THE POST-*FESTO* WORLD OF EQUIVALENTS

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ABSTRACT

The Supreme Court again began to delve into substantial patent issues by addressing the interplay between prosecution history estoppel and the doctrine of equivalents. An analysis of the opinions in the Federal Circuit’s en banc ruling, together with the Supreme Court’s own decision may help to clarify some of the unanswered questions still lingering regarding what equivalents are available and when. The prosecution history will take a more prominent place in the minds of both patent prosecutors and litigators as courts attempt to determine the appropriate relationship between prosecution history estoppel and the doctrine of equivalents.

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THE POST-\textit{FESTO}WORLD OF EQUIVALENTS \textsuperscript{*}

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I. OVERVIEW

On May 28, 2002, the Supreme Court in their significant \textit{Festo} decision (\textit{Festo I})\textsuperscript{1} gave a positive boost to the patent system through the unanimous reversal of the highly controversial Federal Circuit 2000 en banc decision.\textsuperscript{2} Yet, exactly one week later, \textit{Festo} was immediately overshadowed by the radical Supreme Court “\textit{Vornado Tornado};” the \textit{Vornado} decision put an end to exclusive appellate jurisdiction for patent appeals.\textsuperscript{3}

In terms of a positive message to the Wall Street community, \textit{Festo} may be the single most important patent case in the more than twenty years since the Supreme Court delivered the message of patent-eligibility for “living” inventions in the \textit{Chakrabarty} case.\textsuperscript{4} Both \textit{Festo} and \textit{Chakrabarty} sent strong signals to high technology investors that the Supreme Court is “pro-patent.” This is despite the fact that the underlying legal effect may have been relatively minor, as in \textit{Chakrabarty}\textsuperscript{5} or, as in the case of \textit{Festo II}, have a drastic effect on the practice of patent law. \textit{Festo II} is truly revolutionary, a “first” for the Supreme Court. The case may be the first time in history that \textit{any} Court of Appeals that had found noninfringement was

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\textsuperscript{1} \textit{Festo Corp. v. Shoketsu Kinzoku Kabushiki Co., Ltd.}, 535 U.S. 722 (May 28, 2002).
\textsuperscript{2} \textit{Festo Corp. v. Shoketsu Kinzoku Kabushiki Co., Ltd.}, 234 F.3d 558, 569 (Fed. Cir. 2000) (en banc).
\textsuperscript{3} \textit{Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.}, 535 U.S. 826 (2002).
\textsuperscript{5} \textit{Chakrabarty} merely confirmed the patent-eligibility under 35 U.S.C. § 101 of “living” inventions. However, most biotechnology inventions of commercial import that are claimed as patentable inventions either are not claimed in terms of a “living” cell or fragment, and those inventions that are capable of being claimed in that manner can also be claimed as a method— independent of the \textit{Chakrabarty} ruling. The pre-\textit{Chakrabarty} controversy was to find an alternative claim form to method claims for the “living” inventions. For a pre-\textit{Chakrabarty} perspective, see Harold C. Wegner, \textit{Patenting Nature’s Secrets — Microorganisms}, 7 INT'L REV. INDUS. PROP. & COPYRIGHT L. 235 (1976); Harold C. Wegner, \textit{Patent Protection for Novel Microorganisms Useful for the Preparation of Known Products}, 5 INT'L REV. INDUS. PROP. & COPYRIGHT L. 285 (1974).
reversed by the Supreme Court because of a patentee's failure to establish applicability of the doctrine of equivalents. Overall though, *Festo* confirms the status quo for most of the en banc Federal Circuit views and crafts a new test for others; albeit, a test that will be difficult for patentees to apply to avoid prosecution history estoppel.

This paper considers the practical, day-to-day impact of *Festo II*, beginning with the first of the two issues accepted for review by the Court. The first issue reviewed by the Supreme Court was whether the narrowing of a claim for any reason creates prosecution history estoppel. See § II, Narrowing for any Reason Creates Estoppel. A troublesome point for applicants who have not narrowed their claims, but who may nevertheless be subject to prosecution history estoppel was not before the Court: will even a broadening amendment possibly subject the applicant to prosecution history estoppel if there is an argument that a particular feature establishes patentability? See § III, Argument Alone Creates an Estoppel.

The second and more hotly debated issue before the Supreme Court was whether the Federal Circuit's "absolute bar" against any equivalents in the wake of an estoppel should stand. The reversal by the Supreme Court opens the door to an equivalents finding in only a small minority of situations. It may be a legal victory for Festo in the sense of a reversal and remand with a chance to fight another day; however, the decision slams the door shut on the familiar practice of narrowing claims with the hope of recapturing trivial yet known equivalents through the previous flexible bar approach. See § IV, Flexible (Versus Absolute) Bar.

Not addressed by the Supreme Court and left open for decision by regional circuits after *Vornado* is the issue of whether there remains any room left for a finding of equivalence by the blatant copyist who appropriates the most trivial variation of a claimed invention. See § V, Whither the Colorable Copyist. Loose ends concerning the *Festo II* decision have resulted in the Federal Circuit again issuing an order for en banc reargument. See § VI, "Festo II": The Saga Continues.

After deciding a patent case the magnitude of *Festo*, one would have thought that the Supreme Court's involvement in patent law was at an end for the near term. However, that is clearly not the case. The Supreme Court has signaled a clear intention to stay actively involved in its supervisory role for patents, even reopening the door to regional circuit decisions on patent cases that will undoubtedly create inter-circuit conflicts of law, and will clearly lead to a greater number of cases being accepted by the Supreme Court for review. See § VII, Avoiding Dicta in the Other Circuits.

