Date of Download: Jul 1, 2001
IDEA (IDEA: The Journal of Law & Technology)
40 IDEA 123
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(Cite as: 40 IDEA: J.L. & Tech. 123)
IDEA: The Journal of Law and Technology
2000

*123 THE ROLE AND RESPONSIBILITY OF PATENT ATTORNEYS IN IMPROVING THE DOCTRINE OF EQUIVALENTS [FNa1]

The Honorable Paul R. Michel [FNaa1]

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Center; The Honorable Paul R. Michel

I. INTRODUCTION

I thank the Association for the honor of receiving this medal. Prior recipients constitute most impressive company -- prominent professors, high officials, leading legislators, and distinguished judges. That the medal is named after my hero, Jefferson, makes its award all the sweeter. But most of all, I am proud, 44 years later, to walk in the footsteps of my late colleague, Giles S. Rich, who died last Wednesday at 95. He was awarded the Jefferson Medal in 1955, one year before President Eisenhower appointed him to the Court of Customs and Patent Appeals and three years after he helped write the 1952 Patent Act, which is still in effect today.

I want to take this opportunity to discuss the role of patent lawyers, you, in improving the doctrine of equivalents.

The doctrine of equivalents essentially holds that something different from that which a patent claims can infringe, so long as the differences between the claimed and unclaimed subject matter are minor. It sounds so simple. But in practice, it has proven to be the most difficult and least predictable of all doctrines in patent law to apply. Even judges cannot agree on its contours. Imagine the dilemma for lawyers! Pity lay jurors!

*124 The doctrine is so daunting that after enunciating it in 1950, [FN1] the Supreme Court declined to address the doctrine again until 1997, [FN2] nearly half a century later. Our court, the Court of Appeals for the Federal Circuit, did not address the doctrine en banc until 1996, well into our second decade. Still, these decisions, so long in coming, left unanswered as many questions as they answered. Therefore, in the 1997 Warner-Jenkinson Co. v. Hilton Davis Chemical Co. [FN3] decision, the U.S. Supreme Court invited the Federal Circuit to restate the law of equivalence. [FN4]

In several subsequent decisions, we have tried to clarify the doctrine, but it has been challenging. In my view, the results to date have done little to increase "outcome predictability." That is, if a dispute were litigated to conclusion through appeal, would the outcome of the dispute match the prediction of success made at the start of litigation? Predictability is key -- because with courts overburdened, patent lawyers will have to settle most patent disputes. But litigation avoidance and case settlement, as well as reliable opinion letters to clients, require that an outcome be accurately predictable most of the time for a given set of facts. Today, as far as

equivalent infringement goes, patent lawyers cannot with certainty predict dispute outcomes under the doctrine of equivalents.

Judges also encounter a maze of precedent and case law when deciding issues of equivalence. An esteemed colleague and fellow Jefferson Medal recipient, Judge Alan Lourie (whose views, I am now quite sure, must be entitled to great weight), grew so frustrated with the ambiguity of the doctrine that he suggested legislative abrogation.

For myself, I'd rather fix the doctrine than end it. But judges cannot do so alone. We need help from you -- skilled patent lawyers. The question is how you can help clarify the doctrine of equivalents.

In the succeeding sections, I will illuminate three aspects of the doctrine of equivalents. The first section discusses five legal bars that prevent application of the doctrine by the court as a matter of law, on motion. The next section briefly explores what it may mean, in the Supreme Court's words to "effectively eliminate" or "vitiate" a claim limitation. [FN5] In the third section, I suggest three specific theories that litigators could develop to help courts fashion better tests for determining *125 equivalency and to benefit clients as well. Better tests are needed -- for lay jurors who must determine factual equivalency, judges who must instruct jurors, and lawyers who must advise clients.

II. FIVE LEGAL BARS TO THE DOCTRINE OF EQUIVALENTS

The all-limitations rule of Pennwalt Corp. v. Durand-Wayland, Inc. [FN6] is the first, and perhaps greatest, legal bar. Also referred to as ""legal equivalency," this rule holds that no equivalent infringement exists as a matter of law, if the allegedly infringing article lacks any claim limitation. Ordinarily, the issue of "factual equivalency" should be sent to the jury only after "legal equivalency" has first been established.

