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# *The Doctrine of Equivalents and Its Limitations, Including “Ensnarement,” a Particularly Potent Defense*

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The pronouncement of a recent Federal Circuit panel in *Amgen Inc. v. Sandoz Inc.* that the “doctrine of equivalents applies only in exceptional cases”<sup>1</sup> may have led some to question the continued viability of the doctrine. But a closer examination of that decision and other Federal Circuit jurisprudence confirms that the doctrine of equivalents (DOE) is alive and well. Indeed, less than two months after *Sandoz*, another Federal Circuit panel in *UCB, Inc. v. Watson Laboratories, Inc.*<sup>2</sup> affirmed a finding of infringement under the DOE without mentioning *Sandoz*. And on September 3, 2019, the original *Sandoz* panel granted Amgen’s petition for rehearing “to the extent” that it would remove the phrase “applies only in exceptional cases” from its earlier order.<sup>3</sup>

But there are limits to the doctrine. As noted by the *Sandoz* panel, the DOE is not “simply the second prong of every infringement charge, regularly available to extend protection beyond the scope of the claims.”<sup>4</sup> This comment reflects the DOE’s pleading and proof requirements as well as several judicial limitations. In other words, the DOE, although still viable, is the exception—not the rule.

After a brief overview of the DOE, we will review several limitations on the doctrine, with a focus on ensnarement, a useful (and somewhat overlooked) tool for defendants.

## **I. Application of the Doctrine of Equivalents Is the Exception, not the Rule**

The DOE is premised on a balancing of competing policies that support the Constitutional purpose of promoting the “useful arts”:

On the one hand claims must be “particular” and “distinct,” as required by 35 U.S.C. § 112, so that the public has fair notice of what the patentee and the

Patent and Trademark Office have agreed constitute the metes and bounds of the claimed invention . . . . On the other hand, the patentee should not be deprived of the benefits of his patent by competitors who appropriate the essence of an invention while barely avoiding the literal language of the claims. . . . Application of the doctrine of equivalents is the exception, however, not the rule.<sup>5</sup>

The application of the DOE is nondiscretionary—every patent holder is entitled to invoke the doctrine *within* the confines of its limitations.<sup>6</sup> The Supreme Court has set forth two frameworks for evaluating equivalency: the function-way-result test and the insubstantial differences test.<sup>7</sup> In the function-way-result test, the patentee must show that one of ordinary skill in the art would consider that the alleged equivalent in the accused product/process performs substantially the same function in substantially the same way to achieve the same result as the pertinent claim limitation.<sup>8</sup> Under the insubstantial differences test, “[a]n element in the accused device is equivalent to a claim limitation if the only differences between the two are insubstantial.”<sup>9</sup> Recently, the Federal Circuit has explained that “the substantial differences test may be more suitable . . . for determining equivalence in the chemical arts,” and identified “structural equivalen[cy]” as particularly relevant when comparing chemical equivalents.<sup>10</sup>

Importantly, the DOE cannot expand the scope of a claim and, in view of this principle, the Federal Circuit has expressly acknowledged that some claim limitations may have no scope of equivalents:

If our case law on the doctrine of equivalents makes anything clear, it is that all claim limitations are not entitled to an equal scope of equivalents. Whether the result of the All Limitations Rule, prosecution history estoppel or the inherent narrowness of the claim language, many limitations warrant little, if any, range of equivalents.<sup>11</sup>

The “all limitations rule” (often called the “all elements rule”) mentioned above mandates that the DOE

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is applied separately to each element of a claim and not the claim as a whole, *i.e.*, the accused product or process must embody each element of the claim, literally or equivalently.<sup>12</sup>

We now discuss key limitations on the DOE, followed by a detailed review of ensnarement.

## II. Judicial Limitations on the DOE

Application of the DOE is constrained by several judicial limitations, including prosecution history estoppel, narrow claims, disclaimer, vitiation, and public dedication.

