

# Patent Strategies for Protecting Aftermarket Parts: Strengthening the Portfolio, Implementing Enforcement Program

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WEDNESDAY, FEBRUARY 8, 2023

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

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Today's faculty features:

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FITCH EVEN

## Aftermarket, Not Afterthought: Patent Strategies for Protecting Aftermarket Parts

*Presented by*

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# First of All . . .

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# Patents and Utility Models

- ◆ Exclude others from practicing invention in issuing country
- ◆ Protection and duration vary by type
- ◆ Protection varies by country
- ◆ Varying enforcement efficiencies



# What Are Aftermarket Parts?

- ◆ Parts for a product after the product has been sold in the marketplace
- ◆ Less expensive than product
- ◆ High profit margins
- ◆ Examples:
  - Filters
  - Seals
  - Bearings
  - Ground-engaging components
  - Wear components



# What to Protect?



# Why Patent Aftermarket Parts?

- ◆ Stop will-fitters
- ◆ Protect customers
- ◆ Reduce warranty issues
- ◆ Deter direct competitors
- ◆ Protect from revenue-stream erosion



# Road Map

- ◆ Patent application preparation, prosecution, and foreign filing
- ◆ Business involvement in the patent life cycle
- ◆ Identifying and stopping will-fitters
- ◆ Creating non-patent challenges



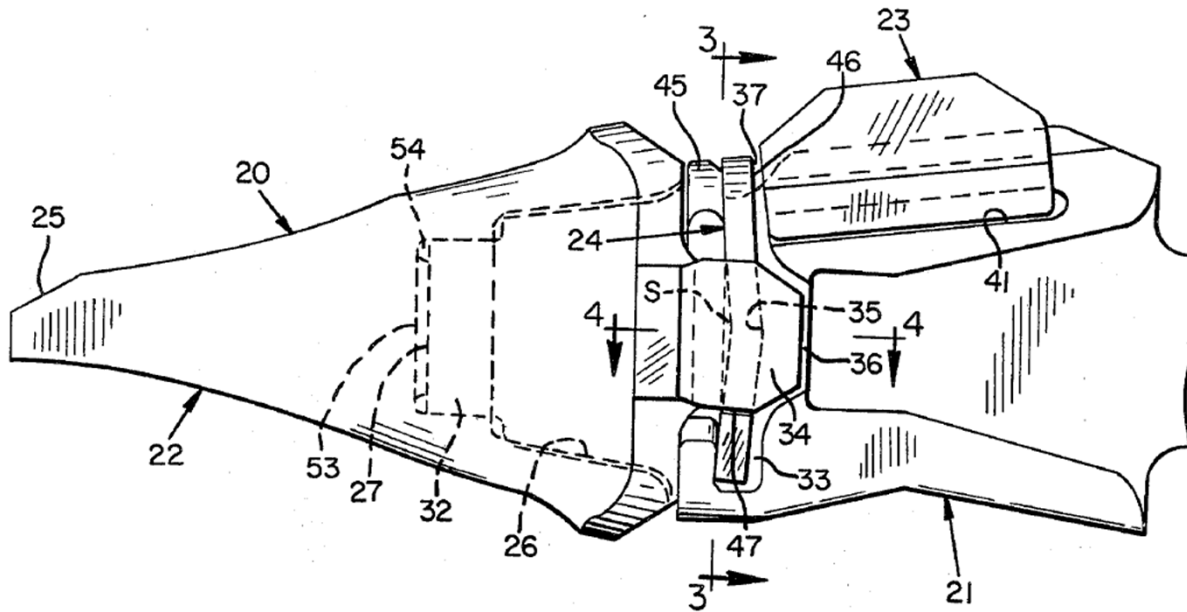
# Patent Application Preparation

- ◆ Business case
- ◆ What kind of application?
  - Utility patent application
  - Design patent application
  - Utility model
  - One or more of the above
- ◆ Multiple applications?



