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The Patent Invalidity/Infringement Parallel: Symmetry or Semantics?

Roy H. Wepner*

I. Introduction

With the United States patent system approaching its 200th birthday, it is hardly surprising that the patent law has become encrusted with various and sundry axioms, maxims and outright cliches.¹ But perhaps no axiom of patent law has seemed to be so indisputable and has proven to be as durable as "that which infringes, if later, would anticipate if earlier."² This axiom, which has been referred to as "the classic test,"³ broadly stands for the proposition that patentability is precluded if the prior art contains an item that would be found to infringe the patent being sought or enforced.

Until recently, it appeared that this axiom would celebrate its centennial unencumbered by closer analysis.⁴ This celebration, however, was not to be. In 1987, the Court of Appeals for the Federal Circuit, which five years earlier assumed jurisdiction over substan-

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1. Professor Chisum notes that, "Opinions in cases on patent infringement are replete with aphorisms, maxims and canons for the interpretation and application of patent claims." D. CHISUM, PATENTS, § 18.03[2] at 18-26.7 (Supp. 1986) [hereinafter CHISUM]. The Chief Judge of the Federal Circuit notes that, until recently, the patent law had become "barnacled with sloganeering encrustations." Markey, *On Simplifying Patent Trials*, 116 F.R.D. 369, 369 (1987). The Federal Circuit has occasionally gone out of its way to note "cliches" and "mis-statements" of patent law in judicial opinions. See, e.g., *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 1574 n.4 (Fed. Cir. 1984) (the court finding it unnecessary to address, *inter alia*, "synergistic results, weakened presumptions of validity, or any other cliché which this court has rejected"). See also *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567 (Fed. Cir.), *cert. denied*, 107 S. Ct. 2187 (1987) ("To contribute to consistency in construing [35 U.S.C.] § 103, this court has affirmed judgments while noting noncontrolling mis-statements of law and cautioning counsel that judgments are appealed, not opinion language.").

2. CHISUM, *supra* note 1, § 3.02[1] n.2 at 3-6.3.

3. *Id.* at § 3.02[1] at 3-6.3; *Chenault v. Nebraska Farm Products*, 138 F. Supp. 772, 785 (D. Neb. 1956).

4. The axiom, "that which infringes, if later, would anticipate if earlier," traces at least as far back as the Supreme Court's decision in *Peters v. Active Mfg.*, 129 U.S. 530, 537 (1889), *aff'g* 21 F. 319, 321 (C.C.S.D. Ohio 1884). Recent restatements of the axiom appear in *Polaroid Corp. v. Eastman Kodak Co.*, 798 F.2d 1556, 1573 (Fed. Cir.), *cert. denied*, 107 S. Ct. 178 (1986) and *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984).

tially all patent cases,⁵ threw a curve at the patent bar. In *Lewmar Marine, Inc. v. Bariant, Inc.*,⁶ the court pointed out that the "classic test" had to be narrowed to more accurately reflect the current state of the law.⁷ In doing so, the court raised an intriguing question as to the relationship between aspects of patent invalidity (specifically, "obviousness") and patent infringement (specifically, the "doctrine of equivalents"). Although the Lewmar court did not pursue this issue, its decision suggests that the parallel between the two concepts actually may be broader and deeper than previously appreciated.

This article will attempt to pick up where the Federal Circuit left off and determine whether attempts to draw parallels between invalidity and infringement are merely superficial semantics or whether there is, in fact, a true symmetry. It will also consider whether such parallels are consistent with today's statutory regime, whether such parallels are desirable, and whether such parallels are even constitutionally required.

II. Patent Invalidity

Every patent application must contain, *inter alia*, a specification.⁸ The specification must include, "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same."⁹ The specification must conclude with one or more "claims" particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.¹⁰

Chapter 10 of the Patent Code¹¹ sets forth certain criteria regarding the patentability of inventions. When a patent application is filed, the Patent and Trademark Office (PTO) examines the application and if it appears that the applicant is entitled to a patent, one is

5. Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 37 (codified at 28 U.S.C. § 1295 (1982)).

6. 827 F.2d 744 (Fed. Cir. 1987), *cert. denied*, 108 S. Ct. 702 (1988).

7. *Id.* at 747.

8. 35 U.S.C. § 111 (1982).