Prosecution history estoppel limits the DOE because “[w]hen the patentee has chosen to narrow a claim, courts may presume . . . that the territory surrendered is not an equivalent of the territory claimed.”<sup>13</sup> Estoppel can occur when the patentee makes a narrowing amendment to a claim or surrenders claim scope through argument to the patent examiner.<sup>14</sup> In fact, there is a rebuttable presumption that if a claim is amended during prosecution, the claim scope has been surrendered.<sup>15</sup> Prosecution history estoppel can also be based on representations to foreign patent offices<sup>16</sup> or compliance with a restriction requirement.<sup>17</sup>

Narrow claim language can also limit the DOE. “[F]or a patentee who has claimed an invention narrowly, there may not be infringement under the doctrine of equivalents in many cases, even though the patentee might have been able to claim more broadly.”<sup>18</sup> In *Sage Products, Inc. v. Devon Industries, Inc.*, the district court held that a patent disclosing a medical waste container with several structural limitations was not infringed under the DOE by the accused device that “achieve[d] a similar result . . . by a different arrangement of elements.”<sup>19</sup> The Federal Circuit affirmed, noting that if the DOE were allowed to encompass foreseeable variations, not just of a claim element, but of a patent claim itself, it would eliminate competitive activity outside the scope of each claim:

If Sage desired broad patent protection for any container that performed a function similar to its claimed container, it could have sought claims with fewer structural encumbrances. . . . Instead, Sage left the PTO with manifestly limited claims that it now seeks to expand through the doctrine of equivalents. However, as between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.<sup>20</sup>

Disclaimer—express limitations in the claims or statements in the specification—may indicate that the inventor renounced certain subject matter as an equivalent. Disclaimer from express claim language will not arise unless the asserted scope of equivalents is inconsistent with the claim language; in other words, where a patentee seeks to assert as an equivalent subject matter that the claim affirmatively excludes.<sup>21</sup> Statements in the specification can also constitute a disclaimer and preclude assertion of the DOE. For example, in *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, the patents-in-suit included a statement that “all embodiments of the present invention” contain a coaxial lumen and expressly distinguished the double lumen configurations by discussing the disadvantages that were overcome by the coaxial lumens. These included “making the shaft sizes of . . . catheters larger than necessary and making the catheters stiffer in their distal regions than would be desired.”<sup>22</sup> The Federal Circuit affirmed the finding that the accused dual lumen catheters did not infringe under the DOE because “[e]ach of the [] patents specifically recognized and disclaimed the dual lumen structure, making clear that the patentee regarded the dual lumen configuration as significantly inferior to the coaxial lumen configuration used in the invention.”<sup>23</sup>

Under the vitiation doctrine, “[i]f a theory of equivalence would vitiate a claim limitation . . . then there can be no infringement under the [DOE] as a matter of law.”<sup>24</sup> In other words, the DOE cannot be used to effectively read out a claim limitation, because the public has a right to rely on the language of patent claims:

[I]f the public comes to believe (or fear) that the language of patent claims can never be relied on, and that the doctrine of equivalents is simply the second prong of every infringement charge, regularly available to extend protection beyond the scope of the claims, then claims will cease to serve their intended purpose.<sup>25</sup>

In *Amgen v. Sandoz*, discussed above, the Federal Circuit affirmed the district court’s finding of non-infringement and held that the DOE could not be used to broaden the scope of a patented purification process because the accused process using one purification step and one solution was not equivalent to the portion of the claims requiring three discrete purification steps and three different solutions.<sup>26</sup> The court cited its earlier holding that the DOE cannot be used to eliminate a claim limitation:

As the district court held, the claim recites a sequence of steps requiring application of “refolding,” “washing,” and “eluting” solutions, and our precedent prohibits us from overriding the natural

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language of claim 7 to extend these limitations to cover nearly any type of adsorbent chromatographic separation.<sup>27</sup>

The DOE is also unavailable where the patentee discloses subject matter in the specification, but does not claim it. This disclosed-but-unclaimed subject matter is dedicated to the public.<sup>28</sup> Significantly, the unclaimed disclosure need not satisfy Section 112, but only needs to allow one skilled in the art to discern the matter disclosed, but not claimed.<sup>29</sup>

The final limitation we discuss—ensnarement—is a potent defense to a finding of infringement under the DOE. In fact, a defendant recently used the defense to negate a \$200+ million judgment of infringement under the DOE.<sup>30</sup> Because ensnarement is not asserted as often as the other DOE defenses discussed above, we now describe this particular defense in further detail below.

