

FEDERAL CIRCUIT PATENT LAW CASE UPDATE

The Toro Co. v. White Consol. Indus., Inc., 03-1424 (Fed. Cir. Sept. 13, 2004) (Linn, J.)

The court affirmed the district court's summary judgment decision that White did not infringe Toro's patent for a convertible vacuum-blower under the DOE. Toro dedicated under Johnson & Johnston the equivalent of a restriction ring removable from the unit cover. In affirming, the court opined that the disclosure-dedication doctrine was a question of law, and that the disclosure foreclosing the asserted equivalent need not be disclosed in such a manner as to satisfy § 112.

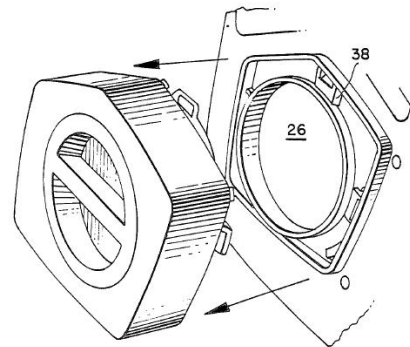
Toro owns U.S. Pat. No. 4,694,528, for a convertible vacuum-blower.

As this court's first opinion described in detail, the '528 patent discloses a vacuum-blower design with a removable cover to which is attached a restriction ring. Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1297-98 (Fed. Cir. 1999) ("Toro I"). When placed over the air inlet, the restriction ring reduces the diameter of the air intake opening and increases the power of the blower. Because the ring can be easily removed from the opening, the machine's design does not impede its vacuuming ability. . . .

White's accused vacuum-blower has a restriction ring that is separate from, and replaceable within, the cover.

In the earlier opinion the court construed the restriction ring to be "permanently affixed to and included as part of the cover." Then it remanded the case for evaluation under the DOE. The case was again appealed to the court, generating a 2001 opinion related to claim construction and DOE, and resulting in another remand. On remand, White applied the dedication doctrine.

White moved for summary judgment of non-infringement under the doctrine of equivalents, asserting that under Johnson & Johnston Associates, Inc. v. R.E. Service Co., 285 F.3d 1046 (Fed. Cir. 2002) (en banc), the two-piece cover/ring embodiment was dedicated to the public because it was disclosed, but not claimed. It relied on the following language from the specification: "Accordingly, building the flow restriction ring 76 as part of the air inlet cover 50, on which it is needed, but leaving a similarly shaped ring off of the vacuum nozzle 98 is also advantageous in that it automatically restricts the size of air inlet 26 depending upon which operation is being



conducted without having the operator manually insert or remove a replaceable ring."

The court first contributed to its standard of review jurisprudence.

Neither Johnson & Johnston nor any of our other disclosure-dedication rule cases have explicitly articulated a standard for reviewing the application of the disclosure-dedication rule. . . . [W]e conclude that both the dedication-disclosure rule and prosecution history estoppel should be analyzed under the same standard of review . . . a question of law, subject to de novo review.

Toro argued an intent element for the disclosure-dedication rule. The court held "that intent is not part of the Johnson & Johnston disclosure-dedication analysis."

The court also disagreed with Toro's next argument: "that because Johnson & Johnston indicates that a patentee would have the opportunity to capture disclosed, but unclaimed, subject matter through reissue or continuation applications . . . the level of disclosure required to trigger a dedication must satisfy the standards of patentability under 35 U.S.C. § 112." The court noted that the "standards articulated in § 112 are directed to the claimed invention, not to disclosures in the written description that may implicate the disclosure-dedication rule." An artisan need only be able to understand and identify the subject matter.

