

Purpose of the Patent Monopoly

- A patent benefits both the inventor, by guaranteeing his exclusive property right in his invention, and the public, by obtaining the full disclosure of a novel and useful invention.

What is claim construction?

- Process by which the courts determine the true meaning of the claims of a patent
- A claim states the invention in a single sentence
- There tends to be plurality of these claims in a single a patent
- Each of these claims are short and concise statements, expressed with immense formality, of the metes and bounds of the patented invention
- “[T]he construction of claims is simply a way of elaborating the normally terse claim language: in order to understand and explain, but not to change, the scope of the claim.”¹
- In 1870, US patent law was amended to formally include claims to set forth the invention.²

Doctrine of equivalents

- The doctrine of equivalents holds that one cannot avoid infringement by making immaterial or insubstantial changes to patented subject matter that carry the “new” matter outside the reach of the patent claim.³
- The purpose of the doctrine of equivalents is to prevent prospective infringers from appropriating a patented invention by utilizing a loophole in the language of the patent, thus excluding their limitation from the literal scope of the patent.⁴
- The doctrine elevates the breadth of scope a patentee may place in his patented technology in view of “merely colorable changes”
- The Supreme Court first referenced the doctrine in *Evans v. Eaton* by noting that “a mere change in the form or proportions of any machine shall not be deemed a discovery.”⁵
- Note:
 - The courts appear to look what constitute a patentable invention to help determine what constitutes a mere colorable change falling within the doctrine of equivalents
- Doctrine of equivalents is generally considered to have been formalized by the Supreme Court in *Winans v. Denmead*⁶. The Supreme Court dealt with a patent for constructing

the body of a railroad car from a sheet of iron. On appeal, the Court set forth the common law definition of the doctrine of equivalents:

- Under our law a patent cannot be granted merely for a change of form. ... To change the form of an existing machine, and by means of such change to introduce and employ other mechanical principles or natural powers, or, as it is termed, a new mode of operation, and thus attain a new and useful result, is the subject of a patent. Such is the basis on which the plaintiff's patent rests.

- It is generally true, when a patentee describes a machine, and then claims it as described, that he is understood to intend to claim, and does by law actually cover, not only the precise forms he has described, but all other forms which embody his invention[.]⁷
- In a 5-4 Winans decision, the Court held that the similarity required for an equivalent finding is one that "must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention."⁸
- Many 19th century cases relied on this development of the doctrine to determine infringement, including *Gould v. Rees* whereby Justice Clifford wrote for the majority of the Supreme Court the following:
 - [A]n alteration in a patented combination which merely substitutes another old ingredient for one of the ingredients in the patented combination is an infringement of the patent, if the substitute performs the same function and was well known at the date of the patent as a proper substitute for the omitted ingredient, but the rule is otherwise if the ingredient substituted was a new one, or performs a substantially different function, or was not known at the date of the plaintiff's patent as a proper substitute for the one omitted from is patented combination.⁹
 - Equivalent if:
 - A. Performs same function
 - B. Was well known at the date of the patent as a proper substitute for the omitted element
- Re B. above, the Supreme Court, in *Werner Jenkinson Co. v. Hilton-Davis Chemical Co.*¹⁰ rejected an argument that the doctrine of equivalents should be limited in application to situations wherein the equivalent was known to be an equivalent substitute at the time of patenting.
- In the late 19th century, the doctrine had some hiccups in its wide acceptance as the construction pendulum swayed to the public's benefit – i.e., the claim construction is be more narrow.

- In 1950, the Supreme Court resurrected from the common law the doctrine of equivalents in the case now steeped in antiquity, *Graver Tank & Mfg. Co. v. Linde Air Prods.*¹¹ In this case, the Supreme Court was confronted with an improvement in welding techniques which the defendants had mirrored in creating an imitation which fell outside the { ? Literal } claim language, but utilized the same principle described in the plaintiff's patent.
 - Court affirmed the lower court verdict of a finding of infringement
 - Justice Jackson wrote opinion affirming the doctrine of equivalents
 - Jackson adopted the “function, way, and result” test set forth over 70 years prior in *Union Paper-Bag Machine Co. v. Murphy*¹²
 - Court in *Graver* said the following was the rationale re the doctrine:
 - [C]ourts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for – indeed encourage – the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would oster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.¹³
- In *Hilton-Davis*, the Federal Circuit commenced its own expansion of the doctrine of equivalents declaring that the “function-way-result” test from *Graver Tank* represented only one possible test of infringement.

¹ *Scripps Clinic & Research Foundation v. Genentech, Inc.* 927 F.2d 1565, 1580, 18 USPQ 2d 1001, 1013 (Fed. Cir. 1991).

² Act of 1870, ch. 230, § 26, 16 Stat. 198 (1870), wherein the applicant “[s]hall particularly specify and point out the part, improvement or combination, which he claims as his own invention.”

³ Kahrl, p 2-54.

⁴ Kahrl, p 2-54

⁵ 16 US (3 Wheat.) 454, 475 (1818).

⁶ 56 US (15 How.) 330 (1853).

⁷ *Id.* at 341.

⁸ *Id.* at 344.

⁹ 82 US (15 Wall.) 187, 194 (1872).

¹⁰ 520 US 17, 37, 41 USPQ2d 1865, 1874 (1997).

¹¹ 339 US 605, 85 USPQ 328 (1950).

¹² 97 US 120 (1877).

¹³ 339 US 605, 85 USPQ 328, 330 (1950).