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**U.S. Supreme Court Restores Doctrine of Equivalents**

In a unanimous decision dated May 28, 2002, the U.S. Supreme Court overruled the decision of the Court of Appeals for the Federal Circuit in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000), and held that application of the Doctrine of Equivalents is not automatically barred under the Doctrine of File Wrapper Estoppel simply because the claim was amended during prosecution for purposes of patentability.

The Doctrine of Equivalents permits a patent owner to extend the scope of a patent claim beyond the literal language of the claim in certain circumstances. The Federal Circuit's decision in *Festo* in November 2000 significantly limited application of the Doctrine of Equivalents by automatically barring the Doctrine whenever the file history reveals that the patentee narrowed the scope of a claim limitation by amendment for any reason related to patentability. By overruling the Federal Circuit's automatic bar, the Supreme Court has confirmed that the Doctrine of File History Estoppel is a flexible bar that forecloses some but not all assertions of equivalents.

To determine whether the Doctrine of Equivalents can be applied, the purpose of the amendment, the scope of the amendment and the alterations in the text of the patent claims must be examined on a case-by-case basis. The Supreme Court recognized that the flexible bar does establish some uncertainty in the scope of a patent claim, but the uncertainty has always been recognized and is tolerated to ensure that the value of the patent is not defeated by "insubstantial alterations that are not captured in the drafting of the original patent claim but which could be created through trivial changes." According to the Supreme Court, the use of the flexible bar is necessary to provide "the appropriate incentives

for innovation” and to ensure that amended patent claims extend to “equivalents unforeseeable at the time of the amendment and beyond a fair interpretation of what was surrendered”. The Court also said there is no reason “to foreclose claims of equivalence for aspects of the invention that have only a peripheral relation to the reason the amendment was submitted”.

The Supreme Court recognized that amendments to patent claims for purposes of patentability often narrow the scope of the claim, and the Doctrine of File Wrapper Estoppel correspondingly limits the equivalents that can be asserted by the patent owner. The Supreme Court additionally confirmed that “even if the amendment’s purpose were unrelated to patentability, the court might consider whether it was the kind of reason that nonetheless might require resort to the estoppel doctrine”, citing from Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997). “Prosecution history estoppel . . . preclud[es] a patentee from regaining, through litigation, coverage of subject matter relinquished during prosecution of the application for the patent”.

While the Supreme Court’s decision is certainly good news to the patent owners, the Court also imposed the burden on the patent owner to establish his right to expand the literal scope of the patent claim under the Doctrine of Equivalents. The Court stated “[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”. Thus, “the patentee bears the burden of proving that an amendment was not made for a reason that would give rise to the estoppel” and “the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question”. If the file history does not contain an explanation for the amendment, “the court should presume that the patent applicant had a substantial reason related to patentability for including the limiting element added by the amendment”. This guidance from the Court suggests that amendments should be explained and justified in the file history in order to preserve some claim to equivalents.

## **Our Assessment**

The Supreme Court’s decision is particularly good news for the patent owners. The Supreme Court has confirmed that the Doctrine of Equivalents can be employed in many situations which were automatically barred under the Federal Circuit’s decision in Festo.

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However, the application of the Doctrine of Equivalents will continue to be limited by the Doctrine of File Wrapper Estoppel. The patent owner bears the burden of establishing that amendments made to the patent claims during the course of patent prosecution did not foreclose application of the Doctrine of Equivalents.

If you have any specific questions regarding the Supreme Court's decision, or would like a copy of the Supreme Court's Opinion, feel free to contact us.