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CLIENT ALERT

Doctrine of Equivalents Reaffirmed in Light of Prosecution History Estoppel Argument

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Eli Lilly and Company v. Hospira, Inc., 2018-2126 (Fed. Cir. Aug. 9, 2019)
The patents claim a method of administering a chemotherapy drug, pemetrexed disodium with vitamins. The New Drug Application ("NDA") filers asserted that prosecution history estoppel barred the patentee from asserting that the filers' proposed pemetrexed ditromethamine product infringes through the doctrine of equivalents. The filers also argued that the patentee dedicated pemetrexed ditromethamine to the public through the disclosure-dedication rule. The district court rejected both arguments; the filers appealed; and the Federal Circuit affirmed.

Prosecution history estoppel arises when a patent applicant narrows the scope of its claims during prosecution for reasons substantially related to patentability, and the process of narrowing is deemed a surrender of all equivalents that could arise between the original claim and the amended claim. This presumption can be overcome where the patentee shows the applicability of an exception. Here, the patentee asserted the application of one exception – that the rationale behind its prior amendment only had a tangential relationship to the equivalent in question. The court agreed, finding that the patentee narrowed its original claim to more accurately define what it invented and overcome a prior art reference that did not relate to the alleged equivalent at issue. As such, the patentee's amendment met the tangential exception to prosecution history estoppel, and the patentee was not barred from asserting infringement through the doctrine of equivalents.

The disclosure-dedication rule limits application of the doctrine of equivalents when the patentee discloses subject matter but does not claim it, under a theory that such subject matter is dedicated to the public. Here, the court declined to apply the disclosure-dedication rule because there was only a "generic reference" to the subject matter at issue. Thus, the patentee could not have intended to dedicate the subject matter to the public.

A copy of the opinion can be found here.

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