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D. Mass.: Knowledge of Parent Patent, by Itself, May Not Suffice to Show Knowledge of Child Patent for Purposes of Indirect and Willful Infringement

August 11, 2025

Reading Time : **3 min**

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In considering a motion to dismiss infringement claims for two related patents, the District of Massachusetts recently held that pre-suit knowledge of a "parent" patent, without more, is insufficient to establish pre-suit knowledge of the "child" patent for purposes of indirect and willful infringement.

Plaintiff Echosens, S.A. accused defendant E-Scopics S.A.S. of directly, willfully, and indirectly infringing two related patents directed to assessing whether a patient has liver fibrosis. The first patent—U.S. Patent No. 11,690,592—which issued in July 2023, is the parent of the second patent—U.S. Patent No. 11,980,497—which issued in May 2024. E-Scopics moved to dismiss all asserted claims on multiple grounds.

As to direct infringement, E-Scopics argued that its accused act of importation lacked any sort of commercial activity and, therefore, was insufficient to support a claim for direct infringement. The district court rejected this argument as to the '592 Patent because the complaint plausibly alleged that E-Scopics imported the accused product with "commercial intent" in November 2023, when it said that it would begin taking orders for the accused product at a trade show. In reaching this conclusion, the district court noted that while the Federal Circuit had not directly addressed whether "importation" for purposes of direct infringement requires some associated commercial activity, it did not need to decide that question given the other allegations in this case. The district court granted E-Scopics's motion to dismiss the direct infringement claim as to the '497 Patent because the alleged importation

occurred before that patent issued, and Echosens failed to plausibly allege any infringing acts taking place after issuance of the '497 Patent.

The district court then addressed the parties' dispute over E-Scopics's alleged knowledge of the '497 Patent—a "required element for both indirect and willful infringement." Echosens argued that it sufficiently pleaded pre-suit knowledge of **both** patents by informing E-Scopics in November 2023 that it infringed **the '592 Patent**. E-Scopics argued that its knowledge of the parent '592 Patent could not be used to impute knowledge of the related '497 Patent, arguing that knowledge of a parent patent "does not automatically confer knowledge" of its children. The district court agreed with E-Scopics, explaining that although "some courts have factored knowledge of the parent patent into the totality of the circumstances" for establishing knowledge, "knowledge of the parent is rarely, if ever, the only allegation evidencing defendant's knowledge." Rather, courts require "other circumstantial evidence, such as the competitive relationship between the parties, a history of prior patent litigation, or allegations that defendant monitored patent prosecutions." Because Echosens failed to plead such additional evidence—and relied solely on the knowledge of the parent—the district court found that it failed to plausibly allege pre-suit knowledge of the '497 Patent.

The district court ultimately denied the motion as to both patents, however, because Echosens established ***post-suit*** knowledge of the '497 Patent based on the filing of the complaint. In making that determination, the district court acknowledged that there is a "minority view" among district courts that filing a complaint cannot establish knowledge, but it rejected that view, seeing "no reason why the Complaint cannot serve as knowledge for any subsequent acts of indirect or willful infringement, particularly at this preliminary stage." Notably, however, the district court clarified that "[l]iability will be limited" on the '497 Patent to the date the complaint was filed, at the earliest, because Echosens failed to plausibly allege pre-suit knowledge. After further determining that Echosens sufficiently pleaded the remaining elements of indirect and willful infringement for both patents, it denied E-Scopics's motion as to those claims.

Practice Tip: When drafting complaints involving infringement of related patents, plaintiffs should ensure that they allege sufficient facts to establish infringement for each theory and for each patent. In particular, when asserting indirect and willful infringement of related patents, plaintiffs should not rely solely on knowledge of a parent patent to establish knowledge of a child. Rather, they should consider pleading additional "circumstantial evidence" that could establish knowledge, such as facts showing the defendant's patent

litigation history, a competitive business relationship between the parties, or prosecution monitoring activities by the defendant. Additionally, to the extent claims of direct infringement are premised on acts of importation, it may be important to include allegations tying the alleged acts of importation to commercial activity, as there appears to be an open question as to the specific requirements for an act of importation to qualify as an act of infringement.

Echosens SA v. E-Scopics SAS, 1-24-cv-11373 (D. Mass. Mar. 20, 2025).

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