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PATENTS

The authors offer guidance on overcoming challenges in presenting the doctrine of equivalents in a jury trial.

The Doctrine of Equivalents and the Challenge of Giving Meaning to “Substantial” in Patent Jury Trials



LISA FERRI, DANIEL COOPER AND LANA KHOURY

Clearly drawn legal instructions serve as an understandable target upon which jurors can focus their assessment of evidence during deliberations. Qualifiers such as “all,” “every,” “absolute” and “identical” give jurors bright lines to help organize deliberations. However, the law often provides less precision

Lisa M. Ferri is a partner in Mayer Brown's intellectual property practice and serves as the IP practice leader for the New York office. She has over 20 years of experience acting as lead trial and appellate counsel on behalf of high-profile companies.

Daniel Cooper is the President of LitStrat Inc., a national jury research and consulting firm with offices in New York and Miami. For nearly 20 years, he has worked with trial teams on hundreds of jury and bench trials throughout the country.

Lana Khoury is a law clerk in the Washington office of Mayer Brown.

and hence less guidance for jurors on a variety of fundamental legal standards.

In the context of a patent jury trial that includes the contention of infringement under the doctrine of equivalents, jurors are instructed to assess whether the accused product is “substantially” the same as or “insubstantially” different from the asserted patent claims. The imprecision of this guidance and the resulting discretion left to jurors to define and apply the proper test presents trial counsel and experts both challenges and opportunities.

Section I of this article discusses the background of the doctrine of equivalents. Section II discusses certain pre-trial issues faced in bringing or precluding the use of the doctrine of equivalents. Section III offers practical suggestions regarding juror concerns about accepting or rejecting an equivalents analysis at trial.

I. Background of the Doctrine of Equivalents

Patent laws afford protection to inventors for their contributions, while also promoting the progress of science and technology. However, the courts and lawmakers have struggled to strike a balance between securing rights for inventors and preventing broad exclusions that may stifle innovation. While a patent grants an in-

ventor the right to exclude others from practicing an invention, determining the limits of a patentee's right to exclude has proven to be a challenge.

Under the patent laws, an inventor may prevent others from making, using or selling devices or processes that embody the claims of a patented invention. But what is an inventor to do when an accused invention does not *literally* infringe the elements of a patent claim? The doctrine of equivalents allows patentees to establish infringement when an accused product has skirted the literal scope of the patent claims but is only insubstantially different from the claimed invention. As the Supreme Court stated in *Graver Tank & Mfg. Co.*, the doctrine of equivalents prevents the “unscrupulous copyist [from making] unimportant and insubstantial changes” that “take the copied matter outside the claim, and hence outside the reach of the law.”¹

The modern doctrine of equivalents, outlined by the Supreme Court in *Warner-Jenkinson Co.*, poses the essential inquiry in determining equivalence: “Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?”² The court found that two tests, the “triple identity test” and the “insubstantial differences test,” were probative of this inquiry and should be considered in determining equivalence. The triple identity test (also known as “function/way/result”) asks whether the element in question “performs substantially the same function in substantially the same way to obtain the same result” as the patented invention. While “insubstantial differences” is a distinct test, the courts often base their conclusions on the triple identity test because “the insubstantial differences test offers little additional guidance as to what might render any given difference ‘insubstantial.’”³

II. Challenges in Bringing and Defending Against an Equivalents Infringement Case

The court in *Graver Tank* did not, however, offer a specific method of presenting or satisfying the triple identity test, i.e., function/way/result. The court only suggested forms of proof of equivalence such as expert testimony, testing, learned treatises and disclosures of the prior art. While the court has maintained that the doctrine of equivalents is “not the prisoner of a formula” and “the available relevant evidence may vary from case to case,” certain evidentiary requirements have developed over time.⁴ These requirements are necessary, as the U.S. District Court for the Federal Circuit stated in *Texas Instruments*, because “although the standard for infringement under the doctrine of equivalents is simple to articulate, it is conceptually difficult to apply.” This is particularly the case where the fact finder is a jury, untrained in both the application of patent law and the underlying technology at issue.

