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Federal Circuit Patent Bulletin: *Jang v. Boston Scientific Corp.*

October 11, 2017

"[W]hen utilizing the hypothetical claim tool, [the patentee's burden of proving that it is entitled to the range of equivalents which it seeks] starts with proposing a proper hypothetical claim that only broadens the issued asserted claims."

On September 29, 2017, in *Jang v. Boston Scientific Corp.*, the U.S. Court of Appeals for the Federal Circuit (Prost, O'Malley, Chen*) affirmed, inter alia, the district court's judgment that BSC did not infringe U.S. Patent No. 5,922,021, which related to a coronary stent. The Federal Circuit stated:

Dr. Jang contends that the district court erred in denying his motion for JMOL because it failed to consider whether Dr. Jang proved that the Express stent's microelements were connecting strut columns, notwithstanding the fact that they may also be expansion columns. In other words, that there was sufficient evidence for the jury to find that the Express stent's microelements were expansion columns is irrelevant to the resolution of his motion for JMOL, Dr. Jang argues, so long as he showed that the microelements were connecting strut columns. Dr. Jang also maintains that the district court erred in denying his motion for JMOL because BSC's arguments rest on legally erroneous premises and so they cannot support the jury's verdict of no literal infringement.

The issue of literal infringement was a question of fact for the jury. The jury heard Dr. Jang's theory of infringement and his supporting evidence but nevertheless found that the Express stent did not literally infringe. The district court did not fail to consider Dr. Jang's theory of infringement and it correctly found substantial evidence to support the jury's finding that the Express stent's microelements do not literally

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meet the connecting-strut-column-related limitations in claim 1. . . .

In an appeal relating to the doctrine of equivalents, a party often challenges the fact finding made below of infringement (or no infringement) under that doctrine, which is usually analyzed under the well-established "substantially the same function-way-result" or "insubstantial differences" inquiry. Here, however, the jury's finding that the Express stent satisfies each claim element of the asserted claims under the doctrine of equivalents is not on appeal. Instead, this appeal centers on the district court's application of a limitation on the reach of the doctrine, known as "ensnarement."

Dr. Jang insists that the district court erred in several respects in overturning the jury's verdict of infringement under the doctrine of equivalents based on BSC's ensnarement defense. Dr. Jang argues that his hypothetical claims three and five are properly broader in scope than representative claim 1, and if they were flawed, the district court was required to proceed with an ensnarement analysis, even if that meant the district court would have to devise an acceptable hypothetical claim for Dr. Jang that was broader in scope than representative claim 1. Dr. Jang is wrong on both counts.

A doctrine of equivalents theory cannot be asserted if it will encompass or "ensnare" the prior art. "This limitation is imposed even if a jury has found equivalence as to each claim element." A "[h]ypothetical claim analysis is a practical method to determine whether an equivalent would impermissibly ensnare the prior art." . . . Hypothetical claim analysis is a two-step process. The first step is "to construct a hypothetical claim that literally covers the accused device." Next, prior art introduced by the accused infringer is assessed to "determine whether the patentee has carried its burden of persuading the court that the hypothetical claim is patentable over the prior art." In short, [the court] ask[s] if a hypothetical claim can be crafted, which contains both the literal claim scope and the accused device, without ensnaring the prior art. "The burden of producing evidence of prior art to challenge a hypothetical claim rests with an accused infringer, but the burden of proving patentability of the hypothetical claim rests with the patentee." . . .

Following Dr. Jang's troubles in drafting a proper hypothetical claim that encompassed the Express stent yet was also patentable in the face of seemingly crowded prior art (a venture that began with generating approximately ten different hypothetical claims), the district court was under no obligation to undertake a hypothetical claim analysis on his behalf. A patentee, like Dr. Jang, bears the burden of proving that it is entitled to "the range of equivalents which it seeks." And, when utilizing the hypothetical claim tool, that burden starts with proposing a proper hypothetical claim that only broadens the issued asserted claims. Dr. Jang cannot effectively transfer the responsibility of defining the range of equivalents to which he is entitled to the district court. Because, as a threshold matter, Dr. Jang failed to submit a proper hypothetical claim for consideration, he was unable to meet his burden of proving that his doctrine of equivalents theory did not ensnare the prior art. The district court thus correctly vacated the jury verdict of infringement under the doctrine of equivalents. . . .

We see nothing legally unsound in BSC raising ensnarement through its pretrial motion in limine, and the district court conducting a post-trial hearing on the defense contingent on an infringement verdict under the doctrine of equivalents. Moreover, based on a review of the record, we are satisfied that Dr. Jang received

sufficient notice of BSC's ensnarement argument. . . . "The ensnarement inquiry . . . has no bearing on the validity of the actual claims" asserted in a case. And that is because ensnarement concerns patentability with respect to a hypothetical patent claim as opposed to the validity of an actual patent claim. Thus, the fact that BSC could not pursue a validity challenge of the asserted claims in this litigation does not somehow mandate that it is likewise barred from challenging a necessarily-broader set of newly-minted, hypothetical claims. . . . [T]he district court permissibly conducted a post-trial ensnarement hearing after finding that BSC timely raised the defense, and it appropriately vacated the jury verdict of infringement under the doctrine of equivalents and entered judgment of non-infringement for BSC when Dr. Jang failed to demonstrate through a proper hypothetical claim analysis that his doctrine of equivalents theory did not ensnare the prior art.