

Patent Law

Prof. Roger Ford

Monday, April 6, 2015

Class 20 – Infringement II: the doctrine of equivalents; indirect infringement

Recap

Recap

→ Class 18

- Laws of nature
- Abstract ideas
- A unified framework

→ Class 19

- Claim construction
- Literal infringement



Today's agenda

Today's agenda

- Infringement by equivalents
- Secondary liability

**Infringement by
equivalents**

Infringement by equivalents

- There will be products that don't meet all the limitations of the claim, but are very close
 - Maybe due to strategic behavior (pH = 3.95 when the claim requires 4–6)
 - Maybe due to unforeseeable technology (Velcro® instead of mechanical fastener)
- Infringement by equivalents fills that gap

Infringement by equivalents

- Similar role to obviousness
 - Obviousness fills in the gap when anticipation doesn't work, but the prior art is very close
 - Equivalents fills in the gap when literal infringement doesn't work, but the accused product is very close

Infringement by equivalents

→ Preview: the basic rules

- You still have to show infringement of every element or limitation (the **all-elements rule**)

Infringement by equivalents

→ Preview: the basic rules

- First main question: does the defendant's product satisfy the **function/way/result test**?
- Does the accused structure or step **perform substantially the same function, in substantially the same way, to achieve substantially the same result**?

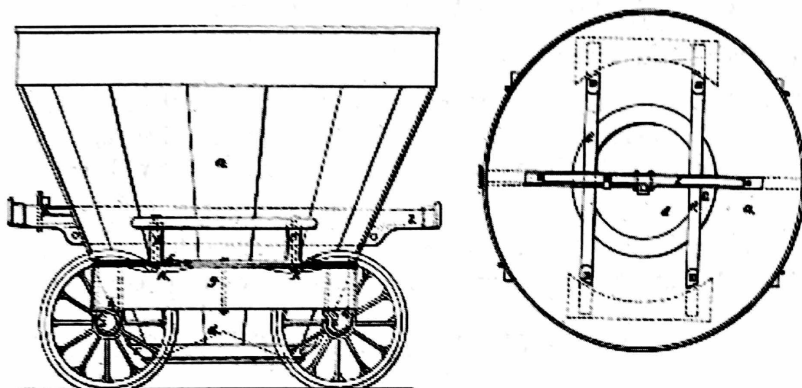
Infringement by equivalents

→ Preview: the basic rules

- Second main question: is there a legal reason to limit the doctrine of equivalents?
- Four common legal reasons: prosecution history estoppel; the disclosure-dedication rule; the all-limitations rule; argument-based estoppel

Winans v. Denmead (1854)

→ Tech: rail car to carry coal with conical design



Winans v. Denmead (1854)

- Accused product: inward-sloping section was eight-sided instead of being conical

Winans v. Denmead (1854)

- Function/way/result test?
 - Function?
 - Way?
 - Result?

Festo v. SKKK

- This doctrine arises out of the fact that prosecution is a negotiation
- What are an applicant's options when an examiner rejects a claim?

Festo v. SKKK

- This doctrine arises out of the fact that prosecution is a negotiation
- What are an applicant's options when an examiner rejects a claim?
 - Argue
 - Amend
 - Appeal
 - Abandon

Festo v. SKKK

- This doctrine arises out of the fact that prosecution is a negotiation
- What are an applicant's options when an examiner rejects a claim?
 - Argue – **claim construction**
 - Amend – **prosecution history estoppel**
 - Appeal
 - Abandon

Festo v. SKKK

- Two amendments:
 - Two sealing rings, each with a lip on one side to hold out impurities
 - Magnetizable sleeve

Festo v. SKKK

- **Two sealing rings, with one lip each**
 - Accused product: one sealing ring, with lips on both sides
 - Function?
 - Way?
 - Result?

Festo v. SKKK

- **Magnetizable sleeve**
 - Accused product: non-magnetizable sleeve
 - Function?
 - Way?
 - Result?

