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PROSECUTION HISTORY ESTOPPEL AND THE DOCTRINE OF EQUIVALENTS: PROSECUTION HISTORY ESTOPPEL IS PRESUMED TO APPLY IF THERE WAS A NARROWING AMENDMENT, AND THEN PATENT HOLDER HAS BURDEN TO SHOW AN EXCEPTION IN ORDER TO ALLEGE INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS.

By: Darren Crew

例年にない寒さでございますが、皆様にはますますご発展の事とお喜び申し上げます。

In *Integrated Technology Corp. v. Rudolph Technologies, Inc.*, Appeal No. 2012-1593 (Fed. Cir., November 4, 2013), the U.S. Court of Appeals for the Federal Circuit (CAFC) reversed the district court regarding infringement under the doctrine of equivalents (before Chief Judge Rader, Circuit Judge Clevenger, and Circuit Judge Moore) (precedential).

Background

Integrated Technology Corp. (ITC) sued Rudolph Technologies, Inc. (Rudolph) for patent infringement, relating to a probe card inspection system claimed in ITC's U.S. Patent No. 6,118,894 (the '894 patent). The district court held that Rudolph's "no touch" products infringed the '894 patent under the doctrine of equivalents. Rudolph's "no touch" products obtain a first image when the probe tips are approximately five microns above the viewing window.

Claim 1 of the '894 patent is representative and recites "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*, and in a second state where said probe tip is driven in contact with said window with a second force" (emphasis added).

The original claim 1 sets forth "a window with a flat surface contacted by said probe tip" and was rejected by the Examiner as indefinite under the second paragraph of 35 U.S.C. §112 and as anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 4,757,256. ITC responded by amending the claim to additionally set forth features including at least the following features "in a first state where said probe tip is driven in contact with said window with a first force."

The district court found: (1) prosecution history estoppel does not preclude a finding of infringement under the doctrine of equivalents; (2) the original claim and the issued claim both required contact between a plate and a probe tip; (3) ITC therefore did not make a narrowing amendment; and (4) Rudolph's "no touch" products infringed the '894 patent under the doctrine of equivalents.

CAFC Holding and Discussion

The CAFC reversed the district court's holding regarding infringement under the doctrine of equivalents. The CAFC found that: (1) prosecution history estoppel presumptively applies when an amendment narrows the scope of a claim in response to a patentability rejection; (2) the original claim was modified to add that there must be two different forces that drive a probe tip in contact with the viewing window in two separate states; (3) ITC made a narrowing amendment, and ITC failed to meet its burden of proving that an exception to prosecution history estoppel applies; and (4) Rudolph's "no touch" products did not infringe the '894 patent under the doctrine of equivalents.

Prosecution history estoppel prevents a patentee from recapturing, through the doctrine of equivalents, subject matter that an applicant surrendered during prosecution. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002). The CAFC indicated that prosecution history estoppel presumptively applies when an amendment narrows the scope of a claim in response to a patentability rejection. The CAFC also indicated that, when it is found that an amendment narrows the scope of a claim in response to a patentability rejection, and the patent holder desires to show that a party infringed under the doctrine of equivalents, the patent holder has a burden to prove, by a preponderance of evidence, that at least one of the following three exceptions to prosecution history estoppel applies:

- rationale underlying amendment may bear no more than a tangential relation to the equivalent;
- the equivalent may have been unforeseeable at the time of the application; or
- patentee could not reasonably be expected to have described the equivalent.

Conclusion

The CAFC found that ITC's amendment during prosecution was a narrowing amendment that surrendered an equivalent product from the scope of the asserted claims, and thus prosecution history estoppel presumptively bars the application of the doctrine of equivalents. ITC failed to rebut the presumption by establishing that any exception to prosecution history estoppel applies. Thus, the CAFC held that application of prosecution history estoppel resulted in Rudolph's "no touch" products not infringing the '894 patent under the doctrine of equivalents.

Please note that the CAFC also addressed additional issues, for example, regarding damages, laches, and Rudolph's other products. If you are interested in such additional issues, please feel free to contact us for more information.

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