9. 35 U.S.C. § 112, 1st ¶ (1982). This requirement adds to the "general store of knowledge" when the patent is issued (thus effectuating public disclosure) and facilitates practice of the invention when the patent expires. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-81 (1974). Full disclosure is said to be the *quid pro quo* of the patent grant. *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 563 (D.C. Cir. 1977).

10. 35 U.S.C. § 112, 2d ¶.

11. 35 U.S.C. §§ 100-04 (1982).

issued.¹² Thereafter, in any action involving the validity or infringement of a patent, the patentee's adversary must plead and prove, *inter alia*, the invalidity of the patent (or any claim at issue) on any ground specified as a condition for patentability.¹³ Thus, unpatentability may be at issue before a patent is issued (and, indeed, may preclude such issuance) and unpatentability may be a basis for invalidating a previously issued patent. For purposes of this article, both circumstances will be considered under the umbrella of "invalidity" or "unpatentability." It should be noted, however, that there are differences between the two circumstances—albeit differences not considered material to the present discussion.¹⁴

Under present law, two sections of the Patent Code, which are typically referred to as the "prior art" provisions, set forth "conditions for patentability." Section 102 deals with "novelty and loss of right to patent"¹⁵ and Section 103 deals with "non-obvious subject matter."¹⁶

Section 102 precludes patentability if certain events "anticipate" the claimed invention. Several subsections of Section 102 deny the right to a patent if certain events occur before the patentee's date of invention.¹⁷ Another subsection precludes patentability if certain events occur more than one year prior to the filing of an application for a patent.¹⁸ Moreover, other subsections preclude patentability when certain actions are taken by the inventor regarding "the invention."¹⁹ Distinctions are sometimes drawn between the aspects of Section 102 that relate to "novelty" and others that relate to "loss

12. 35 U.S.C. § 131 (1982).

13. 35 U.S.C. § 282(2) (1982).

14. For example, claims of a pending patent application are given their broadest reasonable construction consistent with the specification of the patent. This rule is considered appropriate because an applicant is at liberty to narrow his claims to avoid the prior art. *In re Prater*, 415 F.2d 1393, 1404-05 (1969). This rule also applies during "reexamination" of an issued patent within the PTO. *See generally* 35 U.S.C. §§ 301-07. *In re Yamamoto*, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984). On the other hand, in a court proceeding, claims are construed to uphold their validity. *Turrill v. Michigan S. & N.I.R.R. Co.*, 68 U.S. (1 Wall.) 491, 510 (1864); *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 937 n.5 (Fed. Cir. 1983). Thus, claims of a pending patent application might be construed broadly to read on a given prior art reference and thus preclude patentability. The same claims, as part of an issued patent, might conceivably be read narrowly to avoid the same prior art reference.

15. 35 U.S.C. § 102 (1982).

16. 35 U.S.C. § 103 (1982).

17. *See* 35 U.S.C. § 102(a), (b), (g) (1982).

18. 35 U.S.C. § 102(b) (1982).

19. 35 U.S.C. § 102(c) precludes patentability if the inventor has abandoned the invention. 35 U.S.C. § 102(d) involves certain acts relating to a patenting of "the invention" in foreign countries. 35 U.S.C. § 102(f) precludes patentability if the applicant or patentee did not himself invent the subject matter sought to be patented.

of right."²⁰ The test for anticipation is whether a single prior art reference discloses each and every element of the claimed invention.²¹ The novelty requirement, as embodied in Section 102, is designed to prevent an inventor from withdrawing, as the subject matter of his patent, that which is already within the possession of the public.²²

Given the strictness of the test for anticipation (or lack of novelty), it was apparent that a further requirement was needed to prevent patents from being issued for trivial improvements that technically avoided anticipation by a prior art reference. In *Hotchkiss v. Greenwood*,²³ the Supreme Court embarked on a chain of decisions that imposed a requirement of "invention" to sustain the validity of a patent.²⁴ In 1952, the requirement of "invention" was codified at 35 U.S.C. § 103, which states that a patent cannot be obtained

if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.²⁵

Fourteen years later, the Supreme Court stated that the purpose of Section 103 was to "codify the essential purpose" of the requirement of "invention" set forth in the Court's prior decisions.²⁶

As with anticipation, the requirement of nonobviousness is partially rooted in the notion that patents should not withdraw from the public that which was previously available. In the landmark "non-obviousness" case, *Graham v. John Deere Co.*,²⁷ the Supreme Court noted that the constitutional provision which empowered Congress to create a patent system²⁸ limited its authority because "Congress may not authorize the issuance of patents whose effects are to remove

20. CHISUM, *supra* note 1, § 3.01 at 3-4.

21. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986), *cert. denied*, 107 S. Ct. 2490 (1987); *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986).

