

**PRIMOS, INC. v. HUNTER'S SPECIALTIES, INC.: TANGENTIAL RELATIONSHIP**  
**EXCEPTION TO PROSECUTION HISTORY ESTOPPEL**

**Summary**

In *Primos*, the CAFC held prosecution history estoppel does not preclude the application of the doctrine of equivalents where only a tangential relationship exists between the claim amendments and the equivalent in question. *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841 (Fed. Cir. 2006).

**Detailed Discussion**

Primos filed a patent infringement action against Hunter's Specialties and a Hunter's Specialties employee. The Primos patent disclosed a diaphragm mouth call for hunters consisting of a frame, a membrane, a flexible peripheral edge, and a shelf or plate extending above the membrane. *Id.* at 843-44. The Hunter's Specialties diaphragm mouth call device contained, among other features, a dome extending above the membrane, instead of a shelf or plate, as claimed in the Primos patents. *Id.* at 844. The United States District Court for the Northern District of Iowa found Hunter's Specialties liable for literal and willful infringement, inducement of infringement, and infringement under the doctrine of equivalents. Hunter's Specialties appealed. *Id.* at 846.

The CAFC reviewed the district court's finding of literal infringement and held the district court correctly construed "engaging" to mean "to come into contact with" rather than "sealing." The CAFC reasoned that because "engaging" and "sealing" were both expressly recited in the same claim of the Primos patent, they could not be construed as having the same meaning. *Id.* at 848. Further, the figures in the specification of the Primos patent depicted the device touching the roof of a user's mouth and did not reveal an interlocking relationship. *Id.*

The CAFC also agreed with the district court that prosecution history estoppel did not preclude application of the doctrine of equivalents. The Supreme Court held in *Festo* that when a patent claim is amended during prosecution for reasons relating to patentability, there is a presumption that the patentee surrenders all territory between the original claim limitation and the amended claim limitation. *Id.* at 849 (citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002)). The CAFC held "there are situations . . . in which a patentee may overcome that [*Festo*] presumption . . . [such as] when the 'rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question.'" *Primos*, 451 F.3d at 849. Specifically at issue was the term "plate," which had been amended to require that the plate (1) have a "length," and (2) be "differentially spaced" above the membrane. *Id.* The CAFC agreed with the district court that the addition of the term "length" did not narrow the claim because every physical object has a length. *Id.* Additionally, the CAFC agreed with the district court that the territory surrendered by the "differentially spaced" amendment comprises plates that are not "differentially spaced" above the membrane. The CAFC

reasoned that because the accused device included a dome, rather than a plate, and that the dome includes the spacing, prosecution history estoppel did not apply to prevent application of the doctrine of equivalents because the amendment of the term "plate" was merely tangential to the contested element in the accused device. *Id.* Finally, the CAFC held that the "all limitations" rule was not violated because substitution of the accused dome for the claimed "plate" did not eliminate the "plate" limitation in its entirety. *Id.* at 150.

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