The procedural requirements announced by the courts require, for example, that a patentee must present specific evidence for an equivalents claim separately from literal infringement claims. A patentee, per

Colucci v. Callaway, also must provide particularized testimony and an argument linking the differences between the claimed invention and the accused device or process on a limitation-by-limitation basis.⁵ The identification of a doctrine of equivalents theory must begin early on, as many patent procedural rules require sufficient identification of the theory in a patentee's infringement contentions. The court in *ASUS v. Round Rock* struck the patentee's expert testimony on equivalents for failure to provide sufficient notice in its infringement contentions of its reliance on the theory.⁶ In particular, the court rejected boilerplate “placeholder” language and stated that a patentee must sufficiently describe the equivalents theory by identifying the specific components of the accused product that infringe, element by element.

Prior to trial, an expert witness must provide sufficient detail of the patentee's equivalents theory in his or her report. The expert must demonstrate equivalence under either the “function/way/result” or “insubstantial differences” test by applying the test to the claim elements and the allegedly equivalent features of the accused product and by providing a link between the two with evidentiary support.

The expert report paves the way for the expert's trial testimony, as a jury must be provided with the proper evidentiary foundation from which it may permissibly conclude that a claim limitation has been met by an equivalent. Without the appropriate element-by-element evidence provided by a plaintiff, “a jury is more or less put to sea without guiding charts when called upon to determine infringement under the doctrine.”⁷

Indeed, courts have found that generalized testimony as to the overall similarity between a patent claim and the accused product is insufficient. In *Colucci*, the court upheld a jury's verdict of no infringement under the doctrine of equivalents, finding that the plaintiff's expert failed to provide any particularized testimony or linking arguments demonstrating the insubstantiality of the differences between the claim elements and the accused devices. In particular, the court found that the expert's generalized testimony regarding literal infringement that merely invoked the term “substantially” did not fulfill the legal requirements of the doctrine of equivalents. Furthermore, plaintiff's failure to mention the doctrine of equivalents until closing arguments doomed the equivalents infringement argument.

From a defendant's standpoint, the primary objective is to prevent the issue of infringement under the doctrine of equivalents from being submitted to a jury at all. To do this, a defendant must use summary judgment or other motion practice to knock out the claim, in effect establishing that as a matter of law an accused product is not equivalent to a claimed invention. For instance, the doctrine of prosecution history estoppel may be used to bar an equivalents argument for any claim element that was narrowed during prosecution of the patents. Defendants may argue noninfringement, as a matter of law, by showing that the patentee effectively

¹ *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.*, 339 U.S. 605, 607, 85 U.S.P.Q. 328 (1950).

² *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40, 41 U.S.P.Q.2d 1865 (1997).

³ *Id.* at 40.

⁴ See *Texas Instruments v. Cypress Semiconductor*, 90 F.3d 1558, 1566, 39 U.S.P.Q.2d 1492 (Fed. Cir. 1996).

⁵ *Colucci v. Callaway Golf Co.*, 748 F. Supp. 2d 629, 632, 2010 BL 231177 (E.D. Tex. 2010).

⁶ See *ASUS Computer Int'l v. Round Rock Research, LLC*, No. 12-CV-02099 JST (NC), 2014 BL 419503, at *3 (N.D. Cal. Apr. 11, 2014).

⁷ *Lear Siegler v. Sealy Mattress*, 873 F.2d 1422, 1425-26, 10 U.S.P.Q.2d 1767 (Fed. Cir. 1989).

narrowed the very element at issue during the prosecution process. As the Supreme Court held in *Festo v. Shoketsu*, without prosecution history estoppel, the doctrine of equivalents would essentially allow the patentee to regain claim scope given up during prosecution.⁸

A defendant may also move for summary judgment of no infringement under the doctrine of equivalents by arguing claim vitiation. Vitiation is a legal determination that evidence is such that no reasonable jury could determine two elements to be equivalent—in other words, where the claim element is the “polar opposite” of the accused equivalent.⁹ Vitiation can pose an evidentiary hurdle by preventing an equivalents inquiry from reaching the jury. Therefore, a defendant may argue that if applying the doctrine of equivalents would effectively vitiate a claim limitation, the determination must be precluded as a matter of law.

