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The Precedent: Federal Circuit Sidesteps Ruling on the Reverse Doctrine of Equivalents Theory in *Steuben Foods Inc. v. Shibuya Hoppmann Corp.*

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In this edition of *The Precedent*, we outline the decision in *Steuben Foods Inc. v. Shibuya Hoppmann Corp.*

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Overview

This case addresses whether the reverse doctrine of equivalents (RDOE) is a viable defense to patent infringement.

Issue

Whether the RDOE theory is a viable defense to patent infringement.

Holding

The court declined to rule on the issue and decided that Shibuya infringed claim 26 of U.S. Pat. No. 6,209,591 (the '591 Patent) because, regardless of whether RDOE is a viable defense to patent infringement, there was "substantial evidence to rebut any prima facie case of RDOE."

Background and Reasoning

In 2010, Steuben Foods Inc. (Steuben) sued Shibuya Hoppmann Corp. (Shibuya) for infringement of claim 26 of the '591 Patent. Claim 26 is shown below.

> "Apparatus for aseptically filling a series of bottles comprising: a valve for controlling a flow of low-acid food product into a bottle at a rate of more than 350 bottles per minute in a single production line; a first sterile region surrounding a region where the product exits the valve; a second sterile region positioned proximate said first sterile region; a valve activation mechanism for controlling the opening or closing of the valve by extending a portion of the valve from the second sterile region into the first sterile region, such that the valve does not contact the bottle, and by retracting

the portion of the valve from the first sterile region back into the second sterile region."

Steuben alleged that Shibuya's P7 aseptic bottling line infringed the '591 patent. In response, Shibuya argued that there was no infringement based on RDOE. At the district court level, the jury found claim 26 of the '591 patent not invalid and infringed. Shibuya moved for judgment as a matter of law (JMOL) of noninfringement, invoking the RDOE. The district court granted Shibuya's JMOL, agreeing that there was no infringement. Steuben appealed the JMOL decision to the Federal Circuit.

On appeal, Steuben argued that RDOE is not a valid defense to patent infringement because the 1952 Patent Act subsumed or eliminated the RDOE theory and that any concern about overly broad claim coverage should be addressed by a challenge under 35 U.S.C. § 112. Shibuya disagreed and argued that the RDOE theory was not subsumed or eliminated in the 1952 Patent Act and that Supreme Court case law recognizes its existence after passing the 1952 Patent Act. The Federal Circuit stated that it found "Steuben's arguments compelling but need not decide whether RDOE survived the 1952 Patent Act" because Shibuya infringed claim 26 of the '591 Patent regardless of the validity of the RDOE theory. Namely, the court held that there was "substantial evidence to rebut any prima facie case of RDOE." Thus, the Federal Circuit reversed the district court's JMOL of noninfringement regarding claim 26 of the '591 Patent.

Although the Federal Circuit had a ripe opportunity to endorse or kill the RDOE theory of noninfringement, it sidestepped the issue. Given the open issue, more patent litigators may be emboldened to pursue this defense, especially given the District of Delaware's noninfringement finding based on the theory. However, any fervor for this approach should be tempered by the Federal Circuit declaration that it has "never "affirmed a decision finding noninfringement based on the reverse doctrine of equivalents."