

CLIENT ALERT

Disclosure-Dedication Doctrine Bars DOE Pleading When Specification Discloses Alleged Equivalent as an Alternative to the Missing Claim Limitation

MAY 8, 2020

Eagle Pharmaceuticals Inc., v. Slayback Pharma LLC, No. 2019-1924 (Fed. Cir. May 8, 2020)

The Federal Circuit affirmed a noninfringement judgment on the pleadings based on application of the disclosure-dedication doctrine to bar a doctrine of equivalents (DOE) theory.

The patent owner alleged DOE infringement, arguing that the accused product's inclusion of ethanol was equivalent to the claims' recitals of pharmaceutically acceptable fluids comprising, *inter alia*, propylene glycol. The accused infringer defended by arguing that the asserted patents disclosed, but did not claim, ethanol as an alternative to the propylene glycol limitation.

The Federal Circuit panel agreed with the accused infringer. The panel stated that the disclosure-dedication rule bars DOE allegations when a patent specification discloses the alleged equivalent as an unclaimed "alternative to the relevant claim limitation." The unclaimed alternatives are deemed dedicated to the public in order to reinforce the policy that the actual claim language defines the scope of the invention. The panel rejected the patent owner's attempt to narrow the disclosure-dedication doctrine to only applying when the alternative is disclosed as part of a larger embodiment that matches the entire context of the claim. Thus, here, it did not matter that the claims recited an antioxidant embodiment while the specification only disclosed ethanol with respect to chloride salt embodiments.

The Federal Circuit panel also rejected the patent owner's argument that judgment on the pleadings was inappropriate because there was a fact issue created by the patent owner's submission of an expert declaration. The patent owner's expert had opined that skilled artisans would not understand the specification to disclose ethanol as an alternative. The panel stated that district courts have discretion, when ruling on pleadings motions, of whether to consider evidence outside of the complaint and convert the motion into one for summary judgment. Here, the panel found no error in the district court declining to consider the patent owner's expert opinion because the patents' specifications provided sufficient context to determine whether ethanol is disclosed as an alternative.

A copy of the opinion can be found [here](#).

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