

PROSECUTION HISTORY
AND
THE DOCTRINE OF EQUIVALENTS

Festo v. SMC

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May 1, 2001

Festo v. SMC: The History

Suit was filed in 1988. Since then:

- Trial before a Special Master
- Trial before the District Court
- Appeal to the Federal Circuit
- Petition for certiorari to the Supreme Court
- Rehearing before the Federal Circuit (after the Supreme Court granted certiorari, vacated and remanded)
- Rehearing En Banc before the Federal Circuit
- A Second petition for Certiorari

Festo v. SMC

The Federal Circuit En Banc Rehearing Decided Two Cases:

1. The Court answered four of the five questions it had posed for the *en banc* hearing.
(Did not decide the “all elements” question)
2. The Court decided the actual case before it:
Found that SMC did not infringe Festo’s Stoll and Carroll Patents.

Festo v. SMC

- Two Patents In Suit
 - Stoll Patent
 - Carroll Patent
- Both are directed to magnetic rodless cylinders
 - A cylindrical tube
 - A piston in the tube
 - A sleeve surrounding the tube
 - Magnets in the sleeve couple with magnets carried by the piston so that moving the sleeve moves the piston, or visa versa.

Festo v. SMC: Stoll Patent

- Original independent claim required
 - “a driven assembly [a sleeve] which is slidable on the tubular part [the cylindrical tube]”
 - “a piston ... which has sealing means at each end”
- Original dependent claims added
 - “the sealing means of the piston comprise sealing rings and the piston is provided with sliding guide rings near the sealing rings” (claim 4, dependent on any of claims 1-3)
 - “the driven assembly is provided with a sleeve made of a magnetisable material” (claim 8, dependent on any preceding claim)

Festo v. SMC: Stoll Patent

- Rejection under §112
 - Par. 1 - “Exact method of operation unclear. Is device a true motor or magnetic clutch?”
 - Par. 2 - “Improperly Multiply Dependent”
- Festo amended to put the dependent claim limitations into a new independent claim:
 - Replaced “driven assembly” with “a cylindrical sleeve made of a magnetizable material and encircles said tube”
 - Replaced “sealing means at each end” with “plural guide ring means” and “sealing rings located axially outside the guide rings”

Festo v. SMC: Stoll Patent

- Two prior art German patents submitted with the amendment showed:
 - a sleeve of non-magnetizable material
 - a rodless cylinder with a single guiding/sealing ring at each end of the piston
- The remarks said that these two patents “are obviously clearly distinguishable over the subject matter now present....”

Festo v. SMC: Carroll Patent

- Original patent disclosed a piston with “sealing rings” at each end of the piston, but this was not included in the claims.
- During reexamination, Festo added “a pair of resilient sealing rings situated near opposite axial ends of the central mounting member [the piston] and engaging the cylinder to effect a fluid-tight seal therewith.”

Festo v. SMC: Carroll Patent

- The reexamination prior art included a prior German patent of Festo that had sealing rings
- The Remarks said that “the structure now set forth with particularity is not found in the art of record or in [the cited earlier Festo German patent].”
- The Examiner’s “Reasons for Allowance” were unrelated to sealing rings.

Festo v. SMC: Stoll Patent

- No literal infringement
 - The sleeve in the SMC device was not magnetizable
 - The SMC device had a guide ring at each end of the piston but had a sealing ring at only one end.
- The Jury found infringement under the doctrine of equivalents.

Festo v. SMC: Stoll Patent

En Banc, the Federal Circuit reversed:

- “To determine whether a claim amendment gives rise to prosecution history estoppel, we must first determine whether the amendment narrowed the literal scope of the claim.”
- “Because the amendment narrowed the literal scope of the claim, we must determine whether Festo has established that it was made for a reason unrelated to patentability.

Festo v. SMC: Stoll Patent

As to the sealing and guide rings

- “Even if the amendment that added the sealing ring element merely replaced the means-plus-function language..., the amendment had the effect of narrowing the claim.”
- “Festo has not established that the amendment ... was made for a reason unrelated to patentability.”
*** [An amendment made to satisfy [section 112] ... is made for a reason related to patentability.”
- “The amendment also appears to have been made to distinguish the prior art.”

