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Judge and Jury Roles in Equivalents Analysis: Commentary on Malta v. Schulmerich Carillons

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Judge and Jury Roles in Equivalents Analysis: Commentary on Malta v. Schulmerich Carillons*

Mark D. Janis**

TABLE OF CONTENTS

INTRODUCTION ........................................................... 622

I. THE JURY’S ROLE IN DETERMINING INFRINGEMENT ........ 622
   A. The Jury and Issues of Claim Interpretation .......... 623
   B. The Jury and Issues of Comparison of the Properly
      Construed Claim to the Accused Device ............... 626
      2. Infringement Under the Doctrine of Equivalents .... 628

II. PRECURSORS TO MALTA CASE
    A. The Nestier Case .............................................. 629
    B. The Lear Siegler Case ...................................... 631

III. THE MALTA CASE
    A. District Court Decision ..................................... 634
    B. Federal Circuit Decision
       1. Panel Majority Opinion: Judge Rich ............... 636
       2. Concurring Opinion: Judge Michel ................. 638
       3. Dissenting Opinion: Judge Newman ................. 639

IV. APPLYING MALTA
    A. Applying Malta to Bench Trials Involving
       the Doctrine of Equivalents ............................. 644
    B. Applying Malta in View of Symbol Technologies ..... 645

CONCLUSION .............................................................. 650
INTRODUCTION

In Malta v. Schulmerich Carillons Inc. a divided panel of the Federal Circuit affirmed a JNOV granted on a jury verdict of infringement under the doctrine of equivalents. In so doing, the panel majority confirmed the applicability of guidelines from previous cases for determining the threshold level of evidence necessary to get the equivalents issue to the jury. This paper argues that despite powerful criticism from the dissent, the common sense guidelines articulated in the Malta majority opinion are not only necessary, but are appropriate. Indeed, the paper argues that the Malta guidelines are fundamental to the equivalents analysis, and therefore could be extended both to bench trials involving the doctrine of equivalents and to the analysis of structural equivalents under 35 U.S.C. 112, 6th ¶, whether tried to judge or jury.

Part I of this paper reviews the jury’s role in determining infringement, commenting on the jury’s role in both claim interpretation and in the comparison of the properly construed claims to the accused device. Part II reviews the Nestier and Lear Siegler cases, key precursors to the Malta decision. Part III reviews the Malta District Court decision as well as the majority, concurring and dissenting opinions of the Federal Circuit panel. Finally, Part IV considers the applicability of the Malta threshold requirement to a bench trial setting involving 35 U.S.C. 112, 6th ¶, and contrasts the Federal Circuit’s approach in Malta to its approach in Symbol Technologies, Inc. v. Opticon Inc.

I. THE JURY’S ROLE IN DETERMINING INFRINGEMENT

A patent infringement analysis is a two-step process. the first step, interpretation of the patent claims (also referred to as a deter-

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2 1 21 U.S.P.Q. 2d 1161 (Fed. Cir. 1991), 1991 WL 273823. At the time of this writing, Malta had not yet been published in the Federal Reporter.
3 The 6th ¶ of 35 U.S.C. 112 provides that:
An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.
mination of claim "scope") is said to be a question of law. The second step, comparison of the properly construed claims to the accused device, is considered to be a question of fact. Infringement is found only where each element of the properly construed claims is found literally or equivalently in the accused device. The patent owner bears the burden of proving infringement by a preponderance of the evidence.

Despite the characterization of claim interpretation as a question of law, the submission of the claim interpretation issue to the jury will not itself result in reversal. Under appropriate circumstances, the jury may properly interpret the claim terms en route to determining infringement. But the courts have had difficulty defining the precise circumstances when submission of the interpretation issue to the jury is appropriate in the first instance, or, analogously, when the jury's implied interpretation arising from an infringement finding should be overturned on JNOV. Similarly, there is substantial disagreement, as best exemplified by Malta v. Schulmerich Carillons, as to the quantum of evidence required to justify submission of the second inquiry in the infringement analysis (the "comparison" issue) to the jury.

A. The Jury and Issues of Claim Interpretation

One might expect that where the evidence yielded merely of a dispute over claim interpretation, the infringement issue might be taken out of the jury's hands and summarily resolved by the court. Indeed, the Federal Circuit has affirmed summary judgment on both

the literal infringement issue\textsuperscript{14} and the issue of infringement under the doctrine of equivalents\textsuperscript{15} on this basis.

Likewise, one might expect that when the patent owner has been fully heard on the infringement issue and has left only an issue of claim interpretation to be resolved, the trial court might direct a verdict on the infringement issue\textsuperscript{16} or overturn the jury verdict on JNOV.\textsuperscript{17} As to the latter, the trial judge must determine whether the jury’s comparison of the claim to the accused device is supported by “substantial evidence”\textsuperscript{18} and whether the comparison is made in relation to a claim interpretation that can be supported in law.\textsuperscript{19} Thus, a trial judge might presumably decide that the jury’s implied claim interpretation is legally unsupportable, making JNOV appropriate.\textsuperscript{20}


\textsuperscript{16} Rule 50(a)(1), Fed. R. Civ. P., provides that:

If during a trial by jury a party has been fully heard with respect to an issue and there is no legally sufficient evidentiary basis for a reasonable jury to have found for that party with respect to that issue, the court may grant a motion for judgment as a matter of law against that party on any claim, counterclaim, cross-claim, or third party claim that cannot under the controlling law be maintained without a favorable finding on that issue.

\textsuperscript{17} This is not surprising since a summary judgment motion is said to be decided under “essentially the same standard that for a motion for directed verdict or JNOV.” Newell Companies v. Kenney Mfr. Co., 864 F.2d 757, 763, 9 U.S.P.Q.2d 1417, 1422 (Fed. Cir. 1989), citing Anderson v. Liberty Lobby Inc., 477 U.S. 242, 250 (1986). The commentary to Rule 50, Fed. R. Civ. P. confirms this observation, providing in relevant part:

\begin{quote}
...The term “judgment as a matter of law” is an almost equally familiar term and appears in the text of Rule 56; its use in Rule 50 calls attention to the relationship between the two rules... Because [the standard for judgment as a matter of law] is also used as a reference point for entry of summary judgment under 56(a), it serves to link the two related provisions. ...
\end{quote}

\textsuperscript{18} Substantial evidence is “such relevant evidence from the record taken as a whole as a reasonable mind might accept as adequate to support the finding under review.” Verdegaa Brothers, Inc. v. Union Oil of Cal., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1052 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).


\textsuperscript{20} See Senmed Inc., 888 F.2d at 815, 12 U.S.P.Q.2d at 1513 (affirming grant of JNOV).
Judge and Jury Roles in Equivalents Analysis

However, "[e]very legal conclusion must be based on facts established by evidence," and claim interpretation is no exception. Claim interpretation may well require consideration of factual questions, such as the description of the claimed element in the specification, the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and expert testimony as to what the claim term would mean to one of ordinary skill in the art.

Federal Circuit precedent is not as clear as it might be in defining the jury's role in claim interpretation. The best that can be said is that when "extrinsic evidence" (such as the prosecution history or expert testimony) is needed to explain the meaning of a claim term, claim interpretation should generally be left to the jury; the jury "cannot be directed to the disputed meaning for the term of art." Extrinsic evidence is usually needed where the claim term is a complex technical term, or a term potentially having a special meaning to those of ordinary skill in the art different from its common, ordinary meaning.