While American practitioners have grown up with prosecution history estoppel as the norm, a comparative view of Japanese patent law shows that there are other valid approaches. See § VIII, A Comparative View of Prosecution History Estoppel. Statutory and regulatory reforms are clearly needed to clean up the reliance on

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6 A Supreme Court reversal of a trial court before the Evarts Act may be found as recently as the Morley Sewing Machine case. *Morley Sewing Mach. Co. v. Lancaster*, 129 U.S. 263 (1889). Several cases in the past century have affirmed a Court of Appeals finding of equivalents, but this may be the first to reverse a finding of noninfringement under the doctrine of equivalents.


8 *Id.*


prosecution histories, which often run several inches thick and are undecipherable to all but the most skilled patent lawyer. See § IX, Statutory Reform to Eliminate Prosecution History Estoppel.

II. NARROWING FOR ANY REASON CREATES ESTOPPEL

A. The Message from the Supreme Court

The issue creating the most controversy within the patent bar is the Court’s affirmation of the view that essentially any narrowing amendment of a claim may create prosecution history estoppel. This includes any amendments made to overcome or avoid a rejection based upon 35 U.S.C. § 112, ¶ 1 (2000). This even includes the case where a foreign language applicant provides a sloppy translation and where “[t]he PTO might require the applicant ... to improve the translation of a foreign word....”11 Obviously, the message is to clear up the translation before filing.

The Federal Circuit voted 11-1 for this new rule.12 This overwhelming majority, coupled with the endorsement of this view by the Solicitor General, clearly demonstrated the likelihood of affirmance of this holding by the Supreme Court. The Supreme Court explained its ruling by stating, “[w]e agree with the [Federal Circuit] that a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel.”13 Furthermore, the Supreme Court agreed with the Federal Circuit’s viewpoint that even an amendment made to deal with a § 112 rejection is basis for prosecution history estoppel.14 Under the rationale of the Supreme Court, it is wrong to dismiss a rejection as merely being “formal,” as many amicus curiae briefs suggested.15 According to the Supreme

11 Festo, 535 U.S. 736.
12 Id.
13 Festo, 236 F.3d 558.
14 Id at 736. The Supreme Court stated that:
As the [Federal Circuit Court] explained, a number of statutory requirements must be satisfied before a patent can issue. The claimed subject matter must be useful, novel, and not obvious. In addition, the patent application must describe, enable, and set forth the best mode of carrying out the invention. These latter requirements must be satisfied before issuance of the patent, for exclusive patent rights are given in exchange for disclosing the invention to the public. What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue. The patent also should not issue if the other requirements of § 112 are not satisfied, and an applicant’s failure to meet these requirements could lead to the issued patent being held invalid in later litigation. Id. at 1839-40 (internal citations omitted).
15 Id. The Supreme Court addressed the issue of “formality” type rejections, stating:
[Festo] contends that amendments made to comply with § 112 concern the form of the application and not the subject matter of the invention. The PTO might require the applicant to clarify an ambiguous term, to improve the translation of a foreign word, or to rewrite a dependent claim as an independent one. In those cases, [Festo] argues, the applicant has no intention of surrendering subject
Court's decision, the argument that the amendment is largely cosmetic in nature also fails if the scope of the claim is narrowed.\textsuperscript{16}

\textbf{B. The Enduring Rule from the Federal Circuit}

Since the Federal Circuit ruling on this issue was affirmed by the Supreme Court, further exploration of the issue by the Federal Circuit is likely to be based upon its own precedent, although the court is viewed by some of its members as ignoring its own precedent.\textsuperscript{17} Even though the Federal Circuit's majority opinion in

\textsuperscript{16} \textit{Id.} The Supreme Court explained that: 
\[\text{estoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope. If a § 112 amendment is truly cosmetic, then it would not narrow the patent's scope or raise an estoppel. On the other hand, if a § 112 amendment is necessary and narrows the patent's scope – even if only for the purpose of better description – estoppel may apply. A patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the broader subject matter, whether the amendment was made to avoid the prior art or to comply with § 112. We must regard the patentee as having conceded an inability to claim the broader subject matter or at least as having abandoned his right to appeal a rejection. In either case estoppel may apply.}\]

\textsuperscript{17} \textit{Id.} \textit{Festo,} 234 F.3d at 566 (J. Michel dissenting). The Federal Circuit explained that: 
\[\text{[f]or the purposes of determining whether an amendment gives rise to prosecution history estoppel, a "substantial reason related to patentability" is not limited to overcoming or avoiding prior art, but instead includes any reason which relates to the statutory requirements for a patent. Therefore, a narrowing amendment made for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element.} \]
\[\text{[T]here are a number of statutory requirements that must be satisfied before a valid patent can issue and that thus relate to patentability. In addition to satisfying the novelty and non-obviousness requirements of 35 U.S.C. §§ 102 and 103, the claims must be directed to patentable subject matter and the claimed invention must be useful, as set forth in 35 U.S.C. § 101 (1994). Additionally, the first paragraph of 35 U.S.C. § 112 requires that the patent specification describe, enable, and set forth the best mode of carrying out the invention, 35 U.S.C. § 112, ¶ 1 (1994), while the second paragraph of section 112 requires that the claims set forth the subject matter that the applicant regards as his invention and that the claims particularly point out and distinctly define the invention, 35 U.S.C. § 112, ¶ 2 (1994). The Patent Office will reject a patent application that fails to satisfy any one of these statutory requirements. And any one of these requirements may be a ground for invalidating an issued patent. An amendment related to any of these statutory requirements is an amendment made for "a substantial reason related to patentability."} \]
Festo I was clear on the on the affect of “formality” rejections and amendments related to patentability on prosecution history estoppel, the court did leave the door open for patentee’s to establish that an amendment was not for patentability purposes.18

