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TECHNOLOGY LAW
UPDATE

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

Insituform Techs., Inc. v. Cat Contracting, Inc.

Nos. 99-1584, 00-1005 (Fed. Cir. Oct. 4, 2004)

"[W]hether the patentee has established a merely tangential reason for a narrowing amendment is for the court to determine from the prosecution history record without the introduction of additional evidence, except, when necessary, testimony from those skilled in the art as to the interpretation of that record."

On October 4, 2004, on remand from the U.S. Supreme Court in view of *Festo*, the Federal Circuit affirmed-in-part, vacated-in-part, and remanded the district court's judgment entering the jury verdict that CAT infringed U.S. Patent No. 4,366,012, which related to underground pipe repair using a flexible tube liner. The Federal Circuit stated:

> With the complete bar of *Festo I* overturned, we asked the parties to give us their views as to how we should decide the case in light of *Festo II* and *Festo III*. In response, both plaintiffs and defendants urged us to decide the *Festo* issue on the record now before us. [B]ecause resolution of the issue turns on whether Insituform's rationale underlying the narrowing amendment bore no more than a tangential relation to accused Process 1, and because the record has been fully developed on this point, we agree that we can decide the issue.
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> Plaintiffs urge that nothing in either *Festo II* or *Festo III* invalidates *Insituform II*, where we determined that plaintiffs were not barred by prosecution history estoppel from asserting infringement under the doctrine of equivalents. Plaintiffs contend that any presumption of surrender is rebutted because the rationale underlying the amendment narrowing claim 1 to a single cup process bears at most a tangential relation to the infringing equivalent—the multiple-cup method of Process 1. [D]efendants note that claim 1, as originally filed, covered a process using single or multiple cups at any location downstream of the resin front [and] thus argue that accused Process 1 falls squarely within the territory surrendered by the narrowing amendment.
>
> [W]e hold that plaintiffs have rebutted the *Festo* presumption that a narrowing amendment made for a reason of patentability surrenders the entire territory between the original claim limitation and the amended claim limitation. [W]e conclude that the prosecution history establishes that "the rationale underlying" the amendment narrowing the scope of literal claim coverage from multiple cups to a single cup bears "no more than a tangential relation to the equivalent in question," accused Process 1. [A]pplication of the doctrine of equivalents in this case was not barred [and] we again affirm [that] Process 1 infringed claim 1 of the '012 patent under the doctrine of equivalents. . . .
>
> In our view, Insituform has rebutted the *Festo* presumption. The prosecution history and our discussion of that history in *Insituform I* and *II* compel the conclusion that the amendment limiting the literal scope of claim 1 to a single cup process bears "only a tangential relation," if that, "to the equivalent in question," a process using multiple cups. The question we must address is "whether the reason for the narrowing amendment was peripheral, or not directly relevant, to the alleged equivalent." As the discussion above indicates, the narrowing amendment in this case was for the purpose of distinguishing the invention over Everson. Insituform made it clear that the difference between its process and Everson was that its process did not have the disadvantage of the Everson process of a large compressor at the end of the liner. There is no indication in the prosecution history of any relationship between the narrowing amendment and a multiple cup process, which is the alleged equivalent in this case. Thus, we hold that plaintiffs have successfully rebutted the *Festo* presumption by establishing that the amendment narrowing the claimed invention from multiple cups to a single cup was tangential to accused Process 1, which used multiple cups attached at different points along the liner tube. We therefore affirm the judgment of infringement under the doctrine of equivalents.

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