However, the Federal Circuit has also noted that "even where the meaning [of a claim term] cannot be determined without resort to the specification, the prosecution history or other extrinsic evidence," the court may properly find that, upon consideration of the entirety of such evidence, there is no genuine issue of fact for the jury. For example, conflicting options on the meaning of a term

21 Railroad Dynamics, 727 F.2d at 1513, 220 U.S.P.Q. at 936.
26 Johnston, 885 F.2d at 1579, 12 U.S.P.Q.2d at 1385; Howes v. Medical Components, Inc., 814 F.2d 638, 643, 2 U.S.P.Q.2d 1271, 1274 (Fed. Cir. 1987). See also Advanced Cardiovascular Systems v. Scimed Life Systems Inc., 887 F.2d 1070, 12 U.S.P.Q.2d 1539 (Fed. Cir. 1989), in which the panel majority vacated a summary judgment of noninfringement on the basis that extrinsic evidence (in the form of expert testimony) was necessary for claim interpretation. Judge Newman, dissenting, argued that the District Court had correctly rejected the expert testimony and had properly interpreted the claim.
which are considered to be merely "conclusory" will not *ipso facto* raise a genuine issue of material fact precluding summary judgment.\(^{27}\) One would expect, then, that a mere "conclusory" opinion as to the meaning of a claim term might also fail to withstand a motion for directed verdict or a motion for judgment notwithstanding the verdict.

No bright line rule exists for disentangling the factual inquiries underlying claim interpretation from the legal conclusion, and none is likely to emerge. However, District Court judges can assist in imparting more certainty to this area by remaining sensitive to the factual inquiries underlying claim interpretation when the matter comes up for summary resolution or judgment on partial findings. To facilitate review, the District Court judge should specifically articulate views on these factual inquiries. First, the judge should specifically indicate whether the claim interpretation is based in part on "extrinsic" evidence.\(^ {28} \) Next, the judge should make particularized findings of fact showing the presence or absence of any genuine issue of fact arising from such "extrinsic" evidence.\(^ {29} \) Such procedures might lead to a clearer definition of the roles of judge and jury in interpreting patent claims.

B. The Jury and Issues of Comparison of the Properly Construed Claim to the Accused Device

Once a claim interpretation has been made, that interpretation must be employed whether the comparison of the claim to the accused device proceeds under a theory of literal infringement or infringement under the doctrine of equivalents.\(^ {30} \) Where a literal infringement theory is used, the comparison requires a determination of whether in fact the claim elements are literally present in the accused device, an exercise presumably well-suited to the jury. However, where the comparison involves an analysis of equivalents (either structural equivalents under §112, 6th ¶, or equivalents as defined under the


\(^ {28} \) In all probability, extrinsic evidence will be relied upon.

\(^ {29} \) If the inquiry is made in relation to a motion for judgment on partial findings, the judge should specify why judgment follows as a matter of law. If on JNOV, the judge might direct the parties to fashion special interrogatories to enable the jury to express specific conclusions as to the extrinsic evidence. See Railroad Dynamics, 727 F.2d at 1516-17, 220 U.S.P.Q. at 939 (encouraging use of special interrogatories).

\(^ {30} \) Loctite Corp. v. Ultradeal, Ltd. 781 F.2d 861, 870-71, 228 U.S.P.Q. 90, 96 (Fed. Cir. 1985).
doctrine of equivalents) the comparison involves the application of specialized legal principles in addition to an inquiry into facts.


By its explicit terms, §112(6) permits a claim element to be expressed as a means for performing a specified function. Such a "means plus function" element appears on its face to cover any means for performing the claimed function, and indeed, the Patent Office has recently reaffirmed its longstanding position that for purposes of patentability analysis of pending patent claims, means plus function elements will be interpreted to cover any means for performing the claimed function, despite recent Federal Circuit panel opinions to the contrary. For purposes of the infringement analysis, however, it is currently clear that a means plus function element is properly construed to literally cover only the corresponding structure disclosed in the specification for performing the function and equivalent structure. That is, §112(6) actually "operates to cut back on the types of means which could literally satisfy the claim language."

Thus, a jury comparing a means plus function element to an accused device under a literal infringement theory must first identify structure in the accused device which performs the identical function as claimed in the means plus function claim element. Second, the jury must determine whether the identified structure is the same as or equivalent to that disclosed in the patent specification for performing the function. Despite the somewhat convoluted legal framework, this determination of literally infringing "equivalents" under §112(6) is said to be a question of fact.

31 See supra n.2.
32 To cite an oft-used example, a screw may be claimed as a "means for fastening," and that language, on its face, would appear to cover screws, bolts, rivets, glue, magnets, and so forth. 33 See PTO Notice of Application of 35 U.S.C. §112, 6th ¶, 43 Patent, Trademark, & Copyright Journal (BNA) 161–67 (Dec. 19, 1991).
2. Infringement Under the Doctrine of Equivalents

Under the doctrine of equivalents, infringement may be found if an accused device performs substantially the same overall function or work, in substantially the same way, to achieve substantially the same result. At least the "way" portion of this analysis must be applied to the claim on an element-by-element basis. As with §112(6) equivalents, the question of equivalency under the doctrine of equivalents is said to be a question of fact.

The doctrine of equivalents is limited in that infringement cannot be found where the asserted scope of equivalency would encompass the prior art. The question of whether the asserted scope of equivalents encompasses the prior art is said to be a question of law which may have factual underpinnings. A determination here might involve an analysis of whether a "hypothetical claim," sufficient in scope to literally cover the accused device, would have been allowed by the Patent Office over the prior art.

Thus, a jury determining infringement under the doctrine of equivalents may actually be impliedly undertaking a patentability analysis in support of its conclusion if the hypothetical claim analysis is relevant. Although the Federal Circuit has suggested that the hypothetical claim rationale does not necessarily envision a "full-blown" patentability analysis, it is difficult to determine what lesser patentability analysis the Federal Circuit contemplates.

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41 Pennwalt Corp., 833 F.2d at 936, 4 U.S.P.Q.2d at 1740. The element-by-element analysis has generated a plethora of commentary. The author leaves for another day the question of whether Judge Rich has altered this formula by his remark in Malta v. Schulmerich Carillons, that "this court has never adopted the three prong approach to determining equivalency of a limitation." See infra n.95 and accompanying text.


44 Jurgens, 927 F.2d at 1561, 18 U.S.P.Q.2d at 1038.


47 See, e.g., We Care, Inc. v. Ultra-Mark Int'l Corp., 930 F.2d 1567, 18 U.S.P.Q.2d 1562 (Fed. Cir. 1991) (district court applying test analogous to hypothetical claim analysis failed to consider obviousness, hence abused its discretion).
The doctrine is also limited in it will not extend to allow the patent owner to recapture through equivalence certain coverage given up during prosecution.\textsuperscript{48} The scope of equivalents to which the claims are entitled in view of the prosecution history is said to be a question of law.\textsuperscript{49}

Given these intricately intertwined questions of law and fact, the need for specific guidelines as to what constitutes "substantial evidence" of equivalents is great. As the following sections demonstrate, a line of Federal Circuit cases culminating in \textit{Malta} establishes specific guidelines for "substantial evidence" of infringement under the doctrine of equivalents. However, if the \textit{Malta} panel is any indication, the Federal Circuit remains deeply divided not only about the propriety of the guidelines, but about how those guidelines should be applied. Undoubtedly this signals disagreement as to the proper roles of the judge and jury in resolving the equivalents issue.

In the area of §112, 6th ¶ structural equivalency, the Federal Circuit has offered no specific guidelines. Worse, the approach taken in at least one recent § 112(6) case is difficult to reconcile with that taken in \textit{Malta}. This is taken up in Section IV.

