

No.

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**In the Supreme Court of the United States**

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NEXSTEP, INC., PETITIONER

*v.*

COMCAST CABLE COMMUNICATIONS, LLC

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*ON PETITION FOR A WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT*

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**PETITION FOR A WRIT OF CERTIORARI**

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### QUESTION PRESENTED

Under the “doctrine of equivalents,” a product that does not literally infringe the express terms of a patent claim may nonetheless infringe if there is equivalence between the elements of the accused product and those of the patented invention. This Court has long held that equivalence “is not the prisoner of a formula” and that proof of equivalence “can be made in any form.” *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950).

In the decision below, a divided panel of the Federal Circuit set aside a jury’s verdict of equivalence. The majority did so on the ground that the patentee’s expert failed to present “particularized testimony and linking argument”—a categorical, judicially created requirement that the Federal Circuit imposes on all patentees seeking to prove equivalence.

The question presented is:

Whether a patentee must in every case present “particularized testimony and linking argument” to establish infringement under the doctrine of equivalents.

## II

### **PARTIES TO THE PROCEEDING**

Petitioner is NexStep, Inc., the appellant in the court of appeals.

Respondent is Comcast Cable Communications, LLC, the appellee in the court of appeals.

### **CORPORATE DISCLOSURE STATEMENT**

Petitioner NexStep, Inc., has no parent corporation, and no publicly held company holds 10% or more of its stock.

### **RELATED PROCEEDINGS**

United States District Court (D. Del.):

*NexStep, Inc. v. Comcast Cable Communications, LLC*, No. 19-cv-1031-RGA (May 12, 2022)

United States Court of Appeals (Fed. Cir.):

*NexStep, Inc. v. Comcast Cable Communications, LLC*, Nos. 2022-1815, 2022-2005, 2022-2113 (Oct. 24, 2024)

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**OPINIONS BELOW**

The decision of the court of appeals (App., *infra*, 1a-56a) is reported at 119 F.4th 1355. The decision of the district court (App., *infra*, 57a-75a) is unreported but available at 2022 WL 1503922.

**JURISDICTION**

The judgment of the court of appeals was entered on October 24, 2024. A petition for rehearing was denied on January 2, 2025 (App., *infra*, 76a-77a). On March 4, 2025, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including May 2, 2025. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

**STATEMENT**

This case involves the standard for showing infringement under the “doctrine of equivalents.” This Court developed the doctrine of equivalents to ensure that patent infringers could not escape liability by the simple expedient of making



insubstantial changes to an inventor's product or process. Patents would provide little protection if confined to the strict, literal terms of their claims; "[o]utright and forthright duplication is a dull and very rare type of infringement," and "[t]o prohibit no other would place the inventor at the mercy of verbalism." *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950).

"The language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002). So, "[i]f patents were always interpreted by their literal terms, their value would be greatly diminished." *Ibid.* Accordingly, patents cover both their literal claim elements and—under the doctrine of equivalents—the "substantial equivalent" thereof. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 35 (1997) (quoting *Union Paper-Bag Mach. Co. v. Murphy*, 97 U.S. 120, 125 (1877)).

Different tests for equivalence may be appropriate in different circumstances, but the inquiry, ultimately, is whether the accused product contains elements that are equivalent to each of the elements in the claimed invention. See *Warner-Jenkinson*, 520 U.S. at 39-40. That inquiry is flexible, and depends on the circumstances of each case: Equivalence "is not the prisoner of a formula and is not an absolute to be considered in a vacuum." *Graver Tank*, 339 U.S. at 609. Accordingly, "[p]roof can be made in *any form*: through testimony of experts or others versed in the technology; by documents, including texts and

treatises; and, of course, by the disclosures of the prior art.” *Ibid.* (emphasis added).

The decision below is the culmination and extension of several Federal Circuit decisions that shackle this Court’s case-specific, flexible equivalence inquiry with rigid judicially created requirements. Instead of permitting proof of equivalence to be made “in any form,” the court of appeals created a formalistic rule requiring stylized testimony—what it calls “particularized testimony”—that explains, to the court’s satisfaction, “why” a claim element is equivalent.

To make matters worse, though equivalence is a question of fact that, after a jury verdict, is reviewed for substantial evidence (see *Warner-Jenkinson*, 520 U.S. at 23, 38), the court of appeals also requires a witness to provide a particular form of “linking argument.” Without it—and even though argument is not evidence—a patentee’s equivalence case is deemed insufficient as a matter of law.

Most striking of all, the court of appeals imposes these stylized requirements in even the simplest cases. Petitioner’s is a case in point.

The critical question below—whether a short series of button presses on an allegedly infringing smartphone application is equivalent to “a single action”—is readily susceptible to commonsense determination by lay jurors. And here, a properly instructed jury, presented with substantial evidence of equivalence, rendered a verdict of infringement under the doctrine of equivalents. But the district court—now with the blessing of a split panel of the Federal Circuit—threw out the jury’s verdict based on

a determination that petitioner’s technical expert did not provide enough “particularized testimony and linking argument” to establish that several button presses are equivalent to a “single action.” Neither the district court nor the majority of the Federal Circuit panel explained why any technical testimony at all was needed to establish that commonsense finding.

As Judge Reyna explained in his dissenting opinion below, the majority “concoct[ed] a rigid new rule” governing the equivalence determination in all cases. App., *infra*, 53a. That procrustean rule bucks this Court’s doctrine-of-equivalents precedents holding that the equivalence inquiry is a flexible and case-specific one. The majority’s holding also undermines the jury’s factfinding role in infringement trials, as it was based on a perception of insufficient *formal argument* rather than the absence of *substantial evidence*.

