

Keywords: prosecution history estoppel; doctrine of equivalents

General: Regarding prosecution history estoppel, the Supreme Court establishes a presumption that a narrowing amendment made for a reason related to patentability surrenders the entire territory between the original and amended claim limitations, and that this presumption may be rebutted under certain instances.

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Festo VIII)
535 U.S. 722, 62 U.S.P.Q.2d 1705 (2002)
Decided May 28, 2002

I. Facts

Plaintiff Festo (Festo) owns two patents, the Stoll (U.S. Patent No. 4,354,125) and Carroll (U.S. Patent No. 3,779,401) patents, related to magnetic rodless cylinders. During the prosecution history for these two patents, the claims were amended to require the use of two sealing rings that use 1-way seals. The claims of the Stoll patent were also amended to specify that the cylinder sleeve be made from a magnetizable material. Notably, the Stoll patent was also amended to remove claims rejected under 35 U.S.C. § 112 as written in an improper multiple dependent form.

After Festo began selling its products, respondent (SMC) entered the market with a similar device. SMC's cylinder was made from non-magnetic material and used one sealing ring with 2-way seals. While SMC's device does not literally infringe the Festo patents, Festo pleaded infringement under the doctrine of equivalents.

In defending against patent infringement, SMC responded that Festo is prevented from claiming the doctrine of equivalents because of prosecution history estoppel. More specifically, SMC claims the Stoll and Carroll patents were narrowed during the patent application process such that the doctrine of equivalents does not apply to any of the narrowed claims.

The case was brought before the United States District Court for the District of Massachusetts, where the court disagreed with SMC. Instead, the court found the Festo amendments were not made to avoid prior art and therefore the amendments could not give rise to estoppel.

Following several appeals, the case was eventually brought before the Federal Circuit en banc (Festo VI). The court in Festo VI reversed the district court and held that prosecution history estoppel prevents Festo from claiming the doctrine of equivalents. The court further held that estoppel arises from any amendment that narrows a claim, regardless of whether the amendment is done to comply with the Patent Act or to avoid prior art. The court also held that when estoppel applies, it acts as a complete bar against any claim of equivalence for the element that was amended. Under this rule, narrowed claims could only be used for protection against literal infringement.

Four judges dissented from the Federal Circuit's en banc decision to implement a complete bar approach to the doctrine of equivalents. The Supreme Court granted certiorari.

II. Issues

- A. What types of claim amendments can give rise to estoppel?
- B. Does estoppel bar all equivalents from infringing the amended claims?

III. Discussion

- A. The Supreme Court agreed with the Federal Circuit in that § 112 rejections can trigger prosecution history estoppel, if a narrowing amendment is needed to render a claim patentable. In fact, any amendment that narrows the scope of a claim to satisfy the requirements of the Patent Act can give rise to prosecution history estoppel. When entirely cosmetic amendments are made, however, they do not narrow the scope of a patent or raise the possibility of estoppel.
- B. No. The Supreme Court unanimously vacated the Federal Circuit's decision. The Court held that a court must specifically determine what range of subject matter is surrendered by a narrowed claim amendment. The patentee then bears the burden of showing that an amendment did not surrender a particular equivalent in question. In essence, a patentee can rebut the presumption that estoppel bars a claim of equivalence.

In arriving at this decision, the Court relied upon the holdings of *Warner-Jenkinson*. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 *See* (1997). *Warner-Jenkinson* introduces the presumption of estoppel: when narrowing claim amendments were made, the burden falls to the patentee to explain why the amendments were not for purposes of patentability. Otherwise, there is a presumption that the amendment was central to the USPTO's allowance of a claim and that prosecution history estoppel bars the application of the doctrine of equivalents as to the amendment element.

In certain circumstances, amendments cannot reasonably be viewed as surrendering a particular equivalent. These situations can include: (1) an unforeseeable equivalent at the time of invention; (2) the rationale underlying the amendment bears only a tangential relationship to the equivalent in question; and (3) other reasons why the patentee could not reasonably be expected to describe an equivalent. A patentee can rebut the presumption that estoppel bars a claim of equivalence by showing that "at the time of amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent."

IV. Conclusion

- A. Any narrowing claim amendment can give rise to prosecution history estoppel.
- B. Patentees can demonstrate that the narrowing of a claim did not surrender particular equivalents.