Copying products—is it legal?

by Marc E. Brown

Surprisingly enough, copying a competitor's product is perfectly legal in the United States. The United States Supreme Court held in Sears, Roebuck & Co. versus Stiffel Co. (1964) that a product that is not covered by a patent can be lawfully copied. However, infringing a patent, copyright, or trademark is not legal. Here is how to tell the difference.

If a product is protected by a patent, it will usually display the patent number. Rarely, however, will the patent protect all components of the product. To identify those that are not protected, the patent must be examined (a copy may be obtained from a major library or by mailing 50¢ to the Commissioner of Patents and Trademarks, Washington, D. C. 20231).

Each patent will include a drawing and description of the invention, followed by its "claims"—one or more separately numbered lists of its basic components. Although the drawing and description will be informative, the scope of protection is delineated solely by the claims.

The following is an example of a claim (having three components) covering a hypothetical fingerprint-operated door lock:

> *A security entrance-control system comprising a door lock, fingerprint detection means for detecting the presence of an authorized fingerprint, and control means for opening said door lock upon detection of an authorized fingerprint by said detection means.*

The rule is that there will be an infringement when every component recited in any one claim is manufactured, sold, or used.

Would this claim be infringed by the same system if it used a palm-print detector instead of a fingerprint detector? How about a voiceprint detector?

The answer is that courts do in fact extend patent protection to components that are not embraced by the literal language of the claim if they operate in substantially the same way, for substantially the same purpose, to produce substantially the same result. Equivalency will not be found, however, where the component was indicated in the patent application as *not* part of the invention or where the resulting extension in protection would embrace previously known apparatus. Applying these rules, chances are that the palm-print detector, but not the voiceprint detector, would be deemed an equivalent and hence an infringement.

The possibility of infringement need not be of concern if the "issue date" of the patent is more than 17 years old—the patent has expired, and it cannot be renewed. Concern is also unnecessary if the patent is invalid.

One of the most common causes of invalidity is that the patented invention was on sale in this country more than one year before the patent was applied for. Another is that it was merely an obvious variation on what was previously known. There are many others.

Although the court has the authority to reverse the Patent Office's decision to grant the patent by declaring it invalid (and indeed frequently does exactly that), litigating the validity of a patent in court is likely to be very expensive. Accordingly, the decision to willfully infringe a patent should not be made lightly.

If the product is marked "Patent Pending" (or "Pat. Pend."), an application has been filed but the patent has not yet been issued. Copying the product at this stage is risky. Although liability for infringement cannot arise until the patent is issued, it is difficult to determine if and when this might occur. Moreover, because applications may not be examined by the public prior to issuance of the patent, it is virtually impossible to ascertain which, if any, of the product's components will be covered.

If no patent markings appear on the product, it probably is not patented nor the subject of a patent application. But the absence of notice will rarely serve as a total defense against the charge of infringement and thus cannot always be relied upon. The safest bet is to have an "infringement search" performed by a qualified patent attorney. This should uncover all adverse patents, not merely those that are owned by the competitor.

In the next column, the problems associated with copyrights and trademarks will be explored.

This column sets forth basic principles of law and is not intended as a substitute for personal legal advice. Questions and comments are invited and should be sent to Mr. Brown in care of Electronics.