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# When Does a US Patent Cover “Infringement” Occurring Abroad?

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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. There is an exception. Section 271(f) of the Patent Act, adopted in 1984, provides that infringement does occur when one “supplies ... from the United States,” for “combination” abroad, a patented invention’s “components.” 35 U.S.C. § 271(f)(1). This case concerns the applicability of § 271(f) to computer software first sent from the United States to a foreign manufacturer on a master disk, or by electronic transmission, then copied by the foreign recipient for installation on computers made and sold abroad.

AT & T holds a patent on an apparatus for digitally encoding and compressing recorded speech. . . . The question before us: Does Microsoft’s liability extend to computers made in another country when loaded with Windows software copied abroad from a master disk or electronic transmission dispatched by Microsoft from the United States? Our answer is “No.” *Microsoft Corp. v. AT & T Corp.*<sup>1</sup>

The general rule—not the exception of Section 271(f)<sup>2</sup> of the Patent Act—applies to that which is exported from the United States but is not itself “combined” abroad to make a copy of the “patented invention.” On April 30, 2007, the Supreme Court found no infringement liability based on a US patent for copies made abroad of a “master” version of exported software where the exported “master copy” was not combined with a computer abroad to make a patented apparatus.

By so ruling, the Court shifted the patent strategy paradigm applicable to our global economy. Patent prosecution and licensing strategies must evolve to capture the design in the United States of infringing products assembled abroad. Especially for “information products” such as software that can easily be copied from a single master version exported from the United States, an alternative to Section 271(f) would be required to capture worldwide sales “infringing”<sup>3</sup> a US patent.

## Microsoft v. AT&T Fact Pattern

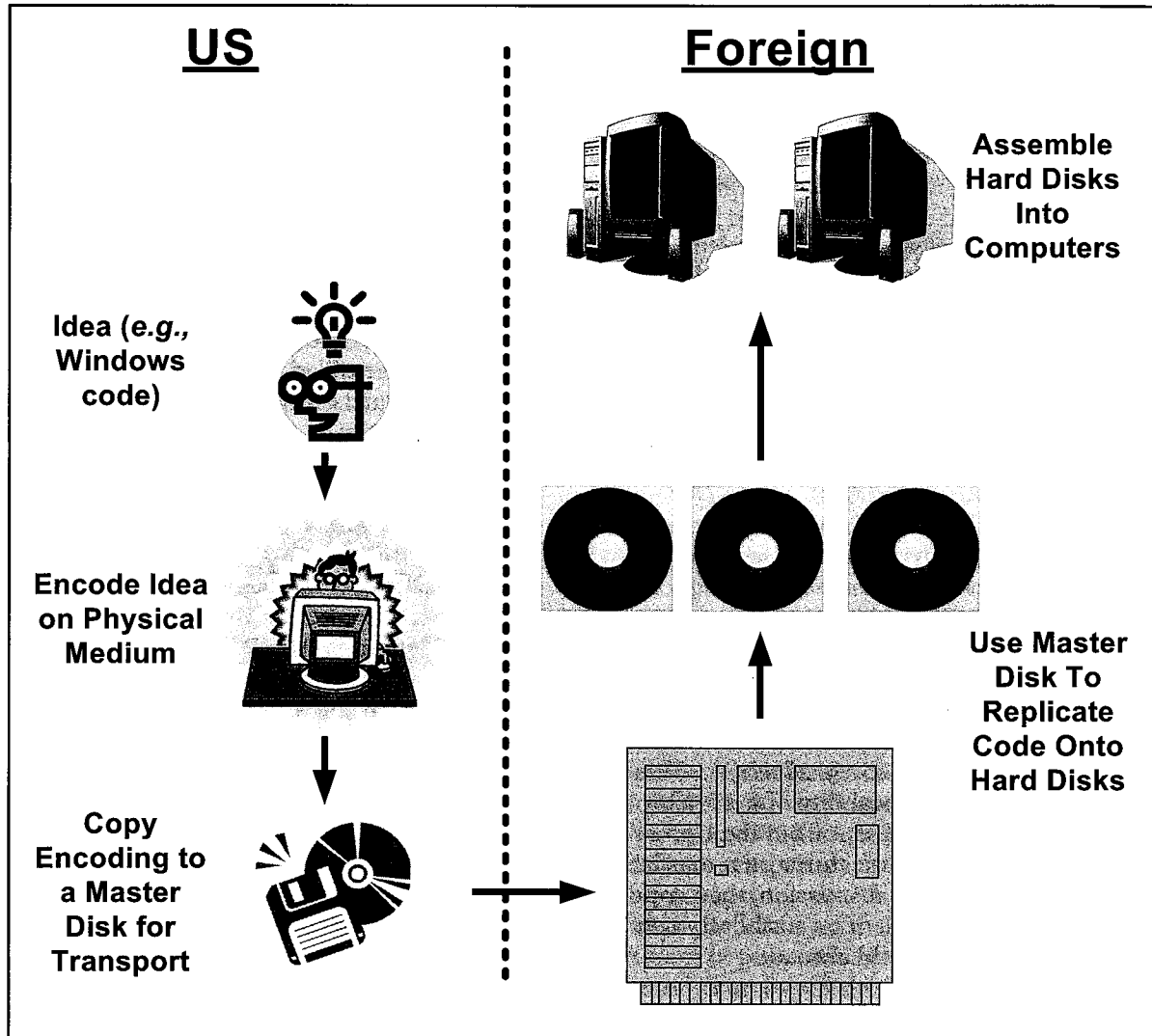
AT&T asserted US Patent Re. 32,580 (‘580 patent) covering an apparatus and method for digitally encoding and recording speech. The ‘580 patent includes method and apparatus claims.

