



**Rotec Indus. v. Mitsubishi gajarsa Corp., 215 F.3d 1246**

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### **Case History**

Rotec is an assignee of the 291 patent and sells a system disclosed by the that patent under the name power belt.

On AUGUST 9, 1995 the People's Republic of China solicited bid proposals for five units of a concrete placing system to be used in the Three Gorges Dam project on the Yangtze river. Mitsubishi corp and mitsubishi international collectively called ME, a French corp. Potain, Johnson who was working on a design of a conveyor system prepared a bid with the help of Tucker Association TA. Tucker agreed to work as an independent contractor in preparing the design and attended a conference that took place in the PRC in October of 1995. According to rotec much of the activity took place in US. Johnson giving financial and other docs to potain and agreement to transfer a Johnson conveyor that was part of the patented article of Rotec.

### **Issue**

Whether there has been an offer to by defendants in order to constitute infringement under section 271(a) and whether the defendants are liable under section 271(f)?

### **Holding**

No infringement under both the sections.

### **Analysis**

- There has been an amendment of section 271(a) after GATT in which an offer to sell was held to be infringing.
- In order to constitute infringement the offer to sell need not rise to the level of commercial offer to sell under the common law. It is liberally construed looking at the federal law.
- The evidence that

- (1) the offering parties met nine times in the United States about supplying a conveyor system for the Three Gorges Dam Project;
  - (2) Johnson and Tucker designed and priced the contemplated system in the United States; and
  - (3) the written offer identified Johnson as the supplier for the concrete system, and confirmed that Johnson had provided all relevant technical and financial documents cannot establish communication of an offer to sell.
- If these are accepted as offers for sale then, it would effectively prohibit a patentee's competitors from:
    - (1) studying a patent in anticipation of its expiration;
    - (2) estimating the cost of producing a disclosed invention before the date of expiration; or
    - (3) reviewing a patent to ascertain whether the claims read on a product currently in development. So they cannot be accepted as offer to sell.
  - The evidence that delegates from china met with Johnson in USA is hearsay evidence and cannot be accepted.
  - Section 271(f) does not include an offer to supply so that offer by Johnson to supply the conveyor which is a component of the patented article cannot constitute infringement.