### III. Ensnarement Is a Potent Defense to Prevent a Finding of Infringement under the DOE

Ensnarement is based on the principle that the allowable range of equivalents to a patent claim cannot encompass or “ensnare” the prior art. To establish infringement under the DOE, the patentee—after a successful jury verdict—must posit a hypothetical claim that literally covers the accused product or process and then prove that the claim is valid over the prior art.<sup>31</sup> Because ensnarement is a question law, this defense has often been evaluated in a separate, mini-trial that follows a jury’s finding of infringement under the DOE. In these instances, an adjudicated infringer gets another opportunity to defeat liability with a back-door invalidity attack.

The ensnarement defense took shape in *Wilson Sporting Goods Co. v. David Geoffrey & Associates*.<sup>32</sup> After a jury found that golf balls sold by defendant Dunlop infringed under the DOE, Dunlop appealed. On appeal, the Federal Circuit, recognizing that application of the DOE “can be a difficult question to answer,” announced a useful, although not mandatory, two-step analytical approach to assist lower courts in their analysis of whether the alleged equivalent would have improperly “ensnared” the prior art.<sup>33</sup> The patentee first constructs a hypothetical claim that literally covers the accused conduct; the court then decides whether the PTO would have allowed the claim to issue over the prior art:

To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the

limitation on the scope of equivalents by visualizing a *hypothetical* patent claim, sufficient in scope to *literally* cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents. If the hypothetical claim could have been allowed, then prior art is not a bar to infringement under the doctrine of equivalents.<sup>34</sup>

This validity analysis is deemed appropriate as the patentee “is seeking patent coverage beyond the limits considered by the PTO examiner.”<sup>35</sup> Because the patentee must once again prove infringement and patentability, ensnarement gives an alleged infringer a second bite at an (enlarged) apple.

#### A. The Patentee Has the Burden of Drafting a Hypothetical Claim and Proving that It Would Have Been Allowable over the Prior Art

The patentee’s task begins with proposing a hypothetical claim that only broadens—not narrows—actual claims. As the Federal Circuit noted in *Streamfeeder, LLC v. Sure-Feed Systems, Inc.*, the analysis is not a license to freely redraft granted claims:

A hypothetical claim analysis is not an opportunity to freely redraft granted claims. That opportunity existed in the PTO. . . . While use of a hypothetical claim may permit a minor extension of a claim . . . one cannot . . . cut and trim, expanding here, and narrowing there, to arrive at a claim that encompasses an accused device, but avoids the prior art. Slight broadening is permitted at that point, but not narrowing.<sup>36</sup>

A court has no duty to craft an appropriate hypothetical claim.<sup>37</sup> In *Jang v. Boston Scientific Corp.*, the Federal Circuit held that the district court correctly declined to analyze hypothetical claims with narrowing limitations, noting that the duty to craft proper hypothetical claims rests with the patentee:

Dr. Jang cannot effectively transfer the responsibility of defining the range of equivalents to which he is entitled to the district court. . . . Because, as a threshold matter, Dr. Jang failed to submit a proper hypothetical claim for consideration, he was unable to meet his burden of proving that his doctrine of

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equivalents theory did not ensnare the prior art. The district court thus correctly vacated the jury verdict of infringement under the doctrine of equivalents.<sup>38</sup>

Once an appropriately crafted hypothetical claim is devised, the question becomes “whether that hypothetical claim could have been allowed by the PTO over the prior art.”<sup>39</sup> “If such a claim would be unpatentable under 35 U.S.C. §§ 102 or 103, then the patentee has overreached, and the accused device is noninfringing as a matter of law.”<sup>40</sup> The initial burden of producing prior art challenging the validity of a hypothetical claim rests with an accused infringer.<sup>41</sup> But the ultimate burden of showing that any such claims do not cover the prior art rests with the patentee, and this burden is satisfied by a preponderance of the evidence.<sup>42</sup>

