



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Toro Co.
v.
White Consol.
Indus., Inc.***

No. 00-1561
Federal Circuit
Sept. 24, 2001

“In some cases, the change in the accused device is so facially ‘unimportant and insubstantial’ that little additional guidance is needed for a fact finder to determine whether an accused device includes an equivalent of a claim limitation.”

On September 24, 2001, the Federal Circuit vacated and remanded the district court’s summary judgment that White did not infringe U.S. Patent No. 4,694,528 under the doctrine of equivalents. The patented technology related to a convertible vacuum-blower. The Federal Circuit noted:

To infringe a claim under the doctrine of equivalents, an accused device must include an equivalent for each literally absent claim limitation. To determine whether the accused device includes equivalents for a claim limitation, this court applies the “insubstantial differences” test. . . . In some cases, the change in the accused device is so facially “unimportant and insubstantial” that little additional guidance is needed for a fact finder to determine whether an accused device includes an equivalent of a claim limitation. For example, if an accused infringer has simply separated into two components what the patentee has claimed as one component, a fact finder might indeed find such a change “insubstantial.” . . . With a fuller understanding of the technology, a reasonable jury could find that White’s two-piece cover is an equivalent to the claimed unitary ring and cover.

[T]he function-way-result test [considers] whether the element in the accused device “does substantially the same thing in substantially the same way to get substantially the same result” as the claim limitation. The district court focused on the function-way-result test in summarily determining that the cover of White’s accused vacuum-blower is not an equivalent of the claimed cover because White’s cover does not perform the function of automatically placing the restriction ring.

Clause [4] of claim 16 recites the objective of the cover as covering the air inlet of the vacuum-blower (to keep fingers and clothes from entering the impeller) and permitting the passage of air through the cover to the inlet. . . . While this structure could have a variety of other functions (as is often the case with structures), including supporting surrounding structures, attaching related parts, and so forth, these functions do not become part of the claimed structure unless claimed as such. The function of automatic placement of the ring in the claimed unitary cover and ring is inherent in that structure, much as supporting surrounding structures are inherent in a structural limitation. In fact, Toro’s expert, Mr. FitzGibbon, testified that automatic placement is inherent in this unitary structure. . . .

Neither the ‘528 patent’s specification nor this court’s claim interpretation, however, make the inherent function of automatic placement a key objective of this invention. Rather, the specification mentions in passing the automatic placement feature among other functions of the cover. Thus, on this record, a genuine issue of material fact remains as to whether White’s vacuum-blower cover performs substantially the same overall function as the cover claimed by the ‘528 patent. In light of the understanding enunciated by this court that automatic placement is a non-critical inherent function of the claimed cover, a reasonable jury could find White’s two-piece structure equivalent to the one-piece structure recited in the asserted claims.