

## Life Technologies Corp. v. Promega Corp.

By: Erin E. Bryan  
August 24, 2017



On February 22, 2017, the Supreme Court issued its decision in *Life Technologies Corp. v. Promega Corp.*<sup>1</sup>, a case focused on interpreting the patent infringement statute which creates liability for exporting a component of a patented invention. Specifically, the Court considered whether a single component may be “a substantial portion of the components of a patented invention.”<sup>2</sup> Reversing the Federal Circuit’s decision, the Supreme Court held that the “supply of a single component of a multicomponent invention for manufacture abroad does not give rise to §271(f)(1) liability.”<sup>3</sup>

Promega Corporation is the owner of the Tautz patent, which describes a toolkit used to conduct genetic testing. The patented toolkit is made up of five individual components. Promega licensed the Tautz patent to Life Technologies for the manufacture and sale of the kits for use in certain licensed law enforcement fields. Life Technologies manufactured four components of the kits in the United Kingdom, while the fifth component, a *Taq* polymerase enzyme, was manufactured in the United States. The *Taq* polymerase was then shipped to the United Kingdom where the kit was assembled with the four other components.

In 2010, Promega sued Life Technologies for infringing on the patents by selling the kits to clinical and research markets, areas that were outside the licensed fields of use. Promega alleged that the shipping of the *Taq* polymerase from the United States to the United Kingdom manufacturing facilities triggered liability under §271(f)(1), which prohibits the supply “from the United States [of] all or a substantial portion of the components of a patented invention,” for combination abroad.<sup>4</sup>

The Court began its analysis by answering “whether §271(f)(2)’s requirement of ‘a substantial portion’ of the components of a patented invention refers to a quantitative or qualitative measurement.”<sup>5</sup> Promega argued that a “substantial portion” should be interpreted as not only the number of components, but also their qualitative importance to the invention overall. The Court rejected this interpretation and concluded that the structure of the statute and the context in which the words “all or a substantial portion” appear indicate that the intent of the statute is to convey a quantitative meaning.

The Court was then tasked with determining “whether, as a matter of law, a single component can ever constitute a ‘substantial portion’ so as to trigger liability under § 271(f)(1).”<sup>6</sup> Here, the Court answered in the negative, reasoning that the statute clearly and consistently refers to “components” intentionally in the plural form so as to indicate that multiple components constitute the “substantial portion” referred to in the statute.

Concluding that the phrase “substantial portion” in § 271(f)(1) has a quantitative meaning and that § 271(f)(1) does not cover the supply of just a single component of a multicomponent invention, the Court remanded the case to the lower court.

The Court's emphasis on the importance of quantity over quality of components somewhat contradicts the experience of those in the industry, who often acknowledge that certain components of multicomponent kits are essential with no suitable substitutions. Although the Court's decision appears to create a bright-line rule that more than one component is required to satisfy a "substantial portion," flexibility remains in determining how a "component" is identified and how many components are actually required to constitute a substantial portion.

For more information, please contact **Erin Bryan**.

---

#### Footnotes.

1. 137 S. Ct. 734 (2017)
2. 35 U.S.C. § 271(f)(1)
3. *Life Techs. Corp. v. Promega Corp.*, 137 S. Ct. 734, 736 (2017)
4. 35 U.S.C. § 271(f)(1)
5. *Life Techs. Corp. v. Promega Corp.*, 137 S. Ct. 734, 739 (2017)
6. *Life Techs. Corp. v. Promega Corp.*, 137 S. Ct. 734, 741 (2017)