\section*{II. PRECURSORS TO MALTA}

\subsection*{A. The Nestier Case}

In \textit{Nestier Corp. v. Menash Corp.},\textsuperscript{50} the Federal Circuit was asked to review a judgment of non-infringement entered pursuant to a jury verdict. The patent owner, Nestier, asserted that the district court had erred in refusing to give a jury instruction relating to infringement under the doctrine of equivalents.\textsuperscript{51} In finding no abuse of discretion in the district court's refusal to give the instruction, the Federal Circuit set forth a standard for "substantial evidence" of infringement under the doctrine of equivalents.

In this case, the patent claims apparently\textsuperscript{52} were directed to a reusable tote box which was capable of both nesting (i.e., with lids open, one box could be placed inside another) and staking (by way of inset covers with a plurality of interdigitating teeth on each cover

\textsuperscript{48} Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 870, 228 U.S.P.Q. 90, 96 (Fed. Cir. 1985).
\textsuperscript{49} Pennwalt, 833 F.2d at 937, 4 U.S.P.Q.2d at 1741.
\textsuperscript{51} Nestier, 739 F.2d at 1578, 222 U.S.P.Q. at 749.
\textsuperscript{52} The reported opinion of the Federal Circuit does not specifically set forth the patent claims at issue.
to prevent the boxes from sliding when stacked). The accused boxes were dimensionally compatible with the patented boxes but did not include the inset covers or teeth.

At trial, the patent owner Nestier showed through expert testimony and demonstration that the accused tote boxes were compatible with Nestier's boxes in both their nesting and stacking functions. However, Nestier presented this evidence strictly in the context of a charge of literal infringement. Indeed, Nestier's own expert witness testified on direct examination that he had no opinion on infringement under the doctrine of equivalents because he had found literal infringement. In addition, during the conference after the evidence on the form of the jury instructions, Nestier's counsel stated that the doctrine of equivalents was not Nestier's theory.

Writing for a five-member panel of the Federal Circuit, Circuit Judge Davis noted preliminarily that the fact that Nestier's expert had no opinion on infringement under the doctrine of equivalents, and the fact that Nestier's counsel stated that Nestier's theory was literal infringement, did not mean that the doctrine of equivalents were per se excluded from consideration in the case. However, those statements, taken in conjunction with "the lack of evidence in the rest of the record to form a basis for analysis of equivalence by the jury," justified the district court's refusal to include a doctrine of equivalents instruction.

Judge Davis commented on this lack of evidence as follows:

At no time did Nestier's attorneys or witnesses present evidence which was explicitly related to the jury in the Graver Tank terms of equivalence of function, means, and result. Analysis of equivalence involves those three factors, and a jury cannot be expected to be able to make any such determination absent evidence and argument concerning the doctrine and each of its elements. *** That is not to say

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53 Nestier, 739 F.2d at 1577–78, 222 U.S.P.Q. at 748.
54 The court commented with disfavor upon this presumably improper comparison of commercial embodiment to accused device, See infra n.62.
55 Nestier, 739 F.2d at 1579, 222 U.S.P.Q. at 749.
56 Id.
57 Nestier's expert testified as follows:
I would never get to the Doctrine of Equivalence because I—I think the claim describes the Menasha box so I would never consider equivalence but I—I don't think that was your—I would not then have an opinion because I don't think the Doctrine of Equivalence comes into play.
Nestier, 739 F.2d at 1580, 222 U.S.P.Q. at 750.
58 Nestier's counsel stated that:
I can't dispute that. It is not our theory. We have from the very beginning advocated direct literal infringement.
Nestier, 739 F.2d at 1580, 222 U.S.P.Q. at 750.
59 Id.
60 Id.
that the exact *Graver Tank* language must be used by attorneys and witnesses. However, [Nestier], which bore the burden of proving infringement, had the responsibility of establishing that context at trial and of stating its case within the context—but it failed to do so.61

*Nestier* no doubt represents an extreme fact setting. By all appearances, the patent owner’s infringement case rested upon a comparison of its commercial embodiment of its claimed invention to the accused device, itself a fundamental flaw which clearly concerned Judge Davis.62 Moreover, the doctrine of equivalents theory, coupled with the argument that it was inherent in the literal infringement claim, appears to have been mere *post hoc* argument of counsel. These obvious weaknesses notwithstanding, the court’s explicit articulated concern was that Nestier had never put the arguments in their proper “context for the jury:

The fact that some of Nestier’s arguments concerning literal infringement might also have been relevant to an equivalency analysis is not sufficient, in itself, to establish that evidence and context for a jury. Although evidence was present here which—had the context been established—might have been related to equivalence of functions and results, there was an absence of any such evidence concerning equivalence of means.63

B. The Lear Siegler Case

*Nestier* could have been limited to its facts. The resultant rule would have been that the failure to provide the proper evidentiary “context,” combined with statements disclaiming reliance on the doctrine of equivalents, justifies a finding that no “substantial evidence” exists on infringement under the doctrine of equivalents. *Nestier* would then presumably have fallen into obscurity. Instead, some four years later, a three-member panel of the Federal Circuit relied upon *Nestier*, and probably extended it, in *Lear Siegler, Inc. v. Sealy Mattress Co.*64

In *Lear Siegler*, the jury found that Sealy’s box spring assemblies infringed claims of two Lear Siegler patents under the doctrine

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62 The court noted that “equivalence must be established with respect to the claims of the patent, not (as was perhaps attempted here) for the commercial structures involved.” *Nestier*, 739 F.2d at 1579, 222 U.S.P.Q. at 749.

63 Id.

64 *Lear Siegler*, 873 F.2d 1422, 10 U.S.P.Q.2d 1767 (Fed. Cir. 1989) (before Skelton, Friedman, and Michel).
of equivalents. Sealy moved for judgment notwithstanding the verdict, arguing that Lear Siegler’s counsel had neither explicitly relied upon the doctrine of equivalents until closing argument nor proved its elements. Specifically, Sealy argued that Nestier required that a patent owner explicitly delineate to the jury, through testimony and argument, the equivalence of function, means, and result between the claimed and accused devices. The Federal Circuit agreed and reversed. Judge Michel, writing for the panel, commented that “even if there was adequate testimony on substantial identity of function, means, and result, no testimony reasonably served to articulate the comparison.”

The evidence which Judge Michel found fatally deficient upon application of Nestier arose through cross-examination of the designer of the accused device, particularly the following:

Q: Now, if you took Plaintiff’s Exhibit #2—I have got two left over—if you took those [torsion bar spring members] out and threw them away and you swung this around, that would be the same design, wouldn’t it:
A: I don’t know.

* * *

Q: Well, just by looking at it, would you agree it is the same configuration.
A: What you have done is you have taken and made a whole different spring out of what you had.
Q: Perhaps. I am not arguing with you. I just want to know whether you agree.
A: You an do anything you want to.
Q: If you took these two, cut this right here and cut it right here and put that up there—
A: Okay, if we did—
Q: Yes.
A: —and if you patent describes it that way, I would say you’d have the same spring.

According to the Federal Circuit, this, coupled with counsel’s summary assertion in closing argument that this testimony “had to do with equivalents,” was all Lear Siegler pointed to to support its position that it had complied with the requirements set forth in Nestier.