Festo v. SMC: Stoll Patent

As to the “magnetizable material”

- “[T]he reason for the amendment ... is not evident from the prosecution history.”
- “Festo argued that the amendment was made to clarify the claim.” *** This assertion is inadequate to escape the Warner-Jenkinson presumption, however, because nothing in the prosecution history of the Stoll patent indicates that the magnetizable sleeve element was merely added for purposes of clarification unrelated to patentability concerns.”

Festo v. SMC: Carroll Patent

- No literal infringement: The SMC device had a sealing ring at only one end.
- District Court granted summary judgment of infringement under the doctrine of equivalents.

Festo v. SMC: Carroll Patent

En Banc, the Federal Circuit reversed:

“The prosecution history ... reveals that the amendment ... was motivated by at least one reason related to patentability: a desire to avoid the prior art. In the remarks ..., Carroll did argue that the combination of features recited in the claims, which includes the pair of sealing rings, distinguished the claims over the German patent.”

Festo En Banc Questions: What Creates An Estoppel?

- (Q1) For the purposes of determining whether an amendment to a claim creates prosecution history estoppel, is "a substantial reason related to patentability," *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997), limited to those amendments made to overcome prior art under § 102 and § 103, or does "patentability" mean any reason affecting the issuance of a patent?
- (Q2) Under *Warner-Jenkinson*, should a "voluntary" claim amendment--one not required by the examiner or made in response to a rejection by an examiner for a stated reason --create prosecution history estoppel?

Festo En Banc Answers: What Creates An Estoppel?

- (A1) “[A] substantial reason related to patentability” is not limited to overcoming prior art, but includes other reasons related to the statutory requirements for a patent. Therefore, an amendment that narrows the scope of a claim 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.” (11-1)
- (A2) “[V]oluntary’ claim amendments are treated the same as other claim amendments; therefore, any voluntary amendment that narrows the scope of a claim for a reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element.” (11-1)

Festo En Banc Questions: What is the Scope of Estoppel?

- (Q3) If a claim amendment creates prosecution history estoppel, under *Warner-Jenkinson* what range of equivalents, if any, is available under the doctrine of equivalents for the claim element so amended?
- (Q4) When "no explanation [for a claim amendment] is established," *Warner-Jenkinson*, 520 U.S. at 33, thus invoking the presumption of prosecution history estoppel under *Warner-Jenkinson*, what range of equivalents, if any, is available under the doctrine of equivalents for the claim element so amended?

Festo En Banc Answers: What is the Scope of Estoppel?

- (A3) “When a claim amendment creates prosecution history estoppel, no range of equivalents is available for the unamended claim element.”(8-4)
- (A4) “[U]nexplained’ amendments are not entitled to any range of equivalents.” (12-0)

Festo v. SMC

Festo's Petition for Certiorari

The Questions Presented

- (1) Whether any claim-narrowing amendment designed to comply with any provision of the Patent Act -- including those provisions not related to prior art -- automatically creates prosecution history estoppel regardless of the reason for the amendment.
- (2) Whether the finding of prosecution history estoppel completely bars the application of the doctrine of equivalents.

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Festo's Petition for Certiorari

The first certiorari question is directed to Federal Circuit Question 1. However, “designed to comply with any provision of the Patent Act” is:

- Slightly broader than Federal Circuit's Answer - “any reason related to the statutory requirement for a patent;” and
- Much broader than the Federal Circuit's actual holding: Festo made the two “sealing ring” amendments to avoid prior art (the German patents) and was unable to explain the third (the “magnetizable material”), and thus subject to the *Warner-Jenkinson* presumption.

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Festo's Petition for Certiorari

The second certiorari question is directed generally to Federal Circuit Question 3. However,

- Even Festo apparently concedes (Petition, pg 15) that *Warner-Jenkinson* held that no range of equivalents was available for an amendment (such as the “magnetizable material”) that was unexplained. (Question 4)

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Festo's Petition for Certiorari

WHAT WILL THE SUPREME COURT DO?