The Court should grant review to align Federal Circuit law with the flexible equivalence standard that this Court has articulated consistently over many decades.

#### **A. Legal Background**

1. A patent must “claim” the invention covered by that patent. 35 U.S.C. § 112(b). Thus, “[i]n determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim.” *Graver Tank*, 339 U.S. at 607. But, this Court recognized some 75 years ago, the inquiry cannot stop there: “[T]o permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a

hollow and useless thing.” *Ibid.* Artificially rigid restrictions on the doctrine of equivalents, like the absence of any such doctrine, threaten such hollowness and uselessness.

After all, a competitor might pirate an invention by making minor and insubstantial changes to the claimed invention. Whether or not the competitor acted in bad faith, confining claims to their precise words or blinkering actual equivalence would “place the inventor at the mercy of verbalism,” thus “depriv[ing] him of the benefit of his invention and \* \* \* foster[ing] concealment rather than disclosure of inventions.” *Graver Tank*, 339 U.S. at 607; see *Festo*, 535 U.S. at 731.

The doctrine of equivalents solves those problems. “Under this doctrine, a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.” *Warner-Jenkinson*, 520 U.S. at 21. The doctrine “grow[s] out of a legally implied term in each patent claim that ‘the claim extends to the thing patented, however its form or proportions may be varied.’” *Id.* at 35 (quoting *Winans v. Denmead*, 56 U.S. (15 How.) 330, 343 (1853)). To escape infringement, the differences between an accused product and the subject patent must be “substantial,” not merely “colorable.” *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 286 (1904); *Duff v. Sterling Pump Co.*, 107 U.S. 636, 639 (1883).

One way to demonstrate equivalence is by showing that the differences between the claimed invention and the accused device are “insubstantial.” See

*Warner-Jenkinson*, 520 U.S. at 39-40. Another way, at issue in this case, is by showing that an accused product “performs substantially the same function in substantially the same way to obtain the same result” as the claimed invention. *Graver Tank*, 339 U.S. at 608 (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)); see also *Gray v. James*, 10 F. Cas. 1015, 1016 (C.C.D. Pa. 1817) (Washington, J.) (“where the machines are substantially the same, and operate in the same manner, to produce the same result, they must be in principle the same”).

Like the literal-infringement inquiry, equivalence is a question of fact to be decided by the jury, not the trial court. *Graver Tank*, 339 U.S. at 609. “[M]inor differences may not be relied on as, of themselves, taking the defendants’ machine out of the reach of the plaintiffs’ patent, but they are the subject of legitimate consideration *by the jury*, as part of the evidence upon which they must pass in determining the question of infringement.” *Coupe v. Royer*, 155 U.S. 565, 580 (1895) (emphasis added).

2. This Court has time and again affirmed the importance and continuing vitality of the doctrine of equivalents. Indeed, the doctrine is critical to the patent bargain, in which inventors “bring[] ‘new designs and technologies into the public domain through disclosure,’ so they may benefit all”—and in turn receive “a limited term of ‘protection from competitive exploitation.’” *Amgen Inc. v. Sanofi*, 598 U.S. 594, 604 (2023) (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989)). Without protection from a mere insubstantial “change of form,” “the property of inventors would be valueless.” *Winans*, 56 U.S. at 342-343.

“Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying.” *Festo*, 535 U.S. at 731. Thus, when asked to eliminate the doctrine in *Warner-Jenkinson*, this Court declined to do so and instead clarified “that the doctrine of equivalents \* \* \* [is] settled law.” *Id.* at 739.

3. This Court has emphasized that the doctrine of equivalents is flexible, not rigid and formulaic. That makes sense—the doctrine of equivalents exists in the first place because forbidding only literal infringement would destroy the patent bargain by “subordinating substance to form.” *Graver Tank*, 339 U.S. at 607. Equivalence, thus, “is not the prisoner of a formula and is not an absolute to be considered in a vacuum”; rather, it must be assessed “against the context of the patent, the prior art, and the particular circumstances of the case.” *Warner-Jenkinson*, 520 U.S. at 24-25 (quoting *Graver Tank*, 339 U.S. at 609). At bottom, the question is always whether the accused product contains elements “equivalent to each claimed element of the patented invention.” *Id.* at 40.

#### **B. The Present Controversy**

1. Petitioner is a startup company that develops technologies to improve consumers’ interaction with electronics. It owns U.S. Patent No. 8,280,009 (“the ’009 Patent”), which is directed to an electronic “concierge device” that initiates streamlined and improved technical support for household devices “responsive to a *single* action performed by a user.” App., *infra*, 17a (emphasis added).

Petitioner sued respondent for infringement based on respondent's "My Account App" smartphone application, which likewise initiates requests for technical support without the need to perform intermediate steps like identifying the malfunctioning device's serial number and determining an appropriate support center for the device. App., *infra*, 16a, 18a-19a. Petitioner alleged that the My Account App infringed the '009 Patent literally and under the doctrine of equivalents. *Id.* at 19a.

The case proceeded to trial, where the main issue was whether the short series of button presses required by the My Account App to trigger customer service constitutes a "single action"—either literally or under the doctrine of equivalents. App., *infra*, 19a. Petitioner's technical expert gave detailed literal-infringement testimony, identifying, describing, and demonstrating to the jury the exact sequence of button presses at issue in the accused product and the downstream troubleshooting actions that they trigger. *Id.* at 34a-35a. The expert concluded that the short sequence of button presses in the My Account App is a "single action"—just as throwing a baseball is a single action, despite requiring constituent steps including picking up, orienting, and propelling the baseball. *Id.* at 34a.

