

IN THE WORLDWIDE PATENT COURT

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Court

Pony Co.

v.

Donkey Co.

Represented by York M. Faulkner

Represented by David Albagli

- **By stipulation of the parties, all issues will be decided by a single bench trial**
- **Absent stipulation:**
 - Claim Construction determined at a Markman Hearing
 - Estoppel arguments typically heard at summary judgment or pre-trial
 - Doctrine of equivalents argued at trial



Before the Hon. Renée Marie Bumb
Chief United States District Judge, District of New Jersey

Scope of Claim 1 After Amendment

Element

- A. A stand for a mobile device comprising a mounting portion on which a mobile device is placed, and a base portion to which said mount is rotatably connected via a hinge shaft, the stand for a mobile device characterized by comprising:
- B. a plurality of recesses formed in said base portion;
- C. a protrusion from the mounting portion side mating with said recesses at a predetermined position; and
- D. ~~an elastic member~~ a metal compression coil spring that biases said protrusion;
- E. whereby [*concluding clause characterizing the stand*].

The Court must rule on Element D

Infringement?

- ***Literal Infringement:***

Pony concedes
literal *difference*
(leaf vs. coil
spring)



No literal
infringement

- ***Pony invokes Doctrine of Equivalents (“DOE”):***

Pony has
burden
under DOE



Disclaimer /
Argument
Estoppel



Festo /
Amendment
Estoppel



Proceed to
DOE

Donkey has
burden of
proof

Pony has
burden of
proof

Issue 1: The *Festo* Rebuttal

“[W]hether an amendment was merely tangential to an alleged equivalent necessarily requires focus on the context in which the amendment was made; hence the resort to the prosecution history.”

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.
[*Festo X*], 344 F.3d 1359, 1370 (Fed. Cir. 2003)

Applicant's Arguments with Amendment

The **rubber stopper** disclosed in Cited Document 1 degrades over time and does not provide a distinct “click” sensation.

In contrast, *the present invention utilizes a **mechanical mechanism characterized by** the linear compression and restoring force of a metal compression coil spring, which constitutes a distinct technical difference.*

“ELASTIC MEMBER” GENUS



“MECHANICAL MECHANISM” SUB-GENUS

↓ *characterized by*
linear compression + restoring force
↓ *exemplified by*
metal compression coil spring



RUBBER STOPPER SUB-GENUS

Document 1 Prior Art

- “deformed state” default condition
- “pressed . . . by rubber elasticity”

Pony’s Remarks

- “degrades over time”
- “no distinct click”

The “distinct technical difference”

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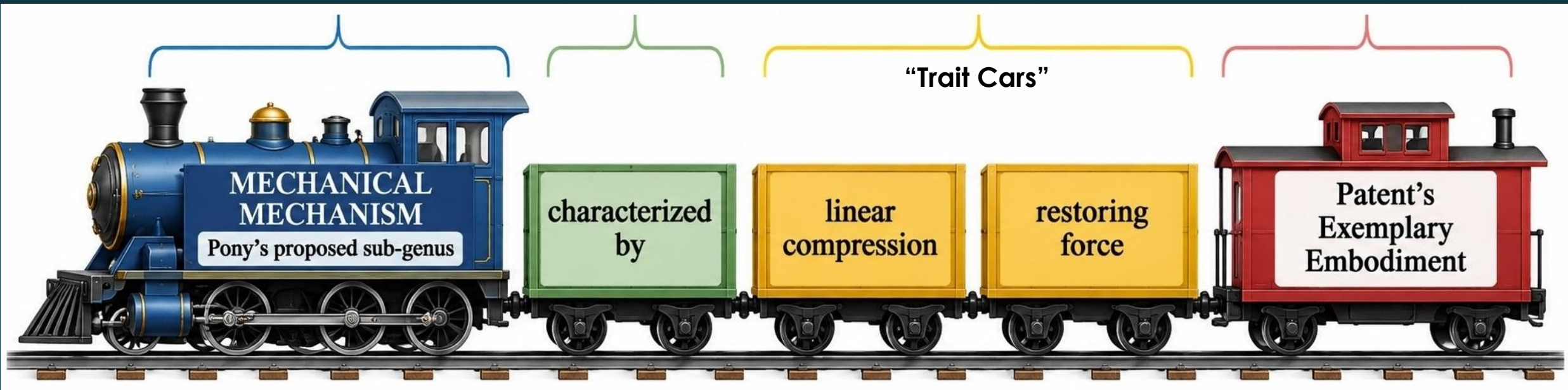
Pony