## **B. A Hypothetical Dependent Claim Can Be Useful Even if a Hypothetical Independent Claim Is Not**

In *Wilson*, the court noted that any asserted hypothetical dependent claims must be separately considered in the ensnarement analysis, even though claims from which they depend are not infringed under the DOE.<sup>43</sup> The court recognized that although dependent claims are narrower than the associated independent claims, a hypothetical claim based on a dependent claim could cover the accused product or process, but not ensnare the prior art. Conversely, hypothetical claims based on broader, independent claims could also cover the accused conduct, but encompass the prior art.<sup>44</sup> Although the hypothetical dependent claims in *Wilson* suffered the same fate as the hypothetical independent claims, this will not always be the case.<sup>45</sup> Accordingly, an ensnarement analysis is a “counterintuitive exception to the general principle that, when one does not infringe a broader claim, one cannot infringe a dependent claim containing all of that broader claim’s limitations plus more.”<sup>46</sup> Put simply, do not overlook dependent claims.

## **C. Ensnarement Is a Question of Law for the Court, not the Jury**

Ensnarement is a question of law and is often determined by the court in a supplemental proceeding.<sup>47</sup> Thus, under *Wilson* and its progeny, a jury cannot decide the ultimate issue of ensnarement.<sup>48</sup> But the jury must render a favorable decision of DOE before the ensnarement defense is considered. It is unclear, however, if the jury evaluates equivalence under the claims as written or the hypothetical claims. In *Wilson*, *Streamfeeder*, and other

cases, it does not appear that hypothetical claims were presented to the jury, but were proposed only after the jury’s decision.<sup>49</sup> Thus, there seems to be no precedent for a jury’s role in evaluating infringement or validity of hypothetical claims.

A jury, however, can decide factual issues or provide an advisory verdict on ensnarement. In *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, after authorizing a separate mini-trial on ensnarement, the district court held: “In light of the fact that the Federal Circuit repeatedly refers to ensnarement as a legal question . . . the Court does not take the view that these cases mandate jury involvement in the ensnarement determination.”<sup>50</sup> But factual findings of a jury may serve as the starting point for an ensnarement analysis.<sup>51</sup> After a 13-day jury trial, the *Depuy* jury found infringement under the DOE and awarded \$226 million dollars.<sup>52</sup>

This set the stage for an ensnarement mini-trial that addressed anticipation, obviousness (including “teaching away”), and secondary considerations (including long-felt need, copying, and commercial success).<sup>53</sup> After the district court rejected the ensnarement defense, Medtronic appealed, arguing that it was entitled to present the defense to the jury because, even if ensnarement is a question of law, the underlying factual issues must be resolved by a jury, if one is requested.<sup>54</sup> The Federal Circuit, however, noted that Supreme Court had recognized “‘various legal limitations’ on the application of doctrine of equivalents to be decided by the court.”<sup>55</sup> It then likened ensnarement to prosecution history estoppel as “two policy oriented limitations” on the doctrine of equivalents, both of which are decided as questions of law:

Accordingly, we hold that ensnarement, like prosecution history estoppel, is “to be determined by the court, either on a pretrial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict. . . . As a practical matter, both legal limitations may be readily addressed in the same set of motions.”<sup>56</sup>

In outlining the procedure for deciding the defense, the Federal Circuit stated that a jury can decide ensnarement, but its decision would be merely advisory:

If a district court believes that an advisory verdict would be helpful, and that a “hypothetical claim” construct would not unduly confuse the jury as to equivalence and validity, then one may be obtained under Federal Rule of Civil Procedure 39(c). . . . Ultimately, however, ensnarement is a question of law for the court, not the jury, to decide.<sup>57</sup>

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Although ensnarement covers much the same ground as a typical invalidity defense, they are distinct doctrines, because ensnarement functions as a limitation on the DOE.<sup>58</sup> Yet, in the ensnarement context as with invalidity, a district court may hear expert testimony and consider other evidence regarding: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations.<sup>59</sup> As *Depuy* indicates, this proceeding has all the earmarks of a typical trial on validity, except the patentee must prove that its hypothetical claim is not invalid over the prior art. Certainly, this procedure is inconsistent with the Federal Circuit's observation in *Key Manufacturing Group, Inc. v. Microdot, Inc.* that the ensnarement proceeding does not envision a "full-blown patentability analysis to the hypothetical claim."<sup>60</sup>

