IN THE WORLDWIDE PATENT COURT

PONY COMPANY, Plaintiff, v. DONKEY COMPANY, Defendant.	**OPINION**

RENÉE MARIE BUMB, Chief United States District Judge

This patent infringement action brought by Plaintiff Pony Company against Defendant Donkey Company asks the Court to examine the Doctrine of Equivalents. The Doctrine of Equivalents exists to protect patent holders from infringement when a competing product does not literally infringe a patent, but nevertheless makes such minor, insubstantial, or tangential changes it may as well—and thus does—infringe. Here, however, the Court finds in Donkey Co.'s favor. Donkey's deviation from Pony's patent is not tangential, and Pony surrendered the ground where Donkey's alteration lies during its patent prosecution when it narrowed its claims to achieve patentability. Prosecution history estoppel thus bars Pony's claims.

Pony patented a hands-free cell phone stand that keeps a cell phone in an upright position to watch video content or monitor incoming notifications. [R.6.] The patent office initially denied Pony's patent application. [R.5 ¶ 1.] The examiner found Element D, "an elastic member that biases [a] protrusion" to keep the stand upright, mirrored prior art and lacked novelty. [*Id.*] In response, Pony amended Element D

narrowing an elastic member generally to a metal compression (or coil) spring specifically. [*Id.* ¶ 3.] Pony described its innovation as preventing degradation compared to a rubber stopper and using "linear compression and restoring force" to achieve its goal. [*Id.*] The patent office approved Pony's patent with the narrowing amendment. [*Id.* ¶ 4.] Donkey's product is identical in all material ways ***except*** at Element D. [R.15.] Donkey's product uses the bending force of a metal leaf spring to achieve the same result in the allegedly infringing product instead of a coil spring. [*Id.;* R.18.] The parties stipulate that this change precludes the Court from finding Donkey's product literally infringes Pony's patent, and any infringement must be by equivalence. [R.18.]

Donkey first argues Pony disclaimed all other elastic members when it chose to use a compression or coil spring. This argument is not persuasive. Pony's amendment lacks the "clear and unmistakable" disclaimer required to consciously surrender Donkey's leaf spring alternative. *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063–64 (Fed. Cir. 2016).

Second, Donkey argues Pony did not rebut *Festo*'s presumption that its narrowing amendment "surrendered all subject matter between the broader and the narrower language." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.* [*Festo X*], 344 F.3d 1359, 1370 (Fed. Cir. 2003). Donkey prevails on this point. Pony made its narrowing amendment in direct response to the patent examiner's rejection, or in other words, to achieve patentability. And leaf springs are an ancient technology found in everything from King Louis's chariot in pre-revolutionary France to the first Model T

Ford in 1908. Their availability as an equivalent should have been well known to Pony at the time it made its narrowing amendment. With no other proffered basis to rebut *Festo*'s presumption, the Court concludes Pony surrendered the ground between the general "elastic member" and specific "metal compression spring" ultimately used—ground that includes Donkey's leaf spring.

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. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28–29 (1997); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950). That different means, albeit to the same end, precludes finding infringement based on the doctrine of equivalence.

The Court will enter an order of judgment in favor of Donkey.