
New *Festo* Decision Focuses on Foreseeability of Equivalents

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In the long-running case of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, on remand from the U.S. Supreme Court, the Federal Circuit has issued yet another decision addressing the standard for determining when prosecution history estoppel prevents the application of the doctrine of equivalents to patent claims that have been narrowed during prosecution. The extent to which this most recent decision clarifies the standard, or marks the end of this fifteen-year-old case, remains to be seen.

Background

The doctrine of equivalents provides that a claim can be infringed even if an accused product or process does not literally meet every limitation of the claim, if the differences between the claimed subject matter and the accused product or process are insubstantial.

The *Festo* case poses the question of when the doctrine can be applied to a claim element that was narrowed during prosecution before the U.S. Patent and Trademark Office.

The Prior Supreme Court Decision

In 2002, the Supreme Court ruled that a narrowing amendment made for any reason related to patentability, not simply one made to avoid prior art, may give rise to an estoppel and the surrender of equivalents. The Supreme Court said that a patentee "may be expected to draft claims encompassing readily known equivalents;"

and that 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." However, the Supreme Court also recognized that there were circumstances in which an amendment might not reasonably be viewed as surrendering a particular equivalent: "The equivalent may have been unforeseeable at the time of the amendment; 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 have been expected to have described the equivalent in question." Thus, the Supreme Court held that a patentee "might rebut the presumption" that a narrowing amendment would bar equivalents, and that to do so, "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."

We discussed the Supreme Court's decision in our [May 30, 2002 IP Law Alert](#).

The Latest Decision

In its most recent decision, the Federal Circuit first decided that whether the presumption had been rebutted was a question for a court rather than a jury. It then turned to whether the presumption could be rebutted by Festo.

However, the Federal Circuit did not specifically address whether Festo could show that "at the time of the amendment one skilled in the art could not reasonably have been expected to have drafted a claim that literally encompassed the alleged equivalent." Rather, it said that the presumption could be overcome if the patentee could demonstrate that the any one of the three potential circumstances

identified by the Supreme Court - (1) unforeseeability of the equivalent, (2) tangential relation of the amendment to the equivalent, or (3) some "other" reason - was present.

The Federal Circuit found that *Festo* could not meet the second or third criteria. With respect to the first, "unforeseeability," the Federal Circuit remanded the case to the district court to hear evidence on whether the alleged equivalents would have been unforeseeable to one of ordinary skill in the art. To determine "unforeseeability," the Federal Circuit held that an objective inquiry was required, possibly including expert testimony and extrinsic evidence on the level of knowledge and skill in the art, and that the court should ask whether the alleged equivalent would have been unforeseeable to one of ordinary skill at the time the claim was amended. The court noted that later-developed technology usually would not be considered foreseeable, whereas old technology, while not always foreseeable, usually would be.

Conclusion

The latest *Festo* decision provides some guidance in applying the doctrine of equivalents to claims that have been amended during prosecution, particularly with regard to what is or is not "foreseeable," but questions remain.

In particular, what test is to be applied to determine whether the *Festo* presumption can be rebutted? Is it whether the patentee could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalents, or are there three separate tests - unforeseeability, tangential relation, and other reasons?

For patent applicants, the importance of carefully considering claim amendments remains significant. However, it will take future decisions to know whether, as stated in the concurring opinion, "an

applicant must now avoid amendments, file more and increasingly specific claims (at the risk of prolonging the backlogged prosecution process), resort to less precise functional claims to preserve a statutory equivalent, or perhaps even use continuation strategies to protect claim scope."

Michael Twomey

michael.twomey@haledorr.com

Irah Donner

irah.donner@haledorr.com