III. ARGUMENT ALONE CREATES ESTOPPEL

Can there be prosecution history estoppel based upon arguments alone or where a non-narrowing amendment is made? This issue was not before the Supreme Court 19 but was considered by the Federal Circuit in their 2000 Festo decision. The Federal Circuit in dictum discusses “argument-based estoppel.” This was a topic without dispute among at least eleven judges, if not all twelve.20 The Federal Circuit confirmed the doctrine of prosecution history estoppel where there is an argument made to establish patentability, even if without any amendment, stating, “[a]rguments made voluntarily during prosecution may give rise to prosecution history estoppel if they evidence a surrender of subject matter.”21

The functions of prosecution history estoppel cannot be fully satisfied if substantial reasons related to patentability are limited to a narrow subset of patentability issues. Rather, substantial reasons related to patentability include 35 U.S.C. §§ 101 and 112 issues, as well as 35 U.S.C. §§ 102 and 103 issues. Id. at 566-67 (internal citations omitted).

18 Id. at 567. The Federal Circuit addressed what it perceived as an unanswered question: [w]hile we do not believe that the Supreme Court itself answered this question in Warner-Jenkinson, we do believe that our answer is not inconsistent with Warner-Jenkinson. Warner-Jenkinson describes prior cases as applying prosecution history estoppel “typically because what [was previously claimed] ... was encompassed within the prior art,” but no language in Warner-Jenkinson limits prosecution history estoppel to amendments made to avoid prior art. Moreover, our approach is consistent with Warner-Jenkinson’s requirement that an amendment “does not necessarily preclude infringement by equivalents of that element.” Thus, if a patent holder can show from the prosecution history that a claim amendment was not motivated by patentability concerns, the amendment will not give rise to prosecution history estoppel. Id. at 567-68 (emphasis added) (internal citations omitted).

19 The Supreme Court rarely chooses to decide an issue that has not been specifically raised by one of the parties dissatisfied with the ruling of the Court of Appeals. Rather, a losing party poses one or more questions as issues that the court is asked to consider. Generally, if the court accepts the review (by an affirmative vote of at least four of the nine members of the Court), it will accept all or some of the questions raised by a losing party. Here, the issue of estoppel by argument was only dictum at the Federal Circuit – unnecessary for its decision – and it was not raised as one of the petitioner’s questions for review.

20 Id. at 569.

21 Id. The court follows this sentence with the following citation to and explanation of cases: E.g., KCJ Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351, 1359-60, 55 U.S.P.Q.2d 1835, 1841-42 (Fed.Cir.2000) (concluding that ‘KCJ’s statements during prosecution reflect a clear and unmistakable surrender of subject matter that cannot be reclaimed through the doctrine of equivalents’); Bayer AG v. Elan Pharm. Research Corp., 212 F.3d 1241, 1252-53, 54 U.S.P.Q.2d 1711, 1719 (Fed.Cir.2000) (finding that ‘through [Bayer’s] statements to the PTO and the declarations it filed, Bayer made statements of clear and unmistakable surrender

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Thus, it is not sufficient to determine whether there is a narrowing of a limitation to invoke prosecution history estoppel. When an argument to establish patentability based upon the particular limitation in question and an amendment that merely clarifies or even broadens a claim limitation are made, then the applicant is in no better position than if he had made an amendment narrowing a claim.

IV. FLEXIBLE (VERSUS ABSOLUTE) BAR

Festo’s apparent victory is the reversal of the “absolute bar” of the Festo I opinion and the reinstatement of the previous “flexible bar.” However, the Supreme Court did not reinstate the previous flexible bar as it was known before the Festo I ruling. Instead, the Supreme Court replaced it with a more draconian presumption of an absolute bar. As announced by the Supreme Court, this new presumption makes application of the flexible bar useless for all but a small number of situations. The Supreme Court decision is a pyrrhic victory for the practitioner toiling in the vineyards of patent prosecution who is forced to chop down the scope of protection of a generic claim to exclude known equivalents that were and still could have been claimed but for an unpatentability ruling by an Examiner.

Reversal of the “absolute bar” with reinstatement of the “flexible bar” is also to be seen as flowing from the hard-hitting dissent of Judge Michel in the en banc ruling of the Federal Circuit, which was joined by Judge Rader. Judge Michel pointedly explained the direct conflict with prior precedent regarding the use of a flexible bar approach to prosecution history estoppel. Additionally, the dissent of Judge Rader, which was joined by Judges Michel and Linn, was very important. They emphatically demonstrated the need for equivalents for after-arising technology. The Supreme Court’s result naturally flows from coupling these dissents with the test for a flexible bar advocated by the Solicitor General.

