



INFRINGEMENT BETWEEN PUBLICATION OF PATENT APPLICATION AND GRANT OF PATENT

We start by discussing what constitutes patent infringement, and subsequently discuss in detail provisions corresponding to patent infringement carried out between patent application publication and patent grant.

A patent owner has the right to exclude other from making, using, selling, offering for sale, and importing the patented product/process. A patent owner who has good reason to believe that an entity (e.g., company or individual, among others) is violating his/her rights, may seek relief by filing a case, typically referred to as “*patent infringement suit*”, against the entity. In case the entity is found guilty of violating the rights of the patent owner, the entity will be liable for “*Patent infringement*”.

The rights of the patent owner start from the date of publication (generally 18 months after filing the patent application) of the patent application. However, a patent owner can file a patent infringement suit only after the patent is granted. In real world scenario, once a patent application is filed, granting a patent may take 3 to 5 years or even more in some cases. Hence, it is evident that there is a significant time lag between publication of a patent application and the eventual grant of patent.

A patent application, and in particular claims, which define the scope of protection sought, of the patent application may undergo several changes before a patent is granted. In majority of the cases, the claims in the published patent application are not the same as the claims in the granted patent. An alleged infringer who may be infringing on the claims of a granted patent may not necessarily infringe on the claims of the published patent application.

There can be a stark contrast between statutes of different jurisdictions corresponding to such matters. Statutes of U.S. and India may be considered to exemplify the contrast between the statutes governing infringement carried out between publication of patent application and grant of patent.

U.S. Patent Law:



35 U.S.C. § 154(d) provides “provisional rights” to a patent owner to claim reasonable royalty from an infringer for an infringement carried out after the publication of the patent application and before the patent is granted.

35 U.S.C. § 154(d) is recited below:

“a patent shall include the right to obtain a reasonable royalty from any person who, during the period beginning on the date of publication of the application ... and ending on the date the patent is issued

(i) makes, uses, offers for sale, or sells in the United States the invention as claimed in the published patent application or imports such an invention into the United States; or

(ii) if the invention as claimed in the published patent application is a process, uses, offers for sale, or sells in the United States or imports into the United States products made by that process as claimed in the published patent application; and

(B) had actual notice of the published patent application and, ...

(2)Right based on substantially identical inventions.

*The right under paragraph (1) to obtain a reasonable royalty shall not be available under this subsection unless **the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.**”(emphasis added)*

In light of the above recitation of the code, it is evident that, to obtain reasonable royalties, an alleged infringer has to have an “*actual notice*” of the published patent application, and the invention as claimed in the patent has to be “*substantially identical*” to the invention as claimed in the published patent application. The above recitation does not clearly define what constitutes “*actual notice*” and “*substantially identical*” under the code. However, several courts have interpreted “*actual notice*” and “*substantially identical*” during patent infringement suits.

Actual notice

One of the district courts stated that, it is not required by a patent owner to take an affirmative action to provide such a notice to the alleged infringer. However, in such a scenario, the patent owner has to prove that the alleged infringer came to have actual notice through “other means”.



In view of the above, one may contemplate that the published patent application, which is in public domain and can be readily accessible by anybody, can be considered as “other means”. However, the district court further added that, the mere fact that the published application is included in a database where it might be found is insufficient to prove that the alleged infringer came to have “*actual notice*”.

Further, another district court stated that in case of direct notification by the patent owner, a notice of the published patent application by calling attention to the same in a letter is sufficient to satisfy the “actual notice” requirement under 35 U.S.C § 154(d).

Thus in summary, if one can prove that the alleged infringer is aware of the published patent application or by sending a direct notice to the alleged infringer stating that a patent application is published would satisfy the “*actual notice*” requirement concerning *provisional right*. However, one should reconsider sending such a direct notice since it’s highly possible that the alleged infringer may assist the examiner in laying a rough road for patent application prosecution. In general, it is a common practise followed by many companies to regularly monitor their competitor’s patents portfolio. Thus, one should also think of using such evidences to prove that the alleged infringer is aware of the published patent application *through other means* to satisfy the *actual notice* requirement.

Substantially identical

A district court in *Pandora Jewelry, LLC v. Chamilia, LLC* patent infringement case stated that, the claims in the published patent application and the claims in the granted patent application are not substantially identical since Pandora Jewelry had made a narrowing amended to substantially amend the scope to overcome the rejections in the Office Action. Thus, in view of the above ruling, the courts have to rely on the scope of the claims instead of going after the literal words.

Further, a district court in *K-TEC, Inc. v. Vita-Mix Corp* patent infringement case stated that, in light of the prosecution history, the published set of claims and the granted set of claims are substantially similar. The court added that although amendment have been made to the claims of the published patent to obtain the patent from the USPTO, which can preclude a finding that the claims are not substantially similar, there is no *per se* rule that an amendment to



a claim in order to overcome a Office Action rejection based on prior art precludes finding provisional rights.

Thus, although the rulings were different in the above mentioned cases, the take home message is that not all amendments to the claims result in a finding that the claims of the published application and issued patent are not substantially identical. Further, amendments made for clarification may not change claims substantially, and each claim amendment must be carefully evaluated for its impact on the scope of the claim. Furthermore, claims can still be substantially identical as long the amendments do not narrow down the scope of the claim, in response to rejections in Office Action.

So, now the question arises, what is considered as a narrowing amendment? Is rewriting a dependent claim in independent form a narrowing amendment?, and the answer is yes in view of the ruling of *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.* case.

The Honeywell court ruling states that “[a] presumption of surrender therefore arises if rewriting the dependent claims into independent form, along with cancelling the original independent claims, constitutes a narrowing amendment”. Thus rewriting the dependent claim into independent form and also cancelling an original independent claim is considered as a narrowing amendment. Therefore in view of the above cited rulings, one should not assume that claims in the issued patent are substantially similar to those in the published application simply because they are the dependent claims with the exact same language rewritten in independent form.

In conclusion, one can obtain damages for an infringement during the period between publication of patent application and the patent grant under provisional right if proved that an infringer had actual notice, and the claims of the published patent application and the granted patent are substantially identical.

India

Section 11A(7) of the Indian Patent Act , 1970 enables a patent owner to claim damages for infringement that was carried out between publication of the application and patent grant.

[Section 11A\(7\)](#) of the Indian Patent Act , 1970 is recited below.

“(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted:...”

It is interesting to note that as per the Act, a patent owner need not prove that an alleged infringer has “actual notice” of the published patent application. Further, the Act does not mention that the invention as claimed in the published patent application has to be substantially identical to the invention as claimed in the granted patent, to claim damages for infringement carried out between publication and grant.

Hence, compared to US, claiming damages in India for infringement carried out between publication and grant is far less burdensome on the patent owner since actual notice requirement is absent. Further, one may argue that the section with *substantially similar* requirement being absent gives rise to great amount of uncertainty to third party, and favours the patent owner.

The above section does not appear to have been scrutinized by a court in India so far. The literal interpretation of the section certainly does not require the claims to be substantially identical. However, literal interpretation may appear to be absurd, and in such cases a purposive interpretation may be called for. It would be interesting to see the interpretation of the above statute by a court as and when the statute is used in an infringement suit.

In conclusion, patent right starts from the date of publication of patent application but it is enforceable only after a patent is granted. However, the prerequisites to seek relief for infringement carried out between publication and grant may vary from one jurisdiction to the other. Such prerequisites may have to be taken into consideration while drafting a patent application and prosecuting the same.

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