Federal Circuit Opts Not to Play its REVERSE [DOE] Card

Steuben Foods, Inc. v. Shibuya Hoppmann Corp., No. 23-1790 (Fed. Cir. 2025)

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On January 24, 2025, the Federal Circuit considered the "long mentioned but rarely applied" reverse doctrine of equivalents ("RDOE") defense. The widely accepted doctrine of equivalents ("DOE") allows plaintiffs to establish infringement when an accused element "matches the function, way, and result of the claimed element," even if it is not exactly the claimed element. RDOE, which can be traced back to the 1800s, is the opposite: a defense allowing an accused infringer to avoid a finding of infringement by showing its accused product "has been so far changed in principle [from the patented invention] that it performs the same or similar function in a substantially different way."[1] In other words, the RDOE provides a rebuttal to literal infringement. It has been questioned whether the RDOE survived the Patent Act of 1952, and to date, the Federal Circuit has not affirmed any decision finding noninfringement based on RDOE nor has it ruled that RDOE is not a valid defense.

In *Steuben Foods*, a jury found infringement of a patented invention for filling sterile food containers using a valve to stop and start food flow. It includes a first sterile region and "a second sterile region positioned proximate said first sterile region." Rather than the valve shaft moving into an unsterile location when closed, it moves into the second sterile region to prevent bringing contaminants into the first region. The accused system similarly provides sterility when the valve is both open and closed; however, it uses a flexible barrier mechanism. The District Court granted Shibuya's motion for judgment as a matter of law, holding that (1) no reasonable juror could have found literal infringement, (2) Shibuya made a prima facia case of RDOE, and (3) Steuben's expert witness's testimony was wrong as a matter of law and entitled to no weight.

On appeal, Steuben argued that the 1952 Patent Act eliminated RDOE. Section 271(a) provides exceptions to infringement, and Steuben asserted that the language "[e]xcept as otherwise provided in this title" requires RDOE to be expressly enumerated in the statute. Steuben further contended that invalidation under § 112, not noninfringement under RDOE, provides the recourse for a claim alleged to be too broad. Shibuya countered that the Supreme Court has held that the 1952 Patent Act "left intact the entire body of case law on direct infringement," and that the Supreme Court rejected Steuben's argument when it held that the 1952 Patent Act "is not materially different from the 1870 Act with regard to claiming."

The Federal Circuit found Steuben's arguments compelling—and noted that it has never affirmed a decision finding noninfringement under RDOE—but held that it need not decide whether RDOE is still a viable defense under the 1952 Patent Act. Rather, the Federal Circuit faulted the District Court for failing to consider expert testimony. When viewing the evidence in the light most favorable to Steuben, the Federal Circuit held that "a reasonable jury could have found the principles of operation of the accused product…were not 'so far changed,' as to support a theory of noninfringement under RDOE" and reversed the District Court's grant of judgment as a matter of law. The Federal Circuit declined to expressly affirm or denounce the availability of the RDOE defense and leaves the future for RDOE uncertain. However, one thing is clear: RDOE is not dead. Yet.

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[1] *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1124 (Fed. Cir. 1985).