Essentially, once all the claim limitations of a claim have been construed, the court investigates whether a counterpart for each and every limitation can be identified in the accused device or process and applies the Pennwalt bar when appropriate. Thus, the inquiry takes one step beyond claim construction to check the "correspondence of these elements or limitations with the components or steps of the accused device or process," as stated in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. [FN7] Festo, decided in 1999, extended Pennwalt, which was decided in 1987.

The second well-settled bar to applying equivalence is obviousness. Fourteen years ago in Loctite Corp. v. Ultraseal Ltd., [FN8] the Federal Circuit held that the doctrine of equivalents does not extend to an infringing device found in the prior art. Five years later, in Wilson Sporting Goods Co. v. David Geoffrey & Associates (a.k.a. Dunlop Sports Co.), [FN9] the court explained that the doctrine of equivalents "exists to prevent a fraud on a patent, not to give a patentee something which he could not lawfully have obtained from the PTO had he tried." [FN10] As the Federal Circuit stated this year in Streamfeeder v. Sure-Feed Systems, Inc., [FN11] this bar applies not only to prior art devices, but also to those that "would have been obvious to one of ordinary skill in the art" at the time *126 of invention. [FN12] Thus, an accused device or process cannot infringe under the doctrine of equivalents if it is merely an obvious variation of prior art inventions.

The third legal bar is prosecution history, or file wrapper, estoppel. In 1997, the Supreme Court addressed this bar in Warner-Jenkinson. Prosecution history estoppel prevents subject matter surrendered when applying for a patent from being reclaimed later under the doctrine of equivalents. Significantly, the Court emphasized that the doctrine of equivalents must give "proper deference to the role of claims in defining an invention and

providing public notice ....'' [FN13] Public notice implicitly leads to and proxies for predictability.

The rule of "dedication" serves as the fourth bar to equivalence. In Maxwell v. J. Baker, Inc., [FN14] the Federal Circuit held that where a patent application discloses unclaimed subject matter, that subject matter must be deemed to have been dedicated to the public. [FN15] Therefore the doctrine of equivalents can not apply to such subject matter.

The fifth legal bar to the doctrine of equivalents concerns the special form of claims allowed by 35 U.S.C. ¤ 112, ¦ 6, known as "means-plus-function" claims. [FN16] In Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., [FN17] the Federal Circuit expressed that such claims limit equivalence to later-developed technologies (those "developed after the patent is granted"). [FN18] This year, in Al-Site Corp. v. VSI International, Inc., [FN19] the Federal Circuit further stated that "[i]n other words, an equivalent structure or act under ¤ 112 for literal infringement must have been available at the time of patent issuance, while an equivalent under the doctrine of equivalents may arise after patent issuance and before the time of infringement." [FN20]

Individually and collectively, all five bars are matters of law, solely for the court to decide. If any or all of the bars are raised on motion, the court must rule on them before the jury can examine factual equivalency.

*127 Lawyers often overlook these potential bars. This seems strange because raising these issues may lead to summary judgment -- often for the defense, but also for the patentee. Parties could avoid much of the expense and delay, as well as risk and uncertainty, of litigation. More importantly, underuse of the legal bars by attorneys also means underdevelopment of the law by courts.

III. INTERPRETING "EFFECTIVELY ELIMINATE" AND "VITIATE''

Judges face challenges in determining when the primary bar -- the "all-limitations rule" -- arises. The problem is matching language and meaning. Exactly what did the Supreme Court mean when it said that equivalence may not ""vitiate" or "effectively eliminate" a claim limitation? [FN21] Black's Law Dictionary defines vitiate as to "destroy or annul, either entirely or in part, the legal efficacy and binding force of an act or instrument." [FN22] General dictionaries assert vitiate to mean "to make ineffective" [FN23] or "to make legally defective or invalid." [FN24] The Federal Circuit has struggled for a more precise definition. In Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc., [FN25] Judge Lourie noted in his dissent that an improper equivalence argument would "completely eradicate the [claim] limitation" in question. [FN26] In Wright Medical Technology, Inc. v. Osteonics Corp., [FN27] the Federal Circuit worried whether Wright's theory of equivalence would not "entirely vitiate" a limitation. [FN28] Perhaps tension exists between the Supreme Court's "effectively eliminate" or "vitiate" and our "completely eradicate" or "entirely vitiate." Uncertainty abounds. The court needs the help of patent attorneys here, too.

