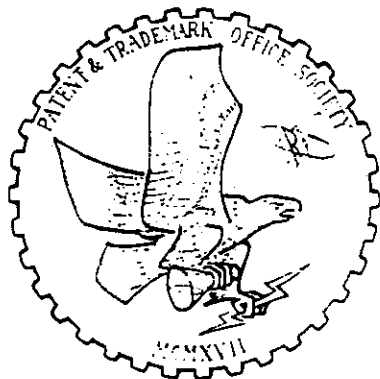


September 1998  
Volume 80, No. 9  
Pages 607-698  
\$4.00 US

# JOURNAL of the PATENT and TRADEMARK OFFICE SOCIETY

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# Only Obvious Variations Infringe

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## INTRODUCTION

**A**ccused infringers increasingly defend patent suits with 35 USC §112. This trend indicates a larger shift in patent law to incorporate the patentability/validity concept of obviousness into infringement analysis. Recent Federal Circuit decisions suggest the Court is using §112 as a tool to assess infringement in terms of the obviousness of the accused device in view of the patent disclosure. This represents a major departure from practitioners' current understanding of the way patent law works, and in particular of the way patent infringement is determined.

### *A. How We Understood §112 and Infringement*

Until recently, patent litigators generally did not concern themselves with §112 in preparing infringement opinions, and did not expect the infringement result in their cases to turn on §112 issues. Litigators could advise their clients with reasonable precision that literal infringement existed when each and every element of a claim found correspondence in the accused device.<sup>1</sup> Even without literal correspondence as to one or more claim element, infringement could still be found under the doctrine of equivalents.<sup>2</sup>

Until recently, patent drafters considered Examiners' rejections based upon the written description requirement of §112 to be minor matters requiring simple amendments. If the Examiner felt the claim was in terms broader than the specification in violation of §112, ¶1,<sup>3</sup> the specification was simply amended to include the language from the

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\*Member, St. Onge Steward Johnston & Reens LLC. The opinions expressed are solely those of the author and may not be attributed to his firm or its clients.

<sup>1</sup> Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (Fed. Cir. 1987)(en banc), cert. denied, 485 U.S. 961 (1988).

<sup>2</sup> Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 608 (1950).

<sup>3</sup> §112, ¶1 reads: "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

claim. Drafters used 'means for' expressions under §112, ¶6 to broadly claim elements of the invention, and only specified particular structure if necessary to obtain allowance.<sup>4</sup>

Times have changed. In a few short years, §112 has become a minefield for the unwary. Patent drafters and litigators alike need to carefully consider §112 before advising their clients on the issue of infringement.

### B. *Shift in Infringement Analysis*

In 1990, the Federal Circuit held in *Wilson Sporting Goods v. David Geoffrey & Associates*,<sup>5</sup> that infringement under the doctrine of equivalents could be demonstrated by formulating a hypothetical claim which is both literally infringed by the accused device and patentable over the prior art.<sup>6</sup> The subject matter of such a hypothetical claim must be adequately-disclosed in the specification in accordance with 35 USC §112.<sup>7</sup> Practitioners who thought validity/patentability and infringement were separate issues wondered why the Court had injected consideration of the patent disclosure's scope into infringement analysis. In fact, the Court had taught that infringement under the doctrine of equivalents depended upon the *literal* scope of the patent disclosure.

### C. *Ascendance of §112 in Infringement Analysis*

§112 sets out the statutory requirements for the patent disclosure. It has become increasingly important as Courts have examined a patent's disclosure to determine infringement.

#### 1. *§112, ¶1*

In 1993, in *North American Vaccine v. American Cyanamid Co.*,<sup>8</sup> the Federal Circuit found that the patentee's claim construction was broader than the specification, and therefore did not meet the description requirement of §112, ¶1.<sup>9</sup> However, the Court was not prepared to invalidate a patent claim for failure to comply with the written description requirement, and so it gave the claim a narrow construction, citing

<sup>4</sup> See, Landis, *Mechanics of Patent Claim Drafting*, §31 (2d ed. 1978).

<sup>5</sup> 904 F.2d 677 (Fed. Cir. 1990).

<sup>6</sup> *Wilson Sporting Goods*, 904 F.2d at 684.

<sup>7</sup> The doctrine of equivalents exists to give the patentee only what he could have lawfully obtained from the Patent Office. *Wilson Sporting Goods*, 904 F.2d at 684.

<sup>8</sup> 7 F.3d 1571 (Fed. Cir. 1993).

<sup>9</sup> *North American Vaccine*, 7 F.3d at 1577.

Carmen Industries v. Wahl<sup>10</sup> for the proposition that claims must be construed so as to preserve their validity.

