UNIVERSITY OF MARYLAND SCHOOL OF LAW

PATENT LAW UPDATE

Schwing GmbH v. Putzmeister Aktien-gesellschaft

No. 01-1615
Federal Circuit
Sept. 24, 2002

"The patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence . . . if the patentee . . . could not reasonably be expected to have described the substitute in question."

On September 24, 2002, the Federal Circuit affirmed the district court's summary judgment that Putzmeister did not infringe U.S. Patent No. RE 32,657 under the doctrine of equivalents with respect to one accused device, but vacated with respect to another. The patented technology related to certain types of concrete pumps. The Federal Circuit stated:

> [P]rosecution history estoppel acts as a complete bar to the doctrine of equivalents, so that a claim limitation that has been narrowed by amendment must be limited to its strict literal terms. [T]he Supreme Court [has] adopted a rebuttable presumption that the narrowing amendment surrendered the particular equivalent in question, and discussed several ways in which the patentee could overcome that presumption. The patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence . . . if the patentee can show that the asserted equivalent was unforeseeable, that the rationale underlying the amendment bears only a tangential relation to the equivalent in question, or that there is some other reason that the patentee could not reasonably be expected to have described the substitute in question.
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> At oral argument, Schwing contended that if we conclude that the amendment narrowed the annular extension limitations, we should remand the case to the district court to determine, in light of the Supreme Court's Festo opinion, whether Schwing can successfully rebut that presumption. We agree with Schwing that, at least as to the modified Bastardring II device, the case should be remanded to the district court to determine, in the first instance, whether Schwing can rebut the Festo presumption. A remand is not necessary with respect to the Bastardring II device, however, because in light of the written description of the '657 patent the embedded metal ring in the Bastardring II cannot be deemed equivalent to the annular extension on the shutter mechanism recited in claim 1. . . .
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> The '657 patent . . . specifically identifies and criticizes the use of embedded metal rings in the prior art. The applicant was aware of the possibility of holding the flexible ring in place with an embedded metal ring, but he dismissed such an approach and instead expressly described and claimed a pump in which the spring means is held in place by, inter alia, an annular extension on the shutter mechanism. Schwing cannot now overlook that deliberate decision and reclaim that subject matter through the doctrine of equivalents. [T]he Bastardring II cannot be held to infringe the '657 patent under the doctrine of equivalents. . . .
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> The modified Bastardring II, which has a grooved seating on the shutter mechanism, presents a different question. While Schwing has not provided any evidence that the innermost ridge overlaps the second side of the flexible elastic ring, its evidence does suggest that even if the innermost ridge of the grooved seating does not overlap the second side, it at least extends into the end of the spring means at a point just below the surface of the second side. . . . A reasonable fact-finder could conclude that the two configurations could perform substantially the same function in substantially the same way to achieve substantially the same result, and that the differences between them are insubstantial.

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