*128 IV. SUGGESTIONS FOR DOCTRINE INTERPRETATION AND CLARIFICATION

Finally, what instruction or advice can courts give to lay juries when determining whether equivalence occurs between an element in the accused device and a claim limitation? Nearly fifty years ago in Graver Tank & Manufacturing Co. v. Linde Air Products Co., [FN29] the Supreme Court asked whether the accused product has substantially the same "function/way/result." [FN30] Later, the Federal Circuit suggested an alternative formulation that reduced this test from three to two words. [FN31] Consequently, outcome predictability probably also fell by one-third. The Federal Circuit asked: "Was there only an insubstantial change?" [FN32] In my view, the Graver Tank

and Warner-Jenkinson opinions were clearer when they emphasized "known interchangeability" of the substituted structure. But known interchangeability is just one factor. Yet multi-factor, case-by-case analysis cannot increase predictability. A true test could. Debate continues to rage over fashioning a better test. Indeed, the Warner-Jenkinson Court commented on the limitations of its "function/way/result" criterion and the Federal Court's "insubstantial change" test, and expressly invited the Federal Circuit to find a better formulation. [FN33]

I suggest that rather than allowing the court to conjure up new phrases, you, patent lawyers, need to help us clarify the doctrine of equivalents based on the realities of actual cases. Three possible new theories are already emerging from our case law: (1) obviousness; (2) known interchangeability; and (3) evidentiary requirements.

In support of the first theory, an obviousness analysis, the late Helen Nies, another Jefferson medalist and the former Chief Judge of the Federal Circuit Court of Appeals, suggested this alternative in her *129 concurring opinion in Roton Barrier, Inc. v. Stanley Works. [FN34] However, litigators ignored her "trial balloon" obviousness theory. This is unfortunate, because the obviousness concept has lain at the heart of patent law since enactment of the 1952 Act. It has served us well and provided a specific, objective and fairly predictable test. Surely it has greater predictive potential than ""function/way/result" or "insubstantial change," for it refers not to abstractions, but to prior patents which can be consulted.

Logically, then, a new obviousness test for determining equivalent infringement could be formulated along the following lines: Unless the substitution would have been obvious to the ordinary artisan at the time of infringement, then it is outside the legally allowable range of equivalents, even if technologically it is equivalent.

I confess that when Judge Nies initially suggested obviousness as the test for equivalence, I resisted. Now I am more enthused. But no one judge or lawyer knows all. No one idea is enough. Many are needed, and they must all be ground through the mill of litigation.

Second, the notion of "known interchangeability" could be developed from a mere factor in a list of criteria to a true test.

Third, other approaches exist that depend less heavily on definitions. In Lear Siegler, Inc. v. Sealy Mattress Co. of Michigan, Inc., [FN35] and Malta v. Schulmerich Carillons, Inc., [FN36] for example, the late Judge Rich and I insisted that to survive legal motions, evidence given to juries must expressly link the function/way/result of each claim limitation with any substituted element. This approach may be developed further.

In conclusion, however, my goal is not to tell you what we as judges can suggest, but to encourage what you as practitioners can and should do to improve legal doctrine. The court can only review new tests as you innovate and litigate them through trial.

Every litigator can contribute.

Certainly, the Federal Circuit Court of Appeals has a special responsibility to clarify and rationalize the law of equivalence. Judges and attorneys share this responsibility. But the first move is yours.

[FNa1]. Originally presented by Judge Michel at a ceremony honoring him as the 1999 Jefferson Medal recipient, at the New Jersey Intellectual Property Law Association's Forty-Ninth Annual Jefferson Medal Dinner on June 11, 1999.

[FNaa1]. Judge Michel was appointed to the Court of Appeals for the Federal Circuit in 1988 by President Reagan, following twenty-two years of government service. Now one of the senior-most judges in active service on the court, he has written over 200 opinions spanning all areas of the court's jurisdiction.

Judge Michel has authored several articles and co-authored a book, entitled, Patent Litigation and Strategy, which was published by the West Publishing Company in 1999.

[FN1]. See Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 85 U.S.P.Q. (BNA) 328 (1950).

[FN2]. See Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 41 U.S.P.Q.2d (BNA) 1865 (1997).

[FN3]. Id.

[FN4]. See id. at 39 n.8, 41 U.S.P.Q.2d at 1876 n.8.