65 Lear Siegler, 873 F.2d at 1424, 10 U.S.P.Q.2d at 1769.
66 Id.
67 Lear Siegler, 873 F.2d at 1426, 10 U.S.P.Q.2d at 1770.
68 Lear Siegler, 873 F.2d at 1426, 10 U.S.P.Q.2d at 1770–71.
69 Lear Siegler, 873 F.2d at 1426, 10 U.S.P.Q.2d at 1771.
After characterizing *Graver Tank* as requiring proof of infringement under the doctrine of equivalents by an analysis separated into the traditional three parts, the Court reviewed its decision in *Nestier*:

In order to assure such a separate analysis, we said in *Nestier*, as Sealy's counsel argued before the trial court, a jury must be separately directed to the proof of each *Graver Tank* element. The party asserting infringement must present "evidence and argument concerning the doctrine and each of its elements." * * *

Absent the proper *Graver Tank* context, i.e., a showing how plaintiff compares the function, means, and result of its claimed invention with those of the accused device, a jury is more or less put to sea without guiding charts when called upon to determine infringement under the doctrine. While we do not doubt the ability of a jury to decide the factual issue of equivalence, to enable the jury to use its ability, *Nestier* requires that the three *Graver Tank* elements must be presented in the form of particularized testimony and linking argument.  

Here, Judge Michel noted, the cross-examination testimony, whatever its probative force, clearly was not broken down into the three *Graver Tank* elements and thus did not constitute the required "particularized testimony." * * * Moreover, counsel's summary assertion that the testimony "had to do with equivalents" failed to qualify as "linking argument," defined by the court as argument linking such evidence as was elicited to the three elements for equivalence.

Addressing the argument that it was extending *Nestier*, the Federal Circuit explained that its decision was really no more than an explication of what *Graver Tank* had always required in the jury context:

It can be argued that the holding in *Nestier* is limited to where the doctrine of equivalents was disavowed and that the alternative ground of absence of explication of each *Graver Tank* element is not truly an alternative ground of decision but merely dicta. Strictly speaking, it can be considered dicta because the result would have been the same without it. Nevertheless, *Nestier* is binding precedent as to what *Graver Tank* implicitly requires.

The court then proceeded to defend the *Nestier* decision:

*Nestier* also was a well-reasoned decision of a five-judge panel of this court. Writing for the court, Judge Davis persuasively noted that if a jury is to rationally find all three elements of equivalence, it must be told what evidence establishes the equivalence of the claimed and accused devices as to each element. Otherwise,

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70 *Lear Siegler*, 873 F.2d at 1425, 1426, 10 U.S.P.Q.2d at 1770.
71 *Lear Siegler*, 873 F.2d at 1425, 1426, 10 U.S.P.Q.2d at 1771.
72 Id.
73 *Lear Siegler*, 873 F.2d at 1427, 10 U.S.P.Q.2d at 1771.
there is too much risk that the jury will simply compare the two inventions as to overall similarity, in violation of Graver Tank.  

III. THE MALTA CASE

A. District Court Decision

It took very little time for Lear Siegler to find its way into a district court decision. In Malta v. Schulmerich Carillons Inc., the district court overturned a jury verdict of infringement under the doctrine of equivalents based on Nestier-Lear Siegler.

The patent-in-suit in Malta disclosed, inter alia, a clapper mechanism for allowing the loudness of a handbell to be adjusted while the bell was being played. A first embodiment (the “Fig. 3 embodiment”) provided a clapper having three opposing pairs of striking surfaces: the first made of hard rubber, the second of slotted rubber, and the third of felt or other soft material. A second embodiment (the “Fig. 7 embodiment”) provided three opposed pairs of buttons, each having a differing degree of hardness.

Claims 2 and 3 of the patent were both alleged to be infringed. Claim 3 recited the invention as including “a plurality of striking buttons positioned in opposed pairs...wherein each pair of buttons has a different degree of hardness.” Claim 2, by contrast, required “at least three opposed pairs of surface portions wherein each of said pairs has a different degree of hardness.” The accused device, the Schulmerich “Quick Adjust” handbell, had features similar to those of the Fig. 3 embodiment.

On special interrogatories, the jury found that claim 2 was not infringed, but found that claim 3 was infringed under the doctrine of equivalents. The jury awarded $950,000 in damages. Schul-
merich moved for JNOV and while its motion was still pending, the Federal Circuit decided Lear Siegler. 85

In reviewing the jury verdict on motion for JNOV, the district court found that the patent owner Malta presented "no more than brief, conclusory evidence" that the accused bell infringed under the doctrine of equivalents. 86 Specifically, Malta had proffered the accused bell itself, a video taped demonstration, poster-type exhibits, and photographs. 87 In addition, Mr. Malta gave opinion testimony on direct examination that the accused bell included "buttons or the equivalent thereof" as recited in the claims at issue. 88 The district court found that this testimony was insufficient under Nestier-Lear Siegler:

The expression in Malta's testimony, "buttons or the equivalent thereof," lays out the controverted issue. Only a fact-finder, aided by particularized evidence as to function, means and result of this claim element, specifically "buttons"—can properly decide whether the [accused] handbell has "the equivalent thereof." Although there was some evidence in Malta's cross-examination as to the nature of the buttons and their development, nothing approaches the detailed comparison of function, means and result called for by the cases. 89

Noting that the proffered testimony left the jury to mere guesswork in analyzing infringement under the doctrine of equivalents, the district court continued:

The evidentiary explanation is lacking as to how and why, as contended by plaintiffs, these features are "buttons or the equivalent thereof." Otherwise, a finding of equivalence, as occurred in this case, rest [sic] largely on the equivalence of the ultimate result... To uphold this jury's finding would violate Graver Tank-Nestier-

85 Id.
87 Judge Newman, dissenting from the Federal Circuit opinion on appeal of Malta, comprehensively listed the infringement evidence. ___F.2d at ___, 21 U.S.P.Q.2d at 1173-74.
88 In particular, Mr. Malta testified as follows:
Q. . . . Would you go on with your explanation of how the portion illustrated in color in the exhibit corresponds to the claim language?
A. Right. The—as I described, we have a plurality of buttons, there's three sets, buttons or the equivalents thereof, and they are in opposed pairs around the periphery. We've described how they are related to these indexing slots in the underside of the brass clapper insert, and each pair has a different degree of hardness, we've described that. Here again we have felt which produced a soft impact sound. Here, this would be in relation to this slotted portion here where we have a slot in the core and at 180 degrees another slot, that would be the medium impact position. And then the lowermost one would be the—this one opposed to this where we have a solid plastic material in the impact plane producing a brilliant sound.
Id.
89 Malta, ___F.Supp. at ___, 13 U.S.P.Q.2d at ___.

September 1992
Lear Siegler and would reduce the doctrine of equivalents to a result oriented catch-all. 90

The patent owner appealed to the Federal Circuit.

B. Federal Circuit Decision

1. Panel Majority Opinion: Judge Rich

After dispensing with a procedural argument regarding sufficiency of defendant’s motion for directed verdict, 91 Judge Rich reviewed the legal standard for infringement under the doctrine of equivalents. 92 Judge Rich first commented on the Graver Tank test as applied by Pennwalt and its progeny. While confirming the applicability of the overall function/way/result test mandated by Graver Tank, the judge further opined that “Pennwalt did not set forth a test as to how one proves that an element in an accused device is the ‘substantial equivalent’ of a claim.” 93 Relying on statements from Corning Glass Works v. Sumitomo Elec. U.S.A. Inc., 94 Judge Rich claimed that “[t]his court has never adopted the three prong approach to determining equivalency of a limitation.” 95

...Thus, while comparison of function/way/result is an acceptable way of showing that structure in an accused device is the ‘substantial equivalent’ of a claim limitation, it is not the only way to do so...”