The issues presented to the Supreme Court were narrowed by stipulations of the parties. Microsoft stipulated that by installing Windows® software on its own computers during the software development process, it directly infringed the ‘580 patent.<sup>4</sup> Microsoft did not dispute that by licensing copies of Windows® software to manufacturers of computers sold in the United States, it induced infringement of AT&T’s patent.<sup>5</sup> AT&T, in turn, agreed that only copies of Windows® software are installed on the foreign assembled computers at issue. The copies of Windows® software were installed on computers by foreign original equipment manufacturers (OEMs) from master versions Microsoft sent from the United States on a disk or by an encrypted electronic transmission. Exhibit 1 provides a pictorial summary of the facts.

## Legal Background: Export Infringement under 35 U.S.C. § 271(f)

Section 271(f) imposes liability for infringing a US Patent based in part on foreign-directed activities. Such liability extends to whoever “supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented

Exhibit 1



invention . . . in such manner as to actively induce the combination of . . . such components outside of the United States . . .”<sup>6</sup> or “supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial non-infringing use . . . intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States . . .”<sup>7</sup>

Prior to the *AT&T* decision, the Federal Circuit had found that a master version of object code (comprising software executable by a computer) exported for copying abroad is a “component” for purposes of Section 271(f).<sup>8</sup> In a separate case, the Federal Circuit also had held that Section 271(f) applies to method

claims, and that catalysts shipped overseas to be used in a patented process can be a “component of a patented invention” giving rise to liability under Section 271(f).<sup>9</sup>

### The *AT&T* Ruling: Summary of the Supreme Court’s Analysis

Section 271(f) does *not* reach the export of intangible information when its physical carrier is not combined into the accused “infringing” foreign combination. Justice Ginsburg’s opinion for the Court reasoned that where the physical, exported thing is not combined with other components to make the claimed invention, Section 271(f) is not triggered.<sup>10</sup>

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Justice Alito's concurring opinion joined by two other Justices more expansively held that when the physical, exported thing is not intended to become a permanent, physical part of the functioning combination, Section 271(f) is not triggered.<sup>11</sup>

## Scientific Grounds

The Court reasoned that intangible information (detached from a thing) cannot be combined with a thing and, therefore cannot be a component within the meaning of Section 271(f):

Until it is expressed as a computer-readable "copy," *e.g.*, on a CD-ROM, Windows software—indeed any software detached from an activating medium—remains uncombinable. It cannot be inserted into a CD-ROM drive or downloaded from the Internet; it cannot be installed or executed on a computer. Abstract software code is an idea without physical embodiment, and as such, it does not match § 271(f)'s categorization: "components" amenable to "combination."

