

Keywords: direct infringement; multiple parties performing one or more steps

General: Direct infringement may be found where an accused infringer directs another party to perform one or more steps of a claimed method.

Marley Mouldings Ltd. v. Mikron Industries Inc.
66 U.S.P.Q.2d 1701 (N.D. Ill. 2003)
Decided April 29, 2003

I. Facts

Marley Mouldings held a patent for a method for forming solid elongated elements designed for use in door, window and frame moldings. A claim at issue called for encapsulating wood flour particles with a polymer resin in an extrudable material by high intensity mixing. Specific volume part ranges were called for in the claim. Further claimed steps included extruding and cutting the material, mixing additional resin and a blowing agent with pellets of the material, compressing the resulting extrudable foam material, and expanding and solidifying the material.

Mikron Industries made a polymer resin/wood flour composite extrusions for use in windows, brick moldings and other applications. However, Mikron did not make the original encapsulated flour material called for in the claim. That material was purchased by Mikron by a supplier who made such materials. The purchases material was made at Mikron's direction and formulation, and with polymer supplied to the supplier by Mikron.

Marley sued Mikron for infringement of its patent. Mikron defended by arguing that no direct infringement could be found as it outsourced the claimed material, and therefore did not perform all of the steps of the claim. Mikron moved for summary judgment, and the present holding results. Based on the evaluation of the court, summary judgment was denied.

II. Issues

1. Can direct infringement of a method claim by a purchaser be found when claim steps are performed by a supplier and the remainder of steps are performed by the purchaser?

III. Discussion

1. Yes. Pursuant to 35 U.S.C. 271(a), a party literally infringes a patent who "without authority makes, uses, offers to sell, or sells any patented invention . . . during the term of the patent . . ." Generally, all elements of a claim must be reproduced for a finding of infringement.

The court observed that the case presented a novel issue not addressed by the Supreme Court or by the Federal Circuit (research may or may not bear this out). That is, whether a party who does not perform every step of a method claim may be liable for direct infringement where separate entities perform separate steps of the claim. The court observed that, in this case, Mikron could not avoid a finding of direct infringement merely by having another entity perform one or more of the required steps. A qualification added by the court in this case was "when that party is connected with the entity performing one or more of the required steps."

In the present case, the court identified the "connection" by observing that the pellets required by the claim were "made to order" based on the directives from Mikron. The case leaves open the question as to the degree of "connection" required for a finding of direct infringement.