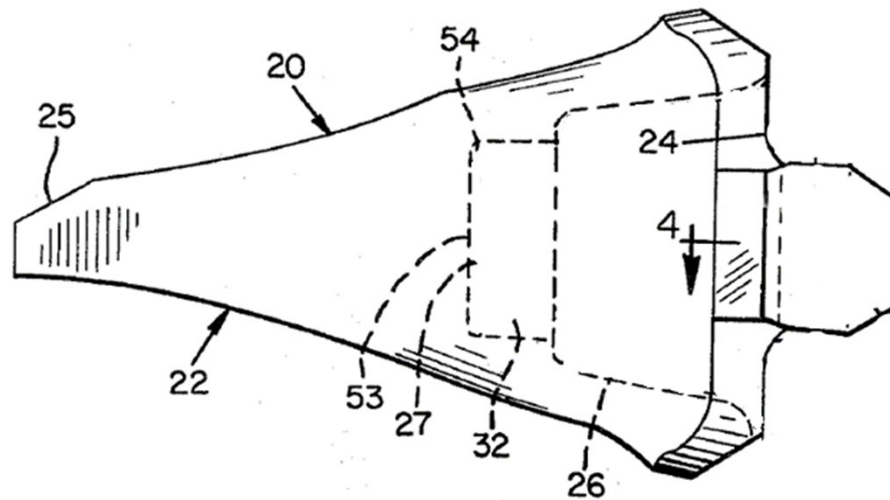
# Claim Strategy

- ◆ Example
  - New excavator bucket tooth assembly



# Claim Strategy

- ◆ What to claim?

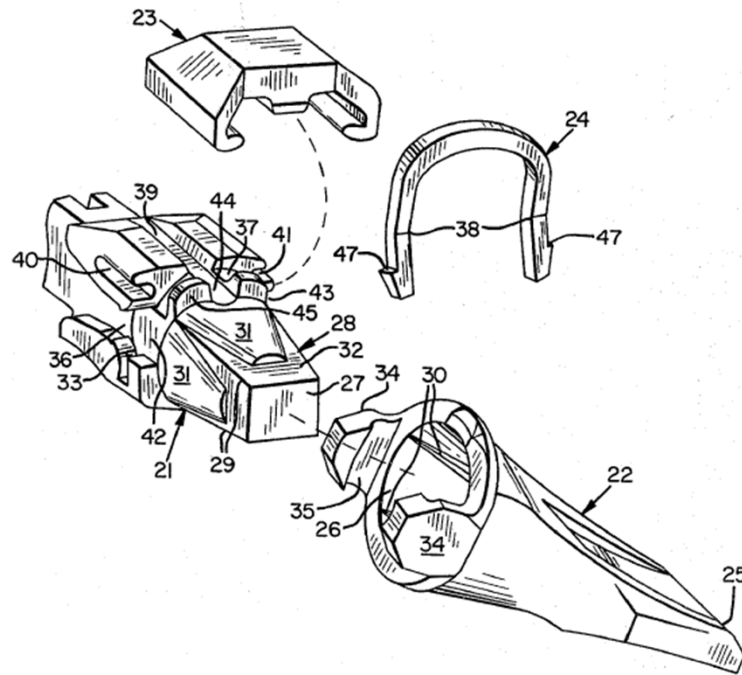


**15.** A tooth point comprising a unitary metal element having a socket at one end and a digging edge at the other end, said socket including a plurality of straight



# Claim Strategy

- ◆ Aftermarket part and interface with system



1. An excavating tooth comprising an adapter element and a point element, said adapter element having

# Claim Language

- ◆ Avoiding nonessential structural elements

1. An air filter for an internal combustion engine, the air filter comprising:

a filter element;

a body supporting the filter element;

an outlet of the body; ~~and~~

~~a clamp configured to secure the outlet of the body to an inlet pipe.~~



# Claim Language

- ◆ Avoiding nonessential structural elements

1. An air filter for an internal combustion engine, the air filter comprising:

a filter element;

a body supporting the filter element; and

an outlet of the body.

# Claim Language

- ◆ Avoiding environmental structural elements

1. A seal for two components, the seal comprising:

an annular body;

a groove of the annular body; and

~~a lip of one of the components extending into the groove.~~

# Claim Language

- ◆ Avoiding environmental structural elements

1. A seal for two components, the seal comprising:  
an annular body; and  
a groove of the annular body **to receive a lip of one of the components.**

# Claim Language

- ◆ Using “just right” environmental language



1. A bearing comprising:
  - an outer race;
  - an inner race having a central opening; and
  - frustoconical roller bearings between the outer race and the inner race.

# Claim Language

- ◆ Using “just right” environmental language

1. A wheel bearing assembly comprising:
  - an outer race;
  - an inner race having a central opening to receive a vehicle spindle; and
  - frustoconical roller bearings between the outer race and the inner race.

# Claim Language

- ◆ Dimensional ranges
- ◆ Equations
- ◆ Ratios

1. An inlet louver assembly for a cooling tower, the inlet louver assembly comprising:  
a plurality of louvers;  
an actuator operable to move the louvers between opened and closed positions;  
**a rectangular outer frame supporting the louvers; and**  
**the rectangular outer frame having a width greater than two feet, a height greater than two feet, and a depth greater than one foot.**

# Claim Language

## ◆ Limiting functional language



1. A tine for a cultivator, the tine comprising:

an elongate body;

~~a portion of the body configured to be mounted to a frame of a cultivator;~~

a ground-engaging portion of the body; and

a resilient portion of the body intermediate the portion and the ground-engaging portion.

