



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

J&M Corp.
v.
**Harley-
Davidson, Inc.**

Nos. 00-1295,
-1296, -1297
Federal Circuit
Nov. 2, 2001

“Structure expressly disclaimed in the specification, of course, cannot be considered an equivalent under the doctrine of equivalents.”

On November 2, 2001, the Federal Circuit affirmed the district court’s summary judgment that Harley-Davidson did not infringe U.S. Reissue Patent No. 34,525, which related to accessories for mounting a microphone and an electrical plug on a motorcycle helmet. The Federal Circuit noted:

The means-plus-function limitation in claims 15-17 – “gripping means” – corresponds in the specification to a structure with two clamps, one for the microphone mount and one for the electrical plug mount. The specification does not disclose any alternative gripping structure, and in view of this specification disclosure and disclaimer of the single mount accessory in the prior art, and in view of the prosecution history, we agree with the district court that these claims are limited to a dual clamp structure. J&M argues, however, that the single clamp of the accused accessories is equivalent to the dual clamp structure required by this means-plus-function limitation, either for the purposes of 35 U.S.C. § 112 ¶ 6 or, alternatively, under the doctrine of equivalents. We conclude that J&M is not entitled to such a broad scope of equivalents.

We first reject J&M’s argument that the gripping means limitation of claims 15-17 literally covers the single clamp structure of the accused devices. The literal scope of a properly construed means-plus-function limitation does not extend to all means for performing a certain function. Rather, the scope of such claim language is sharply limited to the structure disclosed in the specification and its equivalents. Moreover, the extent of equivalents must be interpreted in light of the disclosure of the invention in the specification, as a whole, as well as the prosecution history. Both the prosecution history and the specification of the ‘525 patent limit the scope of § 112 ¶ 6 equivalents for the “gripping means” limitation of claims 15-17, precluding coverage of a single clamp accessory. . . .

In view of the prosecution history, we also conclude that the gripping means limitation of claims 15-17 cannot include a range of equivalents under the doctrine of equivalents that extends to single clamp accessories. J&M submitted the means-plus-function claims 15-17 in response to the examiner’s rejection of claims broadly covering both single clamp and dual clamp accessories. The allowed claims 15-17, which we have determined are limited to dual clamp accessories, are narrower with respect to this limitation. Therefore, prosecution history estoppel bars J&M from asserting coverage of the accused single clamp accessories under the doctrine of equivalents. . . .

Structure expressly disclaimed in the specification, of course, cannot be considered an equivalent under the doctrine of equivalents. As noted above, the specification disclaims coverage of a single clamp structure as a flaw of prior art accessories. Moreover, while Applicants were aware of the possibility of placing the microphone boom and electrical plug mount on a single clamp, they dismissed such an approach and expressly described and claimed accessories in which the boom and plug were separately mounted. J&M cannot now overlook this deliberate decision and reclaim this disclaimed subject matter through the doctrine of equivalents.