Early in 1998, however, in *The Gentry Gallery, Inc. v. The Berkshire Corporation*,<sup>11</sup> the Federal Circuit held a literally broad claim invalid for failure to comply with the written description requirement of §112, ¶1.<sup>12</sup> The claim limitation in question was "control means. . . mounted on. . . seat sofa section".<sup>13</sup> The Court found the claim invalid on grounds the claimed sofa was not adequately described in the specification within the meaning of §112, ¶1, citing *Lockwood v. American Airlines, Inc.*<sup>14</sup> The arguments set forth by the alleged infringer in support of such a narrow claim construction were that the patent only describes sofas having controls on the console, and that an object of the invention is to provide a sectional sofa 'with a console. . . that accommodates the controls'.<sup>15</sup> The patentee argued, to no avail, that the alleged infringer's construction improperly limited the patent claims to the inventor's preferred embodiment, citing *Ethicon Endo-Surgery, Inc v. United States Surgical Corp.*,<sup>16</sup> and *In Re Rasmussen*.<sup>17</sup>

## 2. §112, ¶¶2,6

Back in 1994, in *In Re Donaldson*,<sup>18</sup> an en banc Federal Circuit held that if a patentee employs means-plus-function language in accordance with §112, ¶6,<sup>19</sup> the claim will be invalid, for lack of distinctiveness under §112, ¶2,<sup>20</sup> unless the patentee has adequately disclosed what structure is meant to perform the recited function.<sup>21</sup> Certainly there are patents with means-for claim limitations in which the specification

10 724 F.2d 932, 937 (Fed. Cir. 1983), fn. 5.

<sup>11</sup>Nos. 97-1076, -1104, -1182, (Fed. Cir. January 27, 1998).

<sup>12</sup> *The Gentry Gallery*, at 10.

<sup>13</sup> *The Gentry Gallery*, at 4.

<sup>14</sup> 107 F.3d 1565, 1572 (Fed. Cir. 1997). In *Lockwood*, a narrow claim was narrowly interpreted. The *Gentry* claim is broad.

<sup>15</sup> *The Gentry Gallery*, at 9.

<sup>16</sup> 93 F.3d 1572, 1582 (Fed. Cir. 1993)(a patentee is generally allowed claims which cover more than the specific embodiment shown).

<sup>17</sup> 650 F.2d 1212, 1214 (CCPA 1981)(claim may be broader than the specific embodiment disclosed in the specification).

<sup>18</sup> 16 F.3d 1189 (Fed. Cir. 1994).

<sup>19</sup> §112, ¶6 reads: "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."

<sup>20</sup> §112, ¶2 reads: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

<sup>21</sup> *Donaldson*, 16 F.3d at 1195. Also see, *In Re Dossel*, 115 F.3d 942 (Fed. Cir. 1997).

includes no more specific disclosure of structure for performing the recited function than the claim itself. After all, drafters used means-for expressions precisely because the particular structure used was not considered material to the invention.

Then in early 1998, in *Dawn Equipment Co. v. Kentucky Farms Inc.*,<sup>22</sup> the Federal Circuit reversed the trial court's denial of defendant's motion for JMOL of no infringement, citing damning evidence in the text of the patent itself.<sup>23</sup> The Court looked to the advantages of the invention touted in the patent specification, and held as a matter of law, that defendant's device could not satisfy a §112, ¶6 claim limitation under the doctrine of equivalents.<sup>24</sup> So, structural details put into the specification to satisfy §112, ¶2 under *Donaldson*, may be used to limit the scope of equivalents for means-plus-function claim limitations under *Dawn Equipment*.

In *North American Vaccine*, *Donaldson*, *Gentry Gallery*, and *Dawn Equipment*, the Federal Circuit used §112 to narrowly construe a claim limitation.<sup>25</sup> The infringement determination then proceeded by comparing the interpreted claim to the accused device according to an unarticulated standard.<sup>26</sup>

#### *D. Obviousness: The Unspoken Infringement Standard*

For purposes of determining infringement, the scope of a patent has formerly been defined by the claims,<sup>27</sup> but is increasingly defined by the specification.<sup>28</sup> Enforceability of a patent seems to be taking on an equitable component. Many commentators have explored the equitable nature of the doctrine of equivalents.<sup>29</sup> However, it now seems as

<sup>22</sup> No. 97-1042 (Fed. Cir. March 24, 1998).

<sup>23</sup> *Dawn Equipment*, at 8.

<sup>24</sup> *Dawn Equipment*, at 9.

<sup>25</sup> "terminal portion" in *North American Vaccine*, means-plus-function expressions in *Donaldson*, "sofa" in *Gentry Gallery*, and "means for locking and releasing" in *Dawn Equipment*.