Festo v. SKKK

→ Two legal questions

- Should the doctrine of equivalents apply to amendments for reasons other than prior art?
- What is the scope of the doctrine of equivalents – is it a “complete bar” or a “flexible bar”?

Festo v. SKKK

- Finally, prosecution history estoppel
- What’s the principle?

Festo v. SKKK

- Finally, prosecution history estoppel
- What's the principle?
 - If you originally claimed something broad, but then narrowed it to get a patent, you can't go back and get the broader thing through equivalents
 - The examiner thought there was something wrong with the original claim
 - It's an end run around examination

Festo v. SKKK

- Finally, prosecution history estoppel
- What's the principle?
 - And this has little to do with the reason for the narrowing
 - Prior art
 - Written description/enablement
 - Any other reason that relates to patentability

Festo v. SKKK

- Flexible bar versus complete bar
- Argument for a complete bar?

Festo v. SKKK

- Flexible bar versus complete bar
- Argument for a complete bar?
 - Administrability – the flexible-bar rule was unpredictable and promoted uncertainty

Festo v. SKKK

- Flexible bar versus complete bar
- Argument for a flexible bar?

Festo v. SKKK

- Flexible bar versus complete bar
- Argument for a flexible bar?
 - The prosecution history can tell us what a patent doesn't mean, not what it does mean
 - Just because you've surrendered some claim scope doesn't mean that you're suddenly capable of writing the perfect claim

Festo v. SKKK

- New rule: to get equivalents, even after a claim was narrowed during prosecution, you have to show:
- that the equivalent was unforeseeable;
or
 - that the reason for the amendment was tangential to the equivalent you're trying to capture; or
 - "some other reason"

Festo v. SKKK

- New rule: to get equivalents, even after a claim was narrowed during prosecution, you have to show:
- that the equivalent was unforeseeable;
or
 - that the reason for the amendment was tangential to the equivalent you're trying to capture; or
 - "some other reason"

Festo v. SKKK

- Unforseeable technology
 - mechanical fastener → Velcro®
 - Wright brothers' wing warping → wing flaps or ailerons

Festo v. SKKK

- Tangential: *Primos, Inc. v. Hunter's Specialties*
 - Claim: required a "plate"
 - Amendment: added "differentially spaced" limitation
 - Accused product: used a dome instead of a "plate"
 - Court: the amendment had nothing to do with the "plate," so it was tangential

Infringement by equivalents

→ Preview: the basic rules

- Second main question: is there a legal reason to limit the doctrine of equivalents?
- Four common legal reasons: prosecution history estoppel; the disclosure-dedication rule; the all-limitations rule; argument-based estoppel

Infringement by equivalents

→ Disclosure-dedication rule

- Another form of prosecution-history estoppel
- *Johnson & Johnston*: claim required “sheet of aluminum”
- Specification: one could also use “other metals, such as stainless steel or nickel alloys”
- Court: the patentee had disclosed and dedicated non-aluminum metals to the public

Infringement by equivalents

→ All-limitations rule

- The doctrine of equivalents cannot apply if it would vitiate an entire claim limitation
- *Freedman Seating v. American Seating*: a rotatably mounted seat cannot be the equivalent of a slidably mounted seat
- *Asyst v. Emtrak*: an unmounted part cannot be the equivalent of a mounted part
- *Novartis v. Abbott Labs*: a surfactant cannot be the equivalent of a nonsurfact.

