

ALERT

Federal Circuit Patent Bulletin: *Ring & Pinion Serv. Inc. v. ARB Corp.*

February 19, 2014

"[F]oreseeability of an equivalent at the time of patenting is not a bar to a finding of infringement under the doctrine of equivalents."

On February 19, 2014, in *Ring & Pinion Serv. Inc. v. ARB Corp.*, the U.S. Court of Appeals for the Federal Circuit (Moore,* Clevenger, Reyna) reversed and remanded the district court's summary judgment that R&P did not infringe U.S. Patent No. 5,591,098, which related to an improved automobile locking differential that allows wheels to rotate at different speeds relative to each other. The Federal Circuit stated:

There is not, nor has there ever been, a foreseeability limitation on the application of the doctrine of equivalents. It has long been clear that known interchangeability weighs in favor of finding infringement under the doctrine of equivalents. Excluding equivalents that were foreseeable at the time of patenting would directly conflict with these holdings that "known interchangeability" supports infringement under the doctrine of equivalents. We conclude that the foreseeability of an equivalent at the time of patenting is not a bar to a finding of infringement under the doctrine of equivalents.

[T]here are two differences between the equivalence determination made for literal infringement purposes under § 112(f) and a doctrine of equivalents determination for the same limitation: timing and function. Equivalence under section 112(f) is evaluated at the time of issuance. Equivalence under the doctrine of equivalents, in contrast, is evaluated at the time of infringement. Hence, an after-arising technology, a technology that did not exist at the time of patenting, can be found to be an equivalent under the doctrine of equivalents even though it cannot be an equivalent under the literal infringement analysis of § 112(f). The second difference between literal infringement and doctrine of equivalents infringement under § 112(f) relates to the function of the element. For literal infringement, the accused structures must perform the function recited in the claim (identical function). The doctrine of equivalents covers accused structures that perform substantially the same function in substantially the same way with substantially the same results. The doctrine of equivalents thus covers structures with equivalent, but not identical, functions. This is true whether the

accused equivalent was known at the time of patenting or later arising. [W]hether the accused structure “predates” the patent or is after-arising technology, the doctrine of equivalents applied to a means-plus-function clause requires only that equivalent structures perform substantially the same function. Where a finding of noninfringement under § 112(f) is based solely on the lack of identical function, it does not preclude a finding of equivalence under the doctrine of equivalents. [W]hen the accused technology was known at the time of patenting and the functions are identical, the structural equivalence inquiry under § 112 and the structural equivalence portion of the doctrine of equivalents are coextensive. . . .

We agree with the district court that foreseeability does not create a bar to the application of the doctrine of equivalents. Given the joint stipulation, this conclusion should have resolved the case and the court should have entered a judgment of infringement pursuant to the stipulation. [W]e find that ARB did not waive its argument that the joint stipulation should have been enforced by the court. The stipulation and the parties’ briefing were sufficient to provide notice to R&P of the possible impact of the joint stipulation. We further agree with ARB that the district court erred by failing to enforce the parties’ stipulation. A stipulation of fact that is fairly entered into is controlling on the parties and the court is generally bound to enforce it. Here, the parties stipulated to equivalence, which is a question of fact, and agreed that there were no remaining issues of fact. The district court nonetheless held that a finding of infringement under the doctrine of equivalents would vitiate the “cylinder means formed in . . .” claim limitation. That was legal error.

Vitiation 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.” The parties’ stipulation precludes the conclusion that the “cylinder means formed in . . .” limitation is vitiated because it states that the Ziplocker includes an equivalent to that limitation. Thus, we hold that the court erred by failing to grant summary judgment of infringement to ARB under the doctrine of equivalents.