

Welker Bearing Co. v. PHD, Inc.

No. 08-1169, Fed. Cir. (Rader,* Schall, Prost)

[Where] a proposed equivalent has arisen before patent issuance, “a § 112 ¶ 6 structural equivalents analysis applies and any analysis for equivalent structure under the doctrine of equivalents collapses into the § 112 ¶ 6 analysis.”

On December 15, 2008, the Federal Circuit affirmed the district court’s summary judgment that PHD did not infringe U.S. Patents No. 6,786,478 and No. 6,913,254, which related to pin clamps that hold a work piece securely in place during welding and other manufacturing processes. The Federal Circuit stated:

“[The patentee] may of course obtain damages only for acts of infringement after the issuance of the [] patent” “Mere possession of a product which becomes covered by a subsequently issued patent does not constitute an infringement of that patent until the product is used, sold, or offered for sale in the United States during the term of the patent.” The record [contains no] evidence that PHD engaged in any activity that infringed the ’478 patent after September 7, 2004 (the day the ’478 patent issued). Instead the record shows that PHD only created around ten prototype units of the Clamp I device. Although PHD provided GM one of these sample units for assessment some time in late 2003 or early 2004, that prototype never entered production or commercial use. The record is also devoid of any evidence that PHD ever sold any units to GM at any time.

Welker Bearing’s only theory for infringement of the ’478 patent was that “[PHD] had an affirmative duty at the point in time the patent issued to take the product off the market and they didn’t do that.” [There was] no admissible evidence to show that PHD continued to offer its product for sale (to the extent it ever was for sale) beyond September 7, 2004. Moreover, PHD did not have any burden to prove it retracted any putative offer for sale. Rather the burden remains with the patentee to prove infringement, not on the defendant to disprove it. [T]he district court did not err in granting summary judgment of noninfringement of the ’478 patent.

The district court construed the “mechanism for moving said finger” limitation in claim 1 of the ’254 patent as a means-plus-function limitation subject to 35 U.S.C. § 112 ¶ 6. [A] patentee’s use of the word “means” in a claim limitation creates a presumption that 35 U.S.C. § 112 paragraph 6 applies. In this instance, the ’254 patent’s claim language does not include the word “means,” but instead the similar word “mechanism.” “The generic terms ‘mechanism,’ ‘means,’ ‘element,’ and ‘device,’ typically do not connote sufficiently definite structure [to avoid means-plus-function treatment] The term ‘mechanism’ standing alone connotes no more structure than the term ‘means.’” The applicant for the ’254 patent could have supplied structural context to claim 1 in any number of ways. If claim 1 of the ’254 patent had recited, e.g., a “finger displacement mechanism,” a “lateral projection/retraction mechanism,” or even a “clamping finger actuator,” this court could have inquired beyond the vague term “mechanism” to discern the

understanding of one of skill in the art. If that artisan would have understood such language to include a structural component, this court's analysis may well have turned out differently. Instead the applicant chose to express this claim element as "a means or step for performing a specified function without the recital of structure, material, or acts in support thereof." Therefore, this court must agree with the district court, which properly applied means-plus-function treatment to this term. . . .

Literal infringement of a claim limitation in means-plus-function format "requires that the relevant structure in the accused device perform the identical function recited in the claim and be identical or equivalent to the corresponding structure in the specification." In this case, construing "means for moving said finger" in claim 1 of the '254 patent as a means-plus-function element compels summary judgment of noninfringement in favor of PHD. . . . The record shows that PHD's Clamp II propels clamping fingers in and out of the locating pin without any rotational movement. Instead Clamp II's linear-moving mechanism for finger movement and the claimed "mechanism for moving said finger" with a rotating central post are "substantially different." . . .

Structural equivalents and the doctrine of equivalents are "closely related." They are related in the sense that both § 112 ¶ 6 and the doctrine of equivalents apply "similar analyses of insubstantiality of the differences" between a disclosed structure and an accused infringing structure. However, an important difference between the two inquiries "involves the timing of the separate analyses for an 'insubstantial change.'" Namely, an equivalent structure under § 112 ¶ 6 "must have been available at the time of the issuance of the claim," whereas the doctrine of equivalents can capture after-arising "technology developed after the issuance of the patent."

The record demonstrates that PHD's linear-moving mechanism for finger movement was well known in the prior art and cannot be classified as after-arising technology. Thus, where, as here, a proposed equivalent has arisen before patent issuance, "a § 112 ¶ 6 structural equivalents analysis applies and any analysis for equivalent structure under the doctrine of equivalents collapses into the § 112 ¶ 6 analysis." Under any analysis, Welker Bearing cannot show equivalence between its disclosed mechanism and the Clamp II mechanism. [T]his court affirms the district court's grant of summary judgment of non-infringement of the '254 patent.

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