

Keywords: doctrine of equivalence; prosecution history estoppel

General: Narrowing amendments related to patentability precludes a patentee from recapturing subject matter surrendered by those amendments via the doctrine of equivalents.

Integrated Tech. Corp. v. Rudolph Techs., Inc.

108 U.S.P.Q.2d 1734 (Fed. Cir. 2013)

Decided November 4, 2013

I. Facts

Integrated Tech Corp. (“ITC”) owns patent 6,118,894 (“the ‘894 patent”) to inspection equipment for probe cards used to test chips on semiconductor wafers. Asserted independent claim 1, as originally filed, recited (relevant part only) “a window with a flat surface contacted by said probe tip.” This claim was amended during prosecution to overcome a Section 112 indefiniteness rejection as well as a Section 102 art rejection to add recitations directed to “a window with a flat surface contacted by said probe tip, said viewing system obtaining said digital image through said window *in a first state where said probe tip is driven in contact with said window with a first force.*”

ITC alleged that Rudolph literally infringed the '894 patent with its pre-2007 products that include probe tips that physically contact the viewing window before or during the capture of an image. ITC also alleged that Rudolph infringed the '894 patent under the doctrine of equivalents with its no-touch products that obtain a first image when the probe tips are approximately five microns above the viewing window.

The district court granted summary judgment of literal infringement with respect to the pre-2007 products and a jury found willful infringement of the '894 patent with respect to the no-touch products under the doctrine of equivalents. The district court concluded that prosecution history estoppel did not preclude a finding of infringement by equivalence. It determined that the original and issued claims “both required contact between the plate and the probe tip,” and therefore held that ITC did not make a narrowing amendment.

Rudolph appealed under the theory that prosecution history estoppel bars the application of the doctrine of equivalents.

II. Issues

1. Does prosecution history estoppel bar application of the doctrine of equivalents?
2. Do any of the exceptions apply in the present case?

III. Discussion

1. Yes. The Federal Circuit noted that prosecution history estoppel prevents a patentee from recapturing through the doctrine of equivalents the subject matter that the applicant surrendered during prosecution and it presumptively applies when the applicant made a narrowing claim amendment related to patentability. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki C.*, 535 U.S. 722, 734 and 736-37 (2002). This presumption may be rebutted by establishment of one of three exceptions: a) that the equivalent was unforeseeable at the time of the amendment, b) that the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question, c) some other reason suggesting that the patentee could not reasonably be expected to have described the equivalent. *See id.* at 740-741.

On appeal, Rudolph argued that the equivalent was literally within the scope of the original claim and that the amendment narrowed the scope of the claim by reciting that the probe tip must be “driven in contact with said window” in both recited states. Rudolph also argued that prosecution history estoppel presumptively applies because the narrowing amendment was in response to patentability rejections and that the equivalent bears a direct—as opposed to tangential—relationship to the amendment. Moreover, Rudolph argued that even if ITC did not need to distinguish the prior art on the basis of whether the probe tip and window are in physical contact, it chose to do so and, thus, relied on the difference between the equivalent and the amended limitation to obtain claim 1's allowance.

ITC argued that that the doctrine of equivalents applies as the amendment was not narrowing. ITC contended that the original claim implied measuring the probe tip at two different points of actual physical contact with the viewing window and that the amendment merely expressed that implication. Additionally, ITC argued the amendment bore only a tangential relationship to the equivalent, since the amendment distinguished the prior art solely on the basis of obtaining two images of the probe tip at different positions. ITC thus argued that it did not distinguish the prior art based on the invention requiring physical contact between the probe tip and the viewing window.

The Federal Circuit agreed with Rudolph that prosecution history estoppel presumptively applies because the amendment narrowed the scope of the original claim in response to patentability rejections. The court noted that by its plain language, the amendment added that there must be two different forces that drive the probe tip in contact with the viewing window in two separate states. Accordingly, the court held that ITC surrendered the territory between the original and issued claims, including the equivalent.

2. No. The court determined that ITC failed to meet its burden of proving that an exception to prosecution history estoppel applies. With respect to the tangential relation exception, the court noted that this exception is “very narrow.”

Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc., 480 F.3d 1335, 1342 (Fed.Cir.2007). The court asked “whether the reason for the narrowing amendment was peripheral, or not directly relevant, to the alleged equivalent.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1369 (Fed.Cir.2003) (en banc). The court also noted that the tangential relation inquiry “focuses on the patentee’s objectively apparent reason for the narrowing amendment,” which “should be discernible from the prosecution history record.” *Festo*, 344 F.3d at 1369. The court found that, in the present case, a tangential rationale for the amendment is not objectively apparent from the prosecution history. In particular, the court noted that during the course of prosecution, ITC made representations that conveyed to the public that it was relying on physical contact to overcome the prior art. The court stated that while it may be that ITC did not need to surrender a lack of physical contact between the probe tip and window in either state to overcome Sato, the dispositive fact is that ITC chose to do so. Because ITC was unable to prove, based on the prosecution history, that the “objectively apparent reason for the narrowing amendment” was only tangentially related to the equivalent (*Festo*, 344 F.3d at 1369), the exception did not apply for this case.

With respect to the foreseeability exception, the court noted that the patentee may rebut the application of prosecution history estoppel by establishing that the equivalent would have been objectively unforeseeable to one of ordinary skill in the art at the time of the amendment. *Festo*, 344 F.3d at 1369. The court found that the no-touch products obtain an image in a first state when the probe tip is five microns above the viewing window and obtain an image in a second state when the probe tip touches the window. Accordingly, the court noted, the no-touch products literally satisfy the original claim’s limitation of “a window with a flat surface contacted by said probe tip.” When the patentee “originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter.” *Festo*, 535 U.S. at 733–34. The court found that this principle controls in this case regardless of when Rudolph developed its no-touch products.

Accordingly, the court held that ITC’s narrowing amendment during prosecution surrendered the equivalent from the scope of the asserted claims and that prosecution history estoppel bars the application of the doctrine of equivalents. Thus, the court reversed the denial of Rudolph’s motion for JMOL that its accused no-touch products do not infringe under the doctrine of equivalents.

IV. Conclusion

The Federal Circuit maintained that narrowing amendments related to patentability precludes a patentee from recapturing subject matter surrendered by those amendments via the doctrine of equivalents.