

## The Diminishing Claim Vitiating Limitation to the Doctrine of Equivalents

By Albert Shih and James Yoon

Infringement under the doctrine of equivalents (“DOE”) is frequently asserted in patent litigation. DOE allows a plaintiff to maintain an infringement claim even if the accused instrumentality does not literally possess all the limitations of the claim as interpreted by the court.

Under DOE, an accused instrumentality infringes an asserted patent claim if the differences between the missing patent claim limitation and the accused instrumentality are insubstantial. The most common test for determining whether differences are insubstantial (and, thus, the accused instrumentality is an “equivalent”) is the function-way-result test, that is, asking whether the accused instrumentality performs the same function, in the same way, and achieves the same result, as what is disclosed in a patent claim. If the answers are in the affirmative, the accused instrumentality is found to infringe because it includes the equivalent of the missing limitation (as well as literally possessing the remaining limitations of the claim). Because DOE expands the scope of a patent claim, it is a powerful tool for patent holders as well as a source of concern for the courts because the expansive application of DOE may negate the public notice function of patent claims and create more uncertainty for patent defendants. As a result, the courts have placed a number of restric-

tions on its application in patent cases.

Prosecution history estoppel, or file wrapper estoppel, is one of the most important restrictions that courts have placed on the application of DOE infringement claims. This estoppel generally prohibits the use of DOE on claim limitations that were amended during the prosecution of a patent claim to overcome a rejection by the patent examiner. See generally, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). Courts prohibit the use of DOE on the ground that the public has a right to rely on the public statements made by a patent applicant to obtain his or her patent. *Id.*

Another important restriction on the application of DOE is the rule that the application must not “vitate the central functions of patent claims to define the invention.” *Warner-Jenkinson Company, Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997). This restriction on DOE is known as claim vitiating. Claim vitiating is a question of law for the court. Under claim vitiating, the court must determine whether application of DOE would eliminate or remove a limitation from a patent claim. If so, application of DOE is not permitted. However, as shown most recently in the decision of *Brilliant Instrument Inc. v. Guidetech*, 2013 WL 616915 (Fed. Cir. Feb. 20, 2013), the Federal Circuit appears to have shifted away from applying claim vitiating as a defense or exception separate from the function-way-result test.

its microprocessor circuit designs did not infringe the claims of three Guidetech patents. One of these patents included a claim with the following limitation: “said shunt and said capacitor are operatively disposed in parallel with respect to said first current circuit” (emphasis added). Brilliant argued that it did not literally infringe because its microprocessor designs include a capacitor that was *part of* the accused first current circuit, and *not in parallel* to the accused first current circuit. Brilliant further argued that “infringement theory under the doctrine of equivalents fails because it would vitiate the requirement that the claimed ‘first current circuit’ and the ‘capacitor’ are separate elements.” *Brilliant Instrument* at \*4. In response, Guidetech argued that nothing in the claim precludes the capacitor to be *part of* the first current circuit, and offered expert testimony that “the operation of the accused products was equivalent to operatively disposing the shunt and capacitor in parallel with respect to the first current circuit.” *Id.* The district court agreed with Brilliant and concluded there is no infringement literally or under the doctrine of equivalents. On appeal, the Federal Circuit agreed that there is no literal infringement of this element, but disagreed with Brilliant that claim vitiating renders the application of the doctrine of equivalents unavailable.

The court began by declaring that vitiating “is not an exception to the doctrine of equivalents, but instead a legal determination that ‘the evidence is such that no reasonable jury could determine two elements to be equivalent.’” *Brilliant Instrument* at \*5 (citing *Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349 (Fed. Cir.

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Albert Shih is an associate and James Yoon is a partner in the Palo Alto office of Wilson Sonsini Goodrich & Rosati.

### BRILLIANT INSTRUMENT

In *Brilliant Instrument*, plaintiff Brilliant sought a declaratory judgment that

2012)). The court explained that “the vitiation test cannot be satisfied by simply noting that an element is missing from the claimed structure or process because the doctrine of equivalents, by definition, recognizes that an element is missing that must be supplied by the equivalent substitute,” *Id.*, and that “[t]he vitiation concept has its clearest application ‘where the accused device contain[s] the antithesis of the claimed structure.’” *Id.* (citing *Planet Bingo, LLC v. GameTech Int’l, Inc.*, 472 F.3d 1338, 1345 (Fed. Cir. 2006)). The court then rejected Brilliant’s claim vitiation analysis, and framed the proper inquiry in the context of the function-way-result test, that is, “whether Brilliant’s capacitor, located *within* the first current circuit, performs substantially the same function in substantially the same way to achieve substantially the same result as the claimed capacitor, which is operatively disposed in *parallel* to the shunt.” *Id.* at 6 (emphasis added). The court concluded that Guidetech’s function-way-result analysis created a genuine issue of material fact for the jury, and reversed summary judgment of non-infringement under the doctrine of equivalents.

