Combinations

The Federal Circuit's decision in *Amsted Indus. v. Buckeye Steel Castings Co.*,³¹ appears to counsel a similar strategy to claim individual elements rather than combinations. Here, the Federal Circuit imposed the marking requirement on an unpatented component used in a claimed combination that includes the unpatented component. In this case, Amsted became the owner of U.S.P. 3,664,269, which claimed a center plate in combination with many other elements to form a railroad car underframe structure. Amsted made and sold the center plate but did not assemble the patented combination itself. Instead, the assembly of its components was made by Amsted's customers. Defendant Buckeye began to manufacture a copy of the center plate. Subsequently, Amsted sued Buckeye for contributory infringement, further alleging willful infringement. Buckeye alleged a defense of noncompliance with the marking statute. The district court held that Section 287 limited Amsted's recovery of damages because Amsted's customers, to whom Amsted sold one element of a patented combina-

tion with the expectation that the customer would make and sell the patented invention, were implied licensees making the patented article for Amsted under Section 287. The court reasoned that the distribution or manufacturing arrangement of a patentee, unilaterally chosen by the patentee, cannot be allowed to relieve the patentee of its duty to mark under Section 287.³² Even though *Amsted* clearly reflects that a patentee cannot circumvent a combination claim by manufacturing only a component part and leaving the assembly to others, a corollary effect of the decision is to ease the marking burden by claiming devices in smaller patentable increments.

2. Side Effects of Contributory Infringement Law on Marking

Analogous to the contributory infringement analysis discussed in *Amsted*, other case law also appears to impose marking requirements on apparatus used to produce an end product composition even though the patent only claims the end product composition and not the apparatus.³³ In *Johns Hopkins v. CellPro*, one of the asserted claims licensed by Johns Hopkins University to its licensee Baxter related to cell suspensions. Claim 1 recites:

A suspension of human cells comprising pluripotent lymphohematopoietic stem cells substantially free of mature lymphoid and myeloid cells.³⁴

Johns Hopkins and Baxter alleged that CellPro infringed, contributorily and induced infringement of cell suspension claims 1 and 5 of the '680 patent. As part of its defense, CellPro alleged that Baxter failed to mark its Isolex device that was used to make the cell suspension. The analysis of the court, although brief, suggests that the Isolex device (had it been manufactured by a party other than a licensee or patent holder) would secondarily infringe the cell suspension claims.³⁵ Accordingly, the court charged Baxter with the obligation to mark the Isolex device that produced cell suspensions according to the '680 patent to give users constructive notice that its end product is a patented article.³⁶ Because none of the claims at issue was directed to an apparatus, the requirement that the apparatus be marked would appear to be unwarranted. However, as the decision in *Amsted* corroborates, the requirement to mark unpatented devices is not peculiar to the *Johns Hopkins* case.

3. Application Drafting to Allow Future Flexibility in Applicability of Marking Requirements

During the course of prosecution, a patentee seeking to mitigate the pressures of marking in view of the *Amsted* and *Johns Hopkins* decisions may consider imparting some latitude in its disclosure as to how unpatented components and apparatus of an invention can be used. Notably in both *Amsted* and *CellPro*, an analysis under contributory infringement liability was raised. Implicit in the courts' determinations was that the unpatented article (the center plate in *Amsted* and the Isolex apparatus in *CellPro*) were not capable of noninfringing uses but rather could only be specifically used for the claimed end product. To guard against such an assessment, patentees may

consider drafting disclosures to allow flexibility in the formation of its component parts, or apparatus used to form a resulting end product. For instance, in *CellPro*, the patentee may have written the specification such that Isolex was an exemplary apparatus usable to produce the claimed cell suspensions but that Isolex's use could be generalized to form other formulations and that other devices in addition to Isolex could also be used to form the cell suspensions. In *Amsted*, the patentee may have written the specification to describe the center plate as a general supporting member not specific to the underframe structure as claimed. In this manner, the components do not rise to the level of having no uses, except in connection with the patented article, such that the notice requirement otherwise attaches to unclaimed components.

VI. Conclusion

It is likely that corporations holding large patent portfolios cannot feasibly mark their products with every pertinent patent to comply with the marking statute. This would explain why most of the recent Section 287 discussions focus on actual notice, because marking has not occurred. This being the case, the considerations for prosecution discussed above can allow patent-holding entities to argue against the applicability of the marking statute, such that they can place themselves in a better position to recover damages without the requirements and intricacies of actual notice.

