

KEY IDEAS:

The Doctrine of Equivalents and Ensnarement1

Wilson Sporting Goods Decision2

Wilson Hypothetical Claim Procedure ...2

Five-Step Hypothetical Claim Methodology2

Four Rules to Keep in Mind4

Practical Considerations4

**NOOSE OR LOOSE?
MIND THE ENSNAREMENT TRAP DOOR**

Just how tight is the noose around that patent infringer? For accused infringers, “ensnarement” provides a ready means of escaping the doctrine-of-equivalents noose. But patent owners need to firmly close the ensnarement trap door to preserve a claim of infringement by equivalents and keep the infringer at “the end of his rope.”

The Doctrine of Equivalents and Ensnarement

The Doctrine of Equivalents (DOE) says infringement can be found when the accused device contains an “insubstantial” change from the claimed invention.¹ Equivalency may be based on the “insubstantial differences” test or the “triple identity” test—whether the equivalent element of the accused device “performs substantially the same function in substantially the same way to obtain the same result.”²

Infringement under the DOE exists only if “every limitation set forth in a claim [is] found in an accused product or process exactly or by a substantial equivalent.”³ In other words, the “all elements rule” is applicable to DOE infringement just as it is in literal infringement cases.⁴ Thus, a DOE analysis must be applied to individual claims limitations, not to the invention as a whole.⁵

Periodically, courts have expressed “concern . . . that the doctrine of equivalents . . . has taken on a life of its own, unbounded by the patent claims.”⁶ In response to such concerns, the Federal Circuit developed legal limitations on the DOE’s application, including a prohibition on equivalents that *ensnare* the prior art.⁷ While it is “unequivocally clear” that there is no “practicing the prior art defense” to literal infringement,⁸ the ensnarement defense to DOE claims turns the tables on that notion—a patentee simply *cannot* assert a range of equivalents that encompasses the prior art.⁹

Prepared by:



PETER STRAND
Washington, D.C.
(202) 783-8400
pstrand@shb.com

Peter is a partner in the Firm’s Intellectual Property & Technology Litigation Practice. He holds an LLM in intellectual property law from the University of Houston School of Law.

1 *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 610 (1950); *Tip Sys., LLC v. Phillips & Brooks/Gladwyn, Inc.*, 529 F.3d 1364, 1376 (Fed. Cir. 2008).

2 *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 38-40 (1997); *Graver Tank & Mfg. Co.*, 339 U.S. at 608; *Tip Sys., LLC*, 529 F.3d at 1376.

3 *Jurgens v. McKasy*, 927 F.2d 1552, 1560 (Fed. Cir.), *cert. denied*, 502 U.S. 902 (1991); *Tip Sys., LLC*, 529 F.3d at 1379.

4 *Tip Sys., LLC*, 529 F.3d at 1377.

5 *Warner-Jenkinson Co.*, 520 U.S. at 40; *Eagle Comtronics, Inc. v. Arrow Commc’n Labs., Inc.*, 305 F.3d 1303, 1315 (Fed. Cir. 2002).

6 *Warner-Jenkinson Co.*, 520 U.S. at 28-29; *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1366 (Fed. Cir. 1999).

7 *K-2 Corp.*, 191 F.3d at 1366 -67 (emphasis added).

8 *Tate Access Floors, Inc. v. Interface Arch. Resources, Inc.*, 279 F.3d 1357, 1365 (Fed. Cir. 2002) (citing *Baxter Healthcare Corp. v. Spectramed, Inc.* 49 F.3d 1575, 1583 (Fed. Cir. 1995)). Questions of obviousness in light of the prior art relate to the validity of the claims, not to infringement. *Tate Access Floors, Inc.*, 279 F.3d at 1366.

9 *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1322 (Fed. Cir. 2009); *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1380 (Fed. Cir.), *cert. denied*, 537 U.S. 825 (2002); *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677 (Fed. Cir.), *cert denied*, 489 U.S. 992 (1990), *overruled in part on other grounds*, *Cardinal Chem. Co. v. Morton Int’l, Inc.*, 508 U.S. 83, 92 n.12

“If the doctrine of equivalents does not involve expanding the claims, why should the prior art be a limitation on the range of permissible equivalents?”