Festo v. SMC

Festo's Petition for Certiorari

- Will the Supreme Court decision be based on the Federal Circuit Questions (particularly 1 and 3), or on the actual holding?
- In *Warner-Jenkinson*, how much did the Court “leave ... to [the Federal Circuit's] sound judgment in this area of its special expertise”?
- What has the Supreme Court already decided?

Festo v. SMC

Already Decided?

A proposition:

1. Before *Warner-Jenkinson*: No range of equivalents is available with respect to a claim element that was narrowed to avoid the prior art. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1941)
2. *Warner-Jenkinson* simply addressed the question of what to do if the reason for the amendment was unclear. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997)

Exhibit Supply v. Ace Patents

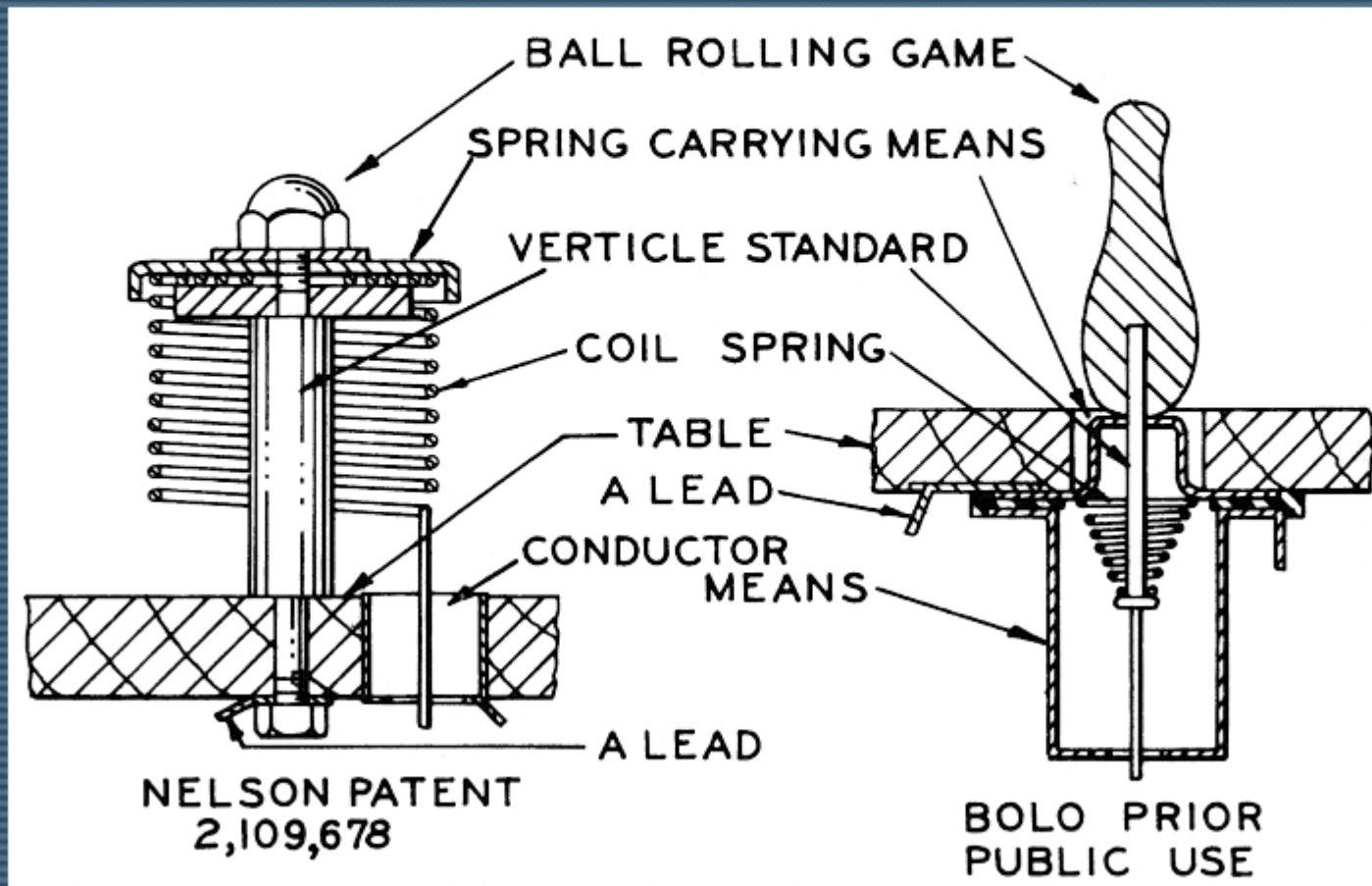


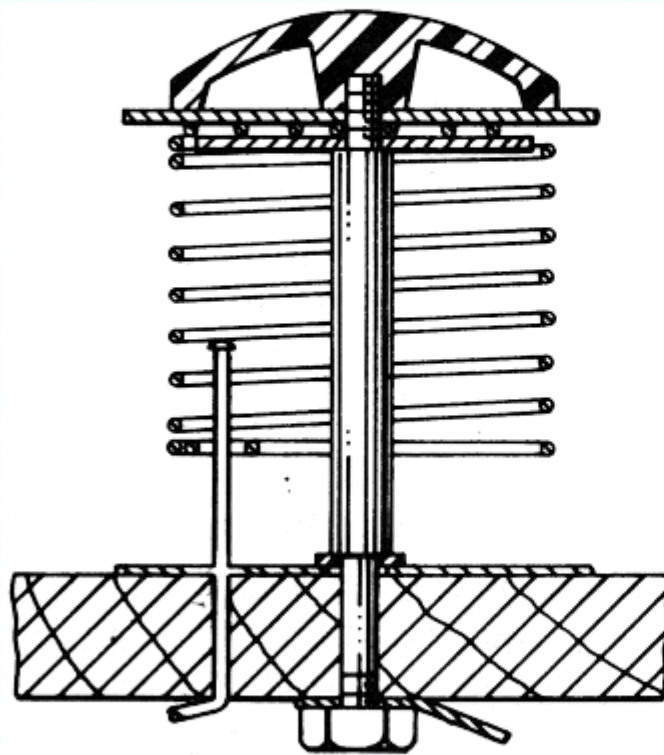
Exhibit Supply v. Ace Patents

- Original claims said that the conductor was “carried by the table”
- Claims were rejected as unpatentable
- Amended claims said that the conductor was “embedded in the table”

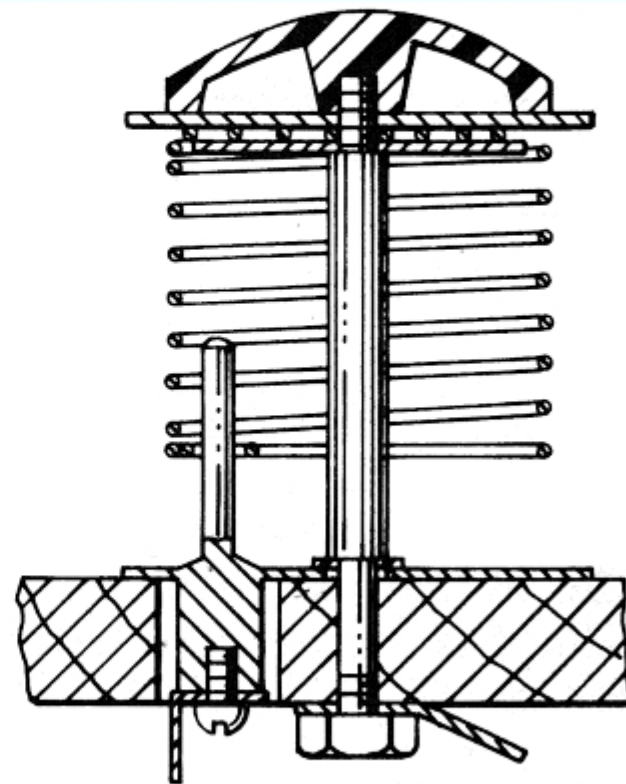
Exhibit Supply v. Ace Patents

The claim before amendment plainly read on plaintiff's Exhibits 5 and 7 in which the nail or pin conductor is driven into the table, since the nail or pin is a “conductor carried by the table” The claim, as amended and allowed as Claim 4, likewise reads on Plaintiff's Exhibits 5 and 7 if the nail or pin conductor which is driven into the table is “embedded in the table.”