## D. Ensnarement Can Be Raised in Various Ways

A defendant can raise ensnarement through various ways. In *Jang*, patentee Jang argued that defendant Boston Scientific waived its ensnarement defense because it was not raised in a motion for summary judgment or JMOL.<sup>61</sup> Relying on its decision in *Depuy*, the Federal Circuit rejected Jang's argument and stated that a district court could, but did not have to, decide the issue through any particular type of procedure:

*DePuy* is most fairly understood as holding that ensnarement is a legal question for the district court to decide and that the district court *could*, but did not have to, decide that question through particular types of motions. . . . We see nothing legally unsound in BSC raising ensnarement through its pretrial motion in limine, and the district court conducting a post-trial hearing on the defense contingent on an infringement verdict under the doctrine of equivalents. Moreover, based on a review of the record, we are satisfied that Dr. Jang received sufficient notice of BSC's ensnarement argument.<sup>62</sup>

Jang also argued that the ensnarement hearing was improper because it was not specifically mentioned in the pretrial order. The court, however, held that because both parties were notified that such hearing would be conducted if Jang prevailed before the jury, there was no need to mention the possible post-trial ensnarement hearing in the pre-trial order "under these circumstances."<sup>63</sup> Despite *Jang*, a defendant should not omit an ensnarement defense from the pre-trial order as *Jang* seems limited to its specific facts.

Of course, a defendant can raise ensnarement in a motion for summary judgment. In *Janssen Biotech, Inc. v. Celltrion Healthcare Co.*,<sup>64</sup> Celltrion successfully moved for summary judgment of noninfringement based on ensnarement. Because Janssen conceded the lack of literal infringement, the court focused on the hypothetical claims, and whether they ensnared the prior art. Apparently, there was no separate analysis of infringement under the DOE. Therefore, the defendant had only one bite at the apple, but still prevailed on its ensnarement defense.

In appropriate circumstances, this procedure could be adopted in bench trials. That is, the parties might forego an initial DOE determination on the original claims and proceed directly to an ensnarement analysis on the proposed hypothetical claims.

## E. The Parties Can Ask for Discovery on Ensnarement

In *Jang*, the court rejected Jang's argument that he was prejudiced by the lack of pretrial discovery on ensnarement because both parties had been informed that an ensnarement trial would be conducted if Jang prevailed before the jury. The court reasoned that "each party was presumably on a level playing field when they arrived at the hearing" because the parties could have taken discovery during the three weeks between the jury verdict and the ensnarement hearing. Moreover, if Jang had needed additional time to conduct discovery, he could have asked for it. He did not.<sup>65</sup>

As a practical matter, if a district court follows the *Jang* mini-trial approach to ensnarement, each party should be prepared to proceed with that hearing immediately following a jury verdict of infringement. Any discovery that might be needed should be taken earlier, even if it is never used, as opposed to seeking court approval to delay the ensnarement hearing to conduct such discovery. Such delay might be denied.

## IV. Conclusion

Despite the Federal Circuit's language in *Amgen v. Sandoz* regarding the DOE, the doctrine should never be overlooked. In each case, the facts should be carefully evaluated in view of each claim limitation to determine whether the DOE and/or its limitations apply.

*The opinions expressed are those of the authors on the date noted above. They do not necessarily reflect the views of (i) Steptoe & Johnson LLP, any other of its lawyers, its clients, or any of its or their respective affiliates, or (ii) Fish & Richardson P.C. or, any other of its lawyers, its*

*clients, or any of its or their respective affiliates. This post is for general information purposes only and is not intended*

*to be and should not be taken as legal advice. No attorney–client relationship is formed.*