The Supreme Court accepts the premise that in some cases a flexible bar may exist. However, the default rule is that any narrowing creates an absolute bar as to

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Id. 22 Festo, 535 U.S. at 742.
23 Festo, 234 F.3d at 598.
21 Id. at 610
25 Id. at 620.
the limitation that has been narrowed.\textsuperscript{26} To benefit from a flexible bar, the burden rests upon the patentee to rebut the presumption of an absolute bar: though, even this option is only available in limited situations. This holding is set forth at the antepenultimate and penultimate paragraphs of the \textit{Festo} opinion.\textsuperscript{27}

Prosecution history estoppel is keyed to a narrowed element or limitation, and not to all aspects of the claim. Thus, the Supreme Court "hold[s] here that the patentee should bear the burden of showing that the amendment does not surrender the \textit{particular equivalent} in question."\textsuperscript{28} Furthermore, it is presumed that the bar is absolute as to all subject matter between the original claim scope and the final (narrowed) claim scope of the patent. The Supreme Court stated, "[a] patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim."\textsuperscript{29} The Supreme Court relied upon quotes from \textit{Exhibit Supply} to support its holding regarding this presumption.\textsuperscript{30}

If the presumption cannot be rebutted, then the bar is an absolute bar, i.e., the exact same result as sought by the appellee and consistent with the result of the Federal Circuit majority. The Court considers it fair to apply what amounts to an absolute bar in all but the exceptional cases it has enumerated: "[w]hen the patentee has chosen to narrow a claim, courts may presume the amended text was composed

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\textsuperscript{26} \textit{Festo}, 535 U.S. at 742

\textsuperscript{27} \textit{Festo}, 535 U.S. at 740. The Supreme Court explained its view of the "new" flexible bar. "We hold here that the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question.... The patentee, as the author of the claim language, may be expected to draft claims encompassing readily known equivalents. A patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence. This presumption is not, then, just the complete bar by another name. Rather, it reflects the fact that the interpretation of the patent must begin with its literal claims, and the prosecution history is relevant to construing those claims. When the patentee has chosen to narrow a claim, courts may presume the amended text was composed with awareness of this rule and that the territory surrendered is not an equivalent of the territory claimed. In those instances, however, the patentee still might rebut the presumption that estoppel bars a claim of equivalence. The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent."

\textit{Id.} at 740-41 (internal citation omitted).

\textsuperscript{28} \textit{Id.} (emphasis added).

\textsuperscript{29} \textit{Id.}

\textsuperscript{30} \textit{Exhibit Supply Co. v. Ace Patents Corp.}, 315 U.S. 126, 136-37 (1942) ("By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference.").
with awareness of this rule and that the territory surrendered is not an equivalent of the territory claimed.”

A. Three Situations Where the Bar is Rebuttable

A flexible bar exists “where the amendment cannot reasonably be viewed as surrendering a particular equivalent.” The Supreme Court gives three situations where the patentee may rebut the presumption. In any of these three situations “the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence.”

1. The Unforeseen Equivalent

The first situation where there is the possibility of equivalents is the case of the unforeseen equivalent. The unforeseen equivalent is keyed to the compelling argument raised in the dissenting opinion of Judge Rader, which argued that patentees should not be estopped from having their claims cover “after-arising” technology that could not have been anticipated during patent prosecution. Judge Rader dissented precisely based upon the issue of “after-arising” technology. Judge Rader stated:

A primary justification for the doctrine of equivalents is to accommodate after-arising technology. Without a doctrine of equivalents, any claim drafted in current technological terms could be easily circumvented after the advent of an advance in technology. A claim using the terms "anode" and "cathode" from tube technology would lack the "collectors" and "emitters" of transistor technology that emerged in 1948. Thus, without a doctrine of equivalents, infringers in 1949 would have unfettered license to appropriate all patented technology using the out-dated terms "cathode" and "anode". Fortunately, the doctrine of equivalents accommodates that unforeseeable dilemma for claim drafters. ....

By definition, applicants could not have surrendered something that did not even exist at the time of the claim amendment, namely after-arising technology.

Because after-arising technology was not in existence during the patent application process, the applicant could not have known of it, let alone surrendered it.

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31 Festo, 122 U.S. at 741.
32 Id. at 740.
33 Id. at 741.
34 Festo, 234 F.3d at 619-21 (Rader, J., dissenting).
35 Id.
36 Id.
2. “Tangential” Relationship

The second situation which may give rise to a finding of equivalents is where “the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question.”\(^{37}\) The Supreme Court declines to exclude unforeseeable equivalents.\(^{38}\) The opinion further states that there is no reason to exclude equivalents for “aspects of the invention that have only a peripheral relation to the reason the amendment was submitted.”\(^{39}\)

3. Difficulty Claiming the Equivalent

The third circumstance in which equivalents may be allowed is where “there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.”\(^ {40}\)

One area where a claim cannot be drafted to the full scope of patentability and a flexible bar is needed is when there is no “written description” to support a subgeneric range. For example, assume that claim 1 is to “[a] composition ... including from 10 to 90 mol. % Zarcondium” and claim 2 limits claim 1 to “the composition of claim 1 wherein the amount of Zarcondium is from 10 to 25 mol %.”

Assume that the patentee can prove that the entire range of 10 to 45 mol. % Zarcondium is patentable over newly discovered prior art showing Zarcondium at 90 mol. %. Here, claim 1 is clearly unpatentable because it reads directly on the prior art Zarcondium at 90 mol. %. The applicant would like to claim the range of 10 to 40 mol % Zarcondium, but cannot do so because of a lack of a written description for this range. So, the patentee resorts to the definition of claim 2 for literal protection of 10 to 25 mol %.

The first question is then: should a flexible bar give the patentee the right to equivalents in the range above 25 up to 40 mol. %? The second question is: if so, is it also necessary that the patentee explain the reason for the amendment not being coextensive with patentability, at the time of the amendment?

