



Warner-Jenkinson Co., Inc. v. Hilton Davis

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Petitioner and respondent both manufacture dyes from which impurities must be removed. Respondent's "'746 patent," which issued in 1985, discloses an improved purification process involving the "ultrafiltration" of dye through a porous membrane at pH levels between 6.0 and 9.0. The inventors so limited their claim's pH element during patent prosecution after the patent examiner objected because of a perceived overlap with the earlier "Booth" patent, which disclosed an ultrafiltration process operating at a pH above 9.0. In 1986, petitioner developed its own ultrafiltration process, which operated at a pH level of 5.0. Respondent sued for infringement of the '746 patent, relying solely on the "doctrine of equivalents."

Issue

Scope of PHE, viability of the test for DOE were at issue.

Analysis

The determination of equivalence should be applied as an objective inquiry on an element-by-element basis.

Graver Tank did not supersede the well-established limitation on the doctrine of equivalents known as "prosecution history estoppel," whereby a surrender of subject matter during patent prosecution may preclude recapturing any part of that subject matter, even if it is equivalent to the matter expressly claimed.

The court does not require proof of intent under DOE.

Time for determining DOE is at the time of infringement.

The doctrine does not vitiate the central function of the claims that is to set the metes and bounds of the invention.

Intent plays no role in the application of the doctrine of equivalence.

Knowledge of one skilled in the art is useful in helping the fact finder understand the substitutes or equivalents.

The court must consider all the elements of the claim one by one.

The court has to look at the reason for the amendment of the claim. If the amendment is not related to patentability PHE will not apply.

The court remanded for a rehearing of the case based on these principles.