. . . [B]efore software can be contained in and continuously performed by a computer, before it can be updated or deleted, an actual, physical copy of the software must be delivered by CD-ROM or some other means capable of interfacing with the computer.<sup>12</sup>

## Legal Grounds

Physical things are "supplied" from where they are made (not where they are designed). When in doubt, the Court will wait for Congress to pass a law clearly interfering with foreign activities:

Because it is so easy to encode software's instructions onto a medium that can be read by a computer, AT & T intimates, that extra step should not play a decisive role under § 271(f). But the extra step is what renders the software a usable, combinable part of a computer; easy or not, the copy-producing step is essential. Moreover, many tools may be used easily and inexpensively to generate the parts of a device. A machine for making sprockets might be used by a manufacturer to produce tens of thousands of sprockets an hour. That does not make the machine a "component" of the tens of thousands of devices in which the sprockets are incorporated, at least not under any ordinary understanding of the term

"component." Congress, of course, might have included within § 271(f)'s compass, for example, not only combinable "components" of a patented invention, but also "information, instructions, or tools from which those components readily may be generated." It did not. In sum, a copy of Windows, not Windows in the abstract, qualifies as a "component" under § 271(f).<sup>13</sup>

The Court reiterated its reluctance to infer any intent of Congress broader than the text of Section 271(f) itself:

- "Without stretching § 271(f) beyond the text Congress composed, a copy made entirely abroad does not fit the description 'supplie[d] . . . from the United States.'"<sup>14</sup>
- "If the patent law is to be adjusted better to account for the realities of software distribution, the alteration should be made after focused legislative consideration, and not by the Judiciary forecasting Congress' likely disposition."<sup>15</sup>

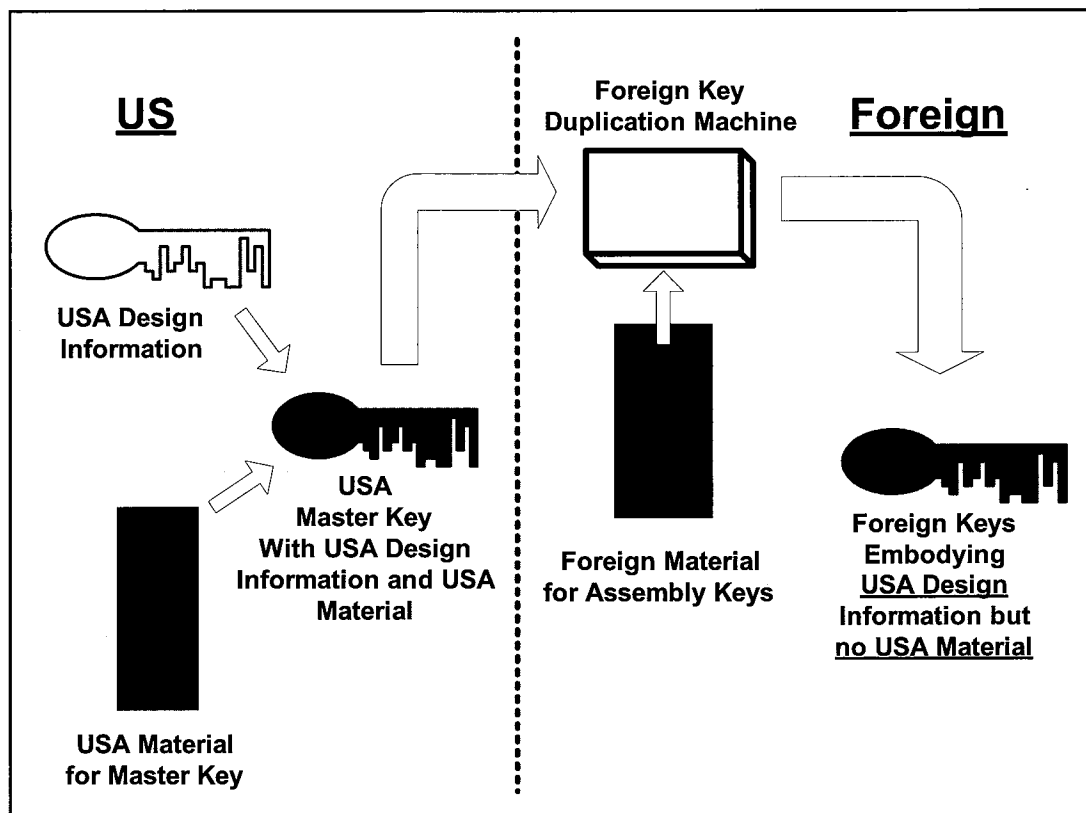
In short, notwithstanding the relative ease with which the information in software code can be copied and incorporated into a patented invention overseas, the Supreme Court elected to treat that information like any other design tool and "[t]here is no dispute . . . that § 271(f) is inapplicable to the export of design tools—blueprints, schematics, templates, and prototypes—all of which may provide the information required to construct and combine overseas the components of inventions patented under United States law."<sup>16</sup> In other words, software is no different than other design information that does not itself become a "component" of a patented invention.