B. Manner of Rebutting the Presumption

To rebut the presumption that an amendment is related to patentability, “[t]he patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.”\(^ {41}\) After-arising technology, situation (1), and the case of the unsupported range, situation (3), appear to be relatively easy to understand, but will still require further guidance from the Federal Circuit in the coming years as it renders opinions that deal with these issues. It is ambiguous how

\(^ {37}\) Festo, 535 U.S. at 740-41
\(^ {38}\) Id.
\(^ {39}\) Id. at 738.
\(^ {40}\) Id. at 741
\(^ {41}\) Id.
an amendment made for a tangential reason, situation (2), can be dealt with under the test that "one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent."\textsuperscript{42}

V. WHITHER THE COLORABLE COPYIST

Completely lost in the shuffle and not an issue before the Court in this case was the question of whether under any circumstance a most trivial difference can avoid infringement where it does not fall under the objective test of Festo. Throughout the early years – starting with the trial court opinions of Justice Story – the "colorable" variation was a target of the judiciary.\textsuperscript{43} A colorable taking is one that is strictly keyed to equity.\textsuperscript{44}

Clearly, the Federal Circuit majority does not wish to consider the doctrine of equivalents to be an equitable doctrine that would permit such application of the "colorable" taking type-remedy. This can be seen from the Festo I case itself, where Circuit Judge Plager\textsuperscript{45} makes a strong argument for dealing with the doctrine of equivalents through its limitations as an equitable doctrine.\textsuperscript{46} In other words, if a copyist in the most extreme case made the most trivial variation from the claimed invention, is there room for the equitable doctrine of equivalents to permit a resolution in favor of the patentee?

Consider, for example, the routine case where there is the invention of a new acid, which is fully and properly claimed as such. Back in the deep recesses of the patent specification there is a single sentence at the end of "Example 493" that states that the acid of that particular example can be treated with ethanol to create the ethyl ester. Nothing is more obvious an equivalent than the ethyl ester of an acid. However, for whatever reason, the claim language does not provide a literal fit to encompass the ethyl ester. This is simply the routine mistake of even the very good patent draftsman, even in the highest and most sophisticated pharmaceutical concerns. Under \textit{dictum} from Johnson \& Johnston, the doctrine of equivalents would appear to be precluded.\textsuperscript{47} This obvious and clearly foreseeable equivalent would also be outside the test set forth by the Supreme Court's Festo case.

The question thus remains: is there room remaining for the equitable doctrine of equivalents? In view of prior decisions of the Federal Circuit, this would not appear possible. To the extent that a regional circuit or the Supreme Court were to take a fresh look at the clear Supreme Court precedent that makes the doctrine one

\textsuperscript{42} Id.
\textsuperscript{43} Odiorne v. Winkley, 18 F. Cas. 581, 582 (C.C.D. Mass. 1814) (No. 10,432)(Story, J).
\textsuperscript{45} Judge Plager was considered one of the leading equity scholars for more than a generation during his academic career on the law faculties of the University of Illinois and Indiana University, the latter where he served with distinction for many years as the Dean.
\textsuperscript{46} Festo, 236 F.3d at 593.
of equity, this remains an open question. The opinions of Judges Plager\(^\text{48}\) and Linn\(^\text{49}\) in *Festo I* make it clear that there are equitable origins for the doctrine of

\(^{48}\) *Festo*, 234 F.3d at 593-94 (Plager, J., concurring). Judge Plager explains:

A better solution [than the majority's limitation on equivalents] would be to declare the doctrine of equivalents -- a judge-made rule in the first place -- to have its roots firmly in equity, and to acknowledge that when and in what circumstances it applies is a question of equitable law, a question for which judges bear responsibility. We have admitted to these roots in a number of cases.

Were this court to openly acknowledge that the doctrine of equivalents can only be legitimated by its equitable roots and should be treated as an equitable doctrine, important consequences would flow. Trial courts, sitting as courts of equity, would be responsible for deciding whether the doctrine of equivalents should be applied, not unlike the practice regarding the doctrine of inequitable conduct. On appeal to this court, we would review a trial court's determination under the deferential standard of abuse of discretion.

By contrast, the notion of "insubstantial differences" between a particular claim and a particular product, viewed as the governing principle, can never be anything other than an ad hoc judgment, dependent on the eye of the beholder in the individual case. Though we talk about considering factors such as the role of copying, interchangeability of elements, and so on, the reality is that, as our cases since *Hilton Davis* demonstrate, the decision on equivalents remains essentially a subjective call, with repetition of verbal formulae but without transferability from case to case of practical guidance. This to me is the antithesis of the rule of law.

That infringement under the doctrine is a fact issue is of no moment; equity courts deal with facts all the time. In addition, a Supreme Court that did not balk at making the most critical aspect of infringement law--claim construction--a matter for judges alone, may, when pressed, find it appropriate to acknowledge the equitable nature of the doctrine of equivalents and the reasons why judges have a comparative advantage in equitable adjudication.

\(^{49}\) 234 F.3d at 622-24 (Linn, J., dissenting). Judge Linn explains the equitable origins:

In my opinion, the majority's new bright line rule eliminating all flexibility in the scope of claim limitations amended for a statutory purpose reflects an unjustified faith in the draftsman to select language to perfectly describe a new and unobvious invention at an early stage of the development process. The same limitations of language noted in selecting words to describe an invention in the first instance are no less present in selecting words to avoid an examiner's rejection of that original language for one statutory reason or another.

Furthermore, the majority's new rule will substantially increase the cost of obtaining patent protection, and may in fact become prohibitively high for individual inventors and start-up companies. It will require applicants to undertake exhaustive pre-filing searches, which will not only be costly but also time consuming. It will also require applicants to file in an original application numerous "narrow" claims or, if "broad" claims are sought, to be prepared to argue to the patent examiner, to the board of appeals, and to this court the
equivalents and there is nothing to preclude the Supreme Court from eventually following its earlier precedents in this matter.

