

Beyond *Festo*

Continuing Case Law Developments in the Doctrine of Equivalents



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OVERVIEW

- Failing to Claim Disclosed Subject Matter
- Cancelling an Independent Claim
- Rebutting the Presumption of No Equivalents
 - Measuring the Effects of a Narrowing Amendment
- Effectively Eliminating a Claim Element

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Disclosure-Dedication Rule



- A disclosed-but-never-claimed embodiment cannot infringe under the D.o.E.
- *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098 (’96)
 - As claimed, system required a tab “secur[ed] ... between said inner and outer [shoe] soles”
 - Spec said, “Alternatively, the tabs may be stitched into a lining seam of the shoes at the sides or back”
 - J. Baker used loops sewn into a side or top seam, and was held not to infringe, as a matter of law

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Johnson & Johnston, 285 F.3d 1046 (Fed Cir 2002) (in banc)



- Claim recites a laminate component used in making printed circuit boards
- Claim 1 – “a sheet of aluminum alloy”
- Spec said, “While aluminum is currently the preferred material for the substrate, other metals, such as stainless steel or nickel alloys, may be used”
- RES used steel, held not to infringe [11 to 1]

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PSC Comp. v. Foxconn Int'l, 355 F.3d 1353 (Fed Cir 2004) (Gajarsa)



- Claim recites a retainer clip for securing a heat sink to a microchip
- Claim 1 – “an elongated, resilient metal strap”
- Spec said ...
 - “The elongated strap ... is made of a resilient metal such as stainless steel although other resilient materials may be suitable for the strap.”
 - “prior art devices use molded plastic and/or metal parts that must be cast or forged”

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PSC Comp. cont'd



- Foxconn's clip is made of plastic
- D. Ct. – Summ'y judg't of no infringement
- PSC
 - “the *Johnson* disclosure was clear and specific, while [our] disclosure is not”
- Fed. Cir. – Affirmed
 - “if one of ordinary skill in the art can understand the unclaimed disclosed teaching ... the alternative matter disclosed has been dedicated to the public”

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PSC Comp. cont'd



- PSC – “metal” language was “inadvertent”
- Fed. Cir. – “The patentee, rather than the public, must bear the burden of inadvertent errors in the patent – including inadvertent dedications.”
 - Fix errors through continuation and reissue practice
- PSC – patentees will write “sparse disclosures”
- Fed. Cir. – Will “motivate patentees to draw the broadest claims that they consider patentable”

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Toro Co. v. White Consol., 383 F.3d 1326 (Fed Cir 2004) (Linn)



- Up on appeal for a third time
- Claim recites a convertible vacuum-blower
 - Removable cover has an attached restriction ring
- Claim 1 – “said cover including means for increasing the pressure developed by” blower
- Spec said ...
 - Invention is “advantageous in that it automatically restricts the size of the air inlet ... without having the operator manually insert or remove a replaceable ring”

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Toro cont'd

- White's restriction ring is separate from, and replaceable within, the cover
- D. Ct. – Summ'y judg't of no infringement [3rd]
- Fed. Cir. – Reviewed *de novo* on appeal
- Toro – “any disclosure was wholly unintentional”
- Fed. Cir. – Affirmed
 - “We hold, as a matter of law, that intent is not part of the *J&J* disclosure-dedication analysis.”

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Toro cont'd

- Toro
 - “Before a disclosure can trigger dedication, it must be good enough to support a claim under § 112, ¶ 1.”
- Fed. Cir.
 - “the level of disclosure needed to implicate the disclosure-dedication rule is different,” i.e., lower
 - “no genuine issue of material fact ... that the disclosure of a replaceable ring would have been apparent to one of ordinary skill in the art”

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Cancelling an Independent Claim



- Estoppel relies on narrowing amendments
- Original claims
 - 1. A method comprising the steps of X, Y, and Z.
 - 2. The process of claim 1 wherein the Z is δ .
- Amended claim
 - ~~1. A method comprising the steps of X, Y and Z.~~
 - 2. A method comprising the steps of X, Y, and Z, wherein the Z is δ .
- Has there been a narrowing amendment ?

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Ranbaxy Pharms v. Apotex, Inc., 350 F.3d 1235 (Fed Cir 2003)



- Apotex's originally filed claims ...
 - 1. Process of preparation of amorphous cefuroxime axetil which comprises the steps of ... dissolving the crystalline cefuroxime axetil in a highly polar organic solvent
 - 3. ... wherein the highly polar solvent is a sulfoxide.
 - 5. ... wherein the highly polar solvent is an amide.
 - 7. ... wherein the solvent is formic acid.
- Claim 1 rejected under §§ 103, 112

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Ranbaxy cont'd



- Apotex's amended claim 1
 - "Process of preparation of amorphous cefuroxime axetil which comprises the steps of ... [dissolving in] a volume of highly polar organic solvent ... wherein the highly polar organic solvent is selected from the group consisting of a sulfoxide, an amide and formic acid."
- Ranbaxy uses acetic acid
- Apotex – "it's equivalent"

