Doctrine of Equivalents I:
The History of DOE
Modern DOE
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

Do the following accused devices infringe?

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

Two concepts of infringement

   Literal Infringement: the accused device contains all identical elements of the claim

   Infringement under the Doctrine of Equivalents (DOE): the accused device is “equivalent” (not identical) to the claim
Why the Doctrine of Equivalents?

Winans v Denmead (1853)

What is the invention? What was significant about the invention?
What did Denmead make that allegedly infringed? How was it different?

Did Denmead infringe? Why?

Explanations for the result:

1. Equity / Fairness
   “the properties of inventors would be valueless [if one could avoid infringement by altering the form]

2. Furtherance of Law’s Purpose
   “the exclusive right to the thing patented is not secured, if the public are at liberty to make substantial copies of it.”

3. (Broad) Claim Construction
   “The invention was more than a change in form”
   “the patentee has introduced a mode of operation not before employed”
   “there being evidence in the case tending to show that other forms in fact embody the plaintiff’s mode of operation
   The law presumes that the inventor intends to cover all he is entitled to
Why the Doctrine of Equivalents?

Winans v Denmead (continued)

Describe the “test” or “principle” we can draw from Winans?

Why would the dissenters come out differently? Who has the better argument?

If the advantage of the Winans invention is the conical shape, then why should a non-conical shape infringe?

The dissent suggests that the majority opinion is an effort to “repair [a] defect of observation”. What do they mean by this? Do you think the majority would agree with this statement?

Claude Neon Lights (2nd Cir. 1929)

How does Judge Hand describe the DOE? Do you agree?

What is the “best case” that can be made for the imposition of the DOE? Does it convince you?
Why the Doctrine of Equivalents?

Graver Tank & Mfg. Co. v. Linde Air Prods Co. (USSC 1950)

How does the Graver Tank court describe the DOE? Are you convinced?

What was the invention in Graver Tank?

The Graver Tank Influence

The opinion sets forth a variety of statements and tests relating to the DOE. Many of these are still widely quoted and used today:

**The Test:** DOE applies when the accused device performs “substantially the same function in substantially the same way to achieve substantially the same result.”

“What determines equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case.”

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

“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.”

A finding of equivalence is a determination of fact

“The record contains no evidence that [the accused device] was developed as the result of independent research experiments.”
Why the Doctrine of Equivalents?

Graver Tank (continued)

1. Should it be relevant that the plaintiff’s claims (which would have covered the accused flux, by claiming simply “metallic silicates”) were invalidated for indefiniteness (“overbreadth”)?

2. Should it be relevant that the accused flux had been covered by prior patents, which had expired at the time of suit?
The Modern Doctrine of Equivalents

*Warner-Jenkinson v Hilton Davis (USSC 1997)*

The key element of the claim:

subjecting an aqueous solution . . . to ultrafiltration at a pH from approximately 6.0 to 9.0

*Warner-Jenkinson* developed and used a process with a pH of 5.0

**Does the W-J process infringe?**

**Question 1: Does DOE survive the enactment of the 1952 Patent Act?**

See arguments, page 361-62. *Which, if any, do you find compelling?*

**Question 2: What is the scope of the modern DOE?**

The court “establishes” the “all-elements-rule”: the DOE is to be applied on an element-by-element basis. (Note that this had been the law of the Federal Circuit since 1987.)

How does the all-elements-rule “reconcile” the following:

- That the DOE may be used to expand claim scope
- That the courts may not expand the patent beyond that allowed by the PTO
The Modern Doctrine of Equivalents

Warner-Jenkinson (continued)

1. The Court declines to determine the appropriate “linguistic framework” for the DOE

2. The DOE remains a question of fact, but see footnote 8 (on page 366-67)

3. Whether DOE applies is unrelated to the mental state of the infringer. Why?

4. Prosecution history estoppel (PHE) survives, with a new presumption. What is it? Why have it?

5. The DOE may apply to any technology, whether known or unknown at the time of filing.
The Modern Doctrine of Equivalents

The Special Problem of Disclosed but Unclaimed Subject Matter

1. A fastening system comprising:
   a threaded bolt with 8 threads per inch,
   a nut

   The accused device is a bolt + nut system using 10 threads per inch
   Does the accused device infringe? Literally? Under the DOE?

In your written description, you describe both the 8 threads per inch embodiment and the 10 threads per inch embodiment.

   Does the accused device infringe?

   Maxwell v J. Baker (Fed Cir. 1996) (RR): “subject matter disclosed but not claimed is dedicated to the public”

   Is this consistent with Graver Tank?

   YBM Magnex (Fed Cir 1998): Maxwell is inconsistent with Graver Tank and is thus not a “universal rule”

   Johnson & Johnson v RE Service: en banc on this issue