



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Eagle
Comtronics
v.
Arrow
Communication
Labs.***

Nos. 01-1544,
-1591

Federal Circuit
Sept. 12, 2002

***“[W]hen
separate claim
limitations are
combined into
a single
element of the
accused
device, a claim
limitation is not
necessarily
vitiating, and
the doctrine of
equivalents
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differences are
insubstantial.”***

On September 12, 2002, the Federal Circuit, *inter alia*, vacated and remanded the district court’s summary judgment that Arcom did not infringe U.S. Patent No. 5,662,494 under the doctrine of equivalents. The patented technology related to an improvement for electrical signal filters used to decode or unscramble protected television signals. The Federal Circuit stated:

[T]here are limits to the application of the doctrine of equivalents aside from the question of insubstantiality of the differences. Two of those limits are at issue in this case. First, prosecution history estoppel can prevent a patentee from relying on the doctrine of equivalents when the patentee relinquishes subject matter during the prosecution of the patent, either by amendment or argument. Second, the question of insubstantiality of the differences is inapplicable if a claim limitation is totally missing from the accused device. This limit is often referred to as the all-limitations rule. We address each in turn. . . .

The doctrine of prosecution history estoppel bars a patentee from asserting as an equivalent subject matter surrendered during prosecution of the patent application. While at least one claim limitation at issue here was amended by the examiner during the prosecution of the patent, Arcom does not allege amendment-based estoppel here. Instead it argues that Eagle is estopped under argument-based estoppel. Any argument-based estoppel affecting a limitation in one claim extends to all claims in which that limitation appears. To invoke argument-based estoppel, the prosecution history must evince a “clear and unmistakable surrender of subject matter.”

After reviewing the entire prosecution history here, we do not find the required clear and unmistakable surrender of subject matter to invoke prosecution history estoppel. While Eagle repeatedly distinguished the prior art by noting that the claimed seal was located between the front cap and the rear insert body, its arguments were not based on the fact that the claimed collet assembly was made of two pieces or were separable. Rather, those arguments were based on the prior art not teaching or suggesting the use of a seal at the interface between the collet assembly and the filter housing. . . . Thus, the district court erred by holding that prosecution history estoppel barred Eagle from asserting infringement under the doctrine of equivalents. . . .

Based on the record before us, we hold that the all-limitations rule does not prevent a finding of infringement under the doctrine of equivalents. While a claim limitation cannot be totally missing from an accused device, whether or not a limitation is deemed to be vitiated must take into account that when two elements of the accused device perform a single function of the patented invention, or when separate claim limitations are combined into a single element of the accused device, a claim limitation is not necessarily vitiated, and the doctrine of equivalents may still apply if the differences are insubstantial. Thus, Eagle is correct that “one-to-one correspondence of components is not required,” and the all-limitations rule does not preclude a finding of equivalents here.