Reevaluating the Doctrine of Equivalents Under the Seventh Amendment

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Judges must construe patent claims while juries may be entrusted with the doctrine of equivalents. The enormous tension resulting from this current state of the law is often overlooked or minimized in discussions of the notice problems associated with patents. While the very existence of the doctrine of equivalents creates a tension with claim construction that was unsuccessfully advanced as a grounds for doing away with the doctrine altogether, the fact that different entities, the judge and jury, may handle claim construction on the one hand and the doctrine of equivalents on the other exacerbates the tension in a dramatic manner.

The Federal Circuit's decision in Hilton Davis is the basis of the current state of the law regarding the jury's role in applying the doctrine of equivalents. Although the Supreme Court reviewed other issues in this case, the Court expressly declined review of the Federal Circuit's analysis of the Seventh Amendment rights associated with the doctrine of equivalents. There are, however, a number of reasons to believe that the Federal Circuit's analysis is flawed. First, the Federal Circuit did not follow the Supreme Court's Seventh Amendment precedent. Second, the Federal Circuit summarily dismissed past references to the "equitable" nature of the doctrine of equivalents, in both in its own cases and Supreme Court cases, by defining such references as "general fairness" rather than "equity in the technical sense." Third, by characterizing the application of the doctrine of equivalents overall as factual, rather than a mixed question of fact and law, the Federal Circuit did not consider whether the task should be broken down into discrete steps.

My work-in-progress reevaluates the Seventh Amendment issue in a manner consistent with Supreme Court precedent. Correcting the errors in the Federal Circuit's analysis has the potential to shift some or all of the application of the doctrine of equivalents to the judge. It is my belief that a rigorous reevaluation of the doctrine of equivalents from the perspective of Seventh Amendment rights will not only fill an existing gap in the literature regarding the proper role of judge and jury, but will also provide
valuable insight into the nature of the maligned and neglected doctrine of equivalents, and prove beneficial in addressing problems related to claim scope and public notice.