



# Extraterritorial Conduct and Patent Infringement: Recent Federal Circuit Decisions

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## Roadmap

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- **Background**
- International Patent Exhaustion
  - *Lexmark Int'l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721 (Fed. Cir. 2016)
- Export of Components
  - *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338, 1345 (Fed. Cir. 2014)
- Sales Outside the U.S.
  - *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 769 F.3d 1371 (Fed. Cir. 2014)

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## In general, infringement is subject to territorial limits

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"[W]hoever without authority . . . makes, uses, offers to sell, or sells any patented invention, **within the United States** . . . infringes the patent."

35 U.S.C. § 271(a)

"It is the general rule under United States patent law that no infringement occurs when a patented product is made and sold in another country."

*Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007)

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## Exceptions to the rule

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- **35 U.S.C. § 271(f)(1), (f)(2)**
  - Export of components of unassembled invention
  - Export of component especially made or adapted for infringement
- **35 U.S.C. § 271(g)**
  - Import of product made abroad by patented process

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## Exceptions to the rule (cont.)

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### 35 U.S.C. § 271(f)(1)

Whoever without authority **supplies ... 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.**

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First appeared as part of the conference materials for the  
21<sup>st</sup> Annual Advanced Patent Law Institute session  
"Overseas Sales in Light of *Lexmark*, *Halo*, and *Life Tech*"