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Ranbaxy cont'd



- D. Ct. – "there was a narrowing amendment"
 - No likelihood of success on the merits
- Apotex – "Claims 3, 5, and 7 are the same after amendment as before."
- Fed. Cir. – Affirmed
 - "the surrender is particularly clear"
 - "The additional language limited 'highly polar organic solvent' to a defined group of solvents"

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Honeywell Int'l v. Hamilton Sundstrand Corp., 370 F.3d 1131 (Fed Cir 2004) (in banc)



“Following our recent decisions in *Deering* and *Ranbaxy*, we hold that the rewriting of dependent claims into independent form coupled with the cancellation of the original independent claims creates a [*Festo*] presumption of prosecution history estoppel.” [11 to 1]

[Cert petition filed in Aug 2004; still pending, with RVSG]

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Festo Presumption Follow-Up



- “The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” 535 U.S. 722, 741 (2002).
- Equivalent was unforeseeable at the time of the amendment
- Rationale for the amendment bears no more than a tangential relation to the equivalent

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The Bupropion Cases



- Litigation over sustained-release versions
 - Patented form uses hydroxypropyl methylcellulose
 - Impax Labs uses hydroxypropyl cellulose
 - Excel Pharms uses polyvinyl alcohol
- *Glaxo v. Impax*, 356 F.3d 1348 (Fed Cir 2004)
 - Impax uses a foreseeable sustained-release agent
 - Presumption of p.h.e. cannot be rebutted
- *SmithKline v. Excel*, 356 F.3d 1357
 - Excel's use of PVA may not have been foreseeable
 - Case remanded for more fact-finding

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Bupropion cont'd



- In both cases, Glaxo argues that ...
 - Disclosure talked only about HPMC
 - Amendments literally covering HPC or PVA would cause "new matter" or "written description" rejection
 - Would not be reasonable to expect the amendments
- Fed. Cir.
 - "*Festo* neither excuses an applicant from failing to claim 'readily known equivalents' at the time of application nor allows a patentee to rebut the *Festo* presumption by invoking its own failure to include a known equivalent in its original disclosure."

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The Insituform Cases



- Fourth appeal decided in October 2004
 - Case first filed in 1990
- Processes for drawing curable resin into the felt layer of a pipe liner
- Prior art - “Everson patent”
 - Applies vacuum continuously at far end of the liner
- Insituform claims ...
 - As filed - applying a vacuum
 - As issued - moving one (and only one) vacuum cup down the tube as the resin advances

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Insituform cont'd



- Insituform overcomes rejection re Everson
 - “Everson’s method is ineffective when dealing with long lengths of tube because that method requires an exceedingly large suction compressor.”
- Inliner’s accused process
 - Multiple cups or tubes, removed sequentially
 - Continuous vacuum

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Insituform cont'd



- Prosecution history estoppel?
 - First appeal - 1996 - “No”
 - Second appeal - 1998 - “No” [*Warner-Jenkinson*]
 - Third appeal - 2001 - “Yes, *Festo* is a complete bar”
- 2004 appeal - No
 - Amendment’s rationale is tangential to the alleged equivalent
 - “no indication in the prosecution history of any relationship between the narrowing amendment and a multiple cup process”

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Eliminating a Claim Element



- Sometimes called ...
 - “vitiating a claim element,” or “All Limitations Rule”
- *Warner-Jenkinson*, 520 U.S. 17, 29 (1997)
 - “It is important to ensure that the application of the doctrine [of equivalents], even as to an individual [claim] element, is not allowed such broad play as to effectively eliminate that element in its entirety.”

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Novartis Pharms. v. Eon Labs, 363 F.3d 1306 (Fed Cir 2004)



- Claim recites a “hydrosol” form’n of cyclosporin
 - Limited to hydrosol made outside the body
- Eon sells cyclosporin dissolved in ethanol
 - Makes a hydrosol inside the patient’s stomach
- Fed. Cir. affirms summ’y judg’t of no D.o.E.
 - Permitting equivalent infringement “would necessarily read the ‘hydrosol’ limitation out of those claims”

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Searfoss v. Pioneer Consol., 374 F.3d 1142 (Fed Cir 2004)



- Claim recites a flexible cover for truck beds
 - Limited to direct connection between two key parts
- Pioneer’s truck bed cover lacks this direct connection - it’s an indirect connection, at best
- Fed. Cir. affirms summ’y judg’t of no D.o.E.
 - “to find as Searfoss argues, that the ‘indirect connection’ constitutes an equivalent of the direct connection ... would, in effect, completely vitiate the connection function”

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And three more ...



- Novartis Pharms. v. Abbott Labs., 375 F.3d 1328 (Fed Cir 2004)
- Asyst Techs., Inc. v. Emtrak, Inc., Nos. 04-1048, -1064 (Fed Cir Mar. 22, 2005)
- V-Formation, Inc. v. Bennetton Group SpA, No. 03-1408 (Fed Cir Mar. 15, 2005)

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In re Ruschig (1967) (Rich, J.)



“The life of a patent solicitor
has always been a hard one.”

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