Having thus declined to propose “a formula of general applicability for determining equivalency to a claim limitation,” 96 Judge Rich proceeded to review the proofs of infringement under the doctrine of equivalents, ultimately concluding that the proofs lacked “evidence to prove

90 Malta, ___F.2d at ___, 13 U.S.P.Q.2d at 1903.
91 Specifically, Malta argued that Schulmerich’s general allegations of insufficiency of the evidence in its directed verdict motion were inadequate to support the JNOV motion. Judge Rich dismissed the argument out of hand.
92 Malta, ___F.2d at ___, 21 U.S.P.Q.2d at 1164.
93 Malta, ___F.2d at ___, 21 U.S.P.Q.2d at 1165.
96 Id.
either that all three prongs of the Graver Tank test [were] met or that the ‘buttons’ limitation was met equivalently.”

As to the testimonial evidence, Judge Rich examined the same portions of the testimony relied upon by the district court, and arrived at the same conclusion: the evidence of equivalents was insufficient. In articulating his conclusions, the judge restated the Nestier-Lear Siegler rationale as follows:

...what is clearly lacking in [Malta’s] testimony is a sufficient explanation of both why the overall function, way, and result of the accused device are substantially the same as those of the claimed device and why the plastic/slotted plastic/felt arrangement is the equivalent of the claimed buttons limitation. Mr. Malta’s offhand and conclusory statements (‘buttons or the equivalent thereof’ and ‘they function like buttons’) are not sufficiently particularized evidence. In short, with little guidance, the jury was left to its own imagination on the technical issue of equivalency.

Judge Rich then turned to the other evidence presented, observing that there was no other evidence rising to the level of substantial evidence of infringement under the doctrine of equivalents sufficient to save the jury verdict. Review of the patent itself revealed no such quantum of evidence supporting Malta’s argument that the claimed “buttons” were equivalent to the striking surface in the accused device. The language of the specification (comparing Figs. 3 and 7) and the claims themselves (claims 2 and 3) maintained a distinction between “striking surfaces” and “buttons.” According to Judge Rich, there was no substantial evidence that “striking surfaces” and “buttons” were equivalent in “way.” Application of claim interpretation principles also yielded no substantial evidence of equivalents.

Judge Rich’s opinion is perhaps most notable for its careful avoidance of references to the Lear Siegler “particularized testimony” and “linking argument” requirements. Indeed, Judge Rich observes that:

[W]hile Lear Siegler does not go so far as to require recitation of the magic words “function”, “way”, and “result”, we think that it at least requires evidence to

97 Id., emphasis supplied.
98 Malta, ___F.2d at ___, 21 U.S.P.Q.2d at 1166.
99 Id.
100 Id.
101 Id. Specifically, Judge Rich characterized claim 2 as using a broad term (“surface portions”) and claim 3 a narrow term (“buttons”) relating to a specific embodiment in the patent. Judge Rich then concluded that this raised the implication that infringement of claim 3 could be avoided by not meeting the narrower term.
establish what the function, way, and result of both the claimed device and the accused device are, and why those functions, ways, and results are substantially the same.  

Doubtless this distancing from the precise Lear Siegler formula is designed in part to counter arguments that Lear Siegler constitutes new law being retroactively applied. More importantly, however, Judge Rich demonstrates that the Lear Siegler formula is simply a set of specific guidelines for determining the existence of “substantial evidence” of infringement under the doctrine of equivalents. Further, the guidelines are not exclusive, merely exemplary. As long as there is testimony or other evidence showing why the overall function, way, and result of the accused device are substantially the same as those of the claimed invention, the court should find the “substantial evidence” requirement met.

Thus, Judge Rich’s opinion establishes that Lear Siegler is simply an example of the fundamental exercise of defining the threshold level of evidence necessary to support a prima facie of infringement under the doctrine of equivalents. While Lear Siegler “set forth this requirement in language particularly suitable to [a] jury case,” and thus applies particularly to the determination of “substantial evidence,” the underlying principles should logically have broader applicability. In any event, the clear implication of Judge Rich’s opinion is that Lear Siegler represents the application of fundamental Graver Tank principles; it is more than a mere isolated, prophylactic rule for juries faced with equivalents issues.

2. Concurring Opinion: Judge Michel

For Judge Michel, “what is fatal in this record is the failure of Mr. Malta to separate and explicate his comparative analysis of ‘way’ from his comparison of ‘function’ and ‘result’ and to substantiate it.” Judge Michel found ample evidence of function and result, but the testimony as to way “was brief, intermingled, inferential and conclusory.” Specifically, “[t]he jury was not separately and explicitly told, however, that drilling slots behind striking surfaces on a clapper made

102 __F.2d at __, n.4, 21 U.S.P.Q.2d at 1166, n.4.
103 See infra n.121–126 and accompanying text.
104 Malta, __F.2d at __, 21 U.S.P.Q.2d at 1167.
105 This is explored in more detail in Section IV.
106 Id.
107 Malta, __F.2d at __, 21 U.S.P.Q.2d at 1168.
of the same plastic material is an equivalent ‘way’ compared to attaching striking buttons made from different materials.\textsuperscript{108}

Judge Michel noted that he was writing separately to ‘clarify Lear Siegler,’\textsuperscript{109} which, after all, he had authored. Judge Michel explained that under Nestier and Lear Siegler, substantial evidence of comparison of function, way, and result was required as part of the patents owner’s prima facie case of infringement.\textsuperscript{110} Under this approach, no amount of purely descriptive evidence will suffice absent “separate, explicit, and substantial” comparison evidence.\textsuperscript{111}

Judge Michel’s opinion carefully balances his desire to maintain the viability of Lear Siegler with the need to avoid the argument that Lear Siegler (decided some seven months after the trial in the Malta case) was being applied retroactively. The judge insisted, as he had done in Lear Siegler itself, that Lear Siegler merely made explicit what was already implicit in Graver Tank. If Lear Siegler had added a gloss to Graver Tank, said Judge Michel, “it was on peripheral points not dispositive here, such as the requirement of ‘testimony’ (as opposed to other forms of evidence) and ‘linking argument’ (which, being only attorney assertions, is of course not evidence at all).”\textsuperscript{112}

Where exactly this leaves the specific Lear Siegler requirements of particularized testimony and linking argument is not at all clear. If the required “comparison” evidence comes in by way of documentary evidence, would Judge Michel nonetheless reject it because it is not particularized testimony? A hypertechnical approach such as this would seem unjustified, and clearly would run counter to the panel majority opinion, under which the evidence would be considered “substantial” so long as it explained “why” the claimed invention and accused device were substantially the same in function, way, and result.

3. Dissenting Opinion: Judge Newman

Judge Newman, entering a characteristically comprehensive thirty-one page dissent, sternly reprimanded the panel majority for engaging in “post hoc, retrospectively imposed, micromanagement of the jury trial process” which is “inimical to due process.”\textsuperscript{113} Adopting a tone

\textsuperscript{108 Id.}
\textsuperscript{109 Malta, ___F.2d at ___, 21 U.S.P.Q.2d at 1170.}
\textsuperscript{110 Malta, ___F.2d at ___, 21 U.S.P.Q.2d at 1168.}
\textsuperscript{111 Malta, ___F.2d at ___, 21 U.S.P.Q.2d at 1169.}
\textsuperscript{112 Id.}
\textsuperscript{113 Malta, ___F.2d at ___, 21 U.S.P.Q.2d at 1180.}
strongly reminiscent of her past dissents in cases such as *Senmed Inc. v. Richard-Allen Medical Indus.*, Judge Newman asserted that

"Today’s paternalistic ruling that more and different evidence and argument are required when infringement is tried to a jury diverts patent jury trials from the mainstream of the law, a place assured by history and once accepted by the Federal Circuit. ...This court, by retroactively imposing new requirements for proving infringement, then re-finding the facts under the guise of determining whether these new requirements were complied with, has denied this litigant’s historic right. I do not lightly charge my colleagues with so serious a breach..."