*Exhibit 2* exemplifies how a design tool such as a template, blueprint, or "master" part may readily supply the information for making a patented invention abroad, while no part of that design tool becomes a part of the foreign-made copy.

## Import of the Scientific and Legal Grounds for the Court's Ruling

The sum total of the Court's ruling falls short of adopting the "molecule test" advocated by *amici* Amazon.com, Inc., Mentor Graphics Corp., and Wacom Technology Corp.<sup>17</sup> That test would simplify the analysis: If no molecule in the foreign combination was supplied from the United States, then no

## Exhibit 2



component of the patented invention was supplied from the United States.<sup>18</sup>

### Physical Components

As to “components” that are wholly physical things, the Court’s majority holding allows for application of this “molecule test” because if no molecule supplied from the United States is in the foreign combination, the physical thing supplied from the United States cannot have been combined abroad.

### Intangible Components?

As to “abstract software code” (or anything else intangible), however, the Court left for another day the question of whether a copy ever can be said to be supplied from the United States for purposes of Section 271(f) when no molecule from the United States becomes a part of the combination made abroad. The Court expressed its refusal to reach that issue in the context of software installation disks—which Justice Alito’s concurrence recognized necessarily result in creating a new, “foreign” copy during the process of installing software to a foreign computer’s hard

disk.<sup>19</sup> The installation disks supplied from the United States typically would not be permanently, physically “combined” with a computer abroad to make the functioning foreign combination. As reflected by Justice Ginsburg’s footnote 14, the Court did not reach the issue of whether such an installation disk results in liability under Section 271(f) “if the disk were removed after installation.” The Court thereby left open the issue of whether it is relevant “that the Windows software was not copied onto the foreign-made computers *directly* from the master disk or from an electronic transmission that originated in the United States.”<sup>20</sup>

The issue reserved by Justice Ginsburg’s footnote 14 is significant in leaving unanswered the question of whether the export of installation disks, *e.g.*, as packaged for retail sale “in a box on the shelf,”<sup>21</sup> could result in liability under Section 271(f) when those disks do not become a permanent, physical part of a functioning foreign computer that would infringe in the United States. Justices Alito, Thomas, and Breyer say “No” because “the physical incarnation of code on the . . . CD-ROM supplied from the United States is not a ‘component’” as no “physical

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part of the disk became a physical part of the foreign-made computer.”<sup>22</sup>

## Impact of the Decision

Where will the practical impact of the Supreme Court’s ruling in the *AT&T* case be felt?

