Patent Law

Prof. Roger Ford
Wednesday, November 8, 2017
Class 20 – Infringement:
the doctrine of equivalents

Recap

Recap

→ Claim construction

→ Claim-construction procedure

→ Literal infringement

Today's agenda

Today's agenda

→ Infringement by equivalents

→ Prosecution history estoppel

Infringement by equivalents

Infringement by equivalents

→ There are products that don't meet all limitations of a claim, but are very close (Why?)

Infringement by equivalents

→ There are products that don't meet all limitations of a claim, but are very close (Why?)

- Maybe due to strategic behavior (pH = 3.95 when the claim requires 4–6)
- Maybe due to unforeseeable technology (Velcro® instead of mechanical fastener)
- Maybe due to different design decisions

→ Infringement by equivalents fills this gap

Infringement by equivalents

→ Similar role to obviousness

- Obviousness is there when anticipation doesn't work, but the prior art is very close
- Equivalents is there when literal infringement doesn't work, but the accused product is very close

Infringement by equivalents

→ How to think about equivalents:

- Literal infringement: You have to show that every element of the claim is literally met by the accused product
- *Except*: Under the doctrine of equivalents, you may be able to show that one or more elements of the accused product are equivalents of the claim limitation
- *Except*: Under prosecution history estoppel (or another doctrine), the doctrine of equivalents may not be available

Infringement by equivalents

→ How to think about equivalents:

- Literal infringement: You have to show that every element of the claim is literally met by the accused product
- *Except*: Under the doctrine of equivalents, [you] may be able to show that one or more [elements] of the accused product are equivalents of the claim limitation
- *Except*: Under prosecution history estoppel (or another doctrine), the doctrine of equivalents may not be available

Factual question

Infringement by equivalents

→ How to think about equivalents:

- Literal infringement: You have to show that every element of the claim is literally met by the accused product
- *Except*: Under the doctrine of equivalents, [you] may be able to show that one or more [elements] of the accused product are equivalents of the claim limitation
- *Except*: Under prosecution history estoppel (or another doctrine), the doctrine of equivalents may not be available

Factual question

Legal question

Infringement by equivalents

→ The basic rules:

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

Infringement by equivalents

→ The basic rules:

- Factual question: does the defendant's product contain an equivalent of a claim limitation?

Infringement by equivalents

→ The basic rules:

- The insubstantial-differences test: Are the differences between the claimed invention and the accused product insubstantial?

Infringement by equivalents

→ The basic rules:

- 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?

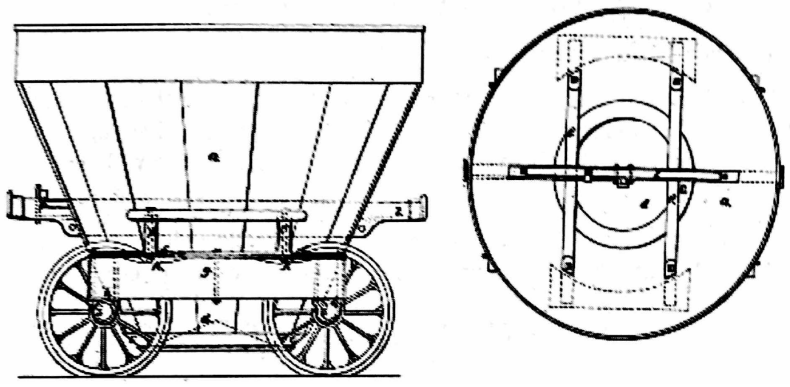
Infringement by equivalents

→ The basic rules:

- Legal question: is there a reason to limit the doctrine of equivalents?
- Four common reasons: prosecution history estoppel; the public-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?

Graver Tank

→ So why is this a thing?

Graver Tank

→ So why is this a thing?

- The Court is very concerned with treating patent holders fairly
- Court: "to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing" (Nard 526)

Graver Tank

→ So why is this a thing?

- Court: "Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form." (Nard 526)

Graver Tank

→ Is this persuasive?

Graver Tank

→ Is this persuasive?

- Often an inventor will describe and claim the novel portion of the invention with great specificity but describe the non-novel components more generically
- E.g., that a novel computer system requires a hard drive, not considering solid-state drives or RAM disks

Graver Tank

→ Is this persuasive?

- Often an inventor will invent something and describe and claim it in ways that contain implicit assumptions that later become false
- E.g., that a hearing aid requires an external controller because the controller function is too large to fit in the aid

Graver Tank

→ Is this persuasive?

- But these problems could all be avoided if patent applicants just write better claims!

Graver Tank

→ Is this persuasive?

- And this hurts the notice function of patent claims!
- Dissent: "We have held in this very case that this statute precludes invoking the specifications to alter a claim free from ambiguous language, since 'it is the claim which measures the grant to the patentee.'" (Nard 529)

Graver Tank

→ Is this persuasive?