VI. "FESTO III": THE SAGA CONTINUES

On February 6, 2003, the Federal Circuit was to have heard oral argument en banc in Festo once again – based upon its order for post-Supreme Court further briefing of the case.\(^{50}\) The focus is on a clarification of the flexible bar. The court quotes from the Supreme Court opinion:

> A patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence.... The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.\(^{51}\)

\(^{50}\) The order is reported at 304 F.3d 1289, 1290 Fed.Cir. 2002 (en banc). This paper was prepared before February 6, 2003, and therefore does not consider the proceedings before the court on that day.

\(^{51}\) Festo 304 F.3d at 1290-91 (quoting Festo, 535 U.S. at 740 (citation omitted)). Based upon the uncertainties seen from the Supreme Court opinion, the Federal Circuit thereupon issued an order to the parties and an invitation to the bar and the public to consider the following issues:

1. Whether rebuttal of the presumption of surrender, including issues of foreseeability, tangentialness, or reasonable expectations of those skilled in the
Unprecedented numbers of amicus curiae briefs were filed in response to the invitation to the public. A considerable number of the amici expressed a concern that there should not be general guidance given in an opinion that is unnecessary to the factual predicates of the case. It could be said that it was improvident to have further considered the case en banc – after all, the court could simply have remanded the case back to the trial court and then permitted the various issues it raised in its order to percolate upward on a case by case basis back to the Federal Circuit.

There has been no sign that the current majority of the court intends to retreat from its strict view of claim construction manifested by its opinion Festo I. Indeed, in 2002, shortly before the Supreme Court decision in Festo II, the Federal Circuit upstaged the Supreme Court decision in its en banc pronouncement in Johnson & Johnston where the court further limited the doctrine of equivalents. 52

VII. AVOIDING DICTA IN OTHER CIRCUITS

It is clear that before the advent of the Federal Circuit, there were regional circuits that would apply the doctrine of equivalents in equitable situations where the Federal Circuit – given the exact same scenarios – would not do so. Only some of these scenarios are precluded from review by the Supreme Court in its Festo II ruling.

For the remainder of these situations, the Supreme Court has opened the forum shopping door to regional circuit consideration of patent issues: If a patent infringement claim is brought through a counterclaim – where the original complaint lacks a patent claim – then the regional circuit has appellate jurisdiction (as explained in § A). 53 Then, it is a matter of arguing the good law of the regional circuit – now some twenty or more years old – that is controlling and better than the rule devised by the Federal Circuit in its Festo opinion.

art, is a question of law or one of fact; and what role a jury should play in determining whether a patent owner can rebut the presumption.

2. What factors are encompassed by the criteria set forth by the Supreme Court.

3. If a rebuttal determination requires factual findings, then whether, in this case, remand to the district court is necessary to determine whether Festo can rebut the presumption that any narrowing amendment surrendered the equivalent now asserted, or whether the record as it now stands is sufficient to make those determinations.

4. If remand to the district court is not necessary, then whether Festo can rebut the presumption that any narrowing amendment surrendered the equivalent now asserted.

Id.

52 Johnson & Johnston Assoc. Inc., 285 F.3d 1046. The case involved the deliberate failure to claim certain embodiments that are disclosed in a patent. Id. The case did not, however, implicate an estoppel in the sense of a narrowing amendment, but rather an estoppel for failure to claim a deliberately disclosed but unclaimed embodiment. Id. The Johnson & Johnston case involved the deliberate failure to claim certain subject matter. Id. The more difficult question arises where there is an inadvertent disclosure of an equivalent that is somehow not within the literal wording of the claims – even though it was the obvious intention of the patentee to have done so. Id.

A. Vornado: Regional Circuit Patent Law

The Federal Circuit denial of equity and its strict rules are not binding on other circuits which – for less than one full month – have renewed patent jurisdiction. The reopening of the door to regional circuit patent case law is a result of the June 3, 2002, Supreme Court decision in Vornado. \(^{54}\) Vornado overrules the en banc ruling of the Federal Circuit in Aerojet-General\(^{55}\) granting exclusive jurisdiction over patent case where the patent cause of action first entered via counterclaim.

In Vornado, the Supreme Court determined that if a well-pleaded complaint sufficient to vest jurisdiction in a federal court lacks a patent claim, then the appellate jurisdiction for that case is with the regional circuit. \(^{56}\) Even if there is a compulsory patent counterclaim brought into the case, the appeal in the case will go to the regional circuit. Where the original complaint does not state a patent claim but then the plaintiff's amended complaint states a patent claim, it is an open question whether the Federal Circuit law controls. In footnote 1, Justice Scalia says that the Vornado case “does not call upon [the Court] to decide whether the Federal Circuit's jurisdiction is fixed with reference to the complaint as initially filed or whether an actual or constructive amendment to the complaint raising a patent-law claim can provide the foundation for the Federal Circuit's jurisdiction.” \(^{57}\)

Justice Stevens in his special concurrence in Vornado noted the “countervailing interest in directing appeals in patent cases to the specialized court that was created, in part, to promote uniformity in the development of this area of the law.” \(^{58}\) He acknowledged, particularly as a result of the decision in Vornado, that “[n]ecessarily, therefore, other circuits will have some role to play in the development of [patent] law.” \(^{59}\) Yet, this was seen as a positive development with the court commenting that “[a]n occasional conflict in decisions may be useful in identifying questions that merit this Court's attention.” \(^{60}\)

B. REOPENING THE DOOR TO THE WISDOM OF THE EARLIER JURISTS

The Supreme Court in Festo was not called upon to rule on the equity issues raised in the Plager and Linn opinions. Yet, it is clear that the Federal Circuit will not accept these views. The question is now whether other circuit courts of appeal

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\(^{54}\) Id.

