

Keywords: doctrine of equivalents; unclaimed subject matter; dedication to the public

General: The doctrine of equivalents cannot be used to capture unclaimed subject matter disclosed in the specification.

Johnson & Johnston Associates Inc. v. R.E. Service Co.
285 F.3d 1046, 62 U.S.P.Q.2d 1225 (Fed. Cir. 2002) (en banc)
Decided March 28, 2002

I. Facts

Johnson and Johnston Associates (“Johnston”) brought action against R.E. Service Co. and Mark Frater (collectively “RES”), asserting United States Patent No. 5,153,050 (the ‘050 patent). A jury found that RES willfully infringed claims 1 and 2 of the patent under the doctrine of equivalents and awarded Johnston \$1,138,764 in damages. Upon entry of judgment, the United States District Court for the Northern District of California (Breyer, J.) further granted Johnston enhanced damages, attorney fees, and expenses.

The ‘050 patent relates to the manufacture of printed circuit boards. At one point during the typical process of manufacturing printed circuit boards, workers manually handle the thin sheets of copper foil during the layering process. The ‘050 patent claims a way to prevent damage to the copper foil by adhering the copper foil to a stiffer substrate sheet of aluminum. The specification states, “While aluminum is currently the preferred material for the substrate, other metals, such as stainless steel or nickel alloys, may be used. In some instances ... polypropylene [sic] can be used.” But, critical to the case, claims 1 and 2 only recite using an aluminum substrate.

Prior to this case, the parties had litigated over the ‘050 patent, but had settled their disputes in 1995. In 1997, RES began making new laminates for manufacture of printed circuit boards that joined copper foil to a sheet of steel as a substrate instead of a sheet of aluminum. After Johnston filed a suit for infringement, the district court granted RES’s motion for summary judgment of no literal infringement. With respect to the doctrine of equivalents, RES argued, citing *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 39 U.S.P.Q.2d 1001 (Fed. Cir. 1996), that the ‘050 specification, which disclosed a steel substrate but did not claim it, constituted a dedication of the steel substrate to the public. Johnston argued that the steel substrate was not dedicated to the public, citing *YBM Magnex, Inc. v. Int’l Trade Comm’n*, 145 F.3d 1317, 46 U.S.P.Q.2d 1843 (Fed. Cir. 1998).

On cross-motions for summary judgment, the district court ruled that the ‘050 patent did not dedicate the steel substrate to the public, and set the question of infringement by equivalents for trial, along with the issues of damages and willful infringement. As mentioned above, the jury found RES liable for willful infringement under the doctrine of equivalents and awarded Johnston damages. RES appealed, arguing that Johnston did not claim steel substrates, but limited its patent scope to aluminum substrates, thus dedicating to the public this unclaimed subject matter.

II. Issue

Can Johnston apply the doctrine of equivalents to cover unclaimed subject matter disclosed in the specification?

III. Discussion

No. In this *per curiam* opinion the court found Johnston could not invoke the doctrine of equivalents to extend its aluminum claim limitation to encompass steel, having disclosed the unclaimed steel substrate in the specification.

In their arguments, each party cited different precedents in support of their position. Relying on *Maxwell*, RES argued the unclaimed subject matter disclosed in the specification had been dedicated to the public. Johnston relied on *YBM Magnex* as support for the opposite position—that it had *not* dedicated its unclaimed subject matter to the public.

In *Maxwell*, the patentee claimed fastening tabs between the inner and outer soles of attached shoes, disclosing stitching the tabs into the lining of the shoes in the specification but not in the claims. The Federal Circuit found that the alleged infringer did not infringe under the doctrine of equivalents by using the unclaimed shoe attachment system that the patentee had disclosed in the specification. The court in *Maxwell* further stated that by failing to put a feature in the claims, the patentee dedicated the unclaimed subject matter to the public.

In *YBM Magnex*, the patent claimed an alloy with a certain oxygen content range. The alleged infringer claimed an oxygen content outside the claimed range but within a range allegedly disclosed in the patent. Contrary to *Maxwell*, the Federal Circuit in *YBM Magnex* held the doctrine of equivalents might encompass unclaimed subject matter disclosed in the specification. The Johnston court stated *YBM Magnex* “purported to limit *Maxwell* to situations where patent discloses an unclaimed alternative distinct from the claimed invention.