22. *In re Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981). In the specific context of the "on sale" bar to patent validity as embodied in 35 U.S.C. § 102(b), one policy underlying the statute is said to be prevention against removing inventions from the public that the public has justifiably come to believe are freely available to all as a consequence of prolonged sales activity. *General Elec. Co. v. United States*, 654 F.2d 55, 61 (Ct. Cl. 1981).

23. 52 U.S. (11 How.) 248 (1851).

24. *See generally*, CHISUM, *supra* note 1, § 5.02 at 5-5.

25. 35 U.S.C. § 103 (1982).

26. *Graham v. John Deere Co.*, 383 U.S. 1, 14-15 (1966).

27. 383 U.S. 1 (1966).

28. U.S. CONST. art. I, § 8, cl. 8.

existent knowledge from the public domain, or to restrict free access to materials already available.”²⁹

Thus, the novelty requirement, as set forth in Section 102, precludes patentability if the subject matter of the patent exists in a single prior art reference. In contrast, the requirement of non-obviousness, as set forth in Section 103, precludes patentability where no single, prior art reference meets all the limitations of the claims, but “[t]he gap between the prior art and [the patented invention] is simply not so great as to render the [invention] nonobvious to one reasonably skilled in the art.”³⁰ In such a case, the prior art as a whole establishes that, in light of the level of skill within that field, the patentee has not met the standard which Congress has equated with true “invention.”

III. Patent Infringement

Patent infringement is typically approached in two steps. First, it must be determined whether there is “literal” infringement of the patent. Literal infringement requires that the accused device embody every element of the claim.³¹ If literal infringement is not present, then it must be determined if the “doctrine of equivalents” applies.³² An accused product or process that does not literally infringe a claim may still be found to infringe under the doctrine of equivalents “if it performs substantially the same function in substantially the same way to obtain the same result” as the claimed product or process.³³ The Supreme Court described the essence of, and the justification for, the doctrine of equivalents as follows:

[C]ourts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law Outright and forthright duplication is a dull and very

29. 383 U.S. at 5-6.

30. *Dann v. Johnston*, 425 U.S. 219, 230 (1976).

31. *Fay v. Cordesman*, 109 U.S. 408, 420-21 (1883); *Stewart-Warner Corp. v. City of Pontiac, Mich.*, 767 F.2d 1563, 1570 (Fed. Cir. 1985).

32. *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1361 (Fed. Cir. 1983); *Stewart-Warner*, 767 F.2d 1563.

33. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950) (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)).

rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.

The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent.³⁴

More recently, the Federal Circuit observed:

If a patentee were bound by the literal language of his specification and claims, the purpose of the doctrine of equivalents, to give relief against the copier who merely makes insubstantial substitutions in a claimed invention, would be frustrated. Thus, the proposition that the claims, taken in view of the specification, measure the metes and bounds of the invention has been realistically tempered by the judicially-formulated doctrine of equivalents.³⁵

Although the doctrine of equivalents is firmly entrenched in the patent law, debate over the doctrine continues to rage. For example, there is currently a schism among the judges of the Court of Appeals for the Federal Circuit regarding the scope of the doctrine.³⁶ One recent decision, *Pennwalt Corp. v. Durand-Wayland, Inc.*³⁷ evoked four separate opinions.

In *Pennwalt*, Judge Nies contended that in view of 35 U.S.C. § 112, which requires the inventor to set forth claims that particularly point out and distinctly claim the subject matter of his invention, "a patent claim is not intended to be and cannot be only a general suggestion of an invention."³⁸ Judge Nies argued further that

[t]he invention is defined by the limitations set out in the claim which thereby fix the scope of protection to which the patentee is entitled. The limitations defining the invention tell the public what it cannot make, use, or sell. Equally important, the limitations defining the invention tell the public what it can make, use or sell without violating the patentee's rights.³⁹

34. *Id.* at 607-08.

35. *Thomas & Betts Corp. v. Litton Sys., Inc.*, 720 F.2d 1572, 1579 (Fed. Cir. 1983).

36. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987), *cert. denied*, 56 U.S.L.W. 3647 (1988).

37. *Id.*

38. *Id.* at 949 (Nies, J., Additional Views).

39. *Id.*

Judge Nies also suggested that the “need for notice of what constitutes [a] violation of a patentee’s rights” was such that a vague standard of infringement would violate due process.⁴⁰

In the very same case, another group of judges viewed the doctrine of equivalents as more of a choice between conflicting policies:

On the one hand, there is the historic right of affording the public fair notice of what the patentee regards as his claimed invention in order to allow competitors to avoid actions which infringe the patent and to permit “designing around” the patent. [citation omitted] On the other hand, equally important to the statutory purpose of encouraging progress in the useful arts, is the policy of affording the patent owner complete and fair protection of what was invented.⁴¹

IV. The *Lewmar* Decision

In its 1987 decision in *Lewmar Marine, Inc. v. Bariant, Inc.*,⁴² the Federal Circuit decided that the classic axiom “that which will infringe, if later, will anticipate, if earlier” had outlived its usefulness and had become less than totally accurate. The court stated that “[w]hile ‘the classic test of anticipation’ was indeed as stated, under the current statute ‘anticipation’ does not carry the same meaning as before, and the ‘classic test’ must be modified to: That which would *literally* infringe if later in time anticipates if earlier than the date of invention.”⁴³

The court noted that prior to the Patent Act of 1952, the term “anticipation” was used in a broader sense than it is today. Prior to 1952, anticipation meant *either* that the subject matter of the claims was not novel (i.e., that it would be deemed invalid under today’s 35 U.S.C. § 102) *or* that it was not “inventive” (the predecessor of the nonobviousness standard now embodied in 35 U.S.C. § 103).⁴⁴ The court observed that anticipation has become “a restricted term of art in patent law meaning that the claimed invention lacked novelty, or was unpatentable under 35 U.S.C. § 102.”⁴⁵

The court then observed that all infringements of a device do not “anticipate” in “this sense”—i.e., the “sense” of anticipation or invalidity under 35 U.S.C. § 102. Judge Nies, speaking for the court,

40. *Id.* at 954.

41. *Id.* at 945 (Bennett, J., dissenting in part).

42. 827 F.2d 744 (Fed. Cir. 1987), *cert. denied*, 108 S. Ct. 702 (1988).

43. *Id.* at 747 (emphasis in original; footnote omitted).

44. See *supra* notes 23-26 and accompanying text.

45. *Lewmar*, 827 F.2d at 748.

then made the following cryptic comment: "Some may be infringements under the doctrine of equivalents which, if one wished to draw a parallel, is somewhat akin to obviousness."⁴⁶

This author *does* wish to draw a parallel between the doctrine of equivalents and obviousness. Indeed, comparing patent invalidity and patent infringement on a broad basis, the parallels are quite striking. Moreover, the parallel, albeit imperfect, arguably goes even further than the Federal Circuit suggested in *Lewmar*.

V. The Equivalents/Obviousness Parallel

One can only speculate as to the meaning of Judge Nies' cryptic reference to a parallel between the doctrine of equivalents and obviousness. However, one can hazard a reasonable guess as to what the court suggests.

The doctrine of equivalents developed in response to situations in which would-be infringers sought to reap the benefit of the patented invention with a device or process that differed from the claimed invention only in a trivial or meaningless manner.⁴⁷ While the doctrine of literal infringement adequately protected patentees from those who would blatantly misappropriate the invention as specifically claimed,⁴⁸ the doctrine of equivalents evolved to cover those situations where the misappropriation was equally unjust but more subtle and insidious. After all, the patent laws are designed to reward those whose creative talents are used to *invent*, not *circumvent*.

The relationship between anticipation and obviousness is not altogether different. The novelty requirement, which precludes patentability where a single, prior art reference completely anticipates the claimed invention, prevents an applicant from withdrawing from the public domain the exact device or process that existed previously and which the public had a right to believe was freely available.⁴⁹ The requirement of nonobviousness, like the doctrine of equivalents, is a more subtle concept.⁵⁰ It also prevents a patent applicant from withdrawing subject matter from the public domain, even though that subject matter does not exist in any one reference, but is nonetheless available to the general public.

