



TECHNOLOGY LAW UPDATE

Biagro W. Sales, Inc.
v.
Grow More, Inc.

No. 04-1414

Federal Circuit
Sept. 13, 2005

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presumption of
surrender.*

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Sung &
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On September 13, 2005, the Federal Circuit affirmed the district court's judgment that Grow More did not infringe U.S. Patent No. 5,830,255, which related to phosphorus fertilizer compositions. The Federal Circuit stated:

A narrowing amendment made for a substantial reason relating to patentability gives rise to a presumption that the patentee has surrendered all subject matter between the original claim limitation and the amended claim limitation. If the narrowing amendment was the addition of a new claim limitation, [e]quivalents are presumptively not available with respect to that limitation. A patentee may rebut the presumption of surrender by showing that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent. [T]he patentee may show that the alleged equivalent would have been unforeseeable at the time of the amendment, that the rationale underlying the amendment bore no more than a tangential relation to the equivalent in question, or that there was "some other reason" that the patentee could not reasonably have been expected to have described the alleged equivalent. [T]he patentee bears the burden of rebutting the presumption of surrender. . . .

During reexamination, the patentee [added] the claim limitation "wherein said phosphorous-containing acid or salt thereof is present in an amount of about 30 to about 40 weight percent." [T]he narrowing amendment was made for a reason substantially related to patentability, and Biagro has presumptively surrendered any equivalents with respect to the amount of phosphorous-containing acid or salt present in the fertilizer.

Biagro [argues] that the rationale underlying the amendment was no more than tangentially related to the asserted equivalent. [W]hether the patentee has overcome the presumption on this ground is determined by the court on the basis of the public record. [The prosecution history shows] that the reason for adding the range limitation was to overcome a prior art fertilizer that was not concentrated. [T]he reason for the amendment and the accused equivalent in the case before us both relate to the concentration of the fertilizer. Biagro also argues that because only the lower limit of the claimed range was necessary to distinguish over prior art, the reason for the amendment is merely tangential to an accused equivalent at the upper end of the range. [Biagro argues] that there was no reason for adding an upper limit of 40%. [S]ince the prosecution history shows no reason for adding an upper limit to the concentration range, Biagro cannot claim that the rationale for the amendment is merely tangential.

Biagro further argues that it can rebut the Festo presumption of surrender with "some other reason" that the patentee could not reasonably have been expected to have described the alleged equivalent when it narrowed the claim. That "other" reason is that the patentee allegedly understood the claim language to refer to a chemical equivalent amount of phosphorous acid. . . . Biagro's contention should be rejected as merely an attempt to reargue the claim construction issue. Moreover, we fail to see how the patentee's supposed inability to draft claims to cover chemical equivalent amounts relates to Biagro's equivalence argument, which is that the approximately 60% concentration of phosphite actually present in the accused product is equivalent to the claimed 30-40% concentration.