After addressing these two conflicting opinions, the court reviewed prior holdings of the Supreme Court and the Federal Circuit, reiterating that the claims define the scope of patent protection and give notice of that scope both to the examiner, during prosecution, and to the public at large, once the patent has issued. Furthermore, the court stated, “a patent applicant defines his invention in the claims, not in the specification, [and] the claims, not the specification, provide the measure of the patentee’s right to exclude.” In addition, when looking at infringement, whether literally or by the doctrine of equivalents, courts look at the claim language as construed by the court, not at the specification or a commercialized product based on the patent. The court then cited two Supreme Court cases from the 1880’s, *Miller v. Bridgeport Brass Co.*, 104 U.S. 350, 352 (1881) and *Mahn v. Harwood*, 112 U.S. 354, 361, (1884), holding, respectively, that unclaimed subject matter was dedicated to the public and was public property.

Next, the court reviewed *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950), where the Supreme Court first applied the doctrine of equivalents to extend the right to exclude beyond the literal scope the claims. In *Graver*, the Court upheld a finding of infringement under the doctrine of equivalents, finding the accused compositions “perform[ed] substantially the same function in substantially the same way to obtain the same result.” *Graver*, 339 U.S. at 608-10 (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42, (1929)). In a predecessor case, the Court had held two composition claims invalid because they broadly encompassed inoperative silicates along with some operative ones, but did not invalidate narrower claims. The *Graver* Court then applied the doctrine of equivalents to the narrower claims to encompass subject matter in the previously invalidated claims. The Court found that the patentee had *not* dedicated the unclaimed subject matter to the public because the patentee had claimed the subject matter in *some* claims, albeit ones later invalidated.

The Federal Circuit also reviewed the Supreme Court’s holding in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997). There, the Court reaffirmed the doctrine of equivalents, finding a pH of 5.0 equivalent to the claimed pH’s of 6.0 to 9.0 in an ultrafiltration process. The court said

Warner-Jenkinson did not present an instance of a patentee dedicating subject matter to the public because the patent at issue in did not disclose or suggest the equivalent in the specification.

Finally, the court chose to follow *Maxwell*, stating that a patentee who failed to claim subject matter disclosed in the specification dedicated that subject matter to the public. It then cited several cases emphasizing again that claims define the scope and limit of a patent on which the public relies to avoid infringement. The court stated, “[A] patentee cannot narrowly claim an invention to avoid prosecution scrutiny by the PTO, and then, after patent issuance, use the doctrine of equivalents to establish infringement because the specification discloses equivalents.” The court reasoned that enforcing *Maxwell* would avoid the problem of having one standard for claim coverage in prosecution and another in infringement analysis.

IV. Conclusion

Having limited the claims in the ‘050 patent to aluminum and only disclosed steel in the specification, the court held Johnston could not invoke the doctrine of equivalents to extend its aluminum limitation to encompass steel. The court, overruling *YBM Magnex*, held that doctrine of equivalents cannot be asserted to cover unclaimed subject matter disclosed in the specification.

V. Concurrences

- A. **Clevenger, J., joined by Lourie, Schall, Gajarsa, and Dyk, JJ.:** The court took the case en banc to ensure uniformity in applying precedent. *Maxwell* and *YBM Magnex* conflicted, and thus *YMB Magnex* was overruled.
- B. **Rader, J., joined by Mayer, C.J.:** Suggests a foreseeability bar as an alternative principle that would reconcile the notice function of patent claims with the protective function of doctrine of equivalents.
- C. **Dyk, Circuit Judge, joined by Linn, J.:** Explains why the current decision is consistent with *Graver Tank*, emphasizing patentee’s control over the claims.
- D. **Lourie, J.:** Casts doubt on Rader’s foreseeability idea, pointing out its similarity to obviousness and how it creates a conflict with conventional patent law ideas. He argues foreseeability applied causes the plaintiff asserting equivalence to have to argue the alleged infringer’s device was not obvious and the defendant to have to counter that the device was obvious.

VI. Dissent

Newman, J.: Argues *stare decisis*, explaining how the *per curium* opinion fails to follow Supreme Court and Federal Circuit precedent, especially the opinion she authored in *YBM Magnex*.