Stated in other terms, the nonobviousness requirement prevents a patentee from withdrawing from the public domain that which dif-

46. *Id.*

47. *See supra* text accompanying notes 33-41.

48. *See supra* text accompanying note 31.

49. *See supra* text accompanying notes 15 and 17-22.

50. *See supra* text accompanying notes 26-30.

fers only slightly and unimportantly from a prior art reference that would otherwise anticipate it. In a similar manner, the doctrine of equivalents prevents an infringer from misappropriating from the patentee that which differs only slightly and unimportantly from the patentee's invention as expressly claimed. The nonobviousness requirement insures that the public will not lose the right to make, use, and sell that which differs from a prior art reference in only a meaningless way. By the same token, the doctrine of equivalents provides similar protection to the patentee, insuring him against the loss of his ability to exclude one from making, using, and selling that which differs from his invention (as claimed) in only a meaningless way.

The parallel is not perfect. Although the tests for obviousness and equivalents seem totally different, at least semantically, perhaps that should not be. There should be some "cross-pollination" between the two concepts, given the similar objectives that the doctrines are designed to achieve.

Indeed, one need not go beyond the landmark doctrine of equivalents case, *Graver Tank & Mfg. Co. v. Linde Air Products Co.*,⁵¹ to find an early "seed" for such "cross-pollination." As Justice Jackson noted in the majority opinion:

Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is *whether persons reasonably skilled in the art would have known* of the interchangeability of an ingredient not contained in the patent with one that was.⁵²

Both the language and the approach of the Supreme Court in *Graver Tank* are strikingly similar to the language and approach of decisions dealing with the question of obviousness under Section 103.⁵³

Given the parallel between anticipation and literal infringement, as well as the further parallel between obviousness and the doctrine of equivalents suggested in *Lewmar*, the question then becomes—does the parallel go any further? It does indeed.

51. 339 U.S. 605 (1950).

52. *Id.* at 609 (emphasis added).

53. See, e.g., *A.E. Staley Mfg. Co. v. Old Rock Distilling Co.*, 223 F. Supp. 798, 803 (W.D. Mo. 1963) (holding claims invalid since the product "involved only a substitution of one known ingredient for another to achieve a similar result, and that the substitution should have been obvious to anyone skilled in the art"); *Griffith Rubber Mills v. Hoffar*, 313 F.2d 1, 3-4 (9th Cir. 1963) ("Selection from among available materials of one material thought more suitable for a particular use is normally within the competence of the person of ordinary skill in the art, and, generally is for that reason not patentable.").

VI. The "Accidental Anticipation"/"Reverse Equivalents" Parallel

For at least ninety years, two additional judicial doctrines of patent law that stand for similar propositions have co-existed on parallel tracks. Under both doctrines, a device or process that fits squarely within the literal language of a patent claim is excused, disregarded or otherwise dismissed. One of these doctrines, which deals with accidental and unappreciated anticipations, carves out an exception to the novelty requirement. The other doctrine, known as the "reverse doctrine of equivalents," carves out an almost identical exception to the doctrine of literal infringement.

For over a century, courts have recognized that something which is technically an anticipation, but which is accidental, unintended and unappreciated, does not invalidate a patent. As early as *Tilghman v. Proctor*,⁵⁴ the Supreme Court held that if certain products "were accidentally and unwittingly produced, whilst the operators were in pursuit of other and different results, without exciting attention and without it even being known what was done or how it had been done, it would be absurd to say that this was an anticipation"⁵⁵ As the Court indicated several years later, "accidental results, not intended and not appreciated, do not constitute anticipation."⁵⁶ This doctrine continues to be followed, and appears to be the law today.⁵⁷

A good explanation of the rationale behind this rule appears in a 1909 decision of the United States Circuit Court for the Middle District of Pennsylvania:

A prior use, in order to negative novelty, must be something more than an accidental or casual one. It must, indeed, be so far understood and practiced, or persisted in, as to contribute to the sum of human knowledge and be accessible to the public, becoming an established fact in the art.⁵⁸

In contrast to the "accidental anticipation" doctrine, the "reverse doctrine of equivalents" is only eighty years old, having its apparent genesis in *Westinghouse v. Boyden Power Brake Co.*⁵⁹ In *Westinghouse*, the Supreme Court stated:

54. 102 U.S. 707 (1881).

55. *Id.* at 711-12.

56. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 66 (1923).