Then, when providing testimony on infringement under the doctrine of equivalents, petitioner's expert referred back to his detailed literal-infringement testimony. He explained that the same short series of button presses that he had previously discussed in detail for literal infringement is, at minimum, equivalent to a single action because it performs

substantially the same function in the same way to obtain the same result. App., *infra*, 25a-26a.

Petitioner's expert echoed and built on many of the points that he had made with respect to literal infringement. Thus, he explained that, "to the extent the action to start the troubleshooting process[] is not literally a single action, it is at least equivalent to a single action because a single stream-like action starts the process to begin troubleshooting." App., *infra*, 35a. The expert explained that the "several button presses" in the My Account App are equivalent to the "single action" claimed in petitioner's patent and perform the "same function" of starting a multifaceted troubleshooting process. *Id.* at 25a-26a.

The jury found that the My Account App did not literally infringe the '009 Patent but did infringe it under the doctrine of equivalents. App., *infra*, 19a. Eight months later, the district court set aside the jury's verdict. *Id.* at 19a-20a, 57a-75a.

The district court observed that the "Federal Circuit has held, 'a patentee must . . . provide particularized testimony and linking argument as to the "insubstantiality of the differences" between the claimed invention and the accused device or process.'" App., *infra*, 68a. Applying that rule, the district court concluded that the "fatal flaw in [petitioner's expert's] testimony" was his "failure to provide a linking argument." *Ibid.* (emphasis added); see *id.* at 73a. The district court therefore granted respondent's motion for judgment of noninfringement as a matter of law. *Id.* at 73a; see *id.* at 3a.



2. A divided panel of the court of appeals affirmed. App., *infra*, 1a-45a.

The majority began by explaining that, as “most relevant to this appeal, ‘we have long demanded specificity and completeness of proof as crucial to enforcing the limits on the doctrine [of equivalents]: The patentee must provide *particularized testimony and linking argument* as to the insubstantiality of the differences between the claimed invention and the accused device.’” App., *infra*, 23a (emphasis added) (quoting *VLSI Tech. LLC v. Intel Corp.*, 87 F.4th 1332, 1343 (Fed. Cir. 2023)). According to the Federal Circuit, those formal requirements “assure that the fact-finder does not, under the guise of applying the doctrine of equivalents, erase a plethora of meaningful structural and functional limitations of the claim.” *Id.* at 23a-24a (quoting *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567 (Fed. Cir. 1996)).

The majority held that petitioner’s expert failed to satisfy its “particularized testimony and linking argument” requirement. It first concluded that, during the portion of his testimony *specifically directed to the doctrine of equivalents*, the expert “never identified a particular element or elements in the My Account App as being equivalent to the ‘single action’ limitation” in the claimed invention. App., *infra*, 27a.

As noted above, petitioner’s expert specifically identified and demonstrated the exact sequence of button presses at issue during his literal-infringement testimony and then referred back to that sequence as the critical function in respondent’s device. He

testified that, in his view, those “several button presses” perform the “same function” as the “single action element” in the claimed invention—and do so in the “same way” to achieve the “same result.” App., *infra*, 25a-26a. According to the majority, however, that testimony did not sufficiently “guide the jury to focus on what theory or what button presses are allegedly equivalent.” *Id.* at 28a. Thus, the majority held, the expert failed to “include a particularized identification of what elements in the accused device are equivalent to the claimed limitation.” *Ibid.*

The majority stated that the expert’s testimony was also “deficient because [he] failed to provide a ‘meaningful explanation of *why*’ the element or elements from the accused product or process are equivalent to the claimed limitation for each part of the function-way-result test.” App., *infra*, 28a (quoting *VLSI*, 87 F.4th at 1344). But, in addition to testifying that several button presses operate “in the same way” as a single button press under the doctrine of equivalents, the expert had previously explained in the context of literal infringement that “multiple steps might be contained in a single action.” *Id.* at 50a-51a (Reyna, J., concurring-in-part and dissenting-in-part).

Under Federal Circuit precedent, however, “even if there ‘was evidence and argument on literal infringement[] that may also bear on equivalence,’ that ‘does not satisfy’ the requirements of the doctrine of equivalents in the absence of particularized testimony and linking argument.” App., *infra*, 38a (quoting *Lear Siegler, Inc. v. Sealy Mattress Co. of Mich., Inc.*, 873 F.2d 1422, 1425 (Fed. Cir. 1989)). The majority thus concluded that the expert’s direct-

infringement testimony failed to provide the requisite particularized testimony and linking argument. *Ibid.*

The majority did not dispute that the infringement question was a simple, non-technical, and “easily understandable” one: whether multiple button presses can be substantially equivalent to a single action. App., *infra*, 39a. But, the majority explained, the Federal Circuit has “never recognized a technology-specific exception to the *evidentiary rules*” that it requires to demonstrate infringement under the doctrine of equivalents. *Id.* at 40a (emphasis added). Rather, its “precedent requires particularized testimony and linking argument, regardless of the complexity or the simplicity of the underlying technology.” *Ibid.*

The majority opined that it is not enough for the “jury [to] understand[] the underlying technology.” App., *infra*, 42a. Instead, “the doctrine of equivalents *itself* introduces a distinct and complex inquiry that *requires* appropriate guidance” in the form of “particularized testimony and linking argument to ensure that the jury does not misapply the doctrine and thereby stray beyond the doctrine’s ‘properly limited’ role.” *Ibid.* (emphasis added) (quoting *VLSI*, 87 F.4th at 1342).