Endnotes

1. 35 U.S.C. § 287(a).
2. 297 U.S. 387 (1936).
3. *Id.* at 387, 397-398.
4. *Id.* at 397.
5. *Amsted Indus., Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994).
6. *Western Emulsions, Inc. v. Copperstate Emulsions, Inc.*, 42 U.S.P.Q.2d 1856 (D. Ariz. 1997) (requiring patentee to mark large storage containers of emulsifier).
7. *Devices for Medicine Inc. v. Boehl*, 3 U.S.P.Q.2d 1288, 1292 (Fed. Cir. 1987) (claims directed to "introducers" for medical devices into the body; *Calmar, Inc. v. Emson Research, Inc.* 31 U.P.Q.2d 1833 (C.D. Calif. 1994) (sprayers)).
8. *Nike Inc. v. Wal-Mart Stores, Inc.*, 46 U.S.P.Q.2d 1001 (Fed. Cir. 1998).
9. *Johns Hopkins University v. CellPro*, 1997 U.S. Dist. LEXIS 24163 (D. Del. 1997) (one patent claiming monoclonal antibodies, one patent claiming cell suspensions. The district court required marking of apparatus to produce the claimed cell suspensions).
10. *Rexnord Inc. v. Laitram Corp.*, 6 U.S.P.Q.2d 1817 (E.D. Wis. 1988).
11. *American Medical Systems Inc. v. Medical Engineering Corp.*, 26 U.S.P.Q.2d 1081, 1095 (E.D. Wis. 1992) (citing *Bandag, Inc. v. Gerrard Tire Co., Inc.*, 217 U.S.P.Q. 977 (Fed. Cir. 1983)).
12. *American Medical Systems*, 26 U.S.P.Q.2d at 1095.
13. *State Contracting and Engineering Corp. v. Condotte America, Inc.*, 68 U.S.P.Q.2d 1481, 1493 (Fed. Cir. 2003).
14. 219 U.S.P.Q. 679 (Fed. Cir. 1983).
15. *Wine Railway*, 297 U.S. at 397.
16. *American Medical Systems*, 28 U.S.P.Q.2d 1321 (Fed. Cir. 1994); *Loral Fairchild Corp. v. Victor Co.*, 1995 U.S. Dist. LEXIS 20948 (E.D.N.Y. 1995). An alternative reading of *Hanson* would lead to the conclusion that the marking statute did not

apply because the apparatus claims were not asserted. However, the proposition that a patentee can skirt the marking requirement by selectively asserting method but not apparatus claims from a patent has been rejected. *Halliburton Services v. Smith Int'l, Inc.*, 2004 U.S. Dist. LEXIS 8419 (E.D. Tex. 2004) *16 (noting that patentee distributed products created by the patented methods).

17. See *American Medical Systems, Inc. v. Medical Engineering Corp.*, 28 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1993); *Halliburton*, 2004 U.S. Dist. LEXIS 8419 at *16.

18. *Id.*

19. *Id.*

20. See 68 U.S.P.Q.2d at 1483.

Compare:

A method of forming a ground-supported column or post, comprising the steps of providing a ground sites of suitable depth and width, filling said sites with a cementitious slurry, providing a reinforced, precast concrete member whose reinforcing bars extend out of the bottom of said member a substantial length beyond said bottom to form an exposed portion, inserting said exposed portion into said slurry until said member merges with said slurry, and permitting said slurry to harden, thus providing an integral column and pile set in the ground.

with

A precise reinforced concrete member containing reinforcing bars which have exposed portions extending beyond one end of the member and parallel to the longitudinal dimension of the member; the number, size and length of such exposed portions being such as to provide sufficient strength when the end of said concrete member is merged with and the bars inserted into a foundation pile of initially wet, cementitious material, which material is then allowed

to set; said exposed portions being further characterized in being completely surrounded by said cementitious material; said concrete member and said pile being merged without mechanical attachment. (Emphasis added to show additional limitations in apparatus claims).

21. *Broadcom Corp. v. Agere Systems, Inc.*, 2004 U.S. Dist. LEXIS 18163 (E.D. Penn. 2004)*10-*13.

22. *Toro Co. v. McCulloch Corp.*, 35 U.S.P.Q.2d 1622 (D. Minn. 1995).

23. 35 U.S.P.Q.2d at 1625.

24. *Id.* at 1626.

25. *Id.* at 1627.

26. *ADC Telecommunications, Inc. v. Siecor Corp.*, 1997 U.S. Dist. LEXIS 1358 (D. Del. 1997).

27. In view of possible benefits from having method claims broader than apparatus claims as shown in *Hanson*, there may be some advantage to pursuing the apparatus claim first to delineate the broadest allowable subject matter and filing the method claim in the divisional once the broadest contours of allowable subject matter are determined.

28. See MANUAL OF PATENT EXAMINING PROCEDURE § 806.05(e).

29. 35 U.S.C. § 287(a).

30. *Calmar*, 31 U.S.P.Q.2d at 1838.

31. 30 U.S.P.Q.2d 1462, 1463 (Fed. Cir. 1994).

32. *Id.* at 1467.

33. *Johns Hopkins University v. Baxter Healthcare Corp.*, 1997 U.S. Dist. LEXIS 24613 (D. Del. 1997).

34. U.S.P. 4,714,680.

35. It is not clear from the decision whether the theory of liability would be for contributory or induced infringement for the claimed cell suspensions. *Johns Hopkins*, 1997 U.S. Dist. LEXIS 24613 at *7.

36. *Id.*

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