Certain technologies were explicitly addressed by the Court and excluded from Section 271(f):

- Software—Master disks, foreign made copies of installation disks, electronic transmissions of software used to make foreign copies.
- Machines and other tools—“Many tools may be used easily and inexpensively to generate the parts of a device” but “those tools are not, however, ‘components’ of the devices in which the parts are incorporated, at least not under any ordinary understanding of the term ‘component.’”
- Catalysts, *e.g.*, for use in chemical process—When used to make a patented composition or thing because a catalyst by definition does not become a physical part or component of the product it is used to make. Maybe not, when the catalyst is used in a patented process.<sup>23</sup>
- Blueprints, schematics, templates, prototypes, instructions, CAD/CAM codes (or anything else containing design information)—Precise instructions for the construction and combination of the components of a patented device; information, instructions, or tools from which components of a patented invention readily may be generated.
- Masters dispatched from the United States that can be copied abroad—Copies of the master version generated abroad, *e.g.*, keys, “paper products [made] by electronic copying and printing,” “chemical or biological substances [that] might be created by reproduction”

Some types of claims are definitely impacted by the *AT&T* decision, while others may not be:

- System—Impacted
- Machine—Impacted
- Apparatus—Impacted
- Composition of matter—Usually, impacted. Unclear for a product-by-process claim including an intangible step.
- Manufacture—Impacted, if it includes “components” that can be “combined.”
- Method—May be impacted

- Signal—May be impacted (if patentable)
- Design patent—May be impacted

## “Money Statements,” Guaranteeing Future Work for Lawyers, in the Court’s Majority Opinion

### Software As a Component?

Some might argue that the Court ruled that software on a disk may be a “component” of a patented invention within the meaning of Section 271(f),<sup>24</sup> ending any debate about whether software can ever be a component. While it is not clear that this debate was resolved by the Court, it is clear that at a minimum software *may* be a component *only* if fixed on a useable, physical medium.<sup>25</sup>

Section 271(c) shares the word “component” with Section 271(f), but is not limited to combinable components. The “combinable” requirement in Section 271(f) was the primary basis for the Court’s ruling, which might lead patent owners to argue for a different result under Section 271(c). On the other hand, patent challengers will argue that the Court’s reasoning that abstract code is the same as any other design information or design tool, should be applied as well to Section 271(c), to support a ruling that “abstract” code cannot be a component of a patented invention under Section 271(c). This latter result would harmonize Section 271 by interpreting the word “component” (of a patented invention) consistently throughout the section.

### Broadening Patentable Subject Matter?

The Court left open the possibility that a “method,” “process,” or “component” might be “intangible,” and yet still qualify as patentable subject matter:<sup>26</sup>

We need not address whether software in the abstract, or any other intangible, can *ever* be a component under § 271(f). If an intangible method or process, for instance, qualifies as a ‘patented invention’ under § 271(f) (a question as to which we express no opinion), the combinable components of that invention might be intangible as well.<sup>27</sup>

Thus, the Court did not foreclose a future finding that an intangible, such as the result or output of a

software algorithm, qualifies as a “component” of an intangible patented method.

Further, the Court’s reference to “an intangible method or process” might be cited as contemplating an expansion of the scope of patentable subject matter under 35 U.S.C. § 101, as prior Supreme Court precedent on point has suggested that methods and processes must be physical.<sup>28</sup> But, as the Court’s footnote does not cite Section 101 or any precedent regarding patentable subject matter, the *AT&T* ruling did not address any of the patent’s method claims, and the point was not addressed in oral argument, the better reading would be to give this comment no precedential weight on this issue.

