

***Warner-Jenkinson Co. v. Hilton-Davis Chemical Co.*: Apt Reconciliation of Supreme Court Precedent, and Reasoned Instruction to a Trusted Federal Circuit  
1997**

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On March 3, 1997, the United States Supreme Court issued its much-awaited opinion in *Warner-Jenkinson Co. v. Hilton-Davis Chemical Co.* The decision could have profoundly changed central issues of the United States patent law: Is there a doctrine of equivalents in United States Patent Law, and if there is, how is equivalence to be determined, and by whom? Indeed, the Petitioner's primary argument to the Court was that the doctrine of equivalents did not survive the 1952 revision of the Patent Act, 35 U.S.C. sub-section 100 et. seq.

Instead of profound change, a fair reading of the decision is that the Supreme Court aptly reconciled its precedent in the area of the doctrine of equivalents, and provided reasoned instruction to a trusted Federal Circuit toward unsupervised further development of the law of equivalents. Summarily stated, the Court did the following:

1. Adopted the view from below of the late Judge Nies that the doctrine of equivalents is applied to individual claim elements, not whole claimed inventions. This analysis is said to harmonize the doctrine of equivalents with the statutory requirement that the claims define the scope of the invention.
2. Declined to address whether a court or a jury should decide the equivalence issue. There is said to be "ample" support for the Federal Circuit decision that the jury should decide the issue. *Markman* is taught to be not to the contrary, and the Federal Circuit is left to its own decision.
3. Decided that proof of intent is not required when determining infringement under the doctrine of equivalents. Indeed, the Court states: "The better view . . . is that intent plays no role in the application of the doctrine of equivalents."
4. Affirmed the traditional role of prosecution history estoppel as relating to amendments made to avoid the prior art *but* added a rebuttable presumption "that the PTO had a substantial reason relating to patentability for including the limiting element added by amendment." Courts must consider the purpose for the amendment to determine whether estoppel is precluded. Unless rebutted by the patent holder, estoppel applies.
5. Resolved that equivalence is to be determined as of the "time of infringement" rather than the time of patent issue. As a corollary, equivalents need not be known by the patentee or disclosed in the patent.
6. Noted objections with all equivalence tests, and left to the Federal Circuit further developments of the "true" test. To the Court, neither the tripartite test nor the insubstantial differences test is considered sufficient or as important as whether an essential inquiry is answered: "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" The Court noted that a focus on the elements and "special vigilance" to make sure that equivalence does not eliminate the elements 'should reduce considerably the imprecision of whatever language is used.

**BACKGROUND**

*Warner-Jenkins Co. v. Hilton-Davis Chemical Co.* involved a patent claims with a lower pH limit inserted at the insistence of an Examiner where the prior art limited the claim only as to an upper pH limit. The claim was limited to a pH range of approximately 6.0 to 9.0, and the parties disputed equivalence and infringement where the accused process was operated at a pH of 5.0. In its initial en banc decision, the Federal Circuit "fractured" into a majority of seven, with three separate dissents commanding a total of five judges. The Federal Circuit held that the doctrine of equivalents tests whether there are "insubstantial

differences between the claimed and accused products or processes." *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1522-23 (Fed. Cir. 1995.) The function-way-result test was characterized as one of many ways to measure the substantiality or insubstantiality of the differences. Relevant facts were said to include the circumstances of copying (or its opposite: independent discovery), or difficulties in designing around the patent claims. Because infringement is a factual question, focused on differences from a claimed invention, the subjective intent or motivation of the accused infringer is relevant only for determining and quantifying enhanced damages, not equivalents.

## **THE APPEAL**

The question before the Supreme Court was whether a patent is infringed when a product is the "equivalent" to the invention claimed in a patent, even though the second product is outside the literal scope of the patent claim? There were a variety of positions presented to the Court for consideration. The following is an exemplary list:

For the Petitioner: The doctrine of equivalents did not survive the 1952 revision of the Patent Act. As fall back arguments, the reason for an amendment during prosecution is irrelevant, and any amendment leads to estoppel; the doctrine requires condemnable intent of an alleged infringer for its application; and the doctrine should be limited to equivalents disclosed within the patent itself.

For the Respondent: The Federal Circuit, exclusively charged by Congress to unify the patent law, after spirited debate, with benefit of enlightened wisdom, and *amicus* assistance, faithfully restated the doctrine of equivalents. The doctrine was not abolished by the 1952 Patent Act.

For *amicus* The United States: The doctrine of equivalents is a useful equitable doctrine properly invoked on a showing that differences from the patent claims are insubstantial, with important indicators of insubstantiality including but not limited the function/way/result test. The comparison must be made, not relative to the invention as a whole, but on an element-by-element basis. Prosecution history estoppel should exist within the limits of preventing recapture of surrendered turf.

