

Federal Circuit Clarifies That Foreseeability Does Not Preclude the Application of the Doctrine of Equivalents

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On February 19, 2014, the Federal Circuit issued a unanimous decision clarifying that the foreseeability of an alleged equivalent at the time of patenting is not a bar to a finding of infringement under the doctrine of equivalents, effectively removing an often-asserted noninfringement argument by alleged infringers. *Ring & Pinion Service Inc. v. Arb Corp. Ltd.*, No. 2013-1238 (Fed. Cir. Feb. 19, 2014). [Read the decision here.](#)

The '098 patent-in-suit covers an improved automobile locking differential that allows wheels to rotate at different speeds while distributing torque such that both wheels spin at the same rate when locked. *Id.* at 2. The parties agreed that the infringing product literally met every claim limitation except for the "cylinder means formed in" limitation, and that the "equivalent" cylinder used would have been foreseeable to a person of ordinary skill in the art at the time the '098 patent application was filed. *Id.* at 2-3. Accordingly, the parties stipulated that the issue of infringement would be governed by the district court's determination of whether an equivalent is barred under the doctrine of equivalents because it was foreseeable at the time of the patent application. *Id.* at 3.

The alleged infringer, Ring & Pinion — like many other alleged infringers — argued that *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997), set a "general foreseeability bar to the doctrine of equivalents." Slip Op. at 5. The unanimous Federal Circuit panel, however, explained that *Sage Products* "held that claim vitiation, not foreseeability, prevented the application of the doctrine of equivalents in that case because its application 'would have utterly written' express limitations 'out of the claim.'" *Id.* Accordingly, *Sage Products* "did not create a foreseeability limitation on the doctrine of equivalents."¹ *Id.* at 5-6. Indeed, the Federal Circuit explicitly stated that "[t]here is not, nor has there ever been, a foreseeability limitation on the application of the doctrine of equivalents," and that "[e]xcluding equivalents that were foreseeable at the time of patenting would directly conflict with

¹ While the district court correctly recognized that foreseeability did not preclude the doctrine of equivalents, it ultimately found that infringement under the doctrine of equivalents would vitiate the "cylinder means formed in" limitation and granted summary judgment of noninfringement. *Id.* at 3. Reversing the district court, the Federal Circuit explained that "[v]itiation 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,'" and that the parties' stipulation dictated a finding of infringement. *Id.* at 9.

[previous holdings of the Federal Circuit as well as the Supreme Court] that ‘known interchangeability’ supports infringement under the doctrine of equivalents.” *Id.* at 4-5.

This decision provides helpful clarity that foreseeability, in and of itself, does not provide an exception to the doctrine of equivalents, and — in fact — can support a finding of infringement under that doctrine.

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If you have any questions concerning these developing issues, please do not hesitate to contact any of the following Paul Hastings lawyers:

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