The Statutory Basis for the Doctrine of Equivalents

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Abstract

The doctrine of equivalents is one of the most perplexing and controversial of all patent doctrines. The doctrine is curious in three distinct ways. First, despite its long history, it is highly controversial and indeterminate. It has been described as "the most difficult and least predictable of all doctrines in patent law…."[1] And "patent law lacks a coherent vision of [the] doctrine…."[2] Second, for a doctrine that is so indeterminate and without theoretical backing, the doctrine of equivalents has a surprising amount of internal structure and sub-doctrines. Third, despite being a long standing part of patent law, the doctrine (or more precisely the application of the doctrine) appears to be vanishing as an empirical matter. Having built up a complicated doctrine with all manner of internal rules, courts are just no longer deciding cases using it.

This article argues that we can make sense of these three oddities by rejecting the one thing about the doctrine of equivalents that seemed uncontroversial. This article argues that the doctrine and its oddities can be best explained by rejecting the notion that the doctrine is entirely judge made law. Instead the doctrine should be understood as having a firm statutory basis. The basis of the doctrine is to fulfill a court's statutory command to grant an inventor exclusive rights over his or her patented invention. The doctrine emerges when a patentee cannot reach that full extent using literal claims.

The article begins by making the case that this was the original purpose of the case law that we have now come to know as the doctrine of equivalents. That statutory basis gives the doctrine a firm legal foundation and it also provides a unified explanation for all of the existing sub-doctrines. And it can explain why despite its statutory basis, the application of doctrine should be now nonetheless in decline.

But this statutory framing brings with it one important new found wrinkle. As the ultimate aim is to provide protection over the patented invention, a valid argument for infringement by equivalents, in contrast to our current understanding of the doctrine, would have to first establish that the equivalent in question was (in a sense) invented and disclosed by the inventor.

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[1] Paul R. Michel, *The Role and Responsibility of Patent Attorneys in Improving the Doctrine of Equivalents*, 40 IDEA 123, 123 (2000).

[2] Michael J. Meurer & Craig Allen Nard, A New Perspective on the Doctrine of Equivalents, 93 Geo. L. J. 1947, 1949 (2005).