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Deere Breathes New Life into the Doctrine of Equivalents

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Legal Update

In *Deere and Co. v. Bush Hog, LLC*, the Federal Circuit recently revisited a district court's claim construction and reviewed the court's failure to apply the doctrine of equivalents. In doing so, the Federal Circuit provided additional guidance on how courts should apply the doctrine of equivalents and claim vitiation. Some have opined that decisions like those in *Deere* potentially breathe new life into the doctrine of equivalents.

The patent at issue in *Deere*, U.S. Patent No. 6,052,980 ("the Deere patent"), discloses an "easy clean dual wall deck" for a rotary cutter. More specifically, the patent discloses a dual-wall deck that encloses the structural components in a torsionally-strong box that leaves smooth surfaces on the top and bottom of the deck.

The question of whether the accused products infringed the Deere patent hinged on the construction of language in independent claim 1 that describes the relationship between the upper deck wall and the lower deck wall:

> 1. A rotary deck comprising:
>
> a lower, substantially planar, horizontal deck wall;
>
> an upper deck wall including a central portion elevated above said lower deck wall, and
>
> front and rear portions respectively sloped downwardly and forwardly, and downwardly and rearwardly from said central portion **into engagement with, and being secured to**, said lower deck wall;
>
> and right- and left-hand end wall structures respectively being joined to right- and left-hand ends of said lower and upper deck walls to thereby define a box section having torsional stiffness.
>
> (Emphasis added.)

The district court construed the terms narrowly and found that there was no literal infringement. In particular, the district court construed the term "into engagement with" to mean "brought into contact with" and construed "being secured to" as "fastened or attached." The district court then granted summary judgment for the accused infringers because the upper deck walls did not directly contact the lower deck walls in any of the accused products. The district court also held that Deere could not recover for infringement under the doctrine of equivalents because doing so would vitiate the "into engagement with" limitation.

The Federal Circuit held that the district court erroneously construed the term "into engagement with" to require direct contact between the upper and lower deck walls. The Federal Circuit reviewed the specification's use of

"engagement" in view of the figures and found that it expressly includes indirect contact. The other terms used to describe the relationship between the upper and lower deck, such as "join," "engage," and "cooperate," did not necessitate the upper deck being in direct contact with the lower deck. Accordingly, the Federal Circuit vacated the district court's construction and remanded the case for further proceedings.

Perhaps more telling than the ultimate decision to remand is the Federal Circuit's review of the doctrine of equivalents and clarification of the role that the court and the fact finder should play in analyzing whether the doctrine of equivalents applies. The Federal Circuit explained that the doctrine of equivalents is applied to the claims on "an element-by-element basis" so that every claimed element (or its equivalent) is present in the accused product. If an element is missing, the fact finder should determine whether the proposed substitute is equivalent to the missing element. The court, on the other hand, ensures that the "doctrine of equivalents does not overtake the statutory function of the claims in defining the scope of the patentee's exclusive rights." Vitiation is not an exception to the doctrine of equivalents, but a legal determination that "the evidence is such that no reasonable jury could determine two elements to be equivalent."

The Federal Circuit also cautioned that courts should not "shortcut this inquiry by identifying a 'binary choice' in which an element is either present or 'not present.'" The Federal Circuit provided an example that "a reasonable jury could find that a small spacer connecting the upper and lower deck walls represents an *insubstantial difference* from direct contact" and thus, the doctrine of equivalents *could* apply.

The *Deere* case is a reminder to practitioners and patent holders that the doctrine of equivalents is available to capture an element that is equivalent to a claimed element. However, this doctrine is balanced by the public notice function of the claims in defining the scope of the patentee's exclusive rights, as referenced in *Deere*. While it does appear that the doctrine of equivalents may be receiving more consideration presently, it nevertheless remains a risky proposition to hang an infringement case solely on the doctrine. Rather, practitioners are typically best served by drafting patent applications with examples of equivalent structures and/or drafting dependent claims that have different scopes in an effort to avoid relying solely on the doctrine of equivalents for alleging infringement.

This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.