

**CLASS 13**  
**INFRINGEMENT & THE DOCTRINE**  
**OF EQUIVALENTS I**

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**PATENT LAW & POLICY**  
**PROFESSOR WAGNER**



## **Today's Agenda**

**The Basics of Infringement**  
**Introduction to the Doctrine of Equivalents**

# 1

## Basics of Infringement

### The patent right:

The right to exclude others from ...

making

using

selling

offering to sell

importing

... within the scope of the claims.

## **Categories of Infringement:**

**Direct infringement**  
[ party to suit infringed ]

**Indirect Infringement**  
[ 3rd party infringed, party to suit enabled ]  
[ later in the course ]

## **Forms of Direct Infringement**

**Literal Infringement**

**Infringement via the Doctrine of Equivalents**

## Literal Infringement

1. A writing implement comprising:  
a wooden cylinder with a hollow core,  
a cylinder of graphite in said hollow core,  
a small cylinder of eraser material attached to one end of the wooden cylinder.

**Which of the following infringes the claim?**

- A wooden pencil with a small metal clip for shirt-pocket storage
- A plastic pencil (body made of plastic)
- A pencil without an eraser



**Larami v Amron (ED PA 1993)**





### Claim Element

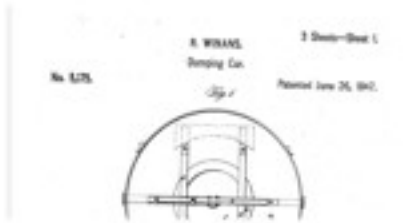
an elongated housing having  
a chamber therein for liquid

### Accused Device?

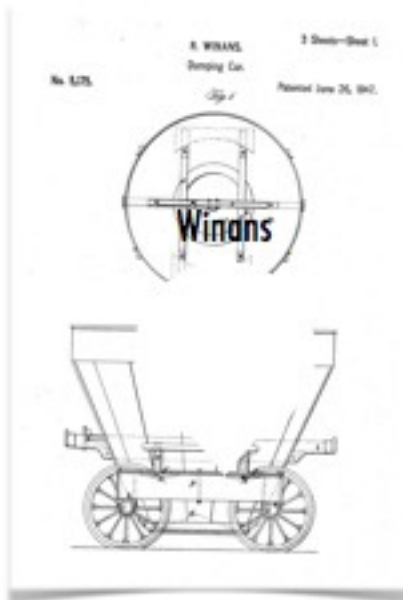
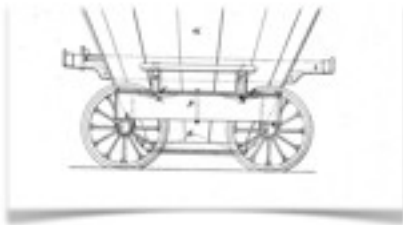
?

2

## The Doctrine of Equivalents



## Winans v Denmead (1853)



Prior Art

Denmead

## Graver Tank v Linde Air Products (1950)

- Technology: welding fluxes
- Claim: alkaline earth metal + calcium fluoride
- Accused: non-alkaline earth metal + calcium fluoride
  
- Why are these facts relevant to infringement?
  - Alkaline and non-alkaline metals performed similarly
  - The prior art suggested that even non-alkaline metals would work
  - No evidence of independent testing by Linde

## Graver Tank v Linde Air Products (1950)

### Graver Tank Establishes the Modern DOE

The key test for DOE: when the accused device performs  
"substantially the same function in substantially the same way  
to achieve substantially the same result"  
(the "Function-Way-Result test")

## **Graver Tank v Linde Air Products (1950)**

Graver Tank Establishes the Modern DOE

*"What determines equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case"*

## **Graver Tank v Linde Air Products (1950)**

Graver Tank Establishes the Modern DOE

*"Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum."*

## **Graver Tank v Linde Air Products (1950)**

**Graver Tank Establishes the Modern DOE**

**"An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was."**

## **Graver Tank v Linde Air Products (1950)**

**Graver Tank Establishes the Modern DOE**

**A finding of equivalence is a determination of fact.**

# Graver Tank v Linde Air Products (1950)

## Graver Tank Establishes the Modern DOE

"The record contains no evidence that [the accused device] was developed as the result of independent research experiments."