### **Section 271(f) Applies to Method Claims?**

The Court’s footnote 13 could be read to assume that Section 271(f) applies to method claims, as the Federal Circuit held in *Union Carbide*.<sup>29</sup> However, the Court’s primary reasoning (requiring the thing exported to be the thing combined abroad) may undermine the argument for applying Section 271(f) to method claims. As the Federal Circuit noted in the *Union Carbide* case, “it is difficult to conceive of how one might supply or cause to be supplied all or a substantial portion of the steps of a patented method in the sense contemplated by the phrase ‘components of a patented invention’ in section 271(f) . . .”<sup>30</sup>

### **Licensing Lessons from the AT&T Ruling**

The *AT&T* ruling reinforces that for a patent owner to be compensated for all US-based activity arising from “infringing” a US patent, new strategies must be considered.

### **Activities Potentially Triggering a License Payment**

Licensors and potential licensees must be able to negotiate a license based on the activity fairly protected by a US patent. A “patented invention” is a “process, machine, manufacture, or composition of matter.”<sup>31</sup> Section 271 offers many ways in which a patented invention can be infringed.

Do not overlook the following as potentially infringing a US patent:

1. Product of a patented process under Section 271(g).
2. Component of a patented machine, manufacture, combination or composition under Section 271(c).
3. Apparatus for use in practicing a patented process under Section 271(c).

4. Material for use in practicing a patented process under Section 271(c).
5. Supplying information for use in infringing activity (e.g., software information, design information, functional information) or other active inducement of patent infringement under Section 271(b).<sup>32</sup>
6. Importing any patented invention into the United States under Section 271(a).
7. Food and Drug Administration applications under Section 271(e).
8. Joint infringement by the participation and combined action of more than one person or entity, e.g., separate entities performing separate steps of a patented method where the combined actions would infringe if performed by a single entity.<sup>33</sup>

Also keep in mind what does *not* infringe a US patent:

1. The *Deepsouth* case<sup>34</sup> is still good law on Section 271(a) infringement. Section 271(a) is limited to actions taken with the entire “patented invention” in the United States.
2. Intangible information alone probably cannot be a “component” after the *AT&T* case.
3. Each step of a method claim must be performed in the United States.<sup>35</sup>
3. Selling or importing a material component of a patented invention included in a larger product where the larger product infringes but has substantial non-infringing uses.<sup>36</sup>

### **If It Infringes, Consider Whether It Should Trigger Payments under a License**

If reasonable under the circumstances, any activity that infringes should be considered as a potential trigger for license payments.<sup>37</sup> Actions that might trigger a duty to pay under a license could be defined in the license agreement, in part, as including any and all activities that would infringe under 35 U.S.C. § 271 but for the license.

### **Negotiating a Payment Based on the Triggering Activity**

Once an infringing trigger is established, a patent owner might contend that the licensing base should include all related downstream revenues, including revenues from arguably “non-infringing” actions (such as foreign sales) arising from the US-based triggering activity. The grounds for using such an expansive

royalty base would be that “but for” the infringing triggering activity, related “non-infringing” revenue would not have been realized. Presumably any infringing triggering event would be undertaken in competition with the patent owner and/or its other licensees or prospective licensees. Thus, an expansive royalty base in a license agreement arguably would be in line with the flexible measures of damages recoverable in litigation.<sup>38</sup> The patent owner might argue that the prospects of large foreign sales and other activity undertaken by a licensee in competition with the licensor are among the many factors a prudent licensor should consider in setting a royalty (as either a running royalty linked to sales or lump sum payments).<sup>39</sup>

A potential licensee would of course contend that such an expansive view of a royalty base under a license and the revenue attributable to the license of a US patent is fundamentally inconsistent with the intent of US patent law and the presumption against extraterritoriality as applied by the Court in the *AT&T* case.

The type and amount of a royalty payment under a license may be best linked to the type of activity triggering the payment. If the trigger is a *de minimis* infringing act, then a large payment based on all global sales is less likely reasonable. On the other hand, if a large revenue stream is primarily attributable to the infringing activity, a larger royalty payment seems more reasonable.

