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# TECHNOLOGY LAW UPDATE

A report of the latest Federal Circuit updates brought to you by Preston Gates.

## Talbert Fuel Sys. Patents Co. v. Unocal Corp.

No. 99-1421 (Fed. Cir. Oct. 28, 2003)

***“When the prior art embraces the alleged equivalent, and a narrowing amendment was made to avoid that equivalent, that subject matter cannot be found to have been unforeseeable at the time of the amendment.”***

On October 28, 2003, on remand from the U.S. Supreme Court in light of *Festo*, the Federal Circuit affirmed the district court’s judgment, *inter alia*, that Unocal did not infringe U.S. Patent No. 5,015,356, which related to certain gasolines, under the doctrine of equivalents. The Federal Circuit stated:

[P]rosecution history estoppel . . . “hold [s] the inventor to the representations made during the application process and to the inferences that may reasonably be drawn from the amendment.” The prosecution history of the ‘356 patent shows narrowing amendments directed to the hydrocarbon content and boiling range of the fuel. [T]he amendment of the Talbert claims to a boiling point upper limit of 345° F, in light of the Hamilton reference showing gasolines with boiling endpoints of 390° F-420° F, is a presumptive surrender of gasolines boiling in the range between Talbert’s amended endpoint of 345° F and Hamilton’s endpoints. . . .

When the prior art embraces the alleged equivalent, and a narrowing amendment was made to avoid that equivalent, that subject matter cannot be found to have been unforeseeable at the time of the amendment. The boiling range limits of the Unocal fuels, starting at 373.8° F, are directly within the space between the 345° F limit of Talbert’s amended claims, and the 390° F of the Hamilton reference. . . . The issue was extensively discussed in the prosecution record, for the examiner persisted in this rejection. It cannot now be credibly argued that it was unforeseeable that fuels with a boiling range significantly higher than 345° F, approaching the prior art fuels, would be equivalent to the fuels as limited by Talbert’s amendments. In view of Talbert’s clear disclaimers of such higher-boiling fuels, the now-asserted equivalence cannot be deemed to have been unforeseeable when Talbert’s amendments were made. [T]he reason for Talbert’s amendment cannot be deemed “tangential” to the Unocal alleged equivalent. The boiling range and carbon content were at issue during prosecution, and were the direct, not tangential, reason for the narrowing amendments to these claim limitations. [E]vidence outside the prosecution record i[s] generally prohibited] in deciding this ground of rebuttal. On the intrinsic evidence, “tangentialness” is not an available ground. [N]o “other reason” for avoiding estoppel has been proffered. Talbert argues that the claims contain an unnecessarily exact boiling limit; if so, the court is without power to make such a correction. The precision or generality with which boiling point ranges or fractionating temperatures are stated is not a matter of the “imprecision of language,” [but] a measurable property of matter in a well-studied field of engineering. We conclude that the presumption of surrender of the range between Talbert’s amended claims and the prior art cannot be rebutted as to the Unocal fuels and that remand is unwarranted.

In addition, the classical principles of the doctrine of equivalents preclude a finding of equivalency, for such finding requires only insubstantial differences between the invention as claimed and the alleged equivalent. The Unocal fuels do not simply depart by a few degrees from 345° F, but have “true boiling point endpoints ranging from 373.8° F to 472.9° F.” Thus, even were Talbert to provide evidence that might overcome the *Festo* presumption of estoppel, no reasonable trier of fact could find only insubstantial differences between fuels having an endpoint of 345° F and fuels with the endpoints shown for the Unocal fuels.