3. Judge Reyna dissented in relevant part. App., *infra*, 46a-56a.

Judge Reyna stated that the majority committed two legal errors. First, the majority analyzed petitioner’s “evidence of infringement under the doctrine of equivalents in a vacuum” and flouted the substantial-evidence standard for reviewing jury verdicts. App., *infra*, 48a (Reyna, J., concurring-in-

part and dissenting-in-part). Petitioner “NexStep presented its doctrine of equivalents evidence in the context of its literal infringement evidence,” and the court must presume that the jury “considered all of NexStep’s evidence when rendering its verdict, rather than only a subset of the evidence.” *Id.* at 49a. Yet the majority discounted testimony on literal infringement that filled the purported gaps in petitioner’s case for equivalence. For example, petitioner’s expert provided a detailed analysis of the exact button presses that were at issue when he provided his literal-infringement analysis. Thus, when the expert “later referred to ‘several button presses’ when addressing infringement under the doctrine of equivalents, the jury could reasonably conclude that [he] was referring them to [the same] specific elements he identified during his literal infringement testimony.” *Id.* at 50a. But the majority’s rigid “evidentiary rule[,]” to which it refused to make an “exception” (*id.* at 40a (majority opinion)), allowed it to discount the substantial evidence in the record clearly supporting the jury’s verdict.

As for the supposedly missing “why” testimony, petitioner’s expert “testified that several button presses are a single action *because* single actions have multiple steps, such as throwing a baseball.” App., *infra*, 51a (Reyna, J., concurring-in-part and dissenting-in-part) (emphasis added). And there was plenty of testimony as to “the ‘way’ that the accused product or the claim limitation operates.” *Id.* at 51a-52a. In short, the panel affirmed the negation of the jury’s verdict through judgment as a matter of law—which is appropriate only in “extraordinary

circumstances,” *id.* at 56a—by “disregard[ing] the totality of the evidence presented” and taking a “non-technical non-complex factual issue” away from the jury. *Id.* at 47a-48a.

Second, Judge Reyna explained, “[t]he majority concoct[ed] a rigid new rule” requiring “expert opinion testimony to prove infringement under the doctrine of equivalents” in every case, no matter how simple. App., *infra*, 53a. While Federal Circuit precedent “at least requires the *evidence*” to show equivalence, expert testimony is but one form such evidence may take. *Ibid.* And expert testimony is unnecessary in cases like this one—where “the technology or the specific doctrine of equivalents issue is so simple that evidence other than expert testimony is more than adequate for a jury to understand the issues.” *Id.* at 54a.

Judge Reyna noted that the majority was concerned that “the doctrine of equivalents itself is ‘conceptually difficult,’” and so its “new rule is necessary so that experts may ease the jury’s burden of understanding the complexity of a legal doctrine.” App., *infra*, 55a. But the “law does not require, and in fact it chastises, witnesses who testify as to the meaning of legal doctrines themselves.” *Ibid.* (citing Fed. R. Evid. 702). “Instead, the proper way to remedy the complexity of legal doctrines is for the district court to instruct the jury on the law,” as was done in this case. *Id.* at 55a-56a. The majority, in contrast, “invade[d] the province of the jury” by requiring formal linking *argument* from an expert and “impos[ed] an unnecessary new rule in all future doctrine of equivalents cases to come.” *Id.* at 56a.

**REASONS FOR GRANTING THE PETITION**

The decision below imposes a rigid formula for proving equivalence that is contrary to this Court's precedents. By requiring formulaic "particularized testimony and linking argument," the Federal Circuit's rule improperly confines an inquiry that this Court has held to be flexible and case-specific. In contradiction to this Court's instruction that evidence of equivalence may take "any form," the Federal Circuit requires a *specific form* of evidence, and effectively imposes a requirement of expert testimony. The Federal Circuit's "particularized testimony and linking argument" formula applies to even the simplest cases, taking commonsense decisions away from juries. And it leads courts to disregard evidence of equivalence that is not presented within the Federal Circuit's preferred rubric.

The question presented is recurring and important. This Court has repeatedly affirmed the critical importance of the doctrine of equivalents to protecting the inventor's end of the patent bargain. But the Federal Circuit has, in a series of decisions culminating in the decision below, gutted that protection by imposing rigid, formulaic requirements to prove infringement under the doctrine—an all-too-familiar error by the Federal Circuit that this Court has granted review to correct in other contexts. In doing so, the Federal Circuit's rule usurps the jury's role and takes courts far astray from the "general principles of appellate review" contemplated by *Graver Tank*. This Court's review is warranted.

**I. The Federal Circuit Has Improperly Imposed A Rigid Formula For Proving Equivalence In All Cases**

“Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum.” *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950). Evidence can take “any form,” including “testimony of experts or others versed in the technology; \* \* \* documents, including texts and treatises; and, of course, \* \* \* the disclosures of the prior art.” *Ibid.* The factfinder’s decision controls and, under “general principles of appellate review,” should “not be disturbed unless clearly erroneous.” *Id.* at 610. The key question for the jury is ultimately a simple one: whether the accused product or process contains elements that are “equivalent” to the elements in the claimed invention. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997). The decision below is contrary to that rule.

1. To begin with, the Federal Circuit’s “particularized testimony and linking argument” requirement improperly confines the flexible equivalence inquiry. Particularized “testimony” is a *specific type* of evidence, whereas this Court has held that “any form” of evidence can suffice. *Graver Tank*, 339 U.S. at 609. The Federal Circuit’s rigid requirement cannot be squared with this Court’s prescription that equivalence may be demonstrated “by documents, including texts and treatises; and, of course, by the disclosures of the prior art.” *Ibid.* Moreover, requiring “particularized” testimony—that is, testimony that explains equivalence of function, way, and result in a formulaic, check-list manner—

licenses courts to decide equivalence as a matter of law even when substantial evidence supports a properly instructed jury's verdict on the question of equivalence.