57. *See, e.g., In re Marshall*, 578 F.2d 301, 304 (C.C.P.A. 1978); *Ralston Purina Co. v. Far-Mar Co.*, 568 F. Supp. 1176, 1214-15 (D. Kan. 1984), *aff'd in part and rev'd in part on other grounds*, 772 F.2d 1570 (Fed. Cir. 1985).

58. *Anthracite Separator Co. v. Pollock*, 175 F. 108, 111 (C.C. Pa. 1909).

59. 170 U.S. 537 (1898).

PATENT INVALIDITY/INFRINGEMENT PARALLEL

We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided. [citations omitted]. The converse is equally true. The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent.⁶⁰

The Supreme Court's 1950 opinion on the "conventional" doctrine of equivalents demonstrated the continued vitality of the "reverse doctrine of equivalents":

The wholesome realism of this doctrine is not always applied in favor of a patentee, but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement.⁶¹

The "reverse doctrine of equivalents" continues to be the law today.⁶²

It is not difficult to see the connection between the "accidental anticipation" doctrine and the "reverse doctrine of equivalents." Both doctrines, by hypothesis, involve situations where an item comes within the language of a patent claim. In the case of an "accidental anticipation," the disputed patent is not invalidated because the patentee has not withdrawn anything from the public domain in any real sense. On the contrary, in such instances the public never truly had the benefit of the purported anticipation.

The very same statement can also be made with regard to the "reverse doctrine of equivalents." In this context, infringement is avoided because the accused infringer has not appropriated the patentee's invention in any real sense, even though the accused item falls within the scope of a claim.

60. *Id.* at 568.

61. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608-09 (1950).

62. *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107 (Fed. Cir. 1985); *Caterpillar Tractor Co. v. Berco, S.p.A.* 714 F.2d 1110 (Fed. Cir. 1983).

VII. The Parallel Lines Converge

When the foregoing discussion is considered as a whole, the overall parallel between patent invalidity⁶³ and patent infringement⁶⁴ becomes clear. To determine both patent invalidity and patent infringement, very similar three-step inquiries must be conducted.

In determining whether there is invalidity in view of the prior art, one must first consider whether there is a single prior art reference that literally comes within the metes and bounds of a claim.⁶⁵ If so, then an ostensible anticipation is established and one must then consider whether such anticipation should be disregarded because it is accidental or unappreciated.⁶⁶ If not, one must then consider whether the patent claim is still invalid because of the obviousness of the invention in view of the prior art as a whole.⁶⁷

The overall approach to infringement is extremely similar. One must first consider whether the accused item comes within the literal scope of a claim. If it does, then there is an ostensible literal infringement⁶⁸ and it is necessary to consider whether the infringement should be disregarded based on the "reverse doctrine of equivalents."⁶⁹ If the accused item *does not* come within the literal scope of a claim, then one must determine whether there is infringement under the doctrine of equivalents.⁷⁰

For both inquiries, the "black letter law" provides a series of guidelines in deciding the broader and more difficult questions of whether the patentee attempted to appropriate in his patent that which previously existed in the art (as opposed to advancing the art), thus establishing invalidity, and whether the accused infringer misappropriated that which the patentee has invented (as opposed to legitimately designing around a patented invention), thus establishing infringement. The ultimate conclusion seems to be that while courts regularly assert that claims define a patented invention,⁷¹ in actuality, "patent claims are only a starting point."⁷²

As one author has explained, "[t]he attitude of the Supreme

63. See *supra* text accompanying notes 8-30.

64. See *supra* text accompanying notes 31-41.

65. See *supra* text accompanying note 31.

66. See *supra* text accompanying notes 54-58.

67. See *supra* text accompanying notes 26-30.

68. See *supra* text accompanying note 31.

69. See *supra* text accompanying notes 59-62.

70. See *supra* text accompanying notes 47-52.

71. See, e.g., *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944); *Scharmer v. Carrollton Mfg. Co.*, 525 F.2d 95, 101 (6th Cir. 1975).

72. *Marvin Glass & Assocs. v. Sears, Roebuck & Co.*, 448 F.2d 60, 62 (5th Cir. 1971).

