Alan Wang in Law360: Still Difficult For Patent Holder to Use Equivalents Theory

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PRACTICES Patents, Patent Prosecution and Counseling, Intellectual Property

A recent Federal Circuit case reminds us how difficult it is for a patent holder to win an infringement case based on a doctrine of equivalents (DOE) infringement theory. In *Jang v. Boston Scientific Corp. & Scimed Life Systems Inc.*,No. 16-1275 (Fed. Cir. Sept. 29, 2017), the Federal Circuit affirmed the district court's vacatur of the jury's infringement verdict, finding that Boston Scientific Corporation's (BSC) product did not infringe the asserted claims of Dr. David Jang's patent under the DOE because Jang did not meet his burden of proving that his DOE theory did not ensnare the prior art.

The DOE allows a patent holder to prove infringement by an accused device if the accused device performs substantially the same function as claimed in substantially the same way to obtain substantially the same result, even if it does not literally infringe the claims of the patent. However, there is a concern that the DOE undercuts the notice function of a patent claim. The courts have come up with various ways of limiting the application of the DOE, including prosecution history estoppel, the public dedication rule, the all-limitations rule and specific exclusion rule, and the ensnarement rule. *Jang* demonstrates an example of the ensnarement rule.

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