- And patent owners have tools to fix these problems!
- Dissent: This is what reissue is for
- Dissent: And reissue has careful protections and limitations to protect accused infringers

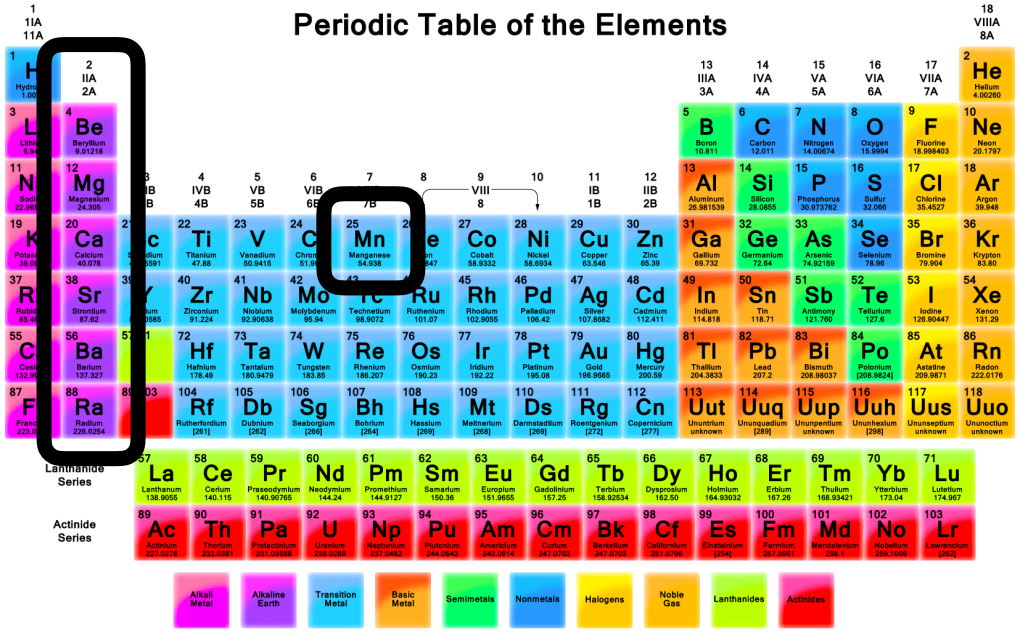
Graver Tank

→ This is a good example of the careful balance patent law seeks

- Interpreting claims too literally hurts patent owners in ways that might hurt the incentive to invent
- Interpreting claims too broadly hurts accused infringers in ways that might hurt competition

Graver Tank

- → So let's apply the doctrine of equivalents
- → <u>Claimed invention</u>: composition containing alkaline earth metal silicates
- → <u>Accused product</u>: composition containing silicates of calcium and manganese
  - Manganese is not an alkaline earth metal



Graver Tank

→ Function/way/result test?

- Function?
- Way?
- Result?

Warner-Jenkinson

→ Problem: The doctrine of equivalents had taken on "a life of its own"

→ Solution: The Court cabins its scope

- It applies on a limitation-by-limitation basis (the all-elements rule)
- Prosecution history estoppel remains a significant limitation

Warner-Jenkinson

→ But: The Court rejects a single factual test to determine equivalence

→ Instead, it embraces both the insubstantial-differences test and the function/way/result test

Prosecution history estoppel

Festo v. SKKK

→ Prosecution is a negotiation between the applicant and the examiner

→ What are an applicant's options when an examiner rejects a claim?

Festo v. SKKK

→ Prosecution is a negotiation between the applicant and the examiner

→ What are an applicant's options when an examiner rejects a claim?

- Argue
- Amend
- Appeal
- Abandon

Festo v. SKKK

→ Prosecution is a negotiation between the applicant and the examiner

→ 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

→ Patent claim: Two sealing rings, with one lip each

→ Accused product: One sealing ring, with lips on both sides

- Function?
- Way?
- Result?

Festo v. SKKK

→ Patent claim: 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've suddenly written the perfect claim

Festo v. SKKK

→ New rule: when can you get equivalents even after a claim was narrowed during prosecution?

Festo v. SKKK

→ New rule: when can you get equivalents even after a claim was narrowed during prosecution?

- If the equivalent was unforeseeable; or
- If the reason for the amendment was tangential to the equivalent you're trying to capture; or
- For "some other reason"

Festo v. SKKK

→ Unforeseeable 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

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

Infringement by equivalents

→ Public-dedication rule

- Another form of estoppel
- Example: *Johnson & Johnston*: the claim required a "sheet of aluminum"
- Specification: one could use "other metals, such as stainless steel or nickel alloys"
- Court: 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

→ All-limitations rule

- But, *Cadence v. Exela* (Fed. Cir. 2015): a limitation requiring X before Y can be equivalent to Y before X
- "A holding that the doctrine of equivalents cannot be applied … because it 'vitiates' a claim limitation is nothing more than a conclusion that the evidence is such that no reasonable jury could conclude that an element of an accused device is equivalent to an element called for in the claim…."

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:* To overcome a prior-art rejection, the applicant argued: "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

Next time

Next time

→ Infringement: indirect and divided infringement; infringement of means-plus-function claims