# Claim Language

## ◆ Limiting functional language



1. A tine for a cultivator, the tine comprising:

an elongate body;

a **mounting** portion of the body;

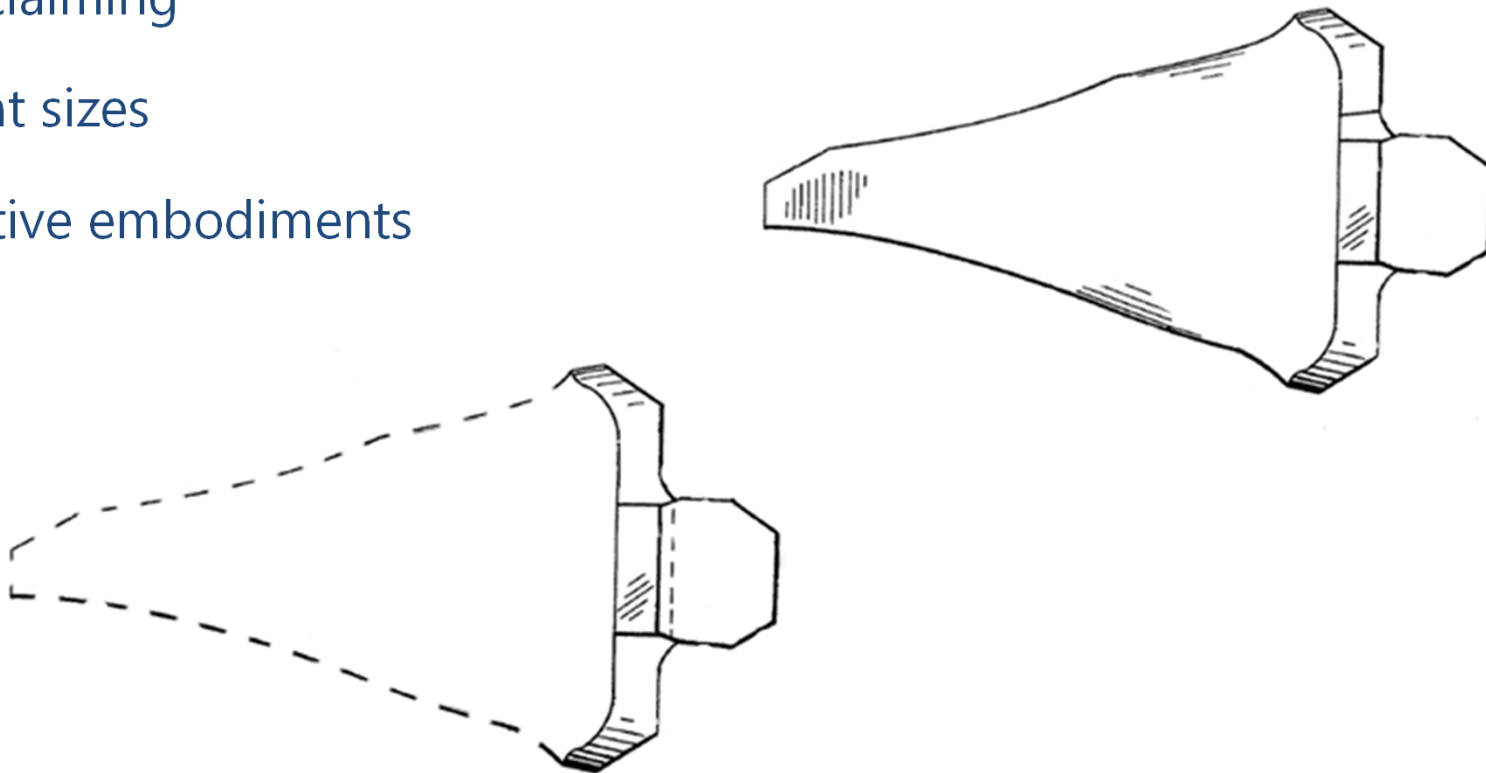
a ground-engaging portion of the body; and

a resilient portion of the body intermediate the mounting portion and the ground-engaging portion.