Should infringement pursuant to the doctrine of equivalents be presented at trial, the parties will also need to anticipate the limited guidelines provided to juries through the jury instructions. In keeping with the controlling law, model jury instructions do not include a definitive formula on how the jury should decide equivalency, but rather state that the jury should consider whether the differences between the two products or processes are “insubstantial” considering all the relevant evidence.¹⁰ No definition of “insubstantial” is provided; rather the jury is instructed that “one way to decide . . . is to consider whether, as of the time of the alleged infringement, the part of the product performed substantially the same function, in substantially the same way, to achieve substantially the same result as the requirement in the patent claim.”¹¹

These instructions still leave it to the jurors to define for themselves the scope of what is insubstantial for the purpose of finding equivalence. Special verdict forms and interrogatories may be used to compensate for the gaps left by ambiguous jury instructions. The Supreme Court endorses the use of special verdict interrogatories to understand particular findings of equivalence of certain claims, finding their use “very useful in facilitating review, uniformity, and possibly postverdict judgments as a matter of law.”¹² To effectively gain information and to limit issues on appeal, the special verdict forms should also separate questions of literal infringement, equivalents and other claims.¹³

III. A Challenge for Juror Decision-Making

As trial counsel, you have managed your patent infringement case from complaint to trial. The pleadings, expert reports, motion practice and legal debates over

the doctrine of equivalents and its applicability to your case have been fully litigated. The openings and closings have been presented; the jurors have the benefit of all the trial testimony, including expert opinions and inventor testimony and have received the judge’s legal instructions regarding the doctrine of equivalents.¹⁴

As the jury deliberates and you wait for the verdict, you sense that the jury remains unresolved on the question of literal infringement and has turned to the doctrine of equivalents. And you ask yourself: Have I done what is necessary regarding the equivalents analysis? What is this jury’s decision-making process? Have I and my expert armed the jurors so that my client can prevail in this battle over whether something that is not identical is nevertheless similar enough to be equivalent?

While there are few opportunities to know how actual juries resolve the equivalents debate, we have watched jurors struggle during mock trials to apply the legal instructions—whether the tripartite function/way/result test or the insubstantial difference standard, or some variation. And it seems that at the core of their difficulty is often their struggle to assess the magnitude of the difference between the patent claim and the product. How are they to determine if a difference is substantial or insubstantial; where is the dividing line between enough and not enough of a difference; and what distinguishes a substantial difference from an insubstantial one? In short, how much of a difference is enough to make a difference?

We have seen that jurors frequently find the answer to this question in the outcome they wish to reach: Juror No. 1, who has been a proponent of literal infringement, simply sees the difference as inconsequential while Juror No. 2, who has been a proponent of noninfringement, now seizes on the difference and concludes that almost any difference is enough. Not unlike a products liability case and the issue of whether a factor is a substantial contributing factor to causing the claimed injury, “substantial” here too is in the eye of the beholder.

Of course, each of these jurors has an expert opinion to turn to in order to bolster their position. Litigants watching these negotiations in the mock setting from behind the mirrors are often heard to grumble: “they [jurors] just don’t understand the technology; they simply want to do what they feel is right; why won’t they debate the substance of the difference; how can *that* ‘meaningless’ difference be considered enough?”

Given the unwillingness of the courts to construe (as they might a disputed claim term) the meaning of a “substantial” difference, the meaning of “substantial” has been largely left to the jurors’ discretion in distinguishing between a substantial and an insubstantial deviation from the claim or claim element. Is it really any wonder that many jurors fit the evidence to the outcome rather than the outcome to the evidence?

