

CLASS 15

DOCTRINE OF EQUIVALENTS III:

PROSECUTION HISTORY ESTOPPEL; PRIOR ART LIMITS ON DOE;
REVERSE DOE; DISAVOWAL

PATENT LAW & POLICY
PROFESSOR WAGNER



Today's Agenda

Prior Art Limits on DOE

Disclosed-But-Unclaimed Subject Matter

DOE § 112

Reverse DOE

1

Prior Art Limits on the DOE

Original (unamended) claim:

1. A fastening system comprising:
A square-headed, stainless steel bolt; and
A corresponding nut.

The Prior Art

Brass hex-headed bolts and nuts.

Can you (should you?) get DOE coverage of:

- Brass, hex headed bolts/nuts
- Brass, square-headed bolts/nuts

Wilson Sporting Goods (Fed Cir 1990)

- Why can there be no infringement, as a matter of law, under DOE?

[17] The answer is that a patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims. The doctrine of equivalents exists to prevent a fraud on a patent. *Crown Cork & Seal Co. v. Lindal Air-Products Co.*, 329 U.S. 490, 494, 70 S.Ct. 454, 456, 94 L.Ed. 1987 (1948), not to give a patentee something which he could not lawfully have obtained from the PTO had he tried. Thus, since prior art always limits what an inventor could have claimed, it limits the range of permissible equivalents of a claim.

- But the Court notes the accused golf balls were not in the public domain – they differ from the prior art.
- So is the court's conception broader than it suggests? (How?)

[18] Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer. To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope to literally cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents. If the hypothetical claim could have been allowed, then prior art is not a bar to infringement under the doctrine of equivalents.

Viewing the issue in this manner allows use of traditional patentability rules and permits a more precise analysis than determining whether an accused product (which has no claim limitations on which to focus) would have been obvious in view of the prior art. Compare with *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 1426, 8 USPQ2d 1323, 1330 (Fed.Cir.1988) (comparing accused product with prior art). In

- The "hypothetical claim" analysis.
- What are the advantages? Disadvantages?
- Is this a good way to analyze these issues?

2

Disclosed-But-Unclaimed Subject Matter

1088 **ON FEDERAL REGISTER, IN BRIEF**

The government may be estopped, but in this regard we stated only. We therefore conclude that the appropriate disposition of this case is to remand to the Board to permit Delta the benefit afforded as a result of the government's breach of its contract, in accordance with the rules set forth in this opinion.

CONCLUSION

The actions of the Board in remand and the case is remanded to the Board to permit Delta the benefit afforded as a result of the government's breach of its contract, in accordance with the rules set forth in this opinion.

TACTICS AND REMARKS

After any motion finding infringement under the doctrine of equivalents and several other arguments, summary judgment, and summary judgment, the court of appeals held that patent, which claimed only one of defendant's processes, was not infringed under the doctrine of equivalents by particular defendant's activities, because use of each was disclosed but not claimed in the patent, even though FRP appears in a full-page appendix to the patent.

REMARKS

Chicago, Circuit Judge, filed concurring opinion in which Judge, Chief Judge, and Judge, Chief Judge, joined.

Johnson & Johnston v. RE Services (Fed. Cir. 2002)

R.E. SERVICE CO., INC. and Mark E. Evans, Individual Appellants.
Nos. 00-1016, 00-1016, 00-1016.
United States Court of Appeals,
Federal Circuit.
DECIDED: March 29, 2002.

Deliberate breach of contract claim under patent infringement, of patent claiming invention consisting of apparatus for detecting and measuring electrical resistance to use in manufacturing printed circuit boards. The United States District Court for the Northern District of California, Charles S. Breyer, J., entered judgment in favor of appellee.

1. Patent 4,000,000

Patent claims give notice of the scope of patent protection, giving notice both to the examiner at the Patent and Trademark Office (PTO) during prosecution, and to the public at large, including potential competitors after the patent has issued.

2. Patent 4,000,000, 4,000,000

The patent claims, and the specification, provide the measures of the patent's rights to others.