Although the dissent presents a multitude of arguments, it focuses on a few major themes.

*(a) De Novo Determination of Infringement*

Characterizing the majority opinion as a "*de novo determination of the factual issue of infringement,*" Judge Newman argued that the majority departed from the precepts underlying the "substantial evidence" standard of appellate review. Judge Newman reviewed Third Circuit law on the standard of review, reciting the familiar requirements that the reviewing court is not free to reweigh evidence, pass on the credibility of witnesses, or substitute its own judgment for that of the jury. Here, said the judge, the majority had substituted its own choice for that of the jury regarding conflicting elements of the evidence.

Judge Rich’s response is that the review is of the trial court’s decision to grant JNOV, not of the jury’s verdict, and that it follows from *Graver Tank* that the trial court’s decision should not be disturbed unless clearly erroneous. Judge Michel has yet a different view—that the issue on review is the trial court’s decision on compliance with *Lear Siegler*, a question of law subject to *de novo* review.

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115 *Malta*, __F.2d at ___, 21 U.S.P.Q.2d at 1179.
116 *Malta*, __F.2d at ___, 21 U.S.P.Q.2d at 1181.
119 Id.
120 *Malta*, 21 U.S.P.Q.2d at 1167
This disharmony is disturbing, particularly in light of the uniformity the appellate review standard has previously enjoyed. It was, after all, Judge Rich himself in *Jurgens v. McKasy* who wrote that:

On proper appeal from a judgment in a jury case, we review the decisions made by the judge for prejudicial legal error...or abuse of discretion... Of course, we review the sufficiency of the evidence underlying a jury verdict on an issue of fact to determine whether the jury’s decision was supported by substantial evidence.  

Judge Newman is surely correct in noting that a motion for JNOV does not convert "appellate review of a jury verdict to simple review of the trial judge's decision." Ultimately, the inquiry is whether "substantial evidence" was presented, and this is true at both the trial court and appellate court levels. Recasting the issue as one of compliance with *Lear Siegler* does not justify de novo review because the comparison evidence required by *Lear Siegler* is, of course, part of the "substantial evidence" necessary to sustain the verdict.

(b) Retroactive Application of Lear Siegler

Because Judge Newman believed that *Lear Siegler* represented new law, she argued that its retroactive application in *Malta* violated due process. In support of her assertion that *Lear Siegler* extended *Graver Tank*, Judge Newman looked to the language of the *Graver Tank* opinion, pointing out the Supreme Court’s statement that proof of equivalents could be made in any form—through testimony, by documents, or by prior art disclosures. The judge further suggested that the majority had inappropriately added a "why" requirement to the three-pronged function/way/result test.  

Judge Newman then proceeded to again attack the "why" requirement on its merits, noting that "an inventor need not know the why of the scientific and technical principles underlying an intention." Referring to *Graver Tank*, Judge Newman observed that the patentee was not required to explain why magnesium and manganese had the same properties. The soundness of this argument might be

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122 *Jurgens*, 927 F.2d at 18, 18 U.S.P.Q.2d at 1035 (citation omitted). See also *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 3 U.S.P.Q.2d 1109 (Fed. Cir. 1987) (patent owner must show the jury’s verdict was supported by substantial evidence to convince appeals court that trial court erred in granting accused infringer’s motion for JNOV).
127 *Malta*, ___F.2d at ___, 21 U.S.P.Q.2d at 1177.
questioned. The principle to which the judge refers is one that allows patentability of an invention where the technological "why" is unappreciated. Here the issue is entirely different: not the issue of the technological "why," but of why two structures can properly be said to function in substantially the same way.\(^8\)

Both Judge Rich and Judge Michel argued that Lear Siegler, and Nestier before it, was merely an explication of Graver Tank. As to the argument that the majority had added a fourth prong to the three-pronged test, Judge Michel quite reasonably noted that "[T]he apparently separate requirement of proof of 'why' is actually only an elaboration on the requirement of equivalents as to 'way'."\(^9\)

(c) Existence of Substantial Evidence

Judge Newman next turned to the infringement evidence presented at trial, which was clearly voluminous.\(^1\) Yet Judge Newman's summary merely shows that much of this massive infringement presentation did not reach the crucial issue of the equivalents of the claimed "buttons" and the accused striking surfaces. For example, the evidence relating to claim 3 shows that of seven claim elements, only one (the "buttons" limitation) provoked any real dispute.\(^2\) In addition, the patent specification itself established that the Fig. 3 embodiment (similar to the accused device) accomplished substantially the same overall results as did the Fig. 7 embodiment (toward which claim 3 was arguably directed).\(^3\)

Thus, the only serious challenge facing Malta was to supply evidence that the accused bell functioned in substantially the same way as did the claimed bell. Judge Newman argued that Malta had presented ample evidence of way by showing that the way both the striking surfaces and the buttons produce their differing tones is by differing hardness.\(^4\) For example, Judge Newman cited Malta's testimony explaining by demonstration the changing of the brightness

\(^{128}\) Graver Tank can thus be reconciled; the question there was why magnesium and manganese functioned in substantially the same way in the claimed composition. The answer was the observed fact that the two had similar properties, so of course there was no need to explore why the two had similar properties.

\(^{129}\) Malta, 21 U.S.P.Q.2d at 1168.

\(^{130}\) Mr. Malta's testimony alone took three trial days. Malta, __F.2d at __, 21 U.S.P.Q.2d at 1176.

\(^{131}\) Malta, __F.2d..... at __, 21 U.S.P.Q.2d at 1173–74.

\(^{132}\) Malta, __F.2d..... at __, 21 U.S.P.Q.2d at 1174.

\(^{133}\) Malta, __F.2d..... at __, 21 U.S.P.Q.2d at 1177.
of the accused bell’s tone using the striking surfaces.\textsuperscript{134} Presumably this could be characterized as a description of the “way” the accused bell’s striking surfaces worked, but it was unaccompanied by a \textit{comparison} to the “way” the claimed inventions worked, according to Judge Michel. Indeed, Judge Newman’s showing here is unpersuasive.

Judge Newman also noted that Malta had presented prior art showing that striking surfaces, pins, and buttons were all known in the prior art for use in connection with rotatable clappers.\textsuperscript{135} Again, however, this evidence was apparently not put into the context of equivalents at the trial to fall back on language from Nestier. Since the actual testimony is not quoted, it is difficult to analyze whether the appropriate context was indeed provided.