“a mechanical mechanism”

“characterized by”

“the linear compression
and restoring force of a”

“metal compression
coil spring”



The “distinct technical difference”

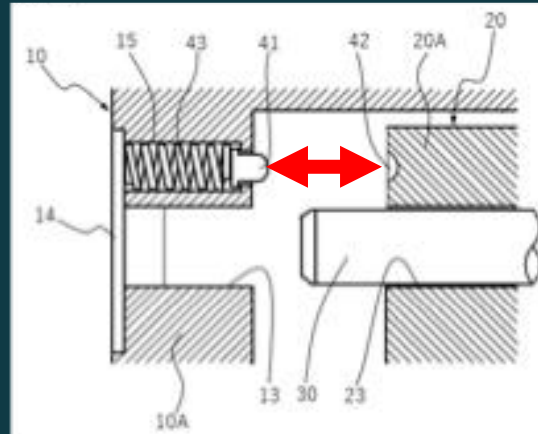
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Pony

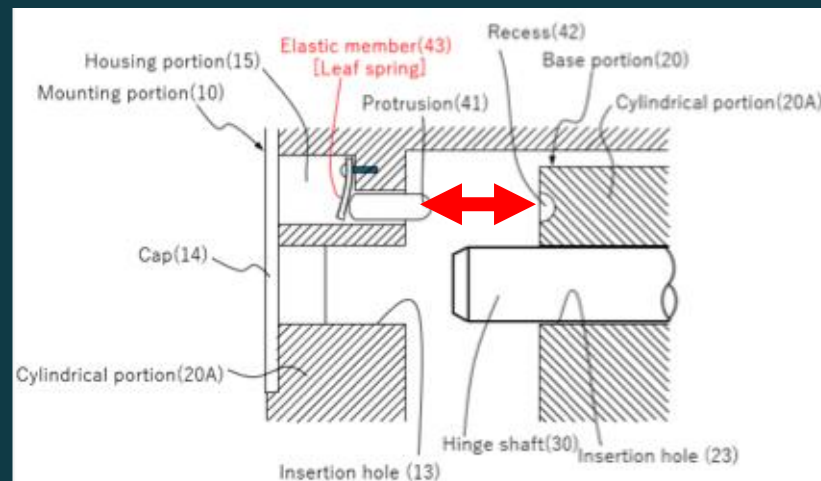
Mechanical Mechanisms

Linear compression and restoring force at protrusion (41) interface

Coil Spring
(axial deflection
along coil)



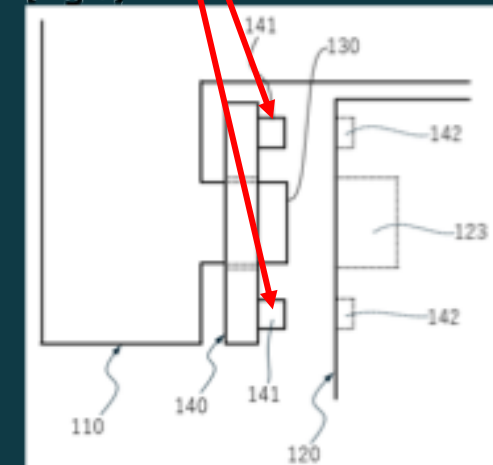
Leaf Spring
(cross-plate
deflection)



Rubber Stoppers

- “installed in an elastically deformed state”
- “pressed against recesses by rubber elasticity”
- “degrades over time”
- “no distinct click”

[Fig.3]



Eli Lilly and Co. v. Hospira, Inc., 933 F.3d 1320 (Fed. Cir. 2019)