3. Patent 4,000,000

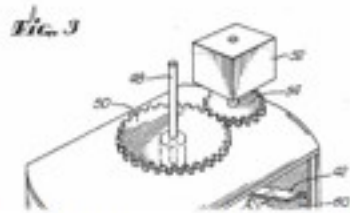
The law of patent infringement requires the accused product with the claim is compared to the claim, infringement.

3

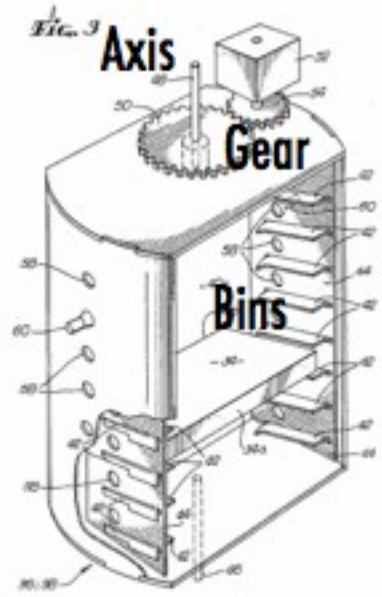
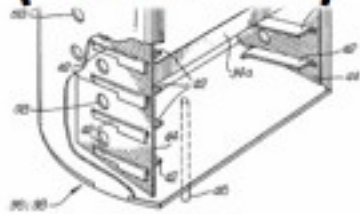
The DOE and Means-Plus-Function Claims

35 U.S.C. 112 Specification.

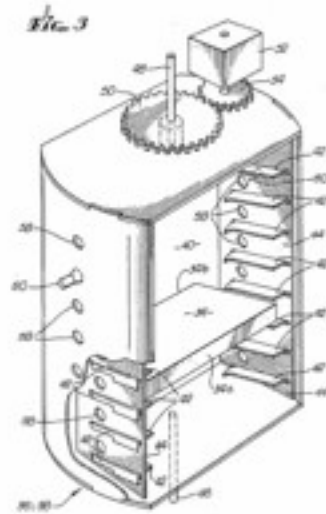
An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification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



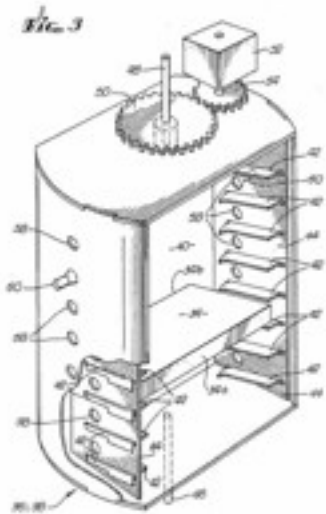
Odetics v Storage Technology (Fed. Cir. 1999)



'151 Patent	Accused Device
Bins	Bins
Axis of Rotation	Axis of Rotation
Gear	Pins



'151 Patent	Accused Device
Bins	Bins
Axis of Rotation	Axis of Rotation
Gear	Pins



JMOL

Odetics v Storage Technology (Fed. Cir. 1999)

How does Odetics distinguish between 112 ¶ 6 and DOE equivalents?

- Recall the test:
 - Equivalent function
 - Equivalent way
 - Equivalent result
 - What 'function' does a 112 ¶ 6 element perform? (Literally? Equivalently?)
- Why not consider equivalence on a component-by-component basis?

Chiuminatta vs Odetics

Type of Infringement	Coverage: <u>Chiuminatta</u>	Coverage: <u>Odetics</u>
Literal	structural/functional identity	structural/functional identity
§ 112 ¶ 6 Equivalents	pre-existing structural equivalents	structure w/ identical function, equivalent way and result
DOE Equivalents	after-arising structural equivalents	structure w/ equivalent function, way, result

4

The Reverse DOE

The Reverse DOE

- Westinghouse:
 - even if literal infringement is found, if the accused device is "so far changed from the principle of the device" so that the literal claims do not represent "the actual invention," then there will be no infringement. (The "reverse doctrine of equivalents".)
- But ... If you propose a claim construction that doesn't represent your actual invention, what should happen?
 - Do we need the rDOE?
 - Note: the Federal Circuit has never found rDOE

NEXT CLASS

DOCTRINE OF EQUIVALENTS IV:
CLASS EXERCISE

PATENT LAW & POLICY
PROFESSOR WAGNER