Finally, Judge Newman seemed to suggest that the requirements for substantial evidence could be eased when the invention is “simple.” Commenting that “[t]hese bells are simple devices,”\textsuperscript{136} Judge Newman expressed surprise that the evidentiary requirement “must be fulfilled no matter how simple the invention.”\textsuperscript{137} It is unclear whether Judge Newman suggests that the \textit{Lear Siegler} requirements should not be imposed at all where the invention is “simple” or merely that a lesser level of “particularized testimony and linking argument” should be required. In either event, the “simplicity of invention” standard, being wholly subjective, would be an unacceptable addition to the analysis.\textsuperscript{138}

\textit{(d) Lear Siegler and the Jury Instructions}

Judge Newman also argued that the accused infringer Schulmerich should have requested jury instructions on the \textit{Lear Siegler}-type guidelines, and Schulmerich’s failure to do so constitutes waiver.\textsuperscript{139} But the \textit{Lear Siegler} guidelines guide the trial judge in determining whether substantial evidence exists; they are not a matter for consideration by the jury.\textsuperscript{140}

\textsuperscript{134} Malta, \textit{___F.2d}...\textit{ at }\textit{___}, 21 U.S.P.Q.2d at 1176.
\textsuperscript{135} Malta, \textit{___F.2d}...\textit{ at }\textit{___}, 21 U.S.P.Q.2d at 1175.
\textsuperscript{136} Malta, \textit{___F.2d}\textit{ at }\textit{___}, 21 U.S.P.Q.2d at 1178.
\textsuperscript{137} Malta, \textit{___F.2d}\textit{ at }\textit{___}, 21 U.S.P.Q.2d at 1172.
\textsuperscript{138} Judge Michel notes that there may be less need for the \textit{Lear Siegler} guidelines when the technology is “simple,” but the guidelines should still apply. \textit{Malta, \textit{___F.2d} at }\textit{___}, 21 U.S.P.Q.2d at 1169.
\textsuperscript{139} Malta, 21 U.S.P.Q.2d at 1178.
\textsuperscript{140} See \textit{Malta}, 21 U.S.P.Q.2d at 1169. (Michel, J., concurring).
Judge Michel adopted the latter stance and went even further. *Lear Siegler*, said Judge Michel,
is based on the very premise that sufficiency of the instructions cannot cure an insufficiency of proof as to the three *Graver Tank* requirements. The reason we do not allow curing by instructions is that even with perfect jury instructions, determining infringement by equivalents would still be guesswork for a jury unless it is given separate, explicit and substantial evidence of comparison as to each requirement of *Graver Tank*."^{141}

Perhaps Judge Newman was reacting to an underlying policy tension. The jury instructions are prophylactic; one might argue that the need for *Lear Siegler* guidelines is lessened by the presence of jury instructions. However, even if that is so, given the existence of the guidelines, they do not belong in the jury instructions.

(e) New Rules for Jury Trials

Judge Newman concluded her dissent by raising a number of interesting questions respecting future application of *Malta*. First, she reemphasized that the *Malta* requirements apply only to jury trials. Judge Newman also argued that the *Malta* requirements conflict with Rule 705 of the Federal Rules of Evidence, citing *Symbol Technologies v. Opticon*. The *Symbol* case also raises the issue of what constitutes a *prima facie* case of structural equivalents under §112, 6th ¶. These issues are taken up in the following section.

IV. APPLYING MALTA

A. Applying Malta to Bench Trials Involving the Doctrine of Equivalents

As Judge Newman correctly pointed out, *Lear Siegler* type requirements have been imposed only in jury cases. One ought to wonder why those requirements would not apply with equal force to bench trials. Indeed, if *Lear Siegler*, as applied by *Malta*, truly sets a fundamental evidentiary threshold for *prima facie* proof of equivalents, then it would seem to follow that failure to meet the threshold proof would subject the patent owner to a Rule 52(c) "judgment on partial

^{141} *Malta*, 21 U.S.P.Q.2d at 1169.
findings” in a bench trial just as it would subject him to a Rule 50(a) judgment as a matter of law in a jury trial, or to an adverse summary judgment.

Of course, in Malta itself, the “comparison” evidence requirement was applied to determine whether the jury verdict was supported by “substantial evidence,” a necessary component of a prima facie case of infringement under the doctrine of equivalents in a jury trial. In the bench trial context, the “comparison” evidence requirement likewise could be applied to determine whether the patent owner had established a prima facie case of infringement. The policy justification—preventing the doctrine of equivalents from devolving into a result-oriented catchall—applies with equal force to a bench trial.

The Federal Circuit should make clear that in bench trials on infringement under the doctrine of equivalents, as in jury trials, evidence must be presented to demonstrate why the accused device performs substantially the same function/way/result as the claimed invention, and that one way to make the threshold showing is to present “particularized testimony” and “linking argument.” Failure to do so in a bench trial should equate to failure on the part of the patent owner to make out a prima facie case of infringement under the doctrine of equivalents.

B. Applying Malta in View of Symbol Technologies v. Opticon

A further application of Malta deserves consideration—namely, application to the analysis of structural equivalents under 35 U.S.C. §112, 6th ¶, whether tried to the judge or to the jury, in view of the Federal Circuit’s recent decision in Symbol Technologies v. Opticon.

Although the Federal Circuit in Malta sets forth specific threshold requirements for determining the existence of “substantial evidence” of infringement under the doctrine of equivalents, the Federal Circuit has recently treated §112, 6th ¶ equivalents quite differently based on Rule 705 of the Federal Rules of Evidence. In Symbol

142 New Rule 52(c), Fed. R. Civ. P., which replaces the Rule 41(b) involuntary dismissal, provides that:

If during a trial without a jury a party has been fully heard with respect to an issue and the court finds against the party on that issue, the court may enter judgment as a matter of law against that party on any claim, counterclaim, cross-claim or third-party claim that cannot under the controlling law be maintained or defeated without a favorable finding on that issue, or the court may decline to render any judgment until the close of all the evidence. Such a judgment shall be supported by findings of fact and conclusions of law as required by subdivision (a) of this rule.
Technologies Inc. v. Opticon Inc., Symbol Technologies had sued Opticon on three patents relating to devices that employ lasers to read bar code symbols. Since the claims included means plus function elements, the literal infringement analysis included application of §112, 6th ¶. In a bench trial, the court found, *inter alia*, that certain claims of the patents were literally infringed. A three-member panel of the Federal Circuit affirmed.

The decision, viewed alongside Malta, squarely raises the issue of whether the court should look for "comparison evidence" in determining whether a *prima facie* case of §112, 6th ¶ structural equivalency exists. Preliminarily, however, the decision raises the issue of whether a Malta-type requirement, applied to the doctrine of equivalents or to §112, 6th ¶ equivalents, conflicts with Rule 705, Fed. R. Evid.

1. The Symbol Case

In setting forth its infringement case, Symbol offered the expert testimony of Mr. Barkan, a co-inventor on each of the patents-in-suit. Using charts which showed each claim broken down by limitation, with numbers adjacent each limitation to designate corresponding structure in the accused device, Mr. Barkan stated that in his opinion each claim limitation was met by structure in the accused device. Mr. Barkan testified that his understanding of the claims was based upon the claims themselves, as well as the specification and statements made during the prosecution history. Opticon failed to cross-examine Mr. Barkan on the infringement issue.

On appeal, Opticon contended that Symbol had failed to make out a *prima facie* case of infringement. Particularly, Opticon pointed to the fact that the asserted patent claims included means plus function elements, and that Mr. Barkan failed to testify in detail regarding equivalency between the structure of the accused device and the structure disclosed in the patent specification for performing the claimed function.