... 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 the patent, . . . not to give a patentee something which he could not lawfully have obtained from the PTO had he tried.

Wilson Sporting Goods Decision

In *Wilson Sporting Goods Co.*, the Federal Circuit confirmed its stand against ensnarement and added an ingenious analytical framework for identifying the extent to which prior art restricts DOE equivalents.¹⁰

Writing for the majority, Judge Giles Sutherland Rich analyzed the accused infringer’s ensnarement claim. He began by observing, “to say that the doctrine of equivalents extends or enlarges *the claims* is a contradiction in terms. The claims—i.e., the scope of patent protection *as defined by the claims*—remain the same and application of the doctrine *expands the right to exclude* to “equivalents” of what is claimed.”¹¹ Judge Rich then posed a question: “If the doctrine of equivalents does not involve expanding the claims, why should the *prior art* be a limitation on the range of permissible equivalents?”¹²

Answering his own question, Judge Rich stated:

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 the patent, . . . *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.¹³

Wilson Hypothetical Claim Procedure

Against, this backdrop, Judge Rich noted, “Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer.”¹⁴ To simplify the analysis, he suggested conceptualizing a hypothetical patent claim broad enough in scope to *literally* cover the accused product.¹⁵

While use of a hypothetical claim to determine the extent to which the prior art restricts the scope of equivalents is not mandatory,¹⁶ the method has been described as both “useful,”¹⁷ and “practical.”¹⁸

Five-Step Hypothetical Claim Methodology

The hypothetical claim methodology described in *Wilson* involves five important steps:

- 1. Plaintiff alleges infringement under the DOE.** Ensnarement is available only in a case involving claims of infringement under the DOE. Thus, the hypothetical claim methodology is used *only* after a patent owner makes a case of infringement by equivalents.¹⁹
- 2. Accused infringer alleges claimed equivalents ensnare prior art.** Once the patent owner makes its DOE case, the burden is on the accused infringer to produce evidence that the claimed equivalents read on the prior art.²⁰

(1993) (internal citations omitted).

¹⁰ *Wilson Sporting Goods Co.*, 904 F.2d at 684; *Conroy v. Reebok Int’l, Ltd.*, 14 F.3d 1570, 1576 (Fed. Cir. 1994).

¹¹ *Wilson Sporting Goods Co.*, 904 F.2d at 684; *Streamfeeder, LLC v. Sure-Feed Sys., Inc.*, 175 F.3d 974, 981 n.1 (Fed. Cir. 1999).

¹² *Wilson Sporting Goods Co.*, 904 F.2d at 684.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ *Id.*; *Streamfeeder, LLC*, 175 F.3d at 981-82; *Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co.*, 204 F.3d 1360, 1364 (Fed. Cir. 2000).

¹⁶ *Conroy v. Reebok Int’l, Ltd.*, 14 F.3d 1570, 1576, 1577 (Fed. Cir. 1994); see *Nat’l Presto Indus., Inc. v. West Bend Co.*, 76 F.3d 1185, 1192 (Fed. Cir. 1996).

¹⁷ *Conroy*, 14 F.3d at 1576.

¹⁸ *Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co.*, 204 F.3d 1360, 1364 (Fed. Cir. 2000).

¹⁹ *Id.* at 1365; *Streamfeeder, LLC*, 175 F.3d at 982-83.

²⁰ *Id.*

Attempts to “freely redraft” the claim will result in a claim that does not pass muster.

Once the hypothetical claim is prepared and necessary evidence is obtained, “The pertinent question becomes whether that hypothetical claim could have been allowed by the PTO over the prior art.”

If the PTO could have allowed the hypothetical claim in view of the prior art, then the prior art is not ensnared and does not preclude the application of the DOE, and thus, infringement may be found. On the other hand, if the hypothetical claim would have been anticipated or obvious in light of the prior art, the prior art is ensnared and the accused device is not infringing as a matter of law.