This presents an interesting challenge in the development of trial strategy regarding the doctrine of equivalents: Is your case enhanced or diminished by trying to teach jurors, through experts and argument, how to

⁸ *Festo v. Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 62 U.S.P.Q.2d 1705 (2002) (64 PTCJ 98, 5/31/02).

⁹ *Brilliant Instruments v. Guidetech*, 707 F.3d 1342, 1347, 105 U.S.P.Q.2d 1879 (Fed. Cir. 2013) (85 PTCJ 567, 3/1/13).

¹⁰ See Model Patent Jury Instructions, Federal Circuit Bar Association (2012).

¹¹ See Model Patent Jury Instructions, The Federal Circuit Bar Association (2012); Model Patent Jury Instructions for the Northern District of California (2014); see also Uniform Jury Instructions for Patent Cases in the United States Court for the District of Delaware (1993).

¹² *Warner-Jenkinson*, 520 U.S. at 17, n. 8.

¹³ Commentary on Patent Litigation Best Practices: Case Management Issues from the Judicial Perspective Chapter, Sedona Conference (2015).

¹⁴ See Model Patent Jury Instructions, The Federal Circuit Bar Association (2012); Model Patent Jury Instructions for the Northern District of California (2014); see also Uniform Jury Instructions for Patent Cases in the United States Court for the District of Delaware (1993).

move beyond top-line conclusions and credibility assessments of conflicting expert opinions regarding equivalents? While the patent holder has the burden of proof, it is often unclear which party faces the burden of persuasion in the minds and hearts of the jurors given the specific circumstances of your case and the nature of the asserted claims and of the accused products.

In addition to the equities that might influence the jurors' sense of whether or not a difference is substantial, we have seen many mock jurors influenced by their personal sense of the difference between a "real" invention and a "tweak." Some jurors see any change as enough while others believe that there have been very few truly inventive developments over time (as one juror was overheard to say: "the flying machine was invented by da Vinci and everything else since regarding helicopters has been a tweak.").

Assuming, however, that you have decided that the understanding and application of the doctrine of equivalents is a critical aspect of your trial preparation and presentation, what can you do to better teach the jurors why (or why not) a *real* difference exists in your case? We have found that three principles can help organize your approach to teaching the doctrine of equivalents:

- (1) Identifying and teaching the difference.
- (2) Giving the jurors an objective basis for evaluating the difference.
- (3) Providing specific and concrete evidence that the difference has value (or no real value).

(1) Identifying and teaching the difference

If the jurors have begun a discussion of the doctrine of equivalents during deliberations, it is typically because at least some of them have decided that the accused product and the asserted claims do not match identically. Less clear is precisely what they have decided is the difference or missing element—is it the entire claim; one or more specific elements; or maybe the "invention" as a whole? The law teaches that the equivalents analysis should be done on an element-by-element basis.¹⁵ The experts who have clashed on the issue of literal infringement should be precise in their "alternative" analysis of infringement/noninfringement pursuant to the doctrine of equivalents.¹⁶

However, the experts asserting the difference (or lack thereof) and the jurors learning and understanding that difference are two very different matters. So it is important that the experts (and the attorneys in their presentations) take the time to clearly articulate the difference upon which they are focusing their equivalents analysis.

In this regard one should not lose sight of the tipping point for many jurors. We have seen that jurors often take a case as an integrated narrative. This narrative is often built around the three phases of technology development: (1) what existed before the "invention" and what problems still remained to be addressed; (2) how did the inventors solve the problems or improve on the

technology, including how hard was it to meet the challenge and how valuable was the improvement; and (3) what path is/was the accused product on and why is that different in a meaningful way. To the extent that gaps exist in the narratives each side presents, we have found that jurors are not shy about filling them with their own experience or speculation. Hence, to the extent that you can, it is important to build a fully developed and integrated story and not leave control of the narrative to your adversary or to the jurors.