As for the Federal Circuit's requirement for "linking argument" (the principal basis for the decision below): That is not evidence at all. See, e.g., *Zafiro v. United States*, 506 U.S. 534, 541 (1993). So it is hard to see how the majority can defend the "linking argument" prong of its formula as an "evidentiary requirement[]" or "evidentiary rule[]." App., *infra*, 23a-24a, 40a.

In *Union Paper-Bag Machine Co. v. Murphy*, 97 U.S. 120 (1877), this Court long ago emphasized the case-dependent nature of equivalence. Where the technology and equivalence question are extremely simple and a matter of common sense, "[a]rgument to show" equivalence may be "quite unnecessary, as that is proved to a demonstration by a comparison of the two devices." *Id.* at 124. After discussing the expert testimony showing that a knife and a cutter perform the exact same task in two similar machines for making paper bags, the Court added that, even if "the explanation last given is too theoretical for practical application, still we are all of the opinion that the knife and the striker employed by the respondents perform substantially the same function as the cutter in the complainants' machine." *Id.* at 124-125. Applying its own common sense, the Court "remanded with directions to enter a decree in favor of the complainants." *Id.* at 126. Yet the modern Federal Circuit could have come out the other way on the same



facts—depending solely on the *form* of expert testimony.

Thus, as Judge Michel has recognized, the Federal Circuit’s rule has erroneously “added gloss” to this Court’s precedents by requiring “‘testimony’ (as opposed to other forms of evidence) and ‘linking argument’ (which, being only attorney assertions, is of course not evidence at all).” *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1331 (Fed. Cir. 1991) (Michel, J., concurring). And the court of appeals has added far more than just “gloss” to *Graver Tank*; it has upended this Court’s pronouncement that proof of equivalence “can be made in any form.” *Graver Tank*, 339 U.S. at 609. Put simply, by requiring “particularized testimony and linking argument” in all cases, the court of appeals has made equivalence the very “prisoner of a formula” that this Court rejected. *Ibid.*

That error led the majority to jettison the jury’s infringement verdict in this case. The majority stated that petitioner’s expert flunked the “particularized testimony and linking argument” requirement because he failed to “identify what element or elements in the accused device are equivalent to the claimed limitation.” App., *infra*, 27a. But, as the majority and dissent both recognized, the expert expressly identified “several button presses” as the critical function in respondent’s device and testified that, in his view, those “several button presses” perform the “same function” as the “single action element” in the claimed invention—and do so in the “same way” to achieve the “same result.” *Id.* at 25a-26a, 50a.

What else could the expert have said to make it any clearer “what element” was equivalent? The majority’s answer: The expert needed to provide “particularized testimony and linking argument” that would “guide the jury to focus on what theory or what button presses are allegedly equivalent.” App., *infra*, 28a. But the expert *did* tell the jury what button presses were equivalent: He “identified the distinct ‘series of button presses’” at issue. *Id.* at 50a (Reyna, J., concurring-in-part and dissenting-in-part). He just did not do so in the formulaic fashion required by the majority as a matter of law.

2. As Judge Reyna explained, moreover, the decision below further expands the Federal Circuit’s ill-founded rule by effectively requiring a patentee to “present expert opinion testimony to prove infringement under the doctrine of equivalents.” App., *infra*, 53a. The majority took issue with Judge Reyna’s assertion that it was creating a “new rule,” noting that its “discussion of the use of expert testimony in proving infringement under the doctrine of equivalents is limited to quoting the standard articulated in *AquaTex Industries, Inc. v. Techniche Solutions*.” *Id.* at 43a. There, the court of appeals stated that “[b]oth the Supreme Court and this court have made clear that the evidence of equivalents must be from the perspective of someone skilled in the art, for example ‘through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art.’” *AquaTex Indus., Inc. v. Techniche Sols.*, 479 F.3d 1320, 1329 (Fed. Cir. 2007) (quoting *Graver Tank*, 339 U.S. at 609).

But, as the majority acknowledged (App., *infra*, 44a), *AquaTex* further stated that such a witness will “typically [be] a qualified expert.” 479 F.3d at 1329. And, even if the majority did not expressly require expert testimony in all cases, it effectively did so: It is difficult to imagine “any way that a mere fact-witness could provide this particularized testimony absent some smoking-gun document involving the accused infringer making admissions about how its product was attempting to mimic the patented invention.” Dennis Crouch, *Doctrine of Equivalents: Expert Testimony Must Include Particularized Links*, Patently-0 (Oct. 25, 2024), <https://perma.cc/76ZC-MZYJ> (discussing the decision below).

Indeed, the majority faulted petitioner’s expert for failing to “guide the jury to focus on *what theory* or what button presses are allegedly equivalent,” App., *infra*, 28a (emphasis added), or provide the requisite “linking argument,” *id.* at 32a. But a fact witness’s job is to present *evidence*—not legal “theories” or “linking argument.” In addition to expert testimony, moreover, petitioner introduced source code and technical documents at trial, and pointed to cross-examination testimony by respondents’ own witnesses, all of which supported equivalence. See Pet. C.A. Br. 41-46. But the majority focused solely on the testimony of petitioner’s *expert*—and his failure to provide sufficiently “particularized testimony and linking argument”—to the exclusion of the other evidence at trial. Thus, the majority’s rule in effect requires formulaic direct expert testimony for a patentee to win an equivalence case.