In rejecting Brilliant’s claim vitiation argument, the court unequivocally instructed that “[t]he proper inquiry for the court is to apply the doctrine of equivalents, asking whether an asserted equivalent represents an ‘insubstantial difference’ from the claimed element, or whether the substitute element matches the function, way, and result of the claimed element.” *Id.* at \*5 (citing *Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349 (Fed. Cir. 2012)). The court highlighted the fact that “Brilliant does not contest [Guidetech’s] recitations of the function, way, and result of the asserted claims or the accused products” or “provide any contrary evidence.” *Id.* at \*4. On the other hand, the court deduced the doctrine of claim vitiation to be simply “an acknowledgement that each element in the claim must be present in the accused device either literally or equivalently,” *Id.* at \*5, and cited two prior cases where the “concept of vitiation” is properly applied and the alternatives are found to be substantially different — in *Planet Bingo*,

where the court found “determining a winning combination *after* a game starts was not equivalent to determining a winning combination *before* the game starts, and in *Moore U.S.A., Inc. v. Std. Register Co.*, 229 F.3d 1091, 1106 (Fed. Cir. 2000), where the court found a claim limitation calling for majority cannot be found to be insubstantially different from minority.

### SUBSTANTIAL UNCERTAINTY

The reasoning in *Brilliant Instrument* has created substantial uncertainty regarding the doctrine of claim vitiation. For example, it is not clear that any capacitor configuration, including serial configuration which is often regarded to be “polar opposite” to parallel configuration, would have been considered by the *Brilliant Instruments* court to satisfy the claim vitiation requirement. A review of other recent decisions suggests that the court’s approach is very fact-dependent and focuses more on the function of the claimed instrumentality. For example, in *Cordis Corp. v. Boston Scientific Corp., et al.*, 561 F.3d 1319 (Fed. Cir. 2009), the court concluded that “circular arcs ... are not antithetical to the ‘corners’ limitation,” because they do not “render[ ] the pertinent limitation meaningless” or “effectively eliminate that element in its entirety.” *Cordis* at 1330 (citations omitted). In *Deere & Company v. Bush Hog, LLC*, 703 F.3d 1349 (Fed. Cir. 2012), the court suggests that a reasonable jury could find that having “a small spacer connecting the upper and lower deck walls represents an insubstantial difference from direct contact [of the upper and lower deck walls].” *Deere* at 1357. In *Trading Techs. Int’l, Inc. v. eSpeed, Inc.*, 595 F.3d 1340 (Fed. Cir. 2010), the Federal Circuit affirmed the district court’s decision that “an occasional automatic re-centering” in the accused instrumentality would vitiate the claim element “a static display of price,” which was construed to mean “never chang[ing] positions unless by manual re-centering or re-positioning.”

Moreover, it is unclear from *Brilliant Instrument* and other recent decisions whether claim vitiation is still a separate hurdle that a patent holder must

satisfy under DOE. Judge Randall R. Rader’s additional views in *Nystrom v. Trex Co., Inc.*, 580 F.3d 1281 (Fed. Cir. 2009) echoed the sentiment of diminishing claim vitiation limitation proffered in *Brilliant Instrument*:

Claim vitiation bars infringement because the same deficit is substantial. In other words, claim vitiation, by definition, simply rewinds and replays the doctrine of equivalents test for substantiality of a missing claim limitation. Thus, a finding of insubstantial difference to show equivalency obviates any further vitiation analysis — the wholly insignificant equivalent, by definition, would not vitiate the claim. On the other hand, a finding of substantial difference renders vitiation unnecessary. Thus, the vitiation doctrine is really subsumed within the test for equivalents itself. *Nystrom* at 1287.

However, one important distinction between DOE and claim vitiation does remain, as Judge Rader pointed out in *Nystrom*, “[j]udges decide vitiation; juries decide equivalents.” *Id.* Thus, while greatly diminished, claim vitiation will continue to be asserted as a defense at least during the summary judgment stage of litigation. It will remain a defense (and source of confusion) until the courts unequivocally declare that claim vitiation is no longer a viable legal determination separate from the insubstantial difference tests under DOE (e.g., function-way-result).

