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Patent Infringement

# LIMITING AMENDMENTS RAISE TOTAL BAR TO EQUIVALENTS, SAYS FED. CIR.

Litton Sys. v. Honeywell Inc.



In partially upholding a district court ruling in a long-running patent infringement case, a divided Federal Circuit panel ruled that a limiting amendment used to overcome a patent examiner's objections to a patent raises a "total bar" to any claim of infringement via the doctrine of equivalents. Litton Systems Inc. v. Honeywell Inc., No. 00-1241 (Fed. Cir., Feb. 5, 2001).

Litton Systems Inc. sued Honeywell Inc. in 1990, claiming infringement of its Reissue Patent No. 32,849, which was based on U.S. Patent No. 4,142,958, for making multiple-layer optical films using a Kaufman-type ion gun. Litton had to amend its application to limit the reissued patent to Kaufman-type guns after the patent examiner twice rejected an amendment to the 958 patent as obvious until the Kaufman restriction was added. An ex-employee of Litton, after a license to him from the company expired, provided some of the technology to Honeywell, and this lengthy litigation ensued.

Litton claimed infringement of the 849 patent and state law torts for interference with contracts and interference with economic advantage. Honeywell argued that its ion ray guns were of two different kinds, not the Kaufman type, and that position has been consistently upheld through all of the battles over this case. The instant appeal is the third time the case had appeared before the U.S. Court of Appeals for the Federal Circuit. The U.S. Supreme Court reversed the Federal Circuit's initial judgment for reconsideration in light of Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17, 41 USPQ2d 1865 (1997). On its next pass, the Federal Circuit ruled on what constitutes a "Kaufman-type ion beam source" and remanded the case to the U.S. District Court for the Central District of California. On remand, the district court granted summary judgment and judgment as a matter of law on the alleged infringement of the 849 patent to Honeywell and granted JMOL on the state claims as well, finding that Litton had not established the "requisite elements" to support them.

This time, the Federal Circuit panel found that the district court had ruled correctly on noninfringement. Litton was arguing that Honeywell's two types of guns were equivalent to its Kaufman-type guns, but the appeals panel said that since Litton had only gotten the 849 patent issued by restricting its application to Kaufman-type guns, it could not claim infringement under the doctrine of equivalents under the Federal Circuit's recent decision in **Festo** Corp. v. Shokestu Kinzoku Kogyo Kabushiki Co. Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir., 2000). That case repudiated a "flexible bar" approach used in the second Litton case and erected a "total bar" to using the doctrine of equivalents in such cases. Since Honeywell's two designs were not literally Kaufman-type guns, and Litton was completely barred from using equivalents as an argument, JMOL had been properly granted, the appeals panel found.

But, finding that the district court "impermissibly decided disputed issues of material fact" on the state claims, the appeals panel voted 2-1 to reverse and vacate the decision on those claims and remanded the case.

A dissenting judge insisted that without the infringement claims, the state torts could not stand, and wrote that he agreed with the district court's grant of summary judgment on those as well.

Litton was represented by John G. Roberts Jr. and Catherine E. Stetson of Hogan & Hartson in Washington, D.C.; Frederick A. Lorig and Sidford L. Brown of Bright & Lorig in Los Angeles; Rory J. Radding of Pennie & Edmonds in New York; and Stanton T. Lawrence III and Carl P. Bretscher of Pennie & Edmonds in Washington, D.C.

Honeywell was represented by Richard G. Taranto of Farr & Taranto in Washington, D.C.; Gregory A. Long and Kent R. Raygor of Sheppard Mullin Richter & Hampton in Los Angeles; John Donofrio of Honeywell International Inc. in Morristown, N.J.; and George E. Quillin of Foley & Lardner in Washington, D.C.

(Call 877-595-0449 for the 12-page opinion.)

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