1. 923 F.3d 1023, 1029 (Fed. Cir. 2019).
2. 927 F.3d 1272, 1274 (Fed. Cir. 2019). On Aug. 9, 2019, another Federal Circuit panel affirmed two findings of infringement under the DOE. *See Eli Lilly and Co. v. Hospira, Inc.*, No. 18-2126, 2018-2127 (Fed. Cir. 2019).
3. On June 7, 2019, Amgen filed a petition for rehearing *en banc* challenging the panel's reasons that the DOE only applies in "exceptional cases." The panel removed the language cited above from its earlier order but refused to reconsider the petition otherwise. *See Amgen Inc. v. Sandoz Inc.*, No. 18-1551 (Fed. Cir. Sept. 3, 2019).
4. *Sandoz*, 923 F.3d at 1029 (quoting *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991)).
5. *Carson Pirie Scott*, 946 F.2d at 1538 (citing U.S. Const. art. I, § 8, cl. 8).
6. *See, e.g., Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 34–35 (1997). Infringement under the DOE is a factual question. *See VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1322–23 (Fed. Cir. 2014).
7. *Warner-Jenkinson*, 520 U.S. at 36.
8. *See Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950).
9. *See Voda v. Cordis Corp.*, 536 F.3d 1311, 1326 (Fed. Cir. 2008) (quoting *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1139 (Fed. Cir. 2004)).
10. *Mylan Institutional LLC v. Aurobindo Pharma. Ltd.*, 857 F.3d 858, 869 (Fed. Cir. 2017).
11. *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106, (Fed. Cir. 2000) (citation omitted).
12. *See Pennwalt Corp. v. Durant-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987); *Bayer Intellectual Property GmbH v. CAP IM Supply, Inc.*, 2018 WL 1517688 (D. Del. May 28, 2018).
13. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741 (2002).
14. *Conoco, Inc. v. Energy & Envtl. Int'l, L.C.*, 460 F.3d 1349, 1363 (Fed. Cir. 2006) (citing *Deering Precision Instruments, LLC v. Vector Distrib. Sys., Inc.*, 347 F.3d 1314, 1324 (Fed. Cir. 2003)).
15. *Festo*, 535 U.S. at 741. This presumption can be rebutted in three different ways. *Id.* at 740–41.
16. *See, e.g., Tanabe Seiyaku Co. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726 (Fed. Cir. 1997); *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110 (Fed. Cir. 1983).
17. *Merck & Co. v. Mylan Pharm., Inc.*, 190 F.3d 1335 (Fed. Cir. 1999).
18. *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420 (Fed. Cir. 1997).
19. *Id.* at 1425.
20. *Id.*
21. *See, e.g., Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1317 (Fed. Cir. 1998); *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1115 n.5 (Fed. Cir. 2000) (affirming summary judgment of no infringement under DOE where the claim expressly recited that an edge be free of an adhesive label and the accused product contained a series of circular dots of adhesive material disposed along the edge). The Federal Circuit has stated that foreseeability of an equivalent at the time of claim drafting is not a *per se* bar to the application of the DOE, but rather is "one factor that may, in some cases, help show that the facts cannot support infringement under the [DOE]." *UCB*, 927 F.3d at 1280 (citing *Ring & Pinion Serv. Inc. v. ARB Corp.*, 743 F.3d 831, 834 (Fed. Cir. 2014)).
22. 242 F.3d 1337, 1344 (Fed. Cir. 2001).
23. *Id.* at 1347.
24. *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1160 (Fed. Cir. 1998) (citing *Warner-Jenkinson*, 520 U.S. at 39 n.8).
25. *Carson Pirie Scott*, 946 F.2d at 1538.
26. *Sandoz*, 923 F.3d at 1029 ("Accordingly, the district court was correct to grant summary judgment that Sandoz does not infringe claim 7 under the doctrine of equivalents because its one-step, one-solution purification process works in a substantially different way from the claimed three-step, three-solution process.").