3. To make matters even worse, the majority extended its rigid “particularized testimony and linking argument” rule to apply to even the simplest of cases. Some complex, technical cases may require extensive expert testimony to establish equivalence—even as simple cases require none. As this Court explained, the equivalence inquiry is not “the prisoner of a formula,” *Graver Tank*, 339 U.S. at 609, and different “frameworks may be more suitable to different cases,” *Warner-Jenkinson*, 520 U.S. at 40.

Yet the majority reasoned that “particularized testimony and linking argument” are needed “in every case,” regardless of the simplicity or complexity of the technology, because “the difficulties and complexities of the doctrine require it.” App., *infra*, 42a (cleaned up). Those requirements, according to the majority, are necessary “to ensure that the jury does not misapply the doctrine and thereby stray beyond the doctrine’s properly limited role.” *Ibid.* (internal quotation marks omitted).

But it is the *court’s* job, not a witness’s, to explain legal doctrine to the jury. Indeed, the law “chastises[] witnesses who testify as to the meaning of legal doctrines.” App., *infra*, 55a (Reyna, J., concurring-in-part and dissenting-in-part). That goes for experts as well as lay witnesses. See *Jimenez v. City of Chicago*, 732 F.3d 710, 721 (7th Cir. 2013) (“It is the role of the judge, not an expert witness, to instruct the jury on the applicable principles of law, and it is the role of the jury to apply those principles of law to the facts in evidence.”); *Sparf v. United States*, 156 U.S. 51, 84 (1895). In short, *proper instructions* from the trial court—instructions that juries are presumed to

follow—are the remedy for any doctrinal complexity. See, e.g., *Richardson v. Marsh*, 481 U.S. 200, 211 (1987).

The central question in this case was a simple one that the jury could answer without “particularized testimony and linking argument”: whether several button presses on a smartphone to initiate technical support are equivalent to a “single action” to initiate that support. That is scarcely rocket science. Cf. *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 693 (2d Cir. 1948) (Hand, J.) (“courts have with curious unanimity held that it does not avoid infringement to combine into one member that which the patent discloses as two, if the single member performs the duties of both in the same way”). Indeed, it is no different from asking a jury to decide if pushing several buttons to dial a phone number is equivalent to a single action. No technical testimony is needed to answer that commonsense question. Rather, a simple “comparison” is enough to show that the button presses and claimed single action are “substantially the same.” *Union Paper-Bag Mach. Co.*, 97 U.S. at 124.

Petitioner’s expert testified that several button presses are the same as or equivalent to a “single action” for the same reason that “throw[ing] a baseball” constitutes a single action, despite requiring multiple steps: “you pick it up, you orient it, you get it in your palm, you throw it.” App., *infra*, 51a (Reyna, J., concurring-in-part and dissenting-in-part). Armed with that testimony, a properly instructed jury could reasonably make the equivalence determination by resorting to common sense, alone. See *Malta*, 952 F.2d

at 1334 (Newman, J., dissenting) (criticizing the fact that the court of appeals’ “particularized testimony and linking argument” requirement “must be fulfilled no matter how simple the invention”).

If the Federal Circuit’s rule cannot be justified by the need to resolve complexities of fact or law for the jury—and if a purportedly “evidentiary” rule cannot explain a demand for “argument”—then what is really going on? Usurpation of the jury’s factfinding role. The “particularized testimony and linking argument” requirement “appl[ies] solely to jury trials.” *Malta*, 952 F.2d at 1333 (Newman, J., dissenting).

Indeed, it was expressly designed to *limit* the jury’s factfinding role. It is “a prophylactic rule of general applicability” meant to “minimize the risk that a jury will find infringement under the doctrine of equivalents” based on equivalence of only one or two of function, way, and result. *Malta*, 952 F.2d at 1330-1331 (Michel, J., concurring); see also *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567 (Fed. Cir. 1996) (“without these requirements, the fact-finder has no analytical framework for making its decision”). Thus, although the majority insisted that it does “not doubt the ability of a jury to decide the factual issue of equivalence,” App., *infra*, 24a (quoting *Lear Siegler, Inc. v. Sealy Mattress Co. of Mich., Inc.*, 873 F.2d 1422, 1426 (Fed. Cir. 1989)), its “particularized testimony and linking argument” requirement says otherwise. Worse still, it is a one-way ratchet: It protects against erroneous findings of equivalence while doing nothing to avoid erroneous findings of *nonequivalence*.

To be sure, this Court has counseled “a special vigilance against allowing the concept of equivalence to eliminate completely” the necessary focus on the equivalence of claim *elements*, so that a patent is not improperly enlarged beyond the scope of its claims. *Warner-Jenkinson*, 520 U.S. at 40. But that is what well-crafted jury instructions are for. And respondents do not dispute that the jury was correctly instructed here. If the jury makes an equivalence finding unsupported by substantial evidence, “general principles of appellate review” provide the remedy. *Graver Tank*, 339 U.S. at 610. The Federal Circuit’s rule goes beyond those guardrails—taking from the jury commonsense, factual equivalence determinations that are well within the jury’s ken.

4. Finally, the majority “disregard[ed]” the literal-infringement testimony at trial because that testimony was not presented in the particular form required by the Federal Circuit to show equivalence. App., *infra*, 48a (Reyna, J., concurring-in-part and dissenting-in-part).

In considering a motion for judgment as a matter of law, “the court should review *all* of the evidence in the record,” and “must draw all reasonable inferences in favor of the nonmoving party.” *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150 (2000) (emphasis added); see Fed. R. Civ. P. 50. And here, petitioner “presented its doctrine of equivalents evidence in the context of its literal infringement evidence.” App., *infra*, 49a (Reyna, J., concurring-in-part and dissenting-in-part). Its expert “testified that several button presses are a single action because single actions have multiple steps, such as throwing a

baseball,” and because “the steps a user takes to perform one button press are the same regardless of whether more than one press is taken.” *Id.* at 51a.