3. Plaintiff prepares hypothetical claim. Once the issue of ensnarement is properly raised, the patent owner must construct a hypothetical claim that literally infringes the accused device.²¹ Preparation of the hypothetical claim, however, is not “an opportunity to freely redraft granted claims.”²² Simply put,

While use of a hypothetical claim may permit a minor extension of a claim to cover subject matter that is substantially equivalent to that literally claimed, one cannot, in the course of litigation and outside of the PTO, cut and trim, expanding here, and narrowing there, to arrive at a claim that encompasses an accused device, but avoids the prior art. Slight broadening is permitted at that point, but not narrowing.²³

Attempts to “freely redraft” the claim will result in a claim that does not pass muster.²⁴

4. The court may take evidence on ensnarement. In the ensnarement context, a court may hear expert testimony and consider other extrinsic evidence regarding “(1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations.”²⁵

Moreover, the district court may use an advisory verdict regarding the ensnarement issue if it would be helpful and not unduly confuse the jury.²⁶

5. The court analyzes hypothetical claim in light of relevant prior art. Once the hypothetical claim is prepared and necessary evidence is obtained, “The pertinent question becomes whether that hypothetical claim could have been allowed by the PTO over the prior art.”²⁷ The specific question is whether the patentee has proved that a hypothetical claim, similar to the claim in suit but broad enough to literally cover the accused product, could have been patentable.²⁸

The hypothetical claim allows the court to use traditional rules of patentability and permits a more precise analysis than determining whether an accused product (which has no claim limitations to analyze) would have been patentable in view of the prior art.²⁹

If the PTO could have allowed the hypothetical claim in view of the prior art, then the prior art is not ensnared and does not preclude the application of the DOE, and thus, infringement may be found.³⁰

On the other hand, if the hypothetical claim would have been anticipated or obvious in light of the prior art, the prior art is ensnared and the accused device is not infringing as a matter of law.³¹

In addition to patentability issues based on anticipation (35 U.S.C. §102) or obviousness (35 U.S.C. §103), proof of invalidating prior public use is just as damaging to the patentability of the proposed hypothetical claim as any other type of prior art.³²

In completing its analysis, the court must apply patentability standards consistent with Federal

21 *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1324 (Fed. Cir. 2009); *Ultra-Tex Surfaces, Inc.*, 204 F.3d at 1364; *Streamfeeder, LLC*, 175 F.3d at 981; *Wilson Sporting Goods Co.*, 904 F.2d at 684.

22 *Streamfeeder, LLC*, 175 F.3d at 983.

23 *Id.*; see *Ultra-Tex Surfaces, Inc.*, 204 F.3d at 1365, 1366.

24 *Id.*

25 *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1324 (Fed. Cir. 2009) (drawing analogy to issues in prosecution history estoppel).

26 *Id.*

27 *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677, 684 (Fed. Cir. 1990).

28 *Id.* at 685.

29 *Id.* at 684.

30 *Streamfeeder, LLC v. Sure-Feed Sys., Inc.*, 175 F.3d 974, 982 (Fed. Cir. 1999); *Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co.*, 204 F.3d 1360, 1364-65 (Fed. Cir. 2000).

31 *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1380 (Fed. Cir. 2002); *Streamfeeder, LLC*, 175 F.3d at 982; see *Abbott Labs. v. Dey, L.P.*, 287 F.3d 1097, 1105-06 (Fed. Cir. 2002); *Wilson Sporting Goods Co.*, 904 F.2d at 685.

32 *Ultra-Tex Surfaces, Inc.*, 204 F.3d at 1366.



ENHANCING YOUR IP IQ

Vol. III, No.8

AUGUST 2011

ABOUT SHB

Shook, Hardy & Bacon offers expert, efficient and innovative representation to our clients. We know that the successful resolution of intellectual property issues requires a comprehensive strategy developed in partnership with our clients.



