

CLAIM CONSTRUCTION
DOCTRINE OF EQUIVALENTS
(PRECEDENTIAL)

DEERE & CO. v. BUSH HOG, LLC, Appeal Nos. 2011-1629, -1630, -1631 (Fed. Cir. Dec. 4, 2012). Before Rader, Newman, and Plager. Appealed from S.D. Iowa (Judge Wolle).

Background:

Deere owned a patent for a dual-walled deck for a rotary cutter that is pulled behind a tractor. The deck enclosed a number of structural components and comprised an upper wall and lower wall. Deere's patent claimed that the upper wall sloped "into engagement with" the lower wall. Bush Hog manufactured a similar rotary cutter, although the upper and lower walls thereof did not directly contact one another. Consequently, Deere sued Bush Hog for infringing the claims of its patent.

The district court narrowly construed the term "into engagement with" as requiring direct contact between the upper and lower walls. The court held that because the walls of the accused product did not directly contact one another, Bush Hog did not literally infringe the claims. The court further held that Bush Hog did not infringe under the doctrine of equivalents because permitting "no direct contact" would vitiate the court's "direct contact" construction. Thus, the district court granted the Defendant's motion for summary judgment of non-infringement. Deere appealed.

Issue/Holding:

Did the district court err in its construction of Deere's claim and its determination that Deere is barred from asserting infringement under the doctrine of equivalents? Yes, reversed and remanded.

Discussion:

The Federal Circuit vacated the district court's construction of "into engagement with" because the term can encompass both a direct, and an indirect, connection between elements. The court noted that the words of a claim are given their ordinary and customary meaning that the term would have to a person of ordinary skill in the art at the time of invention. In this case, the court reasoned that the term "engagement" connotes a connection between two objects in which the motion of one object is constrained by the other. This connection can be indirect, such as where a motor is engaged with a gear through a second, intermediate gear.

Due to the district court's erroneous claim construction, the Federal Circuit reversed the holding of non-infringement under the doctrine of equivalents. However, the Federal Circuit discussed at length the district court's mistreatment of the doctrine of equivalents, and specifically the concept of "vitiating." Vitiating is a legal determination that no reasonable jury could determine two elements to be equivalent. Increasingly, courts have refused to apply the doctrine of equivalents where the accused product, for example, contains the "antithesis" of the claimed element, thereby vitiating the claimed element. In this case, however, the Federal Circuit held that applying the doctrine of equivalents would not have vitiated the construction of "into engagement with" because a reasonable jury could find that a small spacer connecting the upper and lower walls, as embodied in the accused product, represented an insubstantial difference from direct contact.