



# THINK FORWARD

## Federal Circuit Upholds District Court Vacatur of Jury Verdict Under Doctrine of Equivalents Based Upon Ensnarement Defense

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In affirming a District Court vacatur of a jury verdict of infringement under the doctrine of equivalents, the Federal Circuit held that patent owner Dr. Jang failed to prove that his equivalents theory did not ensnare the prior art. *Jang v. Boston Scientific Corp. et al.*, Nos. 2016-1275, 2016-1575, 2017 U.S. App. LEXIS 18825 (Fed. Cir. September 29, 2017) (Circuit Judge Chen authoring the opinion). Similar to prosecution history estoppel, the ensnarement defense limits the reach of the doctrine of equivalents and is a question of law.

Before trial, accused infringer Boston Scientific moved *in limine* to preclude Dr. Jang from presenting arguments to the jury that Boston Scientific's intravascular stents infringed the asserted patent under the doctrine of equivalents, insisting that Dr. Jang's claims that could cause infringement under the doctrine of equivalents would "ensnare" the prior art. While it denied the pretrial motion, the District Court decided to conduct a post-trial ensnarement hearing if the jury returned a verdict of infringement under the equivalents doctrine. At trial, the jury ultimately found infringement under the doctrine of equivalents.

In an ensnarement analysis, a patentee is tasked with proposing a hypothetical claim that would literally cover the accused product, but would also have been allowed over the prior art if that claim had been examined by the patent office. During the post-trial evidentiary hearing on ensnarement, Dr. Jang offered several hypothetical claims to attempt to pass this ensnarement hurdle, which were modifications of representative claim 1 of the asserted patent. The District Court ruled that Dr. Jang failed to draft a proper hypothetical claim for the ensnarement analysis because the claims presented either were of the same scope as issued claim 1 or narrowed versions of claim 1. Because an appropriate hypothetical claim was not proposed, an analysis with respect to the prior art was unnecessary. Accordingly, the District Court vacated the jury verdict of infringement under the doctrine of equivalents and entered judgment of non-infringement in favor of Boston Scientific.

In the *de novo* review of the District Court's ensnarement analysis, the Federal Circuit found that the District Court correctly rejected the hypothetical claims. The burden of proving patentability of the hypothetical claim rests with the patent owner. The pertinent question is whether the hypothetical claim offered by the patentee could have been allowed by the USPTO over the prior art. Federal Circuit precedent has held that a patentee's hypothetical claim may not include any limitations that are narrower than the issued claim.

As a threshold matter, Dr. Jang failed to submit a proper hypothetical claim for consideration because the hypothetical claims considered by the District Court either introduced a narrowing limitation to the claim or were no broader than the scope of patented claim 1. In one of the claims considered on appeal, the Federal Circuit addressed a substitution in claim terms submitted by Dr. Jang, which removed a previous limitation (therefore broadening) but also adding a limitation to the claim (therefore narrowing). The Federal Circuit did not credit a rationale that this claim amendment only resulted in a

broadened claim because the patent's specification did not support such a conclusion. Because the hypothetical claims presented by Dr. Jang did not solely broaden the claims, the Federal Circuit held that Dr. Jang had not met his burden of proof required under the doctrine of equivalents in situations where an ensnarement defense is raised by an accused infringer, and therefore upheld the District Court's decision in vacating the jury verdict.

In addition, the Federal Circuit found that the District Court properly declined to provide its own hypothetical claim in the proceeding on Dr. Jang's behalf. A patentee bears the burden of proving that it is entitled to the range of equivalents which it seeks. In short, a District Court must determine whether patentee has proposed a hypothetical claim that contains both the literal claim scope and the accused device, without ensnaring the prior art, but the District Court has no obligation to assist the patentee in drafting such a hypothetical claim.

### **Potential Implications**

If infringement under the doctrine of equivalents is pled in a complaint, an accused infringer should consider raising an affirmative defense of ensnarement. Such a defense may set forth an open-ended list of relevant prior art, including references raised by the patent examiner during the prosecution of the asserted patent. Such a listing may present an opportunity for judgment on the pleadings, under Federal Rule of Civil Procedure 12(c), based on the ensnarement defense.

The status of a USPTO post-grant proceeding concerning the validity of the asserted patent does not affect the determination of the art relied upon for the ensnarement defense. For example, if an accused infringer is unsuccessful at invalidating asserted claims during an *Inter Partes* Review proceeding, an ensnarement defense based on the same prior art may still be viable.

Also, the ensnarement analysis requires the patentee to introduce a hypothetical claim that would cause the accused product to literally infringe the claim, but yet would have been patentable over the prior art of record if it had been examined for patentability. The ability to introduce a hypothetical claim is limited by the written description requirement, i.e. the hypothetical claim cannot introduce new matter. One tactic that could be used by a patentee to develop a hypothetical claim would be to broaden a claim term to recite a genus when a species (that did not cover the accused product) had been claimed in the issued claim. This hypothetical claim would satisfy the requirement that the hypothetical claim broaden the claim and might theoretically stay clear of the relevant prior art. This hypothetical claim would only be possible if the as-filed specification included sufficient written description support for such an amendment. This is another reason why a broad disclosure with different possible combinations and with disclosure of various components of an invention at a broad genus level and at a detailed species level may be helpful in future enforcement of a patent.

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