## Work Closely with Attorneys and Inventors

When advising clients on seeking foreign patents, address the reach and limitations of US patents under Sections 271(a), 271(f), and 271(g). The patent landscape and potential limitations of US patents should be revisited in view of the *AT&T* decision. Patent prosecutors, licensing attorneys, and inventors all can potentially provide insights into any strategy changes to be made.

Consider real-world infringement and licensing scenarios. What activities of potential infringers likely will occur in the United States? Consider whether patent claims can capture the activity associated with designing “infringing things,” *e.g.*, claims that would be infringed by engineers working on the design of a product embodying a patented invention. In the context of Sections 271(f) and 271(g), narrower and more specific claims may better capture foreign activities. Generally, those seeking patent protection should always consider diversifying the types of claimed subject matter (process, machine, manufacture, or composition of matter) to diversify the types of actions that can be accused of infringement.

As a potential licensee of technology, consider what does not give rise to liability for a United States patent. Especially when a potential licensor has not sought relevant foreign patent rights, consider whether potential license payments can be minimized or eliminated based upon where the technology is used or where components of the technology are combined.

## Conclusion

The Supreme Court’s decision in *AT&T* points to a need to revisit patent prosecution and licensing strategies. An intellectual property owner should consider how best to capture US-based infringing activities and use those as triggers for paying royalties under a license (or litigation damages). This will require focus on the language used in licensing agreements to consider including all possibly infringing activity under Section 271 as a royalty trigger. But first, licensing attorneys and inventors must work closely with patent prosecution attorneys to claim US-based activity and file foreign applications as appropriate in view of *AT&T*.

1. *Microsoft Corp. v. AT & T Corp.*, \_\_\_ U.S. \_\_\_, 127 S. Ct. 1746, 1750–1751 (2007).

2. 35 U.S.C. § 271(f) provides:

(1) Whoever without authority supplies or causes to be supplied in or 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.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined 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.

3. “Infringing” in the context of 35 U.S.C. § 271(f) requires at least that the component “supplied in or from the United States” can be combined with other components abroad “in a manner that would infringe the patent if such combination occurred within the United States.”

4. *See* 35 U.S.C. § 271(a).

5. *See* 35 U.S.C. § 271(b).

6. *See* 35 U.S.C. § 271(f)(1).

7. *See* 35 U.S.C. § 271(f)(2).

8. *Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005).

9. *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d 1366 (Fed. Cir. 2005).

10. *AT & T*, 127 S. Ct. at 1757 (“the very components supplied from the United States, and not copies thereof, trigger § 271(f) liability when combined abroad to form the patented invention at issue”); *see also id.* at 1757 n.14 (“Microsoft suggests that even a disk shipped from the United States, and used to install Windows directly on a foreign computer, would not give rise to liability . . . if the disk were removed after installation. We need not and do not reach that issue here.”).

