

**ALERT**

## **Federal Circuit Patent Bulletin: *EMD Millipore Corp. v. AllPure Techs., Inc.***

September 30, 2014

*“Where no explanation is established . . . the court should presume that the patent applicant had a substantial reason related to patentability for including the limiting element added by amendment.”*

On September 29, 2014, in *EMD Millipore Corp. v. AllPure Techs., Inc.*, the U.S. Court of Appeals for the Federal Circuit (Prost,\* O’Malley, Hughes) affirmed the district court’s summary judgment that AllPure did not infringe U.S. Patent No. 6,032,543, which related to a device for introducing or withdrawing a sample from a container holding a fluid without contaminating the fluid. The Federal Circuit stated:

While we review summary judgment decisions de novo, “[i]nfringement, whether literal or under the doctrine of equivalents, is a question of fact.” However, “a court may determine infringement on summary judgment ‘when no reasonable jury could find that every limitation recited in the properly construed claim either is or is not found in the accused device.’” Whether prosecution history estoppel applies to a particular argument, and thus whether the doctrine of equivalents is available for a particular claim limitation, is a question of law reviewed de novo. . . .

The district court construed the claim limitation “at least one removable, replaceable transfer member” to mean “at least one transfer member that can be removed from the magazine part of the device and replaced with at least one removable, replaceable transfer member.” Neither party has challenged this construction. However, the parties disagree over the meaning of the term “removed,” as contained in the district court’s construction. . . . If a transfer member does not exist when the device is disassembled, as even Millipore’s counsel admitted, then there is no genuine issue of material fact over whether the TAKEONE device contains a “removable, replaceable transfer member” as is literally required by claim 1 of the ‘543 patent. As the district court properly noted, “[t]he problem with Millipore’s characterization of ‘removal’ of a transfer member . . . is the absence of necessary component parts of the transfer member once it is removed . . . . [T]he part of the device removable from the magazine part must have all of the component parts—a holder, needle, and seal.” Since the TAKEONE device lacks a seal when it is disassembled, it necessarily lacks the claimed “removable,

replaceable transfer member.” . . .

Even without literal infringement of a certain claim limitation, a patentee may establish infringement under the doctrine of equivalents if an element of the accused device “performs substantially the same function in substantially the same way to obtain the same result as the claim limitation.” . . . Prosecution history estoppel applies when an applicant during patent prosecution narrows a claim “to avoid the prior art, or otherwise to address a specific concern . . . that arguably would have rendered the claimed subject matter unpatentable.” Estoppel then bars the applicant from later invoking the doctrine of equivalents to recapture the surrendered ground. There is a presumption that prosecution history estoppel applies when a patentee has filed an amendment seeking to narrow the scope of a claim, and “the reason for that amendment was a substantial one relating to patentability.” The patentee bears the burden of rebutting the application of prosecution history estoppel by establishing one of three exceptions: (1) the equivalent was unforeseeable at the time of the application; (2) the rationale underlying the amendment bears no more than a tangential relation to the equivalent in question; or (3) there is some other reason suggesting that the patentee could not same function in substantially the same way to obtain the same result.

[We] conclude that it was unnecessary for the district court to perform a doctrine of equivalents analysis because prosecution history estoppel bars Millipore’s arguments. Although the applicant eliminated the “after use” language, the applicant nonetheless added the requirement that the seal have a first and second end with distinct elements. This narrows the seal limitation, which in turn narrows the transfer member limitation. And the applicant even stated in its reasons for amendment that “none of the references show or disclose a seal formed like the present one.” Thus, these amendments were added to overcome a previous rejection. And to the extent this statement is ambiguous, we note that the Supreme Court has stated “[w]here no explanation is established . . . the court should presume that the patent applicant had a substantial reason related to patentability for including the limiting element added by amendment.”

The district court should have proceeded under the presumption that prosecution history estoppel applies. Millipore then had the burden to rebut the presumption through one of the three enumerated exceptions, but Millipore chose not to present any argument on this issue to the district court. . . . Instead it argued that the amendment was not narrowing. Since Millipore failed to rebut the presumption, the district court should have concluded that Millipore was barred from arguing that the TAKEONE device infringes the transfer member limitation under the doctrine of equivalents. This error, however, does not change the outcome of this case, as the district court still proceeded to grant summary judgment of no infringement under the doctrine of equivalents on the merits.