For *amicus* American Intellectual Property Law Association: The Federal Circuit was correct in holding that infringement under the doctrine of equivalents can be found only when departure from the literal scope of a patent claim was insubstantial. Neither the application nor the scope of the doctrine should depend on equities uniquely related to acts or the intent of a specific infringer.

For *amicus* Automobile Manufacturers Association: The doctrine of equivalents should be restored to the purpose for which it was created and applied in *Graver Tank*: an equity exception, dependent on the equities existing between the parties, to an otherwise strict commandment for definiteness in patents.

For *amicus* Information Technology Industry Council and Intel Corporation: The Federal Circuit departed from established precedent. The function/way/result test should continue as the framework for equivalency.

For *amicus* MCI Telecommunications: The doctrine of equivalents should be limited to providing relief from deliberate copying. It should be applied only where evidence establishes that the patentee contemplated the specific copy at issue or the extension of the patent necessary to accomplish it; where the patent, as written, enables construction of use of the accused product or process; and only within the limits of disclaimers during prosecution which provide notice that the invention patented does not include the elements that were abandoned.

For *amicus* GHZ Equipment Co.: The doctrine of equivalents should be returned to former status on the margins of patent law as an equitable exception applicable only in unusual circumstances.

For *amicus* Intellectual Property Owners: Congress did not eliminate the doctrine of equivalents in passing the 1952 Patent Act. The doctrine should be a decision whether a variation from literal requirements of a

claim are substantial or insubstantial, based on the understanding of one of skill in the art based on objective information from the patent, its history and the prior art. Subjective factors should be excluded.

For *amicus* Micron Separations, Inc.: The Federal Circuit's *Hilton Davis* decision was incongruous with statutory procedures which prohibit broadening patent claims except within two years of patent issue. The Supreme Court needs to provide concrete, narrowly defined limits to the doctrine.

For *amicus* Gateway Technologies, Inc.: It is high time the Court restore the doctrine of equivalents to a proper, limited role in patent litigation: preventing copying.

For *amicus* Chemical Manufacturers Association: The doctrine of equivalents has an important remedial function: it diminishes possibly varying literal constructions of patents with a mandated focus on the substance of what is claimed.

For *amicus* Ohio State Bar Association: Nothing demonstrates any pattern of substantial injustice or unconscionable results that would justify altering the doctrine of equivalents. Comments in the Federal Circuit of hostility for juries should be rejected. For *amicus* Biotechnology Industry Organization: For patented inventions involving sophisticated technologies, the doctrine of equivalents is critical for ensuring protection for the patented invention. The intent of an infringer is not relevant.

For *amicus* Licensing Executive Society: The Court's guidance and clarification is necessary to provide predictability in equivalency analysis.

For *amicus* Litton Systems, Inc.: The Petitioner would have the Court ignore settled law and radically narrow patent law. Congress has never displaced the doctrine. There is no real support for Petitioner's request.

For *amicus* Chiron Corp.: The biotechnology industry depends on a health doctrine of equivalents. Elimination of the doctrine would result in predictable adversities. Practices in Japan substantiate fear of burial of patent owners' competitors with avalanches of trivial information in patents.

## **APT RECONCILIATION OF SUPREME COURT PRECEDENT**

In an opinion delivered by Justice Thomas, the Supreme Court affirmed the doctrine of equivalents and its harmony with infringement of a "means" claim in 35 U.S.C. sub-section 112 paragraph 6. The Court cited *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950) in the opinion's first paragraph as establishing "the modern contours of . . . the doctrine of equivalents." This demonstration of respect for *Graver Tank* presaged the outcome of the Petitioner's argument that the 1952 Act abolished the doctrine. The Court declined Petitioner's invitation to 'speak the death of [the] doctrine,' noting that Petitioner's specific arguments for the end of the doctrine (except one) as a consequence of the 1952 Patent Act were arguments made in *Graver Tank* as to the 1870 Patent Act. All were found to be insufficient.

The Petitioner's remaining argument was that inclusion of an "equivalents" test in paragraph 6 of 35 U.S.C. sub-section 112 of the 1952 Act reflected Congressional intent to abolish the doctrine of equivalents except as adopted in paragraph 6. The Court resolved this argument to be insufficient because the legislative history of paragraph 6 demonstrated that Congress was responding to *Haliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946). The Court declined to read such "limited Congressional action" as "a dubious negative inference" that Congress intended to abolish an entire body of case law.