Addressing the more technical aspects of identifying the difference between the accused product or method and the asserted claim can be particularly difficult when applying the tripartite test. While the function and result often can be reasonably defined, the explanation of the "way" as distinguished from the function and result can be a bit abstract. Jurors have a greater chance of understanding the analysis of each expert if both experts are beginning their assessment at the same place. If the experts are not in a position to at least agree about what they are comparing in the claim to the product or method, then the jurors are much less likely to be in a position to evaluate why and how the experts reached different conclusions. As such, to the extent it is possible to sharpen the starting line during the pre-trial process in the expert reports and deposition testimony, the better equipped the jurors will be to understand and judge the substance and credibility of the different race each expert runs at trial.

(2) Giving the jurors an objective basis for evaluating the difference

While understanding the difference is crucial, so too is the need to provide the jurors with an objective basis for assessing whether that difference is substantial or not. Does the change result in substantially greater efficiency in the operation or use of the product; is it substantially faster, cheaper, smaller or stronger; is it substantially less dangerous; are there fewer unwanted consequences or risk? Whether chemistry, biology, software design, circuitry or chip technology, it is important to give the jurors some empirical basis to characterize the substantial difference.

Remember that an equivalents analysis is not done in a vacuum. Jurors have heard the story of the prior art, the invention story, and how the claimed invention was different enough from the prior art (new and improved) to have been granted a patent. Now comes yet another "invention" claiming to be different. How does the difference stack up to the advancements in the prior art and the claimed advancement in the asserted claim?

In this regard, the expert cannot successfully rely on his or her mere observation or opinion that the difference is a substantial difference. Instead, the expert needs to offer some tangible evidence as the foundation for his conclusion that the difference is a substantial difference in some real way to those practicing the art. A difference without a distinction is no better here than it is in a legal argument, lacking substance in either context.

(3) Providing specific and concrete evidence that the difference has value (or no real value)

If the jurors have been taught a clear understanding of the difference and an objective basis for assessing how and why that difference is substantial—i.e., the line that distinguishes the substantial from the

¹⁵ See *Lear Siegler*, 873 F.2d at 1425.

¹⁶ See *Lottotron, Inc. v. Eh New Ventures*, No. CIV. 09-4942 FSH, 2011 BL 46741, at *3-5 (D.N.J. Feb. 23, 2011); *Colucci*, 748 F. Supp. 2d at 632.

insubstantial—they have learned much but not yet enough. For many jurors, a substantial difference that lacks real value fails to provide a justification for excusing the trespass or misuse of another's hard earned rights.

This observation is a variation of the oft-used juror decision-making principle of WIIFM (what's in it for me). If we broaden the WIIFM concept just a bit so that it is not quite so personal (after all, many inventions do not touch individual lives directly) but reaches to the level that jurors can and do identify with—e.g., the consumer, the patient, the customer, the ordinary user—then we are searching for meaning in a useful place—WIIFU (what's in it for us). Does the difference in the accused product provide an advantage to the “ordinary” user over the asserted claim? In short, why should the juror care about the difference?

Finding and explaining the answer to this fundamental question is an essential component of the expert's report and trial testimony. A difference, even a substantial difference, which cannot be shown to make a difference in the lives of people, faces a tough battle with some jurors. There is a common-sense equation that we have seen operate over the years: The more substantial

the difference, the less crucial the value; BUT the less substantial the difference, the more crucial the showing that the difference makes a difference for jurors.

IV. Conclusion

In patent trials with an equivalents infringement argument, jurors are given detailed descriptions of equivalents law as well as long, complex instructions in order to come to a decision regarding infringement. Yet, these instructions contain little to no guidance as to the essential question: How should one measure “substantially” or “insubstantially.” Without greater guidance about the character of the difference—what it is, why it is/is not different, and why the difference really does/does not matter—jurors are “put to sea” without a map when called upon to determine infringement under the doctrine.

Trial counsel cannot rely on the legal instructions to provide jurors with the map they need to navigate the rough seas of characterizing technical differences, and a failure to craft and present adequate tools runs the risk of finding jurors docked at an undesirable port.