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Pony

- Lilly amended two claims to narrow “**an antifolate**” (like “**elastic member**”) to a specific salt, “**pemetrexed disodium**” (like “**coil spring**”)
 - Lilly could have claimed “**pemetrexed salts**” (like “**metal spring**”) generally but did not
- Hospira’s protocol used an alternative salt “**pemetrexed ditromethamine**” (like “**leaf spring**”)
- Hospira argued that Lilly surrendered all pemetrexed salts except the claimed pemetrexed disodium
- The Federal Circuit held:
 - The type of pemetrexed salt “relates only tenuously to the reason for the narrowing amendment.”
 - “We do not demand perfection from patent prosecutors, and neither does the Supreme Court.”

*** * * Pony’s Amendment * * ***

- Here, the type of “metal spring” (coil or leaf) “relates only tenuously to the reason for” Pony’s narrowing amendment
- A leaf spring has none of the characteristics of a rubber stopper, e.g., deformation and degradation
- A leaf spring shares the recited characteristics of a coil spring
 - A leaf spring is “a mechanical mechanism” that provides a distinct “click”
 - The linear compression and restoring force at the protrusion (41) interface is essentially the same for a leaf spring

Declaration in Support of Claim Amendment:

- “Use of **this particular combination of salts** greatly improves the cost-effectiveness of commercial manufacturing by reducing the number of cycles required for each harvest and reducing the processing time for each harvest.”
- “[C]hoosing a working salt combination was a ‘lengthy development path’ and that ‘merely adding a second salt’ would not result in the invention.”

Federal Circuit

- “[D]uring prosecution [of the patent], Amgen clearly and unmistakably surrendered salt combinations other than **the particular combinations** recited in the claims.”

*** * * Pony’s Amendment * * ***

- No such limiting words as “this particular combination of salts.”
- Instead, a sub-genus “mechanical mechanism” characterized by linear compression and restoring force at protrusion 41 provides traits exemplified by the patent’s coil spring.
- A leaf spring shares those traits and is not expressly excluded in Pony’s prosecution remarks.

Amendment to Claim 1 Triggered Presumption of Surrender under *Festo*

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Donkey

- ▶ “Elastic member” was changed to read “metal compression coil spring” to distinguish the prior art cited by the Examiner as a reference under § 102, which taught a rubber stopper elastic member
 - ▶ Thus, a narrowing amendment for a reason of patentability, and Pony concedes this
- ▶ Prosecution history estoppel presumptively bars Pony from asserting equivalents for the element narrowed by amendment (*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* [*Festo VIII*], 535 U.S. 722, 736-41 (2002))
- ▶ Pony now attempts to resurrect part of the claim scope that was surrendered
 - ▶ *Festo* allows that the surrendered scope does extend to aspects that were **not foreseeable** at the time, aspects that are only **tangential** to the reason for the amendment, or “some other reason” – if the patentee can establish such reasons
 - ▶ Pony asserts that the amendment’s purpose – to exclude a rubber stopper-like elastic member – is **tangential** to use of any and all types of metal-based springs

Presumption of Surrender Triggered – Pony Cannot Rebut for Tangentiality

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Donkey

- ▶ Pony argues the amendment to a “metal compression coil spring” should be construed to cover all types of metal springs – because this “sub-genus” is tangential to the core basis of the amendment
- ▶ The core basis for the amendment was to differentiate between:
 - ▶ parts that **do** or **do not** produce a “click” and that **are not** or **are** degradable, alleging that these properties define the surrendered claim scope, somehow marking the boundary between a mechanical mechanism sub-genus (tangential subject matter) and a rubber body sub-genus (surrendered subject matter)
 - ▶ These properties are, however, not recited in the claims, and are not given patentable weight in attempts to distinguish the apparatus structure over the art (See MPEP 2114)
- ▶ Instead, we just have the amended element as recited, a “metal compression coil spring,” with no tangential subject matter to resurrect
- ▶ Pony’s assertion that “metal compression coil spring” should nonetheless be read more broadly is incorrect

