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Use of "Antithesis" of Claim Element Does Not Bar Application of Doctrine of Equivalents

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In a ***Hatch-Waxman* case**, the U.S. Court of Appeals for the Federal Circuit found that the use of a claimed step, characterized as the "*antithesis*" of a limitation in the asserted claim, nonetheless satisfied that limitation under the doctrine of equivalents. ***Cadence Pharms. Inc. v. Exela Pharma Sciences LLC***, Case No. 14-1184 (Fed. Cir., Mar. 23, 2015) (Linn, J.).

Plaintiff Cadence accused Exela's generic injectable acetaminophen product of infringing two patents. The relevant claim limitation of one of the patents recited a method for preparing an aqueous solution containing acetaminophen by adding an inert gas until the oxygen concentration was below two parts per million. In the Cadence process, acetaminophen was added and then the oxygen was removed from the solution. In Exela's process, oxygen was removed from the solution and then acetaminophen was added. The district court construed the claim as requiring that the acetaminophen must already be dissolved prior to deoxygenation of the solution. Nevertheless, after a bench trial, the district court found that the two methods were insubstantially different and that Exela's product therefore *infringed the claim under the doctrine of equivalents.*

On appeal, the Federal Circuit panel affirmed the district court in full, rejecting Exela's argument that its method was the "antithesis" of what was claimed in the patent and therefore that the finding of infringement under the doctrine of equivalents vitiated the claim limitation. The Court found that the determination of whether a proposed equivalent "vitiated" or was the "antithesis" of a claimed element required an analysis of whether the proposed equivalent was insubstantially different, rather than a substitute for such an analysis. Because the Federal Circuit concluded that the district court could reasonably have concluded Exela's process was insubstantially different from the claimed method, it rejected "the argument that a claim limitation is vitiated by the doctrine of equivalents [as] both incorrect and inapt."

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