The majority did not dispute that petitioner’s expert presented literal-infringement testimony that may “bear on equivalence.” App., *infra*, 38a. But the majority discounted that evidence because it “fell short of providing particularized testimony and linking argument.” *Ibid.* In other words, the majority’s rule requires courts (and juries) to turn a blind eye to evidence of literal infringement that, in *substance*, establishes equivalence, if that evidence is not presented in the precise *form* preferred by the Federal Circuit.

In addition to discounting the literal-infringement testimony because of its form, the majority “invoked a new requirement of proof of equivalency: proof of not only the three *Graver Tank* ‘prongs’ of ‘function, way, and result’, but also a fourth prong of ‘why.’” *Malta*, 952 F.2d at 1334 (Newman, J., dissenting); see App., *infra*, 38a (faulting petitioner’s expert for failing to explain “*why* those functions, ways, and results are substantially the same”). That new requirement is contrary to the flexible inquiry set forth by this Court in *Graver Tank* (and its non-exclusive function-way-result inquiry); contrary to the rule that witnesses present evidence, not argument; and contrary to the rule that, on a motion for judgment as a matter of law, courts must consider “all of the evidence” and “draw all reasonable inferences” in favor of the jury verdict, *Reeves*, 530 U.S. at 150—without requiring that evidence to be presented in a particular *way* that is mentioned nowhere in the Federal Rules of Evidence.



In sum, the majority held that petitioner’s “infringement theory under the doctrine of equivalents was \* \* \* legally insufficient because it failed to comply with ‘the specific evidentiary requirements necessary to prove infringement under the doctrine’ of equivalents.” App., *infra*, 32a (quoting *Texas Instruments*, 90 F.3d at 1566). As explained above, those “specific evidentiary requirements” are contrary to this Court’s precedent. And they allow the Federal Circuit to second-guess jury verdicts that, like the one here, are supported by substantial evidence. A jury can, and should be permitted to, decide for itself whether several button presses are a “single action” in the same way that the single action of throwing a baseball includes several steps.

## **II. This Court’s Review Is Warranted**

### **A. This Court Has Consistently Reaffirmed The Importance Of The Doctrine Of Equivalents**

1. The patent laws embody a bargain “between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor’s exclusive rights.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002). Patent protection is critical to encourage the public disclosure of valuable inventions. The Patent Act thus requires inventors to “describe their work in ‘full, clear, concise, and exact terms.’” *Ibid.* (quoting 35 U.S.C. § 112).

But “the nature of language makes it impossible to capture the essence of a thing in a patent application,” and “[t]he inventor who chooses to patent an invention and disclose it to the public, rather than exploit it in

secret, bears the risk that others will devote their efforts toward exploiting the limits of the patent's language." *Festo*, 535 U.S. at 731. The doctrine of equivalents is thus necessary to ensure that imitators cannot end-run patent protection by making insubstantial changes to an inventor's device. "[T]he property of inventors would be valueless, if it were enough for the defendant to say, your improvement consisted in a change of form; you describe and claim but one form; I have not taken that, and so have not infringed." *Winans v. Denmead*, 56 U.S. (15 How.) 330, 342-343 (1853).

This Court addressed the concern that the doctrine can be taken too far by requiring that "the doctrine of equivalents \* \* \* be applied to individual elements of the claim, not to the invention as a whole" and that equivalency "not [be] allowed such broad play as to effectively eliminate [an] element in its entirety." *Warner-Jenkinson*, 520 U.S. at 29. With those limitations in place, there is no need to cabin the doctrine with one-size-fits-all evidentiary requirements—particularly in cases, like this one, where common sense shows the relevant differences to be insubstantial.

2. The decision below is the culmination and extension of a series of Federal Circuit cases that, despite this Court's admonitions, unduly restrict the doctrine of equivalents. First, the Federal Circuit crafted a new rule—applicable only when a jury is the factfinder—that otherwise-sufficient evidence of equivalence is insufficient as a matter of law if the "means" by which the elements achieve a result are not placed in "context for [the] jury." *Nestier Corp. v.*

*Menasha Corp.—Lewisystems Div.*, 739 F.2d 1576, 1579 (Fed. Cir. 1984).

The court of appeals built on that rigid rule in *Lear Siegler*. There, while purporting “not [to] doubt the ability of a jury to decide the factual issue of equivalence,” the Federal Circuit, in order “to enable the jury to use its ability,” imposed a requirement “that the three *Graver Tank* elements must be presented in the form of particularized testimony and linking argument.” *Lear Siegler*, 873 F.2d at 1426. And the stylized evidence required went beyond the function, way, and result factors that *Graver Tank* considered; the court of appeals requires “evidence” as to “why those functions, ways, and results are substantially the same.” *Malta*, 952 F.2d at 1327 n.5 (emphasis removed); see *id.* at 1334 (Newman, J., dissenting) (explaining that the court of appeals, “applying *Lear Siegler* to remove this case from the jury, has invoked a new requirement of proof of equivalency”).

Now, in the decision below, the majority has gone even further. It has made clear that the Federal Circuit’s rigid “particularized testimony and linking argument” rule effectively requires expert testimony, even in the simplest cases. This Court should grant review to halt the Federal Circuit’s continuing erosion of the doctrine of equivalents—and of innovators’ patent rights.

