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# TECHNOLOGY LAW UPDATE

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

## Toro Co. v. White Consol. Indus., Inc.

No. 03-1424 (Fed. Cir. Sept. 13, 2004)

***“[The Johnson & Johnston] disclosure-dedication rule [is] a question of law, subject to de novo review [that neither considers intent nor imposes] a § 112 requirement on the disclosed but unclaimed subject matter.”***

On September 13, 2004, the Federal Circuit affirmed the district court’s summary judgment that White did not infringe U.S. Patent No. 4,694,528, which related to a vacuum blower. The Federal Circuit stated:

[I]ntent is not part of the Johnson & Johnston disclosure-dedication analysis. . . . “The patentee’s subjective intent is irrelevant to determining whether unclaimed subject matter has been disclosed and therefore dedicated to the public.” [T]he absence of intent as a factor in applying the disclosure-dedication rule of Johnson & Johnston is consistent with [precedent that addressed] circumstances, inter alia, in which the shortfalls of language or the unforeseeability of undeveloped technology preclude or hamper claim drafting. To the contrary, the disclosure-dedication rule applies to cases in which technology is both in existence and recognizably described in the written description of the patent, yet left unclaimed. . . . Graver Tank is distinguishable on its facts [because] there was no question that the applicant actually claimed the subject matter at issue even though the claims were later invalidated. In this case, Toro can only argue that it attempted to claim the disclosed subject matter based on its preferred claim construction. This court, however, in Toro I, concluded that Toro had not claimed a replaceable ring—a holding that is the law of the case. Because intent is not a factor in applying the disclosure-dedication rule, Toro cannot prevail as a matter of law based on its argument that it did not decline to claim or deliberately leave unclaimed the structure of White’s device.

Toro next argues that, even if the unintentional failure to claim an embodiment does not avoid the disclosure-dedication rule, the level of disclosure of a replaceable ring in the ‘528 patent is insufficient, as a matter of law, to trigger the disclosure-dedication rule. Specifically, Toro reasons that because Johnson & Johnston indicates that a patentee would have the opportunity to capture disclosed, but unclaimed, subject matter through reissue or continuation applications, the level of disclosure required to trigger a dedication must satisfy the standards of patentability under 35 U.S.C. § 112, ¶ 1. According to Toro, the statement in Johnson & Johnston that patentees may seek reissue or continuation applications grafts the requirement of § 112 sufficiency onto the disclosure-dedication rule, and a disclosure insufficient to satisfy § 112 will not trigger the disclosure-dedication rule.

[T]he disclosure-dedication rule does not impose a § 112 requirement on the disclosed but unclaimed subject matter. The standards articulated in § 112 are directed to the claimed invention, not to disclosures in the written description that may implicate the disclosure-dedication rule. [T]he level of disclosure needed to implicate the disclosure-dedication rule is different from the level of disclosure required under § 112 to support claims defining the scope of coverage of an invention. Indeed, disclosures implicating the disclosure-dedication rule need not directly relate to the description of the claimed invention or be contained in the “Detailed Description of the Invention” section of the patent, but may appear merely in the portion of the patent describing the “Background of the Invention.” [T]he district court found no genuine issue of material fact in concluding that the disclosure of a replaceable ring would have been apparent to one of ordinary skill in the art. [The conclusion that the specification] does not support a broader claim construction of the term “including,” is neither inconsistent with nor contradicted by the district court’s recognition that the patent mentions a replaceable ring—albeit requiring manual insertion and removal—in a way that would be understood by one of ordinary skill in the art. Nothing more is required to implicate the disclosure-dedication rule.