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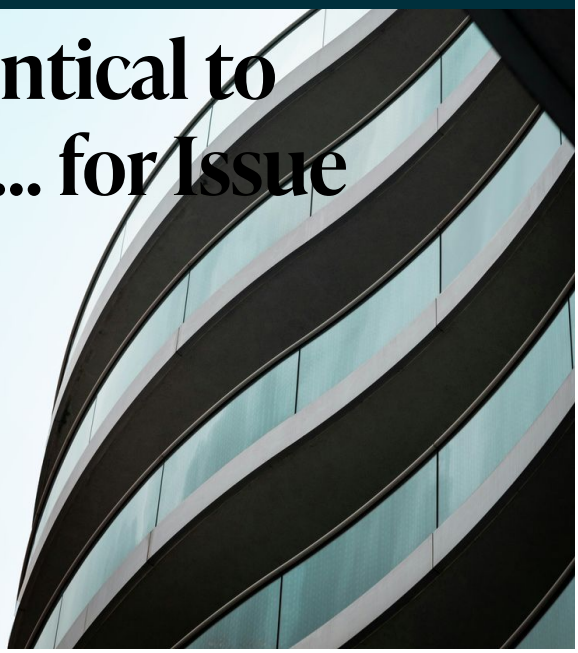
Literal Infringement Is Identical to Infringement Under DOE ... for Issue Preclusion



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By: Ramya Auroprem

On August 28, 2024, the Federal Circuit issued a precedential decision regarding issue preclusion in *Wisc. Alumni Research Found. v. Apple Inc.*, Nos. 2022-1884, 2022-1886. For issue preclusion to apply, "the issue actually litigated in the first action must be identical to the issue in the second action," *see* Op. at 26, but "the factors and tests [need not] be identical for issues to be identical." *See id.* at 27.

In the first case, the plaintiff had abandoned its theory of infringement under the doctrine of equivalents before trial and proceeded only on literal infringement. *See* Op. at 7 n.2. The Federal Circuit affirmed the district court's ruling that the plaintiff was precluded from retrying its claim for infringement under the doctrine of equivalents after an unsuccessful literal infringement claim. *See* Op. at 15 ("WARF was not foreclosed from raising the doctrine of equivalents at trial as an alternative to literal infringement").

In the second case, the plaintiff asserted the same patent against later generations of the accused product. The Federal Circuit upheld the district court's determination that issue preclusion barred the plaintiff from pursuing a doctrine of equivalents theory in the second case and that the *Kessler* doctrine barred the second case even though the accused next-generation products were made/sold before the final judgment of non-infringement in the first action. *See* Op. at 32-33 (prevailing non-infringer obtains the right to manufacture, use, and sell the accused product, which attaches to the product and "operates to grant a product

noninfringer status"). Claim preclusion, not the *Kessler* doctrine, is "temporally limited to acts occurring after final judgment was entered in the first suit." *See* Op. at 36 n.18.

Reasoning that both literal infringement and infringement under the doctrine of equivalents share the same statutory basis, 35 U.S.C. § 271(a), *see* Op. at 27-28, and that the doctrine of equivalents is limited to covering products or processes that are at most insubstantially different from what would literally infringe, *see id.* at 29 n.13, the Federal Circuit determined that the different products accused in the second litigation were "essentially the same" as the accused products in the first litigation and that "literal infringement and the doctrine of equivalents are the same issue for issue-preclusion purposes." *See* Op. at 22, 31.

> **The lengthy litigation history is scattered with strategic decisions that gave rise to the current appeal**
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