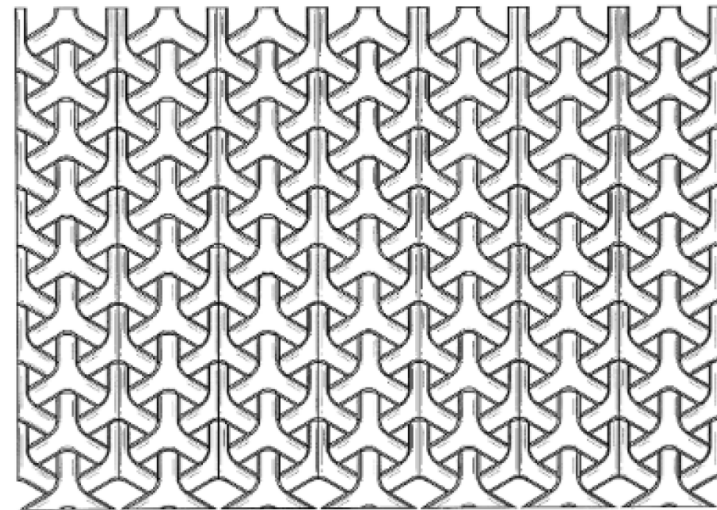
# Design Protection

- ◆ Whole aftermarket part
- ◆ Partial claiming
- ◆ Different sizes
- ◆ Alternative embodiments



# Design Protection

- ◆ Selecting a title to intentionally narrow design scope
  - Filter
    - Oil filter
  - Seal
    - Railway roller bearing seal
  - Heat exchanger
    - Pillow plate heat exchanger
  - Implement
    - Ground engaging machine implement



*Pattern for a chair*

# Business Involvement in Foreign Filing

- ◆ Foreign filing decision
  - Where do we plan on selling?
  - Where are our direct competitors?
  - Where are will-fitters typically found for this type of product?
  - Where are potential distributors?
  - Would we ever enforce patent there?
- ◆ PCT ISR/WO
- ◆ Aggressive China Strategy?
- ◆ Heightened translation review?

# Business Involvement in Prosecution

- ◆ Informed claim amendments
- ◆ Continuing applications
- ◆ Competitor patent activity

# Identifying Will-fitters

- ◆ Firsthand knowledge
  - Training
  - Patented-product identification
  - Clear reporting channels
- ◆ Missing expected revenue



# Identifying Will-fitters

- ◆ Services that search internet for
  - Part numbers
  - Trademarks
  - Images



# Stopping Will-fitters

- ◆ Building your case
  - Private investigator
  - Test purchases
- ◆ Cease and desist letters
  - Cost-effective
  - Evidence preservation
  - Starts clock for civil action?



# Stopping Will-fitters

- ◆ E-commerce platform takedown requests
- ◆ Risks
  - Declaratory judgment
  - Tortious interference





# Stopping Will-fitters

- ◆ Patent enforcement in country of origin
  - Customs
  - Administrative
  - Civil litigation
- ◆ Considerations
  - Costs
  - Remedies
  - Jurisdictional considerations



Image source: [cafc.uscourts.gov](http://cafc.uscourts.gov)

# US IP Enforcement

- ◆ “Schedule A” defendant list
- ◆ File Under Seal
  - Avoid whack-a-mole

| IN THE UNITED STATES DISTRICT COURT<br>FOR THE NORTHERN DISTRICT OF ILLINOIS<br>EASTERN DIVISION  |                                  |
|---|----------------------------------|
| <div>VALENTINO ROSSI,<br/><br/>Plaintiff,<br/><br/>v.<br/><br/>THE INDIVIDUALS, CORPORATIONS,<br/>LIMITED LIABILITY COMPANIES,<br/>PARTNERSHIPS AND<br/>UNINCORPORATED ASSOCIATIONS<br/>IDENTIFIED ON <b>SCHEDULE A</b> HERETO,<br/><br/>Defendants.</div>  | Case No. 20-cv-4746<br><br>Judge |
| <p align="center"><b><u>PLAINTIFF’S MOTION FOR LEAVE TO FILE UNDER SEAL</u></b></p> <p>Plaintiff VALENTINO ROSSI (“Plaintiff”) files this Motion requesting leave to file the following documents under seal: (1) Plaintiff’s Schedule A attached to the Complaint, which identifies and includes a list of the Defendant Domain Names, domain name registration information, and Online Marketplace Accounts; and (2) screenshot printouts showing the active Defendant Internet Stores (Exhibit 2) to the Declaration of Christian Zierhut.</p> |                                  |

# US IP Enforcement

- ◆ TROs
  - Asset restraint
    - Alipay, Amazon Pay, PayPal, etc.
  - TM presumption of irreparable harm



# US IP Enforcement

- ◆ N.D. Ill.
  - Personal jurisdiction advantages
  - Counterfeiting experience
- ◆ Also S.D.N.Y., N.D. Ga., S.D. Fla.



# Creating Non-Patent Challenges

- ◆ Trade secrets
  - Materials
  - Process details
- ◆ Copyrights



# Creating Non-Patent Challenges

- ◆ Trademarks
  - Brand
  - Part numbers
  - Product configuration
- ◆ Watch out for filings!



# Thank You!

*Questions or Comments?*

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