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FEDERAL CIRCUIT PATENT LAW CASE UPDATE


The Supreme Court vacated and remanded Talbert Fuel Systems Patents Co. v. Unocal Corp., 275 F.3d 1371 (Fed. Cir. 2002), in light of its Festo opinion. On remand, the court again found that the DOE was unavailable to Talbert because it amended its patent claims for a gasoline formulation during prosecution to add a “gasoline boiling point range of 121°F to 345°F.” The amendment was to avoid prior art, and Talbert was unable to rebut the Festo presumption of claim scope surrender.

Talbert owns United States Pat. No. 5,015,356, claiming a particular gasoline formulation with a gasoline boiling point range of 121°F to 345°F. “The accused Unocal fuels were stated at trial to have boiling range endpoints of from 373.8°F to 472.9°F.”

The temperature limit was placed in the claims at the examiner’s insistence, to distinguish prior art that included a Hamilton reference that showed hydrocarbon fuels with an endpoint “within the range of about 390°F and about 420°F.” Talbert had argued to the examiner that “the temperature range of the boiling points of the hydrocarbons of the gasoline of the presently claimed invention is between 96.8°F and 345°F.” To gain allowance, Talbert was required to place the temperature restriction in the claims.

The court first turned back Talbert’s literal infringement argument. Then it turned to the DOE analysis.

The prosecution history of the ’356 patent shows narrowing amendments directed to the hydrocarbon content and boiling range of the fuel. Talbert’s claims, as initially filed, contained no temperature range.

The court applied Festo to hold that “the amendment of the Talbert claims to a boiling point upper limit of 345°F, in light of the Hamilton reference showing gasolines with boiling endpoints of 390°F-420°F, is a presumptive surrender of gasolines boiling in the range between Talbert’s amended endpoint of 345°F and Hamilton’s endpoints.”

The court then found that in light of the prosecution history that none of the rebuttal criteria could be met.

When the prior art embraces the alleged equivalent, and a narrowing amendment was made to avoid that equivalent, that subject matter cannot be found to have been unforeseeable at the time of the amendment. . . .

[T]he reason for Talbert’s amendment cannot be deemed “tangential” to the Unocal alleged equivalent. The boiling range and carbon content were at issue during prosecution, and were the direct, not tangential, reason for the narrowing amendments to these claim limitations . . . .

As for the Court’s third potential ground of rebuttal, no “other reason” for avoiding estoppel has been proffered. Talbert argues that the claims contain an unnecessarily exact boiling limit; if so, the court is without power to make such a correction. . . .

In addition, the classical principles of the doctrine of equivalents preclude a finding of equivalency, for such finding requires only insubstantial differences between the invention as claimed and the alleged equivalent. . . . The Unocal fuels do not simply depart by a few degrees from 345°F, but have “true boiling point endpoints ranging from 373.8°F to 472.9°F.” Thus, even were Talbert to provide evidence that might overcome the Festo presumption of estoppel, no reasonable trier of fact could find only insubstantial differences between fuels having an endpoint of 345°F and fuels with the endpoints shown for the Unocal fuels.