
In the course of prosecution, O2 Micro amended the claims of the '615 patent to distinguish over prior art, introducing a limitation relating to the feedback control loop. By way of example, amended claim 1 recites that the feedback control loop would control the second pair of switches "only if said feedback signal is above a predetermined threshold" (the "only if" limitation). O2 Micro provided little explanation for the amendment. Following the amendment, the Examiner issued a notice of allowance.

BiTEK manufactures inverter controllers, which the other defendants incorporate into inverter modules that they sell. The inverter controllers employ feedback loops, but are capable of shutting off the feedback signal's control over power when a feedback signal falls below a predetermined threshold. At certain times, such as during startup, the feedback signal still controls power delivered to the load despite being beneath the threshold. As such, BiTEK argued that its inverter controllers do not violate the claims, as the feedback loop employed by the controllers does not control the switches *only if* the feedback loop is above the predetermined threshold, as claimed.

In a *Markman* hearing, BiTEK and the other defendants argued that the term "only if" should be construed to mean "exclusively or solely in the event that" or "never except when." O2 Micro argued that the term "only if" needed no construction, as the term consists only of "two simple, plain English words." In its *Markman* order, the district court ruled that no construction of "only if" was needed, stating that the term "has a well-understood definition, capable of application by both the jury and this court in considering the evidence submitted in support of an infringement or invalidity case." *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, No. 2:04-CV-32 (E.D. Tex. Aug. 26, 2005).

BiTEK argued in pretrial proceedings that prosecution history estoppel barred O2 Micro from alleging infringement under the doctrine of equivalents. After initially granting a motion in limine for the above, the district court changed course after considering a supplemental briefing from O2 Micro. The district court stated only that "the amendment bears only a tangential relationship to the equivalent at issue." *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, No. 2:04-CV-32 (E.D. Tex. May 8, 2006).

At trial, O2 Micro presented expert testimony that the "only if" limitation applies only to "normal operation" and that the limitation "has nothing to do with startup." O2 Micro even brought the inventor of the asserted patents to testify before the jury regarding the meaning of the "only if" limitation. BiTEK and the other defendants argued to the jury that the term "only if" did not allow for the exceptions argued for by O2 Micro.

The jury found that BiTEK and the other defendants had willfully infringed, that BiTEK had induced infringement, and that one of the other defendants had contributorily infringed each asserted claim in each patent. The district court accordingly issued a final judgment and a permanent injunction. BiTEK and the other defendants appealed the ruling to the Federal Circuit.

II. Issues

- A. Must a district court construe a claim term having a common meaning, when the parties raise an actual dispute as to the claim term regarding the proper scope of the claim?
- B. Is a rationale for a narrowing amendment “tangential” to an alleged equivalent, such that the doctrine of equivalents may apply, when an objectively apparent reason to the contrary is clearly indicated by claim language and the prosecution history offers no other reason?

III. Discussion

- A. Yes. Under *Markman v. Westview Instruments, Inc.*, when the parties raise an actual dispute regarding the proper scope of patent claims asserted to be infringement, the court, not the jury, must resolve the dispute. 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff’d* 517 U.S. 370 (1996). A claim term is generally given its ordinary and customary meaning. See *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). However, when the meaning of a claim term as understood by persons of ordinary skill in the art is not readily apparent, failing to construe the term “may be inadequate.”

Particularly, the Federal Circuit court noted that a determination that no construction is needed “may be inadequate when a term has more than one ‘ordinary’ meaning or when reliance on a term’s ordinary meaning does not resolve the parties’ dispute.” The court stated that parties had disputed the *scope* of the claim language, not merely the *meaning* of the words themselves. Thus, the court reasoned, the district court had failed to resolve the parties’ dispute by failing to construe the meaning of the term “only if.”

- B. No. Under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, “a narrowing amendment... made for a substantial reason relating to patentability” creates a “presumption that the patentee has surrendered all territory between the original claim limitation and the amended claim limitation,” and the claim language itself did not support a rebuttal of the presumption. 344 F.3d 1359, 1367 (Fed. Cir. 2003) (en banc); *accord Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). A patentee may rebut the presumption three ways, by showing: (1) the alleged equivalent was “unforeseeable;” (2) the “objectively apparent” rationale of the amendment had merely a “tangential” relation to the equivalent at issue; or (3) “some other reason.” *Honeywell Int’l v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1140 (Fed. Cir. 2004) (*quoting Festo*, 344 F.3d at 1368). O2 Micro argued only that the narrowing amendment was tangential.

O2 Micro had given little explanation for the “only if” limitation. Thus, the Federal Circuit court looked to the claim language itself to determine the reason for the amendment. Reviewing the “only if” limitation, the court stated that “the ‘objectively apparent’ reason” for the amendment was clear in the context of the claim: to limit the feedback circuit to operation “only if said feedback signal is above a predetermined threshold.” Since the equivalent at issue is a feedback circuit with operation outside of the limitation, the court held that the amendment was not “tangential.” As such, the doctrine of equivalents did not apply.

IV. Conclusion

A district court must construe all disputed claim terms when the meaning of the terms affects the scope of the claims. A narrowing amendment is not “tangential” for purposes of the doctrine of equivalents if the objectively apparent reason for the amendment is clear from the claim language and the prosecution history does not offer another reason.