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New Guidelines For Prosecution History Estoppel In The New En Banc *Festo* Decision (*Festo IX*)

On September 26, 2003, the Federal Circuit issued another en banc decision (thirteen judges, with a concurring and a dissenting opinion) in the long running *Festo* litigation concerning the issue of prosecution history. The Federal Circuit in *Festo Corp v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 95-1066 (Fed. Cir. 9/26/2003)(*Festo IX*), responded to the Supreme Court's reversal and remand of the Federal Circuit's previous *Festo* holding (*Festo VII*) severely limiting a patent's scope when its claims are amended during prosecution in the Patent and Trademark Office. See *Festo Corp v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U. S. 722 (2002)(*Festo VIII*).

Applying the Supreme Court's holdings in *Festo VIII*, the Federal Circuit articulated the following procedure for determining whether claim amendments result in the surrender of a patent's scope under the doctrine of equivalents:

- First, was there an amendment to the claim during prosecution that narrowed its literal scope?
- Second, if the claim was narrowed, did the amendment substantially relate to the patentability of the claim? If there is no explanation for the amendment, then it is the patent owner's burden to rebut the presumption that the amendment was for substantial patentability reasons, using only evidence from the prosecution history.
- Third, if the narrowing amendment was for substantial patentability reasons, then what is the scope of subject matter surrendered by the amendment?
- It is presumed that the patent owner surrendered *all* of the claim scope between the original claim and the amended claim, unless the patent owner proves that the alleged infringement was (1) "unforeseeable" at the time of the amendment; (2) "tangential" to the reason for the amendment or (3) that there is "some other reason"

suggesting that the patent owner could not reasonably have been expected to literally claim the alleged equivalent.

Whether the alleged infringement was "unforeseeable," is an issue of law for the court to decide, not a jury. This may require limited fact findings by the trial judge, applying the following criteria:

- This is an objective inquiry based on the information available to one of ordinary skill in the art at the time of the amendment, and expert testimony and other evidence extrinsic to the patent and its prosecution history may be considered.
- If the alleged equivalent is (1) later-developed technology or (2) technology that was not known in the relevant art at the time of the amendment, then it typically will be considered "unforeseeable."
- However, if the alleged equivalent was "known in the prior art in the field of the invention, it certainly should have been foreseeable at the time of the amendment" and therefore could not be covered under the doctrine of equivalents.

To rebut the presumption of prosecution history estoppel because the amendment was "tangential", the patent owner must prove that "the rationale underlying the narrowing amendment [bore] no more than a tangential relation to the equivalent in question." 535 U.S. at 740. This is an issue of law using the following criteria:

- Whether an amendment is "tangential" is based on the patentee's objective intent discernible only from the prosecution history record.
- An amendment made to avoid prior art that contains the equivalent in question is not tangential: it is normally central to allowance of the claim.
- This determination should be made without reference to evidence outside the prosecution history, except for testimony concerning the interpretation of that record by those skilled in the art, if necessary.

The "other reasons" that can overcome the presumed prosecution

history estoppel must establish that "the patentee could not reasonably be expected to have described the insubstantial substitute in question." 535 U.S. at 741. This also is an issue an issue of law using the following criteria:

- This is a narrow category allowing a patentee to justify the application of the doctrine of equivalents for reasons other than "unforeseeability" and "tangentialness."
- This "third criterion may be satisfied when there was some reason, such as the shortcomings of language, why the patentee was prevented from describing the alleged equivalent when it narrowed the claim."
- The evidence for such "other reasons" also is limited to the prosecution record, when at all possible. The Federal Circuit did not decide what kinds of extrinsic evidence could be considered.

The Federal Circuit, in addition, used *Festo IX* as an opportunity to point out its previous rulings expressly and implicitly endorsed by the Supreme Court:

- A narrowing amendment to comply with any provision of the Patent Act, including 35 U.S.C. §112, normally is for substantial patentability reasons and can create a prosecution history estoppel.
- Voluntary also amendments may create a prosecution history estoppel.

This ninth installment in the *Festo* litigation still leaves several issues open, such as the grounds and evidence constituting the "other reasons" that will rebut the presumption of prosecution history estoppel, and the evidence that is relevant to the "foreseeability" issue. We, however, may yet see further guidance from the court in *Festo X*. The Federal Circuit remanded the case back to the district court to determine whether the patent owner, Festo, preserved its right to pursue the alleged infringer under the doctrine of equivalents because the alleged infringement was "unforeseeable" (although the court strongly suggested that the alleged equivalent was, in fact, known and "foreseeable").

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