Infringement by equivalents

→ Argument-based estoppel

- An applicant who surrenders claim scope in argument before the examiner cannot regain that scope
- *PODS v. Porta Stor*: Applicant argued (to overcome a prior-art rejection) "As the Examiner acknowledges, the Dousset reference clearly lacks the teachings of the singular rectangular-shaped frame."
- Court: PODS cannot get a non-rectangular frame through the doctrine of equivalents

Secondary liability

35 U.S.C. § 271 — Infringement of Patent (post-AIA)

* * *

(b) Whoever **actively induces** infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a **component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process**, constituting a material part of the invention, knowing the same to be **especially made or especially adapted for use in an infringement** of such patent, and **not a staple article** or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

* * *

Wallace v. Holmes (1871)

- Tech: a **new burner** for an oil lamp
- Claim: a new oil lamp with **new burner** AND **standard fuel reservoir, wick tube, chimney**
- Accused product: new oil lamp **minus the chimney**
- Court: this is “palpable interference” with the patent rights

Wallace v. Holmes (1871)

- How could the patentee have prevented this problem?
 - Just claim the novel burner separately
 - Today: this totally works
 - In 1871: not allowed

Wallace v. Holmes (1871)

- Now codified in § 271(c):
 - Offering/selling/importing a component of a patented invention
 - Knowing it to be especially made for infringement
 - Not a staple article of commerce

Aro Manufacturing

- Tech: convertible tops for cars
- Aro: makes replacement fabric parts for when the original wears out

Aro Manufacturing

- Tops are specially made for GM and Ford
- GM is licensed
 - Previous Supreme Court decision (*Aro I*): replacing top is “repair,” not “reconstruction,” so doesn’t need a separate license
- So only Ford parts are at issue here

Aro Manufacturing

- Does Ford infringe?
- Do Ford owners infringe?
- Does repairing Fords infringe?
- Does Aro directly infringe?

Aro Manufacturing

- Court: Aro is supplying a part especially made or adapted for use in the infringing product
- No other use
- So not a staple article of commerce
 - Bolts, screws, &c

Aro Manufacturing

- Also: has to have knowledge of:
 - That the product it's making is especially suited for putting into Ford cars
 - That a patent covers the convertible top
 - That the use by Ford is unlicensed
- Here: Aro had that knowledge because the patent owner had sent it a letter

Aro Manufacturing

- Is this a sensible rule?
- If you make repair parts, how will you behave in light of this rule?

Aro Manufacturing

- Is this a sensible rule?
- If you make repair parts, how will you behave in light of this rule?
 - Bury your head in the sand
 - This means patent holders have a lot of pressure to track down infringers
 - Who has lower search costs?

Global-Tech v. SEB

- § 271(b): whoever “actively induces infringement”
- Question: what mental state is required?
 - Actual knowledge
 - Willful blindness
 - Recklessness
 - Deliberate disregard of a known risk
 - Should have known
 - Negligence
 - Strict liability

Global-Tech v. SEB

- Federal Circuit: Deliberate disregard of a known risk is sufficient
- Supreme Court: No, actual knowledge is required
- However: Willful blindness is a form of actual knowledge
 - Requires: subjective belief that there is a high probability of a patent, and deliberate action to avoid learning about it

Global-Tech v. SEB

- What was the inducement?
 - Here: encouraging others to sell infringing deep fryers
 - In general: actively and knowingly aiding and abetting

Secondary liability

- Contributory infringement:
 - Sale of an article, with knowledge, that is not a staple article of commerce
- Induced infringement:
 - Aiding and abetting, with knowledge
 - Possibly active encouragement
- After *Global-Tech*, the line between the two is very fine

Secondary liability

- Follow-up question: Can you be liable for inducement if you believe the patent is invalid or not infringed?
 - *Global-Tech*: “[W]e now hold that induced infringement ... requires knowledge that the induced acts constitute patent infringement.”
 - Invalidity: ???

Secondary liability

- *Commil USA v. Cisco Systems*:
 - Argued in the Supreme Court last week
 - Question: Is a good-faith belief that a patent is invalid enough to defeat inducement liability?
 - U.S. government: No; and *Global-Tech* should be narrowly construed
 - Court: likely to say yes

Next time

Next time

→ Remedies: injunctions