Class 9: Doctrine Of Equivalents

- Administrative
  - Next Time: Trademarks: 617-24; 624-32; 634
  - Monday: Frontier Flight 721 from DCA to DEN
  - News
    - Tons this week
      - IBM to publish all patent applications on the web at time of filing.
        - http://www.nytimes.com/2006/09/26/technology/26patent.html
      - Great NYT piece about the E.D. Tex., and in particular the town of Marshall Tex.
        - http://www.nytimes.com/2006/09/24/business/24ward.html?hp&ex=1159070400&en=4ad827167d89b9a0&ei=5094&partner=homepage
      - Oprah08.net
- Last Time
  - Hypo #1
    - You have a Patent with Two Claims
      - Independent Claim 1: The doohicky comprising A, B, and C
      - Dependent Claim 2: The doohicky described in claim 1, further comprising D and E
    - All of these questions are about LITERAL infringement only.
    - Which of the following competitor's doohicky's infringe?
      - #1: A, B
        - No infringement (lacks C)
      - #2: A, B, C, G
        - Infringes claim 1 (extra element doesn't matter).
      - #3: A, B, D, E
        - No infringement (lacks C)
      - #4: A, B, C, D, E, F
        - Infringes BOTH claims 1 and 2.
  - Hypo #2
    - You have a Patent with One Claim
      - Independent Claim 1: The doohicky consisting of A, B, and C
    - Which of the following competitor's doohicky's infringe?
      - #5: A, B
        - No infringement (lacks C)
      - #6: A, B, C, G
        - No infringement (consisting of)
      - #7: A, B, C, D, E, F
        - No infringement (consisting of)
  - Hypo #3
    - You have a Patent with One Claim
      - Independent Claim 1: The doohicky comprising A, B, and C
    - Your competitor has a Patent with One Claim
      - Independent Claim 1: The doohicky comprising A, B, C, X and Y
    - Which of the following acts are non-infringing acts?
      - #8: YOU sell doohickys with A, B, and C
        - No infringement. (lacks X and Y)
      - #9: Your competitor sells doohickys with A, B, and C.
        - Competitor infringes your claim 1
      - #10: YOU sell doohickys with A, B, C, and X
        - No infringement (lacks Y)
      - #11: Your competitor sells doohickys with A, B, C, and X
        - Competitor infringes your claim 1 (extra element doesn't matter).
      - #12: YOU sell doohickys with A, B, C, X, and Y
        - You infringe competitor's Claim 1.
      - #13: Your competitor sells doohickys with A, B, C, X, and Y
        - Competitor infringes your Claim 1.
      - #14: Nobody wants to buy doohickys that just have A, B, and C (even if you add only X or only Y). The market demands all five elements. What do you do?
        - Cross-licenses, probably.
- Procedures for Obtaining a Patent
  - "Prosecution"
    - Steps before final OA
      - Assigned to Art unit and examiner.
      - First Office Action (OA) -- usually a rejection (Burden on Examiner)
      - Applicant responds: Traverse or acquiesce.
      - Post-AIPA, third parties can submit prior art references.
      - "Final Rejection" or Allowance
    - Applications can be amended liberally during prosecution.
      - To respond to a rejection or other OA.
      - Correct mistakes IN THE CLAIMS.
      - Add or change drawings
      - Update the disclosure.
    - After final rejection?
      - Continuation or amendment after final rejection.
    - After allowance?
      - Reissue to broaden or narrow the claims (so long as bona fide error or omission."
      - Anyone can ask for reexamination if substantial new basis for questions patentability
      - Lawsuits.
      - Interference proceeding to decide priority
      - ITC actions to block importation of infringing
- Doctrine of Equivalents
  - Policy Rationales
    - ENGLISH LANGUAGE IS IMPRECISE.
    - PRECLUDE TRIVIAL DESIGN AROUND ATTEMPTS
    - CHANGING TECHNOLOGY
      - WHO GETS THE BENEFIT?
    - SETTLED EXPECTATIONS: IT'S BEEN AROUND FOR A LONG TIME.
      - PATENTEE KNOWS ABOUT DOE WHEN THEY GET THE PATENT.
  - Example
    - W-J: Patent used to have no pH limits and it was amended to say "pH range from approximately 6.0 to 9.0"
      - Alleged infringer operated at a pH of 5.0.
      - Held: Remand because the reason for the "6.0" part of the amendment wasn't clear.
- Prosecution History Estoppel
  - Policy Rationale
    - PREVENTS PATENTEE FROM IGNORING/COMMITTING A FRAUD ON THE PTO.
    - ESTOPPEL
  - Festo