
The Reach of Prosecution History Estoppel

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Most discussion of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* has focused on the Federal Circuit's holding that, when prosecution history estoppel applies, it creates an absolute bar to application of the doctrine of equivalents. Even as the Festo case moves to the Supreme Court on appeal, the Federal Circuit in two recent decisions addressed its other critical holding in Festo – that prosecution history estoppel exists whenever a claim is narrowed for reasons related to patentability – and clarified whether a particular amendment is narrowing and to what claims prosecution history estoppel applies when only a single claim has been narrowed.

In *Bose Corp. v. JBL, Inc.*, the Federal Circuit confirmed that the addition of terms describing an already inherent characteristic is not a narrowing amendment under Festo and, therefore, does not trigger its equivalence bar. In Bose, a claim limitation stating that a boundary of a loudspeaker enclosure was “defined by an ellipse” was amended to add that the ellipse had “a major diameter.” Because those skilled in the art would understand that an ellipse inherently has a major diameter, the addition of that language did not narrow the claim and no estoppel applied.

On the other hand, in *Intermatic Inc. v. Lamson & Sessions Co.*, the Federal Circuit determined that an amendment narrowing a limitation in one claim bars application of the doctrine of equivalents for other claims containing the narrower limitation, even if the narrower limitation was present in the other claims as they were originally filed.

In 1994, Intermatic sued Lamson & Sessions, alleging that Lamson's electrical outlet covers infringed a patent owned by Intermatic. Intermatic's patent claimed outlet covers in which an

insert was fitted to a base plate. As a result of a reexamination proceeding initiated by Lamson after Intermatic filed suit, claim 14 of Intermatic's patent was amended. Instead of stating that the insert was "adapted to be *mounted* in the base," the amended claim provided that the insert was "adapted to be *accommodated within the aperture* in the base." This "insert within the aperture" limitation had been included in other claims of the issued patent and had been present in those claims when the application was filed.

After the reexamination proceeding concluded, the district court granted summary judgment of no literal infringement. Nonetheless, a jury found infringement under the doctrine of equivalents, and awarded Intermatic \$12.5 million in damages. The district court then denied Lamson's motion for judgment as a matter of law that prosecution history estoppel barred a finding of infringement under the doctrine of equivalents.

The Federal Circuit reversed. The Court found that the amendment to claim 14 during reexamination barred application of the doctrine of equivalents not only as to the amended limitation in claim 14, but also as to corresponding "insert within the aperture" limitations in other claims in which the limitation always had been present. Although the "insert within the aperture" limitation was worded differently in other claims, the Court determined, in the absence of argument to the contrary, that these different versions of the "insert within the aperture" limitation should be interpreted identically and were subject to the bar on equivalents.

The Court also found that the bar applied retroactively as of the patent's issue date, even though the amendment was made as part of a post-issue reexamination.

The *Intermatic* decision makes clear that claim amendments can create bars to equivalents that apply even to unamended claims and that apply retroactively. The ultimate significance of the decision depends, of course, on whether the Supreme Court upholds *Festo's* more general rule. If the Supreme Court affirms *Festo's* holding that any narrowing amendment made for a reason related to patentability creates a bar to equivalents of the amended limitation, there will remain the question of how much limitations in two different claims must differ if estoppel as to one is to apply to the other as well. In addition, the *Intermatic* decision suggests the possibility that the *Festo* "narrowing amendments create an estoppel" rule could cause an amendment in a continuation or divisional application to apply retroactively to an earlier issued

patent.

More generally, the *Intermatic* decision illustrates why it is desirable to pursue a variety of claim approaches and to consider different ways of expressing inventive concepts.

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