Presumption of Surrender Triggered – Pony Cannot Rebut for Tangentiality

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Donkey

- ▶ Pony's assertion that “metal compression coil spring” should nonetheless be read more broadly, effectively, as “metal spring” is incorrect
 - ▶ Pony points to its statement in the prosecution history that the “metal compression coil spring” is characterized by a “linear compression and restoring force” – and thus the claim covers any metal spring characterized by a linear compression and restoring force – however, this reads “compression coil” out of the claim
 - ▶ *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (rejecting a construction that would render a claim term superfluous)
- ▶ Instead, as in *Amgen v. Coherus*, remarks that base patentability on the amended claim language can result in a surrender of claim scope even to what the prior art did not disclose
 - ▶ Pony surrendered more than was necessary, estoppel bars equivalents as a matter of law, and Donkey's Mobile Device Stand does not infringe under DOE

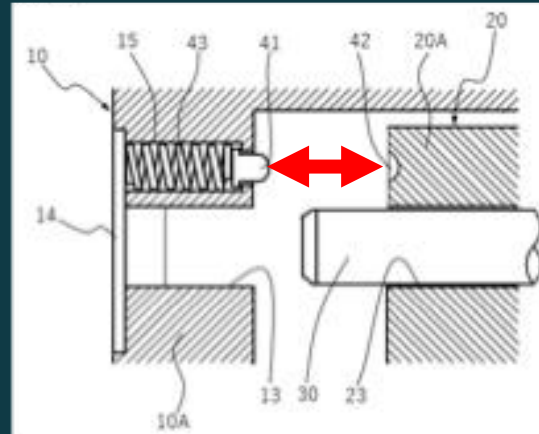
Issue 2: Equivalence

“In substantially the same way”

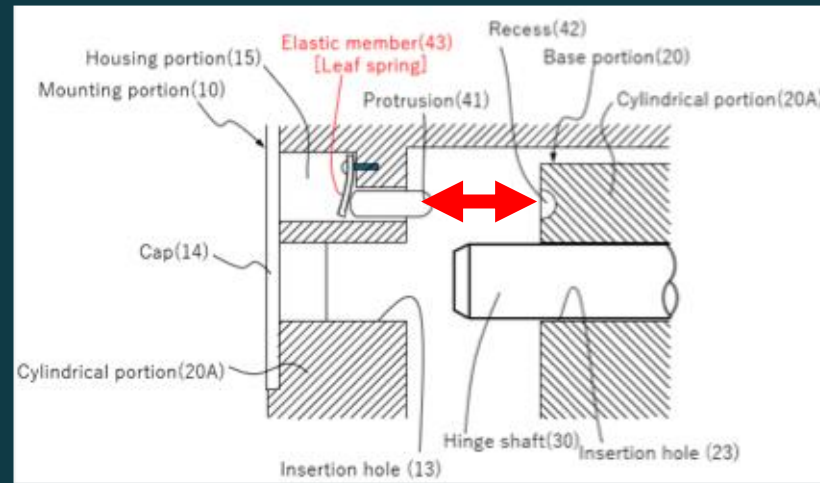
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Pony

Coil Spring
(axial deflection
along coil)



Leaf Spring
(cross-plate
deflection)



- Both springs are characterized by linear compression and restoring force at the protrusion (41) interface.
- The differing points of deflection are an insubstantial difference in the “way.”
- Each spring performs the identical function — biasing protrusion (41) — in substantially the same way, with equal performance and durability as the result.

“ELASTIC MEMBER” GENUS



“MECHANICAL MECHANISM” SUB-GENUS

- ↓ *characterized by*
linear compression + restoring force
- ↓ *exemplified by*
metal compression coil spring
- ↓ *accused metal leaf spring*
same characteristics at protrusion 41



RUBBER STOPPER SUB-GENUS

- **Document 1 Prior Art**
 - “deformed state” default condition
 - “pressed . . . by rubber elasticity”
- **Pony’s Remarks**
 - “degrades over time”
 - “no distinct click”