**B. This Court Has Rejected Rigid Patent-Law Rules Like The One Imposed By The Federal Circuit Here**

This Court has frequently granted review to abolish rigid doctrinal rules imposed by the Federal

Circuit. For example, this Court’s obviousness cases had long “set forth an expansive and flexible approach.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007). The Federal Circuit nevertheless “transform[ed] the general principle” governing obviousness “into a rigid rule that limit[ed] the obviousness inquiry” by requiring a specific “teaching, suggestion, or motivation” to combine prior art references. *Id.* at 419. This Court rejected that inflexible rule, explaining that the court of appeals had improperly allowed a “[h]elpful insight[.]” to become a “rigid and mandatory formula[.]” *Id.* at 418-419.

This Court has twice stepped in to correct inflexible Federal Circuit rules in the related areas of attorneys’ fees and enhanced damages in patent cases. First, the court of appeals replaced a “holistic, equitable approach” for determining whether a case is “exceptional” for purposes of awarding attorneys’ fees with “a more rigid and mechanical formulation.” *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 549-550 (2014). Explaining that “there is no precise rule or formula for making these determinations,” this Court rejected the Federal Circuit’s “overly rigid” and “inflexible” formulation. *Id.* at 554-555 (cleaned up).

Then, two years later, the Court rejected a similarly wooden rule that required the application of a “two-part test” in “every case before district courts may award enhanced damages” for infringement. *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 579 U.S. 93, 104 (2016). This Court “eschew[ed] that “rigid formula,” which insulated some egregious infringers and unduly

restricted trial-court discretion. *Id.* at 107; see also *Shinseki v. Sanders*, 556 U.S. 396, 407 (2009) (rejecting the Federal Circuit’s harmless-error framework, which required the use of “rigid rules” rather than “case-specific application of judgment, based upon examination of the record”); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 393 (2006) (rejecting the Federal Circuit’s “categorical rule” for injunctive relief in patent cases).

Now, the Federal Circuit has yet again erected a “rigid formula”—in contravention of this Court’s precedents. *Halo Elecs.*, 579 U.S. at 107. This Court has long maintained that equivalence “is not the prisoner of a formula” and that proof of equivalence “can be made in any form.” *Graver Tank*, 339 U.S. at 609. The court of appeals has nevertheless transformed that flexible, case-specific equivalence inquiry into a “rigid and mechanical formulation,” *Octane Fitness*, 572 U.S. at 550, by requiring patentees to present “particularized testimony and linking argument” in every case. This Court has also cautioned that “the particular linguistic framework used is less important than whether the test is probative of the essential inquiry,” *Warner-Jenkinson*, 520 U.S. at 40, but the decision below “prevent[s] the reviewing court from directly asking” the essential question, *Sanders*, 556 U.S. at 408—whether there is substantial evidence that the differences between a “single action” and a series of button presses are insubstantial. The Federal Circuit has calcified a particular linguistic and evidentiary framework for *all* equivalence cases.

In *Warner-Jenkinson*, this Court assumed that “the Federal Circuit will refine the formulation of the test for equivalence in the orderly course of case-by-case determinations.” 520 U.S. at 40. But, instead of refining the standard in an orderly, case-by-case fashion, the Federal Circuit has done just the opposite—imposing a strict, one-size-fits-all formulaic rule that pretermits case-specific judgment. This Court previously stepped in to remind the court of appeals, in the closely related area of prosecution history estoppel, that it has “consistently applied the doctrine in a flexible way, not a rigid one.” *Festo*, 535 U.S. at 738. It should do so here, too.

### **C. The Federal Circuit’s Rule Invades The Jury Function**

Review is also warranted because the majority’s approach to review usurps the jury’s role, contrary to this Court’s admonition that equivalence determinations be subject to “general principles of appellate review.” *Graver Tank*, 339 U.S. at 610. Again, the Federal Circuit is having trouble breaking a bad habit that this Court has had to correct before. See *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 321-322 (2015) (reversing the Federal Circuit for usurping the factfinder’s role by reviewing the evidentiary underpinnings of a district court’s claim construction *de novo* rather than for clear error).

Here, rather than ask whether respondent showed that the jury’s findings were “not supported by substantial *evidence*,” as required to overturn a jury verdict, *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1376 (Fed. Cir. 2001) (emphasis added), the majority decided whether petitioner’s

expert faithfully adhered to its “particularized testimony and linking argument” requirement. That move took from the jury a simple, factual question of equivalence—whether a short sequence of button presses is equivalent to a single action—and transformed it into a legal question governed by the court’s rigid rule.

The cost of that error extends beyond this case. By erasing jury verdicts and deciding this and similar cases for itself, the court of appeals “impairs the confidence of litigants and the public in the decisions of the trial courts, and it multiplies the number of appeals.” *Malta*, 952 F.2d at 1332 (Newman, J., dissenting) (quoting Charles Alan Wright, *The Doubtful Omniscience of Appellate Courts*, 41 Minn. L. Rev. 751, 779 (1957)). Indeed, this Court has admonished the Federal Circuit to “have in mind that [its] function is not to decide factual issues *de novo*.” *Teva*, 574 U.S. at 324. It should grant review here to reinforce that instruction.

The decision below is no outlier. The court of appeals has repeatedly overturned (or affirmed decisions overturning) jury verdicts finding infringement under the doctrine of equivalents because the patentee failed to present evidence in the form of “particularized testimony and linking argument.” See *VLSI Tech. LLC v. Intel Corp.*, 87 F.4th 1332, 1345 (Fed. Cir. 2023); *Texas Instruments*, 90 F.3d at 1568; *Malta*, 952 F.2d at 1327; *Lear Siegler*, 873 F.2d at 1426. The erosion of the jury-trial right in doctrine-of-equivalents cases—which has reached its apex in this case—calls out for review.

**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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MAY 2025