[FN5]. Id. at 29, 41 U.S.P.Q.2d at 1871.

[FN6]. 833 F.2d 931, 4 U.S.P.Q.2d (BNA) 1737 (Fed. Cir. 1987).

[FN7]. 172 F.3d 1361, 1370, 50 U.S.P.Q.2d (BNA) 1385, 1390 (Fed. Cir. 1999), reh'g en banc granted, j. vacated 187 F.3d 1381, 51 U.S.P.Q.2d (BNA) 1959 (Fed. Cir. 1999).

[FN8]. 781 F.2d 861, 228 U.S.P.Q. (BNA) 90 (Fed. Cir. 1985).

[FN9]. 904 F.2d 677, 14 U.S.P.Q.2d (BNA) 1942 (Fed. Cir. 1990).

[FN10]. Id. at 684, 14 U.S.P.Q.2d at 1948.

[FN11]. 175 F.3d 974, 50 U.S.P.Q.2d 1515 (Fed. Cir. 1999).

[FN12]. Id. at 982, 50 U.S.P.Q.2d at 1520.

[FN13]. Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 33, 41 U.S.P.Q.2d (BNA) 1865, 1873 (1997) (emphasis added).

[FN14]. 86 F.3d. 1098, 39 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 1996).

[FN15]. See id.

[FN16]. 35 U.S.C. ¤ 112, ¦ 6 (1994).

[FN17]. 145 F.3d 1303, 46 U.S.P.Q.2d (BNA) 1752 (Fed. Cir. 1998).

[FN18]. Id. at 1310-11, 46 U.S.P.Q.2d at 1758.

[FN19]. 174 F.3d 1308, 50 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 1999).

[FN20]. Id. at 1320, 50 U.S.P.Q.2d at 1168 (emphasis added).

[FN21]. Warner-Jenkinson, 520 U.S. at 29, 41 U.S.P.Q.2d at 1871.

[FN22]. BLACK'S LAW DICTIONARY 1572 (6th ed. 1990).

[FN23]. WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 2559 (1993).

[FN24]. THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE 2127 (2d ed. 1987).

[FN25]. 183 F.3d 1347, 51 U.S.P.Q.2d (BNA) 1415 (Fed. Cir. 1999).

[FN26]. Id. at 1359, 51 U.S.P.Q.2d at 1423 (Lourie, J., dissenting).

[FN27]. 122 F.3d 1440, 43 U.S.P.Q.2d (BNA) 1837 (Fed. Cir. 1997).

[FN28]. Id. at 1445, 43 U.S.P.Q.2d at 1842 (citing Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 39 n.8, 41 U.S.P.Q.2d (BNA) 1865, 1876 n.8 (1997).

[FN29]. 339 U.S. 605, 85 U.S.P.Q. (BNA) 328 (1950).

[FN30]. Id. at 608, 85 U.S.P.Q. at 330.

[FN31]. See Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 935, 4 U.S.P.Q.2d (BNA) 1737, 1739 (Fed. Cir. 1987) (en banc) ("[I]n order for a court to find infringement, the plaintiff must show the presence of every element or its substantial equivalent in the accused device.).

[FN32]. See Valmont Indus., Inc. v. Reinke Mrg. Co., 983 F.2d 1039, 1043 n.1, 25 U.S.P.Q.2d (BNA) 1451, 1454 n.1 (Fed. Cir. 1993) ("[T]he doctrine 'is designed to do equity ... it is not designed ... to permit a claim expansion that would encompass more than an insubstantial change."D¢=EQP:0034¢=' (quoting Pennwalt, 833 F.2d at 935, 4 U.S.P.Q.2d at 1739)).

[FN33]. See Warner-Jenkinson, 520 U.S. at 24, 41 U.S.P.Q.2d at 1868.

[FN34]. See Roton Barrier, Inc. v. Stanley Works, 79 F.3d 1112, 1128, 37 U.S.P.Q.2d (BNA) 1816, 1828 (Fed. Cir. 1996) (Nies, J., concurring).

[FN35]. 873 F.2d 1422, 10 U.S.P.Q.2d (BNA) 1767 (Fed. Cir. 1989).

[FN36]. 952 F.2d 1320, 21 U.S.P.Q.2d (BNA) 116 (Fed. Cir. 1991).
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