\(^{55}\) Aerojet-General Corp. v. Machine Tool Works, Oerlikon-Buehrle Ltd., 895 F.2d 736 (Fed. Cir. 1990) (en banc).

\(^{56}\) Id.

\(^{57}\) But, the Federal Circuit takes the view that an amended complaint is a part of the original complaint. Vink v. Schijff, 839 F.2d 676, 678 (Fed. Cir. 1988).


\(^{59}\) Id. at 839

\(^{60}\) Id. at 839. See generally, Rochelle Cooper Dreyfuss, The Federal Circuit: A Case Study in Specialized Courts, 64 N.Y.U.L. Rev. 1, 54 (1989) (“the Federal Circuit demonstrates a greater pro-patent bias than regional circuits.”). Justice Stevens welcomed the chance for inter-circuit conflicts to flush out areas for Supreme Court review: “[O]ccasional decisions by [the regional circuit] courts with broader jurisdiction will provide an antidote to the risk that the specialized court may develop an institutional bias.” Holmes Group, Inc., 535 U.S. at 839.
will do so. What happens where the most trivial change is found such as the case of the accidentally fully disclosed equivalent?

Consider the case where there is a patent to chemical compounds, per se, that are in the form of an organic acid. The claim is to a "compound of the formula" with a particular formula specified. In the patent specification at the last line of the example showing the manufacture of the compound, there is a one-line statement explaining that the compound may be converted into its alcohol ester. Assuming there is no prosecution history estoppel under *Festo II*, there is the clearest case of an equivalency imaginable. Under *dictum in Johnson & Johnston* that deals with a deliberately disclosed but not claimed equivalent, the Federal Circuit is likely to say that equivalents should not apply.

However, this is the most equitable situation for the application of the doctrine of equivalents imaginable. What would happen if a case of this nature were to go before the Second Circuit, where the law of the late Learned Hand expresses an equitable philosophy that the doctrine of equivalents should be applicable for every case?

In *Royal Typewriter Co. v. Remington Rand, Inc.*, Judge Hand noted the limitations of language and the occasional need to find infringement outside the confines of claim wording:

> [A] patent is like any other legal instrument: but it is peculiar in this, that after all aids to interpretation have been exhausted, and the scope of the claims has been enlarged as far as the words can be stretched, on proper occasions courts make them cover more than their meaning will bear. If they applied the law with inexorable rigidity, they would never do this, but would remit the patentee to his remedy of re-issue, and that is exactly what they frequently do. Not always, however, for at times they resort to the 'doctrine of equivalents' to temper unsparing logic and prevent an infringer from stealing the benefit of the invention. No doubt, this is, strictly speaking, an anomaly: but it is one which courts have frankly faced and accepted almost from the beginning.

Hand noted that for every case, consideration had to be given to whether it was necessary to stretch the wording of the claim to "reach a just result." A year later, he explained that "the doctrine of equivalents ... was devised to eke out verbal insufficiencies of claims ... ."

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61 Royal Typewriter Co. v. Remington Rand, Inc., 168 F.2d 691, 692 (2d Cir. 1948) (L. Hand, J.) (footnote omitted)

62 *Id.*

63 *Id.* (“All patents are entitled to its benefit to an extent, measured on the one hand by their contribution to the art, and on the other by the degree to which it is necessary to depart from the meaning to reach a just result”) (emphasis added).

64 Philip A. Hunt Co. v. Mallinckrodt Chem. Works, 177 F.2d 583, 585 (2nd Cir. 1949) (L. Hand, J.)

If the claims were limited to the 'concise and exact terms' in which the specification] ordinarily describe[s] a single example of the invention, few, if any, patents, would have value, for there are generally many variants well-known to the art, which will at once suggest themselves as practicable substitutes for the
Five years before the advent of the Federal Circuit, in one of its last cases to deal with the subject, the Seventh Circuit followed the equitable reasoning of the Supreme Court: "Of course, the fact that verbally the infringing process is not within the claim is no objection to the application of the doctrine of equivalents; indeed it creates the very occasion which should evoke it."\textsuperscript{65} The equitable nature of the doctrine jumps from the page.

Courts have ... recognized that to 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. Such a limitation would leave room for indeed encourage the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim .... One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy ...

The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of Winans v. Denmead, it has been consistently applied by this Court and the lower federal courts, and continues today ready and available for utilization when the proper circumstances for its application arise. 'To temper unsparing logic and prevent an infringer from stealing the benefit of an invention' a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.'\textsuperscript{66}

VIII. A COMPARATIVE VIEW OF PROSECUTION HISTORY ESTOPPELS

While the United States has its own unique doctrine of prosecution history estoppel, this is not a universal practice. Professor Thomas points out that various other countries do not admit introduction of the prosecution history into evidence in an infringement trial.\textsuperscript{67}