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144 Symbol Technologies, 935 F.2d at 1570, 19 U.S.P.Q.2d at 1243.
145 Symbol Technologies, 935 F.2d at 1570, 19 U.S.P.Q.2d at 1244.
147 Id.
148 Id.
149 Symbol Technologies, 935 F.2d at 1575–76, 19 U.S.P.Q.2d at 1245.
150 Symbol Technologies, 935 F.2d at 1575, 19 U.S.P.Q.2d at 1245.
The Federal Circuit disagreed. In the circumstances of this case, Judge Clevenger opined, Rule 705 of the Federal Rules of Evidence "provide[d] the answer to whether Symbol made a prima facie showing of infringement." 151 Noting that testimony on the ultimate issue of infringement had been held admissible in patent cases, Judge Clevenger found that the responsibility for challenging the factual underpinnings of the testimony through cross-examination fell squarely on Opticon. 152 The judge observed that Opticon had chosen "not to expose Barkan’s testimony to the glaring light of cross-examination on this issue," and so Opticon had therefore failed to seize the opportunity provided by Rule 705 to demonstrate that Mr. Barkan’s opinion testimony was factually incorrect. 153

Judge Clevenger provided a mixture of policy arguments and precedent-based arguments to justify the court’s decision. First, the judge pointed out that Rule 705 functions to abbreviate trials by permitting opinion testimony without factual foundation. The specific purpose behind Rule 705, according to Judge Clevenger, is to avoid complex and time consuming testimony. "Patent cases, so often typified by lengthy testimony on complex technical issues, are particularly served by this purpose."

Judge Clevenger also noted that the Federal Rules of Evidence are expressly applicable to all proceedings in courts of the United States per Rule 101 of Fed. R. Evid. 155 Finally, the court suggested that the Federal Circuit had previously applied Rule 705 in similar fashion to the issue of damages in a patent case, citing Studiengeellschaft Kohle v. Dart Indus. 156

2. Conflict Between Malta and Rule 705

Malta and Symbol cannot be easily reconciled, considering that similar infringement proofs were proffered (claim charts, expert testimony) and similar analyses involved (equivalents), but contrasting


The expert may testify in terms of opinion or interference and give reasons therefor without prior disclosure of the underlying facts or data, unless the court requires otherwise. The expert may in any event be required to disclose the underlying facts or data on cross-examination.

152 Id.
153 Symbol Technologies, 935 F.2d at 1576, 19 U.S.P.Q.2d at 1246.
154 Id.
155 Id.
results emerged. Careful examination of Symbol, however, reveals that it fails to support the argument that Malta conflicts with Fed. R. Evid. 705.

First, Rule 705, like all rules of evidence, sets a standard for admissibility of evidence, not for its substantive effect. Thus, Rule 705 simply affirmatively answers the question of whether conclusory expert testimony is admissible. Whether that evidence, alone or in combination with other evidence, leads to the establishment of a prima facie case of infringement is another matter entirely.

The Federal Circuit carefully articulated this distinction in Studiengesellschaft Kohle m.b.H. v. Dart Indus., 157 relied upon in Symbol. In reviewing (and ultimately upholding) a damages award based upon conclusory expert testimony from plaintiff SGK's expert, the Federal Circuit observed that:

We agree that pursuant to Rule 705 [SGK’s expert] was not obligated to reveal the facts or data underlying his opinion on a floor [for the reasonable royalty], because Dart did not cross-examine on this issue and the master did not require otherwise. But nothing in Rule 705 bears on the circumstances under which the trier of fact or a reviewing court is required to credit expert testimony. 158

The Studiengesellschaft court amplified its views in explaining the reasoning of United States v. Santarpio, 159 another case relied upon in Symbol:

In the Santarpio case, an expert gave an opinion without describing or explaining the relevance of the factors upon which he based it. He was not cross-examined regarding his conclusion, and the First Circuit merely held that, under the circumstances of that case, the district court “was entitled to credit the expert’s conclusion.” Thus, Rule 705 and Santarpio do not support SGK’s conclusion that a court must credit expert testimony which goes un-cross-examined, even if that testimony is inherently unbelievable. 160

Likewise, the patent challenger’s failure to cross-examine the expert is only relevant if the patent challenger is later objecting to the admissibility of the testimony. If the patent owner’s expert gives wholly conclusory testimony on equivalents, and the patent challenger believes that the testimony combined with all of the other

158 Id. (emphasis supplied).
160 862 F.2d at 1568, 9 U.S.P.Q.2d at 1277.
Judge and Jury Roles in Equivalents Analysis

September 1992

649

evidence does not add up to a *prima facie* case, the patent challenger is perfectly free to dispense with cross-examination and make a Rule 52(c) motion for judgment on partial findings (in a bench trial) or a Rule 50(a) motion (in a jury trial).

The Federal Circuit should clarify *Symbol Technologies* by reinforcing the correct position in *Studiengesellschaft Kohle v. Dart* that Rule 705 bears only on the admissibility of the expert testimony, not on its substantive effect as creating a *prima facie* case of infringement. It would follow that no conflict arises between application of the *Malta* requirements and Rule 705.

3. Malta and §112, 6th ¶ Equivalents

Comparing the doctrine of equivalents to §112, 6th ¶ equivalents can be a risky endeavor, and the Federal Circuit has been known to warn against confusing the two.161 Equivalents under §112, 6th ¶ are used in the context of *literal* infringement. Nonetheless, it is appropriate for purposes of establishing standards for the *prima facie* case that a parallel be drawn between §112(6) equivalents and the doctrine of equivalents. The Federal Circuit has noted that “the underlying principles of equivalents in *Graver Tank* could be used in a §112 literal infringement analysis.”162

To determine whether the means in an accused device for performing a function is structurally equivalent to the means disclosed in a patent specification for performing that function, one would naturally consider whether the means in the accused device operates in substantially the same “way” as the disclosed means.163 As with the doctrine of equivalents, proof of “way” by descriptive evidence is insufficient. *Malta*-style comparison evidence should be required, particularly when the case is tried to a jury, for the same policy reasons that justify requiring comparison evidence on the doctrine of equivalents.

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162 *Palumbo*, 762 F.2d at 975, n.4., 226 U.S.P.Q. at 7, n.4. Recent statements from the Federal Circuit that the doctrine of equivalents differs from §112, 6th ¶ equivalents because “it is not necessary to consider the prior art in applying §112, Par. 6” do not change this conclusion. *General Instrument Corp.*, __F.2d at __, 20 U.S.P.Q.2d at 1179.
163 See also Waldbaum and Sipiora, *Pennwalt Redux-Judicial Uncertainty vs. Procrustean Bed*, 19 A.I.P.L.A.O.J. 237, 243 (1991) (“if the accused device performs an identical function and employs substantially the same means to obtain the same result, then the device [literally] infringes.”) Of course, it is possible that if the accused device performs an *equivalent* function using substantially the same means, infringement of the claim might be predicated on the doctrine of equivalents.
CONCLUSION

The Malta case requires a patent owner asserting infringement under the doctrine of equivalents to offer "comparison" evidence comparing the function/way/result of the claimed and accused device and explaining why the claimed and accused devices are alleged to function in substantially the same way. A patent owner who fails to do so will be subject to a motion for directed verdict or JNOV on this issue.

"Particularized" and "linking argument" delineating the required comparison are sufficient to get the doctrine of equivalents issue to the jury, but are not required. Under Malta, as long as the evidence effects a comparison (as opposed to mere description), the evidence is sufficient regardless of its form.

The Malta requirement of "comparison" evidence was applied to determine whether a prima facie case of infringement under the doctrine of equivalents had been made out in the context of a jury trial - specifically, to determine whether the evidence was "substantial." But comparison evidence is needed to prevent the doctrine of equivalents from becoming "a result-oriented catchall," and that need does not vanish when the context shifts from jury trial to bench trial. The Federal Circuit should confirm that the Malta comparison evidence is a fundamental requirement for any prima facie case of infringement under the doctrine of equivalents by applying the requirement to bench trials.

Finally, the Malta "comparison" evidence should also be required as part of the prima facie case of literal infringement where §112, 6th ¶ is involved. The Federal Circuit should rethink its position in Symbol Technologies and extend a Malta-type requirement to §112 equivalents.