Court toward the required definiteness and limiting effect of claims language [has] fluctuated over time”⁷³ During one of the Court’s more flexible periods, it stated:

It is generally true, when a patentee describes a machine, and then claims it as described, that he is understood to intend to claim and does by law actually cover, not only the precise forms he has described, but all other forms which embody his inventions; it being a familiar rule, that to copy the principle or mode of operation described, is an infringement, although such copy should be totally unlike the original in form or proportions.⁷⁴

During other periods, the Supreme Court has evinced near total rigidity.⁷⁵

Historically, patents have been analogized to deeds to real property.⁷⁶ Patent claims are even described in terms of “metes and bounds.”⁷⁷ The use of terminology such as “metes and bounds” suggests, “the exact length of each line, and the exact quantity of land, in square feet, rods, or acres.”⁷⁸ It is unrealistic, however, to suggest that something as inherently indefinable as an invention can be surveyed, staked out, mapped and reduced to precise verbal measurements. Current statutes illustrate the difficulty of such a task. Claims are merely required to “particularly [point] out and distinctly [claim] the subject matter which [the] applicant *regards* as his invention.”⁷⁹ The infringement provision makes no attempt at all to be specific; it merely states, “whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.”⁸⁰

The parallels discussed above do indeed point in a single direction. In a sense, the parallel lines converge.⁸¹ It is true, as the Fed-

73. CHISUM, *supra* note 1, § 8.02[3] at 8-9.

74. *Winans v. Denmead*, 56 U.S. (15 How.) 330, 342 (1853).

75. *See, e.g., United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942); *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938); *Merrill v. Yeomans*, 94 U.S. 568 (1877).

76. A. DELLER, *PATENT CLAIMS*, § 21 (2d ed. 1971); *see also, McCormick Harvesting Machine Co. v. Aultman*, 169 U.S. 606, 609 (1898).

77. *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985).

78. *Rollins v. Mooers*, 25 Me. 192, 196 (1845).

79. 35 U.S.C. § 112 (1982) (emphasis added).

80. 35 U.S.C. § 271(a) (1982).

81. The author considers himself at liberty to engage in such mathematical sacrilege in the context of the present discussion, since the Supreme Court itself, in its landmark doctrine of equivalents decision, stated that “[i]n determining equivalents, things equal to the same thing may not be equal to each other” *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 609 (1950).

eral Circuit suggested in *Lewmar*, that there is a parallel between obviousness and the doctrine of equivalents. It is equally apparent that there is a parallel between anticipation and direct infringement, as well as a further parallel between accidental anticipation and the "reverse doctrine of equivalents." It is also true, as the Federal Circuit has indicated, that it is more accurate to assert "[t]hat which would *literally* infringe if later in time anticipates if earlier than the date of invention."⁸² One could also look at the old axiom more broadly, and consider whether the parallel lines converge into an overall theorem: "that which *invalidates*, if earlier, infringes if later." The foregoing analysis demonstrates that the doctrines which govern invalidity of a patent over the prior art are, or at least should be, similar to the doctrines which govern infringement of an issued patent.

The reason for this similarity is apparent. The source of Congress' authority to create a patent system lies in the constitutional provision that states, "Congress shall have Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries"⁸³ In a few elegant words, the framers permitted Congress to give inventors exclusive rights to their inventions. The Constitution *did not* authorize Congress to first issue patents and then provide for remedies. It expressly states that the exclusive rights should be given to inventors *for their respective discoveries*.

VIII. Conclusion

The standards that govern the decision to grant (or invalidate) a patent should be, to the extent possible, parallel to the standards that define what constitutes an infringement. An inventor should not be permitted to withdraw with a patent that which belongs in the public domain; he must make an "invention." Conversely, an infringer should not be permitted to misappropriate that which is actually the patentee's domain—his invention.

A patent system in which the legal tools for ensnaring an infringer are more restrictive than the tools for invalidating a patent has the potential to cheat the inventor. It may create a legal environment in which the full benefit of an invention may not be "secured"

82. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747 (Fed. Cir. 1987) (emphasis in original).

83. U.S. CONST., art. I, § 8, cl. 8.

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to the inventor and in which the inventor may not receive his *quid pro quo*.⁸⁴ By the same token, a system in which expansive rules capture infringers, but only narrow rules invalidate a patent, is a system in which the public may not be treated fairly and fair competition may be thwarted. A patent system in which Congress and the courts remain aware of the invalidity/infringement parallel has the best chance of giving both the inventor and the public the full benefit of their bargain—while promoting the progress of science and the useful arts.

84. See *supra* note 9.