11. *Id.* at 1762 ("There is nothing in the record to suggest that any physical part of the disk became a physical part of the foreign-made computer . . . . Because no physical object originating in the United States was combined with these computers, there was no violation of § 271(f).").
12. *Id.* at 1755–1756 (footnotes omitted).
13. *Id.* at 1756 (footnotes omitted).
14. *Id.* at 1757 n.15.
15. *Id.* at 1760 (citation and quotation marks omitted).
16. *Id.* at 1759.
17. See *Supreme Court Br. of Amazon.com, Inc., Mentor Graphics Corp., and Wacom Technology Corp. as Amici Curiae* in Supp. of Petitioner, available at [http://www.klarquist.com/Articles/18\\_Supreme%20Cr%20%20Amicus%20Brief%20-%20FINAL.pdf](http://www.klarquist.com/Articles/18_Supreme%20Cr%20%20Amicus%20Brief%20-%20FINAL.pdf).
18. See *AT & T* at 1761 (Alito, J., concurring) ("No physical aspect of a Windows CD-ROM-original disk or copy-is ever incorporated into the computer itself. . . . I agree with the Court that a component of a machine, whether a shrimp deveiner or a personal computer, must be something physical.").
19. *Id.* at 1762.
20. *Id.* at 1762 (Alito, J., concurring) (emphasis in original).
21. *Id.* at 1753.
22. *Id.* at 1762.
23. See *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d 1366 (Fed. Cir. 2005).
24. "In sum, a copy of Windows, not Windows in the abstract, qualifies as a 'component' under § 271(f)." *AT & T* at 1756.
25. See *id.* at 1755 ("Until it is expressed as a computer-readable 'copy,' e.g., on a CD-ROM, Windows software-indeed any software detached from an activating medium-remains uncombinable. It cannot be inserted into a CD-ROM drive or downloaded from the Internet; it cannot be installed or executed on a computer. Abstract software code is an idea without physical embodiment, and as such, it does not match § 271(f)'s categorization: 'components' amenable to 'combination.'"); see also *id.* at 1762 (Alito, J., concurring) ("To be sure, if these computers could not run Windows without inserting and keeping a CD-ROM in the appropriate drive, then the CD-ROMs might be components of the computer. But that is not the case here.").
26. See 35 U.S.C. § 101 ("Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.").
27. *AT & T* at 1756 n.13.
28. See, e.g., *Cochrane v. Deener*, 94 U.S. 780, 788 (1877) ("A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing."); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Gottschalk v. Benson*, 409 U.S. 63 (1972) (an algorithm is not patentable); *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. 498, 507 (1874) ("An idea of itself is not patentable . . .").
29. See *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d 1366 (Fed. Cir. 2005).
30. *Id.* at 1380.
31. 35 U.S.C. § 101.
32. Inducement liability requires that the accused (1) actually intended to cause the actions that are directly infringing, and (2) knew or should have known that those actions would be infringing. *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293 (Fed. Cir. 2006) (*en banc*).
33. See *On Demand Mach. Corp. v. Ingram Indus.*, 442 F.3d 1331 (Fed. Cir. 2006).
34. *DeepSouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972).
35. See *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282 (Fed. Cir. 2005) ("We . . . hold that a process cannot be used 'within' the United States as required by § 271(a) unless each of the steps is performed within this country;" but note *infringement of a system claim* even though one of the accused components in RIM's BlackBerry system was not physically located in the United States because "use of a claimed system under § 271(a) is the place at which the system as a whole is put into service, i.e., the place where control of the system is exercised and beneficial use of the system obtained").
36. Under *Hodosh v. Block Drug Co., Inc.*, 833 F.2d 1575 (Fed. Cir. 1987), the focus under Section 271(c) ought to be on the entire thing sold to determine whether it has substantial noninfringing use, and not just on an infringing portion.
37. Some potentially infringing triggering actions to consider include:
  1. Use of the invention by internal employees of the licensee within the United States,
  2. Making a master disk,
  3. Testing the invention,
  4. Using the method as part of testing or development of other products,
  5. Making a prototype,
  6. Offering the invention or master version for sale,
  7. Demonstrating the invention,
  8. Exporting the invention or its components for demonstration abroad (e.g., as a demonstration unit carried by United States-based salespeople to make foreign sales),
  9. Selling or offering a component of a patented invention, and
  10. Importing the invention or a product of a patented process (e.g., a demonstration unit carried abroad by United States-based salespeople to make foreign sales presentations and brought back to a United States office).
38. "Congress sought to ensure that the patent owner would in fact receive full compensation for 'any damages' he suffered as a result of the infringement." *General Motors Corp. v. Devex Corp.*, 461 U.S. 648, 654–655 (1983).
39. See, e.g., *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970) (considering, among other things, the nature and scope of the license, the existing value of the invention to the licensor as a generator of sales of his non-patented items, the established profitability of the product made under the patent and its commercial success, the extent to which the infringer has made use of the invention and any evidence probative of the value of that use).