



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Dow Chem. Co.
v.
Mee Indus.***

No. 03-1117
Federal Circuit
Sept. 5, 2003

“The statement in a claim that the method is intended to serve a particular purpose at most requires that the undesirable result . . . be avoided. Such a statement does not give rise to a defense to infringement by showing that practicing the claimed method was not necessary to achieve that purpose.”

On September 5, 2003, the Federal Circuit, *inter alia*, affirmed the district court’s judgment that Florida Power and Mee did not infringe U.S. Patent No. 5,867,977, but vacated and remanded for further proceedings as to contributory and induced infringement by Mee. The Federal Circuit also affirmed the judgment of invalidity of certain claims of the ‘977 patent and U.S. Patent No. 5,930,990. Both patents related to power augmentation in gas turbines via wet compression. The Federal Circuit stated:

Dow asserted infringement of method claims 23 and 24 of the ‘977 patent by Florida Power under a theory of direct infringement and by Mee under theories of direct, induced, and contributory infringement. The district court held that neither Florida Power nor Mee infringed those claims. . . . As to Dow’s claims of induced and contributory infringement by Mee, the district court cited two findings upon which its holding of noninfringement was based: 1) “[w]hile the Mee fogging systems described in the claim charts provide stages or increments, these claim charts do not describe or show that Mee’s increments or stages are used to ‘avoid destructive thermal stresses’”; and 2) because thermal stresses do not occur at less than 10% overspray and Mee’s systems use a maximum of 3% overspray, “Mee’s fogging systems . . . do not add increasing amounts of water over time to avoid destructive thermal stresses.”

As to the first basis upon which the court found noninfringement, the logic underlying this finding is based on an error of law. The issue is whether by increasing the amount of water over time in the systems sold by Mee, destructive thermal stress was avoided. Even if an operator increased water over time in a Mee system for an entirely different reason, that would not avoid infringement, as the motive of the accused infringer when performing a claimed method is simply not relevant.

As to the second basis upon which the district court found noninfringement, the district court’s conclusion from the evidence that destructive stresses do not occur below 10 weight percent overspray does not negate infringement. The evidence cited by the district court might suggest that it would be unnecessary for a device producing less than 10 weight percent overspray to employ the method recited in claim 23 in order to avoid destructive thermal stresses, but that does not mean that use of the method would not infringe. The statement in a claim that the method is intended to serve a particular purpose at most requires that the undesirable result (here destructive thermal stresses) be avoided. Such a statement does not give rise to a defense to infringement by showing that practicing the claimed method was not necessary to achieve that purpose. [A] party who practices a patented method of automotive emission control that is claimed to avoid violation of state emission standards cannot defend against a charge of infringement by showing that its automobiles would pass state emission standards even without using the claimed method. [E]ven crediting the evidence that destructive thermal stresses would not result under any circumstances from the addition of the concentration of overspray that is used in Mee’s systems does not mean that Mee cannot be liable for induced or contributory infringement