OFFICE LOCATIONS

Geneva, Switzerland
+41-22-787-2000

Houston, Texas
+1-713-227-8008

Irvine, California
+1-949-475-1500

Kansas City, Missouri
+1-816-474-6550

London, England
+44-207-332-4500

Miami, Florida
+1-305-358-5171

San Francisco, California
+1-415-544-1900

Tampa, Florida
+1-813-202-7100

Washington, D.C.
+1-202-783-8400

Circuit law.³³ Generally applicable rules for determining obviousness and anticipation must be observed.

Four Rules to Keep in Mind

When applying the hypothetical claim methodology, four key rules must be kept in mind:

1. Dependent claims must be analyzed separately. Normally, dependent claims cannot be infringed unless the claims from which they depend are infringed.³⁴ But, although it seems counterintuitive, this rule does not apply in the context of ensnarement. Because the dependent claims are necessarily narrower than the independent claim, it does not automatically follow that ranges of equivalents for narrower dependent claims would encompass the same prior art as the broader independent claim.³⁵ Thus, the court will analyze hypothetical claims based on each of the dependent claims in issue.³⁶

2. The accused infringer has the burden of going forward. “When the patentee has made a *prima facie* case of infringement under the doctrine of equivalents, the burden of coming forward with evidence to show the accused device is in the prior art is upon the accused infringer, . . .”³⁷ The burden of going forward is met by “providing prior art which, by disclosing all of the limitations of the hypothetical claim, would have rendered it unpatentable.”³⁸

3. The patent owner has the burden of persuasion. After the accused infringer satisfies its burden of going forward, the burden of persuasion rests on the patentee to show that the hypothetical claim does not cover prior art.³⁹ Simply put, “[T]he burden of proving patentability of the hypothetical claim rests with the patentee,”⁴⁰ because the patent owner has always borne the burden of proving infringement.⁴¹

Patent owners who merely argue that the accused infringer failed to meet its burden of going forward risk an adverse ruling—that the prior art is ensnared.⁴²

4. Ultimately, hypothetical claim analysis is an issue of law. Whether an asserted scope of equivalents ensnares the prior art is ultimately a question of law for the court, not the jury, to decide.⁴³ The issue can be resolved either on a pretrial motion for summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict.⁴⁴

Practical Considerations

Both patent owners and accused DOE infringers must be aware of—and sagely use—the rule against ensnarement.

Patent owners should tailor equivalents (both before and after a claim of ensnarement) with an eye toward avoiding any prior art and getting their case to a jury.

Infringers, on the other hand, would want to marshal invalidating prior art, timely raise an ensnarement defense and seek opportunities to derail a DOE claim as a matter of law.

33 *Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1576, 1577 (Fed. Cir. 1994); see *Abbott Labs.*, 287 F.3d at 1105-06.

34 See, e.g., *Wilson Sporting Goods Co.*, 904 F.2d at 685.

35 *Id.* at 686; *Streamfeeder, LLC*, 175 F.3d at 984-85.

36 See *id.*

37 *Nat'l Presto Indus., Inc. v. West Bend Co.*, 76 F.3d 1185, 1192 (Fed. Cir. 1996); *Ultra-Tex Surfaces, Inc.*, 204 F.3d at 1365; *Streamfeeder, LLC*, 175 F.3d at 983, 984.

38 *Streamfeeder, LLC*, 175 F.3d at 984.

39 *Id.* at 983, 984; *Wilson Sporting Goods Co.*, 904 F.2d at 685.

40 *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1380 (Fed. Cir. 2002).

41 *Streamfeeder, LLC*, 175 F.3d at 983 (citing *Wilson Sporting Goods Co.*, 904 F.2d at 685).

42 *Ultra-Tex Surfaces, Inc.*, 204 F.3d at 1367; *Streamfeeder, LLC*, 175 F.3d at 984.

43 *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1324 (Fed. Cir. 2009).

44 *Id.* at 1324.