Exhibit Supply v. Ace Patents



PL. EX. 5 - SUPR. CT. R. 51
HELD TO INFRINGE



PL. EX. 6 - SUPR. CT. R. 53
HELD NOT TO INFRINGE

Exhibit Supply v. Ace Patents

There remains the question whether respondent may rely upon the doctrine of equivalents ... Respondent concedes that the conductor means in the four devices are not literally “embedded in the table,” but insists that the changes in structure which they exhibit ... are but the mechanical equivalents of the “conductor means embedded in the table” called for by the amended claim....

Petitioners do not seriously urge that the conductor means in the four accused devices are not mechanical equivalents....

Exhibit Supply v. Ace Patents

Had claim 7 been allowed in its original form it would have read upon all the accused devices since in all conductor means ... are “carried by the table.” By striking that phrase and substituting for it “embedded in the table” *the applicant restricted his claim to those combinations in which the conductor, though carried on the table, is also embedded in it. By the amendment he recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference*

Exhibit Supply v. Ace Patents

- The difference which he thus disclaimed must be regarded as material, and since *the abandonment operates a disclaimer of that difference* it must be strictly construed against him. (citations omitted) *** It follows that *what the patentee, by a strict construction of the claim, has disclaimed – conductors which are carried by the table but not embedded in it – cannot now be regained by recourse to the doctrine of equivalents....*

Warner-Jenkinson v. Hilton Davis

Did the Court assume that an amendment to avoid prior art barred equivalents?

- “According to petitioner, any surrender of subject matter during patent prosecution ..., precludes recapturing any part of that subject matter” 520 U.S. at 30
- [P]etitioner reaches too far In each of our cases ... prosecution history estoppel was tied to amendments made to avoid the prior art” Id.

Warner-Jenkinson v. Hilton Davis

“Where the reason for the change was not related to avoiding the prior art, the change ... does not necessarily preclude infringement by equivalents of that element. [fn 7]”

“7. We do not suggest that, where a change is made to overcome an objection based on the prior art, a court is free to review the correctness of that objection when deciding whether to apply prosecution history estoppel.... What *is* permissible for a court to explore is the reason (right or wrong) for the objection and the manner in which the amendment addressed and avoided the objection”
520 U.S. at 33

Warner-Jenkinson v. Hilton Davis

What new did the Court decide:

1. All amendments do not create prosecution history estoppel.

“Our prior cases have consistently applied prosecution history estoppel only where claims have been amended for a limited set of reasons and we see no substantial cause for ... invoking an estoppel regardless of the reasons for a change.” 520 U.S. at 32

Warner-Jenkinson v. Hilton Davis

2. The reason for the amendment is open to explanation.

“We are left with the problem of what to do ... where the record seems not to reveal the reason for [the amendment].... [W]e think the better rule is to place the burden on the patent holder to establish the reason....The court then must decide whether the reason [for an amendment] is sufficient to overcome prosecution history estoppel as a bar to the doctrine of equivalents to the element added by that amendment.” 520 U.S. at 33

Warner-Jenkinson v. Hilton Davis

3. “Where no explanation is established, ... the court should presume that the PTO had a substantial reason related to patentability for including the limiting element added by amendment. In those circumstances, prosecution history would bar the application of the doctrine.” 520 U.S. at 33

Festo v. SMC:
What The Supreme Court Do?

Your guess is as good as mine.

My guess - it depends on:

- Which “case” the Court looks at.
- Whether the Court believes it has already decided that there is an absolute bar if an amendment is made to avoid the prior art.
- The extent to which the Court believes that this is a specialized issue for the Federal Circuit.