Keywords: **foreseeability; doctrine of equivalence; § 112(f) (AIA); § 112, sixth paragraph (pre-AIA); means-plus-function claims; claim vitiation**

General: **Foreseeability of asserted equivalence at the time of patenting is not a bar to the doctrine of equivalents.**

Ring & Pinion Serv., Inc. v. ARB Corp.
109 U.S.P.Q.2d 1779 (Fed. Cir. 2014)
Decided February 19, 2014

I. Facts

ARB Corp. ("ARB") owns patent 5,591,098 ("the '098 patent") with claims to a locking differential for an automobile. Ring & Pinion Serv., Inc. ("R&P") sought a declaratory judgment that its Ziplocker product did not infringe the '098 patent. Claim 1 included a "cylinder *means* formed in said differential carrier and housing an actuator position to cause movement of said locking means relative to said carrier."

At trial, following claim construction, each party motioned for summary judgment. The parties stipulated that there were "no issues of material fact regarding infringement under the doctrine of equivalents." Further, the parties stipulated multiple facts:

1. The Ziplocker product literally infringed each recitation of the claims except for the cylinder means.
2. The Ziplocker product included an equivalent cylinder.
3. The Ziplocker cylinder "would have been foreseeable to a person of ordinary skill in the art at the time the application for '098 patent was filed.
4. The entire outcome would be determined by a single legal issue: whether an equivalent is barred under the doctrine of equivalents because it is foreseeable at the time of the patent application.

The district court held that foreseeability did not preclude application of the doctrine of equivalents. However, the court held that a finding of infringement would vitiate the cylinder means recitation. Therefore, the court granted summary judgment of non-infringement to R&P. ARB appealed.

II. Issues

1. Does foreseeability bar application of the doctrine of equivalents to an equivalent feature in an otherwise infringing product?

2. Does foreseeability bar application of the equivalents analysis for § 112(f) (AIA) or § 112, ¶6 (pre-AIA)[1] claims?

3. Does a finding of infringement vitiate the "cylinder means formed in" recitation?

III. Discussion

1. No. The Federal Circuit refused to adopt a foreseeability bar to the application of the doctrine of equivalents. The Federal Circuit emphasized that "there is no, nor has there ever been, a foreseeability limitation on the application of doctrine of equivalents." The Federal Circuit noted that "known interchangeability" was a long established express object factor that weighs *in favor* of finding infringement under the doctrine of equivalents. *See Werner Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 36 (1997); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950), that support such findings. Furthermore, the Federal Circuit noted that the case relied upon by R&P, *Sage Products*, held that *claim vitiation*, not foreseeability, prevented application of the doctrine of equivalents. *See Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997). Moreover, the Federal Circuit held that foreseeability could not be adopted as a bar to application of the doctrine of equivalents without directly conflicting with the long-stranding. Therefore, the Federal Circuit refused to adopt foreseeability as a *per se* bar to application of the doctrine of equivalents.

2. No. The Federal Circuit refused to adopt a foreseeability bar to the application of the equivalents analysis for § 112(f) (AIA) or § 112, ¶6 (pre-AIA) claims. The Federal Circuit noted that equivalence analysis under § 112(f) (AIA) or § 112, ¶6 (pre-AIA) differed from the doctrine of equivalents in two ways: timing and function.

	§ 112(f)	Doctrine of Equivalents
Timing of analysis	At time of issuance	At time of infringement
Function	Identical functions	Substantially the same function

However, the Federal Circuit emphasized that means-plus-function claims are subject to both the § 112(f) equivalence analysis **and** the doctrine of equivalents. Furthermore, the Federal Circuit noted that when an accused technology was known at the time of patenting and the functions are identical, the § 112(f)

[1] **35 U.S.C. § 112(f) Element in Claim for a Combination.—** An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification *and equivalents thereof.*

equivalence analysis and doctrine of equivalents are coextensive. Thus, in this case, the doctrine of equivalents and the § 112(f) equivalence analysis do not differ. Since the Federal Circuit already stated that foreseeability does not bar the application of the doctrine of equivalents, the Federal Circuit further held that the application of the doctrine of equivalents to means-plus-functions claims is not barred by foreseeability of an equivalent technology at the time of issuance.

3. No. The district court should have enforced the parties' stipulation. The Federal Circuit further emphasized that claim vitiation only prevents application of the doctrine of equivalents when express limitations are "utterly written out of the claim" due to the determination of equivalence. Furthermore, the Federal Circuit stated that claim vitiation is not an exception to the doctrine of equivalence. Instead, the Federal Circuit noted that claim vitiation is a legal determination that no reasonable jury could determine two elements to be equivalent. Since the parties had stipulated that the two cylinders were equivalent, the stipulation precludes the conclusion of claim vitiation. Thus, the Federal Circuit held that the district court erred by failing to grant summary judgment of infringement to ARB, reversed, and remanded.

IV. Conclusion

The Federal Circuit held that foreseeability of asserted equivalence at the time of patenting is not a bar to the doctrine of equivalents. The Federal Circuit further noted that this holding also applies to the application of the doctrine of equivalents to means-plus-function claims in combination or apart from the equivalence analysis under § 112(f).