Having established the vitality of the doctrine of equivalents, the Court turned to the role of the doctrine, the post-*Graver* developments, and the issues of modern-day practice. The doctrine, noted the Court, has "taken on a life of its own, unbounded by the patent claims." There can be "no denying" that the doctrine conflicts with the statute's definition and public notice functions of claims. But how to reconcile the doctrine's apparent ability to declare products and processes outside the claims as infringing nonetheless?

The Court adopted the methodology of the late Helen Nies from her dissent below in distinguishing (a) substituting an equivalent for a component in an invention from (b) enlarging the scope of an invention beyond what is claimed. "[T]he doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole." Further, even as to single limitations, the doctrine should not be allowed to "effectively eliminate [an] element." Thus, the Court clarified the doctrine as requiring an analysis of equivalents as to individual elements.

The Court looked at both the function/way/result and the "insubstantial differences" tests for infringement under the doctrine and found difficulties with both. Neither was sufficient alone. Ultimately, the Court rejected conventional labels and characterizations. The test of infringement under the doctrine of equivalents requires "an essential inquiry: Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?"

### **REASONED INSTRUCTION TO A TRUSTED FEDERAL CIRCUIT**

The majority of the patent bar, as it awaited *Hilton Davis*, did not seem greatly anxious about whether there would continue to be a doctrine of equivalents. Its role and usefulness have been too well ingrained into the patent law.

The question of most interest was the test by which equivalency would be determined. For many, the "insubstantial differences" and "function/way/result" tests both lack contours of intellectual satisfaction appropriate for so important a question of patent practice. Both allow too much argument in the specific case for either to promote uniformly just and predictable outcomes of disputes. Yet to many, the Federal Circuit's "hybridized" formulation of its opinion did not sufficiently promote uniformity. Thus, many patent bar Court watchers hoped for broad, new definition for the test of equivalency.

Hopes were dashed. *Hilton Davis* does not provide a broad, new direction for the doctrine of equivalents. According to the Court, the particular "linguistic framework" of the test of equivalency is not important as long as it answers the essential inquiry: "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" Thus, *Hilton Davis* leaves the linguistic phrasing of the doctrine to the Federal Circuit. "Special expertise" is said to exist in the Federal Circuit, with the result that the Supreme Court has "no need . . . in micromanaging the Federal Circuit's particular word choice for analyzing infringement." Thus, on remand, to the extent the Federal Circuit chooses, it may make its most recently stated, "hybridized," linguistic formulation of the test for equivalence the law of the land. Further, to the extent to which it chooses, the Federal Circuit may change the test from there, within the broad limits of *stare decisis* and sound judicial reasoning. In doing so, it will not be "micromanaged" because of its special expertise.

Concerning the raging controversy whether judges or juries should decide equivalents, the Supreme Court declined to address the issue. It stated only that there was "ample" support for the Federal Circuit decision that juries should decide the issue. Thus, again, trust was placed in the Federal Circuit.

To the extent the Supreme Court made specific decisions beyond those discussed, rather than leave issues for the Federal Circuit, it decided only:

Proof of intent is not required when determining infringement under the doctrine of equivalents.

Prosecution history estoppel continues its traditional role as relating to amendments made to avoid the prior art. A rebuttable presumption is added "that the PTO had a substantial reason relating to patentability for including [a] limiting element added by amendment." Courts must consider the purpose for amendments to determine whether estoppel applies. Unless rebutted by the patent holder, estoppel applies.

Equivalence is to be determined as of the "time of infringement" rather than the time of patent issue. As a corollary, equivalents need not be known by the patentee or disclosed in the patent.

The Supreme Court's Hilton-Davis opinion is likely a net benefit for patent owners and the courts.

The doctrine of equivalents is retained. Its formulation may vary with flexibility and dependent on the case.

The standard for appellate review of equivalents will likely be lower than the "abuse of discretion" standard that would have been applied if the doctrine were a discretionary matter.

Trial judges have a clearer standard for determining the relevance and weight of evidence, in now knowing that equivalence is determined at the time of infringement.

The burden on applicants is reduced in that they need not imagine and disclose potential claim element variations as insurance against restricted claim coverage under equivalents.

Condemnable intent of the accused defendant need not be shown to prove infringement under equivalents.

The rebuttable presumption of prosecution history estoppel provides courts with parties who must present evidence to avoid estoppel or suffer it.

At the same time, those seeking to respect and avoid patents benefit from an "all-elements" rule of equivalents.

## **CONCLUSION**

There is a doctrine of equivalents now and for the 21st Century. It newly tests the equivalence of the accused device or process to the claimed invention on an element-by-element basis. To the extent the Federal Circuit chooses, it may on remand make its most recently stated, "hybridized," linguistic formulation of the test for equivalence the law of the land. To the extent to which it chooses, the Federal Circuit may change the test from there, within the broad limits of stare decisis and sound judicial reasoning.