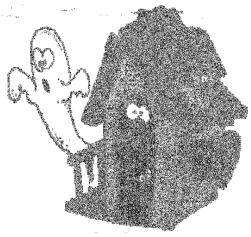
Mesmer & Deleault, PLLC
41 Brook Street, Manchester, NH 03104
Seacoast Office: One New Hampshire Ave., Suite 125
Portsmouth, NH 03801



"Tip of the Month"

Does Your Competition Own Patents? Aim for a "Design Around"

If you are working in or looking to enter an industry, you might be intimidated by certain patents that your competitors own. For example, if you are looking to produce widgets and your competitor owns a patent for widgets, you might think that your dreams of being a widget producer are doomed. However, this is not necessarily the case. There may be a way to use your competitors' patents to your advantage! The solution may be to create a "design around."

What is a design around? – A design around is an invention that provides an alternative to a patented invention while not infringing the claims of the patented invention. For example, assume that your competitor's widget patent claims a widget comprising A, B, C, and D. Based on your knowledge of the widget industry, you know that A, B, and D are essential elements to creating a good widget. However, you also know that while C is an important component, you can easily replace it with E to make a perfectly adequate widget. If you decide to make widgets made of A, B, D, and E (and not C), you may well be making widgets that do not infringe your competitor's patent.

An additional feature by itself does not produce a design around – An effective design around must lack at least one element of a patent's broadest claim. If, taking the example above, you decided that you wanted to make widgets that include E in addition to C instead of replacing C (i.e., widgets made of A, B, C, D, and E), then your new widgets will still infringe your competitor's patent. The reason for this is because your competitor's patent claims a widget made of A, B, C, and D, and all of these elements are found in your new widgets (the inclusion of E is irrelevant).

Beware the doctrine of equivalents – The doctrine of equivalents allows the possibility of infringement when the difference between the limitation in the accused device and the limitation literally recited in the patent claim is "insubstantial." A difference is insubstantial if the limitation in the accused device performs substantially the same function, in substantially the same way, to yield substantially the same result. Using the example above, if E performs substantially the same function as C, in substantially the same way as C, to yield substantially the same result as C, then even though your new widgets do not contain C, they may still be considered to infringe your competitor's widget patent. If not, then you have created an effective design around.

An effective design around does not guarantee that you won't be sued – Even if you have taken care to create an effective design around that does not infringe your competitors' patents, your competitors may still decide to sue you. For example, larger companies sometimes decide to sue smaller competitors even when they know that they would probably end up losing the lawsuit. The larger companies know that a lawsuit (or the threat of one) can be an effective deterrent to smaller competitors who might not have the resources to afford a lengthy lawsuit through to conclusion.

If you need help with designing around patented devices, please call the patent attorneys at Mesmer & Deleault at 603-668-1971 or write to us at *mailbox@biz-patlaw.com*.

Frank B. Mesmer, Jr., Esq.
Robert R. Deleault, Esq.
Charles M. Vivian, Esq.
1010

(603) 668-1971
Fax (603) 622-1445
E-mail: mailbox@biz-patlaw.com
Website: www.biz-patlaw.com