

How Can You Design Around a Competitor's Patent?

The Court of Appeals for the Federal Circuit, the patent court of appeals, says that “[t]he ability of the public successfully to design around – to use the patent disclosure to design a product or process that does not infringe, but like the claimed invention, is an improvement over the prior art – is one of the important public benefits that justify awarding the patent owner exclusive rights to his invention. Designing around is the stuff of which competition is made and is supposed to benefit the consumer.” *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.* (Fed. Cir. 1995). Thus, designing around a patent is not only permitted bylaws, it is encouraged.

The process of designing around a patent begins with a study of the patent and its claims. If an element of each of the claims can be eliminated, or replaced with an element that is not merely an equivalent of the replaced element, then infringement of the patent can be avoided. Patenting a new design around not only helps protect the design, but it helps establish that the design-around is different from the original patented technology.

While designing around is “one of the ways in which the patent system works to the advantage of the public in promoting progress in the useful arts, its constitutional purpose,” (*Slimfold Mfg. Co. v. Kinkead Industries, Inc.*, (Fed. Cir. 1991)), careless language can sometimes turn a legitimate case of design around into one of apparent design theft. Internal references to “knocking-off” or even “copying” a competitor’s product will come out in discovery, and will portray the company in an unfavorable light. The focus of all written and oral discussions should therefore be the development of a “non-infringing competitive product” and not knocking-off or copying a competitor’s product.

OTHER REASONABLE STEPS IN A DESIGN-AROUND:

- 1 Study the patent and identify elements of the claims that can be eliminated or replaced by non-infringing substitutes.
- 2 Consider patenting the design-around both to protect the design-around and to help establish that it is different from the original.
- 3 Be careful in communications about the design around effort, and avoid terms liking “knocking off,” “copying” or “our version of” the original product, which could cast the company’s efforts to design a non-infringing competitive product in an unfavorable light.