



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***Ballard Med.  
Prods.  
v.  
Allegiance  
Healthcare  
Corp.***

No. 00-1393  
Federal Circuit  
Oct. 9, 2001

*“When a patentee advises . . . that a particular structure is not within his invention, the patentee is not permitted to assert in a subsequent infringement action that the same structure is equivalent to the structure described in the patentee’s specification for purposes of section 112 paragraph 6.”*

On October 9, 2001, the Federal Circuit affirmed the district court’s summary judgment of non-infringement of U.S. Patents No. 4,569,344 and 4,696,296. The patented technology related to ventilating and aspirating tracheobronchial catheters. The Federal Circuit noted:

Markman does not require a district court to follow any particular procedure in conducting claim construction. It merely holds that claim construction is the province of the court, not a jury. To perform that task, some courts have found it useful to hold hearings and issue orders comprehensively construing the claims in issue. Such a procedure is not always necessary, however. If the district court considers one issue to be dispositive, the court may cut to the heart of the matter and need not exhaustively discuss all the other issues presented by the parties. District courts have wide latitude in how they conduct the proceedings before them, and there is nothing unique about claim construction that requires the court to proceed according to any particular protocol. As long as the trial court construes the claims to the extent necessary to determine whether the accused device infringes, the court may approach the task in any way that it deems best. . . .

[T]he district court at one point in its opinion referred to prosecution history estoppel in the context of claim construction. What is important, however, is the analysis, not the nomenclature, and we are satisfied that in relying on the prosecution history as an aid to claim construction, the district court did not err. . . .

An inventor may use the specification and prosecution history to define what his invention is and what it is not—particularly when distinguishing the invention over prior art. “[J]ust as prosecution history estoppel may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the PTO may bar an inconsistent position on claim construction under § 112, ¶ 6.” Statements detailing the shortcomings of the relevant prior art have often proved useful in construing means-plus-function claims. . . . When a patentee advises the examiner (and the public after patent issuance) that a particular structure is not within his invention, the patentee is not permitted to assert in a subsequent infringement action that the same structure is equivalent to the structure described in the patentee’s specification for purposes of section 112 paragraph 6. . . .

Because there is no dispute over the structure of the accused device, resolution of the claim construction issue in this case dictates the outcome of the infringement inquiry. . . . The same distinctions of the prior art that inform the claim construction in this case give rise to prosecution history estoppel and prevent the doctrine of equivalents from capturing structure that the patentee surrendered during prosecution. Moreover, where the claim of infringement under section 112 paragraph 6 fails on the ground that the accused device is not equivalent to the structure disclosed in the specification, the doctrine of equivalents is available only if, unlike in this case, the accused device represents new technology developed after the issuance of the patent.