Alan Wang in Law360: Ensnarement as Defense Against Infringement

October 27, 2017

PRACTICES Patents, Patent Prosecution and Counseling, Intellectual Property

Law360 reported on a recent decision by the U.S. Circuit Court of Appeals for the Federal Circuit that cleared Boston Scientific Corp. in a $200 million patent case, drawing attention to the rarely invoked ensnarement defense to infringement. The report quoted Haynes Boone Associate Alan Wang in a primer on how the defense works and why lawyers say accused infringers should consider using it more often.

In a ruling last month, the appeals court upheld a judge's decision that the ensnarement defense shielded Boston Scientific from liability in a case where a doctor alleged the company's Express coronary stent is covered by his patent, *Law360* reported.

Ensnarement bars patent owners from asserting an infringement theory under the doctrine of equivalents that encompasses, or "ensnares," the prior art. In cases involving equivalents, or allegations that a product infringes even if it doesn't fall within the literal scope of the claims, there are significant advantages to invoking ensnarement, attorneys say. …

The idea of the ensnarement defense is that a patent owner cannot argue its claims can be read broadly enough to say an accused product is equivalent to them if reading them that way would render them invalid in view of the prior art.

To ensure that doesn't happen, Federal Circuit precedent has created several hurdles for patent owners seeking to overcome the ensnarement defense, which first arose in a 1990 Federal Circuit decision involving golf balls called *Wilson Sporting Goods Co. v. David Geoffrey & Associates.*

As a result, "the ensnarement rule should be very favorable to the defendant's side," Wang said. …

In addition, once the accused infringer invokes the ensnarement defense and presents earlier patents or other prior art that could be ensnared by the doctrine of equivalents infringement theory, it is up to the patentee to prove otherwise. …

"In a crowded field, it's very difficult not to ensnare the prior art," Wang said. …

"From my point of view as a patent prosecutor, we should be mindful of all these rules against the doctrine of equivalents and draft claims that are broad enough to capture any possible infringing device without relying on the doctrine of equivalents," Wang said. "If you have to rely on the doctrine of equivalents, that's really not a good thing for the patent owner."

When a patent is being drafted, the goal should be to disclose "all foreseeable variants" that the claims cover as much as possible, he said. For instance, he noted, if the patented invention uses a copper conductor, the patent could just claim a "conducting material," so that inventions that use silver or any other conductor would be found to infringe.

Excerpted from *Law360*. To read the full article, click here.