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Foreseeability Does Not Bar Doctrine of Equivalents

The doctrine of equivalents ("DOE") is meant to protect a patent owner from a competitor that makes a competing product by simply changing a claimed element of the patent owner's invention to a known interchangeable substitute. In such a case, the competitor may still be found to infringe the patent even though the competing product is not literally claimed by the patent. There are several tests to determine whether the substitute is an equivalent. One such test is known as vitiation. Under vitiation, if determining that the substitute is equivalent to the claimed element would expand the patent owner's rights to cover products that do not even have that element, then the court will not find infringement.

In *Ring & Pinion Service Inc. v. ARB Corporation Ltd.*, the Federal Circuit found that a substitute that was foreseeable at the time patent application was filed could be covered under the DOE. No. 2013-1238, slip op. (Fed. Cir. Feb. 19, 2014). Thus, even though the patent owner could have foreseen the substitute, there is no requirement that the patent application specifically claim that substitute. The Federal Circuit further held that the district court misapplied the vitiation test by using it as an exception to the DOE.

ARB Corporation ("ARB") owns U.S. Patent No. 5,591,098 directed to a locking differential. A differential in a car is a mechanism that allows the wheels powered by the engine to spin at different speeds. A locking differential contains a locking mechanism that, when engaged, effectively bypasses the differential and causes the wheels to spin at the same speed. In 2011, Ring & Pinion Service Inc. ("R&S") created a locking differential that ARB believed infringed its patent. ARB sued and the court found that R&S's locking differential did indeed infringe ARB's patent. Afterward, R&S made another locking differential named Ziplocker. The Ziplocker was designed to avoid ARB's patent by making a minor change to the air cylinder which provided the force necessary to engage the locking mechanism. Specifically, R&S inverted the air cylinder claimed in ARB's patent. ARB again sued R&S for infringement. During trial, both ARB and R&S agreed that the Ziplocker cylinder was an equivalent to ARB's cylinder. Both also agreed that the Ziplocker's cylinder was foreseeable when ARB wrote the patent application.

The issue before the district court was whether the foreseeability of Ziplocker's cylinder meant that the DOE could not be applied. Both parties agreed that if the DOE applied there was infringement. The district court found that foreseeability did not bar the application of the DOE. But, instead of finding that R&S infringed ARB's patent as was agreed by the parties, the district court applied the vitiation test. Under the vitiation test, the district court determined that finding infringement by R&S would effectively expand ARB's patent rights to include

locking differentials that did not have an air cylinder. Thus, the district court used the vitiation test to overcome the finding of infringement to which the parties had agreed.

The Federal Circuit affirmed the district court's holding that foreseeability is not a bar to the application of the DOE. However, the Federal Circuit disagreed with the district court's application of the vitiation test. The problem was that both parties had already agreed that R&S's cylinder was an equivalent of ARB's cylinder. The Federal Circuit explained that "vitiation is 'not an exception to the…[DOE], but instead, a legal determination that the evidence is such that no reasonable jury could determine two elements to be equivalent." Slip op. at 9. In this case, because both parties had already agreed that the cylinder was an equivalent, it did not matter what a reasonable jury would find. Thus, the district court was not free to make such a legal determination at that point and erred when it did so.

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