

Cohesive Techs., Inc. v. Waters Corp.

Nos 08-1029, -1030, -1031, -1032, -1059, Fed. Cir. (Mayer, Linn,* Prost)

[Where] a patentee has brought what would otherwise be equivalents of a limitation into the literal scope of the claim, the doctrine of equivalents is unavailable to further broaden the scope of the claim.

On October 7, 2008, the Federal Circuit, inter alia, affirmed the district court's summary judgment that Waters did not infringe under the doctrine of equivalents U.S. Patents No. 5,772,874 and No. 5,919,368, which related to high performance liquid chromatography columns. The Federal Circuit stated:

[The patent claims] included limitations requiring in effect that the column particles have average diameters "greater than about 30 μm ." Faced with an accused product (the 25 μm columns) that was identical to an infringing product (the 30 μm columns) in all respects except for particle size, [the] district construed "greater than about 30 μm " expressly with reference to the alleged average diameter of the particles in the accused 25 μm columns The district court erred not only by construing the claim merely to exclude the accused device, but also by reading the term "about" out of the claim. The district court stated that it "d[id] not hesitate in construing 'about 30 microns' to exclude a magnitude of 29.01 microns," because the patentee "could have applied for a patent that included particles of 'greater than 29 microns'" if that is what it had intended. But the patentee likewise could have drafted the limitation as "greater than 30 μm "—rather than "greater than about 30 μm "—if it had intended the narrow scope that the district court gave to the claim. "[C]laims are interpreted with an eye toward giving effect to all terms in the claim." Here, by including the word "about," the patentee plainly intended the limitation "greater than about 30 μm " to encompass columns with particles with average diameters that are less than 30 μm , but are still greater than "about" 30 μm .

"[T]he word 'about' does not have a universal meaning in patent claims, and [its] meaning depends on the technological facts of the particular case." When "about" is used as part of a numeric range, "the use of the word 'about,' avoids a strict numerical boundary to the specified parameter. Its range must be interpreted in its technologic and stylistic context." [To find] how far beyond the claimed range the term "about" extends the claim, "[the focus is] on the criticality of the [numerical limitation] to the invention." [We look] to the purpose that the "about 30 μm " limitation serves, to determine how much smaller than 30 μm the average particle diameter can be and still serve that purpose. [I]t is the purpose of the limitation in the claimed invention—not the purpose of the invention itself—that is relevant. [W]e ask what function the "about 30 μm " low-end limit on particle size plays in the operation of the claimed apparatus and method.

"[A]bout 30 μm " should include particles with 25.434 μm diameters and larger, but should exclude particles with 23.044 μm diameters and smaller. The specification does not, however, provide any concrete guidance as to whether a

column with particles with measured diameters between 23.044 μm and 25.434 μm meets the “about 30 μm ” limitation. Absent any such guidance, we neither can nor should draw a hard and fast numeric line. Rather, we construe “about 30 μm ” to accomplish the function of the low-end limit on particle size described in the specification. From that, we conclude that, for particles between 23.044 μm and 25.434 μm , “about 30 μm ” means a particle of sufficiently large size to assure that a column containing the particles is capable of attaining turbulence. This functional approach is necessary and appropriate, because the deliberate imprecision inherent in the word “about” makes it impossible to “capture the essence” of the claimed invention in strict numeric terms.

The district court granted summary judgment in favor of Waters, finding no infringement under the doctrine of equivalents. [B]ecause of the way that the patentee has used the word “about” in the context of the written description and the claims in this case, construction of the term “about 30 μm ” requires consideration of the purpose or “criticality” of the limitation to the invention. “[A]bout 30 μm ” encompasses particle diameters that perform the same function, in the same way, with the same result as the 30 μm particles, as long as those diameters are within the range left open by the specific disclosures of the specification. Thus, by electing to include the broadening word “about” in the claim, the patentee has in this case already captured what would otherwise be equivalents within the literal scope of the claim. The patentee here has, by its choice of claim language, captured the same “range of novelty” that typically justifies application of the doctrine of equivalents.

Where, as here, a patentee has brought what would otherwise be equivalents of a limitation into the literal scope of the claim, the doctrine of equivalents is unavailable to further broaden the scope of the claim. In these circumstances, a patentee cannot rely on the doctrine of equivalents to encompass equivalents of equivalents. Here, because the “about 30 μm ” limitation already literally encompasses diameters that are equivalent to 30 μm in the context of the patent, any particle diameter that performs the same function, in the same way, with the same result as a 30 μm diameter is already within the literal scope of the claim. Cohesive therefore cannot rely on the doctrine of equivalents for that limitation. Since the “about 30 μm ” limitation was the only disputed limitation, the district court was correct to grant summary judgment in favor of Waters on the issue of infringement by equivalents.

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