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\textsuperscript{67} John R. Thomas, On Preparatory Texts and Proprietary Technologies: The Place of Prosecution Histories in Patent Claim Interpretation, 47 UCLA L. REV. 183, 215-16 (1999) (footnotes omitted) ("Foreign patent regimes have often held that ... prosecution history is inadmissible as evidence of the meaning of a claim as ultimately agreed. In particular,
Japan is one country that has a doctrine of prosecution history estoppel, which was confirmed in the leading case from the Japanese Supreme Court, the *Tsubakimoto* case.\(^{68}\) There, the Japanese Supreme Court fashioned a test for equivalents which expressly takes into account prosecution history estoppel: "even if there are elements [of the claimed invention] that differ from the [accused embodiment], the [accused embodiment] may be equivalent ... if ... (5) there is not any special circumstances such that the [accused embodiment is] intentionally excluded from the scope of the claim during patent prosecution."\(^{69}\) Later in the same opinion, the Court states that when a patentee excludes during patent prosecution an embodiment or equivalent from the technical scope of a patented invention by intentionally excluding it from the claim language, the patentee cannot substantially make assertions that would contradict this exclusion since such a contradiction would not be permitted in view of the law of prosecution estoppel.\(^{70}\)

In terms of prosecution history estoppel the Japanese Supreme Court has yet to rule on whether a formal amendment should create a bar. However, in the Osaka High Court - where an equivalents finding was sustained - there had been narrowing amendments due solely to formal matters.\(^{71}\) The case was not, however, appealed to the Supreme Court. Additionally, the Japanese test for equivalents is also quite strict but distinctly different from *Festo II*. Strikingly different from *Festo II* is the exclusion of equivalents of an element that is "essential" to the patented invention.\(^{72}\) Furthermore, it is questionable whether an unforeseen element could be an equivalent.\(^{73}\)

**IX. STATUTORY REFORM TO ELIMINATE PROSECUTION HISTORY ESTOPPELS**

Perhaps there is a better way to deal with limitations on the doctrine of equivalents than prosecution history estoppel. Two reforms deserve consideration. Following the lead of Circuit Judges Plager and Linn, reliance on a relatively narrow doctrine of equivalents determined by a judge – not a jury – makes more sense when limited to the rare situations where equity demands a finding of equivalence.

Some reliance must be possible based upon the events at the PTO, but is prosecution history estoppel, with its endless file inspections, really an optimum way to operate? Perhaps it is time to heed the advice of Professor John R. Thomas:

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\(^{68}\) Tsubakimoto Seiko Co., Ltd. v. THK K.K., Case No. 1994 (o) 1083, (Japanese Supreme Court 1998), available at [http://www.sofic.or.jp/en/cases/Tsubakimoto_v_THK.html](http://www.sofic.or.jp/en/cases/Tsubakimoto_v_THK.html). This case is sometimes referred to as the "Ball Spline Bearing Case."

\(^{69}\) Id.

\(^{70}\) Id.

\(^{71}\) Id.

\(^{72}\) Test (1) for an equivalent is that "the differing elements are not the essential elements in the patented invention..." Id.

\(^{73}\) Test (3) is that "a person of ordinary skill in the art to which the invention pertains ... could have easily achieved the [accused embodiment]." Id.
The patent community should take the bold steps necessary to abandon the use of the prosecution history as a tool of claim interpretation. There is much to gain by eliminating the tedious inquiry into the chronicle of Patent Office interchange on the occasion of each claim interpretation. Our attention is more properly focused upon the text of the patent instrument, not on preparatory documents of uncertain relation to the proprietary right ultimately granted. 74

In an era of facile creation of websites, is it not time to abbreviate the patent instrument and strip out everything other than the claims and corresponding definitional and enabling disclosure? The rest of what is important can surely be saved in electronic form as part of the electronic prosecution history of the future. 75 Clearly, it is an imposition on the public to track down gargantuan prosecution histories that, for many of the world’s readers, are in a foreign language. Must one hire a someone to copy file wrappers to obtain the raw data to hunt and peck for a valuable estoppel? 76 While a microscopic snippet of a quotation from the prosecution history will appear in litigation, it is just that only a minute fraction of the overall picture. 77

X. CONCLUSION

Reliance upon the doctrine of equivalents is a prospectively dangerous strategy. The case-by-case determination of an equivalents theory in an ongoing patent litigation represents a difficult challenge for a patentee. Downstream reform of the patent


75 The entire “Background of the Invention” section has no meaning to inventors seeking to find new technologies. Cutting out the patent verbiage would only help to focus the reader’s attention on whatever kernels of technological wisdom there may be in the patent disclosure. It also makes no sense to bury the claims at the end of the patent document and then to have the twice redundant generic disclosures that are found at the “Summary of the Invention” and the “Abstract of the Disclosure.” These sections should be eliminated in their entirety, while the claims should be moved to the first page of the patent where they belong as the most important part of the patent document.

The Examiner’s first action on the merits should be entirely rethought. Instead of a detailed and often formalistic first action, the initial action should be a form much like that used by the European Patent Office and the Patent Cooperation Treaty that simply lists the names of the prior art references, pinpoints the exact page and line numbers considered important. Instead of characterizing the prior art, the first action should simply use the “X” and “Y” designations of pertinence that has worked so well in the EPO and PCT examinations.

The prosecution process should be greatly reduced and maintained electronically so as to be linked to the patent document itself.

76 See Thomas, supra note 74 at 186-87 (“[A]lthough the courts have identified prosecution histories as a core source of the meaning of patent claims, they remain physically distinct from the patent instrument and applicable only to the extent litigants wish to place these public records before a court.”).

77 See id. at 190 (footnote omitted) (“Prosecution histories can be lengthy by any standard, for often many years pass before the Patent Office allows a patent to issue. Unlike the more tightly drafted patent instrument, prosecution histories are not designed for ready parsing by a stranger to the transaction”).
system should include a careful rethinking of the nature, content and purpose of the prosecution history.