In Donkey's Mobile Device Stand –“Way” of Element D Is Not Equivalent

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Donkey

- ▶ First, for clarity, analyzing whether the “function – way – result” of the Mobile Device Stand is equivalent to claim 1 is needed only if Pony's argument to rebut the *Festo* presumption of surrender is accepted
 - ▶ Parties agree that the “function” and “result” for element D with respect to the Mobile Stand Device and the claimed invention are substantially the same
 - ▶ Donkey asserts that element D of the MSD does not perform in substantially the same “way” as in the claimed invention
 - ▶ The claimed coil spring biases via axial compression but the MSD's leaf spring biases via bending/flexural stress of a plate
 - ▶ Pony would have the Court assess the “way” at a high level of abstraction, but the patent language itself directs the analysis to this level of detail: axial compression of a helical coil v. the bending of a plate – but mechanically, these are not insubstantially different
- ▶ Donkey also asserts that finding the leaf spring of the MSD to be an equivalent of a “metal compression coil spring” effectively reads the claim terms “compression coil” out of the claim, and this would vitiate the limitation

Issue3: Disavowal

Disavowal by Pony – was “clear and unmistakable”

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Donkey

- ▶ Disavowal of claim scope can be caused by language in the specification or the prosecution history (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316-17 (Fed. Cir. 2005))
- ▶ Disavowal must be clear and unmistakable, though it **need not be explicit** (Trs. of Columbia Univ. v. Symantec Corp., 811 F.3d 1359, 1363-64 (Fed. Cir. 2016))
 - ▶ Statements such as “**the present invention is . . .**” by the patentee limits the claims
- ▶ Pony’s reply to the USPTO’s rejection contains a clear and unmistakable disavowal of mechanisms other than that of a metal compression coil spring
 - ▶ In explaining how the only amendment to claim 1 distinguished the prior art and was done *in order to get the USPTO to allow the claim*, Pony wrote:
 - ▶ “In contrast, **the present invention utilizes** a mechanical mechanism characterized by . . . a metal compression coil spring.”
 - ▶ This is a clear statement that describes a characteristic feature of the invention, and in doing so Pony implicitly limited the invention

No Disclaimer

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Pony

The Patent Specification

- The specification is clear: element 43 of the invention is broadly described as an “elastic member” at every mention; the coil spring is disclosed only as an exemplary embodiment of the “elastic member.”

Pony's Remarks with the Amendment

- The remarks are equally clear and are expressly directed to “a mechanical mechanism” as a sub-genus of the specification’s “elastic member”
- That sub-genus is described, not as a coil spring, but as “characterized by the linear compression and restoring force” of a coil spring.
- The remarks contain no clear and unmistakable words of exclusion: no “only,” no “limited to,” no “does not include”

Court's Ruling — From the Bench

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Court

Question 1: Disavowal or Disclaimer

- Pony succeeds, and the Court moves to *Festo*.

Question 2: Rebuttal of *Festo* Presumption

- Donkey prevails, and the Court finds no infringement.

Question 3: Equivalence

- The Court need not reach question three because it finds no infringement at the *Festo* stage.

Court's Ruling — From the Bench

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Court

Question 1: Disavowal or Disclaimer

➤ The Court finds in Pony's favor; Pony did not use "clear and unmistakable" disclaimer in its amendment that "would have been evident to one skilled in the art." *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063-64 (Fed. Cir. 2016).

Court's Ruling — From the Bench

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Court

Question 2: Rebuttal of *Festo* Presumption

➤ Pony does not rebut the *Festo* Presumption; leaf springs represent “old technology” that should have been “known in the prior art in the field of the invention,” *Festo X*, 344 F.3d at 1369, and Pony’s amendment to its patent **was explicitly** “made to avoid prior art that contains the equivalent in question [and thus] is not tangential,” *id.* at 1370.

Court's Ruling — From the Bench

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Court

Question 3: Equivalence

➤ Because Pony did not rebut the *Festo* presumption, the Court need not reach the equivalence question. However, if it did, it would likely find no equivalence because although both springs provide the same “function” to achieve the same “result,” they both succeed in different “ways,” a coil spring through compressive force and a leaf spring through bending force. That different way precludes finding infringement based on the doctrine of equivalence.

Court's Ruling — From the Bench

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Court

Final judgment in favor of Donkey!



Donkey's product does not infringe Pony's patent.