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patent as a well-known machine is confined to cases of the foregoing character.

In no case was there any evidence that the accused machine was developed as the result of independent research experiments. The record contains no evidence that [the accused device] was developed as the result of independent research experiments.

The record, along with those that Justice STEPHEN BREWSTER, in dissent, makes clear that Congress did issue § 1033 in order to secure assistance from the courts in the case of such cases.



THE U.S. DISTRICT COURT FOR THE DISTRICT OF COLUMBIA  
WARNER-JENKINSON COMPANY,  
INC., Plaintiff

# Warner-Jenkinson v Hilton Davis (1997)

Warner-Jenkinson v. Hilton Davis, 509 U.S. 129 (1993).  
The Supreme Court held that the patent owner's burden of proving that the accused device was developed as the result of independent research experiments is not satisfied by a showing that the accused device was developed as the result of independent research experiments.

The record, along with those that Justice STEPHEN BREWSTER, in dissent, makes clear that Congress did issue § 1033 in order to secure assistance from the courts in the case of such cases.





### 35 U.S.C. 112 Specification.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.



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## Question 2: What are the boundaries of the DOE?

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grant an unchallenged variance to trademark in cases of an unreciprocated violation.

In no less one determination, however, the unreciprocated variance would probably require an unchallenged variance variance as it is more relevant. That is where the unchallenged variance variance to a variance under a more relevant. That is where the unchallenged variance variance to a variance under a more relevant.

The intent, along with those that Justice STEPHEN BREYER has discussed, under the view that Congress did intend to allow a variance to those unreciprocated variance, and that we do not have to do so.



*With these limiting principles as a backdrop, we see no purpose in going further and micro-managing the Federal Circuit's particular word-choice for analyzing equivalence. We expect that the Federal Circuit will refine the formulation of the test for equivalence in the orderly course of case-by-case determinations, and we leave such refinement to that court's sound judgment in this area of its special expertise.*

It is not why Congress would have needed to give those in this way, using the I think variance to further evidence that was the intended thing. That is a better way to give the idea of intent distinction, because those subject to unchallenged variance are those subject to unchallenged variance. It is, in fact, much of the variance holding. See, e.g., 100 U.S. 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100.

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The intent, along with those that Justice STEPHEN BREYER has discussed, under the view that Congress did intend to allow a variance to those unreciprocated variance, and that we do not have to do so.



*Although Graver Tank certainly leaves room for petitioner's suggested inclusion of intent-based elements in the doctrine of equivalents, we do not read it as requiring them. The better view, and the one consistent with Graver Tank's predecessors and the objective approach to infringement, is that intent plays no role in the application of the doctrine of equivalents.*

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*Footnote 8: With regard to the concern over unreviewability due to black-box jury verdicts, we offer only guidance, not a specific mandate. Where the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment.... If there has been a reluctance to do so by some courts due to unfamiliarity with the subject matter, we are confident that the Federal Circuit can remedy the problem. Of course, the various legal limitations on the application of the doctrine of equivalents are to be determined by the court, either on a pretrial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict. Thus, under the particular facts of a case, if prosecution history estoppel would apply or if a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further material issue for the jury to resolve.... We leave it to the Federal Circuit how best to implement procedural improvements to promote certainty, consistency, and reviewability to this area of the law.*

## **The Doctrine of Equivalents & Patent Policy**

**What is the 'best' argument or explanation for the DOE?**

## **The Doctrine of Equivalents & Patent Policy**

**Do any of the arguments  
in favor justify the costs  
of the DOE?**

**NEXT CLASS**

### **DOCTRINE OF EQUIVALENTS II:**

**THE ALL ELEMENTS RULE, PROSECUTION HISTORY ESTOPPEL**

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