<sup>26</sup> See Wynne, Jr., *Warner-Jenkinson C. v. Hilton Davis Chemical Co.: How Can the Federal Circuit Control the Doctrine of Equivalents Following the Supreme Court's Refusal to Set the Standard*, 7 Fed. Cir. B. J. 159, 175 (1997) for a discussion of the Supreme Court's acknowledgment that the appropriate test for analyzing infringement under the doctrine of equivalents could depend on the facts of the particular case.

<sup>27</sup> "claims are infringed, not specifications" *SRI Intern. V. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985).

<sup>28</sup> "[T]he scope of the right to exclude may be limited by a narrow disclosure." *The Gentry Gallery*, slip op. at 10.

<sup>29</sup> See, e.g., Waldbaum and Sipiora, *Pennwalt Redux-Judicial Uncertainty vs. Procrustean Bed*, 19 AIPLA Q. J. 237 (1991); Gartman, *Infringement Under the Doctrine of Equivalents: Gazing Into the Crystal Ball*, 3 Fed. Cir. B. J. 299 (1993); Dunner and Jakes, *The Equitable Doctrine of Equivalents*, 75 J. Pat. Off. Soc'y 857 (1993); and Hoffman and Oliver, *With Hilton Davis the*

if even literal infringement depends upon a sense of fairness in finding infringement. This sense of fairness depends, in turn, upon the similarity of the accused product to the device which is shown and described in the patent. Claims have reduced importance in infringement analysis. In "interpreting" claims, the Federal Circuit uses §112 to determine patent scope according to scope of the specification.

Courts employ §112 analysis to assess similarity of the accused product with the device disclosed in the patent. Only those accused devices which include all features and achieve all objects described in the patent are held to infringe. Accused devices with insubstantial variations to the disclosed device infringe the patent, and those with substantial modifications to the disclosed device do not infringe.<sup>30</sup> The concept of obviousness has been absorbed into the determination of infringement; only obvious variations infringe.

#### *E. Perspectives on Obviousness for Determining Infringement*

Courts seem determined to develop ways to exercise more control over the patent infringement analysis<sup>31</sup> even though the issue of infringement is one of fact for a jury.<sup>32</sup> Perhaps the courts are reacting to perceived abuse in filing of colorable infringement suits under the doctrine of equivalents. The patentee need only show equivalence of a gold-sealed document by a preponderance of evidence,<sup>33</sup> while the defendant is left to try to convince a nontechnical jury by clear and convincing evidence that it should substitute its judgment for that of the U.S. Patent Office.<sup>34</sup> Construing claims with reference to obvious variations of the patent disclosure gives courts more control over the infringement analysis.

Initially, patent holders may not appreciate litigation outcomes which do not square with the advice given by their lawyers under the old rules for determining infringement. Eventually, however, patent

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Federal Circuit Takes the Doctrine of Equivalents Back to its Roots, 77 J. Pat. Off. Soc'y 763 (1995).

30 See, Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co., 117 S.Ct. 1040 (1997)(Infringement exists under the doctrine of equivalents if there are only insubstantial differences between the claimed and accused devices).

31 See, Markman v. Westview Instruments, Inc., 116 S.Ct. 1384 (1996)(construction of a patent is exclusively within the province of the court). But cf. Vitronics Corp. v. Conceptronic Ind., 90 F.3d 1576, 1582 (Fed. Cir. 1996)(court may consider extrinsic evidence in construing claim).

32 Comparison of properly interpreted claim to an accused device to determine infringement is a question of fact. Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, 976 F.2d 1559, 1570 Fed. Cir. 1992).

33 Hughes Aircraft v. United States, 717 F.2d 1351, 1361 (Fed. Cir. 1983).

34 Uniroyal v. Rudkin-Wiley, 837 F.2d 1044, 1050 (Fed. Cir. 1988).

holders will appreciate an infringement analysis standard which gives some credence to their widely held misconceptions. First, that a patent gives them the right to manufacture and sell their product. Second, that they do not infringe their competitor's patent if they have their own patent.<sup>35</sup> And, third, that the rights conferred by a patent are limited by details of the description, and not just limitations in the claims.

Practitioners will see the law of literal infringement and the law of infringement under the doctrine of equivalents merge, unified by the obviousness theory of infringement. Since a defense to infringement might lie in an improvement patent, practitioners should also expect, and advise, increased patent application filings.

### CONCLUSION

Whether or not obviousness is the unstated standard for determining infringement, practitioners should consider the Federal Circuit's recent use of §112 before rendering advice in any patent matter.

In preparing patent applications, drafters should broadly disclose the invention and describe numerous embodiments so that relatively more accused products will be similar to those described in the patent. Less attention should be given to details about a single, preferred embodiment since these might all give rise to noninfringement arguments.

Patent litigators should carefully compare the accused product to the patent specification and examine the equities of the case before advising clients on infringement.

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<sup>35</sup> An alleged infringer who obtains a patent on an improvement to the patented device would have a head start in convincing a court that his device does not infringe, because the Patent