Keywords: Doctrine of equivalents; prosecution history estoppel; foreseeability

General: The doctrine of equivalents cannot operate to extend claim scope to an extension of a range relinquished during prosecution where the relinquished portion of the range was foreseeable to the patentee.

Talbert Fuel Systems Patents Co. v. Unocal Corp.
68 U.S.P.Q.2d 1691 (Fed. Cir. 2003)
Decided October 28, 2003

I. Facts

This case is on remand from the Supreme Court, which vacated a district court's summary judgment holding of non-infringement that had been affirmed by the Federal Circuit.

Talbert holds a patent to hydrocarbon fuel systems (the '356 patent). The claim at issue relates to a liquid gasoline comprising a priming agent and a hydrocarbon mixture (consisting essentially of $C_6 - C_{10}$). The claim further recites that the gasoline has a boiling point range of 121ºF-345 ºF at 1 atmosphere. The latter limitation was added during prosecution to avoid prior art that disclosed a fuel having a boiling point range of 390ºF-420ºF.

Unocal and other defendants were sued for infringement based on fuels they offered having a boiling point range of 373.8ºF to 472.9ºF. The district court held that the amendment to the claim had created prosecution history estoppel effectively limiting Talbert's claim scope to the range recited, and awarded summary judgment of non-infringement to the defendants. The Federal Circuit affirmed.

The Supreme Court, on writ from Talbert, reversed and remanded the decision based upon its decision in *Festo*. That decision was not available when the district court passed its ruling. Talbert essentially argued that evidence of unforeseeability, permitted by *Festo* to secure a broader interpretation under the doctrine of equivalents, was irrelevant prior to *Festo*, and so was not presented. Talbert sought here to obtain a remand to the district court to put on such evidence.

II. Issues

Should Talbert's claim be interpreted to cover a portion of a boiling point range between that literally recited in the claim and a range disclosed in the prior art?

III. Discussion

No. The court's decision on this issue actually turned on prosecution history estoppel and foreseeability that the relinquished portion of the boiling point range should have fallen within the scope of the claim.

On the issue of prosecution history estoppel, the court looked to the fact that the range had actually been added to the claim for the express purpose of overcoming the prior art. The temperature limits were placed in the claim at the insistence of the examiner. While the specification acknowledged that small amounts of other hydrocarbons could raise the boiling

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point of the fuel, the claim was nevertheless amended to recite the range exhibited by the "preferred" intermediate range of hydrocarbons.

Moreover, Talbert had argued the very point in response to the examiner, stating that

> There is no disclosure in [the prior art reference] which suggests the removal of lighter and heavier hydrocarbons from a gasoline type fuel to produce a fuel consisting essentially of hydrocarbons in the range of $C_5 - C_{10}$ having a boiling range set forth in the claims. In fact, [the prior art reference] teaches away from such a fuel by providing a fraction having a boiling range up to 390ºF (column 1, lines 42-43). This fraction is not the same as, nor equivalent to, that which is subject of applicant's composition claims.

The court then turned to the issue unforeseeability. First, the court held that Talbert was presumed to have surrendered the extension of the boiling range above 345ºF. However, citing *Festo*, the court observed that Talbert could rebut the presumption under condition that "the patentee must show that at the time of the amendment one skilled in the art could not have reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent."

Three criteria were available for such rebuttal: (1) that the equivalent was unforeseeable at the time of the application; (2) that the rationale underlying the amendment bore only a tangential relation to the equivalent; or (3) that the was some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.

The court held that when the prior art embraces the alleged equivalent and a narrowing amendment was made to avoid it, the subject matter simply cannot be found to have been unforeseeable. As for the "tangentialness" of the amendment, this too was unavailable to Talbert, as the boiling point was actually at issue during prosecution. Finally, Talbert had proffered no other reason for the amendment or for avoiding estoppel.

Accordingly, the court reaffirmed the district court's holding, and denied Talbert the opportunity to put on further evidence.

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