27. *Id.* (citing *Duncan Parking Techs., Inc. v. IPS Grp., Inc.*, 914 F.3d 1347, 1362 (Fed. Cir. 2019)). *See also Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1129 (Fed. Cir. 2008) (affirming summary judgment of non-infringement because a finding that Taq bacteria was equivalent to *E. coli* bacteria would essentially render the "bacterial source [of] *E. coli*" claim limitation meaningless and would thus vitiate that limitation of the claims).
28. *Johnson & Johnson Assocs. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046 (Fed. Cir. 2002). *See also Eli Lilly*, No. 18-2126, 2018-2127 (Fed. Cir. 2019).
29. *PSC Computer Prods. Inc. v. Foxconn Int'l Inc.*, 355 F.3d 1353, 1360 (Fed. Cir. 2004).
30. *Jang v. Boston Sci. Corp.*, 872 F.3d 1275 (Fed. Cir. 2017).
31. The hypothetical claim test is not the only method for deciding ensnarement, *see Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1576–77 (Fed. Cir. 1994), but the Federal Circuit has not offered an alternative approach.
32. 904 F.2d 677 (Fed. Cir. 1990). District courts have invoked the ensnarement defense to enter judgments of noninfringement in several cases, and the Federal Circuit has approved that approach. *See, e.g., Gemalto S.A. v. HTC Corp.*, 754 F.3d 1364, 1374 (Fed. Cir. 2014); *Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co.*, 204 F.3d 1360, 1364 (Fed. Cir. 2000); *Marquip, Inc. v. Fosber Am., Inc.*, 198 F.3d 1363, 1367–68 (Fed. Cir. 1999); *K-2 Corp. v. Solomon S.A.*, 191 F.3d 1356, 1368 (Fed. Cir. 1999).
33. 904 F.2d at 684.
34. *Id.* (emphasis in original). The patentee need not prove that the hypothetical claim satisfies 35 U.S.C. § 112. *See Sprint Communications Co. v. Cox Communications Inc.*, 302 F. Supp. 3d 597, 613 (D. Del. 2017).
35. *Wilson*, 904 F.2d at 685.
36. 175 F.3d 974, 983 (Fed. Cir. 1999); *accord, Jurgens v. McKasy*, 927 F.2d 1552, 1561 (Fed. Cir. 1991).
37. *Jang*, 872 F.3d at 1287.
38. *Id.* (citation omitted).
39. *Wilson*, 904 F.2d at 684.
40. *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1380 (Fed. Cir. 2001) (citing *Wilson*, 904 F.2d at 683–84).
41. *Id.*
42. *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc. (Depuy II)*, 526 F. Supp. 2d 162, 169 (D. Mass. 2007), *aff'd in part, rev'd in part and remanded*, 567 F.3d 1314 (Fed. Cir. 2009); *accord Streamfeeder, LLC v. Sure Feed Sys., Inc.*, 175 F.3d 974, 983 (Fed. Cir. 1999).
43. *Wilson*, 904 F.2d at 685–86.
44. *Id.* at 686.
45. *Id.*
46. *Streamfeeder*, 175 F.3d at 984–85.
47. *Wilson*, 904 F.2d at 687 (deciding ensnarement "as a matter of law" after jury found infringement); *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc. (Depuy I)*, 515 F. Supp. 2d 206, 207 (D. Mass. 2007) (holding that "defendants' ensnarement defense was a question of law to be litigated in a separate proceeding before the Court"); *Streamfeeder*, 175 F.3d at 981 ("determining whether the scope of equivalents accorded to a particular claim would encompass the prior art is a question of law which we review de novo.").
48. *But see Senmed, Inc. v. Richard-Allan Med. Indus., Inc.*, 888 F.2d 815, 821-24 (Fed. Cir. 1989) (Newman, J., dissenting).
49. *See, e.g., Wilson*, 904 F.2d at 687.
50. *Depuy I*, 515 F. Supp. 2d at 209.
51. *Id.*
52. *Depuy II*, 526 F. Supp. at 165.
53. *Id.* at 165–6.
54. *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc. (Depuy III)*, 567 F.3d 1314, 1322–23 (Fed. Cir. 2009).
55. *Id.* at 1323 (quoting *Warner-Jenkinson*, 520 U.S. at 39 n.8 (1997)).
56. *Id.* (citation omitted).
57. *Id.* at 1324 (citation omitted).
58. *Depuy II*, 526 F. Supp. 2d at 164 n.2.
59. *Depuy III*, 567 F.3d at 1324 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)).
60. 925 F.2d 1444, 1449 (Fed. Cir. 1991).
61. *Jang*, 872 F.3d at 1287–88.
62. *Id.* at 1288 (citation omitted) (emphasis in original).
63. *Id.* at 1289.
64. C.A. No. 17-11008-MLW (D. Mass. July 30, 2018).
65. *Jang*, 872 F.3d at 1288–89.

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